

protected as such before the Acts.¹ Since 1875 the corresponding part of the earlier Acts had been as follows:—(a) *A name of an individual or firm printed, impressed, or woven in some particular and distinctive name.*²

It was pointed out that under the former wording the name of a body corporate might possibly not be included, the word “person” which would have included it not being used.³ In the present Act the word “company” is introduced.

The name need not be that of the company, individual or firm applying for registration, or that of a predecessor in business.⁴ But the name must be that of a real company, individual or firm as opposed to an imaginary company, individual or firm. Thus it was held in *Holt & Co.’s Trade Mark*,⁵ by Lindley and Smith, L.JJ. (Kay, L.J., dissenting), that *Trilby*, being the name of an imaginary person taken from a novel, was not within clause (a) of sec. 64 (1) of the Act of 1883; and Lindley, L.J., said: “Clause (a) does not say that the name to be registered need be the name of a living person, nor the name of the applicant for registration. In this respect clause (a) differs from clause (b). The reference to a firm, however, points rather to real persons than to imaginary persons. In metaphorical language, an imaginary person may perhaps be called an individual, but such a use of the word is unusual, and to my mind rather fanciful. It is hardly to be supposed that the Legislature meant ‘individual’ to be taken in a fanciful or metaphorical sense, or meant it to denote an imaginary person who has not and never had any real existence.” The question whether clause (a) was satisfied if it can be shown that the name has at some time been the name of a real person or firm did not arise; but there is nothing in the judgments of Lindley and Smith, L.JJ., to indicate that they considered that such a name would not fall within clause (a).⁶

Name of
imaginary
person.

¹ “The name of a firm is a very distinctive word indeed”: per Jessel, M.R., in *Ex parte Stephens*, 3 C. D. p. 360; 46 L. J. Ch. p. 47 (1876).

² Sec. 10 of the Act of 1875. Sec. 64 of the Act of 1883. No change was made by the Act of 1885.

³ *Colman’s Application*, [1894] 2 Ch. 127; 11 R. P. C. at p. 134.

⁴ Cf. para. (2), below, p. 140.

⁵ 13 R. P. C. 16 and 118, C. A., [1896] 1 Ch. 711, reversing North, J. It was argued that if the word fell under

clause (a)—with the condition of which it did not comply, as it was not printed in any distinctive manner—it could not be registered under clause (c). The majority of the C. A. approved the argument, but held that the word did not fall under clause (a). For these clauses, see above, p. 130.

⁶ In *Banks and James’ Tm.*, 12 R. P. C. 333 (1895), Chitty, J., held that *Shakspeare* was not a “fancy word,” one of his reasons being that there were many living persons of the name.

The alteration in the present Act from "a name" to "the name" makes it more clear that a real company, individual or firm is intended.

The practice of adopting trade names which are different from those of the traders or of the partners in the firm using them is very common—for instance, in the Scotch whiskey trade, in which it is a common practice to use a Scotch name. The practice is of itself perfectly lawful,¹ and such a name so adopted, and although so adopted for one branch only of a business, would no doubt be within the clause; and as this practice is allowed, there seems to be no reason why a trader should not adopt as his trade mark the name of a real² or imaginary individual. But the effect of the decision in *Holt's Trade Mark* as applied to the present Act is³ that if the name adopted be that of a real person or firm, it comes under paragraph (1), and must be represented in a special or particular manner; whilst if it be that of an imaginary person, it can be registered in ordinary lettering under paragraph (4), provided that it has no direct reference to the character or quality of the goods,⁴ or possibly under paragraph (5). Names falling within clause (1) are not within clause (4).⁵

It does not follow that every name of a company, individual or firm, represented as required by paragraph (1), which an applicant may select is entitled to registration, for, apart from the general restrictions expressly specified by the Act,⁶ the Registrar, in the exercise of his discretion,⁷ would, no doubt, reject any name which, contrary to the fact, tended to suggest that the goods on which it was used were the manufacture or merchandise of, or had some connection with, a particular company, person or firm, or were goods of a particular kind, especially if the name were not the proper name of the applicant or of his predecessors in trade.⁸ And if the name indicated a particular

¹ See *Macmillan v. Ehrmann Bros., Ltd.*, 21 F. P. C. 647 (1904), C. A., where, however, Vaughan Williams, L.J., regretted the lawfulness of the practice.

² Cf. *A. W. Gamage, Ltd. v. H. E. Randall, Ltd.*, 16 R. P. C. 185 (1899) (a passing-off case in which the plaintiffs failed. *Shorland* for cycling shoes). Makers of tennis racquets sometimes name their racquets after well-known players.

³ See note (5), p. 137.

⁴ See *infra*, p. 165.

⁵ The decision in *Holt's case*, *supra*, would seem to apply under the present Act.

⁶ Secs. 11, 19 and 20; Chap. X., p. 221.

⁷ See p. 70.

⁸ Cf. *Thorneloe v. Hill*, [1894] 1 Ch. 569; 11 R. P. C. 61 (*John Forrest*—passing-off case).

living person, who did not assent to the use of his name, the Registrar might in his discretion reject it, even although no connection of the person with the particular goods would be suggested.¹

The name must be the mere name in the nominative case. Thus, where *Pirie's Parchment Bank* was registered as a trade mark, and the two latter words were disclaimed, Lindley, L.J., held that *Pirie's* was not the name of a firm within the former sub-section.²

Name must be mere name in nominative case.

And as regards the registration of names in the possessive case, generally, Lord Herschell's Committee reported³ that "complaints have also been made that where words have been refused as not being distinctive, they have afterwards been allowed where the applicant has applied for a mark consisting of the same word preceded by the applicant's name with an apostrophe. We think," they added, "that this course ought not to be pursued. Little or no mischief might result where the name of the applicant was an uncommon one; but where the name was a common one the result would be to deprive all persons bearing the same name of their right to use a common word in connection with their own name, and even if the name were an uncommon one it would be impossible to say that there were not other persons bearing it who might wish to use it in connection with the common word which it is sought to monopolise."

The report continues: "Evidence has been given that marks consisting of a combination of the applicant's name with the article he manufactures or sells are highly valued. There can be no doubt that if a manufacturer or vendor has obtained for his goods a reputation amongst the public, he could, by process of law, quite apart from the Trade Marks Act, prevent goods that

¹ By Rule 15, where the names or representations of living persons appear on a trade mark, the Registrar shall, if he so require, be furnished with consents from such persons before proceeding to register the mark. The rule also provides that the Registrar may require the consents of legal personal representatives in the case of persons recently dead. See also *Carroll's Application*, 16 R. P. C. 82 (1899), Kekewich, J. (*Princess*

Christian). Portraits of well-known persons have, with their consent, been registered as trade marks.

² *Pirie v. Goodall*, [1892] 1 Ch. 35; 9 R. P. C. 17; cf. *Colman's Tm.*, [1894] 2 Ch. 115; 11 R. P. C. 129, where Stirling, J., held that *Colman's* occurring in a label need not be disclaimed under sec. 64 (3) (1) of the Act of 1883, as amended by the Act of 1888.

³ Report of 1888, p. xii.

were not his from being offered to the public on the representation that they were so. But it would be quite a different thing to give, by virtue of registration under the Trade Marks Act, a right to prevent another manufacturer or merchant honestly describing his own goods by his own name.”¹ The effect of the decision in *Pirie v. Goodall*² will, no doubt, be to put a stop for the future to the registrations which the committee thought objectionable.

Special or particular manner.

The word “distinctive” has been dropped in the present Act. Every trade mark must be distinctive, that is, capable of distinguishing the goods from those of other persons. The word “special” has been, in conjunction with the word “distinctive,” construed by the Court as regards marks registered as old marks.³ There seems to be little difference in meaning between “special” and “particular.” The intention of the requirement that the name should be represented in a special or particular manner is obviously to prevent a name from being so taken as a trade mark that any trader might unintentionally infringe it by an honest use of his own name.⁴ This intention would be carried into effect by construing the words to mean “not ordinary, having regard to the practice in the trade concerned.”

Ordinary type.

It was held under the old clause that a name printed in ordinary type,⁵ or in type in ordinary use, as, for instance, capitals,⁶ or common ornamental letters,⁷ was not within the clause; and that the addition of marks which are common to the trade makes the words no better as a trade mark.⁸ Similar decisions would no doubt be given under the Act of 1905.

Signatures.

(2) The signature of the applicant for registration or some predecessor in his business.

¹ See *Hopkinson's Tm.*, [1892] 2 Ch. 116; 9 R. P. C. 102, Kekewich, J., where something like this seems to have been done by the registration of a name as an old mark.

² See note (2), ante, p. 139.

³ See below, p. 174.

⁴ See the extract quoted above from the report of Ld. Herschell's Committee. As to the right of a man to trade under his own name, see below, p. 532; but cf. *Hopkinson's Tm.*, note (1).

⁵ *Carroll's Application*, 16 R. P. C. 82 (1899) (*Princess Christian* for needles).

⁶ *Gianaclis' Tm.*, 6 R. P. C. 467; 58 L. J. Ch. 782 (1889), North, J. (*Gianaclis Cigarettes*).

⁷ *Re Price's Patent Candle Co.*, 27 C. D. 681; 54 L. J. Ch. 210 (1884), Pearson, J.

⁸ *Ibid.*, and *Bradley's Tm.*, 9 R. P. C. 205 (1892), Chitty, J.; (*Worth's Corsets*) printed between two co-axial ovals.

The corresponding essential particular in the Act of 1883 was as follows :—

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

Under the Act of 1875 the latter words of the clause ran “ of an individual or firm.” The addition “ applying for registration ” was effected by the Act of 1883. A trader can now register the signature of his predecessor in business under this sub-section. Under the old clause (b) this could not have been done, but it is possible that a signature might have been registered under the old clause (a),¹ and a signature of a predecessor could probably have been registered as an old mark.² Of course, the signature of a predecessor in business, properly registered by him and assigned or transmitted as a trade mark, together with the goodwill of the business, is usually as available for use by the successors, and can be as readily protected, as if it had been originally registered by them.³ The words “ written signature of a firm ” were construed by the Comptroller to mean a signature (actually used in the ordinary course of business) of the trading style under which the applicant had a *bonâ fide* right to trade, and which consisted of a *personal name* or of *personal names*, and not to include mere descriptive trading styles, such as *The Excellent Tea Co.* or *The London Stout Co.*⁴ In a recent case under the Act of 1888, “ Macfarlane & Co.,” which had been registered as a signature, was ordered to be removed from the Register, it being admitted that it was an adopted trade name and not the signature of an existing firm.⁵

Copies of written signatures were frequently protected as trade marks, or as material parts of trade marks, before the Acts.⁶ Requirements for a good trade mark. As a man's signature has for several centuries been the mark in universal use to authenticate documents which are his, it might have been expected that it would have been used also to authenticate his goods, and that signatures would have occupied a more prominent place among trade marks than they do. There are, however, several objections to a signature as a trade mark. A

¹ This is discussed in the 2nd ed. of this work, p. 129.

² As to old marks, see below, p. 198.

³ See Chap. XIII., p. 345, Assignment and Devolution of Trade Marks.

⁴ Notice in the Trade Marks Journal, January 1st, 1896.

⁵ *Macmillan v. Ehrmann Bros., Ltd.*, 21 R. P. C. 357 (1904), Buckley, J.

⁶ As in *Farina v. Silverlock*, 1 K. & J. 509; 6 De G. M. & G. 214; 24 L. J. Ch. 632; 26 L. J. Ch. 11; and 4 K. & J. 650 (1855), Wood, V.-C., and Ld. Cranworth.

good trade mark must not only enable a customer to recognise the goods which bear it, when he sees them, as those of the manufacturer or trader with whom he wishes to deal, but must also enable him to describe and call for them. As regards the latter requirement, a signature is usually nothing more than a bare name mark, for the manner of writing it will rarely be such as to enable even a person who could read and recognise it at sight to recollect and describe it; and it is obvious that for customers—some foreigners, for instance—who are unable to read the signature, it, or indeed any name mark, fulfils neither of the requirements referred to. Another disadvantage of a signature as a trade mark is that the protection afforded is very narrow. Thus, a trade mark of which the signature of one of the complainers (it being a Scotch case), Daniel Crawford, was the essential particular was held not to be infringed by a facsimile of the signature of the respondent, Robert Crawford, and apparently the judgment would have been the same although the names had been identical. Lord Kyllachy, after pointing out that the case put forward was purely a trade mark case, said: “Now it is new to me that a man who has a registered trade mark or facsimile of his own signature can complain of another trader using as a trade mark a facsimile of his own merely because the two names happen to be the same;” and, without hearing evidence, he decided that the case was not sustainable.¹

Word Marks.

Words as
trade marks.

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

Word marks were common enough before the Registration

¹ *Crawford & Son v. Bernard & Co.*, 11 R. P. C. 580 (1894); and cf. *Barber v. Manico*, 10 R. P. C. 93 (1893), where Smith, L.J., sitting as a judge of first

instance, held that the words *Edward Barber* were not an infringement of an old trade mark consisting of the words *Era James Barber, Sheffield*.

Acts, and provision has been made in all of these for the registration of any special and distinctive word or words used as trade marks before August 13th, 1875, the date on which the Act of 1875 came into operation, and also, under sections already considered, for the registration of the name of an individual or firm printed, &c., in some particular and distinctive manner, and of a written signature or copy of a written signature. Except such old marks, names, and signatures, no other word marks could be registered under the Act of 1875.¹ This was altered by the Act of 1888, which, under sec. 64 (1) (c), allowed the registration of "a fancy word or words not in common use." The expression "fancy word," however, gave rise to considerable differences of opinion as to its meaning, and after the report of Lord Herschell's Committee it was struck out of clause (c), and the two new clauses (d) and (e) were substituted for it.² These clauses allowed the registration of: (d) "an invented word or invented words"; and (e) a "word or words having no reference to the character or quality of the goods, and not being a geographical name."

The portion of the report above referred to, which relates to this subject, was as follows³:—"It will be convenient to consider first what words ought to be allowed as trade marks. There can be no objection to permitting the registration of an invented word not to be found in the vocabulary of our own or any other country. It seems, further, that existing words may with advantage be permitted as trade marks, subject to limitations which at once suggest themselves. It is manifest that no one ought to be granted the exclusive use of a word descriptive of the quality or character of any goods. Such words of description are the property of all mankind, and it would not be right to allow any individual to monopolise them and exclude others from their use. Again, geographical words, which can be regarded as descriptive of the place of manufacture or sale of the goods, are open to obvious objections. One manufacturer

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

Geographical names.

¹ *Ex parte Stephens*, 3 C. D. 659; 46 L. J. Ch. 46 (1876), Jessel, M.R. (*Acilyton*); *Rose v. Evans*, 48 L. J. Ch. 618 (1879), Hall, V.-C. (*Limetta*); see per Lindley, L.J., in *Van Duzer's Tm.*, 34 C. D. 623; 4 R. P. C. 31 (1887).

² Act of 1888, sec. 10.

³ Report of 1888; p. xi. On a question of construction of the Act of 1888,

it is permissible to refer to this report in order to ascertain the evils which the Act was directed to remedy, per Ld. Halsbury, L.C., in *Eastman Photographic Materials Co.'s Application*, [1898] A. C. 571; 15 R. P. C. 476. The passage given in the text was from the words "It is manifest," quoted by Ld. Halsbury.

or merchant cannot properly be allowed to prevent all his competitors from attaching to their goods the name of the place of their manufacture or sale. The mischief would not be the same where the person seeking to register was the first person who had manufactured or sold the goods in the place the name of which he seeks to appropriate as a trade mark. But there are objections to giving a monopoly even in that case, and to attempt to draw any such distinction would be likely to lead to difficulty and litigation.¹ We think, therefore, that geographical names ought only to be permitted where they clearly could not be regarded as indicative of the place of manufacture or sale. We would add upon this point that we think that where any English word would be rejected as not entitled to registration, no person ought to be permitted to register its translation into any other language. The question has been raised whether a word having the same sound as one entered on the Register, though spelt differently and with a different meaning, should be registered. The question in such a case would seem to be whether the resemblance between the old mark and that applied for was such as to be calculated to deceive; if it were, it ought, of course, to be rejected."

Translated words.

Phonetic equivalents.

The old clauses (d) and (e) introduced by the Act of 1888 are now replaced by paragraphs (3) and (4) of sec. 9 of the Act of 1905, but paragraph (3) is exactly the same as clause (d), namely, "an invented word or invented words," and paragraph (4) differs only in slight respects from clause (e), the differences being in favour of applicants for registration. It is as follows:—"A word or words having no *direct* reference to the character or quality of the goods, and not being *according to its ordinary signification* a geographical name or a surname." The words italicised are new, but surnames were in practice refused registration.

Special restrictions as to the registration of words in the cotton classes are contained in sec. 64 (10) of the Act of 1905.²

A Fancy Word or Words not in common use.³

As already stated, the meaning of these expressions gave rise to considerable differences of opinion, and, since the marks

¹ See Chap. II., at p. 49.

² See above, p. 125.

³ A fancy word was a good trade

mark before the Acts. "The more ridiculous it is, the better it is"; Wood, V.-C., in *Young v. Macrae*, 9 Jur.

registered under the Act of 1883 are still governed by that Act,¹ subject to the provisions of sec. 36 of the present Act,² it is necessary to consider the cases. Before the date of the amending Act a definition of *fancy word* had been laid down by the Court of Appeal which seemed to be fairly clear and precise.

In *Lloyd & Sons' Trade Mark*,³ Chitty, J., in the year 1893, summed up the result of the decisions to that time in the following passage: "To be a fancy word, the word must be obviously meaningless as applied to the article in question. On that principle the Court has held that the term *Gem*,⁴ with reference to a gun, is not a registrable fancy word; with reference to hair restorer, that the word *Melrose*⁵ is not a fancy word; with reference to velveteen, that the word *Electric*⁵ is not a fancy word; and with reference to lace, the opinion of Lord Justice Cotton appears to have been that the term *Alpine*⁶ was not a fancy word. These are some of the numerous illustrations that may be given of what may be thought by some to be the severe and strict construction which the Courts put upon the 64th section. There is another case, which I may also usefully mention, which is the case of *Jubilee* with reference to note paper." The last-mentioned word was also held not to be a fancy word.⁷ The severity of construction, of which Chitty, J., spoke, has, however, been somewhat relaxed by later decisions of the Court of Appeal, referred to below, which appear to have the effect of confining the rules laid down by the earlier decisions of the Court to words which were either ordinary English words, or very slight modifications of such words,⁸ fancifully applied, or, perhaps it would be more correct to say, to words other than newly coined words.

Fancy words.

The leading cases are the consolidated appeals of *Van Duzer's*

Van Duzer's case.

(N. S.) 322 (1862). The expression "fancy word" was well understood as being the antithesis of a descriptive word: see *Wotherspoon v. Currie*, L. R. 5 H. L. 508, *Id.* Hatherley at p. 514 (1872); *Hirst v. Denham*, 14 Eq. 542 (1872), Bacon, V.-C.; *Blair v. Stock*, 52 L. T. 123 (1885), Kay, J.; *Alpine Tm.*, 29 C. D. 877 (1885), Chitty, J.

¹ *Meyerstein's Tm.*, 43 C. D. 604; 7 R. P. C. 114 (1890), Kay, J. (*Satinine*); *Paine's Tm.*, 9 R. P. C. 134 (1892), Kekewich, J., and *Re Tm. Bovril*, [1896] 2 Ch. 600; 13 R. P. C. 382,

Kekewich, J., and C. A.

² See above, p. 132.

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

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

⁵ *Van Duzer's Tm.* and *Leaf's Tm.*, *infra*.

⁶ 31 C. D. p. 639.

⁷ *Towgood Bros. v. Pirie & Sons*, 4 R. P. C. 67; 56 L. T. 394 (1887), Chitty, J.

⁸ As *Reversi*, see below.

Trade Mark and Leaf & Son's Trade Mark,¹ the appeals in *Re Trade Mark Bovril*,² and in *Burroughs, Wellcome & Co.'s Trade Marks*,³ all in the Court of Appeal. The first case arose out of an application to register the words *Melrose Favorite Hair Restorer*, which had been adopted by the applicants in 1880, and were identified by reputation with their goods, and with theirs alone. A label containing them had been already registered by the applicants. It was argued that, although *Melrose* happened to be the name of a place, it was registrable because of its secondary meaning, indicating the applicants' goods;⁴ that it was sufficient if the words were not "in common use" in connection with the goods in question; and that an earlier decision of Chitty, J., in *The Alpine* case,⁵ holding that a word was a *fancy word* if it were fancifully used, was right. The Court of Appeal did not assent to any of these arguments.

The fancy word must be obviously meaningless.

To be a *fancy word*, Cotton, L.J., held, a word must be one "which obviously cannot have reference to any description or designation of where the article is made, or of what character it is." So that it is not enough that it should be shown by evidence that it, in fact, has no such reference, and the incorrect or inappropriate user of a word which is descriptive does not make it a fancy word. Lindley, L.J., said: "To be a fancy word I think the word must either have, to ordinary English people, to whom this Act of Parliament is addressed, no meaning, like the word *Eureka* or the word *Acilyton*, or if it has any meaning at all, it must be obviously non-descriptive⁶ when used as a trade mark"; and Lopes, L.J.,⁷ laid down the following conditions as necessary in order that a word should come within the term:—It must be obviously meaningless as applied to the article in question; it must be fanciful in its application to the article to which it is applied, in the sense of being so obviously and notoriously inappropriate as to be neither deceptive nor

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

² [1896] 2 Ch. 600; 13 R. P. C. 382, Lindley, Lopes and Rigby, L.JJ.

³ [1904] 1 Ch. 736; 21 R. P. C. 217.

⁴ This was sufficient to make the words a trade mark under the law before the Acts. See Chap. II., pp. 37 *et seq.*

⁵ 29 C. D. 877 (1885). The right of

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

⁶ 34 C. D. p. 642; "non-descriptive" was substituted for "meaningless" after a suggestion by Cotton, L.J., of "obviously not intended to be descriptive," p. 645. See also *Meaby & Co., Ltd. v. Triticine, Ltd.*, 15 R. P. C. 1 (1898), North, J.

⁷ Page 644.

descriptive, nor calculated to suggest deception or description; and, further, it must have "an innate and inherent character of fancifulness, which must not depend on evidence, and cannot be supported by evidence, to show that, in fact, it is neither deceptive nor descriptive, or calculated to be deceptive or descriptive." It must speak for itself.

In *Leaf & Son's* case the Court, applying these criteria, held that *Electric* for velveteens was not a fancy word.

The definitions given in these judgments have been cited and were followed in many subsequent cases turning upon the meaning of the expression. Thus, in *Waterman v. Ayres*,¹ the Court of Appeal held, that *Reversi* was not a fancy word for a game. Ordinary Englishmen, Cotton, L.J., said, would consider it was in some way connected with reversing, and Fry, L.J., said that, by its likeness to *reverse*, it was calculated and intended to convey to the minds of persons who read it a notion of the character of the game, and it was, therefore, not a fancy word.²

Whilst, however, there has not been, and could not have been except in the House of Lords, any dissent expressed from the definitions laid down in *Van Duzer's* and *Leaf & Son's* cases,³ a limitation appears to have been drawn in the application of those definitions. In *Densham's Trade Mark*,⁴ the Court was asked to expunge from the Register the word *Mazawattee* which had been registered in 1887 for tea, and subsequently for other articles, on the ground that the word was not a fancy word not in common use. It appeared that the word had been obtained by joining the Hindustani word *Mazadhar*, meaning luscious, to the Cingalese word *Wattee*, meaning garden or growth, and dropping out the syllable "dhar." It was contended that the word was descriptive, but the Court of Appeal, affirming Romer, J., held that it was clearly not descriptive, and was a fancy word. Lopes, L.J., whilst adhering to the previous definition of a "fancy word," expressed the opinion that the cases had gone far enough.

¹ 39 C. D. 29; 5 R. P. C. 368 (1888).

² See also *Edge's Tm.*, 8 R. P. C. 207 (1891) (*Filtered Blur*); and *Hodgson v. Sinclair*, 9 R. P. C. 22; 8 T. L. R. 45 (1891), *Britannia*, for soap.

³ See the judgment of North, J., in

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

⁴ [1895] 2 Ch. 176; 12 R. P. C. 75 and 271, Romer, J., and C. A. (Lindley, Lopes and Kay, L.JJ.).

The Borril
case.

In *The Borril* case,¹ which also came before the Courts on a motion to expunge, the word *Borril* had been on the Register for nine years in Class 42 for substances used as food. The word was new when registered, and had since been applied to meat extract and to other articles of food. Kekewich, J., refused the motion, and the applicants appealed. The decisions of the Court of Appeal in *Van Duzer's* and *Leaf's* cases were cited, and it was contended that *Borril* was not obviously non-descriptive. All the members of the Court (Lindley, Lopes and Rigby, L.JJ.) pointed out that in the cases relied on by the applicant, ordinary English words and not coined words were under consideration; they also all held that as a fact *Borril* was not descriptive. Lindley, L.J., after saying that it would be wrong to substitute for the words "fancy word" "a non-descriptive word," but that they must ask themselves fairly whether *Borril* was a non-descriptive word, said: "I think it is eminently and purely a question of fact. Now, I ask myself this: Supposing that a jury were asked whether, on November 2nd, 1886, *Borril* was a fancy word not in common use, and supposing they said, upon a direction from the judge, which I think it would be the duty of the judge to give, that, if they were of opinion that it really intelligibly described the thing sold, it would not do, could they, with that direction, screw themselves up to say that it was not a fancy word not in common use? I do not think they could. That really settles the matter." Lopes, L.J., also said: "I say to myself, What would an intelligent jury say if they were asked if *Borril* was a fancy word? If I had had to try the case, I should have told them that they must keep in their minds that this word was placed upon the Register in 1886, and that they must regard it as it stood at that time. I should have told them that to be a good fancy word it must be non-descriptive and meaningless as applied to the article to which it was intended to be applied; and if I had so told them, I do not hesitate to say that I am confident that they would have come to the conclusion that the word was not descriptive, and that it

¹ *Re Tm. Borril*, [1896] 2 Ch. 600; 13 R. P. C. 382, Kekewich, J., and Lindley, Lopes and Rigby, L.JJ. The word is an obvious derivation from *Bos* and *Viril*. Bovine and virility are ordinary English words. The word

"vril" is found in Lord Lytton's novel "The Coming Race." It is curious that the Court which rejected *Somulox* (see below, p. 167) should have accepted *Borril*.

was a good fancy word." It will be observed that, whilst the Court accepted the conditions previously laid down by it as applicable to an ordinary English word, it stated them somewhat less rigorously in the case of a newly coined word. However, in *Meaby & Co., Ltd. v. Triticine, Ltd.*,¹ North, J., held that the principle to be applied in the case of the word *Triticumina*, registered in Class 42, in respect of leaven and wheatmeal biscuits, &c., and derived from *triticum*,² was that laid down in *Van Duzer's* case, and that the word was not "obviously not intended to be descriptive," and he accordingly ordered it to be expunged. It is difficult to reconcile this decision with that in *The Bovril* case.

The expression "fancy word" was again considered by the Court of Appeal in *The Tabloid* case,³ in which the facts were that manufacturing chemists, having for some time sold compressed drugs under the word *Tablet*, in 1884 registered for substances used in pharmacy the word *Tabloid*, which they invented for the purpose, and from that date they had sold compressed drugs under that name. With some hesitation the Court held that at the date of registration the word was a fancy word not in common use. They held that the "*Bovril*" case showed that it was not necessary that the word should be absolutely unsuggestive, and that, applying the test laid down by Lindley, L.J., referred to above, the word *Tabloid* was not one "really intelligibly describing the thing sold." Cozens-Hardy, L.J., said that the swing of the judicial pendulum had been very great, and the extreme point of that swing was to be found, he thought, in that case.

The Tabloid
case.

In a recent case⁴ Neville, J., held that *Cyclostyle*, registered in 1884 in respect of stationery and apparatus for producing facsimile copies of writings and designs, was not at the date of registration a fancy word. The word had before registration been applied to a cog-wheel pen and the duplicating apparatus relating to it, and Neville, J., held that it was descriptive, first, because it was the name of a particular article, and secondly, because it gave, although in languages other than English, a combined word which did describe

The Cyclostyle
case.

¹ 15 R. P. C. 1 (1898).

² Wheat.

³ *Burroughs, Wellcome & Co.'s Tms.*, [1904] 1 Ch. 736; 21 R. P. C. 217.

⁴ *In re Gestetner's Tm.*, [1907] 2 Ch. 478; [1908] 1 Ch. 513; 24 R. P. C. 545; 25 R. P. C. 1

the article in question, and his decision was affirmed on appeal.¹

A list of words which have been held not to be "fancy words not in common use" is given on a later page.²

The decisions are only restrictive.

The propositions laid down by the Court of Appeal in the cases cited do not amount to definitions from which tests to show affirmatively that any particular word is within the meaning of the Act can be drawn. They are negative propositions only. "To say that every word is a fancy word because it is unknown to an average Englishman, would be plainly to lay down a proposition which could not be for a moment maintained, (for) there are many good English words descriptive of articles which are unknown to an average Englishman, taking a rather high standard."³

Descriptive words.

A word descriptive of, or intelligibly suggesting a description of, the origin, qualities, or uses of the goods, is not a fancy word.⁴ The word *Gem*, therefore, having come into use to indicate excellence in the article to which it is applied, is not a fancy word.⁵ And on an application to register it as a trade mark for air-guns, it was a further fatal objection that it had, by user, become descriptive of a particular class and make of gun.⁵

Words in a foreign language.

The Acts are directed to ordinary Englishmen,⁶ and the

¹ In the judgment as delivered, Neville, J., said that he did not think that "a word is not descriptive because from the description alone you could not possibly either make the article or form an absolute and definite conclusion as to what shape or character the article would take": 24 R. P. C. at pp. 548, 549. The passage is omitted in the revised judgment in the Law Reports, perhaps, as being not wholly consistent with the judgment in the *Tabloid* case.

² Page 156, below.

³ Per Chitty, J., in *Davis v. Stribolt*, 6 R. P. C. p. 241; 59 L. T. 854 (1888), *Bökol*, the name of a Norwegian beer, rejected as a trade mark for the beer.

⁴ "Descriptive" does not necessarily mean accurately so, but descriptive for practical and popular purposes, per Rigby, L.J., in *Reddaway v. Banham*, [1895] 1 Q. B. 297; 12 R. P. C. at p. 91.

⁵ *Arbenz's Tm.*, 35 C. D. 248; 4 R.

P. C. 143 (1887). So held by the C. A., reversing Kay, J., whose judgment was delivered before that of the C. A. in *Van Duzer's* case. In *Gestetner's Tm.*, [1907] 2 Ch. 478; 24 R. P. C. 545, *Cyclostyle* was held to be the name of the article, and not a fancy word: affirmed on appeal, [1908] 1 Ch. 513; 25 R. P. C. 156. *Reversi*, *Satinine*, *Carnival*, *John Bull*, *Roadster*, and *Beatrice* are other instances, below, p. 156.

⁶ See the judgments of Lindley, L.J., in *Van Duzer's* case, and Cotton, L.J., in *Waterman v. Ayres*, supra, and of Lindley, Lopes, and Rigby, L.J.J., in *Tm. Borril*, supra, and of Kekewich, J., and Rigby, L.J., in *Magnolia Metal Co.'s Tms.*, [1897] 2 Ch. 371; 14 R. P. C. 265 and 621; *Lloyd & Sons' Tm.*, 10 R. P. C. 281 (1893) (*Carnival*); and *Buryoynce's Tm.*, 6 R. P. C. 227; 61 L. T. 39, *Oomoo*, cited below. Cf. the Report of Ld. Herschell's Committee, cited above, p. 143.

question whether the words put forward are obviously meaningless and non-descriptive in regard to the goods for which the mark is to be used, is to be tried, therefore, in the light of such information as ordinary Englishmen may be supposed to possess. It has, nevertheless, been held that *Monobrut*, which is a compound of *brut*, meaning "dry" as opposed to "sweet" in the French wine trade, and which in itself means "very dry," is descriptive, and therefore not a fancy word.¹ As already stated, *Triticumina*, for wheaten food, was held by North, J., to be "obviously descriptive" having regard to its derivation from *triticum*, wheat, and to its use in advertisements.²

The name of the goods is not a good trade mark apart from any objection under the Acts,³ and it cannot, of course, be registered under them.⁴ So that the introducers of a kind of beer, which was common in Sweden and Norway, were not allowed to retain on the Register the names by which it was ordinarily known in those countries, and under which it had been sold in England.⁵ "For the sake of caution limiting my proposition to the European languages," Chitty, J., said, "I am of opinion that, in reference to an article produced in a foreign country and imported into England where it was previously unknown and without a name, the word used in that foreign country as the common term to describe or denote the article is not a fancy word within the meaning of the Act."

Name of the goods in foreign language.

And it is clear that a word which, though not English, carries a well-understood descriptive meaning,⁶ such as *Sanitas*⁷ or *Britannia*,⁸ is not a "fancy word."

¹ *Vignier's Tm.*, 6 R. P. C. 490; 61 L. T. 495 (1889), Kay, J. Cf. *Jackson Co.'s Tm.*, 6 R. P. C. 80 (1888), where Kay, J., rejected the Chippeway Indian word *Kokoko* because it meant *Owl*, which was a common mark; but Romer, J., doubted whether he should have come to the conclusion that the word was descriptive, see *Deusham's Tm.*, [1895] 2 Ch. 176; 12 R. P. C. at p. 82; and *Davis & Co. v. Stribolt & Co.*, infra.

² *Meaby & Co., Ltd. v. Triticine, Ltd.*, 15 R. P. C. 1 (1898), North, J.

³ See Chap. II., at pp. 35 *et seq.*, and the judgment of Chitty, J., in *Barlow v. Johnson*, 7 R. P. C. 395 (1890); also *Gestelner's Tm.*, [1907] 2 Ch. 478; [1908] 1 Ch. 513; 24 R. P. C. 545; 25

R. P. C. 156.

⁴ Per Fry, J., in *Waterman v. Ayres*, supra, p. 147, note (1).

⁵ *Davis & Co. v. Stribolt & Co.*, 6 R. P. C. 207; 59 L. T. 854 (1888), Chitty, J. (*Bökol* and the Swedish form of that word).

⁶ Ld. Herschell's Committee reported that, in their opinion, "where any English word would be rejected as not entitled to registration, no person ought to be permitted to register its translation into any other language." See the whole passage cited above, p. 143.

⁷ *Sanitas Co.'s Tm.*, 4 R. P. C. 533; 58 L. T. 166 (1887), Kay, J.

⁸ *Hodgson v. Sinclair*, 9 R. P. C. 22 (1891), Chitty, J.

This rule does not, however, extend to exclude words taken from a barbarous language. So that the word *Oomoo*, which was said to mean "choice" or "select" among some of the Aborigines of Australia, was held by Chitty, J., to be a fancy word notwithstanding. "If it does mean choice," the judge said, "or if it ever meant choice in the Aboriginal language of Australia, it does not mean choice to an ordinary Englishman, or to a sufficient number of Englishmen in this country, to enable me to say it has a meaning."¹

Names of
common
marks.

The name suggested by a mark which is common to the trade is not a fancy word, and this rule was held to apply where the word was the name in the unwritten language of an uncivilised tribe, the Chippeway Indians, to whom the trade in the goods in question was not shown to have extended.² It is, however, difficult to reconcile this with the rule already referred to that the Acts are directed to ordinary Englishmen, or to reconcile with it the case last stated, which was decided a few months later.

Secondary
distinctive
meaning does
not constitute
a fancy word.

In *The Singer* cases, and other cases of word marks before the Acts, the contest was whether the name was that of the article merely, or whether it had acquired a secondary meaning identifying the article with the owners of the marks;³ but under the Acts of 1883 and 1888 such secondary meaning, so far as regards the right to registration,⁴ is immaterial in the case of marks not used as trade marks before August 13th, 1875. It cannot make a word a fancy word within the Act of 1883,⁵ or an invented word within the Act of 1888 or 1905; it may have an important bearing, however, under paragraph (5) of sec. 9 of the Act of 1905.⁶

Geographical
words.

In *Van Duzer's* case both Cotton and Lindley, L.JJ., refused to hold that no geographical name could possibly be a fancy word. And Lindley, L.J., said⁷: "If you pick out some name which no Englishman ever heard of, such as *Penj Deh*, to which

¹ *Burgoyne's Tm.*, 6 R. P. C. 227 ; 61 L. T. 39 (1889) ; but cf. the case next cited.

² *Jackson Co.'s Tm.*, 6 R. P. C. 80 (1888), Kay, J., *Kokoko*, meaning owl ; but see *supra*, p. 151, note (1).

³ Chap. II., at p. 39.

⁴ It may have an important bearing upon passing off cases, see *Reddaway v.*

Banham, [1896] A. C. 199 ; 13 R. P. C. 218, and Chap. XVI., p. 508.

⁵ *Van Duzer's Tm.*, 34 C. D. 623 ; 4 R. P. C. 31 (1887), C. A. ; *Sanitas Co.'s Tm.*, 4 R. P. C. 533 ; 58 L. T. 169 (1887) ; and see below, p. 183.

⁶ See below, p. 173.

⁷ 34 C. D. p. 643.

our attention was called some years ago, I do not know that that would not do. It conveys no meaning to an Englishman, and such a geographical name, for all I know, may be a fair and proper fancy word." But, as was held in that case, a name which is known to be that of a place from which the goods might come is not registrable.¹ So, in *The Apollinaris* case, the Court decided that the names of the springs from which the mineral waters came, and which were not the property of, or wholly controlled by, the traders who sought to appropriate the names as trade marks, could not be registered.² The word *Britannia*³ has also been held to be objectionable on the ground that it is a geographical word.

If a word which would not ordinarily be understood to be geographical is also the name of a place, it was not necessarily to be treated under the Act of 1888, as the name of a place for trade mark purposes. Apart from special circumstances, as, for instance, a connection between the goods and the place, the question is what meaning the word would bear ordinarily to ordinary people.⁴ Thus the word *Magnolia* was not held to be a "geographical name," merely because there were several places of that name in the United States, from which country the goods came.⁴ And in *Clement et Cie.'s Trade Mark*,⁵ Kekewich, J., held *St. Raphael* not to be geographical, as it was not shown that the words were adopted with the intention of referring to any place of that name. Under the Act of 1905, the limitation given to "geographical name" in *The Magnolia* case is adopted; the words of the Act are "not being according to its ordinary signification a geographical name."⁶ Although the primary signification be not geographical, the real or imputed connection of the article with the locality may make the name a

¹ See also *Ball's Tm.*, 6 R. P. C. 493 (1889), Chitty, J., *Brymbo*, for steel.

² [1891] 2 Ch. pp. 203, 221; 8 R. P. C. 137, C. A. "*Apollinaris*" has now been held to be a word "deemed to be a distinctive mark" under para. (5) of sec. 9 of the Act of 1905, [1907] 2 Ch. 178; 24 R. P. C. 436, Kekewich, J.

³ *Hodgson v. Sinclair*, 9 R. P. C. 22 (1891), Chitty, J. Compare *Painc's Tm.*, 9 R. P. C. 130; 61 L. J. Ch. 365 (1892), Kekewich, J., in which *John Bull Brand* were held not to be "fancy

words" because of their reference to England or the English. Kekewich, J., said that he was not sure that the words were not a geographical name.

⁴ *Magnolia Metal Co.'s Tms.*, [1897] 2 Ch. 371; 14 R. P. C. 265 and 621, Kekewich, J., and Lindley, Lopes, and Rigby, L.JJ., and see "geographical name," below, p. 170.

⁵ [1900] 1 Ch. 114; 16 R. P. C. 173; Court of Appeal, 16 R. P. C. 611. There was no decision on this point.

⁶ See below, p. 170.

“geographical name” for the purpose of the Act of 1888.¹ It is submitted that the same considerations would be applicable in deciding whether such a word would be disqualified to be a “fancy word not in common use” by reason of being geographical.

It seems that the name of the factory from which the goods bearing the mark come is not a geographical word within the meaning intended.²

“Geographical words,” which can be regarded as descriptive of the place of manufacture or sale of the goods,” Lord Herschell’s Committee reported,³ “are open to obvious objections. One manufacturer or merchant cannot properly be allowed to prevent all competitors from attaching to their goods the name of the place of their manufacture or sale. The mischief would not be the same where the person seeking to register was the first who had manufactured or sold goods in the place the name of which he seeks to appropriate as a trade mark.⁴ But there are objections to giving a monopoly even in that case, and to attempt to draw any such distinction would be likely to lead to difficulty and litigation. We think, therefore, that geographical names ought only to be permitted where they clearly could not be regarded as indicative of the place of manufacture or sale.”

Name of a person.

The name of a person,⁵ even though the person be a mythical person,⁶ is not a fancy word, and the name of an individual registrable under (a) could not be registered under sec. 64 (1) (c) of the Act of 1883 as a fancy word.⁷

¹ *Magnolia Metal Co.’s Tms.*, supra.

² *Pinto v. Bulman*, 8 R. P. C. 181 (1891), C. A.; and see *Hall v. Barrows*, 4 De G. J. & S. 150; 32 L. J. Ch. 548; 33 L. J. Ch. 204 (1863), Romilly, M.R., and Westbury, L.C.

³ The whole passage is cited above, p. 143.

⁴ See Chap. II., at p. 50; and *Seiro v. Prozeende*, and *Wotherspoon v. Currie* and other cases there cited.

⁵ *Banks and James’ Tm.*, 12 R. P. C. 333 (1895), *Shakspeare*, Chitty, J.; and *Harris’ Tm.*, 9 R. P. C. 492 (1892), Stirling, J., where *Beatrice*, for shoes, was held not to be non-descriptive; see, however, as to this case, *Holl’s Tm.*,

[1896] 1 Ch. 711; 13 R. P. C. 118. The early case in which *The Lawford* was allowed to be registered seems to be clearly in conflict with the later decisions; (1885), W. N. 124, Pearson, J.

⁶ *Hodgson v. Sinclair*, 9 R. P. C. 22 (1891), *Britannia*, Chitty, J. The C. A., by consent, reversed the order to expunge this mark. And cf. *Paine’s Tm.*, 9 R. P. C. 130, where Kekewich, J., held the words *John Bull* not to be fancy words.

⁷ *Holl’s Tm.*, [1896] 1 Ch. 711; 13 R. P. C. 16 and 118, North, J., and Lindley, Kay, and Smith, L.JJ.; the decision was on the Act of 1893, but the principle appears applicable also to the Acts of 1888 and 1905.

A combination of words, each of which is common to the trade, is not a "fancy word."¹ Combination of words.

Not in Common Use.

In order to come within sec. 64 (c) of the Act of 1888 the word or words not only must be a fancy word or fancy words, but must not be in common use. The time to be considered is the date of application.²

In *The Alpine* case³ Chitty, J., took the view that the use referred to is to be understood to be use in the trade, and this view has been adopted also in a Scotch case, in which Lord Craighill said that the term "common use," as employed in the statute, does not necessarily import that the word must have been used commonly by all members of the community, or by people in all parts of the country. "What is enough, in my opinion," he added, "to establish common use, in the sense of the statute, is this: if it shall be shown that the word has been commonly used by persons who had occasion to use it, and who are connected more or less directly with the use of the commodity to which the term has been applied."⁴ But it is submitted that the condition suggested by the last phrase is not in accordance with the later decisions as to what are fancy words cited above,⁵ and that the construction adopted by Kekewich, J., in the more recent case of *Paine's Trade Mark*,⁶ gives the correct meaning of the Act. "I cannot think," the learned judge said, "it means simply the use applied to this trade only. It cannot mean, I think, that words are not in common use if they are not used in the trade. It must mean something wider and larger than that, and seeing that *John Bull* are two words, or a combination of words, which are in common use wherever the English language is known, I think that I must hold them to be in common use within the meaning of the Act." In a later case Chitty, J., held that *Shakspeare* was a word in common use, as being the name of many living persons.⁷

Common use, whether in the trade or popularly.

¹ *Pirie v. Goodall*, [1892] 1 Ch. 35; 9 R. P. C. 17, V. Williams, J., and C. A.; *Pirie's Parchment Bank*; and see *Perry, Davis & Son v. Harbord*, 15 App. Ca. 316; 7 R. P. C. 336 (1890) (*Perry-Davis' Vegetable Pain Killer*).

² *Re Tm. Bovril*, [1896] 2 Ch. 600; 13 R. P. C. 382.

³ 29 C. D. 877 (1885).

⁴ *Stuart & Co. v. Scottish Val de Travers Paving Co.*, 13 Sess. Cas. 4 Ser. 1 (1885), *Granolithic stone*. The word was held to be in common use.

⁵ Pages 144 *et seq.*

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

⁷ *Banks and James' Tm.*, 12 R. P. C. 333 (1895).

The extent of user which amounts to "common use" has not been defined, but it was decided that the words *Tower Tea*, which were used by the plaintiff and the defendant in the case of the *Great Tower Street Tea Co. v. Smith*, and by three other persons in the tea trade, and of which the word *Tower* was used by several traders in other trades, were words in common use.¹ On the other hand, the mere use by a single person, other than the applicant for registration, at an exhibition in this country, of a word which is not known in the trade concerned, does not amount to common use within the clause.² The phrase may be compared with "common to the trade" in sec. 74 of the Act of 1883 and sec. 15 of the Act of 1905.³

"The" prefixed to word.

Words which are not entitled to registration as fancy words do not become so entitled by having the definite article prefixed to them.⁴ This is clear from the definitions cited above. A different view was taken by the Comptroller⁵ when first the Act of 1883 came into operation, and before the decision of *Van Duzer's* case.

Examples from decided cases.

The following words have been held not to be fancy words not in common use⁶: ALPINE embroidery, p. 155; APOLLINARIS water, *Apollinaris Co.'s Tm.*, [1891] 2 Ch. pp. 202, 221; 8 R. P. C. 137; BEATRICE shoes, *Harris' Tm.*, 9 R. P. C. 492;⁷ BEN LEDI whiskey, *Ainslie & Co.'s Tm.*, 4 R. P. C. 212; BÖKOL beer, p. 151; BRITANNIA soap, pp. 153 and 154; BRYMBO iron (Brymbo being a place in Wales), p. 153; CARNIVAL cigarettes, p. 145; COMPACTUM for umbrellas, *Davis' Tm.*, 14 R. P. C. 903; CYCLOSTYLE (for stationery and duplicating apparatus), *Gestetner's Tm.*, [1907] 2 Ch. 478; [1908] 1 Ch. 513; 24 R. P. C. 545; 25 R. P. C. 156, *supra*, p. 149; ELECTRIC velveteen, p. 147; ELECTROID anti-fouling composition, *Hannay's Tm.*, 7 R. P. C. 46; EMOLLIO cream, *Gros-smith's Tm.*, 6 R. P. C. 180; 60 L. T. 612; EMOLLIORUM dubbing, *Talbot's Tm.*, 11 R. P. C. 77; (1894), W. N. 12; FRIEDRICHSHALL

¹ *Great Tower Street Tea Co. v. Smith*, 6 R. P. C. 165; 5 T. L. R. 232 (1889), North, J.

² *Burgoyne's Tm.*, 6 R. P. C. pp. 230, 232; 61 L. T. 39 (1889), Chitty, J. (*Oomoo*); and see *Ripley v. Baudry*, 14 R. P. C. 591 and 944 (1897).

³ See Chap. IX., p. 212.

⁴ *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and

C. A. (*The Self-Washer*).

⁵ See the *Alpine Tm.*, 29 C. D. 877 (1885).

⁶ The pages referred to are those of this book.

⁷ This was on the ground that a reference to the Princess would be imputed. See, however, *Holl's Tm.*, [1896] 1 Ch. 711; 13 R. P. C. 118 (*Tribby* for gloves, blouses, &c.).

water, *Apollinaris Co.'s Tm.*, [1891] 2 Ch. 186; 8 R. P. C. 137; GEM air-guns, p. 145; GRANOLITHIC stone, *Stuart v. Scottish Val de Travers Paving Co.*, 13 Sess. Cas., 4 Ser. 1; HAND GRENADE FIRE EXTINGUISHER, *Harden Star, &c. Co.'s Tm.*, 8 R. P. C. 132; 55 L. J. Ch. 596; HERBALIN (a medicine), *Humphries v. Taylor's Drug Co.*, 59 L. T. 820; HUNYADI JANOS water, *Apollinaris Co.'s Tm.*, supra; JOHN BULL and JOHN BULL BRAND beer, p. 155; JUBILEE note paper, p. 145; KOKOKO cotton goods, p. 151, note (1), and p. 152; MANOR tin-plates, *Thompson's Tm.*, 6 R. P. C. 213; MELROSE hair restorer, p. 146; MONOBRUT champagne, p. 151; RED, WHITE AND BLUE coffee, *Hanson's Tm.*, 37 C. D. 112; 8 R. P. C. 130; REVERSI (for a card game), p. 147; ROADSTER (for boots), *Thompson's Tm.*, 13 R. P. C. 35; SANTAS (for a disinfectant), *Sanitas Co.'s Tm.*, 4 R. P. C. 533; 58 L. T. 166; SELF-WASHER and THE SELF-WASHER SOAP, *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492; SHAKSPERE (for cigarettes, &c.), *Banks and James' Tm.*, 12 R. P. C. 333; TOWER tea, *Great Tower Tea Co. v. Smith*, 6 R. P. C. 165; TRITICUMINA (for wheaten biscuits, &c.), *Meaby & Co., Ltd. v. Triticine, Ltd.*, 15 R. P. C. 1; WASHERINE soap, *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482; ZEPHYR ASIATIC WALNUT PIPE, *Friedlander's Tm.* (1885), W. N. 85.

The only reported instances of words decided to be within the clause are the words ALPINE (for embroidery), p. 155, *Re Tm. Alpine*, 29 Ch. D. 877;¹ BOVRIL (for foods), p. 148, [1896] 2 Ch. 600; 13 R. P. C. 382; MAZAWATTEE (for tea), p. 147, *Densham & Son's Tm.*, [1895] 2 Ch. 176; 12 R. P. C. 75 and 271; OOMOO (for wine), *Burgoyne's Tm.*, 6 R. P. C. 227 (1889), supra, p. 152; TABLOID (for medicines and preparations of food), *Burroughs, Wellcome & Co.'s Tms.*, [1904] 1 Ch. 736; 21 R. P. C. 217; and THE LAWFORD (for tennis racquets) (1885), W. N. 124 (Pearson, J.). The decision in *The Alpine* case was subsequently disapproved by the Court of Appeal,² and that in the last case is certainly not in accord with the interpretation subsequently put upon the clause under which the registration was allowed.³ Great numbers of words have, however, been registered by the Comptroller as fancy words without objection.

¹ As to this decision see, however, *Van Duzer's Tm.*, and *Leaf's Tm.*, 34 C. D. 623; 4 R. P. C. 31.

² *Alpine Tm.*, 29 C. D. 877 (1885), Chitty, J.; see above, p. 146.

³ See above, p. 155.

Invented
words.

(3) "An invented word or invented words."

The Solio
case.

This paragraph is the same as clause (d), which was, with clause (e),¹ substituted for "fancy word or words not in common use" by sec. 10 of the Act of 1888, upon the recommendation of Lord Herschell's Committee which has been already quoted.² The leading authority on the present clause is *The Solio* case³ in the House of Lords, in which several points were decided. Lord Halsbury, L.C., in his speech referred to the report of that Committee, and both he and Lord Herschell considered that the decisions on the expression "fancy word" had no bearing on the interpretation of the provisions substituted by the Act of 1888.⁴ The House of Lords further overruled the decisions in several earlier cases, including that of the Court of Appeal⁵ in *The Somatose* case, to the effect that clauses (d) and (e) of sec. 10 of the Act of 1888 must be read conjunctively, and not as alternatives. *The Solio* case came before the Courts on an appeal from the Comptroller's refusal to register the word *Solio* for photographic paper, the refusal being on the grounds (*inter alia*) that the mark did not consist of an essential particular, and that it had reference to the quality or character of the goods. Kekewich, J., and the Court of Appeal upheld the refusal to register,⁶ on the ground that the word suggested the sun, and had reference to the character and quality of the goods, and that therefore (following the decision of the Court in *The Somatose* case) it was not registrable as an invented word. The Lord Chancellor did not deal with the point explicitly, but all the other members of the House who took part in the decision⁷ said that clauses (d)

¹ A word or words having no reference to the character or quality of the goods, and not being a geographical name.

² Above, p. 143.

³ *Eastman Photographic Materials Co., Ltd.'s Application*, [1898] A. C. 571; 15 R. P. C. 476.

⁴ This view had been previously expressed by Lindley, L.J., in *The Somatose* case, *Farbenfabriken Vormals Bayer & Co.'s Application*, [1894] 1 Ch. 645; 11 R. P. C. 84.

⁵ *Farbenfabriken, &c. Co.'s Tm.*, supra, note (4), Lindley, Kay, and Smith, L.JJ., all concurring on this point; the other cases overruled are *Meyerstein's*

Application, 43 C. D. 604; 7 R. P. C. 114 (1890), Kay, J.; and *Talbot's Tm.*, 11 R. P. C. 77; (1894), W. N. 12 (*Emolliolorum*), in which Stirling, J., followed the decision of Kay, J. In *Densham & Son's Tm.*, [1895] 2 Ch. 176; 12 R. P. C. 271, Lindley, Lopes, and Kay, L.JJ., took the same view, although, having regard to the facts, the point did not call for decision.

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

⁷ Lds. Herschell, Macnaghten, Morris, and Shand.

and (e) must be treated as independent clauses, and there is no reason to suppose that the Lord Chancellor differed from their judgments. Lord Herschell said that he could not find any justification for qualifying the provision “(d) an invented word or words” by the condition that they should have no reference to the character or quality of the goods, and he went on to point out that under (e) any word in the English language might serve as a trade mark, and that different considerations therefore arose under clauses (d) and (e). “If, then, the use of every word in the language was to be permitted as a trade mark, it was surely essential to prevent its use as a trade mark where such use would deprive the rest of the community of the right which they possessed to employ that word for the purpose of describing the character or quality of goods. But with regard to words which are truly invented words—words newly coined—which have never heretofore been used, the case is, as it seems to me, altogether different; and the reasons which required the insertion of the condition are altogether wanting. If a man has rightly invented a word to serve as his trade mark, what harm is done, what wrong is inflicted if others be prevented from employing it, and its use is limited in relation to any class or classes of goods to the inventor? So far, then, from seeing no reason for a distinction between the particulars designated in (d) and (e), there seems to me abundant reason for not interpolating in (d) words which the Legislature has used only in relation to (e).”

(d) not qualified by (4).

Since *The Solio* case the law is therefore settled that an invented word is not debarred from registration as a trade mark by reason of its referring to the character or quality of the goods.¹ Lord Macnaghten said: “If it is an invented word—if it is ‘new and freshly coined’ (to adapt an old and familiar quotation)—it seems that it is no objection that it may be traced to a foreign source, or that it may contain a covert and skilful allusion to the character or quality of the goods. I do not think that it is necessary that it should be wholly meaningless.” It was decided that the word *Solio* was an invented word, and accordingly capable of registration; and Lords Halsbury, Herschell and Macnaghten disapproved of the suggestion that

¹ *Kodak. Ltd. v. London Stereoscopic &c. Co., Ltd.*, 20 R. P. C. 337 (1903), Swinfen Eady, J., at p. 350.

the word referred to the character or quality of the goods; in fact, one of the main reasons given by Lord Halsbury for his judgment was that the word did not indicate the character or quality of the goods.

Quantum of invention.

Foreign word not necessarily debarred.

The determination of the standard of invention to be applied is both an important and difficult matter. It is clear from *The Solio* case that the mere fact that the word exists in a foreign language, whether modern or classical, is not sufficient to exclude a word, if it really is invented. Thus, neither the fact of the existence of an Italian word *solio* meaning throne, or of a Latin word in the ablative case with the same meaning, prevented *Solio*, which had, in fact, been invented for the purpose of a trade mark, from being entitled to registration.¹ On the other hand, the fact that the word is a foreign word does not make it an invented word in England.² It was said in the same case that words which are in sound ordinary English words, but are misspelt, are not eligible.³ The following are passages from the judgments in *The Solio* case on this point. Lord Halsbury said: "I desire to give my opinion with reference to the particular word, and not to go behind it. I can quite understand suggesting other words—compound words, or foreign words—as to which it would be impossible to say that they were invented words, although, perhaps, never seen before, or that they did not indicate the character or quality of the goods, although as words of the English tongue they had never been seen before. Suppose a person were to attempt to register as a single English word *Cheapandgood*, or even without taking so gross an example, using a word so slightly differing from an ordinary and recognised word as to be neither an invented word nor, avoiding the prohibited choice of a word, indicating character or quality. The line must be sometimes difficult to draw; but, to my mind, the substance of the enactment is intelligible enough, and the Comptroller has to make up his mind whether in substance there has

¹ See also *Field, Ltd. v. Waget Syndicate, Ltd.*, 17 R. P. C. 266 (1900), Buckley, J. (*Saronol*).

² See Ld. Herschell's judgment quoted below, p. 161.

³ See especially Ld. Halsbury's judgment and that of Ld. Herschell. The point had been so decided by Kekewich, J., and the Court of Appeal in *Ripley's Application*, 15 R. P. C. 151

(1898) (*Pirle*). *Unceda* has been held not to be an invented word, being a mere mis-spelling of "You need a": *National Biscuit Co.'s Application*, [1901] 1 Ch. 550; [1902] 1 Ch. 783; 18 R. P. C. 170; 19 R. P. C. 281, Cozens-Hardy, J., and C. A. See also *Christy v. Tipper*, [1904] 1 Ch. 696; [1905] 1 Ch. 1; 21 R. P. C. 97, 755 (*Absorbine*), Joyce, J., and C. A.

been an infringement of the rule." Lord Herschell, referring to the observation of Kay, J., in *The Satinine* case,¹ that there was extremely little invention, said: "It may be that the word *Satinine*, which was there in question, was objectionable on other grounds, but if the word be an 'invented' one, I do not think the quantum of invention is at all material. An invented word is allowed to be registered as a trade mark, not as a reward of merit, but because its registration deprives no member of the community of the rights which he possesses to use the existing vocabulary as he pleases. It may, no doubt, sometimes be difficult to determine whether a word is an invented word or not. I do not think the combination of two English words is an invented word, even although the combination may not have been in use before; nor do I think that a mere variation of the orthography or termination of a word would be sufficient to constitute an invented word, if to the eye or ear the same idea would be conveyed as by the word in its ordinary form."² Again, I do not think that a foreign word is an invented word simply because it has not been current in our language. At the same time, I am not prepared to go so far as to say that a combination of words from foreign languages so little known in this country that it would suggest no meaning except to a few scholars, might not be regarded as an invented word. It is in this respect that I desire to qualify my assent to Lord Justice A. L. Smith's proposition that an invented word can never have a meaning." A passage from Lord Macnaghten's judgment is quoted above.³ Lord Shand said: "I agree . . . in thinking, especially after the decision to be given in this case, that the Comptroller-General will be fully warranted in taking care that there shall not be admitted, under the guise or cover of words called 'invented' by the applicant, words really in ordinary use, which might, in a disguised form, have reference to the character or quality of the goods. There must be invention, and not the appearance of invention only. It is not possible to define the extent of invention required, but the words, I think, should be clearly and substantially different from any word in ordinary and common use. The employment of a word in such use, with a diminutive or a short and meaningless syllable added to it, or a mere combination of two known words, would not be an 'invented' word, and a

¹ *Meyerstein's Tm.*, 43 C. D. 604; 7 R. P. C. 114 (1890).

² See *Unceala* case, p. 160. note (3).

³ Page 159.

word would not be 'invented' which, with some trifling addition or very trifling variation, still leaves the word one which is well known or in ordinary use, and which would be quite understood as intended to convey the meaning of such a word." In a subsequent case,¹ much reliance was placed on the last-quoted passage by the applicants, who were applying to expunge the registration of the word *Saronol*, which had in 1890 been registered for common and soft soaps. They contended that the French word *saron* was used in the soap trade in this country, and that *Saronol*, being merely the word *saron* with a termination, was not an invented word. Buckley, J., held the word to be an invented word, even although *saron* had been used as alleged, and said that he did not understand Lord Shand as meaning to express anything differing from the other Lords.

Variations of ordinary words.

Before the decision in *The Solio* case, registration of a word as an invented word was difficult to obtain, but it afterwards under the Act of 1888 became the practice at the Patent Office to accept for registration, as invented words, words which had very little invention indeed, but were merely ordinary English words having a slight variation in or a slight addition to them.² In such cases, however, the Comptroller required a disclaimer of the part formed by the common word, thus *Fireproofine* has been accepted with a disclaimer of "fireproof." It would seem that a disclaimer of the kind referred to does not help to qualify a word as an invented word,³ although it may protect the public from what would otherwise be the consequence of registration. Thus an application to remove from the Register the word *absorbine*, which had been registered and used for an absorbent preparation, the exclusive use of "absorb" being disclaimed, was successful. The word was held to be a mere variation of the word absorb.⁴

The result of the cases is that a mere ordinary addition to, or misspelling or variation of, a word in use in the English language

¹ *Field, Ltd. v. Wajel Syndicate, Ltd.*, 17 R. P. C. 266 (1900).

² See an article entitled "Words as Trade Marks" in the *Solicitors' Journal* (1900), Vol. XLIV. 548, in which the following examples are given, namely, *Perfumette* for perfumes, *Enameline* for blacking, &c., *Detergene* for goods in Class 47, *Gilazo* for creams and polishes for leather, and *Fireproofine* for a fire-

proofing liquid.

³ See the case next cited.

⁴ *Christy v. Tipper*, [1904] 1 Ch. 696; [1905] 1 Ch. 1; 21 R. P. C. 97 and 755, Joyce, J., and C. A.; and cf. *Application of the Compagnie Industrielle des Petroles*, [1907] 2 Ch. 435; 24 R. P. C. 585, Warrington, J., *Motorine* upheld under para. (4) of sec. 9.

does not make the word so formed an invented word, but the question in each case is one of fact.

Before the Act of 1905, letters not being essential particulars, the Comptroller objected to register names of letters;¹ however, since the definition of "mark" in sec. 3 includes "letter," it is assumed that there would not be the same objection under the present Act, provided, of course, that the mark was distinctive.

Questions have arisen with respect to the meaning of the expression "invented word," first, as to the person inventing the word, and, secondly, as to point of time to be regarded. Inventor.

In *Holt's Trade Mark*,² Kay, L.J., expressed an opinion that, if the person who is seeking to register a word as an invented word has not been the inventor, or first user, he is not entitled to register it.³ The Lord Justice was, however, dealing with a case in which there had been entirely independent prior use of the word. In the *Linotype Co.'s Application*,⁴ Cozens-Hardy, J., held that it was not necessary that the applicant for registration should be the inventor of the word applied for. In that case the word, namely "Tachytype," had been invented by an American Company to distinguish their goods and had been used as part of the name of the Company, which had assigned such rights as it had in the United Kingdom in connection with the mark or name to the applicants. As to the point of time to be regarded, it was held in the case last cited that it was not necessary that there should have been no prior publication of the word in the United Kingdom before the application to register. Date of invention. Further, Swinfen Eady, J., decided in *The Kodak case*⁵ that "if a word is really a newly-invented word when adopted as a trade mark, the mark does not become invalidated because of an interval between its first user and its registration." In that case "Kodak" had been registered for photographic cameras in 1888, and had been used from that date for cameras and films,

¹ *Vest*, the Dutch equivalent of the letters V, Z, was allowed to be registered under special circumstances, and subject to a condition: *Verschure and Zoon's Application*, 22 R. P. C. 568 (1905), Warrington, J.

² [1896] 1 Ch. 711; 13 R. P. C. 118 (*Trilby*, the heroine of Du Maurier's book of that name).

³ See also the judgment of Smith, L.J.,

but Lindley, L.J. (and perhaps Smith, L.J.), decided the point on the ground that the word had become a well-known word.

⁴ [1900] 2 Ch. 238; 17 R. P. C. 380.

⁵ *Kodak, Ltd. v. London Stereoscopic, &c. Co., Ltd.*, 20 R. P. C. 337 (1903). Cf. the judgment of Lopes, L. J., in *The Borril case*, above, p. 148.

but it was not registered for films until 1891. It was held that the registration for films was good. In this case the goods, namely cameras and films, were of the same general description, namely, photographic, and the word had been applied to both substantially about the same time. In a later case¹ Warrington, J., held that in order that a word may be an "invented word," it must be coined for the first time for the purpose of being applied to the goods in question, or in other words, for the purpose of its use as a trade mark in this country; and he expressed the view, without deciding the point, that the word must be newly coined substantially at the date of the application to register it. It is submitted, however, that it is sufficient if the word was an "invented word" when first used as a trade mark for the goods, and has not by reason of other user of it, lost that character.² If, on an application to expunge a word mark, sec. 36 of the Act of 1905, which provides a saving for a trade mark registrable under that Act, is relied on, the proprietor of the mark must show that it is then registrable, and therefore, although the word may have been an "invented word" when first used for the goods, if it has become the name of the article, the section does not assist to save the mark from removal.³

A word already in existence cannot properly be said to be an "invented word," merely because the person claiming to have invented it was not aware of its existence.⁴

The following words have been held to be invented words within the meaning of the Act:—KODAK, *Kodak, Ltd. v. London Stereoscopic Co.*, 20 R. P. C. 337 (1903); KYNITE, *Kynoch & Co.'s Tm.*, 14 R. P. C. 905 (1897); MAZAWATTEE, p. 147, *Densham's Tm.*, [1895] 2 Ch. 176; 12 R. P. C. 75 and 271; NEOSTYLE, *Neostyle Manufacturing Co.'s Tm.*, 20 R. P. C. 329 (1903);⁵ SAVONOL, p. 162, *J. C. & J. Field, Ltd. v. Wagel Syndicate, Ltd.*, 17 R. P. C. 266 (1900); SOLIO, pp. 158, 159, *Eastman Photographic Materials Co.'s Application*, [1898] A. C. 571; 15 R. P. C. 476; TACHYTYPE, p. 163, *The Linotype Co.'s Application*, [1900] 2 Ch. 238; 17

¹ *Hommel v. Gebrüder Bauer & Co.*, 21 R. P. C. 576 (1904) (*Hematogen*).

² See the judgments of North, J., and the Court of Appeal in *Holl's Tm.*, [1896] 1 Ch. 711; 13 R. P. C. 118; and the *Tachytype* and *Kodak* cases cited above, p. 163.

³ *Gestetner's Tm.*, [1907] 2 Ch. 478; 24 R. P. C. 545; [1908] 1 Ch. 513;

25 R. P. C. 156, Neville, J., and C. A. But see the judgment of Parker, J., in the *Diabolo* case, cited p. 165.

⁴ Per Chitty, J., in *Sir Titus Salt & Co.'s Application*, [1894] 3 Ch. 166; 11 R. P. C. 517 (*Eboline*).

⁵ The mark was, on appeal, removed from the Register on other grounds, 20 R. P. C. 803.

R. P. C. 380; VEZET, *Verschure and Zoon's Application*, 22 R. P. C. 568 (1905).

The following words have been held not to be invented words within the meaning of the Act:—ABSORBINE, *Christy v. Tipper*, [1904] 1 Ch. 696; [1905] 1 Ch. 1; 21 R. P. C. 97 and 755; APOLLINARIS,* *Apollinaris Co.'s Tms.*, [1891] 2 Ch. 186; 8 R. P. C. 187;¹ BIOSCOPE, *Warwick Trading Co. v. Urban*, 21 R. P. C. 240 (1904);² CYCLOSTYLE, *Gestetner's Tm.*, [1907] 2 Ch. 478; 24 R. P. C. 545;³ DIABOLO, *Philippart v. Whiteley, Ltd.*, 25 R. P. C. 565, (1908); EBOLINE,* *Sir Titus Salt & Co.'s Application*, [1894] 3 Ch. 166; 11 R. P. C. 517;⁴ ELECTROZONE,* *British Electrozone Co.'s Application*, 13 R. P. C. 447 (1896);⁵ EMOLLIOLORUM,* *Talbot's Tm.*, 11 R. P. C. 77; (1894), W. N. 12;⁶ FORMALIN, *Formalin Hygienic Co.'s Application*, 17 R. P. C. 486 (1900);⁷ HÆMATOGEN. *Hommel v. Gebrüder Bauer & Co.*, 21 R. P. C. 576; 22 R. P. C. 43 (1904);⁸ PANORAM, *Kodak, Ltd. v. London Stereoscopic Co.*, 20 R. P. C. 337 (1903); PIRLE,* *Ripley & Sons' Application*, 15 R. P. C. 151 (1898);⁹ SATININE,* *Meyerstein's Tm.*, 43 C. D. 604; 7 R. P. C. 114 (1890);¹⁰ SOMATOSE,* *Farbenfabriken, &c. Co.'s Application*, [1894] 1 Ch. 645; 11 R. P. C. 84;¹¹ TRILBY,* *Holt's Tm.*, [1896] 1 Ch. 711; 13 R. P. C. 118;¹² UNEEDA, *National Biscuit Co.'s Application*, [1901] 1 Ch. 550; 18 R. P. C. 170.¹³ The cases in which an asterisk is placed against the word, were decided before the decision in *The Solio* case in the House of Lords.

(4) "A word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname."

Words having no direct reference to character or quality of the goods.

¹ *Friedrichshall* and *Hunyadi* were admittedly on the same footing as *Apollinaris*.

² It was held to be a known English word at the date of application for registration.

³ It was held to be the name of a patented article at the crucial date.

⁴ *Eboli* was shown to be the name of an Italian town of 11,000 inhabitants, and the application was for silk goods.

⁵ The word was admittedly well known in the United States.

⁶ The word was, in fact, registered under the Act of 1883.

⁷ The word was held to be the name of the article.

⁸ On the particular facts.

⁹ This case was decided on the ground of the word being a mere mis-spelling of "pearl," which could not itself be registered. Kekewich, J., did not decide whether it was an invented word or not, and the decision of the Court of Appeal does not absolutely cover the point.

¹⁰ See, however, Ld. Herschell's judgment in *The Solio* case.

¹¹ Ld. Herschell, in *The Solio* case, said that he thought it an excellent illustration of an invented word.

¹² That is to say, not at the date of registration.

¹³ Held to be a mere mis-spelling of "You need a."

Act of 1888.

Clause (e) of sec. 64 (1) of the Act of 1888, as that section was amended by the Act of 1888, was as follows:—"A word or words having no reference to the character or quality of the goods, and not being a geographical name." The object of this clause was to permit ordinary English words to be registered subject to the maintenance of the right of the public to employ them in their ordinary meaning.¹ The decisions on the clause, however, and especially those prior to *The Solio* case,² tended to prevent the registration of words having a merely indirect reference to the character or quality of the goods; the framers of the Act of 1905 therefore introduced the word "direct" to qualify "reference" with the object of extending the class of registrable words,³ or at all events of making the object of the Legislature more clear. Only two decisions on paragraph (4) of the Act of 1905 have been given by the Court. In the case of the word "motorine" registered in 1901 for lubricating oil with a disclaimer of the exclusive use of the word "motor," Warrington, J., applying sec. 36 of the Act of 1905, and therefore testing the word by the requirements of that Act, held that it had no direct reference to the character or quality of the goods.⁴ Secondly, in *The Diabolo* case, Parker, J., held that, whether that word was tested by the Act of 1888, under which it was registered, or by the Act of 1905, it ought to be removed from the Register.⁵

Iteration
made by Act
of 1905.

As the decisions under the Act of 1888 may be important in applications to remove marks registered under that Act, and as, moreover, they have a bearing on the construction of paragraph (4), they are shortly stated here.

Test applied
under Act of
1888.

The question under clause (e) was not whether the word which it was sought to place or retain on the Register had in fact any reference to the character or quality of the goods, but whether it had such a reference in appearance. For if it had, it must be either descriptive or deceptive, and in either case it was not entitled to be on the Register.⁶ Under the Act of 1905 a deceptive mark is equally debarred from registration.⁷ A

¹ See the judgment of Ld. Herschell in *The Solio* case, *Eastman Photographic Materials Co.'s Application*, [1898] A. C. 571; 15 R. P. C. 476, quoted *supra*, p. 161.

² See note (1).

³ Kekewich, J., said in *Re Apollinaris Application*, [1907] 2 Ch. 178; 24 R. P. C. 436, that the Act of 1905 is an amending Act intended to bring within the area of registration many trade marks

which could not otherwise be registered.

⁴ *Compagnie Industrielle des Pétroles, Application*, [1907] 2 Ch. 435; 24 R. P. C. 585.

⁵ *Philippart v. Whiteley, Ltd.*, 25 R. P. C. 565 (1908).

⁶ *Edge's Tm.*, 8 R. P. C. 207 (1891) (*Filtered Blue*), Stirling, J.

⁷ Sec. 11.

large number of the decisions on clause (e) have been in relation to words which, under the decision in *The Solio* case,¹ could be registered as invented words independently of the question whether or not they have a reference to the character or quality of the goods; and such decisions have now to some extent lost their importance. But in *The Solio* case,² Lords Halsbury, Herschell, and Macnaghten, differing from the view adopted by the Court of Appeal³ that *Solio* would suggest the sun, and had therefore some reference to the character or quality of the goods for which it was used, namely, photographic paper, held that it had no such reference; and, in substance, the House of Lords overruled the earlier decision in *The Somatose* case,⁴ of the Court of Appeal⁵ that, having regard to the Greek word *σωπα*, meaning *body*, *Somatose* was not a word having no reference to the character or quality of the goods, which included preparations made from meat. On the other hand, the Court of Appeal had held that *Mazawattee*, which was compounded of the Cingalese word for *garden* and part of a Hindustani word meaning *luscious*, had no reference to the character or quality of the goods, which included tea.⁶ Although clause (e) made it a condition of registration that the word should have no reference to the character or quality of the goods, this meant that in the general understanding of ordinary English people it must bear no such reference.⁷ And the fact that an ingenious mind, knowing the class of goods to which the word is applied, can find some reference through etymology or otherwise to the character or quality of the goods is not fatal to registration.⁸ Thus, the suggestion that *Trilby*, the name of the heroine in Du Maurier's book of the same name, when used as a mark for gloves, blouses, &c., would be taken to have a reference to such articles as were fit for such a person as the book describes, was said by Lindley, L.J., to be too fanciful and far-fetched.⁹ Another example is the word *Kynite*, which

¹ See clause (d), p. 158.

² *Eastman Photographic Materials Co.'s Application*, [1898] A. C. 571; 15 R. P. C. 476.

³ 14 R. P. C. 487, affirming Kekewich, J., 13 R. P. C. 707.

⁴ *Farbenfabriken Co.'s Application*, [1894] 1 Ch. 645; 11 R. P. C. 84.

⁵ Smith and Kay, L.J.J., Lindley, L.J., dissenting.

⁶ *Deansham's Tm.*, [1895] 2 Ch. 176; 12 R. P. C. 75 and 271.

⁷ See the judgment of Rigby, L.J., in *Eastman Photographic Materials Co.'s Application*, 14 R. P. C. 407, and of Kekewich, J., in *The Linotype Co.'s Application*, 14 R. P. C. 900 (1897) (*Typograph*).

⁸ See the judgment of Ld. Herschell in *The Solio* case, *supra*, p. 161.

⁹ *Holt & Co.'s Tm.*, [1896] 1 Ch. 711; 13 R. P. C. 118; and see *Ellis & Co.'s Tms.*, 21 R. P. C. 617 (1904) (*Quaker*).

has been held not to contain, by reason of the resemblance of the first syllable to the root of the word *kinetic*, a reference to the character of the goods in question, namely, explosives.¹ If a word, not originally importing a reference such as the clause contemplates, comes to be known as the name of the article, it does not, by that fact, come to have a reference to the character or quality of the goods within the meaning of the section;² thus, although *Magnolia* had come to be known as the name of an alloy, it was held not to refer to the character or quality of the goods. But, of course, a word which is descriptive of the goods, when tendered for registration, is not entitled to registration.³ And the business of the proposed user of the word may be regarded as well as the goods; thus, Kekewich, J., held that *Typograph*, a dictionary word meaning a type-making and type-setting machine, would, if registered by the Linotype Company for metals used in manufacture, have reference to the character or quality of the goods.⁴ Words that would be understood to be commendatory were held not to satisfy the condition imposed by clause (e),⁵ and a word that is a mere misspelling of a word that is not capable of registration is not admissible.⁶

Decisions
under Act
of 1888.

The following words were held not to be within clause (e), on the ground that they could not be said to have no reference to the character or quality of the goods:—*APOLLINARIS*,* for natural mineral waters, *Apollinaris Co.'s Tms.*, [1891] 2 Ch. 186; 8 R. P. C. 137;⁷ *Bioscope*, for cinematograph apparatus, *Warwick Trading Co. v. Urban*, 21 R. P. C. 240 (1904);⁸ *CENTURY*, for machinery, *Printing Machinery Co.'s Application*, 23 R. P. C. 38 (1906);

¹ *Kynoch's Tm.*, 14 R. P. C. 995 (1897), Kekewich, J.

² *Magnolia Metal Co.'s Tms.*, [1897] 3 Ch. 371; 14 R. P. C. 621, Lindley, Lopes, and Rigby, L.J., differing from Kekewich, J., on this point.

³ Thus, *Filtered Blue* for laundry blue is inadmissible: *Edge's Tm.*, 8 R. P. C. 207 (1891), Stirling, J.

⁴ *Linotype Co.'s Application*, 14 R. P. C. 900 (1897).

⁵ See the observations of Rigby, L.J., in *Ripley & Son's Application*, 15 R. P. C. 151 (*Pirle*); *Harrisons and Crossfield's Application*, 18 R. P. C. 34 (1901), Byrne, J. (*Nectar*); *National Biscuit Co.'s Application*, [1901] 1 Ch. 550; [1902] 1 Ch. 783; 18 R. P. C. 170;

19 R. P. C. 281, Cozens-Hardy, J., and C. A. (*Unceda*); and *Printing Machinery Co.'s Application*, 23 R. P. C. 38 (1906). Farwell, J. (*Century*).

⁶ See the *Pirle* and *Unceda* cases cited in the last note, and the judgments in *Eastman Photographic Materials Co.'s Application*, [1898] A. C. 571; 15 R. P. C. 476, also *The Absorbine* case above, p. 162.

⁷ The mark was intended to be used for water from the *Apollinaris* spring. *Friedrichshall* and *Hunyadi Janos* were admittedly on the same footing. *Apollinaris* has now been declared to be a distinctive mark under para. (5) of sec. 9; *In re Apollinaris Tm.*, [1907] 2 Ch. 178; 24 R. P. C. 436.

⁸ On the facts as to previous user.

EDGE'S FILTERED BLUE,* for laundry blue, *Edge's Tm.*, 8 R. P. C. 207 (1891);¹ EMOLLIORUM,* for harness, &c., *Talbot's Tm.*, 11 R. P. C. 77 (1894); HÆMATOGEN, for a medicine, *Hommel v. Gebrüder Bauer & Co.*, 21 R. P. C. 576 (1904); JOHN BULL,* for fermented liquors and spirits, *Paine's Tm.*, 9 R. P. C. 130 (1892);² NECTAR,* for tea, coffee and cocoa, *Harrisons and Crossfield's Application*, 18 R. P. C. 34 (1901); PANORAM, for a panoramic camera, *Kodak, Ltd. v. London Stereoscopic Co.*, 20 R. P. C. 337 (1903); PIRLE,* for cloth, &c., *Ripley's Application*, 15 R. P. C. 151 (1898);³ SATININE,* for starch and soap, *Meyerstein's Application*, 43 C. D. 604; 7 R. P. C. 114 (1890); SOMATOSE,* for a pharmaceutical product principally consisting of ingredients of meat, *Farben-fabriken Co.'s Application*, [1894] 1 Ch. 645; 11 R. P. C. 84; TYPOGRAPH,* for metals and certain machinery, *Linotype Co.'s Application*, 14 R. P. C. 900 (1897); UNEEDA, for biscuits and other goods in Class 42, *National Biscuit Co.'s Application*, [1901] 1 Ch. 550; 18 R. P. C. 170; [1902] 1 Ch. 783; 19 R. P. C. 281. The cases in which an asterisk is placed against the word, were decided before the decision of *The Solio* case in the House of Lords.

The following words have been held to have no reference to the character or quality of the goods:—BROWNIE, BULLSEYE, and KODAK, for films, *Kodak, Ltd. v. London Stereoscopic Co.*, 20 R. P. C. 337 (1903);⁴ KYNITE, for explosives, *Kynoch's Tm.*, 14 R. P. C. 905 (1897); MAGNOLIA, for a metal alloy known by that name, *Magnolia Metal Co.'s Tms.*, [1897] 3 Ch. 371; 14 R. P. C. 621; MAZAWATTEE, for tea, *Densham's Tm.*, [1895] 2 Ch. 176; 12 R. P. C. 75, 271; QUAKER, for fermented liquors, *Ellis & Co.'s Tms.*, 21 R. P. C. 617 (1904);⁵ SOLIO, for photographic paper, *Eastman, &c. Co.'s Tm.*, [1898] A. C. 571; 15 R. P. C. 476;⁶ TRILBY, for gloves, blouses, &c., *Holt's Tm.*, [1896] 1 Ch. 711; 13 R. P. C. 118; VEZET, *Verschure and Zoon's*

¹ This mark was registered under the Act of 1883; the argument, as in *Talbot's Tm.*, *infra*, must therefore have been that, as it was good under the Act of 1888, it ought not to be expunged.

² The mark was actually registered under the Act of 1883, but see note (1).

³ As being equivalent to pearl.

⁴ It was suggested that the names were descriptive of films suitable for

particular types of camera.

⁵ It was suggested that the name suggested goods suitable for Quakers, a suggestion that Farwell, J., described as fantastic.

⁶ Per *Ld. Halsbury, L.C.*, and *Lds. Herschell and Macnaghten*, although this was not the ground of the decision, which was that the word was an invented word within (d).

Application, 22 R. P. C. 568 (1905).¹ In addition to these decisions, in *Pinto v. Badman*, 8 R. P. C. 181 (1891), it was objected that the words *El Destino* on a label for cigars indicated, by the fact that the words were Spanish or Mexican, the character or quality of the goods, but this objection failed both at the trial and in the Court of Appeal. Also, Chitty, J., in *Burgoyne's Tm.*, 6 R. P. C. 227 (1889), came to the conclusion that, if the Act of 1888 applied, which he held was not the case, the word *Oomoo* would have been capable of registration under it, and presumably, therefore, he considered that it had no reference to the character or quality of the goods.

The only decisions of the Court on para. (4) of the Act of 1905 are those referred to on p. 166.

Not being a geographical name.

It is a further condition that the word should not, according to its ordinary signification, be a geographical name. The qualification "according to its ordinary signification" was added in the Act of 1905, and gives express effect to the decision in *The Magnolia* case referred to below. The report of Lord Herschell's Committee was to the effect that the registration of geographical names ought only to be permitted where they clearly could not be regarded as indicative of the place of manufacture or sale,² but the Act contains no such limitation of the prohibition. The words "geographical name" are not equivalent to the "name of any place," and a word does not become a geographical name simply because some place of the earth's surface has been called by it. In *The Magnolia* case,³ it appeared that in the United States, whence the metal had been imported, there were several places known by the name "Magnolia," but it did not appear that the goods had any connection with any of those places. Rigby, L.J., said: "It is, no doubt, shown by the evidence, that there are places in the United States called by the name 'Magnolia,' and if 'geographical name' in sec. 64, sub-sec. (e), were equivalent to the name of any place, 'Magnolia,' as the name of places mentioned in the evidence, would fall within the exception. But in our judgment, the phrase 'geographical name' in sec. 64, sub-sec. (e), ought not, in general, to receive so wide an interpretation. It must, we

Magnolia case.

¹ The objection to the word was that it was equivalent to the letters "V, Z," in the Dutch language.

² Quoted above, p. 143.

³ *Magnolia Metal Co.'s Tms.*, [1897] 2 Ch. 371; 14 R. P. C. 265 and 621, Kekewich, J., and Lindley, Lopes and Rigby, L.JJ.

think, in the absence of special circumstances, be interpreted so as to be in accordance, in some degree, with the general and popular meaning of the words, and a word does not become a geographical name simply because some place upon the earth's surface has been called by it. For example, we agree with Mr. Justice Kekewich that the word 'Monkey' is not proved to be a geographical name by showing merely that a small and by no means generally known island has been called by that name. If, indeed, in its primary and obvious meaning, the word has reference to a locality, as the word *Melrose* in *Van Duzer's* case, or the word *Eboli* in *Sir Titus Salt & Co.'s* case (from which Mr. Justice Chitty declined to distinguish the derivative *Eboline*), it may well be a geographical name within the meaning of the sub-section. Even when the primary signification is not geographical, if the name is really a local name (however little known the locality may be), and the name is given because of the connection of the article with the locality, whether that be real or imputed only by those who give the name, it may well be a geographical name within the meaning of the sub-section. An instance of this is to be found in the case of the word *Apollinaris*, given to the water from a spring known as the Apollinaris Spring. So, if 'Magnolia' had been the name of a place where the metal was manufactured, we should have been by no means inclined to say that it would not be a geographical name when applied to the article manufactured in the place having the name."¹ It would seem that under the Act of 1905 the ordinary signification of a word must be considered apart from its application to the particular goods, but it may be that, where the ordinary signification depends on the context, the application to the particular goods is material.

The prohibition of the registration of a geographical name is not confined to the noun substantive, but extends to the adjectival form.² The mere fact that part of a word is a foreign word, and might therefore have some reference to the country where the word is known, does not make the word a geographical name.³

The decisions on the unamended Act of 1888 arising on the

¹ See also *Clement et Cie.'s Tm.*, [1900] 1 Ch. 114 : 16 R. P. C. 173, 611, Kekewich, J. (*St. Raphael*). On the appeal, it was not necessary, in the view the Court took, to decide the point whether the words were geographical.

² *In re Sir Titus Salt's Application*, [1894] 3 Ch. 166 ; 11 R. P. C. 517, Chitty, J. (*Eboline*).

³ *Re Densham & Son's Tm.*, [1895] 2 Ch. 176 : 12 R. P. C. 75 and 271 (*Mazawoltec*).

question whether a geographical word could be registered as a "fancy word not in common use," will be found collected above.¹

The following words have been held to be geographical names under the Act of 1888 :—*APOLLINARIS*, *Apollinaris Co.'s Tm.*, [1891] 2 Ch. 186 ; 8 R. P. C. 137 ;² *EBOLINE*, *Sir Titus Salt & Co.'s Application*, [1894] 3 Ch. 166 ; 11 R. P. C. 517.³ The following words have, on the other hand, been held not to be geographical names : *MAGNOLIA*, p. 170, *supra* ; *MAZAWATTEE*, *Densham's Tm.*, p. 147, *supra*.⁴ Also in *Pinto v. Badman*, 8 R. P. C. 181, the words *EL DESTINO* on a label were objected to on the ground of being geographical, but this objection was overruled.

Not being a
surname.

A new statutory condition is introduced by the Act of 1905 that the word should not, according to its ordinary signification, be a surname, but in practice the Comptroller refused under the Act of 1888 to register surnames.⁵

Other Distinctive Words.

In addition to the classes of names, signatures and words, which may under paragraphs (1), (2), (3) and (4) of sec. 9 be essential particulars, the Act of 1905 allows registration of any distinctive name, signature, word or words not falling within such paragraphs, but an order of the Board of Trade or the Court declaring that the name, signature, word or words is or are to be deemed distinctive is necessary.⁶ "Distinctive" is defined to mean adapted to distinguish the goods of the proprietor of the trade mark from those of other persons. The rules made under the Act provide a special mode of application for registration of such marks.⁷ Numerous words have now been registered by order of the Board of Trade under this paragraph,⁸ but only in one case has the Court been asked to make an order, namely, in an application to register "*Apollinaris*."⁹ An application was originally made to the Board of Trade, but the Board, under the power conferred on it by Rule 39, required the applicants to apply to the Court, one of the reasons for this course being that the word

¹ Ante, p. 152.

² See also *In re Apollinaris Tm.*, [1907] 2 Ch. 178 ; 24 R. P. C. 436.

³ See p. 171, note (2).

⁴ See above, p. 171, note (3).

⁵ See official notice, 2nd ed. of this work, p. 731.

⁶ Sec. 9 (5), coupled with the definition

of "mark" in sec. 3.

⁷ See Chap. IV., Registration of Trade Marks, above, at p. 82.

⁸ Instances are given below, Appendix XXIII.

⁹ *In re Apollinaris Tm.*, [1907] 2 Ch. 178 ; 24 R. P. C. 436.

had been removed from the Register under the repealed Acts.¹ The applicants, relying on the provision of the section that, in the case of a trade mark in actual use, the tribunal may take into consideration the extent to which such user has rendered such trade mark in fact distinctive for the goods in respect to which it is proposed to be registered, adduced evidence to show that the mark was in fact distinctive. Kekewich, J., held that the applicants had established this fact, and made a declaration that the word ought to be deemed to be a distinctive mark within sec. 9. As the mark had, however, only been used in connection with the water from the particular spring, the applicants were required to give an undertaking not to use the mark except in respect of the water from their property at Neuenahr or in the neighbourhood thereof. It was suggested that the word only distinguished the water from the particular spring from other mineral waters, but Kekewich, J., held that it distinguished the goods of the proprietor of the trade mark from those of other persons, and that, that being so, it did not matter that it also distinguished the goods irrespective of the proprietor. As a general proposition, this might be open to criticism, but in the case before the Court, which was one of a monopoly in a particular product, so long as the mark was applied only to the water from the spring and belonged to the proprietors of the spring, no conflict could take place.

Paragraph (5) is more fully considered below in relation to distinctive marks generally.

(5) Any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the above paragraphs (1), (2), (3) and (4), shall not, except by order of the Board of Trade or the Court, be deemed a distinctive mark. Distinctive marks.

The policy of the Act is that *de facto* trade marks shall be registrable; paragraphs (1), (2), (3) and (4) are therefore supplemented by this general provision. By sec. 3 "mark" shall include a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof. Practically all permanent symbols are covered by these words, but if there be any not expressly mentioned, it may nevertheless come within the meaning of "mark," for the word "include," and not the

¹ See above, pp. 153, 168.

word "mean," is used. It is not a fatal objection that the mark is capable of registration as a design.¹

The corresponding clause of the Act of 1883 was as follows:—

(c) *A distinctive device, mark, brand, heading, label or ticket.*²

It will be observed that distinctive letters and numerals, and distinctive combinations of which they form part, are as well as distinctive names, signatures and words, added to the things which under the previous Acts could constitute essential particulars.

Sec. 9 contains the following definition of the term "distinctive":—

"For the purposes of this section "distinctive" shall mean adapted to distinguish the goods of the proprietor of the trade mark from those of other persons."³

This definition merely expresses what was law before the Registration Acts, that, in order to be a trade mark, a symbol must be capable of distinguishing the goods upon which it is placed from similar goods, so as to identify them with the business of the proprietor of the mark.⁴

The word "distinctive" standing alone in clause (c) of the Act of 1883, and coupled with *special* in relation to old marks,⁵ has been construed in a number of cases. In *Leonard and Ellis'* case, Fry, L.J., expressed an opinion that the words *special and distinctive* of sub-sec. (3) (ii.) of sec. 64 "import the specialising of the make and manufacture of a particular maker from all other manufacturers, and distinguishing the manufacture of one person from the manufacture of all others."⁶ In *Wood v. Butler*,⁷ Lindley, L.J., said that distinctive trade mark "must mean some mark which distinguishes the goods to which

"Distinctive."

¹ *United States Playing Card Co.'s Application*. [1908] 1 Ch. 197, Swinfen Eady, J.

² Sec. 64 (1) (c). "Distinctive" governed each of the words which followed it, *Waterman v. Ayres*, 39 C. D. 29; 5 R. P. C. 368 (1888), C. A.; *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J.; *Pirie v. Goodall*, [1892] 1 Ch. 35; 9 R. P. C. 17, C. A.

³ See the judgment of Kekewich, J., in *The Apollinaris* case, referred to above, p. 173.

⁴ See Chap. II., p. 22; *Orr-Ewing v. The Registrar of Tms.*, 4 App. Ca. 479;

48 L. J. Ch. 707 (1879), and *Hopkinson's Tm.*, [1892] 2 Ch. p. 121; 9 R. P. C. 102, Kekewich, J.

⁵ Below, p. 198. Cf. the meaning of distinctive in sec. 74 of the Act of 1883, *Faulder's Tm.*, 18 R. P. C. 535 (1901), C. A.

⁶ 28 C. D. p. 304; 53 L. J. Ch. 612 (1884), C. A., *Valvoline* for valve oil.

⁷ 32 C. D. 247; 3 R. P. C. 81 (1886), *Eton* for cigarettes, claimed as an old mark; followed in *Wolff v. Nopitsch*, 17 R. P. C. 321 (1900), Cozens-Hardy, J. (*Spanish graphite pencils*), a passing-off case; see the decision of C. A., 18 R. P. C. 27.

it is attached as those made or sold by the person who uses the mark"; and Fry, L.J., repeated his definition from the earlier case. The whole Court held that it was not sufficient for the mark to be distinctive as regards the trade; it must be distinctive in the eyes of the ultimate customers, the consumers. "It ought," said Lopes, L.J., "to be a special and distinctive mark, not only recognisable by the trade, but also recognisable by the consumer, as connecting the article with the manufacturer." So that, as the proprietor of the mark had put upon the boxes in which his goods were enclosed words suggesting that they were made, not by him, but by a foreigner, although the suggestion was, as the trade knew, false, he had by his own act prevented the mark from being distinctive.

Lord Halsbury, in *Perry-Davis & Son v. Harbord*,¹ defined the word in similar language to that of Fry, L.J., quoted above; distinctive, he said, "means distinguishing a particular person's goods from somebody else's,—not a quality attributed to the particular article, but distinctive in that respect that it means that it is a manufacture of his distinguished from somebody else's." And he held that the word *Pain-killer*, as applied to a patent medicine, was neither special nor distinctive.²

"The essence of a trade mark," said Kay, J., in *Richards v. Butcher*, "is that it is some distinctive thing which points out that the goods are the goods of A. B."³

And in *Hopkinson's Trade Marks*⁴ Kekewich, J., said: "In order to protect a trade mark before the Act, you were obliged . . . to prove by evidence, and satisfy the Court, that the words used as a trade mark were known in the market, and—I think it is Lord Westbury's phrase⁵—gave a vendible character to the articles to which they were attached, made these articles

¹ 15 App. Ca. p. 320; 7 R. P. C. 336 (1890). *Pain-killer* claimed as an old mark for medicine.

² So also did Ld. Morris, in the House of Lords, and Fry and Lopes, L.JJ., in the Court of Appeal.

³ [1891] 2 Ch. p. 536; 8 R. P. C. 249, Kay, J., and C. A. *Monopole* for wines. In each of the three cases last referred to, the marks were claimed as special and distinctive words used as trade marks before August 13th, 1875. They were all rejected.

⁴ [1892] 2 Ch. p. 121; 9 R. P. C. 102. *J. & J. Hopkinson* for pianos, claimed and allowed as an old mark. In *Dewar & Son, Ltd. v. J. H. Dewar*, 17 R. P. C. 341 (1900), Lord Kyllachy said he was not satisfied that the words *Dewar's Whisky* were, assuming use prior to 1875, "special and distinctive."

⁵ *The Leather Cloth Co. v. The American Leather Cloth Co.*, 4 De G. J. & S. 137; 33 L. J. Ch. 199 (1863), cited above, p. 52.

recognised as coming from a particular manufactory, and so gave them a character different from every other article in the trade. Therefore it seems to me that the Legislature here¹ did no more than adopt the language of the cases."

Farwell, J., has differentiated the cases of old and new marks thus: "In the case of an old trade mark the word 'distinctive' means that it does in fact distinguish the goods of the plaintiff as his manufacture or selection from the goods of all other persons. That of course is a question of historical fact which can be determined by circumstances which have gone before. In the case of a new mark, of course, that cannot be so, but it means that the mark must be capable of distinguishing the goods of the plaintiff as his manufacture, or selection, from the goods of all other persons."²

James' Tm.

In *The Dome Black Lead* case³ Lopes, L.J., put a somewhat different interpretation on the word *distinctive*. It means, he said, "that it must be a mark or device of such a kind as, in case of infringement, it shall be clear what it is that is being infringed, and that the mark is something distinct from all other marks used in the same class of goods." And the Court of Appeal there held that, upon the evidence, a sketch of a short cylinder terminated by a hemisphere was a distinctive design for black-lead, which was in fact made up for sale in pieces of the shape shown by the sketch. There is, however, no disagreement between the two interpretations, and on consideration it will be seen that the first assumes the second, for no mark can distinguish the goods which bear it from all similar goods, or can create a species within the genus, unless it has itself some recognisable and characteristic peculiarity to separate it from other marks which may be found upon some or all of them. Moreover, a mark which satisfies the second test, and possesses such a peculiarity as is referred to, if this is recognised with sufficient readiness as a peculiarity, must of necessity, when it becomes known, distinguish the goods which bear it in the manner required by the test suggested by the *dicta* first cited. In the case of new marks which have, and can have, acquired no connection by reputation with their owner, all that can be

¹ *I.e.*, by the use of the phrase "special and distinctive" in the old mark clauses of the Acts.

² *Louise & Co., Ltd. v. Gainsborough,*

20 R. P. C. 61 (1903).

³ *James' Tm.*, 33 C. D. 392; 3 R. P. C. 310 (1886), C. A.

demanding of the mark is that it shall be capable of distinguishing the goods to which it is applied in the required manner, and this accords with the old law.¹

Section 9 provides that, in determining whether a trade mark is so adapted—*i.e.*, to distinguish the goods of the proprietor of the trade mark from those of other persons—the tribunal may, in the case of a trade mark in actual use, take into consideration the extent to which such user has rendered such trade mark in fact distinctive for the goods with respect to which it is registered or proposed to be registered. This is an important enactment operating in favour of owners of trade marks which have been used but not registered. There are many such marks which were not registrable under the previous Acts, and as to which it could not, apart from distinctiveness gained by use, be said that they were distinctive, that is to say inherently distinctive. The present Act allows them to be registered if in fact they operate to distinguish the owner's goods.

Effect of user to be considered.

In order to be distinctive, then, a mark must be different from other marks used upon or in connection with the same goods, and the difference must be such as, in the case of a mark already used and known, to distinguish the goods which bear it as the goods of its proprietor; or, in the case of a new mark, to be capable of so distinguishing, and to be likely when used and known, to so distinguish, the goods. Three questions arise upon this:—(1) What are the other marks from which a mark under consideration is to differ? (2) What kind and degree of difference will suffice? and (3) What is the function of evidence in the determination of the inquiry? The second and third questions may be more conveniently considered in connection with the restriction put by sec. 19 upon the registration of marks which too nearly resemble previously registered marks.²

Meaning of "distinctive."

Questions to be considered.

1. What Marks are to be distinguished.

In many trades there are a great number of common marks, which have been generally adopted for ornament or some similar purpose, or which—having been in the first instance appropriated as trade marks—by abandonment,³ by wide-spread piracy,⁴ or, in

Common marks.

¹ See Chap. II., p. 35.

² Chap. X., at p. 234. As to question (2), see also below, p. 183.

³ See below, p. 370.

⁴ See *Ford v. Foster*, 7 Ch. 611; 27

L. T. (N. S.) 219 (1872), C. A. See p. 38, above; also *Ripley v. Bandey*, 14 R. P. C. 591 and 944 (1897), Kekewich, J., and C. A.; and Chap. XIV., p. 362.

the case of word marks, by becoming the names,¹ and therefore descriptive, of the goods, have become *publici juris*. And a mark, to be distinctive, must be distinguishable from all of these.

Thus the committee of experts appointed under the Act of 1875,² to classify the marks tendered for registration in respect of cotton goods, rejected some marks bearing arrangements of elephants, lions, and crowns, on the ground that such devices or symbols in themselves, and by reason of the extensive use by the trade of lions and demi-lions, and crowns and elephants, were not private property, and did not possess a distinctive character; and on the appeal from the Registrar's refusal to register, evidence was given that among the marks rejected by the committee were 31 crowns used by 18 different firms, 52 elephants used by 30 different firms, and 137 lions and demi-lions used by 64 different firms.³ In the same case it was shown that triangular tickets in green and gold were in common use in the cotton trade.

The Orr-Ewing case.

In the early years of the existence of the Register, a number of common marks were accepted and placed upon it in ignorance of their true character. The committee of experts, to which reference has been made, was instituted to assist the Registrar, and, after 1884, the Comptroller, in determining what marks were common in the cotton class, and it was the practice of these officers in other cases to consult the representatives of the trade concerned on the subject.⁴

What marks are common.

It is clear that such marks as those above referred to, which are in common use in the trade, must be standards of comparison by which the distinctiveness of a new mark may be tested;⁵ and some assistance in determining when a mark is to be taken to

¹ See Chap. II., p. 37.

² See Chap. VII., p. 121.

³ *Orr-Ewing v. The Registrar of Tms.*, 4 App. Ca. p. 485; 48 L. J. Ch. 707 (1879); and see *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238, n. (1878); and *Hyde & Co.'s Tm.*, 7 C. D. 724; 54 L. J. Ch. 395, n. (1878), both Jessel, M.R.

⁴ Per Jessel, M.R., in *Kuhn's case*, supra. See also sec. 64 (14) of the Act of 1905.

⁵ See *Bryant and May's Tm.*, 8 R. P. C. 69; 59 L. J. Ch. 763 (1890), North, J.; the cases cited in note (3); *Anderson's*

Tm., 26 C. D. 409; 53 L. J. Ch. 664, Chitty, J.; affirmed on appeal, 54 L. J. Ch. 1084 (1884); *Thewlis and Blakey's Tm.*, 10 R. P. C. 369 (1893), North J., *Ancross* rejected because anchors were common in the trade; and *Hudson's Application*, 24 R. P. C. 582 (1907), Joyce, J., "*The Thunderer*" for whistles; *Anglo-Swiss Condensed Milk Co. v. Pearks, Gunston and Tee, Ltd.*, 20 R. P. C. 509; 21 R. P. C. 261 (1904), Joyce, J., and C. A., "*Milkmaid*" for butter.

be in common use may be obtained from decisions on the repealed Acts. Thus, sec. 64 (1) (c) of the Act of 1883, repealed by the Act of 1888, allowed "fancy words not in common use" to be registered, and on this it was held, that use by several firms in the trade in question, and by others in different trades, was common use.¹ In *The Washerine* case² Chitty, J., held, that marks might be common to the trade within sec. 74 of the Act of 1883, though not publicly used by more than three persons, as required by sub-sec. (3), and that the words did not mean "in common use in the trade," but "open to the trade," and this interpretation was adopted by Kekewich, J., in *The Apollinaris* case.³ Chitty, J., gave as an example the case of a mark widely used and then abandoned by all but two or three persons in the trade. In *The Apollinaris* case the word in question was the name of a mineral water which might have been sold by the proprietors to other traders than the claimants of the mark, although they were, for the time, the sole importers of it. And in *The Herbalin* case⁴ the word had been extensively used before registration both by the plaintiff and by the defendant. The cases cited in this paragraph were all cases of descriptive words.

In *The Stone Ales* case⁵ Lindley, L.J., expressed an opinion that a mark used by one person in the trade only could not be common to the trade.

A mark may be distinctive although there are in use in the trade a number of marks embodying somewhat the same idea. Thus in a case in which the use of a star was held to be *publici juris*

¹ *Great Tower Street Tea Co. v. Smith*, 6 R. P. C. p. 172; 5 T. L. R. p. 232, North, J. (1889), *Tower Tea*; and see above, p. 155. Cf. also sec. 74 of the Act of 1883, and the decisions on "distinctive" and "common to the trade" in that section. Distinctive there meant *prima facie* distinctive: *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J. (*Washerine*); *Thompson v. Miller*, 13 R. P. C. 35 (1895), Stirling, J. (*Roadster*); *Faulder's Tm.*, [1902] 1 Ch. 125; 18 R. P. C. 37, 535, Kekewich, J., and C. A. (*Silverpan*).

² *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889).

³ [1891] 2 Ch. p. 209; 8 R. P. C. 137.

⁴ *Humphries v. Taylor Drug Co.*, 59 L. T. 820; 5 T. L. R. 41, Kekewich, J.

(1888)

⁵ *Thompson v. Montgomery*, 41 C. D. p. 49; 6 R. P. C. 404 (1889). In *Ripley v. Bandley*, 14 R. P. C. 591 (1897) (*Oval Blue*), the defendants were proceeded against for selling blue in an oval shape similar to that employed by the plaintiff, from which his goods had acquired the name *Oval Blue*. Kekewich, J., held that the name had not fallen into common use, although the oval shape had been used by three other persons, but he also held that the plaintiff failed owing to his neglect to enforce his rights against the other users—a result tantamount to holding the shape to be common. On an appeal the case was settled: 14 R. P. C. 914.

in the tobacco trade, the registration of a particular form of star was upheld,¹ and in another case it was held that, although a diamond was present as part of a complex figure in many marks used in the trade, a simple diamond was a good trade mark.² Where a mark has been long registered the *onus* of proving that it was common when registered is not discharged by proving occasional and slight user by other persons.³

If a trade mark contains matter common to the trade or otherwise of a non-distinctive character, the Registrar or the Board of Trade, or the Court, may require, as a condition of the mark being upon the Register, that the proprietor shall disclaim any right to the exclusive use of all or any portion of such matter or make such disclaimer as they shall think needful for the purpose of defining his rights under such registration.⁴

The question how far marks which are or have been used by one or more persons in the trade, but which are not commonly used, or common to the trade in the sense just suggested, and which are not trade marks, ought to be regarded—in judging whether a mark tendered for registration is distinctive—has been the subject of some decisions.

Other trade marks, registered or unregistered.

Where any marks already in use are trade marks, whether registered or unregistered, it is clear that they are obstacles to the registration of any mark which so closely resembles them as to be calculated to deceive, unless the applicant has an independent trade mark right in the mark he puts forward.⁵ This is expressly enacted by sec. 19, in regard to registered trade marks;⁶ and it follows, in the case of unregistered trade marks, from the prohibition placed by sec. 11 upon the registration of any matter, the use of which, by reason of its being calculated to deceive or otherwise, would be deemed disentitled to protection in a Court of Justice.⁷ Apart from these sections, however, the marks in use in the trade at the date of registration may have to be regarded in considering whether a particular mark is distinctive.

¹ *Dexter's Tm.* and *Wills' Tms.*, [1893] 2 Ch. 262; 10 R. P. C. 269.

² *Bass, Ratcliff and Gretton, Ltd.'s Tm.*, [1902] 2 Ch. 579; 19 R. P. C. 129, 529, C. A. See also *Star Cycle Co., Ltd. v. Frankenburys*, 24 R. P. C. 46, 405 (1907), a passing-off case.

³ *Boord & Son v. Thom and Cameron, Ltd.*, 24 R. P. C. 697 (1907), Inner House,

Scotland. And see the judgment of Moulton, L.J., in *Star Cycle Co. v. Frankenburys*, *supra*.

⁴ Sec. 15.

⁵ Cf. Chap. XV., pp. 411 *et seq.*, Infringement, and see sec. 21 as to concurrent user.

⁶ Chap. X., p. 221.

⁷ Page 266.

In *Bass'* case the Court was considering whether Bass' diamond which had been registered as an old mark was distinctive when registered, and it was objected that a diamond was in common use in the trade. Vaughan Williams, L.J., in giving judgment, said, after stating that the question was whether Messrs. Bass' mark of the simple diamond was distinctive: "In order to judge whether it is distinctive, you must look at the other trade marks which, it is alleged, were in use at that time. I do not know that they need be actual marks. Probably they could not very easily be trade marks if they were very similar and used by several persons—three or four or whatever the number might be—because they might indicate apparently any one of those four manufacturers of beer; but you have to compare the simple diamond trade mark as used by Messrs. Bass before they registered with the marks which were in use at that time."¹ A mark which is calculated to deceive the public by leading them to believe that it is the trade mark of some person other than its proprietor, or that the goods sold under it are the goods of another person, cannot generally be distinctive in accordance with the explanations of the term given in the judgments cited above.² In the very extraordinary circumstances of the case of *Mouson v. Boehm*,³ it was held that a trade mark which had been registered at a time when a similar and previously acquired unregistered trade mark for the same goods was in existence might be allowed to remain on the Register, on the ground that the later mark had been registered in good faith and in ignorance of the earlier unregistered mark, and had remained unchallenged on the Register for two years, during which time it had been extensively used in its proprietor's business; but the case was treated as exceptional, and the earlier trade mark was admitted upon the Register also.⁴

But an abandoned unregistered trade mark is, as such, no obstacle to the registration of a similar mark,⁵ that is, unless it has become a common mark in the trade.

Abandoned trade mark.

Besides common marks and trade marks, there are, however,

Marks used in advertisements.

¹ *Bass, Ratcliff and Grelton, Ltd.'s Tms.*, 19 R. P. C. 529 (1902).

² See below, Deceptive Marks, pp. 266 *et seq.*

³ 26 C. D. 398; 53 L. J. Ch. 932 (1884), Chitty, J. The facts are stated below, p. 411. Cf. *Verity's Tm.*, 19 R. P. C. 58.

⁴ See sec. 21 as to concurrent user, below, p. 264.

