

clear from the evidence," Lord Westbury said, in *The Glenfield Starch* case,<sup>1</sup> "that long antecedently to the operations of the respondent, the word *Glenfield* had acquired a secondary signification or meaning in connection with a particular manufacture—in short, it had become the trade denomination of the starch made by the appellants. It was wholly taken out of its ordinary meaning, and in connection with starch had acquired that peculiar secondary signification to which I have referred. The word *Glenfield*, therefore, as a denomination of starch, had become the property of the appellants."

And in *The Camel Hair Belting* case<sup>2</sup> Lord Herschell said: "The name of a person, or words forming part of the common stock of language, may become so far associated with the goods of a particular maker that it is capable of proof that the use of them by themselves without explanation or qualification by another manufacturer would deceive a purchaser into the belief that he was getting the goods of A. when he was really getting the goods of B. In a case of this description the mere proof by the plaintiff that the defendant was using a name, word, or device which he had adopted to distinguish his goods would not entitle him to any relief. He could only obtain it by proving further that the defendant was using it under such circumstances or in such manner as to put off his goods as the goods of the plaintiff."<sup>3</sup>

It follows that where a word, which is not a "fancy word,"<sup>3</sup> but is *primâ facie* descriptive, is claimed as his trade name by the plaintiff, he must show that its original or apparent meaning has been wholly lost, or does not exist, "amongst those who are purchasers of the goods" in question<sup>4</sup> within a definite area. Such area must extend to a large part of England and Wales and

Descriptive meaning must be lost.

Area.

<sup>1</sup> See above, p. 508, note (5).

<sup>2</sup> *Reddaway v. Banham*, [1896] A. C. 199, at p. 210; 13 R. P. C. at p. 228.

<sup>3</sup> Cf. the decisions on the expression "fancy word not in common use" in the Act of 1883, above, p. 144. The current use of the term "fancy word" is as an antithesis to "descriptive," or *primâ facie* descriptive, word. See *Faulder v. Rushton*, 20 R. P. C. 477 (1902), C. A. (*Silverpan Jam*), and the judgments in the *Cellular Clothing* case cited below. *Yorkshire Relish* was referred to as a "fancy word," although

it could not have been registered under the Act: see [1896] 2 Ch. p. 92; 13 R. P. C. 235. The expression is also made use of in regard to trading names, see the judgment of Kennedy, L.J., in *Daimler Motor Co. (1904), Ltd. v. London Daimler Co., Ltd.*, 24 R. P. C. 379 (1907), and the judgment of Parker, J., in *British Vacuum Cleaner Co., Ltd. v. New Vacuum Cleaner Co., Ltd.*, 24 R. P. C. 611 (1907).

<sup>4</sup> This was Lord Herschell's phrase in *Reddaway v. Banham*, [1896] A. C. at p. 208; 13 R. P. C. at p. 227.

include the district in which the defendant trades or proposes to trade.<sup>1</sup> If the word still continues to be used and understood with its original descriptive meaning by any considerable section of such persons, it cannot be monopolised.<sup>2</sup> And the more appropriate the words claimed are as a description of the goods or of some characteristic of the goods, the greater is the burden of proof required from the plaintiff.<sup>3</sup> If the plaintiff has had a monopoly in fact of the goods his difficulty is increased.<sup>4</sup>

The question for the jury.

The question of fact which has to be answered in the cases

<sup>1</sup> In *S. Chivers & Sons v. S. Chivers & Co., Ltd.*, 17 R. P. C. 420 (1900), Farwell, J., expressed the rule by saying that the secondary meaning must be "locally universal." He did not think that the area need necessarily comprise Scotland in order to establish a case in the English Courts. This goes too far. *Faulder v. Rushton*, p. 509, note (3), and the judgment of Moulton, L.J., in *Star Cycle Co. v. Frankenburys*, 24 R. P. C. 405 at p. 414 (1907), where the learned Lord Justice said that small local *bonâ fide* users, which had been proved, did not affect his mind much with regard to the issue (the general reputation of the plaintiffs under the name *Star Cycle*). See also the judgment of Ld. Shand in the *Cellular Clothing* case cited below, note (3).

<sup>2</sup> *Parsons v. Gillespie*, [1898] A. C. 239; 15 R. P. C. 57, P. C. (*Flaked Oatmeal*); *Cellular Clothing Co., Ltd. v. Maxton*, [1899] A. C. 326; 16 R. P. C. 397, H. L. See also the judgments in the Court of Session in the last case, 15 R. P. C. 581.

<sup>3</sup> "I desire to say, speaking for myself, at all events, that where a person for his own purposes, for his own business, adopts such a title" (*American Shoe Co.*) "a title descriptive of the goods which he is selling, and another person is minded to adopt a title descriptive of the goods which he is going to sell, the very heavy burden lies upon the plaintiffs of proving that the adoption of this new title will cause deception, and, again, speaking for myself at all events, I think the Courts ought to be extremely careful to prevent the

acquisition by persons who adopt a descriptive name, of a monopoly not only in that name, but in a name descriptive of another class of goods": per Warrington, J., in *H. E. Randall, Ltd. v. E. Bradley & Son*, 24 R. P. C. 657, affirmed p. 773. The action of the plaintiffs (*The American Shoe Co.*) to restrain the defendants trading as *The Anglo-American Shoe Co.* was dismissed. "In all these cases if the primary meaning of a word is a simple and easy primary meaning, known to everybody, it is extremely difficult to establish that in any particular trade this word has lost its well-known and original meaning, and in that trade acquired a secondary meaning to the exclusion of the natural and original meaning of the word": per Vaughan Williams, L.J., in *Hommel v. Bauer & Co.*, 22 R. P. C. 43 (1905); *Hæmatogen* for a medicine held not to be distinctive. "The *Camel Hair Belting* case may be an example of what, under ordinary circumstances, it would be very difficult to establish": per Halsbury, L.C., in the *Cellular Clothing* case, [1899] A. C. at p. 336; 16 R. P. C. at p. 405.

<sup>4</sup> See Ld. Davey's judgment in the *Cellular Clothing* case, note (3), and Farwell, J., in *Ripley v. Griffiths*, 19 R. P. C. 590 (1902), where the plaintiffs had been the only manufacturers of laundry blue in an oval shape, but they failed to establish a secondary meaning of the words "Oval Blue"; also the *Naptha Soap* cases, *Fels v. Christopher Thomas*, *Fels v. Stephenson*, *Fels v. Hedley*, 21 R. P. C. 85, 89 and 91, C. A.

under consideration has, accordingly, a negative as well as an affirmative part.<sup>1</sup>

The possibility of proving that a word which is *primâ facie* descriptive is in reality a trade name is not an exception to the well-settled rule that no case of passing-off can be made out merely by showing that the defendant has adopted and used a descriptive or other "open" word previously used by the plaintiff.<sup>2</sup> Any trader is entitled to affix a true description to his goods in ordinary language; but if words are used which have lost their ordinary descriptive meaning and have acquired a new meaning which is not descriptive, they no longer constitute a true description.<sup>3</sup>

Literally true  
description  
may mislead.

<sup>1</sup> In his direction to the jury in *A. W. Gamage, Ltd. v. H. E. Randall, Ltd.*, 16 R. P. C. 185 (1899), at p. 196, Russell, L.C.J., said: "The first point is, have Gamages made out to your satisfaction that *Shorland* means a buckle and strap shoe sold by Gamage & Co. exclusively, so that the person who sold the shoe under the name of *Shorland* would be passing off as Gamages' what was not Gamages', but his own, and so that a person buying it would believe that he was getting Gamages' and not the shoe of the man who sold it to him." This was approved by the C. A. In *Reddaway v. Banham*, [1895] 1 Q. B. 280; [1896] A. C. 199; 12 R. P. C. 83; 13 R. P. C. 218, the questions put to the jury were:—1. Does *Camel Hair Belting* mean belting made by the plaintiffs as distinguished from belting made by other manufacturers? (*Answer*, Yes.) 2. Or does it mean belting of a particular kind without reference to any particular maker. (*Answer*, No.) 3. Do the defendants so describe their belting (*i.e.*, by using the term) as to be likely to mislead purchasers, and to lead them to buy the defendants' belting as and for the belting of the plaintiffs? (*Answer*, Yes.) 4. Did the defendants endeavour to pass off their goods as and for the goods of the plaintiffs, so as to be likely to deceive purchasers? (*Answer*, Yes.) Upon these findings, Collins, J., gave judgment for the plaintiffs; the Court of Appeal reversed the judgment

on the ground that the term was descriptive; but the House of Lords restored it. It appears from all the judgments that the fourth question was superfluous.

<sup>2</sup> *Kelly v. Byles*, 13 C. D. 682 (1880), Bacon, V.-C., and C. A. (*Post Office Directory*); *Schove v. Schmincke*, 33 C. D. 546 (1886), Chitty, J. (*Castle Album*); *Great Tower Tea Co. v. Smith*, 6 R. P. C. 165; 5 T. L. R. 232 (1889), North, J. (*Tower Tea*); *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J. (*Washerine*); *Rugby Portland Cement Co., Ltd. v. Rugby and Newbold Portland Cement Co., Ltd.*, 8 R. P. C. 241; 9 R. P. C. 46 (1891), Vaughan Williams, J., and C. A. (*Rugby Portland Cement*); *The Colonial Fire Assurance Co. v. The Home and Colonial Assurance Co., Ltd.*, above, p. 500; *Magnolia Metal Co. v. Atlas Metal Co.*, 14 R. P. C. 389, Collins, J., and C. A. (1897) (*Magnolia Metal*); *Parsons v. Gillespie and Cellular Clothing Co., Ltd. v. Maxton*, above, p. 510, note (3).

<sup>3</sup> "Even a description of goods which is literally true may be so framed as to deceive": per Ld. Davey in *Grand Hotel Co. of Saledonia Springs, Ltd. v. Wilson*, 21 R. P. C. at p. 134. In *Reddaway v. Banham*, [1896] A. C. at p. 212; 13 R. P. C. at p. 229, Ld. Herschell said: "I rather demur, however, to the statement of James, L.J., that the defendant in *Wotherspoon v. Currie* (above, p. 51) was not telling a lie in calling his starch

A descriptive word must not, moreover, be used as a mere blind. Where an ingredient, oxide of iron, was used in making medicinal tablets merely to justify the use of the name "Compound Iron Oxide Tablets," and the name was chosen because it would lead to confusion with the plaintiffs' "Iron-Ox Tablets," and not because it could be said to correctly describe the article, an injunction was granted against the use of the term iron oxide without better distinguishing the defendants' goods from those of the plaintiffs. The plaintiffs' goods did not contain oxide of iron, which was practically useless as a drug, and the name "Iron-Ox Tablets" was held to indicate their tablets and was not associated by the public with any particular drug.<sup>1</sup>

Evidence.

It will be useful to contrast the evidence in some of the recent cases in which the plaintiffs succeeded with that in others in which they failed. In *Reddaway v. Banham*,<sup>2</sup> although it was admitted that the yarn of which the belting was made consisted for the most part of camel hair,<sup>3</sup> it was shown that the name camel-hair belting had never been current as a description in the trade, a number of other names being used, and there was evidence that the defendant had adopted the name in order to deceive purchasers, and that he was likely to succeed in deceiving them by its use. In *Powell v. The Birmingham Vinegar Brewery Co.*,<sup>4</sup> numerous wholesale and retail grocers, export agents, travellers, saucemakers and purchasers, and scientific witnesses were called, and the effect of their evidence, stated shortly, was

*Glenfield Starch*, as I do to the view that the defendants in this case were telling the simple truth when they sold their belting as camel-hair belting. I think the fallacy lies in overlooking the fact that a word may acquire in a trade a secondary meaning differing from its primary one, and that if it is used to persons in the trade who will understand it in its secondary sense, it will be none the less a falsehood that in its primary sense it may be true." Lord Macnaghten said (at p. 219; 13 R. P. C. at p. 233): "At Banham's works, where it cannot mean Reddaway's belting, it may be construed to mean belting made of camel's hair; abroad, to the German manufacturer, to the Bombay mill-owner, to the up-country native, it must mean Reddaway's; it can mean nothing else. I venture to think that

a statement which is literally true, but which is intended to convey a false impression, has something of a faulty ring about it; it is not sterling coin; it has no right to the genuine stamp and impress of truth."

<sup>1</sup> *Iron Ox Remedy Co., Ltd. v. Co-operative Wholesale Society, Ltd.*, 24 R. P. C. 425 (1907), Parker, J.

<sup>2</sup> Above, p. 509. See the findings of the jury, p. 511, note (1). And other "camel hair" cases below, p. 549, note (2).

<sup>3</sup> Cf. the earlier case, *Reddaway v. Bentham Hemp Co.*, [1892] 2 Q. B. 639; 9 R. P. C. 503, C. A., where there was no such admission.

<sup>4</sup> [1894] 3 Ch. 449; 11 R. P. C. 563, interlocutory injunction; [1896] 2 Ch. 54; [1897] A. C. 710; 13 R. P. C. 235; 14 R. P. C. 710, Stirling J., C. A. and H. L.

that if a purchaser asked for Yorkshire Relish he would expect to get the plaintiffs' sauce. There was also evidence of actual deception.<sup>1</sup> In this case, as there was no other maker of the sauce but the plaintiffs themselves, the defendants'<sup>2</sup> sauce being a clever imitation, but not the same thing, it was inevitable that the name should indicate the plaintiffs' goods. This circumstance might have gone some way to displace the plaintiffs' evidence, as in the cases next cited, if the defendants had been prepared to sell the goods which, according to their own contention, were described by the name.

On the other hand, in *Parsons v. Gillespie*,<sup>3</sup> a number of grocers proved that when asked by their customers for "Flaked Oatmeal" they supplied the plaintiff's goods; but there was no evidence of actual deception or confusion, and the value of the evidence first mentioned was discounted by the fact that it wholly or chiefly referred to a period when there were no other goods of the kind in question in the market besides the plaintiff's goods. In *The Cellular Clothing Co., Ltd. v. Marton*,<sup>4</sup> the plaintiffs' evidence consisted of (a) their own advertisements, in which they used the word "cellular" to describe their cloth, but did not suggest that its use distinguished their cloth from cloth of a similar description made by others;<sup>5</sup> (b) statements of witnesses who said that they understood "cellular goods" to mean the goods of the plaintiffs, but who did not say that they knew of any other manufacturers making similar classes of goods; and (c) consent orders for injunctions obtained against other persons who had used the name. In both of these cases the plaintiffs failed.

Secondary meaning not acquired while no competition.

In *A. W. Gamage, Ltd. v. H. E. Randall, Ltd.*,<sup>6</sup> where the plaintiffs were retail shopkeepers, a mass of evidence was called on both sides. The plaintiffs relied principally on the evidence of purchasers, of retail dealers, and of writers in trade news-

<sup>1</sup> [1896] 2 Ch. p. 57.

<sup>2</sup> Above, p. 489.

<sup>3</sup> See [1898] A. C. p. 254; 15 R. P. C., p. 62.

<sup>4</sup> See [1899] A. C. at p. 345; 16 R. P. C. at p. 410. The cases are reviewed in *British Vacuum Cleaner Co. v. New Vacuum Cleaner Co.*, 24 R. P. C. 641 (1907), Parker, J.

<sup>5</sup> It is not sufficient to show extensive advertising apart from the effect of the

T.M.

advertisement. "To make an advertisement relevant you must show that it had an effect." Per Vaughan Williams, L.J., in *Christy v. Tipper*, 21 R. P. C. 97 (1904), at p. 101. See also *Chivers & Sons v. Chivers & Co., Ltd.*, 17 R. P. C. 420 (1900), Farwell, J., at p. 431.

<sup>6</sup> 16 R. P. C. 185 (1899), Russell, L.C.J., and C. A. (*The Shorland Cycling Shoe*). See above, p. 511, note (1).

Word  
qualified by  
plaintiff's  
name.

papers; the defendants principally on that of wholesale dealers. It was admitted that there were in the market shoes of the same pattern as the shoes in question made by other makers, but it was proved that the plaintiffs invariably used, besides their alleged trade name, a stamp bearing the name of the company. Some of the plaintiffs' witnesses admitted that if they saw the name without the stamp they would not think the goods were the plaintiffs'. The jury found for the defendants, being possibly influenced by the admission just mentioned, and the Court of Appeal refused to disturb their verdict.<sup>1</sup>

Name of  
introducer or  
patentee.

The name of the inventor or first introducer of goods which are new to the market, or the name which he gives to those he manufactures or sells, is very readily adopted as the name of goods by whomsoever they are made; and in the case of goods made under a patent, the Court is careful not to extend the patentee's monopoly by forbidding other manufacturers, after the patent has expired, to sell goods lawfully made by them according to its specification under the only name by which they are known.<sup>2</sup>

In *James v. James*,<sup>3</sup> Romilly, M.R., said that anyone who was possessed of the secret of an invention might make the goods according to it, and might sell them under the name of the inventor after his death, but might not sell them in his lifetime, so as to suggest that they were made by him. But the distinction here suggested was questioned by James, L.J.,<sup>4</sup> in a later case, for the death of the inventor would not necessarily prevent the use of his name being calculated to pass off the goods of others as goods manufactured in the business lately carried on by him, if his successors were continuing the business; and, on the other hand, during his lifetime, if there was no monopoly in the manufacture, anyone might state that the goods were made according to his system. It is material also to remember that the name of the first maker or inventor is often understood to imply the good quality of work or materials which has brought the new goods into favour rather than the mode of manufacture or the nature of the ingredients employed.<sup>5</sup> Where this is the

<sup>1</sup> So in *Hommel v. Bauer*, 22 R. P. 3. 43 (1905), the plaintiff had called his goods "Dr. Hommel's Hæmatogen." See the judgment of Vaughan Williams, L.J. Further illustrations will be found under the heading, "Right to use a man's own name," below, p. 532.

<sup>2</sup> See Chap. II., p. 43.

<sup>3</sup> L. R. 13 Eq. 421 (1872) (*Lieutenant James' Horse Blister*).

<sup>4</sup> *Mussam v. Thorley's Cattle Food Co.*, 14 C. D. p. 754 (1880).

<sup>5</sup> See the last case; and cf. the use of "original," above, p. 49.

case the use of the name by traders who have no connection with him must almost always be calculated to deceive.

On the other hand, names which once carried a distinctive reference to a particular trader may, in consequence of successful piracies, or of their use by the trader himself for goods which are the goods of others, or are put forward as such,<sup>1</sup> or for other reasons, lose it and fall into common use and become *publici juris*,<sup>2</sup> in the same way as trade marks may be lost or abandoned. Accordingly, evidence is admissible to show that a word which was once distinctive of a particular trader's goods has become common in the trade. But, where the distinctive meaning alleged is proved to hold generally for the trade and public, cases of small local user for the goods of other traders will not have much effect to displace the evidence.<sup>3</sup>

Names may become *publici juris*

The question is, What is the meaning of the name for the time being? it is possible therefore for a word which has at one time been the trade name of one trader to become so identified with the goods of a rival trader as afterwards to become the trade name of the latter,<sup>4</sup> who may thereby acquire an exclusive right to its use,<sup>4</sup> or, if its association with the original owner has continued, a right concurrent with his right.<sup>5</sup>

or become associated with another trader.

Similarly a word which has, at one time, been in common use in a trade with a mere descriptive meaning may subsequently come to have special reference to the goods of a particular trader, who will then be entitled to prevent others using it without sufficiently distinguishing their goods.<sup>6</sup>

The fact that the plaintiff has for some of his goods a special name does not necessarily negative his right to a more general

<sup>1</sup> *Wood v. Butler*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A. (*Eton Cigarettes*). See also *Wolff v. Nopitsch*, 17 R. P. C. 321 (1900), Cozens-Hardy, J.; 18 R. P. C. 27 (1901), C. A.

<sup>2</sup> Chap. II., p. 38; and Chap. XIV., p. 362.

<sup>3</sup> *Star Cycle Co. v. Frankenburgs*, 24 R. P. C. 405 (1907), see the judgment of Moulton, L.J.; *Boord v. Thom*, 24 R. P. C. 697 (1907), Sc., and cf. "area." above, p. 509. For the converse, see note (6).

<sup>4</sup> *Daniel and Arter v. Whitehouse*, [1898] 1 Ch. 685; 15 R. P. C. 134, Gorell Barnes, J. (*Brazilian Silver*); cf.

next case.

<sup>5</sup> *Edge & Sons, Ltd. v. Gallon & Son*, 16 R. P. C. 509 (1899), C. A. (*Dolly Blue*).

<sup>6</sup> *Daimler Motor Co. (1904), Ltd. v. London Daimler Co., Ltd.*, 23 R. P. C. 718; 24 *ib.* 379 (1906), Buckley, J., and C. A. A word which has denoted the goods of two or three separate firms may come to denote the goods of one only, *Worcester Royal Porcelain Co., Ltd. v. Locke*, 19 R. P. C. 479 (1902), Byrne, J., where, however, the plaintiffs were the successors of all the three firms who had previously used the term "Worcester" to denote their goods, and see above.

name; for instance, in *The Worcester China* case,<sup>1</sup> the plaintiffs had used the terms "Royal Worcester" and "Grainger's Worcester China" for some of their goods, and it was contended that by their conduct they had abandoned or lost their rights in "Worcester China" *simpliciter*, but this defence failed.

Disclaimed  
word.

Under the old Act it was decided that a word, or other particular, forming part of a registered label or other trade mark, which the plaintiff had disclaimed as a condition of registration, was necessarily open, and that the plaintiff could not be heard to allege that by itself it formed a distinctive mark.<sup>2</sup> It is now expressly provided that no disclaimer shall affect any rights of the proprietor of a trade mark except such as arise out of the registration.<sup>3</sup> In the case of a word or mark which has been expunged from the Register, even though it was expunged without the plaintiff's assent, the removal of the mark does not and never did prevent the plaintiff from showing that the mark is, nevertheless, distinctive of his goods,<sup>4</sup> but the Court may infer that other traders have refrained from using the word not because they knew it to mean the plaintiff's goods, but merely because of the registration.<sup>5</sup> It has already been shown that a trade mark which has never been registered, or which has been removed from the Register, may be the basis of a passing-off case.<sup>6</sup>

Expunged  
trade mark.

<sup>1</sup> See p. 515, note (6). But the use of a special name is a matter to be considered, cf. *Whitstable Oyster Fishery Co. v. Hayling Fisheries, Ltd.*, 17 R. P. C. 461; 18 R. P. C. 434, Buckley, J., and C. A.

<sup>2</sup> *Rosenthal v. Reynolds*, [1892] 2 Ch. 301; 9 R. P. C. 189, North, J. (*W. R. Corsets*), interim injunction refused. This was not followed by the Scotch Court in *Bayer v. Baird*, 15 R. P. C. 615 (1898) (*C. B. Corsets*). Might not the plaintiff show, at any rate, that the word has acquired a distinctive meaning after the registration?

<sup>3</sup> Sec. 15.

<sup>4</sup> See *The Yorkshire Relish* (above, pp. 489 and 512), and *Stone Ale* (above, p. 339) cases.

<sup>5</sup> *Hommel v. Bauer*, 21 R. P. C. 576 (1904), Warrington, J., at p. 587; affirmed on appeal, 22 R. P. C. 43.

<sup>6</sup> Above, p. 481; Chap. XII., p. 338.

In *Paine & Co. v. Daniells & Sons' Breweries Co., Ltd.*, [1893] 2 Ch. 567; 10 R. P. C. 217 (*John Bull Beer*), the C. A. assumed that the plaintiffs must fail if their trade mark were expunged from the Register, although the action was brought, not only in respect of infringement, but also in respect of passing-off. But the case was a peculiar one, for the only matter which led the Court to think the defendants' conduct was calculated to pass off their goods as those of the plaintiffs, was the use by the defendants of a label, bearing the words *Registered* and *John Bull*, whereas, in fact, the only registered John Bull mark was that of the plaintiffs. The use of the word "registered" in connection with the label complained of was an element also in *Boord & Son v. Huddart*, 21 R. P. C. 149 (1904), at p. 158, Swinfen Eady, J.



But an open word, that is to say, a non-distinctive word, or open words, may be an important element in the plaintiff's labels, and the use of the same word or words by the defendant in the same manner, especially if coupled with the use of other details of "get-up" which are similar to those which the plaintiff uses, may be strong evidence to support a passing-off case based upon imitation of get-up.<sup>1</sup>

Use of common word by defendant may be an element in a get-up case.

This was pointed out by Wood, V.-C., in *Woollam v. Ratcliff*,<sup>2</sup> where, in commenting upon *The Omnibus* case,<sup>3</sup> he said: "The words *Conveyance Company*, the green omnibus, &c., were held sufficient together to entitle the plaintiffs to an injunction. The defendant might have had those words painted on a yellow omnibus without objection, and so of the other resemblances; the wrong lay in their accumulation, not in any one of them alone."

In the case of trade names which are *primâ facie* geographically descriptive, a special order has sometimes been made in order to avoid any interference with the honest and proper use of them by persons other than the owner of the trade name. Thus, in *Braham v. Beachim*,<sup>4</sup> the plaintiff, being owner of all the collieries in Radstock, except a very small one, traded as the "Radstock Coal Co.," and the defendants began to sell coal under the same name, and also as "The Radstock Colliery Proprietors." An injunction was granted, "to restrain the defendants, unless and until they shall acquire a colliery or coal mine within the parish of Radstock, from trading under, or using, the name or style of 'The Radstock Colliery Proprietors,' or any other name or style signifying that the defendants or either of them are proprietors of any colliery or collieries at Radstock." Subsequently the defendants acquired a colliery, but not in Radstock, and began to trade as "The Radstock Coal and Waggon Co., Colliery Proprietors, Radstock, Somerset," and a motion to commit for breach of the injunction was refused on the ground that the terms used by them did no more than imply that they were proprietors of collieries, and that their place of business was at Radstock, and this was true.<sup>5</sup> So, in *The Whit-*

Geographical names.

<sup>1</sup> As in *Lever v. Goodwin*, 36 C. D. 1; <sup>4</sup> R. P. C. 492 (1887), Chitty, J., and C. A. (*Sunlight Self-Washer*, and *Goodwin's Self-Washing Soap*); and see the report of Ld. Herschell's Committee on disclaimed additions.

<sup>2</sup> 1 H. & M. 259 (1863).

<sup>3</sup> *Knott v. Morgan*, 2 Keen, 213 (1836), Ld. Langdale, M.R., and Cottenham, L.C.

<sup>4</sup> 7 C. D. 848 (1878), Fry, J.

<sup>5</sup> Seb. Dig. p. 633 (1878), Fry, J.

*stable Oyster* case,<sup>1</sup> where it was held that the name "Whitstable Native Oysters" meant the plaintiffs' oysters, and could not be fairly used of French oysters relaid and brought to maturity at Whitstable; the learned judge said, the plaintiffs' right in respect of the name was subject to the inconvenience that the name might honestly be used by anyone to describe real Whitstable natives, whether the plaintiffs' oysters or not.<sup>2</sup>

It may be doubted whether the decision in *The Radstock Colliery* case, and the dicta just referred to, are consistent with the judgments delivered in the House of Lords, in *The Stone Ales* case,<sup>3</sup> where, although the right of the appellant to state that his beer was brewed at Stone was recognised, it was held to be subject to an obligation not to do so in any manner calculated to cause the appellant's beer to be passed off as that of the respondents, which was commonly known as *Stone Ale*, and the learned Lords were clearly of opinion that the obligation would prevent the appellant from using the last-mentioned term at all. And if, as required by the rule laid down in the recent authorities, the plaintiff proves that an apparently descriptive word which he claims to appropriate has wholly lost its descriptive meaning, it is difficult to imagine how the defendant can be truthfully using the word with that meaning.<sup>4</sup>

Author's  
name

An author can restrain the publication under his name of books which are not written by him, on the same principles as a trader can obtain an injunction to protect his trade name or that of his goods.<sup>5</sup> And, further, it has been held that the writer of a work can maintain an action against the owner of the copyright

<sup>1</sup> *Free Fishers of Whitstable v. Elliot*, 4 Times L. R. 273; W. N. (1888), 27, Stirling, J., interlocutory injunction to restrain the use of *native*: no order as to *Whitstable*. In the later case of *The Whitstable Oyster Fisheries Co. v. The Hayling Fisheries, Ltd.*, 17 R. P. C. 461; 18 *ib.* 434 (1900), Buckley, J., and C. A., it was decided that "Whitstable," as applied to oysters, was descriptive of the place where the oysters reach maturity.

<sup>2</sup> Cf. also *Bewlay v. Hughes* and *Wolff v. Nopitsch*, above, p. 51, notes (4) (5). In *Grand Hotel of Caledonia Springs, Ltd. v. Wilson*, [1904] A. C. 103; 21 R. P. C. 117, P. C., it was held that the defendants were entitled to indicate that their mineral waters came

from the Caledonia Springs. Cf. *Apollinaris Co., Ltd. v. Duckworth*, 23 R. P. C. 540 (*Apollinaris Salts*) (1906), Warrington, J., and C. A., and *Rey v. Lecouturier*, 25 R. P. C. 265 (1908), C. A. (*Chartreuse*).

<sup>3</sup> *Montgomery v. Thompson*, [1891] A. C. 217; 8 R. P. C. 361; *Worcester Royal Porcelain Co., Ltd. v. Locke & Co.*, 19 R. P. C. 479 (1902), Byrne, J. See also *The Yorkshire Relish* case, above, p. 489.

<sup>4</sup> Above, p. 511.

<sup>5</sup> *Lord Byron v. Johnson*, 2 Mer. 29 (1816), Eldon, L.C.; cf. *Barnard v. Pillow*, W. N. (1868), 94, Romilly, M.R. (music); and *Martin v. Wright*, 6 Sim. 297 (1833), Shadwell, V.-C., copy of work of diorama painter.

for the damage occasioned to his reputation by the publication of a new edition of the book, purporting to be prepared by him, but in fact not so prepared.<sup>1</sup> But in the case of a serial publication, the purchaser of the goodwill of the business of conducting it—sometimes, but erroneously, called the copyright in the publication—is at liberty to publish subsequent numbers under the old name after determining his business relations with the author or editor of earlier numbers, and notwithstanding that the name is that of the first editor or author.<sup>2</sup>

The author's right to prevent the work of another being passed off as his is, of course, quite distinct from the copyright which he may have in his own work. Upon the principle already stated,<sup>3</sup> the right here under consideration will not enable him to stop the republication under his name of his own, non-copyright, work.<sup>4</sup>

Titles of books, newspapers, or other publications, are also protected on the same principles, that is, as trade names, and no cause of action arises, therefore, unless it is shown that the title is known to indicate the plaintiff's book or paper, so that its use by the defendant would be calculated to lead to deception.<sup>5</sup> There is no copyright in such titles.<sup>6</sup>

Title of book.

### C. Imitation of Get-up.

The general appearance of a trader's goods as they are presented to purchasers is often the most important of the signs by which the goods are recognised as his, and an imitation of it frequently affords the readiest means by which a fraudulent

<sup>1</sup> *Archbold v. Sweet*, 1 M. & R. 162; 5 C. & P. 219 (1832), *Ld. Tenterden, C.J.* In *Lee v. Gibbings*, 67 L. T. 263 (1892), *Kekewich, J.*, said the question was one of libel. He refused an interim injunction. See Chap. XVIII.

<sup>2</sup> *Ward v. Beeton*, L. R. 19 Eq. 207 (1874), *Malins, V.-C.* (*Beeton's Christmas Annual*); cf. *Condy v. Mitchell*, 37 L. T. N. S. 766 (1877), *C. A.* (*Condy's Fluid*). A late editor would be restrained from advertising that a serial is discontinued; *Bradbury v. Dickens*, 27 Beav. 53; 28 L. J. Ch. 667 (1859), *Romilly, M.R.* (*Household Words*).

<sup>3</sup> Above, and pp. 478, 505.

<sup>4</sup> *Clemens v. Belford*, 14 Fed. Rep.

728 (1883), *Amer.* (*Mark Twain*).

<sup>5</sup> *Schore v. Schmincke*, 33 C. D. 546 (1886), *Chitty, J.* (*Castle Album*); *Borthwick v. The Evening Post*, 37 C. D. 449 (1888), *Kay, J.*, and *C. A.*; *Walter v. Emmott*, 54 L. J. Ch. 1059 (1885), *C. A.* (*The Morning Mail*); and cases in the next note. A list of these cases is collected in *Sebastian on Trade Marks*, 4th ed., p. 294.

<sup>6</sup> *Dicks v. Yates*, 18 C. D. 76 (1880), *Bacon, V.-C.*, and *C. A.* (*Splendid Misery*); *Licensed Victuallers' Newspaper Co. v. Bingham*, 38 C. D. 139 (1888), *North, J.*, and *C. A.* (*Licensed Victuallers' Mirror*).

Get-up common to the trade.

rival, and fraudulent retail dealers in collusion with him, can pass off his goods as the goods of the other. The cases falling under this head are almost necessarily cases of deliberate fraud, for such similarity of "get-up" as is calculated to deceive is, as a rule, the result of a resemblance, more or less close, in a number of corresponding details, and this can hardly happen by accident or coincidence. In effect, if the get-up of the defendant's goods appears, on first inspection, closely to resemble that of the plaintiff's, and it is shown that it has recently been adopted by him, the only explanation, consistent with honest conduct, that can ordinarily be given is, that the leading features of the get-up are common to the trade in question. A familiar example of such common features is the square tin box covered with yellow paper, bearing red and black letters, of the mustard trade.<sup>1</sup>

What is compendiously called the "get-up" of goods—the dress in which they are presented to the buyer<sup>2</sup>—comprises, in particular, the size and shape of the packages,<sup>3</sup> where the goods have no definite outline, or none which is shown to the buyer, the material, colour, and decoration of their wrappers, and the lettering and arrangement of their labels.<sup>4</sup> Thus, in *Lever v. Goodwin*,<sup>5</sup> the plaintiffs sold their soap in packets wrapped up in a peculiar parchment paper, with *Sunlight Self-washer* printed in spaced type upon the wrapper; the defendants began to use

<sup>1</sup> See *Farrow's Tm.*, 7 R. P. C. 260; 63 L. T. 233 (1890), Stirling, J. Other examples will be found in *Jamieson & Co. v. Jamieson*, 15 R. P. C. 169 (1898), C. A., overruling Byrne, J.; *Puckham & Co. v. Sturgess & Co.*, 15 R. P. C. 669 (1898), North, J., and C. A.; *Payton & Co. v. Snelling, Lampard & Co.*, 17 R. P. C. 48 and 628, C. A. and H. of L., enamelled tins for French coffee, reversing Byrne, J., 16 R. P. C. 283. *King v. Gillard*, 22 R. P. C. 327 (1905), C. A. (*desiccated soup in steel boxes*).

<sup>2</sup> In *Knott v. Morgan*, 2 Keen, 213 (1836), Langdale, M.R., and Cottenham, J.C., the fraud consisted in the imitation of the painting of the plaintiff's omnibuses, the uniforms of their servants, and the use of their descriptive title—the London Conveyance Co. The facts in *The London General Omnibus Co. v. Felton*, 12 T. L. R. 213, Chitty, J., and *London Road Car Co. v. Era Omnibus Assn.*, (1898) *Times*, June 23: (1899)

*Times*, April 28, were similar.

<sup>3</sup> In *Ripley v. Bandy*, 14 R. P. C. 591, Kekewich, J., the blue was done up in oval packets, and thence called *Oral Blue*; the case was settled on appeal, 14 R. P. C. 944. In *Jones v. Hallworth*, 14 R. P. C. 225 (1897), Kekewich, J., the colours, patterns, shape, and sizes of the plaintiff's *Selvyt* dusters were imitated. In *Elliott v. Hodyson*, 19 R. P. C. 518 (1902), Buckley, J., flat ended cigars were imitated.

<sup>4</sup> A curiously shaped stick on which the plaintiffs' carpets were rolled has been protected in America: *Lowell Manufacturing Co. v. Larned*, Cox, 2nd ed., p. 241. In *Parker and Smith v. Satchwell*, 18 R. P. C. 299 (1901), Farwell, J., the show cards on which the defendant's goods were sold closely resembled those used by the plaintiffs.

<sup>5</sup> 36 C. D. 1; 4 R. P. C. 492 (1887) Chitty, J., and C. A. Cf. *Lever v. Beddingfield*, 16 R. P. C. 3 (1899), C. A.

similar packets and paper, with the words *Goodwin's Self-washing Soap* printed upon it in similar type. It was treated as an obvious case of fraud.<sup>1</sup>

"Looking at the two tablets," Cotton, L.J., said, "one cannot but see that there is a strong general resemblance between them, and especially in the eyes of people who cannot read. But (the defendants') contention was this: there is no trade mark in *Self-washer* or *Self-washing*;<sup>2</sup> there is no monopoly in this parchment paper; there is no monopoly in the spaced printing; then why should we be restrained, in carrying on business, from using those things as to which the plaintiffs cannot claim any monopoly? That is an obvious fallacy. There may be no monopoly at all in the individual things, but, if they are so combined by the defendants as to pass off the defendants' goods as the plaintiffs', then the defendants have brought themselves within the old common law doctrine in respect of which equity will give to the aggrieved party an injunction to restrain the defendants from passing off their goods as those of the plaintiffs."<sup>3</sup>

No case can be made merely by showing an imitation of the parts of the get-up of goods which are common to the trade.<sup>4</sup> And even where a trader introduces a new feature into the get-up of his goods he does not thereby acquire any proprietary interest in it, so as to be able to prevent its use by competitors without proving that it has become so identified with his goods that its use by others is calculated to deceive.<sup>5</sup> The fact that the

No monopoly in the constituent elements.

Get-up common to the trade,

or newly introduced.

<sup>1</sup> Imitations of the descriptive and commendatory inscriptions, and of the directions for use printed on the covers of patent medicines and proprietary articles are very common: *Franks v. Weaver*, 16 Beav. 297 (1847), Langdale, M.R.; and *Massam v. Thorley's Cattle Food Co.*, 14 C. D. 748 (1880), C. A., are instances. As to prizes, medals, and testimonials, see above, p. 487, and below, p. 526, note (5).

<sup>2</sup> It had been struck off the Register on the defendants' application.

<sup>3</sup> *Blofeld v. Payne*, 4 B. & Ad. 410; 2 L. J. K. B. (N. S.) 68 (1833), imitation of envelope; *Great Tower Street Tea Co. v. Langford & Co.*, 5 R. P. C. 66 (1887), Stirling, J., of packets; *Hammond v. Brunker*, 9 R. P. C. 301 (1892), Chitty, J., of label; *Stephens v.*

*Peel*, 16 L. T. N. S. 145 (1867), Wood, V.-C., of bottle, and *Steel-pens for Stephens*.

<sup>4</sup> Page 520, n. (1). *Imperial Tobacco Co. v. Purnell*, 21 R. P. C. 368, 598 (1904), Joyce, J., and C. A., narrow red bands for cigars.

<sup>5</sup> In *Payton v. Snelling, Lampard & Co.* (above, p. 520, n. (1)), the plaintiffs had been the first to put up coffee in tins enamelled in bright colours. The practice was soon followed, and it was held that the plaintiffs had no monopoly in such tins. See also the remarks of Kekewich, J., in *Hubbuck v. Brown*, 17 R. P. C. at p. 154 (1900), and in *Alaska Packers' Association v. Crooks*, 18 R. P. C. 129 (1901), as to the fashion of the market.

peculiarities of get-up which are relied on by the plaintiff have become identified with and distinctive of his trade must be proved as in any other case of passing-off.<sup>1</sup> But very little evidence of user may be sufficient where the get-up is not only novel but striking.<sup>2</sup> The case is then analogous to that of a "fancy word."

Imitation of  
part of get-  
up.

It is not, however, necessary that every part of the get-up should be imitated, for, though no exclusive right to the use of any single feature of it which is not a registered trade mark is recognised, yet a part of the get-up, a picture, for instance, which is used on the label or wrapper, may be shown to be so identified with the plaintiff's goods that its use for similar goods is calculated to pass them off as his. The picture, in effect, may become—as the trade name of the plaintiff's goods may—a "common law trade mark."<sup>3</sup>

Thus, in *Jay v. Ladler*,<sup>4</sup> the plaintiff used the device of a lady and a bear, in his trade as a furrier, by attaching it to the wrappers and boxes in which he sent out his goods, but he had registered it only as a trade mark for sealskin mantles and coats. The defendant began to issue a circular, bearing a similar mark, in connection with his trade, which was also that of a furrier. Two injunctions were granted, one, restricted to the mantles and coats, to restrain infringement of the trade mark, the other, not so restricted, to restrain the defendant from using the device so as to deceive the public.

And, on the other hand, the imitation of a number of things, each of which is in itself not distinctive of the plaintiff's goods, may make a strong case on account of the cumulative effect of the detailed resemblances.<sup>5</sup>

Only things which are put prominently forward so as to be likely to catch the eye of a purchaser and remain in his memory need generally be considered. Thus, the printing on the back or sides of a box may usually be disregarded in considering whether the get-up of goods is likely to deceive.<sup>6</sup>

<sup>1</sup> See note (5), previous page.

<sup>2</sup> *Weingarten v. Bayer*, 22 R. P. C. 341 (1905), H. L. (*Erect Form* with *corsets* written in a flourish of the E).

<sup>3</sup> Above, p. 481, and *Weingarten v. Bayer*, *supra*.

<sup>4</sup> 40 C. D. 649; 6 R. P. C. 136 (1888). Kekewich, J.; see also *Hart v. Colley*, 44 C. D. 193; 7 R. P. C. 93 (1899), North, J.; and *Great Tower Street Tea*

*Co. v. Langford & Co.*, 5 R. P. C. 66 (1887), Stirling, J.; and see p. 516, above.

<sup>5</sup> See the judgment, in *Lever v. Goolwin*, quoted above, and compare it with those in *Lever v. Bedingfield*, 16 R. P. C. 3 (1899), C. A. See also per Wood, V.-C., in *Woollam v. Radcliff*, 1 H. & M. 259, cited ante, p. 517.

<sup>6</sup> "I attribute very little importance indeed in a case of this kind to the sides

It is no answer to a case founded on passing-off by "get-up" that the plaintiff's trade mark which appears on his goods or the special name of his goods is not taken or infringed. But if a plaintiff by his cautions and advertisements shows that he relies wholly or mainly on his trade mark or trade name, he makes his case on general get-up, apart from trade mark or trade name, more difficult to establish.<sup>1</sup>

**3. Use in Connection with the Defendant's Goods.**

The spurious badges must be used in connection with goods which are not the plaintiff's, but they need not be stamped or printed upon them or their envelopes. The fraudulent trade names, for instance, in most of the cases where injunctions have been granted, were used as descriptions of the defendants for general purposes, and in their advertisements and circulars,<sup>2</sup> or were placed over their shop doors.<sup>3</sup> In *Jay v. Ladler*,<sup>4</sup> the deceptive representation was effected by sending to the defendant's customers a circular inclosing a print of a design resembling the plaintiff's distinctive design. The action extends to every kind of representation which is calculated to pass off the defendant's goods as the plaintiff's.

Name, &c., need not be attached to the goods.

**4. Probability of Deception.**

The Court must be satisfied that the defendant's conduct is calculated to pass off other goods as those of the plaintiff, or, at least, to produce such confusion in the minds of probable customers or purchasers as would be likely to lead to the other goods being bought and sold for his.<sup>5</sup> This is the foundation of the action.

Where deception is intended.

If it is shown to have been intended by the defendant to deceive in this way, the Court will not generally push the inquiry further.<sup>6</sup>

and back." Per Kekewich, J., in *Lever v. Beddingfield*, 15 R. P. C. at p. 462 (a box of tablets of soap).

<sup>1</sup> See *Hennessy v. Keating*, 25 R. P. C. 125 and 361 (1908), H. of L., and also *Imperial Tobacco Co. v. Purnell*, 21 R. P. C. 368, 598 (1904), Joyce, J., and C. A.

<sup>2</sup> See the injunctions in *Hendriks v. Montagu*, 17 C. D. 638; *Massam v. Thorley*, 14 C. D. 748; and see *Saxlehner v. Apollinaris Co.*, [1897] 1 Ch. 893;

14 R. P. C. 645; Appendix, pp. 732, 737.

<sup>3</sup> *Burgess v. Burgess*, 3 De G. M. & G. 896; 22 L. J. Ch. 675.

<sup>4</sup> 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

<sup>5</sup> *Hendriks v. Montagu*, 17 C. D. 638 (1881); see per James, V.-C., p. 646, and *Schweppes v. Gibbens*, p. 824, note (3), per Romer, L.J.

<sup>6</sup> "Why should we be astute to say that (the defendant) cannot succeed in

But the intention is only evidence of the actual deception or probability of deception which may be inferred from it. And if the Court does not believe that there is any probability of deception, the action must fail.<sup>1</sup> "The law does not take notice of a fraudulent intention in a man's mind if he does nothing to carry out the fraud."<sup>2</sup>

Deception by the deliberate fraud of a third party, e.g., a retailer, where the defendant's mark when fairly used is not calculated to deceive, is not imputable to the defendant.<sup>3</sup>

The existence of unexpected and unexplained similarities<sup>4</sup> between the goods of the defendant and those of the plaintiff, or of similarities which have been modified by colourable differences<sup>5</sup> or by differences and distinctions so arranged as to escape notice;<sup>6</sup> the use by the defendant of descriptions, which, as applied to himself or his own trade, are inaccurate, and by reason

Badges of  
fraud :  
unexplained  
similarities ;  
colourable  
differences ;

doing what he is straining every nerve to do!" Lindley, L.J., asked, in *Slazenger v. Feltham*, 6 R. P. C. p. 538 (1889). Cf. per Ld. Maclesfield, in *Mitchell v. Reynolds*, 1 Smith L. C., 10th ed., p. 391. "He only can suffer by his knavery, and surely Courts of Justice are not concerned lest a man should pay too dear for being a knave." And see *Lambert and Butler, Ltd. v. Goodbody*, 19 R. P. C. 377 (1902), Farwell, J., at p. 381; *Iron Ore Remedy Co. v. Co-operative Wholesale Society*, 21 R. P. C. 425 (1907), Parker, J., at p. 430; *Hennessy v. Keating*, 24 R. P. C. 125, Fitzgibbon, L.J., at p. 136.

<sup>1</sup> *Lever v. Beddingfield*, 16 R. P. C. 3 (1898), C. A., overruling 15 R. P. C. 453, Kekewich, J.

<sup>2</sup> Per Ld. Esher, M.R., in *Reddaway v. Banham*, 12 R. P. C. at p. 89. "If intent to deceive be once established, it is a short step, though it is a step, and not an inevitable one, to the conclusion that the intention has been fulfilled, and that the goods are calculated to deceive," per Kekewich, J., in *Saichner v. Apollinaris Co.*, 14 R. P. C. at p. 651.

<sup>3</sup> *Payton v. Snelling*, [1901] A. C. 308; 17 R. P. C. 635; *Schweppes, Ltd. v. Gibbens*, 22 R. P. C. 113, 601 (1905), C. A. and H. of L.; *Hennessy v. Keating*, 25 R. P. C. 361 (1908), H. of L.

<sup>4</sup> *Taylor v. Taylor*, 2 Eq. Rep. 290;

23 L. J. Ch. 255 (1854), Wood, V.-C.

<sup>5</sup> *Slazenger & Sons v. Feltham & Co.*, 6 R. P. C. 531 (1889), C. A. (*Demon, Demotic*). Obvious differences between the goods themselves are very material to the question: *Coleman v. Brown*, 16 R. P. C. 619 (1899), North, J., and C. A. on an interlocutory application (*Wincarnis, Vincalis*). *Fairbank Co. v. Cocos Butter Manufacturing Co.*, 21 R. P. C. 23 (1904), Swinfen Eady, J. (*Cottolene, Cocozoline*), an action for infringement; *Apollinaris Co., Ltd. v. Duckworth*, 23 R. P. C. 540 (1906), Warrington, J. (*Apollinaris Salts*); *Reddaway & Co., Ltd. v. Irwell and Eastern Rubber Co., Ltd.*, 23 R. P. C. 621; 24 R. P. C. 203 (1907), Neville, J., and C. A. (*Lancashire* for hair belting, *Lanco* for balata belting); *Pianolist Co.'s Application*, 23 R. P. C. 774 (1906), Parker, J., *Pianola* and *Ncola* for different instruments; *Turner's Motor Manufacturing Co., Ltd. v. Miesse Petrol Car Syndicate, Ltd.*, 24 R. P. C. 531 (1907), Warrington, J., steam motor cars and petrol motor cars. Cf. application of *Compagnie Industrielle des Petroles*, [1907] 2 Ch. 435; 24 R. P. C. 585, Warrington, J., *motorine* for lubricating oils, *motricine* for petrol; and the cases cited above, p. 228.

<sup>6</sup> E.g., "late of," &c., in small letters, Chap. XV., p. 409.



of their inaccuracy approach more nearly to the proper description of the plaintiff,<sup>1</sup> and the gradual approximation of the defendants' names, get-up, or description to those of the plaintiff,<sup>2</sup> are all obvious badges of fraudulent intention frequently recurring in the cases which come before the Court.<sup>3</sup>

gradual approximation.

Instances of actual deception need not be proved if the Court is otherwise satisfied of the probability of deception;<sup>4</sup> and on the other hand, they are not necessarily conclusive where they have occurred, in cases, for example, where their number is comparatively insignificant.<sup>5</sup> And, of course, proof of deception is not sufficient to enable the plaintiff to succeed if the defendant has done nothing but what he was entitled to do, as where he has only used marks common to the trade.<sup>6</sup>

Proof of actual deception.

The question what resemblance is calculated to deceive, and the modes of comparison adopted, have been sufficiently considered in the preceding chapters.<sup>7</sup>

Proof of probability of deception.

All the circumstances of the case must be considered. Thus where the mark in question is not attached to the goods themselves so as to reach the ultimate purchasers, it may be clear that

<sup>1</sup> *Holloway v. Holloway*, 13 Beav. 209 (1850), Langdale, M.R.

<sup>2</sup> *Boulnois v. Peake*, 13 C. D. 513, n. (1868), Giffard, V.-C., *Carriage Repository* changed to *New Carriage Bazaar*; *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478 (1887), C. A. (*Apollinis*); *Sanitas Co., Ltd. v. Condy*, 4 R. P. C. 195, 530; 56 L. T. 621 (1886), Kay, J. (*Condi-Sanitas*). "When a manufacturer's goods are a drug on the market so long as they bear his own name or proclaim their true origin, and yet are saleable at once if marked with nothing but some common English words, and when that manufacturer holds himself out as ready and willing so to mark his goods, and does so mark them at the 'instigation,' as he says, of a purchaser, a Lancashire jury may perhaps be trusted to solve the riddle." Per Ld. Macnaghten in *The Camel Hair Belting* case, 13 R. P. C. at p. 233. See also *Colman v. Farrow*, 15 R. P. C. 198 (1898), Stirling, J.

<sup>3</sup> See further, p. 409.

<sup>4</sup> See the last chapter, p. 401, and Parker, J., in *Iron Ore Remedy Co., Ltd. v. Co-operative Wholesale Society*, 24

R. P. C. 425, at p. 430 (1907).

<sup>5</sup> *Civil Service Supply Association v. Dean*, 13 C. D. 512 (1849), Malins, V.-C.; *Borthwick v. The Evening Post*, 37 C. D. 449 (1888), C. A.; *Leahy, Kelly and Leahy v. Glover*, 10 R. P. C. 141 (1893), H. L.; *Rutter v. Smith*, 18 R. P. C. 4 (1901), Kekewich, J.

<sup>6</sup> See below, *Defences*, and above, p. 520, note (1). In *Jamieson v. Jamieson*, 15 R. P. C. 169 (1898), the C. A. dismissed the action, although Byrne, J., had found both actual deception and intention to deceive. In *King v. Gillard*, 22 R. P. C. 327, the defendant copied some common elements from the plaintiff's box.

<sup>7</sup> Chap. XV., p. 400; Chap. X., p. 234; see also *Goodfellow v. Prince*, 35 C. D. 9 (1887), C. A. (plaintiff and defendant both mere importers); *Bodega Co. v. Owens*, 6 R. P. C. 236; 7 R. P. C. 31; 23 L. R. Ir. 371 (1889), Chatterton, V.-C. (defendant called his wine shop in Belfast *Bodega*; plaintiff had no *Bodega* shop in Ireland outside Dublin).

the trade purchasers to whom the defendant's business is confined are not in danger of being deceived.<sup>1</sup>

### 5. Proof of Damage.

Probability or proof of damage is essential.

Proof of damage is not in every case essential to enable the plaintiff to maintain his action, for if he shows that the defendant is acting so as to pass off goods as those of the plaintiff which are not the plaintiff's, it will generally be assumed that the plaintiff is thereby prevented from selling as many of the goods as he otherwise would. But if this assumption is negated by the circumstances of the case, proof of actual or probable damage is necessary.<sup>2</sup> For the assumption of a name,<sup>3</sup> or an address,<sup>4</sup> similar to the name or address of the plaintiff, without malicious intent, although it may cause annoyance and inconvenience to him,—for instance, by delaying his letters,—is not actionable, unless it is shown to be calculated to injure him in his trade. And no action lies at the suit of any private person for deception practised upon the public, unless it incidentally causes, or is calculated to cause, damage to him as an individual; if this is not the case, the wrongdoer can only be punished through the criminal law, or in a civil action on information brought in the name of the Attorney-General.<sup>5</sup>

The questions how far the inconvenience caused to a trader by the use of his trade name, or the trade name of his goods, in a business which is not in competition with his own, and how far the interference with a possible extension of his existing business entitle him to sue, have already been considered.<sup>6</sup>

<sup>1</sup> *Star Cycle Co. v. Frankenburgs*, 24 R. P. C. 46, 405 (1907), Eady, J., and C. A. (use in trade price lists); *Fairbank Co. v. Cocos Butter Co.*, 21 R. P. C. 23 (1903), Eady, J.

<sup>2</sup> So that a non-trader has no action, ante, p. 392; *Delondre v. Shaw*, 2 Sim. 237 (1828), Shadwell, V.-C.; *Levy v. Walker*, 10 C. D. 436 (1879). See also cases in p. 525, note (7)

<sup>3</sup> *Borthwick v. The Evening Post*, above, p. 506; *Du Boulay v. Du Boulay*, L. R. 2 P. C. 430.

<sup>4</sup> *Day v. Brownrigg*, 10 C. D. 294 (1878), C. A.; *Street v. Bank of Spain and England*, 30 C. D. 156 (1885), Pearson, J., adoption by the defendants (bankers) of the same cypher telegraphic

address as that of the plaintiff.

<sup>5</sup> Per Cotton, L.J., in *The Native Guano Co. v. The Sewage Manure Co.*, 8 R. P. C. p. 128 (1891); see also *Clark v. Freeman and Williams v. Hodge*, cited above, pp. 487, 488; *Batty v. Hill*, 1 H. & M. 264 (1863), Wood, V.-C., false pretence of award of gold medal. In *The Maizena* case (above, p. 364), the Privy Council thought that the defendants had made an objectionable reference to a medal really gained by the plaintiffs, but that it was a mere advertising trick. The defendants gave an undertaking to discontinue the reference, and the action was dismissed: [1894] A. C. 275; 11 R. P. C. 281.

<sup>6</sup> Above, p. 507, and note (4).

**6. Defences.**

The defences, other than a simple denial of the acts alleged, which are commonly set up, may be tabulated as follows: that—

- (1) The name, or other badge, which the plaintiff charges the defendant with having imitated, carries no distinctive reference to the plaintiff's goods.
- (2) The defendant has an independent or a concurrent right to use it.<sup>1</sup>
- (3) The name or other badge which the defendant is using, is not such, or is not so used, as to be calculated to pass off other goods for those of the plaintiff.<sup>2</sup>
- (4) The plaintiff is debarred from suing the defendant for all or part of the relief he seeks by (a) an agreement, or some personal estoppel<sup>3</sup> (other than those next alluded to); (b) acquiescence;<sup>4</sup> (c) delay;<sup>5</sup> or (d) deceptive use of the name or badges he relies on, or because his trade is fraudulent.<sup>6</sup>

(1) This is a traverse of part of the plaintiff's case. It may take the form of an allegation that the name or other badge is merely descriptive.<sup>7</sup> If so, the defence falls under the second head also. Denial of repute.

(2) This defence is discussed below. The most important case is the right of any man, apart from restriction by contract, to trade honestly under his own name.<sup>1</sup> That right is, of course, an answer only to a case which rests wholly upon an alleged imitation or adoption of the trade name which the plaintiff is using. Concurrent right.

(3) This defence also is a mere traverse. It has been considered already.<sup>8</sup> Denial of deception.

(4) The defences collected under the fourth head are precisely analogous to those discussed in the last chapter; they depend on the same considerations and are governed by the same rules.<sup>9</sup> Estoppel.

<sup>1</sup> See, as to the right to use a man's own name, p. 532; and as to the right to describe honestly the place of origin, &c. of his goods, p. 517; and further, the last chapter, "Infringement," pp. 411 *et seq.*

<sup>2</sup> Above, p. 523; and Chap. XV., p. 400.

<sup>3</sup> Page 419.

<sup>4</sup> Page 421.

<sup>5</sup> Page 423.

<sup>6</sup> Page 439.

<sup>7</sup> Above, pp. 507 *et seq.*

<sup>8</sup> Note (2), above.

<sup>9</sup> See *Keal v. Richardson*, 45 L. T. N. S. 54 (1881), C. A. (*Dog's Head Beer*).

## Concurrent Right.

The defendant may have as good a title to use the name or other things in question as the plaintiff has to use the name or things with which it or they are, as he alleges, likely to be confused.

Registered  
trade mark.

The defence of concurrent right with regard to a registered trade mark is discussed in the last chapter.<sup>1</sup> Registration of a mark which is deceptive confers no right to use it so as to pass off the defendant's goods as those of the plaintiff.<sup>2</sup>

Partners after  
dissolution.

On the dissolution of a partnership, in the absence of special agreement, and unless the firm name is sold or assigned with the goodwill, as it may be,<sup>3</sup> each partner has an equal right to use it, if he continues to carry on a similar business to that of the late firm,<sup>4</sup> provided that he does not by so doing expose his former partners to any risk of liability.<sup>4</sup> Whether there will be any such risk is a matter to be determined under the circumstances of the particular case.<sup>5</sup>

Purchaser of  
goodwill.

It is convenient to note here, in passing, that the purchaser of the goodwill of a business, or a partner succeeding to it under agreement upon dissolution of partnership, has a right to use the trade name and trade marks under which it was conducted.<sup>6</sup> And this even though it comprise the personal name of a late partner,<sup>7</sup> or of any other late owner of the goodwill, but not so as to cast any risk of liability upon the late partner or owner<sup>8</sup>

<sup>1</sup> Above, p. 411. *Lyle and Kinahan's Application*, 24 R. P. C. 249 (1907), C. A., see p. 256; *Van Zeller v. Mason*, 25 R. P. C. 37 (1907), Joyce, J.

<sup>2</sup> See the judgment of Buckley, L.J., quoted above, p. 415.

<sup>3</sup> *Hall v. Barrows*, 4 De G. J. & S. 150; 33 L. J. Ch. 204 (1863), Westbury, L.C.; and see Lindley on Partnership, 6th ed., pp. 445 and 449; and *In re David and Matthews*, below, p. 529.

<sup>4</sup> *Burchell v. Wilde*, [1900] 1 Ch. 551; Byrne, J., and C. A. (*Burchell & Co.*); *Banks v. Gibson*, 34 Beav. 566; 34 L. J. Ch. 591 (1865), Romilly, M.R.; *Levy v. Walker*, and *Chappell v. Griffiths*, *infra*; and see further on this subject, Sebastian, 3rd ed., p. 289; 4th ed., p. 299.

<sup>5</sup> *Burchell v. Wilde*, *supra*; and see next paragraph.

<sup>6</sup> *Levy v. Walker*, 10 C. D. 436 (1879), C. A.; *Currie v. Currie*, 15

R. P. C. 339 (1897), Ct. of Sess. (*Prince Charlie*). For a case where the purchase of goodwill and right to use a trade name was inferred upon a sale of stock-in-trade and patterns, see *Rickerby v. Reay*, 20 R. P. C. 380 (1903), Byrne, J. For cases of colourable purchase of a goodwill, see above, pp. 502, 503.

<sup>7</sup> *Condy v. Mitchell*, 37 L. T. N. S. 268, 766 (1887), Bacon, V.-C., and C. A. (*Condy's Fluid Co.*); *Chappell v. Griffiths*, 53 L. T. N. S. 459 (1885), Kay, J.

<sup>8</sup> *Chatteris v. Isaacson*, 57 L. T. N. S. 177 (1887), Kekewich, J. The vendor of the business of "Mme. Elise" agreed that the purchaser should have the exclusive right to use the name "Mme. Elise & Co." Mme. Elise was his wife's name. Held, the purchaser must use the addition "& Co." In *Burchell v. Wilde*, [1900] 1 Ch. 551, it was held that, upon the division of a solicitor's business between the partners on dissolution, the

by using his personal name in such manner as to represent that he is still a member of the firm, or carrying on the business.<sup>1</sup>

But where the goodwill of a business is sold, or is taken over on the dissolution of a partnership by agreement, without any restrictive condition being imposed upon the late owner or the retiring partner which restrains him from exercising his ordinary right, he is at liberty to start in the same trade again at once under his own name, so long as he uses it honestly, even though it be the same as, or be similar to, the name under which the old business was, and continues to be, carried on.<sup>2</sup>

In such a case the vendor or retiring partner could not trade under the old name if it differed from his own personal name.<sup>3</sup> And he would not be allowed to solicit his old customers in the business which he has sold, because to do so would be to derogate from his grant.<sup>4</sup>

In *Re David and Matthews*,<sup>5</sup> there was a provision in a deed of partnership between two partners, that on the death of either a

Trader may use his own name after the sale of his business, where no contrary agreement.

Vendor must not solicit his old customers.

partner whose name was Burchell would run no risk by reason of the use by the other of the old name. *Burchell & Co.* Notice of the change had been given to all the clients. The defendant, in fact, undertook to carry on business under a different name, viz., *Burchell, Wilde & Co.* In *Townsend v. Jarman*, [1900] 2 Ch. 698; 17 R. P. C. 649, Farwell, J., the plaintiff bought the business of Jarman & Co., Ltd., seedsmen, from a company to whom he and the defendant had, on the dissolution of their partnership, transferred it. He carried on business as *Jarman & Co.*, and it was held that the defendant could not complain of this. The defendant had sold business premises on which his name, *E. J. Jarman*, was cut to the company, who had transferred them to the plaintiff. It was held that the defendant could not compel the plaintiff to remove the name. See also *Routh v. Webster*, 10 Beav. 561 (1847); and *Prudential Assurance Co. v. Knott*, L. R. 10 Ch. 142 (1875); also *Rosher v. Young*, Sol. Jo., Vol. 45, p. 344.

<sup>1</sup> *Dickson v. McMaster & Co.*, 18 Ir. Jur. 202 (1866), Brady, C.; *Scott v. Rowland*, 26 L. T. N. S. 391 (1872). *Wickens*, V.-C.; *Gray v. Smith*, 43

C. D. 208 (1889), C. A.; *Thynne v. Shore*, 45 C. D. 577 (1890), Stirling, J. There can be no risk where the late partner is dead, *Webster v. