

CHAPTER XIV.

DETERMINATION OF TRADE-MARK RIGHTS.

| | PAGE |
|---|------|
| 1. Loss of distinctiveness | 339 |
| by the action of the proprietor | 340 |
| by extensive piracy | 341 |
| test whether the mark is <i>publici juris</i> | 342 |
| mark <i>publici juris</i> for a particular class | 342 |
| 2. Separation of the mark from the goodwill | 343 |
| sect. 70 | 343 |
| removal of the mark | 344 |
| temporary separation from goodwill, or disuse of mark, is im- material | 345 |
| 3. Abandonment | 346 |
| agreement to abandon | 346 |
| not mere disuse of mark | 346 |
| adoption of a new mark | 347 |
| use with the proprietor's name | 347 |
| neglect to prosecute infringements | 347 |
| Sheffield corporate mark by non-registration | 348 |
| 4. Forfeiture of right to protection | 348 |
| 5. Removal of mark from the Register | 348 |
| where it has determined | 348 |
| for non-payment of fees, sect. 79 | 349 |
| new mark may be deceptive by resembling the removed mark | 350 |
| cause of the removal to be registered | 351 |
| fees and forms | 351 |

Modes of de-
termination.

THE right of the proprietor of a mark (subject to the rights of other proprietors, if any, of the same mark (a)) to the exclusive use of it upon the goods of the kind in respect of which the right existed is determined:—

- (1) When the mark so used ceases to be distinctive;

(a) See the three mark rule, p. 214, and sect. 87, p. 331.

- (2) When the proprietor is no longer able to use it in the business in connection with which the right was acquired;
- (3) When he has abandoned it; and
- (4) When he has forfeited his claim to protection of his right by using the mark deceptively or in a fraudulent trade (b).

In the first case the mark can no longer be the subject of trade-mark rights, and anyone may use it; but in the others, if there are any independent proprietors of the mark for the same class of goods, their rights will be unaffected by the determination; and in the third and fourth cases their rights will continue to be qualified by his right to use the mark himself on the goods, so long as he uses it in the business in connection with which it was acquired.

The proprietor may, in general, use the mark after his exclusive rights have determined.

1. Loss of Distinctiveness.

The first case follows immediately from the definition of a trade-mark given in Chapter II. It is there shown that the function of a trade-mark is to distinguish the goods to which it is applied or attached from similar goods, and to identify them with a particular trader and his successors in business. And distinctiveness is an essential condition of capacity for registration under the Acts (c). Further, the test of infringement is that the use of the mark, or of a similar mark, by others than the proprietor, is calculated to cause their goods to be bought as his (d). So that, apart from the Acts, a mark which has ceased to be distinctive is incapable of being the subject of trade-mark rights, and no action for infringement could be successfully brought to prevent any trader using it, and if not already registered, it would be incapable of registration under the Acts.

The elements of distinctiveness have been considered at How dis-

(b) See Chap. XV., "the action for infringement," defences, pp. 397 *et seq.*

(c) Chap. VIII. p. 115.

(d) *Mitchell v. Henry*, 15 C. D. 181 (1880), James, L. J.; *Edwards v. Dennis*, 30 C. D. 454 (1885), Cotton, L. J.; see also *Ford v. Foster*, 7 C. D. 611, cited below, p. 342.

distinctiveness
may be lost.

length elsewhere (*e*), and it will be sufficient here to refer to some of the modes in which a mark may cease to be distinctive, and to give a few examples of cases in which the question has arisen. Marks are not distinctive if they are descriptive (*f*), and, in particular, if they have been adopted in the trade concerned as the names of the goods for which they are claimed as trade-marks (*g*), or are common marks (*h*), or marks common to the trade (*i*), or if they connect the goods not with their proprietor but with some other trader (*k*).

By the action
of the pro-
priator.

Distinctiveness may be lost through the action of the proprietor, or by reason of successful piracy.

Thus, if the proprietor abandons his mark (*l*), it will almost inevitably become a common mark, unless there are other persons who have trade-mark rights in it which they assert (*m*). So, if he uses it himself as the name of the goods he deals in, the trade will probably adopt the same course, especially if he is for a time the only dealer in the goods (*n*).

Before the Registration Acts a difficult question of fact was often raised in trade-mark cases where admittedly a name or other mark had been introduced by the plaintiff, but it was alleged that it had by repeated use on the goods of other traders lost its original significance indicating a connection with the plaintiff, and had become *publici juris* (*o*). A case of this type recently came before the Privy Council on appeal from New South Wales in *The National Starch Manufacturing Company v. Munn's Patent Maizena, &c. Company* (*p*). The

(*e*) Chap. II., p. 34; Chap. VIII., p. 132.

(*f*) See above, descriptive marks, p. 36; devices, p. 145; words, p. 163.

(*g*) Page 36.

(*h*) Page 135; see also the "three mark rule," Chap. IX. p. 205.

(*i*) Page 206.

(*k*) *Wood v. Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A. (*Eton Cigarettes*); *Wolff v. Nopitsch*, 17 R. P. C. 321 (1900), Cozens-Hardy, J. (*Spanish Graphite*). See, however, in C. A., 18 R. P. C. 27 (1901).

(*l*) See below, p. 346.

(*m*) As, for instance, in *Daniel & Arter v. Whitehouse*, (1898) 1 Ch. 685; 15 R. P. C. 134; Barnes, J., a passing-off case, where the defendant lost a concurrent right by non-user for some years.

(*n*) *Linoleum Manufacturing Co. v. Nairn*, 7 C. D. 834 (1878), Fry, J.

(*o*) See *Ford v. Foster*, 7 Ch. 611 (1872); *Singer Manufacturing Co. v. Wilson*, 2 C. D. 434; 3 App. Ca. 376 (1875).

(*p*) (1894) A. C. 275; 11 R. P. C. 281.

plaintiffs had invented the word *Maizena* for flour made from maize and had introduced flour under that name to New South Wales in 1863, but they had not registered the word there until 1889. The defendants' predecessors commenced to sell *Maizena* in New South Wales in 1867, and the plaintiffs took no steps against them there until the action, which was founded on the trade-mark and common law rights, but they had taken proceedings successfully in other countries to restrain the use of *Maizena* in connection with the defendants' flour. It was held that, in view of the use in New South Wales by the defendants and other firms of the word in question before 1889, it had become *publici juris*, and the action was dismissed and the mark removed from the Register. The plaintiffs contended that the defendants' user had been originally fraudulent and was continued in fraud, but this was not so found. On this point Lord Ashbourne said: "If during the period in question (*q*), the word was only used in the colony for the fraudulent purpose of counterfeiting their goods, the right of the appellants to register it as their trade-mark would not be impaired. If, on the contrary, it was used and understood before 1889 as a term descriptive of the article, as a product of maize, and did not denote such product to be the manufacture or merchandise of a particular person, then it must be regarded as having become, in the sense of law, *publici juris*." The difficulty is not so likely to arise in the case of a registered mark, since the public advertisement of the registration, and the readiness with which the infringement of a properly registered mark can be prevented under sect. 76, both tend to warn other traders against the use of the mark and to enable the proprietor to protect his rights.

Extensive infringement by a single trader can hardly suffice to make a trade-mark common. "It has been said that one murder makes a villain, and millions a hero; but I think it would hardly do to act on that principle in such matters as this, and to say that the extent of a man's piratical invasion of his neighbour's rights is to convert his piracy

By extensive piracy.

into a lawful trade" (r). Nor will a few unprosecuted scattered infringements by several traders (s).

The test whether a mark has become *publici juris*.

"There is no doubt, I think," said Mellish, L. J., in *Ford v. Foster* (t), "that a word which was originally a trade-mark, to the exclusive use of which a particular trader, or his successors in trade, may have been entitled, may subsequently become *publici juris*, as in the case which has been cited of *Harvey's Sauce* (u). I think the test must be whether the use of it by other persons is still calculated to deceive the public (x), whether it may still have the effect of inducing the public to buy goods not made by the original owner of the trade-mark as if they were his goods. If the mark has come to be so public and in such universal use that nobody can be deceived by it, and can be induced from the use of it to believe that he is buying the goods of the original trader, it appears to me, however hard to some extent it may appear on the trader, yet practically, as the right to a trade-mark is simply a right to prevent the trader from being cheated by other person's goods being sold as his goods through the fraudulent use of his trade-mark, the right to the trade-mark must be gone" (y).

A mark may be *publici juris* in a particular branch of the trade only.

Upon the facts of the case, the Lords Justices held that the name in question had become *publici juris* to this extent, "that by the use of it in trade circulars, which are issued only to retail dealers, or by shirts being invoiced by the wholesale dealers as '*Eureka Shirts*,' no retail dealer would be likely to be deceived, or be led to buy shirts which were not made by Ford believing they were Ford's shirts," but that a considerable portion of the public who buy shirts for the purpose of wearing them would still be very liable to be

(r) Per James, L. J., in *Ford v. Foster*, L. R. 7 Ch. p. 625.

(s) *Kinahan v. Bolton*, 15 Ir. Ch. 75 (1863), Brady, C.; *Rowland v. Michell*, below, note (a).

(t) L. R. 7 Ch. p. 628 (1872).

(u) *Lazenby v. White*, 41 L. J. Ch. 354 (1871).

(x) So the long duration of fraudulent user is immaterial if it is still

calculated to deceive: *Heaton's Tm.*, 27 C. D. 570 (1884), Kay, J. (*Hoop L Iron*); and the judgment of Lord Ashbourne in the *Maizena Case*, quoted above, p. 341.

(y) See also *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238, n.; and *Hyde & Co.'s Tm.*, 7 C. D. 724, both (1878), Jessel, M. R.

deceived by the use of the word *Eureka* on the shirt itself. And the injunction granted by the Court accordingly left the defendants at liberty to advertise the name *Eureka* as between themselves and the trade (s).

Where a plaintiff is alleged to have lost his rights by not interfering with infringers, the character and extent of the trade of the latter, as well as their position, must be taken into account in considering whether he is barred by his neglect to take proceedings (a).

2. Separation of the Mark from the Goodwill.

It has been shown in the last chapter that the trade-mark rights in a mark are inseparable from the goodwill of the business in the goods upon which the mark is used, for the function of the mark is to connect the goods with the trader who owns the business, and his successors (b). The indication of that connection is its original signification, and it cannot legally be used as a trade-mark with any other (c). It follows that if the goodwill is lost, or passes into other hands than those of the proprietor of the mark (d), the exclusive rights of the proprietor in respect of the use of the mark are determined, and this rule is recognized by the Acts in the case of registered marks. Sect. 2 of the Act of 1875, and sect. 70 of the present Act of 1883, enact that a trade-mark "shall be assigned and transmitted only in connection with the goodwill of the business concerned in the particular goods or classes of goods" for which it has been registered, and the latter section expressly adds "and shall be determinable with such goodwill." And, although an assignment of

(s) L. R. 7 Ch. p. 634; cf. *Singer, &c. Co. v. Spence*, 10 R. P. C. 297 (1893), Romer, J.

(a) *Rowland v. Mitchell*, 13 R. P. C. 457; 14 R. P. C. 37 (1897), Romer, J., and C. A.; and see also *Ripley v. Bandy*, 14 R. P. C. 591 (1897), Kekewich, J., where judgment was given for the defendant on the ground of the neglect of the plaintiff to assert his right against in-

fringers. An appeal was settled, 14 R. P. C. 944.

(b) See the judgment of Mellish, L. J., in *Ford v. Foster*, cited above, and Chap. II., p. 23.

(c) See the judgment of Fry, L. J., in *Pinto v. Badman*, 8 R. P. C. 181 (1891), cited above, p. 328.

(d) *Thorneloe v. Hill*, 11 R. P. C. 61 (1894); and cf. *Harness' Tm.*, 17 R. P. C. 40 (1900).

a trade-mark be inoperative by reason of being an assignment in gross, the assignor may lose his right to the mark by such assignment, at all events if the assignee has acted upon the assignment. Thus, where an exclusive licence in gross for a term of years to use a trade-name was granted, it was held that the assignor had at the end of the term lost his right to claim that the name indicated his manufacture (*e*).

No exclusive right in a registered mark apart from the goodwill.

No question arises as to whether the registered owner of a trade-mark which has determined by separation from the goodwill of the business can sue for infringement; for sect. 76, which grants the right of exclusive use to the proprietor of a registered mark, makes the grant "subject to the provisions of this Act," and consequently subject to sect. 70.

Removal of mark when the goodwill is determined (*f*).

It was provided by Rule 34 of the Rules of 1876, for which the Rules of 1890 are now substituted, that—"The Court may, on the application of any person aggrieved, remove any trade-mark from the Register on the ground, after the expiration of five years from the date of the registry thereof, that the registered proprietor is not engaged in any business concerned in the goods within the same class as the goods with respect to which a trade-mark is registered." And in *Ralph's Case* (*g*), where the registered proprietor had not manufactured the machine for which the mark was registered for twenty-one months before the date of the application, Pearson, J., in accordance with the rule, directed the mark to be removed.

The rule has not been re-enacted, and there is now no express provision enabling a properly registered mark to be removed except for non-payment of fees after fourteen years (*h*), or at the request of the proprietor (*i*). But a mark is not properly registered, and it may be removed, if it was not registered with a *bonâ fide* intention to use it for the goods in respect of which it is registered (*k*); and the judgment of the Court of Appeal in *Batt's Trade-Mark*

(*e*) *Thorneloe v. Hill*, 11 R. P. C. 61 (1894), Romer, J.

(*f*) See below, p. 348.

(*g*) 25 C. D. 194 (1883), cited below, p. 345.

(*h*) Sect. 79.

(*i*) Sect. 91.

(*k*) *Batt v. Dummett*, [1899] A. C. 428; 16 R. P. C. 411; and *supra*, pp. 119 *et seq.*

supports the proposition that if at any time after registration the proprietor ceases to have such intention, the mark is on the Register without sufficient cause and may be removed (*l*).

A mere temporary cessation of business (*m*), or delay in the transfer of the goodwill (*n*), would not determine the trade-mark rights. The judgment of Pearson, J., in *Ralph's Case* (*o*), notwithstanding the repeal of the Rule on which it was founded, may be useful to indicate what length of cessation of a business determines the goodwill, and therefore also the trade-mark rights attached to it. "The only question I have to determine," he said, "is whether one year and nine months is sufficient cesser on the part of Mr. Ralph to show that he comes within the (14th) rule. I am of opinion that one year and nine months is quite sufficient. If I had any doubt about it, I am able by analogy to say that I should not be wrong in concluding that one year and nine months is sufficient, from the fact that under the Companies Act you may wind up a company if it has ceased to carry on business for a year. The legislature in that has shown by its enactment when a business is supposed to be carried on, and what amount of cesser shows that the business is not being carried on." And it made no difference, he held, that the cessation of business was due to the ill-health of the proprietor.

Temporary separation from the goodwill or disuse of mark is immaterial.

In a case where the licensees of a patent had, by arrangement with the patentees, registered a trade-mark and used it on the patented goods, and on the determination of the licence the patentees contended that the mark ought to be expunged from the Register on the ground that the goodwill of the licensees had determined, as they could not make the patented goods, the application was dismissed, it being held that the mark in fact indicated the licensees as the source of the goods (*p*).

(*l*) [1898] 2 Ch. 432; 15 R. P. C. 534. *Brunker*, 9 R. P. C. 301 (1892), both Chitty, J.

(*m*) See the next page.

(*o*) Above, p. 344.

(*n*) *Welcome's Tm.*, 32 C. D. 76; 3 R. P. C. 213 (1886); *Hammond v. North*, J.

(*p*) *Freeman Bros. v. Sharpe Bros. & Co., Ltd.*, 16 R. P. C. 205 (1899), North, J.

3. Abandonment.

A trade-mark right, as any other right, can, of course, be abandoned by the owner; but, so long as he remained the registered proprietor of the mark and carried on the business to which the mark was attached, it would be difficult, if not impossible, to show abandonment, unless, either by repeated and undisturbed infringements, or by the use of the mark by the proprietor himself in some way inconsistent with the maintenance of its character as a trade-mark, it had become a common mark so as to fall under the first case (*q*), or a case could be made by any particular defendant sued for infringement by the owner to show that he had been led by the conduct of the plaintiff to believe that the mark was a common mark, and so to set up an estoppel (*r*).

Agreement to
abandon
trade-mark.

The possible case of an agreement by the proprietor to abandon his mark stands by itself. The other party to the agreement, if sued for infringement, could no doubt rely upon it as a defence, and might possibly, if the mark were registered, obtain the removal of the mark from the Register, or an order, by way of specific performance of an implied term in the agreement, that the proprietor should apply under sect. 91 to cancel the registration.

Not mere
disuse.

Mere disuse of the mark does not amount to abandonment of trade-mark rights in respect of it. For "A man who has a trade-mark may properly have regard to the state of the market and the demand for the goods; it would be absurd to suppose that he lost his trade-mark by not putting more goods on the market when it was glutted" (*s*). Accordingly, in the

(*q*) Above, p. 339.

(*r*) See the next chapter: estoppel, p. 390; acquiescence, p. 392; and delay, p. 394. See also *Brown v. Freeman*, 12 W. R. 305; 4 New Rep. 476 (1864), Wood, V.-C., where the dismissal on his own request, of a previous suit by the plaintiff against the defendant, to restrain the use by

the latter of *Chlorodyne*, was treated as conclusive against him that he had no exclusive right to use the word. He brought a third suit in 1873: W. N. 178.

(*s*) Per Chitty, J., in *Mouson v. Boehm*, 26 C. D. 398 (1884). But if in the meantime the mark had come to indicate exclusively the manufac-

case cited, a mark was directed to be registered concurrently with a similar mark in the same class which had been previously registered, and which the Court refused to expunge, although the proprietor of the former mark, having adopted it in 1874 and used it largely in the two years following, from 1876 to 1882 had used it less and less, and had in the last-mentioned year forgotten and ceased to use it altogether. He had not, however, broken up the moulds he used for the marked goods, or erased the mark from his books or price lists. But if a proprietor ceases to have an intention of dealing in the goods for which the mark is registered, that would necessarily entail an abandonment of the mark so far as such goods were concerned (*t*).

The adoption of a new mark may be evidence of the abandonment of an old one (*u*). But the fact of itself is not conclusive, for it is no justification for the defendant to say, "The plaintiff has two ways of identifying his goods, and I have only stolen one of them" (*x*). So where, in opposition to the registration in 1896 of a mark as an old mark, it was shown that a new label had been adopted in 1877, and it was contended that the old mark had been abandoned either then or previously, but it was proved that a large number of the old labels had been ordered in 1877, and that they had been occasional user of them since, and that the stock of them had never been exhausted, it was held that there had been no abandonment (*y*). The fact that the owner of a word-mark uses it always in connection with his own name is not conclusive to show that the mark is not a trade-mark, or that he has waived his rights in it as such (*x*).

Adoption of a new mark.

Use in connection with the proprietor's name.

Neglect to proceed in respect of infringements which do not amount to user sufficient to affect the distinctiveness of

Neglect to prosecute infringements.

ture of the registered owner, its use by another would have been deceptive. Cf. *Daniel & Arter v. Whitehouse*, [1898] 1 Ch. 685; 15 R. P. C. 134 (a passing-off case).

(*t*) *Batt's Tm.*, see above, p. 119.

(*u*) *Lea v. Miller*, Seb. Dig. p. 305 (1876), Jessel, M. R.

(*x*) Per Wood, V.-C., in *Braham v. Bustard*, 1 H. & M. 447; 9 L. T. N. S. 199 (1863) (*Excelsior White Soap*).

(*y*) *Wright, Crossley & Co.'s Application*, [1900] 2 Ch. 218; 17 R. P. C. 386, Byrne, J.

the mark does not affect the proprietor's rights if he is aware of the infringements (*z*), still less if he is not (*a*).

Old corporate
mark.

A corporate trade-mark, not re-registered in the Sheffield Register before the 1st of January, 1889, is to be deemed to have been abandoned (*b*).

4. Forfeiture of Right to Protection.

The forfeiture of the right of the proprietor of a trade-mark to have his trade-mark protected by the Court is discussed elsewhere, under the head of defences to an action for infringement (*c*).

5. Removal of Mark from the Register.

Where the
trade-mark
has deter-
mined.

No provision is expressly made in the present Act or Rules for the removal from the Register of marks in which the trade-mark rights have determined, except for non-payment of fees. Rule 34 of the Rules of 1876 has not been renewed (*d*); and the Court is not constituted the custodian of the Register by any part of the Acts, but is expressly empowered by sects. 90 and 92 to make orders affecting it in the cases included under the sections respectively. It is submitted, however, that the Court has jurisdiction, even if sect. 90 does not apply, to order the registration of a mark which is no longer a trade-mark to be expunged, on the ground that the Register is intended by the Acts to be a register of trade-marks only (*e*). In *Welcome's Case* (*f*), Chitty, J., upon an application under sect. 78, directed an assignment to be registered, although that section contains no reference to the Court, or to rectifica-

(*z*) *Kinahan v. Bolton*, 15 Ir. Ch. 75 (1863), Brady, C.; *Ford v. Foster*, L. R. 7 Ch. 611 (1872), L. JJ.; *Rowland v. Mitchell*, 13 R. P. C. 457; 14 R. P. C. 37 (1897), Romer, J., and C. A.; and see above, p. 313.

(*a*) *Re Farina*, 27 W. R. 456 (1879), Hall, V.-C. See the next chapter, p. 394.

(*b*) Sect. 81 (9).

(*c*) Chap. XV., p. 397.

(*d*) Above, p. 344.

(*e*) See sect. 78.

(*f*) 32 C. D. 213; 3 R. P. C. 76 (1886); and cf. *New Ormonde Cycle Co.'s Tm.*, (1896) 2 Ch. 520; 13 R. P. C. 475.

tion of the Register; but the question of jurisdiction, so far as can be gathered from the report, was not argued. The Court of Appeal has, however, recently expressed the view that the words in sect. 90, "made without sufficient cause," do not refer exclusively to the time of registration, and that if an entry is at any time on the Register without sufficient cause, it may be removed or varied (*g*); and upon this construction of sect. 90 a mark in which the trade-mark rights have determined can, of course, be removed from the Register on the application of any person aggrieved.

It is provided by sect. 79, that:—

"(1.) At a time not being less than two months nor more than three months before the expiration of fourteen years from the date of the registration of a trade-mark, the Comptroller shall send notice to the registered proprietor that the trade-mark will be removed from the Register unless the proprietor pays to the Comptroller before the expiration of such fourteen years (naming the date at which the same will expire) the prescribed fee; and if such fee be not previously paid, he shall, at the expiration of one month from the date of the giving of the first notice, send a second notice to the same effect.

For non-payment of fees.

"(2.) If such fee be not paid before the expiration of such fourteen years, the Comptroller may after the end of three months from the expiration of such fourteen years remove the mark from the Register, and so from time to time at the expiration of every period of fourteen years.

"(3.) If before the expiration of the said three months the registered proprietor pays the said fee together with the additional prescribed fee, the Comptroller may without removing such trade-mark from the Register accept the said fee as if it had been paid before the expiration of the said fourteen years.

Restoration of the mark.

"(4.) Where after the said three months a trade-mark

(*g*) *Balt's Tm.*, [1895] 2 Ch. 432; 14 R. P. C. 534; and see Chap. XI., p. 277. In the view which the Court took of the facts the point did not actually arise for decision.

has been removed from the Register for non-payment of the prescribed fee, the Comptroller may, if satisfied that it is just so to do, restore such trade-mark to the Register, on payment of the prescribed additional fee.

Removed
mark an ob-
stacle to later
registrations.

“(5.) Where a trade-mark has been removed from the Register for non-payment of the fee, or otherwise, such trade-mark shall nevertheless, for the purpose of any application for registration during *the five years* [one year] (*h*) next after the date of such removal, be deemed to be a trade-mark which is already registered [unless it is shown to the satisfaction of the Comptroller that the non-payment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under the proprietor or under his bankruptcy is using the trade-mark]” (*h*).

The section corresponds to Rules 30 to 33 of the old Rules of 1876.

Sub-sect. (5) refers to sect. 72 (*i*). It is directed to prevent the registration by another trader for the same goods or description of goods, of a mark the same as the removed mark, or having such resemblance to it as to be calculated to deceive, until such time after the removal of the other as is considered sufficient to allow the other to be forgotten, so that the new mark may not be taken for that of the proprietor of the old mark. The period provided for by the Act of 1883 was five years, but this was altered by the Act of 1888 to one year on the recommendation of Lord Herschell's Committee (*k*). With their approval also the proviso “unless, &c.” was added at the end of the sub-section, it being considered unnecessary to refuse the re-registration of the mark for a year if the late proprietor were dead or bankrupt, and no one claiming under his bankruptcy were using the mark, and if any other successor to his business neglected to pay the fee.

A new mark
may be de-

Notwithstanding the amendments, it is assumed that, so

(*h*) Act of 1888, s. 19.

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

(*k*) Report of 1888, p. xiii.

long as the recollection of the removed mark survives in the trade, the use of it, or a mark resembling it, might be calculated to deceive, and might therefore be properly refused by the Comptroller under sect. 73, or in his discretion.

ceptive by
resemblance
to a removed
mark.

It is provided by Rule 47 that: "Where a trade-mark has been removed from the Register for non-payment of the prescribed fee, or otherwise, under the provisions of sect. 79 of the said Act, the Comptroller shall cause to be entered in the Register a record of such removal and the cause thereof."

Cause of
removal to be
registered.

The fee for continuance of a registered mark at the expiration of fourteen years is 1*l*. Where the fee is not paid within three months after the expiration of the fourteen years there is an additional fee of ten shillings. The additional fee for restoration of a trade-mark where it has been removed for non-payment of the fee is 1*l*. (l). The forms of applications for continuance and restoration are Forms X, Y, and Z (m).

Fees.

Forms.

(l) Appendix, p. 703.

(m) *Ibid.* p. 714.

CHAPTER XV.

THE ACTION FOR INFRINGEMENT.

| | PAGE |
|---|------------|
| Comparison with passing off action | 353 |
| 1. Commencement of the action | 355 |
| in what court | 355 |
| service out of the jurisdiction | 356 |
| notice of action unnecessary | 357 |
| agents and partners of infringer | 358 |
| 2. The plaintiff's title | 358 |
| joint trade-marks | 358 |
| contract for exclusive sale | 359 |
| one of several proprietors may sue | 360 |
| intention to use necessary | 360 |
| action by executors | 360 |
| 3. Registration | 361 |
| registration of assignment | 361 |
| registration as evidence of title | 361 |
| 4. What constitutes infringement | 363 |
| definition | 363 |
| isolated act of infringement | 364 |
| infringement must be within the realm | 365 |
| whether it must be in defendant's market | 365 |
| use on goods which are not the plaintiff's | 368 |
| (A) WHERE THE DEFENDANT COPIES THE PLAINTIFF'S MARK OR PRETENDS THAT IT IS HIS OWN | 371 |
| (B) WHERE HE COPIES AN ESSENTIAL FEATURE OF IT | 372 |
| (C) WHERE HIS MARK IS A COLOURABLE IMITATION OF IT | 373 |
| test of infringement | 373 |
| actual deception need not be proved | 375 |
| nor intention to deceive | 375 |
| what resemblance is calculated to deceive | 377 |
| principles of comparison summarised | 378 |
| what importance is to be attached to differences between the marks | 379 |
| inconspicuous additions or explanations: "late of," "from," "equal to" | 382 |
| 5. Defences | 382 |
| ATTACK ON THE PLAINTIFF'S TITLE OR THE REGISTRATION OF HIS MARK | 383 |
| CONCURRENT OR INDEPENDENT RIGHT | 384 |
| registration of the defendant's mark | 386 |
| introduction into a new market | 387 |
| trade-marks on dissolution of partnership | 388 |
| or bankruptcy | 389 |
| honest use of defendant's own name | 389 |

| 5. Defences—continued. | PAGE |
|---|------|
| ESTOPPEL | 390 |
| (a) personal estoppel | 390 |
| agreement to condone infringement | 390 |
| uncandid conduct | 391 |
| use of mark in unregistered form | 391 |
| (b) acquiescence | 392 |
| licence | 393 |
| (c) delay | 394 |
| delay may modify the relief, or amount to abandonment | 395 |
| it has a bearing on the evidence | 396 |
| (d) deceptive trade-mark or fraudulent trade | 397 |
| collateral misrepresentation | 398 |
| it is immaterial that the misrepresentation is too gross to deceive | 400 |
| false claim of patent rights | 401 |
| “trade-mark” affixed to part of mark only | 404 |
| false assertion of registration | 407 |
| other misleading statements | 408 |
| fraudulent trade | 409 |
| Havana cigars | 410 |
| misrepresentation after action commenced | 410 |
| 6. The relief granted | 411 |
| I. INJUNCTION | 411 |
| form | 413 |
| restricted to future consignments or a particular market | 414 |
| refused because of acquiescence | 414 |
| interim injunction | 415 |
| refused because of delay | 416 |
| enforcement of the injunction | 418 |
| choice of a new mark by the defendant | 419 |
| delay in application to commit | 419 |
| II. DELIVERY UP OF THE MARKED ARTICLES | 420 |
| erasure of the spurious marks | 420 |
| bailee is not bound to deliver spuriously marked goods | 422 |
| III. DAMAGES OR PROFITS | 422 |
| alternative | 425 |
| as against innocent persons | 426 |
| refused or limited because of delay, &c. | 426 |
| form of order | 427 |
| costs of inquiry or account | 427 |
| where the plaintiff is not solely entitled | 428 |
| 7. Costs | 429 |
| infringer must offer complete redress | 429 |
| stay of action | 431 |
| not given in trivial cases | 431 |
| where the plaintiff claims too much | 432 |
| successful defendant may be refused costs | 433 |
| costs on appeal | 434 |
| higher scale | 435 |
| certificate under sect. 77a, solicitor and client costs | 436 |
| costs of motion to rectify | 437 |
| 8. Appeal | 437 |
| 9. Practice | 438 |
| pleadings | 438 |
| particulars | 440 |
| discovery | 440 |
| inspection | 442 |
| evidence | 443 |

It is convenient to deal separately with actions which are brought to prevent or to recover damages for the infringement of trade-mark

and actions
for passing
off.

of trade-marks, and with what are compendiously described as "passing off actions." In an action of the first class the plaintiff complains that the defendant has infringed his trade-mark by taking it in its entirety, or by taking a substantial portion of it, or by colourably imitating it, and he relies on his title to the exclusive use of the mark in question for goods of a specified kind; in an action of the second class the plaintiff's case is less specialized, for he complains that the defendant is using means which are calculated to pass off, or to cause to be passed off, the goods of the defendant as and for those of the plaintiff, and the means may or may not comprise or consist of an infringement of a trade-mark to which the plaintiff has a title. The distinction between the two classes of actions has been accentuated by the provision, already discussed, which makes registration a condition precedent, in general, to the institution of actions ranking in the first class, that is, trade-mark actions proper (*a*). They are, however, closely connected, and in practice they are frequently combined, the statement of claim alleging both infringement and passing off. The first class is in reality a specialized variety of the second, having been divided off from other passing off actions when property in a trade-mark was first adopted as the ground of jurisdiction (*b*). Moreover, as the test of infringement is still whether, by reason of its resemblance to the plaintiff's mark, the defendant's mark is calculated to lead purchasers to believe that the goods on which it appears are those of the plaintiff, every case of infringement would be a case of passing off but for the fact that where the actual mark is taken, or an obvious imitation is made, the Court does not trouble to inquire whether deception is likely to result, and, in the former case, it seems that it is precluded from doing so by the provision that registration after five years shall give an exclusive title to the use of the registered mark (*c*).

(*a*) Chap. XII., p. 312.

(*b*) Chap. I., pp. 4 and 13.

(*c*) Sect. 76, Chap. XII., p. 306;
Edwards v. Dennis, 30 C. D. 454
(1885), C. A.

1. Commencement of the Action.

The great majority of actions in respect of the infringement of trade-marks are commenced in the Chancery Division of the High Court (*d*), but such actions are not specially assigned to that division, and they have been occasionally transferred from it to the Queen's Bench Division in order to be there tried by jury (*e*). This was done by Kay, J., in a case where the defendant submitted to a perpetual injunction and the question of damages only remained, on the ground that in trade cases a jury is the best tribunal to assess damages (*f*); but in an earlier case, where the right to the injunction was contested, the defendants having given notice requiring the trial to be by a judge and a special jury, Bacon, V.-C., ordered that the action should be by a judge alone (*g*). The last-named judge also refused to order the complicated and difficult case of *The Singer Manufacturing Co. v. Loog* (*h*) to be transferred to the Common Law Division so that the issues involved might be there tried with a jury, on the ground that the questions to be determined involved matters of law as well as fact, and were unfit to be dealt with by a jury.

In what Court a trade-mark action should be commenced.

Jury.

An action for damages not exceeding 50% for infringement of a trade-mark might probably be brought in the County Court, for it is a personal action, and does not fall within any of the exceptions of the County Courts Act, 1888, s. 56. In practice, however, such a course is rarely, if ever, adopted, and it was certainly not contemplated when the Trade-Mark Acts were passed; for the Court upon which jurisdiction is conferred to rectify the Register, to grant certificates to a successful litigant entitling him to solicitor and client costs (*i*) in future actions respecting the

Jurisdiction of the County Court.

(*d*) Or the Court of Chancery of the County Palatine of Lancaster. This Court has jurisdiction under the Patents, &c. Acts, s. 112a (Act of 1888, s. 26).

(*e*) See *Re Martin, Hunt v. Chambers*, 20 C. D. 365 (1882); and Ord. 36, r. 6.

(*f*) *Fennessy v. Rabbits*, 56 L. T. 138 (1887).

(*g*) *Spratt's Patent v. Ward & Co.*, 11 C. D. 240 (1879).

(*h*) 11 C. D. 656 (1879). In *Fennessy v. Clark*, 37 C. D. 184 (1887), the issues of fact were ordered to be tried by a judge and special jury.

(*i*) Sect. 77a (Act of 1888, s. 18).

same mark, and for other purposes, is the High Court (*k*). It has been held that an action for the infringement of a patent, the validity of which is disputed, cannot be brought in the County Court, on the ground that a patent is a franchise within the section 56 above mentioned (*l*); and in the judgments in the case referred to, some stress is laid upon the fact that the Patents, Designs, and Trade-Marks Act of 1883 does not contemplate that patent actions should be brought in a County Court, but this was not, and, it is submitted, could not have been, the ground of decision; for if the jurisdiction to try either patent or trade-mark actions exists in the County Court it is much older than the Act of 1883, and as a trade-mark right is not a franchise, the decision does not affect the jurisdiction to determine trade-mark actions which is apparently conferred by the County Courts Act.

Service out of the jurisdiction.

Service of the writ out of the jurisdiction may be allowed if the case falls under any of the classes enumerated in Order 11, rule 1, for instance, if the plaintiff seeks an injunction to restrain infringements within the jurisdiction (*m*); but if the defendant carries on business in Ireland or Scotland, and not at all, or only to an inconsiderable extent, in England, leave to serve the writ upon him in either of the first-mentioned countries will be refused, and the plaintiff will be left to pursue his remedies in the local courts (*n*). On this ground leave to serve out of the jurisdiction has been refused even where an application to register the defendant's mark was pending before the Comptroller in London on which the same witnesses would be required as in the action (*o*), and also where a motion to expunge the defendant's mark was pending in the English Courts (*p*). In the

(*k*) Sect. 117; or the Palatine Court, sect. 112a.

(*l*) *Queen v. County Court Judge of Halifax*, (1891) 2 Q. B. 263; 8 R. P. C. 338, Pollock and Charles, JJ., and C. A.

(*m*) See *Badische Anilin v. Johnson*, (1896) 1 Ch. 25; 12 R. P. C. 535, C. A.

(*n*) *Kinahan v. Kinahan*, 45 C. D. 78; 8 R. P. C. 18 (1890), Kekewich, J. As to the rectification of the registrations of marks belonging to foreigners, see Chap. XI., p. 288.

(*o*) *Marshall v. Marshall*, 38 C. D. 330 (1888), C. A.

(*p*) *Kinahan v. Kinahan*, *supra*; cf. *King & Co.'s Tm.*, (1892) 2 Ch. 462; 9 R. P. C. 350.

former case (*q*) the refusal was based partly on the fact that if an injunction were granted it could not be enforced against the defendant personally in England, but only against his agents. But where a Scotch manufacturing company had three branches and an important business in England, leave was granted to sue them here (*r*).

An alien, not being a subject of a country actually at war with England, if he is the proprietor of a trade-mark which exists as such in this country, may sue in the English Courts in respect of infringements in England (*s*). But sect. 77, prohibiting actions in respect of the infringements of unregistered trade-marks applies to trade-marks belonging to foreigners (*t*).

Actions by foreigners.

No notice need be given to the alleged infringer before the action is brought (*u*), and the plaintiff's right to bring the action is not affected by the ignorance of the defendant of the plaintiff's claim to the mark, or the readiness of the defendant to cease the infringement when called upon to do so (*x*). "A plaintiff in these cases," Chitty, J., said, in *Upmann v. Forester* (*y*), "is placed in circumstances of difficulty, because if he were to give notice there is great probability of the defendant at once getting rid of the spurious articles before the plaintiff could interfere; and the plaintiff therefore would in many instances be affording the defendant an opportunity of doing what the injunction would have prevented. I well remember that the late Master of the Rolls, Sir G. Jessel, stated that he was, when at the Bar, accustomed in cases like this to advise his clients not to give any notice, but to move at once" (*z*). And con-

Notice of action is unnecessary.

(*q*) *Marshall v. Marshall*, 38 C. D. 330 (1888), C. A.

(*r*) *Burland v. Broxburn Oil Co.*, 41 C. D. 542; 6 R. P. C. 482 (1889), Chitty, J.

(*s*) *The Collins Co. v. Brown*, 3 K. & J. 423 (1857), Wood, V.-C.; *The Collins Co. v. Reeves*, 28 L. J. Ch. 56 (1858), Stuart, V.-C.

(*t*) See *Goodfellow v. Prince*, 35 C. D. 9 (1886), C. A.; and above, Chap. XII., p. 316; although Malins,

V.-C., expressed a contrary opinion in *Twentsche, &c. v. Ellinger & Co.*, 26 W. R. 70 (1877).

(*u*) *Pierce v. Franks*, 15 L. J. Ch. 122 (1846), Knight-Bruce, V.-C.

(*x*) *Burgess v. Hately*, 26 Beav. 249 (1858), Romilly, M. R.

(*y*) 24 C. D. 231 (1883).

(*z*) *Ibid.* The very life of a trade-mark depends upon the promptitude with which it is vindicated. *Johnson v. Orr-Ewing*, 7 App. Ca. 219 (1882).

sequently the omission to give notice before action does not disentitle the plaintiff to costs (a).

Agents and partners of infringer.

The action is one of tort, and, consequently, every infringer is liable to be sued, whether he acted on his own behalf or as agent for a principal. But a mere servant should not, it seems, be added as a defendant (b). An innocent partner of the infringer defendant, who has repudiated the wrongful act of his co-partner, is not, it appears, liable to be sued (c).

2. The Plaintiff's Title.

The plaintiff must be owner of the trade-mark (d) which is alleged to have been infringed, and the onus of proving that he is entitled to the exclusive use of the mark for the particular class of goods (subject, if the case is so, to the concurrent rights of persons, other than the defendant, who are also owners of the same or a similar trade-mark) lies upon him (e). So where three persons, a manufacturer, a shipper and a foreign consignee, devised a trade-mark in concert, and used it for goods sent by the manufacturer through the shipper to the consignee, and afterwards the manufacturer began to use it for goods not sent through the shipper, and the shipper for goods not obtained from the manufacturer, and cross-actions for infringement were brought by the shipper

Joint trade-marks.

(a) See below, p. 429.

(b) *Daniel and Arter v. Whitchouse*, 16 R. P. C. 71 (1899), North, J. (a motion to commit).

(c) *Magnolia Metal Co. v. Atlas Metal Co.*, 14 R. P. C. 389 (1896), Collins, J., and C. A. A passing-off case in which the innocent partner had repudiated the acts of his co-partners and sought a dissolution, and had, of course, separated in his defence. It was said by Collins, J., and Chitty, L. J., that the passing-off was not within the scope of the authority given by one partner to another, but the same remark would apply to an innocent employer whose manager commits the wrong. Cf.

Grierson, Oldham & Co. v. Birmingham Hotel Co., 18 R. P. C. 158 (1901), Buckley, J.; and it is submitted that the case must not be considered as an authority for the general proposition that only partners who are aware of the wrongful acts can be sued. As to damages against an infringer who is innocent of fraud, see below, p. 426.

(d) The questions, What is a Trade-Mark, and, What can be Registered as a Trade-Mark, are discussed in Chap. II., p. 23; and Chap. VIII., p. 115.

(e) *Robinson v. Finlay*, 9 C. D. 487, (1877), C. A. As to concurrent rights, see below, p. 360.

and the manufacturer, it was held that neither of them could make out a title to exclusive use, and both actions were dismissed (*f*).

In a case where Messrs. Harper and Moore, the plaintiffs, had been the lessees of certain brickworks, and had been accustomed to make bricks of the clay produced by mines of which they were lessees also, and after the expiration of their leases, the defendants, who had obtained a lease of the brickworks only, advertised themselves as "E. & J. Pearson (late Harper and Moore)," thereby suggesting that they were successors to the old brick-making business, Wood, V.-C., granted an injunction to restrain the advertisements, and he said he would have granted it as a matter of course had the owner of the mines been plaintiff in the suit. The learned Vice-Chancellor seems, therefore, to have been of opinion that both he and the plaintiffs were interested in the old firm name (*g*).

A mere importer has no title to sue for infringement of the trade-marks of the consignor or producer (*h*).

The plaintiff does not become owner of the trade-mark, or acquire any interest in it sufficient to enable him to sue for infringement, by a contract with the proprietor for the exclusive purchase of the marked goods consigned to a particular district (*i*); but it is submitted that if the contract were for the exclusive purchase of all the marked goods manufactured by the proprietor, so that no goods could be rightly marked which did not pass through the plaintiff's hands (subject to any question of registration (*k*)), he might

Where the plaintiff is the sole purchaser from the proprietor.

(*f*) Last case. A custom in Manchester, by which the shipper, in the absence of agreement, was the owner of the trade-mark, was alleged but not proved. *Jones' Tm.*, 53 L. T. 1 (1885), C. A., is a similar case. See also *Rivière's Tm.*, 55 L. J. Ch. 545; 53 L. T. 237 (1884), Pearson, J., cited p. 269.

(*g*) *Harpers v. Pearson*, 3 L. T. n.s. 547 (1860); cf. *Motley v. Downman*, 3 My. & Cr. 1; 6 L. J. Ch. n.s. 308 (1837), Cottenham, L. C.

(*h*) *Hirsch v. Jonas*, 3 C. D. 584

(1876), Jessel, M. R.; see Chap. II., p. 53; Chap. IV., p. 66; and *Goodfellow v. Prince*, 35 C. D. 9 (1887), C. A.

(*i*) *Richards v. Butcher*, 7 R. P. C. 288 (1890), Kay, J., leave to add the proprietor as plaintiff granted; cf. *Woolley v. Broad*, (1892) 1 Q. B. 806, exclusive licensee of registered design; and *Heap v. Hartley*, 42 C. D. 461 (1889), exclusive local licensee of a patent cannot sue.

(*k*) *Goodfellow v. Prince*, 35 C. D. 9 (1887), C. A.

maintain the action against any person who used the mark, or a spurious mark infringing it, on goods which were not the goods of the manufacturer. The question whether a trader, exclusively entitled by contract with the proprietor to purchase his goods, could rightly register the proprietor's mark as his own, of course with the proprietor's assent, was discussed but left undetermined in *The Apollinaris Case* (l).

Action by one proprietor or by several.

One or more of several persons concurrently entitled may bring the action (m), and several plaintiffs so entitled may join together to sue although their interests are distinct and separate (n). But only a limited number of persons or firms can be concurrently entitled to a mark. If a large number, and, apparently, if more than three, become so entitled, the mark becomes a common mark (o).

Plaintiff must use or intend to use the mark.

It would seem that the plaintiff must be using, or intending to use, the mark, for no damage would otherwise be occasioned to him by the infringement. It has been held that a mortgagee who does not intend to use the mark cannot bring an action in respect of its infringement (p), and intention to use is one of the conditions precedent to proper registration (q).

Action survives to executors, and they may sue.

Infringement of a trade-mark is an interference with a right of property injuring the personal estate of the owner, and consequently the right of action in respect of it is not determined by the death of the owner, and proceedings may be begun or continued (r) by his executors. Of course, if the executors have possession of the goodwill of their

(l) (1891) 2 Ch. p. 231; 8 R. P. C. 137, Fry, L. J., cited above, p. 276.

(m) *Hine v. Lart*, 7 L. T. o.s. 41 (1846), Shadwell, V.-C.; *Dent v. Turpin*, 2 J. & H. 139; 30 L. J. Ch. 495 (1861), Wood, V.-C.; *Southorn v. Reynolds*, 12 L. T. n.s. 75 (1865), Wood, V.-C. As to passing-off actions, see below, p. 463.

(n) *Dent v. Turpin*, above, and *Universities of Oxford and Cambridge v. Gill*, (1899) 1 Ch. 55, Stirling, J.

(o) *Ehrmann's Tms.*, (1897) 2 Ch. 495; 14 R. P. C. 655, Stirling, J.

The question was as to the rights of the partners on dissolution of a firm. And cf. sect. 74, sub-sect. (3), above, p. 205.

(p) *Beazley v. Soares*, 22 C. D. 660 (1882), Pearson, J., a trade-name case.

(q) *Apollinaris Co.'s Tms.*, (1891) 2 Ch. p. 233; 8 R. P. C. 137; see Chap. VIII., pp. 119 and 120, and *Batt's Tm.*, there cited.

(r) *Oakey v. Dalton*, 35 C. D. 700; 4 R. P. C. 313 (1887), Chitty, J.

testator's business, and are carrying on his trade, they can themselves be registered, and can sue as owners of the trade-marks employed in the business and attached to the goodwill (s).

3. Registration.

If the mark is capable of being registered, the plaintiff must, before the commencement of the action, or, at any rate, at the date of the hearing (t), be the registered proprietor, and if the mark is not capable of being registered, in the case of a mark in use before the 13th of August, 1875, the plaintiff must show that registration of it has been refused (u). In each case the registration and the name of the registered proprietor, or the refusal, may be shown by the certificate of the Comptroller (x), or by sealed and certified copies of or extracts from the Register (y).

Proof of registration of the trade-mark.

But the registration of the successor in title of the original proprietor—his assignee for instance—is not necessary to enable the successor to commence an action (z).

Registration of assignment is unnecessary before action.

The registration of a person as proprietor of a trade-mark is *prima facie* evidence of his right to the exclusive use of his trade-mark, and is (in the absence of an application to rectify the Register (a)), after five years from the date of the application for registration (b), conclusive evidence of such right (c).

Registration as evidence of title.

So that after five years (d), the question whether the mark

(s) See Chap. XIII., p. 324; and *Massam v. J. W. Thorley's Cattle Food Co.*, 6 C. D. 574; 14 C. D. 748 (1877), Malins, V.-C., and C. A.

(t) *Hazzopulo v. Kaufmann*, 23 Sol. J. 819 (1879), Little, V.-C.; *Magnolia Metal Co. v. Atlas Metal Co.*, 14 R. P. C. 389, at p. 394 (1896), Collins, J. See further, above, Chap. XII. p. 317.

(u) Sects. 76 and 77; see Chap. XII., p. 312.

(x) Sects. 77 and 84.

(y) Sects. 88 and 89.

(z) *Ihlee v. Henshaw*, 31 C. D. 323

(1886), North, J. See further, above, Chap. XII. p. 317.

(a) Chap. XII., p. 309.

(b) Sect. 75 (Act of 1888, s. 17).

(c) Sect. 76; Chap. XII., p. 306.

(d) In *The Apollinaris Co. v. Snook*, 7 R. P. C. 474 (1890), although the mark had not been registered for five years, Kekewich, J., at the hearing refused to listen to an argument that it ought not to have been registered; but, apparently, his attention was not called to the point in question. And in *Compagnie Générale v. Rehder*, 5 R. P. C. 61, at p. 65 (1887), Kay,

was capable of registration, and therefore the subject of trade-mark rights under the Acts, cannot be raised against the plaintiff (e), unless an application to rectify the Register is before the Court. Other objections may, however, be taken; it may be shown, for instance, that the plaintiff does not possess the goodwill of the business to which the mark is attached (f).

So, too, it is submitted, the question whether the registered proprietor was entitled to the mark when he caused it to be registered, cannot be raised after five years' registration except upon an application to rectify. The dictum of Fry, L. J., in *The Apollinaris Case*, that "a man who puts another's trade-mark on the Register cannot be a person entitled under the Act" (g), was made in a case founded on such an application, and was not, therefore, directed to the operation of sect. 76.

Registration modified by a disclaimer or otherwise.

But the registration is, of course, evidence only of such title as it shows, and the plaintiff's right is, accordingly, subject to the modification imported by any note or limitation entered upon the Register in connection with it. In particular, if there is a disclaimer of part of the registered mark, the registered proprietor has no title to sue in respect of an alleged infringement constituted by the adoption of such part of the mark, for the disclaimer is an indication to all the world that he has no monopoly, by reason of the registration, of the use of that part, at all events by itself (h).

J., took a similar course upon an application for an interim injunction. In *Stuart v. Scottish Val de Travers Co.*, 13 Ct. of Sess. Ca. 1 (1885); and *Lever v. Goodwin*, 4 R. P. C. 492 (1886), Chitty, J., objections to marks registered for less than five years were allowed at the hearing, there being no application to rectify. And in *Free Fishers of Whitstable v. Elliot*, below, p. 486 (not reported on on this point), Stirling, J., decided that this could be done. Until the question is fairly argued and reported the present practice of moving to rectify in all such cases will probably continue. See also the Scotch case

of *Dewar, Ltd. v. Dewar*, 17 R. P. C. 341, where the Court entertained the objection, even after five years' registration, but this case turned on the question of an inherent jurisdiction in the Scotch Court.

(e) *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478 (1887), C. A.; *Edwards v. Dennis*, 30 C. D. 454 (1885), C. A.

(f) *Pinto v. Badman*, 8 R. P. C. 181 (1891), C. A.

(g) (1891) 2 Ch. 186; 8 R. P. C. 137. The importers had registered the mark of the owners of the spring.

(h) *Rosenthal v. Reynolds*, (1892) 2 Ch. 301; 9 R. P. C. 189, North, J.;

And the right to exclusive use, of which registration is evidence, is subject to the concurrent and independent rights, if any exist, of other persons to use the mark upon obtaining registration (*i*). By concurrent rights.

The five years' registration does not, it is submitted, prevent the defendant, although he has made no application to rectify, or although the Court has no jurisdiction to entertain any such application which he has made, from setting up as a defence that the plaintiff's right has determined by abandonment or otherwise, or has been wholly assigned to another (*k*). And it is, of course, no answer to a personal bar which disentitles the plaintiff to sue. Plaintiff's title determined or barred.

4. What constitutes Infringement.

Infringement is the use by the defendant, for trading purposes (*l*) in connection with goods of the kind for which the plaintiff's right to exclusive use exists (*m*) (*i.e.*, goods for which his mark is registered and used), not being the goods of the plaintiff (*n*), of a mark identical with (*o*) the plaintiff's mark, or comprising some of its essential features, or colourably resembling it (*p*), so as to be calculated to cause the goods to be taken by ordinary purchasers (*q*) for the goods of the plaintiff.

It has long been settled that the question of the relative excellence of the plaintiff's and the defendant's goods is not Inferiority of the defendant's goods.

Pirie v. Goodall, (1892) 1 Ch. 35; 9 R. P. C. 17, C. A.; Chap. IX., p. 209. A dictum of Lord Alverstone in *Hubbuck v. Brown*, 17 R. P. C. 638 (1900), suggests that although the exclusive use of part of a mark is disclaimed, nevertheless the proprietor may rely on the whole combination; see also *Pirie v. Goodall*, (1892) 1 Ch. 35. As to passing off cases based upon disclaimed matter, see next chapter, p. 484.

(*i*) See below, p. 384.

(*k*) This is consistent with the

fact that an unregistered assignee can sue, see p. 361.

(*l*) Page 365.

(*m*) Page 366.

(*n*) Page 368.

(*o*) It is usually so expressed. What is meant is, of course, "similar to"; but "similar to" and "resembling" are constantly used to convey the proper meaning of the latter word; see *Welch v. Knott*, 4 K. & J. 747 (1857), Wood, V.-C.

(*p*) Page 373.

(*q*) Page 378.

relevant to the right of the plaintiff to maintain either an action for infringement or "passing off" (*qq*), and this has, accordingly, no place in the above definition. It may, however, affect the amount of the damages to be recovered by the plaintiff if he succeeds, for damages are sometimes claimed and allowed in respect of injury occasioned to the trade reputation of the plaintiff by the defendant's infringement or fraud (*r*). If the defendant's goods are as excellent as his own, the reputation of the plaintiff cannot have been injured by a substitution of one for the other.

Single act of infringement.

The Court has refused to regard an isolated act, done at the request of the plaintiff's agent, who was laying a trap for the defendant, as an infringement (*s*). This must be taken as a special case, however, for, in general, proof of a single act of infringement by the defendant is sufficient to justify the plaintiff in bringing his action (*t*), and the evidence relied on is frequently the sale by the defendant of the spurious goods to the plaintiff or his agent, who has bought them merely for the purpose of procuring evidence (*u*). Whenever trap orders are resorted to, they should be scrupulously fair (*v*).

(*qq*) *Blofield v. Payne*, 4 B. & Ad. 410; 2 L. J. K. B. N. S. 68 (1833); *Edelsten v. Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, L. C.; and see per Lord Blackburn, in *Singer Manufacturing Co. v. Loog*, 8 App. Ca. p. 29.

(*r*) See for instance, *Alexander v. Henry*, 12 R. P. C. 360 (1895), Kekewich, J.

(*s*) *Hennessy v. Kennett*, Seb. Dig. p. 331 (1877), Malins, V.-C.; cf. *Leahy, Kelly & Leahy v. Glover*, 10 R. P. C. 141 (1893), where a single instance of the sale of goods by the defendant's shopwoman, not shown to have been with his authority, was considered insufficient to support a case of passing off; and *Rutter v. Smith*, 18 R. P. C. 49 (1901), Kekewich, J., a similar case. In *Tonge v. Ward*, 21 L. T. N. S. 480 (1869), Romilly, M. R.; and *Tuentsche v. Ellinger*, 26 W. R. 70 (1877), Malins,

V.-C., the defendants were held liable for infringements by their agents committed without their knowledge; and in *Grierson, Oldham & Co. v. Birmingham Hotel Co.*, 18 R. P. C. 158 (1901), Buckley, J., for acts done contrary to the defendants' orders (*Big Tree Brand*). See above, p. 358, note (*c*).

(*t*) See, for instance, *American Tobacco Co. v. Guest*, (1892) 1 Ch. 630; 9 R. P. C. 218, where an injunction was granted but costs refused.

(*u*) *Dunlop Pneumatic Tyre Co. v. Neal*, (1899) 1 Ch. 807; 16 R. P. C. 247, North, J., a patent case, where the plaintiffs succeeded although the only infringement proved was done for their agent.

(*v*) *Californian Fig Syrup Co. v. Taylor's Drug Co.*, 14 R. P. C. 564 (1897), C. A.

The defendant must be shown to have used or intended to use the goods marked with the spurious mark for trading purposes, whether for sale or as samples to enable him to sell similar goods,—and whether these are or are not themselves so marked,—for the essence of the wrong is that purchasers of the spuriously marked goods are deceived, and the plaintiff incidentally suffers by the loss of their custom which would or might, but for the fraud, come to him (*w*). But the Court will not readily believe that the defendant does not intend to use vendible goods marked with the spurious mark for trading purposes if they are found in his possession, and either he is a trader in goods of the kind, or the quantity of the goods is considerable (*x*). So, where the defendant, a china manufacturer, had imported 5,000 spuriously marked cigars, he was held liable, although he did not know that the mark was spurious, and said that he intended the cigars “for family use.”

Defendant must use or intend to use the marked goods for trading purposes.

And the infringement must occur within the realm (*y*). It is sufficient if the spuriously marked goods are brought by the defendant into this country for export to a country where the plaintiff's trade and marks are known (*z*), and it is, of course, sufficient if goods are spuriously marked by him in this country for export (*a*).

Infringement must be within the realm.

If the plaintiff's registered mark, or its essential particulars, are actually copied, it appears to be immaterial, in order to entitle the plaintiff to an injunction, whether the infringe-

Whether infringement must be in plaintiff's market.

(*w*) *Lery v. Walker*, 10 C. D. 436 (1879), C. A.; *Richards v. Butcher*, 7 R. P. C. 288 (1890), Kay, J.

(*x*) *Upmann v. Forester*, 24 C. D. 231 (1883), Chitty, J.

(*y*) Cf. the patent cases, *British Motor Syndicate v. Taylor*, (1900) 1 Ch. 577; (1901) 1 Ch. 122; 17 R. P. C. 189, 723, where goods were bought in England and sold abroad, with *Badische Fabrik v. Basle Chemical Works*, (1898) A. C. 200; 14 R. P. C. 919, where the defendants, who had effected a sale by post in Switzerland, and had despatched the goods addressed to an English trader

from there, were held not to be liable. An English Court has no jurisdiction to prevent infringements which take place wholly abroad: *Morocco Bound Syndicate v. Harris*, (1895) 1 Ch. 534, Kekewich, J. (copyright).

(*z*) *Joseph Rodgers & Sons v. Rottgen*, 5 Times L. R. 678 (1889), Kay, J.; *Tm. of the Société, &c. des Verrieres de l'Étoile*, (1894) 1 Ch. 61; 2 Ch. 26; 10 R. P. C. 436; 11 R. P. C. 142, Stirling, J., and C. A. (*Red Star Glass*).

(*a*) *Orr-Ewing v. Johnson*, 13 C. D. 434; 7 App. Ca. 219, is an illustration.

ment takes place within the area in which the mark is known or not, because the exclusive right conferred by the Act extends to the whole Kingdom.

If the case is one of colourable infringement, and the plaintiff's case is founded on the probability of deception in a particular market, the injunction granted might under special circumstances be limited to that market (*b*); but, except in such cases, it is submitted that the question whether there is a probability of deception must be considered on the assumption of the defendant's mark coming into competition with the plaintiff's mark, and that the fact that the marks had hitherto been respectively confined to different districts within the jurisdiction would not be a defence in law. The registration is, by the Act, declared to be the equivalent of public use, and this must mean, use throughout the realm. An injunction has been granted where the plaintiff's and the defendant's areas, though substantially local and distinct, were both within the realm and were beginning to overlap (*c*).

Defendant
must use the
mark upon
the goods for
which the
plaintiff's
right exists,

The use must be in connection with the goods for which the plaintiff's right exists. "There can be no right to the exclusive ownership of any symbols or marks universally in the abstract. Thus, an iron-founder who has a particular mark for his manufactures in iron could not restrain the use of the same mark when impressed on cotton or woollen goods; for a trade-mark consists in the exclusive right to the use of some name or symbol as applied to a particular manufacture or vendible commodity" (*d*). And the third essential ingredient for constituting an infringement, enumerated by

(*b*) In "passing off" cases where the plaintiff's mark has been used only in a limited area, he sometimes obtains an injunction restricted to such area. See next chapter, p. 517. In the *Orr-Ewing Case*, Cotton, L. J., thought that the injunction ought to have been limited to Eastern markets, had the defendants been trading in any others. It would rarely be practicable to give complete protection in such manner. See *Société V. de l'Étoile Tm.*, (1894)

1 Ch. 61, p. 67; 10 R. P. C. 441, Stirling, J.; and the observations of Kay, L. J., in the same case, during argument on appeal, 11 R. P. C. 145.

(*c*) *Paine & Co. v. Daniells & Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 71, 217 C. A. (*John Bull Beer*). The injunction was unlimited.

(*d*) *Per* Lord Westbury, in *Hall v. Barrows*, 4 De G. J. & S. 150; 33 L. J. Ch. 204 (1863).

Lord Westbury in *McAndrew v. Bassett (e)*, is "that the defendants have imitated the mark for the purpose (*f*) of passing in the market other articles of a similar description."

The limits of the class of goods over which the right in respect of a registered mark extends have been discussed already (*g*), and the class has been shown to be not necessarily co-extensive with any register class (*h*), and it has also been shown that the registered proprietor's right ought to be limited and the registration restricted to the kinds of goods upon which he actually uses or intends to use the mark (*i*).

The plaintiff cannot sue for infringement in respect of goods for which his mark is not registered (*k*), although, if he can make a case, he may sue to restrain passing off. And if his mark is registered generally for a register class comprising a kind of goods for which he does not use it, or for which it is unsuitable, it is not to be considered as registered for such goods. Thus, the proprietor of a mark registered for class 45, "tobacco whether manufactured or unmanufactured," used it only for cut tobacco, and the mark contained the words *Three Crowns Mixture*. It was held

and is registered,

and used.

(*e*) 4 Do G. J. & S. 380; 33 L. J. Ch. 561 (1863).

(*f*) Fraudulent intent is not now essential, *post*, p. 375.

(*g*) Chap. V., p. 96, and Chap. XII., p. 256.

(*h*) Marks may be calculated to deceive, though in different register classes, p. 217; *Australian Wine Importers' Tm.*, 41 C. D. 278; 6 R. P. C. 311 (1889), Kay, J., and C. A. (wines and spirits); *Euo v. Dunn*, 10 R. P. C. 261 (1893), Kekewich, J. (an aperient drink and baking powder); *Turney & Sons' Tm.*, 11 R. P. C. 37 (1893), North, J. (beer and rum). In some instances the Courts have interfered to prevent a defendant using or imitating the trade-name of a well-known firm with the object of fraudulently suggesting that he has a connection of some

sort with the firm, even where the defendant's trade is different from that of the firm, but the difference is not so great as to make the success of the fraudulent suggestion very improbable. *Eustman Co. v. John Griffiths Corpn.*, 15 R. P. C. 105 (photographic materials and cycles); *Dunlop Pneumatic Tyre Co. v. Dunlop Lubricant Co.*, 16 R. P. C. 12, both 1898, Romer, J. (cycle tyres, &c., and cycle lubricants); *Valentine Meat Juice Co. v. Valentine Extract Co.*, *Id.*, 17 R. P. C. 673, C. A., overruling 17 R. P. C. 1 (1900), Stirling, J. (meat extract for food and for medicinal purposes).

(*i*) *Edwards v. Dennis*, 30 C. D. 454 (1885), C. A., cited p. 97.

(*k*) *Jay v. Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.; *Hart v. Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J.

that he could not sue to restrain an infringement in respect of cigars (*l*).

The infringement must be in respect of spurious goods.

Further, the use of the defendant's mark, which is relied on as an infringement, must be a use upon goods which are not the genuine goods—*i.e.*, those upon which the plaintiff's mark is properly used—for anyone may use the plaintiff's mark on the plaintiff's goods, since that cannot cause the deception which is the test of infringement (*m*). So the retailer of goods obtained from the plaintiff may lawfully place or renew (*n*) the labels upon them, and may have sufficient labels printed for the purpose (*o*). In the case last cited, the defendant failed to satisfy the jury, in an action at common law, that he had in fact printed the labels only for use on the genuine goods of the plaintiff; and the injunction, which had been granted in a suit in Chancery by Wood, V.-C., and dissolved on appeal by Cranworth, L. C., was accordingly restored (*p*). The rule just stated is well illustrated by *The Angostura Bitters Case*, where the injunction granted was so expressed as not to prevent the name being applied to an article identical with the plaintiff's, should any other person discover the secret of manufacture and make the goods (*q*).

Adulterations, and goods comprising authentic parts.

But goods of the plaintiff, adulterated by some other person (*r*), are not goods on which the mark may lawfully be placed; nor is the manufacture by the defendant of an article made up of several parts the less an infringement

(*l*) *Hargreaves v. Freeman*, (1891) 3 Ch. 39; 8 R. P. C. 237, Chitty, J.; and see *Beuzley v. Soares*, 22 C. D. 660 (1882), Pearson, J. A person who does not use the mark at all cannot sue; last case, and *Delondre v. Shaw*, 2 Sim. 237 (1828), Shadwell, V.-C.

(*m*) Chap. II., p. 32.

(*n*) *Condy v. Taylor*, 56 L. T. 891 (1887), Kekewich, J.

(*o*) *Farina v. Silverlock*, 1 K. & J. 509; 24 L. J. Ch. 632; 6 De G. M.

& G. 214; 26 L. J. Ch. 11 (1855).

(*p*) 4 K. & J. 650 (1850).

(*q*) *Siegert v. Findlater*, 7 C. D. 801 (1878), Fry, J. In the *Yorkshire Relish Case* (next chapter, p. 481) the defendant's sauce differed from the plaintiffs' by a "pinch of salt," but if the two had been indistinguishable the name would still (according to the evidence) have meant the former only.

(*r*) *Condy v. Taylor*, 56 L. T. 891 (1887), Kekewich, J.

because one genuine part of the plaintiff's manufacture, and bearing his mark, is included in it (*s*).

It is not necessary that the spurious mark should be actually affixed to the goods, provided it is so used in connection with them as to be calculated to cause them to be taken for the plaintiff's goods (*t*). Use on the wrapper in which they are sold, or upon a slip placed in the package with them, or on a show-card to which the goods are attached (*u*), or in circulars or advertisements offering them for sale is sufficient (*t*). So printing the plaintiff's trade-mark labels, without showing that they were for use on genuine goods only (*v*), or using the plaintiff's marked or stamped bottles (*x*), casks (*y*), or boxes (*z*) for goods other than his genuine goods, is an infringement, unless the Court is satisfied that the use under the circumstances is not calculated to deceive (*a*).

What connection with the spurious goods is sufficient.

But the use of a descriptive word registered as an old trade-mark, not in connection with the goods, but only in price lists referring to them, has been held to be no infringement (*b*).

In a recent case Vaughan Williams, J., said: "I am, for my own part, not at all sure that you can prove an infringement of a trade-mark without proving that the defendants have imitated the plaintiffs' trade-mark upon something capable of receiving the impression of the mark. Either the material itself, or the paper which is used, or the sacks, or bags, or boxes, or whatever it is that the material is put into, I should have thought must have been imitated

(*s*) *Richards v. Williamson*, 30 L. T. N. S. 746 (1874), Bacon, V.-C., a gun with stamped lock.

(*t*) *Jay v. Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

(*u*) *Chamelon Patents, &c. Co. v. Marshalls*, 17 R. P. C. 527, (1900) Kekewich, J. (passing off).

(*v*) *Farina v. Silverlock*, note (*o*); *Guinness v. Ullmer*, 10 L. T. O. S. 127 (1847), Shadwell, V.-C.

(*x*) *Rose v. Henley*, 47 L. J. Ch.

577 (1877), Malins, V.-C.; *Rose v. Loftus*, *ibid*.

(*y*) *Hennessy v. Cooper*, Seb. Dig. p. 327 (1877), Malins, V.-C.

(*z*) *Barnett v. Leuchars*, 13 L. T. N. S. 405 (1865), Stuart, V.-C.

(*a*) As in *Welch v. Knott*, 4 K. & J. 747 (1857), Wood, V.-C.

(*b*) *Talbot v. Webley*, 3 R. P. C. 276 (1886), Bacon, V.-C. (*Daffle*, for safes); cf. "Singer system," in *Singer v. Loog*, 8 App. Ca. 15 (1882), and above, p. 38.

to constitute an infringement of a trade-mark" (c). The question actually decided in the case was, that the sale of goods by the descriptive name *Rugby Cement* was not an infringement of a trade-mark comprising those words; and the decision was undoubtedly correct; but it is submitted, with great deference, that, had the words been distinctive and an essential feature of the mark, it would have been an infringement to use them to effect the sale of any goods other than those of the plaintiffs. The distinction suggested by Jessel, M. R., and adopted by the Court of Appeal (d) in *The Singer Manufacturing Co. v. Wilson*, between cases where a name or device taken from a trade-mark is affixed to the goods, and cases where a name so taken is used in respect to them—for instance, in advertisements—to push their sale, was not approved by the House of Lords (e). The abstract question is, however, of little or no importance, since in the case put, the words would almost necessarily come by the legitimate user of the mark to denote the plaintiff's goods, and the use of them by the defendant, in any manner calculated to deceive, could be restrained in a "passing off" action. "It will be observed," Fry, J., said, in *The Linoleum Case* (f), "that the inquiry with regard to the use of the word *Linoleum* as a constituent element in the trade-mark, and the inquiry as to the use of the word *Linoleum* as a misrepresentation, are one and the same inquiry, and I must consider what the word *Linoleum* meant as used at the time when the defendants intended to attribute it to their manufacture."

The infringing mark may either (a) be an actual or substantial copy of the plaintiff's mark; (b) consist of or comprise its essential features; or (c) be a colourable imitation of it (g).

(c) *Rugby Portland Cement Co., Ltd. v. Rugby and Newbold Portland Cement Co., Ltd.*, 8 R. P. C. 241; affirmed on appeal, 9 R. P. C. 46 (1891).

(d) 2 C. D. 434 (1874).

(e) 3 App. Ca. 376; see Lord Cairns' judgment, cited Chap. II., p. 14.

(f) *Linoleum Manufacturing Co. v.*

Nairn, 7 C. D. p. 836 (1878).

(g) It will be seen that (b) and (c) are not distinct cases, although they are separated for convenience in the text. The test of infringement is the same in each (p. 373). In case (b) the whole mark must be infringed, and in case (c) essential features are necessarily imitated or copied.

(a) The first case presents no difficulties. By sect. 76, the registration of the plaintiff as proprietor of the trade-mark is *prima facie* evidence, and, after five years (in the absence of an application to rectify), is conclusive evidence of his right to the exclusive use of the trade-mark (h). The registered proprietor can therefore make a case in an action for the mere using of his mark in connection with goods of the class over which his right extends, without showing that the use is calculated to deceive (i). And this is not, substantially, an alteration of the law as it stood before the Acts (j) if registration be taken as equivalent to public user, although proof of the probability of deception was usually, but not invariably (k), mentioned as an element of right of action; for if the defendant had taken a "material and substantial" portion of the plaintiff's mark, and, *à fortiori*, if he had taken the whole, the onus of showing that his conduct was not calculated to deceive was cast upon him (l), and it was practically, at any rate, impossible for him to support it. Moreover, unless he could give a reasonable explanation to show how he came to adopt a mark identical with that of the plaintiff, the Court would infer that he intended to deceive (m), and would not consider whether or not his attempt was likely to be successful (n).

Where the plaintiff's mark has been copied.

The infringement proved in *Paine & Co. v. Daniells & Sons' Breweries* (o) was effected in a very unusual way. The

False claim to the plaintiff's registered marks.

(h) Above, p. 361.

(i) See the judgment of Cotton, L. J., in *Edwards v. Dennis*, 30 C. D. 454 (1885).

(j) Cf. with the judgment last referred to that of Hall, V.-C., in *Cope v. Evans*, 18 L. R. Eq. 138 (1874).

(k) For instance, see the judgment of Jessel, M. R., in *The Singer Manufacturing Co. v. Wilson*, 2 C. D. p. 422 (1875). "The right which a manufacturer has in his trade-mark is the exclusive right to use it for the purpose of indicating where, by whom, or at what manufactory, the article to which it is affixed was manufactured": *per* Lord Cranworth, in *The Leather*

Cloth Case, 11 H. L. C. p. 533; 35 L. J. Ch. 53 (1865).

(l) *Ford v. Foster*, 7 Ch. 611 (1872), James, L. J.; *Orr-Ewing v. Johnston*, 13 C. D. 434 (1879), Fry, J., and C. A. See also Lord Herschell in *Reddaway v. Banham*, 13 R. P. C. at p. 228.

(m) See *The Orr-Ewing Case*, in the H. L., 7 App. Ca. 219; *Taylor v. Taylor*, 23 L. J. Ch. 255 (1854), Wood, V.-C.

(n) See *per* Lindley, L. J., in *Slazenger v. Feltham*, 6 R. P. C. p. 538 (1889). See, however, *Lever v. Beddingfield*, cited below, p. 372.

(o) (1892) 2 Ch. 567; 10 R. P. C. 71, 217, C. A.

plaintiffs' marks consisted of labels bearing a figure of John Bull, and the words *John Bull* and *John Bull Brand*. The defendants used a label bearing a different figure of John Bull, with the words *John Bull, Registered*. Their label, though entered as their copyright at Stationers' Hall, had been, in 1885, refused registration as a trade-mark, on the ground of the plaintiffs' opposition, but they had, notwithstanding the refusal, continued to use it in their business. Although the labels had been in use so long, no evidence of actual deception was tendered, for the trades of the plaintiffs and defendants had been carried on in different districts, and were only beginning to overlap at one point at the date of the trial. There was no other evidence than that furnished by the labels themselves, that the defendants' label was calculated to deceive; but the Court of Appeal regarded the false claim of registration in their label as amounting in effect to a representation that the plaintiffs' marks—the only John Bull marks which really were registered—were their own, and this was held to be an undoubted infringement (*p*).

Where an essential feature has been copied.

(*b*) The right of the registered proprietor exists in regard to the whole mark, not in regard to any particular part of it (*q*), and an infringement must be an infringement of the whole mark (*r*). But the adoption of a single characteristic and distinctive particular from the plaintiff's mark, and its use alone, or with other matter, may well be an infringement of the entire mark. At any rate, it throws upon the

(*p*) *Lawrie v. Baker*, 2 R. P. C. 213 (1885), Day, J., is a similar case. There the defendant described his goods as *patent cups*, the plaintiff having the only patent. Cf. *Pneumatic Stamp Co. v. Lindner*, 15 R. P. C. 525, cited below, p. 457.

(*q*) *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886), Cotton, L. J.; *Christiansen's Tm.*, 3 R. P. C. 54 (1886), C. A.

(*r*) "It is established by the history of the defendant's label and by comparing it with the plaintiff's label of 1894, that the central space and curved scroll on the plaintiff's label

have been utilized, and to some extent copied, by the person employed by the defendant to prepare his label. If, notwithstanding this circumstance, the defendant's label as a whole is not a copy of the plaintiff's labels, and is not as a whole a colourable imitation of them, it cannot be truly said that the defendant has infringed the rights conferred upon the plaintiffs by the registration of their marks." *Per* Lindley, M. R., in *Lever v. Beddingfield*, 16 R. P. C. 3, at p. 10 (1899) (*Sunlight and Redmaid Soaps*); so *Rugby Cement Co. v. Rugby and Newbold Co.*, note (*t*).

defendant the onus of proving the contrary (s). But it is not an infringement to take non-essential particulars from a mark: for instance, to take merely descriptive or other common words (t).

(c) A colourable imitation is the most common case, for, if the resemblance is intended, the defendant will have tried to introduce apparent differences sufficient to prevent the Court from interfering, while preserving a likeness which is near enough to enable him to profit by the reputation of the plaintiff's mark. So far as the Court succeeds in carrying into effect the principles which govern its interference, the two ends are inconsistent with each other.

Where there is a colourable imitation.

Colourable Imitation.

In both the second and third cases the test of infringement is the question whether or not the defendant's mark is calculated to cause his goods to be taken by ordinary purchasers (u) for the goods of the plaintiff (x), and the Registration Acts have made no alteration of the law in this respect (y).

The test of infringement.

(s) *Ford v. Foster*, 7 Ch. 611 (1872), James, L. J.; *Johnston v. Orr-Ewing*, 13 C. D. 434 (1879), Fry, J., and C. A.

(t) *Linoleum Manufacturing Co. v. Nairn*, 7 C. D. 834 (1878), Fry, J. (*Linoleum*); *Watt v. O'Hanlon*, 4 R. P. C. 1 (1886), Porter, M. R. (*Old Innishowen*); *Humphries v. Taylor's Drug Co.*, 59 L. T. 820 (1888), Kekewich, J. (*Herbalin*); *Native Guano Co. v. Sewage Manure Co.*, 8 R. P. C. 125 (1888), C. A. and H. L. (*Native Guano*); *Rugby Cement Co. v. Rugby and Newbold Co., Ltd.*, 8 R. P. C. 241; 9 R. P. C. 46 (1891), V. Williams, J., and C. A.; cf. Chap. X., p. 243; and *Barber v. Munico*, 10 R. P. C. 93 (1893), A. L. Smith, L. J. See, further, next chapter, p. 476.

(u) See above, p. 363.

(.) *Hall v. Barrows*, 4 De G. J. & S. 150; 33 L. J. Ch. 204 (1863), Westbury, L. C.; *Leather Cloth Co., Ltd. v. The American Cloth Co., Ltd.*, 4 De G. J. & S. 137; 33 L. J. Ch. 199 (1863), Westbury, L. C.; and 11 H. L. C. 523; 35 L. J. Ch. 53. The suggestion in the Scotch case of *Crawford v. Bernard*, 11 R. P. C. 580 (1894), Lord Kyllachy, that colourable infringement can be judged of apart from probability of deception, is not in accordance with the authorities.

(y) *Mitchell v. Henry*, 15 C. D. 181 (1880), C. A.; *Singer Manufacturing Co. v. Loog*, 18 C. D. 395, C. A.; and 8 App. Ca. 15 (1870); *Edwards v. Dennis*, 30 C. D. 454 (1885), Cotton, L. J.; *Lever v. Bedingsfield*, note (r).

“It is not a question whether this (the use of the defendant’s mark) necessarily is deceptive, but whether there is not a strong probability of its causing deception” (s). So that the imitation of the plaintiff’s mark cannot be justified by showing either that the device or inscription on the imitated mark is ambiguous, and capable of being understood by different persons in different ways, or that a person who carefully and intelligently examined and studied it might not be misled (a).

There can be no infringement, therefore, in cases where the plaintiff’s mark is not actually copied, if there is no reasonable probability of deception (b). It was held by the Court of Common Pleas, as early as 1847, that the following questions were properly left to the jury by Williams, J., in *Rodgers v. Nowill* (c):—(1) Whether there was such a resemblance to the plaintiffs’ marks, in the marks put on the knives made by the defendants, as was calculated to make an ordinary person believe that the marks were the marks of the plaintiffs, denoting that the knives were the knives of the plaintiffs? and (2) Did the defendants, with an intention to deceive, sell these knives representing them to be the manufacture of the plaintiffs? It will be shown immediately that if the plaintiffs’ mark was their trademark, the second question has long been held to be immaterial, except so far as it dealt with the mere fact of the sale of the knives.

The same test, as will be shown in the next chapter, applies also to actions for “passing off.” It is sometimes suggested that a less degree of resemblance between the plaintiff’s and defendant’s marks will suffice to support an action for

Questions
for the jury.

Actions for
infringement
and for pass-
ing off.

(s) *Per* Cotton, L. J., in *The Upper Assam Tea Co. v. Herbert & Co.*, 7 R. P. C. p. 186 (1889).

(a) *Per* Lord Selborne, in *The Singer Manufacturing Co. v. Loog*, 8 App. Ca. p. 18 (1882).

(b) *Cope v. Evans*, 18 L. R. Eq. 138 (1874), Hall, V.-C.; *Beddow & Sons v. Boyd*, 4 R. P. C. 310 (1887), Chatterton, V.-C.; see also *Woollam*

v. Radcliff, 1 H. & M. 259 (1863), Wood, V.-C.; *Bradbury v. Beeton*, 39 L. J. Ch. 57 (1869), Malins, V.-C.; *Civil Service Supply Association v. Dean*, 13 C. D. 512 (1879), Malins, V.-C.; and *Borthwick v. The Evening Post*, 37 C. D. 449 (1888), Kay, J., and C. A., in all of which an injunction was refused.

(c) 5 C. B. 109; 17 L. J. C. P. 52.

“passing off” than is required to support an action for infringement, or, what is the same thing, proof of a lower degree of probability of deception. This distinction is, it is submitted, unnecessary and inconvenient. In the cases before the Acts, when the two classes of actions were not yet separated, there could have been no ground for it, and there is nothing in the Acts to require its introduction. The essential difference is plain enough. In an infringement action the plaintiff can rely only upon the imitation of his registered mark, while in an action for “passing off” he may rely on other things, or on additional things, which are proved to be connected with his trade or goods.

Proof of actual deception, if the mark is, in the opinion of the Court, calculated to deceive, or if the plaintiff's registered mark has been substantially copied (*d*), is unnecessary, although the absence of it, where the plaintiff's and defendant's marks have circulated side by side for a considerable time, may go far to negative the probability of deception, unless it is explained, for instance, by the practical impossibility of calling evidence from a distant country to show that purchasers there have been deceived (*e*). The plaintiff is not bound to wait to see whether his customers will, in fact, be deceived, for “the very life of a trade-mark depends upon the promptitude with which it is vindicated” (*f*).

Nor where the defendant's mark has in fact deceived, or is, in the opinion of the Court, calculated to do so, is it necessary to show that the defendant intended to deceive. This was first decided by Lord Cottenham, in *Millington v. Fox* (*g*), as regards the relief by an injunction, and by Lord Westbury, in *Edelsten v. Edelsten* (*h*), as regards both injunction and account. It is now well-settled law (*i*).

(*d*) Above, p. 371; and see *Paine & Co. v. Daniells & Sons' Breweries*, cited *ante*, p. 371.

(*e*) Page 249.

(*f*) *Johnston v. Orr-Ewing*, per James, L.J., 13 C. D. p. 464; and Lord Blackburn, 7 App. Ca. p. 230 (1880).

(*g*) 3 My. & Cr. 338 (1838).

(*h*) 1 De G. J. & S. 185; 10 L. T. N. S. 780 (1863).

(*i*) *Reddaway v. Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9 R. P. C. 503, C. A.; *Johnston v. Orr-Ewing*, 7 App. Ca. 219 (1882); *Powell v. Birmingham Vinegar Co.*, (1896) 2 Ch. 54; 13 R. P. C. 235, in the C. A. As to damages at law, see the first-mentioned case.

Actual deception need not be proved;

nor yet an intention to deceive.

The dicta of Lord Chelmsford in *The Glenfield Starch Case*, that where the trade-mark is not actually copied, fraud is a necessary element in the plaintiff's case—"that is, the party accused of piracy must be proved to have done the act complained of with the fraudulent design of passing off his own goods as those of the party exclusively entitled to the trade-mark" (*k*)—and of Jessel, M. R., and the Court of Appeal, in *The Singer Manufacturing Co. v. Wilson* (*l*), that, where the defendant has not actually put the plaintiff's trade-mark, or a colourable imitation of it, on his goods, or on the bottles or boxes containing them, but has otherwise acted so as to represent his goods as those of the plaintiff (*m*), a fraudulent intent must be proved, cannot now be taken to be law. In the former case, Lord Hatherley said it had been pointed out that a *mala fides* towards the first purchaser was not the ground of the Court's interference; for it is sufficient if such purchaser is furnished by the defendant with goods bearing a label, of which the necessary consequence is that he is enabled to deceive others by means of them (*n*). And in *The Singer Case*, Lord Cairns said: "I wish to state in the most distinct manner that, in my opinion, fraud is not necessary to be averred or proved in order to obtain protection for a trade-mark" (*o*); and in this Lord O'Hagan concurred (*p*). Lord Blackburn said: "I am not as yet prepared to assent either to the position that there is a right of property in a name, or, what seems to me nearly the same thing, to assent to its full extent to the proposition that it is not necessary" (in trade-name cases) "to prove fraud" (*q*). But the last-mentioned judge, in a subsequent case, stated that he thought it clear, at any rate, that if the defendant persevered in using a trade-mark calculated to

(*k*) *Wotherspoon v. Currie*, L. R. 5 H. L. p. 519 (1872).

(*l*) 2 C. D. 432 (1875).

(*m*) As already shown, these may be cases of infringement if the representation is effected by using a mark in connection with the defendant's goods (though not on them) which resembles the plaintiff's mark, or by

using a distinctive name taken from the plaintiff's mark; above, p. 369.

(*n*) L. R. 5 H. L. p. 517.

(*o*) 3 App. Ca. p. 391, quoted and adopted in *Bodega Co., Ltd. v. Owens*, 7 R. P. C. 31 (1889), Chatterton, V.-C.

(*p*) 3 App. Ca. 396.

(*q*) Page 400.

deceive after notice of the facts, that would be evidence to support a claim for damages for knowingly selling his goods as and for those of the plaintiff (*v*). "However honest or inadvertent the original mistake may have been, the continuation of the use of it after that was pointed out is of itself evidence of a fraudulent intention" (*s*).

And it has already been shown that the proprietor of a trade-mark may obtain an injunction against an innocent consignee of spuriously marked goods, and an order for the spurious marks to be expunged from the goods, without having given the defendant any notice before the commencement of the action (*t*).

On the other hand, the mere intention of the defendant to deceive, if the Court is clearly of opinion that the mark complained of is not calculated to deceive, cannot constitute an infringement (*u*).

It follows that the question to be answered when an infringement without taking the actual mark is alleged, is the same question as arises when a mark tendered for registration is objected to, or, having been registered, is sought to be removed from the Register, on the ground that it has such resemblance to a trade-mark already on the Register as to be calculated to deceive, within the restriction of sect. 72 (2). The principles governing the comparison of the marks, and determining what amount of resemblance is calculated to deceive, are the same in both cases, although a higher standard of resemblance must be conformed to in an action for infringement than that set up in cases of the other class. These principles have been already discussed at length (*x*), and it will, therefore, be sufficient in this place to shortly summarise the conclusions deduced from an examination of the authorities.

What resemblance is calculated to deceive.

(*r*) *Singer Manufacturing Co. v. Loog*, 8 App. Ca. 31 (1882); and *Cochrane v. McNish*, (1896) A. C. 225; 13 R. P. C. 100, Privy Council.

(*s*) Per James, L. J., in *Orr-Ewing v. Johnston*, 13 C. D. p. 454 (1880); see also *Paine & Co. v. Daniells & Sons' Breweries*, (1892) 2 Ch. 567; 10

R. P. C. 217, C. A., cited above, p. 371.

(*t*) *Ante*, p. 357; *Upmann v. Forester*, 24 C. D. 231 (1883), Chitty, J.; *American Tobacco Co. v. Guest*, (1892) 1 Ch. 630; 9 R. P. C. 218, Stirling, J.

(*u*) See next chapter, p. 492.

(*x*) Chap. X., pp. 224 *et seq.*

The probable purchasers are to be considered.

(1) The persons with regard to whom the test question—Is the spurious mark calculated to deceive them?—ought to be asked, are the persons who are probable purchasers, whether they buy, or are likely to buy, directly from the plaintiff or defendant, or from, or through, intermediate purchasers from either of them, and whether they are English or foreign, and not merely very careful or intelligent persons, but ordinary unwary purchasers (*y*). No rule has, or probably can be laid down, as to what amount of intelligence or knowledge of the trade in question ought to be attributed to them, since this must necessarily vary with the nature of the case (*z*).

The net impression left by the marks are to be contrasted.

(2) No definite rule as to the amount of resemblance required can be formulated *à priori*, but the net impression produced and “the main idea left on the mind” by one mark must be compared with that left by the other, for marks may well be confused by purchasers, who see the defendant’s mark when they have present in their memories only an indefinite recollection of the plaintiff’s, in cases where the marks could not be mistaken for each other if they were seen side by side (*a*). So that the whole mark of the defendant may too nearly resemble that of the plaintiff, although all the essential particulars of the two are distinguishable (*b*); but special regard must, nevertheless, be paid to the essential features of the plaintiff’s mark in considering whether the defendant has infringed it (*c*).

The marks are to be considered as seen in ordinary use.

(3) Further, the marks must be compared as they are seen in actual ordinary use (*d*) on the goods they are used for; remembering, however, that so far as the plaintiff’s mark substantially differs from the mark on the Register, it is an unregistered mark (*e*).

(*y*) Page 224; and *Shrimpton v. Laight*, 18 Beav. 164 (1854), Romilly, M. R.

(*z*) See the “passing off” cases, *Payton v. Snelling*, 17 R. P. C. 48; and *Payton v. Titus Ward*, *ibid.* 58 (both 1899, C. A.), and above, pp. 225 and 226. The first-mentioned decision was affirmed in the H. of L., 17 R. P. C. 628.

(*a*) Page 227.

(*b*) Page 230.

(*c*) Pages 226 and 236; and cases in note (*z*); also *Hubbuck v. Brown*, 17 R. P. C. 148 and 638, (1900) Kekewich, J., and C. A.

(*d*) Page 234.

(*e*) Page 236.

(4) The circumstances of the trade (*f*) and market in which the marks are used must be considered also,—the language of the purchasers, for instance, and the number of analogous marks in use in connection with the same goods (*g*).

Regard is to be paid to all the circumstances surrounding the marks in use.

But, since colour is not admitted to consideration in estimating the distinctiveness of a mark tendered for registration (*h*), and cannot, on account of the practical difficulties, be registered as an essential element of a trade-mark, similarity of colour is not to be greatly relied upon in deciding a question of infringement (*i*), although it is an element to be considered.

Colour.

If the plaintiff's mark, or some feature of it, has led to the application of a particular name to his goods, it is an infringement for the defendant to use a mark which is calculated to cause the same name to be applied to his (*j*), unless the name is applied, not merely to the plaintiff's goods, but to all goods of the kind (*k*), for instance, because it is suggested by matter in the mark which is common to the trade (*l*); and the defendant's use of his mark is none the less an infringement of the plaintiff's rights, because the exclusive use of the name may give the plaintiff a practical monopoly in certain goods in a particular market (*m*).

And, in particular, to the adoption of a special name for goods bearing the plaintiff's mark.

Attention must be paid, of course, not only to the points of resemblance between the marks, but also to the points of difference. But it will not be sufficient for the defendant to show that the differences might prevent purchasers being deceived. If there is a case for him to answer, the Court must hold that they are "such as to prevent its being likely that they would be deceived" (*n*).

What importance is to be attached to differences between the marks.

(*f*) *Cochrane v. McNish*, (1896) A. C. 225; 13 R. P. C. 100, P. C. (*Club Soda*).

(*g*) Page 240.

(*h*) *Hanson's Tm.*, 37 C. D. 112; 5 R. P. C. 130 (1887), Kay, J., above, p. 194.

(*i*) *Nuthall v. Vining*, 28 W. R. 330 (1880), C. A. Registration confers the exclusive use of the mark in any colours: sect. 67. Colour is often of great importance in a case of

"get up." See the next chapter.

(*j*) Page 240 *et seq.* This appears to have been treated rather as "passing off" than infringement by Romer, J., in *Hodgson v. Kynoch*, 15 R. P. C. 465, at p. 476 (1898).

(*k*) Page 243.

(*l*) Page 244. See note (*z*) above.

(*m*) Page 246. See *The Yorkshire Relish Case*, cited below, p. 481.

(*n*) Per Lord Blackburn, in *Johnston v. Orr-Ewing*, 7 App. Ca. p. 230

Instances of infringements by marks which prominently displayed the defendant's name.

In the following cases it was held that the use of words taken from the plaintiff's mark by the defendant was an infringement, notwithstanding that he always added his own name:—*Perry v. Truefitt*, 6 Beav. 66, PERRY'S MEDICATED MEXICAN BALM, TRUEFITT'S MEDICATED MEXICAN BALM; *Braham v. Bustard*, 1 H. & M. 447, BUSTARD & Co.'s EXCELSIOR WHITE SOFT SOAP; *Kinahan v. Bolton*, 15 Ir. Ch. 75, KINAHAN'S LL WHISKY, BOLTON'S LL WHISKY; *Ford v. Foster (o)*, L. R. 7 Ch. 611, FORD'S EUREKA SHIRTS, FOSTER, PORTER & Co.'s IMPROVED EUREKA SHIRTS; *Eno v. Stephens*, Seb. Dig. p. 372; *Eno v. Dunn*, 10 R. P. C. 261, ENO'S FRUIT SALT, STEPHENS & Co.'s EFFERVESCING VINOUS FRUIT SALTS; DUNN'S FRUIT SALT AND CHLORATE OF POTASH LOZENGES. In *The Glenfield Starch Case (p)*, *Wotherspoon v. Currie*, 5 L. R. H. L. 508, the defendant's own name appeared in bold letters upon the infringing labels, and this was also the case in *Johnston v. Orr-Ewing*, 13 C. D. 434, and 7 App. Ca. 219, but there the Indian customers of the plaintiff could not, it was assumed, read English (*q*). So, in *Rose v. Loftus*, 47 L. J. Ch. 576, the defendant washed the plaintiff's labels off the bottles, leaving only the moulded marks, and pasted his own labels upon the bottles in their place, but was, nevertheless, held to have committed an infringement. And in *Curtis and Harvey v. Pape*, 5 R. P. C. 146, an imitation of a diamond mark was held to be an infringement, although the defendant put a K in the middle of his diamond which did not appear in that of the plaintiffs.

Different get-up.

On similar grounds it is held to be no excuse for a clear infringement of a trade-mark that the infringing mark is used upon goods of which the get-up differs *in toto* from that of the plaintiff's goods (*r*).

(1882), quoted and followed by the Privy Council in *Somerville v. Schembri*, 12 App. Ca. p. 458; 4 R. P. C. 179 (1887). Cf. p. 375, note (*r*).

(*o*) Cited p. 37.

(*p*) Cited pp. 459 and 481. In *The Yorkshire Relish Case*, cited p. 49, the defendants did everything possible to distinguish their goods, but this

proved to be insufficient while they used the (unregistered) trade-mark.

(*q*) *Henderson v. Jorss*, Seb. Dig. p. 110 (1861), Wood, V.-C., is a similar case.

(*r*) *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478 (1887), Chitty, J., and C. A. (*Apollinis*). See note (*p*).

But the use of the defendant's name as part of the mark complained of is an element to be considered, and in some cases it has turned the scale in his favour. Thus, in *Beard v. Turner*, 13 L. T. N. S. 746, KIRBY'S NE PLUS ULTRA NEEDLES, on a label, was held not to be infringed by TURNER'S NE PLUS ULTRA NEEDLES on a label generally resembling the plaintiff's, the words NE PLUS ULTRA being common to the trade; and in *Blackwell v. Crabb*, 36 L. J. Ch. 504, BLACKWELL'S PICKLES on a label, not to be infringed by CRABB'S PICKLES on a label resembling the plaintiff's, the name of the manufacturer, under the circumstances of the case, being the thing which a customer would rely on most to establish the identity of the goods he wanted. In each of these cases the elements of all the labels were for the most part common to the trade (s).

Where any such additions or precautions are relied on by the defendant to rebut an alleged infringement, it is necessary to inquire whether they may not be removed or obliterated by fraudulent retail dealers leaving the imitated marks to effect deception without any check. On this ground, in *Barlow v. Johnson* (t), the Court paid no regard to the tickets and labels attached by the defendant to the towels sold by him under the name, *Osman*, which he had taken from the plaintiff's trade-mark.

Probability of deception is, of course, a question of fact, and, except so far as they lay down any general principle of comparison, the decided cases are of no assistance in the determination of new questions of fact raised upon other materials. "How can observations of judges upon other and quite different facts bear upon the present case, in which the only question is what is the result of the evidence?" Lord Watson asked, in *Johnston v. Orr-Ewing* (u), but the habit of referring to reported cases at the trial of such questions is inveterate, and it has been thought useful, therefore, to collect

Differences which may be removed by retailers are disregarded.

Decided cases do not assist in determining the question of fact.

(s) See also the "passing off" cases, *Jamieson v. Jamieson*, 15 R. P. C. 169, (1898) C. A.; *Payton v. Snelling*, 17 R. P. C. 48 and 628, (1900) C. A. and H. of L.; and *Payton v.*

Titus Ward, *ibid.* 58 (1899), C. A., cited p. 232.

(t) 7 R. P. C. 395 (1890), Chitty, J., and C. A.

(u) 7 App. Ca. 219 (1882).

the cases just cited, and those cited at pp. 249 and 251, above.

Inconspicuous additions a badge of fraud.

The reported cases show that attempts are frequently made to prevent the interference of the Court by using along with the spurious or deceptive marks, words, descriptions, or other additions which, if carefully examined, would prevent the deception, and at the same time, by writing the additions in small letters, or otherwise causing them to be comparatively inconspicuous, to make the probability of careful examination as small as the infringer thinks he safely can. It is obvious that, so far from affording an answer to a charge of infringement, such colourable precautions are themselves a badge of fraud. The defendant is met at once with the questions, if the additions are necessary, why are they not made conspicuous? and, if they are superfluous, why are they used at all? (x) In the following cases the several additions noted in brackets were added in small letters to the plaintiff's name or trade-mark, or to an imitation of it: [Equal to] Day & Martin's, injunction granted, *Day v. Binning*, C. P. Cooper, 489; [Late of] Lundy, Foot & Co., dismissed pending verdict at law, *Foot v. Lea*, 13 Ir. Eq. 484; [From] Thresher & Glenny, injunction granted, *Glenny v. Smith*, 2 Dr. & Sm. 476; [From] Hookham & Pottage, injunction granted, *Hookham v. Pottage*, L. R. 8 Ch. 91; [Agent for] Mason & Brand's Essence of Beef, injunction granted, *Dence v. Mason*, W. N. (1877) 23; W. N. (1878) 42; C. B. [& Co.], the plaintiff's mark was C. B., the infringing goods were made by Connell Brothers & Co., injunction granted, *Bayer v. Baird* (x).

5. Defences.

The ordinary defences.

The defences commonly set up may be tabulated as follows, that:—

- (1.) The plaintiff has no title to the trade-mark in question (y);

(x) *Bayer v. Baird*, 15 R. P. C. 615 (1896), Court Sess.; *Bayer v.*

Connell, 16 R. P. C. 157 (1899), M.R. of Ireland.

(y) Pages 358 *et seq.* and 383. The

- (2.) The defendant has an independent or a concurrent right to use the mark complained of ;
- (3.) The plaintiff has not complied with the provision of sect. 77 by obtaining the registration or refusal of the mark (z) ;
- (4.) There is no infringement (a) ;
- (5.) The plaintiff is debarred from suing the defendant for all or part of the relief he seeks by (a) an agreement or some personal estoppel (other than those next alluded to) ; (b) acquiescence or licence ; (c) delay ; or (d) because the trade-mark is deceptive, or his trade is fraudulent (b).

(1), (3), and (4) are traverses of parts of the plaintiff's case, but (1) may be something more.

Application to vary.

(1) If the plaintiff's mark has been registered for five years (c), whether in his name or in that of his predecessor in title (d), the registration is conclusive evidence of his right to the exclusive use of the mark, subject to the provisions of the Act—that is, subject to his possessing the goodwill of the business in the goods to which the trade-mark is attached (e). The defendant can adduce evidence to show (f), or he may show from the plaintiff's own evidence (g), that this condition is not complied with ; but he cannot attack the plaintiff's title generally, for instance, by showing that the mark is not a trade-mark (h), or is not within the classes of registerable symbols enumerated in sect. 64, except on an application

Attack on the plaintiff's title.

question whether the mark concerned is a trade-mark at all, as to which see Chap. II., p. 23, seldom arises in practice, except on an application to expunge an entry from the Register.

(z) Chap. XII., p. 312.

(a) Page 363.

(b) Page 390.

(c) Sect. 76, *ante*, p. 361.

(d) Sect. 87.

(e) *Ante*, p. 343.

(f) *Edwards v. Dennis*, 30 C. D. 454 (1885), C. A.

(g) As in *Pinto v. Badman*, 8 R. P. C. 181 (1891), C. A.

(h) See Chap. II., p. 23.

under sect. 90 (*i*). The application cannot be made by counterclaim in the action (*k*).

If the plaintiff's mark has not been registered for five years, the defendant can (probably) attack his title without an application to vary the Register (*l*).

Application to expunge or limit the plaintiff's registration.

It follows that the defendant in an infringement action, unless satisfied that the plaintiff's title cannot safely be attacked, generally applies to expunge the mark of the latter from the Register, or to so limit it as to defeat the action, and, according to the usual practice, the application comes on for hearing with the trial of the action, or with the plaintiff's motion for an interlocutory injunction, if any. The Court will, in a proper case, adjourn the decision of the last-mentioned motion in order to enable the defendant to make his cross application to rectify or expunge (*m*).

Determination of the plaintiff's title.

In any case, it is submitted, and notwithstanding that there is no application to rectify, the defendant may show that the plaintiff's right has determined by abandonment or otherwise (*n*).

Concurrent Right.

Concurrent or independent right.

Where the Court has so decided, two or more persons may be registered as proprietors of the same mark for the same goods (*o*), and they will then have concurrent rights. But where more than three persons are independently entitled to use a mark for the same goods it is treated as common to the trade, so that if any of them has obtained registration, the entry ought to be expunged (*p*).

The defendant, therefore, if he have an independent right, can apply for registration himself, and in a proper case the Court will order a motion for an interlocutory injunction

(*i*) As to which see Chap. XI., p. 262.

(*k*) *Pinto v. Badman*, *supra*.

(*l*) See above, p. 361, note (*d*).

(*m*) Cf. *Edwards v. Elkan*, *infra*, note (*q*).

(*n*) See Chap. XIV., p. 338.

(*o*) Sects. 71 and 72. It must be a right to use the mark as a trademark; not, for instance, as a family crest, *Standish v. Whitwell*, 14 W. R. 512; *Beard v. Turner*, 13 L. T. N. S. 746, both (1866) Wood, V.-C.

(*p*) Chap. X., p. 214.

in an action against him to stand over until his application is disposed of (q); or, if he allege that the mark is common, he can apply to remove the plaintiff's mark from the Register.

In *Mouson v. Boehm* (r), where the plaintiffs had independently adopted, and in 1880 had registered, a mark closely resembling a mark which the defendant had previously acquired by user for the same goods, and which he had never abandoned, the plaintiffs brought their action to restrain the defendant from using the latter mark. The defendant applied to register the mark as his, and moved to have the entry of the plaintiffs' mark expunged from the Register. The application to register came before the Court on a summons to proceed, and was heard, together with the motion for an injunction, at the trial of the action. Chitty, J., allowed the defendant to be registered as a proprietor of the mark, but he refused to order the registration of the plaintiffs' mark to be expunged, and he dismissed the action.

*Mouson v.
Boehm.*

Jackson v. Napper (s) is a similar case. There the defendant, in 1876, applied through an agent to register a mark as his trade-mark, and he supposed that it was registered accordingly, but, in fact, the application was not proceeded with and was, as the Court held, abandoned. In the next year the plaintiffs registered a similar mark, and more than five years after their registration they brought the action to restrain the defendant from using his mark, and thereupon the defendant took out a summons for a direction to the Comptroller to proceed with the registration of his mark. Stirling, J., found that the defendant had acquired and used his mark as a trade-mark before the 13th of August, 1875, in respect of the goods in question, except one particular class (sheep-shears); and he held that, notwithstanding that the

*Jackson v.
Napper.*

(q) *Edwards v. Elkan*, 5 R. P. C. 70 (1887), Stirling, J.

(r) 26 C. D. 398 (1884), Chitty, J. A similar case of an old mark is cited by Mr. Sebastian, *Re United Vineyards, &c. Co.* (1889), Stirling, J.; and *Re Bryant and May*, 4 Times L. R. 675 (1888), Stirling, J., is another. In *Daniel and Arter v.*

Whitehouse, (1898) 1 Ch. 685; 15 R. P. C. 134, Gorell Barnes, J. (*Brazilian Silver*), cited below, p. 484, the defendant lost by non-user a concurrent right to an (unregistered) trade name.

(s) 35 C. D. 162; 4 R. P. C. 45 (1886), Stirling, J.

five years' registration of the plaintiffs was conclusive evidence of their right to the "exclusive use" of their mark, he had jurisdiction to allow the defendant to be registered in respect of his own mark, upon the analogy of the rule that an entry on the Register may be rectified, under sect. 90 (t), after five years' registration. He accordingly directed the defendant to be registered as proprietor of his mark for the goods in question, other than the sheep-shears, and dismissed the action, except so far as regarded the last-mentioned goods, in respect of which he granted the injunction the plaintiffs sought.

Where the case made is one of colourable infringement by using part of the registered mark, or a word taken from the registered mark, the defendant may show that he has a concurrent right to the use of the part or word, as, for instance, by prior user of it (u).

The defendant should apply to register his own mark or to expunge the plaintiff's.

It will have been observed that in both *Mouson v. Boehm* and *Jackson v. Napper* there was before the Court an application to register the defendant's mark, and, upon the analogy of the decisions cited above (x), that, in the absence of an application to rectify, the registration of the plaintiff's mark is after five years conclusive proof of his right, it would seem that where the plaintiff's mark has been registered for the period named, the defendant, if he wishes to plead an independent right, must apply either to register his own name or to rectify the registration of that of the plaintiff.

Registration gives the defendant a right to use his mark *prima facie* or conclusive.

It is assumed in the judgments delivered in the above-cited cases, and is besides clearly implied by the Act, that registration when properly made gives the defendant an equal title to use the mark with the plaintiff, but only, of course, according to the terms of the entry. It is just as much an infringement for the defendant to use a registered mark for

(t) Chap. XII., p. 309.

(u) *Edge v. Gallon*, 16 R. P. C. 509, and 17 R. P. C. 557 (1900), C. A. and H. of L. (*Dolly Blue*); *Mealy v. Triticine*, 15 R. P. C. 1 (1897), North, J., both "passing off"

cases. In an infringement action, the defendant would probably argue alternatively that he had not infringed or that the plaintiff's mark was wrongly registered.

(x) Page 361.

goods (*y*), or in a market in respect of which it is not registered, and the plaintiff's mark is registered, as if the defendant's mark were not registered at all. If the plaintiff alleges that the use of the registered mark of the defendant for the goods in respect of which it is registered is an infringement of his mark, his proper course is to apply in the first place to remove the defendant's mark from the Register before commencing, or concurrently with (*z*), the action for infringement.

If the defendant's mark has been registered for five years, on the principle referred to above (*a*), the plaintiff cannot question the right *prima facie* conferred by the registration except upon an application to vary or expunge the entry; but, as in the corresponding case of the plaintiff's registered mark, where the registration is less than five years old, it appears to be open to the plaintiff to prove by evidence in the action that it does not, in fact, confer any right to the use of the mark (*b*).

Registration for copyright purposes of a mark at Stationers' Hall confers no trade-mark rights, and constitutes no defence if the mark is an infringement of another person's trade-mark (*c*).

Registration at Stationers' Hall.

If the plaintiff and defendant are severally entitled to, and are the registered proprietors of, two marks which are in ordinary markets distinct and unlikely to be confused, is it an infringement for the defendant to introduce his mark into a market where the plaintiff's is already known, if from the character of the customers there,—their ignorance of English, for instance,—its use is calculated to cause the defendant's goods to be taken for the goods of the plaintiff? It is

Is the introduction of the defendant's own mark into a new market an infringement?

(*y*) *Upper Assam Tea Co. v. Herbert*, 7 R. P. C. 183 (1889), C. A.

(*z*) As in *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 C. D. 454; 3 R. P. C. 28 (1886), Kay, J., where the Register was rectified by limiting the goods for which the defendant's mark was registered, and an injunction was granted in respect of other goods.

(*a*) Page 362.

(*b*) *Reed v. Richardson*, 45 L. T. 54 (1881), C. A., cited, p. 407, interlocutory injunction granted; *Goodwin v. Venning*, 24 Sol. J. 690 (1880), Jessel, M. R.

(*c*) *Reinhardt v. Spalding*, 49 L. J. Ch. 57 (1879), Hall, V.-C. (*Family Salve*); *Paine v. Daniells & Sons' Breweries*, cited p. 372.

submitted that it is an infringement, for the case put falls within the principle that one trader must not do what is calculated to cause his goods to be taken for those of another, and the defendant's action is in this sense the cause of deception. The question was raised, but not determined, in *Johnston v. Orr-Ewing*, in the House of Lords, and the words of the order of Fry, J., having special reference to the Bombay trade were, with the assent of the respondents, directed to be omitted. Lord Selborne said, in his judgment in the case: "Your Lordships are not called upon to decide whether a ticket, which was a rightful and *bonâ fide* trade-mark of the trader using it, could be excluded by injunction from particular markets (though unimpeachable everywhere else) merely because in those markets it might be liable to be called by a name which the mark of another trader had already acquired there. . . . To that proposition I should not myself, as at present advised, be prepared to assent" (*d*).

Introduction
into a new
trade.

The introduction of the defendant's marks into a new trade in goods for which it is not, and the plaintiff's mark is registered, is undoubtedly an infringement (*e*).

Trade-mark
rights on the
dissolution of
a partnership.

Where a partnership is dissolved without a sale of the goodwill, or any arrangement having been made for its disposal, or governing the use of the trade-marks of the firm, each of the late partners who carries on the business may use the trade-marks (*f*), for he is, as to a portion of the

(*d*) 7 App. Ca. p. 227 (1882). See also *Wilkinson v. Griffith*, 8 R. P. C. 370 (1891), Romer, J. An injunction, on the ground of "passing off," limited to Ireland was granted in *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L. J.

(*e*) Above, p. 387, note (*y*). In *Hodgson v. Kynoch*, 15 R. P. C. 465 (1898), Romer, J., the defendants were makers of ammunition. Their works were known as Lion Works, and they had lion trade-marks. Held, that they were not justified in using lion marks for soap.

(*f*) *Banks v. Gibson*, 34 Beav. 566 (1865), Romilly, M. R.; *Condy v. Mitchell*, 37 L. T. n.s. 268 and 766 (1877), Bacon, V.-C., and C. A.; *Benbow v. Low*, 44 L. T. n.s. 875 (1881), Bacon, V.-C. See Chap. XIII., p. 331. As to cases where the severance of business relations determines a joint trade-mark, see *Robinson v. Finlay*, 9 C. D. 487; and *Jones' Tm.*, 53 L. T. n.s. 1, cited pp. 53 and 54. As to trade-name on dissolution of partnership, see next chapter, p. 496.

goodwill, a successor of the firm (*g*); but if the goodwill is sold as part of the assets of the firm, the exclusive right to use the trade-marks may be sold with it, and in that case the late partners cannot lawfully use the trade-marks, even though they set up a similar business in competition with the purchaser (*h*).

