

A serious question arose on the construction of the original Act, of 1875, as to whether new marks which had never been used could be registered under it;<sup>1</sup> but the view expressed above, that the Act created a new mode of acquiring trade mark rights, which had been acted upon from the first, was finally affirmed in *Hudson's Trade Marks*.<sup>2</sup> "In my opinion," Cotton, L.J., said in that case, "the language (of the Act), though not appropriate, means this, that a man who designs one of those special things pointed out in sec. 10<sup>3</sup> is, as designer, to be considered as the proprietor of it, and if there is no one else who has used it, or who can be interfered with by the registration and subsequent assertion of title to the mark, then he is to be considered as entitled, within the meaning of the Act, to the exclusive use of that which, in fact, has never been in any way used, but which has only been designed by him, and which he can be treated as the person entitled to register, if no one else had so used it, as that his user would be interfered with by the registration."<sup>4</sup>

New and unused trade marks may be registered.

Act of 1875.

*Hudson's case*.

The point decided in *Hudson's case* was provided for in the Act of 1883<sup>5</sup> by sec. 75, which enacted that—

Acts of 1883 and 1888.

"[Application for] registration of a trade mark shall be deemed to be equivalent to public use of the trade mark [and the date of the application shall for the purposes of this Act be deemed to be, and as from the 1st of January, 1876, to have been the date of registration]."

The words included in the brackets were added by the Act of 1888<sup>6</sup> upon the recommendation of Lord Herschell's Committee.<sup>7</sup> The alteration was merely directed to give legislative authority to the rule already in force.

Any other construction of the Acts would have led to very strange results, for no length of user was required to be shown in the actions or suits for infringement before the Acts.<sup>8</sup>

But it was held under the Acts of 1883 and 1888, that although actual use of the mark was not a condition precedent to

Applicant for registration must intend to use the mark.

<sup>1</sup> See *Edwards v. Dennis*, 30 C. D. 454 (1885); *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1886), both C. A.

<sup>2</sup> 32 C. D. 311; 3 R. P. C. 155 (1886), C. A. The application was made, and the case was decided, under the Act of 1875.

<sup>3</sup> *I.e.*, of the Act of 1875.

<sup>4</sup> See per Chitty, J., in *Barlow v. Johnson*, 7 R. P. C. at p. 404 (1890).

<sup>5</sup> The case was decided, however, in 1886, after the passing of the Act of 1883.

<sup>6</sup> Sec. 17.

<sup>7</sup> Report of 1888, p. 13.

<sup>8</sup> See Chap. II., at p. 35.

registration, the applicant must intend to use it for the goods for which it is to be registered, and that if he registered without such an intention the mark ought to be removed from the Register. Thus, where two marks had been registered for goods in class 42 for many years, but, on an application to remove them, Romer, J., found that there had been no real user before registration, and that there had been no real user in respect of such goods since registration, and that at the date of the registration there was no *bonâ fide* intention on the part of the applicants to so use the marks, he ordered the marks to be removed, and the decision was upheld by the Court of Appeal and the House of Lords.<sup>1</sup> Lindley, M.R., who delivered the judgment of the Court of Appeal, said: "Although sec. 75 of the Act of 1888 said that 'registration of a trade mark shall be equivalent to public use of the trade mark,' this language, even when in force, did not and could not mean that continued registration was equivalent to continued use. So to construe the language would lead to the irrational conclusion that a man might properly register a trade mark for any goods he chose, although he carried on no trade or business in them at all. . . . Section 75 was addressed to the time of registration; it substituted registration for previous user and reputation gained by it." And it was pointed out that the alteration of the section by the Act of 1888 made the matter still plainer. The subject of non-user is now dealt with in sec. 37 of the Act of 1905.<sup>2</sup>

Act of 1905.

The Act of 1905 contains no provision corresponding to the first part of sec. 75, but the definition for the purposes of the Act of a "trade mark" contained in sec. 3 includes a mark "proposed to be used" as well as a mark used, so that it is clear that the acquirement by registration of a trade mark not actually used before registration is authorised; and this is effected in a simpler manner than under sec. 75 of the Act of 1888.

Date of registration.

By sec. 16 of the Act of 1905, a trade mark, when registered, shall be registered as of the date of the application for registration, and such date is to be deemed for the purposes of the Act to be the date of registration. This corresponds to the last part of sec. 75, which, as already stated, was introduced by the Act of

<sup>1</sup> *Batt & Co.'s Tms.*, [1898] 2 Ch. 432; 15 R. P. C. 262, 534, in H. of L. (*sub nom. Batt & Co. v. Dunnett*), [1899] A. C. 428; 16 R. P. C. 411. See also *Edwards v. Dennis*, 39 C. D. 454

(1885); *Apollinaris Co.'s Tms.*, [1891] 2 Ch. p. 234; 8 R. P. C. 137; and *Hedley's Tms.*, 17 R. P. C. 719 (1900).  
<sup>2</sup> Above, p. 293.

1888. Sec. 16, however, only applies to trade marks registered under the Act of 1905. As regards trade marks on the Register existing at the commencement of the Act and incorporated with the new Register, it is expressly provided that such trade marks shall retain their original date.<sup>1</sup>

## 2. Registration as Evidence of Title.

This subject was dealt with in sec. 76 of the Act of 1883, which provided that the registration of a person as proprietor of a trade mark should be *primâ facie* evidence of his right to the exclusive use of the trade mark, and should, after the expiration of five years from the date of registration, be conclusive evidence of his right to the exclusive use of the trade mark, subject to the provisions of the Act. Act of 1883.

The most important of the provisions of the Act of 1883 referred to were the sections which enabled a second person who had an independent title to an old mark identical with or similar to a mark already registered, to be registered as proprietor of it;<sup>2</sup> the provision of sec. 65 that a trade mark must be registered for particular goods; the provision of sec. 70 for the assignment of registered marks in connection with the goodwill of the business to which they belong; and the provision of sec. 90 for the rectification of the Register. The operation of the last-mentioned section was to diminish very considerably the value of five years' registration as conclusive evidence of title.<sup>3</sup>

The Act of 1905 contains new provisions on the subject, namely, secs. 39, 40 and 41, differing considerably in substance from those of the Act of 1883, and being differently planned. Section 39 deals with the rights of the proprietor of a registered trade mark arising out of registration, if valid, and secs. 40 and 41 with the fact of registration being evidence, *primâ facie* or conclusive, of the validity of the registration.

Section 39 is as follows :

“ Subject to the provisions of section forty-one of this Act and to any limitations and conditions entered upon the Register, the registration of a person as proprietor of a trade mark shall, if valid, give to such person the exclusive right Rights of proprietor of trade mark.

<sup>1</sup> Sec. 6.

<sup>2</sup> Secs. 62, 71, and 72 (1); *Jackson v. Napper*, 35 C. D. 132; 4 R. P. C. p. 55 (1887), *Stirling, J.*; and see *Mouson v.*

*Boehm*, 26 C. D. 398, cited below, p. 370, and the “three mark rule,” Chap. X., at p. 224.

Above, p. 289.

to the use of such trade mark upon or in connection with the goods in respect of which it is registered: Provided always 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 mark shall (except so far as their respective rights shall have been defined by the Court) be 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."

Registration is evidence of title. The phrase now used is that it gives the right "if valid," but by sec. 40 registration is *prima facie* evidence of the validity of the original registration, and by sec. 41, after seven years<sup>1</sup> the validity of that registration can only be attacked on the ground that it was obtained by fraud, or that the use of the mark is calculated to deceive or disentitled to protection in a Court of Justice. It would appear, therefore, that the onus of showing that the registered proprietor has no title, even within the seven years, rests upon any person denying it.<sup>2</sup> Under the old practice, a defendant in an action for infringement of a registered trade mark who sought to dispute the plaintiff's title applied to rectify the Register.

The title obtained by registration is, of course, of the essence of the Act. Before registration was inaugurated, it was practically possible for a trader to protect his trade mark by calling evidence to show that the use of the mark by the defendant was calculated to pass off the defendant's goods as his goods, and this is still possible, and is often done, where the mark in question is not registered.<sup>3</sup> But the evidence to be adduced on behalf of the plaintiff in such an action must often be elaborate and expensive, and is sometimes difficult to procure, while if the registration is properly effected, all that is necessary is to produce the Registrar's certificate.

Limitations  
on rights.

The right of exclusive use conferred by registration is subject to the general proviso to sec. 41 in favour of any person who has used a similar mark before the use of the registered mark by the proprietor or his predecessor in business.<sup>4</sup> A trade mark may be

<sup>1</sup> That is, from the date of original registration or from the passing of the Act, whichever shall last happen.

<sup>2</sup> Below, p. 329.

<sup>3</sup> Sec. 45, below, p. 338.

<sup>4</sup> Below, p. 331.

registered subject to conditions,<sup>1</sup> and in some cases, at all events, to limitations;<sup>2</sup> and, if so registered, the rights conferred are limited in a corresponding manner.

Section 39 confines the rights conferred by it to use of the trade mark upon or in connection with the goods in respect of which it is registered. Although the old sec. 76 did not specify what was the extent of the exclusive right conferred, yet it was well settled that registration conferred no rights except in regard to the goods for which the mark was registered, whether that was the whole or only part of a register class,<sup>3</sup> and if the registration was limited by a note entered on the Register to some only of the goods which would be otherwise included under it, the rights conferred were limited also in the same way.<sup>4</sup> There is thus no alteration of the law in this respect. Sec. 39 is limited by the words "if valid"; so far as the trade mark is not protected by sec. 41 from an application for rectification, an application may be made either to remove the trade mark wholly or partially or to limit the entry as regards the goods for which it is registered, or otherwise vary the entry. Among other grounds for rectification is that under sec. 37 of non-user in respect of any of the goods for which the mark is registered. In substance, therefore, the exclusive right under sec. 39 is limited to goods in respect of which the trade mark is not open to attack under sec. 37, but an application to rectify may be necessary.<sup>5</sup> It was held under the repealed Acts that if a mark were actually used for certain descriptions of goods only, although registered for others also, the exclusive rights conferred by sec. 76 did not extend to the latter. Thus, where the plaintiff in an action was the assignee of a mark registered for "unwrought and partly wrought metals used in manufacture," and, in fact, he only used it upon sheet iron goods, his business being confined to such goods, and the defendant was the agent of the proprietors

Right limited to goods for which the mark is registered.

Registration restricted to goods for which the mark is used.

*Edwards v. Dennis.*

<sup>1</sup> Sec. 12 (2) and (4), sec. 14 (4) and (6), sec. 21.

<sup>2</sup> Sec. 21.

<sup>3</sup> *Hart v. Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J. The right of opposing an application for registration of another mark extends, however, to the same description of goods, *supra*, Chap. X., at p. 227.

<sup>4</sup> *Jay v. Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1889), Kekewich, J. In

this case, besides the ordinary injunction to restrain infringement on the goods for which the mark was registered, the plaintiff obtained an injunction to restrain the defendant from using the plaintiff's trade mark, on other goods, so as to deceive. The head-note is too loosely stated.

<sup>5</sup> Sec. 37 is set out and considered above, p. 293.

of a similar mark subsequently registered for steel and iron wire, and had sold wire with the latter mark upon it, it was held that the plaintiff had no cause of action, and an order was made that the registration of the plaintiff's mark should be rectified by confining it to sheet iron.<sup>1</sup> In the case just cited the plaintiff was assignee of the registered mark, and the decision turned to some extent upon the rule that a registered mark can only be assigned in connection with the goodwill of the business concerned in the goods for which it has been registered,<sup>2</sup> the plaintiff's business being confined, as already stated, to sheet iron goods; but all the judges in the Court of Appeal indicated an opinion that the rights of the original registered proprietor would in any case have been limited by his actual user of the mark.<sup>3</sup> This opinion was subsequently adopted and followed by Chitty, J., in the case of *Hargreaves v. Freeman*;<sup>4</sup> and in *Batt & Co.'s Trade Marks*,<sup>5</sup> the Court of Appeal considered that the principle of the decision in *Edwards v. Dennis* was that the original proprietor ought not to have registered the mark for goods with which he had no concern, and, applying it to the case before them, they upheld the removal of certain marks from the Register on the ground that there had been no user and no intention to use them.<sup>6</sup>

However, it will probably be held that the right to apply for rectification on the ground of non-user is confined under the Act of 1905 to the cases specified in sec. 37, and the question may arise in an action for infringement whether the defendant can set up by way of defence a non-user which would not afford ground for rectification of the Register. The solution, perhaps, of the question would be found in refusing under the general discretion of the Court an injunction to restrain a use of the mark which could not possibly damage the plaintiff.<sup>7</sup>

Section 39 confers the exclusive right to the use of the trade mark upon or "in connection with" the goods in respect of which it is registered. "In connection with" may refer to a physical connection, but it is submitted that it means any such use as indicates

Upon or in connection with the goods.

<sup>1</sup> *Edwards v. Dennis*, 30 C. D. 454 (1885), C. A.

<sup>2</sup> Sec. 70 of the Act of 1883. Sec. 22 of the Act of 1905.

<sup>3</sup> And see *Hudson's Trn.*, 32 C. D. at p. 319 (1886), and supra, p. 323.

<sup>4</sup> [1891] 3 Ch. 39; 8 R. P. C. 237.

<sup>5</sup> Cited supra, note (1), p. 324.

<sup>6</sup> The decision was affirmed in the House of Lords. See supra, note (1), p. 324.

<sup>7</sup> See the cases above cited, and particularly *Hargreaves v. Freeman*, note (4).

that the goods are the goods of the proprietor, whether the mark is attached to the goods or used in invoices, trade descriptions or advertisements;<sup>1</sup> but it is doubtful whether there could be a verbal infringement.<sup>1</sup>

The proviso to sec. 39 follows the provision for the concurrent registration of identical, or nearly identical, marks which is contained in secs. 19 to 21, and it is substantially new. Before the Acts and apart from them, each of two persons who were entitled to the same mark could sue an infringer for an injunction,<sup>2</sup> but if the plaintiff claimed on account of profits he was only entitled to the share appropriate to his own interest in the mark.<sup>3</sup> Although the present section says expressly that each proprietor shall have the same rights as if he were the sole registered proprietor, the old ruling as to profits ought, it is submitted, to be maintained. The right of a successful plaintiff in an action for infringement of trade mark or for passing-off to elect between profits or damages has lately been affirmed by the House of Lords.<sup>4</sup>

Section 39 is also to be read in conjunction with 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.<sup>5</sup>

By sec. 40—

“In all legal proceedings relating to a registered trade mark (including applications under sec. 35 of this Act) the fact that a person is registered as proprietor of such trade mark shall be *primâ facie* evidence of the validity of the original registration of such trade mark and of all subsequent assignments and transmissions of the same.”

Registration to be *primâ facie* evidence of validity.

This section corresponds to the first part of sec. 76 of the Act of 1883, which provided that the registration of a person as proprietor of a trade mark should be *primâ facie* evidence of his right to the exclusive use of the trade mark; except that now by

<sup>1</sup> In *Kodak, Ltd v. London Stereoscopic and Photographic Co., Ltd.*, 20 R. P. C. 337 (1903), Swinfen Eady, J., supplying other goods in answer to a written order for a Kodak film appears to have been held to be an infringement of the trade mark Kodak. See also above, p. 30, and below, p. 397.

<sup>2</sup> *Ivent v. Turpin*, 2 J. & H. 139; 30 L. J. Ch. 495 (1861), Wood, V.-C., and below, p. 385.

<sup>3</sup> *Dent v. Turpin*, supra.

<sup>4</sup> *Weingarten Bros. v. Bayer & Co.*, 22 R. P. C. 341 (1905).

<sup>5</sup> Below, p. 400.

sec. 40 registration is made *primâ facie* evidence of its validity, and if the registration be valid, the right to the exclusive use follows by virtue of sec. 39.

The main purpose of sec. 40 is to facilitate the proof of title by a plaintiff suing for an alleged infringement of his mark; in place of the evidence of user and reputation, by which he would have had to show his right to the mark before the Acts, he has only to produce his certificate<sup>1</sup> of registration of his mark, and that will be *primâ facie* evidence of his title.<sup>2</sup>

Registration  
*primâ facie*  
valid in appli-  
cation for  
rectification.

Evidence  
rebutted by  
the plaintiff's  
own case.

Registration is also *primâ facie* evidence in applications under sec. 35, that is to say, applications to rectify the Register, so that the onus is thrown on an applicant.<sup>3</sup>

The evidence afforded by the registration may be rebutted, if the registration is less than for the period named in sec. 41, that is, seven years from original registration or from the passing of the Act,<sup>4</sup> whichever shall last happen. Under the Act of 1883 the period was five years.<sup>5</sup> Thus, in the case just cited,<sup>6</sup> the plaintiffs were not content to rest their title, as in the first instance they might have, merely upon the registration, but they set out in their pleadings the steps by which they alleged that the trade mark in question had been transferred to them, and thereby showed that the original proprietors of the mark, and of the cigar factory and business in connection with which it had been acquired, had purported to assign the trade mark without assigning the goodwill of the business. It followed, therefore, that the assignment was a nullity,<sup>7</sup> and, as the registration was less than five years old, the *primâ facie* title conferred by it was consequently rebutted by the evidence furnished by the plaintiffs' own case.

Registration  
to be con-  
clusive after  
seven years.

Sec. 41 provides as follows:—

“In all legal proceedings relating to a registered trade mark (including applications under section thirty-five of this Act) the original registration of such trade mark shall after the expiration of seven years from the date of such original registration (or seven years from the passing of this Act,<sup>4</sup>

<sup>1</sup> Sec. 51, rule 102, Form TM No. 34.

<sup>2</sup> *Pinto v. Badman*, 8 R. P. C. 181 (1889), C. A.

<sup>3</sup> Above, p. 289.

<sup>4</sup> August 11th, 1905.

<sup>5</sup> Sec. 76. Thus, in *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., held that the words *Self*

*Washer*, although they had been two years on the Register, were not a trade mark. The case nevertheless succeeded on the ground of passing-off. See further the chapter on infringement, p. 387, note (8).

<sup>6</sup> *Pinto v. Badman*, supra, note (2).

<sup>7</sup> Sec. 70 of the Act of 1883.



whichever shall last happen) be taken to be valid in all respects unless such original registration was obtained by fraud, or unless the trade mark offends against the provisions of section eleven of this Act:

“ 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.”

This section replaces the last part of sec. 76 of the Act of 1883, which provided that the registration of a person as proprietor of a trade mark should, after the expiration of five years from the date of registration, be conclusive evidence of his right to the exclusive use of the trade mark, subject to the provisions of that Act.

Section 41 effects one of the most important changes made by the Act of 1905. Although the old sec. 76 in terms provided that registration should be conclusive after five years, the provision was construed to be subject to the liability to removal from the Register under the rectification section.<sup>1</sup> The consequence of this was that an application to rectify the Register became part of the regular course of the defence of an action for infringement. This is now altered, and after seven years the original registration is to be treated as valid, unless obtained by fraud, or by reason of being calculated to deceive or otherwise disentitled to protection in a Court of Justice.<sup>2</sup> The presumption of validity does not extend to subsequent assignments entered on the Register,<sup>3</sup> and it is

Changes made  
by the Act of  
1905.

<sup>1</sup> But a mark which had been long registered had every presumption made in favour of its validity: *Chesebrough Manufacturing Co.'s Tm.*, [1902] 2 Ch. 1; 19 R. P. C. 342, C. A. (*Vaseline*); and *Burroughs, Wellcome & Co.'s Tms.*, [1904] 1 Ch. 736; 21 R. P. C. 217, C. A.; *Edwards v. Dennis*, 30 C. D. 454 (1885), decided under the Act of 1875, *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89

(1891), North, J.; *Verity's Tm.*, 19 R. P. C. 58 (1902). Buckley, J., and see the list of trade marks removed or varied after five years' registration given on pp. 310 and 311 of the 2nd Edition of this book. In *Bull's & Co.'s Tms.*, [1899] A. C. 428, cited above, p. 324, the trade marks had been registered more than five years.

<sup>2</sup> Above, p. 330.

<sup>3</sup> Cf. sec. 40, above, p. 329.

subject to the proviso at the end of the section for the protection of prior users of the mark. It is also, it is submitted, subject to sec. 37,<sup>1</sup> at any rate, so far as that section deals with the effects of non-user subsequent to the original registration.

The advantage which this section offers to traders in regard to their own marks is to some extent balanced by the necessity under which they will now be of carefully watching the advertisements of applications to register, in order to see that nothing is registered or allowed to remain on the Register long enough to profit by the section which is likely to interfere with their business or with marks which they are actually using in it. As the last to expire of the two periods is to be taken, the first part of the section cannot come into operation till August 11th, 1912.

Name of  
patented  
goods.

A question which may have to be considered under the present section, or under it and sec. 44, is, how far the use of the name of a new article manufactured under patent rights can be permanently monopolised by the person who owned the patent, if he has registered and used the name as a trade mark while the patent rights subsisted. The common law rule is that such a name becomes merely descriptive when the patent expires, and can be used by anyone to describe the article,<sup>2</sup> but when the seven years mentioned in sec. 41 have expired, the original registration of the name can no longer be attacked. The solution of the difficulty is, it is submitted, to be found in the consideration that when the name becomes merely descriptive on the expiration of the patent rights, it ought to be removed from the Register, not on the ground that it was not originally distinctive, but on the ground that its distinctiveness has ceased. At all events the right of the public to use the name, once it has become merely descriptive, is secured by sec. 44.

The provision that registration is to be conclusive of the validity of the original registration after the expiration of the period named in the section is subject to the following savings or exceptions.

Fraud.

(1) If the original registration was obtained by fraud. In this case the Registrar himself may apply to rectify the Register,<sup>3</sup> at

<sup>1</sup> Above, p. 293.

<sup>2</sup> *Linoleum Co. v. Nairn*, 7 C. D. 834 (1878), Fry, J., and other authorities cited pp. 43 *et seq.* In *Chesebrough Manufacturing Co.'s Tm.*, [1902] 2 Ch. 1; 19 R. P. C. 342, Cozens-Hardy, L.J.,

expressed the opinion that the doctrine was not limited to the names of patented articles, but extended to names given to new articles.

<sup>3</sup> Sec. 35 (3), above, p. 278.

all events if the fraud was directed against possible objections by the Registrar or otherwise with a view to deceive the office. But the exception is a general one, and the person defrauded is not prevented by sec. 41 from applying for rectification. It might be a fraud for a person to procure the registration of a trade mark which he knows he is not entitled to claim the exclusive use of—for instance, if he knows that it is in use by another trader; and although the proviso to the section might protect the other trader from interference, it is submitted that he would be able not merely to claim the benefit of the mark jointly with the registered proprietor, but to object to the registration notwithstanding the lapse of seven years. Another case of fraud which may be suggested is where the agent of a foreign manufacture registers the trade mark of the latter in his own name. The extent which will be given to the exception of fraud can, however, only be learnt from the practical working of the Act.

(2) If the trade mark offends against the provisions of sec. 11 of the Act. That section forbids the registration as a trade mark or part of a trade mark of any matter, the use of which would by reason of its being calculated to deceive or otherwise be disentitled to protection in a Court of Justice, or would be contrary to law or morality or any scandalous design. The provisions of sec. 11 have been fully considered in Chapter X.<sup>1</sup> and it will be seen from the decisions there referred to that a wide meaning has been placed on the words "calculated to deceive."

Marks forbidden by sec. 11 to be registered.

(3) The proviso to sec. 39 saves the rights of persons concurrently registered in respect of the same goods for the same (or substantially the same) trade mark.<sup>2</sup> So that such a person does not need any protection which may also be conferred on him by the more general proviso contained in sec. 41.

Concurrent registrations

(4) If the proviso to sec. 41 applies to a case at all, it extends to the whole Act, not merely to sec. 41. It is new and is a necessary consequence of conferring a conclusive title on the registered owner. In a few cases under the old Acts the person who had been an earlier user of the mark was registered along with a later user who had got upon the Register.<sup>3</sup> The registration of identical, or nearly identical, marks for the

Trade marks of anterior date.

<sup>1</sup> Above, p. 266.

<sup>2</sup> Above, p. 326.

<sup>3</sup> *Jelley's case*, 51 L. J. Ch. 639. n. (1878), Jessel, M.R.; *Mouson v. Boehm*,

6 C. D. 398 (1884), Chitty, J. See also *Verity's Tm.*, 19 R. P. C. 58 (1902). Buckley, J.

same description of goods under the Act is dealt with in secs. 19, 20 and 21.<sup>1</sup>

The first part of the proviso applies whether the earlier user obtains registration under sec. 21 or not, but it is conditional upon his having used the mark continuously. The phrase "continuously used" must, it is submitted, receive a reasonable business interpretation. There are no such saving words in this section with regard to non-user due to special circumstances and not due to an intention to abandon the mark as appear in sec. 37.<sup>2</sup> Nevertheless, it cannot be intended that a mere temporary cessation of user should cause the forfeiture of the right to a valuable mark. "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."<sup>3</sup>

Matters subsequent to registration.

(5) Matters subsequent to the original registration. These are not strictly excepted from sec. 41, inasmuch as the effect of the first part of sec. 41 does not extend beyond the original registration. Among the matters subsequent to the original registration which may give rise to rectification of the Register are (a) wrongful registration of assignments or transmissions, (b) non-user of the trade mark for a period giving ground for removal of the trade mark under sec. 37,<sup>4</sup> (c) assignment of the trade mark without any goodwill in the whole or part of the goods for which it is registered.<sup>5</sup>

### 3. Registration as a Condition precedent to an Action for Infringement.

Sec. 42.

It is provided by sec. 42 that:—

"No person shall be entitled to institute any proceeding to prevent or to recover damages for the infringement of an unregistered trade mark, unless such trade mark was in use before August 13th, 1875, and has been refused registration under this Act. The Registrar may, on request, grant a certificate<sup>6</sup> that such registration has been refused."

<sup>1</sup> Above, pp. 222, 223, 264.

<sup>2</sup> Above, p. 293.

<sup>3</sup> Per Chitty, J., in *Mouison v. Boehm*, 26 C. D. 398; cf. *Daniel and Arter v. Whitthouse*, [1898] 1 Ch. 685; 15 R. P.

C. 134. As to abandonment, see p. 370.

<sup>4</sup> Above, p. 293.

<sup>5</sup> Sec. 22, Chap. XIII., p. 346.

<sup>6</sup> See p. 337.

A trade mark can still be acquired by use,<sup>1</sup> but, if the trade mark is unregistered, trade mark rights in respect of it cannot be enforced except in the case of an old mark which has been refused registration under this Act.

Trade mark can be acquired by use.

The above section corresponds to sec. 77 of the Act of 1888,<sup>2</sup> which was as follows :—

Act of 1888, s. 77.

*“A person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of a trade mark unless, in the case of a trade mark capable of being registered under this Act, it has been registered in pursuance of this Act, or of an enactment repealed by this Act, or, in the case of any other trade mark in use before the thirteenth of August one thousand eight hundred and seventy-five, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused. The Comptroller may, on request, and on payment of the prescribed fee, grant a certificate that such registration has been refused.”*

In the case of new marks, no substantial change is effected, but the change of language avoids some questions left open by the wording of the old sec. 77, and especially by the words “a trade mark capable of being registered under this Act.” These words referred to the trade marks described in sec. 64 of the Act of 1888, and after the passing of the Act of 1888, to those described in sec. 10 of that Act.<sup>3</sup> They correspond to the expression “registrable trade mark” which is defined by sec. 3 of the Act of 1905,<sup>4</sup> and is used in sec. 9.<sup>5</sup> Section 77 of the Act of 1888 did not expressly enact that a new mark, incapable of registration, shall not be the subject of trade mark rights, but the general words of prohibition, as also the savings contained in the section, plainly showed that it was intended to prohibit proceedings to enforce rights in new unregistered marks, and although there was no direct decision as to a new mark incapable of registration, this is the view which has always been taken of the effect of the section as to such a mark.<sup>6</sup> Applica-

New marks

<sup>1</sup> *Sen-Sen Co. v. Britten*, [1899] 1 Ch. 692; 16 R. P. C. 137, Stirling, J.

<sup>2</sup> The corresponding section of the Act of 1875 was sec. 1, but was amended by the Acts of 1876 and 1877. The Acts of 1875, 1876, and 1877 will be found in the Appendix, p. 646. These provisions were discussed in the 1st and 2nd Editions of this book, but they have no

substantial bearing on the present Act.

<sup>3</sup> Printed in the Appendix, p. 626. See secs. 27 and 28 of the Act of 1888.

<sup>4</sup> Above, p. 24.

<sup>5</sup> Above, p. 129.

<sup>6</sup> In *The Normal Co.'s Tm.*, 35 C. D. 235; 3 R. P. C. 269 (1886), Chitty, J., said: “The result (of sec. 77) is that a person, who, I will assume, is entitled to

tions to expunge the plaintiffs' trade marks from the Register on the ground of their being incapable of registration have frequently been made in actions for infringement, and have been treated as effectual defences if successful, unless the plaintiff could make out a case of passing-off<sup>1</sup> by the use of the mark. The Act of 1905 makes the matter quite clear; no action for infringement of an unregistered trade mark can now be maintained, unless it is in respect of an old mark which has been refused registration under the Act of 1905.

Old marks.

The policy of the Acts has been to preserve old trade mark rights substantially without alteration.<sup>2</sup> Section 77 of the Act of 1883 excepted from its operation all old marks of which registration under that Act, or of an enactment repealed by it,<sup>3</sup> had been refused, and a similar saving was introduced into the Act of 1875 by the amending Act of 1876.<sup>4</sup> The new section, however, makes no exception in favour of old marks that have been refused registration under any of the repealed Acts; in order to obtain the benefit of the section there must be a refusal under the Act of 1905. Probably the draftsman had in mind that the Act of 1905 opened the Register to many trade marks formerly incapable of registration. It is provided in sec. 9 that any special or distinctive word or words, letter, numeral, or combination of letters or numerals used as a trade mark by the applicant or his predecessors in business before August 13th, 1875, 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<sup>5</sup> shall be registrable as a trade mark under this Act.<sup>6</sup> But, apart from this proviso, registration of trade marks

be, but by some error has not been, put on the Register by the Comptroller or by the Board of Trade, loses his right, because it is useless to have a trade mark which you cannot protect in case of infringement; as to old marks, however, a distinction is drawn. And where there has been a refusal, there is a right to institute proceedings to prevent infringement. . . . So that the validity of the old trade marks does not depend on the (non-)registration." See also Cotton, L.J., as to the policy of the Acts in *Van Duzer's* case, 34 C. D. 634; 4 R. P. C. 31 (1887); and cf.

*Apollinaris Co.'s Tms.*, [1891] 2 Ch. at pp. 234 and 235; 8 R. P. C. 137, per Fry, L.J.

<sup>1</sup> See below, p. 338, and Chap. XVI, pp. 477.

<sup>2</sup> Per Ld. Blackburn, *Orr-Ewing v. Registrar of Tms.*, 4 App. Ca. p. 498 (1879).

<sup>3</sup> Acts of 1875, 1876 and 1877.

<sup>4</sup> 39 & 40 Vict. c. 33, s. 1, below, p. 650.

<sup>5</sup> Rule 20, p. 658, as to verification of the fact of user.

<sup>6</sup> Above, p. 198.

that have in fact become distinctive in actual use is permitted under sec. 9.<sup>1</sup>

Lord Herschell's Committee advised that the certificate of refusal should be altered to a certificate that the trade mark is incapable of being registered under the Act, on the ground that the former tends to prejudice the proprietor of the mark, especially in proceedings abroad;<sup>2</sup> but the suggestion was not adopted. The fee payable for the certificate of refusal is £1. The form of application is Form TM No. 31.<sup>3</sup>

Certificate of refusal.

It was suggested by Malins, V.-C., in *The Twentsche Stoom Bleekery Goor v. Ellinger & Co.*,<sup>4</sup> that the prohibition of sec. 77 does not apply to foreign owners of trade marks; but it is submitted that the suggestion is ill-founded, and that no distinction can be drawn between trade marks owned by subjects and those owned by aliens.<sup>5</sup>

The section makes registration, in the cases falling within it, a condition precedent<sup>6</sup> to an action for infringement. Where, therefore, the sole consignee of goods for which his consignors had a label registered as a trade mark in France sought to restrain the use of a name which formed a material feature in the label, it was held that the action was in substance an action to restrain an infringement of the label, and, as that might have been registered in England as a trade mark under sec. 103 of the Act of 1888, it fell within the prohibition.<sup>7</sup> An action to restrain the use of a registered mark on goods for which the registration does not avail is also within the prohibition, for it is in effect an action in respect of an unregistered mark.<sup>8</sup>

Registration a condition precedent to action;

The section does not enact that a man shall not have a trade mark until he registers,<sup>9</sup> and it has been compared<sup>9</sup> to sec. 24 of the Copyright Act, 1842,<sup>10</sup> which is satisfied by a registration

not to acquisition of a trade mark.

<sup>1</sup> Above, p. 183.

<sup>2</sup> Report of 1888, p. xiii. In many countries a foreigner cannot obtain registration for a trade mark not registered in his own country.

<sup>3</sup> Appendix, p. 696.

<sup>4</sup> 26 W. R. 70 (1877).

<sup>5</sup> See *Goodfellow v. Prince*, note (7); and Chap. XV., at p. 332.

<sup>6</sup> Per Ld. Blackburn in *Orr-Ewing v. Registrar of Tms.*, 4 App. Ca. 498, 499.

<sup>7</sup> *Goodfellow v. Prince*, 35 C. D. 9 (1887), C. A.

<sup>8</sup> *Hargreaves v. Freeman*, [1891] 3 Ch T.M.

39; 8 R. P. C. 237, Chitty, J.; cf. *Jay v. Ladler* and *Hart v. Colley*, cited below, p. 341, note (1). That the registration was blocked by delay at the office was considered to be no excuse: *Hazzopulo v. Kaufmann*, 23 Sol. J. 819 (1879), Little, V.-C.

<sup>9</sup> *Sen Sen Co. v. Britten*, [1899] 1 Ch. 692; 16 R. P. C. 137; Stirling, J.; and per Chitty, J., in *Barlow v. Johnson*, 7 R. P. C. at p. 405 (1890). See also Cotton, L.J., in *Hudson's Tms.*, 32 C. D. at p. 320; 3 R. P. C. at p. 161 (1886).

<sup>10</sup> 5 & 6 Vict. c. 45.

made subsequently to the wrongful act complained of, but before the commencement of the action. If a person has adopted and used words as a trade mark in this country, but has not registered them as a trade mark, it does not necessarily follow that, by describing such words on the goods as his trade mark, he is making a misrepresentation.<sup>1</sup>

Only the registered proprietor or his assignee can sue.

Only the registered owners, or the assignees of the registered owners, of the trade mark can sue in respect of an infringement of it,<sup>2</sup> but it is not necessary that an assignee should have registered the assignment before commencing his action.<sup>3</sup>

The judgment of North, J., in the case last cited seems to go further and to be founded on the view that an unregistered assignee can sue. In *The Magnolia Metal Company v. Atlas Metal Company*,<sup>4</sup> however, Collins, J., dismissed the action as to trade mark on the ground that the plaintiffs had not at the date of judgment been registered as proprietors of the marks sued on.<sup>5</sup> *Ihlee v. Henshaw*<sup>6</sup> does not seem to have been cited, and the two cases appear to conflict, for sec. 77 of the Act of 1883, like sec. 42 of the Act of 1905, expressly referred to the institution of proceedings, and therefore, if registration of an assignment is necessary at all, it would appear to be necessary before the action is commenced.

#### The Prohibition does not affect Passing-off Actions.

Section 42 of the Act of 1905 has, and sec. 77 of the Act of 1883 had, no application to actions to restrain a trader passing off his goods, or doing what is calculated to pass off his goods, as the goods of another. This is now expressly provided by sec. 45 of the Act of 1905, which enacts that nothing in the Act shall be deemed to affect rights of action against any person for passing off goods as those of another person, or the remedies in respect thereof.

<sup>1</sup> *Sen Sen Co. v. Britten*, supra, note (9), p. 337, distinguishing and explaining *Lewis v. Goodbody*, 67 L. T. N. S. 194. Kekewich, J. See observations of Kekewich, J., on the last-mentioned case, in *Hubbuck v. Brown*, 17 R. P. C. at p. 156 (1900).

<sup>2</sup> *Richards v. Butcher*, 7 R. P. C. 288 ; 62 L. T. 687 (1890), Kay, J. Action by sole purchasers from registered proprietors. Leave to add the proprietors.

<sup>3</sup> *Ihlee v. Henshaw*, 31 C. D. 323 ; 3 R. P. C. 15 (1886), North, J.

<sup>4</sup> 14 R. P. C. 389 (1897).

<sup>5</sup> It appears from the report of *Magnolia Co.'s Tms.*, 14 R. P. C. at p. 266, however, that the plaintiffs were registered as proprietors on the day before the trial: but it is presumed that this fact was not in evidence in the action.



Two questions arise in trade mark actions and in allied actions: first, is the defendant using a mark which is the same as, or which is a colourable imitation of, the plaintiff's registered trade mark? and secondly, is the defendant selling goods so marked as to be designed or calculated to lead purchasers to believe that they are the plaintiff's goods? <sup>1</sup> The two questions are distinct, and the injunctions granted by the Court to meet the wrongs complained of are different in the two cases. Thus, in *Jay v. Laddler*,<sup>2</sup> the defendant was restrained "from infringing the plaintiff's said trade mark by issuing, publishing, or circulating, or causing to be issued, published, or circulated, any circular, advertisement, or notice containing or bearing the trade mark in the pleadings mentioned, or any colourable imitation thereof, in connection with sealskin mantles and sealskin coats (the only goods for which the trade mark was registered), or otherwise using the said trade mark in that connection," and he was also restrained "from using the device of a lady and bear (the trade mark in question), so as to deceive the public," that is, so as to lead the public to believe that the goods of the defendant were the goods of the plaintiff.

Distinction between trade mark and passing-off cases.

The jurisdiction to grant the last-mentioned injunction is part of the general jurisdiction of the Courts to prevent and to give compensation for frauds which cause injury to the person who comes to complain of them,<sup>3</sup> and this jurisdiction, which was well established before the Trade Marks Registration Acts, has not been taken away or altered by anything contained in them.<sup>4</sup>

It is no defence, therefore, to an action for passing off the defendant's goods as those of the plaintiff, that the grant of an injunction would practically confer on the plaintiff trade mark rights in an unregistered trade mark. This is well shown by *The Stone Ales* case. There the plaintiffs had registered the words *Stone Ale* as a trade mark, and they had other registered marks which comprised the same words. An application was

Unregistered trade marks practically protected.

*The Stone Ales* case.

<sup>1</sup> *Mitchell v. Henry*, 15 C. D. 181 (1880), Thesiger, L.J.; *Edwards v. Dennis*, 30 C. D. 454 (1885), Fry, L.J.; see Chap. I., p. 12, and Chap. XVI., p. 481.

<sup>2</sup> 40 C. D. 649; 6 R. P. C. 136 (1889), Kekewich, J.

<sup>3</sup> See Chap. I., p. 1.

<sup>4</sup> *Mitchell v. Henry*, 15 C. D. 181

(1880), C. A.; *Singer, &c. Co. v. Loog*, 8 App. Ca. at p. 32 (1882), per Ld. Blackburn; *Goodfellow v. Prince*, 35 C. D. 9 (1887), C. A.; *Montgomery v. Thompson*, [1891] A. C. 217; 8 R. P. C. 361 (*Stone Ale*); *Reddaway v. Banham*, [1896] A. C. 199; 13 R. P. C. 218; *Lever Bros., Ltd. v. Beddingfield*, 16 R. P. C. 3; 80 L. T. 100 (1899), C. A.

made by the defendant to vary the registration of the first-mentioned mark, by adding a disclaimer of the right to the exclusive use of the word *Stone*, and this application Chitty, J., refused. The Court of Appeal, however, ordered the mark *Stone Ale* to be removed from the Register altogether, on the ground that it was not shown to have been used separately as a trade mark before August 13th, 1875, but they, and subsequently the House of Lords, nevertheless maintained the injunction granted by Chitty, J. The injunction<sup>1</sup> restrained the defendant from "carrying on the business of a brewer at Stone, under the title of 'Stone Brewery,' or 'Montgomery's Stone Brewery,' or under any other title, so as to represent that the defendant's brewery is the brewery of the plaintiffs, and from selling, or causing to be sold, any ale or beer not of the plaintiffs' manufacture, under the term 'Stone Ales,' or 'Stone Ale,' or in any way so as to induce the belief that such ale or beer is of the plaintiffs' manufacture, and from infringing the plaintiffs' registered trade marks, or any of them."

Lord Herschell's judgment.

"The respondents," Lord Herschell said,<sup>2</sup> "are entitled to ask that a rival manufacturer shall be prevented from selling his ale under such a designation as to deceive the public into the belief that they are obtaining the ale of the respondents, and he ought not the less to be restrained from doing so because the practical effect of such restraint may be much the same as if persons seeking the injunction had a right of property in the particular name."<sup>3</sup>

In a later case in which it was contended that sec. 77 of the Act of 1883 was a bar to a passing-off action, Vaughan Williams, L.J., said that he read the section as defining the conditions which were necessary if anyone claimed the benefit of the statute, and it was held that the section was no answer to the claim in respect of passing-off.<sup>4</sup>

In *The Stone Ales* case just quoted the deception was practised by the use of the trade name of the plaintiffs' goods upon the

Passing off by the imitation of an unregistered trade mark.

<sup>1</sup> [1891] A. C. p. 218.

<sup>2</sup> [1891] A. C. p. 220.

<sup>3</sup> See also *Birmingham Vinegar Co. v. Powell*, [1897] A. C. 710; 14 R. P. C. 720, where the words *Yorkshire Relish* had been expunged from the trade marks Register; and *Reddaway v. Banham*, [1896] A. C. 199; 13 R. P. C. 218

(*Camel Hair Belling*). These cases are fully discussed below in Chap. XVI.

<sup>4</sup> *Faulder & Co., Ltd. v. Rushton*, 20 R. P. C. 477 (1903), C. A. (*Silverpan Jam*), where a trade mark including the word *Silverpan* had been expunged from the Register on the ground that that word ought to have been disclaimed.

defendant's goods. The jurisdiction existing, apart from the Acts, extends equally to cases where it is practised by the adoption of the plaintiff's trade mark, or of the "get up" of his goods, and it affords no ground of defence that the trade mark,<sup>1</sup> or an essential part of the get up,<sup>2</sup> might have been, but is not, registered under the Acts.

In *Thorneloe v. Hill*,<sup>3</sup> where the plaintiff sued on trade name, Romer, J., expressed the view that, as the name had been used only as a trade mark, the plaintiff could not sue on it, as it had not been registered; but a distinction seems to have been there made between setting up a pure right of property in a name and seeking protection from passing off by means of the name, and the latter ground of action failed for other reasons.

In *Birmingham Vinegar Co. v. Powell*,<sup>4</sup> Lord Halsbury, after quoting Lord Justice Turner's words in *Burgess v. Burgess*,<sup>5</sup> "that no man can have any right to represent his goods as the goods of another person," stated that that was the only question of law which could arise in such cases; all the rest were questions of fact.

In the case of *Pinto v. Badman*,<sup>6</sup> the jury found, as a fact, that the defendant had fraudulently sold his cigars as those of the plaintiffs, and also that he had infringed the plaintiffs' trade mark, and Day, J., gave judgment in the plaintiffs' favour. The Court of Appeal reversed the decision and gave judgment for the defendant, on the ground that the trade mark on which the plaintiffs relied had been assigned to them without the goodwill of the business in the goods to which it belonged. The question whether the plaintiffs were not, notwithstanding, entitled to retain their judgment on the ground of the finding of the jury, first stated above, does not seem to have been argued, and the plaintiffs' case appears to have been substantially based upon their assumed trade mark right. The decision, therefore, cannot be regarded as conflicting with the proposition that passing-off cases lie outside the Acts.

*Pinto v.  
Badman.*

The cases cited above considerably limited the operation of the prohibition contained in sec. 77 of the Act of 1883. Trade

The operation  
of sec. 77 of  
Act of 1883.

<sup>1</sup> *Jay v. Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1889). Kekewich, J.; *Hart v. Colley*, 44 C. D. 193; 7 R. P. C. 9 (1890). North, J.

<sup>2</sup> *Great Tower Street Tea Co. v. Lang-*

*ford*, 5 R. P. C. 66 (1887), Stirling, J.

<sup>3</sup> 11 R. P. C. 61 (1894).

<sup>4</sup> See p. 340, note (3).

<sup>5</sup> 3 De G. M. & G. 896 (1853).

<sup>6</sup> 8 R. P. C. 181 (1891), C. A.

mark rights, as was shown in the introductory chapter of this book,<sup>1</sup> grew out of the right of a trader to prevent and to obtain compensation for deceptions practised upon the public, which caused, or were likely to cause, damage to him as an individual; and long after property in a trade mark had been practically recognised by the judgment of Lord Cottenham in *Millington v. Fox*,<sup>2</sup> Lord Westbury held that imposition on the public was the test of the property in a trade mark having been invaded or injured, although it was not the ground on which the Court rested its jurisdiction.<sup>3</sup>

The Registration Acts have altered the old law to this extent, that they give the registered proprietor of a mark, so long as he remains registered, the exclusive right to the use of the mark on the goods for which it is registered, so that if it, or an essential part of it, is appropriated by another trader, the proprietor can interfere to restrain the appropriation.<sup>4</sup> But where the complaint is not the appropriation but the colourable imitation of his mark, the test to be applied is still—Is the defendant's mark, by its resemblance to the registered mark, calculated to pass off his goods as the goods of the plaintiff?<sup>4</sup>

The alteration is not, however, of substantial importance, for it was settled law, apart from the Acts, that if a trader has taken a substantial part of the trade mark of another, the onus of showing that he is not using it in a manner calculated to deceive is cast upon him,<sup>5</sup> and this onus he could hardly discharge if the mark had, in fact, become identified by use with the other trader. So that the change is, in effect, no more than the natural consequence of treating registration as equivalent to public use of the registered mark.<sup>6</sup>

In most of the cases where the Court has interfered to prevent the passing off of the defendant's goods as those of the plaintiff,

<sup>1</sup> Page 1.

<sup>2</sup> 3 My. & Cr. 338 (1838); Chap. I., p. 4.

<sup>3</sup> *Hall v. Barrows*, 4 De G. J. & S. 150; 33 L. J. Ch. 204 (1863), Westbury L.C.; *Leather Cloth Co. v. American Leather Cloth Co.*, 4 De G. J. & S. 137; 33 L. J. Ch. 199 (1863), Westbury L.C.; 11 H. L. C. 523; 35 L. J. Ch. 53; and see Ld. Blackburn's judgment in *Orr-Ewing v. The Registrar of Tms.*, 4 App. Ca. at p. 494 (1879).

<sup>4</sup> Secs. 39, 40 and 41 of the Act of 1905; sec. 76 of the Act of 1883; see

per Cotton, L.J., in *Mitchell v. Burg*, 15 C. D. at p. 193 (1880); in *Edwards v. Dennis*, 30 C. D. at p. 471 (1885); and in *Lydon's Tm.*, 32 C. D. at p. 117 (1886); and Chap. XV., at p. 400.

<sup>5</sup> *Orr-Ewing v. Johnston*, 13 C. D. 434, C. A.; 7 App. Ca. 219 (1882). This case was begun in 1877, before sec. 1 of the Act of 1876 came into operation; it was therefore decided under the old law; see 7 App. Ca. p. 228.

<sup>6</sup> Sec. 75 of the Act of 1883, above, p. 323.

Proof of fraud is not necessary to escape the prohibition.

the deception has been found to have been deliberately practised ; but fraud is not necessary to enable the Court to act ;<sup>1</sup> accordingly, the presence of fraud does not constitute a material distinction between cases where actions in respect of the unlawful imitations of trade marks do or do not fall within the prohibition of sec. 42.

It can rarely happen, therefore, that the prohibition of sec. 42 will prevent the owner of an unregistered mark, which has, in fact, become known to the public, or to a considerable although indefinite number of purchasers, as indicating that the goods upon which it appears are his goods, from protecting it against infringement, for the adoption of the mark, or of a substantial part, or a colourable imitation of it, can hardly fail to be calculated to pass off the goods of others as those of the owner ; but the want of registration will cast upon the plaintiff in any action the necessity of proving that goods bearing the mark are known as his, and that goods bearing the mark complained of are likely, by reason of the resemblance between the marks, to be mistaken for his. And where an injunction is granted to restrain the use of a mark calculated to pass off the defendant's goods as those of the plaintiff, by reason of its resemblance to his unregistered mark, it should be so limited as to leave it open for the defendant to use any part, or the whole, of the plaintiff's unregistered mark, if he can do so, in any manner which is not calculated to lead to deception.<sup>2</sup>

The case of *Goodfellow v. Prince*,<sup>3</sup> which is the only reported case<sup>4</sup> in which sec. 77 of the Act of 1883 proved fatal to a plaintiff where he sought relief on the ground of passing off, as well as in respect of an infringement of his trade mark, turned upon the view taken by the Court of Appeal that, as both plaintiff and defendants were importers, not producers, of the goods in question, the mark complained of was not calculated to suggest that the goods sold by the defendant were those of the plaintiff, but only that they were those of the producer from whom he bought.

Failure to register only deprives the proprietor of the advantages of the Acts.

*Goodfellow v. Prince.*

<sup>1</sup> Chap. I., p. 4, and *Chivers & Sons v. S. Chivers & Co., Ltd.*, 17 R. P. C. 429 (1909). Farwell, J. See Chap. XVI., p. 182.

<sup>2</sup> See the judgments in *Montgomery v. Thompson*, [1891] A. C. 217 ; 8 R. P. C. 351 ; *Reblaway v. Banham*, [1896] A. C.

199 ; 13 R. P. C. 218 ; and *Powell v. Birmingham Vinegar Co., Ltd.*, 11 R. P. C. at p. 572 ; 12 R. P. C. at p. 517.

<sup>3</sup> 35 C. D. 9 (1887), C. A.

<sup>4</sup> But see *Thorneloe v. Hill*, *supra*, p. 341.

Unregistered  
trade marks  
and the  
Merchandise  
Marks Act,  
1887.

Failure to register a trade mark, whether it be occasioned by the incapacity of the mark for registration, having regard to the definition clauses, or be due to any other reason, is material on other grounds than those depending upon sec. 42, for the definition of a trade mark contained in the Merchandise Marks Act, 1887, is, as regards Great Britain and Ireland, restricted to trade marks registered under the Act of 1883, or, since the commencement of the Act of 1905, under that Act.<sup>1</sup> An unregistered mark is consequently deprived of the very valuable protection, under the criminal law, constituted by the penalties and punishments provided by the former statute for forging trade marks, falsely applying trade marks to goods, or selling, exposing, or having in possession for sale, or for any purpose of trade or manufacture, any goods or things to which a forged trade mark is applied. The provisions of the statute as to applying a false trade description do, however, extend to unregistered trade marks.<sup>2</sup>

<sup>1</sup> Interpretation Act, 1889, sec. 38,  
Appendix, p. 654.

<sup>2</sup> Sec. 3 (2) ; Appendix. p. 805.

## CHAPTER XIII.

### ASSIGNMENT AND DEVOLUTION OF TRADE MARKS.

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**TITLE to a trade mark cannot be assigned or devolve in gross ; but, unless the mark connotes a personal connection between its original owner and the goods in connection with which it is used, it may be assigned and transmitted, together with the goodwill<sup>1</sup> of the business in such goods.**

A trade mark is assignable only with the goodwill.

This proposition was fully established before the first Registration Act was passed, and, as regards registered trade marks, it

<sup>1</sup> See the definitions of goodwill contained in *Commissioners of Inland Revenue v. Muller & Co.'s Margarine, Ltd.*, [1901] A. C. 217, quoted below, p. 260.

was, in part, embodied in that Act and subsequently in the Act of 1883. It is also contained in sec. 22 of the Act of 1905, which is as follows:—

Sec. 22.  
Assignment  
and trans-  
mission of  
trade marks.

“A trade mark when registered shall be assigned and transmitted only in connection with the goodwill of the business concerned in the goods for which it has been registered and shall be determinable with that goodwill.<sup>1</sup> But nothing in this section contained shall be deemed to affect the right of the proprietor of a registered trade mark to assign the right to use the same in any British possession or protectorate or foreign country in connection with any goods for which it is registered together with the goodwill of the business therein in such goods.”

The corresponding provisions of the Acts of 1875 and 1883<sup>2</sup> only differed from the first sentence of the above sections in having the words “in the particular goods or classes of goods” instead of the words “in the goods” simply. A trade mark must be registered for particular goods or classes of goods,<sup>3</sup> and the rights conferred by registration are limited to the goods for which it is registered.

Until it was established that there could be property in a trade mark, there could, of course, be no question of the assignment of trade mark rights,<sup>4</sup> although the successors of the original founders of a business no doubt took over and continued to use the old trade marks employed in it, and were protected when other traders sought to pass off their goods as the goods of the lawful users of the marks.<sup>5</sup> But as soon as trade marks were recognised as the subjects of property, the alienation of them, as of any other property rights, was permitted, subject only to such limitations as were necessary to prevent the use of the marks becoming deceptive.

Transfer by  
implication  
with goodwill.

And, conversely, it was held that the sale and transfer of the goodwill of a business assigned the trade marks used in the business to the purchaser and transferee by implication, and without any express grant being needed;<sup>6</sup> but it is a question of

<sup>1</sup> See the next Chapter.

<sup>2</sup> Act of 1875, part of sec. 2; Act of 1883, sec. 70.

<sup>3</sup> Sec. 3. above. p. 103.

<sup>4</sup> See per Fry, L.J., in *Pinto v. Badman*, 8 R. P. C. at p. 194 (1891).

<sup>5</sup> See for instance, *Webster v. Webster*,

3 Swan. 490 (1791), Thurlow, L.C.; and *Molloy v. Downman*, 3 My. & Cr. 1; 6 L. J. Ch. (N. S.) 308 (1837), Cottenham, L.C.

<sup>6</sup> *Shipright v. Clements*, 19 W. R. 599 (1871), Malins, V.-C.



intention, to be gathered from the assignment as a whole, whether the trade marks do or do not pass, and an intention not to assign them may appear notwithstanding the use of the word "goodwill" in the assignment.<sup>1</sup>

The leading cases on the subject are *Hall v. Barrows*<sup>2</sup> and *The Leather Cloth Co. v. The American Leather Cloth Co.*<sup>3</sup> They were decided at the same time, in 1863, by Lord Westbury, and his judgment in the latter case was affirmed by the House of Lords; in the first case, the question at issue was whether, in determining the sum to be paid by the surviving partner of a firm who took over the partnership assets at a valuation under the articles of partnership, the value of the trade mark used in the business ought to be taken into account, and the Lord Chancellor, reversing the decision of Romilly, M.R., held that it ought to be so taken, the valuation being made, however, on the footing that the surviving partner was entitled to carry on a similar business and to use the trade mark in it without payment.<sup>4</sup> The trade mark consisted of the letters B. B. H. (the initials of the partners composing the original firm), surmounted by a crown, and the Master of the Rolls had held that it could not be sold, because it designated the firm which manufactured the particular goods. "It would," he said, "obviously be a fraud on the public if the Court of Chancery were to attempt to sell to another person the right of holding out to the public that the goods manufactured by him were, in fact, goods manufactured by another and distinct firm." And he distinguished the mark in question from marks indicating the manufacture of a particular factory, which might rightly be transferred with the factory. Lord Westbury dissented from the view that the trade mark was a personal mark. "It must be borne in mind," he said, "that a name, although originally the name of the first maker, may in time become a mere trade mark or sign of quality, and cease to denote or be current as indicating that any particular person is the maker." And he held, as a fact, that the connection

*Hall v. Barrows.*

Trade mark comprising the name of the original proprietor.

Lord Westbury's judgment.

<sup>1</sup> *Roger's Tm.*, 12 R. P. C. 149 (1895), North, J.

<sup>2</sup> 32 L. J. Ch. 548; 33 L. J. Ch. 204; 4 De G. J. & S. 150, Romilly, M.R., and Westbury, L.C.

<sup>3</sup> 1 H. & M. 271; 32 L. J. Ch. 721; 4 De G. J. & S. 137; 33 L. J. Ch. 199; 11 H. L. C. 523; 35 L. J. Ch. 53,

Wood, V.-C., Westbury, L.C., and H.L. See also *Bury v. Bedford*, 32 L. J. Ch. 741; 4 De G. J. & S. 352; 33 L. J. Ch. 465 (1863), Romilly, M.R., and L.J.J.

<sup>4</sup> As to this, see also the cases discussed in Chap. XVI., below, pp. 528 *et seq.*

represented by the mark was a connection with the business and the factory at which it was carried on, not a connection with the persons who were the owners of these, and that, accordingly, the trade mark belonged to the partnership as part of its property, and might be sold with the business and works.

*The Leather Cloth case.*

In *The Leather Cloth case*,<sup>1</sup> the plaintiffs sued the defendants for an alleged infringement of their trade mark, and Lord Westbury, reversing the decision of Wood, V.-C., dismissed the suit on the ground that the trade mark of the plaintiffs contained material misrepresentations. The plaintiffs had purchased the marks from an American company—the Crockett International Leather Cloth Co.,—who were the successors of Crocketts & Co., and the marks contained the names both of the company and of the firm, as well as an American address which was not the address of the plaintiffs. The presence of the names and address amounted, in Lord Westbury's opinion, to a representation that the goods on which the mark was used were the goods of the original firm or of the American company, and the marks, therefore, could not be properly used by the plaintiffs, and consequently could not be validly assigned to them. And this judgment was fully indorsed by the House of Lords, although Lord Cranworth and Lord Kingsdown, on the appeal, based their judgments chiefly on the ground that there was in fact no infringement, and Lord Westbury placed his upon wider grounds than those he had adopted on the appeal from the Vice-Chancellor, namely, that the alleged trade marks were in fact only advertisements and not trade marks at all.

The mark is unassignable if deceptive when used by an assignee.

Lord Kingsdown's judgment in *The Leather Cloth case*.

The following passage from Lord Kingsdown's judgment in the House of Lords<sup>2</sup> shows the principle upon which the assignment of trade marks and trade names, as well as the limitations restricting such assignment, are based: "By the usage of trade, the name of a firm is understood not to be confined to those who first adopted it, but to extend to and include persons who had afterwards been introduced as partners, or persons to whom the original partners have transferred their business. The name of a firm continues to be used in many cases long after all the original traders have died, or have ceased to have any interest in the concern—as in the great banking houses of Child and Coutts, and many other mercantile houses. If a manufacturing company

<sup>1</sup> Note (3) p. 347. The case is further stated at p. 52, above.

<sup>2</sup> 35 L. J. Ch. p. 64; 11 H. L. C. 523.

uses the name of the firm, and stamps the name of its firm upon its goods, though the name of the firm no longer represents the same persons as at first, it is no fraud upon the public for the reasons I have already mentioned. For the same reason, the use of the old trade mark of the firm by the new partners or their successors (if the term 'trade mark' be understood in what I have already said is its proper sense)<sup>1</sup> is no fraud upon the public; it is only a statement that the goods are the goods of the firm whose trade mark they bear." And Lord Cranworth said: "The right to a trade mark may, in general, treating it as property or as an accessory to property, be sold or transferred upon a sale and transfer of the manufactory of the goods on which the mark has been used to be affixed, and may be lawfully used by the purchaser."<sup>2</sup>

In the case of *Pinto v. Badman*,<sup>3</sup> Fry, L.J., stated the rule governing the assignment of a trade mark in concise and definite terms: "It may be assigned," he said, "if it is indicative of origin, when the origin is assigned with it. It cannot be assigned when it is divorced from its place of origin, or when, in the hands of the transferee, it would indicate something different to what it indicated in the hands of the transferor."

And as the judgments quoted above show, a trade mark is not deceptive in the hands of an assignee of the business of the original proprietor, and consequently unassignable, merely because it comprises the name or initials of the original proprietor, or of any of the former owners of the business.<sup>4</sup> But in special cases, as for instance where the reputation of goods depends on the personal skill of an artist or artizan, the use of his name or mark by a successor might be a misrepresentation, and in such a case the name or mark is not properly assignable.<sup>5</sup>

So, the right to use a trade mark for a sauce cannot be sold without the business in the sauce, or the secret of its manufacture,<sup>6</sup> or the right to the use of a brand for cigars, without the factory and business of the manufacturer who first acquired

The mark used by the assignee must indicate what it indicated when used by the assignor.

A mark comprising the trader's name is assignable.

<sup>1</sup> *I.e.*, a symbol or emblem, come by use to be recognised in the trade as the mark of the goods of a particular person (above, pp. 23 and 35).

<sup>2</sup> 35 L. J. Ch. p. 61.

<sup>3</sup> 8 R. P. C. 181 (1891), C. A.

<sup>4</sup> *Hall v. Barrows*; *Bury v. Bedford*, above, p. 347, notes (1), (2). See also *Hudson v. Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C.

<sup>5</sup> Per Ld. Kingsdown in *Leather Cloth Co. v. American Leather Cloth Co.*, ubi supra, and per Romer, J., in *Thorneloe v. Hill*, 11 R. P. C. at p. 70 (1894). See also the judgment of Ld. Westbury in *Leather Cloth Co. v. American Leather Cloth Co.*, 4 De G. J. & S. 137; 33 L. J. Ch. 199, as to marks becoming deceptive on assignment.

<sup>6</sup> *Cotton v. Gillard*, 44 L. J. Ch. 90 (1874), Jessel, M.R.

it;<sup>1</sup> and where a mark contains a special indication of the locality of the origin of the goods, it could not be properly assigned so as (using Lord Justice Fry's expression) to be divorced from such place of origin.<sup>2</sup>

There must be a business to assign in the United Kingdom.

As already stated, an assignment of a trade mark is inoperative if the assignor has no goodwill to assign.<sup>3</sup> And the goodwill must be that of a business in the United Kingdom.<sup>4</sup> The question whether an assignor has a goodwill of a business in the particular goods to assign may, of course, give rise to difficult questions of fact; but the words of the section as to goodwill are not to be construed narrowly.<sup>5</sup> Thus, where a mark was registered for anti-friction metal bearings, but the registered proprietors, who were an American company, had never sold such bearings in the United Kingdom, but they had imported specimens and also ingots of the anti-friction metal, with the mark on them, for making bearings, such ingots being purchased by an English firm; and the American company had a special agreement with the English firm, under which, as the Court held, the latter were in some respects, and particularly as to trade marks, agents of the company, and the goodwill was to revert on the determination of the agreement to the company; it was held that the company had a business concerned with metal bearings sufficient to support an assignment by them of the trade mark and goodwill.<sup>6</sup>

<sup>1</sup> *Pinto v. Badman*, 8 R. P. C. 181 (1891), C. A.

<sup>2</sup> See judgment of *Id.* Westbury referred to in note (5), p. 349 *supra*, and judgment of Fry, L.J., quoted on p. 349, and *Mason v. Queen*, 23 Sc. L. R. 641 (1886).

<sup>3</sup> *Harness' Tm.*, 17 R. P. C. 40 (1900), Farwell, J., is an example of an assignment being held inoperative on this ground. See also *Valentine Extract Co., Ltd.'s Tms.*, 18 R. P. C. 175 (1901). Cf. *Linotype Co., Ltd.'s Application* (No. 2), 17 R. P. C. 380.

<sup>4</sup> So where the goodwill in France was held by the French Courts to have passed to the defendant, it was held by the Court of Appeal in England that this decision could not affect the trade marks and goodwill in England, and the registration of the alleged assignment of the trade marks to the defendant was ordered to be struck out of the Register, *Rey v. Lecouturier*, 25 R. P. C. 265

(1908). Cf. *Ullmann v. Leuba Freres*, Times, July 21st, 1908, P. C. See also *Magnolia Metal Co.'s Tms.*, below, note (5), where the point is assumed both by Kekewich, J., and C. A. Cf. also *Société Anonyme Panhard et Levassor v. Panhard Levassor Motor Co., Ltd.*, [1901] 2 Ch. 513; 18 R. P. C. 405 (Farwell, J.), a trade name case, where the plaintiffs were held to have an English market, although having no place of business or agent in England. There appears to be no conflict between these cases and the cases on the Stamp Acts quoted below, p. 360.

<sup>5</sup> Per Rigby, L.J., in *Magnolia Metal Co.'s Tms.*, [1897] 2 Ch. 371; 14 R. P. C. 621.

<sup>6</sup> *Magnolia Metal Co.'s Tms.*, above, note (5), Lindley, Lopes, and Rigby, L.J.J., reversing Kekewich, J., on this point. See also *European Blair Camera Co.'s Tm.*, 13 R. P. C. 600, where Stirling, J., held that there was user of

“The main object,” Rigby, L.J., said, “of the restrictions upon assignments imposed by the Act was to prevent confusion or deception by suggesting that the articles to which the mark is applied continue to have some connection or other with the original registered owner.”

Trade marks used in a part of a business may be sold with the goodwill of that part only, and if the goodwill sold is restricted to some only of the goods in which the vendor dealt, the purchaser will only obtain the right to use the trade marks assigned to him upon the goods in question, even though they be registered for other goods. Thus a mark was registered for “unwrought and partly wrought metals used in manufacture,” and the proprietors assigned it together with their goodwill “in the trade or business of galvanised iron merchants and manufacturers”; but the business, in fact, being entirely confined to sheet iron, the assignee’s rights were held to be restricted to that description of goods only.<sup>1</sup>

Sale of trade marks with the goodwill of part of the business.

It is not essential that the assignments of the trade mark and the transfer of the goodwill should be exactly contemporaneous,<sup>2</sup> or even that there should be any legal conveyance of the latter, if the assignee is equitably entitled to it.<sup>3</sup> An assignment to the owner of the business in connection with which the trade mark is used or intended to be used has, consequently, been permitted in some cases where the mark has been registered by mistake or accident in the name of a person other than that owner.<sup>4</sup>

Transfer of goodwill and trade mark not necessarily contemporaneous.

Where a company sold its trade marks and the goodwill of its business, but was dissolved without its making any assignment to the purchaser, the equitable owner was registered as the proprietor of the trade marks.<sup>5</sup>

the word *Bull's-eye* by a foreign importer in connection with cameras in this country, he having imported the cameras in cases which had the word on them, and having sent therewith to the consignee pamphlets containing the word. See above, p. 207, note (1).

<sup>1</sup> *Edwards v. Dennis*, 30 C. D. 454 (1885), C. A. Cf. *Hart's Tm.*, [1902] 2 Ch. 621; 19 R. P. C. 569, Byrne, J. The Register (*scumble*) can be rectified, even after seven years, if the trade mark is assigned without goodwill, above, p. 346.

<sup>2</sup> *Weldon's Tm.*, 32 C. D. 213; 3 R. P. C. 76 (1886), Chitty, J.; *Hammoul v. Malouin, Brunker & Co.*, 9 R. P. C.

301 (1892), Chitty, J.

<sup>3</sup> In *McMillan v. Ehrmann Bros., Ltd.*, 21 R. P. C. 357, 647 (1904), Buckley, J., and C. A., a trade name case, a point was raised, but not decided, whether the plaintiffs to whom the business and trade name was only assigned after action brought by a limited company, the real owners, could sue.

<sup>4</sup> See Chap. XI., at p. 301; *Greenlee's Tm.*, 9 R. P. C. 93 (1892), Stirling, J.; *Leahy v. Glover*, 10 R. P. C. 141 (1893), H. L.; and see note (2).

<sup>5</sup> This appears in the report of *In re Taylor's Agreement Trusts*, 21 R. P. C. 713 at p. 715.

Foreign trade marks and goodwill.

The goodwill<sup>1</sup> of a business may extend to more than one country, and the new provision contained in the latter part of the section expressly saves the right of the proprietor of a trade mark to assign the trade mark rights in any country, but only in connection with the goodwill therein. Registration under the Act is only operative for the United Kingdom and Isle of Man, and the proviso seems to have been inserted by way of precaution. The divisibility of goodwill is also recognised in sec. 23.

Trade marks on bankruptcy and dissolution of partnership.

Upon the dissolution of a partnership, in the absence of special agreement,<sup>2</sup> the trade marks of the firm are part of its assets, and are saleable as such with the goodwill;<sup>3</sup> but it seems that each of the partners is at liberty to make use of the trade name of the firm, and of its trade marks, provided he can do so and does so in such a way as to avoid deceiving the public, or casting any risk or liability upon his late partners.<sup>4</sup> Similarly, upon the death or bankruptcy<sup>5</sup> of a trader, his trade marks may be sold with the goodwill of his business by his executors or trustees.

Under certain circumstances, where the goodwill of a business becomes divided, as on a dissolution of partnership, an apportionment of trade marks can be effected. Section 23 provides—

Apportionment of marks on dissolution of partnership.

“In any case where from any cause, whether by reason of dissolution of partnership or otherwise, a person ceases to carry on business, and the goodwill of such person does not pass to one successor but is divided, the Registrar may (subject to the provisions of this Act as to associated trade marks), on the application of the parties interested, permit an apportionment of the registered trade marks of the person among the persons in fact continuing the business, subject to such conditions and modifications, if

<sup>1</sup> As to the elements constituting goodwill, see below, p. 360.

<sup>2</sup> For instances of this, see *Bury v. Bedford*, 32 L. J. Ch. 741; 4 De G. J. & S. 352; 33 L. J. Ch. 465; and *Hanson v. Game, Harrison and Larner, Ltd.*, 9 R. P. C. 136 (1892). This topic is fully discussed below, Chap. XVI., p. 528.

<sup>3</sup> *Hall v. Barrows*, above, p. 347, note (2).

<sup>4</sup> See the last case, and *Hookham v. Pottage*, L. R. 8 Ch. 91 (1872), C. A.; *Thyane v. Shore*, 45 C. D. 577 (1890), Stirling, J.; and *Burchell v. Wilde*, [1900] 1 Ch. 551, Byrne, J., and C. A. Where a business is conducted at two places and the goodwill at each is sold

separately without special stipulations, the purchasers might have concurrent rights to the use of the trade name. In *Townsend v. Jarman*, 17 R. P. C. 649 (1900), Farwell, J., it was contended that such was the case, but in the particular case the defendant failed to establish a concurrent right with the plaintiff.

<sup>5</sup> *Hammond v. Malcolm, Brunner & Co.*, 9 R. P. C. 301 (1892), Chitty, J.; in *Melrose Drover, Ltd. v. Heddle & Co.*, 4 Fraser 1120 (1902), Ct. of Sess. interdict was granted against the use by the trader of the firm name, trade marks and labels, all of which had been assigned by the trustee in sequestration.

any, as he may think necessary in the public interest. Any decision of the Registrar under this section shall be subject to appeal to the Board of Trade."

This section is new and is designed to meet the hardship which occurred in *Ehrmann's Tms.*,<sup>1</sup> where on the dissolution of a firm it was agreed that one partner should trade as "Ehrmann Frères," and the other as "Ehrmann Brothers," and that new registrations should be made of the old trade marks with consequential alterations; but the new registrations were refused in view of the confusion that might arise. Possibly the scheme proposed in that case would not be allowed under the present section, as the Registrar will, no doubt, only give his approval where the proposed apportionment does not conflict with the interests of the public. But where an apportionment does not involve the entry of duplicate marks on the Register for the same description of goods, then, notwithstanding that the goodwill in such goods is divided and becomes vested in more than one person, the section contemplates that one of such persons may take some marks and another other marks. The section applies not only on dissolution of partnership, but in all cases where a person ceases to carry on business and the goodwill becomes divided, *e.g.*, under the provisions of a will.

Associated trade marks, however, are only assignable or transmissible as a whole,<sup>2</sup> so that it would appear that an apportionment of them under sec. 23 could not be made.

The only appeal from the Registrar is to the Board of Trade,<sup>3</sup> but the Board of Trade may refer the appeal to the Court.<sup>4</sup>

The procedure under sec. 23 is regulated by Rules 87 to 89.<sup>5</sup> An application must be made on Form TM No. 21,<sup>6</sup> and must be accompanied by a case setting out all the facts fully. The Registrar may call for evidence and is to give the parties an opportunity of being heard, if necessary. Upon an apportionment a note is to be entered in the Register in connection with each of the marks of the fact of apportionment and referring to the date of the Registrar's decision.

Section 38 provides as follows:—

"Subject to the provisions of this Act—

(1) The person for the time being entered in the Register as

Power of registered proprietor to assign.

<sup>1</sup> [1897] 2 Ch. 495; 14 R. P. C. 665.

<sup>4</sup> Sec. 59, below, p. 618.

<sup>2</sup> Sec. 27, above, p. 110.

<sup>5</sup> Appendix, p. 666.

Sec. 54, below, p. 617.

<sup>6</sup> Below, p. 688.

proprietor of a trade mark shall, subject to any rights appearing from such Register to be vested in any other person, have power to assign the same, and to give effectual receipts for any consideration for such assignment ;

(2) Any equities in respect of a trade mark may be enforced in like manner as in respect of any other personal property."

No notice of any trust expressed, implied, or constructive is to be entered in the Register, nor is any such notice to be receivable by the Registrar.<sup>1</sup>

This section corresponds to the latter part of sec. 87 of the Act of 1883 ; the first part of that section relating to registration of assignments is now dealt with in a separate section.<sup>2</sup>

Licences.

The old section, which applied to patents and designs as well as to trade marks, contained a reference to the granting of licences. This is now wholly dropped, no doubt because licences are inapplicable in respect of the rights in a trade mark acquired by registration. A licence to use a trade mark is unnecessary if the trade mark is to be used in connection with the goods of the proprietor of the trade mark,<sup>3</sup> and is illegal, because leading to deception, if it is to be used in connection with the goods of anyone else.<sup>4</sup> The principle of sec. 22 seems to be as applicable to a partial assignment as to an absolute assignment.

Lease of goodwill and trade marks.

If the goodwill of a business be leased for a term, the right to use the trade marks identified with it would during the term pass to the lessee, in the absence of special agreement ; and, if it were reserved, on the principles stated above the lessor could not rightly use the marks. It seems that the registration of the lessee as assignee of the marks without the consent of the lessor, would not, however, be rightly made.<sup>5</sup> Where a company, which had carried on business at Glasgow and elsewhere, sold its Glasgow businesses, and agreed not to carry on business there during ten years from the assignment, and expressly licensed the assignee to use certain trade marks during that term, and the

<sup>1</sup> Sec. 5.

<sup>2</sup> Sec. 33, below, p. 357.

<sup>3</sup> Chap. II., at p. 33.

<sup>4</sup> *Oldham v. James*, 13 Ir. Ch. 393 ; 14 Ir. Ch. 81 (1862) ; and see the remarks of North, J., in *Roger's Tm.*, 12 R. P. C. at p. 158 (1895), and those of Moulton,

L.J., in *Boussoul, Valadon & Co. v. Marchant*, 25 R. P. C. at p. 53 (1908), a trade name case ; also *Thorndoe v. Hill*, 11 R. P. C. 61 (1894).

<sup>5</sup> *Re Avril*, Stirling, J., April 20th, 1888 ; Sebastian, 4th ed. p. 374, cited above, p. 302.



assignee applied to register a trade mark containing a representation of Glasgow Town Hall similar to one that had appeared on labels for whisky bottled at Glasgow by the assignors (the label not being expressly mentioned in the assignment), and the assignors opposed the registration, as they did not admit the applicant's right to the exclusive use of the device, although they did admit his right to use it, the application for registration was refused.<sup>1</sup>

Although if the whole goodwill of a business is leased, the lessor cannot as a rule use the trade marks during the lease; yet where a foreigner, who had registered trade marks for metal bearings, entered into an agreement with persons in this country under which they were during a term of years to purchase the particular alloy for the bearings from him, and were to have the exclusive sale in this country, and the agreement contained clauses under which the goodwill was on the determination of the agreement to revert to the foreigner, it was held that he had sufficient goodwill in bearings during the continuance of the agreement to support an assignment by him of the trade marks and such goodwill.<sup>2</sup>

The sole authorised dealer in goods bearing a particular trade mark in the United Kingdom, who is in a sense a licensee of the trade mark rights, cannot sue for infringement of the trade mark.<sup>3</sup> But a true licensee of the rights, if there can lawfully be such a person, could not sue either.<sup>4</sup>

Action by licensee.

A difficult question of fact may arise in considering whether under particular circumstances a person has purchased the right to represent that he is the successor in business of another. Such a question arose in *Rickerby v. Reay*,<sup>5</sup> where the plaintiff had bought the stock in trade and patterns of a business at a price arrived at on the footing that the chattels were for use in a going concern, and had taken a lease of the premises, and during the lease he continued to use the device of a crown, and the word "crown" which had been previously used in connection with machines sold by the old firm. On the determination of the lease he removed to other works, and questions then arose as to

Purchase or lease of goodwill.

<sup>1</sup> *Roger's Tm.*, 12 R. P. C. 149 (1895), North, J.

<sup>2</sup> *Magnolia Metal Co.'s Tms.*, [1897] 2 Ch. 371; 14 R. P. C. 265 and 621; see above, p. 350.

<sup>3</sup> *Richards v. Butcher*, 7 R. P. C. 288

(1890), Kay, J.

<sup>4</sup> *Heap v. Hartley*, 42 C. D. 461; 5 R. P. C. 603 (1888) (a patent case); *Woolley v. Broul*, [1892] 1 Q. B. 806; 9 R. P. C. 208, 429 (a design case).

<sup>5</sup> 20 R. P. C. 380 (1903).

his rights in the goodwill and such name and device. Byrne, J., referred to Lord Lindley's judgment in *Commissioners of Inland Revenue v. Muller & Co.'s Margarine, Ltd.*,<sup>1</sup> and added, "I may also say that it appears to me that one or more of the elements going to make up what is called goodwill may be retained while others may be parted with, and that all or every<sup>2</sup> of such elements may be disposed of without express mention," and the learned judge held on the facts that the purchaser acquired the right to describe himself as carrying on the business formerly carried on by the old firm, and to use the patterns and device as well as the name "crown" to describe his machines, and that his rights did not determine with the lease.<sup>3</sup>

Registered proprietor can make a title.

The registered proprietor can make a good title to a purchaser of the trade mark and goodwill, who has no notice of any conflicting equitable rights in either which may exist in a third person. But sub-sec. (2) keeps all equities open, so that they may be enforced in like manner as in respect of any other personal property.<sup>4</sup> Therefore in a patent case licensees who took their licence with notice of an agreement for assignment by the licensors and registered the licence were held not to have obtained a valid licence against the assignees, although the actual assignment was made subsequently to the licence, and no notification of the agreement was entered on the Register at the date of the licence.<sup>4</sup>

"Subject to the provisions of this Act."

"Subject to the provisions of this Act" in sec. 38 means, subject to the rule of sec. 22, that a trade mark shall not be assigned or transmitted without the goodwill of the business in the goods for which it has been registered,<sup>5</sup> and subject to the provision that associated trade marks are assignable or transmissible only as a whole and not separately.<sup>6</sup>

An assignment is subject to all rights appearing from the Register to be vested in other persons. These may appear in the registration of the trade mark assigned in the form of limitations or conditions,<sup>7</sup> or by the registration of identical or nearly identical trade marks having been permitted under the provisions of secs. 19, 20 and 21.

<sup>1</sup> Quoted below, p. 360.

<sup>2</sup> This should obviously be "any."

<sup>3</sup> A question also arose as to the name of the premises; see below, p. 361.

<sup>4</sup> *New Ixion Tyre and Cycle Co., Ltd. v. Spilsbury*, [1898] 2 Ch. 137, 484; 15

R. P. C. 330, 567, Kekewich, J., and C. A.

<sup>5</sup> Above, p. 345.

<sup>6</sup> Sec. 27, *Associated Marks*, above, p. 110.

<sup>7</sup> Sec. 12 and sec. 14. Above, pp. 66 and 85.

Section 33 provides as follows:—

“ Subject to the provisions of this Act where a person becomes entitled to a registered trade mark by assignment, transmission, or other operation of law, the Registrar shall, on request made in the prescribed manner, and on proof of title to his satisfaction, cause the name and address of such person to be entered on the Register as proprietor of the trade mark. Any decision of the Registrar under this section shall be subject to appeal to the Court or, with the consent of the parties, to the Board of Trade.”

Registration of assignments, &c.

This section corresponds to the first part of sec. 87 of the Act of 1883, which, so far as regards trade marks, was in the same terms except that the words “ subject to the provisions of this Act ” are added in the new section, and that the provision for an appeal is new.<sup>1</sup> The Board of Trade may under sec. 59 refer to the Court an appeal made to it. The words “ subject to the provisions of this Act,” refer to the rule embodied in sec. 22, that a trade can only be assigned in connection with goodwill,<sup>2</sup> and to the provisions of sec. 27 that associated trade marks cannot be assigned separately.<sup>3</sup>

This section relates to changes of proprietorship ; a change of, or correction of an error in, the name or address of the registered proprietor comes under sec. 32.<sup>4</sup>

In view of the appeal expressly conferred by the section from the decision of the Registrar, an application under sec. 35 for the purpose of reversing a decision of the Registrar would probably not be allowed. Under the Act of 1883, an application to rectify was the only remedy against a refusal of the Registrar to register an assignment or other change of proprietorship.<sup>5</sup>

Registration of the assignment is not, as registration of the mark itself is, a condition precedent to any action for infringement by the assignee.<sup>6</sup>

Action before registration.

In some cases the assignment of a trade mark to new proprietors makes an alteration in its form necessary or advisable. In the case of registered marks, such alteration may be obtained

Alteration of registered mark in consequence of assignment.

<sup>1</sup> Cf. sec. 12 (3) and sec. 14 (5).

<sup>2</sup> Above, p. 345.

<sup>3</sup> Above, p. 110.

<sup>4</sup> Above, p. 313.

<sup>5</sup> Secs. 78, 87 and 90 of the Act of 1883 ; see *Bancroft's Tm.*, 5 R. P. C. 209 (1888), Stirling, J., and *New Ormonde Cycle Co.'s Tm.*, [1896] 2 Ch. 520 ; 13

R. P. C. 475, North, J.

<sup>6</sup> *Ihle v. Henshaw*, 31 C. D. 323 ; 3 R. P. C. 15 (1884), North, J. ; *Richards v. Butcher*, 7 R. P. C. 288 (1890), Kay, J. See, however, *Magnolia Metal Co. v. Atlas Metal Co.*, 14 R. P. C. 389 (1897), and above, p. 338.

under sec. 34, provided that the mark is not altered in a manner substantially affecting its identity.<sup>1</sup> Thus in *Guinness & Co.'s Trade Mark*,<sup>2</sup> Chitty, J., allowed the word *limited* to be added to the name upon an old mark, the business and trade marks of the old firm having been taken over by a company bearing the name of the firm with "limited" added to it, and in other cases the same alteration has been allowed in new marks.<sup>3</sup> But in the case of an old mark the Court, in whom the discretion was formerly vested by sect. 92 of the Act of 1883, was very unwilling to allow any alteration to be made, although it had jurisdiction to do so if special circumstances render it necessary, for it was considered that a mark registered as an old mark ought to be kept on the Register as it was actually used before August 13th, 1875. So, in *Re Henry Clay, and Bock & Co.*,<sup>4</sup> Kekewich, J., refused to allow an old mark to be altered by substituting, for the initials of one predecessor of the proprietors, the name of another and later predecessor, notwithstanding that the mark in its altered form had been registered for some years in Havana, and had been extensively used by the applicants in England.<sup>5</sup> The present Act allows alterations in old marks under sec. 34, and appears to contemplate changes in them from time to time not substantially affecting their identity.<sup>6</sup>

Procedure.

The procedure by which registration of assignments and transmissions of title are governed is laid down in the following rules.<sup>7</sup>

#### *Assignment.*

Joint request for entry of assignment.

"76. The Registrar may on request made jointly by a registered proprietor of a mark and the person to whom he has assigned such mark, together with the goodwill of the business concerned in the goods for which it has been registered, register the assignee as proprietor of the mark. Such application shall be in the Form TM No. 16.<sup>8</sup> If the Registrar so require, the assignee shall furnish a declaration in Form TM No. 17.<sup>9</sup>

Request for entry of assignment by subsequent proprietor.

77. Where no such joint request is made, any person who has become entitled to a registered trade mark by assignment, transmission or other operation of law, may leave a request at

<sup>1</sup> *Murphy's Tm.*, 7 R. P. C. 163 (1890), W. N. 84.

<sup>2</sup> 5 R. P. C. 316 (1888).

<sup>3</sup> See Chap. XI., at p. 318.

<sup>4</sup> [1892] 3 Ch. 549; 9 R. P. C. 449.

<sup>5</sup> See further, Chap. XI., p. 276.

<sup>6</sup> See the proviso to sec. 9.

<sup>7</sup> The old rules were 36 to 40 of the Trade Mark Rules, 1890.

<sup>8</sup> Appendix, p. 686.

<sup>9</sup> Appendix, p. 686.

the Office for the entry of his name in the Register as proprietor of such trade mark. The request shall be on the Form TM No. 18,<sup>1</sup> and such request shall contain the name, address, and description of the person claiming to be entitled to the trade mark, hereinafter called the claimant.

78. Together with such request the claimant shall leave a case stating full particulars of the assignment, transmission, or other operation of law by virtue of which he claims to be entitled to be entered in the Register as proprietor of the trade mark, so as to show the manner in which and the person or persons to whom the trade mark has been assigned or transmitted, and so as to show further that it has been so assigned or transmitted in connection with the goodwill of the business concerned in the goods for which the trade mark has been registered.

Case accompanying request.

79. Such request shall in the case of an individual be made and signed by the claimant, and in the case of a firm or partnership by one or more members of such firm or partnership, and in the case of a body corporate shall be signed by a director or by the secretary or other principal officer of such body corporate.

Signature of request.

80. Where the Registrar shall determine that the case sets out particulars such as entitle the claimant to be registered as proprietor of such trade mark, he shall call upon the claimant to furnish a statutory declaration (Form TM No. 19)<sup>2</sup> verifying the several statements in the case and declaring that the particulars given comprise every material fact and document affecting the proprietorship of the trade mark claimed by such request.

Statutory declaration in support of request.

81. In any case, the Registrar may call on any person who desires to be registered as proprietor of a trade mark for such proof or additional proof of title and of the existence and ownership of such goodwill as aforesaid as the Registrar may require for his satisfaction."

Proof of title.

On an assignment for value of trade marks and goodwill the *ad valorem* stamp duty applicable to a conveyance or transfer on sale is payable.

In one case it was held that in the case of a foreign trader who had no place of business in the United Kingdom, but had registered a trade mark here, and had sent goods into this country, the trade mark and right to use it and the business connection here were property within sec. 59 of the Stamp Act, 1891, and, moreover, were not "property locally situate out of

Stamp on assignment of goodwill and trade marks, &c.

<sup>1</sup> Appendix, p. 687.

<sup>2</sup> Appendix, p. 687.

the United Kingdom" within the exception contained in the same section, notwithstanding that they were assigned with freehold premises in America.<sup>1</sup> But the Court of Appeal has subsequently held that where goodwill and the exclusive right to use a trade name are assigned with premises entirely situate out of the United Kingdom, the goodwill is *primâ facie* annexed to the premises, and is, in the absence of facts rebutting the *primâ facie* presumption, property locally situate out of the United Kingdom.<sup>2</sup> In the case referred to the question was as to the stamping of an agreement for the sale of a wholesale manufacturing business carried on abroad, and having no customers in the United Kingdom or anywhere but in Germany. On appeal to the House of Lords<sup>3</sup> the judgment of the Court of Appeal was affirmed. The question what constitutes goodwill was very fully considered, and the following passages occur in the judgments.

What constitutes goodwill.

Lord Macnaghten said: "It" (goodwill) "is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation, and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates. Goodwill is composed of a variety of elements. It differs in its composition in different trades and in different businesses in the same trade. One element may preponderate here and another element there. . . . For my part, I think that if there is one attribute common to all cases of goodwill it is the attribute of locality. For goodwill has no independent existence. It cannot subsist by itself. It must be attached to a business. Destroy the business and the goodwill perishes with it, though elements remain which may perhaps be gathered up and be revived again. No doubt where the reputation of a business is very widely spread, or where it is the article produced rather than the

<sup>1</sup> *Brooke & Co. v. Commissioners of Inland Revenue*, [1896] 2 Q. B. 356, Pollock, B., and Bruce, J.

<sup>2</sup> *Muller & Co.'s Margarine, Ltd. v. Commissioners of Inland Revenue*, [1900] 1 Q. B. 310; distinguishing *Smelting*

*Co. of Australia v. Commissioners of Inland Revenue*, [1897] 1 Q. B. 175 (sole licence to work patent).

<sup>3</sup> *Commissioners of Inland Revenue v. Muller & Co.'s Margarine, Ltd.*, [1901] A. C. 217.

producer of the article that has won popular favour, it may be difficult to localise goodwill. But here, I think, there is no difficulty. We have it in evidence that the firm of Muller & Co. had no customers out of Germany, and it is a significant fact that the protected area—the limit within which the vendor is prohibited from setting up in business—is the limit of fifty miles from Gildehaus.<sup>1</sup> Moreover, under the Stamp Act, 1891, we are not required to define the local situation of the goodwill. We have only to determine whether it is or is not situate out of the United Kingdom.”

And Lord Lindley said: “Goodwill regarded as property has no meaning except in connection with some trade, business or calling. In that connection I understand the word to include whatever adds value to a business by reason of situation, name and reputation, connection, introduction to old customers, and agreed absence from competition, or any of these things, and there may be others which do not occur to me. In this wide sense, goodwill is inseparable from the business to which it adds value, and, in my opinion, exists where the business is carried on. Such business may be carried on in one place or country or in several, and if in several there may be several businesses, each having a goodwill of its own.”<sup>2</sup>

<sup>1</sup> Where the factory was situate.

<sup>2</sup> This passage was quoted by Byrne, J., in *Rickerby v. Reay*, 20 R. P. C. 380, quoted above, p. 356. It is clearly not necessary however for the purpose of sec. 22 of the Act that the assignor of a trade mark should have a place of busi-

ness in England, he may have a goodwill in England without that. See *Magnolia Metal Co.'s Tms.*, [1897] 2 Ch. 371; 14 R. P. C. 621, C. A.; *Société Anonyme Panhard and Levassor v. Panhard Levassor Motor Co., Ltd.*, [1901] 2 Ch. 513; 18 R. P. C. 405, Farwell, J.

## CHAPTER XIV.

### DETERMINATION OF TRADE MARK RIGHTS.

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Modes of determination

The right of the proprietor of a mark (subject to the rights of other proprietors, if any, of the same mark)<sup>1</sup> to the exclusive use of it upon the goods of the kind in respect of which the right existed is determined :—

- (1) When the mark so used ceases to be distinctive ;
- (2) When the proprietor is no longer able to use it in the business in connection with which the right was acquired ;
- (3) When he has abandoned it ; and
- (4) When he has forfeited his claim to protection of his right by using the mark deceptively or in a fraudulent trade.<sup>2</sup>

<sup>1</sup> See the "three mark rule," p. 224, sec. 38, p. 353, and sec. 39, p. 325.

<sup>2</sup> See Chap. XV., "the action for infringement," defences, at pp. 426 *et seq.*



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

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

### 1. Loss of Distinctiveness.

The first case follows immediately from the definition of a trade mark. It is shown in Chapter II., both from the authorities and the statutory definition contained in the Act of 1905, that the function of a trade mark is to distinguish the goods to which it is applied or attached from similar goods, and to identify them with a particular trader and his successors in business. And distinctiveness is an essential condition of capacity for registration under the Acts.<sup>1</sup> Further, the test of infringement is that the use of the mark, or of a similar mark, by others than the proprietor, is calculated to cause their goods to be bought as his.<sup>2</sup> So that, apart from the Acts, a mark which has ceased to be distinctive is incapable of being the subject of trade mark rights, and no action for infringement could be successfully brought to prevent any trader using it, and if not already registered, it would be incapable of registration under the Acts.

The elements of distinctiveness have been considered at length elsewhere,<sup>3</sup> and it will be sufficient here to refer to some of the modes in which a mark may cease to be distinctive, and to give a few examples of cases in which the question has arisen. Marks are not distinctive if they are merely descriptive,<sup>4</sup> and, in particular, if they have been adopted in the trade concerned as the names of the goods for which they are claimed as trade marks,<sup>5</sup> or are common marks,<sup>6</sup> or marks common to the trade,<sup>7</sup> or if they connect the goods not with their proprietor but with some other trader.<sup>8</sup>

How distinctiveness may be lost.

<sup>1</sup> Chap. VIII., p. 127.

<sup>2</sup> *Mitchell v. Henry*, 15 C. D. 181 (1880), James, L.J.; *Edwards v. Dennis*, 30 C. D. 454 (1885), Cotton, L.J.; see also *Ford v. Foster*, 7 C. D. 611, cited below, p. 365.

<sup>3</sup> Chap. II., at p. 35; Chap. VIII., at p. 174.

<sup>4</sup> See above, descriptive marks, pp. 37 and 183; devices, p. 184; words, p. 142.

<sup>5</sup> Page 37.

<sup>6</sup> Page 177; see also the "three mark rule," Chap. IX., at p. 215.

<sup>7</sup> Page 214.

<sup>8</sup> *Wood v. Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A. (*Eton*

By the action  
of the pro-  
prietor.

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

Thus, if the proprietor abandons his mark,<sup>1</sup> it will almost inevitably become a common mark, unless there are other persons who have trade mark rights in it which they assert.<sup>2</sup> So, if he uses it himself as the name of the goods he deals in, the trade will probably adopt the same course, especially if he is for a time the only dealer in the goods.<sup>3</sup>

Before the Registration Acts a difficult question of fact was often raised in trade mark cases where admittedly a name or other mark had been introduced by the plaintiff, but it was alleged that it had by repeated use on the goods of other traders lost its original significance indicating a connection with the plaintiff, and had become *publici juris*.<sup>4</sup> A case of this type came before the Privy Council on appeal from New South Wales in *The National Starch Manufacturing Company v. Munn's Patent Maizena, &c. Company*.<sup>5</sup> The plaintiffs had invented the word *Maizena* for flour made from maize and had introduced flour under that name to New South Wales in 1863, but they had not registered the word there until 1889. The defendants' predecessors commenced to sell *Maizena* in New South Wales in 1867, and the plaintiffs took no steps against them there until the action, which was founded on the trade mark and common law rights, but they had taken proceedings successfully in other countries to restrain the use of *Maizena* in connection with the defendants' flour. It was held that, in view of the use in New South Wales by the defendants and other firms of the word in question before 1889, it had become *publici juris*, and the action was dismissed and the mark removed from the Register. The plaintiffs contended that the defendants' user had been originally fraudulent and was continued in fraud, but this was not so found. On this point Lord Ashbourne said: "If during the period in question,<sup>6</sup> the word was only used in the colony for the

*Cigarettes*); *Wolff v. Nopitsch*, 17 R. P. C. 321 (1900), Cozens-Hardy, J. (*Spanish Graphite*); see, however, in C. A., 18 R. P. C. 27 (1901).

<sup>1</sup> See below, p. 370.

<sup>2</sup> As, for instance, in *Daniel and Arter v. Whitehouse*, [1898] 1 Ch. 685; 15 R. P. C. 134; Barnes, J., a passing-off case, where the defendant lost a concurrent right by non-user for some years.

<sup>3</sup> *Linoleum Manufacturing Co. v. Nairn*, 7 C. D. 834 (1878), Fry, J.; *Gestetner's Tm.*, [1907] 2 Ch. 478; [1908] 1 Ch. 513; 24 R. P. C. 545; 25 R. P. C. 158, Neville, J., and C. A. (*cyclostyle*).

<sup>4</sup> See *Ford v. Foster*, 7 Ch. 611 (1872); *Singer Manufacturing Co. v. Wilson*, 2 C. D. 434; 3 App. Ca. 376 (1875).

<sup>5</sup> [1894] A. C. 275; 11 R. P. C. 281.

<sup>6</sup> 1865 to 1889.

fraudulent purpose of counterfeiting their goods, the right of the appellants to register it as their trade mark would not be impaired. If, on the contrary, it was used and understood before 1889 as a term descriptive of the article, as a product of maize, and did not denote such product to be the manufacture or merchandise of a particular person, then it must be regarded as having become, in the sense of law, *publici juris*." The difficulty is not so likely to arise in the case of a registered mark,<sup>1</sup> since the public advertisement of the registration, and the readiness with which the infringement of a properly registered mark can be prevented,<sup>2</sup> both tend to warn other traders against the use of the mark and to enable the proprietor to protect his rights.

Extensive infringement by a single trader can hardly suffice to make a trade mark common. "It has been said that one murder makes a villain, and millions a hero; but I think it would hardly do to act on that principle in such matters as this, and to say that the extent of a man's piratical invasion of his neighbour's rights is to convert his piracy into a lawful trade."<sup>3</sup> Nor will a few unprosecuted scattered infringements by several traders.<sup>4</sup>

"There is no doubt, I think," said Mellish, L.J., in *Ford v. Foster*,<sup>5</sup> "that a word which was originally a trade mark, to the exclusive use of which a particular trader, or his successors in trade, may have been entitled, may subsequently become *publici juris*, as in the case which has been cited of *Harvey's Sauce*.<sup>6</sup> I think the test must be whether the use of it by other persons is still calculated to deceive the public,<sup>7</sup> whether it may still have the effect of inducing the public to buy goods not made by the original owner of the trade mark as if they were his goods. If the mark has come to be so public and in such universal use that nobody can be deceived by it, and can be induced from the use of it to believe that he is buying the goods of the original trader, it

By extensive piracy.

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

<sup>1</sup> See *Hudson's Application*, 24 R. P. C. 552 (1907), Joyce, J. (*Thunderer* for whistles), where the investigation on applications for registration by rival traders disclosed the fact that the name was *publici juris*.

<sup>2</sup> Secs. 39, 40 and 41. See above, pp. 325, 329, 330. Act of 1883, sec. 76.

<sup>3</sup> Per James, L.J., in *Ford v. Foster*, L. R. 7 Ch. p. 625.

<sup>4</sup> *Kinahan v. Bolton*, 15 Ir. Ch. 75

(1863), Brady, C.; *Rowland v. Michell*, below, p. 367, note (1).

<sup>5</sup> L. R. 7 Ch. p. 628 (1872).

<sup>6</sup> *Lazenby v. White*, 41 L. J. Ch. 354 (1871).

<sup>7</sup> So the long duration of fraudulent user is immaterial, if it is still calculated to deceive: *Heaton's Tm.*, 27 C. D. 570 (1884), Kay, J. (*Hoop & Iron*); and the judgment of Ld. Ashbourne in the *Maizena* case, quoted above, p. 364.

appears to me, however hard to some extent it may appear on the trader, yet practically, as the right to a trade mark is simply a right to prevent the trader from being cheated by other person's goods being sold as his goods through the fraudulent use of his trade mark, the right to the trade mark must be gone."<sup>1</sup>

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

Upon the facts of the case, the Lords Justices held that the name in question had become *publici juris* to this extent, "that by the use of it in trade circulars, which are issued only to retail dealers, or by shirts being invoiced by the wholesale dealers as '*Eureka Shirts*,' no retail dealer would be likely to be deceived, or be led to buy shirts which were not made by Ford believing they were Ford's shirts," but that a considerable portion of the public who buy shirts for the purpose of wearing them would still be very liable to be deceived by the use of the word *Eureka* on the shirt itself. And the injunction granted by the Court accordingly left the defendants at liberty to advertise the name *Eureka* as between themselves and the trade.<sup>2</sup>

Amount of common user necessary.

Where common user is alleged of a trade mark that has been long used and registered, in order to establish this, the use by other persons should be substantial. Thus where it was alleged that a cat and barrel were common to the trade in gin at the date of the plaintiff's registration in 1879, it was held not to be sufficient to have proved nothing more than "a very sporadic use of the labels with a cat and barrel on them." It was found that there had been in the case of none of the users of such labels, other than the plaintiffs, any trade that would associate their goods with a cat and barrel.<sup>3</sup> But it has been held that it may be sufficient to prove common use in the trade in advertisements, show cards, &c., without actual use on the goods, if by reason of such use the mark is not distinctive of the goods of the alleged proprietor.<sup>4</sup>

Where a plaintiff is alleged to have lost his rights by not interfering with infringers, the character and extent of the trade of the latter, as well as their position, must be taken

<sup>1</sup> See also *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238, n.; and *Hyde & Co.'s Tm.*, 7 C. D. 724, both (1878), Jessel, M.R.

<sup>2</sup> L. R. 7 Ch. p. 634; cf. *Singer, &c. Co. v. Spence*, 10 R. P. C. 297 (1893), Romer, J., and *Singer, &c. Co. v. British Empire Manufacturing Co., Ltd.*, 20 R. P. C. 313 (1903), Kekewich, J.

<sup>3</sup> *Boord & Son v. Thom and Cameron,*

*Ltd.*, 24 R. P. C. 697, at p. 721 (1907), Court of Session. Query whether it is necessary that there should be such user as would (if the mark were not common) associate the goods with the person using it. See the next case cited.

<sup>4</sup> *Louise v. Gainsborough*, 20 R. P. C. 61 (1903), Farwell, J.

into account in considering whether he is barred by his neglect to take proceedings.<sup>1</sup>

## 2. Separation of the Mark from the Goodwill.

It has been shown in the last chapter that the trade mark rights in a mark are inseparable from the goodwill of the business in the goods upon which the mark is used, for the function of the mark is to connect the goods with the trader who owns the business, and his successors.<sup>2</sup> The indication of that connection is its original signification, and it cannot legally be used as a trade mark with any other.<sup>3</sup> It follows that if the goodwill is lost, or passes into other hands than those of the proprietor of the mark,<sup>4</sup> the exclusive rights of the proprietor in respect of the use of the mark are determined, and this rule is recognised by the Acts in the case of registered marks. Section 22 of the Act of 1905 enacts that a trade mark "shall be assigned and transmitted only in connection with the goodwill of the business concerned in the goods" for which it has been registered, and the latter section expressly adds "and shall be determinable with such goodwill."<sup>5</sup> And, although an assignment of a trade mark be inoperative by reason of being an assignment in gross, the assignor may lose his right to the mark by such assignment, at all events if the assignee has acted upon the assignment. Thus, where an exclusive licence in gross for a term of years to use a trade name was granted, it was held that the assignor had at the end of the term lost his right to claim that the name indicated his manufacture.<sup>6</sup> Sec. 22.

No question seems to arise as to whether the registered owner of a trade mark which has determined by separation from the goodwill of the business can sue for infringement; for sec. 39, which grants the right of exclusive use to the proprietor of a registered No exclusive right in a registered mark apart from the goodwill.

<sup>1</sup> *Rowland v. Mitchell*, 13 R. P. C. 457; 14 R. P. C. 37 (1897), Romer, J., and C. A.; and see also *Ripley v. Bandy*, 14 R. P. C. 591 (1897), Kekewich, J., where judgment was given for the defendant on the ground of the neglect of the plaintiff to assert his right against infringers. An appeal was settled, 14 R. P. C. 944.

<sup>2</sup> See the statutory definition, Chap. III., p. 57, and the judgment of Mellish, L.J., in *Ford v. Foster*, cited

above, and Chap. II., p. 22.

<sup>3</sup> See the judgment of Fry, L.J., in *Pinto v. Badman*, 8 R. P. C. 131 (1891), cited above, p. 349.

<sup>4</sup> *Thorneloe v. Hill*, 11 R. P. C. 61 (1894); and cf. *Harness' Tm.*, 17 R. P. C. 40 (1900).

<sup>5</sup> Sec. 2 of the Act of 1875 and sec. 70 of the Act of 1883, below, p. 631, were to the like effect.

<sup>6</sup> *Thorneloe v. Hill*, 11 R. P. C. 61 (1894), Romer, J.

mark, makes the grant subject to the registration being valid, and consequently subject to sec. 22. As already pointed out,<sup>1</sup> sec. 41 does not appear to assist a plaintiff in such a case. And by sec. 40 registration is *prima facie* evidence only of the validity of the original registration, and of all subsequent assignments and transmissions.

By Rule 81 the Registrar may call on any person who desires to be registered as proprietor of a trade mark for such proof or additional proof of title and of the existence and ownership of such goodwill as aforesaid (that is, of the business concerned in the goods for which the trade mark has been registered) as he may require for his satisfaction.<sup>2</sup>

Removal of  
mark when  
the goodwill is  
determined.<sup>3</sup>

It was provided by Rule 34 of the Rules of 1876, that—"The Court may, on the application of any person aggrieved, remove any trade mark from the Register on the ground, after the expiration of five years from the date of the registry thereof, that the registered proprietor is not engaged in any business concerned in the goods within the same class as the goods with respect to which a trade mark is registered." And in *Ralph's* case,<sup>4</sup> where the registered proprietor had not manufactured the machine for which the mark was registered for twenty-one months before the date of the application, Pearson, J., in accordance with the rule, directed the mark to be removed.

The rule has not been since re-enacted, and the Act of 1883 contained no express provision enabling a properly registered mark to be removed except for non-payment of fees after fourteen years,<sup>5</sup> or at the request of the proprietor.<sup>6</sup> But it was held under that Act that a mark was not properly registered, and it might be removed, if it was not registered with a *bona fide* intention to use it for the goods in respect of which it is registered;<sup>7</sup> and the judgment of the Court of Appeal in *Batt's Trade Mark* supports the proposition that if at any time after registration the proprietor ceased to have such intention, the mark was on the Register without sufficient cause and might be removed.<sup>8</sup>

The rectification section of the Act of 1905 (sec. 35) expressly extends to the case of a mark "wrongly remaining on the

<sup>1</sup> Above, p. 330.

<sup>2</sup> Above, p. 359.

<sup>3</sup> See below, p. 372.

<sup>4</sup> 25 C. D. 194 (1883), cited below,  
p. 369.

<sup>5</sup> Sec. 79.

<sup>6</sup> Sec. 91.

<sup>7</sup> *Batt v. Dunnell*, [1899] A. C. 428;  
16 R. P. C. 411; and *supra*, pp. 292  
*et seq.*

<sup>8</sup> [1898] 2 Ch. 432; 15 R. P. C. 534.

Register," so that if the goodwill of the business concerned in the goods for which a trade mark has been registered determines, it seems clear that by the combined operation of secs. 22 and 35 the trade mark would be liable to be removed from the Register. Moreover, although there has not been a total determination of goodwill, and although the proprietor still trades in the goods in question, yet non-user may be a ground for removal from the Register.<sup>1</sup>

A mere temporary cessation of business,<sup>2</sup> or delay in the transfer of the goodwill,<sup>3</sup> would not determine the trade mark rights. The judgment of Pearson, J., in *Ralph's* case,<sup>4</sup> notwithstanding the repeal of the Rule on which it was founded, may be referred to on the question what length of cessation of a business determines the goodwill, and therefore also the trade mark rights attached to it. "The only question I have to determine," he said, "is whether one year and nine months is sufficient cesser on the part of Mr. Ralph to show that he comes within the (34th) rule. I am of opinion that one year and nine months is quite sufficient. If I had any doubt about it, I am able by analogy to say that I should not be wrong in concluding that one year and nine months is sufficient, from the fact that under the Companies Act you may wind up a company if it has ceased to carry on business for a year. The Legislature in that has shown by its enactment when a business is supposed to be carried on, and what amount of cesser shows that the business is not being carried on." And it made no difference, he held, that the cessation of business was due to the ill-health of the proprietor. But the view that a goodwill would determine in so short a time is not consistent with the facts of ordinary business.<sup>5</sup>

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

In a case where the licensees of a patent had, by arrangement with the patentees, registered a trade mark and used it on the patented goods, and on the determination of the licence the patentees contended that the mark ought to be expunged from the Register on the ground that the goodwill of the licensees had determined, as they could not make the patented goods, the application was dismissed, it being held that the mark in fact indicated the licensees as the source of the goods.<sup>5</sup>

<sup>1</sup> Sec. 37. It is fully dealt with above, p. 293.

<sup>2</sup> See the next page. Sec. 31 suggests three years non-user as a minimum. See p. 373.

<sup>3</sup> *Welcome's Tm.*, 213 C. D. 76; 3 R. P.

T.M.

C. 76 (1886); *Hammond v. Brunner*, 9 R. P. C. 301 (1892), both Chitty, J.

<sup>4</sup> Above, p. 368.

<sup>5</sup> *Freeman Bros. v. Sharpe Bros. & Co., Ltd.*, 16 R. P. C. 205 (1899), North, J.

### 3. Abandonment.

A trade mark right, as any other right, can, of course, be abandoned by the owner; but, so long as he remained the registered proprietor of the mark and carried on the business to which the mark was attached, it would be difficult, if not impossible, to show abandonment, unless, either by repeated and undisturbed infringements, or by the use of the mark by the proprietor himself in some way inconsistent with the maintenance of its character as a trade mark, it had become a common mark so as to fall under the first case,<sup>1</sup> or a case could be made by any particular defendant sued for infringement by the owner to show that he had been led by the conduct of the plaintiff to believe that the mark was a common mark, and so to set up an estoppel.<sup>2</sup>

Agreement to  
abandon  
trade mark.

The possible case of an agreement by the proprietor to abandon his mark stands by itself. The other party to the agreement, if sued for infringement, could no doubt rely upon it as a defence, and probably could, if the mark were registered, obtain the removal of the mark from the Register, or an order, by way of specific performance of an implied term in the agreement, that the proprietor should apply under sec. 32 to cancel the registration.

Not mere  
disuse.

Mere disuse of the mark does not amount to abandonment of trade mark rights in respect of it. For "A man who has a trade mark may properly have regard to the state of the market and the demand for the goods; it would be absurd to suppose that he lost his trade mark by not putting more goods on the market when it was glutted."<sup>3</sup> Accordingly, in the case cited, a mark was directed to be registered concurrently with a similar mark in the same class which had been previously registered, and which the Court refused to expunge, although the proprietor of the former mark, having adopted it in 1874 and used it largely

<sup>1</sup> Above, p. 363.

<sup>2</sup> See the next chapter; estoppel, p. 419; acquiescence, p. 421; and delay, p. 423. See also *Browne v. Freeman*, 12 W. R. 305; 4 New Rep. 476 (1864), Wood, V.-C., where the dismissal, at his own request, of a previous suit by the plaintiff against the defendant, to restrain the use by the latter of *Chlorodyne*, was treated as conclusive against him that he had no exclusive right to use the word.

He brought a third suit in 1873; W. N. 178.

<sup>3</sup> Per Chitty, J., in *Mouson v. Boehm*, 26 C. D. 398 (1884). But if in the meantime the mark had come to indicate exclusively the manufacture of the registered owner, its use by another would have been deceptive. Cf. *Daniel and Arter v. Whitehouse*, [1898] 1 Ch. 685; 15 R. P. C. 134 (a passing-off case).



in the two years following, from 1876 to 1882 had used it less and less, and had in the last-mentioned year forgotten and ceased to use it altogether. He had not, however, broken up the moulds he used for the marked goods, or erased the mark from his books or price lists. But if a proprietor ceases to have an intention of dealing in the goods for which the mark is registered, that would necessarily entail an abandonment of the mark so far as such goods were concerned.<sup>1</sup> And from a long disuse an intention to abandon might be inferred.<sup>2</sup>

Under sec. 37 of the Act of 1905 non-user for five years in connection with any goods for which the trade mark is registered may be a cause for removal of the mark from the Register, and in effect in such a case is treated as an abandonment of the trade mark so far as rights arising from registration are concerned, unless "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."<sup>3</sup> The Court, however, has a discretion under the section.

The adoption of a new mark may be evidence of the abandonment of an old one.<sup>4</sup> But the fact of itself is not conclusive, for it is no justification for the defendant to say, "The plaintiff has two ways of identifying his goods, and I have only stolen one of them."<sup>5</sup> So where, in opposition to the registration in 1896 of a mark as an old mark, it was shown that a new label had been adopted in 1877, and it was contended that the old mark had been abandoned either then or previously, but it was proved that a large number of the old labels had been ordered in 1877, and that there had been occasional user of them since, and that the stock of them had never been exhausted, it was held that there had been no abandonment.<sup>6</sup> The fact that the owner of a word mark uses it always in connection with his own name is not conclusive to show that the mark is not a trade mark, or that he has waived his rights in it as such.<sup>5</sup>

Adoption of a new mark.

Use in connection with the proprietor's name.

Neglect to proceed in respect of infringements which do not

Neglect to prosecute infringements.

<sup>1</sup> *Batt's Tm.*, see above, p. 292.

<sup>2</sup> Per Farwell, J., in *Louise & Co., Ltd. v. Gainsborough*, 20 R. P. C. 61 (1903); and see *Hart's Tm.*, [1902] 2 Ch. 621; 19 R. P. C. 569.

<sup>3</sup> Sec. 37 is more fully considered above, p. 293.

<sup>4</sup> *Lea v. Miller*, Seb. Dig. p. 305 (1876),

Jessel, M.R.

<sup>5</sup> Per Wood, V.C., in *Braham v. Bustard*, 1 H. & M. 447; 9 L. T. N. S. 199 (1863) (*Excelsior White Soap*).

<sup>6</sup> *Wright, Crossley & Co.'s Application*, [1900] 2 Ch. 218; 17 R. P. C. 386, Byrne, J.

amount to user sufficient to affect the distinctiveness of the mark does not affect the proprietor's rights if he is aware of the infringements,<sup>1</sup> still less if he is not.<sup>2</sup>

#### 4. Forfeiture of Right to Protection.

The forfeiture of the right of the proprietor of a trade mark to have his trade mark protected by the Court is discussed elsewhere, under the head of defences to an action for infringement.<sup>3</sup>

#### 5. Removal of Mark from the Register.

A trade mark may be removed from the Register, (a) at the instance of the registered proprietor or some person entitled by law to act in his name;<sup>4</sup> (b) by the Court on an application to rectify the Register under sec. 35;<sup>5</sup> or (c) by the Registrar on non-payment of renewal fees.

Removal by  
the Registrar  
for non-pay-  
ment of fees.

Under the Act of 1883 the registration was perpetual, subject to liability to removal on non-payment of the prescribed fee at the end of each period of fourteen years.<sup>6</sup> Under the Act of 1905, registration is only for a period of fourteen years, but is renewable from time to time. The position is substantially the same assuming that, as is submitted is the case, the sections printed below do not authorise the Registrar to impose conditions other than those relating to the time and manner of the application for renewal. The sections of the Act of 1905 and the Rules dealing with the renewal of registration are as follows:—

Duration of  
registration

“28. The registration of a trade mark shall be for a period of fourteen years, but may be renewed from time to time in accordance with the provisions of this Act.

Renewal of  
registration

“29. The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period, renew the registration of such trade mark for a period of fourteen years from the expiration of the original registration or of the last renewal of registration, as the case may be, which date is herein termed ‘the expiration of the last registration.’

<sup>1</sup> *Kinahan v. Bolton*, 15 Ir. Ch. 75 (1863), Brady, C.; *Ford v. Foster*, L. R. 7 Ch. 611 (1872), L.J.J.; *Rowland v. Mitchell*, 13 R. P. C. 457; 14 R. P. C. 37 (1897), Romer, J., and C. A.; and see above, p. 367.

<sup>2</sup> *Re Farina*, 27 W. R. 456 (1879),

Hall, V.-C. See the next chapter, at p. 423.

<sup>3</sup> Chap. XV., at p. 426.

<sup>4</sup> Sec. 32, above, p. 314.

<sup>5</sup> Above, p. 278. Sec. 37 provides for rectification under sec. 35 on a special ground.

<sup>6</sup> Sec. 79 of the Act of 1883.

“30. At the prescribed time before the expiration of the last registration of a trade mark, the Registrar shall send notice in the prescribed manner to the registered proprietor at his registered address of the date at which the existing registration will expire and the conditions as to payment of fees and otherwise upon which a renewal of such registration may be obtained, and if at the expiration of the time prescribed in that behalf such conditions have not been duly complied with, the Registrar may remove such trade mark from the Register, subject to such conditions (if any) as to its restoration to the Register as may be prescribed.

Procedure on expiry of period of registration.

“31. Where a trade mark has been removed from the Register for non-payment of the fee for renewal, such trade mark shall, nevertheless, for the purpose of any application for registration during one year next after the date of such removal, be deemed to be a trade mark which is already registered, unless it is shown to the satisfaction of the Registrar that there had been no *bonâ fide* trade user of such trade mark during the two years immediately preceding such removal.”

Status of unrenewed trade mark.

The Rules are as follows :—

“68. At any time not less than two months and not more than three months before the expiration of the last registration of a trade mark any person may leave at the office a fee for the renewal of the registration of the mark upon Form TM No. 12.<sup>1</sup> Such person shall indorse upon such form his name and address, and before taking any further step the Registrar may require such person to furnish within five days an authority to pay such fee signed by the registered proprietor, and if such person does not furnish such authority, may return such fee and treat it as not received.

“69. When he does not require such authority, the Registrar shall upon receipt of such fee communicate with the registered proprietor at his registered address, stating that the fee has been received and that the registration will in due course be renewed.

Notification of receipt of renewal fee.

“70. At a date not less than one month and not more than two months before the expiration of the last registration of a mark, if no fee upon the Form TM No. 12 has been received, the Registrar

Notice before removal of trade mark from Register.

<sup>1</sup> Appendix, p. 684. The ordinary fee is £1 for each mark, but there are concessions in the case of a series of marks,

and in the case of a mark registered under sec. 62 for goods in more than one class, see List of Fees, p. 704.

shall send to the registered proprietor at his registered address a notice in the Form O No. 3.<sup>1</sup>

Second notice  
before  
removal of  
trade mark  
from Register.

“71. At a time not less than fourteen days and not more than twenty-eight days before the expiration of the last registration of a mark, the Registrar shall, if no renewal fee has been received, send a notice to the registered proprietor at his registered address in the Form O No. 4.<sup>2</sup>

Advertise-  
ment of non-  
payment.

“72. If at the date of the expiration of the last registration of a mark the renewal fee has not been paid, the Registrar shall advertise the fact forthwith in the Journal, and if within one month of such advertisement the renewal fee upon Form TM No. 13,<sup>3</sup> together with an additional fee upon Form TM No. 14,<sup>4</sup> is received, he may renew the registration without removing the mark from the Register.

Removal of  
trade mark  
from Register.

“73. Where after one month from such advertisement such fees have not been paid, the Registrar may remove the mark from the Register as of the date of the expiration of the last registration, but may upon payment of the renewal fee upon Form TM No. 13, together with the additional fee upon the Form TM No. 15,<sup>5</sup> restore the mark to the Register if satisfied that it is just so to do, and upon such conditions as he may think fit to impose.

Cause of  
removal to be  
registered.

“74. Where a trade mark has been removed from the Register the Registrar shall cause to be entered in the Register a record of such removal and of the cause thereof.

Notice and  
advertise-  
ment of  
renewal.

“75. Upon the renewal of a registration a notice to that effect shall be sent to the registered proprietor at his registered address and the renewal shall be advertised in the Journal.”

The time table laid down by the above sections and rules is as follows:—During the third month before expiration of the registration, the registered proprietor or an authorised person may apply for renewal; in default the Registrar during the second month before expiration gives the first warning notice, on further default he gives a second warning notice during the fourth or third week before expiration; up to the date of expiration the ordinary fee only is payable; in default of renewal before expiration there is advertisement in the Journal forthwith, and if the additional fee is paid within one month after the advertise-

<sup>1</sup> Appendix, p. 684.

<sup>2</sup> Appendix, p. 684.

<sup>3</sup> Appendix, p. 685.

<sup>4</sup> Appendix, p. 685, additional fee, 10s.

<sup>5</sup> Appendix, p. 686, additional fee, £1.

ment, the Registrar may renew; in default the Registrar may remove the mark, but a discretion is given to him to restore it on payment of a higher additional fee. There appears to be an absolute right to renewal under sec. 29, if the application is made in the prescribed time and manner, including the payment of fee; and it is submitted that the words "the conditions as to fees and otherwise," in sec. 30, only authorise conditions as to fees, time, and manner, so that, for instance, the Registrar could not impose a condition that the registered proprietor should disclaim part of the registered mark; and this seems to be the view taken in drafting the forms of notice referred to in Rules 70 and 71. It is clear, however, that if the trade mark has been properly removed from the Register, the Registrar has a discretion as to restoring it, and it may be also that he has some discretion if the renewal has not been made before expiration, the wording of Rule 72 being permissive.

Right to renewal.

The owner of a trade mark which has been removed from the Register for non-payment of fees may, of course, make a new application for registration, but the removal may entail serious consequences, for the owner on a fresh application must justify the registration as at the date of the application. This is illustrated in a case in which an old mark had been removed for accidental non-payment of fees and was re-registered after a lapse of two years; but it was held that before the fresh registration the mark had, as to certain of the goods for which it was registered, become descriptive of the article, and that registration was therefore held to be invalid as to such goods.<sup>1</sup>

Re-registration.

Section 31 has reference to sec. 19;<sup>2</sup> its main object is the protection of the public. It is directed to prevent the registration by another trader, for the same goods or description of goods, of a mark the same as the removed mark, or so nearly resembling it as to be calculated to deceive, until such time after the removal of the other as is considered sufficient to allow the other to be forgotten, so that the new mark may not be taken for that of the proprietor of the old mark. The period provided for by the Act of 1883 was five years, but this was altered by the Act of 1888 to one year on the recommendation of Lord Herschell's

Status of removed mark.

<sup>1</sup> *Bourne v. Swan and Edgar, Ltd.*, [1903] 1 Ch. 211; 20 R. P. C. 105, Farwell, J. (*Swanbill* for corsets).

sub-sec. 5 of sec. 79 of the Act of 1883, which was amended by sec. 19 of the Act of 1888.

<sup>2</sup> Chap. X., p. 222. It corresponds to

Committee.<sup>1</sup> The proviso "unless, &c.," is new,<sup>2</sup> being substituted for one added by sec. 19 of the Act of 1888, which was as follows: "Unless it is shown to the satisfaction of the Comptroller that the non-payment of fees arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under the proprietor or under his bankruptcy is using the trade mark."

If the proprietor of the removed trade mark is in fact using it, then even after the expiration of the two years prescribed by the section he would have the ordinary right of the owner of an unregistered trade mark to oppose re-registration of the mark, or registration of a mark closely resembling it, on the ground that the proposed trade mark would be calculated to deceive.<sup>3</sup>

<sup>1</sup> Report of 1888, p. xiii.

<sup>2</sup> Cf. sec. 37.

<sup>3</sup> See 11, above, p. 266.

## CHAPTER XV.

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It is convenient to deal separately with actions which are brought to prevent or to recover damages for the infringement of trade marks, and with what are compendiously described as "passing-off actions." In an action of the first class the plaintiff complains that the defendant has infringed his trade mark by taking it in its entirety, or by taking a substantial portion of it, or by colourably imitating it, and he relies on his title to the exclusive use of the mark in question for goods of a specified kind; in an action of the second class the plaintiff's case is less specialised, for he complains that the defendant is using means which are calculated to pass off, or to cause to be passed off, the goods of the defendant as and for those of the plaintiff, and the means may or may not comprise or consist of an infringement of a trade mark to which the plaintiff has a title. The distinction between the two classes of actions has been accentuated by the provision, already discussed, which makes registration a condition precedent, in general, to the institution of actions ranking in the first class, that is, trade mark actions proper.<sup>1</sup> They are, however, closely connected, and in practice they are frequently combined, the statement of claim alleging both infringement and passing-off. The first class is in reality a specialised variety of the second, having been divided off from other passing-off actions when property in a trade mark was first adopted as the ground of jurisdiction.<sup>2</sup> Moreover, as the test of infringement is still whether, by reason of its resemblance to the plaintiff's mark, the defendant's mark is calculated to lead purchasers to believe that the goods on which it appears are those of the plaintiff, every case of infringement would be a case of

Actions for  
infringement  
of trade mark  
and actions  
for passing-  
off.

<sup>1</sup> Chap. XII., p. 334.

<sup>2</sup> Chap. I., pp. 4 and 13.

passing-off but for the fact that where the actual mark is taken, or an obvious imitation is made, the Court does not trouble to inquire whether deception is likely to result, and, in the former case, it seems that it is precluded from doing so by the provision that registration, if valid, gives an exclusive title to the use of the registered mark.<sup>1</sup>

### 1. Commencement of the Action.

In what Court a trade mark action should be commenced.

Jury.

The great majority of actions in respect of the infringement of trade marks are commenced in the Chancery Division of the High Court,<sup>2</sup> but such actions are not specially assigned to that division, and they have been occasionally transferred from it to the King's Bench Division in order to be there tried by jury.<sup>3</sup> This was done by Kay, J., in a case where the defendant submitted to a perpetual injunction and the question of damages only remained, on the ground that in trade cases a jury is the best tribunal to assess damages;<sup>4</sup> but in an earlier case, where the right to the injunction was contested, the defendants having given notice requiring the trial to be by a judge and a special jury, Bacon, V.-C., ordered that the action should be by a judge alone.<sup>5</sup> The last-named judge also refused to order the complicated and difficult case of *The Singer Manufacturing Co. v. Loog*<sup>6</sup> to be transferred to the Common Law Division so that the issues involved might be there tried with a jury, on the ground that the questions to be determined involved matters of law as well as fact, and were unfit to be dealt with by a jury.

No jurisdiction in the County Court.

An action for infringement of a trade mark cannot be brought in the County Court,<sup>7</sup> although a trade mark is not a franchise, as a patent is.<sup>8</sup> Such an action is not a personal action within the meaning of sec. 56 of the County Courts Act, 1888.

<sup>1</sup> Sec. 39, Chap. XII., p. 325; and see *Edwards v. Dennis*, 30 C. D. 454 (1885), C. A.

<sup>2</sup> Or the Court of Chancery of the County Palatine of Lancaster. This Court has jurisdiction under sec. 71 of the Act of 1905, replacing sec. 112 of the Patents, &c., Acts, 1888 (Act of 1888, s. 26).

<sup>3</sup> See *Re Martin, Hunt v. Chambers*, 20 C. D. 365 (1882); and Ord. 36, r. 6.

<sup>4</sup> *Fennessy v. Rabbits*, 56 L. T. 138

(1887).

<sup>5</sup> *Spratt's Patent v. Ward & Co.*, 11 C. D. 240 (1879).

<sup>6</sup> 11 C. D. 656 (1879). In *Fennessy v. Clark*, 37 C. D. 184 (1887), the issues of fact were ordered to be tried by a judge and special jury.

<sup>7</sup> *Bow v. Hart*, [1905] 1 K. B. 592; 22 R. P. C. 222, C. A.

<sup>8</sup> *Queen v. County Court Judge of Halifax*, [1891] 2 Q. B. 263; 8 R. P. C. 338, Pollock and Charles, JJ., and C. A.

Service of the writ out of the jurisdiction may be allowed if the case falls under any of the classes enumerated in Order 11, rule 1, for instance, if the plaintiff seeks an injunction to restrain infringements within the jurisdiction;<sup>1</sup> but if the defendant carries on business in Ireland or Scotland, and not at all, or only to an inconsiderable extent, in England, leave to serve the writ upon him in either of the first-mentioned countries will be refused, and the plaintiff will be left to pursue his remedies in the local Courts.<sup>2</sup> On this ground leave to serve out of the jurisdiction has been refused even where an application to register the defendant's mark was pending before the Comptroller in London on which the same witnesses would be required as in the action,<sup>3</sup> and also where a motion to expunge the defendant's mark was pending in the English Courts.<sup>4</sup> In the former case<sup>5</sup> the refusal was based partly on the fact that if an injunction were granted it could not be enforced against the defendant personally in England, but only against his agents. But where a Scotch manufacturing company had three branches and an important business in England, leave was granted to sue them here.<sup>6</sup>

Service out of the jurisdiction.

An alien, not being the subject of a country actually at war with England, if he is the proprietor of a trade mark which exists as such in this country, may sue in the English Courts in respect of infringements in England.<sup>7</sup> So in a trade name case in which the plaintiffs had prior to the commencement of action no place of business or agent in this country, yet as England was a market for their goods, it was held that they

Actions by foreigners.

<sup>1</sup> See *Bulische Anilin v. Johnson*, [1896] 1 Ch. 25; 12 R. P. C. 535, C. A. Difficult questions of fact often arise as to whether a foreign corporation is resident within the jurisdiction; see for instance, in the patent case, *Dunlop Pneumatic Tyre Co., Ltd. v. Action Gesellschaft, &c., Vorm. Cudell & Co.*, [1902] 1 K. B. 342; 19 R. P. C. 46, where the defendants had simply a stand at an exhibition for show and sale of their goods; and other cases cited in Annual Practice, under Ord. IX., r. 8.

<sup>2</sup> *Kinahan v. Kinahan*, 45 C. D. 78; 8 R. P. C. 18 (1890), Kekewich, J. As to the rectification of the registrations of

marks belonging to foreigners, see Chap. XI., at p. 306.

<sup>3</sup> *Marshall v. Marshall*, 38 C. D. 330 (1888), C. A.

<sup>4</sup> *Kinahan v. Kinahan*, supra; cf. *King & Co.'s Tm.*, [1892] 2 Ch. 462; 9 R. P. C. 350.

<sup>5</sup> *Marshall v. Marshall*, 38 C. D. 330 (1888), C. A.

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

<sup>7</sup> *The Collins Co. v. Brown*, 3 K. & J. 423 (1857), Wood, V.-C.; *The Collins Co. v. Reeves*, 28 L. J. Ch. 56 (1858), Stuart, V.-C.

could sue to protect their trade name.<sup>1</sup> But sec. 42, prohibiting actions in respect of the infringements of unregistered trade marks, applies to trade marks belonging to foreigners.<sup>2</sup>

Notice of  
action is un-  
necessary.

No notice need be given to the alleged infringer before the action is brought,<sup>3</sup> and the plaintiff's right to bring the action is not affected by the ignorance of the defendant of the plaintiff's claim to the mark, or the readiness of the defendant to cease the infringement when called upon to do so.<sup>4</sup> "A plaintiff in these cases," Chitty, J., said, in *Upmann v. Forester*,<sup>5</sup> "is placed in circumstances of difficulty, because if he were to give notice there is great probability of the defendant at once getting rid of the spurious articles before the plaintiff could interfere; and the plaintiff therefore would in many instances be affording the defendant an opportunity of doing what the injunction would have prevented. I well remember that the late Master of the Rolls, Sir G. Jessel, stated that he was, when at the Bar, accustomed in cases like this to advise his clients not to give any notice, but to move at once."<sup>6</sup> And in a case in which the defendants had used a name to the exclusive use of which the plaintiffs were not entitled, but had also imitated a special scroll used by the plaintiffs, and it was suggested that the plaintiffs ought before action to have written to the defendants, stating that it was the scroll that they objected to, Lord Macnaghten said: "I cannot think that there is any substance in that objection. Why should a person assailed and injured by unfair competition teach his opponent how far he may safely go in undermining a rival business which he wishes to destroy? Why should he throw away the only chance of obtaining by process of law redress for injury already done?" Consequently the omission to give notice before action does not disentitle the plaintiff to costs.<sup>7</sup>

Agents and  
partners of  
infringer.

The action is one of tort, and, consequently, every infringer is liable to be sued, whether he acted on his own behalf or as agent for a principal. But a mere servant should not, it seems, be

<sup>1</sup> *Société Anonyme, &c. Panhard et Levassor v. Panhard Levassor Motor Co., Ltd.*, [1901] 2 Ch. 513; 18 R. P. C. 405, Farwell, J.

<sup>2</sup> See *Goodfellow v. Prince*, 35 C. D. 9 (1886), C. A.; and above, Chap. XII., p. 337; although Malins, V.-C., expressed a contrary opinion in *Twentsche, &c. v. Ellinger & Co.*, 26 W. R. 70 (1877).

<sup>3</sup> *Pierce v. Franks*, 15 L. J. Ch. 122 (1846), Knight Bruce, V.-C.

<sup>4</sup> *Burgess v. Hately*, 26 Beav. 249 (1858), Romilly, M.R.

<sup>5</sup> 24 C. D. 231 (1883).

<sup>6</sup> *Ibid.* The very life of a trade mark depends upon the promptitude with which it is vindicated. *Johnson v. Orr-Ewing*, 7 App. Ca. 219 (1882).

<sup>7</sup> See below, p. 458.

added as a defendant.<sup>1</sup> An innocent partner of the infringer defendant, who has repudiated the wrongful act of his co-partner, is not, it appears, liable to be sued.<sup>2</sup>

Directors of a limited company which is sued for infringement should not be joined as defendants if there are no specific allegations against them other than that they are directors.<sup>3</sup> Directors.

## 2. The Plaintiff's Title.

The plaintiff must be owner of the trade mark<sup>4</sup> which is alleged to have been infringed, and the onus of proving that he is entitled to the exclusive use of the mark for the particular class of goods (subject, if the case is so, to the concurrent rights of persons, other than the defendant, who are also owners of the same or a similar trade mark) lies upon him.<sup>5</sup> So where three persons, a manufacturer, a shipper, and a foreign consignee, devised a trade mark in concert, and used it for goods sent by the manufacturer through the shipper to the consignee, and afterwards the manufacturer began to use it for goods not sent through the shipper, and the shipper for goods not obtained from the manufacturer, and cross-actions for infringement were brought by the shipper and the manufacturer, it was held that Joint trade marks.

<sup>1</sup> *Daniel and Arter v. Whitehouse*, 16 R. P. C. 71 (1899), North, J. (a motion to commit).

<sup>2</sup> *Magnolia Metal Co. v. Atlas Metal Co.*, 14 R. P. C. 389 (1896), Collins, J., and C. A. A passing-off case in which the innocent partner had repudiated the acts of his co-partners and sought a dissolution, and had, of course, separated in his defence. It was said by Collins, J., and Chitty, L.J., that the passing-off was not within the scope of the authority given by one partner to another, but the same remark would apply to an innocent employer whose manager commits the wrong. Cf. *Griersm, Oldham & Co. v. Birmingham Hotel Co.*, 18 R. P. C. 158 (1901), Buckley, J., where an hotel company was held responsible for passing-off by waiters contrary to orders; also *Cusnier Fils v. Gaiety Bars and Restaurant Co., Ltd.*, 19 R. P. C. 357 (1902), Buckley, J. It is submitted that *The Magnolia* case must not be con-

sidered as an authority for the general proposition that only partners who are aware of the wrongful acts can be sued. As to damages against an infringer who is innocent of fraud, see below, p. 455.

<sup>3</sup> *Cropper Minerva Machines Co., Ltd. v. Cropper, Charlton & Co., Ltd.*, 23 R. P. C. 388 (1906), Farwell, J. Cf. with the patent case, *Betts v. DeVitre*, 3 Ch. 441 (1868).

<sup>4</sup> The questions, What is a Trade Mark, and What can be Registered as a Trade Mark, are discussed in Chap. II., p. 22; and Chap. VIII., p. 127. The special right of suing to restrain the use of the Royal Arms, &c., conferred by sec. 68 is not, of course, a right to sue for infringement of a trade mark, and constitutes, therefore, no exception to the rule; see below, p. 386.

<sup>5</sup> *Robinson v. Finlay*, 9 C. D. 487 (1877), C. A. As to concurrent rights, see below, p. 388.

neither of them could make out a title to exclusive use, and both actions were dismissed.<sup>1</sup>

In a case where Messrs. Harper and Moore, the plaintiffs, had been the lessees of certain brickworks, and had been accustomed to make bricks of the clay produced by mines of which they were lessees also, and, after the expiration of their leases, the defendants, who had obtained a lease of the brickworks only, advertised themselves as "E. & J. Pearson (late Harper and Moore)," thereby suggesting that they were successors to the old brick-making business, Wood, V.-C., granted an injunction to restrain the advertisements, and he said he would have granted it as a matter of course had the owner of the mines been plaintiff in the suit. The learned Vice-Chancellor seems, therefore, to have been of opinion that both he and the plaintiffs were interested in the old firm name.<sup>2</sup>

Where lamps known as Stewart Arc Lamps had been manufactured by a company in America to the special order of an English company who had acted as the sole agents in this country of the American company, it was held that the name Stewart Arc Lamps had become associated in this country with the English company, and that their successors had the right to use the name and were entitled to an injunction to prevent the American Company from using the word "Stewart" without clearly distinguishing their lamps from those of the successors of the English company.<sup>3</sup>

A mere importer has no title to sue for infringement of the trade marks of the consignor or producer.<sup>4</sup>

The plaintiff does not become owner of the trade mark, or acquire any interest in it sufficient to enable him to sue for infringement, by a contract with the proprietor for the exclusive

Where the plaintiff is the sole purchaser from the proprietor.

<sup>1</sup> Last case. A custom in Manchester, by which the shipper, in the absence of agreement, was the owner of the trade mark, was alleged but not proved. *Jones' Tm.*, 53 L. T. 1 (1885), C. A., is a similar case. See also *Rivière's Tm.*, 55 L. J. Ch. 545; 53 L. T. 237 (1885), Pearson, J., cited p. 280. Cf. *Van Zeller v. Mason, Cuttley & Co.*, 25 R. P. C. 37 (1908). Joyce, J. (*Köpke Roriz*), where that mark was held to indicate the produce of a particular vineyard, and not such produce when sold and shipped by a

particular firm only.

<sup>2</sup> *Harpers v. Pearson*, 3 L. T. N. S. 547 (1860); cf. *Motley v. Downman*, 3 My. & Cr. 1; 6 L. J. Ch. (N. S.) 308 (1837), Cottenham, L.C.

<sup>3</sup> *Defries & Son, Ltd. v. Electric and Ordnance Accessories Co., Ltd.*, 23 R. P. C. 341 (1906), Joyce, J.

<sup>4</sup> *Hirsch v. Jonas*, 3 C. D. 584 (1876), Jessel, M.R.; see Chap. II., at p. 54; Chap. IV., at p. 68; and *Goolfellow v. Prince*, 35 C. D. 9 (1887), C. A.

purchase of the marked goods consigned to a particular district;<sup>1</sup> but it is submitted that if the contract were for the exclusive purchase of all the marked goods manufactured by the proprietor, so that no goods could be rightly marked which did not pass through the plaintiff's hands (subject to any question of registration),<sup>2</sup> he might maintain the action against any person who used the mark, or a spurious mark infringing it, on goods which were not the goods of the manufacturer. The question whether a trader, exclusively entitled by contract with the proprietor to purchase his goods, could rightly register the proprietor's mark as his own, of course with the proprietor's assent, was discussed but left undetermined in *The Apollinaris* case.<sup>3</sup>

One or more of several persons concurrently entitled may bring the action.<sup>4</sup> This is expressly so provided by the proviso to sec. 39 of the Act of 1905 (the section which confers the exclusive right to use), which enacts 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 mark shall (except so far as their respective rights shall have been defined by the Court) be 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. Several plaintiffs so entitled may join together to sue although their interests are distinct and separate.<sup>5</sup> But only a limited number of persons or firms can be concurrently entitled to a mark. If a large number, and, apparently, if more than three, become so entitled, the mark becomes a common mark.<sup>6</sup>

It would seem that the plaintiff must be using, or intending to use, the mark, for no damage would otherwise be occasioned to

Action by one proprietor or by several.

Plaintiff must use or intend to use the mark.

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

<sup>2</sup> *Goodfellow v. Prince*, 35 C. D. 9 (1887), C. A.

<sup>3</sup> [1891] 2 Ch. p. 231; 8 R. P. C. 137, Fry, L.J., cited above, p. 280.

<sup>4</sup> *Hine v. Lart*, 7 L. T. (O. S.) 41 (1846), Shadwell, V.-C.; *Dent v. Turpin*, 2 J. & H. 139; 30 L. J. Ch. 495 (1861),

Wood, V.-C.; *Southorn v. Reynolds*, 12 L. T. (N. S.) 75 (1865). Wood, V.-C. As to passing-off actions, see below, p. 477.

<sup>5</sup> *Dent v. Turpin*, above, note (4), and *Universities of Oxford and Cambridge v. Gill*, [1899] 1 Ch. 55. Stirling, J.

<sup>6</sup> *Ehrmann's Tms.*, [1897] 2 Ch. 495; 14 R. P. C. 665, Stirling, J. The question was as to the rights of the partners on dissolution of a firm. See now sec. 23 and cf. sec. 74, sub-sec. (3) of the Act of 1883, Appendix, p. 632.

him by the infringement.<sup>1</sup> It has been held that a mortgagee who does not intend to use the mark cannot bring an action in respect of its infringement,<sup>2</sup> and intention to use is one of the conditions precedent to proper registration.<sup>3</sup>

Action survives to executors, and they may sue.

Infringement of a trade mark is an interference with a right of property injuring the personal estate of the owner, and consequently the right of action in respect of it is not determined by the death of the owner, and proceedings may be begun or continued<sup>4</sup> by his executors. Of course, if the executors have possession of the goodwill of their testator's business, and are carrying on his trade, they can themselves be registered, and can sue as owners of the trade marks employed in the business and attached to the goodwill.<sup>5</sup>

Unauthorised assumption of the Royal Arms, &c., may be restrained.

A person who, without proper authority, uses the Royal Arms or arms so closely resembling them as to be calculated to deceive, or any device, emblem, or title in a manner calculated to lead to the belief that he is employed by or supplies goods to a member of the Royal Family, is liable to be restrained from so doing at the suit of any person who is authorised to use such arms, device, emblem, or title, or is authorised by the Lord Chamberlain to take proceedings in that behalf.<sup>6</sup> Such an action, although analogous to an action for infringement of trade mark, is a purely statutory one, and differs in particular from an ordinary infringement action in that the person suing is not the proprietor of the mark, the unauthorised use of which is complained of in the action. In several actions under the section injunctions have been granted.<sup>7</sup>

### 3. Registration.

The plaintiff must, before the commencement of the action, or, at any rate, at the date of the hearing,<sup>8</sup> be the registered

Proof of registration of the trade mark.

<sup>1</sup> And see above, p. 328.

<sup>2</sup> *Beazley v. Soares*, 22 C. D. 660 (1882), Pearson, J., a trade name case.

<sup>3</sup> Sec. 37; and *Apollinaris Co.'s Tms.*, [1891] 2 Ch. p. 233; 8 R. P. C. 137; *Batt & Co.'s Tm.*, [1898] 2 Ch. 432; [1899] A. C. 428; 15 R. P. C. 262, 534; 16 R. P. C. 411; see above, Chap. XI., at pp. 292 and 293.

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

<sup>5</sup> See Chap. XIII., p. 345; and *Mas-sam v. J. W. Thorley's Cattle Food Co.*, 6 C. D. 574; 14 C. D. 748 (1877),

*Malins, V.-C., and C. A.*

<sup>6</sup> Sec. 68. The section is fully set out below, p. 623. There is a proviso saving the right (if any) of the proprietor of a trade mark containing such arms, device, &c.

<sup>7</sup> For instance, in *Royal Warrant Holders' Association v. Slade & Co., Ltd.*, 25 R. P. C. 245 (1908), Swinfen Eady, J.

<sup>8</sup> *Hazzopulo v. Kaufmann*, 23 Sol. J. 819 (1879), Little, V.-C.; *Magnolia Metal Co. v. Atlas Metal Co.*, 14 R. P. C. 389, at p. 394 (1897), Collins, J. See further, above Chap. XII., at p. 338.



proprietor, except that if the mark was in use before August 13th, 1875, the plaintiff may show that registration of it has been refused.<sup>1</sup> In each case the registration and the name of the registered proprietor, or the refusal, may be shown by the certificate of the Registrar, or by sealed and certified copies of or extracts from the Register.<sup>2</sup>

But the registration of the successor in title of the original proprietor—his assignee, for instance—is not necessary to enable the successor to commence an action.<sup>3</sup>

Registration of assignment is unnecessary before action.

The registration of a person as proprietor of a trade mark is *prima facie* evidence of the validity of the original registration and of all subsequent assignments and transmissions,<sup>4</sup> and is, subject to certain exceptions, after seven years from the date of the original registration, or from August 11th, 1905<sup>5</sup> (whichever shall last happen), conclusive evidence of the validity of the original registration;<sup>6</sup> and registration, if valid, confers the exclusive right to the use of the trade mark for the goods in respect of which it is registered.<sup>7</sup>

Registration as evidence of title.

So that after the expiration of the above-mentioned period of seven years<sup>8</sup> objections to the original registration cannot be raised against the plaintiff,<sup>9</sup> unless the registration was (a) obtained by fraud, or (b) unless the trade mark is calculated to deceive, or

<sup>1</sup> Sec. 42; see Chap. XII., p. 334.

<sup>2</sup> Secs. 7, 50 and 51, and sec. 64 of the Patents and Designs Act, 1907, replacing sec. 84 of the Act of 1883. Form of Request for Certificate of Registration to be used in legal proceedings, TM No. 31, Appendix, p. 697. Fee £1. Form of Request for Certificate of Refusal to Register, TM No. 32, Appendix, p. 696. Fee £1.

<sup>3</sup> *Ihle v. Henshaw*, 31 C. D. 323; 3 R. P. C. 15 (1886), North, J. See further, above, Chap. XII., at p. 338.

<sup>4</sup> Sec. 40; Chap. XII., at p. 329.

<sup>5</sup> The passing of the Act.

<sup>6</sup> Sec. 41; Chap. XII., at p. 330.

<sup>7</sup> Sec. 39; Chap. XII., at p. 325.

<sup>8</sup> In *Apollinaris Co. v. Snook*, 7 R. P. C. 474 (1890), although the mark had not been registered for five years (the period under the Act of 1883), Kekewich, J., at the hearing refused to listen to an argument that it ought not to have been registered; but, apparently, his attention was not called to the point

in question. And in *Compagnie Générale v. Rehder*, 5 R. P. C. 61, at p. 65 (1888), Kay, J., took a similar course upon an application for an interim injunction. See also *Hommel v. Bauer & Co.*, 20 R. P. C. 802 (1903), Byrne, J. In *Stuart v. Scottish Val de Travers Co.*, 13 Ct. of Sess. Ca. 1 (1885); and *Lever v. Goodwin*, 4 R. P. C. 492 (1887), Chitty, J., objections to marks registered for less than five years were allowed at the hearing, there being no application to rectify. And in *Free Fishers of Whitstable v. Elliot*, below, p. 518 (not reported on this point), Stirling, J., decided that this could be done. See also the Scotch case of *Dewar, Ltd. v. Dewar*, 17 R. P. C. 341 (1900), which, however, turned on the question of an inherent jurisdiction in the Scotch Court.

<sup>9</sup> For cases under the Act of 1883, see *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478 (1887), C. A.; *Edwards v. Dennis*, 30 C. D. 454 (1885), C. A.; and *Verity's Tm.*, 19 R. P. C. 58 (1902), Buckley, J.

otherwise offends against sec. 11 of the Act.<sup>1</sup> Other objections may, however, be taken;<sup>2</sup> it may be shown, for instance, that the plaintiff does not possess the goodwill of the business to which the mark is attached.<sup>3</sup>

Registration modified by a disclaimer or otherwise.

But the registration is, of course, evidence only of such title as it shows, and the plaintiff's right is accordingly subject to the modification imported by any limitation or condition entered upon the Register in connection with it.<sup>4</sup> In particular, if there is any disclaimer of part of the registered mark, the registered proprietor has no title to sue in respect of an alleged infringement constituted by the adoption of such part of the mark, for the disclaimer is an indication to all the world that he has no monopoly, by reason of the registration, of the use of that part, at all events by itself.<sup>5</sup>

The exclusive right to use conferred by sec. 39 is subject to the provisions of sec. 41, preserving the rights of users anterior to the first use of the registered mark. It is also subject to the general provision contained in sec. 44, that no registration under the Act shall interfere with any *bonâ fide* use by any person of his own name or place of business, or that of any of his predecessors in business, or to the use by any person of any *bonâ fide* description of the character or quality of his goods.

By concurrent rights.

And the right to exclusive use is subject to the rights of any person who has obtained concurrent registration,<sup>6</sup> and to the concurrent rights, if any exist, of other persons to use the mark upon obtaining registration.<sup>7</sup>

Plaintiff's title determined or barred.

The seven years' registration does not, it is submitted, prevent the defendant, although he has made no application to rectify, or although the Court has no jurisdiction to entertain any such application which he has made, from setting up as a defence that the plaintiff's right has determined by abandonment or otherwise,<sup>8</sup> or has been wholly assigned to another.<sup>9</sup> And it is, it is also

<sup>1</sup> Sec. 41, Chap. XII., at p. 330.

<sup>2</sup> Above, Chap. XII., at pp. 332, 333, 334.

<sup>3</sup> Sec. 22; *Pinto v. Bulman*, 8 R. P. C. 181 (1891), C. A.

<sup>4</sup> Sec. 39, above, p. 325.

<sup>5</sup> *Rosenthal v. Reynolds*, [1892] 2 Ch. 301; 9 R. P. C. 189, North, J.; *Pirie v. Goolall*, [1892] 1 Ch. 35; 9 R. P. C. 17, C. A.; Chap. IX., at p. 218. A dictum of Ld. Alverstone in *Hubbuck v. Brown*, 17 R. P. C. 638 (1900), suggests that although the exclusive use of part of a

mark is disclaimed, nevertheless the proprietor may rely on the whole combination; see also *Pirie v. Goolall*, [1892] 1 Ch. 35. As to passing-off cases based upon disclaimed matter, see next chapter, p. 516.

<sup>6</sup> The proviso to sec. 39, fully set out above, p. 325.

<sup>7</sup> Sec. 21 and below, p. 411.

<sup>8</sup> Chap. XIV., p. 362.

<sup>9</sup> This is consistent with the fact that an unregistered assignee can sue, see p. 387.

submitted, no answer to a personal bar which disentitles the plaintiff to sue.

#### 4. What constitutes Infringement.

Infringement is the use by the defendant, for trading purposes<sup>1</sup> upon or in connection with goods of the kind for which the plaintiff's right to exclusive use exists<sup>2</sup> (*i.e.*, goods in respect of which his mark is registered,<sup>2</sup>) not being the goods of the plaintiff,<sup>3</sup> of a mark identical with<sup>4</sup> the plaintiff's mark, or comprising some of its essential features, or colourably resembling it,<sup>5</sup> so as to be calculated to cause goods to be taken by ordinary purchasers<sup>6</sup> for the goods of the plaintiff.

It has long been settled that the question of the relative excellence of the plaintiff's and the defendant's goods is not relevant to the right of the plaintiff to maintain an action either for infringement or for "passing-off,"<sup>7</sup> and this has, accordingly, no place in the above definition. It may, however, affect the amount of the damages to be recovered by the plaintiff if he succeeds, for damages are sometimes claimed and allowed in respect of injury occasioned to the trade reputation of the plaintiff by the defendant's infringement or fraud.<sup>8</sup> If the defendant's goods are as excellent as his own, the reputation of the plaintiff cannot have been injured by a substitution of one for the other.

Inferiority of the defendant's goods.

The Court has refused to regard an isolated act, done at the request of the plaintiff's agent, who was laying a trap for the defendant, as an infringement.<sup>9</sup> This must be taken as a special case,

Single act of infringement.

<sup>1</sup> Page 390.

<sup>2</sup> Sec. 39, below, p. 392.

<sup>3</sup> Page 394.

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

<sup>5</sup> Page 400.

<sup>6</sup> Page 404.

<sup>7</sup> *Bliffield v. Payne*, 4 B. & Ad. 410; 2 L. J. K. B. (N. S.) 68 (1833); *Edelsten v. Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, L.C.; and see *per* Ld. Blackburn, in *Singer Manufacturing Co. v. Looy*, 8 App. Ca. p. 29.

<sup>8</sup> See, for instance, *Alexander v.*

*Henry*, 12 R. P. C. 360 (1895), Kekewich, J.

<sup>9</sup> *Hennessy v. Kennett*, Seb. Dig. p. 331 (1877), Malins, V.-C.; cf. *Leahy, Kelly and Leahy v. Glover*, 10 R. P. C. 141 (1893), where a single instance of the sale of goods by the defendant's shopwoman, not shown to have been with his authority, was considered insufficient to support a case of passing-off; *Rutter v. Smith*, 18 R. P. C. 49 (1901), Kekewich, J.; and *Knight & Sons, Ltd. v. Crisp & Co., Ltd.*, 21 R. P. C. 671 (1904), Warrington, J., similar cases; and *Burberrys v. Watkinson*, 23 R. P. C. 141 (1906), Warrington, J., an isolated instance of mistake. See also *Carr & Sons v. Crisp & Co., Ltd.*, 19 R. P. C. 497 (1902), where Byrne, J., said that if one

however, for, in general, proof of a single act of infringement by the defendant is sufficient to justify the plaintiff in bringing his action,<sup>1</sup> and the evidence relied on is frequently the sale by the defendant of the spurious goods to the plaintiff or his agent, who has bought them merely for the purpose of procuring evidence.<sup>2</sup> Whenever trap orders are resorted to, they should be scrupulously fair.<sup>3</sup>

Employer responsible for servant's acts.

An employer will be held responsible for the wrongful acts of infringement or passing-off on the part of his servants done in the course of the employer's business and within the scope of his employment, notwithstanding that the acts were done without the employer's knowledge,<sup>4</sup> or even contrary to his express orders.<sup>5</sup>

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

The defendant must be shown to have used or intended to use the goods marked with the spurious mark for trading purposes, whether for sale or as samples to enable him to sell similar goods—and whether these are or are not themselves so marked—for the essence of the wrong is that purchasers of the spuriously

instance only had been proved he would have followed *Leahy v. Glover*; and *Kodak, Ltd. v. Grenville*, 25 R. P. C. 416 (1908), Eve, J., where the only question was as to costs. Cf. *Hennessy & Co. v. Neary*, 19 R. P. C. 36 (1902), Chatterton, V.-C., Ireland.

<sup>1</sup> See, for instance, *American Tobacco Co. v. Guest*, [1892] 1 Ch. 630; 9 R. P. C. 218, where an injunction was granted but costs refused.

<sup>2</sup> *Dunlop Pneumatic Tyre Co. v. Neal*, [1899] 1 Ch. 807; 16 R. P. C. 247, North, J., a patent case, where the plaintiffs succeeded, although the only infringement proved was done for their agent.

<sup>3</sup> *Californian Fig Syrup Co. v. Taylor's Drug Co.*, 14 R. P. C. 564 (1897), C. A. Trap orders should, wherever possible, be in writing, and, whenever complete, some warning, by proceedings or otherwise, should as soon as possible be given to the defendant that the transactions are going to be called in question: *Carr & Sons v. Crisp & Co., Ltd.*, 19 R. P. C. 497 (1902), Byrne, J. And see *Burberrys v. Watkinson*, 23 R. P. C. 141 (1906), Warrington, J.

<sup>4</sup> *Tonge v. Ward*, 21 L. T. (N. S.) 480 (1869), Romilly, M.R.; *Twentsche v.*

*Ellinger*, 26 W. R. 70 (1877). Malins, V.-C.; *Cusenier Fils v. Giverty Bars and Restaurant Co., Ltd.*, 19 R. P. C. 357 (1902), Buckley, J.; *Hennessy & Co. v. Neary*, 19 R. P. C. 36 (1902), Chatterton, V.-C., Ireland.

<sup>5</sup> *Grierson; Oldham & Co. v. Birmingham Hotel Co., Ltd.*, 18 R. P. C. 158 (1901), Buckley, J. (*Big Tree Brand*); *Munro v. Hunter*, 21 R. P. C. 296 (1901), Channell, J. But in a Scotch case, *Montgomerie & Co., Ltd. v. Young*, 20 R. P. C. 781; 21 R. P. C. 285 (1904), Inner House, reversing Lord Ordinary, Ld. Young held that where a servant, either accidentally or otherwise, violates the express orders of her master not to commit a wrong of this nature, interdict ought not to be granted against the master. Ld. Trayner also held that in view of the precautions taken by the master, even if a few instances had arisen from inadvertence on the part of servants, an interdict should not be granted. The case was a somewhat special one, and a different view as to an employer's liability has been taken in the English cases. See *Parozon Co., Ltd. v. Gibson*, 21 R. P. C. 317 (1904), Ld. Low, Scotland; also above, p. 383, n. 2.

marked goods are deceived, and the plaintiff incidentally suffers by the loss of their custom which would or might, but for the fraud, come to him.<sup>1</sup> But the Court will not readily believe that the defendant does not intend to use vendible goods marked with the spurious mark for trading purposes if they are found in his possession, and either he is a trader in goods of the kind, or the quantity of the goods is considerable.<sup>2</sup> So where the defendant, a china manufacturer, had imported 5,000 spuriously marked cigars, he was held liable, although he did not know that the mark was spurious, and said that he intended the cigars "for family use."<sup>2</sup>

And the infringement must occur within the realm.<sup>3</sup> It is sufficient if the spuriously marked goods are brought by the defendant into this country for export to a country where the plaintiff's trade and marks are known,<sup>4</sup> and it is, of course, sufficient if goods are spuriously marked by him in this country for export.<sup>5</sup>

Infringement must be within the realm.

If the plaintiff's registered mark, or its essential particulars, are actually copied, it appears to be immaterial, in order to entitle the plaintiff to an injunction, whether the infringement takes place within the area in which the mark is known or not, because the exclusive right conferred by the Act extends, in the absence of any limitation on the Register, to the whole Kingdom.

Whether infringement must be in plaintiff's market.

If the case is one of colourable infringement, and the plaintiff's case is founded on the probability of deception in a particular market, the injunction granted might under special circumstances

<sup>1</sup> *Lery v. Walker*, 10 C. D. 436 (1879), C. A.; *Richards v. Butcher*, 7 R. P. C. 288 (1890), Kay, J.

<sup>2</sup> *Umann v. Forester*, 24 C. D. 231 (1883), Chitty, J.

<sup>3</sup> Cf. the patent cases, *British Motor Syndicate v. Taylor*, [1900] 1 Ch. 577; [1901] 1 Ch. 122; 17 R. P. C. 189, 723, where goods were bought in England and sold abroad, with *Baulische Fabrik v. Basle Chemical Works*, [1898] A. C. 200; 14 R. P. C. 919, where the defendants, who had effected a sale by post in Switzerland, and had despatched the goods addressed to an English trader from there, were held not to be liable. An English Court has no jurisdiction to

prevent infringements which take place wholly abroad: *Morocco Bount Syndicate v. Harris*, [1895] 1 Ch. 534, Kekewich, J. (copyright); and see the patent case, *Baulische Fabrik v. Hickson*, [1906] A. C. 419; 23 R. P. C. 433, where there was held to have been no vending in England.

<sup>4</sup> *Joseph Rodgers & Sons v. Kottgen*, 5 Times L. R. 678 (1889), Kay, J.; *Tm. of The Société, &c. des Verreries de l'Étoile*, [1894] 1 Ch. 61; 2 Ch. 26; 10 R. P. C. 436; 11 R. P. C. 142, Stirling, J., and C. A. (*Red Star Glass*).

<sup>5</sup> *Orr-Ewing v. Johnson*, 13 C. D. 434; 7 App. Ca. 219, is an illustration.

be limited to that market;<sup>1</sup> but, except in such cases, it is submitted that the question whether there is a probability of deception must be considered on the assumption of the defendant's mark coming into competition with the plaintiff's mark, and that the fact that the marks had hitherto been respectively confined to different districts within the jurisdiction would not be a defence in law. An injunction has been granted where the plaintiff's and the defendant's areas, though substantially local and distinct, were both within the realm and were beginning to overlap.<sup>2</sup>

Defendant must use the mark upon or in connection with the goods for which the plaintiff's right exists.

The use must be upon or in connection with the goods for which the plaintiff's right exists. The exclusive use conferred by sec. 39 is expressly so limited.<sup>3</sup> The authorities prior to the Act were to the same effect. "There can be no right to the exclusive ownership of any symbols or marks universally in the abstract. Thus an ironfounder who has a particular mark for his manufactures in iron could not restrain the use of the same mark when impressed on cotton or woollen goods; for a trade mark consists in the exclusive right to the use of some name or symbol as applied to a particular manufacture or vendible commodity."<sup>4</sup> And the third essential ingredient for constituting an infringement, enumerated by Lord Westbury in *McAndrew v. Bassett*,<sup>5</sup> is "that the defendants have imitated the mark for the purpose<sup>6</sup> of passing in the market other articles of a similar description."

The limits of the class of goods over which the right in respect of a registered mark extends have been discussed already,<sup>7</sup> and the

<sup>1</sup> In "passing-off" cases where the plaintiff's mark has been used only in a limited area, he sometimes obtains an injunction restricted to such area. See next chapter, at p. 549. In the *Orr-Ewing* case, Cotton, L.J., thought that the injunction ought to have been limited to Eastern markets, had the defendants been trading in any others. It would rarely be practicable to give complete protection in such manner. See *Société V. de l'Étoile Tm.*, [1894] 1 Ch. 61, p. 67; 10 R. P. C. 441, Stirling, J.; and the observations of Kay, L.J., in the same case, during argument on appeal, 11 R. P. C. 145.

<sup>2</sup> *Paine & Co. v. Daniells & Sons' Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 71, 217, C. A. (*John Bull Beer*). The

injunction was unlimited. In a passing-off case it is no defence that the plaintiff's trade in the defendant's market is small: *Grant v. Levitt*, 18 R. P. C. 361 (1901), Porter, M.R., Ireland (*Globe Furnishing Co.*); *Fouldler & Co., Ltd. v. Rushton, Ltd.*, 20 R. P. C. 477, at pp. 484, 492, 494. And see *Passing Off*, Chap. XVI., pp. 491, 509.

<sup>3</sup> Above, p. 325.

<sup>4</sup> *Per* Ld. Westbury, in *Hall v. Barrows*, 4 De G. J. & S. 150; 33 L. J. Ch. 204 (1863).

<sup>5</sup> 4 De G. J. & S. 380; 33 L. J. Ch. 561 (1863).

<sup>6</sup> Fraudulent intent is not now essential, *post*, p. 401.

<sup>7</sup> Chap. V., p. 103, and Chap. XII., p. 321.

class has been shown to be not necessarily co-extensive with any register class,<sup>1</sup> and it has also been shown that the registered proprietor's right ought to be limited, and the registration restricted substantially to the kinds of goods upon which he actually uses or intends to use the mark,<sup>2</sup> and that the Court would probably refuse relief in respect of other goods.

The plaintiff cannot sue for infringement in respect of goods for which his mark is not registered,<sup>3</sup> although, if he can make a case, he may sue to restrain passing-off. And if his mark is registered generally for a register class comprising a kind of goods for which he does not use it, or for which it is unsuitable, it is not to be considered as registered for such goods. Thus, the proprietor of a mark registered for class 45, "tobacco whether manufactured or unmanufactured," used it only for cut tobacco, and the mark contained the words *Three Crowns Mixture*. It was held that he could not sue to restrain an infringement in respect of cigars.<sup>4</sup> But in a recent case a label registered as an

and is registered.

and used.

<sup>1</sup> Marks may be calculated to deceive, though in different register classes, p. 227; *Australian Wine Importers' Tm.*, 41 C. D. 278; 6 R. P. C. 311 (1889), Kay, J., and C. A. (wines and spirits); *Evo v. Dunn*, 10 R. P. C. 261 (1893), Kekewich, J. (an aperient drink and baking powder); *Turney & Sons' Tm.*, 11 R. P. C. 37 (1893), North, J. (beer and rum). In some instances the Courts have interfered to prevent a defendant using or imitating the trade name of a well-known firm with the object of fraudulently suggesting that he has a connection of some sort with the firm, even where the defendant's trade is different from that of the firm, but the difference is not so great as to make the success of the fraudulent suggestion very improbable. *Eastman Co. v. John Griffiths Cycle Corporation*, 15 R. P. C. 105 (photographic materials and cycles); *Dunlop Pneumatic Tyre Co. v. Dunlop Lubricant Co.*, 16 R. P. C. 12, both 1898, Romer, J. (cycle tyres, &c., and cycle lubricants); *Valentine Meat Juice Co. v. Valentine Extract Co., Ltd.*, 17 R. P. C. 673, C. A., overruling 17 R. P. C. 1 (1900), Stirling, J. (meat extract for food and for medicinal purposes); and *Walter v. Ashton*, [1902] 2 Ch. 282, Byrne, J. ("Times" cycles). In *Lucas,*

*Ltd. v. Fabry Automobile Co., Ltd.*, 23 R. P. C. 33 (1906), Warrington, J. (cycle and motor accessories and motor tyres, and in *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Motor Co., Ltd.*, 23 R. P. C. 761, 24 R. P. C. 572 (1907), H. of L. (tyres and cycle and motor repairs) the similarity of the businesses was held not to be so close as to make deception or confusion probable.

<sup>2</sup> *Edwards v. Dennis*, 30 C. D. 454 (1885), C.A., cited p. 104. In this case the goods were substantially different, as pointed out in *Boord & Son v. Huddart*, 21 R. P. C. 149 (1904), Swinfen Eady, J., where it was held that an old mark used before 1875 for gin, but not sloe gin, might be extended to sloe gin, and, being registered so as to cover it, was held to be infringed. See also *Finlay v. Shamrock Co.*, 22 R. P. C. 307, Porter, M.R., Ireland.

<sup>3</sup> *Jay v. Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.; *Hart v. Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J.

<sup>4</sup> *Hargreaves v. Freeman*, [1891] 3 Ch. 39; 8 R. P. C. 237, Chitty, J.; and see *Beazley v. Soars*, 22 C. D. 660 (1882), Pearson, J. A person who does not use the mark at all cannot sue: last case, and *Delondre v. Shaw*, 2 Sim. 237 (1828), Shadwell, V.-C.

old mark for fermented liquors and spirits, including liqueurs, was held to be infringed by a label used for sloe gin, although the registered label contained the words "Cordial Old Tom," which were not used on the mark when employed by the plaintiffs for sloe gin.<sup>1</sup>

The infringement must be in respect of spurious goods.

Further, the use of the defendant's mark, which is relied on as an infringement, must be a use upon goods which are not the genuine goods—*i.e.*, those upon which the plaintiff's mark is properly used—for anyone may use the plaintiff's mark on the plaintiff's goods, since that cannot cause the deception which is the test of infringement.<sup>2</sup> So the retailer of goods obtained from the plaintiff may lawfully place or renew<sup>3</sup> the proper labels upon them, and may have sufficient labels printed for the purpose.<sup>4</sup> In the case last cited, the defendant failed to satisfy the jury, in an action at common law, that he had in fact printed the labels only for use on the genuine goods of the plaintiff; and the injunction, which had been granted in a suit in Chancery by Wood, V.-C., and dissolved on appeal by Cranworth, L.C., was accordingly restored.<sup>5</sup> The rule just stated is well illustrated by *The Angostura Bitters* case, where the injunction granted was so expressed as not to prevent the name being applied to an article identical with the plaintiff's, should any other person discover the secret of manufacture and make the goods.<sup>6</sup>

Adulterations, inferior qualities, and goods comprising authentic parts.

But goods of the plaintiff, adulterated by some other person,<sup>7</sup> are not goods on which the mark may lawfully be placed; nor may a mark used by the owner to denote one quality of his goods be put on goods of such owner of an inferior quality;<sup>8</sup> nor is the manufacture by the defendant of an article made up of several parts the less an infringement because one genuine part of

<sup>1</sup> *Boord & Son v. Huddart*, 21 R. P. C. 149 (1904), Swinfen Eady, J.

<sup>2</sup> Chap. II., p. 33.

<sup>3</sup> *Condy v. Taylor*, 56 L. T. 891 (1887), Kekewich, J.

<sup>4</sup> *Farina v. Silverlock*, 1 K. & J. 509; 24 L. J. Ch. 632; 6 De G. M. & G. 214; 26 L. J. Ch. 11 (1855).

<sup>5</sup> 4 K. & J. 650 (1850).

<sup>6</sup> *Siegert v. Finllater*, 7 C. D. 801 (1878), Fry, J. In *The Yorkshire Relish* case (next chapter, p. 512) the defendant's sauce differed from the plaintiffs' by a "pinch of salt," but if the two had been indistinguishable the name would

still (according to the evidence) have meant the latter only.

<sup>7</sup> *Condy v. Taylor*, 53 L. T. 891 (1887), Kekewich, J.

<sup>8</sup> *Jamson & Son, Ltd. v. Clarke*, 19 R. P. C. 255 (1902), Chatterton, V.-C., Ireland; *Teacher v. Levy*, 23 R. P. C. 117 (1906), Swinfen Eady, J.; *Palestine Wine and Trading Co., Ltd. v. Cohen*, 23 R. P. C. 568 (1906), Warrington, J., and see *Moseley & Sons, Ltd. v. Nathan & Co.*, 23 R. P. C. 345 (1906), Warrington, J. These, however, all seem to have been passing-off cases.



the plaintiff's manufacture, and bearing his mark, is included in it.<sup>1</sup>

It is not necessary that the spurious mark should be actually affixed to the goods, provided it is so used in connection with them as to be calculated to cause them to be taken for the plaintiff's goods.<sup>2</sup> Use on the wrapper in which they are sold, or upon a slip placed in the package with them, or on a show-card to which the goods are attached,<sup>3</sup> or in circulars or advertisements offering them for sale is sufficient.<sup>2</sup> So printing the plaintiff's trade mark labels, without showing that they were for use on genuine goods only,<sup>4</sup> or using the plaintiff's marked or stamped bottles,<sup>5</sup> casks,<sup>6</sup> or boxes<sup>7</sup> for goods other than his genuine goods, is an infringement, unless the Court is satisfied that the use under the circumstances is not calculated to deceive.<sup>8</sup>

What connection with the spurious goods is sufficient.

Before the Act of 1905 it was to some extent doubtful whether there could be infringement by the verbal use of a trade mark, or by its use otherwise than in some physical connection with the goods. The use of a descriptive word registered as an old trade mark, not in connection with the goods, but only in price lists referring to them, was held to be no infringement.<sup>9</sup> But on the other hand, in *Jay v. Ladler*,<sup>10</sup> a circular was held to be an infringement of a trade mark, and in a more recent case *Farwell, J.*, after considering the case last mentioned, and referring to an argument that the use by the defendants of the alleged infringing device as an embellishment in advertisements and circulars, and other

<sup>1</sup> *Richards v. Williamson*, 30 L. T. (N. S.) 746 (1874). Bacon, V.-C., a gun with stamped lock.

<sup>2</sup> *Jay v. Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

<sup>3</sup> *Chamelon Patents, &c. Co. v. Marshalls*, 17 R. P. C. 517 (1900), Kekewich, J. (passing-off).

<sup>4</sup> *Farina v. Silverlock*, p. 394, note (4); *Guinness v. Ullmer*, 10 L. T. (O. S.) 127 (1847), Shadwell, V.-C.; *Jameson & Son, Ltd. v. Johnston & Co., Ltd.*, 18 R. P. C. 259 (1901); *Kuyper & Son v. Baird, Ltd.*, 20 R. P. C. 581, both Porter, M.R., Ireland.

<sup>5</sup> *Rose v. Henley*, 47 L. J. Ch. 577 (1877), Malins, V.-C.; *Rose v. Loftus*, *ibid.* Filling siphons marked with the plaintiff's trade mark and sending them

out to be resold held to be an infringement: *Barr & Co. v. Mair*, 21 R. P. C. 665 (1904), Ld. Kyllachy, Scotland. See also *Thwaites & Co. v. McEvilly*, 21 R. P. C. 397, C. A. Ireland; and cf. *Woolley & Son v. Morrison*, 21 R. P. C. 63, Ld. Kyllachy, Lord Ordinary.

<sup>6</sup> *Hennessy v. Cooper*, Seb. Dig. p. 327 (1877), Malins, V.-C.

<sup>7</sup> *Barnett v. Leuchars*, 13 L. T. (N. S.) 405 (1865), Stuart, V.-C.

<sup>8</sup> As in *Welch v. Knott*, 4 K. & J. 747 (1857), Wood, V.-C.

<sup>9</sup> *Talbot v. Webley*, 3 R. P. C. 276 (1886), Bacon, V.-C. (*Baffle*, for safes); cf. "Singer system," in *Singer v. Looy*, 8 App. Ca. 15 (1882), and above, p. 39.

<sup>10</sup> 40 C. D. 649; 6 R. P. C. (1889), Kekewich, J.

ways, was not infringement, said that he did not think it was necessary that the mark should be used by the defendants as a trade mark, but that the mode of use was an element to be considered, and he held that there was in fact no infringement.<sup>1</sup> The question was also discussed in the Court of Appeal with reference to a pictorial poster.<sup>2</sup>

In a case in which all that the defendants had done was to supply their goods in response to written orders for "Rugby" cement, that word being a prominent part of the trade mark, Vaughan Williams, J., said: "I am, for my own part, not at all sure that you can prove an infringement of a trade mark without proving that the defendants have imitated the plaintiff's trade mark upon something capable of receiving the impression of the mark. Either the material itself, or the paper which is used, or the sacks, or bags, or boxes, or whatever it is that the material is put into, I should have thought must have been imitated to constitute an infringement of a trade mark."<sup>3</sup> The question actually decided in the case was that the sale of goods by the descriptive name *Rugby Cement* was not an infringement of a trade mark comprising those words. In one case in Scotland the use of the plaintiff's trade mark by application by word of mouth to articles sold was held to be an infringement.<sup>4</sup>

The abstract question was, however, of little or no importance, since, in the case put, the use of the word mark by the defendant, in any manner calculated to deceive, could be restrained in a "passing-off" action. "It will be observed," Fry, J., said, in *The Linoleum* case,<sup>5</sup> "that the inquiry with regard to the use of the word *Linoleum* as a constituent element in the trade mark,

<sup>1</sup> *Bourne v. Swan & Edgar, Ltd.*, [1903] 1 Ch. 211; 20 R. P. C. 105.

<sup>2</sup> *Price's Patent Candle Co., Ltd. v. Jeyes' Sanitary Compounds Co.*, 19 R. P. C. 17 (1901). In *Bass, Ratcliff & Gretton, Ltd. v. Davenport & Sons' Brewery, Ltd.*, Kekewich, J., considered, as a question of infringement of trade mark, the question whether a show-card infringed the plaintiffs' rights.

<sup>3</sup> *Rugby Portland Cement Co., Ltd. v. Rugby and Newbold Portland Cement Co., Ltd.*, 8 R. P. C. 241; affirmed on appeal, 9 R. P. C. 46 (1891).

<sup>4</sup> *Montgomerie & Co., Ltd. v. Young*, 20 R. P. C. 781 (1903), *Ld. Kyllachy*; on appeal the decision was reversed on other

grounds, 21 R. P. C. 285 (1901). In *Kodak, Ltd. v. London Stereoscopic Co.*, 20 R. P. C. 337 (1903), Swinfen Eady, J., it was practically admitted by the defendants' counsel that their use of the plaintiffs' trade marks in invoices was an infringement, and an injunction against infringement of trade mark was granted. Under the Merchandise Marks Act, 1887, a description in an invoice sent with goods has been held to be "applied to goods" within sec. 5 (d): *Budd v. Lucas*, [1891] 1 Q. B. 408, Pollock and Charles, JJ.

<sup>5</sup> *Linoleum Manufacturing Co. v. Nairn*, 7 C. D., p. 836 (1878).

and the inquiry as to the use of the word *Linoleum* as a misrepresentation, are one and the same inquiry, and I must consider what the word *Linoleum* meant as used at the time when the defendants intended to attribute it to their manufacture."

By sec. 89 of the Act of 1905 the exclusive right conferred on the registered proprietor of a trade mark is "to the use of such trade mark upon or in connection with the goods in respect of which it is registered." And this accords with the statutory definition of a trade mark.<sup>1</sup> It is submitted that the words quoted are sufficiently wide to cover any such use as indicates, or purports to indicate, the proprietorship of the goods, whether the mark is attached to the goods, or used in invoices, trade descriptions, or as a trade name of the goods.<sup>2</sup>

The infringing mark may either (a) be an actual or substantial copy of the plaintiff's mark; (b) consist of or comprise its essential features; or (c) be a colourable imitation of it.<sup>3</sup>

(a) The first case presents no difficulties. By sec. 40, the registration of the plaintiff as proprietor of the trade mark is *prima facie* evidence of the validity of the registration,<sup>4</sup> and, after the period of seven years mentioned in sec. 41 and subject to certain exceptions, conclusive evidence of his right to the exclusive use of the trade mark.<sup>5</sup> The registered proprietor can therefore make a case in an action for the mere using of his mark in connection with goods of the class over which his right extends, without showing that the use is calculated to deceive.<sup>6</sup> And this is not, substantially, an alteration of the law as it stood before the Acts<sup>7</sup> if registration be taken as equivalent to public user,<sup>8</sup> although proof of the probability of deception was usually, but not invariably,<sup>9</sup> mentioned as an element of right of action;

Where the plaintiff's mark has been copied.

<sup>1</sup> Sec. 3.

<sup>2</sup> See, however, the judgment of Warrington, J., in *Peters, Ltd. v. Domestic Inventions Co.*, 25 R. P. C. 387 (1908), above, p. 31, note (1). See also above, p. 328.

<sup>3</sup> It will be seen that (b) and (c) are not distinct cases, although they are separated for convenience in the text. The test of infringement is the same in each (p. 400). In case (b) the whole mark must be infringed, and in case (c) essential features are necessarily imitated or copied.

<sup>4</sup> Above, p. 329.

<sup>5</sup> This is the effect of secs. 39 and 41

combined. The exceptions are dealt with above, p. 332.

<sup>6</sup> See the judgment of Cotton, L.J., in *Edwards v. Dennis*, 30 C. D. 454 (1885), and *Lambert v. Goolbody*, 19 R. P. C. 377 (1902), Farwell, J.

<sup>7</sup> Cf. with the judgment last referred to that of Hall, V.-C., in *Cope v. Evans*, 18 L. R. Eq. 138 (1874).

<sup>8</sup> See sec. 75 of the Act of 1883, p. 632.

<sup>9</sup> For instance, see the judgments of Jessel, M.R., in *Singer Manufacturing Co. v. Wilson*, 2 C. D. p. 442 (1875), and of Id. Cranworth in *The Leather Cloth case*, 11 H. L. C. p. 533; 35 L. J. Ch. 53 (1865).

for if the defendant had taken a "material and substantial" portion of the plaintiff's mark, and, *à fortiori*, if he had taken the whole, the onus of showing that his conduct was not calculated to deceive was cast upon him,<sup>1</sup> and it was practically, at any rate, impossible for him to support it. Moreover, unless he could give a reasonable explanation to show how he came to adopt a mark identical with that of the plaintiff, the Court would infer that he intended to deceive,<sup>2</sup> and would not consider whether or not his attempt was likely to be successful.<sup>3</sup>

False claim to the plaintiff's registered marks.

The infringement proved in *Paine & Co. v. Daniells & Sons' Breweries*<sup>4</sup> was effected in a very unusual way. The plaintiffs' marks consisted of labels bearing a figure of John Bull, and the words *John Bull* and *John Bull Brand*. The defendants used a label bearing a different figure of John Bull, with the words *John Bull, Registered*. Their label, though entered as their copyright at Stationers' Hall, had been, in 1885, refused registration as a trade mark, on the ground of the plaintiffs' opposition, but they had, notwithstanding the refusal, continued to use it in their business. Although the labels had been in use so long, no evidence of actual deception was tendered, for the trades of the plaintiffs and defendants had been carried on in different districts, and were only beginning to overlap at one point at the date of the trial. There was no other evidence than that furnished by the labels themselves that the defendants' label was calculated to deceive; but the Court of Appeal regarded the false claim of registration in their label as amounting in effect to a representation that the plaintiffs' marks—the only John Bull marks which really were registered—were their own, and this was held to be an undoubted infringement;<sup>5</sup> and in a later case the use of the word "registered" on the label complained of, registration of which had been refused, was held to be a disparagement of the plaintiffs' mark as registered, and to be an

<sup>1</sup> *Ford v. Foster*, 7 Ch. 611 (1872), James, L.J.; *Orr-Ewing v. Johnston*, 13 C. D. 434 (1879), Fry, J., and C. A. See also *Ld. Herschell in Reddaway v. Banham*, 13 R. P. C. at p. 228.

<sup>2</sup> See *The Orr-Ewing* case, in the H. L., 7 App. Ca. 219; *Taylor v. Taylor*, 23 L. J. Ch. 255 (1854), Wood, V.-C.

<sup>3</sup> See *per Lindley, L.J., in Sluzenger v. Feltham*, 6 R. P. C. p. 538 (1889).

See, however, *Lever v. Beddingfield*, cited below, p. 399, note (3).

<sup>4</sup> [1892] 2 Ch. 567; 10 R. P. C. 71, 217, C. A.

<sup>5</sup> *Lawrie v. Baker*, 2 R. P. C. 213 (1885), Day, J., is a similar case. There the defendant described his goods as *patent cups*, the plaintiff having the only patent. Cf. *Pneumatic Stamp Co. v. Lindner*, 15 R. P. C. 525.

element tending to show want of good faith in the manufacturers who issued the label.<sup>1</sup>

(b) The right of the registered proprietor exists in regard to the whole mark, not in regard to any particular part of it,<sup>2</sup> and an infringement must be an infringement of the whole mark.<sup>3</sup> "It is established by the history of the defendant's label and by comparing it with the plaintiffs' label of 1894, that the central space and curved scroll on the plaintiffs' label have been utilised, and to some extent copied, by the person employed by the defendant to prepare his label. If, notwithstanding this circumstance, the defendant's label as a whole is not a copy of the plaintiffs' labels, and is not as a whole a colourable imitation of them, it cannot be truly said that the defendant has infringed the rights conferred upon the plaintiffs by the registration of their marks."<sup>4</sup> But the adoption of a single characteristic and distinctive particular from the plaintiff's mark, and its use alone, or with other matter, may well be an infringement of the entire mark. At any rate, it throws upon the defendant the onus of proving the contrary.<sup>5</sup> But it is not an infringement to take non-essential particulars from a mark: for instance, to take merely descriptive or other common words<sup>6</sup> or common matter.<sup>7</sup> In

Where an essential feature has been copied.

<sup>1</sup> *Boord & Son v. Huddart*, 21 R. P. C. 149 (1904), Swinfen Eady, J. See also *Finlay v. Shamrock Co.*, 22 R. P. C. 301, Porter, M.R., Ireland. Cf. *Warsop & Sons, Ltd. v. Warsop*, 21 R. P. C. 481 (1904), Kekewich, J., where the defendant's use of "registered" was as between him and the plaintiffs innocent.

<sup>2</sup> *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886), Cotton, L.J.; *Christiansen's Tm.*, 3 R. P. C. 54 (1886), C. A.

<sup>3</sup> *Lever v. Beddingfield*, 16 R. P. C. 3, at p. 10 (1899) (*Sunlight and Redmaid Soaps*); so *Rugby Cement Co. v. Rugby and Newbold Co.*, note (6), and *Hennessy & Co. v. Dompé*, 19 R. P. C. 333 (1902), Kekewich, J.; on appeal, in this case, however, the defendants admitted that they had infringed by the use of the labels complained of, 20 R. P. C. 175.

<sup>4</sup> Per Lindley, M.R., in *Lever v. Beddingfield*, note (3).

<sup>5</sup> *Ford v. Foster*, 7 Ch. 611 (1872), James, L.J.; *Johnston v. Orr-Ewing*, 13 C. D. 434 (1879), Fry, J., and C. A. See *Finlay v. Shamrock*, 22 R. P. C. 301 (1904), Porter, M.R., Ireland, where, the

plaintiff being registered for a shamrock leaf, the defendants had taken the top leaf only of the trefoil, but used it in connection with the word "shamrock." This was held to be an undoubted infringement.

<sup>6</sup> *Linoleum Manufacturing Co. v. Nairn*, 7 C. D. 834 (1878), Fry, J. (*Linoleum*); *Watt v. O'Hanlon*, 4 R. P. C. 1 (1886), Porter, M.R. (*Old Innishowen*); *Humphries v. Taylor's Drug Co.*, 59 L. T. 820 (1888), Kekewich, J. (*Herbalin*); *Native Guano Co. v. Sewage Manure Co.*, 8 R. P. C. 125 (1888), C. A. and H. L. (*Native Guano*); *Rugby Cement Co. v. Rugby and Newbold Co., Ltd.*, 8 R. P. C. 241; 9 R. P. C. 46 (1891), Vaughan Williams, J., and C. A.; cf. Chap. X., p. 252; and *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L.J. See, further, next chapter, p. 507.

<sup>7</sup> See *Hennessy v. Dompé*, 19 R. P. C. 333 (1902), Kekewich, J. (reversed by consent on appeal), 20 R. P. C. 175; and *Hennessy v. Keating*, 25 R. P. C. 125 and 361 (1908), C. A., Ireland, and H. of L.

Usages of the trade.

particular, it is provided by sec. 44 of the Act of 1905 that no registration 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 the goods. By sec. 48 the Court trying the question of infringement shall admit evidence of the usages of the trade in respect to the get-up of the goods for which the trade mark is registered, and of any trade marks or get-up legitimately used in connection with such goods by other persons.

Where there is a colourable imitation.

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

#### Colourable Imitation.

The test of infringement

In both the second and third cases the test of infringement is the question whether or not the defendant's mark is calculated to cause his goods to be taken by ordinary purchasers<sup>1</sup> for the goods of the plaintiff,<sup>2</sup> and the Registration Acts have made no alteration of the law in this respect.<sup>3</sup>

“It is not a question whether this (the use of the defendant's mark) necessarily is deceptive, but whether there is not a strong probability of its causing deception.”<sup>4</sup> So that the imitation of the plaintiff's mark cannot be justified by showing either that the device or inscription on the imitated mark is ambiguous, and capable of being understood by different persons in different

<sup>1</sup> See above, p. 236.

<sup>2</sup> *Hull v. Barrows*, 4 De G. J. & S. 150; 33 L. J. Ch. 204 (1863), Westbury, L.C.; *Leather Cloth Co., Ltd. v. The American Cloth Co., Ltd.*, 4 De G. J. & S. 137; 33 L. J. Ch. 199 (1863), Westbury, L.C.; 11 H. L. C. 523; 35 L. J. Ch. 53. The suggestion in the Scotch case of *Crawford v. Bernard*, 11 R. P. C. 580 (1894), Ld. Kyllachy, that colourable infringement can be judged of apart from probability of deception, is not

in accordance with the authorities.

<sup>3</sup> *Mitchell v. Henry*, 15 C. D. 181 (1880), C. A.; *Singer Manufacturing Co. v. Loog*, 18 C. D. 395, C. A.; 8 App. Ca. 15 (1870); *Edwards v. Dennis*, 30 C. D. 454 (1885), Cotton, L.J.; *Lever v. Bedingfield*, p. 399, note (3). *Lambert & Butler, Ltd. v. Goodbody*, 19 R. P. C. 377 (1902), Farwell, J.

<sup>4</sup> *Per* Cotton, L.J., in *The Upper Assam Tea Co. v. Herbert & Co.*, 7 R. P. C. p. 186 (1889).

ways, or that a person who carefully and intelligently examined and studied it might not be misled.<sup>1</sup>

There can be no infringement, therefore, in cases where the plaintiff's mark is not actually copied, if there is no reasonable probability of deception.<sup>2</sup> It was held by the Court of Common Pleas, as early as 1847, that the following questions were properly left to the jury by Williams, J., in *Rodgers v. Nowill*<sup>3</sup> :—

Questions for the jury.

(1) Whether there was such a resemblance to the plaintiffs' marks, in the marks put on the knives made by the defendants, as was calculated to make an ordinary person believe that the marks were the marks of the plaintiffs, denoting that the knives were the knives of the plaintiffs? and (2) Did the defendants, with an intention to deceive, sell these knives representing them to be the manufacture of the plaintiffs? It will be shown immediately that, if the plaintiffs' mark was their trade mark, the second question has long been held to be immaterial, except so far as it dealt with the mere fact of the sale of the knives.

The same test, as will be shown in the next chapter, applies also to actions for "passing-off." It is sometimes suggested that a less degree of resemblance between the plaintiff's and defendant's marks will suffice to support an action for "passing-off" than is required to support an action for infringement, or, what is the same thing, proof of a lower degree of probability of deception. This distinction is, it is submitted, unnecessary and inconvenient. In the cases before the Acts, when the two classes of actions were not yet separated, there could have been no ground for it, and there is nothing in the Acts to require its introduction. The essential difference is plain enough. In an infringement action the plaintiff can rely only upon the imitation of his registered mark, while in an action for "passing-off" he may rely on other things, or on additional things, which are proved to be connected with his trade or goods.

Actions for infringement and for passing-off.

Proof of actual deception, if the mark is, in the opinion of the Court, calculated to deceive, or if the plaintiff's registered mark

Actual deception need not be proved :

<sup>1</sup> Per Ld. Selborne in *The Singer Manufacturing Co. v. Loog*, 8 App. Ca. p. 18 (1882).

<sup>2</sup> *Cope v. Evans*, 18 L. R. Eq. 138 (1874), Hall, V.-C.; *Beddow & Sons v. Boyd*, 4 R. P. C. 310 (1887), Chatterton, V.-C.; see also *Wollam v. Radcliff*, 1 H. & M. 259 (1863), Wood, V.-C.;

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

<sup>3</sup> 5 C. B. 109; 17 L. J. C. P. 52.

has been substantially copied,<sup>1</sup> is unnecessary, although the absence of it, where the plaintiff's and defendant's marks have circulated side by side for a considerable time, may go far to negative the probability of deception, unless it is explained, for instance, by the practical impossibility of calling evidence from a distant country to show that purchasers there have been deceived.<sup>2</sup> The plaintiff is not bound to wait to see whether his customers will, in fact, be deceived, for "the very life of a trade mark depends upon the promptitude with which it is vindicated."<sup>3</sup>

nor yet an  
intention to  
deceive.

Nor where the defendant's mark has in fact deceived, or is, in the opinion of the Court, calculated to do so, is it necessary to show that the defendant intended to deceive. This was first decided by Lord Cottenham, in *Millington v. Fox*,<sup>4</sup> as regards the relief by an injunction, and by Lord Westbury, in *Edelsten v. Edelsten*,<sup>5</sup> as regards both injunction and account. It is now well-settled law.<sup>6</sup> The dicta of Lord Chelmsford in *The Glenfield Starch* case, that, where the trade mark is not actually copied, fraud is a necessary element in the plaintiff's case—"that is, the party accused of piracy must be proved to have done the act complained of with the fraudulent design of passing off his own goods as those of the party exclusively entitled to the trade mark"<sup>7</sup>—and of Jessel, M.R., and the Court of Appeal, in *The Singer Manufacturing Co. v. Wilson*,<sup>8</sup> that, where the defendant has not actually put the plaintiff's trade mark, or a colourable imitation of it, on his goods, or on the bottles or boxes containing them, but has otherwise acted so as to represent his goods as those of the plaintiff,<sup>9</sup> a fraudulent intent must be proved, cannot now be taken to be law. In the former case,

<sup>1</sup> Above, p. 397; and see *Paine & Co. v. Daniells & Sons' Breweries*, cited ante, p. 398.

<sup>2</sup> Page 259; and see *Lambert and Butler, Ltd. v. Goodbody*, 19 R. P. C. 377 (1902); *Bourne v. Swan and Edgar, Ltd.*, 20 R. P. C. 105 (1903), both Farwell, J., and *Iron Ox Remedy Co. v. Co-operative Wholesale Society, Ltd.*, 24 R. P. C. 425 (1907), Parker, J., a passing-off case.

<sup>3</sup> *Johnston v. Orr-Ewing*, per James, L.J., 13 C. D. p. 464; and *Ld. Blackburn*, 7 App. Ca. p. 230 (1880).

<sup>4</sup> 3 My. & Cr. 338 (1838).

<sup>5</sup> 1 De G. J. & S. 185; 10 L. T. N. S. 780 (1863).

<sup>6</sup> *Reddaway v. Bentham Hemp Spin-*

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

<sup>7</sup> *Wotherspoon v. Currie*, L. R. 5 H. L. p. 519 (1872).

<sup>8</sup> 2 C. D. 432 (1875).

<sup>9</sup> As already shown, these may be cases of infringement if the representation is effected by using a mark in connection with the defendant's goods (though not on them) which resembles the plaintiff's mark, or by using a distinctive name taken from the plaintiff's mark; above, p. 395.



Lord Hatherley said it had been pointed out that a *mala fides* towards the first purchaser was not the ground of the Court's interference; for it is sufficient if such purchaser is furnished by the defendant with goods bearing a label, of which the necessary consequence is that he is enabled to deceive others by means of them.<sup>1</sup> And in *The Singer* case Lord Cairns said: "I wish to state in the most distinct manner that, in my opinion, fraud is not necessary to be averred or proved in order to obtain protection for a trade mark";<sup>2</sup> and in this Lord O'Hagan concurred.<sup>3</sup> Lord Blackburn said: "I am not as yet prepared to assent either to the position that there is a right of property in a name, or, what seems to me nearly the same thing, to assent to its full extent to the proposition that it is not necessary" (in trade name cases) "to prove fraud."<sup>4</sup> But the last-mentioned judge, in a subsequent case, stated that he thought it clear, at any rate, that if the defendant persevered in using a trade mark calculated to deceive after notice of the facts, that would be evidence to support a claim for damages for knowingly selling his goods as and for those of the plaintiff.<sup>5</sup> "However honest or inadvertent the original mistake may have been, the continuation of the use of it after that was pointed out is of itself evidence of a fraudulent intention."<sup>6</sup>

And it has already been shown that the proprietor of a trade mark may obtain an injunction against an innocent consignee of spuriously marked goods, and an order for the spurious marks to be expunged from the goods, without having given the defendant any notice before the commencement of the action.<sup>7</sup>

On the other hand, the mere intention of the defendant to deceive, if the Court is clearly of opinion that the mark complained of is not calculated to deceive, cannot constitute an infringement;<sup>8</sup> but if there be an intention to deceive, success will easily be presumed.<sup>9</sup>

It follows that the question to be answered, when an infringe-

What resemblance is calculated to deceive.

<sup>1</sup> L. R. 5 H. L. p. 517.

<sup>2</sup> 3 App. Ca. p. 391, quoted and adopted in *Bodega Co., Ltd. v. Owens*, 7 R. P. C. 31 (1889). Chatterton, V.-C.

<sup>3</sup> 3 App. Ca. 396.

<sup>4</sup> Page 400.

<sup>5</sup> *Singer Manufacturing Co. v. Loog*, 8 App. Ca. 31 (1882); and *Cochrane v. McNish*, [1896] A. C. 225; 13 R. P. C. 100. Privy Council.

<sup>6</sup> Per James, L.J., in *Orr-Ewing v. Johnston*, 13 C. D. p. 454 (1880); see also *Paine & Co. v. Daniells & Sons Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 217, C. A., cited above, p. 398.

<sup>7</sup> Above, p. 382; *Upmann v. Forester*, 24 C. D. 231 (1883), Chitty, J.; *American Tobacco Co. v. Guest*, [1892] 1 Ch. 630; 9 R. P. C. 218, Stirling, J.

<sup>8</sup> See next chapter, p. 523.

ment without taking the actual mark is alleged, is the same question as arises when a mark tendered for registration is objected to, or, having been registered, is sought to be removed from the Register, on the ground that it so nearly resembles a trade mark already on the Register as to be calculated to deceive, within the restriction of sec. 19. The principles governing the comparison of the marks, and determining what amount of resemblance is calculated to deceive, are the same in both cases, although a higher standard of resemblance must be conformed to in an action for infringement than that set up in cases of the other class. These principles have been already discussed at length,<sup>1</sup> and it will therefore be sufficient in this place to shortly summarise the conclusions deduced from an examination of the authorities.

The probable purchasers are to be considered.

(1) The persons with regard to whom the test question—Is the spurious mark calculated to deceive them?—ought to be asked are the persons who are probable purchasers, whether they buy, or are likely to buy, directly from the plaintiff or defendant, or from, or through, intermediate purchasers from either of them, and whether they are English or foreign, and not merely very careful or intelligent persons, but ordinary unwary purchasers.<sup>2</sup> No rule has, or probably can be, laid down as to what amount of intelligence or knowledge of the trade in question ought to be attributed to them, since this must necessarily vary with the nature of the case.<sup>3</sup>

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

(2) No definite rule as to the amount of resemblance required can be formulated *à priori*, but the net impression produced and “the main idea left on the mind” by one mark must be compared with that left by the other, for marks may well be confused by purchasers, who see the defendant’s mark when they have present in their memories only an indefinite recollection of the plaintiff’s, in cases where the marks could not be mistaken for each other if they were seen side by side.<sup>4</sup> So that the whole mark of the defendant may too nearly resemble that of the plaintiff, although all the essential particulars of the two are distinguishable;<sup>5</sup> but

<sup>1</sup> Chap. X., pp. 231 *et seq.*

<sup>2</sup> Page 235; and *Shrimpton v. Lought*, 18 Beav. 164 (1854), Romilly, M.R. As to infringements alleged to be instruments of fraud in the hands of retailers, see below, p. 408.

<sup>3</sup> See the “passing-off” cases, *Pupton v.*

*Snelling*, 17 R. P. C. 48; and *Pupton v. Titus Ward*, *ibid.* 58 (both 1899, C. A.), and above, p. 236. The first-mentioned decision was affirmed in the H. of L., 17 R. P. C. 628.

<sup>4</sup> Page 237.

<sup>5</sup> Page 210.

special regard must, nevertheless, be paid to the essential features of the plaintiff's mark in considering whether the defendant has infringed it.<sup>1</sup>

(3) Further, the marks must be compared as they are seen in actual ordinary use<sup>2</sup> on the goods they are used for; remembering, however, that so far as the plaintiff's mark substantially differs from the mark on the Register it is an unregistered mark.<sup>3</sup>

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

(4) The circumstances of the trade<sup>4</sup> and market in which the marks are used must be considered also,—the language of the purchasers, for instance, and the number of analogous marks in use in connection with the same goods.<sup>5</sup> Section 43 of the Act of 1905 provides that in an action for the infringement of a trade mark the Court trying the question of infringement shall admit evidence of the usages of the trade in respect to the get-up of the goods for which the trade mark is registered, and of any trade marks or get-up legitimately used in connection with such goods by other persons. Where the defendant's mark is identical with or substantially the same as the plaintiff's registered trade mark, the similarity or dissimilarity of the get-up of the respective goods can have little, if any, bearing on the question of infringement;<sup>6</sup> but where there is no such close resemblance, the get-up of the goods may become a material factor. Thus in a passing-off case where it was alleged that the defendants' "Ivory" soap was calculated to deceive on account of its similarity to the plaintiffs' "Ivy" soap, and there was no similarity in the get-up of the goods, the action and an appeal by the plaintiffs were dismissed.<sup>7</sup> Also the distinctiveness or degree of distinctiveness of a trade mark may be affected by other trade marks used by rival traders. Thus the owner of a registered trade mark consisting of a star might be prevented from claiming the exclusive right to use such a device generally by the existence of other star trade marks, but might at the same time have a perfectly good right to protect his special form of star.<sup>8</sup>

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

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<sup>1</sup> Pages 237 and 246; and cases in note (3), p. 404; also *Hubbuck v. Brown*, 17 R. P. C. 148 and 638 (1900), Kekewich, J., and C. A., and *Marshall v. Siddebottom*, 18 R. P. C. 43 (1901), Kekewich, J.

<sup>2</sup> Page 241.

<sup>3</sup> Page 246.

<sup>4</sup> *McNish*, [1896] A. C. 225, 1900 R. P. C. 100, P. C. (*Club Soda*).

<sup>5</sup> Page 18.

<sup>6</sup> *Apollinaris Co. v. Herzfeldt*, 4 R. P. C. 478 (1887), Chitty, J., and C. A.

<sup>7</sup> *Goodwin v. Ivory Soap Co.*, 17 R. P. C. 689; 18 R. P. C. 389 (1901), Kekewich, J., and C. A.

<sup>8</sup> See *Wills' Tms.*, 10 R. P. C. 269 (1893), Wright, J.; *Buss, Ratcliff and Gretton, Ltd.'s Tms.*, 19 R. P. C. 129 and 529 (1902), C. A., reversing Kekewich, J., and *Star Cycle Co., Ltd. v. Frankenburgs*,

Colour.

But, since colour is not admitted to consideration in estimating the distinctiveness of a mark tendered for registration, unless the mark be limited in whole or in part to one or more specified colours,<sup>1</sup> similarity of colour is not to be greatly relied upon in deciding a question of infringement,<sup>2</sup> although it is an element to be considered. If a trade mark is registered with a limitation to a certain colour or to certain colours, there could be no infringement by the use in other colours, for by sec. 39 the exclusive use is only conferred subject to the limitation, but a case of passing-off might be established.

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

If the plaintiff's mark, or some feature of it, has led to the application of a particular name to his goods, it is an infringement for the defendant to use a mark which is calculated to cause the same name to be applied to his,<sup>3</sup> unless the name is applied not merely to the plaintiff's goods, but to all goods of the kind,<sup>4</sup> for instance, because it is suggested by matter in the mark which is common to the trade;<sup>5</sup> and the defendant's use of his mark is none the less an infringement of the plaintiff's rights because the exclusive use of the name may give the plaintiff a practical monopoly in certain goods in a particular market.<sup>6</sup>

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

Attention must be paid, of course, not only to the points of resemblance between the marks, but also to the points of difference. But it will not be sufficient for the defendant to show that the differences might prevent purchasers being deceived. If there is a case for him to answer, the Court must hold that they are "such as to prevent its being likely that they would be deceived."<sup>7</sup>

Instances of infringements by marks

In the following cases it was held that the use of words taken from the plaintiff's mark by the defendant was an infringement,

24 R. P. C. 46 and 405 (1907), *Swinfen Eady, J.*, and C. A., a passing-off case in which, the plaintiffs having at a certain stage in the case claimed the word "Star" in any combination, evidence was admitted of users by other persons of such combinations as "Eastern Star."

<sup>1</sup> Sec. 10. *Hanson's Tm.*, 37 C. D. 112; 5 R. P. C. 130 (1887), *Kay, J.*, at p. 209.

<sup>2</sup> *Nuthall v. Vining*, 28 W. R. 32 (1880), C. A. If, and so far as, a trade mark is registered without limitation of colour, it is to be deemed to be registered for all colours, sec. 10. Colour is often of great importance in a case of "get up."

See the next chapter.

<sup>3</sup> Page 250 *et seq.* This appears to have been treated rather as "passing-off" than infringement by *Romer, J.*, in *Hudgson v. Kynoch*, 15 R. P. C. 465, at p. 473 (1898).

<sup>4</sup> Page 252.

<sup>5</sup> Page 251. See note (3), p. 404, above.

<sup>6</sup> Page 255. See *The Yorkshire Wale's* case, cited below, p. 513.

<sup>7</sup> Per *Ld. Blackburn*, in *Johnston v. Orr-Ewing*, 7 App. Ca. p. 230 (1882), quoted and followed by the Privy Council in *Somerville v. Schembri*, 12 App. Ca. p. 458; 4 R. P. C. 179 (1887). Cf. p. 407, note (2).

notwithstanding that he always added his own name :—*Perry v. Truefitt*, 6 Beav. 66, PERRY'S MEDICATED MEXICAN BALM, TRUEFITT'S MEDICATED MEXICAN BALM; *Braham v. Bustard*, 1 H. & M. 477, BUSTARD & Co.'s EXCELSIOR WHITE SOFT SOAP; *Kinahan v. Bolton*, 15 Ir. Ch. 75, KINAHAN'S LL WHISKY, BOLTON'S LL WHISKY; *Ford v. Foster*,<sup>1</sup> L. R. 7 Ch. 611, FORD'S EUREKA SHIRTS, FOSTER, PORTER & Co.'s IMPROVED EUREKA SHIRTS; *Eno v. Stephens*, Seb. Dig. p. 372; *Eno v. Dunn*, 10 R. P. C. 261, ENO'S FRUIT SALT, STEPHENS & Co.'s EFFERVESCING VINOUS FRUIT SALTS; DUNN'S FRUIT SALT AND CHLORATE OF POTASH LOZENGES. In *The Glenfield Starch* case,<sup>2</sup> *Wotherspoon v. Currie*, L. R. 5 H. L. 508, the defendant's own name appeared in bold letters upon the infringing labels, and this was also the case in *Johnston v. Orr-Ewing*, 13 C. D. 434, and 7 App. Ca. 219, but there the Indian customers of the plaintiff could not, it was assumed, read English.<sup>3</sup> So, in *Rose v. Loftus*, 47 L. J. Ch. 576, the defendant washed the plaintiff's labels off the bottles, leaving only the moulded marks, and pasted his own labels upon the bottles in their place, but was, nevertheless, held to have committed an infringement. And in *Curtis and Harvey v. Pape*, 5 R. P. C. 100, an imitation of a diamond mark was held to be an infringement, although the defendant put a K in the middle of his diamond which did not appear in that of the plaintiffs.

But the use of the defendant's name as part of the mark complained of is an element to be considered, and in some cases it has turned the scale in his favour. Thus, in *Beard v. Turner*, 13 L. T. N. S. 746, KIRBY'S NE PLUS ULTRA NEEDLES, on a label, was held not to be infringed by TURNER'S NE PLUS ULTRA NEEDLES on a label generally resembling the plaintiff's, the words NE PLUS ULTRA being common to the trade; and in *Blackwell v. Crabb*, 36 L. J. Ch. 504, BLACKWELL'S PICKLES on a label, not to be infringed by CRABB'S PICKLES on a label resembling the plaintiffs', the name of the manufacturer, under

<sup>1</sup> Cited p. 38.

<sup>2</sup> Cited p. 51. In *The Yorkshire Relish* case, cited p. 512, the defendants did everything possible to distinguish their goods, the name of Holbrook, their predecessor in business, being prominent on the labels, but this proved to be insufficient while they used the (unregistered) trade mark. The name *Stevenson's*, prefixed to "camel hair belting," which by

itself admittedly meant the plaintiff's belting (see *Redlaway v. Banham*, cited p. 42), was held not to distinguish sufficiently. *Redlaway & Co., Ltd. v. Stevenson and Brother, Ltd.*, 20 R. P. C. 276 (1903), Hall, V.-C.; but cf. *Samie v. Frictionless Engine Pecking Co., Ltd.*, 19 R. P. C. 504 (1902), Hall, V.-C.

<sup>3</sup> *Henderson v. Jorss*, Seb. Dig. p. 110 (1861). *Wood*, V.-C., is a similar case.

which prominently displayed the defendant's name.

the circumstances of the case, being the thing which a customer would rely on most to establish the identity of the goods he wanted. In each of these cases the elements of all the labels were for the most part common to the trade.<sup>1</sup>

Differences which may be removed by retailers are disregarded.

Where any such additions or precautions are relied on by the defendant to rebut an alleged infringement, it is necessary to inquire whether they may not be removed or obliterated by fraudulent retail dealers leaving the imitated marks to effect deception without any check.<sup>2</sup> On this ground, in *Barlow v. Johnson*,<sup>3</sup> the Court paid no regard to the tickets and labels attached by the defendant to the towels sold by him under the name, *Osman*, which he had taken from the plaintiff's trade mark.

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

Probability of deception is, of course, a question of fact, and, except so far as they lay down any general principle of comparison, the decided cases are of no assistance in the determination of new questions of fact raised upon other materials. "How can observations of judges upon other and quite different facts bear upon the present case, in which the only question is what is the result of the evidence?" Lord Watson asked, in *Johuston v. Orr-Ewing*,<sup>4</sup> but the habit of referring to reported cases at the trial of such questions is inveterate, and it has been thought useful, therefore, to collect the cases just cited, and those cited at pp. 260 and 264, above.

Inconspicuous additions a badge of fraud.

The reported cases show that attempts are frequently made to prevent the interference of the Court by the use, along with the spurious or deceptive marks, of words, descriptions, or other additions which, if carefully examined, would prevent the deception, and at the same time, by writing the additions in small letters, or otherwise causing them to be comparatively inconspicuous, to make the probability of careful examination as small as the infringer thinks he safely can. It is obvious that, so far from affording an answer to a charge of infringement, such colourable precautions are themselves a badge of fraud. The defendant is met at once with the questions, if the additions are necessary, why are they not made conspicuous? and, if they

<sup>1</sup> See also the "passing-off" cases, *Jamieson v. Jamieson*, 15 R. P. C. 169 (1898), C. A.; *Poyton v. Snelling*, 17 R. P. C. 18 and 628 (1900), C. A. and H. of L.; and *Payton v. Titus Ward*, *ibid.*, 18 (1899), C. A., cited p. 242; and *King &*

*Co., Ltd. v. Gillard & Co., Ltd.*, 22 R. P. C. 327 (1903), C. A.

<sup>2</sup> See below, p. 456.

<sup>3</sup> 7 R. P. C. 395 (1890), Chitty, J., and C. A.

<sup>4</sup> 7 App. Ca. 219 (1882).

are superfluous, why are they used at all?<sup>1</sup> In the following cases the several additions noted in brackets were added in small letters to the plaintiff's name or trade mark, or to an imitation of it: [Equal to] Day & Martin's, injunction granted, *Day v. Binning*, C. P. Cooper, 489; [Late of] Lundy, Foot & Co., dismissed pending verdict at law, *Foot v. Lea*, 13 Ir. Eq. 484; [From] Thresher & Glenny, injunction granted, *Glenny v. Smith*, 2 Dr. & Sm. 476; [From] Hookham & Pottage, injunction granted, *Hookham v. Pottage*, L. R. 8 Ch. 91;<sup>2</sup> [Agent for] Mason & Brand's Essence of Beef, injunction granted *Dence v. Mason*, W. N. (1877), 23; W. N. (1878), 42; C. B. [& Co.], the plaintiff's mark was C. B., the infringing goods were made by Connell Brothers & Co., injunction granted, *Bayer v. Baird*;<sup>1</sup> [Successors to] Jefferson Dodd, held on a motion to sequester to be calculated to deceive, the name being on the fascia of the shop, and the words "successors to" on the plate glass front, *Jefferson Dodd, Ltd. v. Dodd's Drug Stores, Ltd.*, 25 R. P. C. 16 (1908).

### 5. Defences.

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

The ordinary defences.

- (1) The plaintiff has no title to the trade mark in question;<sup>3</sup>
- (2) The defendant has an independent or a concurrent right to use the mark complained of;
- (3) The plaintiff has not complied with the provision of sec. 42 by obtaining the registration or refusal of the mark;<sup>4</sup>
- (4) There is no infringement;<sup>5</sup>
- (5) The plaintiff is debarred from suing the defendant for all or part of the relief he seeks by (a) an agreement or some personal estoppel (other than those next alluded to); (b) acquiescence or licence; (c) delay; or (d) because the trade mark is deceptive, or his trade is fraudulent.<sup>6</sup>

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

<sup>1</sup> *Bayer v. Baird*, 15 R. P. C. 615 (1896), Court Sess.; *Bayer v. Connell*, 16 R. P. C. 157 (1899), M.R. of Ireland.

<sup>2</sup> Where the widow of a late servant of the plaintiff's continued his business with the use of the words "from G. F. Cockerell & Co., Ltd." rightly used by him, an injunction against such use by her was refused; *Rickett, Cockerell & Co., Ltd. v. Nevill*, 21 R. P. C. 394 (1904),

Kekewich, J.

<sup>3</sup> Pages 383 *et seq.* and 410. The question whether the mark concerned is a trade mark at all, as to which see Chap. II., p. 22, seldom arises in practice, except on an application to expunge an entry from the Register.

<sup>4</sup> Chap. XII., p. 334.

<sup>5</sup> Page 389.

<sup>6</sup> Page 419.

## Application to vary.

Attack on the plaintiff's title.

(1) If the plaintiff's mark has been registered for seven years from the date of the original registration or from the date of the passing of the Act of 1905 (August 11th, 1905),<sup>1</sup> whether in his name or in that of his predecessor in title,<sup>2</sup> the registration is conclusive evidence of his exclusive right to the use of the mark,<sup>3</sup> subject to the provisions of the Act.<sup>4</sup> The defendant is not, however, precluded from proving the invalidity of any assignment or transmission, but the registration of the plaintiff as proprietor is *prima facie* evidence of the validity of his title in these respects.<sup>5</sup> The defendant can adduce evidence to show,<sup>6</sup> or he may show from the plaintiff's own evidence,<sup>7</sup> that the plaintiff does not possess the goodwill of the business in the goods to which the trade mark is attached; but he cannot attack the plaintiff's title generally, for instance, by showing that the mark is not a trade mark,<sup>8</sup> or is not within the classes of registrable symbols enumerated in sec. 9, except on an application under sec. 35,<sup>9</sup> and can only so attack the original registration if the plaintiff is not protected by sec. 41. The application cannot be made by counterclaim in the action.<sup>10</sup>

If the plaintiff's mark has not been registered for the period mentioned in sec. 41, the defendant can (probably) attack his title without an application to vary the Register.<sup>11</sup>

Application to expunge or limit the plaintiff's registration.

It follows that the defendant in an infringement action, unless satisfied that the plaintiff's title cannot safely be attacked, generally applies to expunge the mark of the latter from the Register, or to so limit it as to defeat the action, and, according to the usual practice, the application comes on for hearing with the trial of the action, or with the plaintiff's motion for an interlocutory injunction, if any. The Court will, in a proper case, adjourn the decision of the last-mentioned motion in order to enable the defendant to make his cross application to rectify or expunge.<sup>12</sup>

<sup>1</sup> Sec. 41, ante, p. 330.

<sup>2</sup> Above, p. 330.

<sup>3</sup> Sees. 39 and 41. Above, pp. 325 *et seq.*

<sup>4</sup> Above, p. 332.

<sup>5</sup> Sec. 40, above, pp. 329 and 334.

<sup>6</sup> *Edwards v. Dennis*, 30 C. D. 454 (1885), C. A.

<sup>7</sup> As in *Pinto v. Badman*, 8 R. P. C.

181 (1891), C. A.

<sup>8</sup> See Chap. II., p. 22.

<sup>9</sup> As to which see Chap. XI., p. 276.

<sup>10</sup> *Pinto v. Badman*, supra. Cf. sec. 32 of the Patents and Designs Act, 1907. As to procedure in Scotland, see above, p. 303.

<sup>11</sup> See above, p. 387, note (8).

<sup>12</sup> Cf. *Edwards v. Elkan*, p. 411, note (5).



In any case, it is submitted, and notwithstanding that there is no application to rectify, the defendant may show that the plaintiff's right has determined by abandonment or otherwise by matters subsequent to the original registration.<sup>1</sup>

Determination of the plaintiff's title.

**Concurrent Right.**

(2) Where the Court has so decided, and in certain cases by agreement approved by the Registrar or the Board of Trade, two or more persons may be registered as proprietors of the same mark for the same goods,<sup>2</sup> and they will then have concurrent rights. In such cases no rights of exclusive user are (except so far as their respective rights shall have been defined by the Court)<sup>3</sup> acquired by any one of such persons as against any other by the registration. But where more than three persons are independently entitled to use a mark for the same goods it is treated as common to the trade, so that if any of them has obtained registration, the entry ought to be expunged.<sup>4</sup>

Concurrent or independent right.

The defendant, therefore, if he have an independent right, can apply for registration himself, and in a proper case the Court will order a motion for an interlocutory injunction in an action against him to stand over until his application is disposed of;<sup>5</sup> or, if he allege that the mark is common, he can, subject to sec. 41, apply to remove the plaintiff's mark from the Register.

In *Mouson v. Boehm*,<sup>6</sup> where the plaintiffs had independently adopted, and in 1880 had registered, a mark closely resembling a mark which the defendant had previously acquired by user for the same goods, and which he had never abandoned, the plaintiffs brought their action to restrain the defendant from using the latter mark. The defendant applied to register the mark as his, and moved to have the entry of the plaintiffs' mark expunged

*Mouson v. Boehm.*

<sup>1</sup> See Chap. XIV., p. 364.

<sup>2</sup> Secs. 19, 20, and 21. It must be a right to use the mark as a trade mark; not, for instance, as a family crest: *Standish v. Whitwell*, 14 W. R. 512; *Beard v. Turner*, 13 L. T. N. S. 746, both (1866), Wood, V.-C.

<sup>3</sup> And presumably except so far as such rights have been defined by agreement under sec. 20, although sec. 39 does not in the proviso so provide; see first part of the section.

<sup>4</sup> Chap. X., p. 224.

<sup>5</sup> *Edwards v. Elkun*, 5 R. P. C. 7

(1887), Stirling, J.

<sup>6</sup> 26 C. D. 398 (1884), Chitty, J. A similar case of an old mark is cited by Mr. Sebastian, *Re United Vineyards, &c. Co.* (1889), Stirling, J.; and *Re Bryant and May*, 4 Times L. R. 675 (1888), Stirling, J., is another. In *Daniel and Arter v. Whitehouse*, [1898] 1 Ch. 685; 15 R. P. C. 134, Gorell Barnes, J. (*Brazilian Silver*), cited below, p. 515, the defendant lost by non-user a concurrent right to an (un-registered) trade name.

from the Register. The application to register came before the Court on a summons to proceed, and was heard, together with the motion for an injunction, at the trial of the action. Chitty, J., allowed the defendant to be registered as a proprietor of the mark, but he refused to order the registration of the plaintiffs' mark to be expunged, and he dismissed the action.

*Jackson v. Napper.*

*Jackson v. Napper*<sup>1</sup> is a similar case. There the defendant, in 1876, applied through an agent to register a mark as his trade mark, and he supposed that it was registered accordingly, but, in fact, the application was not proceeded with and was, as the Court held, abandoned. In the next year the plaintiffs registered a similar mark, and more than five years after their registration<sup>2</sup> they brought the action to restrain the defendant from using his mark, and thereupon the defendant took out a summons for a direction to the Comptroller to proceed with the registration of his mark. Stirling, J., found that the defendant had acquired and used his mark as a trade mark before August 13th, 1875, in respect of the goods in question, except one particular class (sheep-shears); and he held that, notwithstanding that the five years' registration of the plaintiffs was conclusive evidence of their right to the "exclusive use" of their mark, he had jurisdiction to allow the defendant to be registered in respect of his own mark, upon the analogy of the rule that an entry on the Register might be rectified, under sec. 90 of the Act of 1883,<sup>3</sup> after five years' registration. He accordingly directed the defendant to be registered as proprietor of his mark for the goods in question, other than the sheep-shears, and dismissed the action, except so far as regarded the last-mentioned goods, in respect of which he granted the injunction the plaintiffs sought.

Defendant should apply for registration.

In the two cases above cited, the defendants' marks were old trade marks, and in a case prior to the Act of 1905<sup>4</sup> the Court refused to extend the principle of those cases so as to allow the registration of a new mark similar to one already registered.<sup>5</sup> But, as already stated, the Act of 1905 permits concurrent regis-

<sup>1</sup> 35 C. D. 162; 4 R. P. C. 45 (1886), Stirling, J.

<sup>2</sup> Sec. 76 of the Act of 1883 after this period made the Register conclusive evidence in the absence on an application to rectify. Sec. 3 of Act of 1875.

<sup>3</sup> Chap. XII., p. 325.

<sup>4</sup> *Hall and Woodhouse's Application*, 19 R. P. C. 58 (1902), Buckley, J.; and

see *Ehrmann's Tms.*, [1897] 2 Ch. 495; 14 R. P. C. 665, Stirling, J.

<sup>5</sup> In a recent case it was held that applicants for a trade mark had established equal rights by concurrent user with the opponents of the word "Kinnahan's" in connection with whisky, and that their mark would not be deceptive by reason of that word appearing on the

tration of identical or nearly identical trade marks in cases of honest concurrent user or under other special circumstances. Where the defendant wishes to set up an independent right, he should, unless he has a defence under sec. 41, apply to register his own mark, and apply for a stay of proceedings pending a decision of his rights under such application.<sup>1</sup> Prior and continuous user by the defendant is, however, under sec. 41, a good defence to an action for infringement. The proviso to that section is as follows: "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<sup>2</sup> 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 on the Register for such similar trade mark under the provisions of sec. 21 of this Act." The first part of the proviso applies whether the earlier user obtains registration under sec. 21<sup>3</sup> or not, but it is conditional upon his having used the mark continuously. The phrase "continuously used" must, it is submitted, receive a reasonable business interpretation. There are no such saving words in this section with regard to non-user due to special circumstances and not due to an intention to abandon the mark as appear in sec. 37.<sup>4</sup> Nevertheless, it cannot be intended that a mere temporary cessation of user should cause the forfeiture of the right to a valuable mark. "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."<sup>5</sup>

Defence under sec. 41.

It was assumed in the judgments delivered in the cited cases of

Registration gives the

mark as used: *Lyle and Kinahan, Ltd.'s Application*, 24 R. P. C. 37 and 249 (1907), Kekewich, J., and C. A.

<sup>1</sup> In *Boord & Son v. Thom and Cameron*, 24 R. P. C. 697 (1907), Inner House, Scotland, it was held in an action commenced in 1905 that the defendants could not set up a concurrent right without a claim that they were entitled to have their mark put on the Register. It is submitted, however, that an appli-

cation to the Patent Office in the ordinary way is necessary, and that the Court could not deal with an application for registration.

<sup>2</sup> Above, pp. 392 and 395.

<sup>3</sup> Above, p. 261.

<sup>4</sup> Above, p. 371.

<sup>5</sup> Per Chitty, J., in *Mouson v. Boehm*, 26 C. D. 398; cf. *Daniel and Arter v. Whitehouse*, [1898] 1 Ch. 685; 15 R. P. C. 134.

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

*Mouson v. Boehm* and *Jackson v. Napper*, and is besides clearly implied by the Act, that registration when properly made gives the defendant an equal title to use the mark with the plaintiff, but only, of course, according to the terms of the entry.<sup>1</sup> It is just as much an infringement for the defendant to use a registered mark for goods,<sup>2</sup> or in a market, in respect of which it is not registered, and the plaintiff's mark is registered, as if the defendant's mark were not registered at all. If the plaintiff alleges that the use of the registered mark of the defendant for the goods in respect of which it is registered is an infringement of his mark, his proper course is to apply in the first place to remove the defendant's mark from the Register before commencing, or concurrently with,<sup>3</sup> the action for infringement. But the registration of the defendant's trade mark may possibly be held to be no answer to an action of infringement based on the use of that mark, at all events in a case in which the defendant has not acquired by the lapse of the period of seven years mentioned in sec. 41 rights under that section. Thus, where under the Act of 1875 the defendant's mark had been registered for less than the period of five years mentioned in sec. 3 of that Act, an interlocutory injunction was granted by the Court of Appeal in terms which in effect restrained the use of the defendant's mark.<sup>4</sup> And in a later case under similar circumstances a final injunction was granted by the Court of Appeal in an action founded on trade name and passing-off which in effect restrained the use of a registered trade mark.<sup>5</sup> And where an action for passing-off was commenced and very shortly afterwards the plaintiffs gave notice of motion to rectify the Register by the removal of the defendant's mark, and the action and motion were heard together, the defendants'

<sup>1</sup> Sec. 39.

<sup>2</sup> *Upper Assam Tea Co. v. Herbert*, 7 R. P. C. 183 (1889), C. A.

<sup>3</sup> As in *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 C. D. 454; 3 R. P. C. 23 (1886), Kay, J., where the Register was rectified by limiting the goods for which the defendant's mark was registered, and an injunction was granted in respect of other goods. And see *Eastman Photographic Materials Co., Ltd. v. John Griffiths Cycle Corporation, Ltd.*, 15 R. P. C. 105 (1898), Romer, J., and *Macmillan v. Ehrmann*, 21 R. P. C. 357 (1904), Buckley, J.

<sup>4</sup> *Read v. Richardson*, 45 L. T. 54 (1881). See also *Goodwin v. Vennings*, 24 Sol. J. 690 (1880), Jessel, M.R. See now the proviso to sec. 39, above, p. 326, and referred to below, p. 416.

<sup>5</sup> *Valentine Meat Juice Co. v. Valentine Extract Co., Ltd.*, 17 R. P. C. 673 (1900). No point seems to have been taken by the defendants as to their having registered "Valtine" as a trade mark. The plaintiffs subsequently obtained the removal of the mark from the Register: *Valentine Extract Co.'s Tm.*, 18 R. P. C. 175.

mark was ordered to be expunged from the Register, and the defendants' were restrained from using it.<sup>1</sup> In both the cases last cited the defendants were endeavouring to get the benefit of the plaintiffs' trade reputation by the use of the mark.

The question whether, in a passing-off action, it would be a defence that the defendant's mark was a registered trade mark arose in a recent case in which the registration of the trade mark was opposed on the ground that it would be deceptive if used with a certain blank in it filled up in the manner proposed; a concurrent user within a certain area was established, and Buckley, L.J., in giving his judgment, said, in reference to an argument that the registration of the applicant's mark would give them a right to use it everywhere in the United Kingdom: "The registration of a trade mark does not confer any right at all of the description there pointed to, but it does confer a right, and the only right is the right to prevent anybody else from using that trade mark as a mark for their goods, but it does not give the registered owner of the trade mark any right to use that trade mark if the trade mark would deceive. I conceive that if at the date when application is made to register a trade mark there is no ground of objection upon the footing that it will be calculated to deceive, and if subsequently by alterations in the character of the business of the two parties respectively the use of the trade mark will be calculated to deceive and a passing-off action were brought by one party against the other, it would be no defence at all on the part of the owner of the registered trade mark to say—'Deception or no deception I am entitled to do it because that is my registered trade mark.' That could not be advanced for a moment. In other words, the registration of a trade mark does not confer any right to do that which could not have been done irrespective of the trade mark, in the sense of doing any acts which would be competition in business. The only right which it confers is a right to restrain others from using that trade mark."<sup>2</sup> The passage quoted seems not to deal directly with the question whether the proprietor of a registered trade mark can maintain an infringement action in respect of the mere use by the defendant of a registered trade mark, or whether he must first obtain the removal of the defendant's trade mark from the

<sup>1</sup> *Eastman Photographic Materials Co., Ltd. v. John Griffiths Cycle Corporation, Ltd.*, 15 R. P. C. 105 (1898), Romer, J.

*tion*, 24 R. P. C. 249 (1907), C. A., at p. 262. See also *Van Zeller v. Mason, Cattley & Co.*, 25 R. P. C. 37 (1908), Joyce, J.

<sup>2</sup> *Lyle and Kinahan, Ltd.'s Applica-*

Register. The principle, however, seems to be the same whether the action is founded on infringement of trade mark or passing-off, and whether by means of an unregistered or registered mark, so that, unless there is anything in the Act preventing an action to restrain the use of a registered trade mark, there seems to be no reason why in a proper case such relief should be refused. It may be that, notwithstanding the proviso to sec. 39, such an action can in the case supposed, and apart from rights acquired by the defendant under sec. 41, be maintained, for sec. 39 confers on the defendant the exclusive right to the use of his trade mark only if the registration of it was valid, and on the supposed facts, namely, that the defendant's mark is identical with or closely resembles the plaintiff's mark, the registration of the defendant's mark could (apart from an independent right such as was established in *Lyle and Kinahan's* case) have been successfully opposed by the plaintiff. And furthermore, even if the period of seven years mentioned in sec. 41 had elapsed, the defendant's trade mark ought, on the supposed facts, not to have been registered, by reason of its offending against the provisions of sec. 11 of the Act.<sup>1</sup> It would appear, therefore, that in any such case, if the original registration could have been opposed by the plaintiff on the ground of the deceptiveness of the defendant's trade mark, and the defendant's mark is still deceptive, a defence founded on sec. 41 is not available to the defendant. But, as already stated, it is advisable for the plaintiff in such a case to apply to remove the defendant's mark from the Register.

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

If the plaintiff and defendant are severally entitled to, and are the proprietors of, two marks which are in ordinary markets distinct and unlikely to be confused, is it an infringement for the defendant to introduce his mark into a market where the plaintiff's is already known, if from the character of the customers there—their ignorance of English, for instance—its use is calculated to cause the defendant's goods to be taken for the goods of the plaintiff? It is submitted that it is an infringement, for the case put falls within the principle that one trader must not do what is calculated to cause his goods to be taken for those of another, and the defendant's action is in this sense the cause of deception. The question was raised, but not determined, in *Johnston v. Orr-Ewing*, in the House of Lords, and the words of the order of Fry, J., having special reference to

<sup>1</sup> Above, p. 333.

the Bombay trade were, with the assent of the respondents, directed to be omitted. Lord Selborne said, in his judgment in the case: "Your Lordships are not called upon to decide whether a ticket, which was a rightful and *bonâ fide* trade mark of the trader using it, could be excluded by injunction from particular markets (though unimpeachable everywhere else) merely because in those markets it might be liable to be called by a name which the mark of another trader had already acquired there. . . . To that proposition I should not myself, as at present advised, be prepared to assent."<sup>1</sup> The passage quoted above from the judgment of Buckley, L.J.,<sup>2</sup> supports the proposition that if the use of the mark in a new district would cause deception the plaintiff could succeed at all events in a passing-off action. On the other hand Lord Alverstone, in the same case, after stating that the Court had not in that case the powers conferred by the Act of 1905, and after referring to the argument that the applicant's concurrent user had only been in a certain district, said: "We have not the materials before us for saying so, but I feel very great difficulty, when once you get a *bonâ fide* concurrent user, in saying that a man is to be limited in a subsequent user if he is entitled to have the registered trade mark for the user that he then possessed. I do not want in any way to fetter the judgment of this Court, or my own judgment, in case it may turn out that some large and extended user would be unfair having regard to the circumstances of the case, but once you get that an honest trader is entitled to come and ask for a registration of his trade mark, I do not think it is an objection to the registration that he is going to use the trade mark in a much more widely competitive area than that in which he has been selling his goods in up to the time his application is made." Within the United Kingdom, if the defendant's mark is registered without limit of area, he has a *prima facie* right so to use it, and in order to challenge that right the plaintiff should take proceedings to rectify the register.<sup>3</sup>

The introduction of the defendant's marks into a new trade in goods for which it is not, and the plaintiff's mark is registered, is undoubtedly an infringement.<sup>4</sup>

Introduction  
into a new  
trade.

<sup>1</sup> 7 App. Ca. p. 227 (1882). See also *Wilkinson v. Griffith*, 8 R. P. C. 370 (1891). Romer, J. An injunction, on the ground of "passing-off," limited to Ireland was granted in *Barber v. Manico*,

T.M.

10 R. P. C. 93 (1893), A. L. Smith, L.J.

<sup>2</sup> Above, p. 415.

<sup>3</sup> See above, pp. 414 to 416.

<sup>4</sup> Above, p. 414, note (2). In *Hodgson v. Kynoch*, 15 R. P. C. 465 (1898).

Where the case made is one of colourable infringement by using part of the registered mark, or a word taken from the registered mark, the defendant may show that he has a concurrent right to the use of the part or word, as, for instance, by prior user of it.<sup>1</sup>

Registration  
at Stationers'  
Hall.

Registration for copyright purposes of a mark at Stationers' Hall confers no trade mark rights, and constitutes no defence if the mark is an infringement of another person's trade mark.<sup>2</sup>

Trade mark  
rights on a  
dissolution of  
a partnership.

Where a partnership is dissolved without a sale of the goodwill, or any arrangement having been made for its disposal, or governing the use of the trade marks of the firm, each of the late partners who carries on the business may use the trade marks,<sup>3</sup> for he is, as to a portion of the goodwill, a successor of the firm;<sup>4</sup> but if the goodwill is sold as part of the assets of the firm, the exclusive right to use the trade marks may be sold with it, and in that case the late partners cannot lawfully use the trade marks, even though they set up a similar business in competition with the purchaser.<sup>5</sup>

But a late partner cannot grant to others who are in no way successors to the firm's business, or any part of it, a right or licence to use the trade marks, even though he be registered as proprietor of the marks. The case of *Hanson v. Game, Harrison and Larner, Limited*,<sup>6</sup> was decided on the construction of a consent order under which the partnership in question had been

Romer, J., the defendants were makers of ammunition. Their works were known as Lion Works, and they had lion trade marks. Held, that they were not justified in using lion marks for soap.

<sup>1</sup> *Edge v. Gallon*, 16 R. P. C. 509, and 17 R. P. C. 557 (1900). C. A. and H. of L. (*Dolly Blue*); *Meaby v. Triticiac*, 15 R. P. C. 1 (1897), North, J., both "passing-off" cases. In an infringement action, the defendant would probably argue alternatively that he had not infringed or that the plaintiff's mark was wrongly registered. See also *Lyle and Kinahan, Ltd.'s Application*, 24 R. P. C. 37 and 249 (1907), Kekewich, J., and C. A.

<sup>2</sup> *Reinhardt v. Spalding*, 49 L. J. Ch. 57 (1879), Hall, V.-C. (*Family Salve*); *Paine v. Daniells & Sons' Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 217

<sup>3</sup> *Banks v. Gibson*, 34 Beav. 566 (1865), Romilly, M.R.; *Condy v.*

*Mitchell*, 37 L. T. N. S. 268 and 766 (1877), Bacon, V.-C., and C. A.; *Bea-how v. Low*, 44 L. T. N. S. 875 (1881), Bacon, V.-C. See Chap. XIII., p. 352. As to cases where the severance of business relations determines a joint trade mark, see *Robinson v. Finlay*, 9 C. D. 487; and *Jones' Tm.*, 53 L. T. N. S. 1. As to trade name on dissolution of partnership, see next chapter, p. 528.

<sup>4</sup> The Act of 1905 permits the apportionment of trade marks by arrangement and with the approval of the Registrar on a dissolution of partnership or other division of goodwill, sec. 23, above, p. 352. As to the law under the Act of 1883, see *Elrmann's Tms.*, [1897] 2 Ch. 495; 14 R. P. C. 665, Stirling, J.

<sup>5</sup> See *Re David and Matthews*, [1899] 1 Ch. 378, Romer, J., cited below, p. 529, where all the authorities are reviewed.

<sup>6</sup> 9 R. P. C. 186 (1892), Stirling, J.



dissolved, and which provided that the late partners "and any partners they may take respectively" were to have the common use of the trade marks; but it is submitted that the decision might have been put on the general ground that the defendants—a limited company, of which one late partner was a shareholder and director—could not use the marks without infringing the rights of the plaintiffs, the other late partner and his partners, because they were not possessed of the goodwill of any part of the old business.

So if the trustee in bankruptcy of a trader sells the goodwill and trade marks of the latter's business, the trader has no right to continue to use the marks.<sup>1</sup>

Sale of trade marks in bankruptcy.

A trader who is honestly using his own name in his business will not be guilty of infringement because its similarity to a name appearing in another's trade mark is calculated to lead to deception. Section 44 provides that no registration under the Act of 1905 shall interfere with any *bonâ fide* use by a person of (*inter alia*) his own name.<sup>2</sup> But to support this defence the business must be the defendant's own, for a fraudulent attempt to cover an infringement by employing or taking into partnership a man who happens to bear the name which is to be used to effect the fraud, still less by buying from him the right to use his name, will not avail to protect the offender.<sup>3</sup>

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

(3) The necessity for registration of the plaintiff's marks, having regard to sec. 42, has already been discussed.<sup>4</sup>

(4) And so has the question, What constitutes an infringement? including the special provisions of secs. 43 and 44 of the Act.<sup>5</sup>

### Estoppel.

(5) (a) With the exception of the several defences which are considered below, there is nothing peculiar to the law of trade marks to determine what agreements, or what circumstances constituting a personal estoppel, will prevent a plaintiff from suing a particular defendant for infringement. It is to be remembered, however, that an infringement is primarily a fraud on the public, in respect of which the plaintiff is allowed to sue, because its

<sup>1</sup> *Hammond v. Brunner*, 9 R. P. C. 301 (1892), Chitty, J.; *Hudson v. Osborne*, 39 L. J. Ch. 79 (1869), James, V.C.; *Mcrose Drover, Ltd. v. Heddle*, 4 Fraser, 1120 (1902), Scotland.

<sup>2</sup> See the corresponding provision of

the Act of 1888, s. 10.

<sup>3</sup> See the next chapter, p. 543, where this matter is fully discussed in relation to trade names.

<sup>4</sup> Above, p. 386; Chap. XII., at p. 334.

<sup>5</sup> Above, pp. 389 *et seq.*

Agreement to condone infringements.

natural effect is to cause damage to him.<sup>1</sup> An agreement, therefore, not to prosecute future infringements would be an agreement to permit a fraud, and although, if established, it would undoubtedly prevent the Court from interfering in favour of any party to it,<sup>1</sup> it could not be specifically enforced, and, unless the intention were clearly indicated, the Court would presume that a lawful arrangement, for instance, a waiver of the remedy in respect of past infringements only, was intended.<sup>2</sup>

Uncandid conduct.

As an instance of estoppel by conduct, the case of *Maxwell v. Hogg*<sup>3</sup> may be taken. There the defendants had received, and published for reward from the plaintiffs, advertisements of an intended new magazine, bearing the title of a magazine which they were themselves preparing to publish, without warning the plaintiffs of their own intention; and this uncandid conduct was held to be sufficient ground for dismissing the cross suit of the defendants for an injunction to prevent the plaintiffs using the name.

Failure to give warning.

And anything in the nature of a representation by the plaintiff to the defendant that his mark was not an infringement, or that it might be lawfully used,<sup>4</sup> or of an encouragement to him to continue using it, would be an answer to a subsequent claim for damages for infringement, although a mere failure by the plaintiff as soon as he had knowledge of the infringement to warn the defendant, would be no bar.<sup>5</sup>

The plaintiff is not barred because he uses his registered mark with additions.

It is sometimes urged, on behalf of the defendant, as an objection to the plaintiff's case, that the plaintiff in actual practice uses his mark in a form different from that for which he has obtained registration; but the variation of his registered mark by the plaintiff, provided it is not an infringement of any other

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

<sup>2</sup> *Oldham v. James*, 13 Ir. Ch. 393; 14 Ir. Ch. 81 (1862), Brady, C., and Blackburn, L.J.

<sup>3</sup> L. R. 2 Ch. 307 (1867), *Turner and Cairns*, L.J.J., cited p. 34.

<sup>4</sup> A defence of this nature was successful on appeal in *Burgoyne v. Godefroy*, 21 R. P. C. 550; 22 R. P. C. 168 (1905), Warrington, J. and C. A., where wine rejected by the plaintiffs and sold on

their orders was contained in casks bearing the words "Burgoyne, London," and the defendants bought it, and afterwards sold it as Burgoyne's wine under a *bona fide* mistake on their part which, it was held, the conduct of the plaintiffs had induced.

<sup>5</sup> See *Proctor v. Bennis*, 36 C. D. 740 (1887), C. A., a patent case; and the notes to *Savage v. Foster*, 2 White & Tudor's Leading Cases, 6th ed., 680. The rule is "*qui potest et debet retare jubet*"; *Osborn v. Lees*, 9 Mod. 96; *Willmott v. Barber*, 15 C. D. 96; 17 C. D. 772. As to delay, see p. 423.

person's mark, or a breach of any agreement binding upon him, is perfectly lawful, although so far as the mark actually used differs substantially from his registered mark, it is an unregistered mark, as has been already pointed out. If the registered mark is in substance not used at all, that would be an independent objection to the plaintiff's action.<sup>1</sup> It is well settled that the use of a varied mark by the plaintiff does not in any way estop him from proceeding against infringers. Thus, in *The Melachrino* case,<sup>2</sup> the plaintiffs had tried to register a label comprising three coats of arms, but the coats of arms had been rejected and the label registered without them. The plaintiffs, nevertheless, always used the labels with the arms in it, and the defendants, who had imitated the label, were enjoined from continuing the infringement. In a subsequent case,<sup>3</sup> Chitty, J., said: "I adhere to what I said in *Melachrino's* case, that the mere addition of something, as, in that case, a coat of arms, to the trade marks, is not sufficient to disentitle a person who otherwise uses the whole of his trade marks to sue for an injunction."

Similarly, it is no ground of estoppel that the plaintiff extends the use of his mark to goods in respect of which it is not registered.<sup>4</sup>

(b) Acquiescence in the infringement on the part of the plaintiff is a complete defence,<sup>5</sup> but it can only be inferred where he is shown to have had knowledge of it.<sup>6</sup> And, assuming that it is shown that the plaintiff knows of the infringement, the Court will not readily infer that he has assented to what is likely to be so detrimental to his property. It has been held that, where it is pleaded in answer to a motion to commit the defendant for the breach of an injunction restraining him from infringing, it must amount to a licence "sufficient to create a new right in him."<sup>7</sup>

Acquiescence.

<sup>1</sup> Above, p. 385.

<sup>2</sup> *Melachrino & Co. v. The Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215 (1887), Chitty, J.; *Newman v. Pinto*, 4 R. P. C. 508; 57 L. T. 31 (1887), Kekewich, J., and C. A. In *Rowland v. Mitchell*, 13 R. P. C. 457; 14 R. P. C. 37 (1896), Romer, J., and C. A., the plaintiff omitted some of the added words and used other words. This was held to be immaterial.

<sup>3</sup> *Hammond v. Brunker*, 9 R. P. C. p. 307 (1892).

<sup>4</sup> *Jay v. Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

<sup>5</sup> Per Chitty, J., in *Mouson & Co. v. Boehm*, 26 C. D. p. 406 (1884).

<sup>6</sup> *Weldon v. Dicks*, 10 C. D. 247 (1878), Malins, V.-C.; *Re Farina*, 27 W. R. 456 (1879), Hall, V.-C., and the last case. See, generally, *De Busche v. Alt*, 8 C. D. 286, C. A.; and *Willmot v. Barber*, 15 C. D. 96; 17 C. D. 772, Fry, J., and C. A.

<sup>7</sup> *Rodgers v. Nowill*, 3 De G. M. & G. 614; 22 L. J. Ch. 404 (1853), per

In *Rowland v. Mitchell*<sup>1</sup> Romer, J., said: "I quite agree that merely threatening a person in cases of this kind, without taking proceedings, is not sufficient. If the plaintiff really does stand by and allow a man to carry on business in the manner complained of, to acquire a reputation, and to expend money, he cannot then, after a long lapse of time, turn round and say that the business ought to be stopped." On the other hand, Lord Russell, L.C.J.,<sup>2</sup> said in the same case: "It cannot be stated as a general proposition in respect of a person, irrespective of the character of the trade done, and the extent of that trade in respect of the position and impecuniosity of that person, that the moment it comes to the knowledge of a manufacturer that somebody has been trying to do a fraudulent thing on his part he is bound to take proceedings, or if he does not take proceedings, it is concluded against him that he means to acquiesce in the right of that other person to continue to do what he has been doing."<sup>3</sup> The facts of each case must be examined to see whether there has been an acquiescence or not.

Licence.

A licence by the plaintiff to the defendant to use the mark would be proof of acquiescence in user falling within the terms of the licence, and would be a defence.<sup>4</sup> Under sec. 87 of the Act of 1883, any registered proprietor could grant licences to use the mark, subject to any equities affecting it, unless, for instance, he had agreed with the plaintiff not to do so.<sup>5</sup> But the Act of 1905 contains no power for the registered proprietor to grant licences,<sup>6</sup> and a licence to a person who has no interest in the goodwill of the business would seem to be invalid as leading to

Turner, L.J. As to what constitutes acquiescence, see *Proctor v. Bennis*, ante, p. 420, note (5); "delay," p. 423; and *Hogg v. Scott*, L. R. 18 Eq. 444, Hall, V.-C.; *Weldon v. Dicks*, 10 C. D. 247, Malins, V.-C. (copyright); and *Smith v. Smith*, L. R. 20 Eq. 500, Jessel, M.R. (ancient lights). See also, generally, the article *Acquiescence* in the *Encyclopædia of English Laws*.

<sup>1</sup> 13 R. P. C. p. 464. It was held there had been no acquiescence or abandonment in this case, see below, p. 425, note (2). See also on the defence of "standing by," per Byrne, J., in *Jamieson v. Jamieson*, 15 R. P. C. 169, at p. 179.

<sup>2</sup> 14 R. P. C. at p. 44. See also Kekewich, J., in *Ripley v. Bunley*, 14 R. P. C. at p. 596.

<sup>3</sup> Followed in *Reddaway v. Stevenson and Brother, Ltd.*, 20 R. P. C. 276 (1903), Hall, V.-C., where the plaintiffs knew of the acts complained of three and a half years before action, but took no proceedings after inquiring into the defendants' position.

<sup>4</sup> *Kinahan v. Bolton*, 15 Ir. Ch. 75 (1863), Brady, C.

<sup>5</sup> *Hanson v. Game, Harrison and Larner, Ltd.*, 9 R. P. C. 186 (1892), Stirling, J.

<sup>6</sup> Cf. sec. 38 with sec. 87 of the Act of 1883.

deception,<sup>1</sup> but it would if given by the plaintiff estop him from complaining of the improper use.

(c) Mere delay, after knowledge of the infringement, to take proceedings, not sufficient to call the Statute of Limitations into operation, or where the infringement continues, is no bar to the action. Before the Judicature Acts it might have furnished an answer to an application for an injunction,<sup>2</sup> at least until the plaintiff had established his rights by recovering damages in an action at law, unless the deception resulting from the use of the defendant's mark were still continuing.<sup>3</sup> But both branches of the Court now enforce legal and equitable rights together, and consequently, wherever an injunction could have been obtained after an action for damages, it can now be obtained at once or concurrently with the judgment for damages. The rule is not peculiar to trade mark cases, but is part of the general law.<sup>4</sup> It was stated by Fry, J., in the following terms, in *Fullwood v. Fullwood* (2):<sup>5</sup> "In my opinion that delay" (from early in 1875, when the plaintiff first knew of the infringement, till November, 1876, when he commenced his action) "—and it is simply delay—is not sufficient to deprive the plaintiff of his rights. The right asserted by the plaintiff in this action is a legal right. He is, in effect, asserting that the defendants are liable to an action for deceit. It is clear that such an action is subject to the Statute of Limitations,<sup>6</sup> and it is also clear that the injunction is sought merely in aid of the plaintiff's legal right. In such a case the injunction is, in my opinion, a matter of course, if the legal right be proved to exist. In saying that I do not shut my eyes to the possible existence in other cases of a purely equitable defence, such as acquiescence or acknowledgment,<sup>7</sup> and the various other equitable defences which may be imagined. But lapse of time, unaccompanied by anything else (and to that I confine my observations), has, in my judgment, just as much effect, and no more, in barring a suit for an injunction as it has in barring an action for deceit. In my judgment, the same rule

Delay does not bar the right of action

<sup>1</sup> See above, p. 354.

<sup>2</sup> *Horenden v. Lloyd*, 18 W. R. 1132 (1870), Bacon, V.-C., fifteen months' delay; *Estcourt v. The Estcourt Hop Essence Co.*, 10 Ch. 276 (1875), Cairns, L.C., and L.JJ., seven months' delay.

<sup>3</sup> *Rodgers v. Rodgers*, 31 L. T. N. S. 285 (1874), L.JJ.

<sup>4</sup> See *The Three Towns Banking Co. v. Maddener*, 27 C. D. 533 (1884), C. A.

<sup>5</sup> 9 C. D. p. 178 (1878); and see *L. C. & D. Rail. Co. v. Bull*, 47 L. T. 413.

<sup>6</sup> But where the tort is continuing, the right of action is also continuing.

<sup>7</sup> *Quere* abandonment.

applies since the Judicature Act as formerly applied in the Court of Chancery when the legal right had to be determined in an action at law."<sup>1</sup>

but delay  
may modify  
the relief  
granted ;

But delay may affect the nature of the relief granted. It may cause the Court to refuse the ordinary interlocutory injunction, either on terms of the defendant keeping an account, or absolutely,<sup>2</sup> or to refuse to give damages, or to direct an account of profits in lieu of damages, or to restrict such account to profits made since the beginning of the action.<sup>3</sup>

And in a case where the plaintiffs took no action on hearing that the defendant had received a small consignment of spurious goods, preferring to wait until he received a larger consignment, Malins, V.-C., ordered the injunction to be directed to future receipts by the defendant only.<sup>4</sup> Unless, however, this case can be supported on the ground of acquiescence, it is submitted that it is inconsistent with the rule established by the cases cited above.

In *Liebig's Extract of Meat Co. v. Chemists' Co-operative Society*,<sup>5</sup> the defendants had used the wrapper complained of in 1893. The plaintiffs discovered in 1894 that the defendants were using it, but they did not know to what extent. They commenced their action in May, 1896, and obtained full relief, *i.e.*, an injunction, an inquiry as to damages, and costs.<sup>6</sup>

In an Irish case, where there had been over a year's delay in bringing the action, the injunction was stayed for six weeks to allow the defendant time to make the arrangements necessary for the alterations of his trade name required by it.<sup>7</sup>

and may  
amount to  
abandonment.

But delay to pursue infringers, where the infringements are numerous and notorious, may amount to abandonment<sup>8</sup> of the trade mark, and lead to its becoming *publici juris*.<sup>9</sup>

<sup>1</sup> Cf. the judgment of Mellish, L.J., upon the defence of misrepresentation in *Ford v. Foster*, L. R. 7 Ch. p. 632.

<sup>2</sup> See below, "Interlocutory injunction," p. 445.

<sup>3</sup> See below, "Profits," p. 455. The American law is the same on both points. It is well stated in *McLean v. Fleming*, 96 U. S. Rep. 245, followed in *Menendez v. Holt*, 128 U. S. Rep. 514 (both Supreme Court), Cox, pp. 326, 467.

<sup>4</sup> *The Anglo-Swiss Condensed Milk Co. v. The Swiss Condensed Milk Co.* (1871), W. N. 163.

<sup>5</sup> 13 R. P. C. 635, 736 (1896), Kekewich, J., and C. A. A trade name and passing-off case.

<sup>6</sup> In *Reidaway v. Stevenson and Brother, Ltd.*, 20 R. P. C. 276 (1903), Hall, V.-C., damages were refused after a delay of three and a half years.

<sup>7</sup> *Grant v. Levitt*, 18 R. P. C. 361 (1901), Porter, M.R. (*Globe Furnishing Co.*).

<sup>8</sup> Page 370.

<sup>9</sup> As in *Hyde & Co.'s Tm.*, 7 C. D. 724 (1878), Jessel, M.R. (*Bank of England Sealing Wax*); Chap. XIV., p. 363.

The delay may be of little importance if it appears that the plaintiff had been led to believe that the infringement had ceased,<sup>1</sup> or if the infringement is of slight amount. Its bearing on the case must always depend upon the circumstances under which it occurs. Thus in *Rowland v. Mitchell*<sup>2</sup> the plaintiff knew of an infringement by a third party in 1892. The third party when threatened with proceedings refused to stop, but was not worth suing. The plaintiff lost sight of him, and thought that the infringement had stopped. The action was begun in October, 1895, and the plaintiff obtained an injunction, with an inquiry as to damages and costs.

Delay may be explained.

And, as already pointed out, delay may have an important bearing on the weight of the evidence in the case, for if, in spite of long user by the defendant of the alleged infringing mark, no case of actual deception is proved, and the absence of evidence of such deception is not otherwise accounted for, it may be difficult for the Court to believe that the defendant's mark is calculated to deceive. Thus where the owners of a trade mark consisting of the word "glacier" registered for transparencies sued for infringement by the use of the word "glazine," and they had known of the defendant's user for at least four years, and no case of deception was proved, the action was dismissed.<sup>3</sup> It has been suggested that, where the infringement has lasted a number of years, it is necessary for the plaintiff to prove that some persons have actually been deceived,<sup>4</sup> but this is not, it is submitted, a rule of law.<sup>5</sup>

It has a bearing on the weight of evidence.

In passing-off cases, where the transaction complained of is purely oral, it is matter of comment if the defendant's attention is not called to it as early as possible.<sup>6</sup>

See also *National Starch Manufacturing Co. v. Munns & Co.*, [1894] A. C. 275; 11 R. P. C. 281 (*Maizena*), there cited. In *Ripley v. Bandy*, 14 R. P. C. 591 (1897), Kekewich, J. (*Oral Blue*), the action was dismissed, because the plaintiff had known of the use by others of the get-up of which he complained beginning sixteen years before the action. This use was at first small, but ultimately became important. An appeal was compromised, 14 R. P. C. 944.

<sup>1</sup> *Daniel and Arter v. Whitehouse*, [1898] 1 Ch. 685; 15 R. P. C. 134, Gorell Barnes, J.

<sup>2</sup> 13 R. P. C. 457; 14 R. P. C. 37,

Romer, J., and C. A., not reported on this point in L. R. The third party was a costermonger. See the passages quoted above, p. 422. Cf. *Ripley v. Bandy*, p. 422, note (2).

<sup>3</sup> *McCaw, Stevenson & Orr, Ltd. v. Lee*, 23 R. P. C. 1 (1906), Swinfen Eady, J.

<sup>4</sup> *Rodgers v. Rodgers*, 31 L. T. N. S. 285 (1874), per Mellish, L.J.; *Isaacson v. Thompson*, 41 L. J. Ch. 101 (1871), Bacon, V.-C.

<sup>5</sup> See "Proof of Actual Deception," p. 259.

<sup>6</sup> *Carr & Sons v. Crisp & Co., Ltd.*, 19 R. P. C. 497 (1902), Byrne, J.

Moreover, lapse of time may prevent conduct which would at first be an infringement from being calculated to deceive. Thus, in *The Marquis of Londonderry v. Russel*,<sup>1</sup> an action against the defendant, for sending coals to the London market as "Londonderry Wallsend Coal," was dismissed because the defendant had used the name for twenty-five years, and the plaintiff had long known of his use of it. Whatever might have been the result had the plaintiff applied in 1861 to restrain the defendant from selling his coals under the name, it was clear, as the Court of Appeal held, that at the time of their judgment the defendant's conduct could not be taken to amount to any representation that his coals came from the plaintiff's Londonderry collieries.

Deceptive  
trade mark  
and fraudu-  
lent trade.

(d) The Court will not interfere to protect the use of a deceptive trade mark, or to assist a trader who is using his mark for the purposes of a fraudulent trade. This principle was well established in the Court of Chancery, and, although no case seems to be reported upon the point, it would no doubt have been recognised also in the Courts of Common Law before the Judicature Acts, had any case occurred, for the maxim *ex turpi causa non oritur actio* is a rule of law.<sup>2</sup>

"The plaintiff," Lord Westbury said, in *The Leather Cloth case*,<sup>3</sup> "desires to restrain the defendant from selling his own goods as the goods of another person; but if, by the use of the trade mark in question, the plaintiff himself is representing and selling his goods as the goods of another, or if his trade mark gives a

<sup>1</sup> 2 Times L. R. 843; 3 Times L. R. 360 (1886), Bacon, V.-C., and C. A.

<sup>2</sup> See the judgment of Mellish, L.J., in *Ford v. Foster*, L. R. 7 Ch. p. 631 (1872), cited below. In a "get up" case, *Jamieson v. Jamieson*, 15 R. P. C. 169, V. Williams, L.J., said, *obiter*, that misrepresentation to the public would be no answer to an action for damages. The misrepresentation alleged was not comprised in the matter sought to be protected, and the Court, in fact, thought there was no misrepresentation. In *Wolff v. Nopitsch*, 18 R. P. C. 27 (1901), Ld. Alverstone, L.C.J., said that he wished to reserve his opinion on the question whether there was any distinction between cases of trade mark and of fraudulent passing off. In *Bile Bean Manufacturing Co. v. Davidson*,

23 R. P. C. 725 (1906), Inner House, Scotland, Ld. Stormonth Darling said that he could not imagine a principle of so general a nature and intended to protect the public against fraud as turning on any mere question of proceeding as between courts of law and courts of equity; and the principle was then applied to a trade name case, see below, p. 440; and the principle was held by Farwell, J., to be applicable in a trade name case, *Cropper Minerva Machines Co., Ltd. v. Cropper Charlton & Co., Ltd.*, 23 R. P. C. 388 (1906), in which he considered that the description "the old and original firm" was not justified by the circumstances.

<sup>3</sup> 4 De G. J. & S. 137; 33 L. J. Ch. 199 (1863).



false description of the article, he is violating the rule upon which he seeks relief against the defendant."

The deceptive mark, in Sir Roundell Palmer's phrase, adopted by James, V.-C., in *The Leather Cloth Co. v. Lonsont*,<sup>1</sup> is "outlawed."

Deceptive trade marks are outlawed.

The earliest of the cases commonly cited, in which the Court of Chancery refused to interfere, on the ground of the plaintiff's own deceptive conduct, until the plaintiff had established his right by action at law, is *Pidding v. How*,<sup>2</sup> and the leading authority on the subject is the judgment of Mellish, L.J., in *Ford v. Foster*.<sup>3</sup> There it was objected by the defendants that the plaintiff in certain invoices and advertisements had falsely described himself as a patentee; but as the false description was collateral and did not appear in the mark in question, and the plaintiff's trade was not shown to be fraudulent, the Court decided that the plaintiff's legal right of action in respect of the defendants' infringement was not barred, and that he was consequently entitled to an injunction, with an account from the filing of the bill, and costs. If the false representation had been in the trade mark itself, the Lord Justice held, no Court of Equity, and, according to his opinion, no Court of law, would have entertained the plaintiff's action, and the same rule would apply if the trade were fraudulent; but, he said, "where the trade is, as in this case, a perfectly honest trade, and where the trade mark is, as in this case, a perfectly honest trade mark, I am clearly of opinion that there is no common law principle upon which it is possible to hold that the fact that the plaintiff has been guilty of some collateral fraud would be an answer to an action. It would be impossible to plead at law as a justification for the defendant's committing the fraud, that the plaintiff had committed a fraud on someone else." "It is true," he added, "that in this case the bills containing this false representation as to its being a patented article are proved to have been given to the defendants themselves; but there is not the slightest evidence, or the slightest reason for supposing, that the defendants were ever deceived by

Collateral misrepresentation.

*Ford v. Foster.*

The judgment of Mellish, L.J.

<sup>1</sup> L. R. 9 Eq. p. 352 (1869).

<sup>2</sup> 8 Sim. 477; 6 L. J. Ch. (N. S.) 345 (1837), Shadwell, V.-C. Lying advertisements as to the origin of tea (*Howqua's Mixture*). The Vice-Chancellor said, "It is a clear rule, laid down by Courts of equity, not to extend their

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

<sup>3</sup> L. R. 7 Ch. 611 (1872) (*Eureka Shirts*). For the American authorities, which are very numerous, see Mr. Cox's note to this case.

that representation, because they knew perfectly well that there was no patent for these shirts."<sup>1</sup>

Examples of collateral misrepresentations.

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

Section 11 provides 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 be disentitled to protection in a Court of Justice, or would be contrary to law or morality, or any scandalous design,<sup>2</sup> and the registered proprietor of a trade mark offending against this section acquires no rights under sec. 41 of the Act, after seven years' registration.

Application to remove deceptive mark from the Register

It follows that a trade mark which contains false statements or misrepresentations ought not to be entered or retained upon the Register, and, in modern cases, if the defendant wishes to rely upon the defence now under consideration, and to allege that the plaintiff's trade mark itself is deceptive, he commonly applies under sec. 35 to have it removed from the Register.<sup>3</sup> This is a convenient method of bringing the question to an issue, if the plaintiff is suing in respect of a registered mark, and it is

<sup>1</sup> See p. 426, note (2) above. The matter is well stated in an American case. "Courts of equity will not protect a trade mark that deceives the public. We do not suppose, however, that that deception need be of such a character as to work positive injury to purchasers, nor, on the other hand, that every erroneous impression which the public or a portion of the public may receive will be sufficient to destroy the validity

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

<sup>2</sup> Chap. X., p. 266.

<sup>3</sup> *Wool v. Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A.; *Dexter's Tm.*, [1893] 2 Ch. 262; 10 R. P. C. 269, Wright, J. See Chap. X., p. 266.

the most advantageous course for the defendant; but there is no reason to suppose that the Court would be any more ready to interfere to protect a deceptive trade mark because it was registered, or that it is not open to the defendant to give evidence in support of a plea of the defence in question without there being any application under sec. 95 before the Court.<sup>1</sup>

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

In *The Leather Cloth* case,<sup>2</sup> the plaintiffs' case failed because, in the label in question, they had described their goods as "tanned leather cloth," "patented," and "J. R. and C. P. Crockett" as the manufacturers, adding an American address, whereas, in fact, much of the cloth for which the mark was used was not tanned, none of it was made under any patent, and the manufacturers were not J. R. and C. P. Crockett, but the plaintiffs themselves, who had no American address. It was urged on behalf of the plaintiffs that the misrepresentations, and in particular the representation that the goods were tanned, could not deceive any ordinary purchaser; but in answer to this Lord Westbury said: "I cannot receive it as a rule either of morality or equity that the plaintiffs are not responsible for a falsehood because it is so gross and palpable that no one is likely to be deceived by it. If there is a wilfully false statement, I will not stop to inquire whether it is too gross to mislead."<sup>3</sup>

*The Leather Cloth* case.

It is immaterial that the misrepresentation does not deceive;

It is no answer to the objection that the trade, or any other given class of persons, know the actual facts and are not deceived;<sup>4</sup> for, as in the case of the test of infringement, the question is—is the mark calculated to deceive any probable purchasers who buy from the plaintiff directly or indirectly through others to whom he sells?

or that the facts are known to the trade.

The employment of the word "patent" in a mark used for goods which are not manufactured under an existing patent right has given rise to much discussion;<sup>5</sup> but the authorities

False claim of patent right.

<sup>1</sup> As to this point, see *Hubbuck v. Brown*, 17 R. P. C. 638 (1900), C. A.

<sup>2</sup> 4 De G. J. & S. 137; 33 L. J. Ch. 199, Ld. Westbury; and 11 H. L. C. 523; 35 L. J. Ch. 53; H. L. overruling 1 H. & M. 271; 32 L. J. Ch. 721, Wood, V.-C. (1863). See also *Newman v. Pinto*, 4 R. P. C. 508; 57 L. T. 31 (1887), C. A., mark representing German cigars as of Havana make, cited p. 439.

<sup>3</sup> 33 L. J. Ch. p. 203. So per Fry, L.J., in *Newman v. Pinto*, 4 R. P. C.

p. 520 (1887).

<sup>4</sup> *Wood v. Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A.; cf. *Eno v. Dunn*, 10 R. P. C. 261 (1893).

<sup>5</sup> Its use may amount to a criminal offence; sec. 89 of the Patents and Designs Act, 1907, replacing similar provisions of sec. 105 of the Act of 1883, below, p. 585; and Merchandise Marks Act, 1887, s. 3 (1) (c). Appendix, p. 807.

do not seem to have established any more definite rule than that it is in each case a question whether or not the employment of the word makes a false and deceptive claim to a non-existent patent right for the goods.<sup>1</sup> It is not necessarily deceptive to describe as "patent" goods made according to a process which once was patented, or even those made according to a process which is, or was when the epithet was first applied, different from the common process, though never protected by a patent, for ordinary usage and understanding have long sanctioned such descriptions, as the names patent leather, patent medicine, patent metal, patent yellow, and patent hoe, show.<sup>2</sup>

Lord Kingsdown's judgment in *The Leather Cloth* case.

The following passage from Lord Kingsdown's judgment, in *The Leather Cloth* case,<sup>3</sup> in reference to the subject under consideration, is very frequently cited in argument: "If a trade mark represents an article as protected by a patent, when in fact it is not so protected, it seems to me that such a statement *prima facie* amounts to a misrepresentation of an important fact, which would disentitle the owner of the trade mark to relief in a Court of Equity against anyone who pirated it. In *F'larcl v. Harrison*,<sup>4</sup> Wood, V.-C., intimated his opinion that this would be so when there never had been any patent at all. But in the subsequent case of *Edelsten v. Vick*,<sup>5</sup> he seems to doubt whether the rule would be the same if there had originally been a patent, and the statement in the trade mark being true when first introduced, had been continued after it had ceased to be true. I confess that I should have had great difficulty in assenting to that distinction. If the word 'patent' be not so used as to indicate the existing protection of a patent, but merely as part of the designation of an article known in the market by that term (and this I collect to have been the main ground of his Honour's decision), then I quite agree with his view. In such case nobody is meant to be deceived, or is deceived. A patent may have

<sup>1</sup> The authorities cannot easily be reconciled under one rule: per Kekewich, J., *Hubbuck v. Brown* (1899), W. N. 251; 17 R. P. C. p. 156.

<sup>2</sup> See per Wood, V.-C., in *Edelsten v. Vick*, 11 Hare, 78 (1853); *Morgan v. McAdam*, 36 L. J. Ch. 228 (1866) (*Patent Plumbing Crucibles*); and *Gridley v. Swinburne*, 5 Times L. R. 71; 52 J. P. 791 (1888), Coleridge, L.C.J.,

and Grautham, J., (*Swinburne's Patent Refined Isinglass*). "The illustrious race whose drops and pills, have *patent powers* to vanquish human ills"—Crabbe, quoted in Ogilvie's Dictionary.

<sup>3</sup> 11 H. L. C. 523; 35 L. J. Ch. p. 64 (1865).

<sup>4</sup> 10 Hare, 467; 22 L. J. Ch. 866 (1853).

<sup>5</sup> 11 Hare, 78 (1853).

expired fifty years ago, and yet the name of patent may have become attached to the article, and be used in the trade as designating it. But if the trade mark represents the article as protected by patent, when in fact it is not so protected, I cannot think that it can make any difference whether the protection has never existed or has ceased to exist."

And in a later case, Jessel, M.R., said: "No doubt a man may use the word 'patent' so as to deceive no one. It may be so used as to mean that which was a patent but is not so now. In other words, you may state in so many words, or by implication, that the article is manufactured in accordance with a patent that has expired. But if you suggest that it is protected by an existing patent, you cannot obtain the protection of that representation as a trade mark. Protection only extends to the time allowed by statute for the patent, and if the Court were afterwards to protect the use of the word as a trade mark, it would, in fact, be extending the time for protection given by the statute. It is, therefore, impossible to allow a man who has once had the protection of a patent to obtain a further protection by using the name of his patent as a trade mark. But further, no man can claim a trade mark in a falsehood. It is a falsehood to represent that the patent is still existing."<sup>1</sup>

Expired  
patent.

In *The Club Soda* case the plaintiff's mark consisted of a label bearing the words "Club Soda," and also "Manufactured in Ireland by H.M. Royal Letters Patent." This was explained to mean "manufactured by the aid of patented machinery." The offending words were also used in advertisements, but the goods were never called "patent club soda water." The Privy Council held that, having regard to the nature of the goods, no one could be deceived, and they gave judgment for the plaintiff.<sup>2</sup>

From the principles stated in these judgments, and from the decided cases, it follows that the use of the word "patent" in a trade mark for unpatented goods is not to be taken to be misleading where either it is shown that the market name of the goods comprises the word,<sup>3</sup> or where the goods are made according to an expired patent, and the word is so used as to be

Where  
"patent" is  
not deceptive.

<sup>1</sup> *Cheavin v. Walker*, 5 C. D. p. 862 (1877), C. A.

<sup>2</sup> *Cochrane v. Maenish*, [1896] A. C. 225; 13 R. P. C. 100.

<sup>3</sup> *Marshall v. Ross*, L. R. 8 Eq. 651 (*Patent Thread*); cf. *Leather Cloth Co. v. Lonsont*, L. R. 9 Eq. 345, both (1869), James, V.-C.

understood to refer to this,<sup>1</sup> or wherein from the nature of the cases it is unlikely to mislead.<sup>2</sup>

The following is a summary of the reported cases on the subject<sup>3</sup> :—

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

First, where the plaintiff's action was barred: FLAVEL'S PATENT KITCHENER, no patent, *Flavel v. Harrison*, 10 Hare, 467; 22 L. J. Ch. 866; PATENTED JAN. 24, '56, patent void, *Leather Cloth Co., Ltd. v. American Leather Cloth Co., Ltd.*, p. 429; *Leather Cloth Co., Ltd. v. Lorsont*, L. R. 9 Eq. 345; PATENT PLUMBAGO CRUCIBLES, no patent, *Morgan v. McAdam*, p. 430; ROYAL LETTERS PATENT, no patent, but duty paid in respect of a patent medicine, *Lamplough v. Balmer*, W. N. (1867), 293;<sup>4</sup> MANUFACTURER AND PATENTEE, no patent, *Nixey v. Roffey*, W. N. (1870), 227; G. CHEAVIN'S IMPROVED PATENT GOLD MEDAL SELF-CLEANING RAPID WATER FILTER, expired patent, *Cheavin v. Walker*, p. 431. In *Hubbuck v. Brown*, 17 R. P. C. 638, where the mark included the words HUBBUCK'S PATENT LONDON in circular form with the words WHITE ZINC within the circle, the mark being an old one registered for paints, it was shown that the plaintiffs had never had any patent for White Zinc Paint, and that although they had had a patent, long since expired, relating to the manufacture of oxide of zinc, they had ceased to confine their mark to paint made with oxide of zinc manufactured under the patent. Rigby, L.J., said that, if necessary, he should have held that the plaintiffs were disentitled to sue.<sup>5</sup>

<sup>1</sup> *Ransome v. Graham*, 51 L. J. Ch. 897 (1882), Bacon, V.-C. In *Morgan v. McAdam*, 36 L. J. Ch. 228 (1866). Wood, V.-C., suggested that in these cases the date of the patent should be given. Cf. sec. 33 of the Patents and Designs Act, 1907, as to marking being notice to infringers.

<sup>2</sup> See note (2) previous page.

<sup>3</sup> The pages given refer to this book. See also *Adams' Tm.*, 9 R. P. C. 174; 66 L. T. N. S. 610 (1892), where Kekewich, J., refused to allow "patent" to be struck out of an old mark for furniture polish.

<sup>4</sup> "Patent medicines" are excepted from the prohibition upon the sale of poisons in the Pharmacy Act, 1868. The exception relates to medicines manufactured under letters patent only: *Pharmaceutical Society v. Piper*, [1893]

1 Q. B. 686; *Same v. Armson*, [1894] 2 Q. B. 720.

<sup>5</sup> See also *The Triticumina* case, *Mealy & Co. v. Triticine*, 15 R. P. C. 1 (1898), where North, J., held that that word was the name of a patented article (above, p. 47), and expressed the opinion, without deciding the point, that as the plaintiffs had represented the article as patented, they would be in no better position if the representation were untrue. And see the copyright case, *Slingsby v. Bradford Patent Truck and Trolley Co.*, [1906] W. N. 50, in which it appeared that many of the articles described in the plaintiffs' catalogue as "patent" had not been patented in England, and the action was dismissed on the ground that by reason of this and other misrepresentations the catalogue was not entitled to the protection of the Court.

Secondly, where the plaintiff's action was not barred: SYKES' PATENT, patent invalid, no plea having reference to the misrepresentation, *Sykes v. Sykes*, 3 B. & C. 541;<sup>1</sup> TAYLOR'S PATENT SOLID-HEADED PINS, expired patent, labels printed from the old blocks in use while the patent existed, *Edelsten v. Vick*, 11 Hare, 78; PATENT THREAD, no patent, evidence that patent was understood in the market to denote the character of the goods, *Marshall v. Ross*, L. R. 8 Eq. 651; CLUB SODA, MANUFACTURED IN IRELAND BY H.M. ROYAL LETTERS PATENT, *Cochrane v. Macnish*, above, p. 431. The case of *Ransome v. Graham*, 51 L. J. Ch. 897, must probably be explained as one of collateral misrepresentation, if it can be supported at all. There the trade mark consisted of letters and numbers stamped upon the working parts of the plaintiff's ploughs, and "patent" was stamped also, although the only patent which had ever existed related to the plough-shares merely, and had expired in 1817. The plaintiff's advertisements and catalogues stated that the patent had expired, but this could hardly be an answer to the objection, as the notice would not, or might not, reach all the persons who saw the stamp.

Action not barred.

The Registrar may refuse to accept any application upon which any of the following appear, namely, "Patent," "Patented," "By Royal Letters Patent," or words to like effect.<sup>2</sup>

"Patent," &c., not to be registered.

It is a misrepresentation which disentitles a label or other trade mark to protection or to registration, to indorse upon it anything which is calculated to mislead the public as to what is the mark of which the proprietor claims the exclusive use. The matter was first brought forward in *The Apollinaris* case,<sup>3</sup> where some of the labels in question had the word *trade mark* printed immediately under the red triangle or disc, which was their most prominent feature, although other parts of the labels, and, in particular, the words *Apollinaris* and *Friedrichshall*, were claimed as essential features of the trade marks. The application before the Court was to remove the marks from the Register on several grounds; and Fry, L.J., who delivered the judgment of the Court of Appeal, dealt with the present objection in the following passage<sup>4</sup> :—

"Trade mark."

*The Apollinaris* case.

<sup>1</sup> See *Hubbuck v. Brown*, cited above, p. 432.

<sup>2</sup> Rule 11, p. 651.

<sup>3</sup> [1891] 2 Ch. 186; 8 R. P. C. 137, C. A. In *Bass, Rutcliffe and Gretton, Ltd.'s Tms.*, [1902] 2 Ch. 579; 19 R. P.

C. 129, 529, C. A., cited p. 435, Romer, L.J., said that he should not have come to the same conclusion on the facts as the Court of Appeal did in the *Apollinaris* case.

<sup>4</sup> [1891] 2 Ch. p. 233.

“One (objection) was, that the mark was calculated to mislead, inasmuch as the whole label is registered as a trade mark, and yet contains the assertion that the red disc, which is the most conspicuous part of the whole label, is ‘trade mark’—not saying ‘a trade mark,’ not saying part of ‘the trade mark’—but an assertion pointing to the conclusion that it, and it alone, is ‘the trade mark,’ and therefore that the label, as a whole, is not the trade mark. Such would have been the impression produced (I am speaking for myself) on my own mind, had I approached the reading of the label unbiassed by what I have learned while sitting in this seat, and such, we think, is the true result of this case. An owner of a registered trade mark may put it on a registered label, but not so as to mislead a reader of that label, and induce him to believe the only thing registered is the distinctive mark.” It is true, the learned Lord Justice added, that the objection might, apparently, have been taken in *Hudson’s* case, where the mark there in question was upheld by the Court of Appeal,<sup>1</sup> but it was, in fact, neither discussed in argument nor considered by the Court.

This judgment caused a number of applications, under sec. 92 of the Act of 1888,<sup>2</sup> for leave to remove “trade mark” from registered marks to be made to the Court. The results of these are stated in Chapter X.<sup>3</sup>

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

*Hammond v.  
Brunker.*

In *Hammond v. Brunker*,<sup>4</sup> the registered label of the plaintiffs comprised a number of devices, and among them a small blank shield in the middle of the upper half. In use, the plaintiffs printed within the blank shield a hand and forearm holding a dart, and having the words “trade mark” beneath it. Chitty, J., in rejecting an objection founded upon this, said:<sup>5</sup> “It is a question of fact in every case where a man puts the term ‘trade mark’ on his device, or some part of it, whether he does or does not so place the words as to indicate to the public that he is claiming a particular part of the trade mark only. In *The*

<sup>1</sup> 32 C. D. 311 ; 3 R. P. C. 155 (1886).

<sup>2</sup> Corresponding to sec. 34 of the Act of 1907.

<sup>3</sup> Page 272.

<sup>4</sup> 9 R. P. C. 301 (1892). Chitty, J., came to a similar conclusion of fact in

*Benedictus v. Sullivan*, 12 R. P. C. 25 (1894), cited below, where the registered trade mark was the words “La Flor de Margareta,” see at p. 32.

<sup>5</sup> 9 R. P. C. 307.



*Apollinaris* case, the Lord Justice's observations were addressed to a label which had been registered, and had the term *Friedrichshall* above a disc, with a quantity of printed matter; the disc was coloured red, and underneath the disc were the words 'trade mark.' Without expressing a final opinion on the matter,<sup>1</sup> the Lord Justice thought that there were grounds for saying, on that label, that the trade mark referred to the disc, and if I may say so myself, with great respect, it seems to me that there were grounds. But, as I say, this is a question of fact, and I am satisfied that these words 'trade mark' in the middle of this label do not indicate to the public that the shield only is the trade mark. In *The Apollinaris* case there was no other device except the disc, which was coloured red, in use.<sup>2</sup> That being so, I think that these two grounds of objection to the plaintiff's suing, namely, the addition of the arrow and the forearm, and the addition of the words 'trade mark,' do not disentitle the plaintiff to ask for an injunction with regard to his trade mark."

In a later case,<sup>3</sup> Wright, J., held the objection to be fatal to one of the respondents' marks, a label, and ordered it to be removed from the Register. There the main portion of the label was occupied by a picture of the head of a negro, inclosed by a circular band containing the words *W. D. & H. O. Wills, Bristol*. Underneath this picture was printed in very large letters the word *Star*. At the side of the label, on the right, was a representation of an eight-pointed star; and in immediate proximity to the star the words "trade mark" occurred.

A similar question came again before the Court of Appeal in *Bass' Tms.*,<sup>4</sup> in which Kekewich, J., had ordered the removal from the Register of a label, having in its centre a diamond (in black as registered) with the words "trade mark" on it; one of the grounds of removal was that the words were deceptive, as leading to the inference that the rest of the label was unregistered. A diamond coloured red on the Register was in fact separately registered and owned by the respondents. They successfully appealed, the Court of Appeal holding that no one could be

<sup>1</sup> This is hardly borne out by the report of the judgment of Fry, L.J.

<sup>2</sup> But there were the important words *Apollinaris* and *Friedrichshall*.

<sup>3</sup> *Dexter's Tm. and Wills' Tm.*, [1893] 2 Ch. 262; 10 R. P. C. 269. See also

*Day and Riley v. Whittaker*, 17 R. P. C. 517 (1900), Buckley, J., as to the mark No. 70,347.

<sup>4</sup> [1902] 2 Ch. 579; 19 R. P. C. 129, 529.

misled or injured by the words as they appeared on the label. Romer, L.J., delivering the principal judgment, said that it could not be laid down as a general rule that, whenever the word "trade mark" appeared on a label, it must be intended to denote only that particular part of the label on which it was placed; and he continued as follows: "In the present case the word 'trade mark' is placed in the centre of the label upon the diamond, and I do not know why I should be bound to assume that the word is intended to apply only to the diamond. But it may so apply, and I will assume that it does. What then? In every case in which the word 'trade mark' is placed upon a particular portion of a label to denote that that portion is a trade mark, is the Court bound of necessity to hold that the label is calculated to deceive? In my opinion it is not. It may, no doubt, in some circumstances be calculated to deceive. If, for example, the part of the label to which alone the word is intended to refer is not in fact the subject of a separate trade mark, I think the label would be calculated to deceive, because it would lead an ordinary person reading it to suppose that the owner of the label as a whole had a specially greater right as against the public than he really had. But if there were a separate trade mark for that part of the label which is designated by the word 'trade mark,' why should it be assumed in every case that the word is calculated to deceive? As I have pointed out in the course of the argument, it is not sufficient to say that the label is 'calculated to deceive.' It must be shown that it is reasonably calculated to injure some one—to lead him to do or to abstain from doing some act the doing or the abstaining from doing which may possibly injure him. Now, there may be a perfectly innocent deception, which would injure no one. If there were such an innocent deception, it ought not to be a ground for removing a trade mark from the Register. The truth is the Court ought in each case to see in the first place whether, assuming that the word 'trade mark' refers to a particular portion only of the label, there would be a natural inference that the rest of the label, or the label as a whole, was not a trade mark. Speaking for myself, I refuse to take it as a natural or necessary inference in every case, from the fact that a particular portion of a label is designated as a 'trade mark,' that the whole of the label is not a trade mark. In my opinion such a conclusion ought not to be drawn in every case. You ought to go further, and to ask in each case, can it

be supposed from the particular facts of the case that there is any substantial probability of injury."

A combination trade mark and a part of it can be each registered, but, if registered under the Act of 1905, they must be registered as associated trade marks.<sup>1</sup>

It is a penal offence to describe a trade mark as registered when it is not.<sup>2</sup> Such a misrepresentation is, it seems, sufficient to deprive the proprietor of the mark of his right to protection against infringers, or against persons who pass off their goods as his under cover of the mark.<sup>3</sup> In *The Melachrino* case,<sup>4</sup> however, Chitty, J., held that the use of the word "registered" with a mark in which blanks appearing on the registered form were filled up by coats of arms in use, was not a bar to the plaintiff's case; and it has been held by the Court of Appeal that the use of the words "special registered trade mark," before registration had been obtained, was not a sufficient objection to prevent the Court granting an interlocutory injunction.<sup>5</sup> And the Court of Appeal has allowed a mark to be registered which had been used with the words "registered shape." In this case both the mark (a dome-topped cylinder) and the words had been impressed on the blocks of blacklead, which were the goods in question, although the registration of the shape as a design had expired in 1864; but the case was not argued on behalf of the respondents.<sup>6</sup>

False assertion of registration.

In *Benedictus v. Sullivan*,<sup>7</sup> the plaintiff had printed at the bottom of one of the labels used upon his cigar boxes "Regd. by H. B. 6458." The label comprised a number of devices and also the words *La Flor de Margareta*. The words alone had been registered in the trade mark registry, and they were so registered under Number 6458. It was, however, held upon a consideration of the whole box and its other labels that there was

<sup>1</sup> Sec. 25, above, p. 109.

<sup>2</sup> Sec. 67, below, p. 585, replacing as to trade marks sec. 105 of the Act of 1883, s. 105, below, p. 642; Merchandise Marks Act, s. 3 (1) (e); see Appendix, p. 807.

<sup>3</sup> In *Sea-Sea Co. v. Britten*, [1899] 1 Ch. 692; 16 R. P. C. 137, Stirling, J., said, "Of course, if the plaintiffs are brought within the terms of that section they must be denied relief."

<sup>4</sup> 4 R. P. C. 215 (1887).

<sup>5</sup> *Read v. Richardson*, 45 L. T. 54

(1881), C. A. In *Lewis v. Goodbody*, 67 L. T. 194 (1892), Kekewich, J., refused an interlocutory injunction in a passing-off case, because the plaintiffs had represented that their mark was a registered trade mark. See p. 438, note (1).

<sup>6</sup> *James' Tm.*, 33 C. D. 392; 3 R. P. C. 340 (1886). And see p. 438, note (5).

<sup>7</sup> 12 R. P. C. 25 (1895), Chitty, J. The label is printed in the report. The label was, in fact, registered at Stationers' Hall, but not under No. 6458.

no representation that anything besides the words of the label was registered.

“Trade Mark.”

The description of an unregistered trade mark as a “trade mark” is no offence within sec. 67, and if the mark is, in fact, as it may be, a trade mark acquired by user, such description is not by itself a misrepresentation.<sup>1</sup> But a person is to be deemed for the purposes of sec. 67 to represent that a trade mark is registered, if he uses in connection with the trade mark the word “registered” or any words expressing or implying that registration has been obtained for the trade mark.<sup>2</sup> The use of the words “Trade Mark—Registered,” or “Registered,” is a representation of registration in this country, and, in the absence of words qualifying that meaning, the use of either expression referring to an unregistered mark is an offence under the section.<sup>3</sup>

Other misleading statements.

It was further suggested, in *The Apollinaris* case, and the Court of Appeal were inclined to hold, that the indorsement upon one of the labels used for natural mineral waters, and claimed as a trade mark, “imitations of this water will be prosecuted,” meant all imitations, whether fraudulent or not, of the water, and was addressed, therefore, to artificial waters which might lawfully be made and sold as imitations of the natural water, and that, if it bore this meaning, it was calculated to deceive.<sup>4</sup>

The Registrar may refuse to accept any application upon which any of the following appear, namely the words “Registered,” “Registered Design,” “Copyright,” “Entered at Stationers’ Hall,” “To counterfeit this is forgery,” or words to like effect, and accordingly such words should not appear upon the representations of trade marks forming part of an application.<sup>5</sup>

The operation of a deceptive misstatement as to the origin of

<sup>1</sup> *Sen Sen Co. v. Britten*, p. 437, note (3). The mark there was registered in the United States. An interlocutory injunction was granted. Stirling, J., held that the use of the words “trade mark” was not a pretence of registration. Kekewich, J., who was reported in *Lewis v. Goodbody*, p. 437, note (5)), as having decided the contrary, has adopted this ruling: *Hubbuck v. Brown*, 17 R. P. C. 148; (1899), W. N. 250.

<sup>2</sup> Sub-sec. 2.

<sup>3</sup> *Wright, Crossley & Co. v. Dohbin*, 15 R. P. C. 21 (Q. B. D. Ireland);

*MacSymons Stores, Ltd. v. Shuttleworth*, 15 R. P. C. 748 (Day and Channell, J.J.), both 1898, and decided therefore under the Act of 1883. See also *Winer & Co., Ltd. v. Armstrong*, 16 R. P. C. 167, as to use of “registered” after expiration of protection of design.

<sup>4</sup> [1891] 2 Ch. p. 226. As to the refusal of costs to a defendant on the ground of his misrepresentation, see below, p. 463.

<sup>5</sup> Rule 11, Appendix, p. 657. Cf. *Altman’s Application*, 21 R. P. C. 753 (1904), Kekewich, J., and *Lyle and*

the goods in destroying the distinctive character of the mark, has been referred to in an earlier chapter.<sup>1</sup> In *The Eton Cigarette* case,<sup>2</sup> it was held that an English tobacconist, who put a Russian name, as that of the maker, upon his goods could not protect the mark which they also bore as his trade mark against infringements.

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

Fraudulent trade.

A plea that the plaintiff made a practice of selling by short weight failed because it was not supported by the evidence, *The Guinea Coal* case, *Lee v. Haley*, L. R. 5 Ch. 155. A Pianoforte Tutor, described as "600th edition, specially revised by Hemy," although the musician referred to had not revised the work for ten years, was held not to be misleading, evidence being given that in the trade an issue of 250 was called an edition, *Metsler v. Wood*, 8 C. D. 606. A trade in German cigars sold in boxes bearing a label with the words LA PUREZA (an old Havana brand), HABANA, RAMON ROMEDO, and additional labels with other words and a sham address in Spanish was held to be fraudulent, the whole get-up being described by Bowen, L.J., as "an elaborate concatenation of pictorial lies" intended to pass off the cigars as made in Havana, although evidence was given that the name *Havana* in the cigar trade indicates the shape of the cigars only, *Newman v. Pinto*, 4 R. P. C. 508; 57 L. T. 31;<sup>3</sup> but the sale of English cigars under a label bearing the word HABANA, in boxes marked BRITISH MANUFACTURE, was held not to be fraudulent in the absence of evidence that the plaintiffs represented that their cigars were made in Havana, *Hargreaves v. Freeman*, [1891] 3 Ch. 39; 8 R. P. C. 237.<sup>4</sup> The application of the name CALIFORNIAN SYRUP OF FIGS to an aperient drug in which fig syrup

Summary of cases.

Havana cigars.

*Kinahan's Application*, 24 R. P. C. 37 and 249 (1907), Kekewich, J., and C. A., where representations before registration as to the marks being registered made by *bonâ fide* mistake or slip were not held sufficient ground for refusing registration.

<sup>1</sup> Chap. VIII., p. 200.

<sup>2</sup> *Wood v. Lambert*, 32 C. D. 247; 3 R. P. C. 51 (1886), C. A.; *Wolff v. Nopitsch*, 17 R. P. C. 321 (1900), Cozens-Hardy, J. (*Spanish Graphite*); on appeal this point was not specially dealt with,

18 R. P. C. 27.

<sup>3</sup> Cf. *Fuente's Tms.*, [1891] 2 Ch. 166; 8 R. P. C. 214; and *Dexter's Application*, [1893] 2 Ch. 262; 10 R. P. C. 269.

<sup>4</sup> Cf. *Benedictus v. Sullivan*, above, p. 437, where a Spanish look about the box, and the words "Fabrica de Tabacos de la Vuelta Abago," was held not to be a representation of foreign manufacture in the face of the words "Regalia Britannica," "Londini"; and *Robinson and Barnsdale, Ltd.'s* case, *Times*, April 2nd, 1901.

*The Bile Bean case.*

was used as a flavouring only was held not to be a misrepresentation: *Californian Fig Syrup Co. v. Taylor's Drug Co.*<sup>1</sup> In *Bile Bean Manufacturing Co. v. Davidson*, 22 R. P. C. 553; 23 R. P. C. 725 (1905), a case of alleged passing-off by means of the words "Bile Beans," the plaintiffs' advertisement falsely stated that the basis of their Bile Beans was an Australian herb discovered by an eminent scientist, whose name was given. There was no such person, and the story of the discovery given in the advertisements was an invention. These advertisements were not, however, on the pill boxes themselves. It was held by the Lord Ordinary that the plaintiffs' trade was a fraudulent one, and that the plaintiffs were disentitled to protection for it, and the action was dismissed on this as well as on other grounds, and the decision was upheld on appeal, it being held that the misrepresentation was not a collateral one, but affected the very essence of the article offered for sale.

Misrepresentation abandoned before, or commencing after action brought.

A misrepresentation which has been corrected and abandoned before the action is no bar.<sup>2</sup> The same rule is said to apply to one adopted after the commencement of the action. So Fry, J., stated in *Siegert v. Findlater*,<sup>3</sup> for, he said, applying the test laid down by Mellish, L.J., in *Ford v. Foster*,<sup>4</sup> its adoption could not, before Sir John Rolt's Act, have warranted the Court of Chancery in restraining the action had it been commenced in a common law Court. The learned Judge held, however, that in the case before him there was in fact no fraudulent misrepresentation which ought, in any case, to debar the plaintiffs. It is submitted, with great deference, that on principle it can make no difference, supposing the plaintiff is seeking the aid of the Court for a fraudulent trade, or for a trade conducted by fraudulent means, that the frauds commenced after the action was begun. The objection is not that the plaintiff's case is incomplete, or that the

<sup>1</sup> 14 R. P. C. 341 (1897), Kekewich, J., reversed on appeal on another point; 14 R. P. C. 564.

<sup>2</sup> *Benedictus v. Sullivan*, p. 437. See also the American case, *Siegert v. Abbott* (2) (1891), Cox, p. 486.

<sup>3</sup> 7 C. D. 801 (1878) (*Angostura Bitters*).

<sup>4</sup> L. R. 7 Ch. 611, cited p. 427, and *Faulder & Co., Ltd. v. Rushton*, 20 R. P. C. 477, at p. 489 (1903), Hall, V.-C., where the plaintiffs' trade mark had

been removed from the Register after the commencement of the action, but the plaintiffs succeeded on passing-off. It was contended that the use by the plaintiffs of the words "trade mark" was a misrepresentation, and it was held that, if after the judgment removing the mark the continued use of the words was a misrepresentation, it was an honest and natural mistake and not such a mistake as disentitled them to relief. See p. 438. "Trade Mark."

defendant has any answer as of right to oppose to it, but that the plaintiff and his business are, when the Court takes cognizance of the matter, unworthy of its protection or assistance.

It may here be noticed that in a firm name case the defendants set up that the use of the name by the plaintiffs, a limited company, had been in contravention of sec. 41 of the Companies Act, 1862, but Farwell, J., held that this was no defence,<sup>1</sup> and his decision has been followed in a later case.<sup>2</sup> But if a limited company sets up a claim to a trade name which they have used in association with their statutory name, they may find it difficult to establish that the trade name by itself indicates them or their goods; and if they omit all reference to their statutory name they may render themselves liable to penalties under sec. 42 of the Companies Act, 1862.<sup>3</sup> A trade mark is not necessarily an advertisement within sec. 41 of that Act.<sup>4</sup>

Alleged  
offences  
against Com-  
panies Acts.

### 6. The Relief granted.

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

#### (i.) Injunction.

This was the characteristic remedy by which the Court of Chancery protected trade marks, either after the plaintiff had recovered damages for past infringements at law, or where it had been appealed to in the first instance and no action had been brought. It is generally the most beneficial relief for the plaintiff, because it summarily stops the particular infringement

<sup>1</sup> *Pearks, Gunston and Tee, Ltd. v. Thompson, Talmev & Co.*, 18 R. P. C. 185 (1901) (*Talmev & Co.*). On appeal the case was settled. Cf. *Ld. Robertson's judgment in Royal Baking Powder Co. v. Wright, Crossley & Co.*, 18 R. P. C. at p. 103.

<sup>2</sup> *H. E. Randall, Ltd. v. British and American Shoe Co.*, [1902] 2 Ch. 354;

19 R. P. C. 393, Swinfen Eady, J.

<sup>3</sup> See the judgments of Cozens-Hardy, M.R., and Farwell, L.J., in *H. E. Randall, Ltd. v. Bradley*, 24 R. P. C. 773 (1907).

<sup>4</sup> *Application of Albert Baker & Co.* (1898), *Ltd.*, [1908] 2 Ch. 86; 25 R. P. C. 513, Eve, J.

which the defendant has practised, and makes it highly dangerous for him to commence any other, and it is operative against impecunious infringers who might care little for repeated judgments for damages against them. The Merchandise Marks Act of 1862<sup>1</sup> empowered a court of law, in any action for fraudulent infringement, to grant an injunction to the successful plaintiff; and, since the Judicature Acts, both divisions of the High Court have the same power as that formerly exercised by the Court of Chancery.

Further infringement must be threatened or be likely to occur.

The grant of an injunction in trade mark cases is governed by the general rules governing it where other rights are concerned. There must be some threat or probability that the infringement will be commenced, continued, or repeated, or the Court will not interfere;<sup>2</sup> but if an actual infringement is shown to have occurred that is usually sufficient, and the plaintiff is not bound to wait until it has been frequently repeated, or until warning has been given and been disregarded,<sup>3</sup> for "the life of a trade mark depends upon the promptitude with which it is vindicated."<sup>4</sup> So an injunction has been granted where the defendant had altered the device and discontinued the use of the labels complained of, and offered to undertake not to use any more of them,<sup>5</sup> although, in some instances, the undertaking of an innocent infringer has been accepted by the Court.<sup>6</sup> Nor is it necessary that any actual infringement should have occurred if it is proved that the defendant contemplates committing or has threatened to commit one,<sup>7</sup> and it is sufficient evidence of this that he is in possession of a considerable quantity of spuriously marked goods,<sup>8</sup> even though it is only as a forwarding agent.<sup>9</sup>

<sup>1</sup> 25 & 26 Vict. c. 88, s. 21, now repealed; see Chap. I., p. 17.

<sup>2</sup> See the cases in which isolated instances of infringement or passing-off only have been proved, above, p. 389. Also the patent case, *Hudson v. Chatteris Engineering Co.*, 15 R. P. C. 438 (1898), Stirling, J. The Court will presume that a trader will use his mark so as not to be deceptive, if it is capable of being used without the probability of being deceptive, unless some reason to the contrary is shown: *Kutnow's Tm.*, 10 R. P. C. 401 (1893), cited p. 271.

<sup>3</sup> See *Upmann v. Forester*, 24 C. D. 231 (1883), Chitty, J., see above, p. 382.

<sup>4</sup> *Johnston v. Orr-Ewing*, 7 App. Ca. 219.

<sup>5</sup> By Malins, V.-C., in *Guinness v. Heap*, Seb. Dig. p. 377 (1878); cf. *Tonge v. Ward*, 21 L. T. N. S. 480 (1859), Romilly, M.R.

<sup>6</sup> *Rose v. Loftus*, 47 L. J. Ch. 576 (1878), Malins, V.-C.

<sup>7</sup> See *The Emperor of Austria v. Day and Kossuth*, 3 De G. F. & J. 217; 30 L. J. Ch. 690 (1861), Campbell, C. and L.JJ.

<sup>8</sup> See above, note (3).

<sup>9</sup> *Upmann v. Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. 130 (1871), Romilly, M.R., and Hatherley, C.



It has already been shown that the fact that the infringement was not fraudulent,<sup>1</sup> or even that it was made in ignorance of the plaintiff's right,<sup>2</sup> is no defence to the claim for an injunction. Proof of fraud not necessary.

The injunction is sometimes directed generally to restrain the infringement of the plaintiff's trade marks to which his title is established in the case,<sup>3</sup> but it is usually expressed with more particularity, to restrain the use by the defendant of such trade marks, or of marks only colourably differing from them, in connection with goods of the kind for which they are registered, by selling or otherwise disposing of the goods marked with such marks. Sometimes the particular colourable infringement of which the defendant has been proved to have been guilty is expressly referred to in the order, a general restraint being added. And, in some cases, the form of injunction which seems more appropriate to the unspecialised action for "passing-off" is made use of also, the defendants being restrained from "in any other way passing off their goods as those of the plaintiff."<sup>4</sup> To avoid a discussion upon a motion to commit for an alleged breach of the injunction,<sup>5</sup> it is obviously advantageous for the plaintiff to combine in the order a particular reference to the form of the infringement which has actually been committed or threatened, with general words, as wide as are obtainable, directed to prevent a colourable evasion of the decree.<sup>6</sup> Form of injunction.<sup>6</sup>

As it is not an infringement to use the plaintiff's mark upon his own goods, that is, goods which possess the attribute connoted by the mark,<sup>7</sup> the injunction is commonly expressed so as to prevent this being a breach of its terms.<sup>8</sup>

<sup>1</sup> *Millington v. Fox*, 3 My. & Cr. 338 (1838), Cottenham, C.

<sup>2</sup> *Moet v. Conston*, 33 Beav. 578 (1864), Romilly, M.R.; *Edelsten v. Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, C.

<sup>3</sup> *The Bodega Co., Ltd. v. Riviere*, 6 R. P. C. 243 (1888), Chatterton, V.-C.; *Montgomery v. Thompson*, [1891] A. C. p. 218; 8 R. P. C. 361.

<sup>4</sup> *Sluzenger & Sons v. Feltham & Co.*, 6 R. P. C. 531 (1889), C. A.

<sup>5</sup> See, for instance, the question which arose in *Ripley v. Arthur*, 19 R. P. C. 443 (1902), where on a division of opinion between V. Williams and Stirling, L.JJ., the judgment of Farwell, J., dismissing a motion to commit was affirmed.

<sup>6</sup> See the forms of injunction collected in the Appendix, p. 730, and in Seton, 6th ed., Vol. I., 623. The Court will not in anticipation lay down a course of conduct for the defendant, *Kerfoot v. R. A. Cooper, Ltd.*, 25 R. P. C. 508 (1908), Eve, J., *Sweet Lips Cachous*.

<sup>7</sup> Chap. II., p. 33. And see *Condy v. Taylor*, 56 L. T. 891 (1887), Kekewich, J.

<sup>8</sup> Cf. the "passing-off" cases; *Siebert v. Fiadluter*, 7 C. D. 801; and *Braham v. Beachin*, 7 C. D. 848, both (1878), Fry, J. In *Palestine Wine and Trading Co., Ltd. v. Cohen*, 23 R. P. C. 568 (1906), Warrington, J., the defendants contended that the goods in question were goods sold by the plaintiffs, but it was held

And in cases where the infringement has been effected by the employment of a word, to the exclusive use of which the plaintiff has no title, the injunction should, it seems, be directed to restrain the defendant from using the word without clearly distinguishing his goods from those of the plaintiff, not to forbid his using it altogether.<sup>1</sup>

Injunction directed to future consignments of goods only.

In a case where the plaintiffs refrained from taking proceedings on learning that the defendants had received a small quantity of the infringing goods, but waited until they had got a larger consignment, Malins, V.-C., ordered the injunction to be directed to stop the sale of future consignments only.<sup>2</sup> It is submitted, however, with great deference, that the calculated conduct of the plaintiffs was not a sufficient reason for allowing the goods already received to be sold under the deceptive labels, although it might have been an answer to a claim for damages for past infringements. It has certainly been held that acquiescence, not sufficient to bar the plaintiff's right, may, in some classes of actions, cause the Court to refuse relief by injunction, and to grant the plaintiff damages only,<sup>3</sup> but the case last referred to did not involve any continuing fraud or deception.<sup>4</sup>

Injunction refused because of acquiescence.

Injunction limited to a particular market.

The injunction may also be limited with reference to the use of the mark in a particular country or market,<sup>5</sup> for instance, if it is calculated to deceive there only,<sup>6</sup> or in a particular manner, as

that there was a trick to sell as the plaintiffs' brandy something which was not in substance the plaintiffs' brandy, the defendant having diluted the same.

<sup>1</sup> *Sciro v. Proccente*, L. R. 1 Ch. 192 (1865), Wood, V.-C., and Cranworth, L.C.; *Johnston v. Orr-Ewing*, 13 C. D. 434; 7 App. Ca. 219 (1880), Fry, J., C. A. and H. L.; and see *Montgomery v. Thompson*, [1891] A. C. 217; 8 R. P. C. 361; and *Reddaway v. Banham*, [1896] A. C. 199; 13 R. P. C. 218; and also the special proviso to the injunction in *Bewlay v. Hughes*, 15 R. P. C. 290 (1898), North, J.

<sup>2</sup> *The Anglo-Swiss Condensed Milk Co. v. The Swiss Condensed Milk Co.*, W. N. (1871), 163.

<sup>3</sup> *Sayers v. Collyer*, 28 C. D. 193, per Fry, L.J. A case relating to a restrictive covenant in regard to buildings. In a passing-off action a delay of three and a half years was under the circumstances of the case held not to disentitle the

plaintiffs to an injunction: *Reddaway v. Stevenson*, 20 R. P. C. 276 (1903). Cf. *McCaw, Stevenson and Orr, Ltd. v. Lee*, 23 R. P. C. 1 (1906), Swinfen Eady, J. And below, p. 455.

<sup>4</sup> The action for infringement may wholly fail, because the defendant has used the plaintiff's mark so long that there is no longer any deception, as in *The Marquis of Londonderry v. Russell*, 2 Times L. R. 843; 3 Times L. R. 360 (1886), Bacon, V.-C. and C. A. Above, p. 426.

<sup>5</sup> *Carver v. Bowker*, Seb. Dig. p. 350. (1877), Little, V.-C.; *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L.J.; see *Société, &c. de l'Etoile's Tm.*, 10 R. P. C. 436; [1894] 1 Ch. 61, Stirling, J., and above, pp. 232 and 391.

<sup>6</sup> See *Wilkinson v. Griffith*, 8 R. P. C. 370 (1891), Romer, J., and above, p. 391. Cf. *Cowie v. Herbert*, 14 R. P. C. 436 (1897), Court of Sess.

by sending goods marked with it to English ports for shipment to the colonies.<sup>1</sup>

The plaintiff in an infringement or "passing-off" action usually moves, as soon as the action is commenced, for an interim injunction to restrain the defendant, until the hearing of the action or further order, from continuing or committing the infringement or deceptive conduct of which he complains, either getting leave to serve notice of motion with the writ,<sup>2</sup> or serving it after the defendant has appeared. In a plain case the motion is, in the first instance, sometimes made *ex parte* for an injunction until the day for which the notice of motion is given; and in a case where the defendant is committing a deliberate fraud, it is important, if possible, to obtain an *ex parte* order before giving him a notice which may lead to the disposal of any spurious goods which he is about to put upon the market.

Interlocutory application for an interim injunction.

Where the plaintiff's title is disputed, or the fact of infringement is doubtful, or misrepresentation amounting to a bar to the action, or some other defence is plausibly alleged upon the interlocutory motion, the Court, in granting or refusing the interim injunction, is guided principally by the balance of convenience, that is, by the relative amounts of damage which seem likely to result if the injunction is granted and the plaintiff ultimately fails, or if it is refused and he ultimately succeeds. Thus, in *Read v. Richardson*,<sup>3</sup> on the defendants undertaking to keep an account, Jessel, M.R., refused an interlocutory injunction; but the Court of Appeal granted it because, while the defendants had only recently commenced to use their mark, and their trade was admittedly not dependent on it, the plaintiffs had a large trade in connection with which they used the label alleged to be infringed, and their rights would have been irremediably and incalculably injured unless the injunction were granted, if their case should be established at the trial. In this action the defendants' mark had been registered as well as the plaintiffs', and the defendants asserted that the plaintiffs' action was barred

Balance of convenience.

<sup>1</sup> *Rodgers v. Rottgen*, 5 Times L. R. 678 (1889), Kay, J.

<sup>2</sup> Ord. 52, r. 9.

<sup>3</sup> 45 L. T. 51 (1881) (*Dog's Head Beer*). In *Evans v. Smith*, 3 Times L. R. 390 (1887), Kay, J., refused an interlocutory injunction because it was a serious question whether the plaintiff's

registered trade mark *Montserrat* was a "special and distinctive word." But *quære* whether sufficient weight was given to sec. 76 of the Act of 1883 in this case; see *Hommel v. Bauer*, 20 R. P. C. 801 (1903), Byrne, J., and above, p. 387, note (8).

because the plaintiffs had, before registration, printed the words "specially registered trade mark" upon their labels.<sup>1</sup>

As appears by the cases just cited, it is not necessary for the plaintiff, upon the interlocutory application, to give conclusive evidence as to his title to the mark. It is sufficient if he makes it appear probable that he will succeed at the hearing, at least in order to bring the question of balance of convenience before the Court, and where there is reason to doubt the good faith of the defendant, the Court is more easily induced to interfere.<sup>2</sup>

The interim injunction will not be granted if the plaintiff has delayed interfering until the defendant has built up a large trade in which he has notoriously used the mark,<sup>3</sup> or if the plaintiff has delayed for a considerable time after he knew of the matters complained of, unless the delay is explained.<sup>4</sup> And in a case in which the acts complained of had been going on for five years, and the plaintiffs failed to satisfy the Court that they did not know of them, an interlocutory injunction was refused.<sup>5</sup> But a slight use of the defendant's mark, chiefly upon sales to a few purchasers for their private use, will not prevent the Court from interfering in a case where the plaintiff's trade is considerable.<sup>6</sup>

Interim  
injunction  
refused on  
account of  
delay.

<sup>1</sup> As to this plea, see above, p. 437. Jessel, M.R., had refused the injunction on the ground of no apparent infringement. See also *Parker and Smith v. Satchwell*, 17 R. P. C. 713 (1900), where the Court of Appeal in a passing-off case granted an interlocutory injunction, which had been refused by Cozens-Hardy, J., on the ground of no probability of deception; a perpetual injunction was granted at the trial, 18 R. P. C. 299 (1901), Farwell, J. In *Alaska Packers' Association v. Crooks*, 16 R. P. C. 503, an interlocutory injunction granted on the balance of convenience by Kekewich, J., was discharged on special (arranged) terms. The plaintiffs failed at the trial, 18 R. P. C. 129 (1901).

<sup>2</sup> *Ratde v. Norman*, L. R. 14 Eq. 348 (1872), Wickens, V.-C.

<sup>3</sup> Above, pp. 421 and 424.

<sup>4</sup> *North British Rubber Co. v. Gormully Co.*, 12 R. P. C. 17 (1894), Chitty, J., a patent case. In *Army and Navy Co-operative Society, Ltd. v. Army, Navy and Civil Service Co-operative Society of South Africa, Ltd.*, 19 R. P. C. 574

(1902), Buckley, J., a trade name case, a delay of three months after the plaintiffs became aware of the incorporation of the defendant company was held to be sufficiently explained.

<sup>5</sup> *Yost Typewriter Co., Ltd. v. Typewriter Exchange Co.*, 19 R. P. C. 422 (1902), Buckley, J. In *Van Oppen & Co., Ltd. v. L. Van Oppen*, 20 R. P. C. 617 (1903), Swinfen Eady, J., the plaintiffs failed to get an interlocutory injunction as to part of the relief claimed, there having been a protest on their part some two years before, without result. See also *Royal Warrant Holders' Association v. Slade & Co., Ltd.*, 25 R. P. C. 245 (1908), Swinfen Eady, J.

<sup>6</sup> *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478; 4 T. L. R. 9 (1887), Chitty, J., and C. A. *Apollinis*, used in Germany from 1876, and in England from 1881. *Derby Photographic Dry Plate Co., Ltd. v. Pollard*, 2 Times L. R. 276 (1886), Bacon, V.-C.; *Isaacson v. Thompson*, 41 L. J. Ch. 101 (1871), Bacon, V.-C.

If the plaintiff intends to ask for an interim injunction he ought to apply for it as soon as possible after commencing proceedings.<sup>1</sup>

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

The interim injunction, being intended only to preserve the plaintiff's rights from serious detriment until the hearing, is, at any rate in cases which appear to be doubtful or honestly disputed, limited as closely as possible to what is sufficient to attain that end.<sup>2</sup> It is only granted upon the plaintiff undertaking to be responsible in damages for the loss (if any) occasioned by it to the defendant, should it turn out at the hearing that it ought not to have been granted.<sup>3</sup> Interim injunction limited as closely as possible ;  
only granted on undertaking as to damages.

A common form of interlocutory injunction is to restrain a wharfinger or consignee from passing into the market goods alleged to bear spurious marks until the trial or further order.<sup>4</sup>

A large proportion of the seriously contested trade mark cases commence with cross motions for an interim injunction, and to expunge or vary the plaintiff's registered mark. The question in what cases it is open to a defendant, without such a motion to expunge or vary to dispute the validity of the plaintiff's registration has been discussed elsewhere,<sup>5</sup> but it would seem that on an application for an interlocutory injunction, the validity cannot as a rule be so disputed.<sup>6</sup> Cross motions for injunction and to expunge.

<sup>1</sup> *Knowles v. Bennett*, 12 R. P. C. 137 (1894), Robinson, V.-C., a designs case.

<sup>2</sup> See *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478; 4 T. L. R. 9 (1887), Chitty, J., and C. A.; and *Alaska Packers' Association v. Crooks*, above, p. 446, note (1).

<sup>3</sup> Whenever an undertaking to the Court is given in lieu of an interlocutory injunction there is inserted in the order a cross-undertaking in damages by the applicant unless the contrary is agreed and expressed at the time, Resolution of Chancery Judges (1904), W. N. pp. 203, 208, and see *Oberrheinische Metallwerke v. Cocks* (1906), W. N. 127. The Court of Appeal had previously held that there was no general practice under which such a cross-undertaking was implied, *Howard v. Press Printers, Ltd.* (1904), W. N. 198. As to the calculation of the damages covered by the undertaking,

see *Mansell v. The British Linen Co. Bank*, [1892] 3 Ch. 159. Under special circumstances the defendant may be left to move specially to enforce the undertaking: *J. & J. Cash, Ltd. v. Cash*, 18 R. P. C. 213 (1901), Kekewich, J., where the final order was narrower than the interlocutory order, the terms of the perpetual injunction being modified on appeal, 19 R. P. C. 181 (1902).

<sup>4</sup> *Rivero v. Norris* (1868), Seb. Dig. p. 178; Seton, 5th ed., p. 536, Giffard, V.-C.; *Del Valle v. Mayer* (1870), Seb. Dig. p. 195; Seton, *ibid.*, James, V.-C.

<sup>5</sup> Above, pp. 325 and 386. *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478; 4 T. L. R. 9 (1887), Chitty, J., and C. A.; *Reed v. Richardson*, 45 L. T. 54, cited p. 445.

<sup>6</sup> *Hommel v. Bauer*, 20 R. P. C. 801 (1903), Byrne, J., but see *Evans v. Smith*, 3 T. L. R. 390 (1887), Kay, J.

In a case where the defendant claimed a right to the mark in question, and had applied to register it himself, an interlocutory motion for an injunction by the plaintiff was ordered to stand over pending the result of the application.<sup>1</sup>

Undertaking  
to keep an  
account.

And sometimes, where there is a substantial case to be tried, the application for an interim injunction is ordered to stand over to the hearing upon the defendant undertaking to keep an account of his sales under the mark objected to.<sup>2</sup>

Enforcement  
of the injunc-  
tion

Breaches of the injunction are contempts of Court, which may be punished by the committal or attachment<sup>3</sup> of the guilty person, or by ordering him to pay a fine or costs. "Committal was the proper remedy for doing a prohibited act, and attachment the proper remedy for neglecting to do some act ordered to be done," but there is now no substantial difference between the two.<sup>4</sup> The course usually adopted is to move to commit, the notice of motion being personally served upon the respondent, or if this is impracticable, leave for substituted service being obtained.<sup>5</sup>

The order granting the injunction should be forthwith drawn up and served upon the defendant, but no formal service or notice of it is necessary to enable the Court to enforce it. It is sufficient to subject him to the risk of committal, if he infringes it, that the defendant or other respondent is shown to have been in fact aware of the order for the injunction having been granted or made,<sup>6</sup> although, as a general rule, a person intending to ask the Court to enforce an order by committal or attachment should proceed strictly.<sup>7</sup>

Where an injunction is granted in general terms, and the defendant is not doing the specific thing on which the judgment was founded, or the injunction having been obtained on default, no specific thing has been admitted or found to be an infringement, the plaintiff may, when moving to commit, be in some difficulty,

<sup>1</sup> *Edwards v. Elkan*, 5 R. P. C. 70 (1887), Stirling, J.

<sup>2</sup> *Mitchell v. Henry*, 15 C. D. 181 (1880), C. A.; *Apollinaris Co. v. Snook*, 7 R. P. C. 474 (1890), North, J.

<sup>3</sup> Ord. 42, r. 7, or in the case of a corporation, by sequestration of its property or attachment of its officers, Ord. 42, r. 31.

<sup>4</sup> *Callow v. Young*, 56 L. T. 147; *Harvey v. Harvey*, 26 C. D. p. 654; *Evans v. Noton*, [1893] 1 Ch. 252. The

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

<sup>5</sup> See the notes to Ord. 44, r. 1, in the Annual Practice.

<sup>6</sup> *Marcovitch v. Bramble, Wilkins & Co.*, Seb. Dig. p. 363 (1878), Malins, V.-C. Annual Practice note to Ord. 42, r. 7; and see *United Telephone Co. v. Dale*, 25 C. D. 778.

<sup>7</sup> *Incandescent Gas Light Co. v. Riemer*, 17 R. P. C. 378 (1900), C. A.

for in a case in which a mere comparison of the two marks or things does not show that the defendant is committing a breach of the injunction, it is necessary for the plaintiff to prove by evidence that there is probability of deception.<sup>1</sup>

The principal question upon an application to commit for breach of an injunction restraining the infringement of a trade mark is, generally: Does the new mark of the defendant constitute an infringement or not? And it may be assumed that if the Court is satisfied that the defendant has honestly tried to select a mark which is not objectionable, having regard to its order, it will be unwilling to send him to prison because he has failed in his endeavour. But the Court has jurisdiction to commit for disobedience to an order which is not shown to have been wilful.<sup>2</sup> If the defendant is in the wrong, even though by mistake or misfortune, he is usually ordered to pay the costs of the motion.<sup>3</sup> A mere servant of the defendant should not be joined as respondent to a motion to commit.<sup>3</sup>

Unintentional breach of the injunction.

It may be safely assumed also that in the case suggested above the Court will be careful not to compel an honest trader to alter his mark more than is necessary to protect the plaintiff's rights. But the following passage from Lord Romilly's judgment in *Bass v. Dawber*,<sup>4</sup> goes, perhaps, too far, for the plaintiff is entitled to have the full extent of his right secured to him, without reference to the loss which it occasions to the defendant. "If a person has *bonâ fide* taken a label or trade mark which does resemble the label of another person, and this is not done with the intention to deceive, the Court will not require him to change it completely, because the change of a trade mark is a serious thing. . . . It is like beginning a new firm."

Choice of a new mark by the defendant.

In a case where the plaintiff refused to take any notice of a label which the defendant suggested and proposed to adopt in lieu of the label against the use of which the injunction was

<sup>1</sup> *Ripley v. Arthur*, 19 R. P. C. 443 (1902), Farwell, J., and C. A., a passing-off case. "An admission by default in pleading never admits anything beyond what is necessary to carry the judgment." Per Vaughan Williams, L.J., at p. 448.

<sup>2</sup> *Hewitt v. Mansell*, 29 Sol. J. 66. In *Parker Manufacturing Co. v. Cooper*, 18 R. P. C. 319 (1901), Cozens-Hardy, J.,

refused to commit the defendant for an isolated instance of passing-off by the defendant's son without the defendant's knowledge; no order was made as to costs.

<sup>3</sup> *Daniel and Arter v. Whitehouse*, 16 R. P. C. 71 (1899), North, J. See note (2).

<sup>4</sup> 19 L. T. N. S. 626 (1869), Seb. Dig. p. 186.

granted, Langdale, M.R., himself undertook to determine whether the distinction between the labels was sufficient.<sup>1</sup>

Delay in application to commit.

If the plaintiff delays taking steps to enforce the injunction for a considerable time after he knows of the fresh infringement, the delay may cause the Court to refuse to commit; but if the infringement is continuing, it has been said that "there must—in order to deprive the party who has obtained the injunction of the right to move for committal upon the breach of it—be a case made out almost amounting to such a licence to the party enjoined, to do the act enjoined against, as would enable him to maintain a bill against others for doing the act. The party enjoined must, I think, show such acquiescence as would be sufficient to create a new right in him."<sup>2</sup> In the case just quoted, the injunction was granted in 1847, the new infringement began in 1848, and was continued until the motion to commit in 1853. The Lords Justices, however, were not satisfied that the plaintiffs were aware of it. Stuart, V.-C., refused the motion on the ground of the delay, but the Lords Justices directed that the defendant should be committed unless, within a week, he suggested, and undertook to use for the future, a mark which the Court should consider satisfactory, and they ordered that he should pay the costs of the motion.

In *Cartier v. May*,<sup>3</sup> where the plaintiff delayed moving for fifteen months after the defendant had commenced a new infringement not expressly covered by the injunction, Wood, V.-C., refused to commit the defendant, but ordered him to pay the costs of the application, and enlarged the injunction so as to make it extend to the new fraud.

### (ii.) Delivery up of the marked articles.

Erasure of the spurious marks.

The Court not only forbids further infringement by its injunction, but, where the defendant is proved to have spuriously marked articles in his possession or under his control, it also orders the erasure of the marks,<sup>4</sup> or the delivery up of the marked

<sup>1</sup> *Croft v. Day*, 28 Leg. Obs. 378; Seb. Dig. p. 39 (1844), on a motion to commit. The French Courts, apparently, will order affirmatively what the defendant is to do: see *Grezier v. Autran*, 13 R. P. C. at p. 10; see also *Rodgers v. Nowill*, note (2); and p. 443, note (6).

<sup>2</sup> Per Turner, L.J., in *Rodgers v.*

*Nowill*, 13 De G. M. & G. 614; 22 L. J. Ch. 404 (1853).

<sup>3</sup> Seb. Dig. p. 111 (1861).

<sup>4</sup> *Dent v. Turpin*, 2 J. & H. 139; 30 L. J. Ch. 495 (1861), Wood, V.-C.; *Upmann v. Elkan*, L. R. 12 Eq. 140; 7 Ch. 130, Romilly, M.R., and Hatherley, L.C., p. 451, note (5) below.



articles for that purpose, or, if erasure is impracticable, for destruction.<sup>1</sup> Thus, in *Slazenger v. Feltham*,<sup>2</sup> where the word *Demotic*, an infringement of the plaintiffs' mark *Demon*, was stamped upon the defendants' tennis racquets, the order of Kekewich, J., for the destruction of the racquets, was varied by the Court of Appeal, upon it being pointed out that the spurious mark could be planed off; and it was ordered that the defendants should make an affidavit verifying the number of the racquets, and that they should either deliver up the racquets to the plaintiffs, to be destroyed, or satisfactorily erase from them the name *Demotic*, in the presence of the plaintiffs or their agent.

A plaintiff may lose his right to delivery up if he unduly delays the commencement of his action.<sup>3</sup> Delay.

The lien of a wharfinger for his charges in regard to goods deposited with him, including the costs he is put to by being made a defendant in a trade mark action, is not destroyed if the goods turn out to be spuriously marked;<sup>4</sup> and although, in some earlier cases,<sup>5</sup> the plaintiff was adjudged to have a lien upon the goods, subject to that of any wharfinger or mortgagee who had an earlier charge, and who was innocent in regard to the infringement, the Court of Appeal, in the case last cited,<sup>4</sup> expressed considerable doubt whether such a lien could be supported. Of course, neither the wharfingers nor any other persons interested in the goods would be allowed to sell or dispose of the goods until the spurious marks were removed.

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

A wharfinger, transport agent, or other bailee who finds that goods committed to his charge are spuriously marked, therefore,

The duty of the bailee of infringing goods.

<sup>1</sup> *Farina v. Silverlock*, 4 K. & J. 650 (1858), Wood, V.-C. The repealed Merchandise Marks Act of 1862, s. 21, empowered the Court to direct any chattel to which any trade mark had been fraudulently applied, or which had been exposed for sale with a forged or counterfeited trade mark applied to it, to be destroyed or otherwise disposed of. The Act of 1887 empowers it to forfeit every chattel by means of, or in relation to which, an offence under the Act has been committed, to her Majesty, and it contains a power for the Court to order the destruction of the forfeited articles; sec. 2 (3), (4); Appendix, p. 806. In *Maréchal and Ruchon v. M'Colgan*, 18 R. P. C. 262 (1901), Chatterton, V.-C.,

Ireland, the stamp was ordered to be delivered up.

<sup>2</sup> 6 R. P. C. 531; 5 T. L. R. 365 (1889), Kekewich, J., and C. A.

<sup>3</sup> *County Chemical Co., Ltd. v. Frankenburg*, 21 R. P. C. 722 (1904), Ld. Alverstone, L.C.J., five months' delay before complaint, the boxes complained of being capable of being used in ways not a breach of the injunction.

<sup>4</sup> *Moct v. Pickering*, 6 C. D. 770; 8 C. D. 372 (1877), C. A., reversing Fry, J.

<sup>5</sup> *Ponsardin v. Peto*, 33 Beav. 642; 33 L. J. Ch. 371 (1863), Romilly, M.R.; *Upmann v. Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. 130 (1871), Romilly, M.R., and Hatherley, C.

is justified in refusing to deliver them up until the objectionable marks have been erased.<sup>1</sup> And, further, he is entitled to an indemnity from the bailor against the damages and costs incurred by him by reason of his dealing with the goods at the latter's request.<sup>2</sup> His proper course, on being informed by the owner of the trade mark infringed, or his agents, that goods in his possession are spuriously marked, is to give all necessary information to enable them to stop the infringement, to undertake that the goods shall not be removed or dealt with until the spurious marks have been obliterated, and to give the persons injured all requisite facilities for that purpose.<sup>3</sup> If he takes this course, the costs of any proceedings subsequently taken against him by the plaintiff will be ordered to be paid to him;<sup>4</sup> but he must pay the costs of proceedings previously taken, even though in an action commenced without notice to him,<sup>5</sup> unless the value of the infringing goods in his possession is trifling.<sup>6</sup>

### (iii.) Damages or Profits.

Nominal  
damages.

It was long ago decided at common law, that the mere proof of an infringement entitles the plaintiff to nominal damages,<sup>7</sup> and that, consequently, no allegation of special damage is a necessary part of his case.<sup>8</sup> And the natural consequence of an infringement, even though it be made in complete ignorance of the plaintiff's rights, is that the infringer must pay at least nominal damages, and the costs of action, so that, if he acted under the direction of a third person, he may reasonably compound with the proprietor of the trade mark on these terms, and claim an indemnity from his employer.<sup>9</sup>

Indemnity to  
agent or  
purchaser

<sup>1</sup> *Hunt v. Muniere*, 34 Beav. 157; 34 L. J. Ch. 142 (1864), Romilly, M.R., and L.J.J. Action by indorsee of dock warrants against wharfingers restrained. In *Knowles v. Bennett*, 12 R. P. C. 137 (1894), Robinson, V.-C., shipowners were restrained from parting with the goods except to the plaintiffs.

<sup>2</sup> *Dixon v. Fawcus*, 3 E. & E. 537; 30 L. J. Q. B. 137 (1861).

<sup>3</sup> *Upmann v. Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. 130 (1871), Romilly, M.R., and Latherley, C.

<sup>4</sup> Last case, and *Moet v. Pickering*, 6 C. D. 770; 8 C. D. 372 (1877), Fry, J., and C. A.

<sup>5</sup> See last cases, and *Upmann v.*

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

<sup>6</sup> *American Tobacco Co. v. Guest*, [1892] 1 Ch. 630; 9 R. P. C. 218, Stirling, J.

<sup>7</sup> *Blofeld v. Payne*, 4 B. & Ad. 410; 2 L. J. K. B. (N. S.) 68 (1833). In *Daniel v. Whitehouse*, 15 R. P. C. 134 (1898), Gorell Barnes, J., 40s. damages were given.

<sup>8</sup> *Rodgers v. Nowill*, 5 C. B. 109; 17 L. J. C. P. 52 (1847). See also *Reddaway v. Bentham Hemp Spinning Co.*, [1892] 2 Q. B. 639; 9 R. P. C. 503.

<sup>9</sup> *Dixon v. Fawcus*, 3 E. & E. 537; 30 L. J. Q. B. 137 (1861). As to implied warranty by the use of a trade mark, see below, Chap. XVII., p. 552. As to third

But, if the plaintiff claims substantial damages, the onus of showing what loss he has actually sustained by reason of the defendant's conduct, lies upon him; and it will not be presumed, in the absence of evidence, that the amount of goods sold by the defendant under the infringing trade mark would, but for the defendant's unlawful use of the plaintiff's mark, have been sold by the plaintiff.<sup>1</sup> The proper form of an order for an inquiry as to damages occasioned by the infringement of a trade mark is, therefore, what damage (if any) has the plaintiff sustained.<sup>2</sup>

Onus of showing substantial damage lies on the plaintiff.

In general, the only injury which is done by an infringement is that the defendant's goods are sold instead of those of the plaintiff, and the sale of the latter is, in some degree, diminished in consequence. But it may, under exceptional circumstances, appear that further damage has been done, for instance, where the spurious goods are so inferior to the genuine as to injure the trade reputation of the plaintiff,<sup>3</sup> or where the stress of the competition compels the plaintiff to lower his prices in order to avoid being driven from the market, and the reduction does not, as it may, bring him a sufficient increase of business to make up for the loss of profit on each article sold.<sup>4</sup>

The case of *Alexander v. Henry*<sup>4</sup> is an example of such excep-

party notice claiming an indemnity, see *Hennessy v. Dompé*, 19 R. P. C. 333 (1902).

<sup>1</sup> *Leather Cloth Co. v. Hirschfeld*, L. R. 1 Eq. 299 (1865), Wood, V.-C.; *Magnolia Metal Co. v. Atlas Metal Co.*, 14 R. P. C. 389 (1896), Collins, J., and C. A. (a passing-off case). If there is a demand which remains unsatisfied after the infringing goods have been sold, it may be inferred that genuine goods would have been sold in place of all the latter: *Alexander v. Henry*, 12 R. P. C. 360 (1895), Kekewich, J. In the United States there appears to be a question whether any recognised rule of law exists on the point or not. Mr. Cox says (p. 198): "There is a conflict between the cases as to the proper measure of damage for the infringement of a trade mark. It has been held in many instances that the profits of the defendant is the true measure, and in others that it is the profits which would have been realised by the plaintiff had he sold the quantity of goods shown to have been sold by the defendant. Perhaps the most authorita-

tive decision on the subject is *Faber v. Hovey* (Codd. Dig. 79, 23 (1875)), decided by the General Term of the Supreme Court of New York, and affirmed on appeal by a divided Court, in which the latter rule was applied, although the mark involved was of a strictly technical nature." As is stated in the text, the plaintiff in England has usually the option of taking the defendant's profits in lieu of damages.

<sup>2</sup> *Davenport v. Rylands*, L. R. 1 Eq. p. 308, per Wood, V.-C.

<sup>3</sup> *Sykes v. Sykes*, 3 B. & Cr. 541; 3 L. J. K. B. (O. S.) 46 (1824).

<sup>4</sup> See the patent cases: *American Wire Co. v. Thomson*, 44 C. D. 274; 7 R. P. C. 152 (1890), C. A.; and *United Horseshoe Co. v. Stewart*, 13 App. Ca. 401; 5 R. P. C. 260 (1888), both discussed in *Alexander v. Henry*, 12 R. P. C. 360 (1895), Kekewich, J., *British Motor Syndicate v. Taylor*, 17 R. P. C. 189, 723 (1900); and *Leeds Forge Co., Ltd. v. Deighton's Patent Flue and Tube Co., Ltd.*, 25 R. P. C. 209 (1908), Swinfen Eady, J.

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

If the infringement is a continuing one, the damages ought to be assessed down to the time of the assessment.<sup>2</sup>

Damages or profits.

The plaintiff may, in general, make his choice of either an account and payment to him of the profits which the defendant has gained by his wrongful conduct, or an inquiry as to, and payment of, the damages occasioned to the plaintiff by reason of it,<sup>3</sup> that is, unless the case is tried before a jury and damages are assessed by the jury at once, or assessed by the judge sitting alone, acting as a jury.

Account of profits and damages are alternative.

The account and inquiry are alternative remedies,<sup>4</sup> for though in some of the earlier cases they were both allowed, they are now considered to be inconsistent. "If you take an account of profits, you condone the infringement," Lord Westbury said, in a patent case,<sup>5</sup> and the same rule applies in trade mark cases also.

Account or inquiry only granted if substantial damage is shown.

But neither an account nor an inquiry as to damages will be granted if the evidence of sales under the objectionable mark is not sufficient to make it worth while,<sup>6</sup> or if it appears that the

<sup>1</sup> This appears to be the meaning of paragraph 3 of the referee's report.

<sup>2</sup> Ord. 36, r. 58.

<sup>3</sup> *Weingarten v. Bayer*, 22 R. P. C. 341 (1905), H. of L., a passing-off case, in which Vaughan Williams and Cozens-Hardy, L.JJ., had intimated that if they had considered the plaintiff entitled to any relief, damages and not an account of profits ought to be given. In the House of Lords the plaintiff partially succeeded, and an account of profits was ordered. See also *Edelsten v. Edelsten*, 1 De G. J.

& S. 185 (1863); *Lerer v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A.; *Sachner v. Apollinaris Co.*, 14 R. P. C. 645; cf. *Hodgson v. Kynoch*, 15 R. P. C. 465 (1898), Romer, J.

<sup>4</sup> Per Cotton, L.J., in *Lerer v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887).

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

<sup>6</sup> *Sanitas Co., Ltd. v. Condy*, 4 R. P. C. 530 (1887), Kekewich, J.; neither was

defendant has only used his mark for a short time.<sup>1</sup> For instance, no account or damages was allowed or given in a case where the only infringement proved was by the defendant, at the request of a customer, filling with lime-juice of his own make, a bottle embossed with the plaintiff's mark, removing the plaintiff's label, and replacing it by his own.<sup>2</sup>

Damages can only be recovered, and the profits to be included in the account can only be reckoned, in respect of infringements occurring within six years from the issue of the writ,<sup>3</sup> subject to the exception in the case of concealed fraud, which is part of the general law.

It has been shown that it is no answer to the claim for an injunction that the infringement was effected innocently, in ignorance of the existence of trade mark rights; but damages or an account of profits are only calculated as against an innocent dealer in, or purchaser of, the spuriously marked goods, in respect of sales, dealings, or other infringements, if any, of which he is guilty after becoming aware of the plaintiff's rights.<sup>4</sup> In a case in which at the most there were only proved one or two inadvertent sales by servants of goods under the plaintiff's special trade name for his goods, and this contrary to the defendant's orders, the Inner House in Scotland held the plaintiff to be entitled to no relief, reversing the Lord Ordinary, who had granted an interdict with a small sum for damages.<sup>5</sup>

The case of a manufacturer who copies a mark he finds on goods which he knows are not his own is different. He may not know whose mark it is, and may possibly be in doubt whether it is a trade mark or not, but he knows that he has no right to the mark, and the damages or account are therefore calculated as against him from the first infringement, within six years of the writ.<sup>6</sup>

The Court has refused, in some cases, to order an account of profits where the plaintiff has neglected to take proceedings after

They only go back for six years;

and, as against innocent purchasers or bailees, only to notice of infringement.

Refused because of delay or acquiescence.

granted in *Magnolia Co. v. Atlas Co.*, 14 R. P. C. 389 (1896), Collins, J., and C. A., although the plaintiffs obtained an injunction.

<sup>1</sup> *McAndrew v. Bassett*, 10 Jur. (N. S.) 495 (1864), Westbury, C.

<sup>2</sup> *Rose v. Loftus*, 47 L. J. Ch. 576 (1878), Malins, V.-C.

<sup>3</sup> Per Mellish, L.J., in *Ford v. Foster*, L. R. 7 Ch. p. 633 (1872).

<sup>4</sup> *Edelsten v. Edelsten*, 1 De G. J. & S.

185; 10 L. T. (N. S.) 780 (1863), Westbury, L.C.; *Moet v. Couston*, 33 Beav. 578; 10 L. T. (N. S.) 395 (1864), Romilly, M.R.; *Ellen v. Slack*, 24 Sol. J. 290 (1880), Jessel, M.R.

<sup>5</sup> *Montgomerie v. Young*, 21 R. P. C. 285 (1904).

<sup>6</sup> *Moet v. Couston*, supra; *Cartier v. Carlile*, 31 Beav. 292; 8 Jur. (N. S.) 183 (1862), Romilly, M.R.

becoming aware of the infringement;<sup>1</sup> and it may be assumed that it certainly would not assist the plaintiff to recover profits which he had deliberately allowed the defendant to earn in the expectation of obtaining them from him.<sup>2</sup> And damages have also been refused on the ground of delay.<sup>3</sup> But delay in order to obtain evidence necessary to establish his case would not bar the plaintiff of his ordinary remedy,<sup>4</sup> nor, it is submitted, would any reasonable delay in the hope of avoiding litigation after a definite warning to the defendant.

Limited because of misrepresentation.

In a case where there had been some delay, and some amount of misrepresentation in his business on the plaintiff's part, and the defendant's proper trade was larger than that of the plaintiff's, the account was limited to profits earned since the commencement of the suit, and Mellish, L.J., said that it was a case where a jury would have given forty shillings damages only.<sup>5</sup>

Form of order for account.

The ordinary form of the order for an account directs an account of the profits made by the defendant in selling or otherwise disposing of the goods bearing the spurious mark or marks to be taken by the master or the official referee, and orders payment of the amount found to be made by the defendant to the plaintiff within a time fixed from the date of the certificate or report.<sup>6</sup>

In the case of *Lever v. Goodwin*,<sup>6</sup> it was objected that the account should be limited to sales made to persons who bought the goods as and for the goods of the plaintiff, by reason of the use of the infringing mark upon them. The Court overruled this objection.<sup>7</sup> They said that the mischief done by the spurious marking of the goods is not merely that it is calculated to deceive immediate purchasers from the infringers, but that it puts "a weapon calculated to be fraudulently used by the middlemen"<sup>8</sup> into their

<sup>1</sup> *Harrison v. Taylor*, 11 Jur. (N. S.) 408; 12 L. T. (N. S.) 339; *Beard v. Turner*, 13 L. T. (N. S.) 746, both (1865), Wood, V.-C.

<sup>2</sup> Cf. *Anglo-Swiss Condensed Milk Co. v. Swiss Condensed Milk Co.* (1871), W. N. 163, Malins, V.-C., cited above, p. 444; *Beard v. Turner*, supra, and see *Crossley v. Derby Gas Light Co.*, 1 Webster's P. C. 119, a patent case.

<sup>3</sup> *Reddaway v. Stevenson*, 20 R. P. C. 276 (1903), Hall, V.-C., three years' delay before action.

<sup>4</sup> See *Cure v. Myers* (1868), Seb. Dig.

p. 181, Giffard, V.-C.; *Lee v. Haley*, 21 L. T. (N. S.) 546; L. R. 5 Ch. 155 (1869), Malins, V.-C., and Giffard, L.J., and *Crossley v. Derby Gas Light Co.*, note (2).

<sup>5</sup> *Ford v. Foster*, L. R. 7 Ch. p. 633 (1872), L.JJ.

<sup>6</sup> *Weingarten v. Bayer*, 22 R. P. C. 341 (1905), H. of L.; *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A.; Appendix, p. 733.

<sup>7</sup> See also *Edelsten v. Edelsten*, 1 De G. J. & S. 185; 10 L. T. (N. S.) 789 (1863), Westbury, L.C.

<sup>8</sup> Per Cotton, L.J., in *Lever v. Goodwin*.

hands, by which they may, intentionally or not, deceive the ultimate purchasers. In a subsequent case Kekewich, J., made an order in the same form notwithstanding that he did not believe that there had been a single sale of the defendant's goods as those of the plaintiff, and notwithstanding that the goods had been fairly competing.<sup>1</sup>

The costs of the inquiry as to damages or the account of profits, should generally be reserved until the result of the inquiry or account is known,<sup>2</sup> at any rate, unless it is clear that it will be of substantial value to the plaintiff; for if no damages or profits are found to have been incurred or made,<sup>3</sup> or if the proceedings subsequent to the judgment are oppressively conducted by the plaintiff, he ought to pay the costs. But where the defendant had filed a false affidavit greatly understating the number of goods sold, although the account showed that he had made no profit, Chitty, J., said it was a case for investigation, and allowed the plaintiff the costs.<sup>4</sup>

Costs of inquiry or account.

Where at the trial the defendant offers a sum as damages, but the plaintiff elects to take an inquiry, the offer will, at the defendant's request, be recited in the order.<sup>5</sup>

Recital in order of offer.

The plaintiff is entitled to the ordinary inquiry as to damages, or account of profits made by the defendant by the use of the infringing mark, although the plaintiff is not the sole owner of the mark. If he elects to have an account of profits, however, he can only claim payment of such proportionate share of the profits as may be found to be appropriable to his interest in the mark.<sup>6</sup> It is submitted that this is so, notwithstanding the language of the proviso to sec. 39, which (*inter alia*) enacts that where two or more persons are registered proprietors of the same

Account where plaintiff not sole owner.

<sup>1</sup> *Saxelner v. Apollinaris Co.*, [1897] 1 Ch. 893; 14 R. P. C. 645.

<sup>2</sup> *Ter Fry, J.*, in *Stark v. Midland Rail. Co.*, 16 C. D. 81 (1880), a case of nuisance.

<sup>3</sup> *Tonge v. Ward*, 21 L. T. (N. S.) 480 (1869), Romilly, M.R.

<sup>4</sup> *Dicks v. Jackson*, March 31st, 1884, cited Sebastian, 3rd ed., p. 255, 4th ed., p. 231.

<sup>5</sup> *Iron-Ox Remedy Co., Ltd. v. Leeds Industrial Co-operative Society, Ltd.*, 24 R. P. C. 434 (1907), Parker, J.

<sup>6</sup> In *Dent v. Turpin*, 2 J. & H. 139 (1861), Wood, V.-C., which is sub-

stantially the only authority on the matter, both of the two owners of the mark had filed bills asking, in each case, for payment of so much of the profits made by the defendant as the plaintiff was entitled to. The Vice-Chancellor said the fact that both owners were suing avoided the difficulty in regard to the account. In *Southorn v. Reynolds*, 12 L. T. (N. S.) 75 (1865), the same Vice-Chancellor followed his previous decision, but the order as to payment (if any) is not reported. In the latter case, contrary to the modern rule, the inquiry and the account were both ordered.

(or substantially the same) trade mark in respect of the same goods each of such persons shall otherwise (*i.e.*, except as against one another) have the same rights as if he were the sole registered proprietor thereof. The defendant is, it seems, entitled to have all the co-owners of the mark made parties, before the account is taken, in order that they may be bound by it, and that it may be taken once for all.<sup>1</sup>

### 7. Costs.

Costs in the discretion of the judge.

Subject to sec. 46 of the Act, which is referred to below, the costs of and incident to an action for the infringement of a trade mark, as the costs in any other action, are in the discretion of the Court or judge, and the Court or judge has full power to determine by whom and to what extent such costs shall be paid.<sup>2</sup> Provided that where the action is tried with a jury, the costs follow the event, unless the judge by whom it is tried, or the Court, for good cause, otherwise orders.<sup>3</sup>

Unsuccessful party usually ordered to pay costs.

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

Infringer must offer

An unsuccessful defendant must usually pay costs, although he has only defended a mark which he honestly adopted without being aware of its too great resemblance to the plaintiff's mark,<sup>4</sup> and though he has acted without fraud and in ignorance of the plaintiff's rights,<sup>5</sup> and the action has been commenced against him without notice.<sup>6</sup> But by offering the plaintiff all that he is

<sup>1</sup> See the patent cases, *Bergman v. Macmillan*, 17 C. D. 423 (1881), Fry, J.; and *Vau Gelder v. Sowerby Society*, 44 C. D. 374; 7 R. P. C. 208 (1890), C. A., see per Cotton, L.J., 44 C. D. p. 392. The defendant cannot, as appears from the last case, object to judgment on the ground of want of parties, but can apply to have the owners who are not plaintiffs added (as plaintiffs or defendants) for the purposes of the account after judgment. See Ord. 16, r. 11, in the Annual Practice.

<sup>2</sup> Supreme Court of Judicature Act, 1890, s. 5.

<sup>3</sup> Ord. 65, r. 1.

<sup>4</sup> *Blair v. Stock*, 52 L. T. 123 (1884), Kay, J.; cf. the registration cases, *Hyde & Co.'s Tm.*, 7 C. D. 724; *Kahn & Co.'s Tm.*, 53 L. J. Ch. 238, n., both (1878), Jessel, M.R.

<sup>5</sup> *Edelsten v. Edelsten*, 1 De G. J. & S. 185; 10 L. T. (N. S.) 780 (1863), Westbury, L.C.; *Tonge v. Ward*, 21 L. T. (N. S.) 480 (1869), Romilly, M.R.

<sup>6</sup> *Field v. Lewis*, Seb. Dig. p. 167 (1867), Wood, V.-C.; *Upmanu v. Forester*, 24 C. D. 231 (1883), Chitty, J. See *Waingarten v. Bayer*, 22 R. P. C. 341, at p. 350 (1905), Ld. Macnaghten.



entitled to,—that is, in the case of the innocent holder<sup>1</sup> of spuriously marked goods, an undertaking<sup>2</sup> not to part with them until the spurious marks have been removed,<sup>3</sup> and all requisite information to enable the plaintiff to stop the infringement<sup>4</sup> and the payment of the taxed costs<sup>5</sup> (if any) already incurred by him in the action, if an action has been commenced,—the defendant may escape liability for subsequent costs.<sup>6</sup> If the plaintiff, after such an offer has been made, commences or continues proceedings against the defendant making it, he will be ordered to pay him his costs subsequently incurred.<sup>7</sup> In a case where, as it turned out, the plaintiff was entitled to an injunction only, and his right to this was admitted on the second day of the trial, he was given costs up to that time, and was ordered to pay the subsequent costs.<sup>8</sup>

complete redress before action.

and will then get subsequent costs.

Where an action was brought for infringement of trade mark by the use of a label and to restrain passing off, the act complained of being the use of the same label, and the defendants

<sup>1</sup> In a case of fraud, the plaintiff may, notwithstanding that the defendant has made a full offer to submit, be allowed the whole costs although he proceeds to trial. *Jameson & Son, Ltd. v. Clarke*, 19 R. P. C. 255 (1902), Chatterton, V.-C., Ireland.

<sup>2</sup> The plaintiff is not bound to accept an undertaking in the case of an infringer with notice, or where there is reasonable risk that it will be necessary to take steps to enforce it. In such a case the plaintiff will usually be allowed the costs of a motion for judgment. *Gandy Bell Manufacturing Co., Ltd. v. Fleming, Kirkby and Goodall, Ltd.*, 18 R. P. C. 276 (1901), Byrne, J.; but at all events the defendant must pay the costs of the plaintiff obtaining an injunction by consent in chambers; *Sluzenger v. Pigott*, 12 R. P. C. 439 (1895), North, J. Cf. the patent case, *Jenkins v. Hope*, [1896] 1 Ch. 278; 13 R. P. C. 57, North, J.

<sup>3</sup> An innocent consignee or bailee may become liable for damages if he sends the spurious goods out of the country, or otherwise puts them beyond the control of the Court. *Upmann v. Elkton*, note (7), and cf. the patent case, *British Motor Syndicate, Ltd. v. Taylor*, [1901] 1 Ch.

122; 17 R. P. C. 723, C. A.

<sup>4</sup> Above, p. 422. The plaintiff is not entitled to the publication of an apology: *Hudson v. Bennett*, 14 L. T. (N. S.) 698 (1866), Stuart, V.-C.; *Hudson v. Chatteris Co.*, p. 460, n. (2); or to receive a list of the defendant's customers, if not entitled to an enquiry or account: *Hipkins v. Plant*, 15 R. P. C. 294 (1898).

<sup>5</sup> *Burpass v. Hills*, 26 Beav. 244; 23 L. J. Ch. 356 (1858), Romilly, M.R.; *McAndrew v. Bassett*, 33 L. J. Ch. 561; 4 De G. J. & S. 380 (1864), Wood, V.-C., and Westbury, C.; *Fennessy v. Day and Martin*, 55 L. T. 161 (1886), Bacon, V.-C.

<sup>6</sup> But the defendant must not ask for a term which he is not legally entitled to, as, for instance, that the plaintiff should not advertise the undertaking: *Hipkins v. Plant*, above, note (4).

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

<sup>8</sup> *Magnolia Metal Co. v. Atlas Metal Co.*, 14 R. P. C. 389, at p. 400 (1896), Collins, J. A passing-off case.

offered to submit to an injunction as regards trade mark, and, after accepting such offer, the plaintiffs continued the action as regards passing-off, the plaintiffs were ordered to pay the costs from the date of the offer.<sup>1</sup>

If the plaintiff moves for an interlocutory injunction after being offered all that he can obtain on such a motion, unless there is ground to believe that the offer will not be carried out, the motion should be refused with costs.<sup>2</sup>

In *Moet v. Pickering*,<sup>3</sup> where wharfingers with whom the spuriously marked goods had been warehoused in the ordinary course of trade, and who were entitled to a lien for their charges, were added as defendants, and the plaintiffs proceeded to trial against them, the Court of Appeal, reversing Fry, J., ordered that their costs of action should be paid by the plaintiffs. The wharfingers had pleaded that they had no knowledge of the infringement, and that they submitted to act as the Court should direct, upon payment of their charges and costs; but the Court of Appeal regarded this as meaning only that they claimed nothing adversely to the plaintiffs or the infringer. The case does not conflict with the rules stated above, for the plaintiffs had claimed to override the wharfinger's lien by a lien of their own for costs, and this was held to be wrong; and besides, it was clearly unnecessary to have added the wharfingers as defendants or to have proceeded to trial against them, since not only had they made no threat to part with the goods, but after notice of the injunction obtained against the infringer it would have been a contempt of Court for them to do so.

Stay of proceedings.

Where the plaintiff has obtained, or is offered, all that he is

<sup>1</sup> *Vernon & Sons v. Buchanan's Flour Mills, Ltd.*, 23 R. P. C. 17 (1906), Farwell, J.; cf. *Hat Manufacturers Supply Co., Ltd. v. Tomlin Bros.*, 23 R. P. C. 413 (1906), Swinfen Eady, J. Where on a motion for an injunction which was treated as the trial, the plaintiff failed as to the relief claimed in the writ, and the motion and evidence were also directed to another complaint, as to which the defendants had made a reasonable offer, including costs to that date, the action was dismissed, the plaintiffs being ordered to pay the subsequent

costs, *Clarke v. Hudson*, 18 R. P. C. 310 (1901), Farwell, J.

<sup>2</sup> *Snuggs v. Seyd and Kelly's Credit Index Co.* (1894), W. N. 95. Chitty, J. In *Hudson v. Chatteris Co.*, 15 R. P. C. 438 (1898), Stirling, J., a patent case, where the defendant had paid sufficient money into Court to cover damages and an injunction was refused at the trial, costs subsequent to the acceptance of the money were given to the plaintiff. See also p. 459, note (2).

<sup>3</sup> A similar order was made in *Uymann v. Elkan*, p. 459, note (7).

entitled to, the Court will stay further proceedings in the action, at the defendant's instance.<sup>1</sup>

And in a trivial case, where an action had been commenced without notice against the innocent purchaser of an inconsiderable quantity of spuriously marked goods, and he at once submitted to do as the Court directed, Stirling, J., refused to give any costs.<sup>2</sup> In some cases of isolated instances of infringement or passing-off, the plaintiff has been refused relief at the trial, and been ordered to pay the costs of the action.<sup>3</sup>

Trivial cases.

It is no reason for not giving costs that the defendant is an infant.<sup>4</sup>

Costs have been refused to a successful plaintiff because he claimed, besides the injunction to which he was entitled, an account to which he was not, against an innocent purchaser of the spuriously marked goods;<sup>5</sup> and in a similar case, where the plaintiffs set up claims to a copyright in a music tutor, as well as an exclusive right to its title, and failed as to the copyright, they were allowed only half their taxed costs of action.<sup>6</sup> On similar grounds, plaintiffs have been ordered to pay,<sup>7</sup> or have been deprived of,<sup>8</sup> the costs occasioned by allegations which they have failed to prove, although they have succeeded and obtained the general costs of their actions. Thus, in a Scotch case, the plaintiffs were deprived of costs because they had alleged personal fraud without proving it, had claimed substantial damages and offered no proof thereof, and had had to make an indispensable

Costs refused because plaintiff claimed too much.

<sup>1</sup> *Rudd v. Rowe*, L. R. 10 Eq. 610 (1870), James, V.-C.; *Curtis and Harvey v. Pope*, 5 R. P. C. 146 (1888), North, J. (*Diamond Gunpowder*).

<sup>2</sup> *American Tobacco Co. v. Guest*, [1892] 1 Ch. 630; 9 R. P. C. 218; cf. *Rose v. Loftus*, 47 L. J. Ch. 576 (1878), Malins, V.-C.

<sup>3</sup> *Leahy v. Glover*, 10 R. P. C. 141 (1893), H. of L., and *Rutter v. Smith*, 18 R. P. C. 49 (1901), Kekewich, J., where only a single act of passing-off by a servant, since discharged, was proved, and costs were given against the plaintiffs; and see the other similar cases cited above, p. 389, note (9). In *Burberry v. Watkinson*, 23 R. P. C. 141 (1906), Warrington J., an isolated case of a wrongful act, the defendant acting unwittingly, the action was dismissed

without costs.

<sup>4</sup> *Chubb v. Griffiths*, 35 Beav. 127 (1865), Romilly, M.R.

<sup>5</sup> *Moct v. Couston*, 33 Beav. 578; 10 L. T. (N. S.) 395 (1864), Romilly, M.R. In *Hipkins v. Plant*, p. 462, note (4), the defendants were given the costs of the action so far as it asked for damages or an account.

<sup>6</sup> *Metzler v. Wood*, 8 C. D. 606 (1877), Malins, V.-C., and C. A.

<sup>7</sup> *Pierce v. Franks*, 15 L. J. Ch. 122 (1846), Knight Bruce, V.-C.

<sup>8</sup> *Standish v. Whitwell*, 14 W. R. 512 (1866), Wood, V.-C., an affidavit charging fraud. So *Saxlehner v. Apollinaris Co.*, p. 462, note (4), Kekewich, J., where a charge of fraud failed in part.

amendment in their pleadings.<sup>1</sup> But where the plaintiff, in an action for infringing his trade mark and also for "passing-off," failed as regards the infringement in respect of some of the goods for which he used, but had not registered, the trade mark, and succeeded as to the rest of the action, and the defendant was held to have been guilty of deliberate infringement in breach of an undertaking previously given by him, Kekewich, J., refused to deprive the plaintiff of any part of his costs.<sup>2</sup> If the plaintiffs' case has been overlaid with unnecessary evidence, he may be deprived of the costs of such evidence.<sup>3</sup>

The usual rule is to apportion the costs, each party getting costs of the substantial issues upon which he has succeeded, the plaintiff getting the costs of the action except so far as these are increased by the issues upon which costs are given against him,<sup>4</sup> unless there is one main issue upon which he has failed.<sup>5</sup>

In a case, where an action for infringement and two motions by the defendants, one to expunge the plaintiff's registration, and the other for an order to the Comptroller to register a mark propounded by the defendants, were tried together, and the action and the second motion failed, but the first motion succeeded, and both parties made unfounded allegations of fraud, North, J., refused to give any costs to either, principally on the ground that it was absolutely impossible for any taxing master to do justice between the parties by distinguishing the costs of one part of the case from another.<sup>6</sup>

Apportionment of costs.

The judge at the trial has jurisdiction to decide what proportion of costs a party is to pay, thus, where the plaintiffs and

<sup>1</sup> *Montgomerie & Co., Ltd. v. Young Bros.*, 20 R. P. C. 781 (1903), Ld. Kyllachy. On appeal the defendants wholly succeeded, 21 R. P. C. 285 (1904), Inner House.

<sup>2</sup> *Jay v. Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888). So *Rowland v. Mitchell*, 13 R. P. C. 457 (1896), Romer, J. In *Hodgson v. Kynoch*, 15 R. P. C. 465 (1898), Romer, J., there was no fraud, and the claim as to infringement had not substantially increased the costs, consequently no order as to them was made.

<sup>3</sup> In *Daimler Motor Co., Ltd. v. London Daimler Co., Ltd.*, 24 R. P. C. 379 (1907), C. A., the plaintiffs were given only one

half the costs of the evidence.

<sup>4</sup> *Saxlehner v. Apollinaris Co.*, [1897] 1 Ch. 893; 14 R. P. C. 645; *Lever v. Bedingfield*, 15 R. P. C. 453 (1898), both Kekewich, J.; *Hipkins v. Plant*, 15 R. P. C. 294 (1898), Byrne, J. *Worthington Pumping Engine Co. v. Moore*, 20 R. P. C. 41 (1902), Byrne, J., a claim that the defendant was trustee for the plaintiffs of these patents, no evidence being offered as to one of them.

<sup>5</sup> *Pneumatic Stamp Co. v. Lindner*, 15 R. P. C. 525 (1898), Byrne, J.

<sup>6</sup> *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1890); *Jackson v. Napper*, 35 C. D. 162; 4 R. P. C. 45 (1886), Stirling, J.

defendants each succeeded partially, the defendants were directed to pay one-third of the plaintiffs' costs, and no order was made as to their own.<sup>1</sup> And where the defendants in an infringement action succeeded in their defence, and in a motion by them for rectification succeeded partially as to one mark, but failed as to another, the plaintiffs were ordered to pay to the defendants two-fifths of the costs of the action and motion, treating them as a whole, and including the costs of an interlocutory motion which were made costs in the action.<sup>2</sup>

A successful defendant is much more often deprived of his costs than a successful plaintiff, for the plaintiff may fail in his action notwithstanding that the evidence makes it clear that the defendant has acted, or intended to act, dishonestly, and in such a case, although the Court declines to assist the plaintiff, it generally refuses to give costs to the defendant.

Successful defendant deprived of costs.

Where, for example, the plaintiff failed because of misrepresentations contained in his trade mark,<sup>3</sup> but the defendant had closely imitated the mark, the action was dismissed without costs; and the same course was followed where there was no sufficient proof that the defendant's mark was calculated to deceive, having regard to the long delay of the plaintiff to take proceedings, and the absence of evidence of actual deception;<sup>4</sup> and in cases where the action was dismissed, but the Court thought that the defendant's conduct had been uncandid and unfair;<sup>5</sup> and North, J., dismissed an action without costs because he thought that the defendants had kept back information;<sup>6</sup> and where the defendants had by their conduct brought the action on themselves, they were given no costs.<sup>7</sup>

So, too, no costs were given where it was proved that the

<sup>1</sup> *Findlater, Mackie, Todd & Co. v. Newman & Co.*, 19 R. P. C. 235 (1902), Kekewich, J.

<sup>2</sup> *Bourne v. Swan and Edgar, Ltd.*, 20 R. P. C. 105 (1903), Farwell, J. And see *In re Pollard* (1902), W. N. 49, Kekewich, J. See also the patent case, *Gawthorp v. Mason*, 23 R. P. C. 401 (1906), Kekewich, J.

<sup>3</sup> *The Leather Cloth Co., Ltd. v. The American Leather Cloth Co., Ltd.*, 4 De G. J. & S. 137; 33 L. J. Ch. 199; 11 H. L. C. 523; 35 L. J. Ch. 53 (1863), Westbury, L.C., and H. L. The House of Lords held that there was no infringe-

ment.

<sup>4</sup> *Rodgers v. Rodgers*, 31 L. T. (N. S.) 285 (1874), L.J.J.

<sup>5</sup> *Estcourt v. The Estcourt Hop Essence Co.*, 31 L. T. (N. S.) 567; L. R. 10 Ch. 276 (1874), Malins, V.-C., Cairns, C., and L.J.J.; *Marwell v. Hogg*, 15 L. T. (N. S.) 204; L. R. 2 Ch. 310 (1866), Stuart, V.-C., and L.J.J.; but see *King v. Gillard*, cited p. 464, note (5).

<sup>6</sup> *Meaby & Co., Ltd. v. Triticine, Ltd.*, 15 R. P. C. 1 (1898).

<sup>7</sup> *Lambert and Butler v. Goodbody*, 19 R. P. C. 377 (1902), Farwell, J.

defendant had represented the goods he sold as being those of the plaintiff, although the proof of the plaintiff's title failed.<sup>1</sup>

In *The Patent Plumbago* case,<sup>2</sup> however, where the plaintiffs failed on the ground of misrepresentation, but the imitation of their trade name was clearly made out, the action was dismissed with costs, the plaintiffs having continued to misdescribe their goods as "patent" after a summons taken out at their instance had been dismissed by the magistrate because of such misdescription.

Defendant *in pari delicto*.

So, in cases in which the plaintiff fails because he is carrying on a fraudulent trade, and the defendant stands *in pari delicto*, the practice is to dismiss the action without costs.<sup>3</sup>

Unfounded charges of fraud.

And a successful defendant has also been deprived of costs because he has made an unfounded charge of fraud.<sup>4</sup>

In a case in which the judge at the trial dismissed the action, but without costs, on the ground of what he found to be untrue statements on the defendants' goods as to prize medals and awards, the Court of Appeal found that there had been no dishonesty on the part of the defendants, but held that even if the statements had been misrepresentations to the public, yet if that was unconnected with a wrong done to the plaintiffs, the judge could not in his discretion on that ground deprive the defendants of costs.<sup>5</sup>

In an earlier case the same judge refused a successful defendant his costs because he put the word "registered" on his goods although his device was not registered; in this case, however, the plaintiffs might have been to some extent affected as they used the word registered, their mark being registered.<sup>6</sup>

<sup>1</sup> *Ainsworth v. Wainman*, L. R. 1 Eq. 518 (1866), Wood, V.-C.; and see *Browne v. Freeman* (1), 12 W. R. 305 (1864), Wood, V.-C., where the defendant misdescribed his goods as *The Original Chlorodyne*.

<sup>2</sup> *Morgan v. McAdam*, 36 L. J. Ch. 228 (1866), Wood, V.-C.

<sup>3</sup> *Newman v. Pinto*, 4 R. P. C. 508; 57 L. T. 31 (1887), C. A.; *Thorncloc v. Hill*, 11 R. P. C. 61 (1894), Romer, J.; cf. *Baschet v. London Standard Co.* [1900] 1 Ch. 73, Kekewich, J., a copy-right case.

<sup>4</sup> *Humphries v. The Taylor Drug Co.*, 39 L. T. 820 (1888), Kekewich, J.;

*Hargreaves v. Freeman*, [1891] 3 Ch. 39; 8 R. P. C. 237, Chitty, J. As to unfounded charges of fraud by the plaintiff, see p. 461.

<sup>5</sup> *King v. Gillard*, [1905] 2 Ch. 7; 21 R. P. C. 589; 22 R. P. C. 327, Kekewich, J., and C. A. *Estcourt v. The Estcourt Hop Essence Co.*, cited p. 463, note (5), was not cited to the Court in this case.

<sup>6</sup> *Warsop & Sons, Ltd. v. Warsop*, 21 R. P. C. 481 (1904), Kekewich, J. Cf. the cases cited above, in which a false representation of registration was held to constitute an element in infringement, above, p. 398.

In a trade name case, where the plaintiffs' action was dismissed by the Court of Appeal on the ground that they were not satisfied that the name adopted by the defendants would cause any deception likely to occasion damage to the plaintiffs, costs, both of the appeal and in the Court below, were refused because the Lords Justices believed that the defendants had chosen the name in dispute with the hope of obtaining some illicit advantage from the plaintiffs' reputation.<sup>1</sup> Costs of appeal.

But, in general, the reasons for depriving the defendant of costs do not apply to the costs of an unsuccessful appeal brought by the plaintiff against the dismissal of his action. Thus, the appeal to the House of Lords in *The Leather Cloth* case<sup>2</sup> and the appeal to the Court of Appeal in *Newman v. Pinto*<sup>3</sup> were both dismissed with costs. In the former case the plaintiff obtained judgment in the first instance, and when this was reversed on appeal by Lord Westbury no costs were given.<sup>4</sup>

A party who succeeds on appeal and recovers the costs paid under the judgment below is not entitled to interest.<sup>5</sup> But where the defendants succeeded at the trial, and received their costs from the plaintiffs, but failed on appeal and repaid the amount so received with interest to date, and on appeal to the House of Lords the defendants succeeded, they were held to be entitled not only to the return of the costs and interest repaid by them, but to interest on the costs from the date of such repayment by them to the date of the return after the House of Lords' decision.<sup>6</sup> Interest on costs repaid

The Court or judge may order the costs adjudged to be paid to be taxed upon the higher scale, if special grounds arising out of the nature and importance, or the difficulty or urgency, of the case appear to exist.<sup>7</sup> Such an order was made by North, J., in *The Great Tower Street Tea Co. v. Smith*,<sup>8</sup> where the hearing occupied a long time, and the facts were complicated, and a great number of witnesses were called. But some special reason for the order must be shown, for, although the application is almost Higher scale.

<sup>1</sup> *Borthwick v. The Evening Post*, 37 C. D. 449 (1888), C. A.

<sup>2</sup> 11 H. L. C. 523; 35 L. J. Ch. 53.

<sup>3</sup> See note (3), ante, p. 464.

<sup>4</sup> 4 De G. J. & S. 137; 33 L. J. Ch. 199. This course was taken also in *Borthwick v. The Evening Post*, supra.

<sup>5</sup> *Edge v. Gallon*, 16 R. P. C. 509, at T.M.

p. 520 (1899), C. A.

<sup>6</sup> *Ashworth v. English Card Clothing Co., Ltd.*, 21 R. P. C. 355 (1904), Joyce, J.

<sup>7</sup> Ord. 65, r. 9. See the note in the Annual Practice.

<sup>8</sup> 6 R. P. C. 165 (1889).

always made in heavy trade mark or patent actions, it is not granted as of course;<sup>1</sup> and it is not granted as a punishment,<sup>2</sup> or merely because a case of gross fraud is made out.<sup>1</sup> The order ought only to be made in cases of very unusual difficulty requiring skill, antiquarian research and things of that kind.<sup>3</sup> That scientific witnesses are necessarily called has been held to be a special reason.<sup>4</sup> An appeal lies on the question whether there are "special grounds" or not.<sup>5</sup>

Costs as between solicitor and client.

It is provided by sec. 46<sup>6</sup> that—

"In any legal proceeding in which the validity of the registration of a registered trade mark comes into question and is decided 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 the statutory provisions with regard to actions for the infringement of a patent.<sup>7</sup>

Certificate that title to trade mark came in question.

A certificate cannot be granted unless the right to the exclusive use of the trade mark has, in fact, come in question, and, therefore, it was refused in a case under the repealed Acts where the defendant's counsel admitted that, upon the failure of the defendant's application to remove the plaintiff's mark from the Register, he had no defence to the action.<sup>8</sup> Under sec. 77A of the Act of 1883,

<sup>1</sup> *Sanitas Co., Ltd. v. Condy*, 4 R. P. C. 530 (1887), Kekewich J. In *Rodgers v. Rottgen*, 5 Times L. R. 678 (1889), Kay, J., said he gave costs on the higher scale very charily. In *Leonhardt v. Kallé*, 12 R. P. C. 103, at p. 120 (1895), Romer, J., said he had never done it except by consent. Collins, J., gave such costs in *Reddaway v. Banham*, 12 R. P. C. 86, and his judgment was restored by the H. of L., [1896] A. C. at p. 222.

<sup>2</sup> *Hudson v. Osgerby*, 32 W. R. 566; 50 L. T. 323 (1884), Pearson, J.; and see *Pooly's Trustee v. Whetham*, 33 C. D. p. 120; and *Paine v. Chisholm*, [1891] 1 Q. B. 531, and the cases there cited.

<sup>3</sup> *Gadd v. Mayor of Manchester*, 9 R.

P. C. 516, at p. 535, Lindley, L.J. See also *Dunlop Co. v. Wapshare Co.*, 17 R. P. C. 433 (1900), Buckley, J., and *Chamberlain and Hookham v. Mayor of Bradford*, 17 R. P. C. 493 (1900), Farwell, J., where the order was made. These are all patent cases.

<sup>4</sup> *Ellington v. Clark*, 5 R. P. C. 328; 58 L. T. 818 (1888), C. A.; *The Robin*, [1892] P. 95, Jeune, J.; *Dunlop Co. v. Wapshare Co.*, supra.

<sup>5</sup> *Paine v. Chisholm*, [1891] 1 Q. B. 531, C. A.

<sup>6</sup> Replacing sec. 18 of the Act of 1888.

<sup>7</sup> Patents and Designs Act, 1907, sec. 35.

<sup>8</sup> *Benjamin Edgington, Ltd. v. John Edgington & Co.*, 6 R. P. C. 513; 61 L. T. 323 (1899), Kay, J.



introduced into that Act by sec. 18 of the Act of 1888, a certificate could only be given in an action for infringement; but it was held that it could under some circumstances be granted upon a motion for rectification where the mark had been registered for five years, since the mark could then only be attacked by proceedings for rectification. Thus where, under an order of the Court, a motion for rectification and an action for infringement were heard together and on the same evidence, it was held that there was jurisdiction to grant a certificate, and the grant was made.<sup>1</sup>

In a case where the Court of Appeal refused an application by the defendant to expunge the plaintiffs' marks, partly on the ground that the defendant was a deliberate infringer, they declined to give the plaintiffs a certificate under the section.<sup>2</sup>

The order granting a certificate is not appealable.<sup>3</sup>

Considerations similar to those above stated govern the grant or refusal of costs in respect of the application to rectify the Register by expunging or varying the registration of the plaintiff's mark, which is an ordinary incident of the defence in an action for infringement. The usual practice is to give the applicant costs, if he succeeds;<sup>4</sup> but if the application is made by the defendant for the purposes of the action, and it is doubtful whether he is not acting fraudulently, the costs may be reserved till the trial,<sup>5</sup> or may be refused.<sup>6</sup>

The costs of three counsel have sometimes been expressly allowed by the Court in trade mark and similar cases,<sup>7</sup> but the present practice of the taxing masters is to exercise their discretion as to allowing such costs without an order of the Court.<sup>8</sup>

Costs of motion to rectify in aid of defence.

Three counsel.

<sup>1</sup> *Field & Co. v. Wagel Syndicate*, [1900] 1 Ch. 651; 17 R. P. C. 266, Buckley, J. A certificate was however refused in *Kodak, Ltd. v. London Stereoscopic, &c., Co.*, 20 R. P. C. 337 (1903), Swinfen Eady, J., where passing-off was the chief issue; and on special grounds in *Bourne v. Swan and Edgar, Ltd.*, 20 R. P. C. 105 (1903), Farwell, J. A certificate was given in *Barlow v. Johnson*, 7 R. P. C. 395, at p. 411 (1890), Chitty, J.; there was a motion to rectify, but the mark had been registered less than five years.

<sup>2</sup> *Paine & Co. v. Daniells & Sons' Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 217, cited p. 398.

<sup>3</sup> *Haslam & Co. v. Hall*, 5 R. P. C. 144 (1888), C. A.

<sup>4</sup> *Richards v. Butcher*, [1891] 2 Ch. 522; 8 R. P. C. 37, Kay, J.

<sup>5</sup> *Gianaclis' Tm.*, 6 R. P. C. 467; 58 L. J. Ch. 782 (1889), North, J.

<sup>6</sup> *Perry-Davis' Tm.*, 5 R. P. C. 333; 58 L. T. 695 (1888), Kay, J.; *Bradley's Tm.*, 9 R. P. C. 205 (1892), Chitty, J. See further Chap. XI., p. 311.

<sup>7</sup> For instance, in *Weingarten v. Rosenthal*, 21 R. P. C. 212 (1904), Farwell, J.

<sup>8</sup> See *Andrews' Patent*, 24 R. P. C. 349, at p. 378 (1907), C. A.; and *Burroughs, Wellcome & Co.'s Tms.*, 22 R. P. C. 164 (1905), where such costs at the trial and in the Court of Appeal were allowed by the taxing master, and Warrington, J., refused to overrule his discretion.

## 8. Appeal.

Appeal  
advanced.

In a case where the defendant desired to appeal against an interim injunction which the plaintiff had obtained, the Court, on his application, and on the ground that the continuance of the injunction would do irreparable damage to his business, advanced the case to the head of the list.<sup>1</sup>

Stay pending  
appeal.

A stay of an injunction pending appeal will only be granted on special grounds, and generally on terms.<sup>2</sup> But a stay as to delivery up is more readily granted.<sup>3</sup> An inquiry as to damages or an account of profits is not often stayed, but sometimes liberty to apply when the inquiry has been answered has been given.<sup>4</sup> A stay of the injunction pending an appeal from the Court of Appeal to the House of Lords, the defendants undertaking to keep an account, was granted in a patent case on the ground of difference of opinion in the Court, coupled with the fact that there was no possible doubt as to the plaintiffs getting their damages if an appeal failed.<sup>5</sup>

Stay of order.

An application to stay a new trial ordered to take place by the Court of Appeal, pending an appeal against the order to the House of Lords, was refused in *Edge v. Johnson*.<sup>6</sup>

Interlocutory  
appeal  
barred by  
delay.

In *Burgess v. Burgess*,<sup>7</sup> delay for five months in appealing against an order for an interim injunction, where the plaintiff was appellant, seeking to have the scope of the order enlarged, was held to be a bar to the appeal.

<sup>1</sup> *Lazenby v. White*, L. R. 6 Ch. 89 (1870), James, L.J.

<sup>2</sup> See the patent cases, *Leeds Forge Co., Ltd. v. Deighton's Patent Flue & Tube Co., Ltd.*, 18 R. P. C. 233 (1901), stay arranged in C. A.; *Pilkington v. Massey*, 21 R. P. C. 421 (1904), Kekewich, J.; *Jandus Arc Lamp, &c. Co. v. Arc Lamp Co.*, 22 R. P. C. 277 (1905), C. A., stay granted on terms; and *Worcester Royal Porcelain Co., Ltd. v. Locke*, 19 R. P. C. 479, at p. 491 (1902), Byrne, J., passing-off, stay on terms including an undertaking to keep an account and to pay over profits if the appeal failed; *Mouchel v. Coignet*, 23 R. P. C. 649 (1906), Warrington, J. See generally as to stay pending appeal, Annual Practice, notes to Ord. 58, r. 16.

<sup>3</sup> *E.g.*, granted in *Parker and Smith v. Satchwell*, 18 R. P. C. 299 (1901), Far-

well, J., where the delivery up was stayed, although a stay of the injunction was refused. Also *Presto Gear Case, &c. Co., Ltd. v. Orme, Evans & Co., Ltd.*, 17 R. P. C. 218 at p. 227 (1900), Farwell, J.; *Mouchel v. Coignet*, note (2).

<sup>4</sup> See the case last but one cited, and *British United Shoe Machinery Co., Ltd. v. A. Fussell & Sons, Ltd.*, 25 R. P. C. 368 (1908), Swinfen Eady, J.

<sup>5</sup> *Consolidated Pneumatic Tool Co., Ltd. v. Clark*, 24 R. P. C. 593, at p. 640 (1907).

<sup>6</sup> 9 R. P. C. 134 (1892).

<sup>7</sup> 3 De G. M. & G. 896; 22 L. J. Ch. 675 (1853), L.J.J. So also in *Re Palmer's Application*, 22 C. D. 88 (1882), C. A., where the Court had decided against a preliminary objection. The time for appealing against an interlocutory order is now fourteen days. R. S. C., Ord. 58, r. 15.

Where the judge of first instance has found, or has refused to find, fraud it is difficult, and usually impossible, for the Court of Appeal to reverse his finding. In a recent case, however, a finding of fraud was reversed, the Court being able to act without relying on the evidence of the defendant, which the judge below had not believed.<sup>1</sup> Appeal in case of fraud.

If an appeal is brought, and the defendant succeeds, judgment is entered in his favour, not a non-suit;<sup>2</sup> but the Court of Appeal, in dismissing the plaintiff's action, may reserve to him liberty to sue again in respect of any part of his claim. This course was adopted in an action where the plaintiff sought to raise a new case of "passing-off," not set up by the pleadings, at the trial, and was not allowed to proceed with it.<sup>3</sup> Non-suit.

### 9. Practice.

There are no rules as to pleadings which are peculiar to actions for the infringement of trade marks;<sup>4</sup> all that is necessary, therefore, is that the statement of claim, defence, and reply, if any, in any such action, shall respectively contain statements, in a summary form, of the material facts upon which the party pleading relies for his claim or defence,<sup>5</sup> giving particulars of the frauds, if fraud is alleged.<sup>6</sup> What are material facts, having regard to the circumstances of the case, may be gathered from the statement of substantive law, given in the earlier part of the present chapter. Pleadings.

The forms provided by the appendices to the Supreme Court Rules are set out below. They, when applicable, and when they are not applicable forms of a like character, and as near as may be to them, are to be used for all pleadings; and, where they are applicable and sufficient, any longer forms are to be deemed prolix, and the costs occasioned by such prolixity are to be Forms in the Rules of the Supreme Court.

<sup>1</sup> *Jamieson & Co. v. Jamieson*, 15 R. P. C. 169 (1897). In *Valentine Meat Juice Co. v. Valentine Extract Co., Ltd.*, the Court of Appeal found fraud, where Stirling, J., had failed to do so, 17 R. P. C. 1 and 673; 83 L. T. 259 (1900).

<sup>2</sup> *Pinto v. Badman*, 8 R. P. C. 181 (1891), C. A. No plaintiff can, under the modern practice, claim to be non-suited: *Fox v. Star Newspaper Co.*, [1900] A. C. 19.

<sup>3</sup> *Native Guano Co. v. Sewage Manure Co.*, 8 R. P. C. 125 (1888), C. A. and

H. L.

<sup>4</sup> Sec. 9 of the Merchandise Marks Act, 1887, provides that in any pleading, proceeding, or document in which any trade mark or forged trade mark is intended to be mentioned, it shall be sufficient, without further description and without any copy or facsimile, to state that trade mark or forged trade mark to be a trade mark or forged trade mark. Appendix, p. 810.

<sup>5</sup> Ord. 19, r. 4.

<sup>6</sup> Ord. 19, r. 6.

disallowed, or to be borne by the party so using the same, as the case may be.<sup>1</sup>

#### INDORSEMENT ON THE WRIT.

The plaintiff's claim is for damages for wrongfully using (or imitating) the plaintiff's trade mark.

#### STATEMENT OF CLAIM.

(1.) The defendant has infringed the plaintiff's trade mark.

(2.) The trade mark is (*describe it*). (*If the plaintiff is not the original proprietor of the trade mark, show shortly how his title is derived.*)

(3.) The following acts are complained of, viz.:—(*Set them out.*)

The plaintiff claims an injunction to restrain the defendant, his servants and agents, from infringing the plaintiff's said trade mark, and in particular from (*stating any particular injunction sought*).

The plaintiff also claims an account or damages.<sup>2</sup>

#### DEFENCE.

(1.) The trade mark is not the plaintiff's.

(2.) The alleged trade mark is not a trade mark.

(3.) The defendant did not infringe.

It will be observed that the form of statement of claim here given does not comprise an allegation that the plaintiff's trade mark has been registered, or that sec. 42 of the Act has been otherwise complied with; but such an allegation is certainly proper, and, it is submitted, necessary.

Some more elaborate and detailed forms are given in the Appendix.<sup>3</sup>

Particulars.

The ordinary rule<sup>4</sup> that the parties must state the facts upon which they rely and which they plead in their pleadings, or in particulars separately delivered, with sufficient particularity to prevent their opponents being taken by surprise at the trial, applies to trade mark cases.

So if the plaintiff alleges that actual deception has occurred.

<sup>1</sup> Ord. 19, r. 5.

<sup>2</sup> Rules of the Supreme Court, Appendix C., sec. 6, Form 8.

<sup>3</sup> Pages 724 *et seq.*

<sup>4</sup> See the notes to Ord. 19, rr. 6 and 7, in the Annual Practice.

he will be ordered to give particulars of the persons deceived.<sup>1</sup> And if the defendant pleads that the plaintiff's trade mark is invalid, he must give particulars of the invalidity alleged.<sup>2</sup>

In a passing-off case in which the plaintiffs alleged that their cigars had come to be known by a name consequent on the use of red bands, they were ordered to give particulars of the dates when the cigars in question first became known by the name, as well as certain particulars as to the alleged passing-off.<sup>3</sup>

If a motion to expunge the plaintiff's mark is made by way of reply to the usual interlocutory application on behalf of the plaintiff for an interim injunction, and both the motion and application stand over to the trial, unless there are affidavits sufficiently showing what the defendant's case is upon his motion to expunge, he is frequently directed to deliver particulars of it. Where a defendant alleges common use of the mark in question, he may be ordered to give particulars of such user, for instance, the date of first user in the trade, and the names and addresses of a certain number of persons alleged to have used the mark.<sup>4</sup> So also where a defendant alleges user by himself he may be ordered to give particulars of the user alleged.<sup>5</sup>

### Discovery.

The ordinary rules<sup>6</sup> governing discovery also apply to trade mark actions.<sup>7</sup>

But a process which enables a rival trader to extract from his opponent information concerning his customers, his trade, and his mode of doing business, is extremely likely to be abused, and in cases where a large trade mark business is affected, even the ordinary order for discovery of documents upon oath may be

Orders for discovery in trade mark cases modified to prevent abuse.

<sup>1</sup> *Humphries v. Taylor Drug Co.*, 3 C. D. 693; 5 R. P. C. 687 (1888), Kekewich, J.; *Whitstable Oyster Fishery Co. v. Hayling Fisheries, Ltd.*, 17 R. P. C. 461 (1900) (the decision at the trial was affirmed on appeal, 18 R. P. C. 434 (1901)).

<sup>2</sup> *Rowland v. Mitchell*, 13 R. P. C. 457 (1896), Romer, J.

<sup>3</sup> *Imperial Tobacco Co., Ltd. v. Purnell & Co.*, 20 R. P. C. 719 (1903), Kekewich, J.

<sup>4</sup> *Aquascutum, Ltd. v. Moore*, 20 R. P. C. 640 (1903), Kekewich, J.; *Schweppes v. Gibbens*, 22 R. P. C. 113, at

p. 116 (1905).

<sup>5</sup> *Macmillan v. Ehrmann Bros., Ltd.*, 21 R. P. C. 357 (1904).

<sup>6</sup> Ord. 31. The Merchandise Marks Act, 1887, provides that nothing in that Act shall entitle any person to refuse to make a complete discovery, or to answer any question or interrogatory in any action: sec. 19. Appendix, p. 812.

<sup>7</sup> *Orr v. Diaper*, 4 C. D. 92 (1876), Hall, V.-C., demurrer to an action for discovery against shippers, brought in aid of an intended action against the consignors, dismissed.

very oppressive.<sup>1</sup> The Court, therefore, will, upon a proper case being shown, modify the common orders so that they shall occasion no more inconvenience to the party to whom they are directed than is necessary to ascertain the rights of his opponent.

Thus, in *Carver v. Pinto Leite*,<sup>2</sup> it was held that the defendants in a suit for infringement, who had been ordered to file an affidavit of documents and to produce the documents in the ordinary way, ought not to be ordered to disclose the names of customers, or of persons to or from whom letters referring to the matters in issue were sent or received, inasmuch as such discovery might be used in a manner prejudicial to the defendants in their trade, and was not likely to assist the plaintiffs in making out their case at the hearing.

And in a later case, where the defence was that the plaintiff was carrying on a fraudulent trade by selling as foreign cigars goods made in England, the plaintiff, who admitted the fact that his goods were in fact made in England, was allowed to refuse to say who was the manufacturer because, under the circumstances, the question was irrelevant.<sup>3</sup>

Disclosure of sales.

Discovery in aid of inquiry or account.

Discovery in regard to the sales effected by the defendant under the disputed mark is not, in general, where the infringement is denied, material, until the fact that the mark is an infringement of the plaintiff's rights has been decided ;<sup>4</sup> but where the giving of an account would occasion little trouble to the defendant, and may enable the plaintiff to get final judgment at the trial, without further inquiry, the judge, in his discretion, may order it to be given.<sup>4</sup> In a case where the questions of fact had been ordered to be tried by a jury, such discovery was refused, before the trial, on the ground that the plaintiff had not elected whether to claim damages or an account of profits if he succeeded.<sup>5</sup> After an account of profits or an inquiry as to damages has been

<sup>1</sup> *Wills' Tms.*, [1892] 3 Ch. 201; 9 R. P. C. 346, C. A.

<sup>2</sup> L. R. 7 Ch. 90 (1871), C. A. See also *Benbow v. Low*, 16 C. D. 93 (1880), C. A.; and *The Attorney-General v. The North Metropolitan Tramways Co.*, [1892] 3 Ch. 70, North, J. Full discovery was ordered in *Howe v. McKernan*, 30 Beav. 547 (1862), Romilly, M.R., where the defendant was charged with advertising himself as the plaintiff's agent after the agency was determined.

<sup>3</sup> *Benedictus v. Sullivan, Powell &*

*Co.*, 12 R. P. C. 25 (1895), Chitty, J. If the question had been relevant, the plaintiff must have answered it.

<sup>4</sup> *Benbow v. Low*, 16 C. D. 93 (1880), C. A. See also Ord. 31, r. 20, and the note in the Annual Practice thereon. And for the decisions in patent cases, see *Frost on Patents*, 3rd ed., p. 440, and *De la Rue v. Dickinson*, 3 K. & J. 388 (1857).

<sup>5</sup> *Fennessy v. Clark*, 37 C. D. 184 (1887), Kay, J., and C. A.

directed, discovery of the names and addresses of the persons to whom the marked goods were sold, or, if this cannot be had, of persons to whom goods—as to which the accounting party cannot swear that they were *not* marked with the objectionable mark—were sold, may be ordered.<sup>1</sup>

### Inspection, &c.

The Court or a judge has wide powers, under Ord. 50, r. 8, to make any order for the detention, preservation, or inspection<sup>2</sup> of any property or thing, being the subject of litigation, and to authorise any persons to enter upon or into any land or building in the possession of any party to the litigation, and, for all or any of the purposes aforesaid, to authorise any samples to be taken, or any observation to be made, or experiment to be tried, which may be necessary or expedient for the purpose of obtaining full information or evidence.

Under this power the Court could, for instance, authorise the plaintiff to inspect goods upon which he showed reasonable grounds for suspecting that a mark infringing his mark had been placed.<sup>3</sup>

The application is made in the Chancery Division by motion or summons; in the King's Bench Division by summons.<sup>4</sup>

Production and inspection of copies of the trade marks, or of other documents which are referred to in any of the pleadings or affidavits of any of the parties in a case, may be obtained by giving notice in writing to such party to produce them, unless some cause or excuse for not complying with the notice is shown, which the Court or judge deems sufficient.<sup>5</sup>

Documents  
referred to in  
the pleadings  
&c.

<sup>1</sup> *The Leather Cloth Co., Ltd. v. Hirschfeld*, 1 H. & M. 295 (1863), Wood, V.-C.; *Powell v. Birmingham Brewery Co.*, 14 R. P. C. 1 (1897), Stirling, J., and C. A.; *Saccharin Corporation v. Chemicals and Drugs Co.*, [1900] 2 Ch. 556; 17 R. P. C. 612, C. A.

<sup>2</sup> Sec. 21 of the repealed Merchandise Marks Act of 1862 gave jurisdiction to order inspection. As to the powers of justices to issue *search warrants* for goods by means of or in relation to which an offence has been committed under the Merchandise Marks Act, 1887, see sec. 12 of that Act, p. 810. A person charged with an offence under the Act

may find it necessary to show that "on demand made by or on behalf of the prosecutor he gave all the information in his power with respect to the persons from whom he obtained such goods or things": sec. 2 (2), and sec. 6. See Appendix, pp. 806 and 808.

<sup>3</sup> Such inspection is frequently authorised in patent cases. See Frost on Patents, 3rd ed. pp. 440 and 498; and *Neilson v. Betts*, L. R. 5 H. L. p. 11, per Ld. Westbury.

<sup>4</sup> See the Annual Practice notes to Ord. 50, rr. 3 and 6.

<sup>5</sup> Ord. 31, r. 15. *Smith v. Harris*, 48 L. T. 869 (1883), Chitty, J. The learned

## Evidence.

The Registrar's certificate, and sealed copies of the Register.

The registration of the plaintiff's mark, or the refusal to register it, is proved by the production of a certificate under the hand of the Registrar, and the actual terms of the registration, and proof of the mark itself as it is registered, are shown and given by the production of an extract or copy from the Register certified by the Registrar and sealed with the seal of the Patent Office.<sup>1</sup>

The request for the certificate should be made to the Registrar in writing, stating for what purpose it is required, in the form given in the second schedule to the Rules.<sup>2</sup> It may be sent by post.<sup>3</sup> The fee for a certificate for use in legal proceedings is one pound.

By sect. 50—

Copies of the Register.

“Printed or written copies or extracts of or from the Register, purporting to be certified by the Registrar, and sealed with the seal of the Patent Office, shall be admitted in evidence in all Courts in his Majesty's dominions, and in all proceedings, without further proof or production of the originals.”

And by sect. 51—

Registrar's certificates.

“A certificate purporting to be under the hand of the Registrar as to any entry, matter, or thing which he is authorised by this Act, or rules made thereunder, to make or do, shall be *prima facie* evidence of the entry having been made and of the contents thereof, and of the matter or thing having been done or left undone.”

These sections correspond to secs. 89 and 96 of the Act of 1883.

The registered mark is, in practice, usually shown by the production of a copy of the advertisement in the Trade Marks Journal, leading to its registration, and this is generally accepted as sufficient.

Proof of title of registered proprietor ;

Where the mark is registered, and the plaintiff is the registered proprietor, proof of the registration, and of the identity (if any question as to this is raised) of the registered proprietor with the plaintiff is *prima facie* evidence of the plaintiff's exclusive right

judge refused to order barrels branded with the mark to be produced. See also *Wills' Tms.*, above, p. 472, note (1).

<sup>1</sup> Sec. 7, Chap. III., p. 62, and sec. 50

*infra.*

<sup>2</sup> Rule 102, Form TM No. 34, Appendix, p. 697.

<sup>3</sup> Rule 7.



to the use of the mark.<sup>1</sup> After seven years from the date of the original registration, or from the passing of the Act of 1905,<sup>2</sup> whichever shall last happen, the original registration is to be taken to be valid in all respects, subject to certain exceptions.<sup>3</sup>

Registration is *prima facie* evidence of the validity of all assignments and transmissions of the trade mark,<sup>4</sup> but if the plaintiff claims, by devolution or assignment, through the registered proprietor, he must prove the devolution or assignment by giving the proper evidence of the facts which effect it, and must prove in the same way that the goodwill of the business concerned has also devolved upon or been assigned to him.<sup>5</sup>

of title by assignment, &c. ;

The infringement must be proved by showing that the defendant, his servants, or agents, have dealt in, or threaten, or are about to deal in goods of the kind to which the plaintiff's trade mark rights extend, in such a manner as to infringe his trade mark.<sup>6</sup>

of infringement ;

The nature of the evidence which should be adduced to satisfy the Court that the defendant's mark has such a resemblance to the plaintiff's as to be calculated to deceive has already been discussed.<sup>7</sup> It has been shown that the Court, in general, refuses to admit the mere statements of opinion by persons who are called as witnesses, to say that they think there is or there is not probability of deception.<sup>8</sup>

of probability of deception.

In *Orr-Ewing v. Johnston*,<sup>9</sup> Fry, J., held that the books kept by the Registrar of Trade Marks were not evidence, in an action for infringement, to show that marks like the plaintiff's mark were in common use and had been refused registration, and that the plaintiff's mark was consequently *publici juris*. The books were only evidence, the learned judge held, that other persons had made claims. Certified copies of entries actually made on the Register are, however, evidence of such entries, and if they

The Registrar's books are not evidence that a mark is *publici juris*.

<sup>1</sup> This is the combined effect of secs. 39 and 40, and is subject to certain limitations; see Chap. XII, Effect of Registration, above, p. 325.

<sup>2</sup> August 11th, 1905.

<sup>3</sup> Sec. 41. See above, p. 330.

<sup>4</sup> Sec. 39. above, p. 325.

<sup>5</sup> Sec. 22, Chap. XIII., p. 346. As to registration of the assignment, see p. 357.

<sup>6</sup> Above, p. 389.

<sup>7</sup> Above, p. 400, and Chap. X., p. 234. In many of the reports in the

R. P. C. the nature of the evidence is very fully indicated; see, for instance, *Liebig's Co. v. Chemists' Society*, 13 R. P. C. 635, and the *Valentine* and *Payton* cases cited in the next chapter.

<sup>8</sup> *Turton v. Turton*, 42 C. D. 149 (1889), C. A., "Compurgators," Fry, L.J. See also *Cope v. Evans*, L. R. 18 Eq. 138 (1874), Hall, V.-C.; and per Jessel, M.R., in *Thorn v. Worthing Skating Rink Co.*, 6 C. D. 415, n.

<sup>9</sup> 13 C. D. at p. 442 (1879).

show that three or more marks other than, but similar to, the plaintiff's have been registered for the same goods, that would, it is submitted, be evidence that the mark is a common mark.<sup>1</sup>

A commission to America to take evidence as to goods ordered from an American firm, who were joined as plaintiffs, in consequence of their advertisements in this country and as to the extent of advertisements sent to this country was refused by the Court of Appeal on the ground of expense, and as not being really necessary for the plaintiffs.<sup>2</sup>

<sup>1</sup> See the "Three Marks Rule," R. P. C. 97 (1904), C. A., reversing Chap. X., p. 224. Kekowich, J.

<sup>2</sup> *Christy & Co. v. Tipper & Sons*, 21

## CHAPTER XVI.

### THE ACTION FOR "PASSING-OFF."

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Definition

It is an actionable wrong for the defendant to represent, for trading purposes, that his goods are those or that his business is that of the plaintiff, and it makes no difference whether the

representation is effected by direct statements, or by using some of the badges by which the goods of the plaintiff are known to be his, or any badges colourably resembling these, in connection with goods of the same kind, not being the goods of the plaintiff, in such manner as to be calculated to cause the goods to be taken by ordinary purchasers for the goods of the plaintiff. But this rule does not extend to prevent the defendant honestly trading under his own name,<sup>1</sup> or under the names of the members of his firm, or honestly describing his goods, and their place of origin, manner of manufacture, and other characteristics, in the ordinary terms current in his trade.

The question whether the use of particular words or badges is calculated to pass off the defendant's goods as those of the plaintiff, or is merely honestly descriptive, is often one of difficulty, but it is, in substance, a question of fact.

"The principle of law may be very plainly stated, that nobody has any right to represent his goods as the goods of somebody else. How far the use of particular words, signs, or pictures, does or does not come up to the proposition enunciated in each particular case must always be a question of evidence, and the more simple the phraseology, the more like it is to a mere description of the article sold, the greater becomes the difficulty of proof; but if the proof establishes the fact, the legal consequence appears to follow."<sup>2</sup>

The action to restrain the defendant from passing off his goods as the goods of the plaintiff is obviously the generalised form of the action to restrain the infringement of a trade mark;<sup>3</sup> and the old principles from which the latter action grew up are still recognised and put into force by the Courts.<sup>4</sup> The action for

Comparison with the action for the infringement of a trade mark.

<sup>1</sup> Below, p. 532. Can the use be said to be honest, after it is shown that the result is to lead to the belief that the defendant's goods are the plaintiff's?

<sup>2</sup> Per Halsbury, L.C., in *Reddaway v. Banham*, [1896] A. C. at p. 204; 13 R. P. C. at p. 224. See generally on the subject of this Chapter the summaries of the law by Kay and Lindley, L.JJ., in *Powell v. Birmingham Vinegar Brewery Co.*, [1896] 2 Ch. 54; 13 R. P. C. 235; and *Id. Davey in Cellular Clothing Co. v. Maxton*, [1899] A. C. at p. 343; 16 R. P. C. at p. 408, the first of which is printed in a note at the end of this Chapter. See also an article entitled "Unfair Competition," by Mr. O. R.

Mitchell, in the *Harvard Law Review* for January, 1897. Leading American authorities are the *Amosteay Co. v. Spear*, 2 Sandf. S. C. 599 (1849); and *Lawrence Co. v. Tennessee Co.*, 138 U. S. 537 (1891).

<sup>3</sup> See Chap. I., pp. 1 and 13, and Chap. XV., p. 379.

<sup>4</sup> See Chapters I. and II., and the judgments of the C. A. in *Powell v. Birmingham Brewery Co.*, [1896] 2 Ch. 54; 13 R. P. C. 235; *Lee v. Haley*, L. R. 5 Ch. 155 (1869), Malins, V.-C., and Giffard, L.J.; *Somerville v. Schembri*, 12 App. Ca. 453; 4 R. P. C. 179 (1887), P. C.; *Montgomery v. Thompson*, 41 C. D. 35; [1891] A. C. 217; 8 R. P. C. 361 (*Stone Altes*).

infringement has been specialised, and the proof of the plaintiff's case in it greatly facilitated and simplified by the registration of trade marks and the provisions of the Acts; but the plaintiff's trade mark, although the most important, is only one of the badges by which his trade or his goods are, or may be, identified with him; and it is equally a wrong, according to the principles laid down in the judgments quoted in the Introduction, and in the cases last cited, to imitate or copy any of the others,<sup>1</sup>—his trade name or the get-up of his goods, for instance,—so as to damage his trade by passing off other goods as his, or by leading his customers to suppose that there is a connection between such other goods and his business, which does not in fact exist.<sup>2</sup>

In a trade mark action the plaintiff must prove his title to the mark he claims, that it is registered as his mark or as the mark of his predecessor in business (unless the trade mark was in use before August 13th, 1875, and has been refused registration under the Act),<sup>3</sup> and that the defendant has infringed the mark.<sup>4</sup> And proof of the registration is, at least *primâ facie*, proof of title also. Further, if the mark has been actually or substantially copied, that constitutes an infringement, although it is not shown that the copy is calculated to deceive.<sup>5</sup> In a passing-off action the plaintiff's case is very similar to this, but registration forms no part of it, and the plaintiff must prove by direct evidence that the conduct of the defendant is calculated to pass off the defendant's goods as his. To do so, he must show either that the defendant has actually represented that his goods or business are those of the plaintiff, or,—and this is the common case,—that he has used certain symbols or badges in connection with his goods or business, which are reputed in the market to import that the goods or business in connection with which they are used are the plaintiff's goods or business.

A plaintiff may, therefore, fail to make out a case of infringement of trade mark rights because he cannot prove his title to the trade mark, or its registration, or that its registration extends

Where trade mark action fails, passing-off action may succeed on the same evidence.

<sup>1</sup> "By the course of trade, by the existence and technology of trade, and by the mode in which things are sold, a man may utter that same proposition" (*i.e.*, that his goods are those of the plaintiff) "but in different words and without using the name of the rival tradesman at all." Per Halsbury, L.C., in *Birmingham Brewery Co. v. Powell*,

[1897] A. C. at p. 711; 14 R. P. C. at p. 728.

<sup>2</sup> See *Borthwick v. The Evening Post*, 37 C. D. 449 (1888), Kay, J., and C. A., cited below, p. 506, and sec. 45, above, p. 338.

<sup>3</sup> Sec. 42, above, p. 334.

<sup>4</sup> See the last Chapter, p. 339.

<sup>5</sup> See p. 397.

to the goods,<sup>1</sup> or to all of the goods,<sup>2</sup> in question, or because the registration is ordered to be annulled,<sup>3</sup> and may yet show that by imitating the mark claimed as a trade mark, or otherwise, the defendant has done what is calculated to pass off his goods as those of the plaintiff. It follows that a case of "passing-off" is generally added as a second string to an action for infringement, and is frequently successful where the trade mark action proper breaks down.<sup>4</sup>

The two actions are frequently combined.

Nothing in the Trade Marks Act affects a trader's right against another in an action for passing-off. This is now expressly declared by sec. 45, but the law was the same under the earlier Acts.<sup>5</sup> It is therefore no bar to an action for passing-off that the trade name, get-up, or any other of the badges identified with the plaintiff's business, which are alleged to have been copied or imitated by the defendant, might have been, but are not, registered under the Acts as trade marks,<sup>6</sup> even though the evidence is wholly addressed to what may be a mark capable of registration.<sup>7</sup> Such unregistered marks are frequently referred to as "common law trade marks."<sup>7</sup>

The Act affords no bar to a passing-off action.

But a plaintiff who has raised no issue upon his pleadings except in regard to the infringement of his trade mark has been refused leave to amend his claim at the trial so as to start a fresh case of "passing-off" in order to save his action.<sup>8</sup> In the

Common law trade marks.

New case of passing-off or of fraud raised at the trial.

<sup>1</sup> *Hart v. Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J.

<sup>2</sup> *Jay v. Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

<sup>3</sup> *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A.; *Montgomery v. Thompson*, 41 C. D. 35; 6 R. P. C. 404; [1891] A. C. 217; 8 R. P. C. 361, C. A. and H. L.; *Powell v. Birmingham Co.*, [1896] 2 Ch. 54; 13 R. P. C. 235; [1897] A. C. 710; 14 R. P. C. 720. The fact that a word which is *prima facie* descriptive has been removed from the Register is an element to be considered when it is alleged in a case for passing-off to be distinctive. The Court may infer that the registration (alone) has prevented other traders from using the name: *Hommel v. Bauer*, 21 R. P. C. 576; 22 *ib.* 43 (1904), Warrington, J., and C. A.

<sup>4</sup> See the cases cited in the last three notes. *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L.J.; and the judg-

ment of Lindley, L.J., in *Reddaway & Co. v. Bentham Hemp Spinning Co.*, [1892] 2 Q. B. 639; 9 R. P. C. 503, C. A. (*Camel Hair Belling*). See also *Compania Général de Tabacos v. Rehder*, 5 R. P. C. 61 (1887), Kay, J., and *Curtis and Harvey v. Pape*, 5 R. P. C. 146 (1887), North, J., where the trade mark questions were left undecided.

<sup>5</sup> See pp. 450 and 451 of the 2nd ed., and *Faulder v. Rushton*, 20 R. P. C. 477 (1902), C. A. The question was argued in *Weingarten v. Bayer*, 20 R. P. C. 289, 649; 22 R. P. C. 341 (1905).

<sup>6</sup> See above, Chap. XII., p. 338, and *Great Tower Street Tea Co. v. Langford & Co.*, 5 R. P. C. 66 (1887), Stirling, J.

<sup>7</sup> *Reddaway & Co. v. Bentham Hemp Spinning Co.*, [1892] 2 Q. B. 639; 9 R. P. C. 503, Lindley, L.J.; *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L.J.

<sup>8</sup> *Native Guano Co. v. Sewage Manure Co.*, 4 R. P. C. 478; 8 R. P. C. 125

case first cited in the note, however, leave was reserved to the plaintiffs to bring a fresh action to restrain the defendants from passing off their goods as the plaintiffs'. If a charge of fraud is to be made at the trial, it is essential that it should be put forward clearly and prominently on the pleadings.<sup>1</sup>

Passing-off cases are usually cases of deliberate and intentional misrepresentation, and they have been treated in many reported judgments even in recent cases, in which the attention of the Court was not directed to the point, as though fraud were a necessary element of the right of action; but it is well settled that this is not the case.<sup>2</sup> In an action to restrain passing-off, proof that the defendant intended to deceive, if his conduct is shown to be calculated to pass off his goods as those of the plaintiff, or to cause them to be so passed off, is no more necessary than in an action for infringement.<sup>3</sup> And if it were necessary, it would be sufficient evidence of fraud to show that the defendant continued, or sought to continue, to use the deceptive badges or descriptions, after the danger of mistake arising from their use had been brought to his notice.<sup>4</sup> For it has never been held that innocent inception is a defence.<sup>5</sup>

Proof of  
fraudulent  
intention is  
not essential.

(1887), Kay, J., C. A. and H. L. Leave was granted, the defendants not objecting, in *Jay v. Luller*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.; and also in *Barber v. Manico*, supra, where the defendants raised the objection.

<sup>1</sup> *Leahy, Kelly and Leahy v. Glover*, 10 R. P. C. 141 (1893), H. L.

<sup>2</sup> *Singer Manufacturing Co. v. Wilson*, 3 App. Ca. 376 (1877), Cairns, L.C., cited above, p. 14; *Johnston v. Orr-Ewing*, 7 App. Ca. 219 (1882); *Singer Manufacturing Co. v. Looy*, 8 App. Ca. 15 (1882); *Reddaway v. Bentham*, [1892] 2 Q. B. 639; 9 R. P. C. 503, C. A.; *Saxlehner v. Apollinaris Co.*, [1897] 1 Ch. 893; 14 R. P. C. 645, Kekewich, J.; and see the judgments of Cotton, L.J., in *Borthwick v. The Evening Post*, 37 C. D. 449 (1888); and *Turton v. Turton*, 42 C. D. 128 (1889), cited below, p. 540, and Halsbury, L.C., in *Cellular Clothing Co. v. Maxton*, [1899] A. C. at p. 334; 16 R. P. C. at p. 404; *Chivers & Sons v. Chivers & Co., Ltd.*, 17 R. P. C. 420 (1900), Farwell, J.

<sup>3</sup> Chap. XV., p. 402. *Carr & Sons v. Crisp*, 19 R. P. C. 497 (1902), Byrne, J.;

*Birmingham Small Arms Co. v. Webb*, 24 R. P. C. 27 (1907). This rule was too well settled to be disturbed by the judgments in *Derry v. Peck*, 14 App. Ca. 337 (1889), although it originally rested upon the extension of the action of deceit to cases where there was no intentional deception, which was reprobated in that case. Although in some judgments actions for passing-off have been referred to as actions for deceit, e.g., as by Vaughan Williams, L.J., in *Jamieson v. Jamieson*, 15 R. P. C. at p. 191, and by the C. A. in *London General Omnibus Co. v. Lavell*, [1901] 1 Ch. 135, they are not actions for deceit in the ordinary sense, i.e., actions brought to recover damages for a fraudulent misrepresentation made to the plaintiff. See also the judgment of Farwell, J., in *Bourne v. Swan and Edyar, Ltd.*, [1903] 1 Ch. 211, and 20 R. P. C. 105.

<sup>4</sup> See p. 403, above; and *Chivers v. Chivers*, note (2).

<sup>5</sup> *Paine & Co. v. Daniells & Sons' Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 217, C. A.



It is obvious, therefore, that a trader has much the same right in respect of his trade name, the get-up of his goods, and all the other distinctive badges and descriptions by which goods are known to be his, as he has in respect of his trade marks, although the latter right is called a right of property, and the former is commonly, but not invariably,<sup>1</sup> denied that title.<sup>2</sup> There are, however, important practical differences between the two rights. A trade mark being deliberately assumed or invented as a distinctive mark to identify the goods of its proprietor because of its supposed fitness for the purpose, could hardly be adopted by any other trader in the same market for similar goods without its use by him being calculated to deceive. But the other badges and descriptions referred to, although by use they may become more or less identified with the trader who used them first or most extensively, may have been adopted merely for purposes of convenience or of ornament, and may have been suggested by the circumstances of the trade in question, or of the trader himself; and the same considerations or circumstances may suggest the use of the same badges and descriptions to others also,<sup>3</sup> and their use of them will not necessarily be calculated to deceive. The cases in which a defendant can plead an independent right to the use of badges or descriptions which are not trade marks,—for instance, to the use of the same trade name as the plaintiff,—are much more important than the rare cases in which he can claim a right to use the trade mark of the plaintiff or a trade mark closely resembling it.<sup>4</sup>

"Property" in trade names and get-up.

It is immaterial to the existence of the plaintiff's right of action that the goods passed off as his are as good as or better than his

Inferiority of the spurious goods need not be shown.

<sup>1</sup> *Clements v. Maddick*, 1 Gill. 98 (1859), Stuart, V.-C.; *Borthwick v. The Evening Post*, 37 C. D. 449 (1887), Kay, J., property in the name of a newspaper. Cf. p. 491, note (1), below.

<sup>2</sup> See per Ld. Blackburn in *Singer Manufacturing Co. v. Wilson*, 3 App. Ca. p. 400. In *Reddaway v. Banham*, [1896] A. C. at p. 209; 13 R. P. C. 228, Ld. Herschell said that he doubted whether it was accurate to speak of there being property in such a trade mark (*i.e.*, a common law trade mark), though no doubt some of the rights which are incident to property might attach to it, especially if it was such as

to be capable of no conceivable legitimate use except by the proprietor. In *Jamieson & Co. v. Jamieson*, 15 R. P. C. at p. 191, Vaughan Williams, L.J., said it was wrong to assume that a trader acquired some sort of property in his trade name or its use, and that the action is one of deceit.

<sup>3</sup> Or to customers of other traders, as for instance in the *Dolly Blue* case, *Edge v. Gallon*, 17 R. P. C. 557 (1901), H. of L.

<sup>4</sup> See per Cotton, L.J., in *Turton v. Turton*, 42 C. D. p. 142, and Chap. XV., p. 411; and the last note.

own;<sup>1</sup> but it would seem that if they are not inferior no case of damage by injury to the plaintiff's trade reputation could be made out.

Rules and practice of infringement action apply, in general, to passing-off action.

It will be seen from the definition placed at the beginning of the chapter, and the comparison of the two actions in the preceding pages, that the rules and principles relating to the action of infringement which are collected in the last chapter, in general apply also to the action for "passing-off," substituting proof of repute for evidence of title and registration. The defences available, the relief granted, and the practice and procedure in both actions are substantially the same.

### 1. Direct Misrepresentation as to Business or Goods.

Where there is a direct misrepresentation by the defendant that the goods he sells are the goods of the plaintiff, the case presents no difficulty.

No injunction if the defendant believed that his representation was true.

Thus, in *Ainsworth v. Walmesley*,<sup>2</sup> it was shown that the defendant had sold certain spools of thread wound and marked like the plaintiff's thread, with a representation that it was of the plaintiff's make. The defendant asserted that he had himself bought it on a like representation, which he believed, and that he had disclosed the source through which he himself obtained the goods, and his assertion was not disproved. The Vice-Chancellor accordingly dismissed the suit, for if the defendant in fact believed that the thread was the plaintiff's thread, he had committed no act of which the plaintiff could complain. Had he known it was not, or threatened to repeat the representation when he knew that it was untrue, there would have been a clear case for an injunction. "The use (by one manufacturer) of the name of another manufacturer," the Vice-Chancellor said, "whether *scienter* or not, is an interference with his business which this Court will interpose to prevent, on the ground that the defendant is endeavouring to pass off

<sup>1</sup> *Blofield v. Payne*, 4 B. & Ad. 410; 2 L. J. K. B. (N. S.) 68 (1833); *Edelsten v. Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, L.C.; per Ld. Blackburn, in *Singer Manufacturing Co. v. Looy*, 4 App. Ca. p. 29. See last chapter, p. 389.

<sup>2</sup> L. R. 1 Eq. 518 (1866), Wood, V.-C. Upon the facts proved the plaintiff would probably succeed at the present

day. The Vice-Chancellor treated the representation as practically equivalent to a warranty to the purchaser and no more. Cf. the defence of "acting innocently" under the Merchandise Marks Act, 1887, sec. 2 (2) (c). *Christie v. Cooper*, [1900] 2 Q. B. 522; *Thwaites v. M'Evilly*, 21 R. P. C. 397 (1904), C. A., Ireland.

the goods of his own, or somebody else's, manufacture, as the manufacture of the plaintiff." But he added, "taking the case most strongly against the defendant, it merely amounts to this, that Walmsley stated to the purchaser, 'I sell you thread which I have bought of Wreford, but which I know to be Ainsworth's.'"

But no action lies for passing off the defendant's goods as "similar to" those of the plaintiff,<sup>1</sup> or with a representation that they are better than his,<sup>2</sup> even though the statements complained of are untrue and injurious to the plaintiff.<sup>3</sup>

Cases in which the defendant directly represents that his business is the plaintiff's business, or a branch of it, or connected with it<sup>4</sup> are equally clear as soon as the false representation is made out.

Representation that the defendant's business is that of the plaintiff.

A partner or servant who has left a well-known firm and set up a similar business of his own, is entitled to advertise his former connection,<sup>5</sup> unless restrained from doing so by contract with his late partners or employers;<sup>6</sup> but he must take care to do it so as not to suggest that the connection is still existing between them and him,<sup>7</sup> or that they have ceased to carry on business and he is their successor.<sup>8</sup>

False pretence of a business connection.

And the same rule holds good of a trader who,<sup>9</sup> or whose trustee in bankruptcy,<sup>10</sup> has sold the goodwill of his business.

Thus, where the son of the plaintiff quitted his father's employment, and described himself as "late of 107, Strand,"<sup>7</sup> an

False representation of succession to business.

<sup>1</sup> *Magnolia Metal Co. v. Tandem Smelting Syndicate*, 15 R. P. C. 701; 17 R. P. C. 477 (1900), C. A. and H. L. Cf. *Burberrys v. Raper*, 23 R. P. C. 170 (1906), Warrington, J., "identical with."

<sup>2</sup> *White v. Mellin*, [1895] A. C. 154.

<sup>3</sup> *Hubbuck v. Wilkinson*, [1899] 1 Q. B. 86, C. A., and see cases last cited.

<sup>4</sup> *Walter v. Ashton*, [1902] 2 Ch. 282.

<sup>5</sup> *Clark v. Leach*, 32 Beav. 14; 1 De G. J. & S. 409; 32 L. J. Ch. 290 (1862), Romilly, M.R., and Westbury, L.C.

<sup>6</sup> As in *Wolmershausen v. O'Connor*, 36 L. T. (N. S.) 921 (1877); and *Selby v. The Anchor Tube Co.*, W. N. (1877), 191 both Bacon, V.-C., where the style and goodwill passed, under the articles, to one partner on a dissolution. A servant must not use information acquired in his employment to enable him to solicit hi

master's customers to deal with him after he has left the employment: *Robb v. Green*, [1895] 2 Q. B. 1 315, Hawkins, J., and C. A. As to sales of goodwill, see below, p. 528.

<sup>7</sup> *Burgess v. Burgess*, 3 De G. M. & G. 896; 22 L. J. Ch. 675 (1853), Kindersley, V.-C., and L.JJ.; *Van Oppen v. L. Van Oppen*, 20 R. P. C. 617 (1903), Eady, J., and see p. 409.

<sup>8</sup> See the cases next cited, and *Labouchere v. Dawson*, L. R. 13 Eq. 322 (1872), Romilly, M.R.

<sup>9</sup> *Churton v. Douglas*, Johns. 174; 28 L. J. Ch. 841 (1859), Wood, V.-C.; *Fullwood v. Fullwood*, W. N. (1873), 93 and 185, Malins, V.-C., and L.JJ. See this further discussed below, p. 529.

<sup>10</sup> *Hudson v. Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C. See further, as to this, below, p. 530.

"Late."

injunction was granted to restrain him from continuing to do so. So, in *Scott v. Scott*,<sup>1</sup> a doorplate, bearing the words "Scott and Nixon, late Robert and Walter Scott," was held to be a representation that Walter Scott had retired, and that Scott and Nixon were carrying on the business of his old firm.

Description of new comer as "the old established."

And in a case where no such connection as those above referred to had ever existed between the defendants and the plaintiffs, but the defendants, having obtained a lease of clay mines formerly leased to the plaintiffs, described themselves in advertisements, referring not only to the mines, but to certain works also, where they carried on a trade similar to that of the plaintiffs, as *E. and J. Pearson (late Harpers and Moore)*, the description was held to be a representation calculated to lead the public to believe that the plaintiffs, Harpers and Moore, had retired from business.<sup>2</sup> So where the plaintiff and defendant were carrying on business as rival dentists in the same street, and, on the expiration of his tenancy, the plaintiff was compelled to remove, and the defendant put up a board describing himself as the "old established dentist," this was held to be a representation that the plaintiff had removed to the defendant's place of business. An interim injunction would have been granted had the defendant not undertaken to put his name very conspicuously upon the board.<sup>3</sup>

Pretence of agency.

Another description of false representation of a business connection which sometimes comes before the Courts, is where the defendant has pretended to be agent for the sale of the plaintiff's goods.<sup>4</sup>

Deceptive circulars.

The fraud is commonly effected by issuing misleading circulars or advertisements,<sup>5</sup> or by placing the deceptive name or title on

<sup>1</sup> 16 L. T. (N. S.) 143 (1866), *Wood, V.-C.*

<sup>2</sup> *Harpers v. Pearson*, 3 L. T. (N. S.) 547 (1860), cited p. 384; *Stevens v. Paine*, 18 L. T. (N. S.) 600 (1868). *Giffard, V.-C.*, and cf. *Townsend v. Jarman*, 17 R. P. C. at 657 (1900), *Farwell, J.*

<sup>3</sup> *Mallam v. Davis*, 3 Times L. R. 221 (1887), *Stirling, J.*

<sup>4</sup> *Howe v. McKernan*, 30 Beav. 547 (1862), *Romilly, M.R.* (discovery ordered); *Wheeler and Wilson Co. v. Shakespear*, 39 L. J. Ch. 36 (1869), *James, V.-C.* (injunction granted).

<sup>5</sup> As in *Purser v. Brain*, 17 L. J. Ch.

141 (1848), *Shadwell, V.-C.*; *Burrows v. Foster*, 32 Beav. 18 (1862), *L.J.J.* *Graveley v. Winchester*, *Seton*, 5th ed. 591; *Seb. Dig.* p. 162 (1867), *Wood, V.-C.* (circulars ordered to be given up); *Stevens v. Paine*, 18 L. T. (N. S.) 600 (1868), *Giffard, V.-C.*; *Selby v. Anchor Tube Co.*, *W. N.* (1877), 191. *Bacon, V.-C.* (defendants restrained from soliciting or executing orders obtained by the misrepresentations); *Mogford v. Courtenay*, 45 L. T. (N. S.) 303; *Vernon v. Hallam*, 34 C. D. 748 (1886), *Stirling, J.*; and see *Townsend v. Jarman*, note (2).

the facia over the defendant's shop,<sup>1</sup> and by opening and replying to letters addressed to, or intended for, the plaintiff, and executing the orders contained in them;<sup>2</sup> or some one or more of these devices.

As further examples of misrepresentation, not included in the classes considered below, may be mentioned claims to medals, prizes, &c., which, in fact, have been gained by the plaintiff,<sup>3</sup> or to patents under which he, and not the defendant, is working.<sup>4</sup> Such claims may enable a rival to pass his goods or business off as those of the person who is really entitled to the medals, prizes, or patents. Where they are not calculated to produce such a result no case can be made.<sup>5</sup>

In the old case of *Clark v. Freeman*,<sup>6</sup> Lord Langdale, M.R., refused to restrain the defendant from selling a quack medicine as "Sir J. Clarke's Consumption Pills," at the instance of the Sir J. Clark referred to, who was an eminent physician, on the ground that the plaintiff carried on no business in pill-making, and that the wrong done to him was a libel only, which the Court of Chancery had no jurisdiction to restrain.<sup>7</sup> It has always

Names over shops.

Executing orders intended for the plaintiff.

Claim to the prizes, medals or patents of another.

Unauthorised use of the name of a non-trader.

<sup>1</sup> *Foot v. Lea*, 13 Ir. Eq. 484 (1850), Smith, M.R.; *Burgess v. Burgess*, 3 De G. M. & G. 896; 22 L. J. Ch. 675 (1853), Kindersley, V.-C., and L.J.J.; *Scott v. Scott*, 16 L. T. (N. S.) 143 (1866), Wood, V.-C. (door plate); *Hookham v. Pottage*, L. R. 8 Ch. 91 (1872), Malins, V.-C., and L.J.J. As to the purchase of a building with the vendor's name built into it, see *Townsend v. Jarman*, p. 486, note (2), and *Boussod, Valudon & Co. v. Marchant*, 25 R. P. C. 42 (1903), C. A. As to names of places of business, see p. 504.

<sup>2</sup> *Schiele v. Brackell*, 11 W. R. 796 (1863); *Seton*, 5th ed. 584, Stuart, V.-C.; *Edgington v. Edgington*, 10 L. T. (N. S.) 299 (1864), Wood, V.-C. (a single instance proved, injunction refused); *Will v. Concoran*, 2 C. D. 69 (1873), Bacon, V.-C.; *Townsend v. Jarman*, p. 486, note (2).

<sup>3</sup> *National Starch Co. v. Munn's Patent Maizena Co.*, [1894] A. C. at p. 281, P. C.; 11 R. P. C. 294; *Franks v. Weaver*, 10 Beav. 297; 8 L. T. (O. S.) 510 (1847), Ld. Langdale; see note (5), and below, p. 526. In *King v. Gillard*, 22 R. P. C. 327 (1905), C. A., the defendant's representations as to medals, &c.,

were held at the trial to be untrue, and they were for that reason deprived of costs. In the Court of Appeal, however, the decision on this point was reversed. The medals, &c., had been awarded to the defendants, but not for the goods in question.

<sup>4</sup> *Laurie v. Baker*, 2 R. P. C. 213 (1885), Day, J.; *Pneumatic Rubber Stamp Co. v. Lindner*, 15 R. P. C. 525 (1898); see also *Paine & Co. v. Daniells & Sons' Breweries*, cited above, p. 398.

<sup>5</sup> *Tallerman v. Dowsing Radiant Heat Co.*, [1900] 1 Ch. 1, Stirling, J. A medicine vendor published as his own testimonials sent to another. There was no probability of deception. Interlocutory injunction refused. An appeal in this case was compromised. See also *Batty v. Hill*, 1 H. & M. 264; 8 L. T. (N. S.) 791. As to medals and certificates at the Exhibitions of 1851 and 1862, see 26 & 27 Vict. c. 119, below, p. 817. Cf. also *Ajello v. Worsley*, [1898] 1 Ch. 274.

<sup>6</sup> 11 Beav. 112; 17 L. J. Ch. 142 (1848).

<sup>7</sup> As to this, see *Bonnard v. Perryman*, [1891] 2 Ch. 269; *Collard v. Marshall*, [1892] 1 Ch. 571; and *Monson v. Tus-saud*, 10 Times L. R. 227 (1894).

been considered<sup>1</sup> that a narrow view was taken of the facts of this case, as the sale of pills under a well-known doctor's name is eminently calculated to suggest that the pills are prepared according to his directions, and to injure his practice if they do not meet with a favourable reception by purchasers who are, or who might become, his patients; but, in a similar recent case, *Kay, J.*, refused to treat the older authority as no longer law, at least, upon an interlocutory application.<sup>2</sup>

System of advertising.

The mere adoption by one person of a system of advertising similar to that used by a rival trader will not support a passing-off action;<sup>3</sup> nor will the adoption of a similar system of window-dressing or decoration of a shop, if only used to attract custom and not to divert customers from the plaintiff's shop.<sup>4</sup>

Passing off one quality of goods for another.

Passing off one class of a manufacturer's goods for a superior class of his goods will be restrained by injunction.<sup>5</sup>

## 2. Imitations of Trade Name, Get-up, &c.

The name or get-up must be known as that of the plaintiff or his predecessors.

Actions based upon direct misrepresentation are comparatively rare. The plaintiff's case more commonly is that the defendant has copied or imitated the trade name, the unregistered trade mark, or the get-up, or some other badge or description by which the plaintiff's business and goods are known to be his. Where the charge is one of indirect misrepresentation of this sort, the onus is cast upon the plaintiff, in the first place, to show that the things copied or imitated are reputed in the market to denote a connection between himself or his predecessors in business, and the business or goods in, upon, or in reference to which they are used. And this is precisely the proof which the plaintiff had to adduce in trade mark actions before the Acts. So far as regards marks applied or attached to the goods them-

<sup>1</sup> Lord Selborne said the case had seldom been cited except to be disapproved: *Re Rivière's Tm.*, 26 C. D. 48 (1884). See also *Maxwell v. Hogg*, L. R. 2 Ch. 307 (1867), *Id. Cairns*; *Springhead Spinning Co. v. Riley*, L. R. 6 Eq. 551 (1858), Malins, V.-C. Cf. the case of the name of a private house, below, p. 505. As to authors' names, see p. 518, below.

<sup>2</sup> *Williams v. Hodge*, 4 Times L. R. 175 (1887). Kekewich, J., did so in

*Lee v. Gibbins*, 67 L. T. 263 (1892). But see *Dockrell v. Dougall*, 80 L. T. 556 (1899), C. A.

<sup>3</sup> *Wertheimer v. Stewart, Cooper & Co.*, 23 R. P. C. 481 (1906), Kekewich, J.

<sup>4</sup> *Plotzker v. Lucas*, 24 R. P. C. 551 (1907), Mackenzie, L. O., Scotland.

<sup>5</sup> *Jameson & Son, Ltd. v. Clarke*, 19 R. P. C. 255 (1902), Ireland, Chatterton, V.-C.; *Teacher v. Levy*, 23 R. P. C. 117 (1906), Swinfen Eady, J.

selves, it has been considered, and the authorities relevant to it have been collected in a previous chapter.<sup>1</sup>

It is not, however, necessary to show that the customers who knew the goods of the plaintiff's firm by a particular name or get-up knew anything whatever about the plaintiff. It is immaterial that they did not even know his name;<sup>2</sup> for it is sufficient to prove that purchasers of his goods recognised, by the use of the marks in question in connection with them, that they were goods of a particular class, and to show that such class is, in fact, constituted by his goods.

The plaintiff himself may be unknown.

Thus, in the much contested *Yorkshire Relish* case,<sup>3</sup> the plaintiff's sauce was made according to a secret recipe, and was always bought and sold by the name alone. The defendants made a sauce described as a "wonderful match" of the plaintiff's, and their contention was that the public knew and cared nothing about the actual manufacturer, but wanted only the sauce known as *Yorkshire Relish*. The contention failed. Lord Herschell said of it in the House of Lords: "I think that the fallacy of the appellant's argument rests on this: that it is assumed that one trader cannot be passing off his goods as the manufacture of another unless it be shown that the persons purchasing the goods know of the manufacturer by name, and have in their mind when they purchase the goods that they are made by a particular individual. It seems to me that one man may quite well pass off his goods as the goods of another if he passes them off to people who will accept them as the manufacture of another, though they do not know that other by name at all. In the present case it seems to me that *Yorkshire Relish* meant the manufacture of a particular person."<sup>4</sup>

Where the existence of such repute is not shown, the action cannot succeed.<sup>5</sup> Thus, in a case where the plaintiff claimed only as the mortgagee of a business and its trade name, and had never used, and did not intend to use, the trade name,<sup>6</sup> and

Evidence of repute essential.

<sup>1</sup> Definition of a trade mark, Chap. II., p. 22; *Lawson v. The Bank of London*, 18 C. B. 84; 25 L. J. C. P. 188 (1856).

<sup>2</sup> *Lerer v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A. (*Sunlight Self-washer Soap*); see next case.

<sup>3</sup> *Powell v. The Birmingham Brewery Co.*, [1896] 2 Ch. 54; 12 R. P. C. 496; [1897] A. C. 710; 14 R. P. C. 720, and

p. 36, above.

<sup>4</sup> [1897] A. C. at p. 715.

<sup>5</sup> *Goodfellow v. Prince*, 35 C. D. 9 (1887), C. A.; *Fels v. Christopher Thomas*, 21 R. P. C. 85 (1903), C. A. (*Naptha Soap*).

<sup>6</sup> *Beazley v. Soares*, 22 C. D. 660 (1882), Pearson, J.; cf. *Clark v. Freeman*, above, p. 487.

in a case in which the plaintiffs were carrying on no business in England,<sup>1</sup> the actions were dismissed. But where the plaintiffs had no place of business in England, but their goods were imported by purchasers with the consent of the owners of the English patents, it was held that they had a reputation and market in England which the Court would protect.<sup>2</sup> No length of time during which the use of the badges in question by the plaintiff or his predecessors must have extended can be laid down,<sup>3</sup> although it seems safe to assume that an actual and practical knowledge of the connection between them and him by a number, apparently considerable, of probable dealers in, or purchasers of, the goods must be shown, and, accordingly, that a name, get-up, or other badge just adopted and brought into use would not now be protected, as a newly adopted trade mark would have been before the Registration Acts,<sup>4</sup> and would be now, if registered. On the other hand, it is not necessary that the association of the plaintiff's mark with his goods should be known all over the kingdom, or to every person in the area where it is known best.<sup>5</sup>

It has been held that three days' use of the name of a new weekly newspaper, of which fifteen copies had been sold (before the defendant's publication began), was not sufficient to give the owners any right to stop other persons using the same name for a rival paper.<sup>6</sup>

The reputed connection must be a connection of the trade or the goods, in or with which the name, get-up, or other badges are used, with the plaintiff himself, or else with his predecessors as owners of the business in which he is at the time of action,

<sup>1</sup> *Robineau v. Charbonnel*, W. N. (1876), 160, Malins, V.-C. The plaintiffs were confectioners (*quere* dressmakers) in Paris, having no agency in England. Held, no probability of injury.

<sup>2</sup> *Société Anonyme Panhard et Levassor v. Panhard Levassor Motor Co., Ltd.*, [1901] 2 Ch. 513; 18 R. P. C. 405, Farwell, J.

<sup>3</sup> This was stated to be a question for a jury in the old case of *Purser v. Brain*, 17 L. J. Ch. 141 (1848), Shadwell, V.-C. (*The London Manure Co.*).

<sup>4</sup> *Maxwell v. Hogg*, L. R. 2 Ch. 307 (1867), L.J.J.; *Hall v. Barrows*, 32 L. J. Ch. 548 (1863), Romilly, M.R.; *McAndrew v. Bassett*, 33 L. J. Ch. 561

(1864), Wood, V.-C., ante, p. 34.

<sup>5</sup> *Faulder v. Rushton*, 20 R. P. C. 477 (1902), C. A., (*Silverpan Jam*); *Weingarten v. Bayer*, 20 R. P. C. 289, 649; 22 *ib.* 341 (1905), H. of L.; *Wurm v. Webster*, 21 R. P. C. 373 (1903), Kekewich, J. (*White Viennese Band*). And below, p. 509, *area*, and p. 508, *secondary distinctive meaning*.

<sup>6</sup> *Licensed Victuallers' Newspaper Co. v. Bingham*, 38 C. D. 139 (1888). North, J., and C. A.; Cotton, L.J., said that the larger sale of the plaintiff's paper subsequently to the adoption of the defendant's name was immaterial; cf. *Maxwell v. Hogg*, supra, and p. 34, above.



using, or intending to use them. And trade names may be assigned and may devolve in connection with the goodwill of the business.<sup>1</sup> The rules in regard to assignment already discussed in relation to trade marks<sup>2</sup> apply, therefore, to trade names and similar matters, for if the things which the defendant has copied or imitated denote a connection, not with the plaintiff, but with someone else, he can have no claim to sue in respect of the deception which, as he alleges, the defendant's use of them is calculated to occasion. Thus, in *Pinto v. Badman*, the jury at the trial found, upon the same facts, that the defendant had both infringed the plaintiff's trade mark, and had passed off his goods as those of the plaintiff. On the appeal it appeared that the label and brand copied by the defendant had, not long before the commencement of the action, been assigned, without the business with which they were connected, by certain third parties to the plaintiff. Upon this ground the Court of Appeal set aside the verdict and entered judgment for the defendants, notwithstanding the finding as to "passing-off."<sup>3</sup> And neither a licence to use, nor an absolute assignment of a trade name without the goodwill of the business to which it was attached, entitles the licensee or assignee to sue in respect of the use of the name by another trader.<sup>4</sup>

Assignment and devolution of trade name, &c.

The question of repute is, however, rarely considered separately, for, as a right of property in respect of the exclusive use of marks or badges other than registered trade marks (and, to some extent, the trade name of the plaintiff) is not recognised, it is generally more convenient to deal directly with the general question: Is the defendant's conduct calculated to pass off his goods as those of the plaintiff?<sup>5</sup>

The question as to repute is not generally considered separately.

The imitation by the defendant of any of the badges by which the plaintiff's goods are known to be his, falls within the scope

<sup>1</sup> "I think it is settled by a series of cases, of which *Hall v. Burrows*" (p. 490, note (4)) "is, I think, the leading one, that both trade marks and trade names are, in a certain sense, property, and that the right to use them passes with the goodwill of the business to the successors of the firm which originally established them, even though the name of that firm be changed, so that they are no longer strictly correct": per Ld. Blackburn, in *Singer Manufacturing Co. v. Loog*, 8 App. Ca. p. 33 (1882). See above, p.

483, n. (2).

<sup>2</sup> Chap. XIII., p. 345.

<sup>3</sup> 8 R. P. C. 181 (1891). The case, so far as regards passing-off, was not expressly referred to in the judgments, but the principles stated were as applicable to that as to the case for infringement.

<sup>4</sup> *Thorneloe v. Hill*, W. N. (1894), 15; 11 R. P. C. 61, Romer, J. (*John Forrest*). It follows that the mere right to use a name cannot be sold; see below, p. 502.

<sup>5</sup> See *Jamieson & Co. v. Jamieson*, 15 R. P. C. 169 (1898), in the C. A.

of the action to restrain passing-off. The most important of these badges are the trade name of the plaintiff and the trade name and the get-up of his goods.

#### A. The Plaintiff's Trade or Firm Name.

A man's own name, or the name under which he trades, may be an ordinary trade mark, if used as such, that is, applied or attached to the goods in which he deals.<sup>1</sup> If it is represented in a special or particular manner, or in the form of the signature of the applicant or some predecessor in his business, it may be entered upon the Register.<sup>2</sup> But, although it is not so used or registered, and therefore does not become a trade mark, its use by the defendant for trading purposes in connection with goods which are not the plaintiff's is obviously calculated to mislead, unless it happens to be the name of the defendant also, or a name under which he is entitled to trade.<sup>3</sup>

Principle on which a trade name is protected.

The ground upon which the Court acts in protecting a trade name was stated by James, L.J., in *Lery v. Walker*<sup>4</sup> in the following passage: "It should never be forgotten that in these cases the sole right to restrain anybody from using any name he likes in the course of any business he chooses to carry on is a right in the nature of a trade mark, that is to say, a man has a right to say, 'You must not use a name, whether fictitious or real—you must not use a description, whether true or not, which is to represent, or calculated to represent, to the world that your business is my business, and so, by a fraudulent<sup>5</sup> misstatement, deprive me of the profits of the business which would otherwise come to me.' An individual plaintiff can only proceed on the ground that, having established a business reputation under a particular name, he has a right to restrain anyone else from injuring his business by using that name."<sup>6</sup>

<sup>1</sup> See Chap. II., p. 22.

<sup>2</sup> Sec. 9 (1) and (2). Chap. VIII., pp. 136 and 140.

<sup>3</sup> See per Wood, V.-C., *Ainsworth v. Walmesley*, L. R. 1 Eq. 518 (1866), and p. 532, below.

<sup>4</sup> 10 C. D. p. 447 (1879). And see *Mrs. Pomeroy, Ltd. v. Scalé*, 24 R. P. C. 177 (1907).

<sup>5</sup> See above, pp. 14 and 482.

<sup>6</sup> Cf. Ld. Chelmsford's statement in *Du Boulay v. Du Boulay*, L. R. 2 P. C. p. 441 (1869): "The right to the exclu-

sive use of a name in connection with a trade or business is familiar to our law; and any person using that name after a relative right of this description has been acquired by another is considered to have been guilty of a fraud, or, at least, of an invasion of another's right, and renders himself liable to an action, or he may be restrained from the use of the name by injunction"; and *Clark v. Freeman*, cited ante, p. 487; see also the judgments of James, L.J., and Jessel, M.R., quoted above, pp. 1 and 13.

In the recent case of *Society of Accountants and Auditors v. Goodway*,<sup>1</sup> the question arose whether the plaintiff society could sue to restrain non-members from using a name which was calculated to represent them as being members of it, and it was held that it suffered a legal injury thereby inasmuch that it was a matter of pecuniary value to the society to have as many members as possible, and that the acts complained of by reducing its status might affect the number of its members.

The name taken or copied by the defendant need not be that under which the plaintiff alone, and no other person, is properly trading. Thus, in *Dent v. Turpin*,<sup>2</sup> Wood, V.-C., held that each of two firms carrying on business separately as watchmakers under the name *Dent* might sue a third person, who had set up a similar business under the same name, for an injunction, delivery up of the marked articles, and an account of profits.<sup>3</sup> But if the name in question is properly used by more than one person the difficulty of showing that its use by the defendant is calculated to cause his goods to be taken for those of the plaintiff may be greatly increased.<sup>4</sup>

And as stated by James, L.J., in the judgment quoted above, the name need not be the personal name of the plaintiff.<sup>5</sup> It

It may belong to others beside the plaintiff.

It need not be the plaintiff's family name.

<sup>1</sup> [1907] 1 Ch. 489; 24 R. P. C. 159, a similar decision was given in Scotland in *Society of Accountants in Edinburgh v. Corporation of Accountants, Ltd.*, 20 R. 750.

<sup>2</sup> 2 J. & H. 139; 30 L. J. Ch. 495 (1861); *Southorn v. Reynolds*, 12 L. T. (N. S.) 75 (1865), Wood, V.-C. See also per Ld. Watson during the argument in *Powell v. The Birmingham Brewery Co.*, 14 R. P. C. at p. 726. The action in *Jamieson & Co. v. Jamieson*, 15 R. P. C. 169 (1898), failed because the defendant had not used anything identified with the plaintiff's (p. 182), not because there were other Jamiesons in the trade at Aberdeen. See the *Whitstable Oyster* case, note (4). Cf. *Worcester Royal Porcelain Co., Ltd. v. Locke*, 19 R. P. C. 479 (1902), Byrne, J.

<sup>3</sup> As to the relief granted in such a case, see the last chapter, p. 457.

<sup>4</sup> See *Jamieson & Co. v. Jamieson*, note (2), in which Vaughan Williams, L.J., said (at p. 193): "The moment it is admitted that the goods of more traders than one are denoted by the same name

you have gone a long way towards disposing of the assertion that the particular name is understood in the trade to denote the goods of the plaintiff." See also *Whitstable Oyster Co. v. Hayling Fisheries, Ltd.*, 17 R. P. C. 461 and 18 R. P. C. 434 (1901), Buckley, J., and C. A., and the judgments of Kekewich, J., in *Paine v. Daniells*, 10 R. P. C. at p. 80; and in *Finclater, Muckie, Todd & Co. v. Newman*, 19 R. P. C. 235, at p. 242; and *Mappin and Webb, Ltd. v. Leapman*, 22 R. P. C. 398 (1905), Farwell, J.

<sup>5</sup> P. 492; also *Mrs. Pomeroy, Ltd. v. Scalé*, 24 R. P. C. 177 (1907). In *Macmillan v. Ehrmann*, 21 R. P. C. 357, 647 (1904), Buckley, J., and C. A., the name in question, *Macfarlane Whiskey*, was adopted by both parties. The action failed because there was no probability of deception. In *Wurm v. Webster*, 21 R. P. C. 373 (1904), Kekewich, J., the plaintiff failed to prove that "White Viennese Band" without the addition of his name meant his band exclusively. Cf. "Defences," below, p. 543.

need not even be that of a predecessor in business, for a trader may lawfully adopt and trade under any name which is unappropriated for businesses of the same kind, and when the name has become his by repute he is as well entitled to protection for it as if it were his own.<sup>1</sup> A modern case before North, J., is an illustration of this rule. There the plaintiffs made and sold a sauce which they called by the name of one of their servants, "Holbrook's Worcester Sauce." The servant left them and joined the defendants, who thereupon advertised that they had acquired the right to make "Holbrook's Worcester Sauce." It was shown that the sauce sold by the plaintiffs was well known as theirs by the name, and the learned judge held that they had a right to the name in question, and that Holbrook could not sell it to the defendants.<sup>2</sup> In that case the sauce was identified by the name with the plaintiffs, and not with Holbrook; an opposite result would have been reached if the name had been understood to indicate that the latter person was the actual maker of the goods, and that they were his goods of which plaintiffs happened to be vendors.<sup>3</sup> Thus, in *Franke v. Chappell*,<sup>4</sup> although the plaintiff had organised a series of concerts known as "Richter Concerts" for many years, when Herr Richter made arrangements to conduct the rival concerts of the defendants, it was held that the defendants might rightly advertise their series under the name, since it was understood to mean, not concerts got up by the plaintiff, but anybody's concerts conducted by Richter.

And a manufacturer has no right to use a name under which goods made by him for a trader have become known and identified with the trader alone, or to prevent him from using it for goods made for him by others.<sup>5</sup>

In the case of a company registered under the Companies Act, 1862, it is enacted that<sup>6</sup>—

"No company shall be registered under a name identical

The trade name of a company.

Sec. 20 of the Companies Act, 1862.

<sup>1</sup> In *Isaacson v. Thompson*, 41 L. J. Ch. 101 (1871), Bacon, V.-C., for instance, the plaintiff traded as *Mme. Elise*. See also *Mrs. Pomeroy, Ltd. v. Scalé*, p. 493, note (5).

<sup>2</sup> *Birmingham Vinegar Brewery Co. v. Liverpool Vinegar Co.*, W. N. (1888), 139, an interlocutory injunction was granted; cf. *Dence v. Mason*, W. N. (1877), 23; (1878), 42, Malins, V.-C. (*Brand's Essence of Beef*).

<sup>3</sup> As to joint trade marks, see p. 383, above.

<sup>4</sup> 57 L. T. (N. S.) 141 (1887), Chitty, J.

<sup>5</sup> *Defries v. Electric and Ordnance Accessories Co.*, 23 R. P. C. 341 (1906), Joyce, J. On the other hand, a merchant cannot continue to use a name identified with the place of origin of the goods, e.g., a vineyard, after he has ceased to obtain his goods from it, *Van Zeller v. Mason, Catley & Co.*, 25 R. P. C. 37 (1907), Joyce, J.

<sup>6</sup> 25 & 26 Vict. c. 89, s. 20.

with that by which a subsisting company is already registered, or so nearly resembling the same as to be calculated to deceive, except in a case where such subsisting company is in the course of being dissolved,<sup>1</sup> and testifies its consent in such manner as the Registrar requires."

And the section further makes provision for a change of the name of any company which, through inadvertence or otherwise, is registered under a name which falls within the prohibition.

As Buckley, L.J., pointed out in his note to the section,<sup>2</sup> it is to be observed (1) that it only applies to the case of taking the name of a subsisting company already registered, and not to a case like *Hendriks v. Montagu*,<sup>3</sup> where a new company proposes to register in the name of, or in a name closely resembling, the name of an old-established company, which is not registered, or of a firm or individual trader;<sup>4</sup> (2) that so soon as the new company is registered, the section has ceased to be applicable, so that the old registered company cannot found upon the section any claim for an injunction to restrain the newly registered company from trading under the name;<sup>5</sup> (3) that the Act forbids registration in the same or a similar name, irrespective of the fact whether the business to be carried on under the name is the same or not.<sup>6</sup>

But the provision of the section is merely in supplement of the ordinary rule upon which the Court acts in protecting trade names, and that rule is in no way limited by the registration of the name objected to as the name of the defendant company.<sup>7</sup> An injunction will therefore be granted to restrain the defendant from carrying on the same trade as that of the plaintiff under a name so nearly resembling his as to be calculated to deceive, whether it has been registered as the name of the defendant

The section is supplementary to the common law.

<sup>1</sup> For example, upon a reconstruction.

<sup>2</sup> Buckley on the Companies Acts, see 8th ed. p. 27; see also Palmer's Company Precedents, 9th ed., Pt. I., p. 365.

<sup>3</sup> 17 C. D. 638 (1881), Jessel, M.R., and C. A.

<sup>4</sup> *Hoby v. Grosvenor Library Co., Ltd.*, 28 W. R. 386.

<sup>5</sup> But the section lays down the principle which ought to govern the Court in dealing with two companies, one of which is an old-established company, the other of which is an infant company. Per Cozens-Hardy, M.R., in *Daimler Motor*

*Co.* (1904), *Ltd. v. London Daimler Co., Ltd.*, 24 R. P. C. 379, at p. 385.

<sup>6</sup> In considering similar names, however, a difference in the nature of the businesses may be material: *Acrators, Ltd. v. Tollit*, [1902] 2 Ch. 319; 18 R. P. C. 418, Farwell, J. See also the *Dunlop* case, cited below, p. 540.

<sup>7</sup> *Merchant Banking Co. of London v. Merchants Joint Stock Bank*, 9 C. D. 560 (1878), Jessel, M.R.; *Manchester Brewery Co., Ltd. v. North Cheshire and Manchester Brewery Co., Ltd.*, [1898] 1 Ch. 539; [1899] A. C. 83.

*Hendriks v.  
Montagu.*

company or not, and, in the latter event, to restrain the defendants also from applying for registration of the name. In *Hendriks v. Montagu*,<sup>1</sup> the leading case on the point, the plaintiff, on behalf of the *Universal Life Assurance Society*, sued certain persons who were the promoters of an intended new company, to be called the *Universe Life Assurance Association*, and an injunction in the following form was granted:—

The injunction granted.

“To restrain the defendants from applying to the Registrar of joint stock companies in England, for registration under the Companies Acts, of any company to be incorporated under the name of the *Universe Life Assurance Association*, or any other name likely to mislead or deceive the public into the belief that the company, being incorporated as aforesaid, is the same as the *Universal Life Assurance Society*, from issuing or publishing advertisements, circulars, or prospectuses representing that a company is to be incorporated pursuant to the Companies Act, 1862, under the name of the *Universe Life Assurance Association, Limited*, or any such other name as aforesaid; and from carrying on or commencing any business under the name of the *Universe Life Assurance Association, Limited*, or any such other name as aforesaid.”

The Master of the Rolls had refused the first branch of the injunction (as to the application to register), on the ground that no case could be made for granting it except under the section, and that the section did not apply, because the plaintiffs were not a registered company, and he had refused the second and third branches (as to advertising and carrying on business), on the ground that it was not shown that the defendants would carry on the same business as the plaintiffs, or that, if they did, the resemblance of the names must necessarily lead to the unfair appropriation by them of part of the plaintiffs' business; but the Court of Appeal overruled all these objections. The Lords Justices held that the defendants were shown to have threatened and intended to carry on the same business, and that it was morally certain that, if they did so under the name they had adopted, persons who had heard of the *Universal* would be misled into going to the *Universe*. And this, the Court said, according to the rules of equity, was sufficient, without reference to the Act, to entitle the plaintiffs to the injunction they claimed.

<sup>1</sup> 17 C. D. 638 (1881), Jessel, M.R., and C. A.

In *Panhard et Levassor v. Panhard-Levassor Motor Co., Ltd.*,<sup>1</sup> the injunction was granted against the defendant company and also against the seven signatories of the Memorandum of Association forbidding them to use the names, and also forbidding the latter to allow the company to remain registered under its then present name.

Injunction against signatories of Memorandum of Association.

The ground of the interference of the Court is, that the use of the defendant company's name, or its intended name, is calculated to deceive, and so to divert business from the plaintiff to the defendant, or to occasion a confusion between the two businesses. If this is not made out there is no case.<sup>2</sup>

And the mere employment of a term which is descriptive of the business of both the parties will not of itself be accepted as sufficient to make out the plaintiff's case.<sup>3</sup> If it were it would give the first user a monopoly in the term. "If a company which does colonial business cannot call itself colonial, it is obvious that, under a species of assertion that the word colonial is symbolical, the plaintiffs might prevent every other person using it as descriptive of his trade."<sup>4</sup>

No monopoly allowed in names merely descriptive.

In *The Guardian Fire and Life Assurance Co. v. The Guardian*

Cases of company trade names.

<sup>1</sup> [1901] 2 Ch. 513; 18 R. P. C. 405, Farwell, J.

<sup>2</sup> See *Daimler Motor Co. (1904), Ltd. v. London Daimler Co., Ltd.*, 24 R. P. C. 379 (1907), C. A.; and *Electromobile Co., Ltd. v. British Electromobile Co., Ltd.*, 25 R. P. C. 149 (1908), C. A.; and the other cases collected below. And the principles to be applied are, at any rate, extremely analogous to those which are applicable in ordinary passing-off cases in which the Court has to consider whether a trade name, or trade description, or a description of a particular class of goods, or the get-up of a particular class of goods, is or is not likely to deceive: *British Vacuum Cleaner Co., Ltd. v. New Vacuum Cleaner Co., Ltd.*, [1907] 2 Ch. 312; 24 R. P. C. 641, Parker, J.

*Colonial Assurance Co., Ltd.*, 33 Beav. 548; 33 L. J. Ch. 741 (1864); see also *India and China Tea Co. v. Teede*, W. N. (1871), 241, Jessel, M.R.; and *The Australian Mortgage, Land, and Finance Co. v. The Australian and New Zealand Mortgage Co.*, W. N. (1880), 6, C. A., cited p. 500: *Daimler Motor Car Co. v. British Motor Traction Co.*, 18 R. P. C. 465 (1901), Buckley, J. (*Daimler Wagon Co.*). The application, which failed in the last case, succeeded six years later when *Daimler* was no longer merely descriptive: *Daimler, &c. Co. v. London Daimler Co.*, 24 R. P. C. 379, C. A. Also *Aerators, Ltd. v. Tollit*, [1902] 2 Ch. 319; 19 R. P. C. 418, Farwell, J.; *British Vacuum Cleaner Co., Ltd. v. New Vacuum Cleaner Co., Ltd.*, 24 R. P. C. 641 (1907), Parker, J.; *H. E. Randall, Ltd. v. Bradley & Son, Ltd.*, 24 R. P. C. 657, 773 (1907), Warrington, J., and C. A.; *Electromobile Co., Ltd. v. British Electromobile Co., Ltd.*, 24 R. P. C. 688; 25 R. P. C. 149 (1908), Warrington, J., and C. A.

<sup>3</sup> Cf. the rule against descriptive trade marks, Chap. II., p. 37; Chap. VIII., p. 183; and as to infringement in similar cases, Chap. X., pp. 253 and 254, and below, p. 507.

<sup>4</sup> Per Ld. Romilly, in *The Colonial Fire Assurance Co. v. The Home and*

and *General Insurance Co.*,<sup>1</sup> the plaintiff company were a very old-established institution, and were commonly known as *The Guardian* or *The Guardian Assurance Co.*, and the defendant company had been lately formed by the reconstruction of the *Guardian Horse and Vehicle Insurance Association*. They had assumed powers to carry on general insurance business, and their offices were near those of the plaintiffs, in Lombard Street. It was shown that there were two other companies doing some insurance business in other parts of London, under names comprising the word *guardian*; but notwithstanding this, Jessel, M.R., held, that the defendants' new name was calculated and intended to deceive, and he would have granted an injunction had they not undertaken to call themselves the "Guardian Horse, Vehicle, and General Insurance Company."

Taking an existing name as a whole.

If a new company take the whole name of a subsisting company, even though that name is of a descriptive character, there is a high probability of deception.<sup>2</sup> Thus, where the Manchester Brewery Co., Ltd., had a brewery and a large business at Manchester, a new company which had acquired a brewery at Macclesfield with a business extending to Manchester, as well as other towns, attached to it, was restrained by the Court of Appeal from trading as the "North Cheshire and Manchester Brewery Co., Ltd." The decision was affirmed by the House of Lords on the ground that the use of the name would amount to a representation that the new company was an amalgamation comprising the business of the complainants.<sup>2</sup> But there is no rule of law that the use of a descriptive word in the name of a new company is deceptive and therefore unlawful, if it forms part or even the whole of the name of a previously existing company engaged in a similar trade.<sup>3</sup>

Name suggesting an amalgamation.

Name comprising plaintiffs' trade name.

In the *Eastman Co. v. The John Griffiths Cycle Corporation, Ltd.*, and the *Kodak Cycle Co., Ltd.*, the first-named defendants had promoted the *Kodak Cycle Co., Ltd.*, to which they gave a name comprising as its distinctive element the trade name of the plaintiffs' goods, *Kodak*. Both defendants were restrained from carrying on

<sup>1</sup> 50 L. J. Ch. 253 (1880), Jessel, M.R.

<sup>2</sup> *Manchester Brewery Co., Ltd. v. North Cheshire, & Co., Ltd.*, [1898] 1 Ch. 539; [1899] A. C. 83.

<sup>3</sup> In *Aerators, Ltd. v. Tollit*, 19 R. P. C. 418 (1902), Farwell, J., a claim to stop *Automatic Acerator Patents, Ltd.*, failed; *British Vacuum Cleaner Co., Ltd. v.*

*New Vacuum Cleaner Co., Ltd.*, [1907]

2 Ch. 312; 24 R. P. C. 641, Parker, J.; *Randall v. Bradley*, 24 R. P. C. 657, 773 (1907), Warrington, J., and C. A. (*Anglo-American Shoe Co.*): *Electromobile Co., Ltd. v. British Electromobile Co., Ltd.*, 24 R. P. C. 688; 25 R. P. C. 149 (1908), Warrington, J., and C. A.



business under the name Kodak Cycle Co., Ltd., or under any name comprising the word *Kodak*.<sup>1</sup>

A limited company, by the purchase of a business, often becomes entitled to a trade name which is different from its registered name, and, provided that sec. 41 of the Companies Act is not violated, there seems to be no objection to its continuing the use of such a name in connection with its own business, and it could, whether it had so used the name or not, if it had not abandoned it, prevent a person so using it as to represent that he was carrying on the business formerly carried on under the name; and, moreover, the company could sell the name with, of course, the goodwill.<sup>2</sup> Although a limited company could not, it is presumed, sell to a purchaser of its goodwill the whole of its registered name, yet a third person would not be permitted after the dissolution of the company to adopt its name (except the word "limited") so as to lead to the belief that his business was that formerly carried on by the company to the injury of the purchaser.<sup>3</sup>

Assignments of trade name to or by a limited company.

Injunctions were granted in *Hoby v. The Grosvenor Library Co., Ltd.*,<sup>4</sup> where the plaintiff's library was called the "Grosvenor Library," and in *The Accident Insurance Co., Ltd. v. The Accident, Disease, and General Insurance Co., Ltd.*,<sup>5</sup> where the plaintiff

Injunctions granted.

<sup>1</sup> 15 R. P. C. 105 (1898), Romer, J. See the order below, p. 738. See also *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Lubricant Co.*, 16 R. P. C. 12 (1899), Romer, J., and cf. the later *Dunlop* case cited p. 497, note (2).

<sup>2</sup> *Townsend v. Jarman*, 17 R. P. C. 649 (1900), Farwell, J.; *Macmillan v. Ehrmann*, 21 R. P. C. 357, 647 (1904), Buckley, J., and C. A. Past contraventions of the section above referred to do not bar the plaintiffs: *Pearks, Gunston and Tee, Ltd. v. Thompson, Talmey & Co.*, 18 R. P. C. 185 (1901), Farwell, J.; *Randall, Ltd. v. British and American Shoe Co.*, 19 R. P. C. 393 (1902), Swinfen Fady, J. But where a plaintiff company in order to comply with the section has always used the special name in conjunction with its own registered name, it may be in a difficulty in showing that the name by itself indicates the company or its goods: see *Randall, Ltd. v. Brudley*, 24 R. P. C. 773 (1907), C. A.

<sup>3</sup> *Montreal Lithographing Company v.*

*Sabiston*, [1899] A. C. 610, J. C., really supports this proposition, although the actual decision, which turned on the special facts of the case (see *Townsend v. Jarman*, 17 R. P. C. 649), was there in favour of the defendant, it being held that the mere use of the name was not, under the circumstances, calculated to deceive.

<sup>4</sup> 28 W. R. 386.

<sup>5</sup> 54 L. J. Ch. 104 (1884), Pearson, J.; see also *Wolmershausen v. G. S. Wolmershausen & Co., Ltd.*, W. N. (1892), 87, Chitty, J.; *Saunders v. The Sun Life Assurance Co. of Canada*, [1894] 1 Ch. 637; 10 Times L. R. 183, Stirling, J.; and *Premier Cycle Co., Ltd. v. Premier Tube Co., Ltd.*, 12 T. L. R. 481 (1896), Chitty, J., interlocutory injunction granted against the use of *Premier* as part of the title of the defendant company, whose works had before the formation of the company for six years been known as "Premier Mills."

company was popularly known as *The Accident Company* or *The Accident*; also in the cases specially mentioned above.<sup>1</sup>

Injunctions  
refused.

In the following cases injunctions were refused: *London and Provincial Law Assurance Society v. London and Provincial Joint Stock Life Assurance Co.*,<sup>2</sup> although there was evidence that the former company was usually called the *London and Provincial Insurance Co.*; *London Assurance v. London and Westminster Assurance Corporation*;<sup>3</sup> *Colonial Life Assurance Co. v. Home and Colonial Assurance Co., Ltd.*;<sup>4</sup> *London and County Banking Co. v. Capital and Counties Bank* (cited in the next case); *Merchant Banking Co. of London v. Merchants Joint Stock Bank*;<sup>5</sup> *The Army and Navy Co-operative Society, Ltd. v. The Junior Army and Navy Stores, Ltd.*;<sup>6</sup> *Australian Mortgage Land and Finance Co. v. Australian and New Zealand Mortgage Co.*;<sup>7</sup> *National Cash Register Co., Ltd. v. Theeman* (who was trading as the *Cash Register Co.*);<sup>8</sup> *Scottish Union and National Insurance Co. v. Scottish National Insurance Co., Ltd.*<sup>9</sup> In *Bumstead v. The General Reversionary Co., Ltd.*, an interlocutory injunction was refused, because, although the defendant company had adopted a name resembling that of the company of which the plaintiff was secretary, the General Reversionary and Investment Co., yet there was no probability of deception because the former was a small Liverpool concern, and the latter a very large London one.<sup>10</sup> See also the *Daimler, Dunlop, Electromobile, Vacuum Cleaner, and American Shoe* cases.<sup>11</sup>

The company  
may continue  
an established  
name.

A limited company formed to take over a business may adopt and use a name embodying a name under which the business has already been lawfully and properly carried on.<sup>12</sup> This was

<sup>1</sup> See the *Daimler* case, above, p. 497, note (1). In *Army and Navy Co-operative Society, Ltd. v. Army, Navy and Civil Service Co-operative Society of South Africa, Ltd.*, 19 R. P. C. 575 (1902), on appeal from an interlocutory injunction granted by Buckley, J., the defendants agreed to change their name to *Naval, Military and Civil Service Co-operative Society of South Africa, Ltd.*

<sup>2</sup> 17 L. J. Ch. 37 (1848), Shadwell, V.-C.

<sup>3</sup> 32 L. J. Ch. 664 (1863), Stuart, V.-C.

<sup>4</sup> 33 Beav. 548; 33 L. J. Ch. 741 (1864), Romilly, M.R.

<sup>5</sup> 9 C. D. 560 (1878), Jessel, M.R.

<sup>6</sup> Seb. Dig. p. 393 (1879), Jessel, M.R.

<sup>7</sup> W. N. (1880), 6, C. A. James, L.J., said: "The difficulty in these cases was, that while the business name of another could not be appropriated, a man could not, on the other hand, give himself any monopoly in a name which, as in this case, merely described the nature of the business or the locality of its operations"; see above, p. 497.

<sup>8</sup> 24 R. P. C. 211 (1907), Kekewich, J.

<sup>9</sup> 25 R. P. C. 560 (1908), Scott, J. The classes of business were quite different.

<sup>10</sup> 4 Times L. R. 2 (1885), Stirling, J.

<sup>11</sup> Above, p. 497, note (2) and (4).

<sup>12</sup> *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Motor Co., Ltd.*, 23 R. P. C. 761

fully recognised by Stirling, J., in the case of *Tussaud v. Tussaud*,<sup>1</sup> where, however, the condition did not obtain. In that case an unsuccessful attempt was made by the defendant to shelter himself under the general exception from the principle stated at the head of this chapter, that anyone may honestly trade under his own name, which is discussed more fully below.<sup>2</sup> The plaintiffs, Madame Tussaud & Sons, Ltd., were the owners of a waxwork exhibition originally founded by a Madame Tussaud, and subsequently carried on by the father and uncles of the defendant. Their business was often referred to as *Madame Tussaud's*, and not infrequently as *Tussaud's* only. The defendant, who was a wax modeller by trade, was promoting a company to be called *Louis Tussaud, Ltd.*, to open and carry on a waxwork exhibition under that name in Shaftesbury Avenue, the plaintiffs' exhibition being situated in the Marylebone Road. He was to be engaged as manager of the exhibition and modeller of the exhibited figures. He had never carried on, and did not possess the goodwill of, any business in any such exhibition.

It follows, said the learned judge, "from the decisions in *Burgess v. Burgess*<sup>3</sup> and *Turton v. Turton*,<sup>4</sup> that the defendant is at perfect liberty to open on his own account, and to carry on in his own name, an exhibition of waxworks. Further, he might take partners into his business, and carry it on under the name *Louis Tussaud & Co.* That seems to me to have been expressly decided in *Turton v. Turton*. Having commenced business on his own account, I apprehend that he might sell it with the benefit of the goodwill to third parties, and that the third parties might, if they thought fit, continue to carry on the business under the same name—that of the defendant; that is to say, they would be entitled to the full benefit of the goodwill which they had honestly and legitimately purchased from the defendant.

The judgment  
of Stirling, J.

(See.) ; aff. in H. L. 24 R. P. C. 757. In *S. Chivers & Sons v. S. Chivers & Co., Ltd.*, 17 R. P. C. 420 (1900), Farwell, J., said, at p. 426 : "To my mind, no element of suspicion of fraud attaches to a man who has established a business under his own name if he turns that business into a limited company, and applies to that limited company his own name with the word "limited," because the reason for doing so is obvious, that he desires to retain the goodwill which he has gained for that name."

<sup>1</sup> 44 C. D. 678 (1890), Stirling, J. ; followed and approved in *Fine Cotton Spinners, &c. Association, Ltd. v. Harwood, Cash & Co., Ltd.*, [1907] 2 Ch. 184; 24 R. P. C. 533, Joyce, J. ; *Rendle v. Rendle & Co.*, 63 L. T. 94 (1890), Kay, J., is a somewhat similar case.

<sup>2</sup> Page 532.

<sup>3</sup> 3 D. M. & G. 806 ; 22 L. J. Ch. 675 (1853), Knight Bruce and Turner, L.J.J., cited p. 533.

<sup>4</sup> 42 C. D. 128 (1889), C. A., reversing North, J., cited p. 540.

Again, the third parties might transfer the business and the goodwill to a joint stock company, and (without expressing a final opinion on the point) I am not prepared at present to say that that company might not be registered under the same name as had previously been used in connection with the business."<sup>1</sup>

Right to use a name not attached to any goodwill cannot be sold.

But the defendant could not, it was held, sell the right to use his name in connection with a business which he had never carried on, and in which he had no interest whatever, or in which he stood simply in the position of a paid servant.<sup>2</sup> And the proper inference to be drawn from the facts of the case *prima facie* was, the learned judge concluded, that the object of the defendant in promoting the proposed company was to induce the world to believe that the business intended to be carried on was that of the plaintiff company or a branch of it, notwithstanding that the prospectus issued by the defendant plainly stated on the face of it that the new exhibition had no connection with the plaintiff company. An interim injunction in the terms of that in *Hendriks v. Montagu*,<sup>3</sup> set out above, was accordingly granted.

In three cases which subsequently came before the Courts attempts appear to have been made to carry through the series of operations indicated in the judgment just cited, but in each instance the defence which might have been founded upon them was displaced by evidence of deliberate fraud.

*Brinsmead & Co. v. T. E. Brinsmead, Ltd.*

In *The Brinsmead* case,<sup>4</sup> the plaintiffs were the well-known firm of pianoforte makers. T. E. Brinsmead and his sons, who were relatives of the partners, and had been in their employment, started a small independent business as "T. Brinsmead & Sons." They were restrained from trading under the name Brinsmead without using their full names, and they then promoted the defendant company under the name of "Thomas Edward Brinsmead & Sons, Ltd.," with the fraudulent intention of getting some of the plaintiffs' business. By the use of this name they induced the public to subscribe for shares in the belief that the company possessed the plaintiffs' business. The defendants were restrained from using the name Brinsmead in connection with

No connection.

<sup>1</sup> 44 C. D. p. 687. See p. 500, note (12).

<sup>2</sup> See also *Five Cotton Spinners v. Harwood, Cash & Co., Ltd.*, p. 501, note (1). Cf. *The Birmingham Vinegar Brewery Co. v. The Liverpool Vinegar Co.*, supra, p. 494; and *Warner v. Warner*, 5 Times L. R. 327, 359 (1889), Stirling, J., and C. A. (*Warner's Cure*); and see

below, p. 543.

<sup>3</sup> Above, p. 496.

<sup>4</sup> *John Brinsmead & Co. v. Thomas Edward Brinsmead & Sons, Ltd.*, 12 Times L. R. 631; 13 *ibid.* 3 (1896), North, J., and C. A. The facts appear in *Re T. E. Brinsmead & Sons, Ltd.*, [1897] 1 Ch. 45, 496.

pianos without an express statement that they had no connection with the plaintiffs' firm.

In *Pinet's* case,<sup>1</sup> a man who had carried on business in special boots for lame persons as "Maison Pinet," assigned his business to a company called "Maison Pinet, Ltd." The French firm of Pinet et Cie. complained of this, but the defendants contended that they intended only to trade in the special boots, and on that ground Kekewich, J., refused an interlocutory injunction. The Court of Appeal did not believe the defendants' story, and granted the injunction restraining them from carrying on their business in boots under the name Pinet without clearly distinguishing their boots from those of the plaintiffs. Subsequently it was discovered that the vendor to the defendant company had assumed the name Pinet for the purpose of defrauding the plaintiffs, and an injunction was then granted forbidding the use of the name by the defendants, and forbidding the liquidator of the company from selling the right to use the name in connection with boots.<sup>2</sup>

*Pinet et Cie. v. Maison Pinet, Ltd.*

And in *Valentine's* case,<sup>3</sup> the Court of Appeal came to the conclusion that there had been an attempt to get the benefit of the plaintiffs' reputation, and in addition to relief in respect of passing-off, they restrained the defendant company from carrying on the business of manufacturers of extract of meat under any name of which *Valentine* formed part.

In some cases of trade name, the defendant has sought to justify the use of the name by setting up the purchase of a business carried on under a name identical with or similar to that of the plaintiff, but the business so purchased has been one dealing in different goods. Whatever may be the legitimate rights of a *bona fide* purchaser of a business to extend it beyond its original scope, the use of the name to defraud the plaintiff by such means will not be allowed by the Courts.<sup>4</sup>

Purchase of a name.

On the other hand, in *The Dunlop* case,<sup>5</sup> a company formed

<sup>1</sup> *Pinet et Cie. v. Maison Pinet, Ltd.*, 14 R. P. C. 933 (1897), C. A.

<sup>2</sup> *Pinet et Cie. v. Maison Louis Pinet, Ltd.*, 15 R. P. C. 65 (1898), North, J.

<sup>3</sup> *Valentine Meat Juice Co. v. Valentine Extract Co., Ltd.*, 17 R. P. C. 673; 83 L. T. 259 (1900), C. A. The facts will be found more fully set out below, p. 537.

<sup>4</sup> *Holloway v. Clent*, 20 R. P. C. 525 (1903), Swinfen Eady, J.; *Rodgers v.*

*Hearnshaw*, 23 R. P. C. 349 (1906), Buckley, J.; *Morrall v. Hessin*, 19 R. P. C. 557; 20 R. P. C. 429 (1903), Swinfen Eady, J., and C. A. Cf. *Mappin and Webb v. Leapman*, 22 R. P. C. 398 (1905), Farwell, J.

<sup>5</sup> *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Motor Co., Ltd.*, 23 R. P. C. 761 (Sc.); aff. 24 R. P. C. 572 (1907), H. L. Cf. *Same v. Dunlop Lubricant Co.*, 16 R. P. C. 12 (1899), Romer, J.

under the name Dunlop Motor Co., Ltd., by R. and J. F. Dunlop to purchase and carry on the motor branch of a motor and cycle repairing business in Edinburgh, which they had previously carried on in partnership, maintained its right to use the name against the well-known Dunlop Pneumatic Tyre Company. There was no proof of fraud and there was no great similarity in the objects of the companies, and, in the view of the Court, there was no probability of deception.

Name of  
business,  
house, or  
factory.

A trader has the same rights in respect of the name of the house, shop,<sup>1</sup> or factory,<sup>2</sup> where he carries on his trade or business, as he has in respect of his trade name. He can, therefore, support an action for passing-off, and obtain an injunction by showing that the name of the house, &c., has a reputed connection with his trade or business or goods, and that the defendant, without having any independent right to do so,<sup>3</sup> is using for

<sup>1</sup> *Boussol, Valadon & Co. v. Marchant*, 24 R. P. C. 665; 25 *ib.* 42 (1907), Parker, J., and C. A. (*Goupil Gallery*); *Hudson v. Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C. (*Osborne House*); *Boulnois v. Peake*, 13 C. D. 512, n. (1868), Giffard, V.-C. (*The Carriage Bazaar*); *Bodega Co. v. Owens*, 6 R. P. C. 236; 7 *ib.* 31; 23 L. R. Ir. 371 (1889), Chatterton, V.-C. (*Bodega Wine Shop*). *Great North of Scotland Rail. Co. v. Mann*, 19 R. 10, 35 (*Palace Hotel*); *Cowan v. Miller*, 22 R. 833 (*Sun Foundry*); both Scotch cases. A number of American decisions are cited by Mr. Sebastian, 3rd ed., p. 294, 4th ed., p. 270. In *Charleston v. Campbell*, 4 Sess. Cas. 4th ser. 149 (1876), an injunction to restrain the use of the "Royal Station Hotel," at the instance of the proprietor of the "Station Hotel," was refused, because the title was merely descriptive.

<sup>2</sup> *Braham v. Beachin*, 7 C. D. 848 (1878), Fry, J. (*Railstock Colliery*); *Montgomery v. Thompson*, 41 C. D. 35; [1891] A. C. 217; 8 R. P. C. 361, Chitty, J., C. A., and H. L. (*Stone Brewery*).

<sup>3</sup> In *Mason v. Queen*, 23 Scot. L. R. 641 (1886), the Lord Ordinary held that the goodwill and trade name of an hotel could not be transferred so as to entitle the transferee to stop a new occupier of the building from using the old name.

The "Waverley Hotel," Glasgow, was taken by a railway company under compulsory powers in May, 1884, compensation being paid for loss of business. The proprietor, who had other "Waverley Hotels" in London and Edinburgh, transferred the goodwill and the right to use the name to the plaintiff, who thereupon changed the name of her own house to "Waverley" and put up a notice of removal upon the old building. In January, 1885, the railway company let the old building to the defendant, who opened it as the "Old Waverley." Held: (1) the plaintiff had no exclusive right to the name, and (2) (but *quere* on the special facts) there was no case of passing-off. See also *Nicholson v. Buchanan*, 19 R. P. C. 321 (1900), Stirling, J., where a firm who were the owners of a business and distillery, sometimes known as "the Black Swan Distillery," which had had a figure of a black swan outside, and who also had a black swan for a trade mark, sold first the premises to the defendants, and subsequently the goodwill and trade mark to the plaintiffs. The vendors had been known chiefly for gin, whereas the defendants carried on business on the premises in Scotch whisky, no distilling being done there. On the evidence it was held that there was no probability of deception, and the action in which

business purposes a name which is calculated to cause his trade, business, or goods to be taken for, or to be confounded with, the plaintiff's.<sup>1</sup> There is no right to the exclusive use of the name of a mere private house,<sup>2</sup> and no cause of action arises where, although the defendant has adopted, for business purposes, an address likely to be confused with that of the plaintiff, yet the businesses of the parties are so different that no damage can result to the plaintiff's trade.<sup>3</sup>

If the goodwill of a business, including the right to a name derived from the house where the business is carried on, be sold, the purchaser is generally entitled to continue to use the name even though he does not acquire, or ceases to possess, the house itself.<sup>4</sup>

If the name in question is taken from a building where a firm carries on business, it may be that on the removal of the firm the name still attaches to the building and may properly be used by the next tenant. The question appears to be one of fact.<sup>5</sup>

### B. The Trade name of the Plaintiff's Goods.

A name which is used upon or in connection with goods for the purpose of indicating that they are the goods of a trader by virtue of manufacture, selection, certification dealing with or offering for sale, is a trade mark.<sup>6</sup> And if it is within any of the classes enumerated in sec. 9, it may be registered as a trade mark. But whether or not the name is used upon or in connection with the goods, so as to conform to the definition just stated, or registered

the plaintiff's complained of the use of the words "Black Swan" and the device was dismissed. In *Cooper and M'Leod v. MacLachlan*, 18 R. P. C. 380; 19 R. P. C. 27 (1902), the defendant was held entitled to use "Castle Brewery" which the plaintiffs also used, there being no probability of deception. Cf. *Findlater, Mackie, Todd & Co. v. Newman*, 19 R. P. C. 235 (1902), Kekewich, J., where "Findlater's Corner" was held to be associated with the place where the defendant carried on business. As to the assignment of marks having a local connotation, see above, p. 349.

<sup>1</sup> See note (1), p. 504, above.

<sup>2</sup> *Day v. Brownrigg*, 10 C. D. 294

(1878), C. A.

<sup>3</sup> *Street v. Union Bank of Spain and England*, 30 C. D. 156 (1885), Pearson, J.; the plaintiffs were advertising agents (telegraphic cypher).

<sup>4</sup> *Rickerby v. Reay*, 20 R. P. C. 38 (1903), Byrne, J. See also the *Goupil Gallery* case, above, p. 504, note (1).

<sup>5</sup> See *Mason v. Queen, Nicholson v. Buchanan*, supra, note (3), p. 504, *Charleston v. Campbell*, supra, p. 504, note (1), and *Rickerby v. Reay*, note (4); *Booth v. Jarrett*, 52 How. Pr. 169 (1876), New York ("Booth's Theatre"); and *Sebastian*, 4th ed., p. 272.

<sup>6</sup> Trade Marks Act, 1905, sec. 3, Chap. II., p. 24.

as a trade mark, if it is in fact known in the market as the distinctive name of the goods of a particular trader, no one else may use it for dealings in other goods of the same description as those in connection with which it has acquired its distinctive signification.

The acquisition of a trade name by the use of it in connection with the sale of, or with dealings in, goods has already been considered, and the authorities bearing on the subject have been collected in the chapter on the definition of a trade mark. It will be sufficient, therefore, to summarise shortly the results deduced from the reported cases.

The qualified right in the trade name,—a right to prevent a defendant from passing off his goods as those of the plaintiff by the use of it,—exists only with regard to goods of the kind for which the plaintiff uses it, and to which the connection with his business suggested by the use of the name extends.<sup>1</sup> So, where the proprietors of *The Morning Post* sought to restrain the publishers of a new evening newspaper from calling their paper *The Evening Post*, the Court of Appeal, holding, as an inference of fact, that there was no probability of the defendant's paper being taken for the plaintiff's, or being taken to have any connection with it so as to cause damage to the plaintiffs, dismissed the action.<sup>2</sup> But if the name, although not actually used by the plaintiff for the particular kind of goods to which the defendant has applied it, is so identified with the plaintiff that the defendant's use of it will induce the belief that his goods are those of the plaintiff, or that his business is an extension of,<sup>3</sup> or an amalgamation with,<sup>4</sup> or is otherwise connected with the plaintiff's

Right restricted to particular goods or business.

*The Evening Post* case.

<sup>1</sup> Page 31; and cf. the rule in respect of the infringement of trade marks, Chap. XV., p. 392.

<sup>2</sup> *Borthwick v. The Evening Post*, 37 C. D. 449 (1888), C. A., overruling Kay, J.; but see *Re The Australian Wine Importers, Ltd.*, 41 C. D. 278; 6 R. P. C. 311 (1889), Kay, J., and C. A., where a mark for wine was refused registration, as too closely resembling a mark for spirits, and the Court left open the question whether its use would amount to infringement or passing-off; and other cases, cited above, in connection with secs. 19, 20 and 21, p. 227. Injunctions were granted in *Walter v. Emmott*, 54 L. J. Ch. 1059 (1885), C. A.

(*The Morning Mail*), and *Reed v. O'Meara*, 21 L. R. Ir. 216, V.-C. (*The Grocer*).

<sup>3</sup> *Eastman, &c. Materials Co. v. John Griffiths' Cycle Corp., Ltd.*, 15 R. P. C. 105 (1898), Romer, J. The plaintiff company dealt in photographic materials, and sold *Bicycle Kodak* cameras. *Kodak* was their trade name. The defendants were restrained from selling *Kodak Cycles*. Romer, J., said it would lead to confusion and to deception, and would be injurious to the plaintiff company. See further as to this case, above, pp. 228, 269, and 498.

<sup>4</sup> See *Manchester Brewery Co. v. North Cheshire, &c. Co.*, above, p. 498, and cf. *Joseph Lucas, Ltd. v. Fabry Automobile*



business, and will thereby cause substantial damage to the plaintiff, an injunction may be granted,<sup>1</sup> and possibly a prospective interference with the natural and probable extension of the plaintiff's business would be sufficient<sup>2</sup> ground to entitle the plaintiff to relief.

Anyone may use the name in connection with goods which are in fact the goods of the plaintiff.<sup>3</sup>

It is the essence of the plaintiff's case that the use of the name should be understood in the market to imply that the goods sold or dealt in under it are his goods.<sup>4</sup>

In *The Two D.* case,<sup>5</sup> Herschell, L.C., said, the foundation of a passing-off case "is that the party alleging it should prove, in the first instance, that any name which he claims as his trade name has been so extensively used in connection with his manufacture or with the goods which he sells, that his goods have come to be known in the market by that name; that anyone using that name would intend to refer to his goods; and that anyone to whom the name was used would understand that his goods were referred to."

Hence the critical question of fact in cases under this head is often whether a word or term is the distinctive name of the plaintiff's goods, or is the name of anybody's goods of the kind,<sup>6</sup> like *Liebig's Extract*,<sup>7</sup> *Chlorodyne*,<sup>8</sup> *Linoleum*,<sup>9</sup> *Wellington Boots*,

The name may be used on the right goods.

It must be distinctive of the plaintiff's goods;

not the mere name of the goods.

*Co., Ltd.*, 23 R. P. C. 33 (1906), Warrington, J., where the plaintiffs had a reputation in cycle accessories, principally metal, under the name "Lucas," and the defendants commenced to sell "Lucas" motor tyres, which were well-known on the Continent, it was found that the tyre trade was a distinct branch of the motor industry, and the action for passing-off was dismissed.

<sup>1</sup> See note (3), previous page.

<sup>2</sup> See the cases last cited, per Ld. Watson in *Eno v. Dunn*, 15 App. Ca. at p. 258, and per Cotton, L.J., in *The Morning Mail* case, p. 506, note (2). In an American case, *Celluloid Co. v. Reed*, 47 Fed. Rep. 712; Cox, p. 509, the judge said the prospect that the complainant will in future want to manufacture starch, is too shadowy to base an injunction upon. But the suggested extension was there improbable in fact.

<sup>3</sup> Pages 33 and 394; and *Ainsworth*

*v. Walmsley*, L. R. 1 Eq. 518 (1866), Wood, V.-C., cited p. 484.

<sup>4</sup> Page 35. *Fels v. Christopher Thomas Brothers, Ltd.*, 21 R. P. C. 85 (1903), C. A. (*Napha soap*)

<sup>5</sup> *Leahy, Kelly and Leahy v. Glover*, 10 R. P. C. p. 155 (1893), H. L.

<sup>6</sup> See pp. 37 and 252 *et seq.*

<sup>7</sup> *Liebig's Extract of Meat Co., Ltd. v. Manbury*, 17 L. T. (N. S.) 298 (1867), Wood, V.-C.; *Liebig Co. v. Anderson*, 55 L. T. 206 (1887), Chitty, J.; and cf. *Same v. Chemists' Co-operative Society, Ltd.*, 13 R. P. C. 736.

<sup>8</sup> *Browne v. Freeman*, (1) 12 W. R. 305 (1864), Wood, V.-C.; (2) W. N. (1873), 178, L.J.J.

<sup>9</sup> *Linoleum Manufacturing Co. v. Nairn*, 7 C. D. 834 (1878), Fry, J. Cf. *Chesebrough Co.'s Tms.*, 18 R. P. C. 191; 19 *ib.* 342 (1901), C. A., reversing Buckley, J. (*Vaseline* not descriptive).

*Gladstone Bag*, and *Hansom Cab*, or a mere description of the goods, denoting only their pattern,<sup>1</sup> mode of manufacture,<sup>2</sup> or sale,<sup>3</sup> ingredients,<sup>4</sup> or place of origin,<sup>5</sup> or the use for which they are intended.<sup>6</sup> In *The Kodak* case it was alleged for the defendants that certain names were descriptive of photographic films suitable for use in cameras of the same names; but it was held, in fact, that they indicated the plaintiffs' goods only.<sup>7</sup>

Descriptive names may have a secondary distinctive meaning.

Words and terms which *primâ facie* are merely descriptive in the sense just explained may, however, acquire by use and reputation a secondary distinctive meaning,<sup>8</sup> so that they may be practically monopolised for use in connection with certain classes of goods by a particular trader, since their employment by anyone else would be calculated to deceive.<sup>9</sup> "I take it to be

<sup>1</sup> *Ford v. Foster*, L. R. 7 Ch. 616 (1872), L.J.J. (*Eureka Shirts*); *Hirst v. Denham*, L. R. 14 Eq. 542 (1872), Bacon, V.-C.; *Harrison, McGregor & Co.'s Tm.*, 42 C. D. 691; 7 R. P. C. 25 (1889), Kekewich, J. (*Albion Mowers*); *Wincer v. Armstrong*, 16 R. P. C. 167 (1899), Byrne, J. (*Wincer Interceptors*). In *Burberry v. Raper and Pulleyn*, 23 R. P. C. 170 (1906), Warrington, J., the defence, that the name "Burberry" meant a coat of a particular shape made of a particular cloth, failed.

<sup>2</sup> *Singer Manufacturing Co. v. Wilson*, 2 C. D. 434; 3 App. Ca. 376 (1875); *Id. v. Looy*, 18 C. D. 395; 8 App. Ca. 15 (1877); *Id. v. Spence & Co.*, 10 R. P. C. 297 (1893), Romer, J.; *Id. v. British Empire Co.*, 20 R. P. C. 313 (1903), Kekewich, J. (*Singer System, Singer Sewing Machines*), cited ante, p. 39. In the last two cases and in *Daimler Motor Co. (1904), Ltd. v. London Daimler Co., Ltd.*, 24 R. P. C. 379 (1907), C. A. (*Daimler*), the plaintiffs after failing in previous actions established that the name had become distinctive.

<sup>3</sup> *Symington v. Footman*, 56 L. T. 696 (1885), Kay, J. (*Guaranteed Corset*).

<sup>4</sup> *Massam v. Thorley's Cattle Food Co.*, 14 C. D. 748 (1880), C. A.

<sup>5</sup> *McAndrew v. Bassett*, 4 De G. J. & S. 380; 33 L. J. Ch. 561 (*Anatolia Liquorice*); *Seico v. Provezende*, L. R. 1 Ch. 192 (*Seico Wine*); *Wotherspoon v. Currie*, 5 L. R. H. L. 508 (*Glenfield Starch*), all cited pp. 49 to 51; see also

*The Reading Biscuit* case, *Huntley and Palmer v. The Reading Biscuit Co., Ltd.*, 10 R. P. C. 277 (1893), Chitty, J.; and *The Rugby Portland Cement* case, *Rugby Portland Cement Co., Ltd. v. The Rugby and Newbold Portland Cement Co.*, 8 R. P. C. 241; 9 R. P. C. 46 (1891), V. Williams, J., and C. A., and *Bewlay v. Hughes*, 15 R. P. C. 290 (1898), North, J. (*Dindigul Cigars*); *Whitstable Oyster Co. v. Hayling Fisheries, Ltd.*, 17 R. P. C. 461; 18 *ib.* 434, Buckley, J., and C. A. (*Whitstable Oysters*).

<sup>6</sup> *Talbot v. Webley*, 3 R. P. C. 276 (1886), Bacon, V.-C. (*Baffle Safes*); *Christy v. Tipper*, 21 R. P. C. 97, 755 (1903), Kekewich, J., and C. A. (*Absorbine Lotion*).

<sup>7</sup> *Kodak, Ltd. v. London Stereoscopic, &c. Co.*, 20 R. P. C. 337 (1903), Swinfen Eady, J. Cf. *Neostyle Manufacturing Co., Ltd. v. Ellam's Duplicator Co.*, 21 R. P. C. 185, 869 (1904), Byrne, J., and C. A., where it was held on the facts that, although "Neostyle" in England denoted the name of the plaintiffs' duplicating machine, the plaintiffs had no exclusive right to it for accessories.

<sup>8</sup> Chap. II., p. 37.

<sup>9</sup> See the cases cited in note (5), and *Montgomery v. Thompson*, 41 C. D. 35; [1891] A. C. 217; 8 R. P. C. 361 (*Stone Ales*); followed in *Worcester Royal Porcelain Co., Ltd. v. Locke*, 19 R. P. C. 479 (1902), Byrne, J. (*Worcester China*).