⁵ See *Mouson v. Boehm*, cited *supra*, note (3), and *Paine & Co. v. Daniells & Sons' Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 217, C. A. (*John Bull beer*).

other marks used by traders in their businesses; for instance, marks employed in advertisements, or in the "get up" of his goods by a single trader. Are these to be taken as standards in estimating the distinctiveness of a new mark? This, it is submitted, depends upon the extent to which they are known and used. Thus in *Louise v. Gainsborough*¹ it was held that the celebrated "Duchess of Devonshire" picture was not rightly registered as a trade mark for hats, &c., because it had at the date of registration been in common use in the trade in almost every way except by impression on the goods. And it would be a great hardship to compel a rival trader to omit a material part of a well-known advertisement of his trade, because someone had registered it as a trade mark. If a mark is well known in connection with a particular trader, though not used as a trade mark by him, its use upon the goods of another would be likely to identify them with him rather than with the latter, and it would not, therefore, be distinctive in regard to such goods, in the sense explained. So Kekewich, J., refused to direct the registration, as a trade mark for wire-bound indiarubber hose, of a device consisting of a sketch of an elaborate knot of the hose, on the ground that it too closely resembled a picture of similar hose printed by the opponents in their price lists, notwithstanding that the device in question had been employed as an advertisement by the applicants in their own price lists, and was registered as their copyright design.² The matter is, however, different where no deception can result. Thus the mere user in a different locality of a mark on a price list was held not to invalidate the subsequent registration of the mark by another trader.³ It would be very onerous on a trader to expect him to discriminate all the marks used by his fellow traders, otherwise than as recognised trade marks, in connection with their businesses, on peril of having his trade mark removed from the Register.

¹ 20 R. P. C. 61 (1903). Farwell, J., held that it had been used in a way which would be an infringement; as to this, see below, p. 395. See also *Anglo-Swiss Condensed Milk Co. v. Pearks, Gunston and Tee, Ltd.*, 21 R. P. C. 261, C. A. (1904), where some of the users

were merely as ornamentations.

² *Sphincter Co.'s Tm.*, 10 R. P. C. 84 (1893).

³ *Verity's Tm.*, 19 R. P. C. 58, Buckley, J. (1902). The trade mark had at the date of the application to rectify been on the Register for thirteen years.

2. What Degree of Distinctiveness is required.

The question, what degree of difference from other marks will entitle a mark to be registered, is considered in the chapter dealing with restrictions on registration, and, in particular, with sec. 19.¹ In addition to what is there said, it may be pointed out that, although a mark offered for registration may be fairly distinguishable from each of several others, yet the existence of these, if they are in use, opposes a cumulative weight of objection to any new mark which has an apparent resemblance to a number of them.²

What degree of distinctiveness is required.

A secondary meaning acquired by user in connection with the applicant's goods, which would have sufficed to create trade mark rights in an apparently descriptive mark before the Acts,³ did not enable such a mark to be registered under the repealed Registration Acts, unless it was used as a trade mark before August 13th, 1875. In *The Stone Ales* case⁴ the mark *Stone Ale* was removed from the Register on the ground that there was no evidence of its separate user as a trade mark before the date mentioned, although its secondary meaning was not only fully established, but was the basis of the injunction granted against the defendant in the case. Now, however, it is possible to register a word which has acquired a secondary meaning as indicating the goods of the applicant only if it can be shown that it is distinctive in actual use.⁵

Secondary distinctive meaning.

If a trade mark is limited in whole or in part to one or more specified colours, in such case the fact that it is so limited is, under the Act of 1905,⁶ to be taken into consideration by any tribunal having to decide on the distinctive character of the mark. This provision is a new one, and reverses the practice under the previous Acts.⁷ Apart from any such limitation, a trade mark is to be deemed registered for all colours.⁶

Colour.

Descriptive Marks.

According to the construction placed upon the Acts, a descriptive mark cannot be distinctive. So that any mark which describes the goods, their quality, or the purpose to which they

Descriptive marks.

¹ Page 234.

² Cf. below, pp. 248, 249.

³ Chap. II., at p. 37.

⁴ *Thompson v. Montgomery*, 41 C. D. 35; 6 R. P. C. 404 (1889). There was no appeal on this point to the House of

Lords. As to old marks, see below, p. 201.

⁵ Sec. 9 (5).

⁶ Sec. 10.

⁷ *Hanson's Tm.*, 37 C. D. 112; 5 R. P. C. 130 (1887), Kay, J., red, white

are to be applied, is not registrable, and this rule has been applied far more strictly than that which rejected mere descriptive words as trade marks before the Acts.¹ The subject is discussed under the head of Word Marks, above.²

Device.

Devices as
trade marks.

Devices have been registrable under all the Acts. They are the oldest, and, in many ways, they form the most valuable, kind of trade marks. Before the description of shops and factories by street and number became the common and convenient method of identification, every trader had his characteristic "sign," and it was an obvious and natural step to transfer the sign from the shop to goods which it was desired to show had come out of it. And this was done in very early days. Fragments of classic pottery bear the potter's mark of their maker, and, to come to later times, the early editions of the Aldine Classics bear the device of a dolphin wound round an anchor.³ A good trade mark which has a device as its central feature has this peculiar advantage, that its use is not restricted to customers who speak any one language. It is not, of course, necessarily equally useful or distinctive everywhere. For instance, pictures of a stag and a buffalo, though perfectly different to people who are acquainted with the forms of both animals, might well be indistinguishable by the inhabitants of some of the Pacific islands where no quadruped is known which is larger than a pig, and who would have no name for either. The chief objection to a device trade mark is the difficulty of choosing one which shall be sufficiently simple and striking to fix itself in the customer's memory, and shall readily suggest a name or description by which it can be referred to, and yet, at the same time, be distinguishable from the other marks in use for the same goods or description of goods.

Word or
letter is not
a device.

It was decided under the Act of 1875, which did not, except in the case of old marks, provide for the registration of words, that a collection of English letters,⁴ or a single letter,⁵ could not, but

and blue in three parallel stripes. See as to old marks, *Bass, Ratcliff and Gretton's Tms.*, [1902] 2 Ch. 579; 19 R. P. C. 529, where the Court reserved the question whether colour could enter into the distinctiveness of old marks. And see below, pp. 209, 210.

¹ Chap. II., at p. 37.

² Pages 142 *et seq.* As to descriptive

devices, see p. 187.

³ Salaman on Trade Marks, p. 1.

⁴ *Ex parte Stephens*, 3 C. D. 659; 46 L. J. Ch. 46 (1876), Jessel, M.R. (*Aeilyton*).

⁵ *Mitchell's Tm.*, 7 C. D. 36; 46 L. J. Ch. 876 (1877), Hall, V.-C., application to register A., as an old mark for pens, refused.

that a word printed in Oriental characters might, be registered as a device.¹ Under the Act of 1905, letters and numerals are included in the term "mark,"² and can be registered, if distinctive.³

The portrait of a person, for instance the portrait of the manufacturer of the goods in question, may be a distinctive device, and as such capable of registration.⁴ But a particular portrait may be common to the trade, for instance if it is that of the inventor of a process of manufacture which is open to the public, and if goods made according to the process are known and described by reference to the inventor. Thus in *Anderson's case*⁵ a device consisting of a portrait of Baron Liebig, with the words *Brand* above and *Baron Liebig* below it, was rejected as a trade mark for Liebig's extract of meat, on the ground that the words *Baron Liebig* were open to the trade,⁶ and that the portrait of the inventor of the goods was descriptive of the goods. In this case, Chitty, J., found⁷ that it was a common practice for those engaged in trade to place a photograph of the inventor on the particular article in order to show that he was the inventor, or to show in the particular case that the article was made according to his invention. But it would appear that, having regard to *Rowland v. Michell*,⁸ if such a practice is relied on to show that a portrait is not distinctive, it must be proved to exist in the particular trade. Registration of a portrait as a trade mark would only confer on the proprietor the right to stop the use of another portrait as being an infringement, if there was not a substantial difference between the two portraits.⁹ Portraits of living persons or of persons recently dead cannot be registered

Portrait of
inventor.

¹ *Rotherham's Tm.*, 11 C. D. 250; 14 C. D. 585; 49 L. J. Ch. 511 (1878), *Bacon V.-C.*, and C. A. (*Tod* in Arabic). Cf. *Gout v. Aleploglu*, 6 Beav. 69, n. (1833) (*Pessendede* (i.e.) warranted in Turkish).

² Sect. 3.

³ Sec. 9 (5). The Comptroller, under the repealed Acts, refused to register words in sound merely equivalent to the names of letters, but the reason for this, namely, that letters could not be registered, is now gone. Under special circumstances the Court allowed the registration of "Vezet" in *Verschure and Zoon's Application*, 22 R. P. C. 568 (1905).

⁴ *Rowland v. Michell*, [1897] 1 Ch.

71; 13 R. P. C. 457; 14 R. P. C. 37, *Romer, J.*, and C. A.

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

⁶ So held in *Liebig's Extract of Meat Co. v. Hanbury*, 17 L. T. (N. S.) 298 (1867).

⁷ Basing his finding on the judgment of the Court of Appeal, and particularly of Cotton, L.J., in an action of *Liebig's Extract of Meat Co., Ltd. v. Anderson*, 55 L. T. 206.

⁸ See judgment of Lindley, L.J., [1897] 1 Ch. 74; 14 R. P. C. 44.

⁹ See note (4), ante.

without the consent of such persons or their legal representatives, as the case may be, if the Registrar require such consents.¹

Part of mark
common to
the trade.

Under the Act of 1905, the system of the Act of 1888, by which an applicant had to disclaim the exclusive use of matter added to an essential particular,² is discontinued. But matter common to the trade is liable to be required to be disclaimed,³ as it was under the earlier Acts.³ In *Baker v. Rawson*,⁴ where a lighthouse, surrounded by two concentric circles, with initials and a date between them, had been registered in 1877 as a new mark, although the circles were in fact common to the trade, an application was made to remove the mark from the Register. North, J., held that the circles ought not to have been registered, but as the whole mark had been used for a number of years, instead of ordering its removal, he directed a note, stating that the circles were common to the trade, to be put upon the Register. It will be noticed that the mark had been registered under the Act of 1875, which contained no provision for disclaimer at all, but registration with disclaimer had been approved under it.⁵

Combination
device.

A combination of devices which are common to the trade may form a new and distinctive device.⁶ The test by which any such combination must be tried is, it is submitted, correctly stated in the following passage from the report of Lord Herschell's Committee.⁷ The Committee say: "In this connection we may refer to a point which has been the subject of considerable controversy, namely, how far registered or common marks when combined together are to be regarded as a new mark. We think that the juxtaposition of two or more such marks is not, if there be nothing more than this, a combination constituting a new mark. An important test appears to be whether the existing marks are so combined as to suggest a new idea. For instance,

¹ Rule 15 below, p. 657. See also *Carroll's Application*, 16 R. P. C. 82 (1899), Kekewich, J. (*Princess Christian*).

² Secs. 64 (2) and 74 of the Act of 1883, as amended by the Act of 1888.

³ Sec. 15. See Chap. IX., p. 212.

⁴ 45 C. D. p. 533; 8 R. P. C. 89 (1890); see also *Kuhn's Tm.*, 53 L. J. Ch. 238, n. (1878), Jessel, M.R., where registration with a disclaimer was approved under the Act of 1875. See now sec. 15, Chap. IX., p. 212.

⁵ By Jessel, M.R., in *Kuhn's Tm.*, 53 L. J. Ch. 238, n. (1878).

⁶ The mark must be looked on as a whole; see Chap. X., at p. 240, and below, p. 192, "Label," and, for an instance, where a number of common and some distinctive elements combined together did not form, as wholes, distinctive combinations: see *Orr-Ewing v. The Registrar of Tms.*, 4 App. Ca. 479; and *Ld. Cairns' judgment*, p. 484 (quoted above, p. 134); 48 L. J. Ch. 707, 708 (1879); and see the order made, 4 App. Ca. p. 503.

⁷ Report of 1888, p. ix. The passage follows that upon the "idea of a trade mark," cited at p. 237.

assuming a cat and a fiddle to be each an old mark, we do not think that the mere representation of a cat and a fiddle together would be a new mark, but the representation of a cat playing upon a fiddle, the idea conveyed by which would be neither the cat nor the fiddle, but a cat playing upon a fiddle, would be a good combination, and might properly be registered. We think that this view differs somewhat from that which has been at times, at all events, entertained by the Board of Trade, but it appears to us to be the sound one."

A combination of devices or labels may be registered as a single trade mark, even although the intention is to use them so that they cannot all be seen at once, where for instance some of the marks are intended to be placed outside and some inside a package of goods.¹

It has been held, in the case of word marks, that descriptiveness is inconsistent with distinctiveness, and it would seem to follow generally, that marks which are descriptive of the goods to which they are to be applied are not within the Acts. In the opinion of Lord Herschell's Committee,² such marks are not legitimate, and after the Committee's report the Comptroller refused to accept them. This opinion is in accordance with the judgment of Pearson, J., in *James' case*,³ holding that a representation of the goods on which the mark was to be used was not a good mark. In that case the mark in question was a sketch of a cylinder with a dome top, which had been registered in 1861 as a design, and as a trade mark in 1877. It was used as a trade mark for black-lead, which was generally, but not exclusively, sold in blocks of the shape shown by the sketch, and upon which the words "registered shape" were stamped. The Court of Appeal reversed the decision of Pearson, J., but Cotton and Lindley, L.JJ., apparently differed from the learned judge in their view of the facts only. They held that the mark was not a mere representation of the goods, and they laid stress on the circumstance that it might be used, and it had occasionally

Devices
descriptive of
the goods.

James' case.

¹ *Crompton & Co.'s Tm.*, [1902] 1 Ch. 758; 19 R. P. C. 265. The mark consisted of three labels, and the essential particulars were stated to be the combination of devices. It was held also that it was not necessary that the devices should be verbally described or specified.

² Report of 1888, p. xii.

³ 31 C. D. 340; 55 L. J. Ch. 915 (1885). It also accords with a number of American decisions: see Sebastian, 4th ed., p. 36. The Court of Appeal, however, thought that little assistance was to be obtained from the American cases; 33 C. D. 392; 3 R. P. C. 340.

been used, on blocks of shapes other than that shown by the sketch.¹ Lindley, L.J., said: "I cannot see why, according to English law, a fish may not be a distinctive mark for a fishing-line, though I can understand that a picture of a fish may not be a distinctive mark of that particular kind of fish. Why a pig should not be, according to English law, a distinctive mark for lard, or something made out of a pig, I do not know. Supposing you tanned a pigskin into leather, I do not know why a pig should not be a good trade mark for tanned pig's hide." Lopes, L.J., took the same view of the facts; but in the course of his judgment he asked: "Why is it (the mark) the less a distinctive device or mark because it represents the thing upon which it appears?" The suggestion of this question is not only at variance with the opinion cited above, but also with the statement of Lindley, L.J., that a fish would not be a good trade mark for fish of the same kind.²

Devices comprising pictures of the goods.

But although descriptive devices, including mere representations of the goods upon which the mark is to be used, are objectionable, there seems to be no reason why pictures of the goods, worked up into a characteristic and uncommon design, should be refused. Thus a drawing of a mere ordinary coil of wire for wire, of a barrel for beer, a cricket-bat for cricketing materials, would be bad as trade marks; but not a drawing of the wire woven up into a knot of new and striking design, or of several barrels or bats arranged in a particular and original manner.³

Device representing name of goods.

In a case in which the word *Magnolia* had been registered as a trade mark, and also a representation of a magnolia flower as another trade mark, and the word at the time of its registration was the name of the alloy in respect of which it was registered,

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

² See *The Sphincter Co.'s Tm.*, 10 R. P. C. 84 (1893), Kekewich, J.; and cf. *Ripley v. Bandy*, 14 R. P. C. 591 and 944 (1897), Kekewich, J., and C. A., where Kekewich, J., held the plaintiff to have established that *Oval Blue* meant his laundry blue, which was of an oval shape, but held that, owing to laches, he could not complain of the use of the oval shape by other traders. In the Court of Appeal the case was settled. An inter-

locutory injunction was granted by Buckley, J., to restrain a defendant from selling cigars made in the plaintiff's distinctive shape without clearly distinguishing, *Elliott & Co., Ltd. v. Hodyson*, 19 R. P. C. 518 (1902); *query*, however, whether the decision went too far.

³ The question was discussed, but not decided, in *The Sphincter Co.'s Tm.*, 10 R. P. C. 84 (1893). The Registrar refuses to accept for registration as trade marks, pictorial representations of goods to which the marks are to be applied.

and that registration was therefore bad, it was held that nevertheless the registration of the flower was good.¹

It is somewhat difficult to define what degree of descriptiveness will make a mark objectionable, but the test is, it is submitted, to be found in the rule that, assuming the mark to be distinctive having regard to the marks already in use in the trade as already defined, it must not be such as to restrict the liberty of any trader to use any drawing, picture, or device, which he may fairly require to enable him to describe his goods to any class of his customers in the ordinary manner.

The rules prohibit the registration of certain devices of a national character as trade marks or prominent parts of new trade marks,² and as regards certain other devices, *e.g.*, the arms of a foreign State or of a city, the Registrar may require justification or consent.³

Brand.

This word was introduced by the Act of 1883, in consequence of the ruling of Jessel, M.R., that cigar marks burnt into the ends of the boxes could not be registered under the Act of 1875, and in order to allow such marks to be registered;⁴ but it has not been restricted in practice to marks burnt into the goods or their envelope. Thus, a number of word marks were at one time accepted and registered in the tin-plate trade as brands, which would not have been accepted under any of the other heads,⁵ because the words were geographical words.

Lord Herschell's Committee said, in their report⁶: "Some controversy has arisen with reference to the meaning of the word *brand* as distinguished from the other words employed. There can be no doubt that the term derives its origin from the practice of producing some mark by means of burning, but it appears now to be in use in certain trades for the purpose of describing trade marks no longer produced in this way, and differing in no respect from the labels and tickets mentioned in the section; nevertheless, a distinction has been made in the practice of the Office, and trade marks have been allowed registration in certain trades as brands when they would not have

¹ *Magnolia Metal Co.'s Tms.*, [1897]

² Ch. 371; 14 R. P. C. 265, 621, Kekewich, J., and C. A.

³ See Rules 11 and 12 below, p. 657.

⁴ Rules 13 and 14, below, p. 657.

⁵ See the evidence of the Comptroller before Ld. Herschell's Com-

mittee, Q. 2993. The Comptroller stated that he did not see any reason for keeping up the distinction between brand and design or mark. Q. 3295.

⁶ *Ibid.*, Q. 3294.

⁷ Report of 1888, p. xi.

been accepted in other classes as labels or tickets. We see no reason for this distinction. It does not appear to us to receive support from the language of the Act, and we think that, in future, brands should be dealt with in precisely the same way as labels or tickets."

*Pirie v.
Goodall.*

This opinion corresponds with that expressed in the judgments delivered in *Pirie v. Goodall*.¹ There the plaintiffs had, in 1885, registered the words *Pirie's Parchment Bank* for paper, disclaiming the exclusive use of both *parchment* and *bank*, which were words in common use in the trade. The defendants in an action for infringement moved to remove the mark from the Register, and the plaintiffs tried to support it (*inter alia*) as a brand. Vaughan Williams, J., held, that the word *brand* must be limited in some way; it could not include all words, whether, for instance, they were *fancy words*² or not. "I think," he said, "that before you can register anything as a brand, there must be evidence that, in point of fact, it is as a brand, and as a brand only, that it is used." The use of the words as a watermark on paper was not, the learned judge thought, user as a brand; but, he added, "I see no reason why a brand should not be woven into the goods just as much as stamped on to them or burnt into them." He ordered the trade mark in question to be removed from the Register. This decision was affirmed on appeal, and Lindley, L.J., who delivered the judgment of the Court, said he did not see why *mark*³ did not include *brand*, and he held that word marks⁴ could only be registered when they came within those parts of the section (64) which expressly relate to words, and consequently that they could not be registered as *brands*.⁵

In *Paine's* case,⁶ the words *John Bull Brand*, registered in 1885 as a trade mark for beer, were ordered to be removed. An attempt was made to support the mark as a brand, but Kekewich, J., pointed out that the mark claimed was the three words, not the first two, and that the addition of the last word did not make the whole a brand. Some question was raised in the cases

¹ [1892] 1 Ch. 35; 9 R. P. C. 17.

² The mark had been registered under the Act of 1883.

³ "Mark" was mentioned in sec. 64 (1) (c) of the Act of 1883.

⁴ That is, marks consisting of a word or words, not headings, labels, or tickets, which comprise words.

⁵ Cf. *Ld. Selborne's* judgment in *Leonard & Ellis's Tm.*, 26 C. D. p. 295;

and the judgments in *Holt's Tm.*, 13 R. P. C. 16 and 118; [1896] 1 Ch. 711, C. A., as to words that are also names.

⁶ W. N. (1892), p. 56; and 9 R. P. C. 130, Kekewich, J. The action in which the question arose is further reported: *Paine & Co. v. Daniells & Sons' Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 71, 217, Kekewich, J., and C. A.

cited above as to whether a brand mark must not be registered as a brand, but there is no machinery for such registration, as no distinction is made between the different heads referred to in the section upon the Register. In a later case, in which the device of a milkmaid was held to be common for butter, the addition in the plaintiffs' mark of the words "Milkmaid Brand" did not enable them to retain their mark.¹

The term *brand* was sometimes applied, before the Acts, to trade marks branded on metal goods, or on wine casks, or corks,² and its use to denote a class of some kinds of goods, as cigars, for instance, is very common; but these uses seem to have nothing to do with its meaning in the Act.

Heading.

The meaning of this term is not at all clear. The word is ordinarily used of a sentence or words placed at the top of a document either as a title or to describe the matter contained in it; and it has been held that the words *Family Salve*, printed thus, *Reinhardt's Celebrated Family Salve*, at the top of a wrapper used for patent medicine bottles, formed a distinctive heading.³ But it was held also, under the Act of 1875, which did not provide for the registration of words, that the single word *Valroline* did not form a heading, on the ground that word marks were specially provided for in the Act.⁴ If the first decision can be relied on, and if it indicates the whole significance of the word in the section, the operation of the section under this head is very limited, for documents attached to the goods or their envelope can themselves be registered as labels.

In the cotton trades a line heading means the pattern or marking woven at the end of a piece of cloth;⁵ and in *The Great Tower Street Tea Co. v. Smith*,⁶ North, J., said that this was what he understood by *heading* as used in this section. These

Line heading
for cotton
goods.

¹ *Anglo-Swiss Condensed Milk Co. v. Pearks, Gunston and Tee, Ltd.*, 20 R. P. C. 509; 21 R. P. C. 261 (1904), Joyce, J., and C. A.

² Sebastian, 4th ed. p. 33; *Millington v. Fox*, 3 My. & Cr. 338 (1838); *Seixo v. Provezende*, L. R. 1 Ch. 192 (1865).

³ *Reinhardt v. Spalding*, 49 L. J. Ch. 57 (1879), Hall, V.-C. The mark had been registered in 1876 as an old mark. It would, under the later decisions, have

been refused as descriptive, and also because it was not the whole mark used before the Act.

⁴ *Leonard & Ellis's Tm.*, 26 C. D. p. 295 (1884), C. A.; see the judgment of Selborne, L.C.

⁵ *Harter v. Souvazoglu* (1875), W. N. 11, 101; *Carver v. Bowker*, Seb. Dig. p. 350 (1877); *Robinson v. Finlay*, 9 C. D. 487 (1877).

⁶ 6 R. P. C. p. 168 (1889).

line headings are of great importance in the Manchester trade, but were not registrable under the Acts of 1875, 1883 or 1888, since they are essentially colour marks. Under the Act of 1905 colour may be taken into consideration as affecting distinctiveness, and line headings can be registered as part of a combination,¹ but no line heading can be registered alone in respect of cotton piece goods, and even if registered as part of a mark a line heading is not to be deemed distinctive, and the registration confers no exclusive right to the use of it.²

Label.

A label consists of a number of words, or of a word or words combined with a device or devices, or of a device or devices alone, printed on paper or other substance, in order to be stuck upon or attached to the goods or their envelope.

A single word or several words, not registrable alone, and not forming any sentence, will not become registrable by being printed on a plain piece of paper. Thus North, J., said³: "The plaintiffs would not be in any better position at all if they had put the words *Tower Tea* upon a piece of paper, otherwise blank, and fixed it on to their packages, than if they had, as they have done, impressed the words *Tower Tea* upon the packages themselves." And it would make no difference that the paper was surrounded by a conventional border, or was occupied by other indistinctive matter, not altogether forming a distinctive combination. Romer, L.J., in his judgment in *Re Clement et Cie's Trade Mark*,⁴ in which the Court of Appeal decided that certain words formed part of a label and not additions to it, said: "I desire to add that our judgment must not be understood as sanctioning the registration of words which in themselves would not constitute a proper trade mark, merely because some flourishes were colourably placed round them with the view of making out a distinctive or compound label, when, in fact, what was really intended to be registered was the words alone." In that case it

¹ See above, p. 125.

² Sec. 64 (10) (b) and (c).

³ *The Great Tower Street Tea Co. v. Smith*, 6 R. P. C. p. 170 (1889). Cf. Ld. Selborne's judgment in *Leonard & Ellis's Tm.*, 26 C. D. 288 (1884). So a black label, bearing the descriptive word

Monobrut in its centre, was removed from the Register in *Vignier's Tm.*, 6 R. P. C. 490; 61 L. T. 495 (1889), Kay, J.

⁴ [1900] 1 Ch. 114; 16 R. P. C. 173, 611.

was held that a description of the qualities of the article, and directions for use, although in form contained in a label, were an addition to a proper label, and this decision has been followed by Farwell, J., in a subsequent case.¹ The name of a firm printed in common letters on an ordinary label does not make a distinctive label.²

Lord Herschell's Committee reported³ that "it is said that there is often a desire to register short phrases, such as proverbs, &c., and that owing to the difficulty of finding new marks, it is expedient that they should be allowed. We see," they added, "no objection to this, provided they be in no way descriptive of the character or quality of the goods, or of their place of origin, sale, or manufacture." Probably such phrases may be registrable under the present Act as "words having no direct reference to the character or quality of the goods";⁴ and, even if they have such reference,⁵ they could be registered as distinctive marks, if by use they have in fact become distinctive of the goods.

Phrases and proverbs.

An ordinary arrangement of parts which are in common use, each part remaining as a separate feature in the combination, does not form a distinctive label.⁶ So a label for match-boxes, bearing representations of a prize medal, with the words *Bryant & May's Royal War Vestas* printed in ordinary type, medals being common marks in the trade, was held not to be distinctive;⁷ and so also was a label bearing two co-axial ovals, with the words *Worth's Corsets* in ordinary type, and four dots arranged as a star at each end printed between them, ovals being common marks in the trade.⁸ In the last case, Chitty, J., held that the

Ordinary arrangement of common parts.

¹ *Royal Baking Powder Co.'s Application*, 19 R. P. C. 261 (1902).

² *Price's Patent Candle Co.*, 27 C. D. p. 686 (1884), Pearson, J.; and *Bradley's Tm.*, 9 R. P. C. 205 (1892), Chitty, J., *Worth's Corsets*, between co-axial ovals. In *The Birmingham Vinegar Co.'s Tm.*, 11 R. P. C. 195; 70 L. T. 646 (1894), Kekewich, J., a label comprising a large H, some common words, and a small device, was held not to be, as a whole, a distinctive label.

³ Report of 1888, p. xii.

⁴ Sec. 9 (4).

⁵ Under the Act of 1888, *Unceda* was held equivalent to "you need a," and not registrable: *National Biscuit Co.'s Application*, [1902] 1 Ch.

783; 18 R. P. C. 170; 19 R. P. C. 281, Cozens-Hardy, J., and C. A.

⁶ Cf. "combination of devices," above, p. 186, and the passage from the report there cited; also *Jamieson v. Jamieson*, 15 R. P. C. 169 (1898), Byrne, J., and C. A., a passing-off case, in which the Court of Appeal reversed the judgment of Byrne, J., for the plaintiff, on the ground that the similarity of the get-up of the defendant's goods to that of the plaintiff's was solely due to features common to the trade.

⁷ *Bryant & May's Tm.*, 8 R. P. C. 69; 59 L. J. Ch. 763 (1890), North, J.

⁸ *Bradley's Tm.*, 9 R. P. C. 205 (1892), Chitty, J.

addition of the trade name of the owner of the mark made it neither better nor worse, and he approved and followed *Price's* case.¹

The Act permits the registration of a distinctive label, and it is, therefore, a sufficient qualification for a mark that it is such a label, but some difficulty arises when the question what is sufficient to render a label distinctive is considered. Ought the label to be looked at as a whole, or should it be analysed, in order to ascertain whether it contains one or more features which are in themselves distinctive? And, further, what must be the nature of such features? The decisions which have already been cited² are to the effect that the label must be examined, and that to qualify for registration some separately distinctive feature must be found in it. Some of the decisions³ seem to go further, however, and to lay down the rule that such a distinctive feature must itself be an "essential particular" (other than a label) within the meaning of the Act. It is submitted, however, that this is not the true view and is contrary to the general rule of construction of the Act of 1888 laid down by the House of Lords in *The Solio* case,⁴ and that it is sufficient if there be found some distinctive feature or features in the label, which operate to make it, as a whole, distinctive. The Court of Appeal has not been called on to give a direct decision on the point, but it has on several occasions determined that a label must be looked at as a whole.⁵

A good many of the difficulties which arose in connection with the registration of labels under the Acts of 1883 and 1888 were due to the provisions of those Acts with respect to additions to

Additions
under the
Acts of 1883
and 1888.

¹ 27 C. D. 681; cited p. 193.

² *Orr-Ewing v. Registrar of Tms.*, 4 4 App. Ca. 479; *Price's Patent Candle Co.'s* case, 27 C. D. 681; *Birmingham Vinegar Brewery Co.'s Application*, 11 R. P. C. 195; *Wright, Crossley & Co.'s Application*, [1900] 2 Ch. 218; 17 R. P. C. 386. See the quotations given above, pp. 134, 135.

³ See the cases in note (2), other than *Price's* case. Chitty, J., in *Bradley's Tm.*, note p. 193 (2), expressly distinguished the case of a combination distinctive as a whole.

⁴ *Eastman Photographic Materials Co.'s Application*, [1898] A. C. 571; 15 R. P. C. 476; see *supra*, p. 135.

⁵ *Apollinaris Co.'s Tms.*, [1891] 2

Ch. 186; 8 R. P. C. 137; *Pinto v. Badman*, 8 R. P. C. 181; and *Clement et Cie.'s Tm.*, [1900] 1 Ch. 114; 16 R. P. C. 173 and 611; of these, two were decisions on disclaimers and the third—*Pinto v. Badman*—on novelty. The passage cited from the judgment of Ld. Cairns in *The Orr-Ewing* case, *supra*, p. 134, must, however, be borne in mind. The actual decision was that the Registrar should proceed with the application to register the distinctive device on the labels, with the name and address of the appellant's firm, it being found that the marks contained devices which were *prima facie* distinctive. The case was under the Act of 1875.

essential particulars and disclaimers.¹ Section 64 of the Act of 1883 contained provisions for enabling certain matter to be added to essential particulars, and the Act of 1888 required such matter to be disclaimed. Section 74 of the Act of 1883 enabled certain marks common to the trade to be registered as an addition to a trade mark, but disclaimer of the addition was required by the section, as it originally stood, and as amended by the Act of 1888.

Under the Act of 1905, the whole system of additions has been swept away. A trade mark must, as before, contain or consist of an essential particular, but it is registered as a whole, and an applicant has no longer to point out in his application for registration what the essential particular is. The applicant may, however, be required to make such disclaimer as may be necessary to define his rights under the registration.² The position is thus much simplified by the Act of 1905. Nevertheless, it is necessary, on account of previous registrations, to consider the law under the Acts of 1883 and 1888.

Additions
abolished by
Act of 1905.

No disclaimer of any part of a distinctive label was required by the Acts of 1883 and 1888, for the whole label is an essential particular.³ Under sec. 64 (2), as amended by the Act of 1888, certain additions to the essential particulars in a mark might be registered, subject to a disclaimer of the exclusive use of the added matter; but, since a distinctive label is itself an essential particular, that sub-section did not apply to anything forming part of the label.⁴ Moreover, common words, that is, words

Disclaimer
in regard to
labels under
previous Acts

¹ *Clement et Cie.'s Tm.*, [1900] 1 Ch. 114; 16 R. P. C. 173 and 611, and *Smokeless Powder Co.'s Tm.*, [1892] 1 Ch. 590; 9 R. P. C. 109, may be instanced out of the many cases cited above.

² Sec. 15. The section is set out fully below, p. 212.

³ *Apollinaris Co.'s Tms.*, [1891] 2 Ch. 186; 8 R. P. C. 137; *Smokeless Powder Co.'s Tm.*, [1892] 1 Ch. 590; 9 R. P. C. 109; *Clement et Cie.'s Tm.*, [1900] 1 Ch. 114; 16 R. P. C. 173, 611; and see *Pinto v. Badman*, 8 R. P. C. 181.

⁴ It is submitted that this statement of the law is in accordance with and follows from the decision of the Court of Appeal in *Clement et Cie.'s Tm.*, supra, note (3). In that case the label was registered under the Act of 1883, but the

amendment of sec. 64 by the Act of 1888 does not appear to affect the decision so far as it has a bearing on that section. See also *Royal Baking Powder Co.'s Application*, 19 R. P. C. 261 (1902), Farwell, J., where the "additional matter" was outside the real label. But in *Birmingham Vinegar Brewery Co.'s Application*, 11 R. P. C. 193; 70 L. T. 646 (1895), Kekewich, J., affirmed the Comptroller's decision requiring an applicant to state that, not his label, but a device contained in it, was the essential particular of the mark, and to disclaim the exclusive use of the other matter. And in *Wright, Crossley & Co.'s Application*, [1900] 2 Ch. 218; 17 R. P. C. 386, Byrne, J., held that there ought to have been in the application a statement of the essential particular and a disclaimer of

which any one is at liberty to use, appearing in a label, did not need to be disclaimed under sec. 74 of the Act of 1888, for that section applied only to additions to the trade mark, and the whole label is itself the trade mark.¹ So, in *The Apollinaris* case, it was held, by the Court of Appeal, that the name *Friedrichshall* occurring on a label need not be disclaimed,² and this was followed by Chitty, J., in the case of *The Smokeless Powder Co.'s* trade marks, where he refused to order the words *Smokeless Powder* to be disclaimed on the application of rival makers of similar powder.³ A dictum of Cotton, L.J., in an earlier case,⁴ decided under the Act of 1875, that such words ought to be disclaimed, was cited in the last-mentioned case; but Chitty, J., declined to follow it. The decision of Stirling, J., in *Edge's* case,⁵ that the words *Filtered Blue*, which he held to be bad as a separate trade mark, must be disclaimed when registered on a label, is also in conflict with the rule stated above. None of the above-mentioned cases were, however, cited in *Edge's* case, and it was not cited in *The Smokeless Powder* case. *Burland v. Broxburn Oil Co.*,⁶ where the point does not appear to have been argued, and *Thompson v. Miller*,⁷ are also in conflict with the rule. The point came before the Court of Appeal again in *Clement et Cie.'s Trade Mark*,⁸ where the Court refused to order a disclaimer of the words *St. Raphael*, on the ground that the words formed part of and were not an addition to the mark.⁹ A distinctive label may accordingly be properly registered, although it contains words or names to the exclusive use of which no claim could be maintained.¹⁰

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

¹ *Pinto v. Bulman*, 8 R. P. C. pp. 188, 191 (1891), and *Clement et Cie.'s Tm.*, [1900] 1 Ch. 114; 16 R. P. C. 173, 611. As to the registration under the Acts of 1883 and 1888 of common marks as added matter or additions, see above, Chap. IX., p. 212.

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

³ [1892] 1 Ch. 590; 9 R. P. C. 109. See also *Faulder's Tm.*, [1902] 1 Ch.

125; 18 R. P. C. 37 and 535. Kekewich, J., and C. A. (*Silverpan*).

⁴ *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886), C. A.

⁵ 8 R. P. C. 207 (1891).

⁶ 6 R. P. C. 482; 41 Ch. D. 542 (1899), Chitty, J. (*Washerine*).

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

⁸ Ubi supra, note (1).

⁹ Cf. also *Wright, Crossley & Co.'s Application*, p. 194, note (2), above.

¹⁰ *Hudson's Tm.*, *Atkins' Tm.*, and *Paine & Co. v. Daniells & Sons' Breweries*, supra. See also *Application of Albert Baker & Co. (1898), Ltd.*, [1908] 2 Ch. 86; 25 R. P. C. 513, Eve, J.

The presence of common words in a registered label does not prevent any trader registering a different label with the same or similar words. Thus *Valvoleum* printed across a label with a particular device was allowed, although *Valvoline* was already registered upon a label with a different device,¹ Jessel, M.R., holding that each word was merely equivalent to *valve oil*.

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

It is a common practice to register labels with blank spaces which in use are filled up by matter which is either not capable of registration, or which for some other reason it is not convenient to register, because, for example, it is changed from time to time.² The practice is unobjectionable, and the use of the added matter, which forms, of course, no part of the trade mark protected by registration, does not interfere with the protection of the label as registered.² But in considering whether a mark is a proper mark to register, regard must be had to the appearance it will present in actual use.³

Blanks in registered labels.

Section 10 of the Act of 1905 provides that a trade mark may be limited in whole or in part to specified colours, and in such case the fact that it is so limited shall be taken into consideration by any tribunal having to decide on the distinctive character of such trade mark. This provision is of considerable importance in its effect on the registration of labels.

Colour.

Ticket.

The only difference between a label and a ticket seems to be that a label is attached by sticking it on to the goods or their envelope, and a ticket by tying.⁴

Name, Signature, Word.

These have been considered above under paragraphs (1), (2), (3) and (4).

¹ *Re Horsburgh & Co.'s Application*, 53 L. J. Ch. 237 (1878); see *Leonard & Ellis' Tm.*, 26 C. D. 288 (1884), C. A.; *Loftus' Tm.*, [1894] 1 Ch. 193; 11 R. P. C. 29; North, J. (*unco' guid whisky*).

² *Hammond v. Malcolm Brunner & Co.*, 9 R. P. C. 301 (1892); *Melachrino & Co. v. Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215 (1887), both Chitty, J.; and see Chap. X., at p. 246. A possible difficulty might arise if the whole mark, as filled up, were described upon the goods as a "registered trade mark."

See "misrepresentation" below, pp. 437 *et seq.* See Rule 15 as to variations of name or description of goods.

³ *Christiansen's Tm.*, 3 R. P. C. 54; 2 T. L. R. 31 (1886), C. A., the *Tændstikker Match* case, and *Lyle and Kinnahan's Application*, 24 R. P. C. 37 and 249 (1907), Kekewich, J., and C. A. And see Chap. X., at p. 244.

⁴ The words are used alternatively in *Orr-Ewing v. The Registrar of Tms.*, 4 App. Ca. 479; and *Great Tower Tea Co. v. Smith*, 6 R. P. C. 165.

Letter.

Under the previous Acts a single letter was not an essential particular;¹ and a combination of English letters was held not to constitute a device,² except in the case of an old mark.³ Letters could only be registered as additions under sec. 64 (2), or as part of a distinctive label or ticket.

Numeral.

“Numeral” is substituted for the word “figure” which was used in the Act of 1883 with the meaning of numeral.² A “numeral,” however, did not constitute an essential particular under that Act, and, except in the case of an old mark,³ could only be registered as an addition under sec. 64 (2), or as part of a distinctive label or ticket.

Old Marks.

Old marks.

Section 9 contains the following proviso :—

“ Provided always that any special or distinctive word or words, letter, numeral,⁴ or combination of letters or numerals, used as a trade mark by the applicant or his predecessors in business before the 13th day of August, 1875,⁵ which has continued to be used (either in its original form or with additions or alterations not substantially affecting the identity of the same) down to the date of the application for registration shall be registrable as a trade mark under this Act.”

Special and distinctive.

All the Registration Acts have contained provisions enabling certain classes of old marks, that is marks used before the commencement of the Act of 1875, to be registered, notwithstanding that they do not conform to the standard required of new marks by containing an essential particular. By sec. 10 of the Act of 1875 “ any special and distinctive word or words, or combination of figures or letters, used as a trade mark before

¹ *Mitchell's Tm.*, 7 C. D. 36 (1877), Hall, V.-C.

² *Ex parte Stephens*, 3 C. D. 659 ; 46 L. J. Ch. 46 (1876), Jessel, M.R.

³ See below, p. 199.

⁴ *Figure* was the term used in the previous Acts, but it was held to mean

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

⁵ Date of commencement of the Act of 1875.

the passing of this Act may be registered as such under this Act."¹ With a slight alteration the same provision was retained in the Acts of 1883¹ and 1888.² It was decided that, under the sub-section as it originally stood, a single letter, although an old mark, could not be registered,³ and to meet this the words "figure, letter" were added by the Act of 1883 before the words "or combination of figures or letters."

It has been said that it was the intention of the Act to allow to be registered anything which was protected as a trade mark under the old law, and could not be registered under the other clauses of the section.⁴ But it was decided under the Act of 1888 that the proviso did not extend to all old marks, and that an old mark, consisting of, or even containing, a device, did not come within the proviso, and was not entitled to registration unless it consisted of or contained one of the essential particulars enumerated, and that it was, in that case, subject to the requirements of sub-sec. (2) of sec. 64 as to disclaimer of added matter.⁵ And, similarly, it would seem that any old mark registered under the Act of 1875 or 1883, if not within the corresponding proviso, must conform to the general requirements of the Act under which it was registered. This decision is contrary to the previous practice of the Patent Office, which had treated all old marks as having a right to registration, and as free from the requirements of sub-sec. (2), and, as pointed out by Byrne, J., in his judgment, some of the results to which the language of the clause leads are anomalous.

It is difficult to understand why a change was made in the Act of 1905 from "special and distinctive" to "special or distinctive," for every proper trade mark must be distinctive; but the practical effect is that an old mark may be registered, if distinctive, although it may not be "special." The word "special" might therefore have been dropped altogether. It was said by Kekewich, J., in *Re Hopkinson's Trade Marks*⁶, that the require-

¹ Sec. 64 (3).

² Sec. 10.

³ *Mitchell's Tm.*, 7 C. D. 36 (1877), Hall, V.-C., *A.*, for steel pens.

⁴ *Barrows' Tm.*, 5 C. D. 353 (1877), per Malins, V.-C.; *Bodegu Co. v. Owens*, 6 R. P. C. 241, Chatterton, V.-C. (1888), in Ireland.

⁵ *Wright, Crossley & Co.'s Application*, [1900] 2 Ch. 218; 17 R. P. C. 386,

Byrne, J., who also held that sec. 74 did not apply in that case, if the mark could be registered under sec. 64 (3) (ii). It is settled that if the application is to register as an old mark, the words must have been used alone, see below, p. 205.

⁶ *Re Hopkinson's Tm.*, [1892] 2 Ch. 116; 9 R. P. C. 102, Kekewich, J.; see as to this, ante, p. 174.

ment that the mark should be "special and distinctive" only embodied the old law.¹ *Special* means of such a character that the mark "separates the article to which it is applied from all others of the same class or character; something which points out the article as standing alone, which makes the man who sees or reads the word understand that the article has a special standing, a special existence, and is not one of the general class, for instance, of pianos, but belongs to a class of a particular character."¹ *Distinctive* means that the mark is a distinctive thing which points out that the goods are the goods of A. B.² Thus, in *The Eton Cigarette* case, Fry, L.J., said: "It appears to me, that to satisfy the requirement of (this) definition the word or words must be distinctive in this sense, that they distinguish the manufacture of the person who has registered the trade mark from the manufacture of all other persons."³

Deceptive
mark not
distinctive.

Where, therefore, a cigarette manufacturer had registered the word *Eton* as an old mark, but had sold the cigarettes in boxes bearing the words *St. Petersburg—P. Marrogordato & Co.*, as well as *Eton*, thereby suggesting to purchasers that the goods were not of his manufacture, but were made in Russia, although the mark was known in the trade as, in fact, indicating his manufacture, it was held that he was not entitled to have it registered, and it was accordingly ordered to be removed.³

Descriptive
words.

It follows that words which were merely descriptive of the goods to which they are applied cannot be registered as old trade marks under the clause, for, in fact, they could not be trade marks at all.⁴ So, where fusees were manufactured under a patent which expired in 1881, and were called *braided fixed stars* (*fixed stars* being a common name for fusees, and *braided* descriptive of the process by which the particular goods were manufactured), and the words were registered as an old mark in 1877, they were ordered to be removed from the Register, on this as well as on other grounds,⁵ and in a case in which it was found

¹ See above, pp. 174 *et seq.*

² *Richards v. Butcher*, [1891] 2 Ch. p. 536; 8 R. P. C. 249, Kay, J.; and per Halsbury, L.C., in *Perry, Davis & Son v. Harbord*, 15 App. Ca. p. 320; 7 R. P. C. 336 (1890). See also the definition of distinctive contained in sec. 9, considered above, p. 174.

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

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

⁴ See Chap. II., at pp. 37 *et seq.*

⁵ *Palmer's Tms.*, 24 C. D. 504 (1882). C. A.; and see *Cheshbrough Manufacturing Co.'s Tms.*, [1902] 2 Ch. 1; 18

as a fact that "Swanbill" was descriptive of a corset with a busk of a particular shape, it was held not to be a special and distinctive word.¹

Before the Acts words which were *prima facie* descriptive might be acquired as trade marks, if, by use as such, in connection with the goods of a particular trader, they, in fact, acquired a secondary distinctive meaning distinguishing the goods as his;² and such words may still be so acquired as a "common law trade mark" apart from registration.³ And it is submitted that wherever such words had been used and acquired as trade marks before August 13th, 1875, they are "special or distinctive," and therefore capable of registration within the clause. It was directly decided by Kekewich, J., in a case under the Act of 1875, that such secondary distinctive meaning made a word "special and distinctive"; and *à fortiori* such a word would be qualified under the present Act as "special or distinctive." In the case referred to⁴ Kekewich, J., held the words *J. & J. Hopkinson*, printed in ordinary type, to be "special and distinctive," and to be properly registered as an old mark. "In order to protect a trade mark before the Act," he said, "you were obliged to prove by evidence and satisfy the Court that the words used as a trade mark were known in the market, and, to use Lord Westbury's expression in *Leather Cloth Co. v. American Leather Cloth Co.*,⁵ gave a 'vendible' character to the articles to which they were attached, made those articles recognised as coming from a particular manufactory, and so gave them a character different from that of every other article in the trade. Therefore, it seems to me, that the Legislature in the Act of 1875 did no more than adopt the language of the cases, by reducing them into a compressed form, and say really that what the Court would have held to be a trade mark independently of the Act should now be capable of registration as a trade mark under the Act, provided only that the mark had been used as a trade mark

Word with a secondary distinctive meaning.

R. P. C. 191; 19 R. P. C. 342 (1902), where Buckley, J., ordered the removal from the Register of the word *Fascline*, registered in 1877, on the ground that it was then descriptive of the goods, but on further evidence the Court of Appeal held that the word had been used not to indicate the article, but an article manufactured by a particular manufacturer. See also the cases cited below.

¹ *Bourne's Tms.*, [1903] 1 Ch. 211; 20 R. P. C. 105, Farwell, J.

² See Chap. II., at p. 37.

³ *Reddaway v. Banham*, [1896] A. C. 199; 13 R. P. C. 218 (*Camel Hair Belling*). See below, p. 508.

⁴ *Hopkinson's Tms.*, [1892] 2 Ch. 116; 9 R. P. C. 102.

⁵ Above, p. 52.

before the passing of the Act." And this accords with the opinions expressed by several other judges.¹ *The Monopole* case was discussed² on the assumption that the word, though in itself descriptive, could be registered if it were shown to have been used before the Act of 1875 as a trade mark; and in *The Stone Ales* case³ the only ground upon which the Court of Appeal proceeded in removing the mark *Stone Ale* was the want of proof of such user.

On the other hand, in *Perry, Davis & Son v. Harbord*,⁴ the question was treated as an open one by two of the Lords Justices, for Fry, L.J., said: "It is not necessary now to inquire whether the words must be special and distinctive from their own proper nature and internal force *ex vi terminorum*, or whether they may acquire a distinctive character by user as applied to the goods"; and Lopes, L.J., made use of similar language, and added: "Speaking for myself, I should be inclined to think (the word tendered for registration as an old mark) must be inherently special and distinctive."⁵ And on the further appeal, Halsbury, L.C., and Lord Morris held that the words in question in the case, *Pain Killer* for a medicine, were not special and distinctive; the Lord Chancellor, on the ground that they were descriptive of a quality attributed to the goods to which they were applied.⁶ This decision is not in conflict with the conclusion stated above, for there was no finding or evidence that the medicine of the plaintiffs was distinguished from the same medicine made by others by use of the words *Pain Killer*; on the contrary, it appeared that there was no competition in its manufacture. It

¹ Malins, V.-C., in *Barrow's Tm.*, 5 C. D. 353 (1877); and Porter, M.R., in *Watt v. O'Hanlon*, 4 R. P. C. p. 15 (1887); and Chatterton, V.-C., in *Bodeyn Co. v. Owens*, 6 R. P. C. 241 (1888), both Irish cases. In *Leonard & Ellis' Tm.*, 26 C. D. p. 295 (1884), Ld. Selborne said: "As to the word *Falcoline*, I for my part am not disposed to doubt that, if that word had been used in the United Kingdom as a trade mark before the passing of the Act, it might have been registered under the Act." See also p. 203, note (1).

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

³ Page 204, note (2).

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

⁵ The question was also referred to by Kay, J., in *Grossmill's Tm.*, 6 R. P. C. 180; 60 L. T. 612 (1889) (*Emollio Cream*). Cf. *Wright, Crossley & Co.'s Tm.*, 15 R. P. C. 131 (1898), where Romer, J., held that *Wright, Crossley & Co.*, which had been registered as an old mark, was not on the face of it an illegal or improper mark. In the Court of Appeal this point was not decided; 15 R. P. C. 377.

⁶ Cf. *The Nourishing Stout* case. *Raggett v. Findlater*, L. R. 17 Eq. 29 (1873). Malins, V.-C.

is submitted that the proper construction was that adopted by Kekewich, J., and, as already pointed out, under the present Act all that is required is to show that a word used before August 13th, 1875, was and is distinctive within the meaning of sec. 9.

A geographical word may be registered if it was used as a trade mark and had acquired a secondary distinctive meaning before August 13th, 1875.¹

In order that a word should be registered as a special and [or] distinctive word, it must be such at the date of registration.²

The following words have been held not to be special and distinctive words: EMOLLIO cold cream, *Grossmith's Tm.*, 6 R. P. C. 180; 60 L. T. 612 (1889); BAFFLE safes, *Talbot v. Webley*, 3 R. P. C. 276 (1886); PERRY-DAVIS' VEGETABLE PAIN KILLER, *Perry, Davis v. Harbord*, 15 App. Cas. 316; 7 R. P. C. 336 (1890); SWANBILL, for corsets, *Bourne Tms.*, [1903] 1 Ch. 211; 20 R. P. C. 105.³

Examples of
old word
marks.

And the following have been admitted to registration as such: FRIGIDOMO, for a hot-house plant wrap, *Edgington's Tm.*, 6 R. P. C. 513; 61 L. T. 323 (1889); FAMILY SALVE, *Reinhardt v. Spalding*, 49 L. J. Ch. 57 (1880); EXCELSIOR SPRING MATTRESS, *Chorlton and Dugdale's Tm.*, 53 L. T. 337 (1885); J. & J. HOPKINSON (for pianos), *Hopkinson's Tm.*, [1892] 2 Ch. 116; 9 R. P. C. 102; VASELINE, *Chesebrough Manufacturing Co.'s Tms.*, [1902] 2 Ch. 1; 18 R. P. C. 191; 19 R. P. C. 342.

Used as a Trade Mark.

What is use as a trade mark has already been considered in Chapter II. The following paraphrase by Lord Esher⁴ of the judgment of the Court of Appeal in *Palmer's case*⁵ sums up the rules there stated: "Let us see what was used in the trade, and let us see whether any article was ever in the market made by

Used as a
trade mark.

¹ See the judgments of Cotton, L.J., in *Van Duzer's Tm.*, 34 C. D. p. 635; 4 R. P. C. 31 (1887); and of Kay, J., in *Compagnia General de Tabacos v. Rehder*, 5 R. P. C. 61 (1887) (*Carité*).

² *Wood v. Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A.; *Bourne's Tms.*, [1903] 1 Ch. 211; 20 R. P. C. 105, Farwell, J.

³ In *Dewar & Sons, Ltd. v. J. H. Dewar*, 17 R. P. C. 341 (1900), a Scotch case, Ld. Kyllachy said that he was not satisfied that the words *Dewar's Whisky*

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

⁴ *Spencer's Tm.*, 3 R. P. C. p. 74; 54 L. T. 659 (1886).

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

these people with these words only on them. If we find these words on goods in the market, which are said to be distinguishing marks on the goods, and on the same goods other marks, and never on any goods these words alone, then the conclusion of fact is that what was used upon the goods to distinguish them was all that was on the goods; and we are not going to inquire whether part of what was put on all the goods to distinguish them was at one end of the goods or at the other end of the goods, or whether they were an inch or half an inch apart, or even whether part was at the top and lapping over the side, or whether part was on one side and part on the other. If you find that they are on goods for the purpose of distinguishing the goods, that makes the user one user.”¹

In accordance with these principles, it has been held that words used only as a description of the goods,² for instance, in ordering them from the applicant, are not used as trade marks, and that a device employed as a pattern or design mark³ is not so used either.

Use on bottles
or boxes only.

So also it has been considered that the use of words upon rough packing-cases containing bottles of wine,⁴ or sauce,⁵ or medicine for animals,⁶ or upon the side of a wine cork where they cannot be seen,⁷ is not a use of them as a trade mark, since it does not “sell the goods,”⁸ although in some cases, for example, where the goods are cigars, soap, or the better classes of candles, the trade mark may be, and almost invariably is, put not upon the goods themselves, but on the boxes which contain them.⁹ But in such cases the boxes go into market and are bought with their contents by the purchasers, to whose attention the marks are directed.

¹ Cf. *Crompton's Tm.*, [1902] 1 Ch. 758; 19 R. P. C. 265, where three labels were held to be rightly registered as one trade mark.

² *Hayward's Tm.*, 54 L. J. Ch. 1003 (1885), Kay, J. (*Coker Canvas*); *Talbot v. Webley*, 3 R. P. C. 276 (1886). Bacon, V.-C. (*Baffle Safes*); *Montgomery v. Thompson*, 41 C. D. 35; 6 R. P. C. 404 (1889), C. A. (*Stone Ale*); *Powell's Tm.*, [1893] 2 Ch. 388; 10 R. P. C. 63, 195 (*Yorkshire Relish*), Chitty, J., and C. A., aff. by H. L., [1894] A. C. 8; 11 R. P. C. 4.