But a late partner cannot grant to others who are in no way successors to the firm's business, or any part of it, a right or licence to use the trade-marks, even though he be registered as proprietor of the marks under sect. 87, or otherwise. The case of *Hanson v. Game, Harrison and Lerner, Limited* (*i*), was decided on the construction of a consent order under which the partnership in question had been dissolved, and which provided that the late partners "and any partners they may take respectively" were to have the common use of the trade-marks; but it is submitted that the decision might have been put on the general ground that the defendants—a limited company, of which one late partner was a shareholder and director—could not use the marks without infringing the rights of the plaintiffs, the other late partner and his partners, because they were not possessed of the goodwill of any part of the old business.

So if the trustee in bankruptcy of a trader sells the goodwill and trade-marks of the latter's business, the trader has no right to continue to use the marks (*k*).

Sale of trade-marks in bankruptcy.

A trader who is honestly using his own name in his business will not be guilty of infringement because its similarity to a name appearing in another's trade-mark is calculated to lead to deception. Sect. 64 (3) (i), which relieves an applicant for registration from the necessity of

Honest use of the defendant's name is no infringement.

(*g*) The partners will not be entitled to re-register the marks in their separate names, or (*semble*), if there are more than two partners, to register themselves separately as assignees. The marks, by arrangement, could be assigned to a trustee for all; *Ehrmann's Tms.*, (1897) 2 Ch. 495; 14 R. P. C. 665, Stirling, J.

(1899) 1 Ch. 378, Romer, J., cited below, p. 498, where all the authorities are reviewed.

(*i*) 9 R. P. C. 186 (1892), Stirling, J.

(*k*) *Hammond v. Brunker*, 9 R. P. C. 301 (1892), Chitty, J.; *Hudson v. Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C.

(*h*) See *Re David and Matthews*,

disclaiming his own name or its foreign equivalent if it forms part of the mark tendered for registration, expressly provides that no entry of any such name upon the Register shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof. But to support this defence the business must be his own, for a fraudulent attempt to cover an infringement by employing or taking into partnership a man who happens to bear the name which is to be used to effect the fraud, still less by buying from him the right to use his name, will not avail to protect the offender (*l*).

(3.) The necessity for registration of the plaintiff's marks, having regard to sect. 77, has already been discussed (*m*).

(4.) And so has the question, What constitutes an infringement? (*n*).

Estoppel.

(a) With the exception of the several defences which are considered below, there is nothing peculiar to the law of trade-marks to determine what agreements, or what circumstances constituting a personal estoppel, will prevent a plaintiff from suing a particular defendant for infringement. It is to be remembered, however, that an infringement is primarily a fraud on the public, in respect of which the plaintiff is allowed to sue, because its natural effect is to cause damage to him (*o*). An agreement, therefore, not to prosecute future infringements would be an agreement to permit a fraud, and although, if established, it would undoubtedly prevent the Court from interfering in favour of any party to it (*o*), it could not be specifically enforced, and, unless the intention were clearly indicated, the Court would presume that a lawful

Agreement
to condone in-
fringements.

(*l*) See the next chapter, p. 511, where this matter is fully discussed in relation to trade-names.

(*m*) Above, p. 361; Chap. XII., p. 312.

(*n*) Above, p. 363.

(*o*) See *Grezier v. Autran*, 13 R. P. C. 1 (1896) (*Chartreuse*), where an agreement was set up, Chitty, J., said, "I need hardly state that the plaintiffs do not move in any sense on behalf of the public."

arrangement, for instance, a waiver of the remedy in respect of past infringements only, was intended (p).

As an instance of estoppel by conduct, the case of *Maxwell v. Hogg* (q) may be taken. There the defendants had received, and published for reward from the plaintiffs, advertisements of an intended new magazine, bearing the title of a magazine which they were themselves preparing to publish, without warning the plaintiffs of their own intention; and this uncandid conduct was held to be sufficient ground for dismissing the cross suit of the defendants for an injunction to prevent the plaintiffs using the name. Uncandid conduct.

And anything in the nature of a representation by the plaintiff to the defendant that his mark was not an infringement, or that it might be lawfully used, or of an encouragement to him to continue using it, would be an answer to a subsequent claim for damages for infringement, although a mere failure by the plaintiff as soon as he had knowledge of the infringement to warn the defendant, would be no bar (r). Failure to give warning.

It is sometimes urged, on behalf of the defendant, as an objection to the plaintiff's case, that the plaintiff in actual practice uses his mark in a form different from that for which he has obtained registration; but the variation of his registered mark by the plaintiff, provided it is not an infringement of any other person's mark, or a breach of any agreement binding upon him, is perfectly lawful, although so far as the mark actually used differs substantially from his registered mark, it is an unregistered mark, as has been already pointed out. If the registered mark is in substance not used at all, that would be an independent objection to the plaintiff's action (s). It is well settled that the use of a varied mark by the plaintiff does not in any way estop him from pro- The plaintiff is not barred because he uses his registered mark with additions.

(p) *Oldham v. James*, 13 Ir. Ch. 393; 14 Ir. Ch. 81 (1862), Brady, C., and Blackburn, L. J.

(q) L. R. 2 Ch. 307 (1867), Turner and Cairns, JJ., cited p. 33.

(r) See *Proctor v. Bennis*, 36 C. D. 740 (1887), C. A., a patent case;

and the notes to *Savage v. Foster*, 2 White & Tudor's Leading Cases, 6th ed., 680. The rule is "*qui potest et debet vitare jubet*"; *Osborn v. Lees*, 9 Mod. 96; *Willmott v. Barber*, 15 C. D. 96; 17 C. D. 772. As to delay, see p. 394.

(s) Above, p. 361.

ceeding against infringers. Thus, in *The Melachrino Case* (t), the plaintiffs had tried to register a label comprising three coats of arms, but the coats of arms had been rejected and the label registered without them. The plaintiffs, nevertheless, always used the labels with the arms in it, and the defendants, who had imitated the label, were enjoined from continuing the infringement. In a subsequent case (u), Chitty, J., said: "I adhere to what I said in *Melachrino's Case*, that the mere addition of something, as, in that case, a coat of arms, to the trade-marks, is not sufficient to disentitle a person who otherwise uses the whole of his trade-marks to sue for an injunction."

Similarly, it is no ground of estoppel that the plaintiff extends the use of his mark to goods in respect of which it is not registered (x).

Acquiescence. (b) Acquiescence in the infringement on the part of the plaintiff is a complete defence (y), but it can only be inferred where he is shown to have had knowledge of it (z). And, assuming that it is shown that the plaintiff knows of the infringement, the Court will not readily infer that he has assented to what is likely to be so detrimental to his property. It has been held that, where it is pleaded in answer to a motion to commit the defendant for the breach of an injunction restraining him from infringing, it must amount to a licence "sufficient to create a new right in him" (a).

(t) *Melachrino & Co. v. The Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215 (1887), Chitty, J.; *Newman v. Pinto*, 4 R. P. C. 508; 57 L. T. 31 (1887), Kekewich, J., and C. A. In *Rowland v. Mitchell*, 13 R. P. C. 457; 14 R. P. C. 37 (1896), Romer, J., and C. A., the plaintiff omitted some of the added words and used other words. This was held to be immaterial.

(u) *Hammond v. Brunker*, 9 R. P. C. p. 307 (1892).

(x) *Jay v. Ludlow*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

(y) Per Chitty, J., in *Mouson & Co. v. Boehm*, 26 C. D. p. 406 (1884).

(z) *Weldon v. Dicks*, 10 C. D. 217 (1878), Malins, V.-C.; *Re Farina*, 27 W. R. 456 (1879), Hall, V.-C., and the last case. See, generally, *De Bussche v. Alt*, 8 C. D. 286, C. A.; and *Willmot v. Barber*, 15 C. D. 96; 17 C. D. 772, Fry, J., and C. A.

(a) *Rodgers v. Nowell*, 3 De G. M. & G. 614; 22 L. J. Ch. 404 (1853), per Turner, L. J. As to what constitutes acquiescence, see *Proctor v. Bennis*, *ante*, p. 391; "delay," section (c); and *Hogg v. Scott*, L. R. 18 Eq. 444, Hall, V.-C.; *Weldon v. Dicks*, 10 C. D. 217, Malins, V.-C. (copyright); and *Smith v. Smith*, L. R. 20 Eq. 500, Jessel, M. R.

In *Rowland v. Mitchell* (b) Romer, J., said :—“ I quite agree that merely threatening a person in cases of this kind, without taking proceedings, is not sufficient. If the plaintiff really does stand by and allow a man to carry on business in the manner complained of, to acquire a reputation, and to expend money, he cannot then, after a long lapse of time, turn round and say that the business ought to be stopped.” On the other hand, Russell, L. C. J. (c), said in the same case : “ It cannot be stated as a general proposition in respect of a person, irrespective of the character of the trade done, and the extent of that trade in respect of the position and impecuniosity of that person, that the moment it comes to the knowledge of a manufacturer that somebody has been trying to do a fraudulent thing on his part he is bound to take proceedings, or if he does not take proceedings, it is concluded against him that he means to acquiesce in the right of that other person to continue to do what he has been doing.” The facts of each case must be examined to see whether there has been an acquiescence or not.

A licence by the plaintiff to the defendant to use the mark would be proof of acquiescence in user falling within the terms of the licence, and would be a defence (d). Any registered proprietor can grant licences to use the mark, subject to any equities affecting it (e), unless, for instance, he has agreed with the plaintiff not to do so (f). But it is submitted that a licence by some registered proprietor, other than the plaintiff, would not be a defence unless the defendant were possessed of the goodwill of the business, or part of it, to which the trade-mark was attached (g).

Licence.

(ancient lights). See also, generally, the article *Acquiescence* in the *Encyclopedia of English Laws*, 1897.

(b) 13 R. P. C. p. 464. It was held there had been no acquiescence or abandonment in this case, see below, note (x). See also on the defence of “standing by,” per Byrne, J., in *Jamieson v. Jamieson*, 15 R. P. C. 169, at p. 179.

(c) 14 R. P. C. at p. 44. See also

Kekewich, J., in *Ripley v. Bandy*, 14 R. P. C. at p. 596.

(d) *Kinahan v. Bolton*, 15 Ir. Ch. 75 (1863), Brady, C.

(e) Sect. 87.

(f) *Hanson v. Game, Harrison and Larner, Ltd.*, 9 R. P. C. 186 (1892), Stirling, J.

(g) See Chap. XIII., p. 335, and sect. 70.

Delay does not bar the right of action;

(o) Mere delay, after knowledge of the infringement, to take proceedings, not sufficient to call the Statute of Limitation into operation, or where the infringement continues, is no bar to the action. Before the Judicature Acts it might have furnished an answer to an application for an injunction (*h*), at least until the plaintiff had established his rights by recovering damages in an action at law, unless the deception resulting from the use of the defendant's mark were still continuing (*i*). But both branches of the Court now enforce legal and equitable rights together, and consequently, wherever an injunction could have been obtained after an action for damages, it can now be obtained at once or concurrently with the judgment for damages. The rule is not peculiar to trade-mark cases, but is part of the general law (*j*). It was stated by Fry, J., in the following terms, in *Fullwood v. Fullwood* (2) (*h*): "In my opinion that delay" (from early in 1875, when the plaintiff first knew of the infringement, till November, 1876, when he commenced his action) "—and it is simply delay—is not sufficient to deprive the plaintiff of his rights. The right asserted by the plaintiff in this action is a legal right. He is, in effect, asserting that the defendants are liable to an action for deceit. It is clear that such an action is subject to the Statute of Limitations (*l*), and it is also clear that the injunction is sought merely in aid of the plaintiff's legal right. In such a case the injunction is, in my opinion, a matter of course, if the legal right be proved to exist. In saying that I do not shut my eyes to the possible existence in other cases of a purely equitable defence, such as acquiescence or acknowledgment (*m*), and the various other equitable defences which may be imagined. But lapse of time, unaccompanied by anything else (and to that I con-

(*h*) *Hovenden v. Lloyd*, 18 W. R. 1132 (1870), Bacon, V.-C., fifteen months' delay; *Estcourt v. The Estcourt Hop Essence Co.*, 10 Ch. 276 (1875), Cairns, L. C. and L. JJ., seven months' delay.

(*i*) *Rodgers v. Rodgers*, 31 L. T. N. S. 285 (1874), L. JJ.

(*j*) See *The Three Towns* &c. &c.

Co. v. Maddever, 27 C. D. 533 (1884), C. A.

(*h*) 9 C. D. p. 178 (1878); and see *L. C. & D. Rail. Co. v. Bull*, 47 L. T. 412.

(*l*) But where the tort is continuing, the right of action is also continuing.

(*m*) *Quære* abandonment.

fine my observations), has, in my judgment, just as much effect, and no more, in barring a suit for an injunction as it has in barring an action for deceit. In my judgment, the same rule applies since the Judicature Act as formerly applied in the Court of Chancery when the legal right had to be determined in an action at law" (n).

But delay may affect the nature of the relief granted. It may cause the Court to refuse the ordinary interlocutory injunction, either on terms of the defendant keeping an account, or absolutely (o), or to refuse to give damages, or to direct an account of profits in lieu of damages, or to restrict such account to profits made since the beginning of the action (p). but delay may modify the relief granted;

And in a case where the plaintiffs took no action on hearing that the defendant had received a small consignment of spuriously marked goods, preferring to wait until he received a larger consignment, Malins, V.-C., ordered the injunction to be directed to future receipts by the defendant only (q). Unless, however, this case can be supported on the ground of acquiescence, it is submitted that it is inconsistent with the rule established by the cases cited above.

In *Liebig's Extract of Meat Co. v. Chemists' Co-operative Soc. (r)*, the defendants had used the wrapper complained of in 1893. The plaintiffs discovered in 1894 that the defendants were using it, but they did not know to what extent. They commenced their action in May, 1896, and obtained full relief, *i.e.*, an injunction, an inquiry as to damages, and costs.

But delay to pursue infringers, where the infringements are numerous and notorious, may amount to abandonment and may amount to abandonment.

(n) Cf. the judgment of Mellish, L. J., upon the defence of misrepresentation in *Ford v. Foster*, L. R. 7 Ch. p. 632.

(o) See below, "Interlocutory injunction," p. 416.

(p) See below, "Profits," p. 422. The American law is the same on both points. It is well stated in *McLean v. Fleming*, 96 U. S. Rep.

245, followed in *Menendez v. Holt*, 128 U. S. Rep. 514 (both Supreme Court), Cox, pp. 326, 467.

(q) *The Anglo-Swiss Condensed Milk Co. v. The Swiss Condensed Milk Co.*, (1871) W. N. 163.

(r) 13 R. P. C. 635, 736 (1896), Kekewich, J., and C. A. A trade-name and passing off case.

ment (*s*) of the trade-mark, and lead to its becoming *publici juris* (*t*).

Delay may be explained.

The delay may be of little importance if it appears that the plaintiff had been led to believe that the infringement had ceased (*u*), or if the infringement is of slight amount. Its bearing on the case must always depend upon the circumstances under which it occurs. Thus in *Rowland v. Mitchell* (*x*) the plaintiff knew of an infringement by a third party in 1892. The third party when threatened with proceedings refused to stop, but was not worth suing. The plaintiff lost sight of him, and thought that the infringement had stopped. The action was begun in October, 1895, and the plaintiff obtained an injunction, with an inquiry as to damages and costs.

It has a bearing on the weight of evidence.

And, as already pointed out, delay may have an important bearing on the weight of the evidence in the case, for if, in spite of long user by the defendant of the alleged infringing mark, no case of actual deception is proved, and the absence of evidence of such deception is not otherwise accounted for, it may be difficult for the Court to believe that the defendant's mark is calculated to deceive. It has been suggested that, where the infringement has lasted a number of years, it is necessary for the plaintiff to prove that some persons have actually been deceived (*y*), but this is not, it is submitted, a rule of law (*z*).

Moreover, lapse of time may prevent conduct which would

(*s*) Page 346.

(*t*) As in *Hyde & Co.'s Tm.*, 7 C. D. 724 (1878), Jessel, M. R. (*Bank of England Sealing Wax*); Chap. XIV., p. 339. See also *National Starch Manufacturing Co. v. Munns & Co.*, (1894) A. C. 275; 11 R. P. C. 281 (*Maizena*), there cited. In *Ripley v. Handley*, 14 R. P. C. 591 (1897), Kekewich, J. (*Oval Blue*), the action was dismissed, because the plaintiff had known of the use by others of the get-up of which he complained beginning sixteen years before the action. This use was at first small, but ultimately became important.

An appeal was compromised, 14 R. P. C. 944.

(*u*) *Daniel and Arter v. Whitehouse*, (1898) 1 Ch. 685; 15 R. P. C. 134, Gorrell Burnes, J.

(*x*) 13 R. P. C. 457; 14 R. P. C. 37, Romer, J., and C. A., not reported on this point in L. R. The third party was a costermonger. See the passages quoted above, p. 393. Cf. *Ripley v. Handley*, note (*t*).

(*y*) *Rodgers v. Rodgers*, 31 L. T. N.S. 287 (1874), per Mellish, L. J.; *Isaacson v. Thompson*, 41 L. J. Ch. 101 (1871), Bacon, V.-C.

(*z*) See "Proof of Actual Deception," p. 249.

at first be an infringement from being calculated to deceive. Thus, in *The Marquis of Londonderry v. Russel* (a), an action against the defendant, for sending coals to the London market as "Londonderry Wallsend Coal," was dismissed because the defendant had used the name for twenty-five years, and the plaintiff had long known of his use of it. Whatever might have been the result had the plaintiff applied in 1861 to restrain the defendant from selling his coals under the name, it was clear, as the Court of Appeal held, that at the time of their judgment the defendant's conduct could not be taken to amount to any representation that his coals came from the plaintiff's Londonderry collieries.

(d) The Court will not interfere to protect the use of a deceptive trade-mark, or to assist a trader who is using his mark for the purposes of a fraudulent trade. This principle was well established in the Court of Chancery, and, although no case seems to be reported upon the point, it would no doubt have been recognized also in the Courts of Common Law before the Judicature Acts, had any case occurred, for the maxim *ex turpi causa non oritur actio* is a rule of law (b).

Deceptive trade-mark and fraudulent trade.

"The plaintiff," Lord Westbury said, in *The Leather Cloth Case* (c), "desires to restrain the defendant from selling his own goods as the goods of another person; but if, by the use of the trade-mark in question, the plaintiff himself is representing and selling his goods as the goods of another, or if his trade-mark gives a false description of the article, he is violating the rule upon which he seeks relief against the defendant."

The deceptive mark, in Sir Roundell Palmer's phrase,

Deceptive trade-marks are outlawed.

(a) 2 Times L. R. 843; 3 Times L. R. 360 (1886), Bacon, V.-C., and C. A.

(b) See the judgment of Mellish, L. J., in *Ford v. Foster*, L. R. 7 Ch. p. 631 (1872), cited below. In a "got up" case, *Jamieson v. Jamieson*, 15 R. P. C. 169, V. Williams, L. J., said, *obiter*, that misrepresentation to the public would be no answer to an action for damages. The misrepresentation alleged was not com-

prised in the matter sought to be protected, and the Court, in fact, thought there was no misrepresentation. In *Wolff v. Nopitsch*, 18 R. P. C. 27 (1901), Lord Alverstone, L. C. J., said that he wished to reserve his opinion on the question whether there was any distinction between cases of trade-mark and of fraudulent passing off.

(c) 4 De G. J. & S. 137; 33 L. J. Ch. 199 (1863).

adopted by James, V.-C., in *The Leather Cloth Co. v. Lonsont* (d), is "outlawed."

Collateral
misrepresentation.

Ford v. Foster.

The judgment of
Mellish, L. J.

The earliest of the cases commonly cited, in which the Court of Chancery refused to interfere, on the ground of the plaintiff's own deceptive conduct, until the plaintiff had established his right by action at law, is *Pidding v. How* (e), and the leading authority on the subject is the judgment of Mellish, L. J., in *Ford v. Foster* (f). There it was objected by the defendants that the plaintiff in certain invoices and advertisements had falsely described himself as a patentee; but as the false description was collateral and did not appear in the mark in question, and the plaintiff's trade was not shown to be fraudulent, the Court decided that the plaintiff's legal right of action in respect of the defendant's infringement was not barred, and that he was consequently entitled to an injunction, with an account from the filing of the bill, and costs. If the false representation had been in the trade-mark itself, the Lord Justice held, no Court of Equity, and, according to his opinion, no Court of law, would have entertained the plaintiff's action, and the same rule would apply if the trade were fraudulent; but, he said, "where the trade is, as in this case, a perfectly honest trade, and where the trade-mark is, as in this case, a perfectly honest trade-mark, I am clearly of opinion that there is no common law principle upon which it is possible to hold that the fact that the plaintiff has been guilty of some collateral fraud would be an answer to an action. It would be impossible to plead at law as a justification for the defendant's committing the fraud, that the plaintiff had committed a fraud on someone else." "It is true," he added, "that in this case the bills containing this false representation as to its being a patented article are proved to have been given to the defendants themselves; but there is not the slightest evidence,

(d) L. R. 9 Eq. p. 352 (1869).

(e) 8 Sim. 477; 6 L. J. Ch. n.s. 345 (1837), Shadwell, V.-C. Lying advertisements as to the origin of tea (*Howqua's Mixture*). The Vice-Chancellor said, "It is a clear rule, laid down by Courts of equity, not

to extend their protection to persons whose case is not founded upon truth."

(f) L. R. 7 Ch. 611 (1872) (*Eureka Shirts*). For the American authorities, which are very numerous, see Mr. Cox's note to this case.

or the slightest reason for supposing, that the defendants were ever deceived by that representation, because they knew perfectly well that there was no patent for these shirts" (*g*).

The following are some miscellaneous examples of cases where objections to the plaintiff's case on the ground of collateral misrepresentation failed: title of a magazine protected, although the magazine purported to be written by someone other than the author, *Hogg v. Kirby*, 8 Ves. 215; 7 R. R. 30; similar cases with regard to songs, *Chappell v. Sheard*, 2 K. & J. 117; *Chappell v. Davidson*, 2 K. & J. 123; 8 De G. M. & G. 1; "Holloway's pills and ointment" protected, although the plaintiff called himself Professor Holloway without warrant, and published exaggerated commendations of his pills, *Holloway v. Holloway*, 13 Boav. 209; an objection on the ground that the plaintiffs retained a brass plate on the door of their business premises, bearing their predecessor's name, overruled, *Hudson v. Osborne*, 39 L. J. Ch. 79.

Examples of collateral misrepresentations.

Sect. 73 provides that it shall not be lawful to register as part of, or in combination with, a trade-mark, any words the use of which would by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a Court of Justice (*h*).

It follows that a trade-mark which contains false statements or misrepresentations ought not to be entered or retained upon the Register, and, in modern cases, if the defendant wishes to rely upon the defence now under consideration, and to allege that the plaintiff's trade-mark itself is deceptive, he commonly applies under sect. 90 to have it removed from the Register (*i*). This is a convenient method

Application to remove deceptive mark from the Register.

(*g*) See note (*b*) above. The matter is well stated in an American case. "Courts of equity will not protect a trade-mark that deceives the public. We do not suppose, however, that that deception need be of such a character as to work positive injury to purchasers, nor, on the other hand, that every erroneous impression which the public or a portion of the public may receive will be sufficient to destroy the validity of a

trade-mark. The question is whether . . . the representation is of such a character as to defeat the petitioner's claim to protection": *Meriden Britannia Co. v. Parker*, 12 Amer. Rep. 401, cited by Cox, p. 29.

(*h*) Chap. X., p. 253.

(*i*) *Wood v. Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A.; *Dexter's Tm.*, (1893) 2 Ch. 262; 10 R. P. C. 269, Wright, J. See Chap. X., p. 253.

of bringing the question to an issue, if the plaintiff is suing in respect of a registered mark, and it is the most advantageous course for the defendant; but there is no reason to suppose that the Court would be any more ready to interfere to protect a deceptive trade-mark because it was registered, or that it is not open to the defendant to give evidence in support of a plea of the defence in question without there being any application under sect. 90 before the Court (*j*).

(i.) Where the trade-mark itself contains misrepresentations—

The Leather Cloth Case.

In *The Leather Cloth Case* (*k*), the plaintiffs' case failed because, in the label in question, they had described their goods as "tanned leather cloth," "patented," and "J. R. and C. P. Crockett" as the manufacturers, adding an American address, whereas, in fact, much of the cloth for which the mark was used was not tanned, none of it was made under any patent, and the manufacturers were not J. R. and C. P. Crockett, but the plaintiffs themselves, who had no American address. It was urged on behalf of the plaintiffs that the misrepresentations, and in particular the representation that the goods were tanned, could not deceive any ordinary purchaser; but in answer to this Lord Westbury said: "I cannot receive it as a rule either of morality or equity that the plaintiffs are not responsible for a falsehood because it is so gross and palpable that no one is likely to be deceived by it. If there is a wilfully false statement, I will not stop to inquire whether it is too gross to mislead" (*l*).

It is immaterial that the misrepresentation does not deceive;

or that the facts are known to the trade.

It is no answer to the objection that the trade, or any other given class of persons, know the actual facts and are not deceived (*m*); for, as in the case of the test of infringe-

(*j*) As to this point, see *Hubbuck v. Brown*, 17 R. P. C. 638 (1900), C. A.

(*k*) 4 Do G. J. & S. 137; 33 L. J. Ch. 199, Lord Westbury; and 11 H. L. C. 523; 35 L. J. Ch. 53; H. L. overruling 1 H. & M. 271; 32 L. J. Ch. 721, Wood, V.-C. (1863). See also *Newman v. Pinto*, 4 R. P. C. 508; 57 L. T. 31 (1887),

C. A., mark representing German cigars as of Havana make, cited p. 410.

(*l*) 33 L. J. Ch. p. 203. So per Fry, L. J., in *Newman v. Pinto*, 4 R. P. C. p. 520 (1887).

(*m*) *Wood v. Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A.; cf. *Kno v. Dunn*, 10 R. P. C. 261 (1893).

ment, the question is—is the mark calculated to deceive any probable purchasers who buy from the plaintiff directly or indirectly through others to whom he sells?

The employment of the word “patent” in a mark used for goods which are not manufactured under an existing patent right has given rise to much discussion (n); but the authorities do not seem to have established any more definite rule than that it is in each case a question whether or not the employment of the word makes a false and deceptive claim to a non-existent patent right for the goods (o). It is not necessarily deceptive to describe as “patent” goods made according to a process which once was patented, or even those made according to a process which is, or was when the epithet was first applied, different from the common process, though never protected by a patent, for ordinary usage and understanding have long sanctioned such descriptions, as the names patent leather, patent medicine, patent metal, patent yellow, and patent hoe, show (p).

The following passage from Lord Kingsdown’s judgment, in *The Leather Cloth Case* (q), in reference to the subject under consideration, is very frequently cited in argument: “If a trade-mark represents an article as protected by a patent, when in fact it is not so protected, it seems to me that such a statement *prima facie* amounts to a misrepresentation of an important fact, which would disentitle the owner of the trade-mark to relief in a Court of Equity against anyone who pirated it. In *Flavel v. Harrison* (r), Wood, V.-C., intimated his opinion that this would be so when there never had been

False claim of patent right.

Lord Kingsdown’s judgment in *The Leather Cloth Case*.

(n) Its use may amount to a criminal offence; sect. 105, and Merchandise Marks Act, 1887, s. 3 (1) (c); Book II., Chap. I., p. 579.

(o) The authorities cannot easily be reconciled under one rule: per Kekewich, J., *Hubbuck v. Brown*, (1899) W. N. 251; 17 R. P. C. p. 156.

(p) See per Wood, V.-C., in *Edelsten v. Vick*, 11 Hare, 78 (1853); *Morgan v. McAdam*, 36 L. J. Ch. 228 (1866) (*Patent Plumbago Crucibles*); and *Gridley v. Swinborne*, 5 Times

L. R. 71; 52 J. P. 791 (1888), Coleridge, L. C. J., and Grantham, J., cited p. 580 (*Swinborne’s Patent Refined Isinglass*). “The illustrious race whose drops and pills, have patent powers to vanquish human ills”—Crabbe, quoted in Ogilvie’s Dictionary.

(q) 11 H. L. C. 523; 35 L. J. Ch. p. 64 (1865).

(r) 10 Hare, 467; 22 L. J. Ch. 866 (1853).

any patent at all. But in the subsequent case of *Edelsten v. Vick* (s), he seems to doubt whether the rule would be the same if there had originally been a patent, and the statement in the trade-mark being true when first introduced, had been continued after it had ceased to be true. I confess that I should have had great difficulty in assenting to that distinction. If the word 'patent' be not so used as to indicate the existing protection of a patent, but merely as part of the designation of an article known in the market by that term (and this I collect to have been the main ground of his Honour's decision), then I quite agree with his view. In such case nobody is meant to be deceived, or is deceived. A patent may have expired fifty years ago, and yet the name of patent may have become attached to the article, and be used in the trade as designating it. But if the trade-mark represents the article as protected by patent, when in fact it is not so protected, I cannot think that it can make any difference whether the protection has never existed or has ceased to exist."

Expired
patent.

And in a later case, Jessel, M. R., said: "No doubt a man may use the word 'patent' so as to deceive no one. It may be so used as to mean that which was a patent but is not so now. In other words, you may state in so many words, or by implication, that the article is manufactured in accordance with a patent that has expired. But if you suggest that it is protected by an existing patent, you cannot obtain the protection of that representation as a trade-mark. Protection only extends to the time allowed by statute for the patent, and if the Court were afterwards to protect the use of the word as a trade-mark, it would, in fact, be extending the time for protection given by the statute. It is, therefore, impossible to allow a man who has once had the protection of a patent to obtain a further protection by using the name of his patent as a trade-mark. But further, no man can claim a trade-mark in a falsehood. It is a falsehood to represent that the patent is still existing" (t).

In *The Club Soda Case* the plaintiff's mark consisted of a

(s) 11 Hare, 78 (1853).

(t) *Cheavin v. Walker*, 5 C. D. p. 862 (1877), C. A.

label bearing the words "Club Soda," and also "Manufactured in Ireland by H.M. Royal Letters Patent." This was explained to mean "manufactured by the aid of patented machinery." The offending words were also used in advertisements, but the goods were never called "patent club soda water." The Privy Council held that, having regard to the nature of the goods, no one could be deceived, and they gave judgment for the plaintiff (u).

From the principles stated in these judgments, and from the decided cases, it follows that the use of the word "patent" in a trade-mark for unpatented goods is not to be taken to be misleading where either it is shown that the market name of the goods comprises the word (x), or where the goods are made according to an expired patent, and the word is so used as to be understood to refer to this (y), or wherein from the nature of the cases it is unlikely to mislead (u).

The following is a summary of the reported cases on the subject (z):—

First, where the plaintiff's action was barred: FLAVEL'S PATENT KITCHENER, no patent, *Flavel v. Harrison*, 10 Ha. 467; 22 L. J. Ch. 866; PATENTED JAN. 24, '56, patent void, *Leather Cloth Co., Ltd. v. American Leather Cloth Co., Ltd.*, p. 400; *Leather Cloth Co., Ltd. v. Lorsont*, L. R. 9 Eq. 345; PATENT PLUMBAGO CRUCIBLES, no patent, *Morgan v. McAdam*, p. 401; ROYAL LETTERS PATENT, no patent, but duty paid in respect of a patent medicine, *Lamplough v. Balmer*, W. N. (1867) 293 (a); MANUFACTURER AND PATENTEE, no patent, *Nixey v. Rossiey*, W. N. (1870) 227; G. CHEAVIN'S IMPROVED

Where
"patent" is
not deceptive.

Summary of
cases where
"patent"
used.
Action
barred.

(u) *Cochrane v. Macnish*, (1896) A. C. 225; 13 R. P. C. 100.

(x) *Marshall v. Ross*, L. R. 8 Eq. 651 (*Patent Thread*); cf. *Leather Cloth Co. v. Lorsont*, L. R. 9 Eq. 345, both (1869), James, V.-C.

(y) *Ransome v. Graham*, 51 L. J. Ch. 897 (1882), Bacon, V.-C. In *Morgan v. McAdam*, 36 L. J. Ch. 228 (1866), Wood, V.-C., suggested that in these cases the date of the patent should be given.

(z) The pages given refer to this

book. See also *Adams' Tm.*, 9 R. P. C. 174; 66 L. T. N.S. 610 (1892), where Kekowich, J., refused to allow "patent" to be struck out of an old mark for furniture polish.

(a) "Patent medicines" are excepted from the prohibition upon the sale of poisons in the Pharmacy Act, 1868. The exception relates to medicines manufactured under letters patent only: *Pharmaceutical Society v. Piper*, (1893) 1 Q. B. 686; *Stone v. Armon*, (1894) 2 Q. B. 720.

PATENT GOLD MEDAL SELF-CLEANING RAPID WATER FILTER, expired patent, *Chevin v. Walker*, p. 402. In *Hubbuck v. Brown*, 17 R. P. C. 638, where the mark included the words HUBBUCK'S PATENT LONDON in circular form with the words WHITE ZINC within the circle, the mark being an old one registered for paints, it was shown that the plaintiffs had never had any patent for White Zinc Paint, and that although they had had a patent, long since expired, relating to the manufacture of oxide of zinc, they had ceased to confine their mark to paint made with oxide of zinc manufactured under the patent. Rigby, L. J., said that, if necessary, he should have held that the plaintiffs were disentitled to sue (z).

Action not
barred.

Secondly, where the plaintiff's action was not barred: SYKES' PATENT, patent invalid, no plea having reference to the misrepresentation, *Sykes v. Sykes*, 3 B. & C. 541 (a); TAYLOR'S PATENT SOLID-HEADED PINS, expired patent, labels printed from the old blocks in use while the patent existed, *Edelsten v. Vick*, 11 Hare, 78; PATENT THREAD, no patent, evidence that patent was understood in the market to denote the character of the goods, *Marshall v. Ross*, L. R. 8 Eq. 651; CLUB SODA, MANUFACTURED IN IRELAND BY H.M. ROYAL LETTERS PATENT, *Cochrane v. Maenish*, above, p. 403. The case of *Ransome v. Graham*, 51 L. J. Ch. 897, must probably be explained as one of collateral misrepresentation, if it can be supported at all. There the trade-mark consisted of letters and numbers stamped upon the working parts of the plaintiff's ploughs, and "patent" was stamped also, although the only patent which had ever existed related to the plough-shares merely, and had expired in 1817. The plaintiff's advertisements and catalogues stated that the patent had expired, but this could hardly be an answer to the objection, as the notice would not, or might not, reach all the persons who saw the stamp.

"Trade-
mark."

It is a misrepresentation which disentitles a label or other

(z) See also the *Triticumina Case*, *Meaby & Co. v. Triticine*, 15 R. P. C. 1 (1898), where North, J., held that that word was the name of a patented article, and expressed the opinion, without deciding the point, that as

the plaintiffs had represented the article as patented, they would be in no better position if the representation were untrue.

(a) See *Hubbuck v. Brown*, cited above.

trade-mark to protection or to registration, to indorse upon it anything which is calculated to mislead the public as to what is the mark of which the proprietor claims the exclusive use. The matter was first brought forward in *The Apollinaris Case* (b), where some of the labels in question had the word *trade-mark* printed immediately under the red triangle or disc, which was their most prominent feature, although other parts of the labels, and, in particular, the words *Apollinaris* and *Friedrichshall*, were claimed as essential features of the trade-marks. The application before the Court was to remove the marks from the Register on several grounds; and Fry, L. J., who delivered the judgment of the Court of Appeal, dealt with the present objection in the following passage (c):—

The Apollinaris Case.

“One (objection) was, that the mark was calculated to mislead, inasmuch as the whole label is registered as a trade-mark, and yet contains the assertion that the red disc, which is the most conspicuous part of the whole label, is ‘trade-mark’—not saying ‘a trade-mark,’ not saying part of ‘the trade-mark’—but an assertion pointing to the conclusion that it, and it alone, is ‘the trade-mark,’ and therefore that the label, as a whole, is not the trade-mark. Such would have been the impression produced (I am speaking for myself) on my own mind, had I approached the reading of the label unbiassed by what I have learned while sitting in this seat, and such, we think, is the true result of this case. An owner of a registered trade-mark may put it on a registered label, but not so as to mislead a reader of that label, and induce him to believe the only thing registered is the distinctive mark.” It is true, the learned Lord Justice added, that the objection might, apparently, have been taken in *Hudson’s Case*, where the mark there in question was upheld by the Court of Appeal (d), but it was, in fact, neither discussed in argument nor considered by the Court.

This judgment caused a number of applications, under sect. 92, for leave to remove “trade-mark” from registered

(b) (1891) 2 Ch. 186; 8 R. P. C. 137, C. A.

(d) 32 C. D. 311; 3 R. P. C. 155

(c) (1891) 2 Ch. p. 233.

(1886).

marks to be made to the Court. The results of these are stated in Chapter X. (e).

It is to be observed that Fry, L. J., does not say that the use of the words "trade-mark" within a label is necessarily misleading; it may be, but it is a question of fact whether it is or not.

*Hammond v.
Brunker.*

In *Hammond v. Brunker* (f), the registered label of the plaintiffs comprised a number of devices, and among them a small blank shield in the middle of the upper half. In use, the plaintiffs printed within the blank shield a hand and forearm holding a dart, and having the words "trade-mark" beneath it. Chitty, J., in rejecting an objection founded upon this, said (g): "It is a question of fact in every case where a man puts the term 'trade-mark' on his device, or some part of it, whether he does or does not so place the words as to indicate to the public that he is claiming a particular part of the trade-mark only. In *The Apollinaris Case*, the Lord Justice's observations were addressed to a label which had been registered, and had the term *Friedrichshall* above a disc, with a quantity of printed matter; the disc was coloured red, and underneath the disc were the words 'trade-mark.' Without expressing a final opinion on the matter (h), the Lord Justice thought that there were grounds for saying, on that label, that the trade-mark referred to the disc, and if I may say so myself, with great respect, it seems to me that there were grounds. But, as I say, this is a question of fact, and I am satisfied that these words 'trade-mark' in the middle of this label do not indicate to the public that the shield only is the trade-mark. In *The Apollinaris Case* there was no other device except the disc, which was coloured red, in use (i). That being so, I think that these two grounds of objection to the plaintiff's suing, namely, the addition of the arrow and the forearm, and the addition of

(e) Page 25^a

(f) 9 R. P. C. 301 (1892). Chitty, J., came to a similar conclusion of fact in *Benedictus v. Suttivan*, 12 R. P. C. 25 (1891), cited below, where the registered trade-mark was the words "La Flor de Margareta," see at

p. 32.

(g) Page 307.

(h) This is hardly borne out by the report of the judgment of Fry, L. J.

(i) But there were the important words *Apollinaris* and *Friedrichshall*.

the words 'trade-mark,' do not disentitle the plaintiff to ask for an injunction with regard to his trade-mark."

In a later case (*h*), Wright, J., held the objection to be fatal to one of the respondents' marks, a label, and ordered it to be removed from the Register. There the main portion of the label was occupied by a picture of the head of a negro, inclosed by a circular band containing the words *W. D. & H. O. Wills, Bristol*. Underneath this picture was printed in very large letters the word *Star*. At the side of the label, on the right, was a representation of an eight-pointed star; and in immediate proximity to the star the words "trade-mark" occurred.

It is a penal offence to describe a trade-mark as registered when it is not (*l*). Such a misrepresentation is, it seems, sufficient to deprive the proprietor of the mark of his right to protection against infringers, or against persons who pass off their goods as his under cover of the mark (*m*). In *The Melachrino Case* (*n*), however, Chitty, J., held that the use of the word "registered" with a mark in which blanks appearing on the registered form were filled up by coats of arms in use, was not a bar to the plaintiff's case; and it has been held by the Court of Appeal that the use of the words "special registered trade-mark," before registration had been obtained, was not a sufficient objection to prevent the Court granting an interlocutory injunction (*o*). And the Court of Appeal has allowed a mark to be registered which had been used with the words "registered shape." In this case both the mark (a dome-topped cylinder) and the words had been impressed on the blocks of blacklead, which were the goods in question,

False asser-
tion of regis-
tration.

(*h*) *Dexter's Tm. and Wills' Tm.*, (1893) 2 Ch. 262; 10 R. P. C. 269. See also *Day and Riley v. Whittaker*, 17 R. P. C. 817 (1900), Buckley, J., as to the mark No. 70,347.

(*l*) Act of 1883, s. 105, below, p. 639; Merchandise Marks Act, s. 3 (1) (e); see Book II., Chap. I., p. 570.

(*n*) In *Sen Sen Co. v. Britten*, (1899) 1 Ch. 692; 16 R. P. C. 137, Stirling, J., said, "Of course, if the

plaintiffs are brought within the terms of that section they must be denied relief."

(*n*) 4 R. P. C. 215 (1887).

(*o*) *Read v. Richardson*, 45 L. T. 54 (1881), C. A. In *Lewis v. Goodbody*, 67 L. T. 194 (1892), Kekewich, J., refused an interlocutory injunction in a passing off case, because the plaintiffs had represented that their mark was a registered trade-mark. See note (*r*).

although the registration of the shape as a design had expired in 1864; but the case was not argued on behalf of the respondents (*p*).

In *Benedictus v. Sullivan* (*q*) the plaintiff had printed at the bottom of one of the labels used upon his cigar boxes "Regd. by H. B. 6458." The label comprised a number of devices and also the words *La Flor de Margareta*. The words alone had been registered in the trade-mark registry, and they were so registered under Number 6458. It was, however, held upon a consideration of the whole box and its other labels that there was no representation that anything besides the words of the label was registered.

The description of an unregistered trade-mark as a "trade-mark" is no offence within sect. 105, and if the mark is, in fact, as it may be, a trade-mark acquired by user, such description is not by itself a misrepresentation (*r*). But the use of the words "Trade Mark—Registered," or "Registered," is a representation of registration in this country, and, in the absence of words qualifying that meaning, the use of either expression referring to an unregistered mark is an offence under the section (*s*).

It was further suggested, in *The Apollinaris Case*, and the Court of Appeal were inclined to hold, that the indorsement upon one of the labels used for natural mineral waters, and claimed as a trade-mark, "imitations of this water will be prosecuted," meant all imitations, whether fraudulent or not, of the water, and was addressed, therefore, to artificial waters

Other mis-
leading
statements.

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

(*q*) 12 R. P. C. 25 (1895), Chitty, J. The label is printed in the report. The label was, in fact, registered at Stationers' Hall, but not under No. 6458.

(*r*) *S-n Sen Co. v. Britten*, note (*m*). The mark there was registered in the United States. An interlocutory injunction was granted. Stirling, J., held that the use of the words "trade-mark" was not a pretence of registration. Kekewich, J., who

was reported in *Lewis v. Goodbody* (note (*o*)), as having decided the contrary, has adopted this ruling: *Hubbuck v. Brown*, 17 R. P. C. 148; (1899) W. N. 250.

(*s*) *Wright, Crossley & Co. v. Dobbin*, 15 R. P. C. 21 (Q. B. D. Ireland); *MacSymons Stores, Ltd. v. Shuttleworth*, 15 R. P. C. 748 (Day and Channell, J.J.), both 1898. See also *Winer & Co., Ltd. v. Armstrong*, 16 R. P. C. 167, as to use of "registered" after expiration of protection of design.

which might lawfully be made and sold as imitations of the natural water, and that, if it bore this meaning, it was calculated to deceive (*t*).

And by the practice of the registry the words "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To counterfeit this is forgery," will not be registered under the Acts, and accordingly should not appear upon the representations of trade-marks forming part of an application (*u*).

The operation of a deceptive misstatement as to the origin of the goods in destroying the distinctive character of the mark, has been referred to in an earlier chapter (*v*). In *The Eton Cigarette Case* (*x*), it was held that an English tobacconist, who put a Russian name, as that of the maker, upon his goods could not protect the mark which they also bore as his trade-mark against infringements.

(ii) Where the plaintiff uses the trade-mark in aid of a fraudulent trade, the rule which bars his action is so clear that it will be sufficient to summarise the few cases reported on the subject. Fraudulent trade.

A plea that the plaintiff made a practice of selling by short weight failed because it was not supported by the evidence, *The Guinea Coal Case, Lee v. Haley*, L. R. 5 Ch. 155. A Pianoforte Tutor, described as "600th edition, specially revised by Hemy," although the musician referred to had not revised the work for ten years, was held not to be misleading, evidence being given that in the trade an issue of 250 was called an edition, *Metzler v. Wood*, 8 C. D. 606. A trade in German cigars sold in boxes bearing a label with the words LA PUREZA (an old Havana brand), HABANA, RAMON ROMEDO, and additional labels with other words and a sham address in Spanish was held to be fraudulent, the whole get-up being described by Bowen, L. J., as "an elaborate concatenation of pictorial lies" intended to pass off the cigars as Summary of cases.
Havana cigars.

(*t*) (1891) 2 Ch. p. 226.

(*u*) Instructions 29, Appendix, p. 728.

(*v*) Chap. VIII., p. 186.

(*x*) *Wood v. Lambert*, 32 C. D. 27.

247; 3 R. P. C. 81 (1886), C. A.; *Wolff v. Nopitsch*, 17 R. P. C. 321 (1900), Cozens-Hardy, J. (*Spanish Graphite*); on appeal this point was not specially dealt with, 18 R. P. C.

made in Havana, although evidence was given that the name *Havana* in the cigar trade indicates the shape of the cigars only, *Newman v. Pinto*, 4 R. P. C. 508; 57 L. T. 31 (y); but the sale of English cigars under a label bearing the word HABANA, in boxes marked BRITISH MANUFACTURE, was held not to be fraudulent in the absence of evidence that the plaintiffs represented that their cigars were made in Havana, *Hargreaves v. Freeman*, (1891) 3 Ch. 39; 8 R. P. C. 237 (z). The application of the name CALIFORNIAN SYRUP OF FIGS to an aperient drug in which fig syrup was used as a flavouring only was held not to be a misrepresentation: *Californian Fig Syrup Co. v. Taylor's Drug Co.* (a).

Misrepresentation abandoned before, or commencing after action brought.

A misrepresentation which has been corrected and abandoned before the action is no bar (b). The same rule is said to apply to one adopted after the commencement of the action. So Fry, J., stated in *Siegert v. Findlater* (c), for, he said, applying the test laid down by Mellish, L. J., in *Ford v. Foster* (d), its adoption could not, before Sir John Rolt's Act, have warranted the Court of Chancery in restraining the action had it been commenced in a common law Court. The learned Judge held, however, that in the case before him there was in fact no fraudulent misrepresentation which ought, in any case to debar the plaintiffs. It is submitted, with great deference, that on principle it can make no difference, supposing the plaintiff is seeking the aid of the Court for a fraudulent trade, or for a trade conducted by fraudulent means, that the frauds commenced after the action was begun. The objection is not that the plaintiff's case is incomplete, or that the defendant has any answer as of right to oppose to it, but that the plaintiff and his business are,

(y) Cf. *Fuente's Tms.*, (1891) 2 Ch. 166; 8 R. P. C. 214; and *Dexter's Application*, (1893) 2 Ch. 262; 10 R. P. C. 269.

(z) Cf. *Benedictus v. Sullivan*, above, p. 408, where a Spanish look about the box, and the words "Fabrica de Tabaccos de la Vuelta Abago," was held not to be a representation of foreign manufacture in the face of the words "Regalia Britannica,"

"Londini"; and *Robinson and Barnsdale, Id.'s Case*, Times, April 2nd, 1901, cited p. 576.

(a) 14 R. P. C. 341 (1897), *Keke-wich, J.*, reversed on appeal on another point; 14 R. P. C. 564.

(b) *Benedictus v. Sullivan*, note (z). See also the American case, *Siegert v. Abbott* (2) (1891), Cox, p. 486.

(c) 7 C. D. 801 (1878) (*Angostura Bitters*).

(d) L. R. 7 Ch. 611, cited p. 398.

when the Court takes cognizance of the matter, unworthy of its protection or assistance.

It may here be noticed that in a recent firm-name case the defendants set up that the use of the name by the plaintiffs, a limited company, had been in contravention of sect. 41 of the Companies Act, 1862, but Farwell, J., held that this was no defence (*e*). Alleged
illegality of
plaintiffs'
user.

6. The Relief granted.

If the plaintiff succeeds in an action for infringement, he may obtain an order for—(i.) an injunction restraining further infringements of his rights; (ii.) the delivery up for destruction, or for the erasure of the marks, of any goods already marked with the spurious mark and in the possession or under the control of the defendant; (iii.) and damages in respect of the past infringement, or, in lieu of damages, an account of the profits made by the defendant by the sale of the spuriously marked goods, or for some one or more of these.

(i.) Injunction.

This was the characteristic remedy by which the Court of Chancery protected trade-marks, either after the plaintiff had recovered damages for past infringements at law, or where it had been appealed to in the first instance and no action had been brought. It is generally the most beneficial relief for the plaintiff, because it summarily stops the particular infringement which the defendant has practised, and makes it highly dangerous for him to commence any other, and it is operative against impecunious infringers who might care little for repeated judgments for damages against them. The Merchandise Marks Act of 1862 (*f*) empowered a court of law, in any action for fraudulent infringement, to grant an injunction to the successful plaintiff; and, since the

(*e*) *Pearks, Gunston & Tee, Ltd. v. Thompson, Talmev & Co.*, 18 R. P. C. 155 (1901) (*Talmev & Co.*). On appeal the case was settled. Cf. Lord Robertson's judgment in *Royal*

Baking Powder Co. v. Wright, Crossley & Co., 18 R. P. C. at p. 103.

(*f*) 25 & 26 Vict. c. 88, s. 21, now repealed; see Chap. I., p. 17.

Judicature Acts, both divisions of the High Court have the same power as that formerly exercised by the Court of Chancery.

Further infringement must be threatened or be likely to occur.

The grant of an injunction in trade-mark cases is governed by the general rules governing it where other rights are concerned. There must be some threat or probability that the infringement will be commenced, continued, or repeated, or the Court will not interfere (*g*); but if an actual infringement is shown to have occurred that is usually sufficient, and the plaintiff is not bound to wait until it has been frequently repeated, or until warning has been given and been disregarded (*h*), for "the life of a trade-mark depends upon the promptitude with which it is vindicated" (*i*). So an injunction has been granted where the defendant had altered the device and discontinued the use of the labels complained of, and offered to undertake not to use any more of them (*j*), although, in some instances, the undertaking of an innocent infringer has been accepted by the Court (*k*). Nor is it necessary that any actual infringement should have occurred if it is proved that the defendant contemplates committing or has threatened to commit one (*l*), and it is sufficient evidence of this that he is in possession of a considerable quantity of spuriously marked goods (*m*), even though it is only as a forwarding agent (*n*).

Proof of fraud not necessary.

It has already been shown that the fact that the infringement was not fraudulent (*o*), or even that it was made in

(*g*) The Court will presume that a trader will use his mark so as not to be deceptive, if it is capable of being used without the probability of being deceptive, unless some reason to the contrary is shown: *Kutnow's Tm.*, 10 R. P. C. 401 (1893), cited p. 258.

(*h*) See *Upmann v. Forester*, 24 C. D. 231 (1883), Chitty, J., see above, p. 357.

(*i*) *Johnston v. Orr-Ewing*, 7 App. Ca. 219.

(*j*) By Malins, V.-C., in *Guinness v. Heap*, Seb. Dig. p. 377 (1878);

cf. *Tonge v. Ward*, 21 L. T. N.S. 480 (1869), Romilly, M. R.

(*k*) *Rose v. Loftus*, 47 L. J. Ch. 576 (1878), Malins, V.-C.

(*l*) See *The Emperor of Austria v. Day and Kossuth*, 3 De G. F. & J. 217; 30 L. J. Ch. 690 (1861), Campbell, C. and L. JJ.

(*m*) See above, note (*h*).

(*n*) *Upmann v. Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. 130 (1871), Romilly, M. R., and Hatherley, C.

(*o*) *Millington v. Fox*, 3 My. & Cr. 338 (1838), Cottenham, C.

ignorance of the plaintiff's right (*p*), is no defence to the claim for an injunction.

The injunction is sometimes directed generally to restrain the infringement of the plaintiff's trade-marks to which his title is established in the case (*q*), but it is usually expressed with more particularity, to restrain the use by the defendant of such trade-marks, or of marks only colourably differing from them, in connection with goods of the kind for which they are registered, by selling or otherwise disposing of the goods marked with such marks. Sometimes the particular colourable infringement of which the defendant has been proved to have been guilty, is expressly referred to in the order, a general restraint being added. And, in some cases, the form of injunction which seems more appropriate to the unspecialized action for "passing off" is made use of also, the defendants being restrained from "in any other way passing off their goods as those of the plaintiff" (*r*). To avoid a discussion upon a motion to commit for an alleged breach of the injunction, it is obviously advantageous for the plaintiff to combine in the order a particular reference to the form of the infringement which has actually been committed or threatened, with general words, as wide as are obtainable, directed to prevent a colourable evasion of the decree (*s*).

As it is not an infringement to use the plaintiff's mark upon his own goods, that is, goods which possess the attribute connoted by the mark (*t*), the injunction is commonly expressed so as to prevent this being a breach of its terms (*u*).

And in cases where the infringement has been effected by

(*p*) *Moet v. Couston*, 33 Beav. 578 (1864), Romilly, M. R.; *Edelsten v. Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, C.

(*q*) *The Bodega Co., Ltd. v. Riviere*, 6 R. P. C. 243 (1888), Chatterton, V.-C.; *Montgomery v. Thompson*, (1891) A. C. p. 218; 8 R. P. C. 361.

(*r*) *Slazenger and Sons v. Feltham & Co.*, 6 R. P. C. 531 (1889), C. A.

(*s*) See the forms of injunction collected in the Appendix, p. 748, and in Seton, 5th ed., Vol. I., 534.

(*t*) Chap. II., p. 32. And see *Condy v. Taylor*, 56 L. T. 891 (1887), Kekewich, J.

(*u*) Cf. the "passing off" cases; *Siebert v. Findlater*, 7 C. D. 801; and *Braham v. Beacham*, 7 C. D. 818, both (1878), Fry, J.

Form of
injunction (*s*).

the employment of a word, to the exclusive use of which the plaintiff has no title, the injunction should, it seems, be directed to restrain the defendant from using the word without clearly distinguishing his goods from those of the plaintiff, not to forbid his using it altogether (*x*).

Injunction directed to future consignments of goods only.

In a case where the plaintiffs refrained from taking proceedings on learning that the defendants had received a small quantity of the infringing goods, but waited until they had got a larger consignment, Malins, V.-C., ordered the injunction to be directed to stop the sale of future consignments only (*y*). It is submitted, however, with great deference, that the calculated conduct of the plaintiffs was not a sufficient reason for allowing the goods already received to be sold under the deceptive labels, although it might have been an answer to a claim for damages for past infringements. It has certainly been held that acquiescence, not sufficient to bar the plaintiff's right, may, in some classes of actions, cause the Court to refuse relief by injunction, and to grant the plaintiff damages only (*z*), but the case last referred to did not involve any continuing fraud or deception (*a*).

Injunction refused because of acquiescence.

Injunction limited to a particular market.

The injunction may also be limited with reference to the use of the mark in a particular country or market (*b*), for

(*x*) *Seixo v. Provezende*, L. R. 1 Ch. (1865), Wood, V.-C., and Cranworth, L. C.; *Johnston v. Orr-Ewing*, 13 C. D. 434; 7 App. Ca. 219 (1880), Fry, J., C. A. and H. L.; and see *Montgomery v. Thompson*, (1891) App. Ca. 217; 8 R. P. C. 361; and *Reddaway v. Banham*, (1896) A. C. 199; 13 R. P. C. 218; and also the special proviso to the injunction in *Bewlay v. Hughes*, 15 R. P. C. 290 (1898), North, J.

(*y*) *The Anglo-Swiss Condensed Milk Co. v. The Swiss Condens. Milk Co.*, W. N. (1871), 163.

(*z*) *Sayers v. Collyer*, 28 C. D. 103, per Fry, L. J. A restrictive

covenant in regard to buildings case. And below, p. 426.

(*a*) The action for infringement may wholly fail, because the defendant has used the plaintiff's mark so long that there is no longer any deception, as in *The Marquis of Londonderry v. Russel*, 2 Times L. R. 843; 3 Times L. R. 360 (1886), Bacon, V.-C., and C. A. Above, p. 397.

(*b*) *Carver v. Bowker*, Seb. Dig. p. 350 (1877), Little, V.-C.; *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L. J.; see *Société, &c. de l'Étoile's Tm.*, 10 R. P. C. 436; (1894) 1 Ch. 61, Stirling, J., and above, pp. 222 and 366.

instance, if it is calculated to deceive there only (c), or in a particular manner, as by sending goods marked with it to English ports for shipment to the colonies (d).

The plaintiff in an infringement or "passing off" action usually moves, as soon as the action is commenced, for an interim injunction to restrain the defendant, until the hearing of the action or further order, from continuing or committing the infringement or deceptive conduct of which he complains, either getting leave to serve notice of motion with the writ (e), or serving it after the defendant has appeared. In a plain case the motion is, in the first instance, often made *ex parte* for an injunction until the day for which the notice of motion is given; and in a case where the defendant is committing a deliberate fraud, it is important, if possible, to obtain an *ex parte* order before giving him a notice which may lead to the disposal of any spurious goods which he is about to put upon the market.

Interlocutory application for an interim injunction.

Where the plaintiff's title is disputed, or the fact of infringement is doubtful, or misrepresentation amounting to a bar to the action, or some other defence is plausibly alleged upon the interlocutory motion, the Court, in granting or refusing the interim injunction, is guided principally by the balance of convenience, that is, by the relative amounts of damage which seem likely to result if the injunction is granted and the plaintiff ultimately fails, or if it is refused and he ultimately succeeds. Thus, in *Read v. Richardson* (f), on the defendants undertaking to keep an account, Jessel, M. R., refused an interlocutory injunction; but the Court of Appeal granted it because, while the defendants had only recently commenced to use their mark, and their trade was admittedly not dependent on

Balance of convenience.

(c) See *Wilkinson v. Griffith*, 8 R. P. C. 370 (1891), Romer, J., and above, p. 366. Cf. *Cowie v. Herbert*, 14 R. P. C. 436 (1897), Court of Sess.

(d) *Rodgers v. Rottgen*, 5 Times L. R. 678 (1889), Kay, J.

(e) O. 52, r. 9.

(f) 45 L. T. 54 (1881) (*Dog's Head Beer*). In *Evans v. Smith*, 3

Times L. R. 390 (1887), Kay, J., refused an interlocutory injunction because it was a serious question whether the plaintiff's registered trade-mark *Montserrat* was a "special and distinctive word." But *quære* whether sufficient weight was given to sect. 76 in this case; see above, p. 361, note (d).

it, the plaintiffs had a large trade in connection with which they used the label alleged to be infringed, and their rights would have been irremediably and incalculably injured unless the injunction were granted, if their case should be established at the trial. In this action the defendants' mark had been registered as well as the plaintiffs', and the defendants asserted that the plaintiffs' action was barred because the plaintiffs had, before registration, printed the words "specially registered trade-mark" upon their labels (*g*).

As appears by the cases just cited, it is not necessary for the plaintiff, upon the interlocutory application, to give conclusive evidence as to his title to the mark. It is sufficient if he makes it appear probable that he will succeed at the hearing, at least in order to bring the question of balance of convenience before the Court, and where there is reason to doubt the good faith of the defendant, the Court is more easily induced to interfere (*h*).

The interim injunction will not be granted if the plaintiff has delayed interfering until the defendant has built up a large trade in which he has notoriously used the mark (*i*), or if the plaintiff has delayed for a considerable time after he knew of the matters complained of, unless the delay is explained (*k*). But a slight use of the defendant's mark, chiefly upon sales to a few purchasers for their private use, will not prevent the Court from interfering in a case where the plaintiff's trade is considerable (*l*).

(*g*) As to this plea, see above, p. 407. Jessel, M. R., had refused the injunction on the ground of no apparent infringement. See also *Parker and Smith v. Satchwell*, 17 R. P. C. 713 (1900), where the Court of Appeal in a passing off case granted an interlocutory injunction, which had been refused by Cozens-Hardy, J., on the ground of no probability of deception. In *Alaska Packers' Association v. Crooks*, 16 R. P. C. 503, an interlocutory injunction granted on the balance of convenience by Kekewich, J., was discharged on special (arranged)

terms. The plaintiffs failed at the trial, 18 R. P. C. 129 (1901).

(*h*) *Raddle v. Norman*, L. R. 14 Eq. 348 (1872), Wickens, V.-C.

(*i*) Above, pp. 392 and 395.

(*k*) *North British Rubber Co. v. Gormully Co.*, 12 R. P. C. 17, (1894) Chitty, J., a patent case.

(*l*) *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478; 4 T. L. R. 9 (1887), Chitty, J., and C. A. *Apollinaris*, used in Germany from 1876, and in England from 1881. *Derby Photographic Dry Plate Co., Ltd. v. Pollard*, 2 Times L. R. 276 (1886), Bacon, V.-C.;

Interim
injunction
refused on
account of
delay.

If the plaintiff intends to ask for an interim injunction he ought to apply for it as soon as possible after commencing proceedings (*m*).

And if no actual infringement is in progress, and no harm is likely to be done, and the motion is seriously contested, it is usually referred to the trial. Application adjourned to the trial.

The interim injunction being intended only to preserve the plaintiff's rights from serious detriment until the hearing is, at any rate in cases which appear to be doubtful or honestly disputed, limited as closely as possible to what is sufficient to attain that end (*n*). It is only granted upon the plaintiff undertaking to be responsible in damages for the loss (if any) occasioned by it to the defendant, should it turn out at the hearing that it ought not to have been granted (*o*). Interim injunction limited as closely as possible ;
only granted on undertaking as to damages.

A common form of interlocutory injunction is to restrain a wharfinger or consignee from passing into the market goods alleged to bear spurious marks until the trial or further order (*p*).

Since registration is *prima facie* evidence of title, and, in the absence of an application to rectify, conclusive evidence after five years, if the plaintiff's mark is registered, but it is desired to dispute his title to it, the defendant's proper course is to apply to expunge the mark under sect. 90 (*q*). This is the course usually adopted, and a large proportion of the seriously contested trade-mark cases commence with cross motions for an interim injunction, and to expunge or vary the plaintiff's registered mark. Cross motions for injunction and to expunge.

In a case where the defendant claimed a right to the mark

Isaacson v. Thompson, 41 L. J. Ch. 101 (1871), Bacon, V.-C.

(*m*) *Knowles v. Bennett*, 12 R. P. C. 137, (1894) Robinson, V.-C., a designs case.

(*n*) See *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478; 4 T. L. R. 9 (1887), Chitty, J., and C. A.; and *Alaska Packers' Association v. Crooks*, *supra*, note (*g*).

(*o*) As to the calculation of the damages covered by the undertaking, see *Mansell v. The British Linen Co. Bank*, (1892) 3 Ch. 159. Under special circumstances the defendant may be

left to move specially to enforce the undertaking: *J. & J. Cash, Ltd. v. Cash*, 18 R. P. C. 213 (1901), Kekewich, J.

(*p*) *Rivcro v. Norris* (1868), Seb. Dig. p. 178; Seton, 5th ed., p. 536, Giffurd, V.-C.; *Del Valle v. Mayer* (1870), Seb. Dig. p. 195; Seton, *ibid.*, James, V.-C.

(*q*) *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478; 4 T. L. R. 9 (1887), Chitty, J., and C. A.; *Read v. Richardson*, 45 L. T. 54, cited p. 415; and see above, p. 361.

in question, and had applied to register it himself, an interlocutory motion for an injunction by the plaintiff was ordered to stand over pending the result of the application (s).

Undertaking
to keep an
account.

And sometimes, where there is a substantial case to be tried, the application for an interim injunction is ordered to stand over to the hearing upon the defendant undertaking to keep an account of his sales under the mark objected to (t).

Enforcement
of the injunc-
tion.

Breaches of the injunction are contempts of Court, which may be punished by the committal or attachment (u) of the guilty person, or by ordering him to pay a fine or costs. "Committal was the proper remedy for doing a prohibited act, and attachment the proper remedy for neglecting to do some act ordered to be done," but there is now no substantial difference between the two (r). The course usually adopted is to move to commit, the notice of motion being personally served upon the respondent, or if this is impracticable, leave for substituted service being obtained (y).

The order granting the injunction should be forthwith drawn up and served upon the defendant, but no formal service or notice of it is necessary to enable the Court to enforce it. It is sufficient to subject him to the risk of committal if he infringes it that the defendant or other respondent is shown to have been in fact aware of the order for the injunction having been granted or made (z), although, as a general rule, a person intending to ask the Court to enforce an order by committal or attachment should proceed strictly (zz).

Unintentional
breach of the
injunction.

The principal question upon an application to commit for

(s) *Edwards v. Elkan*, 5 R. P. C. 70 (1887), Stirling, J.

(t) *Mitchell v. Henry*, 15 C. D. 181 (1880), C. A.; *Apollinaris Co. v. Snook*, 7 R. P. C. 474 (1890), North, J.

(u) O. 42, r. 7, or in the case of a corporation, by sequestration of its property or attachment of its officers, O. 42, r. 31.

(r) *Callow v. Young*, 56 L. T. 147; *Harvey v. Harvey*, 26 C. D. p. 654; *Evans v. Noton*, (1893) 1 Ch. 252.

The proper remedy for the breach of an *undertaking* is committal: *D. v. A. & Co.*, 1900, W. N. 30.

(y) See the notes to O. 44, r. 1, in the Annual Practice.

(z) *Marcovitch v. Bramble, Wilkins & Co.*, Seb. Dig. p. 363 (1878), Malins, V.-C. Annual Practice note to O. 42, r. 7; and see *United Telephone Co. v. Dal*, 25 C. D. 778.

(zz) *Incandescent Gas Light Co. v. Riemer*, 17 R. P. C. 378 (1900), C. A.

breach of an injunction restraining the infringement of a trade-mark is, generally: Does the new mark of the defendant constitute an infringement or not? And it may be assumed that if the Court is satisfied that the defendant has honestly tried to select a mark which is not objectionable, having regard to its order, it will be unwilling to send him to prison because he has failed in his endeavour. But the Court has jurisdiction to commit for disobedience to an order which is not shown to have been wilful (a). If the defendant is in the wrong, even though by mistake or misfortune, he is usually ordered to pay the costs of the motion (b). A mere servant of the defendant should not be joined as respondent to a motion to commit (b).

It may be safely assumed also that in the case suggested above the Court will be careful not to compel an honest trader to alter his mark more than is necessary to protect the plaintiff's rights. But the following passage from Lord Romilly's judgment, in *Bass v. Dawber* (c), goes, perhaps, too far, for the plaintiff is entitled to have the full extent of his right secured to him, without reference to the loss which it occasions to the defendant. "If a person has *bonâ fide* taken a label or trade-mark which does resemble the label of another person, and this is not done with the intention to deceive, the Court will not require him to change it completely, because the change of a trade-mark is a serious thing. . . . It is like beginning a new firm."

Choice of a new mark by the defendant.

In a case where the plaintiff refused to take any notice of a label which the defendant suggested and proposed to adopt in lieu of the label against the use of which the injunction was granted, Langdale, M. R., himself undertook to determine whether the distinction between the labels was sufficient (d).

If the plaintiff delays taking steps to enforce the injunc-

Delay in application to commit.

(a) *Hewitt v. Mansell*, 29 Sol. J. 66.

(b) *Daniel and Arter v. Whitehouse*, 16 R. P. C. 71 (1899), North, J.

(c) 19 L. T. n.s. 626 (1869), Seb. Dig. p. 186.

(d) *Croft v. Day*, 28 Leg. Obs. 378;

Seb. Dig. p. 39 (1844), on a motion to commit. The French Courts, apparently, will order affirmatively what the defendant is to do: see *Grazier v. Autran*, 13 R. P. C. at p. 10; see also *Rodgers v. Nowill*, note (e).

tion for a considerable time after he knows of the fresh infringement, the delay may cause the Court to refuse to commit; but if the infringement is continuing, it has been said that "there must—in order to deprive the party who has obtained the injunction of the right to move for committal upon the breach of it—be a case made out almost amounting to such a licence to the party enjoined, to do the act enjoined against, as would enable him to maintain a bill against others for doing the act. The party enjoined must, I think, show such acquiescence as would be sufficient to create a new right in him" (e). In the case just quoted, the injunction was granted in 1847, the new infringement began in 1848, and was continued until the motion to commit in 1853. The Lords Justices, however, were not satisfied that the plaintiffs were aware of it. Stuart, V.-C., refused the motion on the ground of the delay, but the Lords Justices directed that the defendant should be committed unless, within a week, he suggested, and undertook to use for the future, a mark which the Court should consider satisfactory, and they ordered that he should pay the costs of the motion.

In *Cartier v. May* (f), where the plaintiff delayed moving for fifteen months after the defendant had commenced a new infringement not expressly covered by the injunction, Wood, V.-C., refused to commit the defendant, but ordered him to pay the costs of the application, and enlarged the injunction so as to make it extend to the new fraud.

(ii.) Delivery up of the marked articles.

The Court not only forbids further infringement by its injunction, but, where the defendant is proved to have spuriously marked articles in his possession or under his control, it also orders the erasure of the marks (g), or the

Erasure of
the spurious
marks.

(e) Per Turner, L. J., in *Rodgers* 139; 30 L. J. Ch. 495 (1861),
v. Nowill, 3 D. G. M. & G. 614; 22 Wood, V.-C.; *Upmann v. Elkan*,
L. J. Ch. 404 (1853). L. R. 12 Eq. 140; 7 Ch. 130,

(f) Seb. Dig. p. 111 (1861). Romilly, M. R., and Hatherley,

(g) *Dent v. Turpin*, 2 J. & H. L. C., note (l) below.

delivery up of the marked articles for that purpose, or, if erasure is impracticable, for destruction (*h*). Thus, in *Slazenger v. Feltham* (*i*), where the word *Demotic*, an infringement of the plaintiffs' mark *Demon*, was stamped upon the defendants' tennis racquets, the order of Kekewich, J., for the destruction of the racquets, was varied by the Court of Appeal, upon it being pointed out that the spurious mark could be planed off; and it was ordered that the defendants should make an affidavit verifying the number of the racquets, and that they should either deliver up the racquets to the plaintiffs, to be destroyed, or satisfactorily erase from them the name *Demotic*, in the presence of the plaintiffs or their agent.

The lien of a wharfinger for his charges in regard to goods deposited with him, including the costs he is put to by being made a defendant in a trade-mark action, is not destroyed if the goods turn out to be spuriously marked (*k*); and although, in some earlier cases (*l*), the plaintiff was adjudged to have a lien upon the goods, subject to that of any wharfinger or mortgagee who had an earlier charge, and who was innocent in regard to the infringement, the Court of Appeal, in the case last cited (*k*), expressed considerable doubt whether such a lien could be supported. Of course, neither the wharfingers nor any other persons interested in the goods would be allowed to sell or dispose of the goods until the spurious marks were removed.

Interests of innocent persons in the marked goods unaffected.
Lien for costs.

(*h*) *Farina v. Silverlock*, 4 K. & J. 650 (1858), Wood, V.-C. The repealed Merchandise Marks Act of 1862, s. 21, empowered the Court to direct any chattel to which any trade-mark had been fraudulently applied, or which had been exposed for sale with a forged or counterfeited trade-mark applied to it, to be destroyed or otherwise disposed of. The Act of 1887 empowers it to forfeit every chattel by means of, or in relation to which, an offence under the Act has been committed, to Her Majesty, and it contains a

power for the Court to order the destruction of the forfeited articles; sect. 2 (3), (4); Book II., Chap. I., pp. 611, 619.

(*i*) 6 R. P. C. 531; 5 T. L. R. 365 (1889), Kekewich, J., and C. A.

(*k*) *Moct v. Pickering*, 6 C. D. 770; 8 C. D. 372 (1877), C. A. reversing Fry, J.

(*l*) *Ponsardin v. Peto*, 33 Beav. 642; 33 L. J. Ch. 371 (1863), Romilly, M. R.; *Upmann v. Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. 130 (1871), Romilly, M. R., and Hatherley, C.

The duty of the bailee of infringing goods.

A wharfinger, transport agent, or other bailee who finds that goods committed to his charge are spuriously marked, therefore, is justified in refusing to deliver them up until the objectionable marks have been erased (*m*). And, further, he is entitled to an indemnity from the bailor against the damages and costs incurred by him by reason of his dealing with the goods at the latter's request (*n*). His proper course, on being informed by the owner of the trade-mark infringed, or his agents, that goods in his possession are spuriously marked, is to give all necessary information to enable them to stop the infringement, to undertake that the goods shall not be removed or dealt with until the spurious marks have been obliterated, and to give the persons injured all requisite facilities for that purpose (*o*). If he takes this course, the costs of any proceedings subsequently taken against him by the plaintiff will be ordered to be paid to him (*p*); but he must pay the costs of proceedings previously taken, even though in an action commenced without notice to him (*q*), unless the value of the infringing goods in his possession is trifling (*r*).

(iii.) Damages or Profits.

Nominal damages.

It was long ago decided at common law, that the mere proof of an infringement entitles the plaintiff to nominal damages (*s*), and that, consequently, no allegation of special

(*m*) *Hunt v. Maniere*, 34 Beav. 157; 34 L. J. Ch. 142 (1864), Romilly, M. R., and L. J. J. Action by indorsee of dock warrants against wharfingers restrained. In *Knowles v. Bennett*, 12 R. P. C. 137 (1894), Robinson, V.-C., shipowners were restrained from parting with the goods except to the plaintiffs.

(*n*) *Dixon v. Faucus*, 3 E. & E. 537; 30 L. J. Q. B. 137 (1861).

(*o*) *Upmann v. Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. 130 (1871), Romilly, M. R., and Hatherley, C.

(*p*) Last case, and *Moet v. Pickering*, 6 C. D. 770; 8 C. D. 372 (1877), Fry, J., and C. A.

(*q*) See last cases, and *Upmann v. Forester*, 24 C. D. 231 (1883), Chitty, J.

(*r*) *American Tobacco Co. v. Guest*, (1892) 1 Ch. 630; 9 R. P. C. 218, Stirling, J.

(*s*) *Blofeld v. Payne*, 4 B. & Ad. 410; 2 L. J. K. B. n.s. 68 (1833). In *Daniel v. Whitehouse*, 15 R. P. C. 134 (1898) Gorell Barnes, J., 40s. damages were given.

damage is a necessary part of his case (*t*). And the natural consequence of an infringement, even though it be made in complete ignorance of the plaintiff's rights, is that the infringer must pay at least nominal damages, and the costs of action, so that, if he acted under the direction of a third person, he may reasonably compound with the proprietor of the trade-mark on these terms, and claim an indemnity from his employer (*u*).

Indemnity to agent or purchaser.

But, if the plaintiff claims substantial damages, the onus of showing what loss he has actually sustained by reason of the defendant's conduct, lies upon him; and it will not be presumed, in the absence of evidence, that the amount of goods sold by the defendant under the infringing trade-mark would, but for the defendant's unlawful use of the plaintiff's mark, have been sold by the plaintiff (*x*). The proper form of an order for an inquiry as to damages occasioned by the infringement of a trade-mark is, therefore, what damage (if any) has the plaintiff sustained (*y*).

Onus of showing substantial damage lies on the plaintiff.

In general, the only injury which is done by an infringe-

(*t*) *Rodgers v. Nowill*, 5 C. B. 109; 17 L. J. C. P. 52 (1847). See also *Reddaway v. Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9 R. P. C. 503.

(*u*) *Dixon v. Faucus*, 3 E. & E. 537; 30 L. J. Q. B. 137 (1861). As to implied warranty by the use of a trade-mark, see below, Chap. XVII., p. 521.

(*x*) *Leather Cloth Co. v. Hirschfield*, L. R. 1 Eq. 299 (1865), Wood, V.-C.; *Magnolia Metal Co. v. Atlas Metal Co.*, 14 R. P. C. 389 (1896), Collins, J., and C. A. (a passing-off case). If there is a demand which remains unsatisfied after the infringing goods have been sold, it may be inferred that genuine goods would have been sold in place of all the latter: *Alexander v. Henry*, 12 R. P. C. 360, (1895) Kekowich, J. In the United States there appears to be a question whether any recognized rule of law exists on the point or not. Mr. Cox

says (p. 198): "There is a conflict between the cases as to the proper measure of damage for the infringement of a trade-mark. It has been held in many instances that the profits of the defendant is the true measure, and in others that it is the profits which would have been realized by the plaintiff had he sold the quantity of goods shown to have been sold by the defendant. Perhaps the most authoritative decision on the subject is *Faber v. Hovey* (Codd. Dig. 79, 249 (1875)), decided by the General Term of the Supreme Court of New York, and affirmed on appeal by a divided Court, in which the latter rule was applied, although the mark involved was of a strictly technical nature." As is stated in the text, the plaintiff in England has usually the option of taking the defendant's profits in lieu of damages.

(*y*) *Davenport v. Rylands*, L. R. 1 Eq. p. 308, per Wood, V.-C.

ment is that the defendant's goods are sold instead of those of the plaintiff, and the sale of the latter is, in some degree, diminished in consequence. But it may, under exceptional circumstances, appear that further damage has been done, for instance, where the spurious goods are so inferior to the genuine as to injure the trade reputation of the plaintiff (z), or where the stress of the competition compels the plaintiff to lower his prices in order to avoid being driven from the market, and the reduction does not, as it may, bring him a sufficient increase of business to make up for the loss of profit on each article sold (a).

The case of *Alexander v. Henry* (a) is an example of such exceptional circumstances as are referred to above. There the plaintiffs had had complete command of the Mexican market for their thread until it was taken from them by the fraudulent imitations of their marks in respect of which the damages were awarded. The result of the imitations was (1) to enable the defendants to make sales which would otherwise have been made by the plaintiffs; (2) to compel the plaintiffs to reduce their prices; and (3) to so injure the plaintiffs' reputation that the defendants were able to sell goods, without disguise (b), in competition with them. The action was not defended, and the assessment of damages was referred to an Official Referee who awarded 772*l.* under head (1), and 2,295*l.* under head (2) against one set of defendants (the Henrys), and a lump sum of 5,000*l.* (apparently) under head (3) against the other set of defendants (the Wallers). On an appeal to Kekewich, J., this award was supported.

If the infringement is a continuing one, the damages ought to be assessed down to the time of the assessment (c).

The plaintiff may, in general, make his choice of either an account and payment to him of the profits which the defen-

Damages or profits.

(z) *Sykes v. Sykes*, 3 B. & Cr. 541; 3 L. J. K. B. o.s. 46 (1824).

(a) See the patent cases: *American Wire Co. v. Thomson*, 44 C. D. 274; 7 R. P. C. 152 (1890), C. A.; and *United Horseshoe Co. v. Stewart*, 13 App. Ca. 101; 5 R. P. C. 260 (1888), both discussed in *Alexander v. Henry*,

12 R. P. C. 360 (1895), Kekewich, J., and *British Motor Syndicate v. Taylor*, 17 R. P. C. 183, 723 (1900).

(b) This appears to be the meaning of paragraph 3 of the referee's report.

(c) O. 36, r. 58.

dant has gained by his wrongful conduct, or an inquiry as to, and payment of, the damages occasioned to the plaintiff by reason of it, that is, unless the case is tried before a jury and damages are assessed by the jury at once, or assessed by the judge sitting alone, acting as a jury. But if the Court is satisfied that the defendant's goods have not, to any substantial extent, been passed off as those of the plaintiff, although infringing or deceptive marks have been used upon them, the plaintiff ought not, it is submitted, to be given any option. To allow him to take the profits made by the defendant's trade in goods which were in fact sold without deception would be unjust (*d*).

The account and inquiry are alternative remedies (*e*), for though in some of the earlier cases they were both allowed, they are now considered to be inconsistent. "If you take an account of profits, you condone the infringement," Lord Westbury said, in a patent case (*f*), and the same rule applies in trade-mark cases also.

Account of profits and damages are alternative.

But neither an account nor an inquiry as to damages will be granted if the evidence of sales under the objectionable mark is not sufficient to make it worth while (*g*), or if it appears that the defendant has only used his mark for a short time (*h*). For instance, no account or damages was allowed or given in a case where the only infringement proved was by the defendant, at the request of a customer, filling with lime-juice of his own make, a bottle embossed with the plaintiff's mark, removing the plaintiff's label, and replacing it by his own (*i*).

Account or inquiry only granted if substantial damage is shown.

Damages can only be recovered, and the profits to be included in the account can only be reckoned, in respect of

They only go back for six years;

(*d*) *Hodgson v. Kynoch*, 15 R. P. C. 465 (1898), Romer, J.; but cf. *Saxlehner v. Apollinaris Co.*, cited below, p. 427.

(*e*) Per Cotton, L. J., in *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887).

(*f*) *Neilson v. Betts*, L. R. 5 H. L. 1 (1871); followed in *De Vitre v. Betts*, L. R. 6 H. L. 319 (1872).

(*g*) *Sanitas Co., Ltd. v. Condy*, 4 R. P. C. 530 (1887), Kekewich, J.; neither was granted in *Magnolia Co. v. Atlas Co.*, 14 R. P. C. 389 (1896), Collins, J., and C. A., although the plaintiffs obtained an injunction.

(*h*) *McAndrew v. Bassett*, 10 Jur. n.s. 495 (1864), Westbury, C.

(*i*) *Rose v. Loftus*, 47 L. J. Ch. 576 (1878), Malins, V.-C.

infringements occurring within six years from the issue of the writ (*k*), subject to the exception in the case of concealed fraud, which is part of the general law.

and, as
against inno-
cent pur-
chasers or
bailees, only
to notice of
infringe-
ment.

It has been shown that it is no answer to the claim for an injunction that the infringement was effected innocently, in ignorance of the existence of trade-mark rights; but damages or an account of profits are only calculated as against an innocent dealer in, or purchaser of, the spuriously marked goods, in respect of sales, dealings, or other infringements, if any, of which he is guilty after becoming aware of the plaintiff's rights (*l*).

The case of a manufacturer who copies a mark he finds on goods which he knows are not his own is different. He may not know whose mark it is, and may possibly be in doubt whether it is a trade-mark or not, but he knows that he has no right to the mark, and the damages or account are therefore calculated as against him from the first infringement, within six years of the writ (*m*).

Refused
because of
delay or ac-
quiescence.

The Court has refused, in some cases, to order an account of profits where the plaintiff has neglected to take proceedings after becoming aware of the infringement (*n*); and it may be assumed that it certainly would not assist the plaintiff to recover profits which he had deliberately allowed the defendant to earn in the expectation of obtaining them from him (*o*). But delay in order to obtain evidence necessary to establish his case would not bar the plaintiff of his ordinary remedy (*p*), nor, it is submitted, would any reasonable delay in the hope of avoiding litigation after a definite warning to the defendant.

(*k*) Per Mellish, L. J., in *Ford v. Foster*, L. R. 7 Ch. p. 633 (1872).

(*l*) *Edelsten v. Edelsten*, 1 Do G. J. & S. 185; 10 L. T. n.s. 780 (1863), Westbury, L. C.; *Moet v. Conston*, 33 Beav. 578; 10 L. T. n.s. 395 (1864), Romilly, M. R.; *Ellen v. Slack*, 24 Sol. J. 290 (1880), Jessel, M. R.

(*m*) *Moet v. Conston*, *supra*; *Cartier v. Carlile*, 31 Beav. 292; 8 Jur. n.s. 183 (1862), Romilly, M. R.

(*n*) *Harrison v. Taylor*, 11 Jur.

n.s. 408; 12 L. T. n.s. 339; *Beard v. Turner*, 13 L. T. n.s. 746, both (1865) Wood, V.-C.

(*o*) Ct. *Anglo-Swiss Condensed Milk Co. v. Swiss Condensed Milk Co.* (1871), W. N. 163, Malins, V.-C., cited above, p. 414; *Beard v. Turner*, *supra*.

(*p*) See *Cave v. Myers* (1868), Seb. Dig. p. 181, Giffard, V.-C.; and *Lee v. Huley*, 21 L. T. n.s. 546; L. R. 5 Ch. 155 (1869), Malins, V.-C., and Giffard, L. J.

In a case where there had been some delay, and some amount of misrepresentation in his business, on the plaintiff's part, and the defendant's proper trade was larger than that of the plaintiff's, the account was limited to profits earned since the commencement of the suit, and Mellish, L. J., said that it was a case where a jury would have given forty shillings damages only (*q*).

Limited because of misrepresentation.

The ordinary form of the order for an account directs an account of the profits made by the defendant in selling or otherwise disposing of the goods bearing the spurious mark or marks to be taken by the master or the official referee, and orders payment of the amount found to be made by the defendant to the plaintiff within a time fixed from the date of the certificate or report (*r*).

Form of order for account.

In the case last cited, it was objected that the account should be limited to sales made to persons who bought the goods as and for the goods of the plaintiff, by reason of the use of the infringing mark upon them. The Court overruled this objection (*s*). They said that the mischief done by the spurious marking of the goods is not merely that it is calculated to deceive immediate purchasers from the infringers, but that it puts "a weapon calculated to be fraudulently used by the middlemen" (*t*) into their hands, by which they may, intentionally or not, deceive the ultimate purchasers. In a subsequent case *Kekewich, J.*, made an order in the same form notwithstanding that he did not believe that there had been a single sale of the defendant's goods as those of the plaintiff, and notwithstanding that the goods had been fairly competing (*u*), but it may be doubted whether in the view which the learned judge took of the facts any account of profits should have been ordered at all (*x*).

The costs of the inquiry as to damages or the account of profits, should generally be reserved until the result of the

Costs of inquiry or account.

(*q*) *Ford v. Foster*, L. R. 7 Ch. 1 De G. J. & S. 185; 10 L. T. N.S. p. 633 (1872), L. J.J. 780 (1863), Westbury, L. C.

(*r*) *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A.; Appendix, p. 752. (*t*) Per Cotton, L. J., in *Lever v. Goodwin*.

(*u*) *Saxlehner v. Apollinaris Co.*, (1897) 1 Ch. 893; 14 R. P. C. 645.

(*s*) See also *Edelsten v. Edelsten*, (*x*) See p. 425, note (*g*).

inquiry or account is known (*y*), at any rate, unless it is clear that it will be of substantial value to the plaintiff; for if no damages or profits are found to have been incurred or made (*z*), or if the proceedings subsequent to the judgment are oppressively conducted by the plaintiff, he ought to pay the costs. But where the defendant had filed a false affidavit greatly understating the number of goods sold, although the account showed that he had made no profit, Chitty, J., said it was a case for investigation, and allowed the plaintiff the costs (*a*).

Account where plaintiff not sole owner.

The plaintiff is entitled to the ordinary inquiry as to damages, or account of profits made by the defendant by the use of the infringing mark, although the plaintiff is not the sole owner of the mark. If he elects to have an account of profits, however, he can only claim payment of such proportionate share of the profits as may be found to be appropriable to his interest in the mark (*b*), and the defendant is, it seems, entitled to have all the co-owners of the mark made parties, before the account is taken, in order that they may be bound by it, and that it may be taken once for all (*c*).

(*y*) Per Fry, J., in *Stark v. Midland Rail. Co.*, 16 C. D. 81 (1880), a case of nuisance.

(*z*) *Tonge v. Ward*, 21 L. T. N.S. 480 (1869), Romilly, M. R.

(*a*) *Dicks v. Jackson*, 31st March, 1884, cited Sebastian, 3rd ed. p. 255, 4th ed. p. 231.

(*b*) In *Dent v. Turpin*, 2 J. & H. 139 (1861), Wood, V.-C., which is substantially the only authority on the matter, both of the two owners of the mark had filed bills asking, in each case, for payment of so much of the profits made by the defendant as the plaintiff was entitled to. The Vice-Chancellor said the fact that both owners were suing avoided the difficulty in regard to the account. In *Southorn v. Reynolds*, 12 L. T. N.S. 75 (1865), the same Vice-Chancellor

followed his previous decision, but the order as to payment (if any) is not reported. In the latter case, contrary to the modern rule, the inquiry and the account were both ordered.

(*c*) See the patent cases, *Bergmann v. Macmillan*, 17 C. D. 423 (1881), Fry, J.; and *Van Gelder v. Sowerby Society*, 44 C. D. 374; 7 R. P. C. 208 (1890), C. A., see per Cotton, L. J., 44 C. D. p. 392. The defendant cannot, as appears from the last case, object to judgment on the ground of want of parties, but can apply to have the owners who are not plaintiffs added (as plaintiffs or defendants) for the purposes of the account after judgment. See O. 16, r. 11, in the Annual Practice.

7. Costs.

Subject to sect. 77a of the Act, which is referred to below, the costs of and incident to an action for the infringement of a trade-mark, as the costs in any other action, are in the discretion of the Court or judge, and the Court or judge has full power to determine by whom and to what extent such costs shall be paid (*d*). Provided that where the action is tried with a jury, the costs follow the event, unless the judge by whom it is tried, or the Court, for good cause, otherwise orders (*e*).

Costs in the discretion of the judge.

The Court or judge in general follows the ordinary rule that the unsuccessful party shall pay the costs of the litigation, such costs being taxed upon the usual scale between party and party; but the discretion conferred by the Act and Rule just cited is constantly exercised in trade-mark cases, where the nature of the case, or the conduct of the parties, or of one of them, makes it just that the ordinary practice should be departed from.

Unsuccessful party usually ordered to pay costs.

An unsuccessful defendant must usually pay costs, although he has only defended a mark which he honestly adopted without being aware of its too great resemblance to the plaintiff's mark (*f*), and though he has acted without fraud and in ignorance of the plaintiff's rights (*g*), and the action has been commenced against him without notice (*h*). But by offering the plaintiff all that he is entitled to,—that is, in the case of the innocent holder of spuriously marked goods, an undertaking (*i*) not to part with them until the

Infringer must offer complete redress before action,

(*d*) Supreme Court of Judicature Act, 1890, s. (5).

(*e*) O. 65, r. 1.

(*f*) *Blair v. Stock*, 52 L. T. 123 (1884), Kay, J.; cf. the registration cases, *Hyde & Co.'s Tm.*, 7 C. D. 724; *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238 n., both (1878) Jessel, M. R.

(*g*) *Edelsten v. Edelsten*, 1 De G. J. & S. 185; 10 L. T. n.s. 780 (1863), Westbury, L. C.; *Tonge v. Ward*, 21 L. T. n.s. 480 (1869), Romilly, M. R.

(*h*) *Field v. Lewis*, Seb. Dig. p. 167 (1867), Wood, V.-C.; *Upmann v. Forester*, 24 C. D. 231, (1883), Chitty, J.

(*i*) The plaintiff is not bound to accept an undertaking in the case of an infringer with notice, or where there is reasonable risk that it will be necessary to take steps to enforce it. In such a case the defendant must pay the costs of the plaintiff obtaining an injunction by consent

and will then
get subse-
quent costs.

spurious marks have been removed (*h*), and all requisite information to enable the plaintiff to stop the infringement (*l*) and the payment of the taxed costs (*m*) (if any) already incurred by him in the action, if an action has been commenced,—the defendant may escape liability for subsequent costs (*mm*). If the plaintiff, after such an offer has been made, commences or continues proceedings against the defendant making it, he will be ordered to pay him his costs subsequently incurred (*n*). In a case where, as it turned out, the plaintiff was entitled to an injunction only, and his right to this was admitted on the second day of the trial, he was given costs up to that time, and was ordered to pay the subsequent costs (*o*).

If the plaintiff moves for an interlocutory injunction after being offered all that he can obtain on such a motion, unless there is ground to believe that the offer will not be carried out, the motion should be refused with costs (*p*).

in chambers: *Slazenger v. Pigott*, 12 R. P. C. 439 (1895), North, J. Cf. the patent case, *Jenkins v. Hope*, (1896) 1 Ch. 278; 13 R. P. C. 57, North, J.

(*h*) An innocent consignee or bailee may become liable for damages if he sends the spurious goods out of the country, or otherwise puts them beyond the control of the Court. *Upmann v. Elkan*, *infra*; and cf. the patent case *British Motor Syndicate, Ltd. v. Taylor*, (1901) 1 Ch. 122; 17 R. P. C. 723, C. A.

(*l*) Above, p. 422. The plaintiff is not entitled to the publication of an apology: *Hudson v. Bennett*, 14 L. T. n.s. 698 (1866), Stuart, V.-C.; *Hudson v. Chatteris Co.*, *infra*; or to receive a list of the defendant's customers, if not entitled to an enquiry or account: *Hipkins v. Plant*, p. 433, below, note (*h*).

(*m*) *Burgess v. Hills*, 26 Beav. 244; 28 L. J. Ch. 356 (1868), Romilly, M. R.; *McAndrew v. Bassett*, 33 L. J. Ch. 561; 4 De G.

J. & S. 380 (1864), Wood, V.-C., and Westbury, C.; *Fennessy v. Day and Martin*, 55 L. T. 161 (1886), Bacon, V.-C.

(*mm*) But the defendant must not ask for a term which he is not legally entitled to, as, for instance, that the plaintiff should not advertise the undertaking, *Hipkins v. Plant*, below, note (*b*).

(*n*) *Millington v. Fox*, 3 My. & Cr. 338 (1838), Cottenham, C.; *Moet v. Couston*, 33 Beav. 578 (1864), Romilly, M. R.; *Upmann v. Elkan*, L. R. 12 Eq. 140; 7 Ch. 130 (1871), Romilly, M. R., and Hatherley, C.; *Moet v. Pickering*, 6 C. D. 770; 8 C. D. 372 (1877), Fry, J., and C. A.

(*o*) *Magnolia Metal Co. v. Atlas Metal Co.*, 14 R. P. C. 389, at p. 400 (1896), Collins, J. A passing-off case.

(*p*) *Snuggs v. Seyd & Kelly's Credit Index Co.*, (1894) W. N. 95, Chitty, J. In *Hudson v. Chatteris Co.*, 15 R. P. C. 438 (1898), Stirling, J., a patent case, where the defendant had paid sufficient money into Court to cover

In *Moet v. Pickering* (q), where wharfingers with whom the spuriously marked goods had been warehoused in the ordinary course of trade, and who were entitled to a lien for their charges, were added as defendants, and the plaintiffs proceeded to trial against them, the Court of Appeal, reversing Fry, J., ordered that their costs of action should be paid by the plaintiffs. The wharfingers had pleaded that they had no knowledge of the infringement, and that they submitted to act as the Court should direct, upon payment of their charges and costs; but the Court of Appeal regarded this as meaning only that they claimed nothing adversely to the plaintiffs or the infringer. The case does not conflict with the rules stated above, for the plaintiffs had claimed to override the wharfinger's lien by a lien of their own for costs, and this was held to be wrong; and besides, it was clearly unnecessary to have added the wharfingers as defendants or to have proceeded to trial against them, since not only had they made no threat to part with the goods, but after notice of the injunction obtained against the infringer it would have been a contempt of Court for them to do so.

Where the plaintiff has obtained, or is offered, all that he is entitled to, the Court will stay further proceedings in the action, at the defendant's instance (r). Stay of proceedings.

And in a trivial case, where an action had been commenced without notice against the innocent purchaser of an inconsiderable quantity of spuriously marked goods, and he at once submitted to do as the Court directed, Stirling, J., refused to give any costs (s). Trivial cases.

damages and an injunction was refused at the trial, costs subsequent to the acceptance of the money were given to the plaintiff. See also note (i), above.

(q) A similar order was made in *Upmann v. Elkan*, note (n).

(r) *Rudd v. Rowe*, L. R. 10 Eq. 610 (1870), James, V.-C.; *Curtis and Harvey v. Pope*, 5 R. P. C. 146 (1888), North, J. (*Diamond Gunpowder*).

(s) *American Tobacco Co. v. Guest*, (1892) 1 Ch. 630; 9 R. P. C. 218; cf. *Rose v. Loftus*, 47 L. J. Ch. 576 (1878), Malins, V.-C. Cf. *Leahy v. Glover*, 10 R. P. C. 141 (1893), H. of L., and *Rutter v. Smith*, 18 R. P. C. 49 (1901), Kekewich, J., where only a single act of passing off by a servant, since discharged, was proved, and costs were given against the plaintiffs.

It is no reason for not giving costs that the defendant is an infant (*t*).

Costs refused because plaintiff claimed too much.

Costs have been refused to a successful plaintiff because he claimed, besides the injunction to which he was entitled, an account to which he was not, against an innocent purchaser of the spuriously marked goods (*u*); and in a similar case, where the plaintiffs set up claims to a copyright in a music tutor, as well as an exclusive right to its title, and failed as to the copyright, they were allowed only half their taxed costs of action (*x*). On similar grounds, plaintiffs have been ordered to pay (*y*), or have been deprived of (*z*), the costs occasioned by allegations which they have failed to prove, although they have succeeded and obtained the general costs of their actions. But where the plaintiff, in an action for infringing his trade-mark and also for "passing off," failed as regards the infringement in respect of some of the goods for which he used, but had not registered, the trade-mark, and succeeded as to the rest of the action, and the defendant was held to have been guilty of deliberate infringement in breach of an undertaking previously given by him, Kekewich, J., refused to deprive the plaintiff of any part of his costs (*u*).

The usual rule is to apportion the costs, each party getting costs of the substantial issues upon which he has succeeded, the plaintiff getting the costs of the action except so far as these are increased by the issues upon which costs are given

(*t*) *Chubb v. Griffiths*, 35 Beav. 127 (1865), Romilly, M. R.

(*u*) *Mott v. Couston*, 33 Beav. 578; 10 L. T. n.s. 395 (1864), Romilly, M. R. In *Hipkins v. Plant*, note (*b*), the defendants were given the costs of the action so far as it asked for damages or an account.

(*x*) *Metzler v. Wood*, 8 C. D. 606 (1877), Malins, V.-C., and C. A.

(*y*) *Pierce v. Franks*, 15 L. J. Ch. 122 (1846), Knight-Bruce, V.-C.

(*z*) *Standish v. Whitwell*, 14 W. R.

512 (1866), Wood, V.-C., an affidavit charging fraud. So *Saxlehner v. Apollinaris Co.*, below, note (*b*), Kekewich, J., where a charge of fraud failed in part.

(*a*) *Jay v. Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888). So *Rowland v. Mitchell*, 13 R. P. C. 457 (1896), Romer, J. In *Hodgson v. Kynoch*, 15 R. P. C. 465 (1898), Romer, J., there was no fraud, and the claim as to infringement had not substantially increased the costs, consequently no order as to them was made.

against him (*b*), unless there is one main issue upon which he has failed (*c*).

In a recent case, where an action for infringement and two motions by the defendants, one to expunge the plaintiff's registration, and the other for an order to the Comptroller to register a mark propounded by the defendants, were tried together, and the action and the second motion failed, but the first motion succeeded, and both parties made unfounded allegations of fraud, North, J., refused to give any costs to either, principally on the ground that it was absolutely impossible for any taxing master to do justice between the parties by distinguishing the costs of one part of the case from another (*d*).

A successful defendant is much more often deprived of his costs than a successful plaintiff, for the plaintiff may fail in his action notwithstanding that the evidence makes it clear that the defendant has acted, or intended to act, dishonestly, and in such a case, although the Court decline to assist the plaintiff, it generally refuses to give costs to the defendant. Successful defendant deprived of costs.

Where, for example, the plaintiff failed because of misrepresentations contained in his trade-mark (*e*), but the defendant had closely imitated the mark, the action was dismissed without costs; and the same course was followed where there was no sufficient proof that the defendant's mark was calculated to deceive, having regard to the long delay of the plaintiff to take proceedings, and the absence of evidence of actual deception (*f*); and in cases where the action was dismissed, but the Court thought that the defendant's conduct had been uncandid and unfair (*g*); and North, J., dismissed

(*b*) *Saxlehner v. Apollinaris Co.*, (1897) 1 Ch. 893; 14 R. P. C. 645; *Lever v. Bedingfield*, 15 R. P. C. 453 (1898), both Kekewich, J.; *Hipkins v. Plant*, 15 R. P. C. 294 (1898), Byrne, J.

(*c*) *Pneumatic Stamp Co. v. Lindner*, 15 R. P. C. 525 (1898), Byrne, J.

(*d*) *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1890); *Jackson v. Napper*, 35 C. D. 162; 4 R. P. C. 45 (1886), Stirling, J.

(*e*) *The Leather Cloth Co., Ltd. v. The American Leather Cloth Co., Ltd.*, 4 De G. J. & S. 137; 33 L. J. Ch. 199; 11 H. L. C. 523; 35 L. J. Ch. 53 (1863), Westbury, L. C., and H. L. The House of Lords held that there was no infringement.

(*f*) *Rodgers v. Rodgers*, 31 L. T. n.s. 285 (1874), L. JJ.

(*g*) *Estcourt v. The Estcourt Hop Essence Co.*, 31 L. T. n.s. 567; L. R. 10 Ch. 276 (1874), Malins, V.-C.,

an action without costs because he thought that the defendants had kept back information (*h*).

So, too, no costs were given where it was proved that the defendant had represented the goods he sold as being those of the plaintiff, although the proof of the plaintiff's title failed (*i*).

In *The Patent Plumbago Case* (*j*), however, where the plaintiffs failed on the ground of misrepresentation, but the imitation of their trade-name was clearly made out, the action was dismissed with costs, the plaintiffs having continued to misdescribe their goods as "patent" after a summons taken out at their instance had been dismissed by the magistrate because of such misdescription.

Defendant *in pari delicto*.

So, in cases in which the plaintiff fails because he is carrying on a fraudulent trade, and the defendant stands *in pari delicto*, the practice is to dismiss the action without costs (*k*).

Unfounded charges of fraud.

And a successful defendant has also been deprived of costs because he has made an unfounded charge of fraud (*l*).

Costs of appeal.

In a trade-name case, where the plaintiffs' action was dismissed by the Court of Appeal on the ground that they were not satisfied that the name adopted by the defendants would cause any deception likely to occasion damage to the plaintiffs, costs, both of the appeal and in the Court below, were refused because the Lords Justices believed that the defendants had chosen the name in dispute with

Cairns, C., and L. JJ.; *Maxwell v. Hogg*, 15 L. T. N.S. 204; L. R. 2 Ch. 310 (1866), Stuart, V.-O., and L. JJ.

(*h*) *Mcaby & Co., Ltd. v. Triticine, Ltd.*, 15 R. P. C. 1 (1898).

(*i*) *Ainsworth v. Walmsley*, L. R. 1 Eq. 518 (1866), Wood, V.-C.; and see *Browne v. Freeman* (1), 12 W. R. 305 (1864), Wood, V.-C., where the defendant misdescribed his goods as *The Original Chlorodyne*.

(*j*) *Morgan v. McAdam*, 36 L. J.

Ch. 228 (1866), Wood, V.-C.

(*k*) *Newman v. Pinto*, 4 R. P. C. 504; 59 L. T. 31 (1887), C. A.; *Thorneloe v. Hill*, 11 R. P. C. 61 (1894), Romer, J.; cf. *Baschet v. London Standard Co.*, (1900) 1 Ch. 73, Kekewich, J., a copyright case.

(*l*) *Humphries v. The Taylor Drug Co.*, 59 L. T. 820 (1888), Kekewich, J.; *Hargreaves v. Freeman*, (1891) 3 Ch. 39; 8 R. P. C. 237, Chitty, J. As to unfounded charges of fraud by the plaintiff, see p. 432, note (*z*).

the hope of obtaining some illicit advantage from the plaintiff's reputation (*m*).

But, in general, the reasons for depriving the defendant of costs do not apply to the costs of an unsuccessful appeal brought by the plaintiff against the dismissal of his action. Thus, the appeal to the House of Lords in *The Leather Cloth Case* (*n*), and the appeal to the Court of Appeal in *Newman v. Pinto* (*o*), were both dismissed with costs. In the former case the plaintiff obtained judgment in the first instance, and when this was reversed on appeal by Lord Westbury no costs were given (*p*).

A party who succeeds on appeal and recovers the costs paid under the judgment below is not entitled to interest (*q*). Interest on costs repaid.

The Court or judge may order the costs adjudged to be paid to be taxed upon the higher scale, if special grounds arising out of the nature and importance, or the difficulty or urgency, of the case, appear to exist (*r*). Such an order was made by North, J., in *The Great Tower Street Tea Co. v. Smith* (*s*), where the hearing occupied a long time, and the facts were complicated, and a great number of witnesses were called. But some special reason for the order must be shown, for, although the application is almost always made in heavy trade-mark or patent actions, it is not granted as of course (*t*); and it is not granted as a punishment (*u*), or merely because a case of gross fraud is made out (*t*). The order ought only to be made in cases of very unusual difficulty requiring skill, Higher scale.

(*m*) *Borthwick v. The Evening Post*, 37 C. D. 449 (1888), C. A.

(*n*) 11 H. L. C. 523; 35 L. J. Ch. 53.

(*o*) See note (*h*), *ante*, p. 434.

(*p*) 4 De G. J. & S. 137; 33 L. J. Ch. 199. This course was taken also in *Borthwick v. The Evening Post*, *supra*.

(*q*) *Edge v. Gallon*, 16 R. P. C. 509, at p. 520, (1899) C. A.

(*r*) O. 65, r. 9. See the note in the Annual Practice.

(*s*) 6 R. P. C. 165 (1889).

(*t*) *Sanitas Co., Ltd. v. Condy*, 4 R. P. C. 530 (1887), Kekewich, J.

In *Rodgers v. Rottgen*, 5 Times L. R. 678 (1889), Kay, J., said he gave costs on the higher scale very charily. In *Leonhardt v. Kallé*, 12 R. P. C. 103, at p. 120 (1895), Romer, J., said he had never done it except by consent. Collins, J., gave such costs in *Reddaway v. Banham*, 12 R. P. C. 86, and his judgment was restored by the H. of L., (1896) A. C. at p. 222.

(*u*) *Hudson v. Osgerby*, 32 W. R. 566; 50 L. T. 323 (1884), Pearson, J.; and see *Pooley's Trustee v. Whet- ham*, 33 C. D. p. 120; and *Paine v. Chisholm*, (1891) 1 Q. B. 531, and the cases there cited.

antiquarian research and things of that kind (*u*). That scientific witnesses are necessarily called has been held to be a special reason (*x*). An appeal lies on the question whether there are "special grounds" or not (*y*).

Costs as between solicitor and client.

It is provided by sect. 77 (a) (*z*) that—

"In an action for the infringement of a registered trade-mark the Court or a judge may certify that the right to the exclusive use of the trade-mark came in question, and if the Court or a judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses, as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same."

This section corresponds to the provision of sect. 31 of the Act with regard to actions for the infringement of a patent (*a*).

Certificate that title to trade-mark came in question.

A certificate cannot be granted unless the right to the exclusive use of the trade-mark has, in fact, come in question, and, therefore, it was refused in a case where the defendant's counsel admitted that, upon the failure of the defendant's application to remove the plaintiff's mark from the Register, he had no defence to the action (*b*). But notwithstanding that the section says "in an action," it can under some circumstances be granted upon a motion for rectification where the mark has been registered for five years, since the mark can then only be attacked by proceedings under sect. 90. Thus where, under an order of the Court, a motion for recti-

(*u*) *Gadd v. Mayor of Manchester*, 9 R. P. C. 516, at p. 535, Lindley, L. J. See also *Dunlop Co. v. Wapshare Co.*, 17 R. P. C. 433 (1900), Buckley, J., and *Chamberlain and Hookham v. Mayor of Bradford*, 17 R. P. C. 493 (1900), Farwell, J., where the order was made.

(*x*) *Ellington v. Clark*, 5 R. P. C. 328; 58 L. T. 818 (1888), C. A.; *The Robin*, (1892) P. 95, Joine, J.;

Dunlop Co. v. Wapshare Co., *supra*.

(*y*) *Paine v. Chisholm*, (1891) 1 Q. B. 531, C. A.

(*z*) Act of 1888, sect. 18.

(*a*) See Edmunds on Patents, pp. 329 *et seq.* and 487, 2nd ed. p. 620.

(*b*) *Benjamin Edgington, Ltd. v. John Edgington & Co.*, 6 R. P. C. 513; 61 L. T. 323 (1889), Kay, J.

fication and an action for infringement were heard together and on the same evidence, it was held that there was jurisdiction to grant a certificate, and the grant was made (*c*).

In a case where the Court of Appeal refused an application by the defendant to expunge the plaintiffs' marks, partly on the ground that the defendant was a deliberate infringer, they declined to give the plaintiffs a certificate under the section (*d*).

The order granting a certificate is not appealable (*e*).

Similar considerations govern the grant or refusal of costs in respect of the application to rectify the Register by expunging or varying the registration of the plaintiff's mark, which is an ordinary incident of the defence in an action for infringement. The usual practice is to give the applicant costs, if he succeeds (*f*); but if the application is made by the defendant for the purposes of the action, and it is doubtful whether he is not acting fraudulently, the costs may be reserved till the trial (*g*), or may be refused (*h*).

Costs of motion to rectify in aid of defence.

8. Appeal.

In a case where the defendant desired to appeal against an interim injunction which the plaintiff had obtained, the Court, on his application, and on the ground that the continuance of the injunction would do irreparable damage to his business, advanced the case to the head of the list (*i*).

Appeal advanced.

An application to stay a new trial ordered to take place by the Court of Appeal, pending an appeal against the order to the House of Lords, was refused in *Edge v. Johnson* (*k*).

Stay of order.

(*c*) *Field & Co. v. Wagel Syndicate*, (1900) 1 Ch. 651; 17 R. P. C. 266, Buckley, J.

(*d*) *Paine & Co. v. Daniells and Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 217, cited p. 371.

(*e*) *Haslam & Co. v. Hall*, 5 R. P. C. 144 (1888), C. A.

(*f*) *Richards v. Butcher*, (1891) 2 Ch. 522; 8 R. P. C. 37, Kay, J.

(*g*) *Gionaclis' Tm.*, 6 R. P. C. 167; 58 L. J. Ch. 782 (1889), North, J.

(*h*) *Perry-Davis' Tm.*, 5 R. P. C. 333; 58 L. T. 695 (1888), Kay, J.; *Bradley's Tm.*, 9 R. P. C. 205 (1892), Chitty, J. See further Chap. XI., p. 293.

(*i*) *Lazenby v. White*, L. R. 6 Ch. 89 (1870), James, L. J.

(*k*) 9 R. P. C. 134 (1892).

Barred by
delay.

In *Burgess v. Burgess* (l), delay for five months in appealing against an order for an interim injunction, where the plaintiff was appellant, seeking to have the scope of the order enlarged, was held to be a bar to the appeal.

Appeal in
case of fraud.

Where the judge of first instance has found, or has refused to find fraud, it is difficult, and usually impossible, for the Court of Appeal to reverse his finding. In a recent case, however, a finding of fraud was reversed, the Court being able to act without relying on the evidence of the defendant, which the judge below had not believed (m).

Non-suit.

If an appeal is brought, and the defendant succeeds, judgment is entered in his favour, not a non-suit (n); but the Court of Appeal, in dismissing the plaintiff's action, may reserve to him liberty to sue again in respect of any part of his claim. This course was adopted in an action where the plaintiff sought to raise a new case of "passing off," not set up by the pleadings, at the trial, and was not allowed to proceed with it (o).

9. Practice.

Pleadings.

There are no rules as to pleadings which are peculiar to actions for the infringement of trade-marks (p); all that is necessary, therefore, is that the statement of claim, defence,

(l) 3 De G. M. & G. 896; 22 L. J. Ch. 675 (1853), L. JJ. So also in *Re Palmer's Application*, 22 C. D. 88 (1882), C. A., where the Court had decided against a preliminary objection. The time for appealing against an interlocutory order is now fourteen days. R. S. C., O. 58, r. 15.

(m) *Jamieson & Co. v. Jamieson*, 15 R. P. C. 169 (1897). In *Valentine Meat Juice Co. v. Valentine Extract Co., Ltd.*, the Court of Appeal found fraud, where Stirling, J., had failed to do so, 17 R. P. C. 1 and 673; 83 L. T. 259 (1900).

(n) *Pinto v. Badman*, 8 R. P. C. 181 (1891), C. A. No plaintiff can,

under the modern practice, claim to be non-suited: *Fox v. Star Newspaper Co.*, (1900) A. C. 19.

(o) *Native Guano Co. v. Sewage Manure Co.*, 8 R. P. C. 125 (1888), C. A. and H. L.

(p) Sect. 9 of the Merchandise Marks Act, 1887, provides that in any pleading, proceeding, or document in which any trade-mark or forged trade-mark is intended to be mentioned, it shall be sufficient, without further description and without any copy or facsimile, to state that trade-mark or forged trade-mark to be a trade-mark or forged trade-mark. Appendix, p. 810.

and reply, if any, in any such action, shall respectively contain statements, in a summary form, of the material facts upon which the party pleading relies for his claim or defence (*q*), giving particulars of the frauds, if fraud is alleged (*r*). What are material facts, having regard to the circumstances of the case, may be gathered from the statement of substantive law, given in the earlier part of the present chapter.

The forms provided by the appendices to the Supreme Court Rules are set out below. They, when applicable, and when they are not applicable forms of a like character, and as near as may be to them, are to be used for all pleadings; and, where they are applicable and sufficient, any longer forms are to be deemed prolix, and the costs occasioned by such prolixity are to be disallowed, or to be borne by the party so using the same, as the case may be (*s*).

Forms in the
Rules of the
Supreme
Court.

INDORSEMENT ON THE WRIT.

The plaintiff's claim is for damages for wrongfully using (or imitating) the plaintiff's trade-mark.

STATEMENT OF CLAIM.

(1.) The defendant has infringed the plaintiff's trade-mark.

(2.) The trade-mark is (*describe it*). (*If the plaintiff is not the original proprietor of the trade-mark, show shortly how his title is derived.*)

(3.) The following acts are complained of, viz. :—
(*Set them out.*)

The plaintiff claims an injunction to restrain the defendant, his servants and agents, from infringing the plaintiff's said trade-mark, and in particular from (*stating any particular injunction sought*).

The plaintiff also claims an account or damages (*t*).

(*q*) O. 19, r. 4.

(*r*) O. 19, r. 6.

(*s*) O. 19, r. 5.

(*t*) Rules of the Supreme Court, Appendix C., sect. 6, Form 8.

DEFENCE.

- (1.) The trade-mark is not the plaintiff's.
- (2.) The alleged trade-mark is not a trade-mark.
- (3.) The defendant did not infringe.

It will be observed that the form of statement of claim here given does not comprise an allegation that the plaintiff's trade-mark has been registered, or that sect. 77 of the Act has been otherwise complied with; but such an allegation is certainly proper, and, it is submitted, necessary.

Some more elaborate and detailed forms are given in the Appendix (u).

Particulars.

The ordinary rule (x) that the parties must state the facts upon which they rely and which they plead in their pleadings, or in particulars separately delivered, with sufficient particularity to prevent their opponents being taken by surprise at the trial, applies to trade-mark cases.

So if the plaintiff alleges that actual deception has occurred, he will be ordered to give particulars of the persons deceived (y). And if the defendant pleads that the plaintiff's trade-mark is invalid, he must give particulars of the invalidity alleged (z).

If a motion to expunge the plaintiff's mark is made by way of reply to the usual interlocutory application on behalf of the plaintiff for an interim injunction, and both the motion and application stand over to the trial, unless there are affidavits sufficiently showing what the defendant's case is upon his motion to expunge, he is frequently directed to deliver particulars of it.

Discovery.

The ordinary rules (a) governing discovery also apply to trade-mark actions (b).

(u) Pages 743 *et seq.*

(x) See the notes to O. 19, rr. 6 and 7 in the Annual Practice.

(y) *Humphries v. Taylor Drug Co.*, 39 C. D. 693; 5 R. P. C. 687 (1888), Kekewich, J.; *Whitstable Oyster Fishery Co. v. Hayling Fisheries, Ltd.*, 17 R. P. C. 461 (1900).

(z) *Rowland v. Mitchell*, 13 R. P. C. 457 (1896), Romer, J.

(a) O. 31. The Merchandise Marks Act, 1887, provides that nothing in that Act shall entitle any person to refuse to make a complete discovery, or to answer any question or interrogatory in any action: sect. 19. Appendix, p. 814.

(b) *Orr v. Diaper*, 4 C. D. 92 (1876), Hall, V.-C., demurrer to an action for discovery against

But a process which enables a rival trader to extract from his opponent information concerning his customers, his trade, and his mode of doing business, is extremely likely to be abused, and in cases where a large trade-mark business is affected, even the ordinary order for discovery of documents upon oath may be very oppressive (c). The Court, therefore, will, upon a proper case being shown, modify the common orders so that they shall occasion no more inconvenience to the party to whom they are directed than is necessary to ascertain the rights of his opponent.

Orders for discovery in trade-mark cases modified to prevent abuse.

Thus, in *Carver v. Pinto Leite* (d), it was held that the defendants, in a suit for infringement, who had been ordered to file an affidavit of documents and to produce the documents in the ordinary way, ought not to be ordered to disclose the names of customers, or of persons to or from whom letters referring to the matters in issue were sent or received, inasmuch as such discovery might be used in a manner prejudicial to the defendants in their trade, and was not likely to assist the plaintiffs in making out their case at the hearing.

And in a later case, where the defence was that the plaintiff was carrying on a fraudulent trade by selling as foreign cigars goods made in England, the plaintiff, who admitted the fact that his goods were in fact made in England, was allowed to refuse to say who was the manufacturer because, under the circumstances, the question was irrelevant (e).

Discovery in regard to the sales effected by the defendant under the disputed mark is not, in general, where the infringement is denied, material, until the fact that the mark is an infringement of the plaintiff's rights has been

Disclosure of sales.

shippers, brought in aid of an intended action against the consignors, dismissed.

(c) *Wills' Tms.*, (1892) 3 Ch. 201; 10 R. P. C. 269, C. A.

(d) L. R. 7 Ch. 90 (1871), C. A. See also *Benbow v. Low*, 16 C. D. 93 (1880), C. A.; and *The Attorney-General v. The North Metropolitan Tramways Co.*, (1892) 3 Ch. 70,

North, J. Full discovery was ordered in *Howe v. McKernan*, 30 Beav. 547 (1862), Romilly, M. R., where the defendant was charged with advertising himself as the plaintiff's agent after the agency was determined.

(e) *Benedictus v. Sullivan, Powell & Co.*, 12 R. P. C. 25 (1895), Chitty, J. If the question had been relevant, the plaintiff must have answered it.

Discovery in aid of inquiry or account.

decided (*f*); but where the giving of an account would occasion little trouble to the defendant, and may enable the plaintiff to get final judgment at the trial, without further inquiry, the judge, in his discretion, may order it to be given (*f*). In a case where the questions of fact had been ordered to be tried by a jury, such discovery was refused, before the trial, on the ground that the plaintiff had not elected whether to claim damages or an account of profits if he succeeded (*g*). After an account of profits or an inquiry as to damages has been directed, discovery of the names and addresses of the persons to whom the marked goods were sold, or, if this cannot be had, of persons to whom goods—as to which the accounting party cannot swear that they were *not* marked with the objectionable mark—were sold, may be ordered (*h*).

Inspection, &c.

The Court or a judge has wide powers, under Ord. 50, r. 3, to make any order for the detention, preservation, or inspection (*i*) of any property or thing, being the subject of litigation, and to authorize any persons to enter upon or into any land or building in the possession of any party to the litigation, and, for all or any of the purposes aforesaid, to

(*f*) *Benbow v. Low*, 16 C. D. 93 (1880), C. A. See also O. 31, r. 20, and the note in the Annual Practice thereon. And for the decisions in patent cases, see Edmunds on Patents, p. 308, 2nd ed. p. 420, and *De la Rue v. Dickinson*, 3 K. & J. 388 (1857).

(*g*) *Fennessy v. Clark*, 37 C. D. 184 (1887), Kay, J., and C. A.

(*h*) *The Leather Cloth Co., Ltd. v. Hirschfeld*, 1 H. & M. 295 (1863), Wood, V.-C.; *Powell v. Birmingham Brewery Co.*, 14 R. P. C. 1 (1897), Stirling, J., and C. A.; *Saccharin Corporation v. Chemicals and Drugs Co.*, (1900) 2 Ch. 556; 17 R. P. C. 612, C. A.

(*i*) Sect. 21 of the repealed Merchandise Marks Act of 1862 gave jurisdiction to order inspection. As to the powers of justices to issue *search warrants* for goods by means of or in relation to which an offence has been committed under the Merchandise Marks Act, 1887, see sect. 12 of that Act, p. 618. A person charged with an offence under the Act may find it necessary to show that “on demand made by or on behalf of the prosecutor he gave all the information in his power with respect to the persons from whom he obtained such goods or things”; sect. 2 (2), and sect. 6. See Book II., pp. 598, 604, and 608.

authorize any samples to be taken, or any observation to be made, or experiment to be tried, which may be necessary or expedient for the purpose of obtaining full information or evidence.

Under this power the Court could, for instance, authorize the plaintiff to inspect goods upon which he showed reasonable grounds for suspecting that a mark infringing his mark had been placed (*k*).

The application is made in the Chancery Division by motion or summons; in the Queen's Bench Division by summons (*l*).

Production and inspection of copies of the trade-marks, or of other documents which are referred to in any of the pleadings or affidavits of any of the parties in a case, may be obtained by giving notice in writing to such party to produce them, unless some cause or excuse for not complying with the notice is shown, which the Court or judge deems sufficient (*m*).

Documents referred to in the pleadings, &c.

Evidence.

The registration of the plaintiff's mark, or the refusal to register it, is proved by the production of a certificate under the hand of the Comptroller, and the actual terms of the registration, and proof of the mark itself as it is registered, are shown and given by the production of an extract or copy from the Register certified by the Comptroller and sealed with the seal of the Patent Office (*n*).

The Comptroller's certificate, and sealed copies of the Register.

The request for the certificate should be made to the Comptroller in writing, stating for what purpose it is required, in the form given in the schedule to the Rules (*o*). It may be

(*k*) Such inspection is frequently authorized in patent cases. See *Edmunds on Patents*, p. 307, 2nd ed. p. 413; and *Neilson v. Betts*, L. R. 5 H. L. p. 11, per Lord Westbury.

(*l*) See the Annual Practice notes to O. 50, rr. 3 and 6.

(*m*) O. 31, r. 15. *Smith v. Harris*,

48 L. T. 869 (1883), *Chitty, J.* The learned judge refused to order barrels branded with the mark to be produced. See also *Wills' Tms.*, above, p. 441.

(*n*) Sect. 88, Rule 52, Chap. III., p. 61.

(*o*) Rule 60, Form S., p. 712.

sent by post (*p*). The fee for a certificate for use in legal proceedings is one pound.

By sect. 89—

Copies of the Register.

“Printed or written copies or extracts, purporting to be certified by the Comptroller, and sealed with the seal of the Patent Office, of or from (patents, specifications, disclaimers, and other documents in the Patent Office, and of or from) Registers and other books kept there shall be admitted in evidence in all Courts in her Majesty’s dominions, and in all proceedings, without further proof or production of the originals.”

And by sect. 96—

Comptroller’s certificates.

“A certificate purporting to be under the hand of the Comptroller of any entry, matter, or thing which he is authorized by this Act, or any general rules made thereunder, to make or do, shall be *primâ facie* evidence of the entry having been made and of the contents thereof, and of the matter or thing having been done or left undone.”

This section corresponds to sect. 8 of the Act of 1875.

The registered mark is, in practice, usually shown by the production of a copy of the advertisement in the Trade-Marks Journal, leading to its registration, and this is generally accepted as sufficient.

Proof of title of registered proprietor;

Where the mark is registered, and the plaintiff is the registered proprietor, proof of the registration, and of the identity (if any question as to this is raised) of the registered proprietor with the plaintiff is *primâ facie* evidence of the plaintiff’s right to the exclusive use of the mark, and, after five years from the date of the application for registration, is conclusive evidence of his right, until the registration is annulled upon an application under sect. 90 (*q*).

of title by assignment, &c.;

If the plaintiff claims, by devolution or assignment, through the registered proprietor, he must prove the devolution or assignment by giving the proper evidence of the facts which effect it, and must prove in the same way that the

(*p*) Sect. 98.

(*q*) Sects: 75 and 76. See above, p. 361.

goodwill of the business concerned has also devolved upon or been assigned to him (*r*).

The infringement must be proved by showing that the defendant, his servants, or agents, have dealt in, or threaten, or are about to deal in goods of the kind to which the plaintiff's trade-mark rights extend, in such a manner as to infringe his trade-mark (*s*). of infringement;

The nature of the evidence which should be adduced to satisfy the Court that the defendant's mark has such a resemblance to the plaintiff's as to be calculated to deceive, has already been discussed (*t*). It has been shown that the Court, in general, attaches little weight to the mere statements of opinion by persons who are called as witnesses, or, as Fry, L. J., put it, in *Turton v. Turton* (*u*), as "compurgators," to say that they think there is no probability of deception. of probability of deception.

In *Orr-Ewing v. Johnston* (*x*), Fry, J., held, that the books kept by the Registrar of trade-marks were not evidence, in an action for infringement, to show that marks like the plaintiff's mark were in common use and had been refused registration, and that the plaintiff's mark was consequently *publici juris*. The books were only evidence, the learned judge held, that other persons had made claims. Certified copies of entries actually made on the Register are, however, evidence of such entries, and if they show that three or more marks other than, but similar to, the plaintiff's have been registered for the same goods, that would, it is submitted, be evidence that the mark is a common mark (*y*). The Registrar's books are not evidence that a mark is *publici juris*.

(*r*) Sect. 70, Chap. XIII., p. 324. As to registration of the assignment, see p. 317.

(*s*) *Ante*, p. 363.

(*t*) Above, p. 373, and Chap. X., p. 224. In many of the reports in the R. P. C. the nature of the evidence is very fully indicated; see, for instance, *Liebig's Co. v. Chemists' Society*, 13 R. P. C. 635, and the

Valentine and Payton cases cited in the next chapter.

(*u*) 42 C. D. 149 (1889). See also *Cope v. Evans*, L. R. 18 Eq. 138 (1874), Hall, V.-C.; and per Jessel, M. R., in *Thorn v. Worthing Skating Rink Co.*, 6 C. D. 415, n.

(*x*) 13 C. D. at p. 442 (1879).

(*y*) See the "Three Marks Rule," Chap. X., p. 214.

CHAPTER XVI.

THE ACTION FOR "PASSING OFF."

| | PAGE |
|--|------------|
| Foundation of the action | 447 |
| Comparison with the action for infringement | 448 |
| It often succeeds where that action fails | 449 |
| Section 77 is no bar | 450 |
| Common law trade-marks | 451 |
| New case of passing off or of fraud raised at the trial | 451 |
| Proof of fraud not essential | 451 |
| Property in trade-name, &c. | 452 |
| Inferiority of the spurious goods not essential | 453 |
| Rules and practice of infringement action generally apply | 453 |
| 1. Direct misrepresentation as to business or goods | 454 |
| false pretence of business connection or of succession | 455 |
| "late" | 455 |
| circulars, names over shops, executing orders intended for the plaintiff | 456 |
| claims to medals, patents, &c. | 457 |
| unauthorized use of name of a non-trader | 457 |
| 2. Imitations of trade-name, get-up, &c. | 458 |
| evidence of repute | 459 |
| assignment and devolution of trade-name, &c. | 460 |
| A. THE PLAINTIFF'S TRADE-NAME OR FIRM-NAME | 462 |
| principle on which it is protected | 462 |
| it may belong to others besides the plaintiff | 463 |
| need not be the plaintiff's family name | 463 |
| trade-name of a company | 464 |
| sect. 20 of the Companies Act is supplementary to the common law | 465 |
| <i>Hendriks v. Montagu</i> | 466 |
| no monopoly in names merely descriptive | 467 |
| cases of company trade-names collected | 467 |
| assignments to or by limited company | 468 |
| <i>Tussaud v. Tussaud</i> | 470 |
| right to use a name cannot be sold in gross | 471 |
| <i>Brinsmead v. Brinsmead, Pinet v. Pinet</i> | 472 |
| names of houses of business | 473 |
| B. THE TRADE-NAME OF THE PLAINTIFF'S GOODS | 475 |
| summary of principles | 476 |
| names which are not distinctive, and descriptive names | 476 |
| secondary meaning of descriptive name | 477 |
| name of introducer or patentee | 483 |
| common names | 483 |
| concurrent right | 484 |
| disclaimed word | 484 |
| expunged trade-mark | 484 |
| use of common word by defendant may be an element in a "get-up" case | 485 |
| geographical names | 485 |
| name of author, &c., name of book | 487 |
| C. IMITATION OF "GET-UP" | 488 |
| get-up common to the trade | 488 |
| no monopoly in the constituent elements | 489 |
| imitation of part of get-up | 490 |
| 3. Use in connection with the defendant's goods | 491 |

| | PAGE |
|--|------|
| 4. Probability of deception | 492 |
| where deception is intended | 492 |
| badges of fraud: unexplained similarities, colourable differences, gradual approximations | 492 |
| proof of actual deception | 493 |
| 5. Proof of damage | 494 |
| probability of damage is essential | 494 |
| 6. Defences | 495 |
| the usual defences summarised | 495 |
| concurrent right | 496 |
| partners after dissolution | 496 |
| rights of vendor and purchaser of goodwill | 496 |
| RIGHT TO TRADE UNDER ONE'S OWN NAME | 500 |
| the former rule | 500 |
| present state of authorities | 501 |
| incre similarity of name | 504 |
| the <i>Valentine Case</i> , <i>Chivers v. Chivers</i> , <i>Cash v. Cash</i> | 505 |
| earlier cases | 508 |
| <i>Turton v. Turton</i> | 508 |
| anyone may describe his firm in the ordinary mercantile way | 510 |
| not necessarily by any fancy name | 510 |
| <i>Massam v. Thorley</i> | 510 |
| the name must be the defendant's own | 511 |
| not a bought name, or one altered to resemble the plaintiff's | 511 |
| may be the defendant's name of repute | 512 |
| "limited" may be added | 512 |
| must be used <i>simpliciter</i> , not garnished | 512 |
| proximity as a badge of fraud | 513 |
| 7. The relief granted | 514 |
| injunction | 514 |
| form of injunction in <i>Massam v. Thorley</i> | 515 |
| only deceptive use of common word, &c., restrained | 515 |
| limited prohibition | 516 |
| 8. Costs, appeals, practice, &c. (reference to Chap. XV.) | 518 |
| Note.—Extract from judgment of Kay, L. J., in <i>Yorkshire Relish Case</i> .. | 518 |

It is an actionable wrong for the defendant to represent, for trading purposes, that his goods are those or that his business is that of the plaintiff, and it makes no difference whether the representation is effected by direct statements, or by using some of the badges by which the goods of the plaintiff are known to be his, or any badges colourably resembling these, in connection with goods of the same kind, not being the goods of the plaintiff, in such manner as to be calculated to cause the goods to be taken by ordinary purchasers for the goods of the plaintiff. But, except in a very extreme case (a), this rule has never been applied so as to prevent the defendant honestly trading under his own name (a), or under the names

Foundation of the action.

(a) The very recent case of *Cash v. Cash*, cited below, p. 508. Can the use be said to be honest, after it is shown that the result is to lead to the belief that the defendant's goods are the plaintiff's. See p. 377.

of the members of his firm, or honestly describing his goods, and their place of origin, manner of manufacture, and other characteristics, in the ordinary terms current in his trade.

The question whether the use of particular words or badges is calculated to pass off the defendant's goods as those of the plaintiff, or is merely honestly descriptive, is often one of difficulty, but it is, in substance, a question of fact.

"The principle of law may be very plainly stated, that nobody has any right to represent his goods as the goods of somebody else. How far the use of particular words, signs, or pictures, does or does not come up to the proposition enunciated in each particular case must always be a question of evidence, and the more simple the phraseology, the more like it is to a mere description of the article sold, the greater becomes the difficulty of proof; but if the proof establishes the fact, the legal consequence appears to follow" (*aa*).

Comparison
with the
action for the
infringement
of a trade-
mark.

The action to restrain the defendant from passing off his goods as the goods of the plaintiff, is obviously the generalized form of the action to restrain the infringement of a trade-mark (*b*); and the old principles from which the latter action grew up are still recognized and put into force by the Courts (*c*). The action for infringement has been specialized, and the proof of the plaintiff's case in it greatly facilitated and simplified by the registration of trade-marks and the provisions of the Acts; but the plaintiff's trade-mark,

(*aa*) Per Halsbury, L. C., in *Reddaway v. Banham*, (1896) A. C. at p. 204; 13 R. P. C. at p. 224. See generally on the subject of this Chapter the summaries of the law by Kay and Lindley, L. JJ., in *Powell v. Birmingham Vinegar Brewery Co.*, (1896) 2 Ch. 54; 13 R. P. C. 235; and Lord Davey in *Cellular Clothing Co. v. Marton*, (1899) A. C. at p. 343; 16 R. P. C. at p. 408, the first of which is printed in a note at the end of this Chapter. See also an article entitled "Unfair Competition," by Mr. O. R. Mitchell, in the *Harvard Law Review* for January, 1897. Leading American authori-

ties are the *Amosteug Co. v. Spear*, 2 Sandf. S.C. 599 (1849); and *Lawrence Co. v. Tennessee Co.*, 138 U. S. 537 (1891).

(*b*) See Chap. I., pp. 1 and 13, and Chap. XV., p. 354.

(*c*) See Chapters I. and II., and the judgments of the C. A. in *Powell v. Birmingham Brewery Co.*, (1896) 2 Ch. 54; 13 R. P. C. 235; *Lee v. Haley*, L. R. 5 Ch. 155 (1869), Malins, V.-C., and Giffard, L. J.; *Somerville v. Schembri*, 12 App. Ca. 453; 4 R. P. C. 179 (1887), P. C.; *Montgomery v. Thompson*, 41 C. D. 35; (1891) A. C. 217; 8 R. P. C. 361 (*Stone Ales*).

although the most important, is only one of the badges by which his trade or his goods are, or may be, identified with him; and it is equally a wrong, according to the principles laid down in the judgments quoted in the Introduction, and in the cases last cited, to imitate or copy any of the others (*d*),—his trade-name or the get-up of his goods. for instance,—so as to damage his trade by passing off other goods as his, or by leading his customers to suppose that there is a connection between such other goods and his business, which does not in fact exist (*e*).

In a trade-mark action the plaintiff must prove his title to the mark he claims, that it is registered as his mark or as the mark of his predecessor in business (or that sect. 77 has been otherwise complied with), and that the defendant has infringed the mark (*f*). And proof of the registration is, at least *primâ facie*, proof of title also. Further, if the mark has been actually or substantially copied, that constitutes an infringement, although it is not shown that the copy is calculated to deceive (*g*). In a passing off action the plaintiff's case is very similar to this, but registration forms no part of it, and the plaintiff must prove by direct evidence that the conduct of the defendant is calculated to pass off the defendant's goods as his; and to do so, he must show either that the defendant has actually represented that his goods or business are those of the plaintiff, or,—and this is the common case,—that he has used certain symbols or badges in connection with his goods or business, which are reputed in the market to import that the goods or business in connection with which they are used are the plaintiff's goods or business. A plaintiff may, therefore, fail to make out a case of infringement of trade-mark rights because he cannot prove his title

Where trade-mark action fails, passing off action may succeed on the same evidence.

(*d*) "By the course of trade, by the existence and technology of trade, and by the mode in which things are sold, a man may utter that same proposition" (*i.e.*, that his goods are those of the plaintiff) "but in different words and without using the name of the rival tradesman at all." Per Halsbury, L. C., in *Bir-*

mingham Brewery Co. v. Powell, (1897) A. C. at p. 711; 14 R. P. C. at p. 728.

(*e*) See *Borthwick v. The Evening Post*, 37 C. D. 449 (1888), Kay, J., and C. A., cited below, p. 475.

(*f*) See the last Chapter.

(*g*) See p. 371.

The two actions are frequently combined.

Sect. 77 affords no bar to a passing off action.

to the trade-mark, or its registration, or that its registration extends to the goods (*h*), or to all of the goods (*i*), in question, or because the registration is ordered to be annulled (*k*), and may yet show that by imitating the mark claimed as a trade-mark, or otherwise, the defendant has done what is calculated to pass off his goods as those of the plaintiff. It follows that a case of "passing off" is generally added as a second string to an action for infringement, and is frequently successful where the trade-mark action proper breaks down (*l*).

The Acts, and in particular the definition sections and the sections barring, in certain events, proceedings to prevent or to recover damages for the infringement of unregistered trade-marks (*m*), seem to have been undoubtedly intended to limit and define the classes of symbols which could be appropriated as trade-marks, to restrict the latitude which existed before 1875 (*n*) with regard to the choice of trade-marks, and to make registration a condition precedent to all litigation in respect of subsequently acquired trade-marks corresponding to the trade-mark cases before the Acts. This intention was not, however, sufficiently clearly expressed, and the Acts have, in consequence, been construed so as practically to leave a plaintiff in possession of all the rights which he would have had if they had not been passed, while greatly facilitating the protection of such trade-marks as may be and are properly registered (*o*).

(*h*) *Hart v. Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J.

(*i*) *Jay v. Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

(*k*) *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A.; *Montgomery v. Thompson*, 41 C. D. 35; 6 R. P. C. 404; (1891) A. C. 217; 8 R. P. C. 361, C. A. and H. L.; *Powell v. Birmingham Co.*, (1896) 2 Ch. 54; 13 R. P. C. 235; (1897) A. C. 710; 14 R. P. C. 720.

(*l*) See the cases cited in the last three notes. *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L. J.; and the judgment of Lindley, L. J., in *Reddaway & Co. v. Bentham Hemp*

Spinning Co., (1892) 2 Q. B. 639; 9 R. P. C. 503, C. A. (*Camel Hair Belt-ing*). See also *Compania Général de Tabacos v. Rehder*, 5 R. P. C. 61 (1887), Kay, J., and *Curtis and Harvey v. Pape*, 5 R. P. C. 146 (1887), North, J., where the trade-mark questions were left undecided.

(*m*) Act of 1875, sect. 1; Act of 1883, sect. 77; see Chap. XII., pp. 312 *et seq.*

(*n*) See the judgment of Cotton, L. J., in *Van Duzer's Tm.*, 34 C. D. p. 634; 4 R. P. C. 31 (1887); and above, p. 315.

(*o*) See *Sen Sen Co. v. Britten*, (1899) 1 Ch. at p. 694; 16 R. P. C. at p. 140, Stirling, J.

As the cases cited above show, it is no bar to an action for passing off that the trade-name, get-up, or any other of the badges identified with the plaintiff's business, which are alleged to have been copied or imitated by the defendant, might have been, but are not, registered under the Acts as trade-marks (*p*), even though the evidence is wholly addressed to what may be a mark capable of registration (*q*). Such unregistered marks are frequently referred to as "common law trade-marks" (*q*).

Common law trade-marks.

But a plaintiff who has raised no issue upon his pleadings except in regard to the infringement of his trade-mark, has been refused leave to amend his claim at the trial, so as to start a fresh case of "passing off" in order to save his action (*r*). In the case first cited in the note, however, leave was reserved to the plaintiffs to bring a fresh action to restrain the defendants from passing off their goods as the plaintiffs'. If a charge of fraud is to be made at the trial, it is essential that it should be put forward clearly and prominently on the pleadings (*s*).

New case of passing off or of fraud raised at the trial.

Passing off cases are usually cases of deliberate and intentional misrepresentation, and they have been treated in many reported judgments even in recent cases, in which the attention of the Court was not directed to the point, as though fraud were a necessary element of the right of action; but it is well settled that this is not the case (*t*). In an action

Proof of fraudulent

(*p*) See above, Chap. XII., p. 317, and *Great Tower Street Tea Co. v. Langford & Co.*, 5 R. P. C. 66 (1887), Stirling, J.

(*q*) *Reddaway & Co. v. Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9 R. P. C. 503, Lindley, L. J.; *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L. J.

(*r*) *Native Guano Co. v. Sewage Manure Co.*, 4 R. P. C. 478; 8 R. P. C. 125 (1887), Kay, J., C. A. and H. L. Leave was granted, the defendants not objecting, in *Jay v. Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.; and also

in *Barber v. Manico*, *supra*, where the defendants raised the objection.

(*s*) *Leahy, Kelly and Leahy v. Glover*, 10 R. P. C. 141 (1893), H. L.

(*t*) *Singer Manufacturing Co. v. Wilson*, 3 App. Ca. 376 (1877), Cairns, L. C., cited above, p. 14; *Johnston v. Orr-Ewing*, 7 App. Ca. 219 (1882); *Singer Manufacturing Co. v. Loog*, 8 App. Ca. 15 (1882); *Reddaway v. Bentham*, (1892) 2 Q. B. 639; 9 R. P. C. 503, C. A.; *Saxlehner v. Apollinaris Co.*, (1897) 1 Ch. 893; 14 R. P. C. 645, Kekewich, J.; and see the judgments of Cotton, L. J., in *Borthwick v. The Evening Post*, 37 C. D.

intention is
not essential.

to restrain passing off, proof that the defendant intended to deceive, if his conduct is shown to be calculated to pass off his goods as those of the plaintiff, or to cause them to be so passed off, is no more necessary than in an action for infringement (*u*). And if it were necessary, it would be sufficient evidence of fraud to show that the defendant continued, or sought to continue, to use the deceptive badges or descriptions, after the danger of mistake arising from their use had been brought to his notice (*x*). For it has never been held that innocent inception is a defence (*y*).

"Property"
in trade-
names and
get-up.

It is obvious, therefore, that a trader has much the same right in respect of his trade-name, the get-up of his goods, and all the other distinctive badges and descriptions by which goods are known to be his, as he has in respect of his trade-marks, although the latter right is called a right of property, and the former is commonly, but not invariably (*z*), denied that title (*a*). There are, however, important practical

449 (1888); and *Turton v. Turton*, 42 C. D. 128 (1889), cited below, p. 508; and Halsbury, L. C., in *Cellular Clothing Co. v. Maxton*, (1899) A. C. at p. 334; 16 R. P. C. at p. 404; *Chivers & Sons v. Chivers & Co., Ltd.*, 17 R. P. C. 420 (1900), Farwell, J., is the latest authority.

(*u*) Chap. XV., p. 375. This rule was too well settled to be disturbed by the judgments in *Derry v. Peek*, 14 App. Ca. 337 (1889), although it originally rested upon the extension of the action of deceit to cases where there was no intentional deception, which was reprobated in that case. Although in some judgments actions for passing off have been referred to as actions for deceit, *e.g.*, as by Vaughan Williams, L. J., in *Jamieson v. Jamieson*, 15 R. P. C. at p. 191, they are not actions for deceit in the ordinary sense, *i.e.*, actions brought to recover damages for a fraudulent misrepresentation made to the plaintiff. See also note (*x*).

(*x*) See p. 375, above; and *Chivers v. Chivers*, note (*t*).

(*y*) *Paine & Co. v. Daniells and Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 217, C. A.

(*z*) *Clement v. Maddick*, 1 Giff. 98 (1859) Stuart, V.-C.; *Borthwick v. The Evening Post*, 37 C. D. 449 (1887), Kay, J., property in the name of a newspaper. Cf. p. 460, note (*p*) below.

(*a*) See per Lord Blackburn, in *Singer Manufacturing Co. v. Wilson*, 3 App. Ca. p. 400. In *Reddaway v. Banham*, (1896) A. C. at p. 209, 13 R. P. C. 228, Lord Herschell said that he doubted whether it was accurate to speak of there being property in such a trade-mark (*i.e.*, a common law trade-mark), though no doubt some of the rights which are incident to property might attach to it, especially if it was such as to be capable of no conceivable legitimate use except by the proprietor. In *Jamieson & Co. v.*

differences between the two rights. A trade-mark being deliberately assumed or invented as a distinctive mark to identify the goods of its proprietor because of its supposed fitness for the purpose, could hardly be adopted by any other trader in the same market for similar goods without its use by him being calculated to deceive. But the other badges and descriptions referred to, although by use they may become more or less identified with the trader who used them first, or most extensively, may have been adopted merely for purposes of convenience or of ornament, and may have been suggested by the circumstances of the trade in question, or of the trader himself; and the same considerations or circumstances may suggest the use of the same badges and descriptions to others also (*b*), and their use of them will not necessarily be calculated to deceive. The cases in which a defendant can plead an independent right to the use of badges or descriptions which are not trade-marks,—for instance, to the use of the same trade-name as the plaintiff,—are much more important than the rare cases in which he can claim a right to use the trade-mark of the plaintiff or a trade-mark closely resembling it (*c*).

It is immaterial to the existence of the plaintiff's right of action that the goods passed off as his are as good as or better than his own (*d*); but it would seem that if they are not inferior no case of damage by injury to the plaintiff's trade reputation could be made out.

It will be seen from the definition placed at the beginning of the chapter, and the comparison of the two actions in the preceding pages, that the rules and principles relating to the action of infringement which are collected in the last chapter,

Inferiority of the spurious goods need not be shown.

Rules and practice of infringement action apply, in general, to passing off action.

Jamieson, 15 R. P. C. at p. 191, *Vaughan Williams*, L. J., said it was wrong to assume that a trader acquired some sort of property in his trade-name or its use, and that the action is one of deceit.

(*b*) Or to customers of other traders, as for instance in the *Dolly Blue Case*, *Edge v. Gallon*, 17 R. P. C. 557 (1901) H. of L.

(*c*) See per Cotton, L. J., in *Turton v. Turton*, 42 C. D. p. 142, and Chap. XV., p. 384; and the last note.

(*d*) *Blofield v. Payne*, 4 B. & Ad. 410; 2 L. J. K. B. n.s. 68 (1833); *Edelsten v. Edelsten*, 1 De G. J. & S. 185 (1863), *Westbury*, L. C.; per Lord Blackburn, in *Singer Manufacturing Co. v. Loog*, 4 App. Ca. p. 29. See last chapter, pp. 363 and 364.

in general apply also to the action for "passing off," substituting proof of repute for evidence of title and registration. The defences available, the relief granted, and the practice and procedure in both actions are substantially the same.

1. Direct Misrepresentation as to Business or Goods.

Where there is a direct misrepresentation by the defendant that the goods he sells are the goods of the plaintiff, the case presents no difficulty.

No case if the defendant believed that his representation was true.

Thus, in *Ainsworth v. Walmsley (d)*, it was shown that the defendant had sold certain spools of thread wound and marked like the plaintiff's thread, with a representation that it was of the plaintiff's make. The defendant asserted that he had himself bought it on a like representation, which he believed, and that he had disclosed the source through which he himself obtained the goods, and his assertion was not disproved. The Vice-Chancellor accordingly dismissed the suit, for if the defendant in fact believed that the thread was the plaintiff's thread, he had committed no act of which the plaintiff could complain. Had he known it was not, there would have been a clear case for an injunction. "The use (by one manufacturer) of the name of another manufacturer," the Vice-Chancellor said, "whether *scienter* or not, is an interference with his business which this Court will interpose to prevent, on the ground that the defendant is endeavouring to pass off the goods of his own, or somebody else's, manufacture, as the manufacture of the plaintiff." But, he added, "taking the case most strongly against the defendant, it merely amounts to this, that Walmsley stated to the purchaser, 'I sell you thread which I have bought of Wreford, but which I know to be Ainsworth's.'"

"Similar to." But no action lies for passing off the defendant's goods as "similar to" those of the plaintiff (e), or with a representa-

(d) L. R. 1 Eq. 518 (1866), Wood, V.-C. Upon the facts proved the plaintiff would probably succeed at the present day. The Vice-Chancellor treated the representation as

practically equivalent to a warranty to the purchaser and no more.

(e) *Magnolia Metal Co. v. Tandem Smelting Syndicate*, 15 R. P. C. 701; 17 R. P. C. 477 (1900) C. A. and H. of L.

tion that they are better than his (*f*), even though the statements complained of are untrue and injurious to the plaintiff (*g*).

Cases in which the defendant directly represents that his business is the plaintiff's business, or a branch of it, are equally clear as soon as the false representation is made out.

A partner or servant who has left a well-known firm and set up a similar business of his own, is entitled to advertise his former connection (*h*), unless restrained from doing so by contract with his late partners or employers (*i*); but he must take care to do it so as not to suggest that the connection is still existing between them and him (*h*), or that they have ceased to carry on business and he is their successor (*l*).

And the same rule holds good of a trader who (*m*), or whose trustee in bankruptcy (*n*), has sold the goodwill of his business.

Thus, where the son of the plaintiff quitted his father's employment, and described himself as "late of 107, Strand" (*h*), an injunction was granted to restrain him from continuing to do so. So, in *Scott v. Scott* (*o*), a doorplate, bearing the words "Scott and Nixon, late Robert and Walter Scott," was held to be a representation that Walter Scott had retired,

Representation that the defendant's business is that of the plaintiff.
False pretence of a business connection.

False representation of succession to business.

"Late."

(*f*) *White v. Mellin*, (1895) A. C. 154.

(*g*) *Hubbuck v. Wilkinson*, (1899) 1 Q. B. 86, C. A., and see cases last cited.

(*h*) *Clark v. Leach*, 32 Beav. 14; 1 De G. J. & S. 409; 32 L. J. Ch. 290 (1862), Romilly, M. R., and Westbury, L. C.

(*i*) *Asin Wolmershausen v. O'Connor*, 36 L. T. n.s. 921 (1877); and *Selby v. The Anchor Tube Co.*, W. N. (1877) 191, both Bacon, V.-C., where the style and goodwill passed, under the articles, to one partner on a dissolution. A servant must not use information acquired in his employment to enable him to solicit his master's customers to deal with him after he has left the employment: *Robb v. Green*, (1895) 2 Q. B. 1, 315, Haw-

kins, J., and C. A. As to sales of goodwill, see below, p. 496.

(*l*) *Burgess v. Burgess*, 3 De G. M. & G. 896; 22 L. J. Ch. 675 (1853), Kindersley, V.-C., and L. JJ.; and see p. 382.

(*l*) See the cases next cited, and *Labouchere v. Dawson*, L. R. 13 Eq. 322 (1872), Romilly, M. R.

(*m*) *Churton v. Douglas*, Johns. 174; 28 L. J. Ch. 841 (1859), Wood, V.-C.; *Fullwood v. Fullwood*, W. N. (1873) 93 and 185, Malins, V.-C., and L. JJ. See this further discussed below, p. 497.

(*n*) *Hudson v. Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C. See further, as to this, below, p. 499.

(*o*) 16 L. T. n.s. 143 (1866), Wood, V.-C.

and that Scott and Nixon were carrying on the business of his old firm.

And in a case where no such connection as those above referred to had ever existed between the defendants and the plaintiffs, but the defendants, having obtained a lease of clay mines formerly leased to the plaintiffs, described themselves in advertisements, referring not only to the mines, but to certain works also, where they carried on a trade similar to that of the plaintiffs, as *E. and J. Pearson (late Harpers and Moore)*, the description was held to be a representation calculated to lead the public to believe that the plaintiffs, Harpers and Moore, had retired from business (*p*). So where the plaintiff and defendant were carrying on business as rival dentists in the same street, and, on the expiration of his tenancy, the plaintiff was compelled to remove, and the defendant put up a board describing himself as the "old established dentist," this was held to be a representation that the plaintiff had removed to the defendant's place of business. An interim injunction would have been granted had the defendant not undertaken to put his name very conspicuously upon the board (*q*).

Description of new comer as "the old established."

Pretence of agency.

Another description of false representation of a business connection which sometimes comes before the Courts, is where the defendant has pretended to be agent for the sale of the plaintiff's goods (*r*).

Deceptive circulars.

The fraud is commonly effected by issuing misleading circulars or advertisements (*s*), or by placing the deceptive

(*p*) *Harpers v. Pearson*, 3 L. T. n.s. 547 (1860), cited p. 359; *Stevens v. Paine*, 18 L. T. n.s. 600 (1868), Giffard, V.-C., and cf. *Townsend v. Jarman*, 17 R. P. C. at 657 (1900), Farwell, J.

(*q*) *Mallam v. Davis*, 3 Times L. R. 221 (1887), Stirling, J.

(*r*) *Howe v. McKernan*, 30 Beav. 547 (1862), Romilly, M. R. (discovery ordered); *Wheeler and Wilson Co. v. Shakespear*, 39 L. J. Ch. 36 (1869), James, V.-C. (injunction granted).

(*s*) As in *Purser v. Brain*, 17 L. J. Ch. 141 (1848), Shadwell, V.-C.; *Burrows v. Foster*, 32 Beav. 18 (1862), L. JJ.; *Graveley v. Winchester*, Seton, 5th ed. 591; Seb. Dig. p. 162 (1867), Wood, V.-C. (circulars ordered to be given up); *Stevens v. Paine*, 18 L. T. n.s. 600 (1868), Giffard, V.-C.; *Selby v. Anchor Tube Co.*, W. N. (1877) 191, Bacon V.-C. (defendants restrained from soliciting or executing orders obtained by the misrepresentations); *Mogford v. Courtenay*, 45 L. T. n.s. 303;

name or title on the fascia over the defendant's shop (*t*), and by opening and replying to letters addressed to, or intended for, the plaintiff, and executing the orders contained in them (*u*); or some one or more of these devices.

Names over shops.
Executing orders intended for the plaintiff.
Claim to the prizes, medals or patents of another.

As further examples of misrepresentation, not included in the classes considered below, may be mentioned claims to medals, prizes, &c. which, in fact, have been gained by the plaintiff (*x*), or to patents under which he, and not the defendant, is working (*y*). Such claims may enable a rival to pass his goods or business off as those of the person who is really entitled to the medals, prizes, or patents. Where they are not calculated to produce such a result no case can be made (*z*).

In the old case of *Clark v. Freeman* (*a*), Lord Langdale, M. R., refused to restrain the defendant from selling a quack medicine as "Sir J. Clarke's Consumption Pills," at the instance of the Sir J. Clark referred to, who was an eminent physician, on the ground that the plaintiff carried on no

Unauthorized use of the name of a non-trader.

Vernon v. Hallam, 34 C. D. 748 (1886), Stirling, J.; and see *Townsend v. Jarman*, note (*p*).

(*t*) *Foot v. Lea*, 13 Ir. Eq. 484 (1850), Smith, M. R.; *Burgess v. Burgess*, 3 De G. M. & G. 896; 22 L. J. 675 (1853), Kindersley, V.-C., and L. J.J.; *Scott v. Scott*, 16 L. T. n.s. 143 (1866), Wood, V.-C. (door plate); *Hookham v. Pottage*, L. R. 8 Ch. 91 (1872), Malins, V.-C., and L. J.J. As to the purchase of a building with the vendor's name built into it, see *Jarman v. Townsend*, note (*p*).

(*u*) *Schiele v. Brackell*, 11 W. R. 796 (1863); Seton, 5th ed. 584, Stuart, V.-C.; *Edgington v. Edgington*, 10 L. T. n.s. 299 (1864), Wood, V.-C. (a single instance proved, injunction refused); *Witt v. Concoran*, 2 C. D. 69 (1873), Bacon, V.-C.; *Townsend v. Jarman*, note (*p*).

(*x*) *National Starch Co. v. Munn's Patent Maizena Co.*, (1894) A. C. at

p. 281, P. C.; 11 R. P. C. 294; *Franks v. Weaver*, 10 Beav. 297; 8 L. T. o.s. 510 (1847), Lord Langdale; see note (*z*), and below, p. 494.

(*y*) *Lawrie v. Baker*, 2 R. P. C. 213 (1885), Day, J.; *Pneumatic Rubber Stamp Co. v. Lindner*, 15 R. P. C. 525 (1898): see also *Paine & Co. v. Daniells & Sons' Breweries*, cited *ante*, p. 371.

(*z*) *Tallerman v. Dowling Radiant Heat Co.*, (1900) 1 Ch. 1, Stirling, J. A medicine vendor published as his own testimonials sent to another. There was no probability of deception. Interlocutory injunction refused. An appeal in this case was compromised. See also *Batty v. Hill*, 1 H. & M. 264; 8 L. T. n.s. 791. As to medals and certificates at the Exhibitions of 1851 and 1862, see 26 & 27 Vict. c. 119, below, p. 847. Cf. also *Ajello v. Worsley*, (1898) 1 Ch. 274.

(*a*) 11 Beav. 112; 17 L. J. Ch. 142 (1848).

business in pill-making, and that the wrong done to him was a libel only, which the Court of Chancery had no jurisdiction to restrain (*b*). It has always been considered (*c*) that a narrow view was taken of the facts of this case, as the sale of pills under a well-known doctor's name is eminently calculated to suggest that the pills are prepared according to his directions, and to injure his practice if they do not meet with a favourable reception by purchasers who are, or who might become, his patients; but, in a similar recent case, *Kay, J.*, refused to treat the older authority as no longer law, at least, upon an interlocutory application (*d*).

2. Imitations of Trade-Name, Get-up, &c.

The name or get-up must be known as that of the plaintiff or his predecessors whose business he has.

Actions based upon direct misrepresentation are comparatively rare. The plaintiff's case more commonly is that the defendant has copied or imitated the trade-name, or the get-up, or some other badge or description by which the plaintiff's business and goods are known to be his. Where the charge is one of indirect misrepresentation of this sort, the onus is cast upon the plaintiff, in the first place, to show that the things copied or imitated are reputed in the market to denote a connection between himself or his predecessors in business, and the business or goods in, upon, or in reference to which they are used. And this is precisely the proof which the plaintiff had to adduce in trade-mark actions before the Acts. So far as regards marks applied or attached to the goods themselves, it has been considered, and the authorities relevant to it have been collected in a previous chapter (*e*).

(*b*) As to this, see *Bonnard v. Perryman*, (1891) 2 Ch. 269; *Collard v. Marshall*, (1892) 1 Ch. 571; and *Monson v. Tussaud*, 10 Times L. R. 227 (1894).

(*c*) Lord Selborne said the case had seldom been cited except to be disapproved: *Re Rivière's Tm.*, 26 C. D. 48 (1884). See also *Maxwell v. Hogg*, L. R. 2 Ch. 307 (1867), Lord Cairns; *Springhead Spinning Co. v. Riley*, L. R. 6 Eq. 551 (1868), Malins, V.-C. Cf. the case of the

name of a private house, below, p. 474. As to authors' names, see p. 487, below.

(*d*) *Williams v. Hodge*, 4 Times L. R. 175 (1887). Kekewich, J., did so in *Lee v. Gibbins*, 67 L. T. 263 (1892). But see *Dockrell v. Dougall*, 80 L. T. 556 (1899), C. A.

(*e*) Definition of a trade-mark, Chapter II., p. 23; *Lawson v. The Bank of London*, 18 C. B. 84; 25 L. J. C. P. 188 (1856).

It is not, however, necessary to show that the customers who knew the goods of the plaintiff's firm by a particular name or get-up knew anything whatever about the plaintiff. It is immaterial that they did not even know his name (*f*); for it is sufficient to prove that purchasers of his goods recognized, by the use of the marks in question in connection with them, that they were goods of a particular class, and to show that such class is, in fact, constituted by his goods.

The plaintiff himself may be unknown.

Thus, in the much contested *Yorkshire Relish Case* (*g*), the plaintiff's sauce was made according to a secret recipe, and was always bought and sold by the name alone. The defendants made a sauce described as a "wonderful match" of the plaintiff's, and their contention was that the public knew and cared nothing about the actual manufacturer, but wanted only the sauce known as *Yorkshire Relish*. The contention failed. Lord Herschell said of it in the House of Lords: "I think that the fallacy of the appellant's argument rests on this: that it is assumed that one trader cannot be passing off his goods as the manufacture of another unless it be shown that the persons purchasing the goods know of the manufacturer by name, and have in their mind when they purchase the goods that they are made by a particular individual. It seems to me that one man may quite well pass off his goods as the goods of another if he passes them off to people who will accept them as the manufacture of another, though they do not know that other by name at all. In the present case it seems to me that *Yorkshire Relish* meant the manufacture of a particular person" (*h*).

Where the existence of such repute is not shown, the action cannot succeed (*i*). Thus, in a case where the plaintiff claimed only as the mortgagee of a business and its trade-name, and had never used, and did not intend to use, the trade-name (*k*), and in a case in which the plaintiffs were

Evidence of repute.

(*f*) *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A. (*Sunlight Self-washer Soap*); see next case.

(*g*) *Powell v. The Birmingham Brewery Co.*, (1896) 2 Ch. 54; 12 R. P. C. 496 (1897) A. C. 710; 14 R. P.

C. 720, and p. 35, above.

(*h*) (1897) A. C. at p. 715.

(*i*) *Goodfellow v. Prince*, 35 C. D. 9 (1887), C. A.

(*k*) *Beazley v. Soares*, 22 C. D. 660 (1882), Pearson, J.; cf. *Clark v. Freeman*, *ante*, p. 457.

carrying on no business in England (*l*), the actions were dismissed. But no length of time during which the use of the badges in question by the plaintiff or his predecessors must have extended can be laid down (*m*), although it seems safe to assume that an actual and practical knowledge of the connection between them and him by a number, apparently considerable, of probable dealers in, or purchasers of, the goods must be shown, and, accordingly, that a name, get-up, or other badge just adopted and brought into use, would not now be protected, as a newly adopted trade-mark would have been before the Registration Acts (*n*), and would be now, if registered, under sect. 76.

It has been held that three days' use of the name of a new weekly newspaper, of which fifteen copies had been sold (before the defendant's publication began), was not sufficient to give the owners any right to stop other persons using the same name for a rival paper (*o*).

The reputed connection must be a connection of the trade or the goods, in or upon which the name, get-up, or other badges are used, with the plaintiff himself, or else with his predecessors as owners of the business in which he is at the time of action, using, or intending to use them. And trade-names may be assigned and may devolve in connection with the goodwill of the business (*p*). The rules in regard to

Assignment
and devolu-

(*l*) *Robineau v. Charbonnet*, W. N. (1876) 160, Malins, V.-C. The plaintiffs were confectioners (*querc* dressmakers) in Paris, having no agency in England. Held, no probability of injury.

(*m*) This was stated to be a question for a jury in the old case of *Purser v. Brain*, 17 L. J. Ch. 141 (1848), Shadwell, V.-C. (*The London Manure Co.*).

(*n*) *Maxwell v. Hogg*, L. R. 2 Ch. 307 (1867), L. JJ.; *Hall v. Barrows*, 32 L. J. Ch. 548 (1863), Romilly, M. R.; *McAndrew v. Bassett*, 33 L. J. Ch. 561 (1864), Wood, V.-C., *ante*, p. 33.

(*o*) *Licensed Victuallers' Newspaper*

Co. v. Bingham, 38 C. D. 139 (1888), North, J., and C. A.; Cotton, L. J., said that the larger sale of the plaintiff's paper subsequently to the adoption of the defendant's name was immaterial; cf. *Maxwell v. Hogg*, *supra*, and p. 33, above.

(*p*) "I think it is settled by a series of cases, of which *Hall v. Barrows* (note (*n*)) is, I think, the leading one, that both trade-marks and trade-names are, in a certain sense, property, and that the right to use them passes with the goodwill of the business to the successors of the firm which originally established them, even though the name of that firm be changed, so that they are no

assignment already discussed in relation to trade-marks (q) apply, therefore, to trade-names and similar matters, for if the things which the defendant has copied or imitated denote a connection, not with the plaintiff, but with someone else, he can have no claim to sue in respect of the deception which, as he alleges, the defendant's use of them is calculated to occasion. Thus, in *Pinto v. Badman*, the jury at the trial found upon the same facts that the defendant had infringed the plaintiff's trade-mark, and had passed off his goods as those of the plaintiff. On the appeal it appeared that the label and brand copied by the defendant had, not long before the commencement of the action, been assigned, without the business with which they were connected, by certain third parties to the plaintiff. Upon this ground the Court of Appeal set aside the verdict and entered judgment for the defendants, notwithstanding the finding as to "passing off" (r). And neither a licence to use, nor an absolute assignment of a trade-name without the goodwill of the business to which it was attached, entitles the licensee or assignee to sue to restrain the use of the name by another trader (s).

tion of trade-name, &c.

The question of repute is, however, rarely considered separately, for, as a right of property in respect of the exclusive use of marks or badges other than registered trade-marks (and, to some extent, the trade-name of the plaintiff) is not recognized, it is generally more convenient to deal directly with the more general question: Is the defendant's conduct calculated to pass off his goods as those of the plaintiff? (t).

The question as to repute is not generally considered separately.

The imitation by the defendant of any of the badges by which the plaintiff's goods are known to be his, falls within

longer strictly correct"; per Lord Blackburn, in *Singer Manufacturing Co. v. Loog*, 8 App. Ca. p. 33 (1882). See above, p. 452, n. (x).

(q) Chap. XIII. p. 324.

(r) 8 R. P. C. 181 (1891). The case, so far as regards passing off, was not expressly referred to in the judgments, but the principles stated

were as applicable to that as to the case for infringement.

(s) *Thorneloe v. Hill*, W. N. (1894) 15; 11 R. P. C. 61, Romer, J. (*John Forrest*). It follows that the mere right to use a name cannot be sold; see below, p. 471.

(t) See *Jamieson & Co. v. Jamieson*, 15 R. P. C. 169 (1898), in the C. A.

the scope of the action to restrain passing off. The most important of these badges are the trade-name of the plaintiff and the trade-name and the get-up of his goods.

A. The Plaintiff's Trade- or Firm-name.

A man's own name, or the name under which he trades, may be an ordinary trade-mark, if used as such, that is, applied or attached to the goods in which he deals (*u*). If it is "printed, impressed, or woven in some particular and distinctive manner," or in the form of "a written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade-mark," it may be entered upon the Register (*x*). But although it is not so used or registered, and it therefore does not become a trade-mark, its use by the defendant for trading purposes in connection with goods which are not the plaintiff's is obviously calculated to mislead, unless it happens to be the name of the defendant also, or a name under which he is entitled to trade (*y*).

Principle on which a trade-name is protected.

The ground upon which the Court acts in protecting a trade-name was stated by James, L. J., in *Lery v. Walker* (*z*) in the following passage: "It should never be forgotten that in these cases the sole right to restrain anybody from using any name he likes in the course of any business he chooses to carry on is a right in the nature of a trade-mark, that is to say, a man has a right to say, 'You must not use a name, whether fictitious or real—you must not use a description, whether true or not, which is to represent, or calculated to represent, to the world that your business is my business, and so, by a fraudulent (*a*) misstatement, deprive me of the profits of the business which would otherwise come to me.' An individual plaintiff can only proceed on the ground that, having established a business reputation under a particular name, he

(*u*) See Chap. II., p. 23.

(*x*) Sect. 64, Chap. VIII., pp. 124 and 129.

(*y*) See per Wood, V.-C., *Ains-*

worth v. Walmsley, L. R. 1 Eq. 518 (1866), and p. 500, below.

(*z*) 10 C. D. p. 447 (1879).

(*a*) See above, pp. 14 and 451.

has a right to restrain anyone else from injuring his business by using that name" (b).

The name taken or copied by the defendant need not be that under which the plaintiff alone, and no other person, is properly trading. Thus, in *Dent v. Turpin* (c), Wood, V.-C., held that each of two firms carrying on business separately as watchmakers under the name *Dent* might sue a third person, who had set up a similar business under the same name, for an injunction, delivery up of the marked articles, and an account of profits (d). But if the name in question is properly used by more than one person the difficulty of showing that its use by the defendant has caused his goods to be taken for those of the plaintiff may be greatly increased (e).

It may belong to others beside the plaintiff.

And as stated by James, V.-C., in the judgment quoted above, the name need not be the personal name of the plaintiff (f). It need not even be that of a predecessor in business, for a trader may lawfully adopt and trade under any name which is unappropriated for businesses of the same kind, and when the name has become his by repute he is as

It need not be the plaintiff's family name.

(b) Cf. Lord Chelmsford's statement in *Du Boulay v. Du Boulay*, L. R. 2 P. C. p. 441 (1869): "The right to the exclusive use of a name in connection with a trade or business is familiar to our law; and any person using that name after a relative right of this description has been acquired by another is considered to have been guilty of a fraud, or, at least, of an invasion of another's right, and renders himself liable to an action, or he may be restrained from the use of the name by injunction"; and *Clark v. Freeman*, cited *ante*, p. 457; see also the judgments of James, L. J., and Jessel, M. R., quoted above, pp. 1 and 13.

(c) 2 J. & H. 139; 30 L. J. Ch. 495 (1861); *Southorn v. Reynolds*, 12 L. T. n.s. 75 (1865), Wood, V.-C. See also per Lord Watson during the argument in *Powell v. The Birmingham Brewery Co.*, 14 R. P. C. at

p. 726. The action in *Jamieson & Co. v. Jamieson*, 15 R. P. C. 169 (1898), failed because the defendant had not used anything identified with the plaintiffs (p. 182), not because there were other Jamiesons in the trade at Aberdeen.

(d) As to the relief granted in such a case, see the last chapter, p. 428.

(e) See the last case. Vaughan Williams, L. J., said (at p. 193): "The moment it is admitted that the goods of more traders than one are denoted by the same name you have gone a long way towards disposing of the assertion that the particular name is understood in the trade to denote the goods of the plaintiff." See also *Whitstable Oyster Co. v. Hayling Fisheries, Ltd.*, 17 R. P. C. 461 (1900), Buckley, J.

(f) Cf. "Defences," below, p. 511.

well entitled to protection for it as if it were his own (*g*). A modern case before North, J., is an illustration of this rule. There the plaintiffs made and sold a sauce which, by his permission, they called by the name of one of their servants, "Holbrook's Worcester Sauce." The servant left them and joined the defendants, who thereupon advertised that they had acquired the right to make "Holbrook's Worcester Sauce." It was shown that the sauce sold by the plaintiffs was well known as theirs by the name, and the learned judge held that they had a right to the name in question, and that Holbrook could not sell it to the defendants (*h*). In this case the sauce was identified by the name with the plaintiffs, and not with Holbrook; an opposite result would have been reached if the name had been understood to indicate that the latter person was the actual maker of the goods, and that they were his goods of which plaintiffs happened to be vendors (*i*). Thus, in *Franke v. Chappell* (*k*), although the plaintiff had organized series of concerts known as "Richter Concerts" for many years, when Herr Richter made arrangements to conduct the rival concerts of the defendants, it was held that the defendants might rightly advertise their series under the name, since it was understood to mean, not concerts got up by the plaintiff, but anybody's concerts conducted by Richter.

The trade-name of a company.
Sect. 20 of the Companies Act, 1862.

In the case of a company registered under the Companies Act, 1862, it is enacted that (*l*)—

"No company shall be registered under a name identical with that by which a subsisting company is already registered, or so nearly resembling the same as to be calculated to deceive, except in a case where such subsisting company is in the course of being

(*g*) In *Isaacs v. Thompson*, 41 L. J. Ch. 101 (1871), Bacon, V.-C., for instance, the plaintiff traded as *Mme. Elise*.

(*h*) *Birmingham Vinegar Brewery Co. v. Liverpool Vinegar Co.*, W. N. (1888) 139, an interlocutory injunction was granted; cf. *Dence v. Mason*,

W. N. (1877) 23; (1878) 42, Malins, V.-C. (*Brand's Essence of Beef*).

(*i*) As to joint trade-marks, see p. 358, above.

(*k*) 57 L. T. n.s. 141 (1887), Chitty, J.

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

dissolved (*m*), and testifies its consent in such manner as the registrar requires.”

And the section further makes provision for a change of the name of any company which, through inadvertence or otherwise, is registered under a name which falls within the prohibition.

As Mr. Justice Buckley points out in his note to the section (*n*), it is to be observed (1) that it only applies to the case of taking the name of a subsisting company already registered, and not to a case like *Hendriks v. Montagu* (*o*), where a new company proposes to register in the name of, or in a name closely resembling, the name of an old-established company, which is not registered, or of a firm or individual trader (*p*); (2) that so soon as the new company is registered, the section has ceased to be applicable, so that the old registered company cannot found upon the section any claim for an injunction to restrain the newly registered company from trading under the name; (3) that the Act forbids registration in the same or a similar name, irrespective of the fact whether the business to be carried on under the name is the same or not.

But the provision of the section is merely in supplement of the ordinary rule upon which the Court acts in protecting trade-names, and that rule is in no way limited by the registration of the name objected to as the name of the defendant company (*q*). An injunction will therefore be granted to restrain the defendant from carrying on the same trade as that of the plaintiff under a name so nearly resembling his as to be calculated to deceive, whether it has been registered as the name of the defendant company or not, and, in the latter event, to restrain the defendants also from applying

The section is supplementary to the common law.

(*m*) For example, upon a reconstruction.

(*n*) Buckley on the Companies Acts, 7th ed. p. 27; see also Palmer's Company Precedents, 7th ed., Pt. I., pp. 265—267.

(*o*) 17 C. D. 638 (1881), Jessel, M. R., and C. A.

(*p*) *Hoby v. Grosvenor Library Co., Ltd.*, 28 W. R. 386.

(*q*) *Merchant Banking Co. of London v. Merchants Joint Stock Bank*, 9 C. D. 560 (1878), Jessel, M. R.; *Manchester Brewery Co., Ltd. v. North Cheshire and Manchester Brewery Co., Ltd.*, (1898) 1 Ch. 539; (1899) A. C. 83.

*Hendriks v.
Montagu.*

for registration of the name. In *Hendriks v. Montagu (r)*, the leading case on the point, the plaintiff, on behalf of the *Universal Life Assurance Society*, sued certain persons who were the promoters of an intended new company, to be called the *Universe Life Assurance Association*, and an injunction in the following form was granted:—

The injunction granted.

“To restrain the defendants from applying to the registrar of joint stock companies in England, for registration under the Companies Acts, of any company to be incorporated under the name of the *Universe Life Assurance Association*, or any other name likely to mislead or deceive the public into the belief that the company, being incorporated as aforesaid, is the same as the *Universal Life Assurance Society*, from issuing or publishing advertisements, circulars, or prospectuses representing that a company is to be incorporated pursuant to the Companies Act, 1862, under the name of the *Universe Life Assurance Association, Limited*, or any such other name as aforesaid; and from carrying on or commencing any business under the name of the *Universe Life Assurance Association, Limited*, or any such other name as aforesaid.”

The Master of the Rolls had refused the first branch of the injunction (as to the application to register), on the ground that no case could be made for granting it except under the section, and that the section did not apply, because the plaintiffs were not a registered company, and he had refused the second and third branches (as to advertising and carrying on business), on the ground that it was not shown that the defendants would carry on the same business as the plaintiffs, or that, if they did, the resemblance of the names must necessarily lead to the unfair appropriation by them of part of the plaintiffs' business; but the Court of Appeal overruled all these objections. The Lords Justices held that the defendants were shown to have threatened and intended to carry on the same business, and that it was morally certain that, if they did so under the name they had adopted, persons who had heard of the *Universal* would be misled into going to the

(r) 17 C. D. 638 (1881), Jessel, M. R., and C. A.

Universe. And this, the Court said, according to the rules of equity, was sufficient, without reference to the Act, to entitle the plaintiffs to the injunction they claimed.

The ground of the interference of the Court is, that the use of the defendant company's name, or its intended name, is calculated to deceive, and so to divert business from the plaintiff to the defendant, or to occasion a confusion between the two businesses. If this is not made out there is no case (*s*).

And the mere employment of a term which is descriptive of the business of both the parties, will not of itself be accepted as sufficient to make out the plaintiff's case (*t*). If it were it would give the first user a monopoly in the term. "If a company which does colonial business cannot call itself colonial, it is obvious that, under a species of assertion that the word colonial is symbolical, the plaintiffs might prevent every other person using it as descriptive of his trade" (*u*).

No monopoly allowed in names merely descriptive.

In *The Guardian Fire and Life Assurance Co. v. The Guardian and General Insurance Co.* (*x*), the plaintiff company were a very old-established institution, and were commonly known as *The Guardian* or *The Guardian Assurance Co.*, and the defendant company had been lately formed by the reconstruction of the *Guardian Horse and Vehicle Insurance Association*. They had assumed powers to carry on general insurance business, and their offices were near those of the plaintiffs, in Lombard Street. It was shown that there were two other companies doing some insurance business in other parts of London, under names comprising the word *guardian*; but notwithstanding this, Jessel, M. R., held, that the defendants' new name was calculated and intended to deceive, and

Cases of company trade-names.

(*s*) See the cases collected below.

(*t*) Cf. the rule against descriptive trade-marks, Chap. II., p. 36; Chap. VIII., p. 140; and as to infringement in similar cases, Chap. X., pp. 243, 244, and below, p. 476.

(*u*) *Per* Lord Romilly, in *The Colonial Fire Assurance Co. v. The Home and Colonial Assurance Co.*,

ltd., 33 Beav. 548; 33 L. J. Ch. 741 (1864); see also *India and China Tea Co. v. Teide*, W. N. (1871) 241, Jessel, M. R.; and *The Australian Mortgage, Land, and Finance Co. v. The Australian and New Zealand Mortgage Co.*, W. N. (1880) 6, C. A., cited p. 470.

(*x*) 50 L. J. Ch. 253 (1880), Jessel, M. R.

he would have granted an injunction had they not undertaken to call themselves the "Guardian Horse, Vehicle, and General Insurance Company."

Taking an existing name as a whole.

A new company will not be allowed to take the whole name of a subsisting company even though that name is of a descriptive character (*y*). Thus, where the Manchester Brewery Co., Ltd., had a brewery and a large business at Manchester, a new company which had acquired a brewery at Macclesfield with a business extending to Manchester, as well as other towns, attached to it, was restrained by the Court of Appeal from trading as the "North Cheshire and Manchester Brewery Co., Ltd." The decision was affirmed by the House of Lords on the ground that the use of the name would amount to a representation that the new company was an amalgamation comprising the business of the complainants (*y*).

Name suggesting an amalgamation.

Name comprising plaintiffs' trade-name.

In the *Eastman Co. v. the John Griffiths Corporation, Ltd.*, and the *Kodak Cycle Co., Ltd.*, the first-named defendants had promoted the Kodak Co., to which they gave a name comprising as its distinctive element the trade-name of the plaintiffs' goods, *Kodak*. Both defendants were restrained from carrying on business under the name Kodak Cycle Co., Ltd., or under any name comprising the word *Kodak* (*z*).

Assignments of trade-name to or by a limited company.

A limited company often becomes by purchase of a business entitled to a trade-name which is different from its registered name, and, provided that sect. 41 of the Companies Act is not violated, there seems to be no objection to its continuing the use of such a name in connection with its business (*a*), and it could, whether it had so used the name or not, if it had not abandoned it, prevent a person so using it as to represent that he was carrying on the business formerly carried on under the name; and, moreover, the company could sell the name with, of course, the goodwill (*b*).

(*y*) *Manchester Brewery Co., Ltd. v. North Cheshire, &c. Co., Ltd.*, (1898) 1 Ch. 539; (1899) A. C. 83.

(*z*) 15 R. P. C. 105 (1898), Romer, J. See the order below, p. 759.

(*a*) It would not, perhaps, be proper to use the name *qua* trade-

name alone, but such a use as Jones & Co., incorporated in Smith & Robinson, Ltd., would seem to be unobjectionable.

(*b*) *Townsend v. Jarman*, 17 R. P. C. 649 (1900), Farwell, J. As to the effect of contraventions of the section

Although a limited company could not, it is presumed, sell to a purchaser of its goodwill the whole of its registered name, yet a third person would not be permitted after the dissolution of a company to adopt its name except the word "limited," so as to lead to the belief that his business was that formerly carried on by the company (c).

Injunctions were granted in *Hoby v. The Grosvenor Library Co., Ltd.* (d), where the plaintiff's library was called the "Grosvenor Library," and in *The Accident Insurance Co., Ltd. v. The Accident, Disease, and General Insurance Co., Ltd.* (e), where the plaintiff company was popularly known as *The Accident Company* or *The Accident*; also in the cases specially mentioned above. Injunctions granted.

In the following cases injunctions were refused: *London and Provincial Law Assurance Society v. London and Provincial Joint Stock Life Assurance Co.* (f), although there was evidence that the former company was usually called the *London and Provincial Insurance Co.*; *London Assurance v. London and Westminster Assurance Corporation* (g); *Colonial Life Assurance Co. v. Home and Colonial Assurance Co., Ltd.* (h); *London and County Banking Co. v. Capital and Counties Bank* (cited in the next case); *Merchant Banking Co. of London v. Merchants Joint Stock Bank* (i); *The Army*

above referred to, see *Parks, Gunston & Tee, Ltd., v. Thompson, Talmey & Co.*, 18 R. P. C. 185 (1901), Farwell, J., on appeal the case was settled.

(c) *Montreal Lithographing Company v. Sabiston* (1890), A. C. 610, J. C., really supports this proposition, although the actual decision, which turned on the special facts of the case (see *Townsend v. Jarman*, 17 R. P. C. 649), was there in favour of the defendant, it being held that the mere use of the name was not, under the circumstances, calculated to deceive.

(d) 28 W. R. 386.

(e) 54 L. J. Ch. 104 (1884), Pearson, J.; see also *Wolmershausen v. G. S. Wolmershausen & Co., Ltd.*, W. N. (1892) 87, Chitty, J.;

Saunders v. The Sun Life Assurance Co. of Canada, (1894) 1 Ch. 537; 10 Times L. R. 183, Stirling, J.; and *Premier Cycle Co., Ltd. v. Premier Tube Co., Ltd.*, 12 T. L. R. 481 (1896), Chitty, J., interlocutory injunction granted against the use of *Premier* as part of the title of the defendant company, whose works had before the formation of the company for six years been known as "Premier Mills."

(f) 17 L. J. Ch. 37 (1848), Shadwell, V.-C.

(g) 32 L. J. Ch. 664 (1863), Stuart, V.-C.

(h) 33 Beav. 548; 33 L. J. Ch. 741 (1864), Romilly, M. R.

(i) 9 C. D. 560 (1878), Jessel, M. R.

and *Navy Co-operative Society, Ltd. v. The Junior Army and Navy Stores, Ltd.* (g); *Australian Mortgage Land and Finance Co. v. Australian and New Zealand Mortgage Co.* (h). In *Bamstead v. The General Reversionary Co., Ltd.*, an interlocutory injunction was refused, because, although the defendant company had adopted a name resembling that of the company of which the plaintiff was secretary, the General Reversionary and Investment Co., yet there was no probability of deception because the former was a small Liverpool concern, and the latter a very large London one (i).

The company may continue an established name.

A limited company formed to take over a business may adopt and use a name embodying a name under which the business has already been lawfully and properly carried on (k). This was fully recognized by Stirling, J., in the case of *Tussaud v. Tussaud* (l), where, however, the condition did not obtain. In that case an unsuccessful attempt was made by the defendant to shelter himself under the general exception to the principle stated at the head of this chapter, that anyone may honestly trade under his own name, which is discussed more fully below (m). The plaintiffs, Madame Tussaud and Sons, Limited, were the owners of a waxwork exhibition originally founded by a Madame Tussaud, and subsequently carried on by the father and uncles of the defendant. Their business was often referred to as *Madame Tussaud's*, and not infrequently as *Tussaud's* only. The defendant, who was a wax modeller by trade, was promoting a company to be called

(g) Seb. Dig. p. 393 (1879), Jessel, M. R.

(h) W. N. (1880) 6, C. A., James, L. J., said: "The difficulty in these cases was, that while the business name of another could not be appropriated, a man could not, on the other hand, give himself any monopoly in a name which, as in this case, merely described the nature of the business or the locality of its operations"; see above, p. 467.

(i) 4 Times L. R. 621 (1888), Stirling, J.

(k) In *S. Chivers & Sons v. S. Chivers & Co., Ltd.*, 17 R. P. C. 420 (1900),

Farwell, J., said, at p. 426: "To my mind, no element of suspicion of fraud attaches to a man who has established a business under his own name if he turns that business into a limited company, and applies to that limited company his own name with the word "limited," because the reason for doing so is obvious, that he desires to retain the goodwill which he has gained for that name."

(l) 44 C. D. 678 (1890), Stirling, J.; *Rendle v. Rendle & Co.*, 63 L. T. 94 (1890), Kay, J., is a somewhat similar case.

(m) Page 500.

Louis Tussaud, Ltd., to open and carry on a waxwork exhibition under that name in Shaftesbury Avenue, the plaintiffs' exhibition being situated in the Marylebone Road. He was to be engaged as manager of the exhibition and modeller of the exhibited figures. He had never carried on, and did not possess the goodwill of, any business in any such exhibition.

It follows, said the learned judge, "from the decisions in *Burgess v. Burgess* (n) and *Turton v. Turton* (o), that the defendant is at perfect liberty to open on his own account, and to carry on in his own name, an exhibition of waxworks. Further, he might take partners into his business, and carry it on under the name *Louis Tussaud & Co.* That seems to me to have been expressly decided in *Turton v. Turton*. Having commenced business on his own account, I apprehend that he might sell it with the benefit of the goodwill to third parties, and that the third parties might, if they thought fit, continue to carry on the business under the same name—that of the defendant; that is to say, they would be entitled to the full benefit of the goodwill which they had honestly and legitimately purchased from the defendant. Again, the third parties might transfer the business and the goodwill to a joint stock company, and (without expressing a final opinion on the point) I am not prepared at present to say that that company might not be registered under the same name as had previously been used in connection with the business" (p).

The judgment
of Stirling, J.

But the defendant could not, it was held, sell the right to use his name in connection with a business which he had never carried on, and in which he had no interest whatever, or in which he stood simply in the position of a paid servant (q). And the proper inference to be drawn from the facts of the case *prima facie* was, the learned judge concluded, that the object of the defendant in promoting the proposed

Right to use a
name not
attached to
any goodwill
cannot be
sold.

(n) 3 D. M. & G. 896; 22 L. J. Ch. 675 (1853), Knight-Bruce and Turner, L. JJ., cited p. 501.

(o) 42 C. D. 128 (1889), C. A., reversing North, J., cited p. 508.

(p) 44 C. D. p. 687.

(q) Cf. *The Birmingham Vinegar Brewery Co. v. The Liverpool Vinegar Co.*, *supra*, p. 464; and *Warner v. Warner*, 5 Times L. R. 327, 359 (1869), Stirling, J., and C. A., (*Warner's Cure*); and see below, p. 511.

company was to induce the world to believe that the business intended to be carried on was that of the plaintiff company or a branch of it, notwithstanding that the prospectus issued by the defendant plainly stated on the face of it that the new exhibition had no connection with the plaintiff company. An interim injunction in the terms of that in *Hendriks v. Montagu* (r), set out above, was accordingly granted.

In three cases which subsequently came before the Courts attempts appear to have been made to carry through the series of operations indicated in the judgment just cited, but in each instance the defence which might have been founded upon them was displaced by evidence of deliberate fraud.

Brinsmead & Co. v. T. E. Brinsmead, Ltd.

In *The Brinsmead Case* (s), the plaintiffs were the well-known firm of pianoforte makers. T. E. Brinsmead and his sons, who were relatives of the partners, and had been in their employment, started a small independent business as "T. Brinsmead & Sons." They were restrained from trading under the name Brinsmead without using their full names, and they then promoted the defendant company under the name of "Thomas Edward Brinsmead & Sons, Ltd.," with the fraudulent intention of getting some of the plaintiffs' business. By the use of this name they induced the public to subscribe for shares in the belief that the company possessed the plaintiffs' business. The defendants were restrained from using the name Brinsmead in connection with pianos without an express statement that they had no connection with the plaintiffs' firm.

No connection.

Pinet et Cie. v. Maison Pinet, Ltd.

In *Pinet's Case* (t), a man who had carried on business in special boots for lame persons as "Maison Pinet," assigned his business to a company called "Maison Pinet, Ltd." The French firm of Pinet et Cie. complained of this, but the defendants contended that they intended only to trade in the special boots, and on that ground Kekewich, J., refused an interlocutory injunction. The Court of Appeal did not

(r) *Ante*, p. 466.

(s) *John Brinsmead & Co. v. Thomas Edward Brinsmead & Sons, Ltd.*, 12 Times L. R. 631; 13 *ibid.* 3 (1896), North, J., and C. A. The facts

appear in *Re T. E. Brinsmead & Sons, Ltd.*, (1897) 1 Ch. 45, 406.

(t) *Pinet et Cie. v. Maison Pinet, Ltd.*, 14 R. P. C. 933 (1897), C. A.

believe the defendants' story, and granted the injunction restraining them from carrying on their business in boots under the name Pinet without clearly distinguishing their boots from those of the plaintiffs. Subsequently it was discovered that the vendor to the defendant company had assumed the name Pinet for the purpose of defrauding the plaintiffs, and an injunction was then granted forbidding the use of the name by the defendants, and forbidding the liquidator of the company selling the right to use the name in connection with boots (u).

And in *Valentine's Case* (v) the Court of Appeal came to the conclusion that there had been an attempt to get the benefit of the plaintiffs' reputation, and in addition to relief in respect of passing off, they restrained the defendant company from carrying on the business of manufacturers of extract of meat under any name of which *Valentine* formed part.

A trader has the same rights in respect of the name of the house, shop (x), or factory (y), where he carries on his trade or business, as he has in respect of his trade-name. He can, therefore, support an action for passing off, and obtain an injunction by showing that the name of the house, &c., has a reputed connection with his trade or business or goods, and that the defendant, without having any independent right to

Name of
business,
house, or
factory.

(u) *Pinet et Cie. v. Maison Louis Pinet, Ltd.*, 15 R. P. C. 65 (1898), North, J.

(v) *Valentine Meat Juice Co. v. Valentine Extract Co., Ltd.*, 17 R. P. C. 673, 83 L. T. 259 (1900), C. A. The facts will be found more fully set out below, p. 506.

(x) *Hudson v. Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C. (*Osborne House*); *Boulnois v. Peake*, 13 C. D. 512, n. (1868), Giffard, V.-C. (*The Carriage Bazaar*); *Bodega Co. v. Owens*, 6 R. P. C. 236; 7 *ib.* 31; 23 L. R. Ir. 371 (1889), Chatterton, V.-C. (*Bodega Wine*

Shop). A number of American decisions are cited by Mr. Sebastian, 3rd ed., p. 294, 4th ed., p. 270. In *Charleston v. Campbell*, 4 Sess. Cas. 4th ser. 149 (1876), an injunction to restrain the use of the "Royal Station Hotel," at the instance of the proprietor of the "Station Hotel," was refused, because the title was merely descriptive.

(y) *Braham v. Beachim*, 7 C. D. 848 (1878), Fry, J. (*Radstock Colliery*); *Montgomery v. Thompson*, 41 C. D. 35; (1891) A. C. 217; 8 R. P. C. 361, Chitty, J., C. A., and H. L. (*Stone Brewery*).

do so (s), is using for business purposes a name which is calculated to cause his trade, business, or goods to be taken for, or to be confounded with, the plaintiff's (a). There is no right to the exclusive use of the name of a mere private house (b), and no cause of action arises where, although the defendant has adopted, for business purposes, an address likely to be confused with that of the plaintiff, yet the businesses of the parties are so different that no damage can result to the plaintiff's trade (c).

If the name in question is taken from a building where a firm carries on business, it may be that on the removal of the firm the name still attaches to the building and may properly be used by the next tenant. The question appears to be one of fact (d).

(z) In *Mason v. Queen*, 23 Scot. L. R. 641 (1886), the Lord Ordinary held that the goodwill and trade-name of an hotel could not be transferred so as to entitle the transferee to stop a new occupier of the building from using the old name. The "Waverley Hotel," Glasgow, was taken by a railway company under compulsory powers in May, 1884, compensation being paid for loss of business. The proprietor, who had other "Waverley Hotels" in London and Edinburgh, transferred the goodwill and the right to use the name to the plaintiff, who thereupon changed the name of her own house to "Waverley," and put up a notice of removal upon the old building. In January, 1885, the railway company let the old building to the defendant, who opened it as the "Old Waverley." Held: (1) the plaintiff had no exclusive right to the name, and (2) (but *quere* on the special facts) there was no case of passing off. See also *Nicholson v. Buchanan*, Sol. Jo., vol. 44, p. 408 (1900), where a firm who were the owners of a business and distillery, sometimes known as "the Black Swan Distillery," which had had a

figure of a black swan outside, and who also had a black swan for a trade-mark, sold first the premises to the defendants, and subsequently the goodwill and trade-mark to the plaintiffs. The vendors had been known chiefly for gin, whereas the defendants carried on business on the premises in Scotch whisky, no distilling being done there. On the evidence it was held that there was no probability of deception, and the action in which the plaintiffs complained of the use of the words "Black Swan" and the device was dismissed. As to the assignment of marks having a local connotation, see above, p. 328.

(a) See note (x) above.

(b) *Day v. Brownrigg*, 10 C. D. 294 (1878), C. A.

(c) *Street v. Union Bank of Spain and England*, 30 C. D. 156 (1885), Pearson, J.; the plaintiffs were advertising agents (telegraphic cypher).

(d) See *Mason v. Queen*, *Nicholson v. Buchanan*, *supra*, note (z), and *Charleston v. Campbell*, *supra*, note (x); *Booth v. Jarrett*, 52 How. Pr. 169 (1876), New York ("Booth's Theatre"); and *Sebastian*, 4th ed., p. 272.

B. The Trade-name of the Plaintiff's Goods.

A name which is applied or attached to a trader's goods when they are offered for sale, so as to distinguish them from similar goods, and to identify them with him, or with his successors as the owners of a particular business, as being made, worked upon, imported, selected, certified, or sold by him or them, is a trade-mark (*e*). And if it is within any of the classes enumerated in sect. 64, it may be registered as a trade-mark. But whether or not the name is applied or attached to the goods, so as to conform to the definition just stated, or registered as a trade-mark, if it is in fact known in the market as the distinctive name of the goods of a particular trader, no one else may use it for dealings in other goods of the same class as those in connection with which it has acquired its distinctive signification.

The acquisition of a trade-name by the use of it in connection with the sale of, or with dealings in, goods has already been considered, and the authorities bearing on the subject have been collected in the chapter on the definition of a trade-mark. It will be sufficient, therefore, to summarize shortly the results deduced from the reported cases.

The qualified right in the trade-name,—a right to prevent a defendant from passing off his goods as those of the plaintiff by the use of it,—exists only with regard to goods of the kind for which the plaintiff uses it, and to which the connection with his business suggested by the use of the name extends (*f*). So, where the proprietors of *The Morning Post* sought to restrain the publishers of a new evening newspaper from calling their paper *The Evening Post*, the Court of Appeal, holding, as an inference of fact, that there was no probability of the defendant's paper being taken for the plaintiff's, or being taken to have any connection with it so as to cause damage to the plaintiffs, dismissed the action (*g*). But if the name, although not actually used by

Right restricted to particular goods or business.

The Evening Post Case.

(*e*) Chap. II., p. 24.

(*f*) Page 31; and cf. the rule in respect of the infringement of trade-marks, Chap. XV., p. 366.

(*g*) *Borthwick v. The Evening Post*, 37 C. D. 449 (1888), C. A., overruling *Kay, J.*; but see *Re The Australian Wine Importers, Ltd.*, 41 C. D. 278;

the plaintiff for the particular kind of goods to which the defendant has applied it, is so identified with the plaintiff that the defendant's use of it will induce the belief that his goods are those of the plaintiff, or that his business is an extension of (*h*), or an amalgamation with (*i*), or is otherwise connected with the plaintiff's business, and will thereby cause substantial damage to the plaintiff, an injunction may be granted (*h*), and possibly a prospective interference with the natural and probable extension of the plaintiff's business would be sufficient (*k*) ground to entitle the plaintiff to relief.

The name may be used on the right goods.

It must be distinctive of the plaintiff's goods;

Anyone may use the name in connection with goods which are in fact the goods of the plaintiff (*l*).

It is the essence of the plaintiff's case that the use of the name should be understood in the market to imply that the goods sold or dealt in under it are his goods (*m*).

In *The Two D. Case* (*n*), Herschell, L. C., said, the foundation of a passing off case "is that the party alleging it should prove, in the first instance, that any name which he claims as his trade-name has been so extensively used in

6 R. P. C. 311 (1889), Kay, J., and C. A., where a mark for wine was refused registration, as too closely resembling a mark for spirits, and the Court left open the question whether its use would amount to infringement or passing off; and other cases, cited above, p. 217. Injunctions were granted in *Walter v. Emmott*, 54 L. J. Ch. 1059 (1885), C. A. (*The Morning Mail*), and *Reed v. O'Meara*, 21 L. R. Ir. 216, V.-C. (*The Grocer*).

(*h*) *Eastman, &c. Materials Co. v. John Griffiths' Corp., Ltd.*, 15 R. P. C. 105 (1898), Romer, J. The plaintiff company dealt in photographic materials, and sold *Bicycle Kodak* cameras. *Kodak* was their trade-name. The defendants were restrained from selling *Kodak Cycles*. Romer, J., said it would lead to confusion and to deception, and

would be injurious to the plaintiff company. See further as to this case, above, pp. 218, 256, n., and 468.

(*i*) See *Manchester Brewery Co. v. North Cheshire, &c. Co.*, above, p. 468.

(*k*) See the cases last cited, and per Lord Watson in *Eno v. Dunn*, 15 App. Ca. at p. 258. In an American case, *Celluloid Co. v. Reed*, 47 Fed. Rep. 712; Cox, p. 509, the judge said the prospect that the complainant will in future want to manufacture starch, is too shadowy to base an injunction upon. But the suggested extension was there improbable in fact.

(*l*) Pages 22 and 368; and *Ainsworth v. Walmesley*, L. R. 1 Eq. 518 (1866), Wood, V.-C., cited p. 454.

(*m*) Page 34.

(*n*) *Leahy, Kelly and Leahy v. Glover*, 10 R. P. C. p. 155 (1893), H. L.

connection with his manufacture or with the goods which he sells, that his goods have come to be known in the market by that name; that anyone using that name would intend to refer to his goods; and that anyone to whom the name was used would understand that his goods were referred to."

Hence the critical question of fact in cases under this head is often whether a word or term is the distinctive name of the plaintiff's goods, or is the name of anybody's goods of the kind (o), like *Liebig's Extract* (p), *Chlorodyne* (q), *Linoleum* (r), *Wellington Boots*, *Gladstone Bag*, *Hansom Cab*, and *Vaseline* (s), or a mere description of the goods, denoting only their pattern (t), mode of manufacture (u), or sale (v), ingredients (x), or place of origin (y), or the use for which they are intended.

Words and terms which *primâ facie* are merely descriptive in the sense just explained may, however, acquire by

not the mere name of the goods.

Descriptive names may have a secondary distinctive meaning.

(o) See pp. 36 and 243 *et seq.*

(p) *Liebig's Extract of Meat Co., Ltd. v. Hanbury*, 17 L. T. n.s. 298 (1867), Wood, V.-C.; *Liebig Co. v. Anderson*, 55 L. T. 206 (1887), Chitty, J.; and cf. *Same v. Chemists' Co-operative Society, Ltd.*, 13 R. P. C. 736.

(q) *Browne v. Freeman*, (1) 12 W. R. 305 (1864), Wood, V.-C.; (2) W. N. (1873) 178, L. J.J.

(r) *Linoleum Manufacturing Co. v. Nairn*, 7 C. D. 834 (1878), Fry, J.

(s) *Cheseborough Co.'s Tms.*, 18 R. P. C. 191 (1901), Buckley, J.

(t) *Ford v. Foster*, L. R. 7 Ch. 616 (1872), L. J.J. (*Eureka Shirts*); *Hirst v. Denham*, L. R. 14 Eq. 542 (1872), Bacon, V.-C.; *Harrison, McGregor & Co.'s Tm.*, 42 C. D. 691; 7 R. P. C. 25 (1889), Kekewich, J. (*Albion Mowers*); *Winser v. Armstrong*, 16 R. P. C. 167 (1899), Byrne, J. (*Winser Interceptors*); and see *Talbot v. Webley*, 3 R. P. C. 276 (1886), Bacon, V.-C. (*Baffle Safes*).

(u) *Singer Manufacturing Co. v. Wilson*, 2 C. D. 434; 3 App. Ca.

376 (1875); *Id. v. Loog*, 18 C. D. 395; 8 App. Ca. 15 (1877); *Id. v. Spence & Co.*, 10 R. P. C. 297 (1893), Romer, J. (*Singer System, Singer Sewing Machines*), cited *ante*, p. 38.

(v) *Symington v. Footman*, 56 L. T. 696 (1885), Kay, J. (*Guaranteed Corset*).

(x) *Massam v. Thorley's Cattle Food Co.*, 14 C. D. 748 (1880), C. A.

(y) *McAndrew v. Bassett*, 4 De G. J. & S. 380; 33 L. J. Ch. 561 (*Anatolia Liquorice*); *Seixo v. Provezende*, L. R. 1 Ch. 192 (*Seixo Wine*); *Wotherspoon v. Currie*, 5 L. R. H. L. 508 (*Glensfield Starch*), all cited pp. 47 to 50; see also *The Reading Biscuit Case, Huntley & Palmer v. The Reading Biscuit Co., Ltd.*, 10 R. P. C. 277 (1893), Chitty, J.; and *The Rugby Portland Cement Case, Rugby Portland Cement Co., Ltd. v. The Rugby and Newbold Portland Cement Co.*, 8 R. P. C. 241; 9 R. P. C. 46 (1891), V. Williams, J., and C. A., and *Bewlay v. Hughes*, 15 R. P. C. 290 (1898), North, J. (*Dindigul Cigars*).

use and reputation a secondary distinctive meaning (z), so that, although no longer treated as trade-marks proper, even where they are used as such, and not admitted, unless as old marks, to registration under the Acts, they may be practically monopolized for use in connection with certain classes of goods by a particular trader, since their employment by anyone else would be calculated to deceive (a). "I take it to be clear from the evidence," Lord Westbury said, in *The Glenfield Starch Case* (b), "that long antecedently to the operations of the respondent, the word *Glenfield* had acquired a secondary signification or meaning in connection with a particular manufacture—in short, it had become the trade denomination of the starch made by the appellants. It was wholly taken out of its ordinary meaning, and in connection with starch had acquired that peculiar secondary signification to which I have referred. The word *Glenfield*, therefore, as a denomination of starch, had become the property of the appellants."

And in the *Camel Hair Belting Case* (c) Lord Herschell said: "The name of a person, or words forming part of the common stock of language, may become so far associated with the goods of a particular maker that it is capable of proof that the use of them by themselves without explanation or qualification by another manufacturer would deceive a purchaser into the belief that he was getting the goods of A. when he was really getting the goods of B. In a case of this description the mere proof by the plaintiff that the defendant was using a name, word, or device which he had adopted to distinguish his goods would not entitle him to any relief. He could only obtain it by proving further that the defendant was using it under such circumstances or in such manner as to put off his goods as the goods of the plaintiff" (d).

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

(a) See the cases cited in the last three notes, and *Montgomery v. Thompson*, 41 C. D. 35; (1891) A. C. 217; 8 R. P. C. 361 (*Stone Ales*).

(b) See above, note (y), p. 477.

(c) *Reddaway v. Banham*, (1896) A. C. 199, at p. 210; 13 R. P. C. at p. 228.

(d) Cf. the decisions on the expression "fancy word not in common use" in the Act of 1883, above,

It follows that where a word, which is not a "fancy word" (*d*), but is *prima facie* descriptive, is claimed as his trade-name by the plaintiff, he must show that its original or apparent meaning has been wholly lost, or does not exist, "amongst those who are purchasers of the goods" in question (*e*) within a definite area. Such area must (probably) extend to at least the whole of England and Wales (*f*). If the word still continues to be used and understood with its original descriptive meaning by any considerable section of such persons, it cannot be monopolised (*g*). And the more appropriate the words claimed are as a description of the goods or of some characteristic of the goods, the greater is the burden of proof required from the plaintiff (*h*).

Descriptive meaning must be lost.

The question of fact which has to be answered in the cases under consideration has, accordingly, a negative as well as an affirmative part (*i*).

The question for the jury.

p. 158. The current use of the term "fancy word" is as an antithesis to "descriptive," or *prima facie* descriptive word. See the judgments in the *Cellular Cloth Case* cited below. *Yorkshire Relish* was referred to as a "fancy word," although it could not have been registered under the Act: see (1896) 2 Ch. p. 92, 13 R. P. C.

(*e*) This was Lord Herschell's phrase in *Reddaway v. Banham*, (1896) A. C. at p. 208; 13 R. P. C. at p. 227.

(*f*) *S. Chivers & Sons v. S. Chivers & Co., Ltd.*, 17 R. P. C. 420 (1900), Farwell, J. The learned judge expressed the rule by saying that the secondary meaning must be "locally universal." He did not think that the area need necessarily comprise Scotland in order to establish a case in the English Courts.

(*g*) *Parsons v. Gillespie*, (1898) A. C. 239; 15 R. P. C. 57, P. C. (*Flaked Oatmeal*); *Cellular Clothing Co., Ltd. v. Maxton*, (1899) A. C. 326; 16 R. P. C.

397, H. L. See also the judgments in the Court of Session in the last case, 15 R. P. C. 581.

(*h*) "The *Camel Hair Belting Case* may be an example of what, under ordinary circumstances, it would be very difficult to establish." Per Halsbury, L. C., in the *Cellular Clothing Case*, (1899) A. C. at p. 336; 16 R. P. C. at p. 405.

(*i*) In his direction to the jury in *A. W. Gamage, Ltd. v. H. E. Randall, Ltd.*, 16 R. P. C. 185 (1899), at p. 196, Russell, L. C. J., said: "The first point is, have Gamages made out to your satisfaction that *Shorland* means a buckle and strap shoe sold by Gamage & Co. *exclusively*, so that the person who sold the shoe under the name of *Shorland* would be passing off as Gamages' what was not Gamages', but his own, and so that a person buying it would believe that he was getting Gamages' and not the shoe of the man who sold it to him." This was approved by the C. A. In *Reddaway v. Banham*,

The possibility of proving that a word which is *prima facie* descriptive is in reality a trade-name is not an exception to the well-settled rule that no case of passing-off can be made out merely by showing that the defendant has adopted and used a descriptive or other "open" word previously used by the plaintiff (*k*). Any trader is entitled to affix a true description to his goods in ordinary language; but if words are used which have lost their ordinary descriptive meaning and have acquired a new meaning which is not descriptive, they no longer constitute a true description (*l*).

(1895) 1 Q. B. 280; (1896) A. C. 199; 12 R. P. C. 83; 13 R. P. C. 218, the questions put to the jury were:—1. Does *Camel Hair Belting* mean belting made by the plaintiffs as distinguished from belting made by other manufacturers? (*Answer, Yes.*) 2. Or does it mean belting of a particular kind without reference to any particular maker? (*Answer, No.*) 3. Do the defendants so describe their belting (*i.e.*, by using the term) as to be likely to mislead purchasers, and to lead them to buy the defendants' belting as and for the belting of the plaintiffs? (*Answer, Yes.*) 4. Did the defendants endeavour to pass off their goods as and for the goods of the plaintiffs, so as to be likely to deceive purchasers? (*Answer, Yes.*) Upon these findings, Collins, J., gave judgment for the plaintiffs; the Court of Appeal reversed the judgment on the ground that the term was descriptive; but the House of Lords restored it. It appears from all the judgments that the fourth question was superfluous.

(*k*) *Kelly v. Byles*, 13 C. D. 682 (1880), Bacon, V.-C., and C. A. (*Post Office Directory*); *Schove v. Schmincke*, 33 C. D. 546 (1886), Chitty, J. (*Castle Album*); *Great Tower Tea Co. v. Smith*, 6 R. P. C. 165; 5 T. L. R. 232 (1889), North, J.

(*Tower Tea*); *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J. (*Washerine*); *Rugby Portland Cement Co., Ltd. v. Rugby and Newbold Portland Cement Co. Ltd.*, 8 R. P. C. 241; 9 R. P. C. 46 (1891), Vaughan Williams, J., and C. A. (*Rugby Portland Cement*); *The Colonial Fire Assurance Co. v. The Home and Colonial Assurance Co., Ltd.*, above, p. 469; *Magnolia Metal Co. v. Atlas Metal Co.*, 14 R. P. C. 389, Collins, J., and C. A. (1897) (*Magnolia Metal*); *Parsons v. Gillespie and Cellular Clothing Co., Ltd. v. Maxton*, above, p. 479, note (*g*).

(*l*) In *Reddaway v. Banham*, (1896) A. C. at p. 212; 13 R. P. C. at p. 229, Lord Herschell said: "I rather demur, however, to the statement of James, L. J., that the defendant in *Wotherspoon v. Currie* (above, p. 49) was not telling a lie in calling his starch *Glenfield Starch*, as I do to the view that the defendants in this case were telling the simple truth when they sold their belting as camel-hair belting. I think the fallacy lies in overlooking the fact that a word may acquire in a trade a secondary meaning differing from its primary one, and that if it is used to persons in the trade who will understand it in its secondary sense, it will be none the less a falsehood that in its primary sense it

It will be useful to contrast the evidence in some of the recent cases in which the plaintiffs succeeded with that in others in which they failed. In *Reddaway v. Banham* (*m*), although it was admitted that the yarn of which the belting was made consisted for the most part of camel hair (*n*), it was shown that the name camel-hair belting had never been current as a description in the trade, a number of other names being used, and there was evidence that the defendant had adopted the name in order to deceive purchasers, and that he was likely to succeed in deceiving them by its use. In *Powell v. The Birmingham Vinegar Brewery Co.* (*o*), numerous wholesale and retail grocers, export agents, travellers, sauce-makers and purchasers, and scientific witnesses were called, and the effect of their evidence, stated shortly, was that if a purchaser asked for Yorkshire Relish he would expect to get the plaintiffs' sauce. There was also evidence of actual deception (*p*). In this case, as there was no other maker of the sauce but the plaintiffs themselves, the defendants' (*q*) sauce being a clever imitation, but not the same thing, it was inevitable that the name should indicate the plaintiffs' goods. This circumstance might have gone some way to displace the plaintiffs' evidence, as in the case next cited, if the defendants had been prepared to sell the goods which, according to their own contention, were described by the name.

On the other hand, in *Parsons v. Gillespie* (*qq*), a number of

may be true." Lord Macnaghten said (at p. 219; 13 R. P. C. at p. 233): "At Banham's works, where it cannot mean Reddaway's belting, it may be construed to mean belting made of camel's hair; abroad, to the German manufacturer, to the Bombay mill-owner, to the up-country native, it must mean Reddaway's; it can mean nothing else. I venture to think that a statement which is literally true, but which is intended to convey a false impression, has something of a faulty ring about it; it is not sterling coin; it has no right to the genuine stamp and impress of truth."

(*m*) Above, p. 478. See the findings of the jury, p. 479, note (*i*).

(*n*) Cf. the earlier case, *Reddaway v. Bentham Hemp Co.* (1892), 2 Q. B. 639; 9 R. P. C. 503, C. A., where there was no such admission.

(*o*) (1894) 3 Ch. 449; 11 R. P. C. 563, interlocutory injunction; (1896) 2 Ch. 54; (1897) A. C. 710; 13 R. P. C. 235; 14 R. P. C. 710, Stirling, J., C. A. and H. L.

(*p*) (1896) 2 Ch. p. 57.

(*q*) Above, p. 459.

(*qq*) See (1898) A. C. p. 254; 15 R. P. C., p. 62.

Secondary meaning not acquired while no competition.

grocers proved that when asked by their customers for "Flaked Oatmeal" they supplied the plaintiff's goods; but there was no evidence of actual deception or confusion, and the value of the evidence first mentioned was discounted by the fact that it wholly or chiefly referred to a period when there were no other goods of the kind in question in the market besides the plaintiff's goods. In *The Cellular Clothing Co., Ltd., v. Maxton (r)*, the plaintiffs' evidence consisted of (a) their own advertisements, in which they used the word "cellular" to describe their cloth, but did not suggest that its use distinguished their cloth from cloth of a similar description made by others; (b) statements of witnesses who said that they understood "cellular goods" to mean the goods of the plaintiffs, but who did not say that they knew of any other manufacturers making similar classes of goods; and (c) consent orders for injunctions obtained against other persons who had used the name. In both of these cases the plaintiffs failed.

In *A. W. Gamage, Ltd., v. H. E. Randall, Ltd. (s)*, where the plaintiffs were retail shopkeepers, a mass of evidence was called on both sides. The plaintiffs relied principally on the evidence of purchasers, of retail dealers, and of writers in trade newspapers; the defendants principally on that of wholesale dealers. It was admitted that there were in the market shoes of the same pattern as the shoes in question made by other makers, but it was proved that the plaintiffs invariably used, besides their alleged trade-name, a stamp bearing the name of the company. Some of the plaintiffs' witnesses admitted that if they saw the name without the stamp they would not think the goods were the plaintiffs'. The jury found for the defendants, being possibly influenced by the admission just mentioned, and the Court of Appeal refused to disturb their verdict (*t*).

(*r*) See (1899) A. C. at p. 345: 16 R. P. C. at p. 410. n. (*i*).

(*s*) 16 R. P. C. 185 (1899), Russell, L.C.J., and C. A. (*The Shorland Cycling Shoe*). See above, p. 479,

(*t*) Further illustrations will be found under the heading, "Right to use a man's own name," below, p. 500.

The name of the inventor or first introducer of goods which are new to the market, or the name which he gives to those he manufactures or sells, is very readily adopted as the name of goods by whomsoever they are made; and in the case of goods made under a patent, the Court is careful not to extend the patentee's monopoly by forbidding other manufacturers, after the patent has expired, to sell goods lawfully made by them according to its specification under the only name by which they are known (*u*).

Name of
introducer or
patentee.

In *James v. James* (*x*), Romilly, M. R., said that anyone who was possessed of the secret of an invention might make the goods according to it, and might sell them under the name of the inventor after his death, but might not sell them in his lifetime, so as to suggest that they were made by him. But the distinction here suggested was questioned by James, L. J. (*y*), in a later case, for the death of the inventor would not necessarily prevent the use of his name being calculated to pass off the goods of others as goods manufactured in the business lately carried on by him, if his successors were continuing the business; and, on the other hand, during his lifetime, if there was no monopoly in the manufacture, anyone might state that the goods were made according to his system. It is material also to remember that the name of the first maker or inventor is often understood to imply the good quality of work or materials which has brought the new goods into favour rather than the mode of manufacture or the nature of the ingredients employed (*z*). Where this is the case the use of the name by traders who have no connection with him must almost always be calculated to deceive.

On the other hand, names which once carried a distinctive reference to a particular trader may, in consequence of successful piracies, or of their use by the trader himself for goods which are the goods of others, or are put forward as such (*a*),

Names may
become *publici
juris*;

(*u*) See Chap. II., p. 43.

(*x*) L. R. 13 Eq. 421 (1872) (*Lieutenant James' Horse Blister*).

(*y*) *Massam v. Thorley's Cattle Food Co.*, 14 C. D. p. 754 (1880).

(*z*) See the last case; and cf. the use of "original," above, p. 47.

(*a*) *Wood v. Butler*, 32 C. D. 247;

3 R. P. C. 81 (1886), C. A. (*Eton Cigarettes*). See also *Wolff v.*

Nopitsch, 17 R. P. C. 321 (1900),

Cozens-Hardy, J.; 18 R. P. C. 27

(1901), C. A.

or for other reasons, lose it and fall into common use and become *publici juris* (b), in the same way as trade-marks may be lost or abandoned.

or become associated with another trader.

Further, as the question is, What is the meaning of the name for the time being? it is possible for a word which has at one time been the trade-name of one trader to become so identified with the goods of a rival trader as afterwards to become the trade-name of the latter (c), who may thereby acquire an exclusive right to its use (c), or, if its association with the original owner has continued, a right concurrent with his right (d).

Disclaimed word.

A word, or other particular, forming part of a registered label or other trade-mark, and which the plaintiff has disclaimed as a condition of registration, is, it would appear, necessarily open, and the plaintiff cannot be heard to allege that it by itself forms a distinctive mark (e). The same rule does not hold good of a word or particular which has been expunged from the Register, even though it was expunged without the plaintiff's assent, for the removal of the mark does not prevent the plaintiff from showing that the mark is, nevertheless, distinctive of his goods (f). It has already been shown that a trade-mark which has never been registered, or which has been removed from the Register, may be the basis of a passing off case (g).

Expunged trade-mark.

(b) Chap. II., p. 37; and Chap. XIV., p. 338.

(c) *Daniel & Arter v. Whitehouse*, (1898) 1 Ch. 685; 15 R. P. C. 134, Gorell Barnes, J. (*Brazilian Silver*); cf. next case.

(d) *Edge & Sons, Ltd. v. Gallon & Son*, 16 R. P. C. 509 (1899), C. A. (*Dolly Blue*).

(e) *Rosenthal v. Reynolds*, (1892) 2 Ch. 301; 9 R. P. C. 189, North, J. (*W. R. Corsets*), interim injunction refused, *ante*, pp. 209 and 244. This was not followed by the Scotch Court in *Bayer v. Baird*, 15 R. P. C. 615 (1898) (*C. B. Corsets*). Might not the plaintiff show, at any rate, that the word has acquired a distinctive meaning after the registration?

(f) See the *Yorkshire Relish* (above, pp. 459 and 481) and *Stone Ale* (above, p. 318) cases.

(g) Above, p. 450; Chap. XII., p. 317. In *Paine & Co. v. Daniells & Sons' Breweries Co., Ltd.*, (1893) 2 Ch. 567; 10 R. P. C. 217 (*John Bull Beer*), the C. A. assumed that the plaintiffs must fail if their trade-mark were expunged from the Register, although the action was brought, not only in respect of infringement, but also in respect of passing off. But the case was a peculiar one, for the only matter which led the Court to think the defendants' conduct was calculated to pass off their goods as those of the plaintiffs, was the use by the

But an open word, that is to say, a non-distinctive word, or open words, may be an important element in the plaintiff's labels, and the use of the same word or words by the defendant in the same manner, especially if coupled with the use of other details of "get-up" which are similar to those which the plaintiff uses, may be strong evidence to support a passing off case based upon imitation of get-up (*h*).

Use of common word by defendant may be an element in a get-up case.

This was pointed out by Wood, V.-C., in *Woollam v. Ratcliff* (*i*), where, in commenting upon *The Omnibus Case* (*k*), he said: "The words *Conveyance Company*, the green omnibus, &c., were held sufficient together to entitle the plaintiffs to an injunction. The defendant might have had those words painted on a yellow omnibus without objection, and so of the other resemblances; the wrong lay in their accumulation, not in any one of them alone."

In the case of trade-names which are *primâ facie* geographically descriptive, a special order has sometimes been made in order to avoid any interference with the honest and proper use of them by persons other than the owner of the trade-name. Thus, in *Braham v. Beachin* (*l*), the plaintiff, being owner of all the collieries in Radstock, except a very small one, traded as the "Radstock Coal Co.," and the defendants began to sell coal under the same name, and also as "The Radstock Colliery Proprietors." An injunction was granted, "to restrain the defendants, unless and until they shall acquire a colliery or coal mine within the parish of Radstock, from trading under, or using, the name or style of 'The Radstock Colliery Proprietors,' or any other name or style signifying that the defendants or either of them are proprietors of any colliery or collieries at Radstock." Subsequently the defendants

Geographical names.

defendants of a label, bearing the words *Registered* and *John Bull*, whereas, in fact, the only registered John Bull mark was that of the plaintiffs.

(*h*) As in *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A. (*Sunlight Self-Washer*, and *Goodwin's Self-Washing*

Soap); and see the report of Lord Herschell's Committee on disclaimed additions, Chap. IX., p. 198.

(*i*) 1 H. & M. 259 (1863).

(*k*) *Knott v. Morgan*, 2 Keen, 213 (1836), Lord Langdale, M. R., and Cottenham, L. C.

(*l*) 7 C. D. 848 (1878), Fry, J.

acquired a colliery, but not in Radstock, and began to trade as "The Radstock Coal and Waggon Co., Colliery Proprietors, Radstock, Somerset," and a motion to commit for breach of the injunction was refused on the ground that the terms used by them did no more than imply that they were proprietors of collieries, and that their place of business was at Radstock, and this was true (*l*). So, in *The Whitstable Oyster Case* (*m*), where it was held that the name "Whitstable Native Oysters" meant the plaintiffs' oysters, and could not be fairly used of French oysters relaid and brought to maturity at Whitstable; the learned judge said, the plaintiffs' right in respect of the name was subject to the inconvenience that the name might honestly be used by anyone to describe real Whitstable natives, whether the plaintiffs' oysters or not (*n*).

It may be doubted whether the decision in *The Radstock Colliery Case*, and the dicta just referred to, are consistent with the judgments delivered in the House of Lords, in *The Stone Ales Case* (*o*), where, although the right of the appellant to state that his beer was brewed at Stone was recognized, it was held to be subject to an obligation not to do so in any manner calculated to cause the appellant's beer to be passed off as that of the respondents, which was commonly known as *Stone Ale*, and the learned lords were clearly of opinion that the obligation would prevent the appellant from using the last-mentioned term at all. And if, as required by the rule laid down in the recent authorities, the plaintiff proves that an apparently descriptive word which he claims to appropriate has wholly lost its descriptive meaning, it is difficult to

(*l*) Seb. Dig. p. 633 (1878), Fry, J.

(*m*) *Free Fishers of Whitstable v. Elliot*, 4 Times L. R. 273; W. N. (1888) 27, Stirling, J., interlocutory injunction to restrain the use of *native*: no order as to *Whitstable*. In the later case of *The Whitstable Oyster Fisheries Co. v. The Hayling Fisheries, Ltd.*, 17 R. P. C. 461 (1900),

Buckley, J., it was decided that "Whitstable," as applied to oysters, was descriptive of the place where the oysters reach maturity.

(*n*) Cf. also *Bewlay v. Hughes*, above, p. 50, note (*q*).

(*o*) *Montgomery v. Thompson*, (1891) A. C. 217; 8 R. P. C. 361. See also the *Yorkshire Relish Case*, above, p. 159.

imagine how the defendant can be truthfully using the word with that meaning (*p*).

An author can restrain the publication under his name of books which are not written by him, on the same principles as a trader can obtain an injunction to protect his trade-name or that of his goods (*q*). And, further, it has been held that the writer of a work can maintain an action against the owner of the copyright for the damage occasioned to his reputation by the publication of a new edition of the book, purporting to be prepared by him, but in fact not so prepared (*r*). But in the case of a serial publication, the purchaser of the goodwill of the business of conducting it,—sometimes, but erroneously, called the copyright in the publication,—is at liberty to publish subsequent numbers under the old name after determining his business relations with the author or editor of earlier numbers, and notwithstanding that the name is that of the first editor or author (*s*).

The author's right to prevent the work of another being passed off as his is, of course, quite distinct from the copyright which he may have in his own work. Upon the principle already stated (*t*), the right here under consideration will not enable him to stop the republication under his name of his own, non-copyright, work (*u*).

Titles of books, newspapers, or other publications, are also protected on the same principles, that is, as trade-names, and no cause of action arises, therefore, unless it is shown that the title is known to indicate the plaintiff's book or paper, so

(*p*) Above, p. 480.

(*q*) *Lord Byron v. Johnson*, 2 Mer. 29 (1816), Eldon, L. C.; cf. *Barnard v. Pillow*, W. N. (1868) 94, Romilly, M. R. (music); and *Martin v. Wright*, 6 Sim. 297 (1833), Shadwell, V.-C., copy of work of diorama painter.

(*r*) *Archbold v. Sweet*, 1 M. & R. 162; 5 C. & P. 219 (1832), Lord Tenterden, C. J. In *Ice v. Gibbins*, 67 L. T. 263 (1892), Kekewich, J., said the question was one of libel. He refused an interim injunction. See Chap. XVIII.

(*s*) *Ward v. Beeton*, L. R. 19 Eq. 207 (1874), Malins, V.-C. (*Beeton's Christmas Annual*); cf. *Condy v. Mitchell*, 37 L. T. N.S. 766 (1877), C. A. (*Condy's Fluid*). A late editor would be restrained from advertising that a serial is discontinued; *Bradbury v. Dickens*, 27 Beav. 53; 28 L. J. Ch. 667 (1859), Romilly, M. R. (*Household Words*).

(*t*) Above, and pp. 447, 475.

(*u*) *Clemens v. Belford*, 14 Fed. Rep. 728 (1883), Amer. (*Mark Twain*).

that its use by the defendant would be calculated to lead to deception (*v*). There is no copyright in such titles (*w*).

C. Imitation of Get-up.

The general appearance of a trader's goods as they are presented to purchasers is often the most important of the signs by which the goods are recognised as his, and an imitation of it frequently affords the readiest means by which a fraudulent rival, and fraudulent retail dealers in collusion with him, can pass off his goods as the goods of the other. The cases falling under this head are almost necessarily cases of deliberate fraud, for such similarity of "get-up" as is calculated to deceive is, as a rule, the result of a resemblance, more or less close, in a number of corresponding details, and this can hardly happen by accident or coincidence. In effect, if the get-up of the defendant's goods appears, on first inspection, to closely resemble that of the plaintiff's, and it is shown that it has recently been adopted by him, the only explanation, consistent with honest conduct, that can ordinarily be given is, that the leading features of the get-up are common to the trade in question. A familiar example of such common features is the square tin box covered with yellow paper, bearing red and black letters, of the mustard trade (*x*).

Get-up common to the trade.

What is compendiously called the "get-up" of goods,—the dress in which they are presented to the buyer (*y*),—

(*v*) *Schore v. Schmincke*, 33 C. D. 546 (1886), Chitty, J. (*Castle Album*); *Borthwick v. The Evening Post*, 37 C. D. 449 (1888), Kay, J., and C. A.; and cases in the next note. A list of those cases is collected in Cox's *Trade-marks*, 2nd ed. p. 5.

(*w*) *Dicks v. Yates*, 18 C. D. 76 (1880), Bacon, V.-C., and C. A. (*Splendid Misery*); *Licensed Victuallers' Newspaper Co. v. Bingham*, 38 C. D. 139 (1888), North, J., and C. A. (*Licensed Victuallers' Mirror*).

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

Other examples will be found in *Jamieson & Co. v. Jamieson*, 15 R. P. C. 169, (1898) C. A., overruling Byrne, J.; *Puckham & Co. v. Sturgess & Co.*, 15 R. P. C. 669 (1898), North, J., and C. A.; *Payton & Co. v. Snelling, Lampard & Co.*, 17 R. P. C. 48 and 628, C. A. and H. of L., enamelled tins for French coffee, reversing Byrne, J., 16 R. P. C. 283.

(*y*) In *Knott v. Morgan*, 2 Keen, 213 (1836), Langdale, M. R., and Cottenham, L. C., the fraud consisted in the imitation of the painting of the plaintiff's tin boxes, the uni-

comprises, in particular, the size and shape of the packages (z), where the goods have no definite outline, or none which is shown to the buyer, the material, colour, and decoration of their wrappers, and the lettering and arrangement of their labels (a). Thus, in *Lever v. Goodwin* (b), the plaintiffs sold their soap in packets wrapped up in a peculiar parchment paper, with *Sunlight Self-washer* printed in spaced type upon the wrapper; the defendants began to use similar packets and paper, with the words *Goodwin's Self-washing Soap* printed upon it in similar type. It was treated as an obvious case of fraud (c).

"Looking at the two tablets," Cotton, L. J., said, "one cannot but see that there is a strong general resemblance between them, and especially in the eyes of people who cannot read. But (the defendants') contention was this: there is no trade-mark in *Self-washer* or *Self-washing* (d); there is no monopoly in this parchment paper; there is no monopoly in the spaced printing; then why should we be restrained, in carrying on business, from using those things as to which the plaintiffs cannot claim any monopoly? That is an obvious fallacy. There may be no monopoly at all in the individual things, but if they are so combined by the defendants as to pass off the defendants' goods as the plaintiffs' then the defen-

No monopoly
in the con-
stituent
elements.

forms of their service and the use of their descriptive —the London Conveyance Co. The facts in the *London General Omnibus Co. v. Felton*, 12 T. L. R. 213, Chitty, J., and *London Road Car Co. v. Era Omnibus Assn.*, (1898) *Times*, June 23; (1899) *Times*, April 28, were similar.

(z) In *Ripley v. Bandy*, 14 R. P. C. 591, Kekewich, J., the blue was done up in oval packets, and thence called *Oval Blue*. In *Jones v. Hallworth*, 14 R. P. C. 225 (1897), Kekewich, J., the colours, patterns, shape, and sizes of the plaintiff's *Selyt* dusters were imitated.

(a) A curiously shaped stick on which the plaintiffs' carpets were rolled has been protected in America: *Lowell Manufacturing Co. v. Larned*,

Cox, 2nd ed., p. 241.

(b) 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A. Cf. *Lever v. Bedingfield*, 16 R. P. C. 3 (1899), C. A.

(c) Imitations of the descriptive and commendatory inscriptions, and of the directions for use printed on the covers of patent medicines and proprietary articles are very common: *Franks v. Weaver*, 10 Beav. 297 (1847), Langdale, M. R.; and *Massam v. Thorley's Cattle Food Co.*, 14 C. D. 748 (1880), C. A., are instances. As to prizes, medals, and testimonials, see above, p. 457, and below, p. 491, note (i).

(d) It had been struck off the Register on the defendants' application.

dants have brought themselves within the old common law doctrine in respect of which equity will give to the aggrieved party an injunction to restrain the defendants from passing off their goods as those of the plaintiffs" (e).

Get-up common to the trade,

or newly introduced.

No case can be made merely by showing an imitation of the parts of the get-up of goods which are common to the trade (f). And even where a trader introduces a new feature into the get-up of his goods he does not thereby acquire any proprietary interest in it, so as to be able to prevent its use by competitors without proving that it has become so identified with his goods that its use by others is calculated to deceive (g).

Imitation of part of get-up.

It is not, however, necessary that every part of the get-up should be imitated, for, though no exclusive right to the use of any single feature of it which is not a registered trade-mark is recognized, yet a part of the get-up, a picture, for instance, which is used on the label or wrapper, may be shown to be so identified with the plaintiff's goods that its use for similar goods is calculated to pass them off as his. The picture, in effect, may become,—as the trade-name of the plaintiff's goods may,—a "common law trade-mark" (h).

Thus, in *Jay v. Luller* (i), the plaintiff used the device of a lady and a bear, in his trade as a furrier, by attaching it to the wrappers and boxes in which he sent out his goods, but he had registered it only as a trade-mark for sealskin mantles and coats. The defendant began to issue a circular, bearing

(e) *Blofield v. Payne*, 4 B. & Ad. 410; 2 L. J. K. B. n.s. 68 (1833), imitation of envelope; *Great Tower Street Tea Co. v. Langford & Co.*, 5 R. P. C. 66 (1887), Stirling, J., of packets; *Hammond v. Brunner*, 9 R. P. C. 301 (1892), Chitty, J., of label; *Stephens v. Peel*, 16 L. T. n.s. 145 (1867), Wood, V.-C., of bottle, and Steel-pens for *Stephens*.

(f) Page 488, n. (x).

(g) In *Payton v. Snelling, Lampard & Co.* (above, p. 488, n. (x)), the plaintiffs had been the first to put up coffee in tins enamelled in bright colours. The practice was

soon followed, and it was held that the plaintiffs had no monopoly in such tins. See also the remarks of Kekewich, J., in *Hubbuck v. Brown*, 17 R. P. C. at p. 154 (1900), and in *Alaska Packers' Association v. Crooks*, 18 R. P. C. 129 (1901), as to the fashion of the market.

(h) Above, p. 451.

(i) 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.; see also *Hart v. Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J.; and *Great Tower Street Tea Co. v. Langford & Co.*, 5 R. P. C. 66 (1887), Stirling, J.; and see p. 485, above.

a similar mark, in connection with his trade, which was also that of a furrier. Two injunctions were granted, one, restricted to the mantles and coats, to restrain infringement of the trade-mark, the other, not so restricted, to restrain the defendant from using the device so as to deceive the public.

And, on the other hand, the imitation of a number of things, each of which is in itself not distinctive of the plaintiff's goods, may make a strong case on account of the cumulative effect of the detailed resemblances (*k*).

Only things which are put prominently forward so as to be likely to catch the eye of a purchaser and remain in his memory need generally be considered. Thus, the printing on the back or sides of a box may usually be disregarded in considering whether the get-up of goods is likely to deceive (*l*).

3. Use in Connection with the Defendant's Goods.

The spurious badges must be used in connection with goods which are not the plaintiff's, but they need not be stamped or printed upon them or their envelopes. The fraudulent trade-names, for instance, in most of the cases where injunctions have been granted, were used as descriptions of the defendants for general purposes, and in their advertisements and circulars (*m*), or were placed over their shop doors (*n*). In *Jay v. Ladler* (*o*), the deceptive representation was effected by sending to the defendant's customers a circular inclosing a print of a design resembling the plaintiff's distinctive design. The action extends to every kind of representation

Name, &c.
need not be
attached to
the goods.

(*k*) See the judgment, in *Lever v. Goodwin*, quoted above, and compare it with those in *Lever v. Beddingfield*, 16 R. P. C. 3 (1899), C. A. See also per Wood, V.-C., in *Woolam v. Radcliff*, 1 H. & M. 259, cited *ante*, p. 485.

(*l*) "I attribute very little importance indeed in a case of this kind to the sides and back." Per Kekowich, J., in *Lever v. Beddingfield*, 15 R. P. C.

at p. 462 (a box of tablets of soap).

(*m*) See the injunctions in *Hendriks v. Montagu*, 17 C. D. 638; *Massam v. Thorley*, 14 C. D. 748; and *Saxlehner v. Apollinaris Co.*, (1897) 1 Ch. 893; 14 R. P. C. 645; Appendix, pp. 750, 751, 758.

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

(*o*) 40 C. D. 649; 6 R. P. C. 136 (1888), Kekowich, J.

which is calculated to pass off the defendant's goods as the plaintiff's.

4. Probability of Deception.

Where deception is intended.

The Court must be satisfied that the defendant's conduct is calculated to pass off other goods as those of the plaintiff, or, at least, to produce such confusion in the minds of probable customers or purchasers as would be likely to lead to the other goods being bought and sold for his (*p*). This is the foundation of the action.

If it is shown to have been intended to deceive in this way, the Court will not generally push the inquiry further (*q*).

But the intention is only evidence of the actual deception or probability of deception which may be inferred from it. And if the Court does not believe that there is any probability of deception, the action must fail (*r*). "The law does not take notice of a fraudulent intention in a man's mind if he does nothing to carry out the fraud" (*s*).

Badges of fraud:
unexplained similarities;
colourable differences;

The existence of unexpected and unexplained similarities (*t*) between the goods of the defendant and those of the plaintiff, or of similarities which have been modified by colourable differences (*u*) or by differences and distinctions so arranged as to escape notice (*x*); the use by the

(*p*) *Hendriks v. Montagu*, 17 C. D. 638 (1881); see per James, V.-C., p. 646.

(*q*) "Why should we be astute to say that (the defendant) cannot succeed in doing what he is straining every nerve to do?" Lindley, L. J., asked, in *Slazenger v. Feltham*, 6 R. P. C. p. 538 (1889). Cf. per Lord Macclesfield, in *Mitchell v. Reynolds*, 1 Smith L. C., 10th ed., p. 391. "He only can suffer by his knavery, and surely Courts of Justice are not concerned lest a man should pay too dear for being a knave."

(*r*) *Lever v. Beddingfield*, 16 R. P. C. 3 (1898), C. A., overruling 15 R. P. C. 453, Kekewich, J.

(*s*) Per Lord Esher, M. R., in *Reddaway v. Banham*, 12 R. P. C. at p. 89. "If intent to deceive be

once established, it is a short step, though it is a step, and not an inevitable one, to the conclusion that the intention has been fulfilled, and that the goods are calculated to deceive," per Kekewich, J., in *Saxlehner v. Apollinaris Co.*, 14 R. P. C. at p. 654.

(*t*) *Taylor v. Taylor*, 2 Eq. Rep. 290; 23 L. L. J. Ch. 255 (1854), Wood, V.-C.

(*u*) *Slazenger & Sons v. Feltham & Co.*, 6 R. P. C. 531 (1889), C. A. (*Demon, Demotic*). Obvious differences between the goods themselves are very material to the question: *Coleman v. Brown*, 16 R. P. C. 619, (1899) North, J., and C. A. on an interlocutory application (*Wincarnis, Vincalis*).

(*x*) *E.g.*, "late of," &c., in small letters, Chap. XV., p. 382.

defendant of descriptions, which, as applied to himself or his own trade, are inaccurate, and by reason of their inaccuracy approach more nearly to the proper description of the plaintiff (*y*), and the gradual approximation of the defendants' names, get-up, or description to those of the plaintiff (*z*), are all obvious badges of fraudulent intention frequently recurring in the cases which come before the Court (*a*). gradual approximation.

Instances of actual deception need not be proved if the Court is otherwise satisfied of the probability of deception (*b*); and on the other hand, they are not necessarily conclusive where they have occurred, in cases, for example, where their number is comparatively insignificant (*c*). And, of course, proof of deception is not sufficient to enable the plaintiff to succeed if the defendant has done nothing but what he was entitled to do, as where he has only used marks common to the trade (*d*). Proof of actual deception.

The question what resemblance is calculated to deceive, and the modes of comparison adopted, have been sufficiently considered in the preceding chapters (*e*). Proof of probability of deception.

(*y*) *Holloway v. Holloway*, 13 Beav. 209 (1850), Langdale, M. R.

(*z*) *Boulnois v. Peake*, 13 C. D. 513, n. (1868), Giffard, V.-C., *Carriage Repository* changed to *New Carriage Bazaar*; *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478 (1887), C. A. (*Apollinis*); *Sanitas Co., Ltd. v. Condy*, 4 R. P. C. 195, 530; 56 L. T. 621 (1886), Kay, J. (*Condi-Sanitas*). "When a manufacturer's goods are a drug on the market so long as they bear his own name or proclaim their true origin, and yet are saleable at once if marked with nothing but some common English words, and when that manufacturer holds himself out as ready and willing so to mark his goods, and does so mark them at the 'instigation,' as he says, of a purchaser, a Lancashire jury may perhaps be trusted to solve the riddle." Per Lord Maonaghten

in the *Camel Hair Belting Case*, 13 R. P. C. at p. 233.

(*a*) See further, p. 382.

(*b*) See the last chapter, p. 375.

(*c*) *Civil Service Supply Association v. Dean*, 13 C. D. 512 (1879), Malins, V.-C.; *Borthwick v. The Evening Post*, 37 C. D. 449 (1888), C. A.; *Leahy, Kelly & Leahy v. Glover*, 10 R. P. C. 141 (1893), H. L.; *Rutter v. Smith*, 18 R. P. C. 49 (1901), Kekewich, J.

(*d*) See below, *Defences*. In *Jamieson v. Jamieson*, above, p. 488, n. (*x*), the C. A. dismissed the action, although Byrne, J., had found both actual deception and intention to deceive.

(*e*) Chap. XV., p. 373; Chap. X., p. 224; see also *Goodfellow v. Prince*, 35 C. D. 9 (1887), C. A. (plaintiff and defendant both mere importers); *Bodega Co. v. Owens*, 6 R. P. C. 236; 7 R. P. C. 31; 23 L. R. Ir. 371

5. Proof of Damage.

Probability or proof of damage is essential.

Proof of damage is not in every case essential to enable the plaintiff to maintain his action, for if he shows that the defendant is acting so as to pass off goods as those of the plaintiff which are not the plaintiff's, it will generally be assumed that the plaintiff is thereby prevented from selling as many of the goods as he otherwise would. But if this assumption is negatived by the circumstances of the case, proof of actual or probable damage is necessary (*f*). For the assumption of a name (*g*), or an address (*h*), similar to the name or address of the plaintiff, without malicious intent, although it may cause annoyance and inconvenience to him, —for instance, by delaying his letters,—is not actionable, unless it is shown to be calculated to injure him in his trade. And no action lies at the suit of any private individual for deception practised upon the public, unless it incidentally causes, or is calculated to cause, damage to him as an individual; if this is not the case, the wrongdoer can only be punished through the criminal law, or in a civil action on information brought in the name of the Attorney-General (*i*).

The questions how far the inconvenience caused to a trader

(1889), *Chatterton*, V.-C. (defendant called his wine-shop in Belfast *Bodega*; plaintiff had no *Bodega* shop in Ireland outside Dublin); and the cases in the last note.

(*f*) So that a non-trader has no action, *ante*, p. 366; *Delondre v. Shaw*, 2 Sim. 237 (1828), Shadwell, V.-C.; *Levy v. Walker*, 10 C. D. 436 (1879). See also cases in last note.

(*g*) *Borthwick v. The Evening Post*, above, p. 475, n. (*g*); *Du Boulay v. Du Boulay*, L. R. 2 P. C. 430.

(*h*) *Day v. Brownrigg*, 10 C. D. 294 (1878), C. A.; *Street v. Bank of Spain and England*, 30 C. D. 156 (1885), Pearson, J., adoption by the defendants (bankers) of the same cypher

telegraphic address as that of the plaintiff.

(*i*) Per Cotton, L. J., in *The Native Guano Co. v. The Sewage Manure Co.*, 8 R. P. C. p. 128 (1891); see also *Clark v. Freeman and Williams v. Hodge*, cited above, pp. 457, 458; *Batty v. Hill*, 1 H. & M. 264 (1863), Wood, V.-C., false pretence of award of gold medal. In the *Maizena Case* (above, p. 481), the Privy Council thought that the defendants had made an objectionable reference to a medal really gained by the plaintiffs, but that it was a mere advertising trick. The defendants gave an undertaking to discontinue the reference, and the action was dismissed: (1894) A. C. 275; R. P. C. 281.

by the use of his trade-name, or the trade-name of his goods, in a business which is not in competition with his own, and how far the interference with a possible extension of his existing business entitle him to sue, have already been considered (*j*).

6. Defences.

The defences, other than a simple denial of the acts alleged, which are commonly set up, may be tabulated as follows: that—

- (1.) The name, or other badge, which the plaintiff charges the defendant with having imitated, carries no distinctive reference to the plaintiff's goods.
- (2.) The defendant has an independent or a concurrent right to use it (*k*).
- (3.) The name or other badge which the defendant is using, is not such, or is not so used, as to be calculated to pass off other goods for those of the plaintiff (*l*).
- (4.) The plaintiff is debarred from suing the defendant for all or part of the relief he seeks by (a) an agreement, or some personal estoppel (*m*) (other than those next alluded to); (b) acquiescence (*n*); (c) delay (*o*); or (d) deceptive use of the name or badges he relies on, or because his trade is fraudulent (*p*).

(1.) This is a traverse of part of the plaintiff's case. It may take the form of an allegation that the name or other badge is merely descriptive (*q*). If so, the defence falls under the second head also. Denial of
repute.

(2.) This defence is discussed below. The most important case is the right of any man, apart from restriction by contract, to trade honestly under his own name (*r*). That right Concurrent
right.

(*j*) Above, p. 476, and note (*h*).

(*m*) Page 390.

(*k*) See, as to the right to use a man's own name, p. 500; and as to the right to honestly describe the place of origin, &c. of his goods, p. 485; and further, the last chapter, "Infringement," pp. 334 *et seq.*

(*n*) Page 392.

(*o*) Page 394.

(*p*) Page 409.

(*q*) Above, pp. 477 *et seq.*

(*l*) Above, p. 492; and Chap. XV., p. 373.

(*r*) The right is not absolute; see below, p. 500.

is, of course, an answer only to a case which rests wholly upon an alleged imitation or adoption of the trade-name which the plaintiff is using.

Denial of deception.

(3.) This defence also is a mere traverse. It has been considered already (r).

Estoppel.

(4.) The defences collected under the fourth head are precisely analogous to those discussed in the last chapter; they depend on the same considerations and are governed by the same rules (s).

Concurrent Right.

Partners after dissolution.

The defendant may have as good a title to use the name or other things in question as the plaintiff has to use the name or things with which it or they are, as he alleges, likely to be confused. For instance, on the dissolution of a partnership, in the absence of special agreement, and unless the firm name is sold or assigned with the goodwill, as it may be (t), each partner has an equal right to use it, if he continues to carry on a similar business to that of the late firm (u), provided that he does not by so doing expose his former partners to any risk of liability (x). Whether there will be any such risk is a matter to be determined under the circumstances of the particular case (x).

Purchaser of goodwill.

It is convenient to note here, in passing, that the purchaser of the goodwill of a business, or a partner succeeding to it under agreement upon dissolution of partnership, has a right to use the trade-name and trade-marks under which it was conducted (y). And this even though it comprise the

(r) Note (l), above.

(s) See *Read v. Richardson*, 45 L. T. N.S. 54 (1881), C. A. (*Dog's Head Beer*).

(t) *Hall v. Barrows*, 4 De G. J. & S. 150; 33 L. J. Ch. 204 (1863), Westbury, L. C.; and see Lindley on Partnership, 6th ed., pp. 445 and 449; and *In re David and Matthews*, below, p. 498.

(u) *Burchell v. Wilde*, (1900) 1 Ch. 551, Byrne, J., and C. A. (*Burchell*

& Co.); *Banks v. Gibson*, 34 Beav. 566; 34 L. J. Ch. 591 (1865), Romilly, M. R.; *Levy v. Walker*, and *Chappell v. Griffiths*, *infra*; and see further on this subject, Sebastian, 3rd ed., p. 289; 4th ed., p. 299.

(x) *Burchell v. Wilde*, *supra*; and see next paragraph.

(y) *Levy v. Walker*, 10 C. D. 436 (1879), C. A.; *Currie v. Currie*, 15 R. P. C. 339, (1897) Court of Sess. (*Prince Charlie*).

personal name of a late partner (z), or of any other late owner of the goodwill, but not so as to cast any risk of liability upon the late partner or owner (a) by using his personal name in such manner as to represent that he is still a member of the firm, or carrying on the business (b).

But where the goodwill of a business is sold, or is taken over on the dissolution of a partnership by agreement, without any restrictive condition being imposed upon the late owner or the retiring partner which restrains him from exercising his ordinary right, he is at liberty to start in the same trade again at once under his own name, so long as he uses it honestly, even though it be the same as, or be similar to, the name under which the old business was, and continues to be, carried on (c).

Trader may use his own name after the sale of his business, where no contrary agreement.

(z) *Condy v. Mitchell*, 37 L. T. n.s. 268, 766 (1877), Bacon, V.-C., and C. A. (*Condy's Fluid Co.*); *Chappell v. Griffith*, 53 L. T. n.s. 459 (1885), Kay, J.

(a) *Chatteris v. Isaacson*, 57 L. T. n.s. 177 (1887), Kekewich, J. The vendor of the business of "Mme. Elise" agreed that the purchaser should have the exclusive right to use the name "Mme. Elise & Co." Mme. Elise was his wife's name. Held, the purchaser must use the addition "& Co." In *Burchell v. Wilde*, (1900) 1 Ch. 551, it was held that, upon the division of a solicitor's business between the partners on dissolution, the partner whose name was Burchell would run no risk by reason of the use by the other of the old name, *Burchell & Co.* Notice of the change had been given to all the clients. The defendant, in fact, undertook to carry on business under a different name, viz., *Burchell, Wilde & Co.* In *Townsend v. Jarman* (1900), 2 Ch. 698; 17 R. P. C. 649, Farwell, J., the plaintiff bought the business of Jarman & Co., Ltd., seedsmen, from a company to whom he and the defendant had,

on the dissolution of their partnership, transferred it. He carried on business as *Jarman & Co.*, and it was held that the defendant could not complain of this. The defendant had sold business premises on which his name, *E. J. Jarman*, was cut to the company, who had transferred them to the plaintiff. It was held that the defendant could not compel the plaintiff to remove the name. See also *Routh v. Webster*, 10 Beav. 561 (1847); and *Prudential Assurance Co. v. Knott*, L. R. 10 Ch. 142 (1875); also *Rosher v. Young*, Sol. Jo., Vol. 45, p. 344.

(b) *Dickson v. McMaster & Co.*, 18 Ir. Jur. 202 (1866), Brady, C.; *Scott v. Rowland*, 26 L. T. n.s. 391 (1872), Wickens, V.-C.; *Gray v. Smith*, 43 C. D. 208 (1889), C. A.; *Thynne v. Shove*, 45 C. D. 577 (1890), Stirling, J. There can be no risk where the late partner is dead, *Webster v. Webster*, 3 Swan. 490 (1791), Thurlow, L. C.; see Lindley on Partnership, 6th ed., p. 448.

(c) *Churton v. Douglas, Johnson*, 174; 28 L. J. Ch. 841 (1859), Wood, V.-C.; see page 499; *Johnson v. Helleley*, 34 Beav. 63; 34

Vendor must not solicit his old customers.

In such a case the vendor or retiring partner could not trade under the old name if it differed from his own personal name (c). And he would not be allowed to solicit his old customers in the business which he has sold, because to do so would be to derogate from his grant (d).

In *Re David and Matthews* (c), there was a provision in a deed of partnership between two partners, that on the death of either a general account should be taken for the purpose of determining the value of the share of the deceased partner which was to be paid by the survivor, who, under other provisions, took over the assets of the firm. A question arose whether the goodwill should be included in the account or not, and, if it were, upon what basis it should be valued. Romer, J., after reviewing all the authorities on the subject, decided that the goodwill must be included as part of the assets, and must be valued as on a sale upon the footing that, if it were sold, the surviving partner would be at liberty to carry on a rival business, but not to solicit any person who was a customer of the firm before the death of the partner, or to carry on business under the firm-name, which was made up of the names of both partners.

Questions between the purchaser of a business and its former owners, or some of them, respecting the use of the firm name seldom arise except upon a dissolution of partnership, or after the sale of the goodwill of a debtor's business by his trustee in bankruptcy; for no careful purchaser would agree to buy the goodwill of a business without stipulating for the exclusive use of the trade-name, and probably stipulating also that the vendor should not carry on a new competitive business.

L. J. Ch. 32, 179; 2 De G. J. & S. 446 (1864), Romilly, M. R., and L. J. J.; *Labouchere v. Dutton*, L. R. 13 Eq. 322 (1872), Romilly, M. R.

(c) See previous note.

(d) So finally decided in *Trego v. Hunt*, (1896) A. C. 7, overruling *Pearson v. Pearson*, 27 C. D. 145, on this point. See also *Gillingham v. Beedow*, (1900) 2 Ch. 242. The

order made by the H. L. in the former case restrained the defendant from applying privately by letter, personally, or by a traveller, to any person who was, prior to the dissolution, a customer of the old firm, asking such customer to deal with him (the defendant) or not to deal with the plaintiffs.

(e) (1899) 1 Ch. 378.

A trustee in bankruptcy has no power to contract on behalf of the bankrupt, and the bankrupt is not a grantor so as to be bound by the rule applied in *Trego v. Hunt*. The sale of the goodwill of his business in the bankruptcy, accordingly, throws no obligation upon the bankrupt trader other than the obligation of the general law, not to represent that the business is still carried on by him (*f*).

Sale in
bankruptcy.

It is clear that the late owner or partner must do nothing, other than make an honest use of his own name, which is calculated to suggest that he is carrying on the old business (*g*).

The vendor
must not
represent that
his business is
the old busi-
ness, or its
successor.

“It has been settled,” James, V.-C., said, in *Hudson v. Osborne* (*h*), “that there is no implied covenant of any kind in the sale by an individual himself of the goodwill of his business; but it seems to be settled that a trader, whose business, and the goodwill of whose business, have been sold by himself, or by any person deriving title under him, has no right to represent himself as carrying on that identical business; he has no right to use the trade-marks which were the marks of that business, or, by the use of the name, or of a title of the firm, to represent himself as being the continuer of that identical business which has been sold.”

And, in *Churton v. Douglas* (*i*), a partner, who, after he had sold his share in the business of “John Douglas & Co.” to his co-partners, continued to trade as “Churton, Bankart, and Hirst, late John Douglas & Co.,” was restrained from trading as “John Douglas & Co.,” or representing that his new business was a continuation of the old business.

The question whether a late partner, or other late owner of a business which has passed into the hands of the plaintiff,

(*f*) *Walker v. Mottram*, 19 C. D. 355 (1881), C. A., and last note. In *Trego v. Hunt*, above, note (*d*), Lord Macnaghten said: “There is all the difference in the world between the case of a man who sells what belongs to himself and receives the consideration, and a man whose property is sold without his consent by his trustee in bankruptcy, and who comes under no obligation, express or implied, to

the purchaser from the trustee.”

(*g*) As to the use of the word “late,” see above, pp. 382, 455.

(*h*) 39 L. J. Ch. 79 (1869). This was, of course, before the decision in *Trego v. Hunt*.

(*i*) Note (*c*); *Witt v. Concoran*, 2 C. D. 69 (1873), Bacon, V.-C., is a similar case; *Benbow v. Low*, 44 L. T. 875; 29 W. R. 837 (1881), Bacon, V.-C.

is representing that he is still carrying it on, or that his present business is its successor, or is only fairly working and advertising the latter business as his own, is often one of great nicety (*l*). The case of *Mogford v. Courtenay* (*l*) is an illustration of this. There the partnership between the parties having expired by effluxion of time, and the goodwill passing under the partnership articles to the plaintiff, but without any restrictive covenant binding the defendant not to use the firm-name or any similar name, the defendant was restrained from issuing a circular to the old customers stating the fact of dissolution, and that he had joined a new firm, and asking the customers for a "continuance" of their custom. This was held to be a suggestion that he was about to carry on, not merely a similar business, as he lawfully might, but the identical business which had passed to the plaintiff. It appears by the more recent authorities (*m*) that he ought to have been restrained from privately soliciting the old customers to deal with him in any terms whatsoever.

The right to Trade under one's own Name.

The former rule.

It was formerly supposed to be a rule of law, existing by way of exception to the general rule stated at the beginning of this chapter, that any man might—so long as he acted honestly—trade under his own name, or under the names of himself and his partners, even though the similarity of such name or names to the name under which another person had previously been carrying on business, or to the trade-name of that other's goods, might occasionally lead to confusion or lead to the business or goods of the new-comer being mistaken for the business or goods of the earlier trader (*n*).

(*l*) 45 L. T. N.S. 303 (1881), Fry, J. The decision that the defendant might not solicit the old customers has since been approved by the House of Lords, above, p. 498.

(*m*) *In re David and Matthews*, above, p. 498.

(*n*) See the 5th and 6th rules

stated by Kay, L. J., in the *Yorkshire Relish Case*, printed in a note to this chapter (p. 518), and the judgment of Lindley, L. J., in the same case: (1896) 2 Ch. at p. 70; 13 R. P. C. at p. 270; the judgments of the C. A. in *Turton v. Turton*, 42 C. D. 128 (1889), and *Warner v. Warner*, 6

Thus, Knight-Bruce, L. J., said, in a suit between father and son (*o*), "all the Queen's subjects have a right to sell (their goods) in their own names, and not the less that they bear the same name as their father"; "but" he added, "if any circumstances of fraud had accompanied, and were continuing to accompany, the case, it would stand very differently."

According to the more recent authorities, however, it appears to be now settled that no such rule of law exists (*p*), and that there is no difference in principle between the case of a man's own name and the case of any other apparently descriptive word (*q*). The result is that in the rare and highly exceptional cases where it can be proved that a personal name has become so identified by use in a wide-spread and well-known business with a particular trader as to be necessarily deceptive when used without qualification by anyone else in the same trade, another trader may be restrained from using it "without distinguishing, &c.," although it is his own name. Present state of authorities.

In the *Anchovy Sauce Case* cited above (*r*), Turner, L. J..

T. L. R. 327, 359; and the first edition of this book, p. 420. In *Reddaway v. Banham* (below, p. 502), however, Lord Macnaghten said he was at a loss to know why *Turton v. Turton* was ever reported, and that the plaintiff's case was extravagant and absurd: (1896) A. C. at p. 220; 13 R. P. C. at p. 234.

(*c*) *Burgess v. Burgess*, 3 D. M. & G. 896; 22 L. J. Ch. 675 (1853); see below, note (*r*).

(*p*) That is the case unless the matter should be reconsidered in the House of Lords. As will be shown, the case of *J. & J. Cash, Ltd. v. Cash*, 18 R. P. C. 213 (1901), Kekewich, J., referred to below, p. 508, is the only actual decision on the point. It is said, as stated in the text, that the same rules are to apply to a personal name and any other *primâ facie* descriptive word. One such

rule is that the word must have wholly lost its ordinary descriptive meaning for the trade purposes under consideration (see above, p. 479). How can this be the case while it remains the name and the only proper description of a person who is lawfully engaged in the trade?

(*q*) *The Valentine Meat Juice Co. v. The Valentine Extract Co., Ltd.*, 17 R. P. C. 673; 83 L. T. 259 (1900), C. A. As to the conditions under which a descriptive word can be monopolized, see above, pp. 477 to 486.

(*r*) *Burgess v. Burgess*, 3 D. M. & G. 896; 22 L. J. Ch. 675 (1853), Kindersley, V.-C., and Knight-Bruce and Turner, L. JJ., on an interlocutory application. The defendant, who had recently left the employment of his father, the

said that "it is a mere question of evidence in each case whether there is a false representation or not," and in the *Camel-hair Belting Case* (s), in which the matter was placed upon its modern footing by the opinions of the learned Law Lords, this statement was adopted and approved. The Lord Chancellor said (t) that no principle of law was laid down in the earlier cases which would have prevented an injunction, although the defendant's name was Burgess and although the article was described by a descriptive name, but that, in the view of the Lords Justices, the descriptive name there in question, *Burgess' Essence of Anchovies*, had not, as a matter of fact, acquired the technical signification of being only made by Burgess the father.

Lord Herschell said (u): "the name of a person or words forming part of the common stock of language, may become so far associated with the goods of a particular maker that it is capable of proof that the use of them by themselves without explanation or qualification by another manufacturer would deceive a purchaser into the belief that he was getting the goods of A. when he was really getting the goods of B. In a case of this description the mere proof by the plaintiff that the defendant was using a name, word or device, which he had adopted to distinguish his goods, would not entitle him to any relief. He could only obtain it by proving further that the defendant was using it under such circumstances or in such manner as to put off his goods as the goods of the plaintiff."

These passages, and the passage from the judgment of Vaughan Williams, L. J., in *Jamieson v. Jamieson*, quoted below (x), were cited by Lord Alverstone, M. R., in the *Valentine Meat Extract Case* (y), as establishing that the supposed exception to the general rule in the case of a man's own name does not exist.

plaintiff, and set up a rival business in King William Street, was restrained from describing his business as "late of 107, Strand," his father's address; but the Court refused to restrain him from trading under his own name or describing his goods as "Burgess' Essence of Anchovies."

(s) *Redduway v. Banham*, cited above, pp. 477 and 481.

(t) (1896) A. C. at p. 204; 13 R. P. C. at p. 225.

(u) (1896) A. C. at p. 210; 13 R. P. C. at p. 228.

(x) p. 505.

(y) Above, p. 501, and below, p. 505.

It follows that it is no more essential, in theory, to prove a fraudulent intent in a passing-off case which depends upon the use by the defendant of his own name than in any other case (z).

While, however, the possibility of such a monopoly of a personal name being established as to prevent the honest use of his own name, without qualification, by the defendant is recognised, the degree of proof exacted is very high, and only one case has been reported in which this has been done (a). There are, no doubt, many instances in which the deliberately fraudulent attempt of a defendant to make use of his own name, or, more commonly, an assumed name, in order to pass off his goods as another's, has been restrained (b), or where a company constituted for the purpose of competing with an established business under a name chosen because of its resemblance to the firm-name of such business has been compelled to take steps to prevent deception or to change its name.

In *Jamieson & Co. v. Jamieson* (c), the plaintiff failed *Jamieson & Co. v. Jamieson.*

(z) *S. Chivers & Sons v. S. Chivers & Co., Ltd.*, 17 R. P. C. 420 (1900), Farwell, J. The learned judge said that in order to make out that a personal name has acquired a secondary meaning, its use in the secondary sense must be shown to have become universal, and that, if this were so, the defendant must necessarily have known that his use of it for his own goods was deceptive and dishonest.

(a) *J. J. Cash, Ltd. v. Cash*, cited below, p. 508, and see App., p. 760. In *Dewar, Ltd. v. Dewar*, 17 R. P. C. 341 (1900), Ct. of Sess. at p. 358, Lord Kyllachy said: "I do not myself know of any case in which the use by a man of his own name has been successfully challenged except in circumstances which plainly involved fraud on the part of the user." In *Cellular Clothing Co. v. Maxton*, cited above at p. 482, Lord Shand

((1899) A. C. at p. 341; 16 R. P. C., at p. 407) said the same thing of descriptive names in general. The *Valentine Case* was similar to the *Tussaud* and *Pinet Cases*, cited below, where a company was formed with a deceptive name for the purposes of competition.

(b) *Holloway v. Holloway*, 13 Beav. 209 (1850), Langdale, M. R., was a case of fraudulent imitation of "get-up." The M. R. said: "The defendant's name being Holloway, he has a right to constitute himself a vendor of Holloway's pills and ointment. I do not intend to say anything to abridge any such right."

(c) 15 R. P. C. 169, (1897) C. A., overruling *Byrne, J.* It should be noted that there were other Jamiesons engaged in the trade at Aberdeen besides the parties. It was a "get-up" case, but, in the view of the C. A., the only resemblance between

because the Court of Appeal decided that the defendant was not bound to use extra precautions to avoid confusion between his goods and those of other persons in the trade, if such confusion arose solely from the similarity of his own name with theirs (*d*), and from the use of features common to the trade (*e*). But the Court, as will be seen from the quotations following, carefully distinguished from the case before them the case where the name of a particular trader has come to denote his goods in the market.

Lindley, L. J., after referring to the *Holloway Pill Case* (*f*), said, "When we are asked to restrain a man from carrying on business in his own name, we must take very great care what we are about. The principle applicable to the case, I take it, is this: the Court ought not to restrain a man from carrying on business in his own name simply because there are other people who are doing the same and who will be injured by what he is doing. It would be intolerable if the Court were to interfere, and to prevent people from carrying on business in their own names in rivalry to others of the same name. There must be something far more than that, viz. (there must be), that the person who is carrying on business in his own name is doing it in such a way as to pass off his goods as the goods of somebody else" (*g*). "It is said, because yours may be mistaken for ours you are bound to take extra precautions to prevent yours being mistaken for ours. I am not aware of

Mere similarity of firm-name does not impose duty to take precautions.

the boxes of the plaintiff and defendant was due to the name and to features common to the trade.

(*d*) In *J. H. Brooks & Co., Ltd. v. Norfolk Cycle Co. and John Brookes*, 16 R. P. C. 523, the plaintiffs were makers of the well-known "Brooks" saddle. The defendant Brookes was a saddle maker who had newly entered the trade, but his father had sold saddles under his own name, and had been restrained at the instance of the plaintiffs from doing so. Stirling, J., said that knowing the facts and the probability of confusion, it was the defendant's duty to mark his goods so as to avoid all

possibility of mistake between them and those of the plaintiffs. Instead of doing this he had imitated the plaintiff's manner of marking. An injunction restraining him from marking saddles "J. Brookes" without distinguishing, &c. was granted. *Jamieson & Co. v. Jamieson* does not appear to have been cited, but the case was obviously one of fraud, and possibly also one in which the name had become a trade-name of the goods.

(*e*) Above, p. 232.

(*f*) Page 503, note (*b*).

(*g*) 15 R. P. C. at p. 181.

any case that goes so far as that." "In all cases in which a person has been restrained from carrying on business in his own name he has done something more than use his name: he has copied something from somebody else in the trade, or he has gone out of his way to make his things look like those of a rival in the trade" (h).

Vaughan Williams, L. J., said: "I do not understand that there is any case, or ever has been any case, in which it has been laid down that a man who happens to bear a particular name is debarred from entering into any trade which he chooses to enter into merely because there is somebody else of the same name who has acquired a great reputation in the manufacture of the particular goods dealt with in the trade." Then, after referring to such well-known trade-names as *Bass' Beer* (i), *Colman's Mustard*, and *Pears' Soap*, the Lord Justice continued: "A plaintiff never can complain of the user by the defendant of either the plaintiff's personal name, or of any other name that he chooses to use for the purpose of denoting his goods, unless he first establishes that in the market his goods have come to be known by that name. The right and duty of the Court always is to restrain a man from using a name that has come to be recognized as the name of a particular trader's goods for his, the defendant's, goods so as to suggest that the defendant's goods are the plaintiff's goods, and to pass them off as such" (k).

The question has since come before the English Courts on three occasions (l).

In *The Valentine Meat Juice Co. v. The Valentine Extract Co. Ltd.* (m), the plaintiffs in the Court of Appeal obtained an

The Valentine Case.

(h) At p. 183.

(i) See below, p. 513.

(k) At pp. 192, 193. This passage was cited with approval by Lord Alverstone, M. R., in *Valentine Meat Juice Co. v. Valentine Extract Co., Ltd.*, 17 R. P. C., at p. 680 (1900), as an exposition of the law on the point.

(l) It has also come before the Court of Session in Scotland in *Dewar, Ltd. v. Dewar*, above, p. 503, note (a).

(m) 17 R. P. C. 1, Stirling, J.; 17 R. P. C. 673. 83 L. T. 259 (1901) C. A. Stirling, J., refused the injunction partly because of the difference between the trades, but also on the ground that the defendant, C. K. Valentine, was entitled to promote a company to work his invention under his name, unless fraud were shown, and the learned judge did not find fraud.

injunction (*mm*) to restrain the defendant company from carrying on business as manufacturers or vendors of extract of meat, and from selling any extract of meat, under a name of which *Valentine* formed part, and also an injunction to restrain the defendant, C. K. Valentine, from carrying on business, in such goods, under his name without distinguishing such business from that of the plaintiffs. The plaintiffs' business, although chiefly American, was well known in England, and their goods, a medicinal fluid extract of meat, were always described by a name comprising *Valentine*, and sometimes as *Valentine* simply. The defendant, C. K. Valentine, who had obtained a patent for putting up quite a different extract of meat, which was solid and was intended to be used as a food, promoted the defendant company as a purchaser of his invention, and became its managing director. He never had any business, although he purported to sell to the company "the goodwill of the business which is now being created by the vendor." There was evidence of actual deception, and the Court of Appeal came to the conclusion that C. K. Valentine adopted the name in dispute for his company for the purpose of getting the benefit of the plaintiffs' reputation (*n*). The decision might therefore have been put upon the ground of fraud, and might have been arrived at without going beyond the earlier cases (*o*) cited below. The decision was, however, placed on the broad ground that the supposed distinction in law between personal names and other descriptive words does not exist (*p*).

*Chivers v.
Chivers.*

The second case, *Chivers & Sons v. Chivers & Co. Ltd.* (*q*), is an example of the difficulties which may occur where the extension of a large business brings it into competition with one which is already established in a particular locality. In that case the plaintiffs carried on the business of jam and jelly

(*mm*) Appendix, p. 760.

(*n*) Per Lord Alverstone, M. R.

(*o*) *E.g.*, *Tussaud's Case* and *Pinet's Case* below, p. 511, and above, pp. 470, 472.

(*p*) The defendants were also restrained from using the word *Valtina*

which they had registered as a trademark. It was subsequently removed from the Register, *Valentine's Tm.*, 18 R. P. C. 175 (1901), Farwell, J.

(*q*) 17 R. P. C. 420 (1900), Farwell, J.

makers at Histon, Cambridgeshire, and by very extensive advertising (r) for some years before the action they had developed a large trade in a particular class of their goods known as "table jellies," especially in the Eastern and Midland counties of England. It was not shown that they had any large or extensive trade in Wales. The goods in question were always described by the plaintiffs on the boxes in which all such goods were sold as *Chivers' Table Jellies*. The defendant company had been formed in the year 1895 by a firm of S. Chivers & Co., in which the senior partner, who became the principal managing director of the company, was Samuel Chivers. The firm, and after its incorporation the company, had carried on a substantial business at Cardiff and in South Wales as jam makers, and were locally well known. In the year 1898 the company commenced to make table jellies, the manufacture of which was, as the learned judge found, a by-product of the jam trade. Their boxes were quite different in appearance (s) from those of the plaintiffs, but they placed upon them their name, S. Chivers & Co. Ltd., and it was this of which complaint was made. They did not themselves use the phrase *Chivers' Table Jellies*, but a number of witnesses, most of whom had never heard of the defendant company, were called to prove that in different parts of the country that phrase or *Chivers' Jellies* was understood to mean the plaintiffs' goods, and that by the use of the defendant company's name their goods might and probably would be passed off as those of the plaintiffs. No case of fraud or of actual deception was made out. It was held that, as the plaintiffs had not established that the secondary meaning of the name *Chivers* for which they contended was universal in Wales as well as in England, or that its original meaning had been lost, they could not succeed. The learned judge said that if they could do so they could also prevent the use of the defendant's name for their old-established jam trade.

(r) The learned judge said (at p. 431), "Advertising distinguished from trade is nothing."

(s) They at first adopted a box which, in some particulars, closely

resembled that of the plaintiffs. It had directions copied from the latter. In a previous action they had consented to an injunction in respect of this box.

Cash v. Cash.

The most recent case on the subject is that of *J. and J. Cash, Ld. v. Cash (r)*. The plaintiffs and their predecessors in business had been for some years carrying on business under the name of Cash, in Coventry, and it was established that "Cash's Frillings," and "Cash's Woven Names," and "Cash's Initials" meant the plaintiffs' goods. The defendant, whose proper name was Joseph Cash, commenced to carry on business, also at Coventry, in goods which included frillings, woven names, and initials. He did not claim the right to describe these as "Cash's Frillings," &c., but to trade in such goods under the name of *Joseph Cash & Company* or *Joseph Cash*. Kekewich, J., said: "Is it possible for Joseph Cash to have a shop in Coventry, and there to sell frillings without those frillings being sold and known as 'Cash's Frillings'? It seems to me, speaking as a jury, and simply applying such knowledge of the world as I can to the subject, that it is impossible that that can be done." An injunction was granted restraining the defendant from carrying on the business of manufacturer or seller of the three kinds of article under the name of Cash, or any other name so as to mislead (s). This case, therefore, as an actual decision, goes further than any other case on the point.

Earlier cases

As the earlier cases on the subject are useful as illustrations of circumstances under which the Court has restrained or limited, or refused to restrain or limit, the use by a defendant of his own name, although they cannot now be relied on as laying down a general principle, the summary of them contained in the former edition of this book has been retained.

Turton v. Turton.

The subject had been previously discussed by the Court of Appeal in *Turton v. Turton (t)*. In that case the plaintiffs, Thomas Turton and Sons, Limited, were carrying on a widely known and extensive business acquired by the company in 1886, but established many years previously, under the name

(r) 18 R. P. C. 213 (1901), Kekewich, J. The case, on application for an interlocutory injunction, is reported 82 L. T. 655 (1900).

(s) The order is printed at length in the Appendix, p. 760.

(t) 42 C. D. 128 (1889), C. A., reversing North, J. In *Reddaway v. Banham*, Lord Macnaghten said he was at a loss to know why this case was ever reported. The plaintiff's case was extravagant and absurd: (1896) A. C. at p. 220.

of *Thomas Turton and Sons*, in Sheffield, and one of the trade-marks of the company bore that name upon it. The defendants, John Turton and his two sons, were carrying on a business of a similar description in the same town. Their business had also been established for many years, although not for so long as that of the plaintiffs. For ten years before June, 1888, its style had been *John Turton & Co.*, but John Turton then took his sons into partnership, and changed the style to *John Turton and Sons*, the name the plaintiffs complained of. There was evidence that the plaintiff company were often referred to as *Turton and Sons*, and *Thomas*, or *T. Turton and Sons*, and there were conflicting affidavits by persons engaged in the trade as to whether the distinction between the trade-names was sufficient to prevent mistakes being made. It was also shown that letters intended for the plaintiffs had, in some instances, been delivered to the defendants, but, apart from the adoption of the addition *and Sons*, in place of *and Co.*, there was no evidence that the defendants' conduct was intended or calculated to pass off their goods as those of the plaintiffs.

Mr. Justice North, at the trial, granted an injunction in the terms of that in *Hendriks v. Montagu* (u); but the Court of Appeal reversed this order, and dismissed the action.

In the view of the facts taken by the Court of Appeal, the defendant, John Turton, was not shown to have done anything to give to the name objected to any other meaning than that he was carrying on business in partnership with his sons; he had not done anything with the intent or for the purpose of making the use of his simple name look as if his name were the name of the plaintiffs. "In some cases," Lord Esher said, "besides using the names, parties have, to use what, I think, is a happy phrase of my brother Cotton's, 'garnished that use'—that is, they have done things besides using the name, in order that the use of that name might look as if it were being used by the old firm. There is nothing of that kind here." Lord Esher's judgment.

Notwithstanding the possibility of mistakes between the

(u) *Ante*, p. 466.

two firms being made by careless people, therefore, the Court held that the defendants were justified in adopting the name complained of, and in continuing its use after the possibility of mistake had been brought to their knowledge, and the action was accordingly dismissed. One may venture to regret that the Court did not adopt the slight extension of the principles appealed to which would have been necessary to forbid the defendants from choosing out of several alternative styles, all equally accurate as descriptions, and equally convenient according to business usage, the only one which was calculated to lead to mistake. If *Turton & Co.* did not suit the defendants, they might have been satisfied with *Turton*, *Turton and Turton*, or *Turton* preceded by the initials of the partners.

A man may describe his firm in the ordinary mercantile way ;

not necessarily by any "fancy name."

The foundation of the judgments of all the Lords Justices was that the statement comprised in the defendant's name was nothing other than a statement of the actual fact that their business was the business of Joseph Turton and his sons, expressed in the "ordinary mercantile way" (*x*), and made "truly, honestly, and in the usual manner in which such statements are made in the course of business" (*y*). The case is, therefore, readily distinguishable from cases where a "fancy name" which is not descriptive of actual facts in ordinary language is appropriated (*z*), such as, for instance, the name—the "Universal Life Assurance Association"—in *Hendriks v. Montagu* (*z*). There is no justification for the adoption and use of any such name if it is calculated to deceive.

Massam v. Thorley.

Massam v. J. W. Thorley's Cattle Food Co., Ltd. (*a*), closely resembled the case of *Tussaud v. Tussaud* already referred to (*b*). There the plaintiffs, as executors of one Joseph Thorley, were carrying on a well-known business in a special food for cattle established by their testator. The defendant company had engaged as their manager J. W. Thorley, who was a brother of Joseph Thorley, and having been in his

(*x*) Cotton, L. J., p. 142.

(*y*) Fry, L. J., p. 147.

(*z*) *Ante*, p. 466 ; and see the latter part of the judgment of Cotton, L. J.,

42 C. D. 145.

(*a*) 14 C. D. 748 (1880), C. A. reversing Malins, V.-C.

(*b*) *Ante*, p. 471.

employment some ten years previously, had become possessed of the recipe according to which the cattle food was made by the plaintiff's testator. J. W. Thorley was also the holder of a one-shilling share in the company. The defendants endeavoured to defend their use of the name which they had adopted on the ground of their relations with J. W. Thorley, but unsuccessfully, and the Court of Appeal were further of opinion that the defendants had imitated the get-up of the plaintiff's goods, and had intentionally acted so as to induce buyers to take their goods for them.

