

may be in favour of staying the publication (*x*), and only in the clearest cases (*y*)—where, as it has been put, the plaintiff's case is so strong that if the jury at the trial found for the defendant, their verdict would be set aside as unreasonable (*z*).

For the question, libel or no libel, is peculiarly a question for a jury; and in order to interfere before the hearing the Court must determine that question in advance, without the jury's assistance (*z*). The reluctance to interfere by interlocutory injunction is so strong, that the cases cited of *Bonnard v. Perryman* (*a*), and *Monson v. Tussaud* (*b*), seem to show that, where the defendant alleges justification, and reserves the particulars of his case and the evidence in support of it, the injunction ought never to be granted. In any case, the probability of very serious injury to the plaintiff if the libellous statements are allowed to continue must be made out (*c*).

An action in respect of a trade-mark for slander of title, unlike a mere personal libel, survives to the executors since it occasions an injury to the estate of the testator (*d*). Action survives to executors.

injunction was granted. *Punch v. Boyd*, 16 L. R. Ir. 476 (1885).

(*x*) *Société des Manufactures des Glaces v. Tilghman's Patent Sand Blast Co.*, 25 C. D. 1 (1883), C. A.

(*y*) *Monson v. Tussaud*, (1894) 1 Q. B. D. 671, C. A., per Davey, L. J. (case of a personal libel).

(*z*) Per Lord Esher, M. R., in *Coulson v. Coulson*, 3 Times L. R. 846, adopted in *Bonnard v. Perryman*, (1891) 2 Ch. 269, C. A.; *Lee v. Gibbings*, *supra*.

(*a*) See note (*z*).

(*b*) Note (*y*). These were not, however, trade libels, but the rule was applied in *Champion & Co. v. The Birmingham Vinegar Brewery Co.*, 10 Times L. R. 163 (1893), Div. Court, which was a trade case.

(*c*) *Salomons v. Knight*, (1891) 2 Ch. 294, North, J., and C. A.; *Mogul Steamship Co. v. McGregor, Gow & Co.*, 15 Q. B. D. 476 (1885), Coleridge, L. C. J., and Fry, L. J.

(*d*) *Hatchard v. Mege*, 18 Q. B. D. 771 (1887), Div. Court.

CHAPTER XIX.

TRADE-SECRET AND TRADE-NAME.

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Use of the
trade-name
of a secret
preparation.

It has been shown that anyone is entitled to use a name or mark for the goods to which that name or mark is properly applied (*a*). Thus, anyone who is in possession of goods made or sold by the owner of a trade-mark or trade-name, may apply the trade-name or trade-mark to them (*b*), and may, for instance, replace the old labels upon the goods by new ones (*c*). So, the name of a secret preparation may be used by anyone for goods actually prepared according to the recipe (*d*), for they are the goods indicated by the name, whether prepared by the original inventor of the recipe, or his successors in business, or not. Until the secret is discovered or betrayed the goods of the original inventor or his successors can be the only goods to which the

(*a*) See Chap. II., p. 32, and Chap. XV., p. 368.

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

(*c*) *Farina v. Silverlock*, 6 De G. M. & G. 214; 26 L. J. Ch. 11 (1856), Cranworth, L. C., cited, p. 32.

(*d*) *Canham v. Jones*, 2 V. & B. 218; 13 R. R. 70 (1813), Plumer, V.-C. (*Veluo's Vegetable Syrup*). The case was decided on demurrer, although the bill alleged facts which would now

be held sufficient to support a passing-off case like that of *The Yorkshire Relish*, note (*e*). *James v. James*, L. R. 13 Eq. 421 (1872), Romilly, M. R. (*Lieutenant James' Horse Blister*); *Condy v. Mitchell*, 37 L. T. n.s. 268, 766 (1877), Bacon, V.-C., and C. A. (*Condy's Fluid*); and see the injunction in *Siegert v. Findlater*, 7 C. D. 801 (1878), Fry, J., cited p. 268 (*Angostura Bitters*). In *Benbow v. Low*, 44 L. T. n.s. 875 (1881),

name is applicable, or which are denoted by it (*e*); but when other people can make them, the difficult question of fact, discussed in previous chapters of this book (*f*) arises, whether the name is merely that of the goods themselves, or that of goods of the kind prepared or sold by the original inventor or his successors in business. This was clearly put by Fry, J., in the *Angostura Bitters Case* (*g*). "I cannot say," the learned judge said, "that Meinhard (*h*) may not, if he can, make a bitter identical with the plaintiffs', and, if he does, I cannot prevent him from selling it as *Angostura Bitters*. It is to be observed that the person who produces a new article, and is the sole (*i*) maker of it, has the greatest difficulty (if it is not an impossibility) in claiming the name of that article as his own, because, until somebody else produces the same article, there is nothing to distinguish it from. No distinction can arise from using the name of the class so long as the class consists of only one species, for then the name of the species and the name of the class will be the same."

But, as regards any particular person, the use of a mark or name which is open to the world at large may be restrained by reason of a contract which he has entered into, or of circumstances which make it contrary to conscience for him to avail himself of the general right. Putting aside cases of express

The use of the name or secret may be a breach of contract or of confidence.

Bacon, V.-C., held that an outgoing partner who retained the receipt could use the name of a secret preparation. The question whether the defendant could have used the name in *The Yorkshire Relish Case* (next note), if he had discovered the secret, was left open by the H. L. Lord Davey (1897, A. C. at p. 717; 14 R. P. C. at p. 732) said he saw no reason to differ from the opinion of Fry, J., in *The Angostura Bitters Case*, and of Lindley, L. J., in the case in question, that he could have done so.

(*e*) Thus, in *Birmingham Vinegar Brewery Co. v. Powell*, (1897) A. C. 710; 14 R. P. C. 720, the defendants were restrained from describing their sauce as *Yorkshire Relish* without

clearly distinguishing it from the plaintiff's sauce. They had not succeeded in discovering the recipe, but only in making a wonderful match. See above, p. 459.

(*f*) Above, pp. 36 *et seq.*, and p. 476.

(*g*) *Siegert v. Findlater*, 7 C. D. 801, at p. 813.

(*h*) The maker of the defendant's bitters.

(*i*) On the principle of *Dent v. Turpin* (above, p. 360), if there were two or three makers only, each of them might claim to restrain an outsider from using the name. See observations of Lord Watson during the argument in the *Yorkshire Relish Case*, 14 R. P. C. at p. 726.

contract,—as where, for instance, a partner or servant has covenanted not to use the firm name, or any particular name or marks, or not to engage in any particular business, after the determination of the partnership or employment,—the most important cases of this kind are cases of trade-secrets. The law relating to trade-secrets does not properly fall within the scope of this book, but as it touches upon the limitation of trade-mark and trade-name rights referred to above, it is convenient to shortly refer to the leading cases on the subject.

Wherever secret information has been obtained under circumstances which import a contract not to disclose or make use of it, or by breach of confidence, or under other circumstances which make the disclosure, or the use of the information, contrary to conscience, the Court will restrain the person who has obtained it, or anyone to whom it has been communicated by him, from using or disclosing it (*k*).

Thus, in *Prince Albert v. Strange* (*l*), the publication of a catalogue of a number of etchings made by the late Queen and Prince Albert for their private use and amusement, and never published or authorized to be published by them, and the exhibition of the etchings, was restrained, the copies of the etchings which had passed into the defendant's possession having been obtained surreptitiously and in breach of confidence from or through a printer employed to print them. And in *Morison v. Moat* (*m*) the defendant, who had obtained the secret of manufacturing *Morison's Universal Medicine* from his father, was restrained from using it. Both the defendant and his father had formerly been in partnership with the

Information obtained by breach of contract or of confidence.

(*k*) For a case in which the Court enforced the trusts of a settlement of a trade secret, see *Green v. Folgham*, 1 S. & S. 398; 1 L. J. o.s. Ch. 203 (1822).

(*l*) 2 De G. & Sm. 652; 1 Mac. & G. 25; 18 L. J. Ch. 120 (1849), Knight-Bruce, V.-C., and Cottenham, L. C.

(*m*) 9 Hare, 241; 20 L. J. Ch. 513; 21 *ibid.* 248 (1851), Turner, V.-C., and Knight-Bruce and Lord Cranworth, L. JJ., App., p. 648. The

case of *Canham v. Jones*, 2 Ves. & B. 219; 13 R. R. 70, was distinguished by Turner, V.-C., on the ground that it was not put forward as one of breach of confidence or contract; but the report shows that the bill stated the employment of the defendant, and that the plaintiff's counsel, on the demurrer, to some extent rested their case on breach of confidence. The case would now be differently decided on the alleged facts.

plaintiff, but the father of the defendant, to whom alone the original inventor had disclosed the secret, had entered into a bond not to divulge it to any other person. The injunction restrained the defendant, his agents, &c., from selling, under the title of *Morison's Universal Medicine*, any medicine made by him or under his directions, and also from making any medicines according to the secret, or in any manner using the secret of compounding the medicines, or any part thereof.

Injunctions have been granted on the same principles to restrain the use or publication of secret information obtained by a clerk or servant in the course of his employment (*n*)—and it is said that “every clerk employed in a merchant’s counting-house is under an implied contract that he will not make public that which he learns in the execution of his duty as a clerk” (*o*)—of a list of the names and addresses of the plaintiff’s customers copied by the defendant from his books when employed as his manager (*p*); of a table of details of the dimensions of machinery designed by, or for the plaintiffs, collected from their plans by one of their draftsmen, although the details could all have been gathered from the machines made according to the designs and sold, if access could have been obtained to them (*q*); of materials for the construction of a book of advertisements collected by the plaintiff’s advertising canvassers (*r*); of lectures delivered to a class of students, and not published or authorized to be published by the lecturer (*s*); of private letters written by the plaintiff, or by a person whose estate the plaintiff repre-

Information obtained by a clerk;

table of dimensions by engineer’s draftsman;

book of advertisements by canvasser; lectures;

private letters;

(*n*) *Youatt v. Winyard*, 1 Jac. & W. 394 (1820), Eldon, L. C.

(*o*) Per Wigram, V.-C., in *Tipping v. Clarke*, 2 Hare, 383 (1842); and per North, J., in *Pollard v. Photographic Co.*, 40 C. D. 345 (1888). See next case.

(*p*) *Robb v. Green*, (1895) 2 Q. B. 1, 315, Hawkins, J., and C. A.; damages for breach of the implied contract to observe good faith were also recovered.

(*q*) *Merryweather v. Moore*, (1892)

2 Ch. 518, Kekewich, J. The defendant had been apprenticed to the plaintiffs, and had remained in their employment after his articles expired; cf. *Reuter's Telegram Co. v. Byron*, cited below, p. 543.

(*r*) *Lamb v. Evans*, (1892) 3 Ch. 462; (1893) 1 Ch. 218, Chitty, J., and C. A.

(*s*) *Abernethy v. Hutchinson*, 3 L. J. Ch. o.s. 214 (1824), Eldon, L. C.; *Caird v. Sime*, 12 App. Cas. 326 (1887).

copies of
pictures by
lithographer ;

photographs
of the plain-
tiff.

The jurisdic-
tion rests on
implied
contract.

sents (*t*) ; of copies of the plaintiffs' pictures, delivered to the defendants for the making of copies, in excess of the number made for and delivered to the plaintiffs (*u*) ; and of prints from a photographic negative likeness of the plaintiff, which the defendants had been employed by the plaintiff to take (*x*).

“ Different grounds have been assigned for the exercise of the jurisdiction. In some cases it has been referred to property, in others to contract, and in others, again, it has been treated as founded upon trust or confidence, meaning, as I conceive, that the Court fastens the obligation on the conscience of the party, and enforces it against him in the same manner as it enforces, against a party to whom a benefit is given, the obligation of performing a promise, on the faith of which the benefit has been conferred ” (*y*). But it is submitted that the true ground is always implied contract (*z*), for if information, which both parties understand the present possessor intends to be kept, and to remain secret, is communicated by him to another, or the means of obtaining it are placed by him within the reach of another, for particular purposes, for instance, in the course of an employment, an undertaking not to use or disclose the information ought almost necessarily to be inferred.

As already stated, the jurisdiction extends to enable the Court to restrain a third party from using secret information which has been, to his knowledge, obtained or communicated in breach of faith (*a*) or contract. On similar grounds the right of a person, who has collected information and supplied it for the sole use of his customers, to restrain them from disclosing it to others (*b*), and to restrain others from surrepti-

(*t*) *Perceval v. Phipps*, 2 Ves. & B. 19 (1813), Plumer, V.-C. ; *Earl of Lytton v. Devey*, 54 L. J. Ch. 293 (1884), Bacon, V.-C.

(*u*) *Tuck and Sons v. Priester*, 19 Q. B. D. 629 (1887), C. A.

(*x*) *Pollard v. Photographic Co.*, note (*o*).

(*y*) Per Turner, V.-C., in *Morison v. Moat*, 20 L. J. Ch. p. 522. So, per Kekewich, J., in *Merryweather v.*

Moore, (1892) 2 Ch. p. 522.

(*z*) *Merryweather v. Moore*, *supra* ; *Reuter's Telegram Co. v. Byron*, 43 L. J. Ch. 661 (1874), Jessel, M. R. ; *Robb v. Green*, above, note (*y*), was decided on the ground that there is an implied contract to keep good faith on the part of a servant.

(*a*) Page 540, notes (*l*) and (*m*).

(*b*) *Exchange Telegraph Co. v. Gregory*. (1896) 1 Q. B. 147. C. A.

tiously obtaining it from the subscribers, has been protected (c).

The mere fact that the defendant obtained information as and while he was the agent of the plaintiff, is not a sufficient ground for restraining him from using it, provided there is nothing of a secret character in the information itself, or confidential or surreptitious in the manner in which it was communicated or obtained, so that a contract not to communicate or use it can be implied. "The plaintiffs here do not seek to restrain the defendant from publishing anything," Jessel, M. R., said, in *Reuter's Telegram Co. v. Byron* (d), "but from making use of knowledge acquired while the relation of principal and agent subsisted, after that relation had terminated. Now I am not aware of any authority in which this has been done in the absence of a contract, expressed or implied." And he added, "the jurisdiction of the Court cannot be stretched on an interlocutory application. I do not mean to say it cannot be done at all." The circumstances of the case just cited were, that the plaintiffs had invented a large number of telegraphic cyphers indicating the names of their customers, which were communicated to the defendant while he was the plaintiffs' agent, and after he had left their employment, and started a rival business, he sent circulars to the customers, stating that he had their cyphers, and soliciting their custom. It was said that the defendant had committed no breach of confidence with regard to the cyphers, because these were known to the customers, and could have been obtained by the defendant from such of them as chose to do business through him. It may be doubted whether the importance of having access to the large number of cyphers invented or collected by the plaintiffs was fully appreciated in this case, and whether the decision is consistent with the reasoning accepted in the later cases of *Lamb v. Evans*, and *Merryweather v. Moore*, cited above (c). It was, however, as appears from the judgment of the learned Master of the Rolls, a decision on an interlocutory application only.

Use of agent's information where no breach of contract or confidence.

Reuter's Co. v. Byron.

(c) *Exchange Telegraph Co. v. Central News*, (1897) 2 Ch. 48, Stirling, J.

(d) See note (z), *ante*, p. 542.

(e) Page 541.

The principle stated in the judgment, and quoted above, is undoubtedly sound, whatever may be thought of its application to the facts of the case.

No injunction unless there is danger of the secret being communicated.

Following the ordinary rule in regard to injunctions, no injunction to restrain the communication of a secret will be granted unless by reason of a threat or otherwise the Court is satisfied that there is a danger of the communication being made (*e*).

(*e*) *Morison v. Moat*, 20 L. J. Ch. p. 529.

CHAPTER XX.

REGISTRATION OF FOREIGN AND COLONIAL TRADE-MARKS.

BEFORE the introduction of the Register of trade-marks a foreigner, not being an alien enemy, was allowed to sue for the infringement of his trade-mark in the English Courts (*a*), provided that the trade-mark had become his trade-mark in England by user, or to prevent or obtain damages for the passing off the goods of others as his goods, in the same way and on the same terms as an English subject. And many treaties existed by which this country agreed to give to the subjects of other countries the same right of protection, in respect of their trade-marks, as it gave to its own subjects (*b*). The prohibition contained in sect. 77 of the present Act, and the corresponding section of the Act of 1875, restraining actions in respect of the infringement of unregistered trade-marks (*c*), however, apply to the trade-marks of foreigners (*d*), and therefore actions for infringement could not, since 1875 (in general (*c*)), be brought by a foreigner without his trade-mark being registered in England; actions for passing off, to which the prohibitory sections of the former or the present Acts do not apply, remaining as before.

A foreigner, or any resident in a British possession, may apply for and obtain registration under sect. 62; but if he does not apply under the convention mentioned below, and is out of the United Kingdom at the time of making the

(*a*) *The Collops Co. v. Reeves*, 28 L. J. Ch. 56 (1858), Stuart, V.-C.

(*b*) See a paper presented to Parliament, 1872, C. 633. For later instances of similar treaties, see the Convention between Great Britain and Guatemala, July 20, 1898 (1899, C. 9504), which withdrew from the International Convention during

1895, and the Convention between Great Britain and Luxemburg, Jan. 25, 1900 (1900, C. 31).

(*c*) For the precise effect of the section, see its terms, and Chap. XII., pp. 312, 320.

(*d*) *Goodfellow v. Prince*, 35 C. D. 9 (1887), C. A.: see above, pp. 316, 323.

application, he must give an address for service in the United Kingdom (*e*); and under sects. 103 and 104 of the Act, further provisions are made in his favour if he is a subject of a state in respect of which, or a British subject resident in a British possession to which, these sections have been, by Order in Council, declared to be applicable.

The sections referred to, so far as they relate to trade-marks (*f*), provide that—

International arrangements for protection of inventions, designs, and trade-marks.

“103. (1.) If her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of trade-marks, then any person who has applied for protection for any trade-mark in any such state, shall be entitled to registration of his trade-mark under this Act, in priority to other applicants; and such registration shall have the same date as the date of *the protection obtained* [the application (*g*)] in such foreign state.

“Provided that his application is made, in the case of a trade-mark, within four months from his applying for protection in the foreign state with which the arrangement is in force.

“Provided that nothing in this section contained shall entitle the proprietor of the trade-mark to recover damages for infringements happening prior to the date of the actual registration of his trade-mark in this country (*h*).

“(2.) The use in the United Kingdom, or the Isle of Man, during such period of the trade-mark, shall not invalidate the registration of the trade-mark.

“(3.) The application for the registration of a trade-mark under this section must be made in the same manner as an ordinary application under this Act (*i*). Provided that, in the case of trade-marks, any trade-mark the registration of which has been duly applied for

(*e*) Act of 1888, s. 8 (62 (6)), *ante*, p. 65.

(*f*) The words referring only to patents or designs are here omitted; the full text is printed in the Appendix, p. 669.

(*g*) Act of 1888, s. 6.

(*h*) The ordinary rule is, that where trade-mark rights exist,

damages for infringements before the registration may be recovered: *Barlow v. Johnson*, 7 R. P. C., p. 411 (1890), Chitty, J., *ante*, p. 316. Cf. with this sub-section the International Copyright Act. See *Moul v. Groenings*, (1891) 2 Q. B. 443; and *Schauer v. Field*, (1893) 1 Ch. 35.

(*i*) Sect. 62, Chap. IV., p. 75.

in the country of origin may be registered under this Act (*k*).

“(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which her Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state (*l*).

“104. (1.) Where it is made to appear to her Majesty that the legislature of any British possession has made satisfactory provision for the protection of (inventions, designs, and) trade-marks, (patented or (*m*)) registered in this country, it shall be lawful for her Majesty from time to time, by Order in Council, to apply the provisions of the last preceding section, with such variations or additions, if any, as to her Majesty in Council may seem fit to such British possession.

Provision for colonies and India.

“(2.) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for her Majesty in Council to revoke any Order in Council made under this Act” (*l*).

At the time when these sections were passed into law, the International Convention for the Protection of Industrial Property, as it was originally settled at Paris, had been drawn up and agreed to by several of the countries which are parties to it, and in the following year (*n*) this country acceded to the Convention. Practically all civilized States, except Germany, Austria, Russia and Norway, have now acceded to the original Convention.

The International Convention.

At a subsequent conference at Madrid, in 1891, besides an agreement to endow the International Bureau at Berne, two Conventions were signed by most of the States of the Union. Of these one, which was signed by Great Britain (*o*), related to false indications of origin; the other, signed by Belgium, Brazil, France, Italy, the Netherlands, Portugal, Spain,

International registration of trade-marks.

(*k*) See p. 553.

(*l*) For list of States and Possessions to which the sections apply, see Appendix. p. 762.

(*m*) The brackets are not part of the Act: see note (*f*), above.

(*n*) 20th March, 1883.

(*o*) See *post*. p. 771.

Switzerland, and Tunis, but not by Great Britain, established a system for the international registration of trade-marks (*p*). The principles of this system are admirably explained by M. Frey-Godet, Secretary to the International Bureau at Berne, in a paper read by him before the London Congress of the International Association for the Protection of Industrial Property, in 1898 (*q*). "The proprietor of the trade-mark makes an application for international registration to the Government of his native country, which then forwards his request to the International Office at Berne. The latter registers the trade-mark, and notifies this registration to all the States which have become parties to the Arrangement of Madrid, and afterwards publishes a description of the trade-mark, with all the data in connection with it, in a publication entitled *Les Marques Internationales*, which forms an appendix to *La Propriété Industrielle*, the official organ of the Office.

"The registration of the trade-mark at the International Office produces absolutely the same effect as if the trade-mark had been registered on the same day in all the contract States. . . . The trade-marks judged inadmissible must be refused at latest during the year following the notification by which the Berne Office has made known the registration of the trade-mark to the contract States. When a State refuses legal protection to a trade-mark registered internationally, the proprietor enjoys the same means of appeal as if he had made the application to the national registration department of the State concerned.

"The effect of international registration lasts for twenty years; but it can only be invoked so long as the trade-mark remains protected in the country of origin. Nevertheless, if a trade-mark has been temporarily deprived of protection in that country owing to delay in renewing the application, it is sufficient to make a fresh application in order again to set in operation the international protection which had remained in abeyance. This is, then, only an expansion of the protection which the trade-mark enjoys in the country of origin. Con-

(*p*) The text of this arrangement will be found in the Appendix, p. 773.

(*q*) Trans. Inter. Assoc. for the Protection of Ind. Prop., Vol. II. (1898), p. 102.

sequently every modification relating to the property of an international trade-mark (annulment, erasure, renunciation, transfer, &c.) must be notified by the national Government to the International Office, which makes a memorandum of this and forwards the information to the various contract States.

“Whoever wishes to effect the international registration of a trade-mark must pay a fee of 100 francs, which goes to the International Office, and a national fee, which goes to the country of origin. Each country fixes at its pleasure the amount of this fee, which is supposed to be an equivalent for the labour furnished by the Government of the country on the occasion of the international registration of the trade-mark to which it refers. France, for instance, imposes a fee of 25 francs; Switzerland a fee of 5 francs only, whilst Belgium exacts none at all.

“The international and national fees together are always inferior in amount to the total of national fees which it would be necessary to discharge in the different contract countries in order to obtain in each of them the national registration of the trade-mark (165 francs). But the amount of the official fee is insignificant in comparison with the expenses which would be entailed by translations, authentications, agent’s fees, &c., if the application for registration of a trade-mark were contemplated in each of the States adhering to the arrangement.”

The objection of Great Britain to accede to this arrangement is based on several grounds with which M. Frey-Godet deals in succession. It does not appear that the point has ever been taken on behalf of this country that international registration, by diminishing the number of national applications for registration of foreign trade-marks, would at the same time reduce the registration fees collected by the British Government. But if such an argument were advanced, M. Frey-Godet’s answer is twofold. In the first place, Great Britain would not grudge the expenditure of a few thousand francs in order to be assured of a valuable advantage to her commerce. In the second place, it is by no means certain that the fee collected by Great Britain on international applications effected by British subjects, added

Obstacles to
Great
Britain’s
accession.

to that derived from the surplus receipts of the service of registration, would not make up for the diminution in the number of ordinary registrations. A second objection, and one which has greater weight, may be put in this way: British trade-mark law is based on a registration effected by a national government. To a system of this kind it is impossible to assimilate one of registration carried out in a foreign country. M. Frey-Godet's answer is that our internal legislation by which copyright is only granted to literary works if they have been entered at Stationers' Hall, does not apply to works produced in the countries forming part of the Literary and Artistic Union. It may be noted in passing, that Article V. of the Madrid Arrangement preserves the right of the contracting states to reject any trade-mark presented for registration under the international scheme to which it could object if an application were made for its registration in the ordinary course. The Patent Office would, therefore, be free to examine trade-marks for which international registration was desired, and to reject those which were inadmissible on the ground of internal legislation. Our internal legislation, however, gives rise to several difficulties of its own. Sect. 64, sub-sect. (2) of the Act of 1883 requires an applicant in his application for registration to indicate the essential elements of his trade-mark, and to disclaim what is non-essential. Again, sect. 65 of the Act of 1883 provides that "a trade-mark must be registered for particular goods or classes of goods"; and in this country trade-marks must be published in the official journal of the Patent Office. How are these provisions to be severally adjusted to the system of international registration? As regards disclaimers, M. Frey-Godet's suggestion is that the applicant might be required expressly to disclaim the non-essential parts of his trade-mark before embarking on a law-suit. A similar procedure is, no doubt, in force in this country in regard to patents. But this solution of the problem does not deal with the inconvenience that would be caused to applicants for national (or even international) registration by the uncertainty as to what were the essential parts of marks already on the Register of Trade-Marks. The

difficulty as to publication might be met, as M. Frey-Godet points out, by the annexation to the national publication of a trade-mark either of the publication of the Berne Office, or, preferably, of an authenticated translation of it.

The text of the International Convention of Paris to which, as already stated, this country is a party, and a list of the countries and British possessions to which the above sections have been made applicable by Orders in Council, are set out in the Appendix (*r*).

The Inter-
national Con-
vention.

The convention and the accession thereto of this country may be referred to by the Court as a matter of history, in order to enable it to understand under what circumstances the sections of the Act were passed (*s*); but the terms of the convention cannot be employed as a guide to interpret the sections (*t*), for a treaty with a foreign State binds the subjects of the Crown only in so far as it has been embodied in legislation passed into law in the ordinary way (*u*).

The provisions of the sections, in fact, do not carry out the international agreements constituted by the convention, for, by Art. VI. of the Convention, it is agreed that "every trade-mark duly registered in the country of origin shall be admitted for registration, and protected in the forms originally registered in all other countries of the Union" (*v*); and by clause 4 of the final protocol, it is explained that this article "is to be understood as meaning that no trade-mark shall be excluded from protection in any State of the Union, from the fact alone that it does not satisfy, in regard to the signs composing it, the conditions of the legislation of the State, provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in the said country of origin"; but it has, nevertheless, been decided that, in order to be qualified for registration, a mark tendered under these sections, just as any other mark which is sought to be registered, must fall within the descriptions

Foreign
trade-mark
may be re-
fused regis-
tration.

(*r*) Pages 762, 764.

Stirling, J.

(*s*) *Carter Medicine Co.'s Tm.*, (1892) 3 Ch. 472; 9 R. P. C. 401, North, J.

(*u*) See last case, and *Walker v. Baird*, (1892) A. C. 491.

(*t*) *Californian Fig Syrup Co.'s Tm.*, 40 C. D. 620; 6 R. P. C. 126 (1888),

(*v*) *I.e.*, the union of the contracting states for the protection of industrial property.

of sect. 64. So that the words *Syrup of Figs* (*x*), and the words *Carter's Little Liver Pills* (*y*), were refused registration as trade-marks, although registration of them respectively had been duly applied for and actually obtained in the United States, one of the States to which sect. 103 has been applied.

The effect of the decisions just referred to is to reduce the operation of the Convention, in regard to trade-marks (*z*) in this country, to very narrow limits. As between applicants for the registration of new marks, or marks acquired as trade-marks since the application for protection in a foreign State within the Union, the applicant in the foreign State is to have priority, provided that he makes his application in this country within four months from the date of the foreign application on which he relies. And this priority is not affected by the success or failure of the foreign application.

Publication
of foreign
trade-mark.

The proviso that use of the trade-mark in this country during the period of four months shall not invalidate the registration, is surplusage, if it is directed to use by the applicant himself, as it seems intended to be, for the publication or use of a mark by the applicant before registration in no case prejudices a right to registration. The proviso might have some useful meaning and operation, if it were construed to prevent an opponent, who had first used the trade-mark in question in this country after the application in a foreign State by the applicant for registration, from relying on his use of the mark, or the title acquired by him in consequence of that use, as an objection to the registration of the applicant. But so long as the Convention is not embodied in legislation, as already stated, it can have no operation upon the right to registration at all. It might, however, it is submitted, properly affect the Comptroller's discretion.

(*x*) *Californian Fig Syrup Co.'s Tm.*, 40 C. D. 620; 6 R. P. C. 126 (1888), Stirling, J.

(*y*) *Carter Medicine Co.'s Tm.*, (1892) 3 Ch. 472; 9 R. P. C. 401, North, J.

(*z*) Another part of the conven-

tion, relating to false marking and false trade description and the seizure on importation of falsely marked goods, has been carried into effect by the Merchandise Marks Act, see p. 624, below.

The last clause of sub-sect. (3), providing that "any trade-mark the registration of which has been duly applied for in the country of origin may be registered under this Act," does not give an independent or new right of registration under the Act (a), and it seems to bear no other construction than that suggested on behalf of the Comptroller in *The Carter Medicine Co. Case* (a), namely, that "may be registered" is to be read as "may be the subject of application for registration," although this construction reduces it also to surplusage.

The application of the sections to any foreign State can, under no circumstances, afford any answer to a motion under sect. 90 to remove from the Register a mark which was originally registered without sufficient cause (b).

(a) *Californian Fig Syrup Co.'s Tm.*, and *Carter Medicine Co.'s Tm.*, *supra*. In *Vidal's Patent*, 15 R. P. C. 721 (1898), Sir R. Webster, A.-G., said:—"I am clearly of opinion that, when a person claims under those articles, he cannot claim greater privileges than a national applicant,

and that he is liable to the same restrictions as a subject or citizen of the country in which he is making the application."

(b) *Vignier's Tm.*, 6 R. P. C. 490 (1889), Kay, J. (*Monobrut Champagne*).

BOOK II.

THE CRIMINAL LAW OF FALSE MARKING.

CHAPTER I.

THE MERCHANDISE MARKS ACT, 1887.

(50 & 51 Vict. c. 28.)

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A SHORT introductory account of the Merchandise Marks Act, 1887 (*a*), and of the Act of 1862, which it repealed and replaced, will be found in Chap. I. of Book I. (p. 16), and the nature of the contents and subject-matter of the Act can be readily gathered from the table placed at the head of this chapter, and sects. 2, 3, 4, 5, 6 of the Act which are set out below. The table of sections given in the Queen's

(*a*) This Act is quoted throughout this and the following chapter as "M. M. A. 1887," and the Merchandise Marks Act, 1891, as "M. M. A. 1891." The Report of the Select Committee of the House of Commons of 1862 is quoted as

"M. M. A. Report, 1862," that of the Committee of 1887 as "M. M. A. Report, 1887," that of the Committee of 1890 as "M. M. A. Report, 1890," and that of the Committee of 1897 as "M. M. A. Report, 1897."

Printers' copy and the text of the statute itself are printed at length in the Appendix (p. 805).

The most important substantive enactments of the Merchandise Marks Act, 1887, are comprised in the sub-sects. (1) and (2) of sect. 2 of the Act, which enumerate the principal offences against which the Act was directed; the greater part of the remainder of the statute being directed to the definition and explanation of the terms employed in the sub-sections referred to, and the provision of machinery for the prosecution and punishment of the offences created by them. In addition to the provisions relating to these offences, the Act contains a very important provision (sect. 16) prohibiting the importation of deceptively or spuriously marked goods, and some special provisions as to marks on watches (sects. 7 and 8). Two subsidiary sections of the Act—namely, sect. 17, dealing with the statutory warranty implied by the sale of marked goods (*b*), and sect. 20, imposing a penalty for false representations as to royal warrants (*c*)—are considered in other chapters of this work.

Sect. 2 is divided into six sub-sections, which deal respectively with the offences against the Act, (1) and (2); penalties, (3) (*d*); destruction of forfeited articles, (4) (*e*); appeals against convictions, (5) (*f*); and prosecutions, (6) (*ff*).

It provides as follows:—

Offences as to trade-marks and trade descriptions.

“ 2.—(1.) Every person who—

“ (a) forges any trade-mark; or

“ (b) falsely applies to goods any trade-mark or any mark so nearly resembling a trade-mark as to be calculated to deceive; or

“ (c) makes any die, block, machine, or other instrument for the purpose of forging, or of being used for forging, a trade-mark; or

“ (d) applies any false trade description to goods; or

(*b*) Book I., Chap. XVII., p. 520.

(*c*) Below, p. 641.

(*d*) Page 611.

(*e*) Page 611.

(*f*) Page 617.

(*ff*) Page 612.

“ (e) disposes of or has in his possession any die, block, machine, or other instrument for the purpose of forging a trade-mark ; or

“ (f) causes any of the things above in this section mentioned to be done,

shall, subject to the provisions of this Act, and unless he proves that he acted without intent to defraud, be guilty of an offence against this Act.

“ (2.) Every person who sells, or exposes for, or has in his possession for, sale, or any purpose of trade or manufacture, any goods or things to which any forged trade-mark or false trade description is applied, or to which any trade-mark or mark so nearly resembling a trade-mark as to be calculated to deceive is falsely applied, as the case may be, shall, unless he proves—

“ (a) That having taken all reasonable precautions against committing an offence against this Act, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the trade-mark, mark, or trade description ; and

“ (b) That on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons from whom he obtained such goods or things ; or

“ (c) That otherwise he had acted innocently ;
be guilty of an offence against this Act.

“ (3.) Every person guilty of an offence against this Act shall be liable (p. 611)—

“ (i) on conviction on indictment, to imprisonment, with or without hard labour, for a term not exceeding two years, or to fine, or to both imprisonment and fine ; and

“ (ii) on summary conviction to imprisonment, with or without hard labour, for a term not exceeding four months, or to a fine not exceeding twenty pounds, and in the case of a second or subsequent conviction to imprisonment, with or without hard labour, for a term not exceeding six months, or to a fine not exceeding fifty pounds ; and

“ (iii) in any case, to forfeit to her Majesty every chattel,

article, instrument, or thing by means of or in relation to which the offence has been committed.

“(4.) The Court before whom any person is convicted under this section may order any forfeited articles to be destroyed or otherwise disposed of as the Court thinks fit (p. 611).

“(5.) If any person feels aggrieved by any conviction made by a court of summary jurisdiction, he may appeal therefrom to a court of quarter sessions (p. 617).

“(6.) Any offence for which a person is under this Act liable to punishment on summary conviction may be prosecuted, and any articles liable to be forfeited under this Act by a court of summary jurisdiction may be forfeited, in manner provided by the Summary Jurisdiction Acts: Provided that a person charged with an offence under this section before a court of summary jurisdiction shall, on appearing before the Court, and before the charge is gone into, be informed of his right to be tried on indictment, and if he requires be so tried accordingly.”

Offences by
a corporation
or a partner-
ship.

Every person (s. 2 (1)).—Person means person or persons (*g*), and includes any body of persons corporate or unincorporate (*h*). According to the letter of the statute, therefore, a corporation or a private partnership, or trade society, could, as such, be convicted and fined for an offence under the statute; and in various cases such convictions have taken place (*i*), although the point as to whether corporations or partnerships are within the statute has not been expressly raised and determined. In modern cases, however, no difficulty has been felt in construing statutes so as to cast a duty, which is enforceable through the criminal law, upon corporations (*h*), notwithstanding the objections that a corporation cannot act except through its agents, who have no authority to do any

(*g*) 52 & 53 Vict. c. 63, s. 1.

(*h*) M. M. A. 1887, s. 3 (1).

(*i*) Cf. *Jones Brothers' Case*, Times, Jan. 9 and 16, 1899.

(*k*) See *The Queen v. Tyler*, (1891)

2 Q. B. 588, and the cases there cited; and per Lord Blackburn in *Pharmaceutical Society v. London and Provincial Supply Association*. 5 App. Cas. at p. 869 (1881).

criminal or other illegal act (*l*); that a principal is never criminally liable (*m*) for the acts of his agent which he has not specially authorized, unless expressly made so by statute in any particular case (*n*); and that a specific criminal intent cannot be attributed to a corporation (*o*). It would be a serious curtailment of the usefulness of the Act if the limited liability companies, by which so much of the trade of the country is now carried on, could not be reached by the pecuniary penalties instituted by it; for proceedings against their officers for their own share in causing or participating in the offences charged might often be inadequate to stop the mischief aimed at by the Act (*p*).

If a corporation can be convicted under the Act and fined, there seems to be no principle upon which unincorporated bodies can be held to be outside its operation. And where all the members of a partnership are individually guilty of an offence there is no further difficulty in holding the partnership itself liable also, since its property, upon which the fine inflicted would be levied, is the property of the several partners. A question may, however, arise—if some partners establish on their own account one of the defences specified in the Act, for instance, show that they acted without intent to defraud, under sect. 2 (1), or that they complied with the provisions of sect. 2 (2), (a) and (b), while others fail to do

(*l*) *Re The Royal British Bank, Ex parte Nicol*, 3 De G. & J. 387; 28 L. J. Ch. 257 (1859).

(*m*) It was held in *The Queen v. Stephens*, L. R. 1 Q. B. 702 (1865), that the owner of works carried on by agents for his profit might be indicted for a nuisance committed by the agents without his knowledge and against his general directions, on the ground that the case was in substance a civil proceeding.

(*n*) *Chisholm v. Doulton*, 22 Q. B. D. 736 (1889); *Budd v. Lucas*, (1891) 1 Q. B. 408.

(*o*) On the general question of the liability of a corporation for crimes, see Brice's *Ultra Vires*, 3rd ed.

Chap. XIII., and for torts, Chap. XII., and Buckley on the Companies Acts, 7th ed., pp. 104 and 532; *Barwick v. English Joint Stock Bank*, L. R. 2 Ex. 259 (1866); *Houldsworth v. City of Glasgow Bank*, 5 App. Cas. 317 (1880); and *British Mutual Banking Co., Ltd. v. Charnwood Forest Ry. Co.*, 18 Q. B. D. 714 (1887); *Cornford v. Carlton Bank, Ltd.*, (1899) 1 Q. B. 392; (1900) 1 Q. B. 22; 68 L. J. Q. B. 196, 1020, Darling, J., and C. A. (in the Court of Appeal the point was abandoned).

(*p*) See per Denman, C. J., in *The Queen v. Great North of England Ry. Co.*, 9 Queen's Bench Rep. 315; 16 L. J. M. C. 16 (1846).

so—whether the partnership, and through it the innocent partners, according to their interest in its property, are liable to be fined for the offences charged, because the proceedings have been taken against the firm. The case is precisely similar to that of an offending corporation having some innocent corporators; and, it is submitted, the question must be answered in the affirmative.

Liability of
servants and
workmen.

As regards persons employed on behalf of others, see sect. 6 (*g*). That section does not apply to offences under the clauses in sect. 2 (1) (*a*) and sect. 2 (1) (*e*), although it is difficult to see why it should not. And as regards the acts of a servant, done in obedience to the instructions of his master, see sect. 19 (3) (*r*).

Sect. 2 (1) deals with three groups of offences: forging trade-marks, (*a*), (*c*), and (*e*); falsely applying trade-marks to goods, (*b*); and applying false trade descriptions, (*d*); the general clause (*f*) adding the following offence—causing any of the other offences to be committed.

1. Forging Trade-Marks.

Sect. 2 (1).

“ (*a*) Forges any trade-mark ;

“ (*c*) Makes any die, block, machine, or other instrument for the purpose of forging, or of being used for forging, a trade-mark ;

“ (*e*) Disposes of or has in his possession any die, block, machine, or other instrument for the purpose of forging a trade-mark.”

What is a
trade-mark.

Trade-Mark.]—For the purposes of the Act—

“ The expression ‘ trade-mark ’ means a trade-mark registered in the Register of Trade-Marks kept under the Patents, Designs, and Trade-Marks Act, 1883, and includes any trade-mark which, either with or without registration, is protected by law in any British possession or foreign State to which the provisions of the 103rd section (*s*) of the Patents, Designs, and Trade-Marks Act, 1883, are, under Order in Council, for the time being applicable ” (*t*).

(*g*) “ Persons employed,” p. 598.

(*r*) Page 597.

(*s*) See Book I., Chap. XX., p. 545.

(*t*) Sect. 3 (1). Appendix, p. 762.

The Register is kept under sect. 78 of the Patents, &c. Act, and the questions: What may be Registered? (*u*) and What is the Effect of Registration? (*r*) have already been discussed at length. Any entry made on the Register without sufficient cause may be expunged or varied by the Court, upon application, under sect. 90 of the Patents, &c. Act (*y*).

Registered
trade-mark.

Proof of registration is effected by a copy of, or extract from, the Register, purporting to be certified by the Comptroller, and sealed with the seal of the Patent Office (*z*), or by a certificate purporting to be under the hand of the Comptroller (*a*).

The question may arise whether registered, in the above definition, means only "actually registered," or means "properly registered." It is submitted that registered in fact is the true construction, for any other would, to a great extent, defeat the operation of the Act. It cannot have been intended that, in the summary proceedings before two justices contemplated by the Act, inquiries should be entered upon, such as those undertaken on applications under sect. 90, to remove trade-marks from the Register: for instance, inquiries whether a registered trade-mark was a common mark or a descriptive mark, or whether, if registered as an old mark, it was in fact used as registered before the 13th of August, 1875 (*b*). A similar question arises with regard to "the proprietor" of a registered trade-mark (*c*). By sect. 76 of the Act of 1883, the registration of a person as the proprietor of a trade-mark is *prima facie* evidence of his right to the exclusive use of the trade-mark, and is, after the expiration of five years from the date of registration, conclusive evidence of his right to the exclusive use of the trade-mark, subject to the provisions of the Act. And, in civil proceedings, it has been held, under this provision, that registration after five years is conclusive, both as to the title of the proprietor and as to the propriety of the registration itself, in the absence of an application to

Where the
trade-mark
is improperly
registered.

(*u*) Sects. 62 and 64, Book I., Chap. VIII., p. 115.

(*r*) Sects. 75 and 76, Chap. XII., p. 302.

(*y*) Chap. XI., p. 262.

(*z*) Act of 1883, s. 89.

(*a*) *Ibid.*, s. 96.

(*b*) See Book I., Chap. XI., p. 262, "Rectification of the Register."

(*c*) *Infra*, p. 564.

rectify, under sect. 90 (*d*). No doubt, if a plausible claim for rectification were seriously put forward in criminal proceedings based upon a registered trade-mark, an adjournment, to enable an application to the High Court to be made under sect. 90, would be granted pending the result of such application. And the existence of such a claim might of itself, in many cases, be sufficient to negative the intent to defraud, which is an element of each of the offences under the M. M. A., sect. 2 (1), or to show that the person charged had acted innocently, within the meaning of the M. M. A., sect. 2 (2).

The M. M. A.
1862.

The Act of 1862 applied only to trade-marks as defined by the Act (*c*). No register of trade-marks existed when the Act was passed.

Unregistered
trade-marks.

Unregistered trade-marks within the United Kingdom are not protected by the Act as trade-marks, but they are in many cases protected by the provisions relating to the application of a false trade description under the extension of that term contained in sect. 3 (2) and (3) (*f*). The number of such trade-marks in use is enormous, exceeding, it is said, the number of registered trade-marks (*g*); and, as has been shown in the earlier part of this book, infringements of them, in general, can be restrained in actions for "passing off" (*h*), even where, under sect. 77 (*i*) of the Act of 1884, they do not form the subject of an action for infringement, properly so called.

Trade-marks
in British
possessions.

"British possession," in the definition of a trade-mark, means any part of his Majesty's dominions, exclusive of the United Kingdom, and where parts of such dominions are under both a central and a local legislature, all parts under the central legislature are, for the purposes of this definition, to be deemed one British possession (*k*).

(*d*) *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478 (1887), C. A.; *Pinto v. Bolman*, 8 R. P. C. 181, (1891), C. A., above, p. 308 *et seq.*

(*c*) 25 & 26 Vict. c. 88, s. 2, set out *ante*, p. 25.