³ *Harrison's Tm.*, 42 C. D. 691; 7 R. P. C. 25 (1889), Kekewich, J. (*Albion*).

⁴ *Richards v. Butcher*, [1891] 2 Ch. 522; 8 R. P. C. 249, Kay, J., and C. A.

⁵ *Powell's Tm.*, supra, note (2).

⁶ *Day v. Riley*, 17 R. P. C. 517 (1900). Buckley, J.; and see *European Blair Camera Co.'s Tm.*, 13 R. P. C. 600 (1896), below, p. 207, note (1).

⁷ *Kinahan's Tm.*, 10 R. P. C. 393 (1893), above, p. 31.

⁸ Chap. II., at p. 30, and see *Louise v. Gainsborough*, 20 R. P. C. 61, at p. 64, where it appears that the plaintiffs relied on the use of the Duchess of Devonshire's picture on labels affixed to the boxes in which the hats were delivered. Farwell, J., doubted if that was sufficient.

⁹ *Powell's Tm.*, supra, note (2).

The use by the applicant of a trade mark other than and distinct from the marks which he is seeking to place or maintain on the Register as an old mark is a circumstance to be considered in determining whether he used the mark in question as a trade mark, but it is not conclusive that he did not, for traders often have numerous trade marks and they not infrequently use two or more of them on the same goods at once.¹

Where the applicant has another trade mark.

And, as stated in the passage quoted above,² the mark sought to be registered must have been used, in the form in which it is offered for registration,³ and as a separate mark complete in itself,⁴ as a trade mark before August 13th, 1875.⁵ So that words taken out of a label which was an old trade mark,⁶ and words which had been used as a trade mark when combined with a device,⁷ or with the name of the proprietor,⁸ or with other words,⁹ and which were not shown to have been separately used as trade marks, apart from the other matter, have been refused registration or removed from the Register.

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

The Act of 1905 requires that the use of the trade mark should continue down to the application to register. Under the previous Acts the owner of an old trade mark was entitled to register unless it had been abandoned; mere discontinuance of user, not coupled with an intention to abandon, and not such that an

Use must continue until application to register.

¹ *Powell's Tm.*, [1893] 2 Ch. pp. 394, 406, 411; 10 R. P. C. 63 and 195; [1894] A. C. 8; 11 R. P. C. 4, Chitty, J., C. A. and H. L. (*Yorkshire Relish*); *Richards v. Butcher*, [1891] 2 Ch. 522; 8 R. P. C. 249, Kay, J., and C. A. (*Monopole*); *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. C. 523; 35 L. J. Ch. 53 (1865).

² Pages 203 and 204.

³ *Mecus' Application*, [1891] 1 Ch. 41; 8 R. P. C. 25, Chitty, J. (*Key Brand Genera*); *Fuente's Tm.*, [1891] 2 Ch. 163; 8 R. P. C. 214, Romer, J., both combination marks. See, however, below, p. 316.

⁴ *Spencer's Tm.*, 3 R. P. C. 73; 54 L. T. 659 (1886), Chitty, J., and C. A., and the cases next cited.

⁵ Small user is, of course, sufficient, *Wright, Crossley & Co.'s Application*, [1900] 2 Ch. 218; 17 R. P. C. 386, Byrne, J.

⁶ *Palmer's Tm.*, 24 C. D. 504 (1883),

C. A. (*Braided Fixed Stars*); and see *The Stone Ale and Yorkshire Relish* cases, *supra*, p. 204, note (2).

⁷ *Spencer's Tm.*, *supra*, *Diamond Cast Steel* combined with a cutler's mark; *Leonard & Ellis' Tm.*, 26 C. D. 288 (1884), Pearson, J., and C. A. (*Valentine*).

⁸ *Richards v. Butcher*, [1891] 2 Ch. 522; 8 R. P. C. 37, 249 (1891), Kay, J., and C. A., *Monopole*, with *Heidsieck & Co.* See also *Heddlie & Co.'s Application*, 20 R. P. C. 599 (1903), Byrne, J., device with name of proprietor.

⁹ *Perry, Davis v. Harbord*, 15 App. Cas. 316; 5 R. P. C. 333; 7 R. P. C. 336 (1888), Kay, J., C. A. and H. L. (*Perry-Davis' Vegetable Pain Killer*); and *John Dewar & Sons, Ltd. v. J. H. Dewar*, 17 R. P. C. 341 (1900), Court of Session, where *Dewar's Whisky* had been registered, but it was held that the name under which the whisky had been sold was *Dewar's Perth Whisky* or *John Dewar's Perth Whisky*.

intention to abandon would be inferred, was no disqualification.¹ It will probably be held under the Act of 1905 that the use since August 13th, 1875, must be substantially continual, and that, in deciding whether this condition has been complied with, the circumstances of the trade must be considered.²

Slight variations permitted.

The continued use need not be of the trade mark exactly in its original form, but may be, as sec. 9 provides, with additions or alterations not substantially affecting the identity of the trade mark.³ The Act does not expressly provide that the mark may be registered otherwise than in its original form, but the intention of the proviso appears to be to treat the original mark and the mark as used with additions or alterations not substantially affecting its identity as one and the same. The present Rules provide that an application for an old mark must contain a statement of the time during which and by whom it has been used in respect of the goods mentioned in the application; and the Registrar may require a statutory declaration verifying such user with exhibits showing the mark as used.⁴

Use for the same goods.

The mark must have been used as a trade mark for the class of goods in respect of which it is to be registered,⁵ for it is only in respect of them that it is an old mark; and if registration is applied for in other classes the application, so far as regards such other classes, must be treated on the footing that the mark was not used before August 13th, 1875.⁶ But use on goods essentially the same as those in the class to which the application relates, although they pass under a different name owing to slight variations in size or shape, is sufficient to qualify a mark as an old mark. Thus a mark used on hatchets and augers has been admitted as an old mark for axes and gimlets.⁷

Use in the United Kingdom.

The use must have been use as a trade mark in the United

¹ *Mouson v. Boehm*, 26 C. D. 398 (1884), Chitty, J.; *Wright, Crossley & Co.'s Application*, [1900] 2 Ch. 218; 17 R. P. C. 386, Byrne, J.

² *Mouson v. Boehm*, 26 C. D. 398. Cf. sec. 37.

³ Cf. secs. 14 (9), 26, 27 and 34.

⁴ Rule 20, below, p. 658.

⁵ Chap. V., p. 103.

⁶ *Jelley, Son & Jones' Application*, 51

L. J. Ch. 639, n.; 46 L. T. 381, n. (1878), Jessel, M.R.; and see *Leonard & Ellis' Tm.*, 26 C. D. 288 (1884), C. A., cited pp. 197 and 202, note (1); *Harrison v. Woodroffe*, 42 C. D. 691; 7 R. P. C. 25 (1889), Kekewich, J., and *Batt's Tm.*, (1889) A. C. 428; 16 R. P. C. 411.

⁷ *Jackson & Co. v. Napper*, 35 C. D. 162; 4 R. P. C. 45 (1886), Stirling, J.

Kingdom,¹ and mere importation into a British port for the purpose of re-shipment and transportation is not sufficient.¹

User which was commenced and continued in fraud of the rights of the owner of another trade mark cannot qualify a mark for registration.² The registration of the mark in such case would, besides, almost necessarily be within the prohibition of sec. 11 or sec. 19, as calculated to deceive.

Fraudulent user.

The owner of an old trade mark does not lose his title to register merely because other traders have infringed his right,³ unless the infringements have been so extensive as to make the mark common⁴ or non-distinctive.⁵

Effect of infringements.

Slight evidence of user as an old mark will be accepted, it is said, even the production of a single label,⁶ at any rate after the mark has been registered and used for a long time. Moreover, the onus of proving that a mark registered as an old trade mark was not used before August 13th, 1875, is on the person applying to remove the mark from the Register, at all events where the mark has been long registered.⁷ And where a mark

Slight evidence of user sufficient.

¹ *Meens' Application*, [1891] 1 Ch. 41 ; 8 R. P. C. 25, Chitty, J. ; *Monck's Application*, 50 L. T. 12 (1884), Chitty, J. In *Jackson & Co. v. Napper*, 35 C. D. p. 177 ; 4 R. P. C. 45 (1886), Stirling, J., said : " You must make out user in England " ; but the learned judge probably used the name of the only part of the United Kingdom in which user had been suggested, without intending to exclude user in Scotland or Ireland. The question whether foreign user was sufficient was raised as early as *Leonard & Ellis' Tm.*, 26 C. D. 288 (1884), C. A. In *The European Blair Camera Co.'s Tm.*, 13 R. P. C. 600 (1896), Stirling, J., a foreigner sold to an importer and sent the goods into this country in cases bearing the word *Bull's-eye* and his trade name, and also used the word in pamphlets sent with the goods ; the importer himself sold the goods apart from the cases, and to the public the word had become known only in connection with goods sold by the importer. It was held that there had been such use of the word in connection with the goods in this country as would have entitled the foreigner to oppose the registration of the word by

the importer, and the registration which had been effected in the name of the latter was expunged. The case does not decide that there was user of the word as a trade mark. See also *Neostyle Manufacturing Co., Ltd.'s Tm.*, 20 R. P. C. 329 and 803 (1903), C. A., where a person who had manufactured goods in this country and exported them marked with the word " Neostyle " was held to be a " person aggrieved " by the registration of the word by another person. As to user on cases, see p. 204.

² *Heaton's Tm.*, 27 C. D. 570 (1884), Kay, J. (*Hoop & Iron*) ; *Monck's Application*, note (1).

³ See *Heaton's Tm.*, supra.

⁴ Chap. XIV., p. 362.

⁵ Above, p. 201.

⁶ *Chorlton and Dugdalc's Tm.*, 53 L. T. 337 (1888), Pearson, J. ; *Palmer's Tm.*, 21 C. D. 47 ; 24 C. D. 504 (1882), Chitty, J., and C. A. The usual evidence is the production of old prints and dies or blocks for printing.

⁷ *Edgington's Tm.*, 6 R. P. C. 513 ; 61 L. T. 323 (1889), Kay, J. ; *Cheshbrough Manufacturing Co.'s Tm.*, [1902] 2 Ch. 1 ; 19 R. P. C. 342, C. A.

has stood upon the Register unchallenged for years, and important witnesses have died who might have given evidence of qualifying user before 1875, the Court accepts evidence of non-user, put forward by any one who seeks to procure the removal of the mark from the Register, with considerable hesitation.¹

Where, on a motion to expunge, the owner of the mark does not appear to defend it, the onus is still on the applicant to prove non-user, and he may be in some difficulty in making out such a case.² But the onus of proving non-user before 1875, although on the person attacking the validity of the mark, may be shifted. Thus, in a Scotch case in which the owners of the mark led in the proof, but called no evidence to show such user and the mark had not been registered till 1891, and the evidence showed that during the period which it covered, commencing at some date subsequent to 1875, and down to the date of the proceedings a different trade mark had been used,³ it was held that the onus was shifted on to the owners, and that, as they had not discharged it, the presumption was that there had been no user prior to August 13th, 1875.⁴

Standardisation Trade Marks.

By sec. 62 of the Act of 1905—

Standardisation,
&c.,
trade marks.

“Where any association or person undertakes the examination of any goods in respect of origin, material, mode of manufacture, quality, accuracy, or other characteristic, and certifies the result of such examination by mark used upon or in connection with such goods, the Board of Trade may, if they shall judge it to be to the public advantage, permit such association or person to register such mark as a trade mark in respect of such goods, whether or not such association or person be a trading association or trader or possessed of a goodwill in connection with such examination and

¹ *Edgington's Tm.*, p. 207, note (7).

² In *Royal Baking Powder Co.'s Tms.*, 14 R. P. C. 425 (1897), Romer, J., where the applicants were successful, they showed that they had on first hearing of the mark some years before cautioned a person who represented the registered proprietor against using the mark, and

heard no more of it for ten years afterwards.

³ *Dewar's Perth Whisky*, the registered trade mark being *Dewar's Whisky*.

⁴ *John Dewar & Sons, Ltd. v. J. H. Dewar*, 17 R. P. C. 341 (1900), Court of Session.

certifying. When so registered such trade mark shall be deemed in all respects to be a registered trade mark, and such association or person to be the proprietor thereof, save that such trade mark shall be transmissible or assignable only by permission of the Board of Trade."

A trade mark applied for under this section must be a registrable trade mark, and comply with sec. 9. The effect of the section is simply to allow associations and traders to register trade marks to be applied to goods certified by them, although they have no such trade connection with such goods as would, apart from this section, entitle them to register the marks in respect of such goods. The definition in the Act of a trade mark includes a mark used or proposed to be used to indicate that the goods are those of the proprietor of the trade mark by virtue of "certification,"¹ and therefore covers the case dealt with by this section.

The general rule of sec. 22 that a trade mark is assignable only in connection with the goodwill of the business in the goods is, of course, inapplicable to marks registered under sec. 62. The permission of the Board of Trade is required to an assignment or transmission in order to prevent a standardisation mark being passed on to somebody in whose hands it would have a meaning different from that it had come to import. The procedure on application to register is dealt with above, p. 83.

Colour.

By Sec. 10—

"A trade mark may be limited in whole or in part to one or more specified colours, and in such case the fact that it is so limited shall be taken into consideration by any tribunal having to decide on the distinctive character of such trade mark. If and so far as a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours."

Trade marks
by be limited
to specified
colours.

Under the Act of 1875, colours could not be registered.² Sec. 67 of the Act of 1888 was as follows:—"A trade mark may be registered in any colour or colours,³ and such registration shall (subject to the provisions of this Act) confer on the

¹ See the definition, above, p. 24.

resemble a silver coin is inconsistent with the later authorities.

² *Robinson's Tm.*, 29 W. R. 31 (1880), Jessel, M.R. The decision in this case that a gold coin could not too nearly

³ The words "or colours" were added by the Act of 1888, s. 11.

Registration
in colours.

registered owner the exclusive right to use the same in that or any other colour or colours.¹ This provision was, however, of little use to owners of trade marks, for it was held that a trade mark propounded for registration in colours must be distinctive independently of the colours. Thus an oblong label divided into three sections, which were respectively printed in red, white, and blue, was held not to be distinctive within the meaning of the Act.² Colour, said Kay, J., is treated as an accident, and if the mark were registered the applicant might use it in any colours he chose. "You may register a mark, which is otherwise distinctive, in colour, and that gives you the right to use it in any colour you like; but you cannot register a mark of which the only distinction is the use of a colour, because, practically, under the terms of the Act, that would give you a monopoly of all the colours of the rainbow." The only exception to this rule was possibly in the case of an old mark.³

The alteration in the law in this respect made by the Act of 1905 is a very useful one, for many marks depend for their distinctiveness on their colouring, and in such cases advantage will no doubt be taken of the terms of sec. 10 to limit them to specified colours. It must be remembered, however, that the fact that the registration of a trade mark was so limited would have to be taken into account in considering a question of infringement. It is therefore not advisable in registering a trade mark to limit it as regards colour, except so far as is necessary in order to assist distinctiveness.

Where a mark is registered without limitation of colour, the Registrar may grant a certificate of its registration for the purpose of obtaining registration abroad either in the colour in which it appears upon the Register or in any other colour or colours.⁴

The question of colour in connection with line headings for cotton piece goods is referred to in the earlier part of the chapter.⁵

The colours in which a mark is actually used, or is likely to be used, have often a material bearing upon questions of alleged

Bearing of
colour upon
the resem-
blance of
marks.

¹ See note (3) previous page.

² *Hanson's Tm.*, 37 C. D. 112; 5 R. P. C. 130 (1887), Kay, J. But the same mark, registered without colours, *i.e.*, as a label with three parallel stripes and the words *red, white and blue*, had been protected from infringement by the use of a similar coloured label comprising

the same words: *Hanson v. British Tea, &c. Association* (1884), Bacon, V.-C., and C. A.; Sebastian, 4th ed. p. 338.

³ *Bass, Ratcliffe and Gretton's Tms.*, [1902] 2 Ch. 579; 19 R. P. C. 129 and 529.

⁴ Rule 103, below, p. 669.

⁵ Above, p. 191.

resemblance calculated to deceive, or of infringement;¹ for instance, a design similar in outline to that of the device in another mark, but filled up in a totally different manner, may have the distinctive filling up obscured by the use of a deep colour in printing.² Again, registration of a mark which contained Oriental words meaning *The Golden Fan Brand*, was refused on account of the presence on the Register of a fan mark, which in use was in gold colour,³ and the refusal was upheld by the Court of Appeal. The fact that a registered owner whose mark is registered without limitation of colour, may use it in any colour must also be taken into consideration. Thus the words *red star brand* were directed to be removed from the Register on the ground that they constituted a mark having such resemblance to a star device mark, which might be coloured red in actual use, as to be calculated to deceive.⁴

Trade marks for the same description of goods, which while resembling each other in the material particulars thereof differ in colour amongst other things, may be registered in a series.⁵

In some cases under the earlier Acts marks have been allowed to be entered or retained on the Register upon the proprietors undertaking to use them in particular colours only, a note of the undertaking being placed on the Register.⁶ But some disapproval of notes on the Register limiting a registration was expressed in a subsequent case under the Act of 1898.⁷ Under the present Act, however, a limitation of colour is expressly recognised, in addition to which the Registrar and the Court have full powers to impose conditions on applicants.⁸

¹ *Mitchell v. Henry*, 15 C. D. 181 (1880), C. A.; *Turney & Sons' Tm.*, 11 R. P. C. 37 (1893), North, J. See also *Lever Bros., Ltd. v. Beddingfield*, 15 R. P. C. 453; affirmed as to infringement, 16 R. P. C. 3 (1898), Kekewich, J., and C. A.

² *Worthington's Tm.*, 14 C. D. 8 (1880), C. A.; *Biegel's Tm.*, 4 R. P. C. 525; 57 L. T. 247 (1887), Chitty, J., *Turney & Sons' Tm.*, note (1).

³ See *Dewhurst's Application*, [1896] 2 Ch. 137; 13 R. P. C. 288.

⁴ *Société, &c. de l'Étoile's Tm.*, [1894] 1 Ch. 61; 2 Ch. 26; 10 R. P. C. 436;

11 R. P. C. 142; Stirling, J., and C. A.

⁵ Sec. 26.

⁶ *Re Jeffrey & Co.*, May 18th, 1888, Stirling, J., registration allowed with note binding applicants not to use mark in black, or any colour so dark as to resemble black; *Re Johnson, Philpott & Co.*, Feb. 21st, 1888, North, J., Register rectified by consent, by adding note that the proprietor was only to use his mark in blue and white. Both cases are cited Sebastian, 4th ed. p. 338.

⁷ *Dewhurst's Application*, above note (3).

⁸ Secs. 12 (2), (6) and 14 (5), (6).

CHAPTER IX.

DISCLAIMERS.

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Sec. 15 of the
Act of 1905.
Disclaimers.

Sec. 15 of the Act of 1905 enacts as follows:—

“ If a trade mark contains parts not separately registered by the proprietor as trade marks, or if it contains matter common to the trade or otherwise of a non-distinctive character, the Registrar or the Board of Trade or the Court, in deciding whether such trade mark shall be entered or shall remain upon the Register, may require, as a condition of its being upon the Register, that the proprietor shall disclaim any right to the exclusive use of any part or parts of such trade mark, or of all or any portion of such matter, to the exclusive use of which they hold him not to be entitled, or that he shall make such other disclaimer as they may consider needful for the purpose of defining his rights under such registration: Provided always that no disclaimer upon the Register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.”

Mark may
contain non-
distinctive
matter.

It is provided by sec. 9 of the Act that a registrable trade mark must contain or consist of at least one of the essential particulars enumerated in that section; and it is clear from that section, as well as from sec. 15, that a trade mark may include matter besides its essential particular or particulars, as, for

instance, the name and address of the proprietor of the mark, statements of quality or price, place of manufacture, or descriptive or ornamental matter. In the Act of 1883 certain additions to essential particulars were expressly authorised,¹ and there was also authorised the addition to a trade mark of any distinctive word, or combination of words, although the same was common to the trade,² that is to say, open to the trade,³ in the particular goods. Under the Act of 1883, as amended by the Act of 1888, an applicant had to specify in his application the essential particular or particulars of his trade mark and expressly disclaim the right to the exclusive use of such additional matter or additions, except so far as they consisted of his own name, or the foreign equivalent thereof, or his place of business.⁴ Registration of old marks with additions, but subject to disclaimer, was also allowed by these Acts.⁵ The system of additions and disclaimers complicated the working of the Acts, and the result of the provisions as to disclaimer was in some cases that an applicant was required as a condition of registration of his mark to disclaim matter, which did not constitute an essential particular within the meaning of the Acts, but did form perhaps an important feature of his mark contributing to the distinctiveness of the whole. This result entailed in many cases a hardship on the owner of a trade mark, particularly as it was held that a plaintiff in a passing-off action could not rely in that action on matter which he had so disclaimed,⁶ and some traders considered it preferable not to apply to register their trade marks, or even to submit to a trade mark being removed from the Register, rather than to make the disclaimer imposed on them by the Acts. Thus, in *Faulder's Trade Mark*,⁷ the owners of a trade mark registered in respect of preserves elected to have their trade mark, which included the word "Silverpan," expunged from the Register rather than have a disclaimer of that word entered on the Register; and subsequently in an action for passing-off brought

Added matter
in Acts of
1883 and
1888.

¹ Sec. 64 (2). The Act is fully set out below, pp. 626 to 645.

² Sec. 74 (1) (b).

³ *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J.

⁴ Act of 1883, secs. 64 and 74; Act of 1888, secs. 10 and 16.

⁵ Act of 1883, sec. 74; Act of 1888,

sec. 16.

⁶ *Rosenthal v. Reynolds*, [1892] 2 Ch. 301; 9 R. P. C. 189, North, J. The Court of Session in Scotland refused, however, to follow that decision, *Bayer v. Baird*, 15 R. P. C. 615 (1898).

⁷ [1902] 1 Ch. 125; 18 R. P. C. 37 and 535, C. A.

Scheme of the Act of 1905 as to disclaimers.

by the owners of the mark the word "Silverpan" was held to be a fancy word identified with the plaintiffs' firm, and an injunction was granted against the defendants restraining the use of a circular in which the words "Silver Pan" were prominent. The system of additions with disclaimers above referred to has been swept away by the Act of 1905,¹ and the scheme of that Act is that, provided that a mark is qualified for registration by the possession of one or more essential particulars, it should be registered as a whole, subject only in exceptional cases, where necessary for the protection of public or private rights, to a disclaimer having the effect of defining the rights of the owner of the mark. In a recent case² *Eve, J.*, said that the object of the Legislature was to relieve traders from the necessity of disclaiming, and that the condition was one for the imposition of which some good reason ought to be established rather than one which ought to be imposed, unless some good reason to the contrary was made out; and he held that an unsuccessful claim to a monopoly of the letters A.B.C. was not a ground necessarily for requiring a disclaimer of them. The alteration of the law is especially important where registration abroad is desired, since some countries do not register a foreign owner of a trade mark unless it is registered in his own country.

In what cases disclaimers may be required.

A disclaimer under sec. 15 of the Act may be required in either of the following cases: (1) If the mark contains parts not separately registered by the proprietor as trade marks; (2) If it contains matter common to the trade or otherwise of a non-distinctive character.

Parts not separately registered.

(1) A combination trade mark or a label may, and often does, contain a mark which may be separately registered, as, for instance, a distinctive device; and it is expressly provided by sec. 25 that, if the proprietor of a trade mark claims to be entitled to the exclusive use of any portion of such trade mark separately, he may apply to register the same as separate trade marks (*sic*). Each such separate trade mark must satisfy all the

¹ It will be found fully discussed in the 2nd edition of this work, Chap. IX., p. 197, but, as it is practically obsolete, the full discussion is omitted in this edition; and as to additions or added matter, see *Faulder's Tm.*, [1902] 1 Ch. 125; 18 R. P. C. 535, C. A.; and *Royal Baking Powder Co.'s Application*,

19 R. P. C. 261 (1902), Farwell, J. As to the particularity formerly required in a statement of essential particulars, see *Crompton's Tm.*, [1902] 1 Ch. 758; 19 R. P. C. 265.

² *Application of Albert Baker & Co. (1898) Ltd.*, [1908] 2 Ch. 86; 25 R. P. C. 513 (*A.B.C.*).

conditions and have all the incidents of an independent trade mark, except that when registered it and the trade mark of which it forms part are to be entered on the Register as associated marks, with the result that they are not separately assignable. A disclaimer may be required of parts of a mark not so separately registered subject to this, that the parts required to be disclaimed must be parts to the exclusive use of which the tribunal holds the proprietor not to be entitled, or the disclaimer must be necessary for the purpose of defining the rights of the proprietor of the mark under the registration; and these particular words of the section seem to apply to a case in which a mark contains matter, not common to the trade or otherwise of a non-distinctive character, but of which the owner of the mark cannot claim a right of exclusive use by reason, for instance, of another trader having the right to use the same.

(2) Matter common to the trade or otherwise of a non-distinctive character. The expression "common to the trade" occurred in sec. 74 of the Act of 1883, which allowed the registration as an addition to a trade mark of certain distinctive matter, although the same was common to the trade in the goods with respect to which the application was made, but a disclaimer of the exclusive use of such matter was required.¹ Matter which is really distinctive cannot at the same time be "common to the trade," so that the word distinctive in this section was held to mean *prima facie* distinctive,² and the section was held to apply to additions which would be distinctive if they were not common to the trade. The expression "common to the trade" is capable of two meanings, namely, in common use in the trade,³ or open to the trade to use. Sub-sec. (3) of sec. 74 (which enacted that any device, &c., which was, before August 13th, 1875, publicly used by more than three persons

Matter
common to
the trade.

The three
mark rule.

¹ The section is fully set out below, pp. 631, 632. It was held under the Act of 1875 that registration of a distinctive label conferred no exclusive right to words common to the trade, *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886); and as to infringement of a label containing such matter, see *Hennessy v. Dompé*, 19 R. P. C. 333; 20 R. P. C. 175 (1903); and *Hennessy & Co. v. Keating*, 24 R. P. C. 485; 25 R. P. C. 125 and 361 (1908), H. L.

² *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J. (*Washerine*); *Thompson v. Miller*, 13 R. P. C. 35 (1896), Stirling, J. (*Roadster*); *Faulder's Tm.*, [1902] 1 Ch. 125; 18 R. P. C. 37 and 535, Kekewich, J., and C. A. (*Silverpan*).

³ "Nothing, I apprehend, can be common to the trade, which is only used by one person in the trade." Per Lindley, L.J., in *Thompson v. Montgomery*, 41 C. D. 35; 6 R. P. C. 404 (1889).

on the same or a similar description of goods, should, for the purposes of that section, be deemed common to the trade in such goods) provided a test of what was common in the trade. It was in fact a statutory recognition of a rule, known as the three mark rule, originally introduced by the Commissioners of Patents under the Act of 1875, and recognised by the Courts before the Act of 1883 was passed.¹ It applied whether the marks used by the three persons were precisely, or only substantially, similar, and whether they had been used as trade marks or otherwise, provided that they had been used on the same or a similar description of goods,¹ but use abroad did not fall within the rule.² The Act of 1905 contains no similar provision, but the same test of what is common in the trade would no doubt be applied. But as regards additions to new marks, the words "common to the trade" in the earlier part of sec. 74 were held not to be confined to such matter, but to mean "open to the trade to use."³ This would, of course, apply to all merely descriptive matter, but, as pointed out above, the section dealt with matter *prima facie* distinctive, and the expression "common to the trade" was said in one case⁴ to be applicable in the sense of "open to the trade to use" to a word once largely used in the trade, but which had subsequently fallen out of use by all but one or two persons, or to a word descriptive of the goods, if *prima facie* distinctive.⁵ In the Act of 1905 the expression is probably wide enough to include, not only matter in common use in the trade, but matter *prima facie* distinctive, which for some reason, as, for instance, that suggested in *The Washetine* case, is open to the trade to use.⁶ Matter which is merely descriptive is clearly covered by the words "or otherwise of a non-distinctive

¹ See *Jelley's Application*, 51 L. J. Ch. 639, n. (1878); *The Walkden, ac. Co.'s Application*, 54 L. J. Ch. 394, n. (1877), both Jessel, M.R.; *Wragg's Tms.*, 29 C. D. 551 (1885), Pearson, J.; *Benbow v. Low*, 44 L. T. 875 (1891), Bacon, V.C.; and the judgment of Chitty, J., in *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889); also *Baker v. Rawson*, 45 C. D. 429; 8 R. P. C. 89 (1891), North, J.

² See *Munch's Application*, 50 L. T. 12 (1884), Chitty, J.

³ *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889),

Chitty, J. (*Washetine*); *Thompson v. Miller*, 13 R. P. C. 35 (1896), Stirling, J. (*Roadster*). See also *In re Faulder's Tm.*, [1902] 1 Ch. 125; 18 R. P. C. 37 and 535, Kekewich, J., and C. A. (*Silverpan*).

⁴ *The Washetine* case, note (3).

⁵ *Humphries v. Taylor Drug Co.*, 59 L. T. 920 (1888), Kekewich, J. (*Herbalin*) and the *Washetine* and *Roadster* cases, note (3).

⁶ In *Application of Albert Baker & Co. (1898) Ltd.*, [1908] 2 Ch. 86; 25 R. P. C. 513, Eve, J., seems to have so construed the section.

character" in sec. 15. Such matter, however, will not as a general rule be required to be disclaimed. The rights of other traders will generally be sufficiently protected by sec. 44, which provides that no registration under the Act shall interfere with any *bonâ fide* use by a person of his own name or place of business or that of any of his predecessors in business or the use by any person of any *bonâ fide* description of the character or quality of his goods.¹ Apart from this special enactment, the registration of a label distinctive as a whole does not give to the proprietor the right to the exclusive use of merely descriptive matter contained in it; at least this was so held under the Act of 1875 by the Court of Appeal,² and the principle of the decision seems to be still applicable.

It was settled under the Acts of 1883 and 1888 that words common to the trade or common matter contained in a distinctive label need not be disclaimed,³ for a distinctive label is itself an essential particular, and consists of the combination of all the parts.⁴ A distinction must be made between such a label and a mere word or device coupled with mere flourishes or a conventional border.⁵ Under sec. 15 of the Act of 1905 there seems to be power to require a disclaimer of part of a distinctive label.

Label distinctive as a whole.

In any case coming within the terms of the first part of the section a disclaimer may be required of the right to the exclusive use (1) of any part or parts of such trade mark to the exclusive use of which the tribunal holds the proprietor not to be entitled, or (2) of all or any portion of matter, common to the trade or otherwise of a non-distinctive character, to the exclusive use of which the tribunal hold the proprietor not to be entitled.⁶ The

¹ Cf. sec. 64 (3) (ii.) and sec. 74 (2) of the Act of 1883, as amended by that of 1888, below, pp. 629, 632.

² *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886). See also cases referred to above, p. 215, note (1)

³ *Smokeless Powder Co.'s Tms.*, [1892] 1 Ch. 590; 9 R. P. C. 109, Chitty, J.; *Apolinaris Co.'s Tms.*, [1891] 2 Ch. 186; 8 R. P. C. 137, C. A.; *Clement et Cie.'s Tm.*, [1900] 1 Ch. 114; 16 R. P. C. 173 and 611, Kekewich, J., and C. A.; and *Application of Albert Baker & Co.* (1898), *Id.*, 25 R. P. C. 513 (1908), Eve, J. A contrary opinion seems to have been expressed in the earlier case of *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155

(1886). The *Washerine* and *Roadster* cases, p. 216, note (3), were not, perhaps, cases of labels distinctive as a whole.

⁴ Per Esher, M.R., in *Pinto v. Badman*, 8 R. P. C. 181 (1891).

⁵ *Clement et Cie.'s Tm.*, p. 216, note (7); and in *Royal Baking Powder Co.'s Application*, 19 R. P. C. 261 (1902). Farwell, J., a part of the label separated from the distinctive part by a border, and containing the name of the article and directions for use, &c., was held to be "added matter."

⁶ The words "to the exclusive use," etc., seem to apply both to (1) and (2). See the section set out above, p. 212.

words marked (1) seem to refer especially to the words in the earlier part of the section relating to parts of the mark not separately registered, and the words marked (2) to common or non-distinctive matter; but it may be that the construction ought not to be strictly *reddendo singula singulis*. Lest the parts of the section already quoted do not meet the case, the tribunal is under it given an express power to require such other disclaimer as it may consider needful for the purpose of defining the rights of the proprietor under such registration; but the case must fall within the opening words of the section, otherwise no disclaimer can be required under it. By Rule 34 the Registrar may call on an applicant to insert in his application such disclaimer as the Registrar may think fit in order that the public generally may understand what the applicant's rights, if his mark is registered, will be. It will be noticed that the wording of this Rule does not follow that of sec. 15.

Time at which disclaimer may be required.

It was held, both under the Act of 1883 and that of 1888, that a disclaimer required by the Acts must be made on application for registration, and that therefore the Court on an appeal from the Comptroller could not allow an amendment of the application by disclaimer,¹ and, although the Court in a few cases did make an order for disclaimer on a motion for rectification,² the power of the Court so to do was questioned by the Court of Appeal.³ It is quite clear that under sec. 15 of the Act of 1905 a disclaimer may be required by the Registrar on an application to register, or by the Board of Trade or the Court on an appeal from the Registrar in an application to register, or on such an application as a condition of registration of a standardisation mark under sec. 62, or by the Court on an application to rectify the Register under sec. 35. Full powers of allowing amendment of applications to register are conferred on the Registrar, the Board of Trade and the Court, by sec. 12 (6). In an application for rectification the proprietor could elect to have his trade

¹ *Goodall's Tm.*, 42 C. D. 566 (1889), North, J.; *Mecus' Application*, [1891] 1 Ch. 41; 8 R. P. C. 25, Chitty, J.; *Wright, Crossley & Co.'s Application*, [1900] 2 Ch. 218; 17 R. P. C. 386, Byrne, J.; *Playfers' Application*, [1901] 1 Ch. 382; 18 R. P. C. 65, Cozens-Hardy, J. A disclaimer was allowed in *König and Ebhardt's Tm.*, [1896] 2 Ch.

236; 13 R. P. C. 149.

² *Hayward's Tm.*, 54 L. J. Ch. 1003 (1885), Kay, J.; *Wright's Tm.*, 8 R. P. C. 207-291, Chitty, J.; *Berland v. Brunner, Oldfield & Co.*, 42 C. D. 274; 6 R. P. C. 182, Chitty, J.; *Thompson v. Miller*, 13 R. P. C. 35 (1896), Stirling, J.

³ *Faulder's Tm.*, [1902] 1 Ch. 125 18 R. P. C. 535.

mark expunged from the Register, rather than have a disclaimer entered on the Register. This appears clear from the terms of the section itself, and a trade mark can always be cancelled on the application of the proprietor.¹

The Registrar may, on the request of the registered proprietor of a trade mark or of some person entitled by law to act in his name, enter on the Register a disclaimer or memorandum relating to it which does not in any way extend the rights given by the existing registration of such trade mark.² A right of appeal to the Board of Trade is given.

The effect of a disclaimer is that the proprietor of the registered trade mark cannot claim any trade mark rights under the Acts, in respect of the parts of the mark to which the disclaimer relates,³ so that, for instance, no action for infringement lies in respect of the use or imitation of the disclaimed particulars. But sec. 15 expressly provides that no disclaimer shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made. This proviso gets rid of the decision of North, J., who, in a passing-off case,⁴ refused an interlocutory injunction on the ground that the plaintiff was relying on certain letters the exclusive use of which he had disclaimed. The Scotch Court of Session, however, declined to follow North, J., on the point, and held that such a disclaimer did not affect the registered proprietor's common law rights.⁵ In addition to the proviso to sec. 15, the Act contains an express reservation of all rights of action in passing-off cases.⁶ The mere presence in a second mark tendered for registration of disclaimed words does not make it resemble an earlier registered mark, in which the same words had been disclaimed, within the

Disclaimer at the instance of the proprietor.

Effect of registration with disclaimer.

¹ Sec. 32. See also *Faulder's Tm.*, [1902] 1 Ch. 125; 18 R. P. C. 535.

² Sec. 32. See also below, p. 313.

³ *Pirie v. Goodall*, [1892] 1 Ch. 35; 9 R. P. C. 17, V. Williams, J., and C. A., *Pirie's Parchment Bank*, the plaintiffs disclaimed *parchment* and *bank*, but sought to set up some right to the combination; as to this see *Hubbuck v. Brown*, 17 R. P. C. 638 (1900), C. A.; also *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1890), North, J.

⁴ *Rosenthal v. Reynolds*, [1892] 2 Ch.

301; 9 R. P. C. 189, North, J. See also *Packham v. Sturgess*, 15 R. P. C. 669 (1898), North, J.

⁵ *Bayer v. Baird*, 15 R. P. C. 615 (1898) (*C. B. Corsets*). Cf. also *Thompson v. Miller*, 13 R. P. C. 35 (1896), Stirling, J. (*Roadster*), with *Burland v. Broxburn Oil Co.*, 6 R. P. C. 482, Chitty, J. (*Washerine*); and see also *Packham v. Sturgess*, 15 R. P. C. 669 (1898), North, J., and C. A. (*Sparkling Lime Wine*).

⁶ Sec. 45.

Registration
with blanks.

meaning of sec. 19.¹ But in comparing two marks which are alleged to resemble each other too closely, some account must be taken of elements common to the trade which are included in both,² and on this ground the registration of a trade mark, with the common words or other particulars which are actually used in it, may secure it a more efficient protection under sec. 19 against the subsequent registration of similar marks in the same class than would be obtained by the registration of its distinctive elements only. If the places occupied by matter which would have to be disclaimed are left blank upon the Register, the proprietor forfeits none of his exclusive rights to the use of the registered and distinctive parts of the mark by filling up the blanks, in actual use, in any manner he pleases,³ and, for the purposes of sec. 19, marks should be compared with the blanks filled in as actually used.⁴

Traders prefer to register their marks as they are actually used, both because it saves the expense and trouble of preparing special prints for registration only, and for convenience of reference. Moreover, in some foreign countries registration is only permitted in the case of trade marks owned by foreigners in the exact form in which the marks are registered in the country of origin.

¹ *Loftus' Tm.*, [1894] 1 Ch. 193; 11 R. P. C. 29, North, J. (*Unco's* Guid in each of two quite distinct labels); and the cases in note (3), p. 219.

² See Chap. X., p. 241.

³ *Melachrino & Co. v. The Melachrino Egyptian, &c. Co.*, 1 R. P. C. 215 (1887);

Hammond v. Brunner, 9 R. P. C. 301 (1892), both Chitty, J.; and see Chap. XV., at p. 250.

⁴ *Christiansen's Tm.*, 3 R. P. C. 54 (1886); *Lyle & Kinahan's Application* 24 R. P. C. 249 (1907), C. A.

CHAPTER X.

RESTRICTIONS ON REGISTRATION.

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The Registrar's discretion is not limited by the express restrictions.

NOTHING can be entered upon the Register which is not authorised by the sections set out and commented on in Chapter VIII.,¹ and, as stated in that chapter, the Registrar has a discretion, subject to appeal, to refuse to register marks which he thinks ought not to be accepted, although they comply with the provisions of the enabling sections. This discretion is, as has been shown, general, and it extends beyond the letter of the restrictions imposed by other sections of the Acts which are the subject of the present chapter.²

The most important sections to be considered in this chapter are secs. 11, 19, 20, and 21.

I. Identical or Resembling Marks.

Sec. 19 is as follows:—

“Except by order of the Court or in the case of trade marks in use before the the thirteenth day of August, one thousand eight

Identical or resembling marks.

¹ Page 129, secs. 9 and 62, see are imposed by Rules 11 to 16 inclusive; see below, p. 657.

² Certain restrictions on registration

hundred and seventy-five, no trade mark shall be registered in respect of any goods or description of goods which is identical with one belonging to a different proprietor which is already on the Register with respect to such goods or description of goods, or so nearly resembling such a trade mark as to be calculated to deceive."

And sec. 20 provides :—

"Where each of several persons claims to be proprietor of the same trade mark, or of nearly identical trade marks in respect of the same goods or descriptions of goods, and to be registered as such proprietor, the Registrar may refuse to register any of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by him or (on appeal) by the Board of Trade."

Rival claims
to identical
marks.

The corresponding provisions of the Act of 1883, as amended by the Act of 1888, were as follows :—

Sec. 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.*

"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.*

"(2) *Except as aforesaid, the Comptroller shall not register with respect to the same goods or description of goods a trade mark 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.*"

It will be noticed that sec. 20 extends to marks nearly identical, whereas sec. 71 of the former Act was confined to cases in which there were conflicting claims to registration to the same trade mark. The provisions of the two sub-sections of sec. 72 of the former Act are now condensed into a single provision, which is substantially the same as before; in adopting the expression "so nearly resembling" instead of "having such resemblance," the Legislature has, however, reverted to the language of the Act of 1883 before amendment. The former expression suggests a closer resemblance than the latter one does.¹

The special exception made in sec. 19 in the case of a trade Old marks.

¹ See the Report of Ld. Herschell's Committee, quoted below, p. 237.

mark in use before August 13th, 1875, the commencement of the first Registration Act,¹ enables the Registrar to accept such a trade mark, although it is identical with one already on the Register for the same goods or description of goods. Under the repealed Acts, an order of the Court was required by sec. 72. Before the introduction of registration, when trade mark rights could, except in a few special trades and in particular places,² be acquired only by user, the duplication of marks for use in connection with the same description of goods, by use in different districts, was very common, and many duplicate old marks have been admitted on to the Register. A limit was put to the number of such duplicates which would be accepted by the adoption of the three mark rule which has been already referred to.³ According to the rule, three, but not more than three, identical or substantially identical⁴ old marks may be registered for use upon the same, or substantially the same, class or description of goods, provided that the marks have been honestly and lawfully acquired and used. So that a mark which was originally unlawfully copied from another could not claim registration along with the other under cover of the rule.⁵ If more than three such marks had been so acquired and used before August 13th, 1875, they were all treated as common to the trade;⁶ but the use of a mark abroad did not fall within the rule.⁷ Leave to register a second old mark is granted as of course, if an independent and honestly acquired title to the mark as a trade mark is shown. In *Jelley's case*,⁸ Jessel, M.R., said: "I have often had the case of a man in one town not knowing that another man in another town has the same mark, and he has got his trade mark registered. The second applicant must prove his title, that is all. The leave of the Court mentioned in sec. 6⁹ is not a capricious leave. The rule of the Court which I have just stated is always followed, and it merely means that the second man must show his title. You cannot deprive him of his trade mark. Look at the monstrous injustice that would be done if a man who had a trade mark for,

The three
mark rule.

Application
of the rule.

¹ Trade Marks Registration Act, 1875, printed below, p. 647.

² *E.g.*, the cutlery trade in Sheffield.

³ Chapter IX., p. 215; Act of 1883, s. 74 (3).

⁴ *White Rose Tm.*, 30 C. D. 505 (1885), Kay, J.

⁵ *Jelley's Application*, 51 L. J. Ch. 639, n. (1878), Jessel, M.R.

⁶ See *Burland v. Brockburn Oil Co.*, 42 C. D. at p. 280; 6 R. P. C. 482 (1889), Chitty, J.

⁷ *Münch's Application*, 50 L. T. 12 (1884), Chitty, J.; and see *Jackson & Co. v. Napper*, 35 C. D. at p. 178; 4 R. P. C. 45 (1886), Stirling, J.

⁸ 51 L. J. Ch. 639, n. (1878).

⁹ *I.e.*, of the Act of 1875.

perhaps, forty years, should lose it, because another man who had it for four years had happened to register it first." It was held that registration of an old mark might be allowed, although a similar mark had been on the Register for more than five years.¹

The rule has never been applied to new marks, that is to say, to marks first used or invented since August 13th, 1875.² Title to a trade mark can still, however, be acquired by use, although registration is a condition precedent to any action by the proprietor in respect of its infringement,³ and it is possible for two traders to acquire similar trade marks independently by user in separate districts. The Court has, however, now a discretion to allow registration of similar marks in a case of honest concurrent user.⁴

Section 20 empowers the Registrar, if there are rival claimants to registration of identical or of nearly identical trade marks in respect of the same goods or description of goods, to refuse registration, until their rights have been determined by the Court or settled by approved agreement. It corresponds to sec. 71 of the Act of 1883. Both sections are set out in extenso at the commencement of this chapter. Section 20 deals with cases in which there are two or more applications pending, sec. 19 with those in which one of the rival owners or claimants is already on the Register. The search to be made by the Registrar on receiving an application to register includes pending applications.⁵ Two methods of settling the conflicting claims are permitted under the section, one by submitting the question of such claims for determination by the Court, the other by agreement. No special procedure under this section is laid down by the rules.⁶ In the first case that was submitted to the Court under the section, the application was by one of the claimants that the registration might proceed notwithstanding the other application; this was in accordance with the usual directions given by the Court under the earlier Acts and the rules thereunder.⁷ In

Sec. 20.
Duplicate
claims.

¹ *Jackson & Co. v. Napper*, 35 C. D. 162;

⁴ R. P. C. 45; *Bancroft & Co.'s Tm.*,
⁵ R. P. C. 209 (1888), both Stirling, J.

² *Jackson & Co. v. Napper*, 35 C. D. p. 162; 4 R. P. C. 45 (1886), Stirling, J. : *Verity's Tm.*, 19 R. P. C. 58 (1902), Buckley, J.; and see *Ehrmann's Tms.*, [1897] 2 Ch. 495; 14 R. P. C. 665. Stirling, J.

³ Sec. 42.

⁴ Below, p. 264.

² Rule 20, below, p. 659.

⁶ Rule 121 provides that appeals to the Court shall be by motion, but the application to the Court under sec. 20 may not be an appeal.

⁷ *Simpson, Davis & Son's Tm.*, 15 C. D. 525 (1880), Jessel, M.R. Rule 44 of 1890 provided, however, that the claims should be submitted to the Court by a special case, unless the Court otherwise ordered.

the case referred to Joyce, J., entertained the motion in the absence of objection, but without laying down a general rule that the procedure adopted was right.¹ In a subsequent case in which each of the rival claimants entered an opposition to the application of the other, and the Registrar declined to proceed with either application until the rights of the claimants had been determined by the Court, the matter came before the Court on motions by the several claimants that the Registrar might be ordered to proceed with their respective applications.²

Registration by agreement of identical or nearly identical marks is now authorised, with the limitation that the approval of the Registrar, or (on appeal) of the Board of Trade, is required. Probably no agreement will be approved where the applicants have no existing rights in the marks arising from user or otherwise; the language of the section seems to imply that the applicants have some claims to the respective trade marks other than merely being applicants for registration. The Court has under sec. 21 power to permit duplicate registrations in the case of honest concurrent user,³ and probably what may be done by the Court under that section may be done by agreement under sec. 20.

Public
interests to
be considered.

In deciding cases under secs. 19 and 20 the Court will consider public interests as well as the rights of the applicants *inter se*, and, unless the former are protected, will not give effect to an agreement for concurrent registrations of identical new marks, at all events in the absence of special circumstances.⁴ In *Ehrmann's Trade Marks*⁵ the applicants had formerly been partners, and certain registered marks had been used by the firm. The partnership was dissolved by an agreement that one partner should carry on business under one trade name which had been used by the firm, and the others under another trade name which had also been used by the firm, and each party was to be entitled to use the firm's marks with certain alterations to be made by them respectively, and applications were to be made by each party for registration of such marks; the agreement also provided for the cancellation of the former registrations if that should be necessary for the fresh registrations. On the

¹ *Hudson's Application*, 24 R. P. C. 582 (1907). On the hearing of the motion the mark was held to be *publici juris*.

² *Application of Albert Baker & Co. (1898), Ltd.*, [1908] 2 Ch. 86; 25

R. P. C. 513, Eve, J.

³ See below, p. 264.

⁴ See below, *Concurrent User*, p. 264.

⁵ [1897] 2 Ch. 495; 14 R. P. C. 665, Stirling, J.

applications for registration being made, the Comptroller required the respective applicants to submit their rights to the Court, whereupon the applicants appealed. On the appeals being referred to and coming before the Court, the Comptroller raised objections to registration—first, on the ground of the existing registrations, but, having regard to the view which the Court took, this was not finally dealt with; and, secondly, on the ground that identical new marks ought not to be registered in the names of different persons; whilst the applicants relied on the special circumstances as giving them a right to the registrations. Stirling, J., held that in such a case the Court should consider the protection of the public, and ought to be satisfied that there was no reasonable probability of harm resulting, and he dismissed the appeals.¹

The words “except by order of the Court” refer presumably to cases in which, either on concurrent applications under sec. 20, or under the powers conferred by sec. 21, the Court shall have made an order permitting identical or resembling trade marks to be registered by different proprietors for the same goods or description of goods.²

The operation of sec. 19 is not limited by the classes into which goods are divided for the purposes of registration.³ Thus, in *The Australian Wine Importer's* case, which was decided under the Act of 1883, the question arose whether an application to register a label containing a device and the words *Golden Fleece* for wine could be opposed on the ground of the prior registration of what were held to be similar labels for spirits, both wine and spirits being in the same register class (42), and Kay, J., held that, whether sec. 72 of the Act of 1883 applied or not, the use of the mark tendered, having regard to the presence on the Register of the other marks, would be calculated to deceive within the meaning of the next section, and that it ought not to be registered. The Court of Appeal affirmed the decision, and Lindley, L.J., said⁴: “For the purpose of deciding whether two sets of goods are of the same description, we must not, it appears

Sec. 19 is not limited by the register classes.

¹ See now sec. 23 as to apportionment of the trade marks of a firm on dissolution, below, p. 352.

² See below, pp. 264 to 266.

³ In the Act of 1875 the words “goods or classes of goods” were used

instead of “goods or description of goods” used in the Acts of 1883 and 1905.

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

The same goods or description of goods.

to me, lay too much stress on the classification in the schedule to the rules. You find there goods of the same description in different classes, and goods of different descriptions in the same class. For example, if you turn to classes 26—29, you will find that flax and hemp are in one class, and jute in another, though all of them are fibrous, and more or less of the same description for trade purposes. Then, if you turn to class 22, you will find bicycles and railway carriages in the same class. Now, for trade purposes, can you have any goods more different than bicycles and railway carriages? Of course, they are utterly different things, and yet they are put by the framers of these Rules into the same class, so that we cannot be guided by their classification in construing the words 'same goods or description of goods,' which are the words used in sect. 72." And the judges were all inclined to think that wines and spirits were of the same description of goods, although they did not decide the point. And North, J., in a subsequent case, expressed the opinion that beer and rum are the same description of goods within the meaning of the section.¹ In a later case² Romer, J., found as a fact that there was an intimate connection between the bicycle and camera trades, and he ordered a trade mark, which had been registered in class 22 for bicycles, to be expunged on the application of a company which had used the mark for bicycle cameras and had registered marks containing the word in question in classes other than class 22.³ On the other hand, in *Braby & Co.'s Applications*, North, J., allowed a new mark to be registered for galvanised iron sheets, although a similar mark was already registered and used for bar iron and

¹ *Turney & Sons' Tm.*, 11 R. P. C. 37; 10 Times L. R. 175 (1893), North, J.

² *Eastman, &c. Co., Ltd. v. John Griffiths Cycle Corporation, Ltd.*, 15 R. P. C. 105 (1898) (*Kodak*). As to this case see also below, p. 269; and see *Euo v. Dunn*, 15 App. Cas. 252; 7 R. P. C. 311 (1890), where the registration of "Dunn's Fruit Salt Trade Mark Baking Powder" was refused for baking powder in class 42 by reason of a prior use of the words "fruit salt" for a medicinal drink; and *Euo v. Dunn*, 10 R. P. C. 261 (1893).

³ In *Finlay v. Shamrock Co.*, 22 R. P. C.

301 (1905), Porter, M.R., Ireland, a passing-off case, the defendants' washing powder, which contained no soap, and the plaintiff's washing powder, sold as an extract of soap, were held to be the same description of goods. In *Compagnie Industrielle des Petroles' Application*, [1907] 2 Ch. 435; 24 R. P. C. 585, Warrington, J., expressed the opinion that lubricating oil suitable for motors and petrol spirit were goods of the same description within the meaning of sec. 19. A difference in the nature of goods is often an important element in passing-off cases; see below, p. 524.

wire, which goods were within the same register class as the iron sheets.¹ The true test would seem to be supplied by the question—Are the two sets of goods so commonly dealt in by the same trader that his customers, knowing his mark in connection with one set and seeing it upon the other, would be likely to suppose that it was used upon them also to indicate that they were his goods?² It has already been stated that the proprietor of a mark used for only part of a register class, even though it be registered for the whole, and *à fortiori* if the registration as well as the user is limited within the class, cannot by virtue of his registration prevent the use of the mark by other traders upon other descriptions of goods, although they may be included in the same register class.³ But the fact that an opponent of an application for registration could not get an injunction to restrain the use which the registration sought is intended to cover, is by no means conclusive upon the question of the right to registration.⁴

Use or registration for part of a register class.

A second mark has often been admitted to registration by agreement with the proprietor of a mark already registered, who might otherwise have opposed it, on the terms that it shall be limited to part only of the register class. The limitation was effected by placing a note on the Register.⁵ And in the same way marks have been allowed to be registered on the terms of being used in a particular manner, so as not to be confused with

Registration of a second mark by agreement.

¹ 21 C. D. 223 (1882); and see *Jelley's Application*, 51 L. J. Ch. 639, n. (1878), Jessel, M.R.; see also *Edwards v. Dennis*, 30 Ch. 454, where a mark which had been used only for sheet iron was held not to be infringed by use of a somewhat similar mark for wire; and cf. *König and Ehardt's Tm.*, 13 R. P. C. 449; [1896] 2 Ch. 236, where Stirling, J., allowed registration of a mark in class 39 on the application being confined to account books, ruled paper, and other paper for use in books. In *Suter, Hartmann & Rahtjen's Composition Co.'s Tm.*, 19 R. P. C. 42 (1902), Byrne, J., expressed the opinion that glue and gelatine were not the same description of goods as anti-corrosion and anti-fouling compositions, all being within Class I. In *Leiner's Application*, 20 R. P. C. 253 (1903), Byrne, J., registration for gelatine was allowed

notwithstanding the use of an unregistered mark for tapioca and sago (Class 42). In *Lake and Elliott's Application*, 20 R. P. C. 605 (1903), Kekewich, J., the application was to register "Millennium" for carriages; the opponents who were flour millers had registered the same word for "food," and had sold flour and bread under the name "Millennium" out of carts bearing prominently that name and alleged that some confusion would be caused, but their opposition failed.

² See per Kay, J., 41 C. D. at p. 281, in the *Australian Wine Importers' case*.

³ See p. 104, sec. 8; and see *Hargreaves v. Freeman*, [1891] 3 Ch. 39; 8 R. P. C. 237, Chitty, J.

⁴ See *The Australian Wine Importers' case*, *supra*, and p. 227, above.

⁵ See *Re Rabone Bros. & Co.*, Selb. Dig. p. 395 (1879), Jessel, M.R.

a mark already registered,¹ or for use in a particular district.² And the Comptroller has in some cases been directed to put a note, in accordance with the agreement, upon the Register.² These last-mentioned cases, however, were decided under an old rule; and the Court of Appeal, in a case under the Act of 1888, disapproved of placing any territorial limitations on the Register on the grounds both of the want of jurisdiction to do so, and of the inexpediency of such a course having regard to the duty of protecting the public.³ Under the Act of 1905, however, the Registrar, the Board of Trade, and the Court have power in an application to register to allow registration subject to conditions,⁴ and sec. 24 expressly authorises, in cases which fall within it, conditions and limitations, if any, as to mode or place of user or otherwise.⁵ But inasmuch as the tribunals have regard to the interests of the public as well as of opponents, they will probably, except perhaps in cases under sec. 21, be chary of allowing registration with a territorial limitation.

Where identical or similar marks are registered for different goods in the same register class, it is an infringement for the proprietor of either to use his mark upon the goods for which the other is registered.⁶

The provisions of sec. 19 embody the old rule, that a mark which from its resemblance to an existing trade mark is calculated to deceive cannot be protected as a trade mark, for its use is an infringement of the other mark, which would be restrained by the Court.⁷ But the restriction extends beyond the rule, and it does not follow, because an opponent could not obtain an injunction against the use by the applicant

Sec. 19 extends beyond infringing marks.

¹ *Whiteley's Tm.*, 43 L. T. 627, n. (1879), Jessel, M.R.; *Sykes & Co.'s Tms.*, *ibid.*, p. 626 (1880), Hall, V.-C. For restrictions as to colour, see Chap. VIII., at p. 209.

² *Keop's Tm.*, 26 C. D. 187 (1884), Pearson, J.; *Mitchell & Co.'s Tm.*, 28 C. D. 666 (1884), Chitty, J.; *Whiteley's Tm.*, 43 L. T. 627 (1879), Jessel, M.R.

³ *Dehurst's Application*, [1896] 2 Ch. 137; 13 R. P. C. 288 (Lindley, Lopes, and Kay, L.JJ.); and cf. *Ehrmann's Tms.*, *supra*, p. 226; and *Hall and Woodhouse's Application*, 19 R. P. C. 58 (1902), Buckley, J., where the registration of a second mark was refused,

although both marks were local and their districts wide apart.

⁴ Sec. 12 (2) and (4); sec. 14 (4) and (6). See also the similar power given by sec. 23 on an apportionment of trade marks where the goodwill of a business has become divided.

⁵ See *Concurrent User*, below, p. 264.

⁶ *Upper Assam Tea Co. v. Herbert*, 7 R. P. C. 183 (1890), C. A.

⁷ *Seixo v. Provezende*, L. R. 1 Ch. 192 (1866), Cranworth, L.C.; and see *Cope v. Evans*, L. R. 18 Eq. 158 (1874), Hall, V.-C., and the cases there cited. Deceptive trade marks are not protected, see Chap. XV., at p. 426.

of the mark which he tenders for registration, that it is not calculated to deceive within this sub-section. Thus, in *Speer's case*,¹ Kay, J., said: "I could quite conceive a case in which the similarity would not be such as would induce the Court, on that fact alone, to grant an injunction, but in which the Comptroller would still be entirely within his duty in saying that these marks are so nearly resembling one another, at any rate, that I will not, by allowing the registration, encourage the use of a mark which may lead to litigation hereafter. It seems to me that is a matter which the Comptroller ought to consider." And this is fully in accord with the judgments of the law lords in *The Fruit Salt case*;² and the distinction has often been noticed.

The law under the corresponding section of the Act of 1883 was summed up by Parker, J.,³ in a case involving the comparison of two words, as follows: "You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion—that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods—then you may refuse the registration, or rather you must refuse the registration in that case."

The restrictions on registration of deceptive marks are not only for the protection of owners of marks on the Register, but also of the public, and therefore, notwithstanding the consents of owners who might oppose the registration, a mark may be refused on the ground of the likelihood of confusion with their marks, and the consents are only some evidence as to the probability of deception.⁴

Consents of proprietors.

¹ 4 R. P. C. at p. 524; 55 L. T. 880 (1887); and see *The Australian Wine Importers' Tm.*, 41 C. D. 278; 6 R. P. C. 311 (1889), C. A.

² *Eno v. Dunn*, 15 App. Ca. 252; 7 R. P. C. 311 (1890). See also *Société*,

de l'Étoile's Tm., below, page 232, note (4).

³ *Picnotist Co., Ltd.'s Application*, 23 R. P. C. 774, at p. 777 (1906).

⁴ *Dewhurst's Application*, [1896] 2 Ch. 137; 13 R. P. C. 288, C. A. See

The words "belonging to a different proprietor" in sec. 19 limit the operation of the section by excluding from it a case in which an applicant has already on the Register for the same goods or description of goods a trade mark similar to the one which he is applying to register. In one case under the Act of 1888 an objection by the Registrar founded on such a similarity was upheld by the Court.¹ In such a case the Registrar may under the Act of 1905 require the marks to be registered as associated trade marks.²

Expired trade marks.

Under sec. 31 a trade mark which has been removed from the Register for non-payment of renewal fees is for the purpose of sec. 19 deemed to be a registered trade mark during one year next after the removal, unless it is shown to the satisfaction of the Registrar that there has been no *bonâ fide* user of it during the two years immediately preceding such removal.

Marks used in different Markets.

Limitation to particular market.

The question has been raised whether a mark which is sufficiently distinguishable from an opponent's mark everywhere except in a particular country or market, but has there such resemblance to it as to be calculated to deceive, on account of the local circumstances of the trade, for instance, because goods bearing the latter mark have locally acquired a particular name,³ falls within the section, and ought, therefore, to be refused registration.⁴ The question has not been directly decided,⁵ but it is submitted that the objection would be sufficient to justify the rejection of the mark, unless the justice of the case could be met by a limitation as to area placed on the Register.⁶ The

also *König & Ebhardt's Tm.*, [1896] 2 Ch. 236; 13 R. P. C. 449, Stirling, J. And as to compromise on an application to expunge, see below, p. 288.

¹ *Playe & Son's Application*, [1901] 1 Ch. 382; 18 R. P. C. 65, Cozens-Hardy, J.

² Secs. 24 and 25. See above, p. 107.

³ See p. 250, below.

⁴ In *Société Anonyme des verreries de l'Étoile*, [1894] 1 Ch. 61; 10 R. P. C. 436, the trades of the applicants for rectification and of the respondents were in fact competing in the colonies, and Stirling, J., held that the use of the applicants' mark on goods shipped in

English ports for the colonies was use in England, where the respondents' main trade was. Aff. by C. A., [1894] 2 Ch. 26; 11 R. P. C. 142.

⁵ In *Dewhurst's Application*, [1896] 2 Ch. 137; 13 R. P. C. 288, C. A., Lindley, Lopes, and Kay, L.JJ., similar questions were discussed, and it was pointed out by Kay, L.J., that there might be deception in Burma, but the Court thought that there might be deception outside Burma, and proceeded on that ground.

⁶ See the case last cited.

authorities cited below¹ show that probability of deception in England only is not all that is to be considered in cases of infringement; and it cannot be supposed that a mark would be admitted on to the Register if it were shown that the proprietor would forthwith, upon the application of the opponent, be restrained from using it. It is true that, where old marks have been in use simultaneously for years in different markets, the injunctions granted in infringement cases have occasionally been locally limited,² and such limitations have the support of a dictum of Cotton, L.J., in *Johnston v. Orr-Ewing*;³ but in that case, on appeal, Lord Selborne expressed a doubt whether the rightful and *bonâ fide* trade mark of the trader using it could be excluded by injunction from particular markets (though unimpeachable everywhere else), merely because in those markets it might be liable to be called by a name which the mark of another had already acquired there.⁴ And it seems clear that the principle upon which the limitation of the injunctions in the cases referred to was based cannot avail to enable a new mark to be registered, which is deceptive in any market, by reason of the existence of a mark with which it might there be confused. Moreover, as regards registered marks, registration confers in the absence of an express limitation rights unlimited as to locality; and, although the owner of a previously registered mark may not yet have extended his trade to the particular market in question, it is open to him to do so.⁵ Thus, in *The John Bull Beer* cases, where the two marks concerned were used by the plaintiffs and the defendants respectively in different districts of England, the more lately adopted mark was refused registration, and subsequently an injunction was granted to restrain the use of it.⁶ So, too, in *The Jackson Co.'s* case,⁷ registration of a word was refused

¹ Page 235.

² *Carver v. Bowker*, Seb. Dig. p. 350 (1877), Little, V.-C.; *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L.J., a passing-off case. See below, p. 549.

³ 13 C. D. p. 464.

⁴ 7 App. Ca. p. 227. To that proposition, he said, he could not assent. See also the observations of L.J. Alverstone in *Lyle and Kinahan's Application*, 24 R. P. C. 249 (1907) at p. 259.

⁵ See *Dewhurst's Application*, p. 232

note (5).

⁶ *Paine & Co. v. Daniells & Son's Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 71, 217. In *Grant v. Lecitt*, 18 R. P. C. 361 (1901), Porter, M.R., Ireland (*Globe Furnishing Company*), the defendants contended that an injunction should not be granted on the ground that the plaintiffs did not largely trade in Ireland, but this defence failed.

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

because it was the name of a common mark in the cotton trade among the Chippeway Indians, to whom the English cotton trade had not then extended. In *Dewhurst's Application*,¹ the Court of Appeal refused registration of a mark, having as an essential particular the words *The Golden Fan Brand* in the Burmese language and characters, on the ground of the presence on the Register, in respect of the same goods, of a fan which in fact, as used, was coloured gold. In this case the owner of the latter mark had consented to the registration, and the applicants were willing to submit to a condition that the mark should only be put on goods exported to Burma, and they adduced evidence that part of the mark was already known there as *The Golden Fan Trade Mark*. The broad ground on which the Court acted was that a second mark should not be placed on the Register containing a mere verbal description of an existing mark, because of the danger of purchasers being deceived.²

In the case of honest concurrent user or other special circumstances which in the opinion of the Court make it proper so to do, the Court may under sec. 21 permit registration of the same trade mark or nearly identical trade marks under conditions which may include a limitation as to place of user³; but, except in cases falling within this section or sec. 20, registration of a new mark with such a limitation will probably not be allowed, at all events where it is opposed by the owner of a trade mark registered for the same goods or description of goods.

Deceptive Resemblance.

Calculated to deceive.

“Calculated to deceive” may mean either “intended to deceive” or “likely to deceive,” and the prohibition applies where the case falls within either meaning,⁴ although the latter, which is, of course, the more inclusive meaning, is sufficient to dispose of most, if not all, of the questions that arise under the section. The words are not equivalent to “capable of being used to deceive,”⁵ for it must be assumed, until the contrary is shown, that the applicant will make an honest use of his mark.⁴ A

¹ [1896] 2 Ch. 137; 13 R. P. C. 288.

² The decision expressly left it open for the Comptroller, if he thought fit to do so, to allow the words to be registered as additional words subject to a disclaimer. In the application the words had been claimed as an essential par-

ticular.

³ Sec. 21, below, p. 264.

⁴ *Kutnow's Tm.*, 10 R. P. C. 401 (1893), North, J. (*Carlsbad Salts*); and see the next case.

⁵ *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1886), C. A.

trade mark is calculated, by its resemblance to another already on the Register, to deceive, if in the course of its legitimate use in the trade it is likely to do so.

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

A. What Persons are to be considered.

In accordance with the cases decided in suits and actions for the infringement of trade marks before the Registration Acts, it is held that the persons to be considered in estimating whether the resemblance between the marks in question is calculated to deceive are all of those who are likely to become purchasers of the goods upon which the marks are used. So that, if such persons, using ordinary care¹ and intelligence, are likely to be deceived, then the Registrar ought not to accept the mark.

It is clearly not enough for the applicant to show that retail dealers buying his goods for resale would not be deceived, since they might themselves fraudulently or carelessly make use of the ambiguous character of the trade mark to deceive their customers, the ultimate purchasers.² In fact, dealers who buy from the manufacturers in order to sell by retail are generally aware of attempted infringements, and are parties to the fraud.³ Nor is the inquiry to be confined to England, or to persons acquainted with the English language, in cases where the goods

Whom the mark must be calculated to deceive.

The ultimate purchasers.

Foreigners.

¹ *Christiansen's Tm.*, 3 R. P. C. 54 (1886). See per Esher, M.R., p. 62, quoted below, p. 240.

² *Wilkinson v. Griffith*, 8 R. P. C. at p. 374 (1891), Romer, J. See the judgment of Mellish, L.J., in *Ford v. Foster*, L.R. 7 Ch. 616 (1872); and the judgment of Ld. Selborne in *The Singer Manufacturing Co. v. Loog*, 8 App. Ca. 15 (1882); and *Powell v. Birmingham Vinegar Brewery Co.*, [1896] 2 Ch. 54; 12 R. P. C. 496; 13 R. P. C. 235; and in the House of Lords, [1897] A. C. 710; 14 R. P. C. 720; especially the judgment of Kay, L.J., 13 R. P. C. 250; and *Hubbuck v. Brown*, 17 R. P. C. 645 (1900), C. A.

³ *Anglo-Swiss, &c. Co. v. Metcalf*, 31

C. D. 454; 3 R. P. C. 28 (1886), Kay, J.; *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), C. A. "In my opinion the whole gist of the complaint against the defendants is, 'You have sold a weapon calculated to be used fraudulently by the middlemen'" (Cotton, L.J.). If ultimate purchasers do not know who is the manufacturer of the goods which they have been accustomed to purchase, that circumstance might contribute to make the mark of a rival trader deceptive. Cf. *Powell v. Birmingham Vinegar Brewery Co.*, supra, note (2); especially Ld. Watson's judgment, 14 R. P. C. at p. 730.

Persons of ordinary ability and carefulness.

in question have a foreign market.¹ It must not be assumed that a very careful or intelligent examination of the mark will be made,² and if it were shown that the class of persons who bought the goods were illiterate, that would be a material fact in cases where printing entered into the marks;³ but, on the other hand, it can hardly be a bar to the admission of a mark that unusually stupid people,⁴ "fools or idiots,"⁵ may be deceived.⁶ And if the goods are expensive and not of a kind usually selected without deliberation, and the customers generally educated persons, these are all matters to be considered.⁷ If some parts of the mark are common, one must consider whether people who know the distinguishing characteristics of the opponent's mark would be deceived.⁸ The cases cited are nearly

¹ *Johnston v. Orr-Ewing*, 7 App. Ca. 219 (1882); *Wilkinson v. Griffith*, supra.

² "Unwary purchasers": *Wotherspoon v. Currie*, L. R. 5 H. L. 508 (1872), Ld. Chelmsford; *The Singer Manufacturing Co. v. Looy*, 8 App. Ca. 15 (1882), Ld. Selborne. "Ordinary purchasers purchasing with ordinary caution": *Sciro v. Provezende*, L. R. 1 Ch. 192 (1866), Cranworth, L.C. "Ordinary or unwary purchasers": *Powell v. Birmingham Vinegar Brewery Co.*, 13 R. P. C. at p. 258, Lindley, L.J.; not "persons of an ideal character who either are particularly innocent or too easily deceived": *Payton v. Snelling*, 17 R. P. C. at p. 57, Romer, L.J., whose judgment was approved by the H. of L., 17 R. P. C. 628; and see the judgments of Kekewich, J., in *Marshall v. Sidebotham*, 18 R. P. C. 43 (1901), and *Alaska Packers' Association v. Crooks*, 18 R. P. C. 129 (1901). "The unwary customer is extremely difficult to find": see the last case.

³ See *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 192. The proposition is not contrary to the following passages from the judgments in *Singer Manufacturing Co. v. Looy* where the fact of illiteracy of the customers was not established. "Whatever be the class of persons who buy these things (sewing machines), we must at all events assume that they are persons capable of reading and writing, or of reading, at all events": per James, L.J., 18 C. D. p. 413. "The

possibility of such a mistake is not a cause of action (for passing-off). The same thing might happen if the defendant issued circulars that his were *not* Singer sewing machines. For however large he printed the *not*, some one might not see it": per Ld. Bramwell, 8 App. Ca. p. 42. In one case in which the goods (lemonade powders) were largely bought by children, and it was suggested that they would be more easily deceived than adults, Byrne, J., expressed the opinion that, having regard to the nature of the goods, which they would be likely to purchase for themselves, they would be less likely to be deceived than grown-up people: *Clark v. Sharp*, 15 R. P. C. at p. 149 (the case was settled on appeal, 15 R. P. C. 268 (1898)).

⁴ *Payton & Co., Ltd. v. Titus Ward & Co., Ltd.*, 17 R. P. C. at p. 67, Romer, L.J. (1900).

⁵ Jessel, M.R., 2 C. D. at p. 447.

⁶ See note (3), ante.

⁷ *Pianolist Co.'s Application*, 24 R. P. C. 774 (1907), Parker, J. (*Neola, Pianola*).

⁸ See the judgments of Romer, L.J., in *Payton & Co., Ltd. v. Snelling & Co., Ltd.*, 17 R. P. C. at p. 57; and *Same v. Titus Ward & Co., Ltd.*, 17 R. P. C. at p. 67 (1900) (passing-off cases); the former judgment being approved by the H. of L. on appeal, 17 R. P. C. 628; also *Alaska Packers' Association v. Crooks*, and *Marshall v. Sidebotham*, note (2), above.

all cases of infringement or passing off, and, as already said, a weaker case than would entitle a plaintiff to succeed in an action for infringement will enable an opponent to successfully object to the registration of a new mark.

B. Rules of Comparison.

It is impossible to discover from the decided cases any criterion as to the amount of resemblance which will suffice to cause the rejection of a mark more definite than that expressed in the section itself, and probably no test could usefully be stated;¹ but a perusal of the more recent cases under the Act of 1888 shows that the Comptroller and the Court applied the restriction much more strictly against new marks than formerly, and, as already shown, it is settled that the onus of proving that there is no reasonable probability of deception is cast on the applicant.² In comparing the marks, the Registrar must, as appears from the authorities referred to below, take into account all the circumstances of the case, and must consider whether, as a whole, the applicant's mark is substantially different from the opponent's. The report of Lord Herschell's Committee on this point admirably states what are conceived to be the critical tests, and it shows also what the amendment of the Act of 1883³ by the Act of 1888 was intended to effect; but it must be borne in mind that the Legislature has in the Act of 1905 reverted in this respect to the language of the Act of 1883. It will be useful to set out the whole passage.

What amount of resemblance is calculated to deceive.

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

"We have given very careful consideration to the evidence which has been laid before us by those interested in the trade of Lancashire. The number of marks registered in classes 23, 24, and 25, which are commonly described as the Cotton Classes, is very large; and the administration of the Act in relation to these classes is of great importance to the trade. There can be no doubt that the working of the Trade Marks Act has not given

Lord Herschell's Committee on the principle of comparison.

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

² *Eno v. Dunn*, 15 App. Ca. 252; 7 R. P. C. 311 (1890). See also *Capsuloid Co., Ltd.'s Application*, 23 R. P. C. 782 (1906), Swinfen Eady, J.

³ Substituting "having such resemblance" for "so nearly resembling."

satisfaction in Lancashire. Even if at times there may have been a disposition to expect too much, we think there have been substantial grounds for the dissatisfaction which has prevailed. The great bulk of the goods manufactured in Lancashire, in respect of which trade marks are used, is exported to other countries, and there can be no doubt that these marks fulfil important functions in the trade between Lancashire and India and other countries. One chief complaint has been that the usages of the trade and the character of the markets where the marks are intended to serve their purpose have not been sufficiently kept in view by the Patent Office. By sec. 72, sub-sec. (2), the Comptroller is directed not to register, with respect to the same description of goods, a trade mark so nearly resembling a trade mark already on the Register with respect to such description of goods as to be calculated to deceive. It is on the question whether marks do so nearly resemble one another as to be calculated to deceive, and what extent of resemblance to an old mark ought to cause the rejection of an application, that the chief difference has arisen between the trade and those to whom the administration of the Act has been entrusted. The tendency of the Office has been to construe the words of the Act more favourably towards applicants for new marks than the trade have thought right. We think the difference has arisen in part from the wording of the Act. The Comptroller has felt unable to say that two marks 'so nearly' resemble each other as to be calculated to deceive. He has thus not considered himself at liberty to take into consideration to the extent he otherwise might, the character of the market in which the mark is to serve its purpose. Two marks, when placed side by side, may exhibit many and various differences, yet the main idea left on the mind by both may be the same; so that a person acquainted with the mark first registered, and not having the two side by side for comparison, might well be deceived, if the goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted. Take, for example, a mark representing a game of football; another mark may show players in a different dress, and in very different positions, and yet the idea conveyed by each might be simply a game of football.¹ It would be too much

The idea of each mark to be considered.

¹ Cf. *Barker's Tm.*, 53 L. T. 23 (1885), Kay, J. (*Huntsman, or Sportsman's cherry brandy*).

to expect that persons dealing with trade-marked goods, and relying, as they frequently do, upon marks, should be able to remember the exact details of the marks upon the goods with which they are in the habit of dealing.

"In order to avoid misapprehension in the future, we recommend, even though it may not be absolutely necessary, a slight amendment of the Act, substituting for the words 'so nearly resembling' the words 'having such resemblance to'; and further, we would suggest that when the question arises whether a mark applied for bears such resemblance to one on the Register as to be calculated to deceive, it should be determined by considering what is the leading characteristic of each. The one might contain many, even most, of the same elements as the other, and yet the leading, or it may be the only, impression left on the mind might be very different; whilst, on the other hand, a critical comparison of two marks might disclose numerous points of difference, and yet the idea which would remain with any person seeing them apart at different times might be the same."

It is conceived that the principles which should guide the Registrar, and the Court or Board of Trade on appeal from him, and also on applications under sec. 35 to remove a trade mark from the Register as too closely resembling another registered mark, are here stated in accordance with the leading cases on the subject.

The principle is adopted by the Court.

Thus, in *Johnston v. Orr-Ewing*,¹ where both the plaintiffs' and the defendants' marks consisted of tickets bearing pictures of two elephants with a banner between them, the figures being differently arranged, Lord Selborne said:² "Although the mere appearance of these two tickets could not lead anyone to mistake one of them for the other, it might easily happen that they might both be taken by natives of Aden or of India, unable to read and understand the English language, as equally symbolical of the plaintiff's goods. To such persons, or at least to many of them, even if they took notice of the differences between the two labels, it might probably appear that they were only differences of ornamentation, posture, and other accessories, leaving the distinctive and characteristic symbol substantially unchanged.

The Two Elephant case.

¹ 7 App. Ca. 219 (1882).

² At page 225. See also *Baschiera's Tm.*, 33 Sol. J. 469; 5 T. L. R. 480 (1889), Chitty, J., where the ground of ejection was that "the dominating

portion of each mark was a lion, and the goods were designated by the prevailing feature according to the custom of the trade."

Such variations might not unreasonably be supposed to have been made by the owners of the plaintiff's trade mark themselves for reasons of their own."

The Taendstikker case.

And in *The Taendstikker case*,¹ where the Court of Appeal, reversing the decision of Chitty, J., held that a label for match-boxes so nearly resembled an older label registered for the same goods as to be calculated to deceive, the judgment of the Court proceeded on the ground that the net impression produced by both labels was the same. The appellant's label as registered consisted of a black oblong, bearing the word *taendstikker* printed at the bottom, and the word *nitedals* at the top, and a small geometrical device having two overlapping medals on each side of it in the middle. The respondents' label as registered showed the same elements, with the word *medals* instead of *nitedals*, two blank spaces having the same outline as the medals, and a cross instead of the device, the blanks and cross corresponding in size and shape with the medals and device. It was shown that in practice the respondents printed representations of medals over the blanks.

Lord Esher's judgment. The marks to be compared as wholes.

"The trade mark," said Lord Esher, "is the whole thing—the whole picture on each. You have, therefore, to consider the whole. Mr. Justice Chitty has looked at the distinguishing features. He, I think, only looked at it to see whether, with that distinction, the whole was like or unlike. That is what he did, but the argument raised by Mr. Romer, and which was not only shadowed but plainly put forward by his skilful cross-examination, was this: the moment there is any distinction in any part, the things are at once unlike. That is his point. Therefore he cross-examined the people thus:—'The lamps² or the medals are alike, and they are common?—Yes. The two things in the middle are unlike?—Yes. The word at the bottom is common to the trade, and it is the same in both?—Yes; but it is common to the trade. Therefore, he says, everything but the words *medals* and *nitedals* is common, and those two are different, and therefore the whole is different. It seems to me he has fallen into this fallacy—he takes each thing by itself, and says either it is common or it is the same, and leaves out altogether the mode in which the things are put together in the two pictures."

There may be general resemblance with many differences in details.

¹ *Christiansen's Tm.*, 3 R. P. C. 54 (1886).

² *I.e.*, the blank spaces.

And Lindley, L.J., said: "The difference here, looking at the boxes, is simply this, that the word *medals* is used instead of the word *nitedals*, all the rest being, according to the evidence, common. Now I do not think that is a dissimilarity which is sufficient in this case, because, although I rather agree with the view taken by Chitty, J., that the leading feature is the name at the top or bottom of the label, one must not be misled by that. The question is, notwithstanding that, what is the effect of the use or introduction of that distinguishing character on the whole? When you look at the wholes, then it appears to me, I confess, that the dissimilarity is not enough to make the wholes dissimilar."¹

So that, where common marks are included in the trade marks to be compared, or in one of them, it appears, from the judgments just quoted,² that the proper course is to look at the marks as wholes, and not to disregard the parts which are common, although Cairns, L.C., in *The Orr-Ewing* case, expressed a different opinion.³

Included common marks are not to be disregarded.

Farrow's case⁴ is a good illustration of Lord Esher's rule.⁵ There both the applicant and the opponent were mustard merchants, and both used square boxes covered with yellow labels printed in black and red, for these boxes were common to the trade. The applicant placed upon his labels a picture of a charging buffalo, and the opponent a picture of a bull's head; both pictures were contained within silver rings, and these rings were also common to the trade. Stirling, J., said that the buffalo and the bull's head, as printed in the *Trade Marks Journal*, were very different, but when they were placed upon

Parts of the contrasted marks common to the trade not to be disregarded.

¹ "Though no one particular mark was exactly imitated, the combination was very similar and likely to deceive": Hatherley, L.C., in *Abbott v. The Bakers', &c. Association*, W. N. (1872), 31. Cf. with *The Taenlatikker* case that of *Lever v. Beddingfield*, 15 R. P. C. 453; and 16 R. P. C. 3 (1899), Kekewich, J., and C. A., in which it was held that there was no infringement of the mark as a whole, although some features had been taken from the plaintiff's label.

² 4 App. Ca. 479 (1879).

⁴ *Farrow's Tm.*, 7 R. P. C. 260; 63 L. T. 233 (1890), Stirling, J.

⁵ Page 240, above. In *Hennessy & Co. v. Dompé*, 19 R. P. C. 333; 20 R. P. C. 175 (1903), where some features of the marks were common to the trade, but one of them in its particular form had apparently been copied from the plaintiff's label in composing the defendant's, Kekewich, J., held that there was no infringement, but on appeal the defendant consented to an injunction. See also *Hennessy & Co. v. Keating*, 24 R. P. C. 455; 25 R. P. C. 125 and 361 (1908), H. L.

³ *Christiansen's Tm.*, 3 R. P. C. 54 (1886), above, p. 240; and see *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1890), North, J.

the coloured labels, the applicant's label too closely resembled that of the opponent to be admitted to the Register.

But if the only resemblances between the two marks are in parts which are common, so that the owner of the one has taken nothing which is peculiar to the other, then there is at all events no infringement,¹ at any rate unless the plaintiff had a distinctive arrangement of the common elements. Thus, in *Payton & Co., Ltd. v. Snelling, Lampard & Co., Ltd.*, a passing-off case, Lindley, M.R., said² the plaintiffs "must make out that the defendants' goods are calculated to be mistaken for the plaintiffs', and where, as in this case, the goods of the plaintiff and the goods of the defendant unquestionably resemble each other, but where the features in which they resemble each other are common to the trade, what has the plaintiff to make out? He must make out, not that the defendant's are like his by reason of those features which are common to them and other people, but he must make out that the defendant's are like his by reason of something peculiar to him and by reason of the defendant having adopted some mark, or device, or label, or something of that kind, which distinguishes the plaintiff's from other goods which have, like his, the features common to the trade. Unless the plaintiff can bring his case up to that, he fails." And in *Payton & Co., Ltd. v. Titus Ward & Co., Ltd.*, the same learned judge said³: "When what is called the plaintiffs' get-up consists of two totally different things combined, namely, a get-up common to the trade, and a distinctive feature affixed, or added to the common features, then what you have to consider is not whether the defendants' get-up is like the plaintiffs' as regards the common features, but whether that which specially distinguishes the plaintiffs' has been taken by the defendants. A defendant may take it more or less. It is very seldom that he copies it. Of course he does not do that, but if he so nearly takes it that when you look at it as a whole you can say that the defendant's goods are calculated to be taken

¹ *Jamieson & Co. v. Jamieson*, 15 R. P. C. 169 (1898), C. A., Lindley, M.R., Rigby and Vaughan Williams, L.J.J., reversing Byrne, J.; *Payton & Co., Ltd. v. Snelling, Lampard & Co., Ltd.*, 17 R. P. C. 48 (affirmed by H. of L. 17 R. P. C. 628); *Payton & Co., Ltd. v. Titus Ward & Co., Ltd.*, 17 R. P. C. 58, both C. A. (1900), Lindley, M.R., Sir F. Jeune and Romer, L.J., all passing-off

cases: *Marshall v. Sidebotham*, and *Alaska Packers' Association v. Crooks*, above, p. 236 note (2) (trade mark and passing-off). See also *Hubbuck & Son, Ltd. v. Brown*, 17 R. P. C. 148 and 638 (1900); and *Wolff v. Nopitsch*, 17 R. P. C. 321 and 18 R. P. C. 27 (1901).

² 17 R. P. C. 52.

³ 17 R. P. C. 63.

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

The fact that there has been actual copying of part of the plaintiff's mark is a matter to be considered, but it may not constitute infringement,¹ nor would it necessarily make the new mark deceptive.

The resemblance between two marks must be considered with reference to the ear as well as to the eye. Thus, if a star be registered, the word *star* for the same goods would be calculated to deceive, and further, since the registered proprietor of the device of a star could, under sec. 67 of the Act of 1883, use it in any colour, the words *Red Star* were held to be as objectionable as the word *star* by itself.² So, also, the words *The Golden Fan Brand* were refused registration as an essential particular of a mark, on account of the presence on the Register of a fan which was in fact coloured gold in use;³ and a mark containing prominently the representation of half an apple on account of the words *Apple Brand* in two registered marks.⁴

Ear as well as eye to be considered.

A good illustration of the principle that the idea of the marks must be considered is afforded by *Currie & Co.'s Application*.⁵ There the registered mark included the words *The Cock o' the North*, with the picture of a cock in a defiant attitude, and the applicants' mark also included a somewhat similar cock, both marks being for Scotch whisky. They contained other prominent features which were different in the two marks, but Kekewich, J., held that the Comptroller was justified in refusing registration of the applicants' mark, as it included in a central position the thing which caught the eye in the registered mark.

¹ *Lever v. Beddingfield*, 16 R. P. C. 3; 80 L. T. 100 (1899), C. A., Lindley, M.R., Chitty and Vaughan Williams, L.JJ.

² *Société Anonyme des Verreries de l'Étoile's Tm.*, [1894] 1 Ch. 61; 10 R. P. C. 436, Stirling, J.; [1894] 2 Ch. 26; 11 R. P. C. 142, Lindley, Kay and

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

³ *Devhurst's Application*, [1896] 2 Ch. 137; 13 R. P. C. 288, Lindley, Lopes and Kay, L.JJ.

⁴ *Application of Pomril, Ltd.*, 18 R. P. C. 181 (1901), Joyce, J.

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

The *Cat and Barrel* cases¹ are also good illustrations of the same principle. In these cases it was found that the plaintiffs' trade mark had come to be known as the "Cat and Barrel Brand," and the marks held to be infringements included combinations of a cat and barrel differing to a considerable extent from that which appeared in the plaintiffs' mark.¹

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

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

It is also clear that the Registrar ought not merely to look at the marks as they stand side by side, for, from the nature of the case, they will not be so put before any customer whom it is sought to deceive by means of either of them. He can only contrast the mark upon the goods offered to him with his recollection of the mark used upon those he is seeking to buy, and allowance must be made for this in estimating the probability of deception. Any other rule would be of no practical use.² Moreover, variations in details might well be supposed by customers to have been made by the owners of the trade mark they are already acquainted with for reasons of their own.³

but as seen and remembered in actual use.

In comparing the marks, therefore, regard must be had not only to their form as they appear on the Register,⁴ but also to the appearance they would present in actual use when fairly and honestly used ; to the nature of the goods upon which they are to be employed ; to the character and size of the marks themselves, and to the probability of their becoming partially or wholly blurred or modified as ordinarily stamped or printed, or by ordinary wear and tear.⁵

¹ *Boord & Son v. Huddart*, 21 R. P. C. 149 (1904), Swinfen Eady, J. ; *Same v. Thom and Cameron, Ltd.*, 24 R. P. C. 697 (1907), Inner House, Scotland.

² *Seixo v. Provezende*, L. R. 1 Ch. 192 (1866), Cranworth, L. C. ; *Wilkinson v. Griffith*, 8 R. P. C. 370 (1891), Romer, J., and *Ld. Alverstone, M.R.*, in *Hubbuck v. Brown*, 17 R. P. C. at p. 645.

³ *Johuston v. Orr-Ewing*, 7 App. Ca. 219 (1882), *Ld. Selborne*, ante, p. 239.

⁴ *Jessel, M.R.*, held, in several cases, that the Register only should be looked at : *Re Jelley*, 51 L. J. Ch. (N. S.) 639, n. (1878) ; *Robinson's Tm.*, 29 W. R. 31 (1880) ; *Mitchell v. Henry*, 15 C. D. 181 (1880) ; but in the latter case the C. A.

dissented from his opinion and overruled his decision : *Christiansen's Tm.*, 3 R. P. C. 54 (1886), Chitty, J. ; *Lyle and Kinahan's Application*, 24 R. P. C. 37 and 249 (1907), Kekewich, J., and C. A.

⁵ *Rosing's Application*, 54 L. J. Ch. 975, n. (1878), C. A. ; *Lynlon's Tm.*, 32 C. D. 109 ; 3 R. P. C. 102 (1885), C. A. ; *Haines, Batchelor & Co.'s Tm.*, 5 R. P. C. 669 (1888), Chitty, J. ; *Lambert's Tm.*, 5 R. P. C. 542 ; 6 R. P. C. 344 ; 61 L. T. 138 (1889), C. A. In *Hubbuck v. Brown*, 17 R. P. C. 148 and 638, the plaintiffs relied to some extent on the effect of stencilling, and see the judgment of Collins, L.J.

For instance, a mark which is used for hardware goods, and is stamped upon them with a die, is not likely to appear so definitely or to be so readily distinguishable from a similar mark as one which is engraved or printed upon a paper label, and so attached to the goods.¹ In the former case, too, the mark will necessarily be used in a small size only.¹ As regards size, however, even under circumstances in which, from the nature of the goods, large sizes showing the design distinctly can be, and generally are used—since it is open to a registered proprietor to use his mark in any size—size would not seem to be a material element in the comparison.² It must not be assumed against the applicant or registered proprietor that he is going to use his mark unfairly, in the sense that he is going to use something different,³ by leaving out or obliterating any parts of the mark, for instance, so as to make it more like that of the opponent,⁴ for the Court presumes that a trade mark will be used fairly and without fraud.⁵ But the Registrar must consider any alterations which the applicant lawfully might make, without altering the essential features of his mark or losing the protection which would be conferred by registration.⁶ Thus he may, unless he has under the Act of 1905 registered with a limitation as to colour,⁷ use the mark in any colour, and in *Worthington's* case⁸ a triangular frame with the picture of a church inside was rejected on the ground that it would, if the whole were coloured red, too nearly resemble Bass' well-known solid red triangle. And if it is shown that the applicant does actually use, or intend to use, his mark so altered as more nearly to resemble that of the opponent, as, for example, in *The Taendstikker* case,⁹ by filling

Size of mark.

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

¹ See the two cases cited in the previous note before *Hubbuck v. Brown*, in which, however, the opposition failed; and see *Re Jelly*, 51 L. J. (N. S.) Ch. 639, n. (1878), Jessel, M.R.

² *Speer's Tm.*, 4 R. P. C. 521; 55 L. T. 880 (1887), Kay, J.

³ *Biegel's Tm.*, 4 R. P. C. 525; 57 L. T. 247 (1887), Chitty, J.

⁴ *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1886), C. A.

⁵ *Lambert's Tm.*, 6 R. P. C. 344; 61 L. T. 138 (1889), C. A.; *Haines, Bachelor & Co.'s Tm.*, 5 R. P. C. 669 (1888), Chitty, J.; *Kutnow's Tm.*, 10 R. P. C. 401 (1893), North, J. (*Carlsbad Salts*).

⁶ *I.e.*, making his mark so different as to be practically an unregistered mark.

⁷ See 10.

⁸ 14 C. D. 8 (1879), Jessel, M.R., and C. A.; and see *Hanson's Tm.*, 37 C. D. 112 (1887), Kay, J.; see "colour," p. 210.

⁹ *Christiansen's Tm.*, cited above, p. 240. Also *Lyle and Kinahan's Application*, 24 R. P. C. 37, 249 (1907), C. A. In this case, however, the applicants established a long concurrent user of the name which it was proposed to insert in the blank, that name being the basis of the opponent's objection.

Variation in the use of the opponent's mark.

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

up blanks left in the mark as registered, the mark so altered will, as against the applicant, be treated as the mark to be considered.¹ On the other hand, such alteration of the opponent's mark, being something other than the ordinary effects of its lawful user in the registered form, is immaterial as against the applicant,² for no one can extend the protection given to his registered mark by departing from the registered form. The fact that the objector uses his mark in a form different from that in which it appears on the Register is, however, no answer to an objection if the mark in question so nearly resembles the objector's mark, as it there appears, as to be calculated to deceive,³ for such use is legal, although, so far as the mark used is substantially different from the mark registered, it is not protected. Even if the user were illegal, it could hardly act as an estoppel;⁴ and if the opponent were using his mark improperly, for instance, in aid of a fraudulent or illegal trade, or if his mark as used by him were calculated to deceive,⁵ the applicant's proper course would be to remove the mark out of the way by an application to rectify the Register under sec. 35, if that remedy be not under the circumstances of the case barred for him by sec. 41.

Differences in the nature or origin of the goods to which the trade marks are to be applied, though the goods are of the same description, are elements to be taken into consideration.⁶

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

Regard must be specially directed to the essential particulars of the marks to be compared. In *Murphy's Trade Mark*⁷ it was pointed out that the remaining matter in any of them might, subsequently to registration, be changed on an application under sec. 92 of the Act of 1883.⁸ On this ground Stirling, J., refused

¹ See note (9), p. 245.

² *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1886), C. A.

³ *Melachrino v. The Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215 (1887), Chitty, J.; *Hammond v. Malcolm, Brunner & Co.*, 9 R. P. C. 301 (1892), Chitty, J.; *Rowland v. Michell*, 13 R. P. C. 457; 14 R. P. C. 37 (1897), Romer, J., and C. A.; all cases of infringement.

⁴ See *James' Tm.*, 33 C. D. 392; 3 R. P. C. 340 (1886), C. A.

⁵ See *Newman v. Pinto*, 4 R. P. C. 508; 57 L. T. 31 (1887), C. A.

⁶ *Leiner's Application*, 20 R. P. C. 253 (1903), Byrne, J.; *Pianolist Co.'s Application*, 23 R. P. C. 774 (1906), Parker, J.; and the passing-off cases cited below, p. 247, note (1).

⁷ 7 R. P. C. 163 (1890).

⁸ See below, Chap. XI. at p. 316.

to allow a mark consisting of a lion carrying a sheaf, together with other matter, to be registered, there being already on the Register another mark comprising a lion bearing a crown, because the lions were the sole essential particulars of both, although each mark had additional matter, and the general appearances of the two were different. The applicants in this case offered an undertaking that they would use their mark only in the form tendered for registration, but this was not deemed sufficient by the proprietors of the opposing mark, and, as the mark was a new one, the judge refused to accept the offer as an answer to the difficulty raised by the resemblance of the essential particulars.¹ The section of the Act of 1883 referred to above is now replaced by sec. 34 of the Act of 1905, which permits alterations not substantially affecting the identity of the trade mark, but this does not affect the reasons for the decision in *Murphy's* case, for changes in non-essential particulars will be more easily obtainable than changes in essential particulars.

Undertaking
not to vary
registered
mark in use.

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

Further, the Court must have regard to all the circumstances of the trade in which the marks in question are employed, or are to be employed, and in particular to the nature of the market, whether a home or a foreign one; to the number of other trade marks similar to the contrasted marks already circulating in connection with the same description of goods²; to the common marks which are or may be combined with the contrasted marks or either of them; and, generally, to the customs and usages of the trade.

It is obvious that marks which are readily distinguishable by Englishmen, or persons who can read English, may so resemble each other as to be calculated to deceive foreigners whose language is not only different from English, but written in different

Marks
deceptive in
particular
markets.

¹ And cf. *Jamieson v. Jamieson*, 15 R. P. C. 169 (1898); *Clark v. Sharp*, 15 R. P. C. 141 (1898); *Payton & Co., Ltd. v. Saelling, Lampard & Co., Ltd.*, 16 R. P. C. 283; 17 R. P. C. 48 and 628; and *Same v. Titus Ward & Co., Ltd.*, 16 R. P. C. 424; 17 R. P. C. 58 (1900); all passing-off cases, in which a prominent and distinctive feature of the plaintiff's get-up had not been taken; also *Marshall v. Sidebotham*,

18 R. P. C. 43 (1901), trade mark and passing off.

² Cf. the provision of sec. 43 that in an action for infringement the Court shall admit evidences of the usages of the trade in respect to the get-up of the goods and of any trade marks legitimately used in connection with such goods by other persons. See Chap. XV., Infringement, p. 377.

characters and in a different manner.¹ For them, if they are ignorant of English, the words upon a mark are only subordinate devices not readily distinguishable from other words occupying corresponding positions in any contrasted mark, and being of about the same length. But if the possible confusion between the marks in a particular market would arise entirely from a device, the use of which is open to the applicant for registration, *e.g.*, the Royal Arms, the opponent would fail.²

The fact that a mark only becomes deceptive owing to the presence in it of words in a foreign language and only when the meaning of those words is understood, will not help the applicant, and the mark will be refused registration if the translation of the words in English would be deceptive, even although the language used is an Oriental one.³

Numerous marks of the same kind on the Register.

In cases where there are a large number of marks similar to the mark propounded on the Register, the Court may think that, though the applicant's mark might be fairly distinguishable from the opponent's if there were no other, and perhaps also from each of the others taken alone, yet the extension of the number of such marks may lead to deception.⁴ Thus in *Margreaves* case,⁵ there being four anchor marks already on the Register in the same class, Hall, V.-C., refused to allow another anchor mark to be added to them, notwithstanding that the new mark was sought to be registered for bacon and hams, while those already registered were used for different articles of food, such as biscuits, potted meat, &c., and that it was said to be distinguishable from them all. But the extent of the class is a

¹ *Johansen v. Orr-Ewing*, 7 App. Ca. 219 (1882); *Wilkinson v. Griffith*, 8 R. P. C. 376 (1891), Romer, J.

² *Hubbuck v. Brown*, 17 R. P. C. 156, Kekewich, J., an infringement and passing-off case, in which the plaintiffs alleged that their goods were known in Spanish-speaking markets as *Dos Leones*, by reason of their use of the Royal Arms. In the Court of Appeal, 17 R. P. C. 638, the decision was affirmed, it being held that there had not been a deliberate copying of the plaintiffs' particular form of the Royal Arms. The particular case could not now occur with a new mark, see Rule 12.

³ *Deichurst's Application*, [1896] 2 Ch. 137; 13 R. P. C. 288.

⁴ Cf. the provision of sec. 43 that in trying a question of infringement the Court shall admit evidence of any trade marks legitimately used in connection with the goods by other persons, below, p. 247, note (2).

⁵ 11 C. D. 669 (1879); *Theurlis and Blakey's Tm.*, and *Hughes and Young's Tm.*, 10 R. P. C. 369 (1893), North, J.; and see *Orr-Ewing v. The Registrar of Tms.*, 4 App. Ca. 479 (1879). Cf. *Bass, Ratcliff and Gretton's, Ltd.'s Tms.*, [1902] 2 Ch. 579; 19 R. P. C. 129, 529, where a simple diamond was held to be distinctive notwithstanding the existence of many complex marks including diamonds.

matter to be considered.¹ The registration of other marks belonging to the applicant himself would not generally be material to defeat his application, since a trader often desires to register slightly differing marks to distinguish goods which are of different qualities or prices ;² but a condition may be required that the trade marks be entered on the Register as associated trade marks.³ Of course, the objection referred to in the present paragraph is much more material in the case of a new trade mark than in that of an old one.⁴

Similar marks belonging to the applicant.

In some cases, on the other hand, the existence of a number of marks, either as common marks or as trade marks, may operate to render a finer distinction allowable than would otherwise be the case, for the persons concerned in the trade in question may have had their attention directed to the kind of distinction which exists between the mark propounded and any of the others, because it is analogous to the known distinctions existing between the latter. Thus, in *König and Ebhardt's Trade Mark*⁵ the mark applied for included a crown, and the evidence showed that there were twenty-seven marks registered in the same class which consisted of, or included a crown or coronet, but the registration was allowed with a limitation of the goods for which it was registered⁶ and a disclaimer of the crown. And in *Mitchell v. Henry*,⁷ an action for infringement, the reasoning which led Jessel, M.R., to dismiss an application by the plaintiffs for an interlocutory injunction, was summed up by Cotton, L.J., as follows: "What is claimed by the plaintiffs is a double thread on a white selvage; if that is distinctive, then what the defendants are using, namely a triple thread upon a white selvage, must be a distinctive trade mark, and therefore I cannot restrain the defendants."⁷

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

The case just referred to forcibly illustrates the difficulties which led Lord Herschell's Committee to recommend that the line headings woven at the ends of lengths of piece goods should not be admitted as trade marks upon the Register.⁸ As they are

Line headings.

¹ *König and Ebhardt's Tm.*, [1896] 2 Ch. 236; 13 R. P. C. 449.

² "Series," sec. 26, Chap. V., at p. 110; and per Cotton, L.J., in *Mitchell v. Henry*, 15 C. D. at p. 193 (1880).

³ Sec. 24, above, p. 108.

⁴ See Ld. Blackburn's judgment in *The Orr-Ewing* case, 4 App. Ca. 499 (1879); and that of Stirling, J., in *Murphy's Tm.*, 7 R. P. C. p. 166 (1890).

⁵ *König and Ebhardt's Tm.*, [1896] 2 Ch. 236; 13 R. P. C. 449. Cf. also *The Star Tobacco* case, on p. 255.

⁶ See also the judgment of North, J., in *Baker v. Rawson*, 8 R. P. C. at p. 107 (1891).

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

⁸ Report of 1888, p. ix.

all constructed by weaving coloured threads into a narrow strip at the end of the piece, the range of possible variation is very closely limited, while the number of existing headings is extremely great, so that it was considered practically impossible to maintain effective distinctions between them, or to sufficiently identify and describe them on the Register. It is now by the Act of 1905 expressly enacted that a line heading shall not be deemed distinctive or registered alone.¹

Marks common to the trade may be material in estimating resemblance.

The bearing of marks common to the trade upon the distinctiveness of a mark propounded for registration has been already discussed;² but besides affecting the right to registration in that way, the nature and number of the common marks with which it will be associated or contrasted may cause the mark propounded to be more or to be less distinguishable from a particular mark than if they did not exist. It is clear, therefore, that the Registrar must have regard to the marks common to the trade in applying sec. 19.³

5. Where the Opponent's Goods are known by a Name suggested by the Mark.

Where the goods of a particular trader have become known by a name derived from his trade mark, any other mark which would be likely to suggest the use of the same name for the goods on which it is used, so resembles the former as to be calculated to deceive.

Seixo v. Provezende.

Thus, where the trade mark of the plaintiff was a crown and the word *Seixo*, and his goods had in consequence come to be known in the market as *Crown-Seixo* wine, the defendants were restrained from using marks which led their wine to be described by the same name,⁴ although evidence was given that *Seixo* was a common word in Portuguese. "The plaintiff," said Lord Cranworth, "had adopted a device or trade mark which had caused his wines to obtain celebrity under a name descriptive of that trade mark. The defendants have adopted a trade mark which could not fail to lead purchasers to attribute to the wines so marked the same name as that under which the plaintiff's wines were known, and so to believe that in purchasing them they would be purchasing the wines of the plaintiff. Against the use

¹ Sec. 64 (10). See Chap. VII, at *Henry*, 15 C. D. 193 (1880), decided under the Act of 1875. p. 125.

² Page 177, above.

⁴ *Seixo v. Provezende*, L. R. 1 Ch. 192

³ Per Cotton, L.J., in *Mitchell v.* (1866).

of such a trade mark the plaintiff has, I think, a right to have the injunction of this Court." So where a trade mark consisting of the full-length figure of a milkmaid carrying two pails, one on her head and one in her right hand, with the words *milkmaid brand* above it, was registered for condensed milk, coffee and milk, cocoa and milk, chocolate and milk, and essence of coffee, and the goods upon which it was used were known as the *milkmaid* or *dairy-maid* brand, and subsequently another trade mark consisting of a half-length figure of a woman carrying a pail under her right arm, with the words *dairy-maid* at the side of the figure, was registered for butterine and other fatty substances used as food or as ingredients in food, an order was made to rectify the Register by confining the second registration to goods other than those included in the first, and to restrain the use of the second mark upon any of the goods for which the first was registered.¹

The Dairy-maid Milk case.

The objection is equally strong if the word suggested by the new trade mark, although not the same as a word suggested by the older mark, yet so nearly resembles it, as to be calculated to deceive.²

The cases just cited are cases where the name applied to the opponent's or plaintiff's goods was taken from the device used as a trade mark. The rule applies also to cases where the name is

¹ *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 C. D. 454; 3 R. P. C. 28 (1886), Kay, J. But cf. *Same v. Pearks, Gunston and Tee, Ltd.*, 29 R. P. C. 509; 21 R. P. C. 261 (1904), Joyce, J., and C. A.; *Orr-Ewing v. Johnston*, 13 C. D. 434; 7 App. Ca. 219 (1879), Fry, J., C. A., and H. L. (*Two Elephant Yarn*); *Speer's Tm.*, 4 R. P. C. 521; 55 L. T. 880 (1887), Kay, J. (*Dog, Tower, and Hoop Linen*); *Read v. Richardson*, 45 L. T. 54 (1881), C. A. (*Dog Head Beer*); *Buschiera's Tm.*, 33 S. J. 469; 5 T. L. R. 489 (1889), Chitty, J. (*Lion Matches*); *Société Anonyme des Ferreries de l'Étoile*, 10 R. P. C. 436; [1894] 1 Ch. 61; 11 R. P. C. 142; [1894] 2 Ch. 26, Stirling, J., and C. A. (*Red Star Glass*); *Wilkinson v. Griffith*, 8 R. P. C. 370 (1891), Romer, J. (*Red Medal Polish*); *Dewhurst's Application*, [1896] 2 Ch. 137; 13 R. P. C. 288, C. A. (*Golden Fan Cotton*); *Currie & Co.'s Application*, 13 R. P. C. 681 (1896), Kekewich, J. (*Cock*

of the North Whisky), and the *Cat and Barrel* cases, cited above, p. 244, are to the same effect. In *Cowie Bros. v. Herbert*, 14 R. P. C. 436 (1897), Court of Session, such a case was set up by the plaintiffs, but failed (*Et Musjid*), as also did the plaintiffs in *Lerer Bros., Ltd. v. Bedingfield*, 16 R. P. C. 3 (1899), where the plaintiffs had a small picture of a laundry-maid on the label, and the defendant had the words *Red Maid*, and the plaintiffs relied (*inter alia*) on that. See also the *Ship Brand* case, *Price's Patent Candle Co. v. Jey's Sanitary Compound Co.*, 19 R. P. C. 17 (1902), compromised on the plaintiffs' appeal. Cf. also *Application of Pomril, Ltd.*, 18 R. P. C. 181 (1901), Joyce, J. (*Apple Brand* cider).

² *E.g.*, *Ancross* for umbrellas in a new mark, was rejected because there were several old anchor marks: *Therel's and Blakey's Tm.*, 10 R. P. C. 369 (1893), North, J.

taken from some word or words appearing upon the mark. *The Osman Towel* case¹ is an illustration of this;² *The Milkmaid* case;³ *The Lion Soap* case;⁴ and *Currie & Co.'s Application*,⁵ already cited, and *Meeus' Application*,⁶ are instances belonging to both classes.

The cases referred to above include instances both of the applicant's (or defendant's) mark containing⁶ and of its suggesting⁷ a word contained in or suggested by the opponent's or plaintiff's mark.

The name given by the public to the goods may be different from that which is given to them by the owner of the goods, but if it is proved that the plaintiff's goods, and his alone, are known by the name given by the public, the Court will protect it.⁸

Answers to objections founded upon names derived from marks.

Where the alleged resemblance is put upon the probability of the application of the same name to the goods of both the applicant and the opponent, it is often contended in reply, (a) that the name is in fact the name or description of the goods themselves; (b) that it is suggested by words, or devices, comprised in the marks, which are common to the trade, or is itself a word or the name of a mark which is common to the trade; or (c) that the proprietor of the opposing mark is seeking to secure a monopoly in the word under cover of his mark.

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

(a) The first objection is really included in the second, but may conveniently be stated separately. It is a question of fact whether the name concerned is the name of the goods or of some

¹ *Barlow v. Johnson*, 7 R. P. C. 395, W. N. (1890), 110, C. A.

² So also are *Hodgson and Simpson v. Kynoch, Ltd.*, 15 R. P. C. 465 (1898), Romer, J. (*Lion Soap*), a trade mark and passing-off case, the plaintiff failing as to the former; *Cochrane v. McNish*, [1896] A. C. 225; 13 R. P. C. 100, P. C. (*Club Soda*), infringement and passing-off; *Powell v. Birmingham Vinegar Brewery Co.*, [1897] A. C. 710; 14 R. P. C. 720, passing-off. See also *Application of Pomril, Ltd.*, 18 R. P. C. 181 (1901), Joyce, J. (*Apple Brand*).

³ *Supra*, p. 251, note (1).

⁴ See note (2).

⁵ [1891] 1 Ch. 41; 8 R. P. C. 25 (1890), Chitty, J. (*Key Brand Geneva*).

⁶ *Anglo-Swiss Condensed Milk Co. v.*

Metcalf; La Société Anonyme des Verriers de l'Étoile; Dewhurst's Application; Cochrane v. McNish; Saxeherner v. Apollinaris Co.; Barlow v. Johnson; Meeus' Application; Powell v. Birmingham Vinegar Brewery Co.; all supra.

⁷ *Orr-Ewing v. Johnston; Speer's Tm.; Read v. Richardson; Wilkinson v. Griffith; Currie's Application; Application of Pomril, Ltd.; above, p. 251, note (1).*

⁸ *Orr-Ewing v. Johnston*, 7 App. Ca. 219 (*Two Elephant Yarn*) was of this nature, as well as others of the cases cited above. And see *Fels v. Christopher Thomas & Brothers, Ltd.*, 21 R. P. C. 85 (1904), C. A. (*Naptha Soap*), in which, however, the plaintiffs failed to establish a secondary meaning.

quality¹ attributed to them, having no reference to the traders by whom they are made or dealt in, or whether it conveys a representation that the goods are made or dealt in by the proprietors of the opposing mark. The question has already been discussed.² All the authorities relevant to it before 1890 were discussed and commented on in *The Osman Towel* case³ by Chitty, J., and the Court of Appeal. As has been shown elsewhere,⁴ where a name was first given by a trader to goods in the manufacture or sale of which he had a monopoly, whether as of right under a patent,⁵ or in fact because he was the first inventor or introducer of the goods,⁶ the Court will more readily infer that the name is the name of the goods merely, and that it connotes no connection between them and the trader, and the probability that this is the case is nearly, although not quite, as strong where, in similar circumstances, the public themselves have taken the name from the trader's marks and applied it to the goods. Of course, it is much more difficult to make out that the name has no such connotation if it is not the only name applied to the goods in the market.

Where the opponent has had a monopoly in the goods.

If the fact is made out that the name suggested by the marks is merely descriptive, and there is no other resemblance which is calculated to deceive, the second mark is not disentitled to registration. Thus, in *Horsburgh & Co.'s Application*, Messrs. Leonard and Ellis, in 1873 had adopted, and subsequently registered, a trade mark comprising the word *valvoline*; four years later the

¹ *E.g.*, excellence: *Arbenz' Application*, 35 C. D. 248; 4 R. P. C. 143 (1886), C. A. (*Gem Air-guns*); or size: *Wood v. Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A. (*Eton cigarettes*).

² Chap. II., at p. 37; see per Ld. Selborne, in *Singer v. Wilson*, 3 App. Ca. p. 376 (1878).

³ *Barlow v. Johnson*, 7 R. P. C. 395; W. N. (1890), 110.

⁴ Chap. II., at pp. 43 *et seq.*

⁵ *Wheeler & Wilson Co. v. Shakespeare*, 39 L. J. Ch. 36 (1869), James, V.-C.; *Linoleum Co. v. Nairn*, 7 C. D. 834 (1878), Fry, J.; and *Palmer's Tm.*, 24 C. D. 504 (1882), Chitty, J., and C. A.; *Slazenger v. Feltham*, 6 R. P. C. 531; 5 T. L. R. 365 (1889), C. A. (*Demon Racquets*) (a case of an invalid patent); *Magnolia Metal Co.'s Tms.*,

[1897] 2 Ch. 371; 14 R. P. C. 265 and 621, Kekewich, J., and C. A. (*Magnolia Metal*); *Meaby & Co., Ltd. v. Triticine, Ltd.*, 15 R. P. C. 1 (1897), North, J. (*Triticumina biscuits*); *Formalin Hygienic Co.'s Application*, 17 R. P. C. 486; (1900), Farwell, J. (*Formalin*); *Gestetner's Tm.*, [1907] 2 Ch. 478; [1908] 1 Ch. 513; 24 R. P. C. 545; 25 R. P. C. 156.

⁶ *Leonard and Ellis' Tm.*, 26 C. D. 288 (1884), C. A. (*Valvoline*); *Arbenz' Application*, 35 C. D. 248; 4 R. P. C. 143 (1887), C. A. (*Gem Air-guns*); *Waterman v. Ayres*, 39 C. D. 29; 5 R. P. C. 368 (1888), C. A. (*Reversi*); *Chesebrough Co.'s Tm.*, [1902] 2 Ch. 1; 18 R. P. C. 191; 19 R. P. C. 342 (*Vaseline*), Buckley, J., and C. A., where, however, *Vaseline* was held to be a good trade mark.

applicants sought to register a different mark comprising the word *valvolum*. The words were held to be substantially the same, and each of them to be descriptive of the valve oil in connection with which both marks were to be used, and Jessel, M.R., allowed the second mark to be registered.¹

Section 44 of the Act of 1905 enacts that no registration under the Act shall interfere (*inter alia*) with the use by any person of any *bonâ fide* description of the character or quality of his goods.

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

(b) Where the name is suggested by words or devices which are common to the trade and which occur in the trade mark offered for registration, the words or devices may be required to be disclaimed,² and, if they form part of the opponent's mark, cannot be, by themselves, relied on to support the opposition;³ and, if not disclaimed by him, a disclaimer of them may possibly be obtained by an application to rectify the register.⁴ The rule may also be applicable if a word or device was at the date of registration saved from disclaimer only by being part of an essential particular, as, for instance, occurring in a distinctive label.⁵ In one case, where there was no disclaimer on the Register, and no application to rectify, North, J., notwithstanding evidence that part of the opponent's registered mark was common to the trade, held that it was used distinctively.⁶ The presence of the common elements in both marks may be an element in creating a general resemblance between them looked at as wholes.⁷

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

¹ 53 L. J. Ch. 237, n. (1878). The opponents had also registered *Valvoline* alone as a trade mark. It was subsequently removed from the Register; *Leonard and Ellis' Tm.*, 26 C. D. 288 (1884), C. A.; *Blair v. Stock*, 52 L. T. 123 (*Strathmore Blend Whisky*); *Loftus' Tm.*, [1894] 1 Ch. 193; 11 R. P. C. 29, North, J. (*Unco' Guin Whisky*).

² Sec. 15, Chap. IX., p. 212; formerly the disclaimer had to be in the application to register, *Mccus' Application*, [1891] 1 Ch. 41; 8 R. P. C. 25, Chitty, J. (*Key Brand Geneva*). Cf. *Players' Application*, [1901] 1 Ch. 382; 18 R. P. C. 65, Cozens-Hardy, J.

³ *Loftus' Tm.*, above, note 1. An injunction cannot be obtained in respect of disclaimed matter, except in a passing-off action (sec. 45); *Pirie v. Goodall*,

[1892] 1 Ch. 35; 9 R. P. C. 17, C. A. (*parchment bank paper*); *Bessenthal v. Reynolds*, [1892] 2 Ch. 301; 9 R. P. C. 189, North, J. (*W. R. Corsets*); *Wall v. O'Hanlon*, 4 R. P. C. 1 (1886), Porter, M.R., an Irish case (*Old Innishowen*); *Hubbuck v. Brown*, 17 R. P. C. 148 and 638 (1900), Kekewich, J., and C. A. See, however, p. 218, above.

⁴ Secs. 35 and 15. The disclaimer sections of the Act of 1883 were sec. 64 (2) and sec. 74 (2). These were amended by secs. 10 and 16 of the Act of 1888.

⁵ *Semble*, per Romer, L.J., during the argument in *Clement et Cie's Tm.*, 16 R. P. C. 611 (1899).

⁶ *Goodall's Tm.*, 42 C. D. 566 (1889), North, J. (*parchment bank paper*).

⁷ See p. 250.

The Star Tobacco Mark case¹ is an authority to show that the suggestion both by the mark of the applicant and by that of the opponent of a word which is common to the trade, because it is a name or description for the goods in connection with which both marks are used, is not a sufficient reason for refusing the application to register. There the opponents had registered as an old mark a characteristic eight-pointed star, and also, as a new mark, a label with the star, another device and the word *star*, and they asserted that their goods were frequently sold and ordered as *star* goods. The applicant's mark consisted of a sea-picture within a ring, having a small six-pointed star in the clouds at the top, and a conspicuously drawn anchor in the lower part of the picture, and the words *star of hope*. The judge found that the device of a star, although not the particular star of the opponents' old mark, was common to the trade, and he allowed the registration. "I think," he said, "that the use of the word *star* and the use of the figure of a star are matters *publici juris*, and have been *publici juris* at all material times, except so far as some particular trader may have appropriated a particular phrase in which *star* is used in some special manner, or may have appropriated a particular design in which the figure of a star has assumed a special form, or has been so combined with other matters as to produce a specific thing different from what may be called the ordinary image of a star."²

Where the name is common to the trade.

In *Hubbuck v. Brown*³ the plaintiffs sought to establish that in certain foreign countries their goods had acquired the name *Dos Leones*, and that the defendant's mark would deceive, but they were in the difficulty that their goods had acquired the name from the presence of the Royal Arms in their mark, and that they could not restrain the use of such Arms by the defendant without setting up a monopoly in them to which they were not entitled.⁴

(c) The third ground of reply has also been dealt with in several cases, and it is settled that a trader will not be allowed to acquire or use a mark which will probably lead to his goods being

(c) Where the name is said to give a practical monopoly.

¹ *Re Dexter's Application, Re Wills' Tm.*, [1893] 2 Ch. 262; 10 R. P. C. 269, Wright, J.

² As to such exceptions, see above, p. 179.

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

R. P. C. 638.

⁴ Cf. also *Phillips v. Ogden*, 12 R. P. C. 325 (1895), Wills, J., a passing-off case, in which both plaintiffs and defendants had the right to use *Guinea Gold* for cigarettes, and otherwise the boxes were sufficiently distinguished.

The Red Medal Polish case.

mistaken for those of another, even though this may make it difficult for him to truly describe the place of origin of his goods, or to present them to purchasers in the form in which they expect to receive goods of the class.¹ Thus, in *Wilkinson v. Griffith*,² an infringement case, Romer, J., in restraining the defendants from using their label, relied upon evidence that the plaintiff's goods were known as red stamp polish from the figures upon his labels, although it was urged on the defendants' behalf that the plaintiff's claim practically involved a claim to a monopoly in red labelled goods. The judge, however, expressly stated that the plaintiff was not entitled to any such monopoly. "I by no means hold, nor do I think, the evidence as a whole can fairly be said to establish," he said, "that any red mark on a label of the defendant would render that label deceptive. I can imagine many red marks, or even red medals, being so used as to prevent deception." But it is for the applicant for registration of the mark which is alleged to be deceptive to make it clear that such is not the case.

Evidence.³

Evidence material to the question of resemblance.

It follows that upon any question with respect to the registration of a mark which arises under sec. 19 it is material for the tribunal to be furnished with evidence of the matters of fact involved in the propositions stated above wherever it is alleged that they tend to increase or diminish the resemblance referred to in the sub-section.

Expert evidence as to probability of deception.

Besides this evidence, the evidence of persons who are well acquainted with the trade concerned was formerly constantly tendered by the parties to show that in the opinion of such persons, as experts, the alleged resemblance between the contrasted marks was, or was not, calculated to deceive, and it was formerly constantly admitted, although judges often expressed much impatience of evidence of this class,⁴ and certainly it frequently presents in an eminent degree the characteristic vices of expert testimony. It

¹ *Wotherspoon v. Currie*, L. R. 5 H. L. 508 (1872) (*Glenfield Starch*); *Montgomery v. Thompson*, [1891] A. C. 217; 8 R. P. C. 361 (*Stour Ales*). It is to be noted, however, that these were both cases of attempted frauds. *Johnston v. Orr-Ewing*, 7 App. Ca. 210 (1892), H. L. (*Two Elephant Yarns*). See also the last paragraph.

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

³ As to the evidence upon applications to register generally, see Chap. IV., at pp. 96 and 97.

⁴ *Re Jelley*, 51 L. J. Ch. 639, n., Jessel, M. R. (1878); *Pinto v. Bulman*, 8 R. P. C. 181 (1891), C. A.

consists in general of opinions formed after the dispute has arisen; not upon any judicial balance of the opposing contentions, but upon a scrutiny of the subject directed to discover what can be said in favour of one side only. And where the question is as to the degree of a resemblance between two words or designs, or as to whether a difference in particular parts of two contrasted labels is substantial or immaterial, reasons can rarely be found by the witnesses to recommend an opinion to anyone who has not conceived it for himself without their assistance. Since the decision of the House of Lords in *North Cheshire Brewery Co. v. Manchester Brewery Co.*¹ judges have in many cases refused to allow to be put to a witness, or have disapproved the question whether the public would be or would be likely to be deceived.² In that case Lord Halsbury, L.C., said: "Is this name so nearly resembling the name of another firm as to be likely to deceive? That is a question upon which evidence, of course, might be given as to whether or not there was another brewery either in the one place or in the other, or whether there were several breweries nearly resembling it in name; what the state of the trade was, and whether there was any trade name. All those are matters which are proper to be dealt with upon evidence; but upon the one question which your Lordships have to decide, whether the one name is so nearly resembling another as to be calculated to deceive, I am of opinion that no witness would be entitled to say that, and for this reason: that that is the very question which your Lordships have to try." And in *Payton & Co., Ltd. v. Snelling, Lampard & Co., Ltd.*,³ Lord Macnaghten, commenting on the evidence and on questions having been put to witnesses whether a person going into a shop as a customer would be deceived, said: "But that is not a matter for the witness; it is a matter for the judge. The judge, looking at the exhibits before him, and also paying the attention to the evidence adduced, must not surrender his own independent judgment to any witness whatever." The question of evidence as to probability of deception

¹ [1899] A. C. 83 (a trade name case).

² *Alaska Packers' Association v. Crooks & Co.*, 18 R. P. C. 129 (1900). Kekewich, J.; *Hennessy v. Dompé*, 19 R. P. C. 333, at p. 339, Kekewich, J. (1902); *Lambert and Butler v. Goodbody*, 19 R. P. C. 377 (1902), Farwell, J.; *Bourne v. Swan and Edgar, Ltd.*, [1903] 1 Ch. 211; 20 R. P. C. 105, Farwell, J.; *Fairbank Co.*

v. Cocos Butter Manufacturing Co., 21 R. P. C. 23, at p. 26 (1904), Swinfen Eady, J. See also *Hennessy v. Keating*, 21 R. P. C. 485, 25 R. P. C. 125, 361 (1907), Porter, M.R., and C.A., Ireland, and H.L.

³ 17 R. P. C. 628 (alleged passing-off by get-up); the passage referred to is at p. 635.

in such cases subsequently came before the Court of Appeal in *London General Omnibus Co. v. Lavell*.¹ In that case Farwell, J., who tried the case, had after a view of the rival omnibuses arrived at the conclusion that there was a resemblance intentionally designed and that the ordinary user of omnibuses would very probably be deceived, but no evidence was given of actual deception, and only the secretary of the company and a painter of their omnibuses were called as to the probability of deception. In allowing the defendant's appeal, the Court pointed out that there were considerable differences in the two omnibuses, and that, with the exception of one alteration made about five years before the trial, the defendant's omnibus had been running without alteration for ten years, and it held that the evidence for the plaintiffs was insufficient to prove probability of deception. In commenting on the lack of evidence, the members of the Court referred to the Court being required to make an assumption as to the habits of people travelling in omnibuses and of such matters, of the absence of evidence by persons in the habit of using omnibuses, and by officers of the company in the habit of checking the user of omnibuses and seeing passengers as they got in and out, and hearing complaints of deception. This decision has been the subject of considerable discussion in some subsequent cases,² but it is to be noticed that none of the members of the Court of Appeal intimated that a witness could be asked directly whether the defendant's omnibus would be calculated to deceive, and, as already stated, such a question, at all events if objected to, has in recent cases been disallowed. Expert evidence as to the circumstances usually attending the sale of the goods in the particular trade, and as to the ordinary class of customers served, their intelligence and education, what they particularly look for in purchasing the plaintiff's goods, and, if the goods are sold abroad, their knowledge of the meaning of English words in the marks, and such like matters, is no doubt admissible.³ The judge must in the end act upon his own view on a comparison

¹ [1901] 1 Ch. 135; 18 R. P. C. 74.

² Particularly in *Bourne v. Swan and Edgar. Ltd.*, [1903] 1 Ch. 211; 20 R. P. C. 105. Farwell, J., in this case refers to the omnibus case as having been treated as a common law action of deceit. This is no doubt the phrase used in the Court of Appeal, but it is the name generally applied to an action brought by the

person deceived himself, in which sense, of course, it could not have been used. It is difficult to see in what respects the action differed from an ordinary action for passing-off.

³ See *Hubbuck v. Brown*, 17 R. P. C. 148 (1900), Kekewich, J., as an instance of a case in which some evidence of this nature was given.

of the marks, having regard to the matters of fact referred to above. To quote a recent authority, in *Schweppes, Ltd. v. Gibbens*¹ Warrington, J., whose judgment was approved by the majority of the Court of Appeal and by the House of Lords, said: "It seems to me that each of these cases must be looked at by itself, and the judge looking at the label, or the get-up, or the device, whatever it may be that is complained of, with such assistance as to the practice of the trade as he can get from witnesses, must decide for himself whether the article complained of is calculated to deceive or not."

Evidence of ordinary members of the public who are not acquainted with the usages of the trade involved, or even of experts, that they think they would or would not be deceived by the resemblance of one mark to another, is of little assistance in the determination of questions of alleged deceptive similarity.²

Direct evidence of probability of deception.

If one or more cases of actual deception are made out to the satisfaction of the Court, this will, of course, afford very strong evidence that the resemblance of the marks in question is so close as to be calculated to deceive. But the absence of evidence of actual deception is a circumstance which varies greatly in weight according to the nature of the case. It is conceived that it can never be conclusive by itself;³ but where the marks have been circulating side by side in the market where deception is alleged to be probable, the fact that no one appears to have been misled is very material,⁴ unless the absence of such evidence is

Evidence of actual deception.

¹ 22 R. P. C. 113, 601 (1905). The passage quoted above is also quoted in *Hennessy v. Keating*, cited p. 257, note (2), in which the same result appears to have been arrived at, at all events in the House of Lords. The question is to be decided partly by the judge's eyesight, and partly by his view of the evidence: *Farrow's Tm.*, 7 R. P. C. 260; 63 L. T. 233 (1890), Stirling, J. See, however, *Mitchell v. Henry*, 15 C. D. at p. 195 (1880); and *Christiansen's Tm.*, 3 R. P. C. 54 (1885), Chitty, J., and C. A.

² See *Kutnow's Tm.*, 10 R. P. C. 401 (1893), North, J. (*Carlsbad Salts*), and note (2), p. 257, supra. In *Turton v. Turton*, Fry, L.J., compared this evidence to the oaths of compurgators in a mediæval trial: 45 C. D. at p. 149.

³ *Edelsten v. Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, L.C.; *Compania*

General de Tabacos v. Rehder, 5 R. P. C. 61 (1887), Kay, J.; *Reddaway & Co. v. Bentham Hemp Spinning Co.*, [1892] 2 Q. B. 639; 9 R. P. C. 503, C. A.; *Paine & Co. v. Daniell & Sons' Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 71, C. A.

⁴ *Cope v. Evans*, 18 L. R. Eq. 138 (1874), Hall, V.-C.; *Rodgers v. Rodgers*, 31 L. T. 285 (1874), Mellish, L.J.; *Estcourt v. The Estcourt Hop Essence Co.*, L. R. 10 Ch. 276 (1875), C. A.; *Lambert's Tm.*, 5 R. P. C. 556; 61 L. T. 138 (1888), North, J.; and *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. at p. 107 (1889), North, J.; *Talbot's Tm.*, 11 R. P. C. 77 (1894); *Phillips v. Ogden*, 12 R. P. C. 325 (1895), Wills, J.; but see *Liebig's Extract of Meat Co. v. Chemists' Co-operative Society*, 13 R. P. C. 635, 736 (1896), Kekewich, J., and C. A.

satisfactorily explained by the difficulty of procuring witnesses from a distant foreign market,¹ or otherwise. On the other hand, if one or both of the marks is new or nearly new, there can have been no opportunity, or little opportunity, for deception to occur.

On an appeal from the Registrar by an applicant for registration, the onus is on the appellant to show affirmatively that his trade mark is not calculated to deceive.²

Examples and illustrations.

The cases following, of marks held to have, or not to have, such resemblance to each other as to be calculated to deceive, illustrate the principles referred to above. Many of them have been cited already.

Contrasted Devices.

A pointer eating out of a pot, too near for registration to a similar dog standing by a pail with STANCH beneath it; *Jelley's Application*, 51 L. J. Ch. 639, n. A twisted curved horn, with a twig bearing two roses, too near a similar untwisted horn with a cord having two loops in the same place as the roses in the twig; *Rosing's Application*, 54 L. J. Ch. 975, n. A triangular frame with words upon it and a church inside, too near Bass's solid triangle; *Worthington's Tm.*, 14 C. D. 8; so also a white diamond within a red diamond; *Turney & Sons' Tm.*, 11 R. P. C. 37. A half-length figure of a milkmaid, with the word *Dairy-maid*, too near a full-length figure of a milkmaid carrying two pails; *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 C. D. 454; 3 R. P. C. 28. A woman's head wearing a helmet with ATHENA beneath, not too near a man's head with WAY beneath; *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102. A tower in an oval border, with a dog and harp, too near a tower, dog, and harp without any border; *Speer's Tm.*, 4 R. P. C. 521. An oval label containing interlaced triangular frames with a stag's head within them, too near an oval label with three superimposed solid triangles, although the lettering on the marks was conspicuously different; *Biegel's Tm.*, 4 R. P. C. 525; 57 L. T. 247. A sheep suspended by its middle, with the words GOLDEN FLEECE, too near a somewhat different sheep with the same words; *The Australian Wine Importers' Tm.*, 41 C. D. 278; 6

¹ *Wilkinson v. Griffith*, 8 R. P. C. 370 (1891), Romer, J. In *Cowie Bros. v. Herbert*, 14 R. P. C. 436 (1897), the Scotch Court of Session commented on the absence of such evidence.

² *Eno v. Dunn*, 15 App. Ca. 252; 7 R. P. C. 311 (1889); *Capsuloid Co., Ltd.'s Application*, 23 R. P. C. 782 (1906), Swinfen Eady, J.

R. P. C. 311. A pig in outline, and H. B. & Co., not too near shaded pointer dog, and STANCH; *Haines, Batchelor & Co.'s Tm.*, 5 R. P. C. 669. A tobacco pipe and dart, not too near a tobacco pipe alone; *Lambert's Tm.*, 5 R. P. C. 542; 6 R. P. C. 344; 61 L. T. 138. A charging buffalo, too near a bull's head, both being placed in silver rings on similar yellow wrappers; *Farrow's Tm.*, 7 R. P. C. 260; 63 L. T. 233. A mark having as its sole essential particular a lion bearing a sheaf, too near a mark having as an essential particular a lion with a crown; *Murphy's Tm.*, 7 R. P. C. 163. An elephant in a border with lettering round it, an infringement of a somewhat different elephant alone; *Upper Assam Tea Co. v. Herbert & Co.*, 7 R. P. C. 183. A label bearing a winged cross surrounded by two circles in its upper third, not an infringement of a similar label, being a lighthouse similarly surrounded and placed; *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89. A label with two red medals and a balloon, an infringement of a similar label with two red medals only, both labels being used for polish known in India, from the latter label, as red medal polish; *Wilkinson v. Griffith*, 8 R. P. C. 370. A label with a cock in the centre, the groundwork being a piece of plaid with the words *Prince Charlie, King o' the Hieland Hearts*, in the upper part, too near a label bearing in the upper part the words *The Cock o' the North* with a cock in a central position over a coat of arms, with a Highlander on one side and a horse on the other; *Currie's Application*, 13 R. P. C. 681. A label bearing a representation of the Royal Exchange, Glasgow, and the words *Royal Exchange Whisky* below, refused registration because it would give the right to restrain a label bearing the same representation with the words *Bodega Special Whisky* below; *Rogers' Tm.*, 12 R. P. C. 149. C. B. & Co. and also C. B. D. held to infringe marks, one consisting of the device of a corset and the letters C. B. within a star, and the other of C. B. corsets; *Bayer v. Connell Bros.*, 16 R. P. C. 157.¹ The device of a red deer's head, not an infringement of a trade mark consisting of a moose head; *Alaska Packers' Association v. Crooks & Co.*, 16 R. P. C. 503, and 18 R. P. C. 129. The device of the cut side of half an apple cut vertically, with the word *Pomril* across it, too near a mark containing a representation of an apple and the words "apple brand," both marks being for

¹ In Ireland before Porter, M.R. See also *Bayer v. Baird*, 15 R. P. C. 615 (1897), Sc. Ct. of Session.

cider; *Pomril Ltd.'s Application*, 18 R. P. C. 181. J. B. D. in an oval ring, an infringement of G. B. D. in an oval ring; *Maréchal and Ruchon v. M'Colgan*, 18 R. P. C. 262 (Ireland). A show-card with a device having some of the features and lines of a diamond and the word "famous" on it, not an infringement of a plain diamond; *Bass, Ratcliff and Gretton, Ltd. v. Davenport & Sons' Brewery, Ltd.*, 19 R. P. C. 129 and 529. A sphinx in combination with Egyptian scenery not an infringement of a sphinx in a different position; *Lambert and Butler v. Goodbody*, 19 R. P. C. 377. A rampant cat on a horizontal barrel, known as the "Cat Brand" or "Cat and Barrel Brand," held to be infringed by a cat's head and fore-quarters out of the top of a barrel on end, with the words CAT BRAND; *Boord & Son v. Huddart*, 21 R. P. C. 149. The same trade mark held to be infringed by a cat sitting on the top of a barrel placed on end; *Boord & Son v. Thom & Cameron, Ltd.*, 24 R. P. C. 697. A label of which a signature was claimed as the essential feature held not to be infringed by a label similar in structure, but having the defendant's name prominently upon it; *Dawson v. Stewart*, 22 R. P. C. 250. An ace of spades with the word *Hub* on it held to be an infringement of an ace of clubs with the word *Club* on it; *Munday v. Carey*, 22 R. P. C. 273. A shamrock with a stalk twisted so as to form "& Co.," not too near a compound mark of a crown and a shamrock in a different position with the letters M. V. on it; *Shamrock & Co.'s Application*, 24 R. P. C. 569. A diamond divided into two triangles, and bearing upon it a device and monogram, refused registration on the ground, *inter alia*, of similarity to other diamond marks; *La Union Agricola's Trade Marks*, 25 R. P. C. 295.

Contrasted Words.

WHITE ROSE, too near ROSALINE; *White Rose Tm.*, 30 C. D. 505. CONDI-SANITAS and SANITANT, infringements of SANITAS; *Sanitas Co. v. Condy*, 4 R. P. C. 195 and 530; 56 L. T. 621. BOYD'S UNRIVALLED HARNESS COMPOSITION, in a label with the Arms of the City of Dublin, not an infringement of PROPERT'S IMPROVED HARNESS COMPOSITION in a label, with a fox's head, the labels being similarly got up; *Beddow v. Boyd*, 4 R. P. C. 310. APOLLINIS, an infringement of APOLLINARIS; *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478. STEINBERG, an infringement of STEINWAY, the words being used with devices showing a general

similarity; *Steinway v. Henshaw*, 5 R. P. C. 77. EMOLLIO, too near EMOLLINE; *Grossmith's Tm.*, 6 R. P. C. 180; 60 L. T. 612. EMOLLIOLORUM, not too near MOLLISCORIUM; *Talbot's Tm.*, 11 R. P. C. 77. SWIFT'S SPECIFIC occurring in a trade mark, not calculated to deceive merely because the words were descriptive of the opponent's drug; *Swift Specific Co.'s Tm.*, 6 R. P. C. 352. OOMOO, not too near EMU; *Burgoyne's Tm.*, 6 R. P. C. 229; 61 L. T. 39. KOKOKO, too near the common word COCO; *Jackson & Co.'s Tm.*, 6 R. P. C. 80. DEMOTIC, an infringement of DEMON; *Slazenger v. Feltham*, 6 R. P. C. 531. DUNN'S FRUIT SALT BAKING POWDER, too near ENO'S FRUIT SALT; *Eno v. Dunn*, 41 C. D. 439; 15 A. C. 252; 7 R. P. C. 311; subsequently held to be an infringement, 10 R. P. C. 261. EL DEVINO, an infringement of EL DESTINO; *Pinto v. Trott*, 8 R. P. C. 173. Label with EL DESTINACION, an infringement of a similar label with EL DESTINO; *Pinto v. Badman*, 8 R. P. C. 181. Label with LONDON PICKLES, an infringement of a similar label with LONDON PICKLE Co.; *Hammond v. Malcolm, Brunker & Co.*, 9 R. P. C. 301. STAFFORD, an infringement of TRAFFORD; FORT of FORTRESS; NEW MISTRESS, but not NEW MATRON, NEW MASTER, or MASTER, of MISTRESS; but SOUTH AFRICAN not an infringement of a mark consisting of a negro's head and the word AFRICAN; *Smith and Wellstood v. Carron Co.*, 13 R. P. C. 108. VINCALIS, not too near WINCARNIS, the goods being different in appearance and use; *Coleman & Co., Ltd. v. Brown & Co.*, 16 R. P. C. 619 (passing-off). TRITICUMINA, not infringed by TRITICINE; *Meaby & Co., Ltd. v. Triticine, Ltd.*, 15 R. P. C. 1. Signature ROBERT CRAWFORD, not infringement of signature DANIEL CRAWFORD; *Crawford v. Bernard & Co.*, 11 R. P. C. 580. MARGARITA, an infringement of LA FLOR DE MARGARETTA; *Benedictus v. Sulliran, Powell & Co.*, 12 R. P. C. 25. SAVOLINE, an infringement of SAVONOL; *Field, Ltd. v. Wajel Syndicate, Ltd.*, 17 R. P. C. 266. IVORY, for soap, not necessarily calculated to cause the goods to be confused with IVY soap; *Goodwin v. Ivory Soap Co.*, 18 R. P. C. 389.¹ NIGHT CAP, not too near RED CAP or MOTHER RED CAP; *Hedley's Tms.*, 17 R. P. C. 719. VALTINE, too near VALENTINE; *Valentine Meat Juice Co. v. Valentine Extract Co., Ltd.*, 17 R. P. C. 673, passing-off (and see 18 R. P. C.

¹ The action was dismissed on another ground, and the appeal would apparently have failed also on that ground, namely,

that the defendants had acquired a right to use the word Ivory. The only point of similarity lay in the names.

175). S. GRIFFITHS, three stars and I. X. L., not infringed by E. GRIFFITHS and three stars, the stars being common marks of quality; *Marshall v. Sidebotham*, 18 R. P. C. 48. On an application for an interlocutory injunction, St. Ives cheese held too similar to ST. IVEL, registered for cheese; *Aplin and Barrett v. Richards*, 20 R. P. C. 799. NEOSTYLE, not too near CYCLOSTYLE; *Neostyle Manufacturing Co.'s Tm.*, 20 R. P. C. 329 and 803. SECURINE, an infringement of SECCOTINE; *McCaw, Sterenson and Orr, Ltd. v. Nickols & Co.*, 21 R. P. C. 15. COCOSOLINE, not an infringement of COTTOLENE; *Fairbank Co. v. Cocos Butter Manufacturing Co.*, 21 R. P. C. 23. Mark including the words JOCK SCOTT, too near SCOTCH JOCK; *Booth Distillery Co.'s Application*, 21 R. P. C. 18. TABLONES, too near TABLOIDS; *Capsuloid Co., Ltd.'s Application*, 23 R. P. C. 782. NEOLA, not too near PIANOLA; *Pianotist Co., Ltd.'s Application*, 23 R. P. C. 774. LANCO, not too near LANCASHIRE; *Reddaway & Co., Ltd. v. Irwell and Eastern Rubber Co., Ltd.*, 23 R. P. C. 621; 24 R. P. C. 203, alleged passing-off, the goods being somewhat different. B. A. S., too near B. S. A.; *Birmingham Small Arms Co., Ltd. v. Webb & Co.*, 24 R. P. C. 27, passing-off. MIDLAND STAR, not too near STAR; *Star Cycle Co., Ltd. v. Frankenburgs*, 24 R. P. C. 46 and 405, alleged passing-off, there being several names in use in the trade which included the word star.

Concurrent User.

Concurrent
user.

By sec. 21 :—

“In case of honest concurrent user or of other special circumstances which, in the opinion of the Court, make it proper so to do, the Court may permit the registration of the same trade mark, or of nearly identical trade marks, for the same goods or description of goods by more than one proprietor subject to such conditions, and limitations, if any, as to mode or place of user or otherwise, as it may think it right to impose.”

Prior to the Act of 1905 the Court had held itself bound by the terms of the Acts to refuse registrations of two identical or similar marks for the same goods.¹ This was an undoubted

¹ *Ehrmann's Tms.*, [1897] 2 Ch. 495; 14 R. P. C. 665; *Hall and Woodhouse, Ltd.'s Application*, 19 R. P. C. 58 (1902). An old mark has sometimes been registered notwithstanding the presence

on the Register of a similar new mark: *Mouson v. Boehm*, 26 C. D. 398 (1884); *Jackson v. Napper*, 35 C. D. 162; 4 R. P. C. 45 (1887).

hardship in the cases, which sometimes occurred, of a trader having built up a trade under a trade mark in ignorance of a similar registered trade mark of another person, the businesses of the traders under the marks being confined to different localities so as not to have clashed. Section 21 provides a remedy for such a state of things by conferring on the Court in cases of honest concurrent user or of other special circumstances power to permit registration, either of the unregistered trade mark, or, if neither is registered, of both trade marks, subject to such, if any, conditions and limitations as it may think fit.¹ Where neither of the marks has been registered, the owners can also, if they settle their claims by agreement to the approval of the Registrar or the Board of Trade, obtain registration under sec. 20;² at least this appears to be the effect of secs. 20 and 21 taken together, but it may be held that the Court only can allow concurrent registration in cases which fall within the terms of sec. 21, although this would give a narrow interpretation to sec. 20. Restrictions as to mode or place of user³ are expressly authorised, and limitations as to colour⁴ or as to the goods on which the marks are to be used are amongst those which the Court can impose. No doubt in exercising its discretion under the section the Court will have regard to the interests of the public as well as those of the owners of the trade marks. Moreover, if the trade mark is one which ought not, under sec. 11, to be registered by reason of its being deceptive or otherwise, sec. 21 ought not to be applied in favour of it.⁵

Three other provisions of the Act may here be noticed, namely, that relating to apportionment of trade marks where a goodwill becomes divided on dissolution of partnership or otherwise;⁶ the proviso to sec. 39, which provides that where two or more persons are registered proprietors of the same (or substantially the same) trade mark in respect of the same goods, no rights of exclusive user of such trade marks shall (except so far as their respective rights shall have been defined by the Court) be

Concurrent rights in registered mark.

¹ In *Boord & Son v. Thom and Cameron, Ltd.*, 24 R. P. C. 697 (1907), Inner House, Scotland, the Court held that where in an action for infringement concurrent user is alleged, the defendant ought to ask to be put on the Register. It is doubtful whether the Court can do this, however, without an application to register the mark in the usual way.

² Above, p. 225.

³ As to the view taken by the Courts in respect of limitations of locality under the previous Acts, see above, p. 76.

⁴ Sec. 10. See Chap. VIII., above, at p. 211.

⁵ *Compagnie Industrielle des Petrole's Application*, [1907] 2 Ch. 435; 24 R. P. C. 585, Warrington, J.

⁶ Assignment and transmission of trade marks, Chap. XIII., below, p. 345.

acquired by any one of such persons as against any other by the registration thereof, but each of such persons shall otherwise have the same rights as if he were the sole registered proprietor thereof; and the following proviso to sec. 41 (which makes registration conclusive after a period of years):—

“Provided that nothing in this Act shall entitle the proprietor of a registered trade mark to interfere with or restrain the user by any person of a similar trade mark upon or in connection with goods upon or in connection with which such person has, by himself or his predecessors in business, continuously used such trade mark from a date anterior to the user of the first-mentioned trade mark by the proprietor thereof or his predecessors in business, or to object (on such user being proved) to such person being put upon the Register for such similar trade mark in respect of such goods under the provisions of section twenty-one of this Act.”

II. Deceptive or Scandalous Marks.

Sec. 11.

Deceptive or scandalous marks.

It is provided by sec. 11 that—

“It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being calculated to deceive or otherwise,¹ be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.”

With certain alterations to be noticed, this section embodies the provisions of secs. 73 and 86 of the Act of 1883.² The latter section related to trade marks the use of which was contrary to law or morality. Section 73 of the Act of 1883 affected only words, whilst in the present section the more general term “matter” is used. The words “as a trade mark or part of a trade mark” are substituted for the words “as part of or in combination with a trade mark”; this is in harmony with the remainder of the present Act, which omits all provisions for registering additions to trade marks. Sec. 73 was apparently in one case applied to a trade mark consisting only of a single word.³ The word “exclusive” which qualified “use,” both in the Act of 1875 and

¹ See p. 274, below.

² See below, pp. 274 and 275. The corresponding provision of the Act of 1875 was sec. 6.

³ *Eastman Photographic Materials Co. v. John Griffith's Cycle Corporation*, 15 R. P. C. 105 (1898), Romer, J.

in the Act of 1883, was removed, upon the suggestion of Lord Herschell's Committee, by the Act of 1888.¹ The Committee say: "Words might be offered for registration in conjunction with a trade mark for which the applicant did not claim, and of which he would not be entitled to claim the exclusive use, but the use of which might nevertheless be calculated to deceive, and so be disentitled to the protection of a court of justice."

"Exclusive use."

The provisions as to deceptive marks were, no doubt, intended to embody the old rule of the Court of Chancery, which refused protection to the owner of a deceptive trade mark;² and it was held, by Jessel, M.R., that their operation was confined to cases where the marks were in themselves inherently deceptive;³ but the Courts have held that the restriction is of wider scope than the old rule, or than this construction would suggest.⁴ The leading case in point is *Eno v. Dunn*,⁵ in which the House of Lords (Lord Halsbury and Lord Morris dissenting) overruled the judgment of the Court of Appeal (Lindley and Fry, L.JJ., Cotton, L.J., dissenting), and restored that of Kay, J. The question in that case was whether the words *Fruit Salt* occurring in a mark consisting of the words *Dunn's Fruit Salt Trade Mark Baking Powder*, and in a mark consisting of a distinctive label, quite different in character from the device used by the opponent, Eno, and bearing the words *Dunn's Fruit Salt Baking Powder*, were calculated to deceive, having regard to the well-known use of the words as the name of Eno's Fruit Salt. Eno, in the first instance, based his opposition to Dunn's application to register his marks partially upon his title as the owner of the mark *Fruit Salt*, registered as "a proprietary medicine for human use," and also as a "dry preparation for making a non-intoxicating beverage"; but finding that he could not prove user of that mark before 1875, and that the words were consequently not capable of registration under the Acts then in force, he was driven to consent to its removal from the Register, and to rely wholly upon the alleged deceptiveness of the marks propounded by Dunn.

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

The Fruit Salt case.

¹ Sec. 15.

² See Chap. XV., at p. 246; and Ld. Macnaghten's judgment in *Eno v. Dunn*, *infra*.

³ *Horsburgh's Application*, 53 L. J. Ch. 237, n.; 50 L. T. 23, n. (1878) (*Valvolcum*).

⁴ See the judgment of Cotton, L.J., in which the majority of the law lords

concurrent, in *Eno v. Dunn*, 41 C. D. p. 448.

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

Doubtful
new marks to
be rejected.

Lord Her-
schell's judg-
ment.

Lord Mac-
naghten's
judgment.

Lord
Watson's
judgment.

The marks were normally used for different goods. Dunn's preparation was a baking powder, and Eno's an aperient effervescing powder; but evidence was given that, in a very few instances, Eno's salt had been used as a baking powder, although it was shown to be very unsuitable for the purpose. The majority of the law lords held that Dunn's marks were deceptive, and the application to register was dismissed. Lord Herschell and Lord Macnaghten based their judgments upon the discretion conferred on the Comptroller—apart from the sections considered in this chapter—to refuse marks from which it is not clear that deception might not result. Lord Herschell said: "I think it is enough to say that I am not satisfied that there would be no reasonable danger of the public being so deceived. The case was argued on behalf of the respondent, as if he had an absolute right to have any trade mark registered which was not proved to fall within the terms of either the 72nd or 78rd section of the Act. I do not so read the statute. Those sections prohibit the registration of a trade mark in certain specified cases; but there is no duty cast upon the Comptroller of registering every other trade mark that may be applied for. On the contrary, whilst he is in certain cases prohibited from registering, a discretion whether to register or not appears to me to be in all cases fairly conferred." And Lord Macnaghten said of the marks: "They are calculated, and I think designed, to create a confusion in the minds of those persons to whom Mr. Dunn's advertisements are addressed, and to lead the ordinary run of such persons to suppose that his baking powder is in some way or other connected with Mr. Eno's preparation"; and he held, therefore, that the marks ought to be rejected, for the "Comptroller ought to reject words which involve a misleading allusion or suggestion of that which is not strictly true, as well as words which contain a gross and palpable falsehood."

Lord Watson, on the other hand, treated the case as one falling within the 78rd section. "These prohibitory clauses," he said, referring to secs. 73 and 72 (2), "cast upon the applicant the duty of satisfying the Comptroller, or the Court, that the trade mark which he proposes to register does not come within their scope. In an inquiry like the present, (the applicant) does not hold the same position which he would have occupied if he had been defending himself against an action for infringement. There, the onus of showing that his trade mark was

calculated to mislead rests, not on him, but upon the party alleging infringement; here, he is *in petitorio*, and must justify the registration of his trade mark by showing affirmatively that it is not calculated to deceive. It appears to me to be a necessary consequence that, *in dubio*, his application ought to be disallowed." And upon the question of fact he said: "There would be a supposed connection in the minds of many persons, who would naturally assume that the baking powder had been manufactured with the appellant's fruit salt, and purchase it in that belief; so that a batch of badly made baking powder might seriously injure the credit of the effervescing powder."¹

The following cases deserve special notice. In *Dewhurst's Application*² the words *The Golden Fan Brand* in Burmese characters were refused registration as an essential particular of a mark, there being on the Register for the same goods a fan which in use was coloured gold; and Kay, L.J., expressly based his judgment on sec. 73 of the Act of 1883, holding that the words would, in Burma, be calculated to deceive, in the event of the owner of the registered fan trading there. In *Eastman Photographic Materials Co. v. John Griffith's Cycle Corporation*,³ the last-named company had registered *Kodak* as a trade mark for cycles, and the plaintiffs, who moved to remove the mark from the Register, had identified that name with themselves and their goods, and in particular with bicycle cameras, and the name was comprised in several of their trade marks, but none of them was registered in class 22, which includes bicycles. Romer, J., held that the defendants intended, by the use of the name, to cause the public to think that they were connected with the plaintiff company, or that their goods were those of the plaintiff company, and, following *Eno v. Dunn*, he ordered the mark to be removed, as, when registered, being likely to deceive. It is not clear, however, whether the decision was one on sec. 73 or on the general discretion of the Comptroller to refuse a deceptive mark apart from any particular section of the Act.

In a recent case the proprietors of a trade mark consisting of the word *Motorine*, and registered for lubricating oils, opposed an application for registration of the word *Motricine* as a trade mark for petrol spirit, and the opposition was partly based on

¹ See above, p. 70, "the Registrar's discretion." See supra, p. 234.

² 15 R. P. C. 105 (1898), Romer, J.

³ [1898] 2 Ch. 137; 13 R. P. C. 288.

sec. 11, and the danger to the public by explosion, in case the petrol spirit were by reason of similarity of the name taken for the lubricating oil, was relied on. Warrington, J., decided that there was a possibility of confusion, and that serious consequences might ensue to the public, and he upheld the decision of the Registrar, who had refused registration.¹

Mark containing name of the opponent's goods not necessarily deceptive.

The Smokeless Powder Co. case.

A mark is not calculated to deceive merely because it contains an ordinary description of an article of commerce which is occasionally used to describe a rival trader's goods.² To hold otherwise would certainly be, as Fry, L.J., said in *The Fruit Salt* case, to allow the objector "to enclose and appropriate as private property certain little strips of the great open common of the English language."³ Thus, where *The Smokeless Powder Co., Ltd.*, had registered a label bearing a target, with their name printed prominently upon it, supported on one side by the figure of a sportsman and on the other by that of a rifleman, an unsuccessful attempt was made by a rival powder-making company to have the mark removed from the Register, or to have a disclaimer of the words *Smokeless Powder* added to the registration. The application failed as to the disclaimer, because the words were not distinctive, and also because they were not additions within the meaning of sec. 74, and were part of the name of the proprietors of the mark. It was argued that the presence of the words in the label was in effect a claim of a monopoly of the words, although the manager of the respondent company stated that the company made no such claim; but Chitty, J., decided against the objection,⁴ and held that the use of the words in the mark was not calculated to deceive.⁵ No such identification of the words in question with the applicant's goods was proved in this case, as was shown in *The Fruit Salt* case of the words *Fruit Salt* with Eno's powder, and in *The*

¹ *Compagnie Industrielle des Petrol's Application*, [1907] 2 Ch. 435; 24 R. P. C. 585.

² See *Dexter's Application*, [1893] 2 Ch. 282; 10 R. P. C. 269, Wright, J. (*Star Tobacco*), above, p. 255.

³ 41 C. D. at p. 455.

⁴ See Chap. VIII., at p. 192, "Label." Cf. *Application of Albert Baker & Co. (1898) Ltd.*, [1908] 2 Ch. 86; 25 R. P. C. 513, Eve, J.

⁵ So also in *Faulder's Tm.*, 18 R. P. C.

37 (1901), Kekewich, J., held that "Silverpan" in a mark registered for jam was descriptive and not calculated to deceive. On appeal, however, it was held that the word was distinctive and ought to have been disclaimed under sec. 74 of the Act of 1883, [1902] 1 Ch. 125; 18 R. P. C. 535. The registered proprietors stated that they did not claim any exclusive use by reason of their registration.

Stone Ales case¹ of the words *Stone Ales* with Joule & Sons' beer; but, apart from this, the case seems readily distinguishable, on the ground already mentioned, that the words concerned were the ordinary words which anyone would choose to describe the goods both of the applicants and the respondents, and words which, apart from the Acts, could never have become, for such goods, the subject of exclusive rights.²

And as the presence of a common word in a label does not make the label deceptive, although the word is used of the opponent's goods,³ so neither does the presence of a device which suggests such a word. Thus, in *Kutnow's* case,⁴ a label which included a picture of the Deer-leap rock at Carlsbad—a well-known and remarkable object in the environs of the town—was allowed to be registered for use with Carlsbad Salts, the name of the salts being common property, and applicable both to the natural product of the springs at Carlsbad and to artificial imitations of it. The opponents in the case were the Municipality of Carlsbad—who own both the springs and the rock in question—and their lessees of the springs. They sought to show that the use of the picture by the applicant would be calculated to lead purchasers to believe that the goods upon which it appeared were their goods; but the judge held that it would only suggest that the goods were Carlsbad Salts. And this would be true if, as he was bound to anticipate, the applicant used his mark honestly. The opponents had no monopoly in Carlsbad Salts.

Device suggesting the name of the opponent's goods.

In *The Apollinaris* case, Fry, L.J., in delivering the judgment of the Court of Appeal, expressed an opinion that a label which bears the word "trade mark" so printed upon it as apparently to refer only to a device which forms part of the label, the whole label being, in fact, the trade mark, is calculated to deceive,⁵ notwithstanding that the objection might have been, but was not, taken in the earlier case of *Hudson's Trade Marks*,⁶ where the Court of Appeal decided in favour of the mark propounded; and in *Re Wills' Trade Marks*, Wright, J., subsequently ordered a mark to be removed from the Register on this ground.⁷ This

Trade mark attached to part of the mark only may be deceptive.

¹ [1891] A. C. 218; 8 R. P. C. 361.

² Chap. II., at pp. 35 *et seq.* See also sec. 44.

³ See above, p. 252.

⁴ 10 R. P. C. 401 (1893), North, J. Cf. also *Hubbuck v. Brown*, 17 R. P. C. 148 and 638.

⁵ [1891] 2 Ch. at p. 233; 4 R. P. C. 478.

⁶ 32 C. D. 311 (1886).

⁷ [1893] 2 Ch. 262; 10 R. P. C. 269. The order was made subject to an application to amend being made within a reasonable time, but no such application was made.

objection caused considerable uneasiness to proprietors of trade marks, and led to several applications to the Court, under sec. 92, for leave to amend registered marks, for the word *Trade Mark* is often printed upon labels and other trade marks; but it is to be observed that it is only objectionable where its presence apparently implies that part of the actual mark is the whole trade mark. In the mark to which Fry, L.J., was directly referring, the word was placed immediately under a red disc, which was the most prominent feature in the label. In *Hammond & Co. v. Malcolm, Brunker & Co.*,¹ Chitty, J., said: "It is a question of fact in every case where a man puts the term 'trade mark' on his device, or some part of it, whether he does or does not so place the words as to indicate to the public that he is claiming a particular part of the trade mark only." The question came again before the Court of Appeal in *Bass's Tms.*,² where the devices on which the words occurred were also separately registered, and the Court held the question to be one of fact, and decided that there was no deception. In *Colman's Trade Marks*,³ Kekewich, J., allowed "trade mark" to be struck out of a number of labels, on condition that the proprietors should state what were and what were not the essential particulars of the marks.⁴ But in a later case, Chitty, J., refused to allow a similar alteration to be made in an old mark on the ground that, in accordance with the decisions of the Court, an old mark ought to be registered and kept registered, in all essential particulars, as it was used before August 13th, 1875.⁵ In the earlier case, two of the marks allowed to be altered had, in fact, been old marks, but in that case the Comptroller had raised no objection on this ground, as he did in the later case.⁵ In *Re Wills' Trade Marks*,⁶ the mark was ordered to be expunged unless an application to amend was

Alterations
of marks to
remove trade
mark.

¹ 9 R. P. C. p. 307; and the observation of the same judge in *Gordon & Dilworth's Tm.*, 13 R. P. C. p. 634.

² [1902] 2 Ch. 579; 19 R. P. C. 529. Romer, L.J., intimated that he would probably not have come to the same conclusion of fact in the *Apollinaris* case as the Court of Appeal did.

³ [1891] 2 Ch. 402; 8 R. P. C. 209.

⁴ Cf. sec. 64 (2) of the Act of 1883, as amended. The condition would probably not now be required, as an applicant is not required to specify in his application

what the essential particulars of the mark are; and see Chap. IX., at pp. 212 and 213.

⁵ *Phillips' Tm.*, [1891] 3 Ch. 139; 8 R. P. C. 469; and see *Henry Clay & Co.'s Tm.*, [1892] 3 Ch. 549; 9 R. P. C. 449, Kekewich, J. Cf. sec. 34 of the Act of 1905.

⁶ *Supra*, p. 271, note (7). The mark was a new one registered under the Act of 1883, as also was the mark referred to in the case next cited.

made within a reasonable time, but in *Day v. Riley and Whittaker*,¹ Buckley, J., refused to give such an opportunity. Section 25 of the Act of 1905 expressly permits separate registration of part of a registered trade mark, but the part so registered must itself possess all the qualifications of a good trade mark, and it must be registered as associated with the trade mark of which it forms part.²

Fry, L.J., also suggested, in *The Apollinaris* case,³ that the indorsement, "imitations of this water will be prosecuted," upon a label registered for use in connection with a natural mineral water, *Hunyadi Janos*, caused the mark to be calculated to deceive, because it probably meant all imitations of the water, whether fraudulent or not, and was therefore addressed to artificial *Hunyadi Janos* waters which might have been legitimately made and legitimately sold under the name, provided that it was made clear that they were artificial waters.³ It may be noted that the Registrar may refuse to register the words "patent," "patented," "by Royal Letters Patent," "registered," "registered design," "copyright," "entered at Stationers' Hall," or "to counterfeit this is a forgery."⁴

Threats of prosecution in the mark may be deceptive.

The Registrar refuses patent, registered, copyright, &c.

And when there appears on a trade mark the name or a description of any goods the Registrar may refuse to register the mark in respect of any goods other than the goods so named or described.⁵

Mark referring to particular goods.

The questions Who can register a trade mark?⁶ and What is the implication of a trade mark with regard to the origin of the goods?⁷ are dealt with elsewhere. It has been held that a mark comprising the consignees' names, and a representation of their house, which is used by the consignor, is calculated to deceive.⁸

Deceptive representation as to origin of goods.

The case of *Hill's Trade Mark*⁹ furnishes a good illustration of a deceptive mark. The mark consisted of a fir tree, with the

¹ 17 R. P. C. 520 (1900).

² See above, p. 109, and Appendix, p. 609.

³ Above, p. 271; [1891] 2 Ch. p. 226.

⁴ Rule 11, below, p. 657. See also *Mcikle's Tms.*, 46 L. J. Ch. 17 (1876), Hall, V.-C. In *Wright, Crossley & Co. v. Dobbin*, 15 R. P. C. 21 (1898). and *MacSymons' Stores, Ltd. v. Shuttleworth*, 15 R. P. C. 748 (1898), it has been held both in Ireland and England that

"registered" in a mark means registered in the United Kingdom.

⁵ Rule 16. By the same rule registration with a variation of a name or description may be permitted

⁶ Chap. IV., at p. 67.

⁷ Chap. II., at pp. 53 *et seq.*; see also Chap. XV., p. 383, "Joint trade marks."

⁸ *Jones' Tm.*, 53 L. T. 1 (1885), C. A.

⁹ 10 R. P. C. 113 (1893), Chitty, J.

words *Forrest* above and *London* below it in large letters, and it was registered and used by a Coventry watch-maker, who had no connection with the business formerly carried on by Forrest in London. He alleged, in answer to an application to remove the mark, that the words in question were commonly used by the trade in Coventry, although, in a correspondence with the applicant, he had previously claimed an exclusive right to them. The judge held that the mark was calculated and intended to deceive.¹

On the other hand, a suggestion that "Mazawattee" was deceptive, as leading people to suppose from the character of the name that the tea came from a particular estate, did not prevail.²

A mark which has been used fraudulently, or for the purposes of a fraudulent trade, if offered for registration, is open to the objection that its further use will tend to continue the old deceptions, and it is therefore a deceptive mark, and registration of it should be refused.³ Thus the use of the words "Registered Trade Mark" before registration would be a ground for refusal to register, except where, as in the cases cited below,⁴ a *boni fide* mistake was proved to have been made or an adequate explanation given.

"Or otherwise."

The words "or otherwise" in the section, having regard to the last part of it, seem to be merely redundant.⁵ They were, however, under the Act of 1875, held to be sufficient to exclude the registration, as part of a trade mark, of words which are merely descriptive of the article upon which the mark is to be used, whether they are merely descriptive from their nature, or whether they have become descriptive by the course of the trade and in the market.⁶ But the decision in the case referred to rested upon the opinion of the learned judge that, if he allowed

¹ Its use was unquestionably an offence under the M. M. A. 1887; see Appendix, p. 805. It appears from the report of *Thorneloe v. Hill*, 11 R. P. C. 61 (1894), that the Comptroller afterwards refused to register the tree alone on account of its having been part of a fraudulent mark.

² *Densham's Tm.*, [1895] 2 Ch. 176; 12 R. P. C. 75 and 271; and above, p. 172.

³ *Fuente's Tm.*, [1891] 2 Ch. 166; 8 R. P. C. 214, Romer, J.; see further, as to trade marks vitiated by misrepresentation, Chap. XV., at pp. 426 *et seq.*

⁴ *Altman's Application*, 21 R. P. C. 753 (1904), Kekewich, J.; *Lyle and Kinahan's Application*, 24 R. P. C. 37 and 249 (1907), Kekewich, J., and C. A.; in this case the representation as to registration had appeared for a short time only in a price list.

⁵ Sec. 11 includes provisions formerly contained in a separate section, namely, sec. 86 of the Act of 1883.

⁶ *Anderson's Tm.*, 26 C. D. at p. 415 (1884), Chitty, J. (*Brand Baron Liebig*).

the words in question to be registered as part of the applicant's mark, he would be giving him a monopoly in the words to which he was not entitled. In the Act of 1883 the word "disentitled" was substituted for the expression "not entitled," and in a later case¹ the decision just referred to was distinguished on the ground of the different wording of sec. 73 of the Act of 1883, and it was held that, although the word "Silverpan" was descriptive when used for jam, it was not thereby "disentitled" to protection within the meaning of this section.

"Disentitled."

¹ *Faulder's Tm.*, 18 R. P. C. 37 (1901), Kekewich, J. On appeal the Court did not decide this point, the word in question being held to be *prima facie* distinctive,

[1902] 1 Ch. 125 ; 18 R. P. C. 535. See also *Smokeless Powder Co.'s Tm.*, [1892] 1 Ch. 590 ; 9 R. P. C. 109.

CHAPTER XI.

RECTIFICATION OF THE REGISTER.

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PROVISION is made for the rectification of the Register by four sections of the Act. Sec. 35 provides for cases where any person is aggrieved by the omission from, or by the entry upon, the Register of any particulars without sufficient cause, and enables the Court to direct the necessary rectification to be made; sec. 32 authorises the Registrar at the request of the proprietor to correct clerical errors in the registration, to enter any change in the name or address of the proprietor, to cancel the entry of a

trade mark on the Register, to strike out goods from those for which a mark is registered, and to enter on the Register certain disclaimers or memorandums; sec. 33 provides for the registration of the name and address of the new proprietor on assignment, transmission, or other operation of law;¹ and sec. 34 enables the Registrar to permit an addition to, or alteration of, a registered mark to be made in any manner not substantially affecting its identity. The Act also directs that after fourteen years from its registration a mark shall be removed from the Register unless the prescribed fee be paid. This provision is considered in another chapter.²

1. Rectification under Sec. 35.

Section 35.

Rectification
of register.

Sec. 35³ is in the following terms:—

Subject to the provisions of this Act—

“(1) The Court may on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the Register of any entry, or by any entry made in the Register without sufficient cause, or by any entry wrongly remaining on the Register, or by any error or defect in any entry in the Register, make such order for making, expunging, or varying such entry, as it may think fit:

(2) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of the Register:

(3) In case of fraud in the registration or transmission of a registered trade mark, the Registrar may himself apply to the Court under the provisions of this section:

(4) An order of the Court rectifying the Register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner, who shall upon receipt of such notice rectify the Register accordingly.”

This section corresponds to sec. 90 of the Act of 1883, which underwent a slight amendment by the Act of 1888.⁴ The terms of the new section are wider and more general than those of the repealed one; in particular its provisions are expressly applicable to an entry wrongly remaining on the Register, as in the

¹ See Chap. XIII., at p. 357.

² Sec. 30; see Chap. XIV., p. 362.

³ Cf. Companies Act, 1862, s. 35, and the Copyright Act, 1842 (5 & 6 Vict. c. 45), s. 14.

⁴ Sec. 23. For the section as amended, see Appendix, below, p. 638. The corresponding section of the Act of 1875 was sec. 5, Appendix, below, p. 616.

case of a trade mark removable for non-user under sec. 37. It was, however, held, under sec. 90 of the Act of 1883, that a trade mark wrongly on the Register could be removed.¹ The general power of rectifying errors and defects is new. Sub-sec.(3), giving the Registrar power in certain cases to apply for an order for rectification, is also new.

The Court had under sec. 90 of the Act of 1883 power to award damages to the party aggrieved, but it was never exercised.² In addition to this, other provisions contained in that section have been dropped, namely, those as to directing issues and as to costs; these are covered by the general powers of the Court.³

Certain new provisions introduced by the Act of 1905 materially affect the practical working of sec. 35. First, by sec. 36, no trade mark which was upon the Register at the commencement of the Act, and which under this Act is a registrable trade mark, is to be removed from the Register on the ground that it was not registrable under the Acts in force at the date of its registration. This provision, and the decisions on it, have been considered in the chapter on what may be registered.⁴

Secondly, the power of the Court to require a disclaimer is now expressly extended to a case in which the Court is deciding whether a trade mark shall remain on the Register;⁵ that is to say, on an application under sec. 35 to remove the trade mark.

Thirdly, by sec. 41, in applications under sec. 35, the original registration of a registered trade mark is, subject to certain exceptions mentioned in sec. 41, after the expiration of seven years from the date of such original registration (or seven years from the passing of the Act,⁶ whichever shall last happen), to be taken to be valid in all respects.⁷

Who are persons aggrieved.

The application to rectify the Register must be made by a person who is aggrieved by the entry, if it is made without sufficient cause, or by the omission, error or defect complained of.

All persons substantially inconvenienced if the registration is wrong.

¹ *Batt's Trms.*, [1898] 2 Ch. 432; [1899] A. C. 428 (*sub nom. Batt v. Dunnett*, 15 R. P. C. 262, 534; 16 R. P. C. 411).

² See, for instance, *Reid v. Thomson & Co.*, 22 R. P. C. 376 (1905), Scotland.

³ As to issues, see Orders XXXIII. and XXXVI.; and as to costs, see Judicature Act, 1890, s. 5, and Order

LXV., r. 1.

⁴ Chap. VIII., above, p. 127.

⁵ Sec. 15. See Chap. IX., Disclaimers, above, p. 212.

⁶ August 11th, 1905. The commencement of the Act was April 1st, 1906.

⁷ See Chap. XII., Effect of Registration, below, p. 321.

The phrase in the section has been very liberally construed, and except, perhaps, in the case of a mark consisting of a name,¹ it would be difficult to find any person engaged in the trade concerned, or any allied or connected trade, who is prevented by the qualification which it requires from moving to rectify the Register. The persons who are aggrieved are, it is held, all persons who are in some way or other substantially interested in having the mark removed—where it is a question of removal—from the Register, or persons who would be substantially damaged if the mark remained. It is very difficult to frame a nearer definition than that.²

The Apollinaris case.

The question is one of *locus standi* only.

One of the leading cases on the subject is that of *The Apollinaris Co.'s Trade Marks*. In that case, Fry, L.J., in delivering the judgment of the Court of Appeal, said: "We approach this question (Are the applicants persons aggrieved?) on the assumption, which is necessary, of course, to answer this question, that the trade mark was wrongly on the Register; and, further, with these two observations: in the first place, that the question is merely one of *locus standi*;³ and in the second, that the words 'person aggrieved' appear to us to have been introduced into the statute to prevent the action of common informers, or of persons interfering from merely sentimental motives;⁴ but that they must not be so read as to make evidence of great and serious damage a condition precedent to a right to apply. Further, we are of opinion that, wherever one trader, by means of his wrongly registered trade mark, narrows the area of business open to his rivals, and thereby either immediately excludes, or with reasonable probability will in the future exclude, a rival from a portion of that trade into which he desires to enter, that rival is an 'aggrieved person.'"⁵ And in the same case the Court of Appeal held, that the fact that the applicants for registration of certain new marks had attempted to support their

¹ See *Wright, Crossley & Co.'s Tm.*, 15 R. P. C. 131 and 377 (1898), cited below, p. 282.

² Per Bowen, L.J., in *Powell's Tm.*, [1893] 2 Ch. 388; 10 R. P. C. 195.

³ In *Crompton's Tm.*, [1902] 1 Ch. 758; 19 R. P. C. 265, Swinfen Eady, J., held that a person who sought to remove a trade mark on the ground (*inter alia*) that the registration added nothing to a prior registration by the same proprietor

was, if this were so, not a person aggrieved, but possibly he only intended to decide that such an objection was purely one for the Comptroller, and could not be taken after registration.

⁴ See Ld. Selborne's judgment, in *Rivière's Tm.*, 26 C. D. at p. 54 (1884), and the judgments of Lindley and Fry, L.JJ., on the subsequent hearing of the same case, 55 L. J. Ch. 545.

⁵ [1891] 2 Ch. p. 224; 8 R. P. C. 137.

application by reference to other marks already registered by them, notwithstanding that they subsequently abandoned the attempt, made the opponents to the registration of the former marks persons aggrieved by the registration of the marks already registered, and therefore persons entitled to apply for the removal of them from the Register.¹ They further held that an alleged infringer of a mark is always a person aggrieved by its registration.² "The practical conclusion of this view," said Fry, L.J., "is, we think, a sound one. It will stop the practice, of which we have seen instances in this case, of a trader registering his mark without justification, using it as a means to intimidate or coerce other traders, and then, at the bar, alleging that the threat was idle, and the persons against whom it was used are not aggrieved thereby."³

Any person
intimidated
or harassed
by the regis-
tration.

The words in question have received their most liberal interpretation in the subsequent case of *Powell's Trade Mark*.⁴ In that case the applicants were being sued to restrain them from passing off a sauce called *London Relish* as the goods of the registered proprietor of a mark consisting of the words *Yorkshire Relish* by means of a label said to resemble one of his trade labels. They moved to expunge the mark *Yorkshire Relish*, and they were held to be "persons aggrieved" notwithstanding that they did not trade in Yorkshire Relish Sauce, and had not even considered the question of trading in it, and that the Court thought it probable that they could not trade in it under the same name without wrongfully causing their goods to be taken for those of the respondent, the registered proprietor of the mark. Lord Herschell, in giving judgment, said that although the words were no doubt inserted to prevent officious interference by those who had no interest at all in the Register being correct, and to exclude a mere common informer, it was undoubtedly of public interest that they should not be unduly limited; and he also said: "Wherever it can be shown, as here, that the applicant is in the same trade as the person who has registered the trade mark, and wherever the trade mark, if remaining on the Register, would or might limit the legal rights of the applicant, so that by reason of the existence of the entry on the Register he could not

Powell's case.

¹ [1891] 2 Ch. p. 228; 8 R. P. C. 137.

² See also *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1891), North, J.

³ [1891] 2 Ch. p. 229.

⁴ [1893] 2 Ch. 388; [1894] A. C. 8; 10 R. P. C. 195; 11 R. P. C. 4, Chitty, J., C. A., and H. L.; followed in *Talbot's Tm.*, 11 R. P. C. 77 (1894), Stirling, J.

lawfully do that which but for the existence of the mark upon the Register he could lawfully do, it appears to me he has a *locus standi* to be heard as a person aggrieved." Lord Watson, in his judgment, said that the fact that a trader deals in the same class of goods, and could use the mark, was, *prima facie*, sufficient evidence of his being aggrieved, which could only be displaced by the person who registered the mark, upon whom the onus lay, showing that there was no reasonable probability that the objector would have used it, although he were free to do so.

But the grievance of the applicant must be substantial, and a fanciful suggestion of grievance is insufficient. Thus, in *Wright, Crossley & Co.'s Trade Mark*,¹ a firm had registered their firm-name of "Wright, Crossley & Co." as an old trade mark, and a company, called the Royal Baking Powder Company, trading in the same trade, applied to remove it. There had been considerable litigation between the applicants and the registered owners as to the words "Royal Baking Powder," and it was suggested that the applicants had an interest as the mark was being used by the owners in connection with those words, and that there was a possibility of a wrongful user of the words "Trade Mark." It was also suggested that the applicants might at some time acquire the right to trade under the name Wright, Crossley & Co., or part of it. But Romer, J., and the Court of Appeal came to the conclusion that the suggestions of possible injuries to the applicants were fanciful, and that the applicants were not persons aggrieved. Rigby, L.J., pointed out that the judgments in the House of Lords in the *Yorkshire Relish* case did not support the contention that the mere fact that a man was in the same trade was sufficient to make him a person aggrieved. It is not necessary, however, for an applicant to show that he is interested in the sense of deriving any profit from his trade;² and it is sufficient to constitute trading if he is trading by his agents.³ A merely sentimental grievance does not make a person "aggrieved" within the meaning of the section.³

Defendant in
a passing-off
action.

A defendant charged in an action with passing off his goods as those of the plaintiff⁴ is aggrieved by the registration of a trade mark referred to in the plaintiff's pleadings, although no case of

¹ 15 R. P. C. 131, 377 (1898), Romer, J., and C. A.

² *Harness' Tm.*, 17 R. P. C. 40 (1900), Farwell, J.

³ *Ellis & Co.'s Tm.*, 21 R. P. C. 617

(1904), Farwell, J. (*Quaker, for spirits*). In this case it was held that the Society of Friends were not persons aggrieved by the registration.

⁴ See Chap. XVI, p. 477.

infringement is set up;¹ and so also is a trader who wishes or may wish to use the registered mark, not as a trade mark, but as a description of his goods.² And it is not necessary that the applicant should actually trade in the goods for which the mark is registered: it is sufficient if there is such a close connection between the business in those goods and the applicant's business that there is a probability that he may wish to extend his business to the other goods.³ And the applicant does not cease to be a person aggrieved because the registered proprietor offers to register a disclaimer, or to confine the use of the mark to particular goods in such manner that if the disclaimer or limitation were actually registered the applicant's grievance would be removed;⁴ for, as was pointed out by Fry, L.J., in the passage quoted above, the grievance is only necessary to give a *locus standi*, and it exists if at the time when the application is launched the registration is such as to occasion it.

Offer of a disclaimer is no answer to an application to rectify.

A person who has before registration used the registered trade mark is a person aggrieved.⁵

Person who has actually used the trade mark.

The exporter of goods made abroad, which are brought to England and then shipped to the Colonies, is a person aggrieved by the registration of a mark having such a resemblance to the mark which he has registered, and which he uses in his trade, as is calculated to deceive, although the mark objected to is employed in a trade confined wholly or almost wholly to England, and not extending to the Colonies.⁶ So also a person who had made the goods in this country and exported them marked with the registered word from a date prior to its registration was held to be clearly a person aggrieved.⁷

Exporter aggrieved by mark for home trade.

And a foreigner may be a "person aggrieved" by the registration of a mark. This was decided by the Court of Appeal, over-

Foreigner.

¹ *Gianuelis' Tm.*, 6 R. P. C. 467; 58 L. J. Ch. 782 (1889), North, J.

² *Rolph's Tm.*, 25 C. D. 194 (1883), Pearson, J. (*Homewasher*); *Rose v. Eans*, 48 L. J. Ch. 618 (1879), Hall, V.-C. (*Limetta*); *Porrell's Tm.*, supra, p. 281; *Talbot's Tm.*, 11 R. P. C. 77; 63 L. J. Ch. 264 (1894), Stirling, J. (*Emolliolorum*).

³ *Eastman, ac. Co., Ltd. v. John Griffiths Cycle Corporation, Ltd.*, 15 R. P. C. 105 (1898), Romer, J. There was no express finding, however, as to the applicants being persons aggrieved;

but it was held that they could have successfully opposed the registration.

⁴ *Bull's Tm.*, 6 R. P. C. 493 (1889), Chitty, J.; *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1891), North, J.

⁵ *Zonophone Tm.*, 20 R. P. C. 450 (1903), Byrne, J.

⁶ *Société Anonyme des Verreries de l'Etoile*, [1894] 1 Ch. 61; [1894] 2 Ch. 26; 10 R. P. C. 436; 11 R. P. C. 142, Stirling, J., and C. A.

⁷ *Newstyle Manufacturing Co.'s Tm.*, 20 R. P. C. 803 (1903), C. A.

ruling the judgment of Pearson, J., in *Rivière's* case,¹ where the applicants, who carried on business in India, but did not trade or intend to trade in England, alleged that, on their request to register the mark in question for them, the registered proprietors had wrongfully registered it in their own names; and the Court, in holding that the applicants might be aggrieved, assumed, but did not decide,² that, as foreign traders, the applicants could not themselves have registered the mark.

Wider view
now taken
than in the
earlier cases.

On the further hearing of the case just cited,³ it was shown that the registered mark was an old mark belonging to the respondents, Rivière & Co., but that they had for many years allowed it to be used upon labels bearing the name of the applicants, McDowell & Co., for brandy manufactured by Rivière & Co., and shipped by them to McDowell & Co. for sale in India. The labels were used by McDowell & Co. upon brandy not made by or purchased from Rivière & Co., after the rupture of business relations between the parties, and Rivière & Co. had commenced proceedings in India for infringement in respect of this user. Under these circumstances, Pearson, J., and the Court of Appeal held that the applicants were not in fact aggrieved by the registration, but that it was rightly made, and they refused to annul it. Lindley, L.J., said: "Aggrieved in the sense of being annoyed (McDowell & Co.) certainly were, and, I think, not without cause; but aggrieved in the sense in which it is necessary they should be aggrieved—in the sense of sustaining legal damage either immediate or prospective—they have not shown that they were"; and Fry, L.J., said it was possible that they might be injured, but there was no reason to suppose that they would be, and therefore they were not within the section.⁴ In subsequent cases the section, and the phrase "person aggrieved," has been more stringently construed against the registered proprietor; and although there is no conflict between this decision⁵ and the decisions cited above, it is plain that in them a view

¹ 28 C. D. 48 (1884), decided on the Act of 1875. Also *European Blair Camera Co.'s Tm.*, 13 R. P. C. 600; 75 L. T. 63 (1896), Stirling, J., where the applicants' predecessor had used the mark in England.

² It is clear that the later Acts contemplate registrations by foreign traders; see secs. 103 and 104 of the Act of 1883,

and sec. 8 of the Act of 1888. These sections were not repealed by the Act of 1905, but are now replaced by sec. 91 of the Patents and Designs Act, 1907.

³ 55 L. J. Ch. 545; 53 L. T. 237 (1885).

⁴ *I.e.*, sec. 5 of the Act of 1875.

⁵ Because the Court held that the mark was properly registered.

was taken of the section different from that acted upon in it.

In one case it was suggested that, although the applicant was not a person aggrieved, the Court would, in the interests of the public, rectify the Register if the mark was bad;¹ but, even if the Court would, under any circumstances, take such a course in the absence of a person aggrieved,² it would only do so in the case of a registration which was on the face of it illegal or improper.³

Purity of
the register.

Under the Act of 1883 a refusal by the Comptroller to cause the name of a person who had become entitled by assignment, transmission, or other operation of law to a registered trade mark to be entered as proprietor of the trade mark in the Register under sec. 87 would have constituted such person a "person aggrieved" and given the Court jurisdiction under sec. 90 to order the entry to be made,⁴ but if a person applied to the Comptroller for an alteration in a case for which the Acts did not provide, and it was refused, he was not a "person aggrieved."⁵ Under the Act of 1905 both these matters are provided for by special sections with special rights of appeal,⁶ and recourse should not be had to sec. 35.

Applications
as to matters
otherwise
dealt with in
the Act.

In an application by the Registrar under sub-sec. (3) he would, of course, be in the position of a person aggrieved.

The Exercise of the Jurisdiction under the Section.

The question of the grievance of the applicant being merely one of *locus standi*, if on the face of the proceedings the applicant is enabled, as a person aggrieved, to bring his application before the Court, the Court has jurisdiction to rectify the Register, which, in the case of a mark not belonging to the class of marks admitted to registration under the Acts,⁶ it ought to exercise, even under circumstances in which the applicant is precluded from exercising the right with which the registration interferes. Thus, in *The Stone Ales* case,⁷ the Court of Appeal removed the

Where the
mark was
incapable of
registration
it must be
removed.

¹ *Wright, Crossley & Co.'s Tm.*, infra, note (3).

² See the judgment of Bowen, L.J., in *Paine & Co. v. Daniells & Sons' Breweries*, quoted infra, p. 287. In that case, however, the defendants, being sued, were clearly persons aggrieved.

³ *Wright, Crossley & Co.'s Tm.*, 15 R. P. C. 131, 377 (1898), especially the judgment of Romer, J.

⁴ *New Ormonde Cycle Co.'s Tm.*, [1896] 2 Ch. 520; 13 R. P. C. 475, North, J. See also *Patent Plumbago Crucible Co.'s Tms.*, 7 R. P. C. 282 (1890), Stirling, J.

⁵ Secs. 33 and 34.

⁶ See Chap. VIII., p. 127. See also sec. 36, below, p. 291.

⁷ *Thompson v. Montgomery*, 41 C. D. 35; 6 R. P. C. 404 (1889). There was no appeal to the H. L. against this

plaintiffs' mark, *Stone Ale*, from the Register on the application of the defendant, although they maintained the injunction granted by Chitty, J., restraining the defendant from selling goods not of the plaintiffs' manufacture under the name in question.

The conduct of the applicant is irrelevant.

And the demerits of applicant in any such case are irrelevant to the question whether rectification should be ordered or not, for the question is not between the applicant on the one hand and the respondent on the other, but between the public and the respondent. Where, therefore, a mark on the Register bearing the words *Forrest London* was shown to be deceptive, because it was used by a Coventry watch-maker who had no connection with the business of Forrest once carried on in London, Mr. Justice Chitty refused to enter upon an inquiry whether the conduct and the trade of the applicant were tainted with fraud, as the respondent alleged. "I state my opinion," he said, "that directly it is apparent that any part of the trade mark is calculated to deceive, it is the duty of the Court to order it to be removed."¹

So an agreement by which the respondents, the registered proprietors of a mark, appointed the applicants sole agents for the goods which they sold under the mark, and the applicants agreed to sell no goods but those of the respondents under the mark, was held to furnish no answer to an application to remove the mark from the Register, and Chitty, J., said: "This is not a question of equity; this is a question of right under the statute; and the defence, which I find really a difficulty in appreciating, appears to me to fail altogether. I am at a loss to discover how any such agreement as this can displace the applicants' right to have the Register of trade marks disencumbered of that which is not a trade mark at all."²

Where the mark was capable of registration but might have been opposed. *Paine v. Daniells*.

But in cases where the mark attacked belongs to the class of symbols which are capable of registration, the Court has a discretion, under the Acts, either to expunge or vary the registration or to refuse the application. This was decided by the Court of Appeal in the case of *Paine & Co. v. Daniells & Sons' Breweries*,³ where the matter was fully considered. In that case

order. The words had not been used as a trade mark before August 13th, 1875, and were not fancy words. See *Powell's Tm.*, [1893] 2 Ch. 388; 10 R. P. C. 63, 195; [1894] A. C. 8; 11 R. P. C. 4; Chitty, J., C. A. and H. L. (*Yorkshire Relish*), above, p. 281.

¹ *Hill's Tm.*, 10 R. P. C. 113 (1893); see also *Eno v. Dunn*, 15 App. Ca. 252; 7 R. P. C. 311 (1890).

² *Ainslie & Co.'s Tm.*, 4 R. P. C. 212 (1887).

³ [1893] 2 Ch. 567; 10 R. P. C. 71, 217. See also *Wright, Crossley & Co.'s*

the defendants, in an action for infringement and passing off, applied to remove the words *John Bull* and *John Bull Brand* from the plaintiffs' registered labels. It appeared that at the time of the registration of the labels certain third persons, unknown to the plaintiffs, were using *John Bull* as a trade description of their goods in a district, in and around Sheffield, to which the plaintiffs' trade did not extend, but such user had wholly ceased before the date of the application to rectify. And it was assumed by the Court that these persons might have successfully opposed the registrations had they known of them and thought fit to do so. In the view which the Court of Appeal took, the defendants had been guilty for years of deliberate infringement of the plaintiffs' trade mark. The Court refused to direct the marks to be removed, and the following passage from the judgment of Bowen, L.J., fully explains the grounds of their decision:—

“The purity of the Register of trade marks—if one may use the expression—is of much importance to trade in general, quite apart from the merits or demerits of particular litigants. If on a motion like the present the attention of the Court is called to the entry on the Register of a trade mark which cannot in law be justified as a trade mark, it seems to me that the Court's duty may well be, whatever are the demerits of the applicant, to purify the Register and to expunge the illegal entry in the interests of trade, as was done in *The Stone Ales* case.¹ As a rule, the Court, on being seised of the matter, would doubtless put an end to the existence of a trade mark which could not possibly be justified by law. But the matter is wholly different when the trade mark complained of is one which is not in itself illegal or improper, although at the date of registration its registration might have been, perhaps, successfully opposed by some third party who did not in fact oppose it. In such a case, the defect in the Register is not a defect of which the law is bound to take cognizance at the instance of every complainant. Consent by the *Sheffield* company would, in the present case, have removed all difficulty in the registration of the plaintiff's trade mark.² The defendants have no right, as it appears to me, to take the point that such consent

The Court has a discretion.

Tm., 15 R. P. C. 131, 377 (1898), Romer, J., and C. A.

40 (1900).

¹ *Supra*, p. 285. Any interest which the public may have in the matter is to be considered: *Harness' Tm.*, 17 R. P. C.

² The *Sheffield* company had not registered *John Bull* beer, and therefore the question of conflicting registered marks would not have arisen.

was not in fact shown to have been given by the *Sheffield* firm, in order to displace a trade mark which they have been meanwhile dishonestly infringing. I am of opinion that the Court is not bound under sec. 90 of the Act of 1883, on the application of an unmeritorious applicant, to displace an entry on the Register, which, on the face of it, is not illegal, because the original registration might have been opposed on the ground of prior user by a third person who never opposed it on any such ground, and who, at the time of the motion to rectify, has discontinued his user."

The construction of sec. 90 of the Act of 1883, here adopted, was certainly in accordance with the apparent meaning of the section, for its terms empowered the Court to make "such order . . . as the Court thinks fit," or to refuse the application. Similar words occur in the present section.

Independent title acquired by registration and user.

So, in a case where the registered proprietor of a mark had adopted and registered it in ignorance of the rights of the applicant, who previously possessed, but had temporarily ceased to use, a similar mark, and the proprietor had largely used his mark for two years, an application to remove it from the Register was refused. The applicant, however, was allowed to register his mark also.¹

There are, however, some reported cases which can hardly be reconciled with the view taken by the Court of Appeal in *The Stone Ales* case² by the distinction suggested in the judgments in *Paine v. Daniells*³ between marks which are good marks under the Acts upon the face of them, although the registration of them might for some extrinsic reason have been opposed, and marks which are bad in themselves.

Mark allowed to remain in pursuance of a compromise.

Thus, in a case where Chitty, J., had ordered a mark to be removed from the Register, on the ground that it did not comply with sec. 64 of the Act of 1883, the Court of Appeal expressed a strong opinion that the applicant (the defendant) had made a binding agreement with the registered proprietor (the plaintiff) not to use the mark, and, the applicant consenting, they set aside the order for removal.⁴ And, in an earlier case,⁵ Kekewich, J.,

¹ *Mouson & Co. v. Boehm*, 26 C. D. 398; 53 L. J. Ch. 932 (1884), Chitty, J. In *Verity's Tm.*, 19 R. P. C. 58 (1902), Buckley, J., refused to apply this case to a new mark. See now sec. 21, above, p. 264.

² See note (7), ante, p. 285.

³ See note (3), ante, p. 286.

⁴ *Hodgson v. Sinclair*, 9 R. P. C. 22 (1892).

⁵ *Harrison McGregor & Co.'s Tm.*, 42 C. D. 691; 7 R. P. C. 25 (1889) (*Albion*). The variation is not stated in the Law Reports.

allowed an order expunging a mark from the Register to be varied (subject to any objection being made by the Comptroller) with the consent of the applicant, although he held that, having been used to indicate a design, and not as a trade mark, it ought not to have been registered.

It was well established under the Act of 1883 that on an application to remove a trade mark from the Register the onus was on the applicant,¹ and by sec. 40 of the Act of 1905 registration is expressly made *prima facie* evidence in applications under sec. 35 of the validity of the original registration and of all subsequent assignments and transmissions.² Where a trade mark has been long registered, and the validity of the registration depends on the facts which existed at or prior to the date of registration,³ the Court will give the registered owner the benefit of any doubt.⁴ The onus may be shifted, however, in the course of the hearing.⁵

Onus is on the applicant.

The fact that the Registrar has exercised his discretion in favour of the registration of a mark, and has allowed it to be registered, does not prevent the Court from ordering its removal if the registration was made without sufficient cause;⁶ but an applicant for rectification is in a somewhat less advantageous position than an opponent to registration.⁷

The Registrar's decision is no bar to rectification.

Section 90 of the Act of 1883 was held not to be limited by sec. 76 of that Act, so that a mark registered without sufficient cause could be removed notwithstanding the fact that it had been five years upon the Register.⁸ Section 41 of the Act of 1905, which makes registration valid after a period of seven years from original registration or the passing of the Act, whichever shall last happen, is expressly extended to applications under sec. 35.⁹

Effect of sec. 41.

¹ *Leonard and Ellis' Tm.*, 26 C. D. 288 (1884), C. A.; *Benjamin Edgington, Ltd. v. John Edgington & Co.*, 6 R. P. C. 513 (1889); *Chesebrough Manufacturing Co.'s Tm.*, [1902] 2 Ch. 1; 19 R. P. C. 342, C. A.; *Boord & Son v. Thom and Cameron, Ltd.*, 24 R. P. C. 697 (1907) (Scotland).

² Below, p. 329.

³ *The Chesebrough* case, cited in note (1); also *Bass, Ratcliff and Gretton, Ltd.'s Tm.*, 19 R. P. C. 529, C. A. Romer, L.J., said that where there had been long uninterrupted user, and the mark had been long registered without attack, every reasonable intendment ought to be made by the Court in favour of the registration.

⁴ *Burroughs, Wellcome & Co.'s Tms.*, [1904] 1 Ch. 736; 21 R. P. C. 217, C. A.

⁵ *Edgington v. Edgington*, note (1), and *Dewar & Sons, Ltd. v. Dewar*, 17 R. P. C. 341 (Scotland).

⁶ Sec. 54; and see *Arbenz's Application*, 35 C. D. p. 260; 4 R. P. C. 143 (1887), C. A. (*Gem*).

⁷ See *Société, &c. de l'Étoile's Tm.*, p. 290, note (1), and cases on delay.

⁸ *Lloyd & Sons Tm.*, 27 C. D. 646 (1884), Chitty, J.; *Edwards v. Dennis*, 30 C. D. 454 (1885), C. A.; *Verity's Tm.*, 19 R. P. C. 58 (1902), Buckley, J.

⁹ The section is treated of in Chap. XII., p. 321.

Delay in making the application to rectify is generally no bar,

but delay may have a bearing on the evidence.

The delay of the applicant in coming to the Court to ask for rectification of the Register is not of itself any bar to his application,¹ and marks have been removed or varied after being registered for long periods to the knowledge of the applicant,² and this may still be so under the Act of 1905, in cases not covered by sec. 41, for instance, cases of obtaining registration by fraud. But where the objection alleged to a mark is that it is the same as that of the applicant, or that it has such resemblance to his as to be calculated to deceive, it will be some evidence against the applicant, on whom the burden lies of showing that the registration was made without sufficient cause, if he has stood by and allowed the registered proprietor to use the mark objected to for a length of time, especially if no case of actual deception is proved.³ Where an opposition to an application to register on such a ground would have been successful two things are to be considered: first, what was the reason of the delay in the application to expunge; and, secondly, whether any substantial injury has been caused by the delay to the person who has registered.⁴ Thus, if the objection depends upon proof of a state of facts at a given time—for instance, upon the question whether an old mark was used before August 13th, 1875, in the form registered—after a long lapse of time, and especially if important witnesses have died, the Court will receive the evidence of the applicant upon the point with hesitation.⁵

Entry formerly to be vacated or rectified if originally wrongly made.

Prior to the Act of 1905, it was held that an entry made with-

¹ *Great Tower Street Tea Co. v. Smith*, 6 R. P. C. 165 (1889), North, J.; *Société, etc. de l'Étoile's Tm.*, [1894] 1 Ch. 61; 10 R. P. C. 436; [1894] 2 Ch. 26; 11 R. P. C. 142; *Talbot's Tm.* (1894), W. N. 12; 11 R. P. C. 77, Stirling, J.; *Bourne v. Swan and Edgar, Ltd.*, [1903] 1 Ch. 211; 20 R. P. C. 105, Farwell, J. But acquiescence may possibly be a bar in a case in which the ground of applying for rectification is that the applicant could have opposed the mark by reason of having rights in it. See *Neostyle Manufacturing Co.'s Tm.*, 20 R. P. C. 329, at p. 335 (1903), Kekewich, J. The case was reversed on appeal, 20 R. P. C. 803, being decided on other grounds.

² For instance in *The Apollinaris*

case, some of the marks removed had been registered for fourteen years; [1891] 2 Ch. 186; 8 R. P. C. 137, C. A. See also *Paine & Co. v. Daniells & Sons' Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 71, 217, C. A.

³ *Talbot's Tm.*, supra, note (1).

⁴ *Eastman Photographic Materials Co., Ltd. v. John Griffiths Cycle Corporation, Ltd.*, 15 R. P. C. 105, at p. 111 (1898), Romer, J. In *Société, etc. de l'Étoile's Tm.*, supra, three years' delay, which was explained by want of knowledge of the registration, was held by Stirling, J., and the Court of Appeal not to disentitle the applicant to relief.

⁵ *Benjamin Edgington, Ltd. v. John Edgington & Co.*, 6 R. P. C. 513; 61 L. T. 323 (1889), Kay, J.

out sufficient cause ought to be expunged, even though, so far as appeared at the hearing of the application to rectify, an application to re-register could be successfully made at once, for there ought to be fresh advertisements and a fresh opportunity for objectors to oppose the registration.¹ So, where a misstatement as to the length of time during which the mark had been used was made, not fraudulently but through carelessness, in the application for registration, North, J., directed the registration to be vacated.² And in *The Apollinaris* case, in dealing with the objection that the company, when only importers, had registered marks belonging to the producers of the goods as their own, Fry, L.J., said³: "On behalf of the Apollinaris Co. an argument was addressed to us to this effect, that as they had, in the year 1881, become the sole owners of the produce of the spring, they could now get these marks on the Register, and that we ought not to remove marks which, as soon as we have taken them off, can be put on again. But even assuming that the respondents are *prima facie* entitled now to be placed on the Register, as to which we say nothing, we are of opinion that the course suggested is rendered impossible by the statutory provision for advertisements. To allow a mark which ought not to have been on the Register to remain on by reason of some intervening event would be to preclude the public from challenging the new title of the applicant for registration." But the rule laid down did not compel the Court to order the removal of a mark if the registration of a note, partial removal, or other variation met the justice of the case.⁴

Judgment of Fry, L.J., in *The Apollinaris* case.

The policy of the Act of 1905 is different, and sec. 36 provides that a trade mark shall not be removed from the Register if it is a registrable trade mark under the Act, although it was not registrable under the Acts in force at the date of its registration.⁵ Moreover, the Court has now power to order a disclaimer,⁶ and may, under sec. 35, vary the entry. It may do this instead of

Act of 1905.

¹ In *Hayward's Tm.*, however, where the objection was that the application on which the mark was registered ought to have been treated as abandoned, Kay, J., allowed the mark to stand, with a note limiting the date from which the five years should run before the registered proprietor acquired an absolute title to the date of actual registration; 54 L. J. Ch. 1003 (1885).

² *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1891).

³ [1891] 2 Ch. p. 230; 8 R. P. C. p. 163.

⁴ See note (1) and the instances cited below, pp. 297 *et seq.*

⁵ The section has been considered above, p. 132.

⁶ Sec. 15, above, p. 212.

expunging the entry, on the application of the respondent in a suitable case.¹

Entry, originally rightly made, may be expunged or varied.

Under the Act of 1883 the Court of Appeal took the view that an order could be made under the section to remove from the Register a mark the presence of which on the Register was not legitimate, even although the original registration was proper. In *Batt's Trade Marks*, Lindley, M.R., delivering the judgment of the Court, and referring to the words "entry made without sufficient cause in any such Register," said: "We are not disposed to put a narrow construction on this expression, nor to read it as if the word 'made' were the all-important word, and as if the words 'made without sufficient cause' must be read as if they were 'made without sufficient cause at the time of registration,' so as to be confined to that precise time. If any entry is at any time on the Register without sufficient cause, however it got there, it ought, in our opinion, to be treated as covered by the words of the section."² As pointed out in the judgment referred to, in the view taken by the Court of the facts the decision of the point was not necessary to the decision of the case, and no order has been made, it is believed, for the removal of a mark originally rightly registered.³ The principle has, however, been recognised in sec. 35, for a person aggrieved by any entry wrongly remaining on the Register may apply to expunge it.

Removal for non-user, &c.

In *Batt's case*,⁴ already referred to, it was decided by the House of Lords, that a trade mark not registered by the proprietor with a *bonâ fide* intention of using it may be removed

¹ *Gestetner's Tm.*, [1907] 2 Ch. 478; 24 R. P. C. 545; [1908] 1 Ch. 513; 25 R. P. C. 156.

² [1898] 2 Ch. 432; 15 R. P. C. 534, Lindley, M.R., Chitty and Collins, L.JJ. The case was affirmed in the House of Lords, but no decision was given on this point.

³ In *Valentine Extract Co.'s Tm.*, 18 R. P. C. 175 (1901), Farwell, J., the trade mark *Valtine* was ordered to be removed from the Register, an injunction having been granted at the instance of the applicants against its use (Appendix, p. 738), but they could no doubt have successfully opposed the registration.

⁴ Decided in the House of Lords *sub*

nom. Batt v. Dunnell, [1899] A. C. 428; 16 R. P. C. 411. It has been followed in several cases in which the registration has been limited by striking out goods for which there was no intention to use the mark, *Hart's Tm.*, [1902] 2 Ch. 621; 19 R. P. C. 569; *Suter, &c. Composition Co.'s Tm.*, 19 R. P. C. 42; *Anglo-Swiss Condensed Milk Co.'s Tms.*, 20 R. P. C. 509; 21 R. P. C. 261 (1904). In *Louise v. Gainsborough*, 20 R. P. C. 61 (1903), Farwell, J., said that in order to remove a trade mark from the Register on the ground of non-user, there must be shown either want of *bonâ fide* intention to use at the date of registration and that it has not been used, or that it has been abandoned.

from the Register. With respect to this and non-user, sec. 37 of the Act of 1905 provides as follows:—

“ A registered trade mark may, on the application to the Court of any person aggrieved, be taken off the Register in respect of any of the goods for which it is registered, on the ground that it was registered by the proprietor or a predecessor in title without any *bonâ fide* intention to use the same in connection with such goods, and there has in fact been no *bonâ fide* user of the same in connection therewith, or on the ground that there has been no *bonâ fide* user of such trade mark in connection with such goods during the five years immediately preceding the application, unless in either case such non-user is shown to be due to special circumstances in the trade, and not to any intention not to use or to abandon such trade mark in respect of such goods.”

cc. 37.

The section creates special grounds of removal under sec. 35 of a trade mark from the Register, and, although the exercise of the jurisdiction is discretionary, the entry of a mark, which is liable to removal under this section, is one wrongly remaining on the Register. The application must be made by a person aggrieved.¹ The grounds of removal are alternatively either registration without any *bonâ fide* intention to use the mark in connection with the particular goods and no *bonâ fide* user in fact, or no *bonâ fide* user during the five years immediately preceding the application.² Where a trade mark has been registered for five years, the last ground will obviously be the one selected by an applicant for rectification. If it has been registered for less than five years, then the applicant must show in addition to non-user that it was registered without *bonâ fide* intention to use it in connection with the goods, and it is doubtful whether the want of such *bonâ fide* intention to use it would be inferred merely from non-user in fact. In *Batt's case*³ the want of such intention was inferred from non-user, but the trade marks had been registered for many years. Other circumstances might assist to show the absence of intention to use, for instance, the fact that the proprietor's business had never extended to the particular goods, for the section enables an application for rectification to be made in respect of any of the goods for which the mark is registered.

The proprietor may, although a *primâ facie* case is made

¹ Above, p. 279.

referring to non-user *after* registration.

² The Legislature is here evidently

³ Cited above, p. 292.

against him, show that the non-user is due to special circumstances in the trade¹ and not to any intention not to use or to abandon the mark in respect to the goods in question.²

Associated
trade marks.

Where a trade mark and a portion or portions of it are separately registered as associated trade marks, user of the whole trade mark is for the purposes of the Act to be deemed to be also a user of such registered trade marks as it contains.³ And it is also provided generally by sec. 27 that, where under the provisions of the Act user of a registered trade mark is required to be proved for any purpose, the tribunal may, if and so far as it shall think right, accept user of an associated registered trade mark,⁴ or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for such user.

Section 41, which makes registration for a period of seven years from the date of original registration or from the passing of the Act (whichever shall last happen) conclusive as to the validity of the original registration,⁵ subject to certain exceptions, contains no exception referring to sec. 37; but it would seem that it would not avail to save a trade mark from removal on the ground of non-user for five years immediately before the application to remove it, that being a matter subsequent to registration, and, as already pointed out, where the trade mark has been registered, but not used, for five years, it is not necessary under sec. 37 to show a want of intention to use it at the date of registration.

What Orders may be made under the Section.

The section empowers the Court to make "such order for making, expunging, or varying the entry," of the omission or registration of which complaint is made, as the Court thinks fit. The Court may therefore (1) direct an entry to be made on the Register; (2) order an entry already appearing thereon to be wholly removed; or (3) to be partially removed; or (4)

¹ "A man who has a trade mark may properly have regard to the state of the market and the demand for the goods; it would be absurd to suppose that he lost his trade mark by not putting more goods on the market when it was glutted." Per Chitty, J., in *Mouson v. Boehm*, 26 C. D. 393 (1884). Cf. *Daniel*

and *Arter v. Whitehouse*, [1898] 1 Ch. 685; 15 R. P. C. 134.

² Abandonment, p. 370.

³ Sec. 25.

⁴ Associated trade marks, see above, p. 107.

⁵ See below, p. 330.

to be modified by a disclaimer; or (5) by limiting it to particular goods; or (6) by limiting it to one or more specified colours; or (7) by the entry of conditions; or (8) to be varied as to its form; or (9) date; or (10) the name of its registered proprietor; or (11) by correcting any error or defect in the entry.

(1) The jurisdiction to order a new entry to be made seems to be specially referable to the preceding words of the section, "aggrieved by the non-insertion in or omission from the Register of any entry," but the Court is not empowered by the section to order to be entered upon the Register a mark which the Registrar has refused, for a special mode of appeal from the Registrar's decision to the Board of Trade or to the Court is provided by sec. 12, and, consequently, no other appeal is permitted.¹ And it cannot direct a new mark to be registered with regard to which the proper procedure by application and advertisement has not been resorted to.² So far as actual marks are concerned, the reference to entries to be made upon the Register must, therefore, notwithstanding the words quoted above, be taken to refer only to the variation of marks already registered by addition to them.

New entries.

New marks cannot be registered under the section.

(2) Orders for total removal of entries from the Register have been made in a great number of cases, and many examples have been given already in this and the two preceding chapters. The entry is to be expunged if made without sufficient cause, or if wrongly remaining on the Register. What is a sufficient cause for refusing an application to register is considered in Chapter IV.,³ and generally the same reasons will afford grounds for removing an entry inadvertently made. But the Court has a discretion to refuse to vacate the registration of a mark, independently adopted and extensively used by the proprietor, if it falls within the class of symbols which may be registered as trade marks, and the only objection is that it had been previously used or acquired as his

Total removal.

Reasons for removal.

¹ *The Normal Co.'s Tm.*, 35 C. D. 231; 4 R. P. C. 123 (1887), Chitty, J., and C. A., decided under the Act of 1883.

² *Riviere's Tm.*, 55 L. J. Ch. 545; 53 L. T. 237 (1885), C. A.; and as to transfers from one name to another, see below, p. 301, and cf. p. 291. In *Jackson v. Napper* there was an application for registration, and the summons was

not, as stated in 4 R. P. C. 45, an application to rectify under sec. 90, but an application to proceed under sec. 62. It seems to have been irregular in any case, as there was no appeal from the Comptroller to the Board of Trade, so far as the report shows: 35 C. D. 162 (1886), Stirling, J.

³ At page 71.

trade mark by another person.¹ The proprietor of a registered mark stands in a better position than an applicant for registration, since the Registrar's discretion² has been exercised in his favour, and the onus of showing that the registration was made without sufficient cause is cast upon the person applying to vary it.³

The reasons for removing a mark may be classified as follows: namely, that the registered proprietor is not the person entitled to use it;⁴ the mark was not capable of registration,⁵ or it fell within the restrictions forbidding registration contained in the Acts;⁶ the registration was procured by a material misstatement;⁷ or the person who registered had no *bona fide* intention to use the mark, and has not used it in fact⁸ or has not used it for five years immediately preceding the application.⁹

Alteration of circumstances subsequent to registration.

The Court of Appeal held, under the Act of 1883, that the words "made without sufficient cause" did not relate merely to the date of registration,⁹ and that there was jurisdiction to rectify although there had been no mistake or error in the original registration. This point does not arise under sec. 35 of the Act of 1905, because express power is given to the Court to remove an entry wrongly remaining on the Register. As already noticed, a trade mark can be removed for non-user, and it would seem that if a registered proprietor ceases to carry on business, or abandons all further intention to trade in the goods for which the mark is registered,¹⁰ or in any other way renders it improper that the mark should remain on the Register, it can be removed. It has been decided that no events subsequent to the date of

Abandonment or mis-user of mark.

¹ *Moulson v. Boehm*, 26 C. D. 398 (1884). Chitty, J.; *Paine & Co. v. Daniells & Sons' Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 217, above, p. 286. The Court can now allow the objector's trade mark to be registered under sec. 21, but a substantive application in the prescribed manner would no doubt be necessary.

² Chap. IV., at p. 70; but see above, p. 289.

³ Above, p. 289.

⁴ Chap. IV., at p. 67.

⁵ Chap. VIII., p. 127. This ground is subject to the provisions of sec. 36, see above, pp. 132 and 291.

⁶ Chap. X., p. 221.

⁷ *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1891), North, J.; *Gordon and*

Dilworth's Tm., 13 R. P. C. 629 (1896); *Eastman, &c. Co. v. John Griffiths Cycle Corporation, Ltd.*, 15 R. P. C. 105 (1898), cited p. 269.

⁸ Above, pp. 292 and 293.

⁹ *Bull's Tms.*, [1898] 2 Ch. 432; 15 R. P. C. 534; supra, p. 292; *Ward, Sturt, and Sharp's Tms.*, 50 L. J. Ch. 347 (1881). Hall, V.-C., was to the contrary effect. In *Louise & Co., Ltd. v. Gainsborough*, 20 R. P. C. 61 (1903), Farwell, J., said that to remove a mark for non-user either want of *bona fide* intention to use the mark or abandonment must be shown.

¹⁰ Cf. *Bull's Tms.*, supra, p. 292; and as regards the removal of an abandoned mark, see below, p. 372.

registration can be appealed to by the registered proprietor to defend his mark.¹

(8) If part only of a composite mark is objectionable, that part may be removed. This course was adopted in *Biegel's Trade Mark*,² where the applicants, Younger & Co., complained that the use of three interlaced triangles in the respondent's label caused it to resemble too closely their own label, which contained three superimposed solid triangles similarly placed. The remainder of the label was distinctive, and the applicants did not complain of it. The order made was to strike out the triangular device. Where, however, the registered mark consisted of a fir tree, with the words *Forrest* above and *London* below printed in large letters, and, the proprietor being a Coventry watchmaker, having no connection with the business formerly carried on by Forrest in London, the mark was deceptive, Chitty, J., directed the whole mark to be struck out, but without prejudice to any application the respondent might make to register the fir tree alone.³

Partial removal.

Deceptive mark wholly removed.

In the case last cited it was argued on behalf of the Comptroller that sec. 90 of the Act of 1883 did not authorise the alteration of a registered mark, and that any application to vary must have been made under sec. 92 of that Act;⁴ and a similar contention may perhaps be raised on secs. 34 and 35 of the Act of 1905; but such a contention is opposed to the express words of sec. 35, and it would leave unprovided for cases which do not fall within sec. 34, which is confined to applications by registered proprietors themselves.

(4) Registration with a disclaimer has already been discussed.⁵ *Edge's Trade Mark*⁶ is an example of the compulsory registration of a disclaimer. The respondent had registered the words *Edge's*

Registration of a disclaimer.

¹ Above, p. 291. This, however, is subject to sec. 36.

² 4 R. P. C. 525; 57 L. T. 247 (1887), Chitty, J.; *Blair v. Stock*, 52 L. T. 123 (1884), Kay, J.; *Stratmore* struck out of mark.

³ *Hill's Tm.*, 10 R. P. C. 113 (1893). Such an application was made, but refused: see the report of *Thorneloe v. Hill*, 11 R. P. C. 67 (1894).

⁴ See now sec. 34, below, p. 316.

⁵ Chap. IX., p. 212.

⁶ 8 R. P. C. 207 (1891), Stirling, J. (see above, p. 196); *Burland v. Broxborn Oil Co.*, 42 C. D. 274; 6

R. P. C. 482 (1889), Chitty, J. (*Washerine*); *Hayward's Tm.*, 54 L. J. Ch. 1003 (1885), Kay, J.; *Thompson v. Miller*, 13 R. P. C. 35 (1896), Stirling, J. (*Roadster*), are other instances. But see *The Smokeless Powder Co.'s Tm.*, [1892] 1 Ch. 590; 9 R. P. C. 109, Chitty, J.; *Clement et Cie.'s Tm.*, [1900] 1 Ch. 114; 16 R. P. C. 173, 611, Kekowich, J., and C. A. (*St. Raphael*), where disclaimers were not ordered, and *Faulder's Tm.*, [1902] 1 Ch. 125; 18 R. P. C. 37 and 535 (*Silverpan*), where the jurisdiction was questioned.

Filtered Blue, and a label containing these words with certain devices. Mr. Justice Stirling held that the word *filtered* was either descriptive or deceptive, and that the respondent could have no exclusive right to use it. He accordingly directed the first mark to be removed from the Register, and the exclusive right to the use of *filtered* in the other to be disclaimed. So, an order for the disclaimer of the exclusive use of the words *white zinc* and of the word *patent* and of the Royal Arms was made in the case of an old mark.¹ In some cases under the repealed Acts, it was, at the instance of the Comptroller, made a condition for granting leave to make alterations in a mark, that an entry be made of a statement of the essential particulars and a disclaimer of the exclusive use of the added matter;² the principle being that the applicants should put themselves in the same position as if they were registering under the Act for the time being in force; but under the present procedure such a statement of essential particulars is not required to be made in an application to register. Under sec. 15 the Court has now express power to require a disclaimer as a condition of a trade mark remaining on the Register.³

Limitation of the registration—
to particular goods;

(5) A limitation restricting the registration of a trade mark to those goods for which the registered proprietor actually used the mark, and to which alone the goodwill of the business transferred to him with the mark by the former proprietor extended, was adjudged to be notified upon the Register in *Edwards v. Dennis*.⁴ And in *The Milkmaid Brand* case,⁵ where the defendant's mark too nearly resembled the previously registered mark of the plaintiffs, it was ordered that the registration of the former should be confined to goods for which the plaintiffs' mark was not registered. In *Banks and James' Trade Mark*⁶ the registration of a mark registered for cigars, cigarettes, and tobacco was, on a motion to rectify, and with the consent of the proprietor, ordered to be limited to cigars.⁷

Section 37, which enables a trade mark to be removed from the

¹ This appears in the report of *Hubbuck v. Brown*, 17 R. P. C. 118, where the mark is shown.

² *Colman's Tms.*, [1891] 2 Ch. 402; 8 R. P. C. 209, Kekewich, J.; *Orlando Jones & Co.'s Tms.*, 12 R. P. C. 278 (1895), Stirling, J.

³ See above, p. 212.

⁴ 30 C. D. 454 (1885), C. A.

⁵ *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 C. D. 454; 3 R. P. C. 28 (1886), Kay, J.

⁶ 12 R. P. C. 333 (1895), Chitty, J.

⁷ And in *Bull's Tms.*, 15 R. P. C. 534 (1898), one of the marks was only expunged as regards goods in one class.

Register on the ground of non-user, has been referred to earlier in this chapter,¹ and it is there pointed out that the mark may be removed in respect of any of the goods for which it is registered. The following cases were decided under the former Acts on the principle of *Edwards v. Dennis*² and *Batt's Trade Marks*.³

In *Suter, &c. Composition Co.'s Trade Marks*,⁴ a trade mark registered for chemical substances used in manufacture, photography and philosophic research, anti-corrosives and anti-foulers, was limited to anti-corrosives and anti-foulers, for which only it was intended, and the registration of another mark was limited to such goods as, on the respondent's evidence, it had been used for. In this case it was said that on an application of this nature, the order should not be simply to exclude the articles in respect of which the applicant is interested, but to amend the entry so as to confine it to the goods in respect of which the registered mark has been used, so as to avoid further applications to limit. In *Hart's Trade Mark*,⁵ an order was made excluding condensed milk from the goods for which the trade mark was registered, although the mark had been registered for twenty years, and the proprietor dealt in condensed milk, and had at the date of the application for rectification determined to use the mark on condensed milk. He had used other marks for such goods.⁶ In the *Anglo-Swiss Condensed Milk Co.'s Trade Marks*⁷ an order was made excluding butter from the goods for which a trade mark was registered on the ground that there had never been any intention to use it for butter, the mark having been registered without such use for over twenty years.

In *Bourne v. Swan and Edgar, Ltd.*,⁸ the word "Swanbill," which was registered for ladies' corsets and other ready-made underclothing, was held to be descriptive of a particular shape of corset, and the Register was ordered to be rectified by confining the goods to ladies' ready-made underclothing other than corsets.

The Court has under sec. 90 of the Act of 1883 ordered a note of an undertaking by the registered proprietor restricting the use

to particular market.

¹ Above, p. 293.

² Note (4), p. 238.

³ Above, p. 292.

⁴ 19 R. P. C. 42 (1902), Byrne, J.

⁵ [1902] 2 Ch. 621; 19 R. P. C. 569, Byrne, J.

⁶ *Harc's Tm.*, 24 R. P. C. 263 (1907), Swinfen Eady, J., is an instance of

limitation under the Act of 1905. The respondent did not oppose at the hearing, but was ordered to pay the costs.

⁷ 29 R. P. C. 509; 21 R. P. C. 261 (1904), Joyce, J., and C. A.

⁸ [1903] 1 Ch. 211; 20 R. P. C. 105, Farwell, J.

of the mark, in accordance with an agreement between the proprietor and the applicant, to be entered on the Register,¹ and the Court has probably power under the present Act to impose limitations and conditions, including limitations of area, as a condition of a trade mark remaining on the Register.²

Limitation to specified colours.

(6) Under sec. 10 of the Act a trade mark may now be registered with a limitation as to the whole or a part to one or more specified colours; and in cases where that is done colour may be taken into consideration for the purpose of distinctiveness.³ This being so, if a registration without colour were successfully challenged, but the trade mark would be unobjectionable if confined to the colours in which it was used, it is probable that the Court would exercise its discretion by imposing a limitation to those colours instead of removing the mark from the Register.⁴

Entry of conditions.

(7) As already pointed out, registration subject to conditions is now permissible,² and in a proper case the Court could probably therefore enter a condition on the Register instead of expunging the mark.

Variation in form of mark.

(8) The only variation in the form of a registered mark ordered under sec. 90 of the Act of 1888 which occurs in any reported case is variation by striking out part of the mark.⁵ Any alteration which, to use the language of sec. 34 of the Act of 1905, substantially affected the identity of the mark would be open to the objection that it would cause a new mark to be entered on the Register, the application for which had not been advertised,⁶ and had not been approved by the Registrar. Possibly the Court would in a suitable case under the present Act adjourn the hearing to enable the respondent to make an application under sec. 34.

Variation of date of entry.

(9) A variation of the date of registration was directed in *Hayward's* case.⁷ There a mark was registered in 1885 on an application made in 1879, and it was held that the registration, not having been completed within one year, ought to have been

¹ *Mitchell & Co.'s Tm.*, 28 C. D. 666 (1885), Chitty, J.; cross undertakings for local user. As to entering such undertakings or at all events those referring to locality, on the Register, under the Acts of 1883 and 1888, see *Dewhurst's Tm.*, [1896] 2 Ch. 137; 13 R. P. C. 288, and *supra*, p. 230; and *Eastman, &c. Co., Ltd. v. J. Griffiths' Cycle Corporation, Ltd.*, 15 R. P. C. at p.

109 (1898) (the Comptroller's objection).

² Cf. sec. 12 (4) and sec. 14 (6).

³ Colour, above, p. 209.

⁴ Cf. sec. 36.

⁵ See above, p. 297; and as to alterations under sec. 34, see below, p. 316.

⁶ See above, pp. 291 and 295.

⁷ 54 L. J. Ch. 1003 (1885), Kay, J.

treated as abandoned, under sec. 63 of the Act of 1883. Kay, J., however, refused to expunge the registration, but ordered that the five years which under that Act made registration conclusive evidence of exclusive right of user¹ should run from the date of the actual registration instead of from the date of the application to register.

(10) The Register could not be rectified under sec. 90 of the Act of 1883, where a mark had been wrongfully registered in the name of someone other than the proprietor, by expunging the name and substituting that of the person entitled to the mark, and this is probably so under the Act of 1905. The whole entry may be expunged, but the true proprietor must be left to make a fresh application for registration, which will be advertised in the ordinary course, and may lead to opposition.² So where an agent wrongfully registered his principal's trade mark in his own name, Jessel, M.R., refused to order the name to be changed.³ And the same rule was applied where the entry was innocently made in the wrong name by mistake, as by a partner in his own name instead of his firm's,⁴ or by an agent acting for two principals, in the name of the wrong principal.⁵ In the former case, the proper course was for the registered owner to assign, and for the assignee's name to be registered under sec. 87.⁶ But in a case where a partner registered the mark in his own name thus—"Arthur Rust, trading as T. W. Rust & Co."—Jessel, M.R., allowed the names of all the partners to be substituted for "Arthur Rust";⁷ and this case was distinguished in the later judgment, on the ground that the application had been made in the name of the true proprietors, the firm. And where the owners of the mark changed the name under which they were carrying on business, Stirling, J., on an application under

Variation
of name of
proprietor.

Registration
in the wrong
name.

Change of
name of
proprietor.

¹ See sec. 41 of the Act of 1905, below, p. 330.

² *Rivière's Tm.*, 55 L. J. Ch. 545 (1885). C. A. cited above, p. 283; *Harness' Tm.*, 17 R. P. C. 40 (1900), Farwell, J.

³ *Marler's Tm.*, 44 L. T. 98, n. (1878). In the case of a design the name has been altered in the absence of fraud: *In re Grocott's Design*, 17 R. P. C. 139 (1900); but different considerations apply in the case of designs, and the case does not affect the practice as to trade marks.

⁴ *Farina's Tm.*, 44 L. T. 99, n. (1881), Jessel, M.R.

⁵ *Kingsford & Son's Application*, 6 R. P. C. 413; 61 L. T. 426 (1889), Kay, J.

⁶ *Greenlees' Tm.*, 9 R. P. C. 93 (1892), Stirling, J.; and *Farina's Tm.*, supra. Sec. 33 of the Act of 1905 corresponds to this part of sec. 87 of the Act of 1883. Sec. 70 of the Act of 1883 (sec. 22 of the Act of 1905, trade mark to be assigned only with goodwill) was not an obstacle to such assignment: *Welcome's Tm.*, 32 C. D. 213; 3 R. P. C. 76 (1886), Chitty, J.

⁷ *Rust's Tm.*, 44 L. T. 98, n. (1880).

the section, allowed the new name to be entered, with a note that the firm formerly traded under the old name.¹ But in a later case North, J., held that on an alteration of the name of a limited company, who were the proprietors of a trade mark, the Comptroller could enter the new name of the proprietors on the Register under sec. 87 of the Act of 1883, and unless he refused, the Court could not order rectification under sec. 90.² The Registrar now has power on request by the registered proprietor, or by some person entitled by law to act in his name, to enter any change of name of the person who is registered as proprietor of a trade mark;³ so that an application under sec. 35 is not necessary for this purpose, and probably would not be entertained in a case to which sec. 32 applied. In *Re The Australian Wine Co.*⁴ a mark had been registered in his own name by the sole consignee of wines from a particular vineyard, the consignee intending to use the registration solely for the protection of such wines, and so long only as he should remain consignee. The mark was transferred by his trustee in bankruptcy, with the consignee's business, to a purchaser who procured the entry on the Register of his own name as proprietor. Subsequently, upon the application, under sec. 90 of the Act of 1883, of the then owners of the vineyard, Chitty, J., directed their names to be entered as proprietors of the mark, in lieu of that of the purchaser of the consignee's business, on the ground that the mark had been registered for the benefit of the owner of the vineyard, not for that of the owner of the business.

And in a case where the registered proprietor of a mark had assigned her business and the use of the mark for six years to the respondents, with an express provision for the same reverting to her, and they had procured the registration of their own names as assignees, upon their application it was ordered that the Register should be rectified by removing their names and restoring that of the original proprietor.⁵

In a recent case an alleged assignment of trade marks was held to be wrongly registered, and was ordered to be expunged.⁶

Where an assignor by mistake purported to assign a mark and

¹ *Plumbago Crucible Co.'s Tms.*, 7 R. P. C. 282 (1890); followed by Kekewich, J., in *Burton v. Wilkinson*, 40 Sol. J., p. 336 (1896).

² *New Ormonde Cycle Co.'s Tm.*, [1896] 2 Ch. 520; 13 R. P. C. 475.

³ Sect. 32, below, p. 314.

⁴ 61 L. T. 427, n. (1885).

⁵ *Re Acril*, April 20th, 1888, Stirling, J.; Sebastian, 4th ed. pp. 374, 382.

⁶ *Rey v. Lecouturier*, 25 R. P. C. 265 (1908) C. A.

goodwill after a previous agreement to assign to a third person, and the assignee was registered as proprietor, his name was expunged on the application of the executors of the person with whom the agreement had been made, the second assignment being inoperative by reason of there being no goodwill to assign.¹

(11) The Court has power on the application of a person aggrieved by any error or defect in any entry on the Register to vary the entry as it may think fit. Some of the cases under the former Act referred to above under (10) would be covered by these words.²

Procedure on an Application under sec. 35.

“The Court” in England is His Majesty’s High Court of Justice,³ or, with reference to marks of which the registration was applied for in the Manchester Trade Marks Office,⁴ the Palatine Court of Chancery;⁵ and those Courts have jurisdiction to rectify a registered mark, whether the registered proprietor is domiciled or resident in England, or in Scotland, or Ireland, or elsewhere;⁶ although where he is domiciled or resident in Scotland or Ireland, the Scotch or Irish Courts have, perhaps, a concurrent jurisdiction.⁷ The question of the jurisdiction of the Scotch and Irish Courts to rectify the Register is somewhat doubtful. Under the Act of 1883 the Irish Courts held that they had no jurisdiction to rectify,⁸ but it was held by the Scotch Courts that they had jurisdiction to make a declaration that an entry in the Register is invalid, and that thereupon sec. 111, sub-sec. (2), of the Act of 1883⁹ became applicable.¹⁰ That sub-section is not, however, reproduced in the present Act, but sub-sec. (4) of sec. 35, which is in general terms without express reference to proceedings in Scotland or Ireland, enacts that any order of the Court rectifying the Register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner, who shall upon the receipt of such

¹ *Harness' Tm.*, 17 R. P. C. 40 (1900), Farwell, J.

² Cf. sec. 32 (1), below, p. 314.

³ Sec. 3 (sec. 117 of the Act of 1883).

⁴ Chap. VII., p. 121.

⁵ Sec. 71; Act of 1888, sec. 26.

⁶ *Re King & Co.'s Tm.*, [1892] 2 Ch. 462; 9 R. P. C. 350, Kekewich, J., and C. A. As to notice of motion in such cases, see below, p. 306.

⁷ See the case last cited, and sec.

111 (2).

⁸ *Bayer v. Connell Bros.*, 14 R. P. C. 275 (1897).

⁹ Appendix, p. 643.

¹⁰ *Dewar & Sons, Ltd. v. Dewar*, 17 R. P. C. 341 (1900), followed in *Dawson v. Stewart*, 22 R. P. C. 250, and *Reid v. Thomson & Co.*, 22 R. P. C. 376, at p. 379 (1905), and in *Boord & Son v. Thom and Cameron, Ltd.*, 24 R. P. C. 697 (1907), Inner House, Scotland.

notice rectify the Register accordingly. The omission in the new Act of sub-sec. (2) of sec. 111 of the Act of 1883 does not strengthen the contention that there is jurisdiction in the Scotch or Irish Courts to order rectification of the Register.¹

In practice, proceedings to rectify are almost always taken in the Chancery Division, except where they occur in the course of an action for infringement or passing-off, commenced against the applicant in the King's Bench Division;² and unless disputed questions of fact are involved which it is desirable to try by the aid of a jury, the Chancery Division will almost always be found to provide the more satisfactory tribunals for the trial of trade mark questions.

Sec. 35 states that the application is to be made in the prescribed manner, which in relation to proceedings before the Court means prescribed by rules of Court,³ but no rules have been made under the Act prescribing the manner in which the application to the Court must be made. In practice the procedure has in recent years always been by motion, though formerly applications by originating summons were not infrequent.⁴

Not by
action.

There is no reported English case where the application has been made by action; and in *Pinto v. Badman*,² Bowen, L.J., suggested that to proceed in that way would be an abuse of the process of the Court. It may be assumed, at any rate, that the plaintiff in an action, unless he could show some good ground for adopting a course which is both unusual and, in general, unnecessarily expensive, would have to pay the extra costs incurred, even though he were successful.

Not by
counterclaim.

In the case last cited, it was held that the application could not be made by counterclaim, apparently on the ground that it did not fall within sec. 24 (3) of the Judicature Act of 1873.⁵

By motion.

As already stated, the application is now always made by motion. If an action is pending in the matter, the motion will almost always be adjourned to the hearing of the action. The notice of motion must, if issued in the Chancery Division, be marked with the name of a judge,⁶ and the notice must, unless special leave for short notice is given by the Court or a

¹ Cf. secs. 94 and 95 of the Patents and Designs Act, 1907.

² As in *Pinto v. Badman*, 8 R. P. C. 181 (1891).

³ Sec. 3.

⁴ As to the procedure by summons, see

2nd ed. of this work, p. 287.

⁵ Cf. sec. 32, Patents and Designs Act, 1907.

⁶ Ord. 5, r. 9 (c); *King & Co.'s Tm.*, [1892] 2 Ch. 469; 10 R. P. C. 350. Form, p. 723.

judge, be served two days before the motion is made.¹ By Rule 129 of the Trade Mark Rules, 1906, every application to the Court under the Act must be served on the Registrar. And sec. 47 of the Act provides as follows:—

Service on the Registrar.

“In any legal proceeding in which the relief sought includes alteration or rectification of the Register, the Registrar shall have the right to appear and be heard, and shall appear if so directed by the Court. Unless otherwise directed by the Court, the Registrar in lieu of appearing and being heard may submit to the Court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting the same or of the practice of the office in like cases, or of such other matters relevant to the issues, and within his knowledge as such Registrar, as he shall think fit, and such statement shall be deemed to form part of the evidence in the proceeding.”

Sec. 47.

Under the old practice the Comptroller had the right to appear on an application to rectify²; but the latter part of the section is new in substance as well as in form. It is intended to enable the Registrar to save the parties the cost of an appearance on his behalf. He will probably be content with submitting a statement under the section wherever he does not think that examination of witnesses or argument on his behalf is necessary in the public interest. The words “particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting the same” would apply to appeals under secs. 23, 32, 33 or 34, in which the matter would have come before the Registrar in the first instance, and on appeal might come before the Court, directly (under sec. 33) or on a reference by the Board of Trade. They might also apply in cases under sec. 35 where there has been a previous decision of the Registrar relating to the entry.

The Court may in any application for rectification review a decision of the Registrar relating to the entry in question or correction sought to be made.³ But where there has been a decision of the same matter by the Court between the parties, for instance, on an appeal from the Registrar to the Court arising

¹ Ord. 52, r. 5.

Comptroller.

² Rule 49 of 1890; notice of an application to rectify had to be given to the

³ Sec. 54.

out of an opposition, the matter would be *res judicata*, and it is presumed that the question could not, under sec. 35, be reopened by the defeated party.¹

No special terms should be inserted in an order for rectification, even by consent, unless the Registrar has notice of them.²

Service on the registered proprietor.

Where the proprietor is resident abroad.

It is proper, when the registered proprietor of the trade mark in question is resident within the jurisdiction, to serve him with the notice of motion;³ but if he is resident abroad, under the existing rule of Court this cannot be done, nor is it necessary to enable the Court to entertain the application in question.⁴ In the case of *La Cie. Générale d'Eaux Minérales, &c.*, notice of motion to remove a mark belonging to a foreign company not carrying on business in England was served upon the company in Paris; and Stirling, J., upon their application, set aside the service, because it would have founded a jurisdiction to give costs and damages⁵ against the company, and there is, he held, nothing in the Acts to warrant this in the case of such a respondent. The notice of motion had been served abroad without the leave of a judge, but that was really immaterial, as there is no jurisdiction under Order XI. or otherwise to grant leave in respect of the application in question. On a subsequent application the learned judge directed that the name of the company should be struck out of the notice of motion, leaving the Comptroller as the sole respondent, but that information of the application should be given to the company.⁶ This course was adopted and approved in *King & Co.'s* case,⁷ where the registered proprietors of the mark in question were a company having its registered office and carrying on business in Ireland. In that case the Court of Appeal held that service of the formal notice of motion was not required to enable the Court to deal with the application, and that, as the Acts and Rules were silent on the subject, all that was required by natural justice, and therefore all that the Court would insist on, was that the persons interested in the mark should have actual notice of the applica-

Notice of motion not to be served out of the jurisdiction.

Notice by letter only.

¹ See *Normal Co.'s Tm.*, 35 C. D. 231; 3 R. P. C. 269; 4 R. P. C. 123 (1887).

² See *Golding's Tm.*, 19 R. P. C. 375 (1902), Joyce, J.

³ See *King & Co.'s Tm.*, [1892] 2 Ch. 462; 9 R. P. C. 350.

⁴ See *King & Co.'s Tm.*, supra, and *Royal Baking Powder Co.'s Tms.*, 14

R. P. C. 425 (1897), Romer, J. And the steps taken by the applicant in *Ashton's Tm.*, 48 W. R. 389 (1900), where the registered proprietor, resident abroad, could not be traced.

⁵ As to damages, see above, p. 279.

⁶ [1891] 3 Ch. 451; 8 R. P. C. 446.

⁷ Supra, note (3).

tion to be made respecting it.¹ If they should take advantage of the notice to appear and oppose the application it was, the Court held, open to them to do so, but in that event they would be liable, if they failed, to be ordered to pay costs. Lindley, L.J., expressed a doubt whether it was necessary, in the case before Stirling, J., to strike out the name of the foreign respondents from the notice.² He said: "If you go down to the root of the argument there is nothing in it except a false analogy based on the supposition that, because the notice of motion is marked by an English judge, the parties interested must be technically named at the foot of it as respondents, and you must get leave to serve them if they are to be affected by it. It appears to me that all that they want for the purposes of this Act is notice, and that they have had."³

Foreigner appearing on the application may be made liable for costs.

If it appears that the registered proprietor has not the equitable interest, the person having such interest ought to be added as a respondent unless he distinctly disclaims all interest.⁴

It has been held that a foreigner who is the registered proprietor of a mark which it is sought to remove from the Register is entitled, on receipt of information as to the intended application to rectify, to appear upon the application without giving security for costs, on submitting to the jurisdiction;⁵ but if he appeal from an order made on the motion, he may be ordered to give security.⁶

Security for costs by foreigner.

The Court has in several cases refused to allow actions for infringement to be brought or proceeded with in England where it has considered the Scotch or Irish Courts to be more convenient, notwithstanding that motions to rectify were pending before it with regard to the same matters.⁷

Action for infringement in Scotland or Ireland.

¹ Cf. Ord. 52, r. 3.

² [1892] 2 Ch. p. 482.

³ Cf. *Bancroft & Co.'s Tm.*, 5 R. P. C. 209 (1888), and *Robertson, Sanderson & Co.'s Tm.*, [1892] 2 Ch. 245; 9 R. P. C. 213, where notices of appeals from the Comptroller were sent to persons out of the jurisdiction, but the notices of motion were not served on them.

⁴ *Re Zonophone Tm.*, 20 R. P. C. 450 (1903), Byrne, J.

⁵ *Société, &c. de l'Étoile's Tm.*, 10 R. P. C. 290 (1893), Stirling, J.; *Miller's Patent*, W. N. (1894), 4; 1

R. P. C. 55, Kekewich, J.

⁶ In *Société, &c. de l'Étoile's Tm.*, 11 R. P. C. 142, an order was made by consent, the appellants having no place of business in England. On the other hand, in *Re Apollinaris Co.'s Tms.*, [1891] 1 Ch. 1, a foreign applicant who appealed was not ordered to give security, he having ample assets within the jurisdiction.

⁷ *Kinahan v. Kinahan*, 45 C. D. 78; 8 R. P. C. 18 (1891), Kekewich, J.; *Marshall v. Marshall*, 38 C. D. 330 (1888), C. A.

Evidence on the Application.

The evidence is, in accordance with the usual rule, generally given in the first instance by affidavit, subject to cross-examination of the deponents if ordered by the Court or a judge.¹ But applications under the section are very frequently heard upon *vivâ voce* evidence given in Court. And the Court had, by the terms of sec. 90 of the Act of 1883, power to direct an issue to be tried for the determination of any fact arising upon the application, but this is rarely, if ever, done. No special provision in this respect is contained in the Act of 1905, the matter being covered by the general powers of the Court.² Where an action is pending by the proprietor of the mark against the applicant, it is very usual, especially in cases where the application to rectify depends on questions of fact, to order the application to stand over until the trial, and to come on to be heard with the action, with leave to use the affidavits and cross-examine on them, and to adduce oral evidence. In such a case the applicant for rectification is generally ordered to give particulars of his objections to the entry attacked.

Declarations
of the pro-
prietor.

Statutory declarations, or certified copies of declarations, made on the application for registration of the mark sought to be removed or varied, and on the occasion of transfers of the mark by predecessors in title of the owners of the mark, may be put in evidence by the applicants, but not declarations made by persons who are neither parties to the application nor predecessors in title of the respondents.³

Discovery.

In a proper case discovery of documents may be ordered to be made by either party to the application.⁴ In *Wills' Trade Marks*,⁵ on an application by notice of motion to remove certain marks from the Register, and after the evidence had been completed (except as to the cross-examination of two witnesses, which was to be taken in Court), the applicants took out a summons for an order for discovery of documents by the respondents, the proprietors of the marks. Kekewich, J., required the applicants to make a statement in writing of the grounds upon which they sought to have the marks removed, and upon it formulated six questions relative to the use of the marks by the respondents,

¹ Ord. 39, r. 1.

² Ords. 33 and 36.

³ *Thewlis and Blakey's Tm.*, 10 R. P. C. p. 373 (1893), North, J.

⁴ Ord. 31, r. 12; see *Re Norwich Town Close Estate Charity*, 40 C. D. 310 (1889).

⁵ [1892] 3 Ch. 201; 9 R. P. C. 346.

and ordered that a member of the respondents' firm should make discovery of the documents relating to the several questions, not disclosing all the documents, but only specimens representative of each class of them. The Court of Appeal held that this order, carefully limited as it was, was oppressive at the then stage of the proceedings, and upon the respondents undertaking to deliver to the applicants a statement of the labels on which they intended to rely, and to have the relevant documents in Court at the hearing, and not to object to produce them, the Court set aside the order, without prejudice to any order the judge at the trial might think fit to make as to discovery of documents.

A statement in writing made by the Registrar under sec. 47 may form part of the evidence in the proceeding.¹

Written statement by Registrar.
Particulars.

Besides the particulars of objections referred to above, further particulars which are necessary to make the applicant's case clear are sometimes ordered. If the case set up is that the mark objected to is deceptive, and it is alleged that it has in fact deceived certain persons, particulars as to the persons deceived may be ordered to be given.² In a case in which common use in the trade was alleged, particulars of three instances of such user and certain other particulars were ordered.³

An office copy of any order to rectify must be left forthwith at the Trade Marks Branch of the Patent Office together with Form TM No. 30, and the Register is to be thereupon rectified accordingly. The person to leave the order is the person in whose favour the order has been made, or such one of them, if more than one, as the Registrar shall direct.⁴ The Registrar may, if he thinks that the order should be made public, publish it in the Trade Marks Journal.⁵

Order to be served on the Registrar.

Certificate.

It is provided by sec. 46 :—

“ In any legal proceeding in which the validity of the registration of a registered trade mark comes into question and is decided

Certificate of validity.

¹ See above, p. 305.

² *Humphries v. The Taylor Drug Co.*, 39 C. D. 693 ; 5 R. P. C. 687 (1888), Kekewich, J., an action for infringement. See also *Whitstable Oyster Co. v. Hayling Fisheries, Ltd.*, 17 R. P. C. 461 ; 18 R. P. C. 434 (1901), Buckley, J., and C. A., a passing-off case.

³ *Aquascutum, Ltd. v. Moore and*

Scantlebury, 20 R. P. C. 640 (1903), Kekewich, J. See also the particulars of common use ordered in *Schweppes, Ltd. v. Gibbens*, 22 R. P. C. 113, at p. 116, a passing-off case, and the cases cited below, p. 470.

⁴ Sec. 35 (4) and Rule 129. For Form TM No. 30, see Appendix, p. 696.

⁵ Rule 130.

in favour of the proprietor of such trade mark, the Court may certify the same, and if it so certifies then in any subsequent legal proceeding in which such validity comes into question the proprietor of the said trade mark on obtaining a final order or judgment in his favour shall have his full costs, charges, and expenses as between solicitor and client, unless in such subsequent proceeding the Court certifies that he ought not to have the same."

This section corresponds to sec. 77A of the Act of 1883, introduced into that Act by sec. 18 of the Act of 1888.¹ The important change is that under the new section a certificate may be given in any legal proceeding in which the validity of a trade mark comes into question, and not merely in an action for infringement. Questions as to validity generally arise upon motions to rectify the Register, but under sec. 77A a certificate could not be given in such a proceeding, although in some cases in which an action for infringement and a motion to rectify were heard together and on the same evidence, the Court gave the certificate.²

Moreover, where a certificate has been given, costs as between solicitor and client are recovered, subject to a certificate by the Court to the contrary, by the proprietor of the trade mark on obtaining a final order or judgment in any subsequent legal proceeding in which the validity of the trade mark comes into question. The old section only gave a right to such costs in subsequent actions for infringement, but it gave such right whether the validity again came into question or not, subject to the power of the Court to certify to the contrary.³

The giving of the certificate of validity is a matter of discretion,⁴ as is also the refusal of solicitor and client costs in the subsequent proceeding.⁵ A certificate that validity has come into question has in several patent cases been given where invalidity has been alleged in the defence and particulars of objections, notwithstanding that the defendant has not appeared

¹ Appendix, p. 633.

² *Field, Ltd. v. Wajel Syndicate, Ltd.*, [1900] 1 Ch. 651; 17 R. P. C. 266, Buckley, J.; *Barroughs, Wellcome & Co. v. Thompson and Capper*, 21 R. P. C. 69 (1904), Byrne, J. See also *De Kuyper v. W. & G. Baird, Ltd.*, 20 R. P. C. 581 (1903), Porter, M.R., Ireland.

³ Cf. the patent cases, *Welsbach Incandescent Gas Light Co., Ltd. v. Daylight Incandescent Mantle Co., Ltd.*, 16

R. P. C. 344, at p. 354, and the cases there cited. In several cases where the only question raised was infringement the full costs have been withheld: *Saccharin Corporation, Ltd. v. Dawson*, 19 R. P. C. at p. 173; *Edison Bell Consolidated Phonograph Co., Ltd. v. Waterfield Clifford & Co.*, 19 R. P. C. 329 (1902).

⁴ *Bourne's Tm.*, [1903] 1 Ch. 211; 20 R. P. C. 105, Farwell, J.

⁵ See the cases referred to in note (3).

at the trial.¹ But where, on the hearing of an action for infringement and a motion to rectify, the defendant abandoned the motion as to one mark, a certificate as to that mark was refused under the circumstances of the case, it appearing that there was a fair question which might be raised at a future time as to some of the goods for which the trade mark was registered.²

“Subsequent legal proceeding” means one commenced after the date of the certificate of validity.³ The form of the certificate to be given under the new section is that the validity of the trade mark came into question and was decided in favour of the proprietor. This, however, is only a change of form.

The order granting a certificate is not appealable.⁴

Certificates have already been given under sec. 46 in some cases.⁵

Costs.⁶

The ordinary rule that the unsuccessful party must pay the costs of the proceedings is rarely departed from,⁷ and these costs include the Registrar's costs, if he think fit to appear. His costs are in the discretion of the Court, but he cannot be ordered to pay costs.⁸

The Court has, however, a discretion whether to give costs or not, and, in the exercise of this discretion, Kekewich, J., refused to give costs to a successful applicant who, could not have been interfered with in the slightest degree in his business had he allowed the mark to remain unaltered;⁹ and costs were

¹ *E.g.*, in *J. B. Brooks & Co., Ltd. v. E. Lyett, Ltd.*, 20 R. P. C. 390 (1903).

² *Bourne v. Swan and Edgar, Ltd.*, [1903] 1 Ch. 211; 20 R. P. C. 105.

³ *Automatic Weighing Machine Co. v. International Hygienic Society*, 6 R. P. C. 175 (1889).

⁴ *Huslam v. Hall*, 5 R. P. C. 144 (1888), C. A.

⁵ *Boord & Son v. Thom and Cameron, Ltd.*, 24 R. P. C. at p. 722; *Major Bros. v. Franklin*, 25 R. P. C. 406 (1908), Jett, J.

⁶ See also Chap. IV., at p. 99, and Chap. XV., at p. 458.

⁷ *Hyle & Co.'s Tm.*, 7 C. D. 724 (1878); *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238, n. (1878), both Jessel, M.R.; and where the mark is expunged costs may be given not only against the registered

proprietor, but against another person who has claimed to be interested in the mark and brought proceedings in consequence: *Davis' Tms.*, 14 R. P. C. 903 (1897), North, J. (*Compactum*). The general rule as to costs applies to applications to limit a registration as regards the goods; see, for instance, *Hare's Tm.*, 24 R. P. C. 263 (1907), Swinfen Eady, J. As to whether an order for rectification is a “final judgment” within sec. 4, sub-sec. 1 (8) of the Bankruptcy Act, 1883, cf. *Re Owen*, Sol. J., Vol. 45, p. 103, Dec. 8, 1900.

⁸ Sec. 48, see p. 615.

⁹ *Humphries v. Taylor Drug Co.*, 59 L. T. 820 (1888), Kekewich, J. (*Herbalin*); see also *Perry Davis' Tm.*, 5 R. P. C. 337; 58 L. T. 695 (1888), Kay, J.

refused to applicants who had asked by their notice of motion not only for the expunging of the proprietor's name, but also for the entry of their own names on the Register, and they were ordered to pay the Comptroller's costs;¹ and, in a case where the defendant in an action for passing off his goods as those of the plaintiff successfully applied to expunge the plaintiff's registered mark, North, J., reserved the costs of the application till after the hearing of the action.² And where in a similar case the plaintiff obtained an injunction against the defendant, on the ground of the fraudulent passing off of the latter's goods as his, and the defendant's motion to rectify failed, and was dismissed with costs at the trial, but, when urged on other grounds, succeeded in the Court of Appeal, no costs of the appeal on that point were given, because the objection was not urged in the Court below, and the rest of the appeal was dismissed with costs.³

In *Hill's Trade Mark* the application to rectify was proceeded with at the applicant's instance, without waiting for the further investigation of charges of improper trading brought against him by the respondent, upon his undertaking not to ask for costs in any event.⁴

In *Talbot's Trade Mark*,⁵ where the application to rectify succeeded, no costs were given, because the applicant failed in regard to one of the grounds relied on, and he had delayed to move for three years.

In a case in which an action for infringement and a motion to rectify were heard together, it was held that there was jurisdiction to deal with the costs of both together and divide the whole of them fractionally.⁶

Where the respondents did not appear, and the notice of motion did not ask for costs, but in a letter prior to the motion the applicants had warned the respondents that they

¹ *Harness' Tm.*, 17 R. P. C. 40 (1900), Farwell, J. The Comptroller is in the Act of 1905 referred to as the Registrar, sec. 4.

² *Gianacis' Tm.*, 6 R. P. C. 467; 58 L. J. Ch. 782 (1889); and in *Thompson v. Miller*, 13 R. P. C. 35 (1896), Stirling, J., whilst giving the costs of the motion to the defendant in the action, added a direction that such costs were not to include the costs of the affidavits used, except so far as should be directed

at the trial.

³ *Thompson v. Montgomery*, 41 C. D. 35; 6 R. P. C. 404 (1889), Chitty, J., and C. A. (*Stone Ale*).

⁴ 10 R. P. C. 113 (1893), Chitty, J.

⁵ W. N. (1894), 12; 11 R. P. C. 77, Stirling, J. (*Emolliolorum*).

⁶ *Bourne v. Swan and Edgar, Ltd.*, [1903] 1 Ch. 211; 20 R. P. C. 105, following *In re Pollard* (1902), W. N. 49, Kekewich, J.

would ask for costs, the respondents were ordered to pay the costs.¹

Although Appendix N of the Rules of the Supreme Court does not provide for a fee for instructions on brief on an originating motion, the same can be allowed.²

As regards security for costs where the respondent is resident abroad, see above, p. 307.

Appeal.

An order made on an application under sec. 35 is a final order, and an appeal to the Court of Appeal against it must consequently be heard by not less than three judges,³ except under the Supreme Court of Judicature Act, 1899,⁴ by which the consent of all parties is requisite. The appeal must be brought within fourteen days, and must be by a fourteen days' notice of motion.⁵

The Court may stay execution of its order to rectify pending an appeal, and it will generally do so,⁶ but the appeal itself does not act as a stay.⁷ In *Re Palmer's Application*⁸ the Court of Appeal, having reversed the decision of the judge of first instance on a preliminary objection, refused to stay the proceedings before the judge on the merits pending an appeal to the House of Lords against their decision, and in *Neostyle Manufacturing Co.'s Trade Mark*⁹ the Court of Appeal refused to stay their order expunging the mark pending an appeal, to the House of Lords.

Stay of execution.

¹ *North Shore Mill Co., Ltd.'s Tms.*, 22 R. P. C. 599 (1905).

² *Burroughs, Wellcome & Co.'s Tms.*, 22 R. P. C. 164 (1905), Warrington, J. This was under Ord. 65, r. 27 (29). In the same case the costs of three counsel at the trial and in the Court of Appeal were allowed, see below, p. 467.

³ *Riviere's Tm.*, 26 C. D. 48 (1884), C. A.; Judicature Act, 1875, s. 12; see the notes to Ord. 58, rr. 3 and 15, in the Annual Practice.

⁴ 62 Vict. c. 6. As to the necessary consents, &c., see *Re Hope*, 43 Sol. J. 649; W. N. (1899), 113.

⁵ Ord. 58, rr. 3, 9 and 15; see *Re Blyth and Young*, 13 C. D. 416 (1879); and *Onslow v. The Commissioners of the Island Revenue*, 25 Q. B. D. 465 (1890); and cf. *Arbenz's Tm.*, 35 C. D. 248; 4 R. P. C. 143 (1887), C. A., where it was held that an appeal on an application to

proceed must be brought within twenty-one days (now changed to fourteen days, Orders of 1893).

⁶ *Harrison v. Woodroffe*, 7 R. P. C. 25; 42 C. D. 691 (1889), Kekewich, J.; see also *In re Tm. Borril*, 13 R. P. C. 387; 74 L. T. 805 (1896), where Kekewich, J., said that if he had decided that the mark ought to be removed he should have stayed execution. In *Hommel v. Bauer & Co.*, 21 R. P. C. 576 (1904), Warrington, J., a stay was refused.

⁷ Ord. 58, r. 16.

⁸ 22 C. D. 88 (1882).

⁹ 20 R. P. C. 803 (1903). Cf. *Re Bayer's Design*, 24 R. P. C. 65 (1907), where a stay was ordered on terms. It appears from the report of *The Neostyle* case that there is no established practice at the office not to act, pending an appeal, on an order to remove a trade mark from the Register.

Security for costs of the appeal may be ordered under special circumstances.¹

2. Correction and Cancellation of Entries at the Proprietor's Request.

By sec. 32—

Correction of Register.

“The Registrar may, on request made in the prescribed manner by the registered proprietor or by some person entitled by law to act in his name,—¹

- (1) Correct any error in the name or address of the registered proprietor of a trade mark ; or
- (2) Enter any change in the name or address of the person who is registered as proprietor of a trade mark ; or
- (3) Cancel the entry of a trade mark on the Register ; or
- (4) Strike out any goods or classes of goods from those for which a trade mark is registered ; or
- (5) Enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of such trade mark.

“Any decision of the Registrar under this section shall be subject to appeal to the Board of Trade.”

This section deals with alterations of entries in the Register. Alterations in the registered trade mark itself are dealt with in sec. 34. The section corresponds to those parts of sec. 91 of the Act of 1883 which related to alterations of entries in the Register,² namely (b) and (c), so far as relates to trade marks, but it is much wider. The sub-sections referred to enabled the Comptroller to (b) correct any clerical error in the name, style, or address of the registered proprietor of a trade mark ; (c) cancel the entry or part of the entry of a trade mark on the Register.

Sub-sec. (b) only related to errors, and not to changes, of name or address. Changes of address were, however, provided for by Rule 48 of 1890. Clause (2) of the new section now expressly authorises the entry of change of the name or address of the registered proprietor.³ Changes of proprietorship come under

¹ Ord. 58, r. 15. Security was ordered *In re Tm. Borril*, 13 R. P. C. p. 387. As to such security in the case of foreigners, see *supra*, p. 307.

² Appendix, p. 638. The parts (a) and (d) of sec. 91, as amended by the Act of 1888, relating to correction and amendment of applications are now

replaced by sub-sec. (6) of sec. 12.

³ In *New Ormonde Cycle Co.'s Tm.*, [1896] 2 Ch. 520 ; 13 R. P. C. 475, North, J., held that on a change of name of a company the Comptroller could enter the new name on the Register, and, if he refused, the Court could make the alteration.

sec. 33, and not under this section. Clauses (3), (4) and (5) deal with cancellations and alterations in the registration, either annulling in whole or in part, or altering without extending, the rights of the registered proprietor arising out of the registration. Where a registered proprietor finds that he cannot support the registration as it stands, it is often expedient for him, especially if threatened with a motion to rectify,¹ to cancel his mark, or, as the present section enables him to do, to apply to confine the registration to part only of the goods for which it is registered, or to enter a disclaimer or memorandum. Non-user in connection with any of the goods for which a trade mark is registered may form a ground for removing the trade mark from the Register in respect of such goods.²

Disclaimers may be required on the original registration of a trade mark or as a condition of its remaining on the Register, *e.g.*, when an application is made to remove it.³ "Memorandum" seems to contemplate some entry not a disclaimer, *e.g.*, a note better defining the rights covered by the trade mark, or possibly the entry of a condition which might have been required on the application to register.⁴

Where the registered proprietor is desirous of cancelling the mark only with a view to another registration, as, for instance, a registration on dissolution of partnership, the existing registration being an obstacle to the intended registration, it is doubtful whether he could make an application under sub-sec. (3) for the cancellation conditionally on the other registration being effected; but in the course of the proceedings for registration of the new mark the result might perhaps be arrived at, assuming no other objection to be taken by the Registrar, by an acceptance of the mark conditional on the proper application for cancellation being made.⁵

The rules in regard to matters under this section are Rules 82 and 90 to 92.⁶ An application for a disclaimer or memorandum

Procedure.

¹ Sec. 35, above, p. 278.

² Sec. 37, above, p. 293.

³ Sec. 15, above, p. 212.

⁴ Sec. 12 and sec. 14, above, pp. 66 and 85.

⁵ The matter was considered in *Ehrmann's Tms.*, [1897] 2 Ch. 495; 14 R. P. C. 665, where the Comptroller refused to accept an undertaking to cancel the existing marks. See now sec. 12 (2).

⁶ Appendix, pp. 666, 667. Forms, on change of address, TM No. 20; for correction of clerical error, TM No. 22; on change of name, TM No. 23; for cancellation of entry, TM No. 24; on application to strike out goods, TM No. 25; on request to enter disclaimer, &c., TM No. 26; pp. 688 *et seq.*; see in each case, 5s.

is to be advertised in order to enable any person desiring so to do to state in writing any reasons against the applicant being allowed to make such disclaimer or memorandum.¹ An application may be made under the section by the trustee in bankruptcy or liquidator (as the case may be) of the registered proprietor;² but applications on changes of proprietorship come under sec. 33. If a mark is removed from the Register, a record is to be entered of such removal and of the cause of it.³

Appeal.

There is a right of appeal to the Board of Trade,⁴ but there is no right of appeal to the Court,⁵ although the Board may refer the appeal to the Court under sec. 59.

3. Alteration of a Registered Trade Mark.

Sec. 34.

Sec. 34 provides that—

“The registered proprietor of any trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter such trade mark in any manner not substantially affecting the identity of the same, and the Registrar may refuse such leave or may grant the same on such terms as he may think fit, but any such refusal or conditional permission shall be subject to appeal to the Board of Trade. If leave be granted, the trade mark as altered shall be advertised in the prescribed manner.”

This section relates to alterations in the mark itself, and does not extend to alterations in the Register,⁶ to which matter sec. 32 relates.

Act of 1883.

The corresponding section of the Act of 1883 was sec. 92, from which two important changes have been made.⁷ In the first place, under that section the Court alone had power to make an alteration in a registered trade mark, whereas under the Act of 1905 the Registrar has jurisdiction, and the Board of Trade on appeal from him. The Court has no jurisdiction, under sec. 34, except where an appeal to the Board of Trade is referred to the Court.⁸ But it has on an application under sec. 35 power to vary the entry on the Register to which the application relates.⁹

¹ Rule 92.

² Rule 90.

³ Rule 74.

⁴ See p. 314.

⁵ Sec. 54.

⁶ *New Ormonde Cycle Co.'s Tm.*, [1896] 2 Ch. 521; 13 R. P. C. 475, North, J., under the Act of 1883. See

also *National Wholesale Tea Supply Association*, 10 R. P. C. 164 (1893), Chitty, J.; and *Patent Plumbago Crucible Co.'s Tms.*, 7 R. P. C. 282 (1890), Stirling, J.

⁷ See the section below, p. 638.

⁸ Sec. 59, below, p. 618.

⁹ Above, p. 286.

Secondly, a much wider power of altering a registered trade mark is conferred on the Registrar than was given to the Court under the old section, which excepted essential particulars from the part of a trade mark which might be varied.¹

Section 34 allows alterations in the trade mark itself, notwithstanding that the change of an essential particular is involved. But the addition or alteration must not substantially affect the identity of the trade mark. It is probable that, except to meet changes of circumstances, *e.g.*, change of a name or address, the addition of the word "limited" on the incorporation of a firm, and so forth, leave will only be granted to alter essential particulars in very special cases.

Under the repealed Acts it was more difficult to obtain the alteration of a trade mark registered as an "old mark," *i.e.*, as used before August 13th, 1875, than of a new mark; and this may still be the case. The policy of the Acts has always been that old marks should be registered and kept registered substantially as they were used before the date mentioned.² In the absence of special circumstances therefore no alteration at all should be permitted.³ The power to allow alterations is, however, in both cases subject to precisely the same limitation, which is also embodied in sec. 9.⁴ That section allows an old mark to be registered "either in its original form or with additions or alterations not substantially affecting the identity of the same." This corresponds to the words of sec. 34.⁵

The more restricted operation of sec. 92 of the Act of 1883 in regard to old marks was partly due to the fact that old marks registered under sec. 64 (3) (ii.) of the Act, like old marks registered under sec. 9 of the Act of 1905, had no "essential particulars" necessarily, but were registered, if distinctive, as a whole, so that in regard to them "essential" in sec. 92 had to be read as equivalent to "substantial"⁶ or "material."

¹ Essential particulars, sec. 9, above, p. 134. See *Hammond and Stow's Tm.*, 22 R. P. C. 299 (1905), where the Comptroller objected to the addition of "Limited" to a signature, which was an essential particular, and no such alteration was made. Cf. *Guinness & Co.'s Tm.*, 5 R. P. C. 316 (1888) (an old mark) and *Hayward & Sons Tms.*, 13 R. P. C. 729 (1896).

² *Phillips' Tms.*, [1891] 3 Ch. 139; 8 R. P. C. 469, Chitty, J.; *Adams' Tms.*,

9 R. P. C. 174; 66 L. T. 610 (1892), Kekewich, J.

³ *Re Henry Clay*, [1892] 3 Ch. 549; 9 R. P. C. 449, Kekewich, J.

⁴ Above, p. 129.

⁵ Cf. sec. 26 (c) and sec. 27.

⁶ *Adams' Tms.*, 9 R. P. C. 174; 66 L. T. 610 (1892), Kekewich, J.; cf. per Ld. Cairns in *Orr-Ewing v. The Registrar of Tms.*, 4 App. Ca. p. 484 (1879).

“Trade
mark.”

“Patent.”

The following are instances of alterations in old marks allowed or disallowed by the Court under the Act of 1888. The Court has authorised the addition of the word *limited* to an old mark where the proprietors had assigned their rights to a company bearing their old firm name with that addition;¹ and has permitted the name of certain works abandoned by the proprietors to be struck out, and the name of other works retained by them to be printed in a different position in the registered mark;² and has allowed the addition of *and Son* to a name, and the substitution of new addresses for former ones;³ and the alteration of a firm name;⁴ and in *Orlando Jones & Co.'s Trade Marks*,⁵ it allowed certain words to be added to two marks registered as old marks. Minor alterations have also been permitted.⁶ But the Court has refused to expunge *trade mark* so printed upon a label as to suggest that part only of the matter of the label was the trade mark,⁷ in a case where the mark had stood for twelve years on the Register;⁸ or to strike out *patent* printed as part of the name of the goods upon a label, there being in fact no letters patent;⁹ or to substitute the name of one former proprietor of a mark for that of another in the mark.¹⁰ And in a mark consisting

¹ *Guinness & Co.'s Tm.*, 5 R. P. C. 316 (1888), Chitty, J.

² *Burham Brick, &c. Co.'s Tm.*, 9 R. P. C. 422 (1892), Stirling, J.

³ *Brown's Tms.*, 11 R. P. C. 365; 71 L. T. 156 (1894), Stirling, J. The Comptroller objected to mere striking out, so as to leave blank spaces. Also *Cockle's Tm.*, 20 R. P. C. 353 (1903), Farwell, J. In this case the order was, at the instance of the Comptroller, made in the form of allowing alterations as shown on an exhibited label, and on an undertaking to supply the Comptroller with a block of the mark as altered; see Rule 94, below, p. 667. This form of order was followed in *Davenport's Tm.*, 21 R. P. C. 726 (1904), Joyce, J.; Appendix, p. 740.

⁴ *Maw, Son and Thompson's Tm.*, 19 R. P. C. 260 (1902), Buckley, J.

⁵ 12 R. P. C. 278 (1895), Stirling, J. The words added were: “This label is issued only by *Orlando Jones & Co., Ltd.*” There appears to have been no opposition by the Comptroller. Presumably the marks had been used with these words, but *query* as to this.

⁶ *E.g.*, in *Davenport's Tm.*, above, note (3).

⁷ See Chap. X., at p. 271.

⁸ *Phillips' Tm.*, supra. This alteration was allowed in the case of a new mark in *Colman's Tms.*, [1891] 2 Ch. 402; 8 R. P. C. 209, by Kekewich, J., the proprietors of the mark undertaking to register a statement of the essential particulars of their marks and to disclaim the remainder of them. A similar condition for certain alterations in a new mark was made in *Orlando Jones' Tms.*, 12 R. P. C. 278 (1895), Stirling, J. Such statements are not now required in applications to register, as they were under the Act of 1888.

⁹ *Adams' Tm.*, supra, note (6), p. 317. It appears from the report of *Hubbuck v. Brown*, 17 R. P. C. 148 (1899), Kekewich, J., that in 1879 an order had been made for rectification of an old trade mark appearing in the report by entry of a disclaimer of the exclusive right to the words *White Zinc* and *Patent*, and the Royal Arms.

¹⁰ *Re Henry Clay*, p. 317, note (3).

partly of Russian characters, alterations in the words on the mark, which were held to be alterations so material as to possibly prevent persons in England recognising it, were refused.¹

In a case in which the registration of a new mark was objected to on the ground of its resemblance to a registered trade mark, the judge, in deciding against the mark applied for, referred to the possibility of alteration in non-essential particulars.²

No alteration to the prejudice of other registered proprietors, or such as to cause the altered entry to infringe the restrictions of the Acts, can be allowed. Thus, in *Reiss' Trade Mark*,³ the applicants, having a registered combination device trade mark bearing the words *Grass Bleach, Best Quality*, and having ceased to use the method of grass bleaching, desired to substitute for *Grass* their own trade name, *Reiss*. The Comptroller required⁴ them to inform the Court that there were certain other trade marks containing the name *Reiss*, and North, J., refused to grant the application until he was satisfied that the altered mark would bear no resemblance to any of the marks referred to.

Amongst the alterations allowed in reported cases under the repealed Acts are the addition of *limited* to a name;⁵ the correction of an English letter printed by mistake for a Russian letter;⁶ the omission of certain words;⁷ the alteration of the name of the proprietor's works;⁸ the substitution of the initials of the new name of a limited company for those of its former name;⁹ the substitution of certain words so as to change the old name of a limited company to its new name, such name not being printed in a particular or distinctive manner.¹⁰ An application to omit

Alterations allowed in new marks.

None allowed to the prejudice of other persons.

Instances of alterations.

¹ *Savin's Tm.*, 13 R. P. C. 21 (1896), North, J.

² *Murphy's Tm.*, 7 R. P. C. 163 (1890), Stirling, J.

³ 5 R. P. C. 291 (1888), North, J.

⁴ He consented not to appear on their undertaking to read his letters in the matter to the Court.

⁵ *Bryant and May's Tm.*, 4 T. L. R. 675 (1887), Stirling, J.; *Guinness & Co.'s Tm.*, 5 R. P. C. 316 (1888), Chitty, J.; *Burke's Tms.*, W. N. (1891) 2, North, J.; *Hayward & Sons' Tms.*, 13 R. P. C. 729 (1896), Stirling, J., but *Ltd.* was refused. *Holbrook's Tms.*, 18 R. P. C. 447 (1901), Cozens-Hardy, J. See also *Hammont and Stow's Tm.*, 22 R. P. C. 299 (1905), Farwell, J.

⁶ *Ermon and Roby's Tm.*, 4 R. P. C. 70; 56 L. J. 177 (1886), Chitty, J.

⁷ *Burke's Tm.*, supra, note (5).

⁸ *Burham Brick, &c. Co.'s Tm.*, 9 R. P. C. 422 (1892), Stirling, J.

⁹ *National Wholesale Tea Supply Association, Ltd.'s Tms.*, 10 R. P. C. 164 (1893), Chitty, J.

¹⁰ *Stock-Owners' Meat Co. of New South Wales, Ltd.'s Tms.*, 14 R. P. C. 733 (1897), Romer, J. The company under its new name appears to have been registered as proprietor. See the practice laid down in *New Ormonde Cycle Co.'s Tm.*, [1896] 2 Ch. 520; 15 R. P. C. 475; and supra, p. 314. For other orders, see Sebastian, 4th ed., pp. 380 *et seq.*

two oval lines from a trade mark was, in one case, refused, the Comptroller contending that the mark was a combination mark,¹ and the addition of the words "superior quality," which were alleged to have been omitted on registration by the applicant's mistake, was refused, except on certain conditions as to disclaimer,² the mark having been registered for eighteen years.

When a limited company, which is the registered proprietor of a trade mark, changes its name, it should apply to the Registrar, under sec. 32, to make the necessary alteration in the Register, and should not, where no alteration in the mark itself is desired, apply to the Registrar under sec. 34.³

If a proprietor wishes to continue the registration and use of the unaltered mark he can apply to register the altered mark as an associated trade mark.⁴

Procedure.

The procedure under sec. 34 is regulated by Rules 93 and 94.⁵ The application for alteration must be made on Form TM No. 27,⁶ and the applicant must furnish the Registrar with six copies of the mark as it will be when altered. The Registrar may also require the applicant to furnish a block for the purpose of advertisements, and may advertise the fact of the application having been made. No procedure as to opposition is, however, provided by the section or rules. The only course therefore for a person thinking himself aggrieved by a proposed alteration is to submit his reasons to the Registrar,⁷ or, if the alteration is allowed, to apply to the Court under sec. 35 for rectification. Advertisement of the trade mark after leave has been given is required by the section and provided for in Rule 94. The Registrar may refuse the application or may grant leave to alter the trade mark on such terms as he may think fit.

Appeal.

The only appeal against a refusal by the Registrar to allow the alteration or against conditions imposed by him is to the Board of Trade, but the latter can, under sec. 59,⁸ refer the appeal to the Court.

¹ *Orlando Jones & Co.'s Tms.*, 12 R. P. C. 278 (1895), Stirling, J.

² See *supra*, p. 318, note (8).

³ *New Ormonde Cycle Co.'s Tm.*, [1896] 2 Ch. 520; 13 R. P. C. 475, North, J.; decided under the Act of 1888, and see *supra*, p. 314.

⁴ Sec. 24, above, p. 108.

⁵ Appendix, p. 667.

⁶ Appendix, p. 690. Fee £1 for first mark, 10s. for every other mark if the addition or alteration is the same in each case.

⁷ Cf. Rule 92.

⁸ Below, p. 618, and see sec. 54.

CHAPTER XII.

EFFECT OF REGISTRATION.

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Object of the Acts.

The general object of the Registration Acts was not to create new rights, but to regulate the use of, and the means of protecting, trade marks.¹ Their main effects, however, have been (1) to provide a new way in which title to a trade mark may be acquired, namely, by registration; (2) to simplify infringement actions, by making registration evidence, and, under certain circumstances, conclusive proof of title; and (3) to constitute registration, in general, a condition precedent to an action for infringement. The first of these changes was a substantive alteration of the old law.

The Acts have also defined and limited the classes of symbols which can be registered as trade marks,² and thereby, as a consequence of the third alteration just referred to, have restricted the number of marks in which trade mark rights can, as such, be effectively protected.³

1. Title to New Trade Marks conferred by Registration.

Title to new mark.

Registration, if properly made in accordance with the Acts,⁴ confers upon the registered proprietor trade mark rights in the registered mark in respect of the goods for which it is registered and upon which it is used, subject (1) to the rights appearing from the Register to be vested in any other person;⁵ (2) to rights conferred by concurrent registrations;⁶ (3) to the rights of persons who have used their marks before the user of the registered trade marks;⁷ (4) until the expiration of the period mentioned in sec. 41, to the conflicting rights of any other person in the same mark.⁷ And the rights so acquired date back to the date of the application to register.

Trade mark acquired by user before registration.

As registration gives an independent title, the owner of trade mark rights acquired by user, when he has registered his mark, will only need to avail himself of his earlier title if the propriety of the registration is questioned, or if, within the period mentioned in sec. 41, conflicting rights to the marks are set up.

Before the Acts (except in the case of Sheffield cutlers' marks) user of the mark was the only way in which trade mark rights in it could be acquired.⁸

¹ *Lyndon's Tm.*, 32 C. D. p. 117; 3 R. P. C. 102 (1886), per Cotton, L.J.

² Chap. VIII., p. 127.

³ As to this, see below, p. 339.

⁴ Chap. VIII., p. 127.

⁵ Sec. 38; Act of 1883, sec. 57; see

Mitchell's Tm., 28 C. D. 666 (1885), Chitty, J., and p. 325.

⁶ Proviso to sec. 39; see also sec. 21. above, p. 264.

⁷ Proviso contained in sec. 41.

⁸ Chap. II., p. 22.