The injunction granted left the defendants at liberty to use their name, and to use the word *Thorley* in connection with their goods (if they could) in any way not calculated to mislead the public (c).

The injunction in this case might, in the view which the Lords Justices took of the facts, have been granted on the fraudulent intention of the defendants alone, for, as appears from the judgments quoted above, it is only the honest use of a man's own name which is ever a defence (d).

And the justification only extends, in any case where it applies, to the use of a man's own name, or that of his predecessor who founded his business and established it under the name which the defendant is using (e); not to the use of that of his servant (f), or of an alleged partner who has really no interest in his business, and has been brought into it only in aid of an attempt to cover the employment of a deceptive name (g). Still less to the use of the name of a stranger (h),

Name must be the defendant's own name;

not a bought name,

(c) See the form of injunction, 14 C. D. 762; and Appendix, p. 750.

(d) See also *Warner v. Warner*, 5 Times L. R. 327, 359; *Huntley & Palmer v. The Reading Biscuit Co.*, 10 R. P. C. 277 (1893), Chitty, J.; and *Clayton v. Day*, where one Day joined one Martin in a fraudulent attempt to carry on business as "Day and Martin," in unfair competition with the well-known firm, 26 Sol. J. 43 (1881), Chitty, J.

(e) See *Pinet v. Maison Pinet, Ltd.*, ante, p. 472; *Turton v. Turton*, ante,

p. 508; *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L. J.

(f) *Southorn v. Reynolds*, 12 L. T. n.s. 75 (1865), Wood, V.-C. (*Southorn's Broseley Pipes*); *Birmingham Vinegar Brewery Co. v. Liverpool Vinegar Co.*, W. N. (1888) 139, North, J., cited p. 464; *Tussaud v. Tussaud*, ante, p. 470.

(g) See *Croft v. Day*, infra; *Schweitzer v. Atkins*, 37 L. J. Ch. 847 (1868); *Dence v. Mason*, W. N. (1877) 23, (1878) 42 (*Brand's Essence of Beef*), both Malins V.-C.

(h) *Isaacson v. Thompson*, 41 L. J.

even though it is alleged that he has authorized the defendant to use it (*i*).

or a name altered to resemble the plaintiff's;

Such practices are badges of fraud rather than grounds of defence. So, where the defendant has altered his name in such a way as to make it more nearly resemble the plaintiff's, the inference is almost inevitable that fraud is intended (*k*), and whether it is or not, the rule in question only applies to the use of the defendant's name in its ordinary form.

but may be the defendant's name of repute.

But it is submitted that the name need not be that which the defendant received from his parents. A name which he has adopted and used until it has come to be his name by repute is as much his name as that by which his parents were known (*l*). Of course, a new name adopted at the time of, or shortly before, the alleged deceptive user of it would generally be taken to have been adopted for fraudulent purposes, even if it could be shown by the date of the trial to have become the defendant's name by repute.

Addition of "limited" to a firm-name.

The name of a company formed by the addition of "limited" to the firm-name of a business which the company takes over stands in the same position as the firm-name itself (*m*).

It must be used *simpliciter*, not garnished to look like the plaintiff's.

In most of the reported cases in which a defendant has been restrained from passing off his goods as those of the plaintiff under cover of a similar name, the defendant has added the "circumstances of fraud," to which Knight-Bruce,

Ch. 101 (1871), Bacon, V.-C. (*Madame Elise*), defendant used his daughter's name, *E. Louise*; interim injunction refused on account of delay. *Parks, Gunston & Tee, Ltd. v. Thompson, Talmev & Co., Ltd.*, 18 R. P. C. 185 (1901), Farwell, J.

(*i*) *Crest v. Day*, 7 Beav. 84 (1843), Langdale, M. R. (*Day and Martin*); *Shrimpton v. Laight*, 18 Beav. 164 (1854), Romilly, M. R.; *Melachrino & Co. v. The Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215 (1887), Chitty, J. See also *Tussaud v. Tussaud and Rendle v. Rendle & Co.*, above, p. 470, note (*l*), and the *Talmev* case, note (*h*).

(*k*) *Taylor v. Taylor*, 23 L. J. Ch. 255 (1854), Wood, V.-C.; *James v. James*, L. R. 13 Eq. 421 (1872), Romilly, M. R. (*Robert Joseph James called himself Robert James*); and see *Slazenger v. Feltham*, 6 R. P. C. 531 (1889), C. A.

(*l*) See per James, L. J., and Bramwell, L. J., in *Massam v. Thorley, &c.*, 14 C. D. 757, 760. It has already been shown that a name of repute is protected as a trade-name: above, p. 463.

(*m*) *Chivers v. Chivers*, above, p. 506. See also *Townsend v. Jarman*, above, p. 497, note (*a*).

L. J., referred, in *Burgess v. Burgess* (*n*), or, in the phrase of Cotton, L. J., in *Turton v. Turton* (*o*), has "garnished the use of his name" by imitating the get-up of the plaintiff's goods (*p*); or his labels and show-cards (*q*), or has issued circulars or advertisements (*r*) calculated to foster the error which the resemblance of his name and that of the plaintiff's was calculated to produce.

Thus, in *Moët v. Clybourn* (*s*), the defendant claimed to be entitled to use the names *Meadows* and *Clybourn*, and, by virtue of such right, to brand upon the corks of his champagne bottles the letters *M. & C.* in a circle on the bottom, and the word *England* at the side, in obvious imitation of the plaintiff's practice. And in *Holt v. Smith* (*t*), the defendant bought the business of H. Newman and changed its name to Newman & Co., in imitation of the plaintiff's trade-name.

The proximity of the place where the defendant sets up his business to that where a well-known firm is already trading may be evidence to show that, although trading under his own name, the defendant is seeking to take fraudulent advantage of its similarity to the plaintiff's name. The case of somebody finding a man named *Bass* and setting up a brewery at Burton as *Bass & Co.* (*u*), and the case of a man starting business as a banker in the Strand under the name of *Coutts* (*x*), have been cited as instances

Proximity
may be a
badge of
fraud.

(*n*) *Ante*, p. 501; e.g., by adding & Co.; *Graveley v. Winchester*, Seb. Dig. p. 162 (1867), Giffard, V.-C.; *Churton v. Douglas*, Johnson, 174; 28 L. J. Ch. 841 (1859), Wood, V.-C.; *Witt v. Concoran*, 2 C. D. 69 (1873), Bacon, V.-C.

(*o*) *Ante*, p. 509.

(*p*) *Holloway v. Holloway*, 13 Beav. 209 (1850), Langdale, M. R., above, p. 503, note (*b*); *Taylor v. Taylor*, note (*k*); *Schweitzer v. Atkins*, note (*g*); *Fullwood v. Fullwood* (1), W. N. (1873), 93, 185, Malins, V.-C., and L. J.J.; *J. H. Brooks & Co., Ltd. v. Norfolk Cycle Co. and John Brookes*, 16 R. P. C. 523, Stirling, J., above, p. 504, note (*d*).

K.

(*q*) *Croft v. Day*; *Melachrino v. The Melachrino Egyptian Cigarette Co.*, note (*i*).

(*r*) *Massam v. J. W. Thorley's Cattle Food Co.*, *supra*, p. 510.

(*s*) Seb. Dig. p. 316 (1877), Jessel, M. R. (*Moët and Chandon*).

(*t*) 4 Times L. R. 329 (1888), Kay, J. Action stayed on the defendant undertaking to use *H. and drop Co.*; defendant to pay costs.

(*u*) James, L. J., in *Massam v. Thorley, &c.*, 14 C. D. p. 757; see above, p. 505.

(*x*) Chitty, J., in *Melachrino v. The Melachrino, &c. Co.*, 4 R. P. C. p. 221.

in which it is scarcely conceivable that the use of the name could be honest (*y*). In *Turton v. Turton* (*z*), the defendants were trading in the same town, Sheffield, as the plaintiff, but their presence there was reasonably accounted for, because their business had been established in the town long before the circumstances which led them to adopt the name complained of arose.

7. The Relief granted.

The relief granted to the plaintiff, if he succeeds in a passing off action, corresponds to that granted in the action for infringement of a registered trade-mark to which the first-mentioned action is so closely allied. It comprises, therefore—(i.) an injunction (*a*); (ii.) an order for the delivery up for destruction, or for the erasure of the names or other badges, of any goods already marked with the deceptive names or badges, and in the possession or under the control of the defendant (*b*); and (iii.) damages in respect of the past interferences with the plaintiff's rights (*c*); or (iv.) an account of the profits made by the defendant by the sale of goods under the deceptive names or badges (*d*), or some one or more of these.

Injunction. The general principles governing the grant of an injunction have been sufficiently considered in the last chapter.

Form of the injunction. The form of the injunction granted varies considerably, according to the nature of the deceptive representation which the defendant is shown to have made use of, or threatened to make use of.

Where he has imitated or adopted the plaintiff's trade-

(*y*) *Lee v. Haley* is another illustration. There the plaintiff's late manager set up in business as the "Pall Mall Guinea Coal Co.," in the Strand, and afterwards removed to 46, Pall Mall. The plaintiffs traded, at 22, Pall Mall, as "The Guinea Coal Co." An injunction was granted; 21 L. T. N.S. 546; 22

ib. 251; L. R. 5 Ch. 155, Malins, V.-C., and Giffard, L. J.

(*z*) Page 508.

(*a*) Last chapter, p. 411. See below, and the orders collected in the Appendix, pp. 748 *et seq.*

(*b*) Page 420.

(*c*) Page 422.

(*d*) Page 422.

name, the order may be an absolute injunction that he shall not carry on business under that name (*e*).

A very full form of order was adopted in *Massam v. Thorley's Cattle Food Co.* (*f*). It restrained the defendant company and their servants from selling, or procuring to be sold, and from in any manner representing any goods manufactured by them as the goods of the late Joseph Thorley or the plaintiffs, his successors; from in any manner representing, or doing anything which should lead to the belief that the defendant company were carrying on the business of the late Joseph Thorley; from affixing to their goods, or otherwise employing, any labels, wrappers, or marks used by him or the plaintiffs, or so contrived as to represent, or lead to the belief, that the goods manufactured or sold by the defendant company were his goods or those of the plaintiffs; and from using or circulating any circulars or advertisements, used or circulated by him or the plaintiffs, or which should in any manner represent or lead to the belief that the defendant company had been or were carrying on the business of the late Joseph Thorley, or were his successors.

Injunction in
Massam v.
Thorley.

But a device or name, which is not a trade-mark or the trade-name of the plaintiff, may always be used by the defendant in any way which is not calculated to deceive, if such way can be found; and the injunction in passing off cases is usually drawn so as to preserve this right, the order not to use a particular device or word being qualified by the addition "so as to represent, or lead to the belief," that the defendant's goods are the plaintiff's (*g*).

Only decep-
tive use of
open word,
&c. restrained.

Thus, in *Massam v. Thorley's Cattle Food Co.*, the Lords Justices refused to prohibit the defendants from using the word Thorley in connection with cattle food altogether (*h*). And in *Slazenger v. Feltham*, the Court of Appeal modified the order of Kekewich, J., forbidding the defendants to stamp

(*e*) As in *Hendriks v. Montagu*, 17 C. D. 638, set out above, p. 466.

(*f*) 14 C. D. p. 762, set out in the Appendix, p. 750.

(*g*) *Slazenger & Sons v. Feltham & Co.*, 6 R. P. C. 531 (1889); *Jay v.*

Ladler, 40 C. D. p. 656; 6 R. P. C. 136 (1888), Kekewich, J.; *Magnolia Metal Co. v. Atlas Metal Co.*, 14 R. P. C. 389 (1897), Collins, J., and C. A.

(*h*) 14 C. D. 763.

Demotic on their lawn-tennis bats, by adding the words "so as to represent that (they) are manufactured by the plaintiffs, or in any other way from passing off their lawn-tennis bats as the goods of the plaintiffs."

Where what is complained of is the deceptive use of an open word, which has come to be associated with the plaintiff's trade or goods, the form of injunction is now generally directed to prevent the defendant from using it "without clearly distinguishing his goods from the plaintiffs." This was the form adopted in the infringement cases *Seiro v. Provezende* (i), and *Johnston v. Orr-Ewing* (k), and in the *Yorkshire Relish* (l), and *The Stone Ales* cases. In the last-mentioned case several of the Lords of Appeal referred to it as the proper form to adopt unless the plaintiff had a claim to the exclusive use of the word, name, or other mark in question (m).

"Without distinguishing, &c."

The Stone Ales Case.

In the last-mentioned case, however, the injunction to restrain the defendant (*inter alia*) from selling beer not of the plaintiff's manufacture, under the term *Stone Ales* or *Stone Ale*, or in any way so as to induce the belief that such ale was of the plaintiff's manufacture, was, under the circumstances, maintained, the Lords of Appeal holding that the *Seiro v. Provezende* form of injunction would be more stringent, as it would, in effect, prevent the defendant using the term *Stone Ale* at all (n).

Temporary or contingent prohibition.

And the defendant has, in some instances, been restrained from using a word or words which could not be used by him at all, except deceptively, so long as this should continue to be the case; for instance, from calling his bitters *Angostura*

(i) L. R. 1 Ch. 194 (1865), Wood, V.-C., and Cranworth, J. C.

(k) 13 C. D. 434; 7 App. Ca. 219, Fry, J., C. A., and H. L.

(l) Above, p. 459. *Bewlay & Co., Ltd. v. Hughes*, 15 R. P. C. 290 (1898), North, J. (*Dindigul Cigars*); and *Grezier and Doyle v. Autran*, 13 R. P. C. 1 (1895), Chitty, J., and C. A. (*Chartreuse*), are other recent examples. See also Lord Macnaghten's judgment in *Reddaway v. Banham*, (1896) A. C. at p. 221; 13

R. P. C. at p. 234.

(m) Lord Watson and Lord Macnaghten: *Montgomery v. Thompson*, (1891) A. C. 217; 8 R. P. C. 361; see also *Thompson v. Bent's Brewery Co., Ltd.*, 8 R. P. C. 479 (1891), Chitty, J. In *The Magnolia Case* (note (g)), Collins, J., granted an injunction in this form, and the plaintiffs unsuccessfully appealed, asking for an absolute prohibition.

(n) See above, p. 485; and *Braham v. Beacham*, there cited.

Bitters until he should find out how to make the real *Angostura Bitters* (o); or from using the name *Radstock Colliery Proprietors* until he should be able to sell coal from Radstock (p).

The *Pinet* cases (q) illustrate the different cases to which the absolute and the limited forms of injunction are respectively applicable. In the first case it was supposed that the assignor to the defendant company had traded under his own name, "Pinet," and a limited injunction was granted. Subsequently it was discovered that this was not his own name, but a name adopted for the purpose of the fraud, and thereupon an absolute injunction was decreed.

No general rule can be laid down as to what additions to the objectionable matter will be sufficient to effect the requisite distinction (r). It must depend upon the circumstances of each case. Where the order is in respect of a word which has, in fact, become the trade-name of the plaintiff's goods, the most careful differentiation of the get-up of the goods (s), and the greatest possible prominence of the defendant's own name (t) upon his labels may not be enough. In such cases the limitation of the order is more likely to mislead the defendant than to protect him in his assumed right to use the word.

The injunction may be limited with reference to the use of the mark in a particular country or market (u).

No rule as to what distinction is sufficient.

Limited to particular market.

(o) *Siebert v. Findlater*, 7 C. D. 801 (1878), Fry, J.

(p) See note (n), *ante*, p. 516.

(q) *Pinet v. Maison Pinet, Ltd.* 14 R. P. C. 933 (1897), C. A.; *Same v. Maison Louis Pinet, Ltd.*, 15 R. P. C. 65, North, J.

(r) "No Court has ever said how the distinction is to be made": per Stirling, J., in *Powell v. Birmingham Vinegar Co.*, (1896) 2 Ch. at p. 64. But see the last chapter, p. 419. In France the Court sometimes settles what may be used: see *Grezier and Doyle v. Aufran*, 13 R. P. C. 1.

(s) In the last case the bottles and labels of the defendants' *Yorkshire Relish* were totally different from

those of the plaintiffs. They are shown in 13 R. P. C. pp. 237, 238, and 240.

(t) In *Daniel and Arter v. Whitehouse*, 16 R. P. C. 71 (1898), North, J., *F. Whitehouse's Brazilian Silver* was held to be an infringement of an order not to use *Brazilian Silver* without distinguishing, &c.

(u) *Curver v. Bowker*, Seb. Dig. p. 350 (1877), Little, V.-C., a trademark case before the Acts; *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L. J.; the action succeeded only as to passing off; the injunction was limited to Ireland. In *Société, &c. de l'Etoile's Tm.*, (1894) 1 Ch. 61; 10 R. P. C. 436, a regis-

Interim
injunctions.

Interim injunctions are granted in passing off actions on the same terms and according to the same principles as in infringement actions (u).

8. Costs, Appeals, and Practice.

And the rules and principles in regard to costs (x), appeals (y), and practice (z), are also the same in both actions, except in so far as they depend upon registration and the Registration Acts, which do not extend to or affect passing off actions.

NOTE.

Rule.

First
exception.

Second
exception.

In *Powell v. Birmingham Vinegar Brewery Co.*, (1896) 2 Ch. at p. 79; 13 R. P. C. at p. 256, Kay, L. J., said: "The law relating to this subject may be stated in a few propositions: (1) It is unlawful for a trader to pass off his goods as the goods of another. (2) Even if this is done innocently it will be restrained (*Millington v. Fox*, 3 My. & Cr. 338). (3) *A fortiori* if done designedly, for that is a fraud. (4) Although the first purchaser is not deceived, if the article is so delivered to him as to be calculated to deceive a purchaser from him, that is illegal (*Sykes v. Sykes*, 3 B. & C. 541). (5) One apparent exception is that where a man has been describing his goods by his own name, another man having the same name cannot be prevented from using it, though this may have the effect of deceiving purchasers (*Burgess v. Burgess*, 3 De G. M. & G. 896; *Turton v. Turton*, 42 Ch. D. 128). (6) But this exception does not go far. A man may so use his own name as to infringe the rule of law. "It is a question of evidence in each case whether there is false representation or not" (per Turner, L. J., *Burgess v. Burgess*, 3 De G. M. & G. 905). So he may be restrained if he associates another man with him, so that under their joint names he may pass off goods as the goods of another person (*Croft v. Day*, 7 Beav. 81; *Clayton v. Day*, 26 Sol. Jour. 43; *Melachrino v. The Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215). (7) Another apparent exception is where a man trading under a patent had a monopoly for fourteen years, and has given the article a descriptive name, he cannot, when the patent has expired, prevent another from selling it under that name (*Young v. Macrae*, 9 Jur. n.s. 322; *Linoleum Co. v. Nairn*, L. R. 7 Ch. D. 831). (8) I am not sure that this would be so if the name so used were the name of the patentee, or even a purely fanciful name not

tered trade-mark case, *Stirling, J.*, said that he did not think limiting the registration would give the applicants, under the circumstances of the case, complete relief. See above, pp. 222 and 414.

(u) Chap. XV., p. 415.

(x) Page 429.

(y) Page 437.

(z) Page 438; forms of pleadings, p. 743.

descriptive. (9) Certainly where there has not been a patent, and an article has been made and sold under a fanciful name not descriptive, so that the article as made by one person has acquired reputation under that name, another trader will not be permitted to use the name for a similar article made by him (*Braham v. Bustard*, 1 K. & M. 417; *Cochrane v. MacNish*, 13 R. P. C. 100). (10) In this last proposition there is again a limitation. If the first maker has slept upon his rights or allowed the name to be used by others until it has become *publici juris*, this Court will not interfere. Third exception.

CHAPTER XVII.

WARRANTY OF TRADE-MARKS AND TRADE DESCRIPTIONS (*a*).

| | PAGE |
|--|------|
| Under the Merchandise Marks Act, 1887 | 520 |
| Implied at common law | 522 |
| Where goods are described by reference to a trade-mark | 522 |
| Pictures ascribed to particular artists | 523 |
| Remedies for breach of warranty | 523 |
| Indemnity to manufacturer employed to apply an infringing mark | 526 |

It is provided by sect. 17 of the Merchandise Marks Act, 1887, that:—

“On the sale or in the contract for the sale of any goods to which a trade-mark (*b*), or mark, or trade description (*c*) has been applied (*d*), the vendor shall be deemed to warrant that the mark is a genuine (*e*) trade-mark and not forged (*f*) or falsely applied (*g*), or that the trade description is not a false trade description (*h*) within the meaning of this Act, unless the contrary is expressed in some writing signed by or on behalf of the vendor and delivered at the time of the sale or contract to and accepted by the vendee.”

This section corresponds to sect. 19 of the Merchandise Marks Act, 1862, but the older section applied only to trade-marks which were applied to goods sold, and the implied warranty was that the trade-marks were “genuine and true, and not forged or counterfeit, and not wrongfully used.”

(*a*) The references in this Chapter are to the Merchandise Marks Act, 1887, which is set out and commented on in Book II.

(*b*) “Trade-mark,” sect. 3 (1), see next page.

(*c*) “Trade description,” sect. 3 (1), p. 570.

(*d*) “Applied,” sect. 3 (2), and sect. 5 (1), p. 567.

(*e*) “Genuine,” cf. sect. 2 (2) (a), p. 608.

(*f*) “Forged,” sect. 4, p. 563.

(*g*) “Falsely applied,” sect. 5 (3), p. 569.

(*h*) “False trade description,” sect. 3 (1), pp. 570, 584.

Trade-mark (*i*) here means registered trade-mark or trade-mark protected by law in any British possession or foreign state to which sect. 103 of the Patents, &c. Act, 1883, is applicable (*k*). The section, however, imports a warranty of the genuineness of unregistered English trade-marks, at any rate when the application of them to the goods is reasonably calculated to lead persons to believe that the goods are the manufacture or merchandise of the proprietor of the trade-mark, and also of any trade-mark, whether registered or not, which the mark applied to the goods purports to be, for in such cases the mark is a false trade description applied to the goods (*l*). "Mark," where it first occurs in the section, can hardly include an unregistered trade-mark, for the warranty implied is that the mark is a genuine trade-mark, that is, a genuine registered trade-mark, and that it does not purport to be. "Mark," where it occurs the second time, should be trade-mark or mark. Trade-mark.

The several terms occurring in the section have the meanings given to them respectively by the sections of the Merchandise Marks Act, 1887, which are referred to in the notes (*m*). The general effect of the implied warranty is that the trade-marks, or marks purporting to be trade-marks, applied to the goods, are used with the assent of the proprietor of the trade-marks which they purport to be, and that the statements made or implied by the trade descriptions are true.

The saving at the end of the section is, it will be observed, very carefully expressed. The statement required to prevent the implication of a warranty must be in writing, signed, delivered at the time of sale, and accepted by the vendee (*n*). Statement in writing to the contrary.

(*i*) "Trade-mark," sect. 3 (1), p. 560.

(*k*) See Chap. XX., p. 545, and the list in the Appendix, p. 762.

(*l*) Sect. 3 (2), p. 588.

(*m*) See Book II., Chap. I., p. 554.

(*n*) The Food and Drugs Act, 1875 (38 & 39 Vict. c. 63), s. 25, enables the vendor to set up as a defence that he purchased the adul-

terated goods under a written warranty and resold them unaltered. See *Laidlaw v. Wilson*, (1894) 1 Q. B. 74; and *Robertson v. Harris*, (1900) 2 Q. B. 117. Sect. 9 makes any alteration in the article without disclosure to the purchaser an offence. A notice exhibited in the shop may be such a disclosure: *Spiers & Pond v. Bennett*, (1896) 2

What "accepted by the vendee" means is not clear. It would probably be construed to import at least that the vendee understood that he was to get no warranty, and that he completed the purchase on that footing.

Implied
warranty at
common law.

Apart from the statutory warranties implied by the Merchandise Marks Act, it is held, at common law (*o*), that when a purchaser orders goods from a firm who are manufacturers only of such goods, and not dealers in them, then, unless it is shown that in the particular trade, or as regards the particular goods, there is a custom for the manufacturer to supply the goods of other makers, the purchaser must be assumed to have contracted with the particular manufacturers in reliance on the general excellence of the work of their firm, and he is entitled (in the absence of any express stipulation to the contrary) to have goods of the manufacturer's own make delivered in performance of the contract (*p*).

Warranty
where goods
are described
by a trade-
mark.

It is a question of fact, or, if there is a written contract, of construction, whether a manufacturer or vendor has agreed to deliver goods, which are referred to by a trade-mark in the contract, stamped with the mark, and being, therefore, goods of the kind properly denoted by it, or whether he has agreed only to deliver goods of the same quality as those which are denoted by the mark. Thus, in *Hopkins v. Hitchcock* (*q*), where the contract was for iron described as "S. and H. (crown) bars," and the vendors were Hopkins & Co., the successors of Snowden and Hopkins, iron marked "H. & Co." with a crown was delivered, and the jury found that the mark

Q. B. 65. Knowledge of the adulteration on the purchaser's part is not a defence: *Heywood v. Whitehead*, 76 L. T. 781 (1897). Under sect. 17 of the Merchandise Marks Act, such questions can hardly arise. The statement in writing must, if the construction in the text is adopted, be a term of the contract. Disclosure that, for example, a trade-mark is not genuine without the statement would not prevent a warranty being implied. Under the Food and Drugs Act proof of scienter is necessary to a conviction for giving a false

warranty, *Derbyshire v. Houlston* (1897), 1 Q. B. 772.

(*o*) Warranties of the genuineness of marks are implied, in respect of *anchors and chain cables*, by 37 & 38 Vict. c. 51, s. 4, and in respect of *hops*, by 29 & 30 Vict. c. 37, s. 8.

(*p*) Per Cotton, L. J., in *Johnson v. Raylton*, 7 Q. B. D. 438 (1881), Cotton and Brett, L. JJ., Bramwell, L. J., dissenting; *Starcy v. Chilworth Gunpowder Co.*, 24 Q. B. D. 90 (1889), Div. Court.

(*q*) 14 C. B. N.S. 65; 32 L. J. C. P. 154 (1863).

was not a material part of the bargain. Judgment was given for the vendors in an action for the price of the iron, and the Court of Queen's Bench upheld the judgment, on the ground that the contract was for iron of a particular quality, not for iron bearing a particular mark.

A somewhat similar question has arisen upon sales of pictures under the names of the supposed painters of them, and in such cases the matter to be decided is whether the use of the artist's name amounts to a warranty by the vendor that the picture in question is his, or merely to an expression of the vendor's opinion. Pictures ascribed to particular artists.

In a case where pictures had been sold as "Views in Venice, Canaletto," and they were not by Canaletto (*r*), the question was left to the jury; but where the supposed artist was an old master, Lord Kenyon, at *Nisi Prius*, held that it was impossible to make the case one of warranty. The pictures, he said, were the work of artists of some centuries back, and there being no way of tracing the picture itself, it could only be matter of opinion whether the picture in question was the work of the artist whose name it bore or not; the catalogue only expressed the opinion of the vendor, but left the determination to the buyer's own judgment (*s*).

The remedy for breach of warranty, whether implied under the section set out above, or at common law (*t*), or imported by express agreement in any contract in regard to goods sold or agreed to be sold, is an action for damages, reduction of the agreed price, or rescission of the contract. The rules determining the nature and extent of the remedy are now contained in the Sale of Goods Act, 1893 (*u*), from which the following sections are quoted:— Remedy for breach of the warranty.

"53.—(1.) Where there is a breach of warranty by the seller, or where the buyer elects, or is compelled, to treat any breach of a condition on the part of the seller as a breach of warranty, the buyer is not by

(*r*) *Power v. Barham*, 7 C. & P. 356; 4 Ad. & E. 472; 5 L. J. K. B. n.s. 88 (1835) (Canaletto died in 1768). The jury found there was a warranty. P. C. 572 (1797) (Teniers and Claude Lorraine, who died in 1694 and in 1682 respectively).

(*t*) See Benjamin on Sale, Book IV., Part II., Chap. I.

(*s*) *Jendwine v. Slade*, 2 Esp. N. (*u*) 56 & 57 Vict. c. 71.

reason only of such breach of warranty entitled to reject the goods; but he may—

“ (a.) Set up against the seller the breach of warranty in diminution or extinction of the price; or

“ (b.) Maintain an action against the seller for damages for the breach of warranty.

“ (2.) The measure of damages for breach of warranty is the estimated loss directly and naturally resulting, in the ordinary course of events, from the breach of warranty.

“ (3.) In the case of a breach of warranty of quality such loss is *prima facie* the difference between the value of the goods at the time of delivery to the buyer and the value they would have had if they had answered to the warranty.

“ (4.) The fact that the buyer has set up the breach of warranty in diminution or extinction of the price, does not prevent him from maintaining an action for the same breach of warranty if he has sustained further damage.

“ (5.) Nothing in this section shall prejudice or affect the buyer’s right of rejection in Scotland as declared by this Act.”

“ 54. Nothing in this Act shall affect the right of the buyer or seller to recover interest or any special damages in any case where by law interest or special damages may be recoverable, or to recover money paid where the consideration has failed.”

Rescission of the contract for breach of warranty. When condition is to be treated as warranty.

The right to rescind the contract and return the goods is dealt with by an earlier section of the same Act.

“ 11.—(1) In England or Ireland—

“ (a.) Where a contract of sale is subject to any condition to be fulfilled by the seller, the buyer may waive the condition, or may elect to treat the breach of such condition as a breach of warranty, and not as a ground for treating the contract as repudiated.

“(b.) Whether a stipulation in a contract of sale is a condition the breach of which may give rise to a right to treat the contract as repudiated, or a warranty the breach of which may give rise to a claim for damages, but not to a right to reject the goods and treat the contract as repudiated, depends in each case upon the construction of the contract. A stipulation may be a condition, though called a warranty in the contract (*x*).

“(c.) Where a contract is not severable, and the buyer has accepted the goods, or part thereof, or where the contract is for specific goods, the property in which has passed to the buyer, the breach of any condition to be fulfilled by the seller can only be treated as a breach of warranty, and not as a ground for rejecting the goods and treating the contract as repudiated (*y*), unless there be a term of the contract, express or implied, to that effect.

“(2.) In Scotland, failure by the seller to perform any material part of a contract of sale is a breach of contract, which entitles the buyer either within a reasonable time to reject the goods and treat the contract as repudiated, or to retain the goods and treat the failure to perform such material part as a breach which may give rise to a claim for compensation or damages. The Scotch rule.

“(3.) Nothing in this section shall affect the case of any condition or warranty, fulfilment of which is excused by law by reason of impossibility or otherwise.”

The warranty implied by the Merchandise Marks Act will accordingly operate to enable an innocent purchaser of goods which have been forfeited under that Act, or which have led to a prosecution, entailing expenses upon him, to recover damages in respect of the loss or expenses from the vendor, for such damages directly and naturally Damages for breach of warranty of trade-mark.

(*x*) See *Behn v. Burness*, 3 B. & S. 460 (1831); *Heyworth v. Hutchinson*, 756; 32 L. J. Q. B. 204 (1863), L. R. 2 Q. B. 447 (1867); *Hooper v. Blackburn on Sale*, 2nd ed., p. 198. *Balfour*, 62 L. T. 646 (1890); *Re Green*

(*y*) *Street v. Blay*, 2 B. & Ad. and *Balfour*, 63 L. T. 97, 325 (1890).

result in the ordinary course of events from the breach of warranty. It will also enable the purchaser to recover from the vendor any damages which may have been recovered from the purchaser by a sub-purchaser upon a resale by him, at any rate where the goods were known by the vendor to have been bought for the purpose of resale (z).

Indemnity to manufacturer infringing a trade-mark at his customer's request.

A manufacturer has at common law, and apart from any question of implied warranty, a right of indemnity by his customer, if, in compliance with the customer's orders, he innocently places a mark upon goods made for him, and the mark turns out to be an infringement of some third person's trade-mark, so that the manufacturer is rendered liable to an action by the owner of the trade-mark (a).

(z) *Hammond v. Bussey*, 20 Q. B. D. 79 (1887), C. A.; *Agius v. Great Western Colliery Co.*, (1899) 1 Q. B. 413. See further, as to consequential damages, *The Argentino*, L. R. 13 P. D. 191 (1888), C. A.

(a) *Dixon v. Faucus*, 3 Ell. & Ell.

537; 30 L. J. Q. B. 137 (1861). As to the defence of the manufacturer in any such case upon proceedings under the Merchandise Marks Act, see sect. 2 (2), sect. 6, and sect. 19 (3) of that Act, and Book II., Chap. I., below.

CHAPTER XVIII.

TRADE-LIBEL.

| | PAGE |
|--|------|
| No action for threats lies in respect of a trade-mark | 527 |
| but a threat may be libel, or slander of title | 528 |
| A warning against infringements may be issued in good faith .. | 528 |
| suggestion that goods are spurious | 529 |
| special damage must be proved | 531 |
| a threat or warning may be made, if <i>bonâ fide</i> | 532 |
| Misleading report of a trade-mark action | 532 |
| True statements are not libellous | 533 |
| Publication of an apology | 534 |
| Statements, pending proceedings, may be contempt of Court .. | 534 |
| although published in reply | 535 |
| undertaking as to damages | 535 |
| contempts by editors of newspapers | 535 |
| Injunctions to restrain trade-libels | 536 |
| interlocutory injunctions | 536 |
| The right of action survives to executors | 537 |

UNDER sect. 32 of the Patents, &c. Act, 1883, an action for damages or an injunction lies against any person claiming to be a patentee, who by circulars, advertisements, or otherwise, threatens any other person with legal proceedings or liability, at the instance of anyone who is aggrieved by the threats (a). The section does not extend to threats in respect of the use of a trade-mark or trade-name, and there is no precisely corresponding right apart from it. So that the publication in good faith of a statement that the plaintiff is infringing the defendant's trade-mark, and that the defendant intends to

There is no
threats action
in respect of a
trade-mark ;

(a) See Edmundson Patents, p. 348. 2nd ed., p. 470; Lawson on the Patents, &c. Acts, 3rd ed., p. 321; *Challender v. Royle*, 36 C. D. 425; 4 R. P. C. 363 (1887), C. A.; *Johnson v. Edge*, (1892) 2 Ch. 1; 9 R. P. C. 112, C. A.; and *Skinner v. Shew*, (1893) 1 Ch. 413; and as to damages, *S. C.*, (1894) 2 Ch. 581; and *Skinner v. Perry*, 11 R. P. C. 406 (1894).

take proceedings against all persons dealing in the infringing goods, is not actionable, and cannot be restrained by injunction (*a*). In a recent passing off case (*b*), a counterclaim which alleged threats merely without malice was ordered to be struck out as disclosing no reasonable cause of action.

but the threats may amount to libel or slander of title.

But disparaging statements calculated to injure the plaintiff's trade or to diminish the value of his goods, if they are not made in good faith, are actionable; and the continued publication of them after they have been shown, or have been held by the Court (*c*), to be untrue may be restrained (*d*). For they amount to libels on the plaintiff in the way of his trade, or to slander of title (*e*).

A warning against infringements, &c. may be issued in good faith.

A fair warning to the public, or to probable purchasers of the goods, or to customers of the businesses concerned, by a trader that he regards the conduct of another as an infringement of his rights, if published in good faith, and in the belief that it is well-founded, is not libellous (*d*), although it may turn out to be mistaken (*f*). So, anyone who thinks his trade-name is likely to be confused with that of another business may publish a warning that there is no connection

(*a*) *Colley v. Hart*, 44 C. D. 179; 6 R. P. C. 17 (1888), North, J. (interim injunction refused as to the trade-mark). Also at the trial, 7 R. P. C. 101, at p. 113.

(*b*) *Ripley v. Arthur & Co.*, 18 R. P. C. 82 (1901) Farwell, J.

(*c*) *Burnett v. Tak*, 45 L. T. 713 (1882), Kay, J.

(*d*) *Wren v. Weild*, L. R. 4 Q. B. 730 (1869), a patent threats action before the Act of 1883. In *Halsey v. Brotherhood*, 19 C. D. p. 392 (1881), a similar action, Lindley, L. J., said: "*Wren v. Weild* comes to this: that if I am a patentee, so long as I act honestly, I am entitled to say, without running the risk of having an action for damages brought against me, that somebody is infringing my patent, or that somebody else's manufacture is an infringement of my patent. . . . If I

say it dishonestly, I am so liable; and if I know that what I say is untrue, it would not take much to persuade a jury that I was acting dishonestly."

(*e*) A false and malicious statement in writing, printing, or by word of mouth, injurious to any person's title to property, and causing special damage, is an actionable slander of title. Tindal, C. J., in *Malachy v. Soper*, 3 Bing. N. C. 371 (1835).

(*f*) In *Dicks v. Brooks*, 15 C. D. p. 40 (1880), Bramwell, L. J., said: "Although, according to our opinion, they would have been wrong in their law with respect to its being a piracy, I think their saying so would not have been actionable, because a man is not bound to be correct in his statement of law, though he is bound to be correct in his statement of

between his business and the other (*g*). And this, notwithstanding the pendency of proceedings in which the right of the proprietor of the other to use the name or marks he has adopted comes into question (*h*). But under pretence of the honest publication of a fair warning there is no excuse for an allegation that the goods of the other party are spurious (*i*), or that he is foisting a fictitious article upon the public (*g*), or is fraudulently endeavouring to pass off his goods as those of the person who issues the advertisement or circular complained of (*k*).

Thus, in *Thorley's Cattle Food Co. v. Massam* (*l*), the defendants had published an advertisement warning the public that any goods purporting to be Thorley's Cattle Food, and not signed by their trade-name "Joseph Thorley," were not of their manufacture, and alleging that they were the only persons possessed of the secret recipe according to which the food was compounded, and also a circular stating that the plaintiffs were seeking to "foist upon the public an article which they pretend is the same as that manufactured by the late Joseph Thorley." The defendants were the executors of the late Joseph Thorley, the inventor of the cattle food, and they were carrying on his business; but the statement that they alone possessed the secret recipe, and the suggestion that the goods of the plaintiffs were not prepared according to it, were both false, for one Josiah Thorley, a brother of Joseph

Suggestion that the plaintiff's goods are spurious.

facts." "To support such an action it is necessary for the plaintiffs to prove (1), that the statements complained of were untrue; (2), that they were made maliciously, *i.e.*, without just cause or excuse; (3), that the plaintiffs have suffered special damage thereby": per Lord Davey, in *Royal Baking Powder Co. v. Wright, Crossley & Co.*, 18 R. P. C. 95 (1901), H. of L. See also the passage as to *bona fides*, below, p. 532.

(*g*) *Thorley's Cattle Food Co. v. Massam*, 14 C. D. 763 (1880), C. A. ;

William Coulson and Sons v. James Coulson and Sons, 3 Times L. R. 740 (1887), Div. Court. In the last case the defendants added to their warning a statement that the plaintiff firm was lately bankrupt.

(*h*) *Coats v. Chadwick*, (1894) 1 Ch. 347, Chitty, J.; see p. 534, below; *Anderson v. Liebig, & Co.*, 45 L. T. 757 (1881), Chitty, J.

(*i*) *Thorley's Case*, *supra*.

(*k*) *Coats v. Chadwick*, *supra*.

(*l*) *Supra*; *Liebig, & Co. v. Anderson*, 55 L. T. 206 (1887), Chitty, J.

Thorley, who had obtained the recipe from him, was manager of the plaintiff company (*m*). An injunction was granted at the trial to restrain the defendants from advertising, or representing, or suggesting in their advertisements or circulars, that they, or the proprietors of their testator's business, were alone possessed of the secret recipe, and from representing or suggesting, or doing anything calculated to represent or suggest, that the cattle food manufactured or sold by the plaintiffs was spurious or not genuine.

And in *Thomas v. Williams* (*n*), the publication of circulars suggesting that the goods of the plaintiff were not genuine, but were imitations of goods sold by the defendants, was restrained.

But a mere puff of the defendant's own goods, or a statement that they are superior to those of a rival trader, even if untrue and the cause of damage to the latter, is not actionable (*o*). And it cannot be made actionable by proof of malice (*o*).

(*m*) A suit for an injunction by the executors to restrain the use of the name *Thorley's Cattle Food* by the company had been abandoned, after an application in it for an interim injunction had failed; 6 C. D. 583, Malins, V.-C. But, subsequently, the executors succeeded in a trade-name and passing-off action against the company, *ante*, p. 510.

(*n*) 14 C. D. 864 (1880), Fry, J.; *Liebig, &c. Co. v. Anderson*, note (*l*) "only genuine brand."

(*o*) *Hubbuck v. Wilkinson*, (1899) 1 Q. B. 86, C. A., adopting the opinion expressed by Herschell, L.C., in *White v. Mellin*. In the latter case ((1894) 3 Ch. 276; (1895) A. C. 151), the defendant, a chemist, had placed upon the goods of the plaintiff, Mellin, which he sold, an advertisement of *Vance's Food*, a rival food for infants. The advertisement stated that *Vance's Food* was "far more

nutritious and healthful" for infants and invalids "than any yet offered." The plaintiff complained of this as a trade-libel. Romer, J., dismissed the action at the close of his case. The C. A. ordered a new trial, but this order was reversed by the H. L. on the ground that neither the untruth of the statement complained of, nor that it had caused special damage to the plaintiff, had been proved. Both points were essential to the plaintiff's case. Lord Watson also held that, notwithstanding the manner in which the statement had been affixed to and sold with the plaintiff's goods, it was not, in any legal sense, published of and concerning them. Lord Herschell said (at p. 164): "I entertain very grave doubts whether any action can be maintained for an alleged disparagement of another's goods merely on the allegation that the goods sold by the party who is alleged to have

In an action for a trade-libel, as distinguished from an ordinary personal libel, proof of special damage—*i.e.*, that the publication of the libel has actually injured the business or property of the plaintiff—is essential (*p*). If the libel is “in its very nature intended, or reasonably likely to produce,” and “in the ordinary course of business does produce, a general loss of business, as distinct from the loss of this or that known customer, evidence of such general decline of business is admissible” to prove special damage (*q*).

Special damage must be proved.

If the injury proved is trifling and no threat to repeat the publication is proved, the action should be dismissed (*r*).

The interruption of an illegal trade cannot be legal damage (*s*).

And in a case where the only evidence of damage to the plaintiff, by the publication of a libellous circular misstating the result of an action for passing off the plaintiff's goods as those of the defendant, was the plaintiff's own affidavit alleging that his business had fallen off, and the plaintiff had delayed bringing his action for three months after he first knew of the publication, North, J., assessed the damages at 5*l.*, but granted an injunction, and gave the plaintiff the costs of the action (*t*). But a disparaging statement with regard to a trader's goods may be an ordinary libel upon the

Statement may be a personal libel.

disparaged his competitor's goods are better either generally or in this or that particular respect than his competitor's are.” His lordship put aside the question of malice. The other learned lords concurred in this view. See also *Magnolia Metal Co. v. Tandem Smelting Syndicate*, 17 R. P. C. 477 (1900), H. of L.

(*p*) *White v. Mellin*, *supra*, approving *Evans v. Harlow*, 5 Q. B. 624 (1814); *British Empire Type Co. v. Linotype Co.*, 79 L. T. 8 (1898), C. A. *Royal Baking Powder Co. v. Wright, Crossley & Co.*, 18 R. P. C. 95 (1901), H. of L. The contrary had formerly been held: see cases cited in *White v. Mellin* and *Hayward v. Hayward*, *infra*.

(*q*) *Ratcliffe v. Evans*, (1892) 2 Q. B. 524, C. A.

(*r*) *Dicks v. Brooks*, 15 C. D. 22 (1879), C. A. There the defendants, who owned the copyright in an engraving of Millais' “Huguenots,” had threatened proceedings against persons who bought copies of the plaintiff's paper containing a wool-work pattern, wrongly alleged to be an infringement of the copyright. Only two or three numbers were shown to have been returned or not sold in consequence of the threats.

(*s*) Per Lord Robertson, in *Royal Baking Powder Co.'s Case*, note (*p*).

(*t*) *Hayward & Co. v. Hayward & Sons*, 34 C. D. 198 (1886).

trader personally and, accordingly, be actionable without proof of special damage. Such, for instance, would be the case if the goods were described as worthless (*t*) or spurious (*u*). To write of a trader that he sells such goods is clearly defamatory.

A threat or warning may be made, if *bonâ fide*.

It is essential, in order to entitle the plaintiff to redress in respect of the publication of a threat or warning, that he should make out that the statements complained of are not published in good faith. He must show that the defendant was not saying what he did in defence of his own right, or, as he believed, in defence of his own right—for the defendant might make a mistake (*x*). Upon an application, therefore, for an interim injunction to restrain the publication of threats by the defendant, it is not sufficient proof, if it is any evidence at all, of want of good faith, to show that he has commenced an action for infringement of trade-mark, or for passing off goods against the plaintiff, but has neglected to apply in it for an interlocutory injunction (*y*); nor to show even a long delay in bringing an action for infringement, if the delay is reasonably explained (*z*).

Misleading report of a trade-mark action.

The publication of a misleading report of a trade-mark action, or of an order obtained by the successful party therein either at the trial or on an interlocutory application, may be a trade-libel falling within the principles of the cases referred to in this chapter. Thus, where an action for passing off had failed and been dismissed without costs, because the evidence showed only a few instances of representations that the defendant's goods were those of the plaintiffs, and also that

(*t*) *British Empire Type Co. v. Linotype Co.*, 79 L. T. 8 (1898). The defendants published a statement that the plaintiffs' machines had been removed, after a very short trial, from several newspaper offices. The plaintiffs got a verdict at the trial, and the C. A. refused a new trial on the ground stated in the text.

(*u*) See *The Liebig Case*, above, p. 530.

(*x*) Per Lindley, M. R., in *Royal*

Baking Powder Co. v. Wright, Crossley & Co., 16 R. P. C. 217, (1899) C. A. In the House of Lords the decision was unanimously affirmed, the majority of the learned lords holding that special damage was not proved, 18 R. P. C. 95.

(*y*) *Anderson v. Liebig's Extract of Meat Co.*, 45 L. T. N.S. 757 (1881), Chitty, J.; and note (*s*).

(*z*) *Incandescent Gas Light Co. v. Sunlight Incandescent Co.*, 14 R. P. C. 180 (1897), Stirling, J.

these representations were made by the defendant's agents without his knowledge or authority, the defendant offered an undertaking that he would never make such representations, and this undertaking was inserted in the order at the desire of the judge. The plaintiffs then published a circular headed "Caution," which, referring to the action, alleged that:—

"By the judgment the defendant was ordered to undertake not to represent that his firm is, or that the plaintiff's firm is not, the original firm of Richard Hayward & Co.," and added that the plaintiffs, "finding that serious misrepresentations were in circulation to their prejudice, felt themselves compelled to bring the above action." In a subsequent action (*a*), brought by the former defendants against the former plaintiffs, the circular was held to be untrue and libellous, and to have been published maliciously, and an injunction was granted to restrain its further publication.

So far as the case against an advertisement or other publication rests upon its being a libel, proof that the statements complained of in it are, in fact, true, is an answer to any action for damages, or an injunction in respect of its publication (*b*). It makes no difference that ignorant readers might misunderstand it (*c*).

True statements are not libellous.

Accordingly, an action for publishing a statement that certain persons, meaning the plaintiff company, had wrongfully used the word *Singer* to designate machines not manufactured by the *Singer* company, which came on for trial after the *Singer* company had established, in a passing off action against the plaintiff company, that the use of the word by the latter was actually wrongful, was dismissed with costs (*b*).

The meaning of the statements complained of is determined by the Court itself, and unless circumstances are proved tending to show that their actual meaning, in the particular

Evidence to construe the libel.

(*a*) *Hayward & Co. v. Hayward & Sons*, 34 C. D. 198 (1886), North, J.; *Liebig's, &c. Co. v. Anderson*, 55 L. T. 206 (1887), Chitty, J.

(*b*) *Nähmaschinen Fabrik, &c. v. Singer Manufacturing Co.*, 10 R. P. C.

310 (1893), Romer, J.; and the *Baking Powder Case*, note (*x*).

(*c*) *Incandescent Gas Light Co. v. Sunlight Incandescent Co.*, 14 R. P. C. 180 (1897), Stirling, J.

case, is different from the natural meaning, evidence cannot be adduced to prove that they were not understood according to it (*d*).

Solicitor.

A solicitor who has made the publication merely as agent for the real defendants should not be joined as a defendant (*e*).

Publication of an apology.

So the publication of an apology actually made by the plaintiffs to the defendants is justifiable, though it may have been extracted from the plaintiffs under duress of civil or criminal proceedings in respect of the false marking of their goods (*f*).

But a statement pending proceedings, whether true or not, may be a contempt of Court.

But the publication of a statement which turns out to be true may be improper pending legal proceedings in which the matters it refers to are in issue, not as being libellous, but as contempt of Court, if it tends to interfere with the fair trial of the action, or to embarrass one of the parties in the preparation or conduct of his case. And such contempt may be punished by imprisonment (*g*), fine, or sequestration of goods, or the publication may be restrained by injunction, upon a summary application by motion in the action (*h*). The reluctance of the Court to interfere by interlocutory injunction to restrain the further publication of an alleged libel which the defendant justifies, does not extend to such cases as these. As already stated, the parties are at liberty to warn the trade as much as they like, notwithstanding the pendency of the action; but they are bound to refrain during its pendency from public discussion on the merits or demerits of the case (*i*). "You can warn as much as you like," Kay, J., said, in *Goulard v. Lindsay* (*h*), "but can you advertise: 'I have brought an action against A. B. which is certain to succeed'?" And the

(*d*) Note (*x*), above.

(*e*) Note (*e*), above.

(*f*) *Fisher v. Apollinaris Co.*, L. R. 10 Ch. 297 (1875), L. J.J.

(*g*) *Rouch v. Hull*, 2 Atk. 469 (1742), Hardwicke, L. C. The respondents were imprisoned for publishing statements calling some of the witnesses "affidavit men." *Kitcat v. Sharp*, 31 W. R. 227 (1883), Fry, J. (defendant restrained

from publishing the statement of claim and correspondence).

(*h*) *Coats v. Chadwick*, (1894) 1 Ch. 317, Chitty, J. The plaintiffs, in an action for passing off, were restrained from publishing a circular charging the defendants with fraudulent imitation of their goods. *Goulard v. Lindsay*, 4 R. P. C. 189 (1887), Kay, J. (a patent case).

(*i*) Per Chitty, J., (1894) 1 Ch. 350.

learned judge added that to advertise a positive statement that the defendants had infringed the plaintiff's patent was wrong.

It is no answer to an application for an injunction in respect of a publication alleged to be a contempt of Court, to say that it was made in reply to a statement published by the applicant himself with reference to the same matter, although this circumstance may influence the Court in dealing with the costs of the application (*k*).

Statement in reply to one published by the other side.

But every publication bearing upon the matters in question *pendente lite* is not a contempt. A fair and accurate report of interlocutory proceedings, for instance, is allowable (*l*). And the Court may refuse to restrain a report which it thinks unfair or discreditable to the persons responsible for it, if not convinced that the report is calculated to obstruct the course of justice, or to prejudice the public mind (*m*).

Where the publication of a statement *pendente lite* is restrained as being a contempt of Court, the applicant is not required to give an undertaking to be answerable in damages to the respondent for any loss occasioned by the injunction if it turns out that the respondent was in the right (*n*), as is usual upon the grant of an interlocutory injunction, for the publication is wrong in any event, whether the statements are found in the end to be false or to be well-founded.

Undertaking as to damages.

The rule under which the publication of biased comments reflecting on matters in issue in pending litigation and calculated to interfere with the fair trial of the action, is restrained, is of general application, and it is not confined to publications made by, or at the instance of, interested parties.

Contempts by newspaper editors.

(*k*) *Coleman v. West Hartlepool Ry. Co.*, 8 W. R. 734 (1860), Wood, V.-C.

(*l*) A newspaper report published contemporaneously, if otherwise libellous, would be privileged under the Law of Libel Amendment Act, 1888.

(*m*) *Brook v. Evans*, 29 L. J. Ch. 616 (1860), Stuart, V.-C., and L. J.J. The plaintiffs advertised that they

had established that they first used the word *Glacé*, but that the defendants relied on the lapse of time as an answer to the motion, although the plaintiffs had constantly protested against the defendants' use of the word. The defendants, in fact, had not been called upon on the motion.

(*n*) *Fenner v. Wilson*, (1893) 2 Ch. 656, Kekewich, J.

Applications under it to commit the editors of newspapers were very frequent a few years ago, and, in spite of the constantly expressed reluctance of the judges to interfere where it is not necessary to protect the fair prosecution of the action (*o*), the applications generally result in the costs incurred, or part of them (*p*), and sometimes a substantial fine (*q*), being thrown upon the respondents if they have ventured at all beyond a mere accurate report, or a colourless account of the proceeding.

Injunction to restrain trade-libels.

Before the Judicature Act the Courts had no jurisdiction to restrain the publication of a libel, even though it affected the plaintiff's trade or property (*r*); but the jurisdiction is conferred by that Act upon all the divisions of the High Court, and it has been exercised in many cases (*s*).

Interlocutory injunction.

The Court has also jurisdiction to interfere by interlocutory injunction to restrain the further publication of an alleged trade-libel, which is the subject of an action, until the hearing (*t*). But it will only do so if it is satisfied, upon the facts and evidence before it, that the statements complained of are false (*u*), however much the balance of convenience

(*o*) In *Re Clements*, 46 L. J. Ch. 383 (1877), Jessel, M. R., said: "I say that a judge should be most careful to see that the cause cannot be fairly prosecuted to a hearing unless this extreme mode of dealing with persons brought before him on accusations of contempt should be adopted." In *The Plating Co. v. Farquharson*, 17 C. D. 49 (1881), the C. A. dismissed an application to commit the editor of a paper in respect of an advertisement asking for subscriptions and evidence to assist the appeal in a patent case. In *Re Martindale*, (1894), 3 Ch. 193, North, J., refused with costs motions to commit the editors of several papers who had innocently copied from another paper.

(*p*) See *Duncan v. Sparling*, *The Times*, 9th March, 1894.

(*q*) *Re The Crown Bank*, 44 C. D. 649 (1890) (a bad case of contempt).

(*r*) *Prudential Assurance Association v. Knott*, L. R. 10 Ch. 142 (1875), Cairns, L. C. and L. J.

(*s*) *Thorley's Cattle Food Co. v. Massam*, 6 C. D. 582 (1877), Malins, V.-C.; 14 C. D. 763 (1880), Malins, V.-C., and C. A.; *Thomas v. Williams*, 14 C. D. 864 (1880), Fry, J.; *Saxby v. Easterbrook*, 3 C. P. D. 339 (1878), Div. Court, and the cases cited below.

(*t*) *Lee v. Gibbings*, 67 L. T. 263 (1892), Kekewich, J., and the cases next cited.

(*u*) *Collard v. Marshall*, (1892) 1 Ch. 571, Chitty, J. The libel was that the plaintiffs were "sweaters," and that their work was not properly executed. The defendants said the statements were, in substance, true, but did not suggest that they had any further evidence not before the Court. They were willing to treat the motion as the trial. An interim