(*f*) See below, pp. 588—592.

(*g*) M. M. A. Report, 1887, evi-

dence of Mr. Courtenay Boyle, Qq. 400, 420. The bulk of the cotton marks are unregistered; evidence of Mr. Wright, Q. 3981.

(*h*) Book I., Chap. XVI., p. 446.

(*i*) *Ibid.* Chap. XII., p. 317.

(*k*) Interpretation Act, 1889 (52 & 53 Vict. c. 63), s. 18 (2).

By sect. 9—

“In any indictment, pleading, proceeding, or document, in which any trade-mark or forged trade-mark is intended to be mentioned, it shall be sufficient, without further description and without any copy or facsimile, to state that trade-mark or forged trade-mark to be a trade-mark or forged trade-mark.”

Trade-mark, how described in pleading.

Forges.]—By sect. 4—

“A person shall be deemed to forge a trade-mark who either—

What is forging a trade-mark.

“ (a) without the assent of the proprietor of the trade-mark makes that trade-mark or [a¹] (l) a mark so nearly resembling that trade-mark as to be calculated to deceive; or

“ (b) falsifies any genuine trade-mark, whether by alteration, addition, effacement, or otherwise;

and any trade-mark or mark so made or falsified is in this Act referred to as a forged trade-mark.

“ Provided that in any prosecution for forging a trade-mark the burden of proving the assent of the proprietor shall lie on the defendant ” (m).

So that the phrase covers the three distinct offences, (a), [a¹], and (b).

At common law the offence of forgery is the making or alteration of a writing or document to the prejudice of another person's right with intent to defraud (n), and a trade-mark is not a writing or document within the definition (o). But the sale of goods under a spurious mark, which the vendor knew to be spurious, has been held in many cases to constitute obtaining money by false pretences (p).

Forgery of a trade-mark at common law.

In *R. v. Smith* (o), where the prisoner was charged with having forged imitations of Borwick's baking powder labels,

(l) [a¹] is not in the Act.

(o) *R. v. Smith*, 8 Cox, 32; 27

(m) Below, p. 601. Cf. sect. 5 (3), p. 569.

L. J. M. C. 225 (1858), C. C. R.; Seb. Dig. p. 89.

(n) Not necessarily to defraud a particular person. 24 & 25 Vict. c. 98, s. 44; Archbold, 22nd ed., p. 672.

(p) *R. v. Dundas*, 6 Cox, 380; *R. v. Ardley*, L. R. 1 C. C. R. 301; Seb. Dig. “False Pretences.”

Pollock, C. B., said :—“ The issuing of this wrapper without the stuff within it would be no offence. In the printing of these wrappers there is no forgery ; the real offence is the issuing them with fraudulent matter in them ” (*q*). The offence under the M. M. A. is, however, complete, whether the forged trade-marks be applied to goods or not, unless intent to defraud is disproved. The application of a trade-mark, whether forged or genuine, to goods other than the goods of the proprietor of the trade-mark is an offence under sects. 2 (1) (b), 2 (1) (d), and 3 (2).

The proprietor.

(a) *The proprietor*]—is the registered proprietor (*r*), or his assignee, who is possessed of the goodwill of the business for which the trade-mark in question was acquired and used (*s*). It has been held, in civil cases, that the assignee of a registered trade-mark need not register the assignment before commencing proceedings to restrain, or to obtain damages in respect of, an infringement (*t*), and the rule will, no doubt, apply also in proceedings under the M. M. A. The question, whether a defendant charged under the Act can go behind the Register and deny the title of the registered proprietor, has already been referred to (*u*).

“ Proprietor ” includes any body of persons, corporate or unincorporate (*x*).

Assent of the proprietor.

Without the assent of the proprietor, &c.]—The owner of goods of the kind which a trade-mark is properly used to indicate—that is to say, goods of the manufacture or selection, &c. (*y*) of the proprietor of the trade-mark—and of the class for which the trade-mark is used, is entitled to apply the trade-mark to them. He may, for instance, lawfully replace soiled labels (*z*), or refill, with the proprietor’s goods,

(*q*) Cf. the civil case of *Farina v. Silverlock*, above, p. 32.

(*r*) Act of 1883, sect. 78. Cf. *ante*, p. 65.

(*s*) *Ibid.* sect. 70, Book I., Chap. XIII., p. 324, Assignment and Devolution of Trade-marks.

(*t*) *Thlee v. Henshaw*, 31 C. D. 323; 3 R. P. C. 15 (1886), North, J. See, however, above, p. 317.

(*u*) *Ante*, p. 561.

(*x*) Sect. 3 (1).

(*y*) Book I., Chap. II., p. 52; Chap. XIX., p. 538.

(*z*) *Farina v. Silverlock*, 1 K. & J. 509; 24 L. J. Ch. 632; 6 De G. M. & G. 214; 26 L. J. Ch. 11 (1855), Wood, V.-C., and Cranworth, C.

stamped bottles or cases, and he may label goods purchased in bulk, and broken up into smaller quantities, with the vendor's mark (a). Where such goods have been purchased of the proprietor, it is submitted, he would be estopped from denying his assent to the use of the trade-mark. In any case such use would not be use with intent to defraud. And if it were shown that the marks made by the person charged were made solely for such use, he would not, it is submitted, be guilty of any offence under the Act. In *Farina v. Silverlock* (z), Lord Cranworth held, that the defendant, a printer, who copied the Farina Eau de Cologne labels, was not guilty of infringement if he established his allegation that he printed the copies only to replace worn-out labels properly used in connection with the plaintiff's scent; but this he in fact failed to do (b).

[a¹] *So nearly resembling, &c.*—This is taken from the civil law with regard to trade-marks. Such resemblance is the test of infringement where a mark is not actually copied (c). The rules of comparison adopted in the Courts have been stated in the earlier part of this work (d). And it has been shown that the persons whom the alleged spurious mark must be calculated to deceive are, in actions for infringement or passing off, taken to be any class of probable purchasers of the goods in connection with which the marks are to be used, whether the immediate purchasers from the manufacturers, the ultimate purchasers from the last retailers, or intermediate purchasers. Foreign purchasers are to be considered, if the marks circulate in foreign markets, and the bearing of their probable ignorance of the English language upon the question whether the resemblance between the marks before the Court is calculated to deceive is also material. There seems no ground for holding that buyers within the United Kingdom only are to be considered in the application of the Act.

Making a mark nearly resembling a trade-mark.

Where a trade description is used only so as to be brought

(a) *Condy v. Taylor*, 56 L. T. 891 Q. B.; and 4 K. & J. 650, Wood, (1887), Kekewich, J., and *ante*, V.-C. pp. 368 and 369.

(b) 30 L. T. 242; 31 L. T. 99,

(c) Book I., Chap. XV., p. 373.

(d) Pages 224 *et seq.*, 373 *et seq.*

to the notice of expert dealers in the goods to which it is applied, it is not treated by the Custom House authorities as false or falsely applied, under sect. 16 of the Act, if it does not deceive such dealers, although it might deceive the buyers who have no expert knowledge (*e*). It may be assumed that a corresponding construction would be applied in the case of marks which nearly resemble trade-marks.

The phrase "so nearly resembling," &c., appears also in sect. 2 (1) (b) and sect. 5 (3). In sect. 3 (2), the words used are "calculated to lead persons to believe that the goods (to which a false trade description is applied) are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are." This is the deception a forged or false trade-mark is calculated to produce, and it is difficult to see how the more general expression "calculated to deceive" in the present and the first above-named sub-sections can have any different meaning.

Falsifying a trade-mark.

(b) *Falsifies any genuine trade-mark.*]—The assent of the proprietor (*f*) is no defence under this head—that is, unless it in fact negatives any intent to defraud.

This sub-section reproduces the substance of part of sect. 5 of the Act of 1862.

An alteration of a genuine trade-mark, such as to make it resemble another registered trade-mark, might fall under (a) or [*a*¹].

The retailer of goods bearing a trade-mark might alter the mark with intent to pass off it, and the goods upon which it appeared, as his own. The use of a trade-mark so altered would fall within sect. 2 (1) (b) and sect. 5 (1) (d) as a false application of the trade-mark, and it might also amount to the application of a false trade description within sect. 2 (1) (d) and sect. 3 (2). The sub-section is probably intended to meet cases of fraudulent alterations, such as that suggested, where no use or application can be proved.

(*e*) See below. p. 636.

(*f*) *Ante*, p. 564.

2. Falsely applying a Trade-Mark to Goods.

Sect. 2 (1).

“ (b) Falsely applies to goods any trade-mark (*g*), or any mark so nearly resembling (*h*) a trade-mark as to be calculated to deceive.”

Goods.]—This is defined by sect. 3 (1) to mean anything which is the subject of trade, manufacture, or merchandise. *Goods.*

Trade-marks are registered only for definite classes of goods (*i*), and the rights of the proprietor of a trade-mark are restricted to goods of the class for which it is registered, and for which it is actually used or intended to be used. He can have no right in respect of its user upon goods in which he does not deal (*k*). It is submitted, upon the same principle, that it would not be an offence under this head to apply a trade-mark registered for cotton goods, for instance, to ironware, without the assent of the proprietor of the trade-mark, even if such use could be held to be a use with intent to defraud.

Applies to goods.]—By sect. 5—

Sect. 5 (1).

“ (1.) A person shall be deemed to apply a trade-mark or a mark or a trade description to goods who—

Applying marks and descriptions.

“ (a) applies it to the goods themselves ; or

“ (b) applies it to any covering, label, reel, or other thing in or with which the goods are sold or exposed or had in possession for any purpose of sale, trade, or manufacture ; or

“ (c) places, or encloses, or annexes any goods which are sold or exposed or had in possession for any purpose of sale, trade, or manufacture, in, with, or to any covering, label, reel or other thing to which a trade-mark or trade description has been applied ; or

“ (d) uses a trade-mark or mark or trade description in any manner calculated to lead to the belief that the goods in connection with which it is used are designated or described by that trade-mark or mark or trade description.

(*g*) Page 560, “ trade-mark.”

(*i*) Act of 1883, sects. 65 and 66 ;

(*h*) Page 565, “ So nearly resembling.”

Book I., Chap. V., p. 96.

(*k*) See above, p. 307.

Sect. 5 (2).
Covering.
Label.

“(2.) The expression ‘covering’ includes any stopper, cask, bottle, vessel, box, cover, capsule, case, frame, or wrapper; and the expression ‘label’ includes any band or ticket.

“A trade-mark, or a mark, or trade description, shall be deemed to be applied whether it is woven, impressed, or otherwise worked into, or annexed, or affixed to the goods, or to any covering, label, reel, or other thing” (l).

What is a sufficient application of a spurious trade-mark to goods to constitute an infringement has already been considered (m).

Sub-sect. (1) (c) covers such cases as the refilling of bottles to which a trade-mark or trade description has previously been applied (n).

Sub-sect. (1) (d) is exceedingly general in its terms. It has been held, in cases of trade description, to extend to a description in an invoice sent with the goods (o), even where the description was originally made verbally, and was added to the invoice at the request of the purchaser of the goods (p).

A trade description is not “applied” to goods within the meaning of the Act unless it is physically applied (q).

In *Starey v. Chilworth Gunpowder Co.* (r), the false trade description was painted on the barrels in which gunpowder was delivered by government contractors to the government agents.

The words “calculated to lead to the belief,” &c., at the end of the sub-section, may be compared with the corre-

(l) For sect. 5 (3) see next page.

(m) See above, pp. 369 and 491.

(n) As in *Wood v. Burgess*, 24 Q. B. D. 162 (1889), a case under the Act; and the infringement cases cited on p. 369, *ante*.

(o) *Budd v. Lucas*, (1891) 1 Q. B. 408, Pollock and Charles, JJ.

(p) *Coppen v. Moore* (No. 1), (1898) 2 Q. B. 300; 67 L. J. Q. B. 689. And see *Cameron v. Wiggins*, (1901) 1 Q. B. 1.

(q) *Langley v. Bombay Tea Co., Ltd.*,

(1900) 2 Q. B. 460; 69 L. J. Q. B. 752, Grantham and Channell, JJ. In a recent Scotch case the offence was held to have been committed although the defendant, while appropriating the trade-mark and bottles of the prosecutor, put his own labels on the bottles as well: *Burns v. Turner*, 25 Ct. of Sess. Ca. 4th ser. 38 (1898), Lord Justice Clerk Kingsburgh, Lord Trayner, Lord Moncrieff.

(r) 24 Q. B. D. 90 (1888), Coleridge, L. C. J., and Mathew, J.

sponding words "calculated to deceive," used elsewhere in the Act (*s*).

Falsely applies, &c.]—By sect. 5—

"(3.) A person (*t*) shall be deemed to falsely apply to goods (*u*) a trade-mark or mark, who without the assent of the proprietor (*r*) of a trade-mark (*y*) applies (*z*) such trade-mark, or a mark so nearly resembling it as to be calculated to deceive (*a*); but in any prosecution for falsely applying a trade-mark or mark to goods the burden of proving the assent of the proprietor shall lie on the defendant" (*b*).

This sub-section corresponds to sect. 4 (*a*) (*c*), defining the offence of forging a trade-mark. The reference in it to a mark resembling a trade-mark is redundant, as to falsely apply a mark so nearly resembling a trade-mark, &c. is, by sect. 2 (1) (*b*), declared to be a distinct offence.

3. Applying a False Trade Description to Goods.

"(d) Applies any false trade description to goods" (*d*). Sect. 2 (1) (*d*).

The sale of goods under a false trade description may constitute an offence of cheating or obtaining goods by false pretences at common law. The application of a false trade description was made a substantive offence by the Act of 1862, from sect. 7 of which Act the provisions in the present Act under this head are substantially taken. That Act did not, and the present Act does not, extend to descriptions of quality as apart from kind; but it is the intention of the present Act, under the sections dealing with trade-marks, of which the office is to indicate the maker, vendor, or selector of the marked goods (*e*), and which are, therefore, of the nature of trade descriptions, and under the sections dealing

The Act does not extend to false descriptions of quality.

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|--|--|
| (<i>s</i>) See above, p. 565. | (<i>a</i>) "So nearly resembling," p. 565. |
| (<i>t</i>) "Person," p. 558. | (<i>b</i>) Below, p. 601; cf. sect. 4, p. 563. |
| (<i>u</i>) "Goods," p. 567. | (<i>c</i>) Page 563. |
| (<i>r</i>) "Proprietor," p. 564; "assent of the proprietor," p. 564. | (<i>d</i>) "Goods," p. 567. |
| (<i>y</i>) "Trade-mark," p. 560. | (<i>e</i>) See Book I., Chap. II., p. 52. |
| (<i>z</i>) "Applies to goods," p. 567. | |

with false trade descriptions, extended by sect. 3 (2) and (3) to marks in general which fill the office of trade-marks, to reach all false merchandise marks, other than marks of quality (*f*).

Trade description.]—By sect. 3 (1)—

What is a
trade de-
scription.

“The expression ‘trade description’ means any description, statement, or other indication, direct or indirect—

“ (a) as to the number (p. 573), quantity, measure (p. 573), gauge, or weight (p. 573) of any goods, or

“ (b) as to the place or country in which any goods were made or produced (p. 574), or

“ (c) as to the mode of manufacturing or producing any goods (p. 578), or

“ (d) as to the material of which any goods are composed (p. 578), or

“ (e) as to any goods being the subject of an existing patent (p. 579), privilege, or copyright ;

and the use of any figure (*g*), word, or mark which,

Customary
trade de-
scription.

(*f*) *Quality.*—Adulteration, or the sale of goods not of the nature or quality demanded, or pretended, is made a criminal offence by other statutes in many special instances. By far the most important of these statutes are the Sale of Food and Drugs Acts, 1875, 1879 and 1899 (38 & 39 Vict. c. 63, and 42 & 43 Vict. c. 30 and 62 & 63 Vict. c. 51), by which it is an offence to mix injurious ingredients with any article of food, or any drug, with intent that the same may be sold, or to sell the article of food or drug so mixed ; to sell articles of food or drugs not of the nature, substance, and quality demanded by the purchaser ; to abstract from an article of food, with intent that the same may be sold without notice, any part of it so as

injuriously to affect its quality, substance, or nature, or to sell (without notice) the article so altered, and to import margarine and other foods insufficiently described upon their containers. For cases under these Acts, see the Law Reports Digest, “Adulteration.” Among other statutes may be mentioned 6 & 7 Will. 4, c. 37 (bread) ; 4 Geo. 2, c. 14, 17 Geo. 3, c. 29 (tea) ; 5 Geo. 1, c. 11, s. 23 (coffee) ; 37 & 38 Vict. c. 49, s. 14, 48 & 49 Vict. c. 51, s. 8 (beer) ; 32 & 33 Vict. c. 112 (seeds) ; 56 & 57 Vict. c. 56 (agricultural fertilizers and feeding stuffs) ; and the Margarine Act, 1887 (50 & 51 Vict. c. 29).

(*g*) *I.e.*, numeral. *Ex parte Stephens*, 3 C. D. 660, see above, p. 198.

according to the custom of the trade (p. 581), is commonly taken to be an indication of any of the above matters, shall be deemed to be a trade description within the meaning of this Act."

And by the M. M. A. 1891, s. 1, it is provided that—

" [f] the Customs entry (*h*) relating to imported goods shall, for the purposes of the M. M. A. 1887, be deemed to be a trade description applied to goods."

M. M. A.
1891.
Customs
entry.

It has now been decided by a Divisional Court (confirming the view expressed in the 1st edition of this work) that the provisions of sect. 2 (2) of the M. M. A. 1887, which make it an offence to sell goods to which a false trade description is applied, do not apply where the description is entirely verbal, still less where it is a mere inference from conduct, *e.g.*, the act of a salesman in handing over to a customer a parcel (alleged to contain a false trade description) without comment (*i*). The whole framework of the statute, with the exception of sect. 20 (*inf.*, p. 641), points to the necessity for a written or printed mark, or a physical mark in some other sense than a purely verbal description. But unintelligible writing may be explained by a statement made at the time of sale (*j*). Where a merely verbal description is the subject of complaint, proceedings may be taken under the Sale of Food and Drugs Acts (*k*).

Verbal trade
description.

The non-inclusion of verbal statements leaves a large class of frauds untouched by the Act (*l*). Goods, for instance, which have passed through the Customs under cover of an explanation placed upon their coverings may be sold retail

Frauds
effected under
cover of
verbal false
descriptions.

(*h*) See p. 583, below.

(*i*) *Coppen v. Moore* (No. 1), (1898) 2 Q. B. 300; 67 L. J. Q. B. 689, Wright and Darling, JJ.; *Langley v. Bombay Tea Co. Ltd.*, (1900) 2 Q. B. 460, Grantham and Chanuell, JJ.

(*j*) *Cameron v. Wiggins*, (1901) 1 Q. B. 1, Lawrance and Kennedy, JJ.; evidence to show that "N. M." meant New Zealand Mutton, was held to be admissible.

(*k*) *Coppen v. Moore* (No. 1), per Wright, J., (1898) 2 Q. B. at p. 304; 67 L. J. Q. B. at p. 690.

(*l*) Proceedings may be taken under the Sale of Food and Drugs Acts in cases coming within those statutes: see *Coppen v. Moore* (No. 1), (1898) 2 Q. B., per Wright, J., at p. 304; 67 L. J. Q. B. at p. 690.

Imitation
Demerara
sugar.

without the explanation, and with a verbal false description; as, of course, may also goods which, bearing no description at all, or no false description, could not be stopped on importation, or home-made goods. Mr. Poland, K.C., has expressed the view that the imitation of the crystals of Demerara sugar in beet-root sugar, and its sale as Demerara sugar, was not an offence under the Act (*m*). Sales upon such verbal false statements may, however, amount to the offence of cheating, or obtaining money by false pretences, if they are deliberate false statements of matters of fact known to the person charged, and are made in order to induce, and do actually induce, the buyer to purchase.

Imitations of
"get-up."

Goods may be passed off as those of the manufacture or merchandise of some person other than the person whose they are, without an explicit description of them as the goods of the first person, or any piracy or colourable imitation of his trade-mark or trade-name. This fraud forms the ground of a civil action (*o*). Such imitations may be false trade descriptions applied to the goods under sect. 3 (2) (*p*).

Words forming part of
the goods.

Words forming part of the goods upon which they appear cannot, it would seem, be taken to be a trade description applied to those goods within the meaning of the Act, although they may, in fact, give or suggest some description, statement, or other indication within the definition just cited, for the description is treated in the definition as an addition to the "goods," which are complete without it. This is the view taken by the Customs authorities in the application of sect. 16 (*q*). For instance, English words in verses on Christmas cards; the title of a book; the words *fast* and *slow* upon the regulator of a watch; mottoes and words of friendship on handkerchiefs, crockery, and so forth, are not treated by the Customs authorities as indications that the goods were produced in an English-speaking country. "On *such* goods, made abroad, it has been

(*m*) See the case and opinion set out, M. M. A. Report, p. 166.

(*o*) Book I., Chap. XVI., p. 446.

(*p*) *Infra*, p. 588.

(*q*) See M. M. A. Report, 1890, Appendix I., p. 275, a paper handed in by Mr. Follett, Solicitor of the Board of Customs, from which the illustrations in the text are taken.

thought " by the Customs authorities " wiser to regard (with some exceptions) English wording which goes no further than above mentioned (that is to say, which does not go into such statements as ' printed in England,' or ' very superfine cards,' or ' London lever watch,' &c.), as part of the ' goods,' and as not, therefore, rendering the goods liable under the Act, even though the general appearance given to them may be on this account, and on account of the wording, unquestionably English " (*r*).

The trade description may be a trade-mark or part of a trade-mark (*s*), or may include a trade-mark (*t*); but the case of a false name or initials is dealt with specially (*u*).

Trade description may be a trade-mark.

(a.) *Number, &c.*]—This sub-section is directed to descriptions applied to coverings (*v*) purporting to contain a specified or indicated number, quantity, &c., of goods, as well as to descriptions attached to the goods themselves. It meets frauds, such as the practice of marking upon cotton goods the number of laps or folds by a figure so placed as to be " commonly taken " to indicate the number of yards in the marked piece, the true number of yards being in fact less than the number marked (*y*).

Number.

It has been questioned whether the words in the clause cover indications of width, dimension, and weight per unit of length, which are of great importance in the textile trades; but it is submitted that they do, and it is said that the Manchester magistrates have so construed them (*z*).

Measure.]—The description of casks of beer as *barrels* in an invoice sent with them, has been held to be a statement within the definition that the casks contain thirty-six gallons each (*a*).

Measure.

Weight.]—In a civil case it has been held that goods done up in cases and supplied according to contract, the cases being

Weight.

(*r*) From the paper referred to in the last note.

(*s*) Sect. 3 (1). " False trade description," p. 584.

(*t*) Sect. 3 (2), p. 588.

(*u*) Sect. 3 (3), p. 590.

(*v*) Sect. 5 (2), p. 567.

(*y*) See the evidence of Mr. Bailey, Qq. 1966 *et seq.*, M. M. A. Report, 1890.

(*z*) See previous note.

(*a*) *Budd v. Lucas*, (1891) 1 Q. B. 408, Pollock, B., and Charles, J.

marked as one-pound cases, could not be forced upon a purchaser if they were actually under the weights indicated, although not deficient by more than an alleged customary allowance, on the ground that the purchaser could not sell them without committing an offence under the Act (*b*).

Where a description is applied to goods showing that the weight supplied is less than that for which the customer asks, no offence against sect. 3 (1) (a) is committed (*c*).

(*b*.) *Place or country.*]—This sub-section was regarded by many of the advocates of the bill as the most important clause of the definition; it is under cover of it that goods made abroad and so marked as to suggest that they are made in England are brought within the Act, and are made liable to seizure by the Customs authorities in accordance with sect. 16 (*d*).

Place of
origin.

The chief difficulty in the application of this clause of the definition arises from the fact that the clause is apparently framed on the assumption that all goods will be wholly made or produced in one place or country, whereas in fact many kinds of goods are worked upon in several before they are finished and ready for the market, or are made up of parts made or produced in different countries. *Bishop v. Toler* (*e*) was a case of this kind. A person had in his possession, for sale, margarine packed in cardboard boxes, marked with the words, "French factory." The margarine consisted of a substance, called *Le Dansk*, manufactured from animal fat at a factory in Paris, and sent thence to a factory at Southampton, where, by admixture with Danish butter and English milk, it assumed the form in which it was offered for sale. It was only when the margarine assumed this form that it was described as *Le Dansk*. The words "French

(*b*) *Hooper v. Balfour*, W. N. (1890) 61; 62 L. T. 616; *Green and Balfour's Arbitration*, W. N. (1890), 139, 156, Kay, J., and C. A.; and see *Guinness, Son & Co., Ltd. v. Wythe*—a case decided by a metropolitan police magistrate—30 L. Jo. 455 (1895).

(*c*) *Langley v. Bombay Tea Co., Ltd.*, (1900) 2 Q. B. 460; 69 L. J. Q. B. 725, Grantham and Channell, JJ.

(*d*) And in accordance with the agreements arrived at by the Commissioners at the International Convention, Conference of Rome, in 1886. This convention has not been ratified.

(*e*) 65 L. J. M. C. 1 (1895), Lord Russell of Killowen, L. C. J., and Cave, J.

factory" were held to be a "false trade description" within sects. 2 and 3 of the M. M. A. 1887, inasmuch as the margarine first became a finished product in England, while it was sold in circumstances which represented it to the buyer as having been manufactured in France. It has been held by a metropolitan police magistrate that the principle laid down in the *Le Dansk* case, that an article becomes a finished product at the time when it assumes the form in which it is offered for sale, although applicable to chemical combinations in which the several parts are lost in the whole composition, is not applicable to mechanical combinations in which all the parts remain unaltered, and that therefore the description of a watch, in which at least three wheels and four pinions of the "train," in addition to other parts of greater or less importance, were of foreign origin, as an "English lever" was a false trade description (*f*).

The difficulty above referred to is partly met by the definition of a false trade description as one which is false in a material respect, for this reduces it to a question of fact. No doubt, any Court, in determining whether the indication of a particular country as the place of manufacture was false in this sense or not, would be guided by the custom of the trade in the goods concerned, that is, supposing it to be consistent with honesty. The description of goods partly made in each of two countries as made in a third would, it may be assumed, be indefensible under any custom, unless it fell within the general saving of sect. 18 as a "conventional" or "generic" description lawfully and generally used at the

(*f*) *Lancashire Watch Co. v. H. D. Williamson, Ltd.*, Times, March 5, 1900. In the Q. B. D. (*Williamson v. Tierney*, 17 T. L. R. 174 (1901), Lord Alverstone, L. C. J., Kennedy and Phillimore, JJ.) the Court held that the mere fact that part of the watch was made abroad was not sufficient to make the description false, but that if the magistrate decided the case on what he held to be the recognised meaning of the word "English" as applied to watches, his decision would not be disturbed. In re-stating the case the learned magistrate said that he came to the conclusion, as a determination of fact upon evidence pro-

duced before him, that in the watch trade no watch was regarded as an English watch, or was rightly called English, which contained foreign parts of material importance other than the hair- and main-spring, or things of comparatively insignificant character, such as screws, and that certain parts of the watches were of most material importance, and were imported from abroad in such a condition that they were foreign parts when they arrived in this country, and remained foreign parts after they had been operated upon, polished, and fitted into the watch by the appellants. The Court, therefore, dismissed the appeal.—Times, April 17th, 1901.

passing of the Act, as, for instance, *French polish*, *American leather*, or *Indian rubber*. The last-mentioned section, however, extends to a trade description of place or country calculated to mislead as to the place or country where the goods to which it is applied were actually made or produced (the goods not being actually made or produced in the place or country indicated or suggested), only if there is added to the trade description, immediately before or after the name of that place or country, in an equally conspicuous manner with that name, the name of the place or country in which the goods were actually made or produced, with a statement that they were made or produced there (*g*). From this has arisen the now familiar notices, "made in Germany," "made in France," &c. (*gg*).

It is to be observed that the provision in sect. 18 requiring the addition of the name of the place or country of actual manufacture is only applicable where the trade description is calculated to mislead (*h*). It is not necessary, for instance, to mark *Morocco* leather or *Brussels* carpets as made in England, since the term is not calculated to lead any buyer to think the leather was made in Morocco or the carpet in Brussels.

By sect. 10 (2)—

Evidence of country of origin.

"In the case of imported goods, evidence of the port of shipment shall be *prima facie* evidence of the place or country in which the goods were made or produced."

And the port of shipment is stated in the Customs entry (*i*), which is now itself a trade description applied to the goods referred to by it (*k*).

Customs practice as to country of origin.

The practice of the Customs authorities, under sect. 16, with regard to the matters above referred to, was described by Mr. Follett, to the Committee of 1890, in the following terms (*l*): "As general rules, the board have acted on the principle that goods must (as indeed is in accordance with sect. 10 of the Act) be held *prima facie* to have been the

(*g*) Sect. 18, *infra*, p. 594; and see *Bischof v. Toler*, *ubi sup.*, at pp. 2 and 3.

(*gg*) In *Robinson & Barnsdale, Ltd.'s Case*, the words "made in England" on the back of a cigar-box did not save from a conviction for applying a false trade description to boxes of

English-made cigars, which bore the words Havannah and Santiago, &c. —*Times*, April 2nd, 1901.

(*h*) Cf. "So nearly resembling," *ante*, p. 565.

(*i*) Below, p. 583.

(*k*) M. M. A. 1891, s. 1.

(*l*) *Ante*, p. 572, n. (*g*).

make or produce of the country from which they last come; and that if a qualifying description to that effect is re-monstrated against on the ground that it would be untrue as to a material part, there must be a statement as to that part. For instance, if there were an importation of German cutlery with the name of an English dealer, and a qualification of *made abroad* were objected to on the ground that the handles (taking it to be knives), or the woodwork (taking it to be planes), were made in England and sent out by the dealer to be fitted, then it would be required that these should be stated, *blades (or woodwork) made in Germany*. Similarly (although as to the important part of the goods the circumstances are just reversed), it was required that if British goods were sent abroad to be finished in any respect, as, for instance, yarns to be dyed, that fact must be stated, *dyed abroad*, when they are re-imported.

Goods finished abroad.

“As regards goods coming in in an incomplete state, or merely as parts of an intended complete article, the Board have felt that they could do no more than deal with them as they stand, taking care that there is no description either of the parts themselves or of the whole goods to which they are going to be added which can form an incorrect indication as to the make of the imported portion.”

Foreign goods finished in England.

In the case of goods imported through the ports of a country other than that of their origin, for example, Swiss goods coming through a French port and marked as Swiss, the practice of the authorities is to detain them until a declaration by the importer, or other evidence regarded as satisfactory, is tendered to show that the goods are in fact Swiss.

Imports from inland country.

It has been held in an Irish case that the description of bacon which was killed in America, and was cured by the defendant Lipton partly in America and partly in Ireland, as “Lipton’s cure,” and “own cure at Lipton’s market,” was not a false trade description; although the magistrates and one of the judges who heard the case thought the use of the description by an Irish shopkeeper was likely to be deceptive (*m*).

(*m*) *R. v. Lipton*, 32 L. R. Ir. 115 (1893), Q. B. D. See also *R. v. Bramall*, Times, December 18th, 1891, where a description of machine-cut files as “hand-cut” was held to be an offence.

In a case where a tradesman sold bacon, which really came from Ireland, as "finest Wiltshire cut," and was prosecuted for applying a false trade description to the commodity, the defence was successfully set up, both before the justices and in the High Court, that the description referred, not to the place of origin of the bacon, but to the cut (*n*).

It is provided by sect. 16 (4) (*o*) that—

Goods bearing the name of an English place.

"Where there is on any goods a name which is identical with or a colourable imitation of the name of a place in the United Kingdom, that name, unless accompanied by the name of the country in which such place is situate, shall be treated for the purposes of this section as if it were the name of a place in the United Kingdom."

This provision is expressly restricted to the purposes of the section in which it occurs, that is, the section dealing with the importation of deceptively or spuriously marked goods; but the rule laid down in the clause would probably be adopted in regard to any suggested false trade description by the use upon goods of a name like the name of an English, Scotch, or Irish place. Goods marked simply "Rugby," for example, would be taken to be falsely described if made in Rugby, Tennessee.

(*c*.) *Mode of manufacturing, &c.*]—In the Irish case referred to above it was also held that the description in question was not an offence within this clause (*p*).

Material.

(*d*.) *Material, &c.*]—In a case where goods were marked and described as "natural wool" goods, this was held by the magistrates at Leicester to be an indication within the definition that the goods were all, or substantially all, woollen, although a custom to call cheap mixtures of cotton and a little wool "natural wool" was alleged (*q*).

(*n*) *Morris v. Royle*, 31 L. Jo. 339 (1896). See also *Harrod's Stores Case*, Times, Jan. 9, 1898, in which it was held on the facts that the term "Dresden" as applied to china indicated the factory from which the wares came, and not the style of decoration.

(*o*) See further, p. 634, and "Customs entry," p. 583.

(*p*) See note (*m*), *ante*, p. 577.

(*q*) *Leicester Case*, Times Newspaper, 20 Oct. 1893; and see *Meadows v. Catesby & Sons*, 107 L. T. Jo. 440 (1899), where it was held, by a metropolitan police magis-

“Flannelette” has been held by a metropolitan police magistrate not to be a “false trade description,” although the material was found on analysis to consist entirely of cotton, without the faintest trace of any wool. Except for a ticket bearing the word “flannelette,” with the price, attached to the goods, no representation was made to the public as to the meaning of the word “flannelette.” The magistrate was not satisfied that it was believed by the public to contain wool, or was bought on that ground, and he held that “flannelette” might fairly be construed as meaning “an article not quite equal to flannel, but clearly resembling it, and much cheaper” (r).

(e.) *Existing patent.*]—By sect. 105 of the Patents, &c. Patent Act, 1883, it is provided that—

“ (1) Any person who represents that any article sold by him is a patented article when no patent has been granted for the same, or describes any design or trade-mark applied to any article sold by him as registered when it is not so, shall be liable for every offence on summary conviction to a fine not exceeding 5*l*. ”

Sect. 105 of the Act of 1883.

“ (2) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade-mark is registered if he sells the article with the word ‘patent,’ ‘patented,’ ‘registered,’ or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to the article.”

Application for a patent (s), or provisional protection (t),

trate, a false trade description to describe a mattress containing sixty or seventy per cent. of jute or hemp as a “wool” mattress. There have also been convictions where trinkets were invoiced as composed of 800 parts silver out of 1,000, whereas they fell considerably short (Birmingham, *Pell's Case*), and where carbolic acid was sold as *Condy's Fluid* (Wandsworth, *Hall's Case*). See paper by Mr. G. B. Ellis on “The Merchandise Marks Act” in the *Trans. Chart. Inst. of Pat. Agents*,

Vol. XVII., p. 83.

(r) *Whiteley's Case*, Times, Jan. 16, 1895; and see *Nicholl's Case*, (1896), a prosecution before a metropolitan police magistrate for selling lard solidified with beef stearine as pure lard.

(s) So held by a magistrate in *R. v. Crampton*, 3 R. P. C. 537 (1886). See further as to this section below, Book II., Ch. II., p. 639.

(t) So held by a magistrate in *R. v. Wallis*, 3 R. P. C. 1 (1886).

does not authorize the use of the words patent or patented so as to avoid the penalty of this enactment; but the acceptance of the complete specification for a patent does, for it entitles the applicant to "the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance" (t).

The section just cited from the Patents, &c. Act does not apply to the case of a representation in respect of an article for which a patent has at some time been granted, but which has ceased to exist by effluxion of time or otherwise; the M. M. A. is not so limited. On the other hand, the section applies to every representation within its terms, whether made with intent to defraud or not.

There is no provision similar to sub-sect. (2) of the above section in the M. M. A., and the use of the words patent or patented does not necessarily, therefore, amount to a description, statement, or other indication that the goods to which they are applied are subject to an existing patent. A false claim of patent rights contained in a trade-mark is a bar to the interference of the Court for the protection of the trade-mark, and the cases decided on this subject will, no doubt, apply, so far as they go, in the construction of the present sub-section; but they do not lay down any definite rules (u).

In *Gridley v. Swinborne* (v), a case under the present Act, Coleridge, L. C. J., said that where the original patentee continued to use his old labels containing the word *patent*, there was no necessary implication of fraud; and the Court held that the defendant, who had sold goods, made from gelatine, under a patent which expired in 1847, as *Swinborne's patent refined isinglass*, was not guilty of any offence under the Act. In a case at Wolverhampton, however, Messrs. H. & T. Vaughan, lock manufacturers, were convicted under sub-sect. (c) for selling locks stamped "Vaughan's

t) Act of 1883, s. 15. And see *R. v. Townsend*, 13 R. P. C. 265 (1896), Worship Street Police-court; *per contra* in *Girdler's Case*, Times Nov. 22, 1894.

u. See Book I., Chap. XV., p. 401, above. (v) 52 J. P. 739, 791; 5 T. L. R. 71 (1888), Coleridge, L. C. J., and Grafton, J.

Patent" for which there was no existing patent, although the article was of their own manufacture (*x*); and it was held in a later case at the Mansion House to be no defence to a charge of selling articles marked "Patent," in contravention of sect. 105 of the Act of 1883, that the defendant's specification had been officially "accepted" by the Patent Office, although sect. 15 of that Act provides that on acceptance the applicant shall have the like privileges and rights as if a patent had been sealed on the day of acceptance (*y*).

In a recent case in Ireland, the defendants had sold a box of baking powder bearing a label with the words "Trade Mark—Royal—Registered," and on the obverse side the words "Manufactured by Royal Baking Powder Company, New York." The label in question was not registered in England, though it was registered in the United States. It was held that the use of the word "Registered" amounted to a representation that the word was registered in the United Kingdom, which was not affected by the words describing where the article was manufactured, and that accordingly a contravention of sect. 105 had been committed (*z*). But the use of the words "Trade Mark" is not necessarily a representation that the mark is registered (*a*).

Custom of the trade (b).]—Custom does not here mean the custom of merchants, which is part of the common law (*c*), or any of the six *consuetudines* mentioned by Coke (*d*). It is more akin to the custom or usage of a particular trade or market which is resorted to in order to import terms into commercial contracts not inconsistent with their words, or to explain the meaning of the expressions employed in them, that is, a particular custom to be established by evidence (*e*),

Custom of the trade.

(*x*) *Times*, Feb. 25, 1888.

(*y*) *Gruber's Case*, *Times*, Nov. 22, 1891. But see *R. v. Townsend*, 13 R. P. C. 255 (1896), Worship Street Police Court.

(*z*) *Wright Crossley & Co. v. William Johnson & Co.*, 15 R. P. C. 21 (1898). O'Brien, L. C. J., O'Brien and Boyd, JJ. *MacSymons' Stores, Ltd. v. Southworth*, 15 R. P. C. 748 (1898).

Day and Channell, JJ., was a similar case.

(*a*) *Sen Sen Co. v. Britten* (1899), 1 Ch. 692; 16 R. P. C. 137.

(*b*) Cf. "Common repute" in sect. 7, below, p. 620.

(*c*) Blackstone, Vol. 1, p. 74.

(*d*) 2 Inst. 58.

(*e*) *Wiggleworth v. Dillison*, 1 Sm. L. C., 10th ed., p. 528, and the cases cited in the notes.

or to the "custom of the country" imported into agricultural tenancies and leases, of which it is said it "must be applied to the approved habits of husbandry in the neighbourhood under circumstances of the like nature" (*f*). The custom is, therefore, the existing and generally recognized practice or usage of the trade, whether old or recent; but if recent, sufficiently old to have become generally recognized and followed (*g*).

The words may be compared to those used in the first sentence of sect. 18—"lawfully and generally applied to goods of a particular class, or manufactured by a particular method, to indicate the particular class or method of manufacture of such goods" (*h*).

In judging whether an alleged trade-mark, or a mark tendered for registration as a trade-mark, is calculated to deceive by reason of its resemblance to another trade-mark or otherwise, the Civil Courts, as has already been shown, consider all the circumstances of the trade concerned, and admit the evidence of persons engaged in the trade as experts (*i*).

The evidence to prove a custom within the definition above stated must obviously be similar to the expert evidence just mentioned—that is to say, it must be given by persons engaged in the trade, whether as manufacturers, merchants, or retailers, or by persons in the employment of such persons, or otherwise practically acquainted (for instance, as conductors of technical or trade journals) with the customs they depose to.

In a case where the question was whether the imposition on a vest of German manufacture, after its importation into England, of the words "Dr. Jaeger's Sanitary Woollen System Company, Sole Concessionaires: Pure Wool Warranted," was a "false trade description" under sect. 2 (1),

(*f*) 2 Platt, 279, cited in Stroud's Dic. s. v.

(*g*) "Usage of trade is a general and prevailing course of business, and witnesses who are called to prove it should cause their minds to revolve over instances known to

them of its having been acted upon." *Hall v. Hanson*, 7 C. & P. 711.

(*h*) See p. 594.

(*i*) Book I., Chapter X., "Restrictions on Registration," pp. 237, 247.

evidence was held admissible as to whether, according to the custom of the trade, the imposition of such words would be taken to indicate English manufacture (*j*).

In a case where an alleged custom in the furniture trade, to deliver goods upon sale or return, was set up in answer to a claim under the reputed ownership clauses of the Bankruptcy Act, Cave, J., said the question was, "whether it amounted to a custom of the trade of so notorious a character that anyone making inquiry of persons cognizant of the trade might ascertain that it was a custom" (*k*).

The part of the sub-section relating to the custom of the trade does not, by implication, exclude other evidence to explain the meaning of unintelligible writing (*l*).

Customs entry.]—The Customs entry for imported goods is a statement made up from the bill of lading (*m*) for purposes of Customs duty, and signed and declared to be true by the importer or his agent. It contains the name of the port or place from whence the goods come, and a description of the number of packages and the quantity and description of goods, in accordance with the requirements of the Official Import List. It was made a trade description under the principal Act by the Act of 1891, upon the recommendation of the Committee of 1890, and in accordance with the following passage from their report: "The evidence given before your Committee has, in their opinion, conclusively proved that goods (notably, articles of consumption) come into this country in large quantities in an adulterated form, but cannot, according to the evidence given by the Customs authorities, be detained under sect. 3 (d) (*n*) of the M. M. A.,

Customs entry.

Report of the M. M. A. Committee of 1890 on fraudulent importations.

(*j*) *Watson v. Dr. Jaeger's Sanitary Woollen System Co.*, 13 T. L. R. 150 (1897), Wright and Bruce, JJ. Evidence was also held admissible in this case as to alleged statements of the defendants' salesmen that the goods were English. The case was remitted on these points, but the summons was dismissed, both the alleged custom and the statements above mentioned having been held not to be proved. An appeal by case

stated by the Board of Trade was proposed, but not taken. See 32 L. J. p. 262.

(*k*) *Ex parte Nassau*, 2 T. L. R. 339 (1886).

(*l*) *Cameron v. Wiggins* (1901), 1 Q. B., Lawrence and Kennedy, JJ.

(*m*) See Mr. Seymour's evidence, M. M. A. Report, 1890, Q. 4824.

(*n*) False trade description as to the material of which any goods are composed.

because, in most instances, they bear no trade description as defined by sects. 3 and 5 of the said Act. Your Committee are of opinion that much harm is being done to legitimate trade by the impunity with which spurious articles are introduced into this country. They therefore propose that the Act should be amended by making the Customs 'entry,' which must bear a description of the goods imported, a 'trade description' within the meaning of the Act. The adoption of this amendment would, in the opinion of your Committee, give the Customs power to detain goods, the 'trade description' of which is false as to the material of which they are composed."

No general obligation to mark the place of origin.

The Committee refused to recommend that it should be made compulsory to mark all goods with an indication of origin, on the ground that this "would seriously restrict trade, and virtually destroy the business of warehousemen, commission agents, and small masters."

False trade description (o).]—By sect. 3 (1)—

What is a false trade description.

"The expression 'false trade description' means a trade description which is false in a material respect as regards the goods to which it is applied, and includes every alteration of a trade description, whether by way of addition, effacement, or otherwise, where that alteration makes the description false in a material respect, and the fact that a trade description is a trade-mark, or part of a trade-mark, shall not prevent such trade description being a false trade description within the meaning of this Act."

The last part of the definition would have been more appropriately placed in the definition a "trade description" (p).

The "false name or initials of a person" is specially dealt with by sect. 3 (3) (q), and the definition just stated is expanded by sect. 3 (2), which is set out below (r).

So that "false trade description" under the Act includes—

- (1.) A trade description false in a material respect as regards the goods to which it is applied.

(o) "Trade description," p. 570.

(q) Below, p. 590.

(p) "Trade description," p. 570.

(r) Page 588.

- (2.) An alteration of a trade description, whether false or not, such as to make it false in a material respect.
- (3.) Figures, words, or marks, or an arrangement or combination thereof, such as are reasonably calculated to lead persons to believe that the goods to which they are applied are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are (sect. 3 (2)).
- (4.) A false name or initials within sect. 3 (3) (s).

False.]—False is construed by the Customs authorities in the application of sect. 16 to mean, not “misleading” but simply “untrue” (*t*). It is immaterial that the buyer was not deceived (*u*). The expression “false description” is taken from the Act of 1862, s. 7, where it certainly means a description intended to deceive, since it is coupled with the phrase “for the purpose of falsely indicating, &c.,” but the construction just mentioned seems, on the whole, to be that intended by the Act, for *false* is contrasted with *genuine* in sects. 2 (2) (a), 4 (b), 6 (c), and 17; false declarations are referred to in sect. 8 (3); and sect. 18 seems to contemplate that some false descriptions within its scope may not be misleading. It is doubtful, however, whether, for the purposes of the Act, there is any substantial difference in effect between the two meanings. The essence of a description is that it should suggest something, and if it suggests what is untrue it is misleading.

In *The Patent Isinglass Case* (*v*), Coleridge, L. C. J., said that a false description within the Act meant something more than a mere inaccurate or mistaken description. There must be a criminal intent, a *mens rea* in the application; this is inferred because the Act creates criminal offences, and the construction adopted is consistent with the reference to “intent to defraud” in sect. 2 (1), and the defence that the person charged had “acted innocently,” which is admitted by sect. 2 (2).

(s) Below, p. 590.

(t) See Mr. Follett's evidence, ante, p. 572, n. (q).

(u) See *Kirschbaum v. Salmon & Gluckstein*, (1898) 2 Q. B. 19; 67

L. J. Q. B. 601, Lord Russell of Killowen, C. J., Hawkins, Day, Wills, and Wright, JJ.

(v) *Gridley v. Swinborne*, 52 J. P. 739, 791; 5 T. L. R. 71 (1888).

Material
respect.

False in a material respect.]—This expression was chosen, after much consideration, to meet the case of descriptions which are partly false; for instance, descriptions of mixed or composite goods, referring to some or one only of their composite parts. The clause was inserted “because it was considered impossible to test the exact percentage of a particular material, the name of which was assigned to the article” (*x*). Under it, the Court is left to decide as a question of fact whether it is false, for example, to describe textile goods made partly of cotton as *natural wool* (*y*); a material consisting entirely of cotton as “flannelette” (*z*); a cask containing less than thirty-six gallons of beer as a barrel (*a*); gelatine made from cod sounds as patent isinglass (*b*); or a watch with an English case and an English movement but a Swiss regulator, as an English watch (*c*); or, generally, goods partly made in the United Kingdom and partly abroad, as made in the United Kingdom (*d*).

Materially or
substantially
false.

“False in a material respect” is here treated as equivalent to materially or substantially false, so that the question is one of degree, and as regards some of the attributes referred to in the definition of trade description, no other meaning could be given to it. A description of weight, for example, can only be false by being too great or too small. But, as regards some of the other attributes referred to, the phrase seems more properly to mean that the matter falsely stated is material to be truly stated to the persons concerned, that is, the probable buyers, or others to whom the description is addressed. For example, if goods go through different stages in the course of manufacture in different countries, it is conceivable that only the country where they are finished, or where any other

(*x*) See the evidence of Mr. Courtenay Boyle, assistant secretary to the Board of Trade, M. M. A. Report, 1887, Qq. 38 *et seq.*

(*y*) See *The Leicester Case*, *ante*, p. 578, *Times Newspaper*, Oct. 20, 1893.

(*z*) *Whiteley's Case*, *Times*, Jan. 16, 1895.

(*a*) *Budd v. Lucas*, (1891) 1 Q. B. 408.

(*b*) *Gridley v. Swinborne*, 52 J. P. 739, 791; 5 T. L. R. 71 (1888).

(*c*) As to watches, see *Williamson v. Tierney*, 17 T. L. R. 174 (1900) (*English Lever*), and above, p. 575; also sect. 7, below, p. 620. It is said that all English watches have Swiss regulators.

(*d*) See p. 574, “place or country,” and *R. v. Lipton*, *ante*, p. 577.

particular stage is passed, is material to be named (*e*), and that, therefore, for the purposes of the Act, the goods may be well described only as made in that country (*f*). So, if the material of which goods are made is a metallic alloy, as the gold of commerce, it may be immaterial to state truly the nature of the baser metal (provided there is no false statement as to its absence, or its proportion in the mixture).

The materiality of a false trade description cannot be made dependent on a "doctrine of equivalents." If an article is sold under such a description—*e.g.*, machine-made cigarettes as "guaranteed hand-made"—the false description will not cease to be material because the article sold was as good as, or better than, that asked for by the purchaser (*g*). Doctrine of equivalents inapplicable.

The Committee of 1890 were strongly urged to recommend the adoption, as part of the Act, of certain definite limits in regard to measure, within which a deficiency from the measure actually indicated by a trade description should not be, but beyond which it should be deemed to be, false in a material respect; but they declined to suggest the enactment as a rule of law of what they regarded as properly a matter of evidence. Limits of error allowed.

The limits suggested by the Manchester Chamber of Commerce in 1888, and adopted under the Indian Merchandise Marks Act, are set out in the Appendix (*h*).

Alteration.]—The person who makes the alteration which causes the trade description to be false, applies the false trade description (*i*). Alteration of a trade description.

This clause of the definition relates only to alterations of the description, not to alterations of the goods described so that the description becomes false as applied to them. An

(*e*) Cf. the case of watches, below, p. 622.

(*f*) But see *Bishop v. Toler*, 65 L. J. M. C. 1 (1895), *ante*, p. 574.

(*g*) *Kirschenboim v. Salmon & Gluckstein*, (1898) 2 Q. B. 19; 67 L. J. Q. B. 601, Lord Russell of Killowen, C. J., Hawkins, Day, Wills, and Wright, JJ. The term "hand-cut" has been held by a Metropolitan

police magistrate to be a false trade description when applied to machine-cut tobacco: *Cohen, Wrenn & Co.'s Case*, *Times*, May 3, 1899.

(*h*) Page 863. M. M. A. Report, 1890, p. 322. Evidence of Mr. Bailey, Q. 2024.

(*i*) Cf. forgery of a trade-mark by altering a genuine trade-mark, sect. 4 (b), above, p. 563.

alteration, for example, by the adulteration of marked goods, such as to make them cease to be the goods described, may be an offence against the Act, if, within sect. 5 (1) (c) or (d), the person making the alteration applies the description to the altered goods, since it is false as regards them.

Application
of false trade
description.

Applies any false trade description.]—Sect. 5 defines when a person shall be deemed to apply a trade description to goods. It has been already set out (*k*).

By sect. 3—

“(2.) The provisions of this Act respecting the application of a false trade description to goods shall extend to the application to goods (*l*) of any such figures (*m*), words (*n*), or marks, or arrangement or combination thereof, whether including a trade-mark or not, as are reasonably calculated to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are.”

This sub-section does not in terms refer to goods to which a false trade description has been applied, as the next and corresponding sub-sect. 3 (3) does. It is difficult to see any reason for the change of language, and, it is submitted, it makes no difference in the construction of the Act, for it is not possible to extend the definition of “application” without extending correspondingly the class of things to which the application is made.

The name *Chilworth Gunpowder Co., Ltd.*, placed by contractors for the supply of gunpowder to the Government, upon barrels of powder, in the place where the name of the contractor was required to be inserted, was held in *Starey v. Chilworth Gunpowder Co.* (*o*) to be a false trade description, the powder being imported German powder, and not the manufacture of the defendants, and it being clear, as the Court held, that, in the particular case, contractor meant manufacturer, the defendants having dealt with the Govern-

(*k*) Above, p. 567.

(*l*) See sect. 5, above, p. 567.

(*m*) *I.e.*, numerals. *Ex parte Stephens*, 3 C. D. 659 (1876), Jessel, M. R.

(*n*) For names and initials, see sect. 3 (3), below, p. 590.

(*o*) 24 Q. B. D. 90 (1889), Coleridge, L. C. J., and Mathew, J.

ment as manufacturers only, although it is commonly a word of ambiguous meaning, capable of signifying either maker or vendor, or both. This decision must have been under sect. 3 (2), for sect. 3 (3) did not apply; but the question suggested above was not argued or referred to.

The sub-section makes the offence of applying a false trade description include that of forging a (registered) trade-mark, which is itself a separate offence under sect. 2 (1) (a), and also that of forging a trade-mark which is unregistered and not a trade-mark within the meaning of the Act (*p*), for the office of a trade-mark is to indicate that goods are the manufacture or merchandise of the persons with whose business or goods the trade-mark is identified by registration or use.

An unregistered trade-mark may be a trade description.

The following sub-section deals with false names and initials. That sub-section may possibly be held to be restricted to a very small class of such names and initials (*q*), and the question may then arise whether names and initials which are so used as not to fall within it, are *words* within the present sub-section. On a strict construction it may be difficult to hold that a general word in one sub-section can include a particular meaning introduced by an appropriate word into a co-ordinate sub-section immediately following the first; but there are many cases of overlapping sections and provisions in the present Act, and, if it be necessary in order to carry out the obvious intention of the Act, it is submitted that the interpretation suggested ought to be adopted.

Names and initials.

Calculated to lead, &c.]—The phrase may be compared with “calculated to deceive,” of sect. 2 (2) and sect. 4 (a) (*r*), and with “intent to defraud” of sect. 2 (1) (*s*). The persons intended are any class of probable purchasers of, or dealers in, the goods, so that it would be no defence to prove that the immediate purchasers, the persons to whom the goods falsely described were sold, if the offence were committed upon a sale, were not in fact deceived. This is the rule adopted in infringement cases (*t*). In such cases proof of

Calculated to lead persons to believe, &c.

(*p*) See sect. 3 (1), above, p. 560.
“trade-mark.”

(*s*) Page 603, *post*.

(*q*) See below, p. 591.

(*t*) See Book I., Chap. X., p. 221;

(*r*) Above, p. 565.

Chap. XV., p. 378.

actual deception is not a necessary part of the plaintiff's case (*u*), although its unexplained absence may be significant, if the alleged deceptive mark has been long in the market (*x*); and it is no excuse for the defendant to show that the actual buyers from him of the spuriously marked goods knew whose goods they were. They generally do know, and are parties to the intended frauds (*y*).

(4.) By sect. 3—

False name
or initials.

“ (3.) The provisions of this Act respecting the application of a false trade description to goods, or respecting goods to which a false trade description is applied (*z*), shall extend to the application to goods of any false name or initials of a person (*n*), and to goods with the false (*b*) name or initials of a person applied, in like manner as if such name or initials were a trade description, and for the purpose of this enactment the expression false name or initials means, as applied to any goods, any name or initials of a person which—

“ (a) are not a trade-mark (*c*) or part of a trade-mark, and

“ (b) are identical with, or a colourable imitation of the name or initials of a person carrying on business in connection with goods of the same description, and not having authorized the use of such name or initials, and (*d*)

“ (c) are either those of a fictitious person or of some person not *bonâ fide* carrying on business in connection with such goods.”

This is an awkwardly drawn sub-section, not in harmony with the remainder of the Act. The insertion of the negative clause (a), for instance, is not in accord with the general plan of allowing sections creating similar and similarly punished offences to overlap, and the expression colourable imitation

(*u*) Above, p. 375.

(*x*) Page 249.

(*y*) *Lever v. Goolwin*, 36 C. D. 1; 4 R. P. C. 472 (1887), C. A., cited p. 427.

(*z*) This clause is omitted from the last sub-section 3 (2).

(*a*) “Person,” sect. 3 (1), p. 558.

(*b*) Cf. “false trade description,” sect. 3 (1), p. 584, and “falsely apply,” sect. 5 (3), p. 569.

(*c*) “Trade-mark,” *i.e.*, registered trade-mark, sect. 3 (1), p. 560.

(*d*) *Quære*, “or.” see p. 591.

is in other sections represented by the phrase "so nearly resembling, &c."

The sub-section seems to be intended to extend the protection of the Act to trade-names which are protected by the civil law much in the same way as trade-marks (*e*), and also to stay frauds perpetrated by the use of "blind names" (*f*), that is, names belonging, in fact, to no one, but so used as to appear to be the names of respectable firms.

By the letter of the sub-section, a name or initials, to fall within its terms must fulfil each of the conditions (*a*), and (*b*), and (*c*); but it is submitted that the second *and* should be *or*, for no name can be identical with the name of a person carrying on business in connection with the goods, and at the same time be that of a person not *bonâ fide* so carrying on business (*g*). The Courts have no difficulty in reading *or* for *and* where the context requires it (*h*).

Reading (*b*) and (*c*) as alternatives, the operation of the sub-section is to forbid the use of any false name or initials (not being a registered trade-mark (*i*), or part of a registered trade-mark) which is either an unauthorized copy or imitation of a trade-name or trade-initials, or is the trade-name or trade-initials of no one, or no one *bonâ fide* carrying on business, *i.e.*, is a "blind name." If this is the correct view of the sub-section, it is an offence within sect. 2 (1) (*d*) or sect. 2 (2), to apply to any goods any name or initials of a person other than the trade-name of a person who has authorized the application, or to sell, &c., any goods to which any name or initials of a person, other than the trade-name of a person applied with his authority, have been applied.

For the civil law relating to trade-names, see Book I., Chap. XVI., and for the right of a man to honestly use his own name in his trade, p. 500.

(*e*) See Book I., Chap. XVI., p. 446.

(*f*) Below, p. 593.

(*g*) The view suggested has now been adopted by the Q. B. D. in Ireland, *R. v. Lipton*, *infra*, p. 594.

(*h*) As in *Townsend v. Read*, 10 C. B. n.s. 317; 30 L. J. M. C. 245;

and see Stroud's Dictionary, "or for and."

(*i*) Or trade-mark which, either with or without registration, is protected by law in any British possession or foreign state to which the provisions of sect. 103 of the Act of 1883 are applied. See p. 560.

Name.]—"The expression 'name' includes any abbreviation of a name" (*k*).

False name or initials.]—The adjective false governs the whole sub-section. Its effect seems to be to restrict the operation of the section to names and initials which are not the personal or the trade-names or initials of the persons applying them (*l*).

(a) *Not a trade-mark.*]—Trade-mark means trade-mark registered or otherwise within sect. 3 (1) (*m*). Many trade-marks consist of or include the names of their proprietors, or of the predecessors in trade of their proprietors, and a trade-name, if used in connection with the goods which its owner deals in, almost necessarily becomes a trade-mark if it is distinctive (*n*). The reason for excluding trade-marks and parts of trade-marks, seems to be that they are elsewhere dealt with under the heads of forgery and false application of a trade-mark (*o*); but this is not the case as regards parts of a trade-mark which do not so nearly resemble the trade-mark as to be calculated to deceive within the meaning of sect. 4 (*p*). Trade-marks which are or include names or initials, and which do not fall within the definition (*q*), are included within this sub-section if they comply with conditions (b) and [or] (c).

(b) *A colourable imitation, &c.*]—This expression is commonly used in infringement and passing off cases. It is equivalent to the phrase, used elsewhere in the Act, so nearly resembling as to be calculated to deceive (*r*), which has been already discussed.

Of the same description.]—Both trade-mark and trade-name rights are limited to the class of goods for which they are registered or used (*s*).

(*k*) Sect. 3 (1).

(*l*) Cf. "false," above, p. 585: and see p. 593, below.

(*m*) Page 560, "trade-mark."

(*n*) See Book I., Chap. VIII., p. 124, "name-marks."

(*o*) Sect. 2 (1) (a), p. 560: and 2 (1) (b), p. 567.

(*p*) Page 563.

(*q*) Page 560, "trade-mark."

(*r*) Sect. 4 (a), p. 565.

(*s*) See Book I., Chap. V., p. 96.

Not having authorized.]—This is more generally expressed than “without the assent of the proprietor,” which is the phrase used elsewhere in the Act (*t*), and already discussed, but it has probably just the same meaning. Proof of authority of proprietor.

There is no provision in the present sub-section casting the onus of proving the authority in question upon the defendant. This is probably due to an oversight.

(*c*) *Either those of a fictitious person or of some person not bonâ fide carrying on business in connection with the goods.*]—Apart from this Act it is perfectly legal, and the practice is very common, for a trader to use as his trade-name some name other than his own, and either the name of his predecessors in business, or a name chosen for some other reason, not being such a name as to infringe the rights of any other person in respect of his trade-name (*u*). It is submitted that the Act does not make the practice illegal, but that the above sub-section, under clause (*c*), is directed against the application to goods of any name which is not the trade-name of the person who applies it, whether that trade-name is his personal name or not, for the whole sub-section is governed by the use of the words “false name” and “false name or initials,” and the trade-name of the person using it is not a false name, nor are his trade-initials false initials (*x*). Trade-name of repute.

Evidence was given before the Committee of 1887 (*y*) of Blind names. the fraudulent use of well-sounding names which were not trade-names at all, and were used, not to identify the goods to which they were applied with the person applying them, or with any other manufacturer or merchant, but to suggest that they were the manufacture or merchandise of some seemingly respectable firm. Spanish sounding names on pseudo Spanish cigars; “The Sheffield Knife Company,” there being no such company, and the trade-names of defunct firms, were cited as examples of such “blind names” as they are called. Sub-sect. 3 (3) (*c*) seems to have been directed to

(*t*) Sect. 4 (a), p. 563; sect. 5 (3), p. 569.

(*u*) Book I., Chap. XVI., p. 463.

(*x*) Cf. as to the meaning of false, p. 585, above.

(*y*) See, for instance, the evidence of Mr. Freeman, M. M. A. Report, 1887, Qq. 2871 *et seq.*; of Mr. Hughes, *ibid.* Q. 1805; and Mr. Lockwood, *ibid.* Q. 1992.

stop the use of such names as these. It was stated before the Committee of 1890, that the Act had failed in this particular (z), but the statement was made under the assumption that the conditions (a), (b), and (c) were all required to be complied with, (b) and (c) not being treated as alternative, as is suggested above. The Committee did not think fit to recommend any alteration of the sub-section.

Fictitious.]—The words “a fictitious or non-existing person,” in sect. 7 (3) of the Bills of Exchange Act, 1882, have been held to apply to a case where the name used, as that of the payee of a forged bill, was the name of an actual person who was known to the acceptor and accustomed to have business dealings with him, but who had not, and was never intended by the drawer to have, any interest in the bill (a).

The description of bacon cured by Lipton as “Tracey’s cure,” where Tracey was Lipton’s foreman curer, has been held, in Ireland, to be an offence under sect. 3 (3) (c); although a custom was alleged for bacon dealers to describe their second quality goods by the names of their foremen curers (b). No evidence of the custom was adduced.

Not bonâ fide carrying on business, &c.]—The name and initials of a person who is carrying on business in connection with the goods are dealt with under the preceding head, sect. 3 (3) (b).

Conventional description.]—By sect. 18—

“Where at the passing of this Act (c), a trade description is lawfully and generally applied to goods of a particular class, or manufactured by a particular method, to indicate the particular class or method of manufacture of such goods, the provisions of this Act with respect to false trade descriptions shall not apply to such trade description when so applied: Provided that where such trade description includes the name of a place or country,

Provisions of the Act as to false description not to apply in certain cases.

(z) Evidence of Mr. Hughes, M. M. A. Report, 1890, Q. 5011, and Mr. Follett, p. 277.

(a) *The Governor and Company of the Bank of England v. Vagliano Brothers*, (1891) A. C. 107; *Clutton v.*

Attenborough, (1897) A. C. 90; 66 L. J. Q. B. 221.

(b) *R. v. Lipton*, 32 L. R. Ir. 115 (1892), Q. B. D.

(c) 23 August, 1887.

and is calculated to mislead as to the place or country where the goods to which it is applied were actually made or produced, and the goods are not actually made or produced in that place or country, this section shall not apply unless there is added to the trade description, immediately before or after the name of that place or country, in an equally conspicuous manner, with that name, the name of the place or country in which the goods were actually made or produced, with a statement that they were made or produced there" (*d*).

This general saving with regard to what are commonly called "generic descriptions," but may more accurately be termed "conventional descriptions," seems to have been suggested by a discussion which took place before the Committee of 1887, as to whether the name *Balbriggan hose* (*dd*) was properly applied to hosiery manufactured in Ireland, at Balbriggan only, or to hosiery of the same description made at several places in England, and in particular at Nottingham. It is based upon the fact that descriptions at first applied to, and appropriate for, a group within a class, constantly become used for the whole class, and are at length as appropriate for the rest of it as for the particular group. The case of trade-marks in this way become *publici juris* by piracy, misuse or abandonment, has been several times noticed in the preceding book (*e*). *Liebig's Extract*, *American leather cloth*, *French chalk*, *patent leather*, are examples of conventional descriptions within the section. The question whether an alleged conventional description does indicate the particular class or method of manufacture of the goods, *i.e.*, the kind of goods, is of course a question of fact to be established by evidence. It corresponds to the question whether an alleged trade-mark or trade-name of goods was the symbol or name of any goods of the kind, or the symbol or name of the plaintiff's goods of the kind only, which constantly arose for determination in trade-mark cases before the Registration Acts, and still frequently arises in trade-name and passing off cases (*f*).

(*d*) Cf. p. 574, "place or country," and see the Madrid Convention, Art. IV., App., p. 772. Marks (India), Appendix, p. 866, and p. 634.

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

(*dd*) As to this instance, see Trade- (*f*) See above, pp. 36 and 477.

It is to be noted that the section only applies to trade descriptions lawfully and generally applied at the passing of the Act.

“Lawfully” must mean not only so as not to be obnoxious to any then existing trade-name or trade-mark rights, or to particular statutes such as the Cutlors Acts (*g*), but also so as not to be within the prohibitions of the M. M. A. of 1862. That Act, however, contained a section (sect. 9) corresponding to sect. 18, but not limited to descriptions in use at the commencement of the Act. “Generally applied” means, it is submitted, applied by probable purchasers and persons dealing in the goods in question.

In *The Patent Isinglass Case* (*h*), the Court held that a good defence might have been raised under this section upon the finding of the magistrate that the article in question had been known to the trade as patent isinglass, although it was made from cod sounds. But it may be doubted whether such a finding would be sufficient if it were shown that the description deceived the public, although it was understood by the trade (*i*).

4. Causing an Offence to be Committed.

“ (f) Causes any of the things above in this section mentioned to be done.”

Sect. 2 (1).
Master and
servant.

Master and servant.]—The provisions of sect. 2 (2) of the M. M. A., 1887, make a master criminally liable for acts done by his servants in contravention of the section when acting within the general scope of their employment, although contrary to their master’s orders, unless the master can show that he has acted in good faith and has done all that it was reasonably possible to do to prevent the commission of offences by his servant (*k*).

(*g*) Below, p. 641.

(*h*) *Gridley v. Swinborne*, 52 J. P. 739, 791; 5 T. L. R. 71 (1888), Coleridge, L. C. J., and Grantham, J. See also per Holmes, J., in *R. v. Lipton*, p. 594, note (*b*).

(*i*) See *Ford v. Foster*, L. R. 7 Ch.

611, cited p. 37, and above, p. 342. And see *Hooper v. Balfour*, W. N. (1890) 61, 139, cited *ante*, p. 574, under “weight.”

(*k*) *Coppen v. Moore* (No. 2), (1898) 2 Q. B. 306; 67 L. J. Q. B. 689 (overruling a dictum of Pollock, B.,

By sect. 19 (3)—

“Nothing in this Act shall be construed so as to render liable to any prosecution or punishment any servant of a master resident in the United Kingdom who *bonâ fide* acts in obedience to the instructions of such master, and, on demand made by or on behalf of the prosecutor, has given full information as to his master.”

It seems an obvious inference from this section and from sect. 6 (1), relating to persons employed by others in the ordinary course of business, that servants and persons employed who do not come within the terms of the sections are to be liable for acts done in obedience to the instructions of their masters or employers (though they may, of course, be able to show that they acted without intent to defraud, or innocently). And this accords with the ordinary law that every person who either actually does, or authorizes, or procures to be done, a criminal act is guilty of the crime (*m*).

Thus, under the Pharmacy Act, 1868 (*n*), an unregistered chemist's assistant has been held liable to penalties for selling poisons on behalf of his master who was himself duly registered.

Both sect. 19 (3) and sect. 6 are restricted to cases of masters or employers resident in the United Kingdom.

Bonâ fide.]—It is difficult to attach any definite meaning to this expression in the section. It can hardly be construed to import the requirements of reasonable precaution, and having no reason to suspect the genuineness of the trade-mark or trade description, expressed in sect. 6 (b) and (c). It may mean without knowledge of the illegal character of the act, or merely that the person excepted has in reality, and not colourably only, acted as a servant and in obedience to his master's instructions. The last meaning suggested, however, would make the words mere surplusage.

in *Budd v. Lucas*, (1891) 1 Q. B. 408), Lord Russell of Killowen, C. J., Sir F. H. Jeune, P., Chitty, L. J., Wright, Darling, and Channell, JJ.; and see further, as to the nature of the defence in such cases, *infra*, pp. 601, 602.

(1) See next page.

(m) See Archbold, 22nd ed., pp. 10 *et seq.*; and sect. 11, below, p. 670.

(n) 31 & 32 Vict. c. 121, s. 15. *The Pharmaceutical Society v. Wheel- don*, 24 Q. B. D. 683 (1890), Div. Court. An action for penalties,

On demand has given full information.]—Compare sect. 2 (2) (b), (o), and sect. 6 (d).

Persons employed.]—By sect. 6—

Exemption
of certain
persons em-
ployed in
ordinary
course of
business.

“Where a defendant is charged with making any die, block, machine, or other instrument for the purpose of forging, or being used for forging a trade-mark, or with falsely applying to goods any trade-mark or any mark so nearly resembling a trade-mark as to be calculated to deceive, or with applying to goods any false trade description, or causing any of the things in this section mentioned to be done, and proves—

“ (a) That in the ordinary course of his business he is employed, on behalf of other persons, to make dies, blocks, machines, or other instruments for making, or being used in making, trade-marks, or as the case may be, to apply marks or descriptions to goods, and that in the case which is the subject of the charge he was so employed by some person resident in the United Kingdom, and was not interested in the goods by way of profit or commission dependent on the sale of such goods; and

“ (b) That he took reasonable precautions against committing the offence charged; and

“ (c) That he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the trade-mark, mark, or trade description; and

“ (d) That he gave to the prosecutor all the information in his power with respect to the persons on whose behalf the trade-mark, mark, or description was applied—

he shall be discharged from the prosecution, but shall be liable to pay the costs incurred by the prosecutor, unless he has given due notice to him that he will rely on the above defence.”

This section appears, in effect, to offer to any person charged with either of the offences mentioned in it the alternative of satisfying the four requirements specified in it, or of proving that he acted without intent to defraud within the meaning of sect. 2 (1) (p). It is probable that

(o) Page 609, below.

(p) *Infra*, p. 603, “intent to defraud.”

the latter will usually be the easier course, and it is submitted, although with some doubt, that in judging whether the defendant has acted without intent to defraud, the fact that he has not acted as the section indicates,—for instance, has taken no precautions,—is not to be regarded where he shows that he did not know, believe, or suspect, that the mark or description in question was forged, or false, or falsely applied.

Much evidence was given before the Committee of 1887 on behalf of the Association of Bleachers, whose members are accustomed in the ordinary course of their business to mark trade-marks and descriptions upon goods, and to pack the goods according to their customers' orders, to show that from the enormous number of the marks (*q*) and descriptions employed in the textile trade, and the fact that many contain words in Oriental languages with which the bleachers are not acquainted, it would be a great hardship to cast upon them the duty of verifying the title to, and the genuineness of every mark furnished to them by their customers. The association presented a memorial to the chairman of the Committee protesting against the Bill under their consideration in its then form, and suggested for insertion into it a section nearly corresponding to the present section, but without the modifications (b), (c), and (d). The section was, no doubt, based upon these representations and proposals (*r*).

The
Bleachers'
protest.

Clauses 2 (1) (a) ("forges any trade-mark"), and 2 (1) (e) ("disposes of or has in his possession any die, &c. for the purpose of forging a trade-mark") are omitted from the section, and so also is sub-sect. 2 (2) ("exposing, &c. for sale goods to which a forged trade-mark, &c. has been applied").

The first condition (a) is triple, so that the person charged must prove in all six propositions to bring himself within the section.

Precautions:—Information.]—Clauses (b) and (c) correspond to clause (a) of sect. 2 (2); clause (d) to clause (b) of sect. 2 (2), (*s*), except that the words "on demand made by

(*q*) 60,000 cotton marks were registered as trade-marks before 1887. There were probably many more unregistered, but in use.

(*r*) M. M. A. Report, 1887, pp. 254, 266.

(*s*) See below, pp. 604, 608.

or on behalf of the prosecutor" are there inserted. Under the present section, it seems, the party charged must volunteer the information if it is not demanded, but, on the other hand, he can give it at any time down to the hearing of the charge.

Costs.]—Compare sect. 14 (*t*). This penalty is omitted from sect. 2 (2), because the information there referred to must be given on demand as a condition of the special defence allowed by the sub-section.

Accessories.

Accessories.]—The offences dealt with by the Act are all misdemeanours, and there are, accordingly, no accessories to them. The provision of the Act of 1862 (sect. 13) making every person who shall aid, abet, counsel, or procure the commission of an offence under the Act guilty of a misdemeanour, has not been introduced into the present Act, and any such person can, consequently, only be convicted of an offence if he has committed it as a principal under sect. 2 (1) (f) ("causes any of the things above in this section mentioned to be done"), or under one of the special headings. Sect. 11, set out below, is not directed to the punishment of accessories generally, as the side-note wrongly suggests, but to the punishment of offences committed abroad.

Offences committed abroad.]—By sect. 11—

Punishment
of accessories
[to offences
committed
abroad].

"Any person who, being within the United Kingdom, procures, counsels, aids, abets, or is accessory to the commission, without the United Kingdom, of any act, which, if committed in the United Kingdom, would under this Act be a misdemeanour, shall be guilty of that misdemeanour as a principal, and be liable to be indicted, proceeded against, tried, and convicted in any county or place in the United Kingdom in which he may be, as if the misdemeanour had been there committed."

The side-note to this section in the Queen's Printers' copy (punishment of accessories) is misleading. The section is directed to meet offences committed abroad by persons in the

(*t*) Page 616, below. Similar penalties as to costs are imposed by the Margarine Act, 1887 (50 & 51 Vict. c. 29), s. 7, and the Sale of Food and Drugs Act, 1875 (38 & 39 Vict. c. 63), s. 25,

United Kingdom. In general, offenders can only be prosecuted in the counties or districts where their offences were committed (*u*), and penal Acts are to be read, if possible, as not creating any offence to be committed outside the country for which they are enacted (*v*).

The Civil Courts will interfere by injunction to prevent steps being taken, or anything done within the jurisdiction, with a view to, or for the purpose of, infringing the plaintiff's trade-mark, or passing off goods as his abroad (*y*).

5. Defences under Sect. 2 (1).

The sub-section concludes with the words "shall, subject to the provisions of this Act, and unless he proves that he acted without intent to defraud, be guilty of an offence against this Act."

The provisions of the Act referred to are sect. 6 (*z*) (persons employed); sect. 13 (*a*) (vexatious indictments); sect. 15 (*b*) (limitation for prosecutions); and sect. 19 (3) (*c*) (servants acting under their masters' orders).

Unless he proves (d).]—The policy of the Act is, when once it has been established that a trade-mark has been made without the assent of the proprietor, or that a false description has been applied to goods, or that goods to which a forged trade-mark has been applied have been sold by the person charged (*e*), or any other thing done which, if done

Proof of
innocence.

(*i*) See *Archbold*, 22nd ed., pp. 34 *et seq.* There are many exceptions by statute. See, in particular, as regards the places mentioned in the list at p. 763, 53 & 54 Vict. c. 37.

(*x*) *Machod v. Att.-Gen. for New South Wales*, (1891) A. C. 455.

(*y*) *Rodgers & Son, Ltd. v. Rottgen*, 5 T. L. R. 678 (1889), Kay, J.; *Société Anonyme des Verriers de l'Etoile's Tm.*, (1894) 1 Ch. 61; (1894) 2 Ch. 26; 10 R. P. C. 436; 11 R. P. C. 142, Stirling, J., and C. A.

(*z*) Page 598.

(*a*) Page 615.

(*b*) Page 615.

(*c*) Page 597.

(*d*) Cf. the second part of sect. (2), p. 607, and the Food and Drugs Act, 1875 (38 & 39 Vict. c. 63), s. 24, by which, if a defendant relies on any provision or exception in the Act, he must prove that he falls within it.

(*e*) The master is *prima facie* liable for the act of his servant, being within the scope of his employment, even though contrary to his orders,

with such a criminal intent as is contemplated by the Act, would be an offence, to cast upon the person charged the onus of disproving the existence of such intent, and this is carried further by casting upon him also the onus of proving the assent of the proprietor (*f*), where that is material. Great stress was laid upon this feature of the Act when the Bills upon which the Act was founded were before the Committee of 1887, as the almost total failure of the Act of 1862 was believed to be due to the necessity for the prosecutor in prosecutions under it to prove the intent to defraud (*g*). There are now upon the statute book a good many Acts by which the onus of proof of justification or excuse is cast on the person charged (*h*). For instance, the application of any of the marks scheduled to the Public Stores Act, 1875 (*i*), without authority (proof of which authority lies on the party accused), is a misdemeanour; and so is being found at night having in possession house-breaking implements without lawful excuse (proof of which excuse lies on the party charged) (*k*). Purchasing, or receiving, or having in possession forged bank-notes or bills, knowing them to be forged (*l*), and making or having in possession coining tools (*m*) without lawful authority (the proof of which authority lies on the party accused), are felonies. The Sale of Food and Drugs Act, 1875 (*n*), and the Margarine Act, 1887, are other instances (*o*).

but may meet that *prima facie* case successfully by showing that he acted without intent to defraud: *Coppen v. Moore* (No. 2), (1898) 2 Q. B. 306; 67 L. J. Q. B. 689, Lord Russell of Killowen, C. J., Sir F. H. Jeune, P., Chitty, L. J., Wright, Darling, and Channell, JJ.

(*f*) Sect. 4; sect. 5 (3). Proof of the authority required under sect. 3 (3) (b) is not thrown on the person charged.

(*g*) M. M. A. Report, 1887. See the evidence of Messrs. Hughes, Lockwood, and Uttley. The Committee of 1862 were strongly urged to report in favour of the insertion

of similar provisions as to the onus of proof in the Act of that year, but they declined to do so. M. M. A. Report, 1862, evidence of J. T. Smith, Q. 2643.

(*h*) See a paper by Mr. J. T. Smith in M. M. A. Report, 1862, p. 162.

(*i*) 38 & 39 Vict. c. 25, s. 4.

(*k*) 24 & 25 Vict. c. 96, s. 58.

(*l*) 24 & 25 Vict. c. 98, s. 13.

(*m*) 24 & 25 Vict. c. 99, s. 24.

(*n*) See sects. 5 and 8. *Bitts v. Armstead*, 20 Q. B. D. 771.

(*o*) Cf. also the presumption of guilty knowledge from evidence of possession of recently stolen goods. *Arcbold*, 22nd ed., p. 313.

And by the common law, wherever the act charged is not indifferent, but in itself unlawful, the proof of justification or excuse in such case lies on the defendant, and on failure thereof, the law implies a criminal intent (*p*).

Intent to defraud.]—This does not mean intent to defraud any particular person (*q*). So that an offence may be committed, although precautions are taken to prevent the immediate purchaser from the person charged being deceived, as, for example, by adding to a false trade description upon a covering a label which bears the name of the person whose manufacture or merchandise the goods within the covering really are, or which is otherwise explanatory, for the label may be intended to be removed, and the goods passed on to the ultimate purchasers with the false trade description unqualified (*r*).

Intent to defraud.

The provision of the Act of 1862, s. 12, that, where in proceedings in respect of an offence under that Act it should be necessary to allege or mention an intent to defraud, it should not be necessary to allege or prove an intent to defraud any particular person (*s*), has not been reproduced, probably because the onus of proof has, in the present Act, been shifted to the person charged. It appears that the absence of the provision makes no difference to the effect of the Act.

“The words ‘intent to defraud’ in this Act mean more than an intent to cheat a customer.” They apply to cases “where a person uses a particular mark without any intent in so doing to induce a buyer to accept goods which might otherwise be rejected” (*t*). And in a case where the offence consisted in English manufacturers placing their name on

(*p*) Per Lord Mansfield, *R. v. Woodfall*, 5 Burr. 2667, note (1).

(*q*) *Wood v. Burgess*, *infra*. Cf. forging a trade-mark, above, p. 563, note (*u*).

(*r*) *Wood v. Burgess*, 24 Q. B. D. 162 (1889), Coleridge, L. C. J., and Mathew, J., a case under sect. 2 (2). And cf. “so nearly resembling,” sect. 4 (a), *ante*, p. 565, and “calculated to lead,” sect. 3 (2), above, p. 589; and the civil law rule, above, pp. 225, 381, and *Lever v.*

Goodwin, 36 C. D. 1; 4 R. P. C. 492 (1887), C. A.

(*s*) Similar sections occur in 24 & 25 Vict. c. 98, s. 44 (forgery), 24 & 25 Vict. c. 96, s. 88 (false pretences), and 24 & 25 Vict. c. 97, s. 58 (malicious injuries to property).

(*t*) Per Mathew, J., in *Starey v. Chilworth Gunpowder Co.*, 24 Q. B. D. 90 (1889). See also the judgment of Channell, J., in *Christie, Manson & Woods v. Cooper* (1900), 2 Q. B. 522.

goods manufactured by other persons, but equal in quality to their own (*u*), Coleridge, L. C. J., said: "In the present case all further controversy is superfluous when once one has ascertained with certainty what *fraud* means in the Act. I agree that if the word is used in the sense of putting off a bad article on a customer in order to get money unfairly, there is no evidence here of anything of the kind having been done. On the contrary, it is expressly found that the article supplied was as good as that contracted for. But that, I think, is not the correct meaning of the word *fraud* as used in this Act of Parliament. The Act is directed against the abuse of trade-marks, and the putting off on a purchaser of not a bad article, but an article different from that which he intended to purchase and believes he is purchasing. It would apply to cases where a particular article, manufactured by a particular person, had acquired a wide-spread reputation (as, for instance, happened in the celebrated case of the fish sauces (*v*)), and some one supplied another and a different article under that name, so as to make the purchaser take something which he did not know he was taking."

On the other hand, the Act does not apply to mere cases of inaccurate or mistaken descriptions. The charges under it are criminal charges, and, according to the ordinary rule, a criminal intent—a *mens rea* in the person charged—must be made out (*x*). It is immaterial that the buyer was not deceived (*y*).

Giving
information.

Reasonable precautions. — Giving information.] — Where special defences are provided by the Act, in sect. 2 (2) (*a*) and (*b*) (*z*), and sect. 6 (*a*), the matters to be proved by the person charged include, that he took all reasonable precautions against committing an offence against the Act, and that he

(*u*) See note (*t*), *ante*, p. 603.

(*v*) *Burgess v. Burgess*, 3 De G. M. & G. 896; 22 L. J. Ch. 675, cited p. 501.

(*x*) *Gridley v. Swinborne*, 52 J. P. 739, 791; 5 T. L. R. 71 (1888), Coleridge, L. C. J., and Grantham, J.; *Budd v. Lucas*, (1891) 1 Q. B. 408.

(*y*) See *Kirschenboim v. Salmon & Gluckstein*, (1898) 2 Q. B. 19; 67 L. J. Q. B. 601, Lord Russell of Killowen, C. J., Hawkins, Day, Wills, and Wright, JJ.

(*z*) Below, pp. 607, 608.

(*a*) Above, p. 598.

gave all the information in his power (b) with respect to the persons from whom he obtained the marked goods, or the person on whose behalf the mark or description in question was applied. No doubt it was intended by the draughtsmen of the Act to make these matters tests of innocent conduct on all charges under the Act, but it is submitted that the provisions respecting them cannot be imported into sections, as the above section, where they are not expressed; in fact, this has recently been held to be so in regard to sect. 2 (2) (c) (c). The most ordinary evidence to show that the party charged acted without intent to defraud, or "otherwise innocently" (d), would be evidence of ignorance of the facts on which the charge is based: for instance, evidence that he did not know or suspect that the mark forged was a trade-mark; that the goods to which the trade description was applied were not the goods described; or evidence that he believed he had the assent or authority of the proprietor of the trade-mark in question to apply it.

Evidence of the defendant.]—By sect. 10 (1) (in any prosecution for an offence against this Act)—

Evidence of the defendant and his wife.

"A defendant, and his wife, or her husband, as the case may be, may, if the defendant thinks fit, be called as a witness, and, if called, shall be sworn and examined, and may be cross-examined and re-examined in like manner as any other witness."

Rebutting evidence.]—If the person charged gives, or calls evidence to show that he acted without intent to defraud, the prosecutor may give rebutting evidence, and, in particular, evidence of transactions similar to the offence charged, in which the person charged was concerned, and antecedent (but, it is said, not subsequent (e)) to that offence (f).

(b) See also sect. 19 (3), above, p. 597.

(c) *Christie, Manson & Woods v. Cooper*, (1900) 2 Q. B. 522, Grantham and Channell, JJ.; and see "otherwise acted innocently," below, p. 610.

(d) Sect. 2 (2) (c), *infra*, p. 610.

(e) *R. v. Holt*, 30 L. J. M. C. 11 (1861).

(f) *Budd v. Lucas*, (1891) 1 Q. B. 408, Pollock, B., and Charles, J. Evidence of previous short deliveries. *R. v. Francis*, L. R. 2 C. C. R. 128, a case of false pretences. See Archbold, 22nd ed., p. 285.

The above provisions seem to be impliedly superseded by the Criminal Evidence Act, 1898 (61 & 62 Vict. c. 36). But the extent to which that statute repeals such provisions has not yet been determined (*f*).

6. Sale or Possession of Falsely-Marked Goods.

Sub-sect. 2 (2) provides that—

“Every person (*g*) who sells, or exposes for, or has in his possession for, sale, or any purpose of trade or manufacture, any goods or things to which any forged trade-mark (*h*) or false trade description (*i*) is applied (*k*), or to which any trade-mark or mark so nearly resembling a trade-mark as to be calculated to deceive is falsely applied (*l*), as the case may be, shall” (unless he establishes one of specified defences (*m*)) “be guilty of an offence against this Act.”

Cases where possession or sale is an offence *prima facie*.

Some other cases where possession is made an offence *prima facie*, are collected at p. 602. Imitating the mark of the Birmingham Proof House for gun barrels, or knowingly selling any barrel bearing an imitation of such mark (*n*); marking the mark of a hammer on cutlery not made of hammered steel, or having in possession for the purposes of sale articles so marked; marking cutlery, or having in possession for sale cutlery marked, with a false indication of quality, or with the words *London* or *London made*, unless the cutlery were manufactured in the city of London (*o*), or within twenty miles thereof, are misdemeanours.

By the Margarine Act, 1887, s. 6 (*p*), it is provided that every package, whether open or closed, and containing marga-

(*f*) See *R. v. Dunning*, 34 L. J. 33 (1899), C. C. C.; *R. v. Brazil*, 34 L. J. 132; 63 J. P. 138; (1899), Sussex Assizes, Wills, J. As to cross-examination in reference to previous convictions, see *Charnock v. Merchant*, (1900) 1 Q. B. 474.

(*g*) Page 558.

(*h*) Pages 560, 563.

(*i*) Pages 570, 584.

(*k*) Page 567.

(*l*) Page 569.

(*m*) See p. 607.

(*n*) 53 Geo. 3, c. 115.

(*o*) 59 Geo. 3, c. 7. See a paper by Mr. J. T. Smith, M. M. A. Report, 1862, p. 162.

(*p*) 50 & 51 Vict. c. 29. This section is amended in certain details by the Sale of Food and Drugs Act, 1899 (62 & 63 Vict. c. 51).

rine (*q*), shall be branded or marked in a certain way, and that "if such margarine be exposed for sale, by retail, there shall be attached to each parcel thereof so exposed, and in such manner as to be clearly visible to the purchaser" a specified label. It has been held that a parcel of margarine placed behind a screen out of the sight of purchasers in a shop, and from which portions were cut for sale to them, is not (*r*), but that parcels done up in wrappers and placed in the shop so that the wrappers, but not the margarine itself, could be seen by purchasers, are "exposed for sale" within the meaning of this section (*s*). In a later case, slices of bread, spread with a mixture of Danish butter and margarine, and also haddocks on which was put margarine cut from a lump kept on a shelf, were sold at a refreshment room for consumption on the premises; no margarine was sold to customers to take away, and the establishment was conducted strictly as a refreshment house. There were no labels either on the slices or on the lump of margarine; but notices were posted in the shop that "Nothing but a mixture of the best Danish butter and margarine is sold at this establishment." It was held that the margarine had not been exposed for sale by retail within the meaning of sect. 6 of the Act of 1887, and that the machinery of that section was inapplicable to such a course of business (*t*).

7. Defences under Sect. 2 (2).

Sub-sect. (2) declares the person charged, if he falls within the earlier part of the sub-section, to be guilty of an offence against the Act—

"Unless he proves—

"(a) That having taken all reasonable precautions

(*q*) The provisions of the Margarine Act, 1887, as to margarine, are now extended to margarine cheese, by the Sale of Food and Drugs Act, 1899 (62 & 63 Vict. c. 51), s. 5.

(*r*) *Crane v. Laurence*, 25 Q. B. D. 152 (1890), Cave and Smith, JJ. See also case of *Butter Association v. Edmonds*, 30 L. Jo. 214 (1895).

(*s*) *Wheat v. Brown*, (1892) 1 Q. B. 418, Lawrance and Wright, JJ.

(*t*) *Moore v. Pearce's Dining and Refreshment Rooms*, (1895) 2 Q. B. 657; 73 L. T. 400, Lord Russell of Killowen, C. J., Cave, J. See also *World's Tea Co. v. Gardner*, 59 J. P. 358 (1895), Day and Wright, JJ.

against committing an offence against this Act, he had at the time of the commission of the alleged offence no reason to suspect the genuineness (*u*) of the trade-mark, mark, or trade description; and

“ (b) That on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons from whom he obtained such goods or things (*r*); or

“ (c) That otherwise he had acted innocently.”

The onus of establishing the innocence of any person charged, whose case is shown to fall within the earlier part of the section, is, therefore, as under the corresponding subsection (1) (*y*), already considered, cast upon the person charged. Clauses (a) and (b) of sub-sect. (2) of sect. 2 apply to cases where the goods in question are in the possession of the accused for sale, or are sold with the forged trade-mark or false trade description already stamped upon or otherwise applied to them. But any defendant to whose case clauses (a) and (b) applies is entitled to prove that he “acted innocently” otherwise than by proving that he had taken all reasonable precautions against committing the offence, and that he had no reason to suspect the genuineness of the trade-mark or trade description (*z*). Where the false trade description is applied on the occasion and as part of the terms of sale, the accused must rely for his exculpation upon clause (c)—viz., by showing that he had acted innocently (*a*).

The special defences (a) and (b) correspond to (b), (c), and (d) of sect. 6 (*b*), except that the information here re-

(*u*) Page 605. Cf. sect 6 (*e*), p. 598, and sect. 17, p. 520, and also “false,” p. 585.

(*x*) Pages 599, 604 and 609.

(*y*) Page 601.

(*z*) *Christie, Manson and Woods v. Cooper*, (1900) 2 Q. B. 522, *Grantham and Channell, JJ.* See also p. 610.

(*a*) *Coppen v. Moore* (No. 2), (1898) 2 Q. B. 306, at p. 313; 67 L. J. Q. B. 689, at p. 693; *Christie, Manson and*

Woods v. Cooper, ubi supra. In this case the appellants had catalogued goods for sale by auction as “Dresden china,” but, having received information before the sale leading them to doubt the genuineness of the marks on the china, they sold it “for what it was.” It was held that the absence of *mens rea* was a good defence, and the conviction by the magistrate was quashed.

(*b*) Page 598.

ferred to is to be given on demand, and in sect. 6 there is a special provision as to costs, which does not occur here. Rebutting evidence may be given by the prosecution to displace these defences (c).

Gave all the information.]—In the evidence given before the Committees of 1862 and 1887, great stress was laid upon the importance of compelling retail traders and others found in possession of spurious goods, or found offering them for sale, to give such information as should lead to the discovery of the real, or the original, offenders. For frauds by false marking can usually only be detected when the goods are offered to the general public, and the goods are then in the hands of persons who are, or may be, or may speciously pretend to be, innocent of the frauds. Mr. Hindmarch, Q. C., the draughtsman of the Act of 1862, described the provisions for disclosure as of the essence of the Bill upon which the Act was founded (d).

Information as to principal offender.

By sect. 6 of the last-mentioned Act (e), a person who sold, &c. any article together with a forged trade-mark, &c., was bound, upon demand in writing, by or on behalf of the persons whose trade-mark was forged, &c., and within twenty-four hours after the demand, to give full information in writing of the name and address of the person from whom, and the time when, he obtained the article. And any justice of the peace might order such information to be given. Refusal or neglect to comply with the order was punishable by a penalty of 5*l.*, and was *prima facie* evidence of guilty knowledge at the time when he sold the article, on the part of the person refusing or neglecting.

Provision for disclosure in the M. M. A. 1862.

There is no provision in the present Act corresponding to this and enabling an order for disclosure to be made, or making refusal or neglect to give information evidence of guilty knowledge or intent. Proof that the person charged has given all the information in his power is made a term of the special defences under sect. 2 (2) (b), and sect. 6 (d), and under sect. 14 the Court, upon a prosecution, in making an

(c) Page 605.

(d) M. M. A. Report, 1862, Q. 2865.

(e) 25 & 26 Vict. c. 88. The section is much abbreviated.

order for costs, may have regard to the information given by, and the conduct of, the defendant and prosecutor respectively; but it is quite conceivable that a defendant might refuse to give information with impunity, except as to payment of costs, and secure an acquittal under the general defences of sect. 2 (1) (without intent to defraud), or sect. 2 (2) (c) (acted innocently). In a civil action against him, based upon the same offences, the person charged could, of course, be compelled to make the disclosure on "discovery," if it were relevant to the issues raised.

"Otherwise acted innocently."

(c) *That otherwise he had acted innocently.*] — Compare "without intent to defraud," above, p. 603. Whether the defendant tenders evidence or not, and whether any of the special defences sanctioned by the Act is set up or not, the Court must, in order to convict, be satisfied that he acted with a criminal intent in doing the acts complained of (*f*). But where the defendant has knowingly applied a false trade description to goods, he cannot bring himself within clause (c) by showing that he had no intention of deceiving the buyer, but acted from some other motive, *e.g.*, a desire to save expense by using up a stock of old labels which had ceased to be a true description of the goods to which they were applied (*g*).

The statute enables a defendant to prove that he had "acted innocently" otherwise than by proving that he had taken all reasonable precautions against committing the offence, and that he had no reason to suspect the genuineness of the trade-mark or trade description, &c. (*h*). Innocence of any intention to infringe the Act might co-exist with a suspicion as to the genuineness of the mark or description (*i*).

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

(*g*) *Kirschenboim v. Salmon & Gluckstein*, (1898) 2 Q. B. 19; 67 L. J. Q. B.

601, Lord Russell of Killowen, C. J., Hawkins, Day, Wills, Wright, JJ.

(*h*) *Christie, Manson and Woods v. Cooper*. See note (*a*).

(*i*) Per Channell, J., (1900) 2 Q. B. at p. 529.

8. Punishment.

By sect. 2 (3) and (4)—

“ (3.) Every person guilty of an offence against this Act shall be liable—

“ (i.) on conviction on indictment, to imprisonment, with or without hard labour, for a term not exceeding two years, or to fine, or to both imprisonment and fine; and Fine and imprisonment.

“ (ii.) on summary conviction to imprisonment, with or without hard labour, for a term not exceeding four months, or to a fine not exceeding twenty pounds, and in the case of a second or subsequent conviction to imprisonment, with or without hard labour, for a term not exceeding six months, or to a fine not exceeding fifty pounds; and

“ (iii.) in any case, to forfeit to her Majesty every chattel, article, instrument, or thing by means of or in relation to which the offence has been committed. Forfeiture of the goods.

“ (4.) The Court before whom any person is convicted under this section may order any forfeited articles to be destroyed or otherwise disposed of as the Court thinks fit.”

Forfeiture and destruction (k).]—Sect. 21 of the Act of 1862 authorized the Court in any suit at law or in equity for forging a trade-mark, &c., to order the goods bearing the spurious marks to be destroyed; and the various sections of the Act imposing penalties contained provisions for forfeiture and destruction to the same effect as the sections set out above.

It has been shown in the earlier part of the book that the Court of Chancery would have interfered, and now the High Court of Justice interferes, independently of sect. 21 of the Act of 1862, to order the destruction of spuriously marked articles, but that if the marks can be completely removed, the

(k) Cf. sect. 12 (3), p. 619, by which compensation for loss may be awarded to an innocent party out of the proceeds of forfeited goods. And as to forfeiture on importation, see sect. 16, p. 624.

Court permits this to be done without requiring the articles to be destroyed (*l*).

9. Prosecution.

By sect. 2—

“(6.) Any offence for which a person is under this Act liable to punishment on summary conviction may be prosecuted, and any articles liable to be forfeited under this Act by a Court of summary jurisdiction may be forfeited, in manner provided by the Summary Jurisdiction Acts (*m*): Provided that a person charged with an offence under this section before a Court of summary jurisdiction shall, on appearing before the Court, and before the charge is gone into, be informed of his right to be tried on indictment, and if he requires be so tried accordingly.”

The Court in Scotland is the Sheriff Court (*n*), and the Summary Jurisdiction Acts there mean the Summary Procedure Act, 1864, and any Acts amending the same (*n*). In Dublin, the Summary Jurisdiction Acts are the Acts regulating the powers and duties of justices of the peace for the police district of Dublin metropolis, and, as regards the rest of Ireland, the “Summary Jurisdiction Acts” means the Petty Sessions (Ireland) Act, 1851, and any Act amending the same. The “Court of summary jurisdiction” means justices acting under those Acts (*o*).

Indictment and information.]—For forms of these, see the Appendix, p. 844.

Official prosecutions.]—It is provided by sect. 2 of the M. M. A. 1891, that—

“2.—(1.) The Board of Trade may, with the concurrence of the Lord Chancellor, make regulations providing that in cases appearing to the Board to affect the general

(*l*) Book I., Chap. XV., p. 421. *Sluzinger & Sons v. Feltham & Co.*, 6 R. P. C. 531 (1889), C. A.

(*m*) 42 & 43 Vict. c. 49.

(*n*) Sect. 21. Any aggrieved person can prosecute in Scotland, with the concurrence of the Procuro-

rator Fiscal: *Burns v. Turner*, 25 Ct. of Sess. Ca., 4th ser., 38 (1898), Lord Justice Clerk Kingsburgh, Lord Trayner, Lord Moncrieff.

(*o*) Sect. 22. The compromise of a prosecution is, it seems, not improper. See *Fisher v. Apollinaris Co.*, 10 L. R. Ch. 297 (1875), L. J.

interests of the country, or of a section of the community, or of a trade, the prosecution of offences under the M. M. A. 1887, shall be undertaken by the Board of Trade, and prescribing the conditions on which such prosecutions are to be so undertaken. The expenses of prosecutions so undertaken shall be paid out of moneys provided by Parliament.

“(2.) All regulations made under this section shall be laid before Parliament within three weeks after they are made if Parliament is then sitting, and if Parliament is not then sitting, within three weeks after the beginning of the next session of Parliament, and shall be judicially noticed, and shall have effect as if enacted by this Act, and shall be published under the authority of her Majesty’s Stationery Office.

“(3.) Nothing in this Act shall affect the power of any person or authority to undertake prosecutions otherwise than under the said regulations.”

This provision was made upon the recommendation of the Committee of 1890.

The regulations made by the Board of Trade under the Act (*p*) are set out in the Appendix, p. 840. The fifth of such regulations provides that the Board may, before undertaking a prosecution at the instance of any applicant, require the applicant to give security for costs on such terms and in such manner as it thinks proper.

It is provided by sect. 1 of the Merchandise Marks (Prosecution) Act, 1894 (*q*), that—

The powers exercisable by the Board of Trade under the M. M. A. 1891, with respect to the prosecution of offences under the M. M. A. 1887, may, in cases which appear to the Board of Agriculture to relate to agricultural or horticultural produce, be exercised by

(*p*) 21 May, 1892. A list of the prosecutions instituted by the Board of Trade from Jan. 1888 to the end of 1896 will be found in the *Trans.*

Chart. Inst. Pat. Agents, 1897-98, at p. 130.

(*q*) 57 & 58 Vict. c. 19. The Act is to be read with the M. M. A. 1887 and 1891.

that Board, and in such cases the former Act shall apply as if the Board of Agriculture were referred to therein instead of the Board of Trade.

By sect. 2 it is provided that—

“This Act shall not apply to Ireland.”

This Act was passed in accordance with a recommendation of a Select Committee of the House of Lords, appointed in 1893, to consider the question of the marking of foreign meat (*r*).

The regulations made by the Board of Agriculture under the Act of 1894 are set out in the Appendix, p. 841.

A circular letter, dated 1st February, 1895, addressed by the Board of Agriculture to secretaries of Chambers of Agriculture, agricultural societies and farmers' clubs, on the working and interpretation of the Merchandise Marks (Prosecution) Act, 1894, will be found in the Appendix, *post*, p. 842.

Indictment,
right to be
tried by.

Right to be tried by indictment.]—If notice of this right be not given to the person charged on his appearing in Court, and before the charge is gone into, the proceedings are invalid (*s*). And, *semble*, it is immaterial whether or not the defendant knew of his right to be tried by jury, and whether or not the Court knew before the proceedings commenced that he intended to plead guilty in the course of the case (*t*). This was so held in a case under sect. 17 of the Summary Jurisdiction Act, 1879, by which a similar duty of informing a defendant, charged with one of the offences included under the section, of his right to be tried by a jury is cast upon the Court of summary jurisdiction (*u*). There are numerous special Acts comprising corresponding provisions (*r*).

(*r*) 1893 (214), p. xviii. par. 110.

(*s*) Cf. 38 & 39 Vict. c. 63, s. 14, under which it is a condition precedent to the right of the purchaser of adulterated goods to take proceedings, that he should have given the seller notice of his intention to have the goods analysed. *Parsons v. Birmingham Dairy Co.*, 9 Q. B. D. 172 (1882), Div. Court. See also *Carle v. Elkington*, 40 W. R. 510;

R. v. Cockshott, (1898) 1 Q. B. 582; 67 L. J. Q. B. 467, Wright and Darling, JJ.

(*t*) *R. v. Cockshott*, *supra*.

(*u*) Last case and *Re Holeton*, *Times Newspaper*, 29 June, 1885; *Stone's Justices' Manual*, 31st ed., p. 43.

(*r*) See Glen's *Summary Jurisdiction Acts*, 6th ed., p. 126.

Limitation of prosecutions.]—By sect. 15—

“No prosecution for an offence against this Act shall be commenced after the expiration of three years next after the commission of the offence, or one year next after the first discovery thereof by the prosecutor, whichever expiration first happens.” Limitation.

Sect. 18 of the Act of 1862 was to the same effect. The ordinary period of limitation upon the summary prosecution of offences is six months (*y*).

A question may arise as to whether the above section applies to a prosecution for the special offences created by sect. 8 or sect. 20 of the Act (*z*), since the phrase “an offence against this Act” which occurs in it, is taken from sect. 2, and does not occur in those sections. It is submitted that sect. 15 does not apply, and that, accordingly, the ordinary rule of six months’ limitation holds for prosecutions under sect. 8 or sect. 20.

Vexatious Indictments Act.]—By sect. 13—

“The Act of the session of the twenty-second and twenty-third years of the reign of her present Majesty, chapter seventeen, intituled ‘An Act to prevent vexatious indictments for certain misdemeanours’ (*a*), shall apply to any offence punishable on indictment under this Act, in like manner as if such offence were one of the offences specified in section one of that Act, but this section shall not apply to Scotland.” Vexatious
Indictments
Act.

The effect of this is, that no bill of indictment can be presented to, or found by, any grand jury for an offence under the Act, unless either the prosecutor has been bound over to prosecute or give evidence; or the person charged has been committed to or detained in custody, or has been bound over to answer an indictment for the offence; or the indictment is preferred with the consent of a judge, the attorney-general, or the solicitor-general. And where a justice refuses to commit, or to hold to bail a person charged with an

(*y*) Summary Jurisdiction Act, 1848, sect. 11; Stone’s Justices’ Manual, 31st ed., p. 36; Glen, pp. 39, 45.

(*z*) Sect. 8 (3) (false declaration as to watch). Sect. 20 (pretended royal warrant).

(*a*) 22 & 23 Vict. c. 17.

indictable offence under the Act to be tried for the same, the justice may, and must at the desire of the prosecutor, take the recognizance of the prosecutor to prosecute and transmit the recognizance, information, and depositions, if any, to the Court in which the indictment ought to be preferred, in the same manner as if he had committed the person charged for trial (*b*).

Costs.

By sect. 14—

“On any prosecution under this Act the Court may order costs to be paid to the defendant by the prosecutor, or to the prosecutor by the defendant, having regard to the information (*c*) given by and the conduct of the defendant and prosecutor respectively.”

This is subject to the special rule of sect. 6 (*d*), where the defence allowed by that section is set up.

The section gives the Court unlimited jurisdiction over the costs, without reference to the result of the prosecution, except so far as this is made a subject for consideration by the reference to conduct. It may be compared with Ord. 65, r. 1 (*e*), and sect. 5 of the Judicature Act, 1890, which deal with the costs of civil proceedings (*f*). Under Ord. 65, r. 1, it is held that a lump sum, assessed by the Court, may be awarded as costs (*g*); that a successful plaintiff may be ordered to pay the costs of the action (*h*); but that the defendant cannot be ordered to pay them where the plaintiff had no cause of action (*i*). The discretion must, of course, be exercised judicially and on fixed principles of general application (*k*).

(*b*) Stone's Justices' Manual, 31st ed., p. 622.

(*c*) See above, p. 609, “information.”

(*d*) Above, p. 598.

(*e*) See the note to this in the Annual Practice, from which the cases next cited are taken.

(*f*) As to costs in actions for infringement, see Book I., Chap. XV., p. 429.

(*g*) *Willmott v. Barber*, 17 C. D. p. 774 (1881); *Corporation of Bradford*

v. Pickles, (1894) 3 Ch. 53; 63 L. J. Ch. 587.

(*h*) *Harris v. Petherick*, 4 Q. B. D. 611 (1879); *Fane v. Fane*, 13 C. D. 228 (1879).

(*i*) *Dicks v. Yates*, 18 C. D. 76 (1881); *Foster v. G. W. Ry. Co.*, 8 Q. B. D. 515 (1882).

(*k*) *Cooper v. Whittingham*, 15 C. D. 501 (1880); *Jones v. Curling*, 13 Q. B. D. 265 (1884); *The Monk-seuton*, 14 P. D. 51 (1889). And see the trade-mark cases *Upmann v.*

The ordinary rule as to the costs of summary proceedings is, that if a conviction or order is made, the justices may order the defendant to pay to the prosecutor or complainant, and if the information or complaint is dismissed, the prosecutor or complainant to pay to the defendant, such costs as they think just and reasonable (*l*).

Where a fine ordered to be paid on a conviction by a Court of summary jurisdiction does not exceed five shillings, then, except so far as the Court may think fit to expressly order otherwise, an order shall not be made for payment by the defendant to the informant of any costs, and the Court shall, except so far as they think fit to expressly order otherwise, direct all fees payable or paid by the informant to be remitted or repaid to him; the Court may also order the fine or any part thereof to be paid to the informant in or towards the payment of his costs (*m*).

Under sect. 12 (3) (*n*) compensation may be awarded to an innocent party out of the proceeds realized from forfeited goods for any loss sustained by him in dealing with such goods.

Appeal.

By sect. 2 (5)—

“If any person feels aggrieved by any conviction made by a court of summary jurisdiction, he may appeal therefrom to a court of quarter sessions.”

The appeal will be governed by sect. 31 of the Summary Jurisdiction Act, 1879, and the provisions of that section must be complied with (*o*).

The decision of justices upon any point of law, or if it is alleged to be in excess of jurisdiction, may also be questioned by requiring the justices to state a case for the determination

Forrester, 24 C. D. 231 (1883), and the *American Tobacco Co. v. Guest*, (1892) 1 Ch. 630; 9 R. P. C. 218, cited above, pp. 429, 431.

(*l*) Summary Jurisdiction Act, 1848, sect. 18; Stone's Justices' Manual, 32nd ed., p. 66.

(*m*) Summary Jurisdiction Act, 1879, sect. 8.

(*n*) Page 619, below.

(*o*) See Glen's Summary Jurisdiction Acts, 6th ed., p. 148; Stone's Justices' Manual, 32nd ed., p. 89.

of the Queen's Bench Division (*p*); an order or conviction made by them without jurisdiction may be quashed upon a *certiorari* (*q*); and if they have refused to hear and determine a case in which they have jurisdiction they may be ordered to do so by *mandamus* (*q*).

Saving of other Proceedings.

By sect. 19 (1) and (2)—

“ (1.) This Act shall not exempt any person from any action, suit, or other proceeding which might, but for the provisions of this Act, be brought against him.

“ (2.) Nothing in this Act shall entitle any person to refuse to make a complete discovery, or to answer any question or interrogatory in any action, but such discovery or answer shall not be admissible in evidence against such person in any prosecution for an offence against this Act ” (*r*).

Search Warrant.

By sect. 12—

“ (1.) Where, upon information of an offence against this Act (*s*), a justice has issued either a summons requiring the defendant charged by such information to appear to answer to the same, or a warrant for the arrest of such defendant, and either the said justice on or after issuing the summons or warrant, or any other justice, is satisfied by information on oath that there is reasonable cause to suspect that any goods or things by means of or in relation to which such offence has been committed are in any house or premises of the defendant, or otherwise in his possession or under his control in any place, such justice may issue a warrant under his hand by virtue of which it shall be lawful for any constable named or referred to in the warrant, to enter such house, premises, or place at any reasonable time by

Where a
prosecution
is pending.

(*p*) 20 & 21 Vict. c. 43, s. 3; 42 & 43 Vict. c. 49, s. 33. The statement of the case must be requested in writing within seven days of the date of the proceeding to be questioned. S. J. Rule 17; Stone, p. 83.

(*q*) See Stone, p. 86. See Shortt and Mellor's Crown Office Practice, pp. 114 *et seq.*

(*r*) Cf. sect. 23, by which rights, penalties, &c. under the M. M. A. 1862, are saved.

(*s*) Sect. 2 (1) and (2), p. 556.

day, and to search there for and seize and take away those goods or things; and any goods or things seized under any such warrant shall be brought before a court of summary jurisdiction for the purpose of its being determined whether the same are or are not liable to forfeiture (*t*) under this Act (*u*).

“(2.) If the owner of any goods or things which, if the owner thereof had been convicted, would be liable to forfeiture under this Act, is unknown or cannot be found, an information or complaint may be laid for the purpose only of enforcing such forfeiture, and a court of summary jurisdiction may cause notice to be advertised stating that, unless cause is shown to the contrary at the time and place named in the notice, such goods or things will be forfeited, and at such time and place the Court, unless the owner or any person on his behalf, or other person interested in the goods or things, shows cause to the contrary, may order such goods or things or any of them to be forfeited.

Where the owner of the goods cannot be found.

“(3.) Any goods or things forfeited under this section, or under any other provision of this Act (*t*), may be destroyed or otherwise disposed of, in such manner as the Court by which the same are forfeited may direct, and the Court may, out of any proceeds which may be realized by the disposition of such goods (all trade-marks and trade descriptions being first obliterated), award to any innocent party any loss he may have innocently sustained in dealing with such goods.”

Disposal of forfeitures, compensation to innocent party.

Forfeiture without conviction.]—An offence against the Act comprises two distinct elements: first, the doing of one of the specified acts, for instance, making a trade-mark without the assent of the proprietor, applying a false trade description to goods, or having in possession for sale any goods to which a forged trade-mark is applied; and, secondly, doing this with intent to defraud, or not innocently, and without any of the special defences mentioned in the Act. The existence of the first element can be ascertained from the chattel, article, instrument, or thing by means of, or in relation to which the offence (*x*), if committed at all, has been committed; but the

(*t*) See sect. 2 (3) (iii), p. 611.

(*u*) As to search warrants generally, see Glen's Summary Jurisdiction Acts, 6th ed., p. 302, where a list of

the numerous Acts authorizing the granting of them is given.

(*x*) Sect. 2 (3) (iii), p. 611.

existence of the second can only be established in relation to the conduct of a particular person, here referred to generally as "the owner" of the goods or things. The Act, however, in almost all cases casts the onus of establishing that he acted without intent to defraud, or otherwise innocently, or a special defence upon the person charged, and, in the absence of any evidence by "the owner," for the purpose of forfeiting the goods under the section, evidence supplied by inspection of the goods themselves, or otherwise given in relation to them, and the marks applied to them will be sufficient (*y*).

Marks on Watch Cases.

By sect. 7—

Application
of the Act to
watches.

"Where a watch case has thereon any words or marks which constitute, or are by common repute (*z*) considered as constituting, a description of the country (*a*) in which the watch was made, and the watch bears no description of the country where it was made, those words or marks shall *prima facie* be deemed to be a description of that country within the meaning of this Act, and the provisions of this Act with respect to goods to which a false trade description has been applied (*b*), and with respect to selling or exposing for or having in possession for sale, or any purpose of trade or manufacture, goods with a false trade description (*b*), shall apply accordingly, and for the purposes of this section the expression 'watch' means all that portion of a watch which is not the watch case" (*c*).

Gold or silver watch cases, whether of British make or imported into Great Britain, are required to be stamped with assay marks, of which the most important are the hall-marks, showing the standard of purity of the metal (*d*). Evidence was adduced before the Committee of 1887 to show that the English hall-mark upon a watch case containing a foreign movement was understood by buyers to be an indication that the movement was of English make, and, further, that the

(*y*) Cf. sect. 16, below, p. 627, "such goods."

(*z*) Cf. "custom of the trade," in sect. 3 (1), *ante*, p. 581.

(*a*) See sect. 3 (1), "place or

country," p. 574.

(*b*) Sect. 2 (2).

(*c*) *I.e.*, The "movement."

(*d*) The statutes are very numerous.

See Appendix, p. 847.

introduction of the letter *F* into the hall-marks put upon imported watch cases, which had been provided for by the Customs Tariff Act, 1876 (*c*), was not sufficient to enable buyers to distinguish foreign from English-made cases. The section set out above, and sect. 8 of the Act, were accordingly introduced for the purpose of preventing the assay marks from leading, or being used to lead, to deception (*f*). It is said that the provisions have been successful, and have proved highly beneficial to the English watch trades (*f*).

On examination, sect. 7 appears to be a special case falling within provisions elsewhere contained in the Act, for words or marks which constitute, or are by common repute considered as constituting a description of the country in which the movement was made, marked upon the case would seem to be a "trade description" within sect. 3 (1) (*g*), "applied to" the whole watch within sect. 5 (*h*), and if the movement has not, in fact, been made in the country indicated by the description, the trade description is false within sect. 3 (1) (*i*). This is another instance of overlapping, of which several cases occur in the Act. It is submitted that the construction of the wider general provisions ought not to be affected, in regard to watches, by the presence of the narrower special section here referred to (*j*).

The section applies only where the double condition that the watch case has upon it words or marks which constitute, or are by common repute considered as constituting a description, of the country where the movement was made, and that the movement bears no description of the country where it was made, is fulfilled. It does not, therefore, extend to the sale of a watch in a case marked so as to indicate that the movement was made in any country other than that where it was, in fact, made, if the movement itself is marked with a description of the country in which it was made, although a

(*c*) 39 & 40 Vict. c. 35, s. 1, amended by the Revenue Act, 1883 (46 & 47 Vict. c. 55), s. 10.

(*f*) See "Watches" in the indexes to the M. M. A. Reports, 1887 and 1890.

(*g*) Page 570.

(*h*) Page 567.

(*i*) Page 584.

(*j*) Cf. p. 589.

purchaser who did not notice or appreciate the conflict between the marks, might be misled by the mark on the case. But any such sale would, it is submitted, fall within the general provisions dealing with false trade descriptions of the Act.

Movements
partly made
abroad.

Description of the country where it was made.—It is often difficult to say what country is the country where a movement was made, since almost, if not quite, all English movements contain foreign-made parts, for instance, the chain, hair spring, and regulator, and sometimes foreign-made movements are imported in the rough and are finished in England (*k*). In regard to the former case there was a general, but not unanimous, agreement among the expert witnesses called before the Committee of 1887 that, at any rate, if the foreign-made parts are only those mentioned, the movement may fairly be described as English made, but in regard to the latter there was a decided difference of opinion (*l*). This difficulty has already been referred to in considering what is meant by “false in a material respect” (*m*). It must be solved in each case according to the view the Court takes, having regard to such usages of the trade as are proved to exist, and as can be supposed to be familiar to the ultimate buyers.

Prima facie be deced.—It is impossible to attach any sensible meaning to the words *prima facie* in this section. They were probably intended only to enable the person charged to show that the words or marks in question do not constitute, and are not by common repute considered as constituting a description of the country in which the movement was made, as alleged, but for this they are both unnecessary and inappropriate.

Marking watch cases.—By sect. 8—

“ (1.) Every person (*n*) who after the date (*o*) fixed by Order in Council sends or brings a watch case,

(*k*) *Williamson v. Tierney*, 17 T. L. R. 174 (1900), and *Times*, April 18th, 1901, cited p. 575, was such a case.

(*l*) See “Watches” in the index to M. M. A. Report, 1887.

(*m*) Above, p. 586. See also “place or country,” p. 574, and sect. 18, p. 594.

(*n*) Sect. 3 (1), p. 558, “person.”

(*o*) 28 Nov. 1887: *London Gazette*, 9 Dec. 1887.

whether imported or not, to any assay office in the United Kingdom for the purpose of being assayed, stamped, or marked, shall make a declaration declaring in what country or place the case was made. If it appears by such declaration that the watch case was made in some country or place out of the United Kingdom, the assay office shall place on the case such a mark (differing from the mark placed by the office on a watch case made in the United Kingdom), and in such a mode as may be from time to time directed by Order in Council.

“ (2.) The declaration may be made before an officer of an assay office, appointed in that behalf by the office (which officer is hereby authorized to administer such a declaration), or before a justice of the peace, or a commissioner having power to administer oaths in the Supreme Court of Judicature in England or Ireland, or in the Court of Session in Scotland, and shall be in such form as may be from time to time directed by Order in Council.

“ (3.) Every person who makes a false declaration for the purposes of this section shall be liable, on conviction on indictment, to the penalties of perjury, and on summary conviction to a fine not exceeding twenty pounds for each offence” (*p*).

See sect. 7, above, p. 620. The Order in Council is printed in the Appendix, p. 837.

The section is only directed to secure that foreign-made cases shall bear a distinctive mark. It does not prevent English movements being put into foreign cases, or foreign movements into English cases.

The Committee of 1897 recommended that the marks of foreign origin placed upon watches or watch cases ought to be required in equally visible letters upon the dome or dial of the watch itself, inasmuch as the watch is often made abroad, but imported in order to be placed in a British hall-marked case and then sold as of home manufacture (*q*).

Importation of marked watches.]—By sect. 42 of the Customs Act, 1876 (*r*), the importation of clocks and watches, Watches and
clocks.

(*p*) See sect. 15, p. 615, “limitation.”

(*q*) M. M. A. Report, 1897, p. 70.
(*r*) 39 & 40 Vict. c. 36.

or any other article of metal impressed with any mark or stamp representing, or in imitation of, any legal British assay, mark, or stamp, or purporting by any mark or appearance to be of the manufacture of the United Kingdom is prohibited.

10. Prohibition on Importation.

By sect. 16 (*s*)—

“Whereas it is expedient to make further provision for prohibiting the importation of goods which, if sold, would be liable to forfeiture under this Act; be it therefore enacted as follows:

Goods liable to forfeiture under the Act, or bearing British or Irish trade-marks or names.

“ (1.) All such goods, and also all goods of foreign manufacture bearing any name or trade-mark being or purporting (*t*) to be the name or trade-mark of any manufacturer, dealer, or trader in the United Kingdom, unless such name or trade-mark is accompanied by a definite indication of the country in which the goods were made or produced, are hereby prohibited to be imported into the United Kingdom, and, subject to the provisions of this section (*u*), shall be included among goods prohibited to be imported as if they were specified in section forty-two of the Customs Consolidation Act, 1876 (*v*).

Customs regulations.

“ (2.) Before detaining any such goods or taking any further proceedings with a view to the forfeiture thereof under the law relating to the Customs, the Commissioners of Customs may require the regulations under this section, whether as to information, security, conditions, or other matters, to be complied with, and may satisfy themselves in accordance with those regulations that the goods are such as are prohibited by this section to be imported.

“ (3.) The Commissioners of Customs may from time to time make, revoke and vary, regulations, either general or special, respecting the detention and

(*s*) The sub-sections are badly arranged. (4) should have been placed second.

(*t*) For the interpretation of “purports” in the Consolidated Instruc-

tions of 1900, see para. 5. Appendix, p. 819.

(*u*) *I.e.*, sub-sects. (2) and (3).

(*v*) 39 & 40 Vict. c. 36. See p. 623.

forfeiture of goods the importation of which is prohibited by this section, and the conditions, if any, to be fulfilled before such detention and forfeiture, and may by such regulations determine the information, notices, and security to be given, and the evidence requisite for any of the purposes of this section, and the mode of verification of such evidence.

- “ (4.) Where there is on any goods a name which is identical with or a colourable imitation of the name of a place in the United Kingdom, that name, unless accompanied by the name of the country in which such place is situate, shall be treated for the purposes of this section as if it were the name of a place in the United Kingdom. Names like names of places in the United Kingdom.
- “ (5.) Such regulations may apply to all goods the importation of which is prohibited by this section, or different regulations may be made respecting different classes of such goods or of offences in relation to such goods. Customs regulations.
- “ (6.) The Commissioners of Customs, in making and in administering the regulations, and generally in the administration of this section, whether in the exercise of any discretion or opinion, or otherwise, shall act under the control of the Commissioners of her Majesty’s Treasury.
- “ (7.) The regulations may provide for the informant reimbursing the Commissioners of Customs all expenses and damages incurred in respect of any detention made on his information, and of any proceedings consequent on such detention.
- “ (8.) All regulations under this section shall be published in the ‘London Gazette’ and in the ‘Board of Trade Journal.’
- “ (9.) This section shall have effect as if it were part of the Customs Consolidation Act, 1876 (*y*), and shall accordingly apply to the Isle of Man as if it were part of the United Kingdom. Customs Act, 1876.
- “ (10.) Section two of the Revenue Act, 1883 (*z*), shall be repealed as from a day (*a*) fixed by regulations

(*y*) 39 & 40 Vict. c. 36, s. 42, pp. 623, 627.

(*z*) 46 & 47 Vict. c. 55, s. 2.

amending the last-cited section.

(*a*) 1st of Jan., 1888. Customs Regulations of 1 Dec. 1887, Appendix, p. 834.

under this section, not being later than the first day of January, one thousand eight hundred and eighty-eight, without prejudice to anything done or suffered thereunder.”

This section is a most important part of the scheme of the Act, for it, so far as it is effective, stops at the outset a class of frauds which, according to the evidence given before the Committees of 1862 and 1887, were widely prevalent and continually increasing, to the grave detriment of English manufacturers. Its main provisions are in accordance with the legislation now adopted in most civilized countries, under the International Convention, drawn up at the conference on the subject of Industrial Property and Merchandise Marks, at Paris, in 1883, and amended at the subsequent Conference at Madrid, in 1889. The terms of the several Conventions are set out in the Appendix, pp. 764—773.

The Inter-
national
Conventions.

According to English law these terms, or the terms of any of the numerous treaties concluded between this country and other countries for the mutual protection of the trade-mark and allied rights of their respective subjects, have no application to or between subjects, and cannot be recognized as having any legal effect, except so far as they have been embodied in the municipal law of the several countries (*b*). An English Court is not competent to inquire into a matter involving the construction of treaties or other acts of state, or to treat them as in any way operative to create or modify rights or duties, and the Crown cannot sanction any invasion by its officers of the rights of private individuals as they exist according to the municipal law, on the ground that it is necessary in order to comply with or compel obedience to a treaty (*c*).

(*b*) See Art. IX. of the International Convention; Book I. Chap. XX. p. 545; and *The Californian Fig Syrup Co.'s Tm.*, 40 C. D. 620; 6 R. P. C. 126 (1888), Stirling, J., decided on sect. 103 of the Patents, &c. Act, 1883; and *Lauri v. Renad*, (1892) 3 Ch. 402. The Court may refer to a treaty, in accordance with which an

Act has been passed, to ascertain the circumstances to which the Act was intended to apply, as an aid to its construction. *Re Carter Medicine Co.'s Tm.*, (1892) 3 Ch. 472; 9 R. P. C. 401, North, J.

(*c*) *Walker v. Baird*, (1892) A. C. 491.

France was, apparently, the first country to take effective steps to stop the importation of goods made abroad, but bearing words or marks describing them as made in the country of importation (*d*); but sect. 42 of the Customs Act of 1876, amended by the now repealed section of the Revenue Act of 1883, was amply sufficient for the purpose, if it had been effectively enforced.

Sect. 42 of the Customs Act, 1876, contains a list of goods among which the goods enumerated in this section are to be considered as included, and it provides that—

Sect. 42 of the Customs Act, 1876.

“The goods enumerated and described in the following table of prohibitions and restrictions inwards are hereby prohibited to be imported or brought into the United Kingdom, save as thereby excepted (*e*); and if any goods so enumerated and described shall be imported or brought into the United Kingdom contrary to the prohibitions or restrictions contained therein, such goods shall be forfeited, and may be destroyed or otherwise disposed of as the Commissioners of Customs may direct” (*f*).

The policy of the Act is to prevent fraudulent marking, whether by means of forged trade-marks or false trade descriptions, and this section, as the remainder of the Act, only applies to goods which bear marks bringing them within its terms. There is no general obligation to stamp imported goods with any indication of origin (*g*). And if the deceptive marks which make such an indication necessary under the Act appear only upon the covering or package of goods, it is considered sufficient that the qualifying indication of origin should be stamped on the covering or package only also (*h*).

Only marked goods come within the prohibition.

All such goods.]—The goods which are liable to forfeiture

(*d*) See M. M. A. Report, 1887, Index, “France.”

the importation of watches, see p. 623.

(*e*) There are no general exceptions, but only exceptions relative to particular classes of goods, none of which are here material.

(*g*) M. M. A. Report, 1890; and see General Order, Consol. Instr. of 26 Feb. 1900, *post*, p. 818, par. 2.

(*f*) For the section dealing with

(*h*) See below, p. 632, note (*p*).

under this section (*i*), in addition to those specially enumerated in sub-sect. (1), are goods which, if sold, would be liable to forfeiture under the Act, that is, by the joint operation of sect. 2 (3) (iii) and sect. 2 (1), goods or things to which any forged trade-mark (*k*) or false trade description (*l*) is applied (*m*), or to which any trade-mark (*n*), or mark so nearly resembling a trade-mark as to be calculated to deceive (*o*), is falsely applied (*p*). It is submitted that the words "if sold" must here be construed to mean if sold with such guilty intent as is necessary to justify a conviction under the Act (*q*). This is in accordance with the principle of throwing upon the person charged the onus of proving that he acted without intent to defraud, or that he is protected by one of the special defences specified in the Act, or that he acted otherwise innocently (*r*). Otherwise there could be no forfeiture under this part of the section, except where an offence would have actually been committed had the goods been sold; and sale by an innocent person would not constitute an offence. The construction contended for accords with the remainder of the section, and with the older Acts, for it is plain that the forfeitures constituted by the latter part of sub-sect. (1) are independent of proof of guilty intention on the part of anyone, and the clauses of sect. 42 of the Customs Consolidation Act of 1876, and sect. 2 of the Revenue Act of 1883, which are replaced by this section, contained no reference to the knowledge, intention, or purposes of the importer, or of any other person in relation to the goods (*s*).

Goods bearing English words or names.

So far as can be judged from the summary of agricultural produce detained under the Act in the years 1888 and 1889, which is appended to the M. M. A. Report, 1890, a very

(*i*) See the summary in the Customs General Order of 26 Feb. 1900, paragraphs 3, 4 and 19, Appendix, p. 818.

(*k*) Page 560.

(*l*) Page 584.

(*m*) Page 567.

(*n*) Page 560.

(*o*) Page 565.

(*p*) Page 569.

(*q*) The same construction is arrived at by treating sect. 2 (2) as imported without the qualifications contained in it. Cf. *Re Anglessea Colliery Co.*, L. R. 1 Ch. 555, a decision on sects. 38 and 74 of the Companies Act, 1862.

(*r*) Sect. 2 (2) (c), p. 610.

(*s*) Cf. sect. 12, "Search warrant," and "Forfeiture without conviction," pp. 618, 619.

large proportion of the goods seized upon importation is seized because they bear words or lettering in the English language (*t*).

As regards words forming parts of the goods on which they appear, see *ante*, p. 572; and as regards goods partly made in two or more countries, p. 574.

The practice of the Customs House authorities in the matter was stated by Mr. Follett, in the paper already cited (*u*), to be based upon the conclusion that "the use of the English language and of English trade descriptions was misleading and *prima facie* inadmissible on foreign goods; but that this could not be held to apply to foreign goods coming from the United States or the Colonies."

Goods from the Colonies or the United States.

All goods of foreign manufacture, &c.]—The prohibition of this part of sub-sect. (1) is absolute (subject to the proviso contained in it) without regard to intention, or to any licence or right to use the name or trade-mark from the proprietor, and it applies where the name or trade-mark has been applied by the proprietor himself, or in accordance with his orders, for the section is intended to guard against the importation of goods which appear to be home-made, because they bear the name or trade-mark of a manufacturer, &c. in the United Kingdom, in cases where the name or trade-mark is used honestly, and in cases where it is used with, as well as where it is used without, the concurrence of the manufacturer (*r*). The last cases are already provided for, since the goods would be liable to forfeiture under the earlier parts of the Act.

Goods bearing British or Irish trade-marks or names.

Manufactured goods only come within this part of the subsection, although the Act generally applies to all goods whatsoever which are the subject of trade, manufacture, or merchandise (*y*). According to the view of the Act taken by the Customs authorities, goods which have undergone any

Only manufactured goods are included.

(*t*) See sect. 3 (1) (b), "place or country," p. 574.

(*x*) See Customs General Order, 26 Feb. 1900, r. 29, Appendix, p. 824.

(*u*) M. M. A. Report, 1890, Appendix, p. 275.

(*y*) Sect. 3 (1), "goods,"

process of manufacture, for instance, ground wheat, or hides tanned in the least degree, are manufactured goods (z).

Bearing any name, &c.]—It is unfortunate that the expression “having applied to them,” which is defined in the Act (a), was not here used instead of “bearing.” It is doubtful whether a name or mark which is not placed upon the goods or their covering, but is otherwise used in connection with them in any manner calculated to lead to the belief that the goods are designated or described by it, would be borne by the goods within the meaning of the sub-section (b).

Name (c).]—This includes any abbreviation of a name (d), and, therefore, initials which are the equivalent of a name in the market, as, for instance, D. L. R. & Co. for De La Rue & Co. (e).

Trade-mark.]—According to the definition of the Act, trade-mark means a registered trade-mark, or a trade-mark which is protected in any British possession or foreign state to which the provisions of sect. 103 of the Patents, &c. Act, 1883, are applied (f); but the draughtsman of this section of the Act must have intended to include other marks, for a mark purporting to be the trade-mark of a manufacturer, and not being such trade-mark, could hardly be a registered trade-mark. It is probably impossible to adopt this meaning in the construction of the Act, having regard to the express words of the interpretation clause. In other parts of the Act marks nearly resembling trade-marks are specially mentioned (g).

To enable the Customs officers to carry out the provisions of the section prohibiting the importation of goods marked with the names or trade-marks of manufacturers, dealers, or traders within the United Kingdom, registers of the names and trade-marks of such persons as choose to avail themselves

Customs
register of
names and
marks.

(z) M. M. A. Report, 1890, Evidence of Messrs. Seymour and Follett, Q. 286.

(a) Sect. 5, p. 567.

(b) This would be within sect. 5 (d), p. 567. And cf. the use of a trade-mark which constitutes an infringement, above, p. 369.

(c) See “names and initials,” p. 589.

(d) Sect. 3 (1).

(e) Mr. Follett, M. M. A. Report, 1890, p. 276.

(f) Sect. 3 (1).

(g) *E.g.*, sect. 4 (a) and sect. 5 (3).

of them are kept at the various ports of the United Kingdom in accordance with rules 26—28 of the Customs General Order of 26th February, 1900 (*h*).

Indication of the country, &c.]—The Committee of 1890 refused to recommend that the words “made abroad” be accepted as sufficient to pass the goods instead of the words “made in Germany,” &c., then required, where, without the statement as to origin, the goods marked would fall within the section (*i*). But a recommendation to this effect has been made by the Committee of 1897 (*k*); and now with regard to (a) goods, whether manufactured or raw, having applied to them any description, figures, words, &c. which by being or including, either expressly or by reference, the name of a place in, or a part of, the United Kingdom, or otherwise constitute a statement or indication that the goods were made or produced in the United Kingdom, the words “made abroad” will be generally sufficient (*l*). With regard to (b) goods of foreign manufacture bearing any name or mark which is, or purports (*m*) to be, the name or trade-mark of a manufacturer, dealer, or trader in the United Kingdom, the name of the country is a sufficient indication without the words “Made in,” if the name or trade-mark only appears. Where there is an address, as “John Smith, Sheffield,” then the qualification must be “Made in Germany,” or similar words. “Germany” alone would not counteract “Sheffield” (*n*). With regard to (c) goods, whether manufactured or raw, having applied to them a generally used trade description which, in indicating a particular class of goods or method of manufacture, includes expressly the name of a place in, or a part of, the United

“Made in Germany.”

(*h*) Appendix, p. 824. See the form of declaration on registration, p. 835.

(*i*) Cf. the case of goods bearing English words, pp. 572 and 577. Where a trade description suggesting an English origin has to be explained, and it does not fall within sect. 16 (1), the qualification “made abroad” is sufficient.

(*k*) M. M. A. Report, 1897, p. iv.

(*l*) Customs General Order of 26 Feb. 1900, rr. 4 (a), 7, 8, Appendix, pp. 819, 820.

(*m*) As to the meaning of “purports” in this connection, see the Customs General Order of 26 Feb. 1900, r. 5, Appendix, *post*, p. 819.

(*n*) Customs General Order of 26 Feb. 1900, rr. 4 (b), 8, Appendix, *post*, pp. 819, 820.

Kingdom, and is thereby calculated to mislead as to the place of manufacture or production of the goods, the full statement "Made" (*e.g.*) "in Germany" is required (*o*).

An indication which can readily be removed, for instance, words on a label attached by a string, is not accepted as sufficient to take the goods out of the section (*p*). It is, of course, a question of fact whether the explanation does accompany the objectionable name or trade-mark, and a merely pretended accompanying would be of no account.

The Customs officers are not expected to decide whether goods were actually made or produced in the country from which in the qualification they are stated to come: the name of *some* foreign country, or of some place in a foreign country, is sufficient (*q*). If the goods bear the name of a place identical with, or a colourable imitation of, the name of a place in the United Kingdom, the name should be accompanied by the name of the country in which the place is situated—*e.g.*, Boston, in Massachusetts, by the name "United States," or by the initials "U. S. A.," or even by the abridgement "Mass." (*r*).

In 1896 orders were given by the Customs to detain goods only where they bore marks raising a direct claim to British origin, or bearing a name or trade-mark of some one known firm having its principal place of business in the United Kingdom, without qualification. The Committee of 1897, however, expressed the opinion that while these orders have given great relief, it is unnecessary and uncalled-for to detain goods and insist upon a qualification because they are marked with English words of description, if intended for sale in this

(*o*) Customs General Order of 26 Feb. 1900, rr. 4 (c), 8, Appendix, *post*, pp. 819, 820.

(*p*) M. M. A. Report, 1890, Q. 1953. The Lords' Committee on the Marking of Foreign Meat (1893) have recently reported that: "Traders complain that importers are only compelled by the M. M. Act to apply the mark of foreign origin to the package, and that the

contents are systematically branded by English importers with English titles." Report, p. x.

(*q*) Customs General Order of 26 Feb. 1900, r. 9, Appendix, p. 820. Cf. r. 30, App., p. 825, as to quality-ing marks added as a condition of release.

(*r*) *Ibid.* r. 10, Appendix, p. 820. As to "initials" generally, see *ibid.* r. 12, Appendix, p. 820.

country, or with words in the language of that to which they are consigned, unless such words are calculated to deceive the purchaser in regard to the country of origin. The Committee added that the practice of the Customs should, in their opinion, be in the direction of requiring the excision of offending marks, rather than in that of adding a qualifying mark (s). In accordance with this recommendation (s) a rule has been laid down to the effect that trade descriptions in the English language applied to foreign goods are not to be regarded as a direct or indirect indication that the goods are of British or Irish origin, unless the Customs officers have good ground for considering that such trade descriptions are specially designed to convey, and do, in fact, convey, an impression of British or Irish origin for the goods (t). These regulations have considerably diminished the number of cases in which goods have had to be stopped (u).

Importation.]—In spite of a strong appeal from shipping agents and other traders, whose businesses were said to be adversely affected by the working of the Act, the Committee of 1890 refused to recommend the exclusion of goods in transit from the operation of the M. M. A. Goods in transit.

Such a recommendation was, however, made by the Committee of 1897 (x), and although to give full effect to it an alteration in the law would be required, the Commissioners of Customs, acting in the spirit of the recommendation, have adopted the principle that no examination, transshipment, or transit of goods is to be made specially for the purpose of scrutinising marks, and such goods are not detained under the M. M. A. unless they infringe its provisions in one or other of the following ways:—(a) By bearing marks which raise a clear and direct claim to British origin; (b) by bearing the name or trade-mark of a manufacturer, dealer, or

(s) M. M. A. Report, 1897, p. iv.

(t) See 42nd Rep. Comms. of Customs, 1898, p. 8; also Customs General Order of 26 Feb. 1900, r. 11, Appendix, *post*, p. 820.

(u) See 43rd Rep. Comms. of Customs, 1899, p. 10.

(x) The objections to the inclusion of goods in transit are forcibly summed up in the M. M. A. Report, 1897, pp. iii, iv. Under the Madrid Convention of 1891, the authorities are not bound to effect the seizure of goods in transit. Appendix, p. 772,

trader in the United Kingdom; (c) by bearing a trade-mark specially registered at the Customs (*y*).

Name of place
in the United
Kingdom.

Name of place in the United Kingdom.]—Sub-sect. (4), dealing with offences effected by false trade descriptions as to place or country (*z*), is more stringent than the proviso of sect. 18, since that only applies where the use of the name of a place or country is calculated to deceive.

The three classes of cases under this sub-section have been set out above (*a*) in dealing with *Indication of the country of origin*. They include, as will be observed, in effect cases—(a) where the name is intended to refer to the place in the United Kingdom of which it is the name, and to that alone; (b) where the name is that of a foreign place to which it is intended to refer, for instance, Boston; (c) where the name has originally been taken from the place in the United Kingdom, but is used to describe the goods or their process of manufacture, without any reference to the place being intended.

(a) Goods supplied according to an order from an English trader to a foreign manufacturer requiring the latter to put the address of the former on goods manufactured for him, would come under the first class, and so also would goods bearing such inscriptions as “A present from Brighton,” as well as goods expressly marked *English, Irish, London-made*, or with any similar express misstatements (*b*); (b) the second class, which relates to manufactured goods and not to entirely raw goods, is unimportant; (c) Kidderminster carpets, Windsor soap, Balbriggan hose, Shetland shawls (*c*), and Cheddar cheese, are examples of the third class. Where, however, such a description has become associated with a particular class of goods in a manner practically to preclude any probability of deception, as “Portland cement” and “Bath chaps,” the description need not be accompanied by a state-

(*y*) 42 Rep. Commrs. of Customs, 1898, p. 8; General Order of 26 Feb. 1900, r. 36, Appendix, *post*, p. 825.

(*z*) Sect. 3 (1) (b), “place or country,” p. 574; sect. 18, p. 594.

(*a*) See p. 631.

(*b*) Cf. Customs General Order of 26 Feb. 1900, rr. 4 (a), 37, Appendix, pp. 819, 826.

(*c*) These examples are given in the Customs General Order, r. 6, Appendix, p. 819.

ment of the country of actual production. This applies also to the case of colonial names describing, for instance, classes of wool, &c. where, although the names are British, the circumstances preclude mistake (*d*). The saving contained in sect. 18 with regard to conventional or generic descriptions (*e*) does not apply to sect. 16 (4), for the words of the latter are precise, that the name shall be treated as if it were the name of a place in the United Kingdom, and therefore not a description of the goods. In any case, however, the proviso of sect. 18 requires the name of the place or country where the goods were actually made or produced to be added, if the description includes the name of a place or country, and is calculated to mislead.

Customs regulations.]—The general orders (*f*) and other regulations (*f*) issued by the Customs authorities under the Acts are set out in the Appendix. The regulations provide, in accordance with the Act, that where goods are detected by the officers to be such as are prohibited to be imported, they are to be detained (*g*). They do not, however, contemplate that the officers will be competent of their own knowledge to detect the attempted infringement of the Act in all cases, or in all classes of cases (*h*); and accordingly they make provision for the officers to act upon information (*i*) given by private persons, for instance, by the owners of trade-marks or names which are likely to be wrongly used on imported goods, and in certain cases they require the informants to give security (*k*), or to make a deposit of money (*l*), as a condition of the detention of the goods. The register of names and trade-marks for the use of Custom officers has already been referred to (*m*).

An information relating to a forged trade-mark, alleged to

(*d*) Customs General Order, r. 6.

(*e*) Above, p. 594.

(*f*) Appendix, pp. 818 *et seq.*

(*g*) Pages 820, 832.

(*h*) General Order of 26 Feb. 1900, rr. 9, 12.

(*i*) Regulations 2 and 3. Form of notice to Customs officer, p. 834.

General Order of 26 Feb. 1900, rr. 46—49, Appendix, p. 828.

(*k*) Form of bond, p. 834. Regulations, 3, 4, 7, p. 833.

(*l*) General Order of 26 Feb. 1900, r. 47, p. 828.

(*m*) Page 630; General Order of 26 Feb. 1900, r. 26. Form of declaration, p. 835.

be one recognized in a British possession or foreign state, will not be good unless it relates to a possession or state to which sect. 103 of the Patents, &c. Act, 1883, has been applied by Orders in Council. A list of such possessions and states will be found at p. 762.

Special regulations as to particular goods.

Marks not intended to reach purchasers.

Address marks.

Sardines.

Goods not produced in United Kingdom.

“Coverings.”

Special regulations as to particular goods have been made in some cases, besides the general regulations just referred to. The earliest of these relate to watches (*n*). The other exemptions from detention under the Act are of packing cases (containing goods) having the name of a port or place of destination applied to them in which the goods are clearly not intended to be sold or exposed for sale (*o*); address marks, when they are merely and manifestly such, for purposes of carriage only (*p*); sardines from places other than France bearing the trade description *Sardines à l'huile* (*q*); samples or patterns, readily distinguished as such and valueless in themselves (so far as British origin is concerned) (*r*); goods not produced in the United Kingdom, such as wine, tea, and other produce not grown in this country, such as linseed, rapeseed, &c. (so far as British origin is concerned); this exemption is applied further to some special forms of manufacture which by shape, make or colour cannot be mistaken for the manufacture here of the same article, *e.g.*, Dutch cheese, of the kind well known to be made in Holland, bearing the initials of British dealers (*s*); “coverings,” such as boxes, capsules, bottles, &c., if the marks, such as Royal arms, refer not to the coverings themselves, but to the goods to be covered, and it is shown to the satisfaction of the officer that they will be British goods, or goods as to which British marks are not objectionable (*t*). The rule last stated applies to coverings (such as ornamental boxes for tobacco, tea, or confectionery) with names on them of firms who have

(*n*) General Order of 18 Jan. 1888, p. 836; and see General Order of 26 Feb. 1900, r. 45, p. 828.

(*o*) General Order of 26 Feb. 1900, r. 13, p. 821.

(*p*) *Ibid.* r. 13, p. 821.

(*q*) General Order of 18 Dec. 1888, p. 839.

(*r*) General Order of 26 Feb. 1900, r. 17, p. 822.

(*s*) *Ibid.* r. 18.

(*t*) *Ibid.* r. 14, p. 821. If, as rarely happens, the marks refer distinctly to the coverings, the case should be reserved for the Board. *Ibid.*

ordered the coverings for their own goods, or where such firms, though not having actually ordered the coverings themselves, consent in writing to their importation for such goods (u).

The name and address of a merchant in this country upon grain sacks are regarded as an indication that the grain is of British origin, and require the addition of a statement of the country of production. In the case of grain imported in bulk and transferred *after due entry and clearance* into sacks on board the importing ship, such marking of the sacks does not need to be qualified with a statement of the foreign origin of the grain (x). And by the General Order of the 26th of February, 1900 (y), discretionary powers have been conferred on officers, without a special order, to admit goods within the letter of the Act which are either articles, not dutiable, sent to an individual as presents or for personal use; articles, not new and manifestly private property, and old, used, or damaged articles sent into the United Kingdom for repairs; returned samples of no value, made by competing firms in the United Kingdom; certain foreign samples imported for purposes of manufacture or comparison, or British returned goods, not dutiable, or in respect of which no drawback could have been received.

Grain sacks.

Goods for private use.

Goods for repair.

Samples.

Returns.

The authorities when they have seized goods as contravening the Act, either forfeit and destroy or sell them, or release them upon receiving satisfactory explanations, or upon the removal or qualification of the objectionable marks, and, in some instances, upon the payment of fines (z). The officers are directed to take care that, in all cases where the Board allow qualifying words to be added before the delivery of goods, such words are applied in characters clear, conspicuous and as indelible as the marks requiring qualification, and in close proximity to those marks (a).

Practice of the Customs authorities.

Any proceedings taken against the Customs authorities or their officers, in respect of anything done or omitted in execution or intended execution of their duties under the

Proceedings against the Customs authorities

(u) General Order of 26 Feb. 1900, r. 15, p. 821. in transit down to March, 1890, M. M. A. Report, 1890, Appendix, p. 326.

(x) *Ibid.* r. 16, p. 821.

(y) Rr. 31—35, p. 823.

(z) See the return of goods detained (u) General Order of 26 Feb. 1900, r. 41, p. 827.

Act, fall within the Public Authorities Protection Act, 1893 (*b*), so that the proceedings must be commenced within six months; judgment for the defendant carries costs as between solicitor and client; the defendant may plead a tender of amends, and if the plaintiff does not recover more than the amount tendered, the defendant is entitled to costs (but this provision is not to affect costs on any injunction in the action); and if, in the opinion of the Court, the plaintiff has not given the defendant a sufficient opportunity of tendering amends before the commencement of the proceedings, the Court may award to the defendant costs as between solicitor and client (*c*).

It has been held that an officer is not liable in trespass for detaining goods while in doubt whether they ought to be detained or not, and until the Commissioners of Customs had given directions concerning them, although he might, it was said, have been liable in damages for so detaining them for an unreasonable time (*d*). In an earlier case, it was held that for a wrongful refusal, except upon payment of an excessive amount of duty, to sign a bill of entry in order to enable goods to pass, an officer might be sued (*e*). The orders of his superior officer do not afford any defence for an officer who has acted illegally to the prejudice of any British subject (*f*).

(*b*) 56 & 57 Vict. c. 61, which has repealed 39 & 40 Vict. c. 36, ss. 267 to 272, and 40 & 41 Vict. c. 13, s. 4.

(*c*) This replaces the old requirement of one month's notice of action. Where at the trial by a judge with a jury of an action against a public authority the latter succeeds, but the judge is satisfied that such good cause appears as to warrant him, under R. S. C. O. 65, r. 1, in depriving the defendant authority of costs, he may do so notwithstanding sect. 1 of the Public Authorities Protection Act, 1893: *Bostock v. Ramsey Urban Council*, (1900) 1 Q. B. 357; (1900) 2 Q. B. 616, Lord

Russell of Killowen, C. J. and C. A.; overruling the decision of Bruce, J., in *Cree v. St. Pancras Vestry*, (1899) 1 Q. B. 693; 68 L. J. Q. B. 389. The provision does not apply to appeals, *Fielden v. Morley Corporation*, (1900) A. C. 133.

(*d*) *Jacobsohn v. Blake*, 6 M. & G. 919; 7 Scott, N. R. 772 (1844).

(*e*) *Barry v. Arnaud*, 10 Ad. & Ell. 670 (1839).

(*f*) See *Walker v. Baird*, (1892) A. C. 491; *Sands v. Child*, 3 Lev. 352 (1693), and *Entick v. Carrington*, 19 State Trials, 1043 (1765). And see further *Raleigh v. Goschen*, (1898) 1 Ch. 73; 69 L. J. Ch. 59, Romer, J.

CHAPTER II.

MISCELLANEOUS MATTERS.

False representation as to grant of patent or registration of design or trade-mark.]—By sect. 105 of the Patents, &c. Act, 1883—

“ (1.) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade-mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction (*a*) to a fine not exceeding five pounds. Penalty on falsely representing articles to be patented.

“ (2.) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade-mark is registered, if he sells the article with the word ‘patent,’ ‘patented,’ ‘registered,’ or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.”

The offences here dealt with are applications of false trade descriptions (*b*), but the liability to punishment under the M. M. A. would afford no answer to a prosecution under the above section (*c*).

And an infringement of the section is no bar to an application for the registration of the trade-mark which has been wrongly described as registered (*d*).

Sub-sect. (2), if taken literally, makes the use of “patent” unlawful in cases where, apart from its provision, the use of the word would not have been held to amount to a false or

(*a*) As to the Isle of Man, see Act of 1883, sect. 112; and as to Ireland, *ibid.* sect. 117.

(*b*) See M. M. A. 1887, s. 3 (*a*), above, pp. 570, 579.

(*c*) M. M. A. s. 19 (1), above, p. 618.

(*d*) *James' Tm.*, 33 C. D. 392; 3 R. P. C. 340 (1886), C. A.: see above, p. 407.

misleading claim of a patent right, as, for example, where no patent has ever existed but the word has become part of the trade-name of the goods and has been used by the manufacturer in his description of them (*e*). It also prohibits the use of such ordinary names of commerce as "patent leather" and "patent medicine" (*f*). It is submitted that some limitation must be placed upon the literal meaning of the enactment which will exclude these cases from the section (*g*). The use of the word "Registered" has been held to indicate registration in the United Kingdom (*h*).

Falsification of the Register of Patents, Designs, and Trade-marks.]—By sect. 93 of the above-mentioned Act of 1883—

Falsification of entries in Registers.

"If any person makes or causes to be made a false entry in any Register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor."

False declaration as to country or place where a watch case was made.]—By sect. 8 (3) of the M. M. A. 1887—

False declaration as to watch case.

"Every person (*i*) who makes a false declaration for the purposes of this section shall be liable, on conviction on indictment, to the penalties of perjury, and on summary conviction, to a fine not exceeding 20*l.* for each offence."

(*e*) *Edelsten v. Vick*, 11 Hare, 78 (1858), Wood, V.-C. (*Taylor & Co.'s Patent Solid-headed Pins*); see further, Book I. Chap. XV. p. 401; *Gridley v. Swinborne*, 52 J. P. 739, 791; 5 T. L. R. 71 (1888), Div. Court, *Swinborne's Patent Refined Isinglass*, held not to be a false trade description, see the last chapter, p. 580.

(*f*) See above, p. 403.

(*g*) Application for a patent, or provisional protection, does not authorize the use of the word patent; but, it is submitted, the acceptance of the complete specification of a patent does. See above, p. 580.

(*h*) *Wright, Crossley & Co. v. William Dobbin & Co.*, 15 R. P. C. 21 (1898) in Ireland. *MacSymons' Stores, Ltd. v. Shuttleworth*, 15 R. P. C. 748 (1898) in England. See above, p. 581. The use of the words "Trade Mark," in relation to an unregistered trade-mark, is not necessarily an offence under the section: *Sen Sen Co. v. Britten*, (1899) 1 Ch. 692; 16 R. P. C. 137.

(*i*) "Person" includes corporation and partnership, above, p. 558; as to limitation of time for proceedings, see above, p. 615; for sect. 8, see p. 622.

False representation as to Royal warrant.]—By sect. 20 of the M. M. A. of 1887—

“Any person (*j*) who falsely represents that any goods are made by a person holding a Royal warrant, or for the service of Her Majesty, or any of the Royal Family, or any government department, shall be liable, on summary conviction (*k*), to a penalty not exceeding 20*l*. False representation as to Royal warrant.

Unauthorized assumption of Royal arms.]—By sect. 106 of the Patents, &c., Act of 1883—

“Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any government department, assumes or uses in connection with any trade, business, calling, or profession, the Royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction (*l*) to a fine not exceeding 20*l*.” Penalty on unauthorised assumption of Royal arms.

In a recent prosecution under this section the defendant unsuccessfully contended that he was entitled to use the Royal arms as he held a patent for an invention which he was using in his business, and the Patent Office was a Government department (*m*).

Cutlery marks.]—By the Act 59 Geo. 3, c. 7, it is forbidden to mark cutlery and the other goods mentioned in the Act with the figure of a hammer, unless the goods have been wrought or forged, or to place false marks of quality upon such goods, or to falsely mark them as London made; and the offences created by the Act extend to selling, or having in possession for the purposes of sale, such goods marked in breach of the Act. The material provisions of the Act (*n*) may be summarised as follows:— The Cutlers' Marks Act, 1819.

1. Where any knives, knife-blades, forks, razors, razor- Hammer marks.

(*j*) See note (*i*), above.

(*k*) In Scotland, in the Sheriff Court (sect. 21); and in the Dublin police district, the Courts of the justices under the Petty Sessions Act, 1851 (sect. 22).

(*l*) As to the Isle of Man, see Act of 1883, sect. 112; and as to Ireland, *ibid.* sect. 117.

(*m*) *Webber & Co.'s Case*, Times, Feb. 2, 1897.

blades, scissors, shears, and other articles of cutlery, edge tools and hardware requiring a cutting edge, of wrought steel, or of iron and steel, are made by means of the hammer, the maker may mark the figure of a hammer upon them before they are ground.

3. No one may mark such figure on any of the goods enumerated not so made, before the *bonâ fide* sale of the goods to the user, or have in his possession for the purpose of sale, or sell any such goods not so made, and being marked with such figure, under penalty of forfeiture of the goods and a fine of 5*l.* for every dozen.

Quality
marks.

4. No one may mark on any of the goods enumerated, whether made with the hammer or cast in a mould, before the *bonâ fide* sale of the same to the user, "any word or words which shall or may denote or indicate the quality of such articles to be otherwise than the real and true quality thereof," or have in his possession for the purpose of sale, or sell any such goods so marked, under penalties as aforesaid.

London
made.

5. No one may mark on any of the goods enumerated whether made with the hammer or cast in a mould, before the *bonâ fide* sale of the same to the user, the word or words *London* or *London made*, or any word or words having any similitude thereto, unless the goods were made in the City of London, or within twenty miles distance therefrom, or have in his possession, &c., or sell (as before) under a penalty of forfeiture and fine of 10*l.* a dozen articles.

Innocent
purchasers.

7. Any one having in his possession for the purposes of sale, or selling any of the goods aforesaid contrary to the Act, who shall, before information or complaint laid against him, prove satisfactorily by oath before one or more justice or justices that he purchased the goods with the marks thereon without knowing they were marked contrary to the Act, and shall discover to two or more justices the name of the person from whom he bought, so that the latter shall be prosecuted to conviction, shall not be liable to penalties himself (o), but shall be entitled to two-thirds of the penalty recovered from his vendor, as any other informer.

Counterfeit-
ing Sheffield
corporate
marks.

The Cutlers' Co. Act of 1814 contains a provision inflicting penalties upon any person who counterfeits or imitates assigned corporate marks; and by sect. 81 (13) of the Patents, &c. Act of 1883, this provision has been extended to any mark entered

(n) Sect. 17 has been repealed by the Stat. Law Rev. Act, 1873, and sect. 2 by the Stat. Law Rev. Act, 1874, sects. 8—10 in part, and

sects. 11—13 and 15 wholly, repealed by 47 & 48 Vict. c. 43, s. 4.

(o) Cf. M. M. A. sect. 2, "unless he proves," above, pp. 601, 607.

in the Sheffield Register (*p*). The section of the first-mentioned Act is as follows (*q*) :—

“If any member or members of the Cutlers’ Company, or any other person or persons using, exercising, or carrying on any of such arts or trades as aforesaid within the said lordship or liberty, or six miles compass of the same, shall at any time after the passing of this Act strike, engrave, impress or use, or cause or procure to be stricken, engraved, impressed or used upon his or their goods, wares, or manufactures, any mark, device, stamp, or impression, with intent to counterfeit or imitate any mark or device assigned, or which may hereafter be assigned, by the said master, wardens, or searchers and assistants of the said company, to be used by any other person, the person or persons so offending shall, for every such offence, forfeit and pay (in lieu of the penalty imposed by the said last recited Act (*r*)) any sum not exceeding 20*l.*, one moiety whereof shall be paid to the person whose mark shall have been so counterfeited or imitated, and the other moiety to the said master and wardens of the said company; and the provisions in the said last recited Act (*r*) contained for the recovery and application of the penalty thereby imposed shall be used, applied, and put in force for the recovery and application of the penalty hereby made payable, as fully and effectually as if the same provisions were in this Act severally and separately repeated and re-enacted.”

The sections of the Cutlers’ Co. Act of 1791 (*s*), which are referred to and incorporated by the last-mentioned section, provide (sect. 26) that the penalties may be sued for by the company, or (sect. 27) recovered summarily before a justice or justices of the West Riding of York, or of the county of Derby, who shall have power to award costs, and to issue a distress warrant, or, if the goods of the offender are insufficient, to commit him to the House of Correction for one month to enforce payment of the penalty. Sect. 28 contains a form of conviction, and sect. 29 gives an appeal to quarter sessions.

A number of statutes of little general importance, requiring special marks to be placed upon particular classes of goods, are summarized in the Appendix, p. 846. Statutes relating to particular goods.

(*p*) Above, p. 111.

(*q*) 54 Geo. 3, c. 119, s. 5 (local).

(*r*) The Cutlers’ Co. Act of 1791, see above, p. 102.

(*s*) 31 Geo. 3, c. 58 (local).

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APPENDIX.

No. 1.

THE PATENTS, DESIGNS, AND TRADE-MARKS ACT, 1883,

AS AMENDED BY THE ACT OF 1888 (a).

ARRANGEMENT OF SECTIONS.

SECTION

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2. Division of Act into parts.
3. Commencement of [the Acts].

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Registration of Trade-Marks.

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63. Limit of time for proceeding with application.
64. Conditions of registration of trade-mark.
65. Connexion of trade-mark with goods.
66. Registration of a series of marks.
67. Trade-marks may be registered in any colour.
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Effect of Registration.

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Register of Trade-Marks.

78. Register of trade-marks.
79. Removal of trade-mark after fourteen years unless fee paid.

Fees.

80. Fees for registration, &c.

Sheffield Marks.

81. Registration by Cutlers' Company of Sheffield marks.

(a) These Acts have been printed from Mr. Lewis Edmunds' "Patents, &c. Acts, Consolidated," by his permission.

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46 & 47 VICT. c. 57.

An Act to amend and consolidate the Law relating to Patents for Inventions, Registration of Designs, and of Trade-Marks. [25th August, 1883.]

51 & 52 VICT. c. 50.

An Act to amend the Patents, Designs, and Trade-Marks Act, 1883. [24th December, 1888.]

* * The general text of the Act of 1883 is adhered to. The repealed parts are printed in italics, and the additions in square brackets. The amending Act and section are quoted in the margin.

BE it enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :

PART I.—PRELIMINARY.

1. This Act may be cited as the Patents, Designs, and Trade-Marks Act, 1883. Short title.

By Act 1888, s. 29, the principal Act of 1883, and the Amending Acts of 1885, 1886, and 1888, may be cited collectively as the Patents, Designs, and Trade-Marks Acts, 1883 to 1888.

The Acts of 1885 and 1886 do not relate to trade-marks.

2. This Act is divided into parts, as follows :—

Division of Act into parts.

- Part I.—PRELIMINARY.
- II.—PATENTS.
- III.—DESIGNS.
- IV.—TRADE-MARKS.
- V.—GENERAL.

3. This Act, except where it is otherwise expressed, shall commence from and immediately after the thirty-first day of December one thousand eight hundred and eighty-three. Commencement of Act.

[The Act of 1888 shall, except so far as is thereby otherwise specially provided, commence and come into operation on the first day of January one thousand eight hundred and eighty-nine.] Act, 1888, s. 28.

What Act applied to pending registrations, p. 121.

PART IV.—TRADE-MARKS.

Registration of Trade-Marks.

Application
for registra-
tion.

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

The Comptroller, p. 57, and sect. 82.

Discretion to refuse registration, although the mark tendered is within sect. 64, p. 69.

Intention to use mark necessary, p. 119.

Registration of trade-marks, Chap. IV., p. 63.

Person includes firm or partnership (Rule 7, p. 692), and body corporate, sect. 117. See also Instructions 11, p. 726.

Proprietor, see as to who may apply to register, p. 65.

Procedure on application to register, p. 75.

Application by agent, p. 68. The agent must be authorised to the satisfaction of the Comptroller. Rule 9, p. 692, and Instructions 12, p. 726.

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

Act, 1888,
s. 8.

Form of application, p. 75, Form F., p. 706.

Address of the Patent Office, p. 56; Instructions 8, p. 725; Rule 8, p. 692.

Applications in classes 23, 24, or 25 go to the Manchester Branch Office, Chap. VII., p. 113; Instructions 8, p. 725; Rule 8, p. 692.

As to Sheffield marks, see Chap. VI., p. 101, sect. 81, Rules 56—59, p. 701.

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

Representations, Instructions 9, 15 and 16, pp. 725, 726; Rules 14 and 15, p. 694.

Classes of goods, Chap. V., p. 96; list of classes, p. 715.

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

Discretion to refuse, p. 69.

Applicant is entitled to be heard before the refusal, p. 74, sect. 94, Rules 17 and 18, p. 695.

Appeal to Board of Trade, p. 86; Forms, pp. 707, 737; Rules 20 to 26, p. 695.

Registration subject to conditions, p. 92. See also sect. 69 (3).

(5.) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court; and in that event the Court

shall have jurisdiction to hear and determine the appeal and may make such order as aforesaid.

Reference of the appeal to the Court, p. 88.

No direct appeal to the Court, p. 88.

The Court, p. 88, sect. 117 (1).

Summons or notice of motion, p. 89 ; Forms, pp. 735 *et seq.*

Costs, p. 93.

An order of the Court allowing an appeal must be served on the Comptroller, Rule 46, p. 700.

[(6.) Where an applicant for the registration of a trade-mark otherwise than under an international convention is out of the United Kingdom at the time of making the application he shall give the Comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given.] Act, 1888, s. 8.

Page 76, cf. opponent's address, sect. 69 (6).

International Convention, Chap. XX., p. 545, sect. 103. The Convention is printed at p. 764.

As to applications to rectify where the registered proprietor is resident abroad, see p. 288.

63. Where registration of a trade-mark has not been or shall not be completed within twelve months from the date of the application, by reason of default on the part of the applicant, *the application shall be deemed to be abandoned* [the Comptroller shall give notice of the non-completion to the agent employed on behalf of the applicant, and, if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant, and if at the expiration of the latter fourteen days, or such further time as the Comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned]. Limit of time for proceeding with application. Act, 1888, s. 9.

Abandonment of application, pp. 76, 283.

It is no bar to a subsequent application by the same person and in respect of the same mark, p. 77.

64. (1.) *For the purposes of this Act, a trade-mark must consist of or contain at least one of the following essential particulars:—* Conditions of registration of trade-mark. Repealed. Act, 1888, s. 10.
(a) *A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or*
(b) *A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade-mark; or*
(c) *A distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use.*

Fancy word, p. 158.

Not in common use, p. 168.

Name of person, p. 168.

(2.) *There may be added to any one or more of these particulars*

any letters, words, or figures, or combination of letters, words, or figures, or of any of them.

(3.) Provided that any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures used as a trade-mark before the thirteenth day of August one thousand eight hundred and seventy-five may be registered as a trade-mark under this part of this Act.

Conditions of
registration of
trade-mark.

Act, 1888,
s. 10.

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

As to what marks may be registered as trade-marks, see Chap. VIII., p. 115.

As to what Act applies to pending registrations, p. 121, Act of 1883, sect. 113; Act of 1888, sect. 27, p. 683.

For comparison with repealed sections, see p. 118.

Essential particulars, pp. 122, 201.

Additions, p. 124, sect. 64 (2). Additions common to the trade, p. 204, sect. 74.

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

Name marks, p. 124; trade-name, p. 462.

Name of imaginary person not included, p. 125.

Mere name in nominative case, p. 127.

Particular and distinctive manner, p. 128.

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

Signature, p. 120.

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

Distinctive, pp. 132—140; loss of distinctiveness, p. 339.

Descriptive marks, pp. 36, 140, 163, 178.

The mark must be distinctive, apart from colour, pp. 150, 194.

Distinctiveness is an essential element of a trade-mark, apart from the Acts, Chap. II., p. 34.

Device, p. 141; copyright design, p. 86. n.; words not a device, p. 141.

Mark, p. 147.

Brand, p. 147.

Heading, p. 149; line headings, p. 150.

Label, p. 150; disclaimer of words in, pp. 153, 207.

Ticket, p. 156.

(d) An invented word or invented words; or

(d) not qualified by (e), p. 172.

Word marks, p. 156.

Invented word, p. 171; standard of invention, pp. 173—176.

Whether applicant need be first user, p. 177.

Decisions, pp. 177, 178.

(e) A word or words having no reference to the character

or quality of the goods, and not being a geographical name.]

Page 178. Descriptive words, pp. 36 *et seq.*, 163 *et seq.*

Secondary distinctive meaning of word *prima facie* descriptive, pp. 36, 140, 165.

Decisions, pp. 181, 182.

Geographical names, pp. 157, 166, 182.

Decisions, p. 184.

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

Additions and disclaimers, Chap. IX., p. 197.

Effect of disclaimer, p. 209.

Addition of matter common to the trade, sect. 74, p. 204.

Disclaimer of person's own name, see next sub-section.

"Figures" means "numerals," *Ex parte Stephens*, 3 C. D. 659 (1876), Jessel, M.R.

Essential particulars, pp. 122, 201.

Disclaimer of devices, p. 199.

Additions to labels, pp. 201, 207.

[(3.) Provided as follows :

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

Page 202.

Part of name, p. 203.

Possessive case, p. 204.

As to a trader's right of monopoly in his trade-name, see p. 202, Chap. XVI., pp. 452, 462 ; and as to whether it is the right of anyone to trade honestly under his own name, pp. 500 *et seq.*

(ii) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures, used as a trade-mark before the thirteenth day of August one thousand eight hundred and seventy-five, may be registered as a trade-mark under this part of this Act.]

Registration of old marks, p. 184. Not all old marks come within the clause, p. 185.

"Figure" means "numeral," *Ex parte Stephens*, 3 C. D. 659 (1876), Jessel, M.R.

13th August, 1875, date of commencement of first Registration Act.

Special and distinctive, p. 185 ; cf. distinctive in sub-sect. (1) (c), pp. 132-140.

Used as a trade-mark, p. 189, and Chap. II., p. 23. The mark must have been used as it is to be registered, p. 191.

Alteration of registered old mark under sect. 92, p. 298.

Common addition to old mark, sect. 74, p. 204.

Connection of trade-mark with goods.

65. A trade-mark must be registered for particular goods or classes of goods.

Classification of goods, Chap. V., p. 96 ; list of classes, p. 715.

A trade-mark is assignable only in connection with the goodwill of the business concerned in the goods for which it is registered, sect. 70.

Registration for part of a class, pp. 97, 219.

Registration of a series of marks.

66. When a person claiming to be the proprietor of several trade-marks which, while resembling each other in the material particulars thereof, yet differ in respect of (a) the statement of the goods for which they are respectively used or proposed to be used, or (b) statements of numbers, or (c) statements of price, or (d) statements of quality, or (e) statements of names of places, seeks to register such trade-marks, they may be registered as a series in one registration. A series of trade-marks shall be assignable and transmissible only as a whole, but for all other purposes each of the trade-marks composing a series shall be deemed and treated as registered separately.

Series of marks, p. 100 ; Representations, Rules 14 and 30, pp. 694, 696 ; Instructions 17, p. 726.

Trade-marks may be registered in any colour.

Act, 1888, s. 11.

67. A trade-mark may be registered in any colour [or colours], and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour [or colours].

Colour, p. 194. The mark must be distinctive, apart from colour, p. 142.

Advertisement of application.

Act, 1888, s. 12.

68. Every application for registration of a trade-mark under this part of this Act shall as soon as may be after its receipt be advertised by the Comptroller [unless the Comptroller refuse to entertain the application].

Advertisement, p. 77 ; Rules 27 to 30, p. 696 ; Instructions 20 to 27, p. 727.

Notice of refusal is to be given to the applicant, Rule 19, p. 695 ; see further, as to refusal, sect. 62 (4).

Opposition to registration.

Act, 1888, s. 13, sub-ss. 1, 2.

69. (1.) Any person may within *two months* [one month or such further time, not exceeding three months, as the Comptroller may allow] of the *first* advertisement of the application, give notice in duplicate at the Patent Office of opposition to registration of the trade-mark, and the Comptroller shall send one copy of such notice to the applicant.

Opposition, pp. 79—86 ; Rule 31, p. 697 ; Instructions 32, p. 728 ; Summary of procedure, p. 82 ; Forms, pp. 708 *et seq.*

Opposition is limited to the grounds stated in the notice, p. 84 ; amendment, p. 84.

Act, 1888, s. 13, sub-s. 3.

(2.) Within *two months* [one month] after receipt of such notice or such further time as the Comptroller may allow, the applicant may send to the Comptroller a counter statement in

duplicate of the grounds on which he relies for his application, and if he does not do so, shall be deemed to have abandoned his application.

Counter-statement, Form, p. 736.

Abandonment: cf. abandonment of application, sect. 63. Apparently the abandonment of the opposition would not estop the opponent from applying to remove the mark from the Register under sect. 90, see *Arbenz' application*, 35 C. D., at p. 257; 4 R. P. C. p. 145, (1887) C. A.

Enlargement of time, p. 84.

(3.) *If the applicant sends such counter statement, the Comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall require him to give security in such manner and to such amount as the Comptroller may require for such costs as may be awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement was made or such further time as the Comptroller may allow, the opposition shall be deemed to be withdrawn.*

Repealed.

Act, 1888,

s. 13, sub-s. 4.

The requirement of security from an opponent was abandoned at the suggestion of Lord Herschell's Committee, Report of 1888, xiii.

(4.) *If the person who gave notice of opposition duly gives such security as aforesaid, the Comptroller shall inform the applicant thereof in writing, and thereupon the case shall be deemed to stand for the determination of the Court.*

[(3.) If the applicant sends such counter-statement the Comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall, after hearing the applicant and the opponent, if so required, decide whether the trade-mark is to be registered, but his decision shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the opponent and the Comptroller, and may make an order determining whether, and subject to what conditions (if any), registration is to be permitted.]

Act, 1888,

s. 13, sub-s. 4.

Appeal to Board of Trade and to the Court, pp. 86—93; cf. sect. 62 (4) and (5).

Costs, p. 93.

Forms, pp. 635 *et seq.*

Modification of application on appeal, p. 91.

Registration subject to conditions, p. 92, and see limitation of the registration and variation in its form, p. 282; and registration with a note, pp. 58, 99 (class of goods), p. 195 (colour), and p. 219 (use).

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

See last note.

An order of the Court, disallowing an opposition, must be served on the Comptroller, Rule 46, p. 700.

[(5.) If the applicant abandons his application after notice of opposition in pursuance of this section, he shall be liable to pay

to the opponent such costs in respect of the opposition as the Comptroller may determine to be reasonable.]

If a counter-statement is put in, it would seem that costs cannot be given against an applicant.

The power to give costs in respect of an abandoned application was conferred, at the suggestion of Lord Herschell's Committee, with a view to spare owners of registered trade-marks the expense of contesting unwarrantable applications to register marks which would prejudice their rights.

There is no power to give costs, in respect of proceedings before the Comptroller, against an opponent: *Australian Wine Importers' Tm.*, 41 C. D. 278; 6 R. P. C. 311 (1889), C. A.; *Brandreth's Tm.*, 9 C. D. 618 (1878), Jessel, M. R.

[(6.) Where the opponent is out of the United Kingdom, he shall give the Comptroller an address for service in the United Kingdom.]

Page 90.

Assignment
and trans-
mission of
trade-mark.

70. A trade-mark, when registered, shall be assigned and transmitted only in connexion with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that goodwill.

Classes of goods, sect. 65. Registration is restricted to the goods for which the mark is registered, p. 307; and trade-mark rights are limited by the actual signification of the trade-marks, that is, to the goods of the original proprietor, or his successor in business, upon which it has been used, pp. 30, 307, 361.

Assignment and devolution, Chap. XIII., p. 324.

Assignment where a mark has been registered in the wrong name, pp. 68, 283.

Registration of assignments and transmissions, sects. 78 and 87, Rules 36 to 40, p. 698. Form of request for the registration of a subsequent proprietor, Form K., p. 708. Such registration before action is not essential in order to enable the subsequent proprietor to sue for infringement: *Ihlee v. Henshaw*, 31 C. D. 323; 3 R. P. C. 15 (1886), North, J.; but registration before the time of hearing has been held to be necessary: *Magnolia Metal Co. v. Atlas Metal Co.*, 14 R. P. C. 389, (1897) Collins, J., and see p. 317.

Determination of trade-mark rights, Chap. XIV., p. 338.

Conflicting
claims to
registration.

71. Where each of several persons claims to be registered as proprietor of the same trade-mark, the Comptroller may refuse to register any of them until their rights have been determined according to law, and the Comptroller may himself submit or require the claimants to submit their rights to the Court.

Page 212, Rules 44 and 45, p. 699. The Comptroller may require a written or oral explanation from any of the claimants in regard to his claim, Rule 43, p. 603. Old marks, up to three, which have existed independently as trade-marks, are allowed to be registered; if there are more than three, they are treated as common marks: see the "three marks rule," pp. 207, 214, and sect. 74 (3).

An old mark may be registered although a similar mark has been on the Register for five years: *Jackson v. Napper*, p. 385.

Restrictions
on registra-
tion.

72. (1.) Except where the Court has decided that two or more persons are entitled to be registered as proprietors of the same trade-mark, the Comptroller shall not register in

respect of the same goods or description of goods a trade-mark identical with one already on the Register with respect to such goods or description of goods.

Duplicate marks, Chap. X., p. 212.

"Except, &c.," refers to sect. 71.

Same goods or description of goods, p. 217.

An order of the Court, allowing registration under this section, must be served on the Comptroller, Rule 46, p. 700.

(2.) [Except as aforesaid] the Comptroller shall not register with respect to the same goods or description of goods a trade-mark so nearly resembling [having such resemblance to] a trade-mark already on the Register with respect to such goods or description of goods as to be calculated to deceive. Act, 1888, s. 14.

See last note.

Mark resembling a registered mark, Chap. XII., pp. 220 to 252.

Comptroller's discretion, p. 69.

73. It shall not be lawful to register as part of or in combination with a trade-mark any words the *exclusive* use of which would by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a court of justice, or any scandalous design. Further restriction on registration. Act, 1888, s. 15.

Deceptive marks, Chap. XIII., pp. 253 to 261.

"Exclusive" was omitted as misleading, at the suggestion of Lord Herschell's Committee, Report of 1888, p. xiii.

Cf. sect. 86, which forbids the registration of a trade-mark, the use of which would, in the Comptroller's opinion, be contrary to law or morality.

74. (1.) Nothing in this Act shall be construed to prevent the Comptroller entering on the Register, in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade-mark— Saving for power to provide for entry on Register of common marks as additions to trade-marks.

(a) In the case of an application for registration of a trade-mark used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive device, mark, brand, heading, label, ticket, letter, word, or figure, or combination of letters, words, or figures, though the same is common to the trade in the goods with respect to which the application is made;

(b) In the case of an application for registration of a trade-mark not used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive word or combination of words, though the same is common to the trade in the goods with respect to which the application is made;

Additions and disclaimers, Chap. IX., p. 197; cf. sect. 64 (2).

What is registered as part of the mark is not an addition, *Clement et Cie.'s Tm.*, (1900) 1 Ch. 114; 16 R. P. C. 173 and 611; see also p. 208.

"Distinctive" means *prima facie* distinctive: *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889); for its meaning in sect. 64, see pp. 131—140.

“Common to the trade” means open to the trade, p. 206; see the case last cited.

Clause (a), dealing with old marks, is wider than clause (b), because the policy of the Acts is to register old marks exactly as they were used: p. 170; *Phillips' Tm.*, (1891) 3 Ch. 139; 8 R. P. C. 469, Chitty, J.; *Henry Clay & Co.'s Tm.*, (1892) 3 Ch. 549; 9 R. P. C. 449, Kekowich, J.

Common words in a distinctive label need not be disclaimed, p. 207.

Repealed.
Act, 1888,
s. 16.

(2.) *The applicant for entry of any such common particular or particulars must, however, disclaim in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the Register.*

Act, 1888,
s. 16.

[(2.) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade-mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the Register.

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

The amendment is in accord with that of sect. 64 (2) and (3) (i), p. 199.
As to honest trade under one's own name, see pp. 202, 500 *et seq.*

(3.) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words, or figures, which was or were, before the thirteenth day of August one thousand eight hundred and seventy-five, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods.

The “three mark rule,” pp. 207, 214.

13th of August, 1875, is the date of commencement of the first Registration Act.

Effect of Registration.

Registration
equivalent to
public use.

Act, 1888,
s. 17.

75. *Registration of a trade-mark shall be deemed to be equivalent to public use of the trade-mark.*

[Application for registration of a trade-mark shall be deemed to be equivalent to public use of the trade-mark, and the date of the application shall for the purposes of this Act be deemed to be, and as from the first day of January one thousand eight hundred and seventy-six to have been, the date of the registration.]

Page 304.

Continued registration not necessarily equivalent to continued user, p. 306.

Effect of registration, Chap. XII., p. 302. As to the acquisition of trade-marks by user, see Chap. II., p. 24.

Date of application. It was the practice, from the first, to register the

entry as of the date when the application was received by the Registrar, see Rule 20 of the Rules of 1876, and Rule 32 of the Rules of 1883. The amendment was made to give this practice statutory authority; report of Lord Herschell's Committee, p. xiii.

Entry post-dated, *Hayward's Case*, p. 233.

76. The registration of a person as proprietor of a trade-mark shall be *prima facie* evidence of his right to the exclusive use of the trade-mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade-mark, subject to the provisions of this Act.

Right of first proprietor to exclusive use of trade-mark.

Page 306. Registration is evidence of title, conclusive only after five years, p. 361.

Rectification of the Register after five years, p. 383.

Test of infringement where the registered mark is actually copied, p. 371

For deceptive resemblance, see pp. 224—252, and pp. 372—382.

See note to sect. 71.

77. A person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of a trade-mark unless, in the case of a trade-mark capable of being registered under this Act, it has been registered in pursuance of this Act, or of an enactment repealed by this Act, or, in the case of any other trade-mark in use before the thirteenth of August one thousand eight hundred and seventy-five, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused. The Comptroller may, on request, and on payment of the prescribed fee, grant a certificate that such registration has been refused.

Restrictions on actions for infringement, and on defence to action in certain cases.

Registration as a condition precedent to an action for infringement, p. 312.

The prohibition does not affect actions for passing off, p. 317. It applies to foreigners, pp. 316, 357.

13th of August, 1875, is the date of commencement of the first Registration Act.

Certificate, p. 315; Rule 60, p. 702; Instructions 35, p. 730; Form of application, Form L., p. 709; Fee 1/.

[77a. In an action for infringement of a registered trade-mark the Court or a judge may certify that the right to the exclusive use of the trade-mark came in question, and if the Court or a judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or judge trying the subsequent action certifies that he ought not to have the same.]

Certificate as to exclusive use and costs thereon.
Act, 1888, s. 18.

Pages 292 and 436.

This section was added on the precedent of sect. 31, which applied to patent actions only.

Although the validity of the trade-mark be raised on an application to remove it, yet where such application and an action by the proprietor for

infringement are heard together and on the same evidence, the certificate may be given. *Field, Ltd. v. Wagel Syndicate Ltd.*, (1900) 1 Ch. 651, 17 R. P. C. 266.

Register of Trade-Marks.

Register of trade-marks.

78. There shall be kept at the patent office a book called the Register of Trade-Marks, wherein shall be entered the names and addresses of proprietors of registered trade-marks, notifications of assignments and of transmissions of trade-marks, and such other matters as may be from time to time prescribed.

Cf. sect. 87.

The Register, Chap. III., p. 56. The date of the application for registration, and such other particulars as the Comptroller thinks necessary, are to be entered, Rule 34, p. 698.

An application to the Court has been allowed under this section where the Comptroller refused to register an assignment, p. 333; *Bancroft's Tm.*, 5 R. P. C. 209 (1888), Stirling, J.

Quere, whether an abandoned mark can be removed under the section, p. 348.

Removal of trade-mark after fourteen years, unless fee paid.

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

Page 349. The cause of the removal is to be entered, Rule 47, p. 700.

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

Fee 17., Form X., p. 714.

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

Additional fee, 10s., Form Y., p. 714.

(4.) Where after the said three months a trade-mark has been removed from the Register for non-payment of the prescribed fee, the Comptroller may, if satisfied that it is just so to do, restore such trade-mark to the Register on payment of the prescribed additional fee.

Additional fee, 17., Form Z., p. 714.

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

Act, 1888,
s. 19, sub-s. 1.

Act, 1888,
s. 19, sub-s. 2.

Page 350.

Fees.

80. There shall be paid in respect of applications and registration and other matters under this part of this Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of her Majesty's Exchequer in such manner as the Treasury may from time to time direct.

Fees for
registration,
&c.

List of fees, p. 703.

Sheffield Marks.

81. With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called the Cutlers' Company) and the marks or devices (in this Act called Sheffield marks) assigned or registered by the master, wardens, searchers, and assistants of that company, the following provisions shall have effect:

Registration
by Cutlers'
Company of
Sheffield
marks.

Sheffield marks, Chap. VI., p. 101, Rules 56 to 59, p. 701.
"Metal goods" is defined in sub-sect. (14).

- (1.) The Cutlers' Company shall establish and keep at Sheffield a new Register of trade-marks (in this Act called the Sheffield Register):
- (2.) *The Cutlers' Company shall enter in the Sheffield Register, in respect of cutlery, edge tools, or raw steel and the goods mentioned in the next sub-section all the trade-marks entered before the commencement of this Act in respect of cutlery, edge tools, or raw steel and such goods in the Register established under the Trade-Marks Registration Act, 1875, belonging to persons carrying on business in Hallamshire, or within six miles thereof, and shall also enter in such Register, in respect of the same goods, all the trade-marks which shall have been assigned by the Cutlers' Company and actually used before the commencement of this Act, but which have not been entered in the Register established under the Trade-Marks Registration Act, 1875:*

Act, 1888,
s. 20, sub-s. 1.

Act, 1888,
s. 20, sub-s. 1.

38 & 39 Vict.
c. 91.

[(2.) The Cutlers' Company shall enter in the Sheffield Register, in respect of metal goods as defined in this section, all the trade-marks entered before the first day of January one thousand eight hundred and eighty-nine in respect of metal goods either in the Register established under the Trade-Marks Registration Act, 1875, or in the Register of trade-marks under this Act, belonging to persons carrying on business in Hallamshire or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield Register, in respect of metal goods, all the trade-marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January one thousand eight hundred and eighty-four, but which have not been entered in either of the said other Registers:]

Act, 1888,
s. 20, sub-s. 2.

(3.) An application for registration of a trade-mark used on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge [on metal goods] shall, if made after the commencement of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company:

(4.) Every application so made to the Cutlers' Company shall be notified to the Comptroller in the prescribed manner, and unless the Comptroller within the prescribed time gives notice to the Cutlers' Company that he objects to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner:

(5.) If the Comptroller gives notice of objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the Court:

(6.) Upon the registration of a trade-mark in the Sheffield Register the Cutlers' Company shall give notice thereof to the Comptroller, who shall thereupon enter the mark in the Register of trade-marks; and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the Comptroller on that day:

Act, 1888,
s. 20, sub-s. 3.

(7.) *The provisions of this Act, and of any general Rules made under this Act, with respect to application for registration in the register of trade-marks, the effect of such registration, and the assignment and transmission of rights in a registered trade-mark shall apply in the case of applications and registration in the Sheffield Register; and notice of every entry made in the Sheffield Register must be given to the Comptroller by the Cutlers' Company, save and except that the provisions of this sub-section shall not*

prejudice or affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield Register :

- [(7.) The provisions of this Act and of any general Rules made under this Act with respect to the registration of trade-marks, and all matters relating thereto, shall, subject to the provisions of this section, apply to the registration of trade-marks on metal goods by the Cutlers' Company, and to all matters relating thereto ; and this Act and any such general Rules shall, so far as applicable, be construed accordingly with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield Register, for the Comptroller, the Patent Office, and the Registrar of Trade-Marks, respectively ; and notice of every entry, cancellation, or correction made in the Sheffield Register shall be given to the Comptroller by the Cutlers' Company : provided that this section shall not affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield Register :]
- (8.) Where the Comptroller receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade-mark used *on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge* [on metal goods], he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company : Act, 1888,
s. 20, sub-s. 2.
- (9.) At the expiration of five years from the commencement of this Act the Cutlers' Company shall close the Cutlers' register of corporate trade-marks, and thereupon all marks entered therein shall, unless entered in the Sheffield Register, be deemed to have been abandoned :
- (10.) A person may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield Register as proprietor of two or more trade-marks :
- (11.) A body of persons, corporate or not corporate, may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield Register as proprietor of a trade-mark or trade-marks :
- (12.) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the Comptroller, who shall have power to confirm, reverse or modify the decision, but the decision of the Comp-

troller shall be subject to a further appeal to the Court :

Person aggrieved, *of. sect. 90, p. 265.*

(13.) So much of the Cutlers' Company's Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate marks, that is to say, the fifth section of the Cutlers' Company's Act of 1814, and the provisions in relation to the recovery and application of the penalty imposed by such last-mentioned section contained in the Cutlers' Company's Act of 1791, shall apply to any mark entered in the Sheffield Register :

See pp. 102 and 643.

Act, 1888,
s. 20, sub-s. 4.

[(14.) For the purposes of this section the expression "metal goods" means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal.]

[(15.) For the purpose of legal proceedings in relation to trade-marks entered in the Sheffield Register a certificate under the hand of the master of the Cutler's Company shall have the same effect as the certificate of the Comptroller.]

Certificate of the Comptroller, *sect. 96, Rule 60, p. 702.*

PART V.—GENERAL.

Patent Office and Proceedings thereat.

Patent Office. **82.** (1.) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.

As to the Patent Office, Trade-Marks Branch, see Chap. III., p. 56.

(2.) Until a new patent office is provided, the offices of the Commissioners of Patents for inventions and for the registration of designs and trade-marks existing at the commencement of this Act shall be the patent office within the meaning of this Act.

(3.) The Patent Office shall be under the immediate control of an officer called the Comptroller-General of patents, designs, and trade-marks, who shall act under the superintendence and direction of the Board of Trade.

Pages 57, 74.

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

83. (1.) The Board of Trade may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the Comptroller-General of patents, designs, and trade-marks, and so many examiners and other officers and clerks with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

Officers and clerks.

(2.) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by Parliament.

84. There shall be a seal for the Patent Office, and impressions thereof shall be judicially noticed and admitted in evidence.

Seal of patent office.

Cf. sect. 89, sealed and certified copies of the Registers; and sect. 96, the certificate of the Comptroller to be evidence.

85. There shall not be entered in any Register kept under this Act, or be receivable by the Comptroller, any notice of any trust expressed, implied, or constructive.

Trust not to be entered in Registers.

The section does not forbid the entry of a note upon the Register stating the effect of an undertaking limiting the right of user of the trade-mark, see pp. 58, 99 (class of goods), 195 (colour), 219 (use of mark), 282 (note entered under sect. 90), where instances of orders made will be found. The decision in *Dewhurst's Tm.*, (1896) 2 Ch. 137; 13 R. P. C. 288, seems, however, to have changed the practice; at all events as to geographical limitations.

By reason of this section, and sect. 87, the registered proprietor can make a good title to any purchaser of the trade-mark and of the goodwill of the business concerned (sect. 70), who has no notice of any equitable rights in the trade-mark or goodwill existing in any third person.

But a registered assignee who takes an assignment with notice of an equitable title in a third person takes subject to his rights, see the patent case, *New Ixion Tyre and Cycle Co., Ltd. v. Spilsbury*, (1898) 2 Ch. 137, 484; 15 R. P. C. 380, 567.

86. The Comptroller may refuse to grant a patent for an invention, or to register a design or trade-mark, of which the use would, in his opinion, be contrary to law or morality.

Refusal to grant patent, &c. in certain cases.

Cf. sect. 73.

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade-mark, the Comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design, or trade-mark, in the Register of patents, designs, or trade-marks, as the case may be. The person for the time being entered in the Register of patents, designs, or trade-marks, as proprietor of a patent, copyright in a design or trade-mark, as the case may be, shall, subject to [the provisions of this Act and to] any rights appearing from such Register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the same and to give effectual receipts for any consideration for

Entry of assignments and transmissions in Registers.

Act, 1888, s. 21.

such assignment, licence, or dealing. Provided that any equities in respect of such patent, design, or trade-mark may be enforced in like manner as in respect of any other personal property.

Assignment and devolution of trade-marks, Chap. XIII., p. 324. Registration of assignments, p. 331, Rules 36 to 40, p. 698.

As to notice of equities, see note to sect. 85.

Licence to use a trade-mark, p. 335. Licensee cannot sue, pp. 336, 359. Licence as a defence is an infringement action, p. 393.

Inspection
of and ex-
tracts from
Registers.

Act, 1888,
s. 22.

88. Every Register kept under this Act shall at all convenient times be open to the inspection of the public, subject to [the provisions of this Act and to] such regulations as may be prescribed; and certified copies, sealed with the seal of the patent office, of any entry in such Register shall be given to any person requiring the same on payment of the prescribed fee.

Inspection, searches and indexes, pp. 60, 61. Hours of inspection, Rule 52, p. 700. Searches, Instructions 7, p. 725. Fees, for inspection or searching, 1s. for every quarter of an hour; for office copy of documents, for every 100 words (but never less than 1s.), 4d.; for certifying office copies, MS. or printed, 1s.

Sealed copies
to be received
in evidence.

89. Printed or written copies or extracts, purporting to be certified by the Comptroller and sealed with the seal of the patent office, of or from patents specifications disclaimers and other documents in the patent office, and of or from Registers and other books kept there, shall be admitted in evidence in all Courts in her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

Cf. sect. 84, seal of the patent office; and sect. 96, the certificate of the Comptroller.

Fees, see sect. 88.

Rectification
of Registers
by Court.

Act, 1888,
s. 23.

90. (1.) The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person [or of any other particulars] from any Register kept under this Act, or by any entry made without sufficient cause in any such Register, make such order for making, expunging, or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.

Rectification of the Register, Chap. XI., p. 262. As a defence, p. 383.

An entry may be rectified after five years' registration, notwithstanding sect. 76, p. 309.

"Made without sufficient cause" includes "existing without sufficient cause," *Batt's Tms.*, (1898) 2 Ch. 432; 15 R. P. C. 534; above, p. 277.

Costs, p. 293. Security for costs by a foreigner, p. 289.

Procedure, p. 285. The Court, p. 285. Four clear days' notice of the application must be given to the Comptroller, Rule 49, p. 700.

Forms, p. 742. Fee, 10s.

(2.) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to

decide for the rectification of a Register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

Damages, p. 291.

(3.) Any order of the Court rectifying a Register shall direct that due notice of the rectification be given to the Comptroller.

An office copy of the order, with a notice in Form N., p. 710, must be left at the patent office forthwith, Rule 46, p. 700. Publication of the order, Rule 50, p. 700.

91. The Comptroller may, on request in writing accompanied by the prescribed fee—

Power for
Comptroller
to correct
clerical errors.

(a) Correct any clerical error in or in connexion with an application for a patent, or for registration of a design or trade-mark; or

Pages 78, 84. The Comptroller has a general power to amend documents and correct irregularities in procedure under Rule 54, p. 78.

Fee on request to amend application, 5s. Form Q., p. 711.

(b) Correct any clerical error in the name, style, or address of the registered proprietor of a patent, design, or trade-mark.

Page 295. Form of request, Q., p. 711. Fee 5s. Alteration of address, Rule 48, p. 700. Form N., p. 710. Fee 5s. Fee on entry of a rectification or alteration other than of alteration of address, or cancellation of the entry or part of it at the owner's request, 10s.

(c) Cancel the entry or part of the entry of a trade-mark on the Register: provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on the Register as the proprietor of the said trade-mark.

Page 295. Statutory declaration, Rules 61, 62, pp. 702, 703. Form P., p. 710. Form of request, O., p. 710. Fee 5s.

[(d) Permit an applicant for registration of a design or trade-mark to amend his application by omitting any particular goods or classes of goods in connexion with which he has desired the design or trade-mark to be registered.] Act, 1888, s. 24.

Page 78. The sub-section was added to allow an applicant to disclaim any right to use the mark for some of the goods in the register class or classes to which his application refers, in order, for instance, to avoid opposition by the proprietors of trade-marks used or registered for the disclaimed goods. Report of Lord Herschell's Committee, p. xiv. Form of request, Q., p. 711. Fee 5s.

As to amendments on appeal, see p. 91,

Alteration of registered mark.

92.—(1.) The registered proprietor of any registered trade-mark may apply to the Court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act, and the Court may refuse or grant leave on such terms as it may think fit.

Alterations in non-essential particulars, p. 297.

Alterations of old marks, pp. 297, 298.

“Such mark,” not the registration, p. 297.

Procedure, p. 300.

Forms, p. 742. Fee 10s.

(2.) Notice of any intended application to the Court under this section shall be given to the Comptroller by the applicant; and the Comptroller shall be entitled to be heard on the application.

Fourteen days' notice of the application must be given to the Comptroller, and if the application is granted representations of the trade-mark as altered must be sent to him, Rule 51, p. 700.

(3.) If the Court grants leave, the Comptroller shall, on proof thereof and on payment of the prescribed fee, cause the Register to be altered in conformity with the order of leave.

An office copy of the order with a notice in Form N., p. 710, must be left at the patent office forthwith, Rule 46, p. 700. Publication of the order, Rule 50, p. 700.

Falsification of entries in Registers.

93. If any person makes or causes to be made a false entry in any Register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such Register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanour.

Exercise of discretionary power by Comptroller.

94. Where any discretionary power is by this Act given to the Comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade-mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

Pages 69, 74, and 78. The course of events laid down by the rules is as follows:—Notice by the Comptroller to the applicant of his objection; application by the applicant to be heard, Form E., p. 705, within one month; ten days' notice by the Comptroller of a time when the applicant may be heard; notice by the applicant to the Comptroller whether he desires to be heard or not, within five days; Rules 17 to 19, p. 695. See also pp. 82 and 83. Fees, on hearing by the Comptroller, payable by the applicant, and by the opponent respectively, 1/.

Power of Comptroller

95. The Comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this

Act, apply to either of the law officers for directions in the matter. to take directions of law officers.

See p. 57, note (g), and p. 74, note (t).

96. A certificate purporting to be under the hand of the Comptroller as to any entry, matter, or thing which he is authorized by this Act, or any general rules made thereunder, to make or do, shall be *prima 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. Certificate of Comptroller to be evidence.

Page 61, Rule 60.

Cf. sect. 84, seal of the patent office, and sect. 89, sealed and certified copies to be evidence.

Request for certificate for use in obtaining registration abroad, Form R.; for use in legal proceedings, Form S.; for other general certificates, Form T 1.; form of general certificate, U.; request for copy of official notification of registration, Form V., pp. 711—713.

Fees for the various certificates, p. 701.

97. (1.) Any application, notice, or other document authorized or required to be left, made, or given at the patent office or to the Comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post. Applications and notices by post.

(2.) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

98. Whenever the last day fixed by this Act, or by any Rule for the time being in force, for leaving any document or paying any fee at the patent office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days if two or more of them occur consecutively. Provision as to days for leaving documents at office.

The Comptroller has a general power to enlarge the times prescribed by the Rules, Rule 55, p. 701.

99. If any person is, by reason of infancy, lunacy or other inability, incapable of making any declaration or doing anything required or permitted by this Act or by any Rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed by any Court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly Declaration by infant, lunatic, &c.

corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted.

Declarations, Rules 61, 62, p. 702.

The Comptroller has a general power to dispense with any act or thing required to be done by the Rules, or any document or declaration or evidence to be signed, made, or produced, Rule 53, p. 701.

Transmission of certified printed copies of specifications, &c.

100. Copies of all specifications, drawings, and amendments left at the patent office after the commencement of this Act, printed for and sealed with the seal of the patent office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the patent office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

Power for Board of Trade to make general rules for classifying goods and regulating business of patent office.

101. (1.) The Board of Trade may from time to time make such general rules and do such things as they think expedient, subject to the provisions of this Act—

- (a) For regulating the practice of registration under this Act:
- (b) For classifying goods for the purposes of designs and trade-marks:
- (c) For making or requiring duplicates of specifications, amendments, drawings, and other documents:
- (d) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, amendments and other documents:
- (e) For securing and regulating the making, printing, publishing and selling of indexes to, and abridgments of, specifications and other documents in the patent office; and providing for the inspection of indexes and abridgments and other documents:
- (f) For regulating (with the approval of the Treasury) the presentation of copies of patent office publications to patentees and to public authorities, bodies and institutions at home and abroad:
- (g) Generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the Comptroller, or of the Board of Trade.

(2.) Any of the forms in the First Schedule to this Act may be altered or amended by rules made by the Board as aforesaid.

The forms prescribed by the Rules of 1890 are printed at pp. 705 *et seq.* They must be used in all cases to which they are applicable, Rule 5, p. 691.

(3.) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.

The Rules of 1890, showing also the amendments made by the Rules of 1897 and 1898, are printed at pp. 691 *et seq.* They repeal all former rules, Rule 63.

“Prescribed,” where it occurs in the Act, means prescribed by any of the schedules to the Act, or by general rules under or within the meaning of the Act, sect. 117.

(4.) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the Comptroller.

(5.) If either House of Parliament, within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.

102. The Comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act. Annual reports of Comptroller

[102a. (1.) All things required or authorized under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.] Proceedings of Board of Trade. Act, 1888, s. 25.

[(2.) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorized in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.]

[(3.) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.]

International and Colonial Arrangements.

103. (1.) If Her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of inventions, designs, and trade- International arrangements for protection

of inventions,
designs, and
trade-marks.

Act, 1885,
s. 6.

marks, or any of them, then any person who has applied for protection for any invention, design, or trade-mark in any such state, shall be entitled to a patent for his invention or to registration of his design or trade-mark (as the case may be) under this Act, in priority to other applicants; and such patent or registration shall have the same date as the *date of the protection obtained* [date of the application] in such foreign state.

Provided that his application is made, in the case of a patent within seven months, and in the case of a design or trade-mark within four months, from his applying for protection in the foreign state with which the arrangement is in force.

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade-mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade-mark in this country, as the case may be.

Registration of foreign and colonial trade-marks, Chap. XX., p. 545.

The International Conventions of 1883 (signed at Paris, 20th March, 1883; ratified 6th June, 1884) and 1891 (signed at Madrid, 14th April, 1891; ratified 15th June, 1892) are printed at pp. 764—773, and the list of foreign states to which the section is applicable at p. 762.

Great Britain did not sign the arrangement relating to the International Registration of Trade-Marks of 1891, above, p. 547, and p. 773.

(2.) The publication in the United Kingdom, or the Isle of Man, during the respective periods aforesaid, of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade-mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade-mark :

This seems to be surplusage so far as regards trade-marks, see p. 552.

(3.) The application for the grant of a patent, or the registration of a design, or the registration of a trade-mark under this section, must be made in the same manner as an ordinary application under this Act: provided that, in the case of trade-marks, any trade-mark the registration of which has been duly applied for in the country of origin may be registered under this Act :

Page 553.

(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which Her Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state.

Provision for
colonies and
India.

104. (1.) Where it is made to appear to Her Majesty that the legislature of any British possession has made satisfactory pro-

vision for the protection of inventions, designs, and trade-marks, patented or registered in this country, it shall be lawful for Her Majesty from time to time by Order in Council to apply the provisions of the last preceding section, with such variations or additions, if any, as to Her Majesty in Council may seem fit, to such British possession.

Registration of foreign and colonial trade-marks, Chap. XX., p. 545.
List of British Possessions to which the section is applicable, p. 762.
Definition of British Possession, sect. 117.

(2.) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the order, take effect as if its provisions had been contained in this Act; but it shall be lawful for Her Majesty in Council to revoke any Order in Council made under this Act.

Offences.

105. (1.) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade-mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds. Penalty on falsely representing articles to be patented.

(2.) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade-mark is registered, if he sells the article with the word "patent," "patented," "registered," or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.

Page 639, also 401 *et seq.*, 407, and cf. the application of a false trade description under the M. M. A. pp. 569, 579.

106. Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any Government Department, assumes or uses in connexion with any trade, business, calling, or profession, the Royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds. Penalty on unauthorized assumption of Royal arms.

Page 641.

Scotland, Ireland, &c.

107. In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the Court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process Saving for Courts in Scotland.

of the Courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those Courts.

For the purposes of this section "Court of Appeal" shall mean any Court to which such action is appealed.

Summary proceedings in Scotland.

108. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the sheriff court.

Proceedings for revocation of patent in Scotland.

109. (1.) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.

(2.) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

Reservation of remedies in Ireland.

110. All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.

An entry registered in the name of an Irish proprietor can be rectified under sect. 90 by the English Courts: *Re King & Co.'s Tm.*, (1892) 2 Ch. 462; 9 R. P. C. 350; Kekewich, J., and C. A. pp. 285, 288.

General saving for jurisdiction of Courts.

111. (1.) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade-marks; and with reference to any such proceedings in Scotland, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either division of the said Court; and with reference to any such proceedings in Ireland, the terms "the Court" and "the Court of Appeal" respectively mean the High Court of Justice in Ireland and her Majesty's Court of Appeal in Ireland.

See note to sect. 110; and as to rectification of the Register, pp. 285, 286.

(2.) If any rectification of a Register under this Act is required in pursuance of any proceeding in a Court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification, shall be served on the Comptroller, and he shall rectify the Register accordingly.

Isle of Man.

112. This Act shall extend to the Isle of Man, and—

(1.) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade-mark competent to those Courts;

- (2.) The punishment for a misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court;
- (3.) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

[112a. The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade-marks the registration whereof is applied for in the Manchester Office, have the like jurisdiction under this Act as Her Majesty's High Court of Justice in England, and the expression "the Court" in this Act shall be construed and have effect accordingly.

Jurisdiction of Lancashire Palatine Court. Act, 1888, s. 26.

Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that Court in other cases.]

Repeal, Transitional Provisions, Savings.

113. The enactments described in the Third Schedule to this Act are hereby repealed. But this repeal of enactments shall not—

Repeal and saving for past operation of repealed enactments, &c.

- (a) Affect the past operation of any of those enactments, or any patent or copyright or right to use a trade-mark granted or acquired, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act; or
- (b) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed; or
- (c) Take away or abridge any protection or benefit in relation to any such action or proceeding.

As to which Act applied to the registration of a trade-mark where the application was pending at the date of commencement of a new Act, see p. 121. And see sect. 27 of the Act of 1888, p. 683.

114. (1.) The Registers of patents and of proprietors kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the Register of patents kept under this Act.

Former Registers to be deemed continued.

(2.) The Registers of designs and of trade-marks kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the Register of designs and the Register of trade-marks kept under this Act.

Saving for existing rules.

115. All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed altered or amended by the Board of Trade, as if they had been made by the Board under this Act, but so that no such repeal alteration or amendment shall take effect before the commencement of this Act; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act.

Saving for prerogative.

116. Nothing in this Act shall take away abridge or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

General Definitions.

General definitions.

117. (1.) In and for the purposes of this Act, unless the context otherwise requires,—

“Person” includes a body corporate:

“The Court” means (subject to the provisions for Scotland, Ireland, and the Isle of Man) Her Majesty’s High Court of Justice in England:

“Law officer” means Her Majesty’s Attorney-General or Solicitor-General for England:

“The Treasury” means the Commissioners of Her Majesty’s Treasury:

“Comptroller” means the Comptroller General of Patents, Designs, and Trade-Marks.

“Prescribed” means prescribed by any of the Schedules to this Act, or by general rules under or within the meaning of this Act:

“British possession” means any territory or place situate within Her Majesty’s dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man, and all territories and places under one legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act:

“Legislature” includes any person or persons who exercise legislative authority in the British possession; and where there are local legislatures as well as a central legislature, means the central legislature only.

In the application of this Act to Ireland, “summary conviction” means a conviction under the Summary Jurisdiction Acts,

that is to say, with reference to the Dublin Metropolitan Police District, the Acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.

SCHEDULES.

THE FIRST SCHEDULE.

FORMS OF APPLICATION, &c.

FORM F.

Section 62.

FORM OF APPLICATION FOR REGISTRATION OF TRADE-MARK.

See Form F., Trade-Marks Rules, 1890, p. 706.

THE THIRD SCHEDULE.

Section 113.

Enactments repealed.

- | | |
|---------------------------------|--|
| 38 & 39 Vict. c. 91.
[1875.] | The Trade-Marks Registration Act, 1875. |
| 39 & 40 Vict. c. 33.
[1876.] | The Trade-Marks Registration Amendment Act,
1876. |
| 40 & 41 Vict. c. 37.
[1877.] | The Trade-Marks Registration Extension Act, 1877. |

No. 2.

PATENTS, DESIGNS, AND TRADE-MARKS
ACT, 1888.

(51 & 52 Vict. c. 50.)

*** The several sections of this Act are printed and annotated together with the principal Act above; they are printed here for convenience of reference.

An Act to amend the Patents, Designs, and Trade-Marks Act, 1883. [24th December, 1888.]

46 & 47 Vict.
c. 57.

WHEREAS it is expedient to amend the Patents, Designs, and Trade-Marks Act, 1883, hereinafter referred to as the principal Act:

Be it therefore enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Register of
patent agents.

1.—(1.) After the first day of July one thousand eight hundred and eighty-nine a person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act.

(2.) The Board of Trade shall, as soon as may be after the passing of this Act, and may from time to time, make such general rules (a) as are in the opinion of the Board required for giving effect to this section, and the provisions of section one hundred and one of the principal Act shall apply to all rules so made as if they were made in pursuance of that section.

(3.) Provided that every person who proves to the satisfaction of the Board of Trade that prior to the passing of this Act he had been bonâ fide practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act.

(4.) If any person knowingly describes himself as a patent agent in contravention of this section he shall be liable on summary conviction to a fine not exceeding twenty pounds.

(5.) In this section "patent agent" means exclusively an agent for obtaining patents in the United Kingdom.

(a) Register of Patent Agents Rules, 1889 and 1891: see *Institute of Patent Agents v. Lockwood*, (1891) A. C. 317; 11 R. P. C. 355; *Stacey v. Graham*, (1899) 1 Q. B. 406; 16 R. P. C. 108

2. For section seven of the principal Act the following section shall be substituted, namely:—

Amendments
of 46 & 47
Vict. c. 57.

“7. (1.) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not, or have not, been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject matter of the invention, the Comptroller may refuse to accept the application, or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the Comptroller so directs, bear date as from the time when the requirement is complied with.

s. 7, as to
applications.

“(2.) Where the Comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer.

“(3.) The law officer shall, if required, hear the applicant and the Comptroller, and may make an order determining whether, and subject to what conditions (if any), the application shall be accepted.

“(4.) The Comptroller shall, when an application has been accepted, give notice thereof to the applicant.

“(5.) If, after an application for a patent has been made, but before the patent thereon has been sealed, another application for a patent is made, accompanied by a specification bearing the same or a similar title, the Comptroller, if he thinks fit, on the request of the second applicant, or of his legal representative, may, within two months of the grant of a patent on the first application, either decide to proceed with the second application or allow the surrender of the patent, if any, granted thereon.”

3. In sub-section five of section nine of the principal Act the words “other than an appeal to the law officer under this Act” shall be omitted.

s. 9, as to
disclosure of
reports of
examiners.

4. In sub-section one of section eleven of the principal Act the words from “or on the ground of an examiner” to “a previous application,” both inclusive, shall be omitted, and there shall be added in lieu thereof the following words, namely, “or on the ground that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification.”

s. 11, as to
opposition to
grant of
patent.

5. For sub-section ten of section eighteen of the principal Act the following sub-section shall be substituted, namely:—

s. 18, as to
amended
specifications.

“(10.) The foregoing provisions of this section do not apply when, and so long as any action for infringement or proceeding for revocation of a patent is pending.”

s. 52, as to inspection of designs.

6. After sub-section one of section fifty-two of the principal Act the following words shall be added ; namely,

“Provided that where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered.”

s. 58, as to piracy of registered designs.

7.—(1.) In section fifty-eight of the principal Act the words “or cause to be applied” shall be added after the word “apply.”

(2.) To the same section the following words shall be added: “Provided that the total sum forfeited in respect of any one design shall not exceed one hundred pounds.”

s. 62, as to application for registration.

8.—(1.) In sub-section 2 of section sixty-two of the principal Act for the words “the patent office in the prescribed manner” shall be substituted the words “such place and in such manner as may be prescribed.”

(2.) To the same section of the principal Act the following sub-section shall be added :—

“(6.) Where an applicant for the registration of a trade-mark otherwise than under an international convention is out of the United Kingdom at the time of making the application he shall give the Comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given.”

s. 63, as to limit of time for proceeding with application.

9. In section sixty-three of the principal Act for the words “the application shall be deemed to be abandoned” shall be substituted the words “the Comptroller shall give notice of the non-completion to the agent employed on behalf of the applicant, and, if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant, and if at the expiration of the latter fourteen days, or such further time as the Comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned.”

s. 64, as to fancy words.

10.—(1.) For section sixty-four of the principal Act the following section shall be substituted, namely—

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

- “(a) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner ; or
- “(b) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade-mark ; or
- “(c) A distinctive device, mark, brand, heading, label, or ticket ; or
- “(d) An invented word or invented words ; or

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

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

“(3.) Provided as follows :

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

“(ii.) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures used as a trade-mark before the thirteenth day of August one thousand eight hundred and seventy-five, may be registered as a trade-mark under this part of this Act.”

11. In section sixty-seven of the principal Act the words “or colours” shall be added after the word “colour” in each place where that word occurs. s. 67, as to colours of trade-marks.

12. In section sixty-eight of the principal Act after the word Comptroller shall be added the words “unless the Comptroller refuse to entertain the application.” s. 68, as to advertisement of applications.

13.—(1.) In sub-section one of section sixty-nine of the principal Act for the words “two months” shall be substituted the words “one month or such further time, not exceeding three months, as the Comptroller may allow.” s. 69, as to opposition to registration.

(2.) In the same sub-section the words “first” shall be omitted.

(3.) In sub-section two of the same section for the words “two months” shall be substituted the words “one month.”

(4.) For sub-sections three and four of the same section the following sub-sections shall be substituted ; namely,

“(3.) If the applicant sends such counter-statement the Comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall, after hearing the applicant and the opponent, if so required, decide whether the trade-mark is to be registered, but his decision shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the opponent and the Comptroller, and may make an order determining whether, and subject to what conditions (if any), registration is to be permitted.

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

“(5.) If the applicant abandons his application after notice of opposition in pursuance of this section he shall be liable to pay to the opponent such costs in respect of the opposition as the Comptroller may determine to be reasonable.

“(6.) Where the opponent is out of the United Kingdom he shall give the Comptroller an address for service in the United Kingdom.”

s. 72, as to restrictions on registration.

14. In sub-section two of section seventy-two of the principal Act, the following words shall be added at the beginning of the sub-section, namely, “except as aforesaid,” and for the words “so nearly resembling” shall be substituted the words “having such resemblance to.”

s. 73, as to restriction on registration.

15. In section seventy-three of the principal Act the word “exclusive” shall be omitted.

s. 74, as to additions to trade-marks.

16. For sub-section two of section seventy-four of the principal Act the following sub-section shall be substituted; namely,

“(2.) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade-mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the Register.

“Provided that a person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof.”

s. 75, as to effect of registration.

17. For section seventy-five of the principal Act the following section shall be substituted; namely,

“Application for registration of a trade-mark shall be deemed to be equivalent to public use of the trade-mark, and the date of the application shall for the purposes of this Act be deemed to be, and as from the first day of January one thousand eight hundred and seventy-six to have been, the date of the registration.”

Certificate as to exclusive use and costs thereon.

18. After section seventy-seven of the principal Act the following section shall be added and numbered 77A; namely,

“In an action for infringement of a registered trade-mark the Court or a judge may certify that the right to the exclusive use of the trade-mark came in question, and if the Court or a judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as

between solicitor and client, unless the Court or judge trying the subsequent action certifies that he ought not to have the same."

19.—(1.) In sub-section five of section seventy-nine of the principal Act, for the words, "the five years" shall be substituted the words "one year."

Amendments of 46 & 47 Vict. c. 57.

(2.) To the same sub-section the following words shall be added; namely, "unless it is shown to the satisfaction of the Comptroller that the nonpayment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade-mark."

s. 79, as to removal of trade-mark from the Register.

20.—(1.) For sub-section two of section eighty-one of the principal Act the following sub-section shall be substituted:

s. 81, as to Sheffield marks.

"(2.) The Cutlers' Company shall enter in the Sheffield Register, in respect of metal goods as defined in this section, all the trade-marks entered before the first day of January one thousand eight hundred and eighty-nine in respect of metal goods either in the Register established under the Trade-Marks Registration Act, 1875, or in the Register of trade-marks under this Act, belonging to persons carrying on business in Hallamshire or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield Register, in respect of metal goods, all the trade-marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January one thousand eight hundred and eighty-four, but which have not been entered in either of the said other Registers."

38 & 39 Vict. c. 91.

(2.) In sub-sections three and eight of the same section, for the words "on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge," shall be substituted the words "on metal goods."

(3.) For sub-section seven of the same section the following sub-section shall be substituted:

"(7.) The provisions of this Act and of any general rules made under this Act with respect to the registration of trade-marks, and all matters relating thereto, shall, subject to the provisions of this section, apply to the registration of trade-marks on metal goods by the Cutlers' Company, and to all matters relating thereto; and this Act and any such general rules shall, so far as applicable, be construed accordingly, with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield Register, for the Comptroller, the Patent Office, and the Register of Trade-Marks, respectively; and notice of every entry, cancellation, or correction made in the Sheffield Register shall be given to the Comptroller by the Cutlers' Company: Provided that this section shall not affect any life estate and interest of a widow of the holder of any

Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield Register.”

(4.) To the same section the following sub-sections shall be added; namely,—

“(14.) For the purposes of this section the expression ‘metal goods’ means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal.

“(15.) For the purpose of legal proceedings in relation to trade-marks entered in the Sheffield Register a certificate under the hand of the master of the Cutlers’ Company shall have the same effect as the certificate of the Comptroller.”

s. 87, as to entry of assignments, &c.

21. In section eighty-seven of the principal Act, after the words “subject to,” shall be added the words “the provisions of this Act and to.”

s. 88, as to inspection.

22. In section eighty-eight of the principal Act, after the words “subject to,” shall be added the words “the provisions of this Act and to.”

s. 90, as to rectification of Register.

23. In section ninety of the principal Act, after the words “of the name of any person,” shall be added the words “or of any other particulars.”

s. 91, as to correction of errors.

24. To section ninety-one of the principal Act the following sub-section shall be added; namely,

“(d) Permit an applicant for registration of a design or trade-mark to amend his application by omitting any particular goods or classes of goods in connection with which he has desired the design or trade-mark to be registered.”

Proceedings of Board of Trade.

25. After section one hundred and two of the principal Act the following section shall be added and numbered 102A; namely,

“(1.) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

“(2.) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

“(3.) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.”

26. After section one hundred and twelve of the principal Act the following section shall be added and numbered 112A; namely, Jurisdiction of Lancashire Palatine Court.

“The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade-marks the registration whereof is applied for in the Manchester Office, have the like jurisdiction under this Act as Her Majesty’s High Court of Justice in England, and the expression ‘the Court’ in this Act shall be construed and have effect accordingly.

“Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that Court in other cases.”

27. The principal Act shall, as from the commencement of this Act, take effect subject to the additions, omissions, and substitutions required by this Act, but nothing in this Act shall affect the validity of any act done, right acquired, or liability incurred before the commencement of this Act. Construction of principal Act.

28. This Act shall, except so far as is by this Act otherwise specially provided, commence and come into operation on the first day of January one thousand eight hundred and eighty-nine. Commencement of Act.

29. This Act may be cited as the Patents, Designs, and Trade-Marks Act, 1888, and this Act and the Patents, Designs, and Trade-Marks Acts, 1883 to 1886, may be cited collectively as the Patents, Designs, and Trade-Marks Acts, 1883 to 1888. Short title.

No. 3.

THE TRADE-MARKS REGISTRATION ACTS,
1875—77.

THE TRADE-MARKS REGISTRATION ACT, 1875.

38 & 39 VICT. c. 91.

An Act to establish a Register of Trade-Marks.

[13th August, 1875.]

Be it enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:—

Registration
of trade-
marks.

1. *A Register of trade-marks as defined by this Act, and of the proprietors thereof shall be established under the superintendence of the Commissioners of Patents, and from and after the first day of July one thousand eight hundred and seventy-six a person shall not be entitled to institute any proceeding to prevent the infringement of any trade-mark as defined by this Act until and unless such trade-mark is registered in pursuance of this Act.*

Character-
istics of
registered
trade-mark.

2. *A trade-mark must be registered as belonging to particular goods, or classes of goods; and when registered shall be assigned and transmitted only in connection with the goodwill of the business concerned in such particular goods or classes of goods, and shall be determinable with such goodwill, but subject as aforesaid registration of a trade-mark shall be deemed to be equivalent to public use of such mark.*

Title of first
proprietor of
a trade-mark.

3. *The registration of a person as first proprietor of a trade-mark shall be prima facie evidence of his right to the exclusive use of such trade-mark, and shall, after the expiration of five years from the date of such registration, be conclusive evidence of his right to the exclusive use of such trade-mark, subject to the provisions of this Act as to its connection with the goodwill of a business.*

Title of
proprietor
claiming by
transmitted
proprietor-
ship.

4. *Every proprietor registered in respect to a trade-mark subsequently to the first registered proprietor shall, as respects his title to that trade-mark, stand in the same position as if his title were a continuation of the title of the first registered proprietor.*

5. *If the name of any person who is not for the time being entitled to the exclusive use of a trade-mark in accordance with this Act, or otherwise in accordance with law, is entered on the Register of trade-marks as a proprietor of such trade-mark, or if the Registrar refuses to enter on the Register as proprietor of a trade-mark the name of any person who is for the time being entitled to the exclusive use of such trade-mark in accordance with this Act, or otherwise in accordance with law, or if any mark is registered as a trade-mark which is not authorised to be so registered under this Act, any person aggrieved may apply in the prescribed manner for an order of the Court that the Register may be rectified; and the Court may either refuse such application, or it may, if satisfied of the justice of the case, make an order for the rectification of the Register, and may award damages to the party aggrieved.*

Rectification
of Register.

Where each of several persons claims to be registered as proprietor of the same trade-mark, the Registrar may refuse to comply with the claims of any of such persons until their rights have been determined by the Court, and the Registrar may himself submit or require the claimants to submit in the prescribed manner their rights to the Court.

The Court may, in any proceeding under this section, decide any question as to whether a mark is or is not such a trade-mark as is authorised to be registered under this Act, also any question relating to the right of any person who is party to such proceeding to have his name entered on the Register of trade-marks, or to have the name of some other person removed from such Register, also any other question that it may be necessary or expedient to decide for the rectification of the Register.

The Court may direct an issue to be tried for the decision of any question of fact which may require to be decided for the purposes of this section.

Whenever any order has been made rectifying the Register the Court shall by its order direct that due notice of such rectification be given to the Registrar.

6. *The Registrar shall not, without the special leave of the Court, to be given in the prescribed manner, register in respect of the same goods or classes of goods a trade-mark identical with one which is already registered with respect to such goods or classes of goods, and the Registrar shall not register with respect to the same goods or classes of goods a trade-mark so nearly resembling a trade-mark already on the Register with respect to such goods or classes of goods as to be calculated to deceive.*

Restrictions
on Registry of
trade-marks.

It shall not be lawful to register as part of or in combination with a trade-mark any words the exclusive use of which would not, by reason of their being calculated to deceive or otherwise, be deemed entitled to protection in a Court of Equity; or any scandalous designs.

7. *Subject as aforesaid, a Register office shall be established from and after such time (not being later than the first day of January one thousand eight hundred and seventy-six), in such manner and*

Establish-
ment of
Registry and
general rules.

with such officers, and at such salaries, to be paid out of moneys provided by Parliament, as the Lord Chancellor may, with the consent of the Treasury, direct; and the Lord Chancellor may from time to time, with the assent of the Treasury as to fees, make, and, when made, alter, annul, or vary, such general rules as to the Registry of trade-marks, and as to notices to be given by advertisement before the registration of trade-marks, and as to the classification of goods for the purposes of this Act, and as to the registration of first and subsequent proprietors of trade-marks, and as to the fees to be charged for registration, and also for the continuance of a trade-mark on the Register or otherwise, and as to the removal from the Register of any trade-mark, as to notices, and as to the persons entitled to inspect the Register, and as to any proceedings to be taken to obtain the judgment or leave of the Court in any matter in which the judgment or leave of the Court is required to be obtained under this Act, and generally for the purpose of carrying into effect this Act, as he may deem expedient.

Any rules made in pursuance of this section shall be laid before both Houses of Parliament if Parliament be then sitting, or if not then sitting, then within ten days from the then next assembling of Parliament, and shall be of the same validity as if they had been enacted by Parliament; provided that if either House of Parliament resolve, within one month after such rules have been laid before such House, that any of such rules ought not to continue in force, any rule in respect of which such resolution has been passed shall, after the date of such resolution, cease to be of any force, without prejudice, nevertheless, to the making of any other rule in its place, or to anything done in pursuance of any such rules before the date of such resolution.

Certificate of Registrar to be evidence.

8. The certificate of the Registrar as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be evidence of such entry having been made, and of the contents thereof, and of such matters and things having been done or left undone.

Provision as to Cutlers' Company and Sheffield corporate marks.

9. With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called "the Cutlers' Company"), and the marks or devices (in this Act called "Sheffield corporate marks") assigned or to be assigned by the master, wardens, searchers, and assistants of that company, be it enacted as follows:—

- (1.) Within the prescribed time and in the prescribed manner the Cutlers' Company shall at their own expense deliver to the Registrar under this Act copies of all Sheffield corporate marks in force at the time of such delivery:
- (2.) When any person, after the passing of this Act, applies to the said master, wardens, searchers, and assistants to assign to him any mark or device, notice of such application, with a copy of such mark or device, shall, within the prescribed time and in the prescribed manner, be delivered to the Registrar under this Act; and such mark or device

shall not be assigned until after the expiration of the prescribed period from the giving of such notice. In like manner, when any person applies for the registration under this Act of a trade-mark as belonging to any goods or class of goods specified in section two of the Cutlers' Company's Act of 1860, notice of such application, with a copy of such trade-mark, shall, within the prescribed time and in the prescribed manner, be delivered to the Cutlers' Company; and such trade-mark shall not be registered until after the expiration of the prescribed period from the giving of the last-mentioned notice:

- (3.) Upon the assigning of any such mark or device, or the registration of any such trade-mark as aforesaid, notice of the assignment or registration shall, within the prescribed time and in the prescribed manner, be given to the Registrar under this Act, or to the Cutlers' Company, as the case may be:
- (4.) The Registrar under this Act, without the special leave of the Court, to be given only in cases where the applicant proves his right, shall not in respect of any goods or classes of goods with respect to which a Sheffield corporate mark shall have been assigned and actually used, and of which mark a copy or description or notice of the assigning whereof shall have been delivered or given to the Registrar as aforesaid, register a trade-mark identical with such Sheffield corporate mark, or so nearly resembling the same as to be calculated to deceive:
- (5.) The master, wardens, searchers, and assistants of the Cutlers' Company, shall not assign to any person a mark or device identical with any trade-mark registered under this Act, and notice of the registration whereof shall have been given to the Cutlers' Company as aforesaid, or so nearly resembling the same as to be calculated to deceive:
- (6.) Any person to whom a Sheffield corporate mark legally belongs shall be entitled to have the same mark registered also as a trade-mark under this Act, in respect of any particular goods or classes of goods, in the same manner and upon the same terms and conditions in and upon which he might have registered the same if it were not a Sheffield corporate mark:
- (7.) Nothing in this Act shall prejudice or affect the rights and privileges of the Cutlers' Company, nor, save as otherwise in this Act expressly provided, shall any of the provisions of this Act apply to or in the case of any Sheffield corporate mark.

10. For the purposes of this Act—

A trade-mark consists of one or more of the following essential particulars; that is to say,

Defini-
tions (a).

(a) See sect. 64 of the present Act, ante, p. 650.

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

A written signature or copy of a written signature of an individual or firm; or

A distinctive device, mark, heading, label, or ticket;

and there may be added to any one or more of the said particulars any letters, words, or figures, or combination of letters, words, or figures; also

Any special and distinctive word or words or combination of figures or letters used as a trade-mark before the passing of this Act may be registered as such under this Act.

“Prescribed” means prescribed by general rules made in pursuance of this Act; and

“Court” means any of Her Majesty’s superior courts of law or equity at Westminster, or any Court to which the jurisdiction of such Courts may be transferred, or any one or more of such Courts which may be declared to be the Court for the purposes of this Act by such general rules as aforesaid; but the provisions of this Act conferring a special jurisdiction on the Court as above defined shall not, excepting so far as such jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in causes, actions, suits, or proceedings relating to trade-marks; and if the Register requires to be rectified in consequence of any proceedings in any such Court in Scotland or Ireland, due notice of such requirements shall be given to the Registrar, and he shall rectify the Register accordingly.

Short title of Act.

11. This Act may be cited for all purposes as the Trade-Marks Registration Act, 1875.

THE TRADE-MARKS REGISTRATION AMENDMENT ACT, 1876.

39 & 40 VICT. c. 33.

An Act for the Amendment of the Trade-Marks Registration Act, 1875. [24th July, 1876.]

38 & 39 Vict. c. 91.

Whereas by the Trade-Marks Registration Act, 1875, in this Act referred to as the principal Act, it is provided that from and after the first day of July one thousand eight hundred and seventy-six, a person shall not be entitled to institute any proceeding to prevent the infringement of any trade-mark as defined by the principal Act until and unless such trade-mark is registered in pursuance of that Act:

And whereas by reason of the number of trade-marks, and especially by reason of the difficulties attending the registration of trade-marks in relation to textile fabrics, it has been found impossible to

complete the registration of existing trade-marks within the time specified by the said section; and it is therefore expedient to prolong the time for the completion of such registration as aforesaid, and otherwise to amend the principal Act :

Be it therefore enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :—

1. There shall be repealed so much of section one of the principal Act as provides that from and after the first day of July one thousand eight hundred and seventy-six, a person shall not be entitled to institute any proceeding to prevent the infringement of any trade-mark as defined by that Act until and unless such trade-mark is registered in pursuance of that Act, and in place thereof be it enacted that—

Amendment of s. 1 of the principal Act.

From and after the first day of July one thousand eight hundred and seventy-seven, a person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of any trade-mark as defined by the principal Act until and unless such trade-mark is registered in pursuance of that Act, or until and unless, with respect to any device, mark, name, combination of words, or other matter or thing in use as a trade-mark before the passing of the principal Act, registration thereof as a trade-mark under the principal Act shall have been refused as hereinafter is mentioned.

2. When an application by any person to register as a trade-mark a device, mark, name, word, combination of words, or other matter or thing proposed for registration as a trade-mark, which has been in use as a trade-mark before the passing of the recited Act, has been refused, it shall be the duty of the Registrar, on request, and on payment of the prescribed fee, to give to the applicant a certificate of such refusal, and a certificate so granted shall be conclusive evidence of such refusal.

Saving of marks and devices not capable of being registered under Act.

3. This Act may be cited for all purposes as the Trade-Marks Registration Amendment Act, 1876.

Short title.

THE TRADE-MARKS REGISTRATION EXTENSION ACT, 1877.

40 & 41 VICT. c. 37.

An Act for extending the Time for the Registration of Trade-Marks, in so far as relates to Trade-Marks used in Textile Industries. [6th August, 1877.]

Whereas by section one of the Trade-Marks Registration Amendment Act, 1876, it is provided that from and after the first day of

39 & 40 Vict. c. 33.

38 & 39 Vict.
c. 91.

July one thousand eight hundred and seventy-seven, a person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of any trade-mark as defined by the Trade-Marks Registration Act, 1875 (referred to in such Amendment Act and in this Act as the principal Act), until and unless such trade-mark is registered in pursuance of the principal Act, or until and unless, with respect to any device, mark, name, combination of words, or other matter or thing in use as a trade-mark before the passing of the principal Act, registration thereof as a trade-mark under the principal Act shall have been refused, as is in the said Act thereafter mentioned :

And whereas by reason of the difficulties attending the registration of trade-marks used in the textile industries it has been found impossible to complete the registration of such trade-marks within the time specified by the said section, and it is therefore expedient to prolong such time as aforesaid :

Be it therefore enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :

Extension of
time for regis-
tration of
trade-marks
used in textile
industries.

1. In so far as relates to the registration of trade-marks used in the textile industries, but not further or otherwise, section one of the Trade-Marks Registration Amendment Act, 1876, shall be construed as if for the words "from and after the first day of July one thousand eight hundred and seventy-seven" there were substituted the words "from and after the first day of January one thousand eight hundred and seventy-eight, or such further time as Her Majesty may by Order in Council determine."

Definition of
"trade-marks
used in the
textile in-
dustries."

2. The expression in this Act "Trade-marks used in the textile industries" means the trade-marks relating to goods comprised in Classes 23 to 35, both inclusive, of the First Schedule to the Rules under the Trade-Marks Registration Acts, 1875—76, dated September, 1876.

Short title of
Act.

3. This Act may be cited for all purposes as "The Trade-Marks Registration Extension Act, 1877," and this Act and the Trade-Marks Registration Amendment Act, 1876, and the Trade-Marks Registration Act, 1875, may be cited together as "The Trade-Marks Registration Acts, 1875—77."

No. 4.

TRADE-MARKS RULES, 1890.

(As Amended by the Trade-Marks Rules, 1897 and 1898 (a).)

By virtue of the provisions of the Patents, Designs, and Trade-Marks Acts, 1883 to 1888, the Board of Trade do hereby make the following Rules:—

Preliminary.

1. These Rules may be cited as the Trade-Marks Rules, 1890, and shall come into operation from and immediately after the 31st day of December, 1889.

Interpretation.

2. In the construction of these Rules any words herein used defined by the said Acts shall have the meanings thereby assigned to them respectively. Interpretation.

Fees.

3. The fees to be paid in pursuance of the said Acts, so far as they relate to trade-marks, shall be the fees specified in the First Schedule hereto. Fees.

Forms.

4. The Form F in the First Schedule to the Patents, Designs, and Trade-Marks Act, 1883, shall be altered or amended by the substitution therefor of the Form F in the Second Schedule to these Rules. Forms.

5.—(1) An application for registration of a trade-mark shall be made in the Form F in the Second Schedule to these Rules; (2) the remaining forms in such schedule may be used in all cases to which they are applicable.

Classification of Goods.

6. For the purposes of trade-marks registration and of these Rules goods are classified in the manner appearing in the Third Schedule hereto. Classification of goods.

If any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the Comptroller.

Application for Registration.

7. An application for registration of a trade-mark, if made by any firm or partnership, may be signed by some one or more members of such firm or partnership, as the case may be. Application by firm.

If the application be made by a body corporate it may be

(a) The repealed Rules are printed in italics, and the substituted Rules in square brackets, the amending Rules being referred to in the margin.

signed by the secretary or other principal officer of such body corporate.

Address of application.

8. Where a trade-mark for registration of which application is made is in Classes 23, 24 or 25 of the Third Schedule to these Rules, the applicant shall address and send his application to the Manchester Trade-Marks Branch, 48, Royal Exchange, Manchester. Other applications (except applications which under section 81 of the said Acts should be made to the Cutlers' Company) shall be addressed and sent to the Patent Office, Trade-Marks Branch, 25, Southampton Buildings, Chancery Lane, London, W.C.

Agency.

9. *An application for registration and all other communications between the applicant and the Comptroller may be made by or through an agent duly authorised to the satisfaction of the Comptroller.*

Rule 2 of 1898 (a).

[An application for registration and all other communications between the applicant and the Comptroller may be made by or through an agent duly authorised to the satisfaction of the Comptroller, but the Comptroller shall not be bound to recognise as such agent, or to receive further communications from, any person whose name, by reason of his having been adjudged guilty of disgraceful professional conduct, has been erased from the Register of Patent Agents kept under the provisions of the Patents, Designs, and Trade Marks Act, 1888, relating to the registration of patent agents, and not since restored.]

Acknowledgment of application.

10. On receipt of the application the Comptroller shall furnish the applicant with an acknowledgment thereof.

Contents of form of application.

11. Where application is made to register a trade-mark which was used by the applicant or his predecessors in business before the 13th of August, 1875, the application shall contain a statement of the time during which and of the person by whom it has been so used in respect of the goods mentioned in the application (b).

Size, &c. of documents.

12. Subject to any other directions that may be given by the Comptroller, all applications, notices, counter-statements, representations of marks, papers having representations affixed, or other documents required by the said Acts or by these Rules to be left with or sent to the Comptroller or to the Cutlers' Company, shall be upon foolscap paper of a size of 13 inches by 8 inches, and shall have on the left-hand part thereof a margin of not less than one inch and a half.

(a) Rule 1 is as follows:—"These Rules may be cited as the Trade Marks Rules, 1898, and shall come into operation from and immediately after the date hereof" (September 15th, 1898).

(b) Where the user claimed has been by a firm, it is not necessary to state the names of the persons who were from time to time members of the firm, nor to insert the words "and their predecessors in business for the time being." (*Wright, Crossley & Co.'s Application*, (1900) 2 Ch. 218; 17 R. P. C. 386, Byrne, J.) Stirling, J., had previously held (*Bryant & May's Tm.*, 17 R. P. C. at p. 396) a statement of user by the applicants or their predecessors in title to be sufficient.

13. Subject to any other directions that may be given by the Comptroller, three representations of each trade-mark, except in the case of marks applied for in Classes 23 to 35 inclusive, must be supplied upon paper of the size aforesaid, and must be of a durable nature. One of such representations must be made upon or affixed to the form of application, the others upon separate half-sheets. In the case of trade-marks exceeding the limits of the foolscap paper of the size aforesaid, such marks may be pasted and folded upon the sheets of foolscap.

Representations of trade-mark.

In the case of marks applied for in Classes 23 to 35 inclusive, the applicant shall supply four representations of each mark for each class.

Where a drawing or other representation or specimen cannot be given in manner aforesaid, a specimen or copy of the trade-mark may be sent either of full size or on a reduced scale, and in such form as the Comptroller may think most convenient.

The Comptroller may, if dissatisfied with the representation of a trade-mark, require a fresh representation, either before he proceeds with the application or before he registers the trade-mark.

The Comptroller may also, in exceptional cases, deposit in the Patent Office a specimen or copy of any trade-mark which cannot conveniently be shown by a representation, and may refer thereto in the Register in such manner as he may think fit.

[13. Every application for registration of a trade-mark shall contain a representation of the mark affixed to it in the square which the Form F contains for that purpose.

Substituted by Rule 2 of 1897 (c).

Where the representation exceeds such square in size the representation shall be mounted upon linen, tracing cloth or other material that the Comptroller may consider suitable. Part of the mounting shall be affixed in the space aforesaid, and the rest may be folded over.

With every application for registration sent to the Manchester Trade Marks Branch, there shall be supplied four additional representations of each mark on the Form G, exactly corresponding with that on the application Form F, and noted with all such particulars as may from time to time be required by the Comptroller or by the Keeper of Cotton Marks at Manchester. Such particulars shall, if required, be signed by the applicant or his agent.

In the case of marks applied for in any of the Classes 5, 6, 7, 11, 12, 13, 14, 22, 26, 27, 28, 29, 30, 31, 32, 33, 34 and 35, there shall be sent with the application four additional representations of each mark on the Form G, exactly corresponding with that affixed to the application in Form F, and noted with all such particulars as may from time to time be required by the Comptroller. Such particulars shall, if required, be signed by the applicant or his agent.

(c) Rule 1 is as follows:—"These Rules may be cited as the Trade Mark Rules, 1897, and shall come into operation from and immediately after the date hereof" (December 31st, 1897).

In the case of marks applied for in any other class there shall be sent with the application three additional representations of each mark on the Form G, exactly corresponding to that affixed to the application Form F, and noted with all such particulars as may from time to time be required by the Comptroller. Such particulars shall, if required, be signed by the applicant or his agent.

All representations of marks must be of a durable nature, but the applicant may in case of need supply in place of representations on the Form G, half-sheets of strong foolscap of the size aforesaid with the representations affixed thereon and noted as aforesaid.

Applications for the registration of the same mark in different classes shall be treated as separate and distinct applications.

The Comptroller, if dissatisfied with any representation of a mark, may at any time require another representation satisfactory to him to be substituted before proceeding with the application.

Where a drawing or other representation or specimen cannot be given in manner aforesaid, a specimen or copy of the trade-mark may be sent either of full size or on a reduced scale, and in such form as the Comptroller may think most convenient.

The Comptroller may also, in exceptional cases, deposit in the Patent Office a specimen or copy of any trade-mark which cannot conveniently be shown by a representation, and may refer thereto in the Register in such manner as he may think fit.]

Representations of a series of trade-marks.

14. When an application relates to a series of trade-marks differing from one another in respect of the particulars mentioned in section 66 of the said Acts, a representation of each trade-mark of the series shall be made or affixed upon the form of application and also upon each of the separate half-sheets of paper aforesaid.

Substituted by Rule 2 of 1897 (d).

[14. When application is made for the registration of a series of trade-marks under section 66 of the Patents, Designs, and Trade Marks Act, 1883, a representation of each trade-mark of the series shall be affixed, as aforesaid, to the application upon Form F, and to each of the accompanying Forms G.]

Translation of foreign characters.

15. Wherever a mark consists of or includes words printed in other than Roman character, there shall be given at the foot or on the back of each representation a translation of such words, signed by the applicant or his agent.

Substituted by Rule 2 of 1897 (d).

[15. When a trade-mark contains a word or words in other than Roman characters, there shall be endorsed on the application in Form F, and on each of the accompanying representations in Form G, a sufficient transliteration and translation to the satisfaction of the Comptroller of each of such words, and every such endorsement shall be signed by the applicant or his agent.

Where a trade-mark contains a word or words in a language other than English, the Comptroller may ask for an exact trans-

(d) See note (c) above.

lation thereof, and if he so requires such translation shall be endorsed and signed as aforesaid.]

16. Any application, statement, notice, or other document authorized or required to be left, made, or given at the Patent Office, or to the Comptroller, or to any other person under these Rules, may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post. Mode of sending notices, &c.

In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

Exercise of Discretionary Powers.

17. Before exercising any discretionary power given to the Comptroller by the said Acts adversely to the applicant for registration of a trade-mark, the Comptroller shall (if so required by the applicant within one month from the date of the Comptroller's objection) give the applicant an opportunity of being heard personally or by his agent by sending the applicant ten days' notice of a time when he may be so heard. Hearing by Comptroller.

18. Within five days from the date when such notice would be delivered in the ordinary course of post, the applicant shall notify to the Comptroller whether or not he intends to be heard upon the matter. Notice of wish to be heard before Comptroller.

19. The decision of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified to the applicant. Notification of decision.

Appeal to the Board of Trade.

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

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

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

23. The Board of Trade may thereupon give such directions (if any) as they may think fit with respect to evidence, or otherwise, for the purpose of the hearing of the appeal by the Board of Trade, or for the purpose of their referring the appeal to the Court to hear and determine the same. Directions by Board.

Hearing of appeal.

24. Where the Board of Trade intend to hear the appeal, seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing, shall be given to the Comptroller and to the appellant, and where there has been an opposition before the Comptroller, to the opponent or applicant, as the case may be.

No appeal unless notice duly given.

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

Evidence on appeal.

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

Advertisement of Application.

Advertisement of application.

27. Every application shall be advertised by the Comptroller in the official paper, during such times and in such manner as the Comptroller may direct, unless he refuse to entertain the application.

If no representation of the trade-mark be inserted in the official paper in connection with the advertisement of an application, the Comptroller shall refer in such advertisement to the place or places where a specimen or representation of the trade-mark is deposited for exhibition.

Definition of official paper.

28. The official paper for the purposes of these Rules shall be some paper published under the direction of the Board of Trade, or such other paper as such Board may from time to time direct.

Means of advertising trade-mark to be supplied to official paper.

29. For the purposes of such advertisement the applicant may be required to furnish a wood block or electrotype (or more than one, if necessary) of the trade-mark, of such dimensions as may from time to time be directed by the Comptroller, or with such other information or means of advertising the trade-mark as may be required by the Comptroller; and the Comptroller, if dissatisfied with the block or electrotype furnished by the applicant or his agent, may require a fresh block or electrotype before proceeding with the advertisement.

Advertisement of series.

30. When an application relates to a series of trade-marks differing from one another in respect of the particulars mentioned in section 66 of the said Acts, the applicant may be required to furnish a wood block or electrotype (or more than one, if necessary) of any or of each of the trade-marks constituting the series; and the Comptroller may, if he thinks fit, insert with the advertisement of the application a statement of the manner in respect of which the several trade-marks differ from one another.

Opposition to Registration.

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

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

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

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

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

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

(7.) On the completion of the evidence the Comptroller shall, upon application by either party, upon Form E in the Second Schedule to these Rules, and upon payment of the prescribed fee, appoint a time for the hearing of the case, and shall give the parties at least seven days' notice of such appointment. Applications for leave to adduce further evidence.

(8.) On the hearing of the case no opposition shall be allowed in respect of any ground not stated in the notice of opposition, Appointment of time for hearing.

* The counter-statement required by the Acts must also be delivered by the applicant within one month from the date of the receipt of the opponent's notice of opposition. Disallowance of opposition in certain cases.

and where the ground or one of the grounds of opposition is that registration is being applied for in respect of a trade-mark identical with one already on the Register with respect to the same goods or description of goods, or having such resemblance to a trade-mark already on the Register with respect to such goods or description of goods as to be calculated to deceive, the opposition shall not be allowed upon such ground, unless the date of registration and the number on the Register of the said trade-mark already on the Register have been duly specified in the notice of opposition.

Decision to be notified to parties.

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

Register of Trade-Marks.

Time of registration of trade-marks.

32. As soon as may be after the expiration of one month from the date of the advertisement of the application, the Comptroller shall, subject to opposition to the application and the determination thereof, if he is satisfied that the applicant is entitled to registration, and on payment of the prescribed fee, enter the name, address, and description of the applicant in the Register of Trade-Marks as the registered proprietor of the trade-mark in respect of the particular goods or classes of goods described in his application.

Where applicant dies before registration, the trade-mark may be registered for successor to goodwill of business.

33. In case of the death of any applicant for a trade-mark after the date of his application, and before the trade-mark applied for has been entered on the Register, the Comptroller, after the expiration of the prescribed period of advertisement, may, on being satisfied of the applicant's death, enter on the Register, in place of the name of such deceased applicant, the name, address, and description of the person owning the goodwill of the business, if such ownership be proved to the satisfaction of the Comptroller.

Entries to be made in Register.

34. Upon registering any trade-mark the Comptroller shall enter in the Register the date on which the application for registration was received by the Comptroller, and such other particulars as he may think necessary.

Notice of registration.

35. The Comptroller shall send notice to the applicant of the registration of his trade-mark, together with a reference to the advertisement of such trade-mark in the official paper.

Request by subsequent proprietor.

36. Where a person becomes entitled to a registered trade-mark by assignment, transmission, or other operation of law, a request for the entry of his name in the Register as proprietor of the trade-mark shall be addressed to the Comptroller, and left at the Patent Office, Trade-Marks Branch.

Signature of request.

37. Such request shall in the case of an individual be made and signed by the person requiring to be registered as proprietor, and in the case of a firm or partnership by some one or

more members of such firm or partnership, or in either case by his or their agent respectively duly authorized to the satisfaction of the Comptroller, and in the case of a body corporate by their agent, authorized in like manner.

38. Every such request shall state the name, address, and description of the person claiming to be entitled to the trade-mark (hereinafter called the claimant), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the Register as proprietor, so as to show the manner in which, and the person or persons to whom, the trade-mark has been assigned or transmitted, and so as to show further that it has been so assigned or transmitted in connection with the goodwill of the business concerned in the particular goods or classes of goods for which the trade-mark has been registered.

Contents of request.

39. Every such request shall be accompanied by a statutory declaration to be thereunder written, verifying the several statements therein, and declaring that the particulars above described comprise every material fact and document affecting the proprietorship of the trade-mark as claimed by such request.

Declaration to accompany request.

40. The claimant shall furnish to the Comptroller such other proof of title and of the existence and ownership of such goodwill as aforesaid as he may require for his satisfaction.

Further proof of title if required.

41. A body corporate may be registered as proprietor by its corporate name.

Body corporate.

42. The term "applicant" in Rules 17, 18 and 19 shall include each of several persons claiming to be registered as proprietor of the same trade-mark.

Definition of applicant.

43. Whether all such persons so claiming require to be heard before the Comptroller or not, he may, before exercising the discretion vested in him by section 71 of the said Acts, require such persons, or any or either of them, to submit a statement in writing within a time to be notified by him, or to attend before him and make oral explanations with respect to such matters as the Comptroller may require.

Comptroller may require statement from rival claimants.

44. Where each of several persons claims to be registered as proprietor of the same trade-mark, and the Comptroller refuses to register any of them until their rights have been determined according to law, the manner in which the rights of such claimants may be submitted to the Court by the Comptroller, or if the Comptroller so require, by the claimants, shall, unless the Court otherwise order, be by a special case; and such special case shall be filed and proceeded with in like manner as any other special case submitted to the Court, or in such other manner as the Court may direct.

Submission to Court of conflicting claims.

45. Where the special case is to be submitted by the parties it may be agreed to by them, or if they differ, may be settled by the Comptroller, on payment of the prescribed fees.

Settlement of special case.

Order of Court.

46. Where an order has been made by the Court in either of the following cases, viz. :—

- (a) allowing an appeal under section 62 of the said Acts ;
- (b) disallowing an opposition to registration under section 69 ;
- or,
- (c) under the provisions of sections 72, 90 or 92 of the said Acts,

the person in whose favour such order has been made, or such one of them, if more than one, as the Comptroller may direct, shall forthwith leave at the Patent Office, Trade-Marks Branch, an office copy of such order. The Register shall thereupon be rectified or altered, or the purport of such order shall otherwise be duly entered in the Register, as the case may be.

Removal of mark from Register.

47. Where a trade-mark has been removed from the Register for non-payment of the prescribed fee or otherwise, under the provisions of section 79 of the said Acts, the Comptroller shall cause to be entered in the Register a record of such removal and the cause thereof.

Alteration of address in Register.

48. If the registered proprietor of a trade-mark send to the Comptroller, together with the prescribed fee, notice of an alteration in his address, the Comptroller shall alter the Register accordingly.

Notice to Comptroller of applications to rectify Register.

49. Four clear days' notice of every application to the Court under section 90 of the said Acts, for rectification of the Register, shall be given to the Comptroller.

Publication of rectification or variation of Register.

50. Whenever an order is made by the Court for making, expunging, or varying an entry from or in the Register, the Comptroller shall, if he thinks that such rectification or variation should be made public, and at the expense of the person applying for the same, publish, by advertisement or otherwise, and in such manner as he thinks just, the circumstances attending the rectification or variation in the Register.

Notice to Comptroller of order of Court for alteration of trade-mark under section 92 of Acts.

51. Whenever the registered proprietor of any trade-mark intends to apply for the leave of the Court to add to or to alter such trade-mark, under section 92 of the said Acts, the notice to be given to the Comptroller shall be given fourteen days at least before such application. If leave be granted on such application the applicant shall forthwith supply to the Comptroller such a number of representations of the trade-mark as altered as he may deem sufficient.

Inspection of Register.

Hours of inspection.

52. The Register of Trade-Marks shall be open to the inspection of the public, on payment of the prescribed fee, on every week day, between the hours of ten and four, except on the days and at the times following :—

- (a) Christmas Day, Good Friday, the day observed as Her Majesty's Birthday, days observed as days of public fast

- or thanksgiving, and days observed as holidays at the Bank of England; or
- (b) Days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office;
 - (c) Times when the Register is required for any purpose of official use.

Power to Dispense with Evidence.

53. Where under these Rules any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the Comptroller, or at the Patent Office, and it is shown to the satisfaction of the Comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Comptroller, with the sanction of the Board of Trade, and upon the production of such other evidence, and subject to such terms as they may think fit, to dispense with any such act or thing, document, declaration, or evidence. Dispensing with evidence.

Amendments.

54. Any document or drawing or other representation of a trade-mark for the amending of which no special provision is made by the said Acts may be amended, and any irregularity in procedure which in the opinion of the Comptroller may be obviated without detriment to the interests of any person may be corrected, if the Comptroller think fit, and on such terms as he may direct. Amendment of documents.

Enlargement of Time.

55. The time prescribed by these Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the Comptroller, if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms as he may direct. Comptroller may enlarge time.

Cutlers' Company.

56. All applications to the Cutlers' Company for registration of a trade-mark, under section 81 of the said Acts, shall be in duplicate, accompanied by the prescribed fees and representations. Sheffield applications in duplicate.

57. The Cutlers' Company shall, within seven days of the receipt by them of an application to register a trade-mark, send the Comptroller one copy of such application, by way of notice thereof, together with two representations of the mark for each class for which the applicant seeks registration. Notice to Comptroller.

Time within which Comptroller may object to application made at Sheffield.

Advertisement of application made at Sheffield.

Manner of notifying to Cutlers' Company application received by Comptroller.

Similarity of proceedings at London and at Sheffield.

58.—(1.) The time within which the Comptroller shall give notice to the Cutlers' Company of any objection he may have to the acceptance of an application for registration made to the said company shall be one month from the date of the receipt by the Comptroller of the notice from the said company of the making of the application.

(2.) If no such objection is made by the Comptroller, the Cutlers' Company shall require the applicant to send the Comptroller a wood block or electrotype as the Comptroller may direct, and the Comptroller shall, if satisfied with such wood block or electrotype, advertise the application in the same manner as an application made to him at the Patent Office.

(3.) The manner in which the Comptroller shall notify to the Cutlers' Company an application and proceedings thereon made as mentioned in sub-section 8 of section 81 of the said Acts shall be by sending to the Cutlers' Company a copy of the official paper containing the application of which notice is required to be given, with a note distinguishing such application.

59. The provisions of these Rules as to forms, representations, the proceedings on opposition to registration, registration, and all subsequent proceedings shall, as far as the circumstances allow, apply to all applications to register made to the Cutlers' Company, and to all proceedings consequent thereon.

Certificates.

Certificate by Comptroller.

60. The Comptroller, when required to give a certificate as to any entry, matter, or thing which he is authorized by the said Acts or any of these Rules to make or do, may, on receipt of a request in writing, and on payment of the prescribed fee, give such certificate; but every certificate of registration shall have specified on the face thereof whether the same is to be used in legal proceedings or for the purpose of obtaining registration in a foreign country, or for purposes other than use in legal proceedings or obtaining registration in a foreign country.

Declarations.

Manner in which, and persons before whom, declaration is to be taken.

61. The statutory declarations required by the said Acts and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows:—

- (a) In the United Kingdom, before any justice of the peace, or any commissioner or other officer authorized by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding;
- (b) In any other part of Her Majesty's dominions, before any court, judge, justice of the peace, or any officer authorized by law to administer an oath there for the purpose of a legal proceeding; and

(c) If made out of Her Majesty's dominions, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice-Consul, or other person exercising the functions of a British Consul, or a notary public, or before a judge or magistrate.

62. Any document purporting to have affixed, impressed, or subscribed thereto or thereon the seal or signature of any person hereby authorized to take such declaration in testimony of such declaration having been made and subscribed before him, may be admitted by the Comptroller without proof of the genuineness of any such seal or signature, or of the official character of such person or his authority to take such declaration. Notice of seal of officer taking declaration to prove itself.

Repeal.

63. All general rules as to the registration of trade-marks heretofore made by the Board of Trade under the Patents, Designs, and Trade-Marks Acts, 1883 to 1888, and in force on the 31st day of December, 1889, shall be, and they are hereby repealed, as from that date, without prejudice, nevertheless, to anything done under such rules, or to any application pending at the said date. Previous rules repealed.

M. E. HICKS-BEACH,
President of the Board of Trade.

SCHEDULES.

FIRST SCHEDULE.

FEEES.

	£	s.	d.
1. On application to register a trade-mark for one or more articles included in one class	0	5	0
2. For registration of a trade-mark for one or more articles included in one class	1	0	0
3. For registering a series of trade-marks, for every additional representation after the first in each class	0	5	0
4. On appeal from Comptroller to Board of Trade—by appellant	1	0	0
5. On notice of opposition for each application opposed—by opponent	1	0	0
6. On hearing by Comptroller—by applicant and by opponent, respectively	1	0	0
7. On application to register a subsequent proprietor in cases of assignment or transmission, the first mark	1	0	0
8. For every additional mark assigned or transmitted at the same time	0	2	0
9. For continuance of mark at expiration of 14 years	1	0	0
10. Additional fee where fee is paid within three months after expiration of 14 years	0	10	0
11. Additional fee for restoration of trade-mark where removed for non-payment of fee	1	0	0

	£	s.	d.
12. For altering address on the Register, for every mark	0	5	0
13. For every entry in the Register of a rectification thereof or an alteration therein, not otherwise charged	0	10	0
14. For cancelling the entry or part of the entry of a trade-mark upon the Register, on the application of the owner of such trade-mark	0	5	0
15. On request to Comptroller to correct a clerical error, or permit amendment of application under section 91	0	5	0
16. For certificate of refusal to register a trade-mark under section 77	1	0	0
17. For certificate of refusal at the same time for more than one trade-mark, for each additional trade-mark after the first..	0	10	0
18. For certificate of registration to be used in legal proceedings..	1	0	0
19. For certificate of registration to be used for the purpose of obtaining registration in foreign countries	0	5	0
20. For certificate of Comptroller under section 96, other than certificate of registration to be used in legal proceedings, or for the purpose of obtaining registration in a foreign country..	0	5	0
21. For copy of notification of registration	0	2	0
22. Settling a special case by Comptroller.....	2	0	0
23. For inspecting Register, for every quarter of an hour	0	1	0
24. For making a search amongst the classified representations of trade-marks, for every quarter of an hour.....	0	1	0
25. For office copy of documents, for every 100 words (but never less than one shilling).....	0	0	4
26. For certifying office copies, MS. or printed	0	1	0
27. In cases where the wood block or electrotype of the trade-mark exceeds 2 inches in breadth or depth, or in breadth and depth—for every inch or part of an inch over 2 inches in breadth	0	2	0
For every inch or part of an inch over 2 inches in depth	0	2	0
28. Manchester Trade-Marks Office	Same as above		
29. Sheffield Marks.....	Same as above		
30. On appeal from Cutlers' Company, Sheffield, to Comptroller..	1	0	0

M. E. HICKS-BEACH,
President of the Board of Trade.

Approved,

FRANK MOWATT,
*Assistant Secretary for the
Lords Commissioners of Her Majesty's Treasury.*

SECOND SCHEDULE.

FORMS.

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PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.)

Form E.

Form of Application for Hearing by the Comptroller.

In Cases of Opposition, &c.

SIR,
of (a) hereby apply to be heard in reference to
and request that I may receive due notice of the day fixed for the
hearing.

Sir, your obedient Servant,
_____.

*To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.*

(a) Here insert full address.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.
(TRADE-MARKS.) Form F.

Application for Registration of Trade-Mark.

One representation to be fixed within this square, and two (a) others to be sent on separate half-sheets of foolscap.

Representations of a larger size may be folded, but must be mounted upon linen and affixed thereto.

(a) See now Rule 13 substituted by Rules of 1897, p. 693, above.

You are hereby requested to register the accompanying Trade Mark in Class _____, in respect of (a) _____ in the name of (b) _____ who claims to be the proprietor thereof (c).

The essential particulars of the Trade-Mark are the following (d) and _____ disclaim any right to the exclusive use of the added matter.

(Signed) _____ (e).

Dated the _____ day of _____, 18 _____.

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

[Or where the application is for a mark in Classes 23, 24 or 25]

To the Comptroller, Manchester Trade-Marks Branch,
48, Royal Exchange, Manchester.

NOTE.—If the Trade-Mark has been in use in respect of the goods since before August 13th, 1875, state length of such user.*

(a) Only goods contained in one and the same class should be set out here. A separate application form is required for each separate class.

(b) Here insert legibly the full name, address, and description of the individual firm or company. Add trading style (if any).

(c) Alter to "claim to be the proprietors thereof" in the case of a firm or company.

(d) See sub-sections (2) and (3) of section 64 of the Acts.

(e) To be signed by the applicant or by an agent duly authorized.

* As to the form of a claim of user by a firm, see *Wright, Crossley & Co.'s Application*, (1900) 2 Ch. 218; 17 R. P. C. 386.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

Form G.

Additional Representation of Trade-Mark, to accompany Application for Registration.

One representation of the Trade-Mark to be affixed within this square.

It must correspond *exactly*, in all respects, with the representation affixed to the Application Form.

Any representation of a larger size than foolscap may be folded, but must then be mounted upon linen and affixed thereto.

Two of these ADDITIONAL REPRESENTATIONS of the Trade-Mark must accompany *each* Form of Application (a).

In the case of a Trade-Mark claimed in one of the CLASSES 23 to 35, THREE of these ADDITIONAL REPRESENTATIONS of the Mark must accompany the Form of Application (a).

(a) See now the new Rule 13 substituted by the Rules of 1897, p. 693, above.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.)

Form H.

Form of Appeal from the Comptroller to the Board of Trade.

I, (a) of (a) hereby give notice of my intention to appeal to the Board of Trade from (b) of the Comptroller of the day of 18 , whereby he (c) .

Accompanying this notice is a statement of my case for the decision of the Board of Trade.

(Signed) _____.

Dated day of 18 .

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London, and to
[Name of Respondent to Appeal].

(a) Here insert full name and address of appellant.

(b) Here insert "the decision" or "that part of the decision," as the case may be.

(c) Here insert the decision complained of.

Appendix—No. 4.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.)

Form I.

Fee for Registration of a Trade-Mark.

SIR,

In reply to your request I hereby transmit the prescribed fee for the registration of the Trade-Mark No. _____ in Class _____.

I am, Sir, your obedient Servant,
_____.

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.)

Form J.

Notice of Opposition to Application for Registration.

[To be accompanied by an unstamped duplicate.]

In the matter of an application, No. _____ by _____ of _____
I, (a) _____ hereby give notice of my intention to oppose the registration
of the Trade-Mark advertised under the above number for Class _____ in the
Trade-Marks Journal of the _____ day of _____ 18____, No. _____, page _____.

The grounds of opposition are as follows:— (b)

(Signed) _____.

Dated the _____ day of _____ 18____.

Address for service:—

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

(a) Here state full name and full address.

(b) See pp. 85 and 735.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.)

Form K.

Request to Enter Name of Subsequent Proprietor of Trade-Mark upon the Register, with Declaration in support thereof.

I, (a) _____ hereby request that you will enter (b) _____ name (c) in the Register of Trade-Marks as proprietor _____ of the Trade-Mark No. _____ in Class _____.

(d) _____ entitled to the said Trade-Mark and to the goodwill of the business concerned in the goods with respect to which the said Trade-Mark is registered.

(e) _____
And I do solemnly and sincerely declare that the above several statements are true, and the particulars above set out comprise every material fact and document affecting the proprietorship of the said Trade-Mark as above claimed.

(f) And I make this solemn declaration conscientiously believing the

same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835. (g) ———.

Declared at this day of }
18 . }
Before me,
(h) ———.

*To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.*

- (a) Or we. Here insert name, full address, and description.
- (b) My or our.
- (c) Or names.
- (d) I am, or we are.
- (e) Here state whether Trade-Mark transmitted by death, marriage, bankruptcy, or other operation of law, and if entitled by assignment state the particulars thereof, as *c.g.*, "by deed dated the day of 18 , made between So-and-So of the one part."
- (f) This paragraph is not required when the declaration is made out of the United Kingdom.
- (g) To be signed here by the person making the declaration.
- (h) Signature and title of the authority before whom the declaration is made.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form L.

Request for Certificate of Refusal to Register a Trade-Mark in use before 13th August, 1875.

In the matter of an application for registration of an old Trade-Mark, No. in Class .

SIR,
I, , of , the applicant in the above matter, hereby request you to furnish me with your Certificate of Refusal to Register the said Trade-Mark.

Dated this day of , 18 . (a) ———.
*To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.*

(a) Signature of applicant.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form M.

Notice of Application for Alteration of Address on Register of Trade-Marks.

In the matter of the Trade-Mark, No. registered in Class .

SIR,
NOTICE is hereby given that I , of , the registered proprietor of the Trade-Mark numbered as above, desire that my address on the Register of Trade-Marks be altered to

Dated this day of , 18 . (a) ———.
*To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.*

(a) Signature of proprietor.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form N.

*Notice of Order of Court for Alteration or Rectification of Register of Trade-Marks.*In the matter of the Trade-Mark, No. _____, registered in
Class _____, in the name of _____

SIR,

NOTICE is hereby given that by an Order of the Court made on the day of _____, 18____, it was directed that the entry on the Register of Trade-Marks in respect of the Trade-Mark numbered as above should be rectified in the manner therein specified.

An office copy of the Order of the Court is enclosed herewith.

Dated this _____ day of _____, 18____.

(a) _____.

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

(a) To be signed by the person interested or his agent.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form O.

Form of Application by Proprietor of Registered Trade-Mark to Cancel Entry on Register.

Trade-Mark No. _____, Class _____, advertised in Trade-Marks Journal No. _____, page _____.

Name of registered proprietor or firm _____, place of business _____.
I, the undersigned, _____ of _____, [or I, the undersigned, _____, a member of the firm of _____, of _____, on behalf of my said firm] apply that the entry upon the Register of the Trade-Marks in Class _____ of the Trade-Mark No. _____ may be cancelled.

The _____ day of _____, 18____.

(Signed) _____.

This is the statement marked "O" referred to in the Declaration of _____, made before me the _____ of _____, 18____.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

Form P.

Form of Declaration in support of Application for Cancellation of Trade-Mark by Owner.

I, _____, of _____; [or I, _____, a member of the firm of _____, of _____], do hereby solemnly and sincerely declare, to the best of my knowledge and belief, as follows:—

(1) The application signed by me, and dated the _____ day of _____, 18____, and marked with the letter "O," and shown to me at the time of making this Declaration, is true.

(2) I am the person whose name appears on the Register of Trade-Marks as the proprietor of the Trade-Mark referred to in the said application marked with the letter "O."

[or My said firm is the firm whose name appears on the Register of Trade-Marks as the proprietor of the Trade-Mark referred to in the said application marked with the letter "O."]

And I make this solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

(Signed) _____.

Declared at _____, this _____ day of _____, 18 ____ . }
 Before me _____ . }

If the declaration be made before a Commissioner to administer oaths it will require to be stamped with a 2s. 6d. impressed Inland Revenue stamp.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form Q.

Form of Request for Correction of Clerical Error or for Permission to amend Application under Section 91.

SIR,

I HEREBY request that _____ .

*To the Comptroller, Patent Office, Trade-Marks Branch,
 25, Southampton Buildings, London.*

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form R.

Request for Certificate of Registration of Trade-Mark for use in obtaining Registration Abroad.

In the matter of the Trade-Mark, No. _____, registered in Class _____, in the name of _____ .

SIR,

I, _____ of _____, the registered proprietor of the above Trade-Mark, hereby request you to furnish me with your Certificate of Registration for use in obtaining registration of the same in (a) _____ .

(b) _____ .

Dated this _____ day of _____, 18 ____ .

*To the Comptroller, Patent Office, Trade-Marks Branch,
 25, Southampton Buildings, London.*

- (a) Here state name of country in which registration is to be sought.
- (b) Signature.

Appendix—No. 4.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.
 (TRADE-MARKS.) Form S.
*Request for Certificate of Registration of Trade-Mark to be used in
 Legal Proceedings.*

In the matter of the Trade-Mark, No. _____, registered in
 Class _____, in the name of _____.

SIR,
 I, _____, of _____, the registered proprietor of the above Trade-Mark,
 hereby request you to furnish me with your Certificate of Registration to be
 used in legal proceedings.

Dated this _____ day of _____, 18 _____. (a) _____.
 To the Comptroller, Patent Office, Trade-Marks Branch,
 25, Southampton Buildings, London.

(a) Signature.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.
 (TRADE-MARKS.) Form T.
*Application for Settlement of a Special Case on Application to
 Register a Trade-Mark.*

In the matter of the application of _____ and of the application
 of _____.

SIR,
 NOTICE is hereby given that I, _____ of _____, and I, _____ of _____,
 are unable to agree upon the facts on which the opinion of the Court is to
 be taken, and that we request you to fix a day on which we may attend
 before you and obtain your finding on the matters of fact to be submitted to
 the Court as settled.

Dated this _____ day of _____, 18 _____. (a) _____.
 To the Comptroller, Patent Office, Trade-Marks Branch,
 25, Southampton Buildings, London.

(a) To be signed by both parties.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.
 (TRADE-MARKS.) Form T 1.
*Request for General Certificate of Comptroller (other than Certi-
 ficate for use in Legal Proceedings or for use in obtaining
 Registration Abroad).*

In the matter of the Trade Mark No. _____, in Class _____.

SIR,
 I, _____, of _____, hereby request you to furnish me with your certificate,
 that (a) _____.

Dated this _____ day of _____, 18 _____. (b) _____.
 To the Comptroller, Patent Office, Trade-Marks Branch,
 25, Southampton Buildings, London.

(a) Here set out the particulars which the Comptroller is requested to
 certify.

(b) Signature.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form U.

General Certificate of Comptroller (other than Certificate for use in Legal Proceedings or for use in obtaining Registration Abroad).

Patent Office, Trade-Marks Branch,
London, 18 .

I, _____, Comptroller-General of Patents, Designs, and Trade-Marks,
hereby certify

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form V.

Request for Copy of Official Notification of Registration of Trade-Mark.

In the matter of the Trade-Mark, No. _____, registered in Class _____.

SIR,
I, _____ of _____, the registered proprietor of the Trade-Mark above named,
hereby request that you will furnish me with a copy of the official notification of the registration of the same.

(a) _____.

Dated this _____ day of _____ 18 .

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

(a) Signature.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form W.

Form of Appeal from Cutlers' Company at Sheffield to Comptroller.

[To be accompanied by an unstamped duplicate.]

SIR,
I HEREBY give notice of appeal against the decision of the Cutlers' Company of Sheffield in regard to my application for registration of a Trade-Mark No. _____ in Class _____ for _____ and I beg to submit my case (a) for your decision accordingly.

(b) _____.

Dated this _____ day of _____ 18 .

To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

(a) The statement of the case to be written upon foolscap paper (on one side only), with a margin of two inches on the left-hand side thereof.

(b) Signature.

Appendix—No. 4.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form X.

Continuance of Mark at Expiration of Fourteen Years from the date of Registration.

SIR,

In pursuance of the notice received from you, I hereby transmit the prescribed fee of 1*l.* for continuance on the Trade-Marks Register of the Trade-Mark No. in Class .

Dated the day of 18 .

(a) ———.

*To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.*

(a) Signature of proprietor.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form Y.

*Additional Fee of 10*s.* to accompany "Continuance Fee" (Form X) within Three Months after Expiration of Fourteen Years.*

SIR,

In pursuance of the notices issued by you, and of the provisions of sect. 79 (3) of the above Acts, I hereby transmit the additional fee of 10*s.* (along with Form X) for the continuance on the Trade-Marks Register of the Trade-Mark No. in Class .

Dated the day of 18 .

(a) ———.

*To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.*

(a) Signature of proprietor.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

(TRADE-MARKS.) Form Z.

*Restoration of Trade-Mark where Removed for Non-payment of Fee.**(To accompany Form X.)*

SIR,

In pursuance of the notices issued by you, and of the provisions of sect. 79 (4) of the above Acts, I hereby transmit the additional fee of 1*l.* (along with Form X) for restoration to the Trade-Marks Register of the Trade-Mark No. in Class .

Dated the day of 18 .

(a) ———.

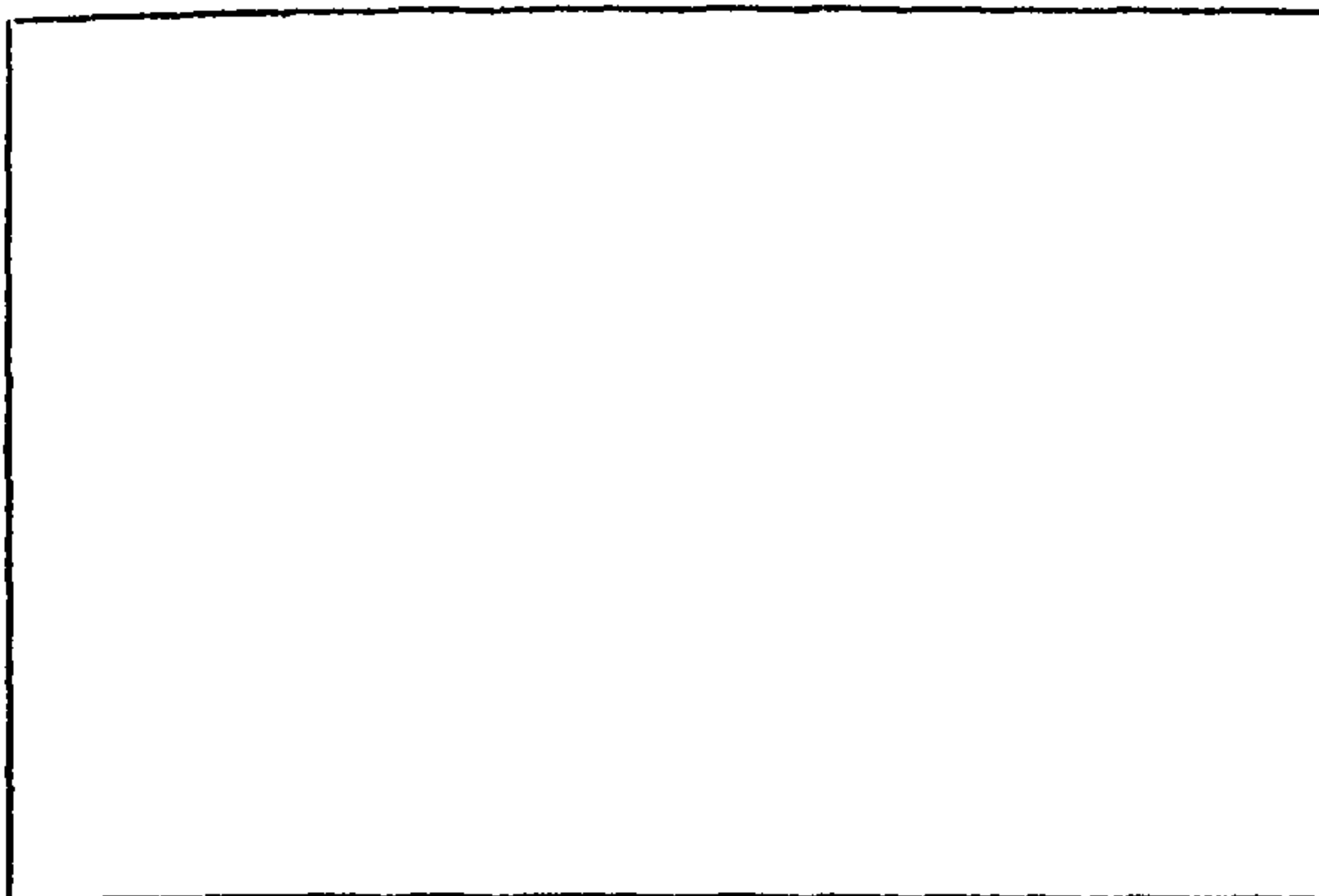
*To the Comptroller, Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.*

(a) Signature of proprietor.

PATENTS, DESIGNS, AND TRADE-MARKS ACTS, 1883—1888.

Application for Registration of Old Corporate Trade-Mark.

(CORPORATE TRADE-MARK.)



You are hereby requested to register the accompanying old Corporate Trade-Mark in Class _____, in respect of _____, in the name of _____, who claims to be the proprietor thereof.

(Signed) _____.

Dated the _____ day of _____ 18 ____ .
To the Cutlers' Company, Cutlers' Hall, Sheffield.

M. E. HICKS-BEACH,
President of the Board of Trade.

—◆—
THIRD SCHEDULE.

GENERAL NOTE.

Any wares made of mixed materials (for example, of both cotton and silk) shall be included in such one of the classes appropriated to those materials as the Comptroller may desire.

—◆—
CLASSIFICATION OF GOODS (a).

Illustrations.

Note.—Goods are mentioned in this column by way of illustration, and not as an exhaustive list of the contents of a class.

(a) See Chap. V. p. 96.

By rule 6, "If any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the Comptroller."

An alphabetically arranged list comprising a great number of kinds of goods with references to their proper register classes, is published by

<p style="text-align: center;">CLASS 1.</p> <p>Chemical substances used in manufactures, photography, or philosophical research, and anti-corrosives.</p>	<p>Such as— Acids, including vegetable acids; alkalies; artists' colours; pigments; mineral dyes.</p>
<p style="text-align: center;">CLASS 2.</p> <p>Chemical substances used for agricultural, horticultural, veterinary, and sanitary purposes.</p>	<p>Such as— Artificial manure; cattle medicines; deodorisers; vermin destroyers.</p>
<p style="text-align: center;">CLASS 3.</p> <p>Chemical substances prepared for use in medicine and pharmacy.</p>	<p>Such as— Cod liver oil; medicated articles; patent medicines; plasters; rhubarb.</p>
<p style="text-align: center;">CLASS 4.</p> <p>Raw or partly prepared vegetable, animal, and mineral substances used in manufactures, not included in other classes.</p>	<p>Such as— Resins; oils used in manufactures and not included in other classes; dyes, other than mineral; tanning substances; fibrous substances (<i>e.g.</i>, cotton, hemp, flax, jute); wool; silk; bristles; hair; feathers; cork; seeds; coal; coke; bone; sponge.</p>
<p style="text-align: center;">CLASS 5.</p> <p>Unwrought and partly wrought metals used in manufacture.</p>	<p>Such as— Iron and steel, pig or cast; iron, rough; iron, bar and rail, including rails for railways; iron, bolt and rod; iron, sheet, and boiler and armour plates; iron, hoop; lead, pig; lead, rolled; lead, sheet; wire; copper; zinc; gold, in ingots.</p>
<p style="text-align: center;">CLASS 6.</p> <p>Machinery of all kinds, and parts of machinery, except agricultural and horticultural machines included in Class 7.</p>	<p>Such as— Steam engines; boilers; pneumatic machines; hydraulic machines; locomotives; sewing machines; weighing machines; machine tools; mining machinery; fire engines.</p>

authority, and is called the "Guide to the Classification of Goods under the Patents, &c. Acts, 1883—1888." It is prefaced by the following direction:—

"If any person intending to apply for registration of a Trade-Mark is, on examining the following enumeration of goods, uncertain as to the class to which his goods belong, he should send to the Comptroller-General a letter addressed—

"The Comptroller-General,
"The Patent Office, Trade-Marks Branch.
"25, Southampton Buildings, Chancery Lane, London, W.C.

"giving a full description of the goods and of the purposes for which they are used. He will then be informed by the Comptroller-General what class he should name in his application."

CLASS 7.

Agricultural and horticultural machinery, and parts of such machinery.

Such as—

Ploughs; drilling machines; reaping machines; thrashing machines; churns; cyder presses; chaff cutters.

CLASS 8.

Philosophical instruments, scientific instruments, and apparatus for useful purposes. Instruments and apparatus for teaching.

Such as—

Mathematical instruments; gauges; logs; spectacles; educational appliances.

CLASS 9.

Musical instruments.

CLASS 10.

Horological instruments.

CLASS 11.

Instruments, apparatus, and contrivances, not medicated, for surgical or curative purposes, or in relation to the health of men or animals.

Such as—

Bandages; friction gloves; lancets; fleams; enemata.

CLASS 12.

Cutlery and edge tools.

Such as—

Knives; forks; scissors; shears; files; saws.

CLASS 13.

Metal goods not included in other classes.

Such as—

Anvils; keys; basins (metal); needles; hoes; shovels; corkscrews.

CLASS 14.

Goods of precious metals (including aluminium, nickel, Britannia metal, &c.) and jewellery, and imitations of such goods and jewellery.

Such as—

Plate; clock cases and pencil cases of such metals; Sheffield and other plated goods; gilt and ormolu work.

CLASS 15.

Glass.

Such as—

Window and plate glass; painted glass; glass mosaic; glass beads.

CLASS 16.

Porcelain and earthenware.

Such as—

China; stoneware; terra cotta; statuary porcelain; tiles; bricks.

CLASS 17.

Manufactures from mineral and other substances for building or decoration.

Such as—

Cement; plaster; imitation marble; asphalt.

- CLASS 18.**
Engineering, architectural, and building contrivances. Such as—
Diving apparatus; warming apparatus; ventilating apparatus; filtering apparatus; lighting contrivances; drainage contrivances; electric and pneumatic bells.
- CLASS 19.**
Arms, ammunition, and stores not included in Class 20. Such as—
Cannon; small arms; fowling pieces; swords; shot and other projectiles; camp equipage; equipments.
- CLASS 20.**
Explosive substances. Such as—
Gunpowder; gun-cotton; dynamite; fog-signals; percussion caps; fireworks; cartridges.
- CLASS 21.**
Naval architectural contrivances and naval equipments not included in Classes 19 and 20. Such as—
Bouts; anchors; chain cables; rigging.
- CLASS 22.**
Carriages. Such as—
Railway carriages; waggons; railway trucks; bicycles; bath chairs.
- CLASS 23.**
(a) Cotton yarn, and sewing cotton not on spools or reels.
(b) Sewing cotton on spools or reels.
- CLASS 24.**
Cotton piece goods of all kinds. Such as—
Cotton shirtings; long-cloth.
- CLASS 25.**
Cotton goods not included in Classes 23, 24 or 38. Such as—
Cotton lace; cotton braids; cotton tapes.
- CLASS 26.**
Linen and hemp yarn and thread.
- CLASS 27.**
Linen and hemp piece goods.
- CLASS 28.**
Linen and hemp goods not included in Classes 26, 27 and 50.
- CLASS 29.**
Jute yarns and tissues, and other articles made of jute not included in Class 50.
- CLASS 30.**
Silk, spun, thrown, or sewing.

CLASS 31.

Silk piece goods.

CLASS 32.

Other silk goods not included in Classes 30 and 31.

CLASS 33.

Yarns of wool, worsted, or hair.

CLASS 34.

Cloths and stuffs of wool, worsted, or hair.

CLASS 35.

Woollen and worsted and hair goods not included in Classes 33 and 34.

CLASS 36.

Carpets, floor-cloth, and oil-cloth.

Such as—

Drugget; mats and matting, rugs.

CLASS 37.

Leather, skins unwrought and wrought, and articles made of leather not included in other classes.

Such as—

Saddlery; harness; whips; port-manteaus; furs.

CLASS 38.

Articles of clothing.

Such as—

Hats of all kinds; caps and bonnets; hosiery; gloves; boots and shoes; other ready-made clothing.

CLASS 39.

Paper (except paperhangings), stationery, and bookbinding.

Such as—

Envelopes; sealing wax; pens (except gold pens); ink; playing cards; blotting cases; copying presses.

CLASS 40.

Goods manufactured from india-rubber and gutta-percha not included in other classes.

CLASS 41.

Furniture and upholstery.

Such as—

Paperhangings; papier-mâché; mirrors; mattresses.

CLASS 42.

Substances used as food, or as ingredients in food.

Such as—

Cereals; pulses; olive oil; hops; malt; dried fruits; tea; sago; salt; sugar; preserved meats; confectionery; oil cakes; pickles; vinegar; beer clarifiers.

CLASS 43.

Fermented liquors and spirits.

Such as—

Beer; cyder; wine; whisky; liqueurs.

CLASS 44.

Mineral and aerated waters, natural and artificial, including ginger-beer.

CLASS 45.

Tobacco, whether manufactured or unmanufactured.

CLASS 46.

Seeds for agricultural and horticultural purposes.

CLASS 47.

Candles, common soap, detergents; illuminating, heating, or lubricating oils; matches; and starch, blue, and other preparations for laundry purposes.

Such as—
Washing powders; benzine col-
las.

CLASS 48.

Perfumery (including toilet articles, preparations for the teeth and hair, and perfumed soap).

CLASS 49.

Games of all kinds and sporting articles not included in other classes.

Such as—
Billiard tables; roller skates; fish-
ing nets and lines; toys.

CLASS 50.

Miscellaneous—

- (1.) Goods manufactured from ivory, bone, or wood, not included in other classes.
- (2.) Goods manufactured from straw or glass, not included in other classes.
- (3.) Goods manufactured from animal and vegetable substances, not included in other classes.
- (4.) Tobacco pipes.
- (5.) Umbrellas, walking-sticks, brushes, and combs.
- (6.) Furniture cream, plate powder.
- (7.) Tarpaulins, tents, rickcloths, rope, twine.
- (8.) Buttons of all kinds, other than of precious metal or imitations thereof.
- (9.) Packing and hose of all kinds.
- (10.) Goods not included in the foregoing classes.

Such as—
Coopers' wares.

(Signed) **M. E. HICKS-BEACH,**
President of the Board of Trade.

No. 5.

INSTRUCTIONS TO PERSONS WHO WISH TO
REGISTER TRADE MARKS.

PRELIMINARY.

1. All communications relating to trade-marks, not being marks in Classes 23, 24 or 25, or Sheffield marks, should be addressed to the Comptroller, the Patent Office, Trade Marks Branch. All applications for registration should be in the English language.

They may be made by post, or left at the Patent Office, Trade Marks Branch, 25, Southampton Buildings, Chancery Lane, London, W.C. (See also paragraphs 8 and 33.)

For further particulars as to the method of making applications, see paragraph 9.

2. The fees in relation to trade-marks registration cannot be received at the Patent Office. They should be paid in exchange for the *stamped forms* required, which may be obtained at the following places:—

(a) The Inland Revenue Office, Royal Courts of Justice, London (Room No. 6).

(b) The following Post Offices in London:—

The General Post Office, E.C.

District Post Office, Lombard Street, E.C.

„ 195, Whitechapel Road, E.

„ 239, Borough High Street, S.E.

„ Charing Cross, W.C.

„ 28, Eversholt Street, Camden Town,
N.W.

Post Office, 12, Parliament Street, S.W., or

(c) The Chief Post Office of the undermentioned cities and towns:—

IN ENGLAND AND WALES.

Accrington.	Beverley.	Bristol.
Altrincham.	Birkenhead.	Bromsgrove.
Ashton-under-Lyne.	Birmingham.	Burnley.
Barnsley.	Blackburn.	Burslem.
Barrow-in-Furness.	Bolton.	Burton-on-Trent.
Bath.	Bradford.	Bury.
Bedford.	Brighton.	Cambridge.

IN ENGLAND AND WALES—continued.

Cardiff.	Knutsford.	Rotherham.
Carlisle.	Lancaster.	Rugby.
Chatham.	Leamington.	Salford.
Chester.	Leeds.	St. Helen's.
Clitheroe.	Leicester.	Scarborough.
Congleton.	Lichfield.	Sedgley.
Coventry.	Lincoln.	Sheffield.
Crewe.	Liverpool.	Southampton.
Croydon.	Macclesfield.	Stafford.
Darlaston.	Manchester.	Stalybridge.
Derby.	Middlesbrough.	Stockport.
Dewsbury.	Nantwich.	Stoke-on-Trent.
Doncaster.	Newcastle.	Stourbridge.
Dorchester.	Newport (Mon.).	Stourport.
Driffield.	Northallerton.	Sunderland.
Droitwich.	Northampton.	Swansea.
Dudley.	Nottingham.	Tamworth.
Durham.	Nuneaton.	Truro.
Exeter.	Oldbury.	Tunstall.
Gateshead.	Oldham.	Wakefield.
Goole.	Patlington.	Walsall.
Greenwich.	Plymouth.	Warrington.
Guildford.	Pontefract.	Wednesbury.
Halifax.	Portsmouth.	West Bromwich.
Hartlepool.	Prescot.	Whitby.
Huddersfield.	Preston.	Widnes.
Hull.	Reading.	Wigan.
Ipswich.	Redditch.	Wolverhampton.
Keighley.	Richmond (Yorks).	Wolverton.
Kendal.	Ripon.	Woolwich.
Kidderminster.	Rochdale.	York.
Knaresbro'.		

IN SCOTLAND.

Aberdeen.	Glasgow.	Leith.
Dumbarton.	Greenock.	Paisley.
Dundee.	Inverness.	Perth.
Edinburgh.	Lanark.	Renfrew.

IN IRELAND.

Belfast.	Dundalk.	Londonderry.
Cork.	Galway.	Waterford.
Dublin.	Limerick.	Wexford.

NOTE.—Arrangements have also been made by which any of the forms required may be ordered at any Money Order Office in the United Kingdom not included in the above List.

3. The following is a list of the stamped forms under the Patents, Designs, and Trade-Marks Acts, 1883—1888, which relate to trade-marks, and which may be obtained at the places mentioned above:—

TRADE MARKS.

Letter.	Title of Form.	Fee.
E	Application for hearing by Comptroller, in oppositions..	£ s. d. 1 0 0
F	Application for registration of trade-mark	0 5 0
G	Additional representation form	No stamp.
H	Appeal to Board of Trade from decision of Comptroller..	1 0 0

Instructions for Registering Trade-Marks.

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TRADE-MARKS—continued.

Letter.	Title of Form.	Fee.
		£ s. d.
I	Registration fee	1 0 0
J	Notice of opposition to application for registration.....	1 0 0
K	Request to enter name of subsequent proprietor, with declaration in support thereof	1 0 0
L	Request for certificate of refusal to register a trade-mark	1 0 0
M	Notice of application for alteration of address	0 5 0
N	Notice of order of Court for alteration or rectification of Register	0 10 0
O	Application to cancel entry of mark on Register	0 5 0
Q	Request for correction of clerical error or for amendment of application under sect. 91	0 5 0
R	Request for certificate of registration for use abroad	0 5 0
S	Request for certificate of registration for use in legal proceedings	1 0 0
T	Application for settlement of a special case	2 0 0
T ¹	Request for general certificate of Comptroller.....	0 5 0
V	Request for copy of official notification.....	0 2 0
W	Appeal from Cutlers' Company at Sheffield to Comptroller	1 0 0
X	Fee for continuance of trade-mark at expiration of fourteen years	1 0 0
Y	Additional fee where fee is paid within three months after expiration of fourteen years	0 10 0
Z	Additional fee for restoration of trade-mark where removed for non-payment of fee	1 0 0

Of the above forms, those bearing the letters F, G, and I, are kept in stock at the various offices named in paragraph 2. Any of the others when required must be bespoke.

If it should not be convenient to apply in person at any of the above offices, the forms may be ordered by persons in this country or abroad *by post* from the Controller of Stamps, Room No. 7, Inland Revenue Office, Somerset House, London, W.C.

An application by post for forms must be accompanied by a banker's draft, or by a Money Order or Postal Order, payable to the Commissioners of Inland Revenue, and crossed "Bank of England," for the value of the stamp together with the cost of the postage and of the *registration* of the letter in which the forms will be forwarded to the applicant.

SALE OF OFFICIAL PUBLICATIONS.

4. The Patents, Designs, and Trade Marks Acts, 1883—1888, and the Trade Marks Rules, 1890, should be carefully studied. Copies of the Acts and of the Rules can be purchased at the Sale Branch of the Patent Office. The price of the Acts and Rules together is 2s. 6d., postage 2d.; of the Acts alone, 2s., postage, 1½d.; and of the Rules alone, 6d., postage, 1d. Sums exceeding 1s. should be remitted by Postal Order or Post Office Order.

5. Copies of the *Trade Marks Journal* may also be obtained from the Sale Branch of the Patent Office, 25, Southampton Buildings, London, W.C.

The price of the *Trade Marks Journal* is:—

Nos. 1 to 509 (Years 1876 to 1887) -	-	1s. per number.
Nos. 510 to 561 (Year 1888) -	-	1s. 6d. „
No. 562 and following Nos. from 1st January, 1889 -	-	6d. „

DEFINITION OF A TRADE-MARK.

6. The definition of a trade-mark is given in the 64th section of the Acts, as follows:—

- “(1.) For the purposes of this Act, a trade-mark must consist of or contain at least one of the following essential particulars:
- (a) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or
 - (b) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade-mark; or
 - (c) A distinctive device, mark, brand, heading, label, or ticket; or
 - (d) An invented word or invented words; or
 - (e) A word or words having no reference to the character or quality of the goods, and not being a geographical name.
- “(2.) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them, but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade-mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the Register.
- “(3.) Provided as follows:—
- (i.) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof;
 - (ii.) Any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures used as a trade-mark before the thirteenth day of August one thousand eight hundred and seventy-five may be registered as a trade-mark under this part of this Act.”

SEARCHES.

7. A person wishing to adopt a trade-mark should, before engraving a block and circulating impressions of the mark among his customers, make a search or a formal application for registration at the Trade-Marks Branch of the Patent Office with the view of ascertaining whether his proposed mark is already registered, or whether, from its being calculated to deceive by a resemblance to other marks already on record, it would be refused registration under the 72nd section of the Acts.

The fee payable by a person making a search amongst the classified representations of trade-marks is 1s. for each quarter of an hour. The fee for a formal application for registration is 5s. See paragraphs 9 and 3 of these Instructions as to the mode of making a formal application.

Complete searches amongst classified collections of marks in the *Cotton Classes* (Classes 23, 24 and 25) can only be made at the Manchester Branch Office, 48, Royal Exchange, Manchester. See paragraph 34.

The Comptroller does not undertake to make searches amongst the trade-marks recorded at his office, *except in connexion with formal applications for registration.*

APPLICATIONS FOR REGISTRATION.

8. Applications sent by post should be addressed—

The Comptroller,
The Patent Office, Trade-Marks Branch,
25, Southampton Buildings,
London, W.C.

In the case of marks claimed in the Cotton Classes (23, 24 or 25), applications should be addressed—

The Comptroller,
Manchester Trade-Marks Branch,
48, Royal Exchange,
Manchester.

Agents and other persons who may be interested in more than one application are particularly requested to make communications relating to different applications in *separate* letters.

9. An application for the registration of a trade-mark consists of :—

(a) An application form (Form F) bearing an impressed stamp of 5s. (*see* paragraph 3).

(The applicant should, before filling up the form, carefully read the marginal notes.)

(b) Certain additional representations of the trade-mark, mounted on forms (Form G) (*see* paragraphs 3 and 15).

10. A *separate* application form is required for *each* class in

cases where the same trade-mark is claimed in more than one class of goods.

11. If the mark be the property of a firm, the Form F should be signed by a member of the firm, who should add, after his signature, "A Member of the Firm"; if of a company, by the secretary or other principal officer, who should add, after his signature and designation, "For the Company."

12. Applications may be made by agents in the names of and on behalf of the owners of trade-marks. The agent must be duly authorised in writing by the owner or owners; the authority to an agent should be signed by the owner or owners; in the case of a firm or of a company the authority should be signed in the same manner as indicated in the paragraph next above.

Applications made by agents should have, after the name of the agent, the description "Agent."

13. When an applicant for the registration of a trade-mark, otherwise than under an International Convention, is out of the United Kingdom at the time of making the application, he must give the Comptroller an address for service in the United Kingdom.

14. When the mark consists of or includes words printed in other than Roman characters, there should be given upon the forms a translation and a transliteration of such words, signed by the applicant or his agent.

In the case of marks claimed in Classes 23, 24 or 25, the applicant should state by what name the particular mark claimed would be referred to in the invoices of his house.

Additional Representations of Mark.

15. Each of the additional representations should be placed in the centre of a separate Form G.

In the case of a trade-mark which is claimed in any of the Classes 1 to 4, 8 to 10, 15 to 21, and 36 to 50, *three* additional representations are required for *each* class claimed.

In the case of a trade-mark claimed in any of the Classes 5 to 7, 11 to 14, or 22 to 35, *four* additional representations should be sent for *each* of such classes.

The representations of the mark on the Forms G must agree in *every respect* with each other, and with that on the Form F.

16. Representations of a mark of a large size may be folded. In that case they must, however, be backed with linen and firmly affixed to the forms. Representations must in no case be executed *in pencil*. They should be not only of a durable nature, but of such a kind as will admit of their being preserved and bound together in volumes as records of the property of the owners.

SERIES OF TRADE-MARKS.

17. By section 66 of the Acts, the Comptroller is empowered to register under one registration a "series" of trade-marks

which, whilst they resemble each other in the material particulars, differ from each other in respect of statements of the goods for which they are used, of numbers, of statements of price, of statements of quality, or of statements of names of places. When an application is made for such a "series," a representation of *each* of the marks included in the series must be affixed to the Form F, and also to each of the Forms G.

COMMON OR OPEN MARKS.

18. In the case of a trade-mark used since before the 13th August, 1875, common or open marks of any kind may be registered in connection with it; but in the case of a trade-mark not so used, only such common or open marks as consist of *a word or of a combination of words* can be registered as a part of the mark.

In each case the applicant for entry of such common particular or particulars must disclaim the right to the exclusive use of the same in a note at the foot of the application form, such note to be signed by the applicant or his agent.

See section 74 of the Acts, sub-section 3, for definition of common marks.

CLASSIFICATION OF GOODS.

19. A guide to the classification of goods under the Trade-Marks Rules can be obtained on application at the Patent Office, Trade Marks Branch, and should be asked for if the applicant feels any difficulty in determining to which of the classes set out in the Third Schedule to the Rules the goods for which he uses his mark belong.

ADVERTISEMENT IN THE "TRADE-MARKS JOURNAL."

20. A trade-mark cannot in any case be entered upon the Register until one month after its advertisement in the official paper.

21. A wood-block or electrotype must be furnished for each mark in each class claimed, except in the case of Classes 23, 24 and 25, for which no blocks are required.

No block or electrotype should be forwarded until a formal demand for it is sent by the Comptroller.

22. In the case of a "series" of trade-marks differing only in respect of the particulars mentioned in section 66 of the Acts, a wood-block or electrotype must be furnished for each mark in the series, for each class claimed.

23. The wood-blocks or electrotypes furnished must correspond *exactly* with the representations, must afford *perfectly distinct* impressions of the marks, and must be upon a scale sufficiently large to reproduce the marks faithfully. Worn or mutilated blocks or electrotypes cannot be accepted.

24. The largest space available for the insertion of any single block or electrotype is five and a-half inches broad by seven and a-half inches deep.

When a block or electrotype *exceeds two inches in depth or breadth*, a charge for additional space is made, at the rate of two shillings for every inch or part of an inch in depth or breadth beyond the two inches.

25. The official number given by the Comptroller to a mark should *not* be cut on the face of the block or electrotype, but should be *marked upon the side* in such a manner as to secure identification.

26. All blocks or electrotypes should be sent to the Patent Office, Trade Marks Branch, together with the paper marked "Form 2," and with the representation of the mark sent for the guidance of the applicant in preparing the block or electrotype.

27. The blocks or electrotypes supplied for the advertisement of trade-marks cannot in any case be returned to applicant.

RESTRICTIONS ON REGISTRATION.

28. Ornamental or coloured groundwork, such as tartans or checks, cannot be claimed as part of a mark unless such groundwork be included within the mark by some border or lines.

29. The words "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To counterfeit this is forgery," will not be registered under the Acts, and should not, therefore, appear upon the representations of trade-marks forming part of an application.

30. The following will not be registered as trade-marks, or as prominent parts of trade-marks, unless the marks have been used since before 13th August, 1875 :—

The Royal Arms, or arms so nearly resembling them as to be calculated to deceive.

Representations of her Majesty the Queen, or of any member of the Royal Family.

Representations of the royal crown.

The national arms or flags of Great Britain.

31. When there appears on the face of a trade-mark an indication of the goods to which the mark is applied, the claim for its registration must be in respect of *those goods only*.

OPPOSITIONS.

32. Notice of opposition to the registration of a trade-mark (Form J) must be filed within one month (or such further time, not exceeding three months, as the Comptroller may allow) from the date of advertisement of the mark in the *Trade-Marks Journal*.

The applicant's counter-statement must be filed within one month from the date of receipt of the opponent's notice of opposition.

The opponent's evidence, in support of the opposition, must be filed within two months after the expiration of one month (or such further time, not exceeding three months, as the Comptroller may allow) from the date of advertisement of the mark in the *Trade-Marks Journal*, and a copy of such evidence must be forthwith sent to the applicant.

The applicant's evidence must be filed within one month from the delivery of the opponent's evidence, and a copy of such evidence must be forthwith sent to the opponent.

The opponent's evidence in reply must be filed within seven days from the delivery of the applicant's evidence, and a copy of such evidence must be forthwith sent to the applicant.

On the completion of the evidence, a hearing is appointed by the Comptroller. Each party attending the hearing must lodge the Hearing Fee Form (Form E, with 1*l.* stamp).

FORM OF COUNTER-STATEMENT.

The following is a form of commencement for a counter-statement:—

Patents, Designs, and Trade-Marks Acts, 1883—1888.

Trade-Marks.

In the matter of an application No.
and of the opposition thereto No.

In reply to the notice of opposition in this matter by _____ of _____,
I give notice by way of counter-statement that I rely for my application on
the following grounds:—

(To be dated and signed by the *applicant* or his *solicitor*.)

To the Comptroller,
The Patent Office, Trade-Marks Branch,
25, Southampton Buildings, London.

CUTLERS' COMPANY OF SHEFFIELD.

33. By section 81 of the Acts, application for the registration of trade-marks used on metal goods shall, if made by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company of Sheffield. See Rules 56 to 59.

Applications made to the Cutlers' Company in pursuance of section 81 of the Acts should be made on Form F, the address in the left-hand corner to be, "To the Cutlers' Company, Sheffield," instead of "To the Comptroller," and should be left at, or sent by post to, the Cutlers' Hall, Sheffield.

Each application should be accompanied by an unstamped copy on foolscap paper. See Rule 56.

Applications sent by post should be addressed—

The Law Clerk to the Cutlers' Company,
The Cutlers' Hall,
Sheffield.

MANCHESTER OFFICE.

34. For the convenience of merchants and manufacturers engaged in the cotton trade, and for the purpose of facilitating the recording of trade-marks used in respect of cotton goods, an office is open at 48, Royal Exchange, Manchester, where searches can be made, on payment of 1s. for each quarter of an hour, for marks in classes of textiles from Class 23 to Class 35.

CERTIFICATES.

35. The Comptroller's certificate in relation to a trade-mark is of four kinds, viz. :—

- (i.) For use in legal proceedings.
- (ii.) For use in applying for registration in foreign countries.
- (iii.) Of any application made and of proceedings thereon.
- (iv.) A certificate of refusal of a mark in use since before 13th August, 1875, and not registerable.

36. A person desirous of obtaining any of the above certificates should forward Form S, Form R, Form T 1, or Form L (*see* paragraph 3), as the case may be, to the Comptroller, giving the Comptroller's official number of the mark, and stating whether the certificate is required for use in legal proceedings, or for use in applying for the registration of the mark in a foreign country, or for what other purpose.

37. In every case where a certificate is required in respect of a cotton mark, or in respect of any trade-mark of which the representations or specimens forming part of the application for registration are *coloured*, or in respect of an application made, or in respect of an application refused, two unmounted copies of the mark must be supplied, agreeing *in every respect* with the representations forming part of the application for registration. Special attention should be paid to this requirement, as the certificate cannot in any such case be prepared until these unmounted copies are received by the Comptroller.

REGISTRATION OF SUBSEQUENT PROPRIETORS OF REGISTERED TRADE-MARKS.

38. The request and declaration to be made by a subsequent proprietor on application for the registration in his name of a registered trade-mark must be made on Form K (*see* paragraph 3). In the case of a firm the Declaration K may be made by one member of the firm. In the case of a company the Declaration K should be made by a principal officer of the company.

C. N. DALTON,
Comptroller.

May, 1897.

No. 6.

OFFICIAL NOTICES PUBLISHED IN THE
OFFICIAL JOURNAL (a).

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(a) These are from the year 1889 onwards.

PICTURE OF ARTICLE—NAME IN POSSESSIVE CASE.

Journal, No. 570, 1889, p. 220.

After the 31st March next, marks of the nature indicated below will not be accepted for registration as trade-marks under the Patents, Designs, and Trade-Marks Acts, 1883—1888:—

- (1) Pictorial representations of goods to which the marks are to be applied.
- (2) Names of persons in the possessive case in combination with the names of goods.

NOTICE AS TO NAME MARKS.

Journal, No. 606, Nov. 6th, 1889.

In future no mere surname or combination of surname and christian name which might possibly be the name of an existing individual will be accepted for registration as a new trade-mark under sect. 64 of the Patents, Designs, and Trade-Marks Acts, 1883—1888, unless rendered in some particular and distinctive manner in accordance with sub-sect. 1 (a) of that section; and the same will apply to any christian name which is in use as a surname.

AUTHORISATION OF AGENTS.

Journal, No. 711, 1891, p. 1042.

Any agent forwarding to the Patent Office an application for the registration of a trade-mark must at the same time forward the applicant's authority to act as agent, unless he has already supplied a general authority, in which latter case he should with the application send a note of the date of such general authority.

Appendix—No. 6.

Journal, No. 713, 1891, p. 1085.

(*As above in last with following addition.*)

If no authority be supplied the application may not be dealt with in the ordinary course, and communications respecting it will be sent to the applicant only.

INDEXES.

Journal, No. 714, 1891, p. 1123.

Alphabetical indexes to the words forming the essential or material feature of trade-marks as advertised in the several classes (except Classes 23, 24 and 25) have been compiled for the use of the public, and are placed in the Public Search Room.

ADVERTISEMENT OF CLAIMS AND DISCLAIMERS.

Journal, No. 715, 1891, p. 1147.

From the beginning of the year 1892 it is intended to print, in connection with the advertisement in the *Trade-Marks Journal* of applications for the registration of trade-marks, copies of all statements and disclaimers which may have been inserted in such applications in pursuance of the provisions of sects. 64 and 74 of the Patents, Designs, and Trade-Marks Acts, 1883 to 1888.

AUTHORISATION OF AGENTS.

Journal, No. 726, 1892, p. 153.

(*As above in Trade-Marks Journal*, No. 713, with following additions.)

In future an agent forwarding to the Patent Office an application for the registration of a trade-mark in the name of an applicant carrying on business out of the United Kingdom must at the same time forward the applicant's authority to act as agent.

GENERAL AUTHORISATIONS.

(This notice asks agents as far as possible to file with applications separate authorisations for each mark or series of marks.)

CLASS 50.

Journal, No. 781, 1893, p. 245.

The Comptroller desires to call attention to the increasing practice of applying for marks in Class 50 for goods contained in a very extended list of goods, which it is difficult to suppose would be generally dealt in by the same firm.

Class 50 being a miscellaneous class, the goods covered by a registration in this class should be very carefully specified, and care should be taken not to include goods for which the mark is not intended. The specifications of goods in applications in this class made after this date will be most carefully scrutinised, and evidence may be asked for as to points that may arise in consequence of such scrutiny.

REPRESENTATIONS OF TRADE-MARKS APPLIED FOR IN CLASSES 5, 6,
7, 11, 12, 13 and 14.

Journal, No. 873, 1894, p. 1021.

On and after the 1st January, 1895, it is proposed to establish for the convenience of the trade a complete collection of representations of pending applications in Classes 5, 6, 7, 11, 12, 13 and 14, to be kept by the Cutlers' Company at the Cutlers' Hall, Sheffield, for public inspection.

Applicants at this office for marks in these classes should therefore, on and after the 1st January, 1895, be so good as to furnish three forms "G," bearing representations of the mark applied for, instead of two. One of the forms "G" will be forwarded forthwith to the Cutlers' Company, who will preserve it, along with the applications made at Sheffield, until the mark is either refused registration or proceeds to advertisement, or is abandoned.

[*See the present Rule 13.*]

OFFICIAL CROWN BRANDS FOR HERRING.

Journal, No. 882, 1895, p. 137.

[A notice by the Fishery Board for Scotland, calling attention to the official Crown Brands for Herrings prescribed under the Herring Fishery (Scotland) Acts, the unauthorised use of which is prohibited. Illustration of one of the Brands subjoined.]

SIGNATURES ON TRADE-MARKS.

Journal, No. 925, 1895, p. 1038.

In consequence of difficulties which have arisen as to the interpretation which should be put on the words in sub-sect. (1) of sect. 64 of the Act, "written signature of a firm," the Comptroller has been advised thereon, and is directed that they must be construed to mean a signature (actually used in the ordinary course of business) of the trading style under which the applicant has a *bonâ fide* right to trade, and which consists of a personal name or personal names, and that they do not include mere descriptive trading styles, such as "The Excellent Tea Company," or "The London Stout Company."

BLOCKS FOR ADVERTISEMENT OF MARKS IN THE "TRADE-MARKS
JOURNAL."

Journal, No. 932, 1896, p. 115.

The attention of applicants is called to the necessity for supplying blocks for the *Trade Marks Journal* of sufficient size to show

clearly the features of the mark, and especially those features which are claimed as being essential particulars of the mark within the meaning of sect. 64 of the Statute, and any letterpress appearing on the mark.

REPRESENTATIONS OF TRADE-MARKS APPLIED FOR IN CLASS 22.

Journal, No. 993, 1897, p. 317.

With reference to the notice which appeared in this journal at the end of the year 1894 and the beginning of the year 1895, with regard to the establishment of a collection of marks, the subject of pending applications in certain classes, to be kept by the Cutlers' Company of Sheffield, it is now proposed to add representations of marks in Class 22 (carriages) to that collection.

Applicants, therefore, for marks in Class 22 should, on and after the 1st May, 1897, be good enough to furnish three forms "G," each bearing a representation of the mark applied for, instead of two. The other classes in which an extra representation is required for the Cutlers' Company are Classes 5, 6, 7, 11, 12, 13 and 14.

[*See the present Rule 13.*]

No. 7.

PRECEDENTS OF FORMS UPON AN OPPOSED APPLICATION TO REGISTER A TRADE- MARK AND ON APPEAL (a).

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1. APPLICATION FOR REGISTRATION.

(Form F., above, p. 706.)

2. NOTICE OF OPPOSITION.

(Form J., above, p. 708.)

(Grounds of opposition.)

1. We are the registered proprietors of a trade-mark in Class , for [*describing the goods*] registered on the of 18 , and numbered 1,234, and we use, and since the of , 18 , we have extensively used, the said mark as a trade-mark in our business as [*describing the business.*]

2. We also use, and since the of , 18 , we have extensively used, a mark consisting of [*describing it*] for [*describing the goods*] as a trade-mark, and also in our advertisements and price lists, in our said business.

3. The mark which the applicants by their application above referred to are seeking to register has such resemblance to our

(a) See Chap. IV., p. 63.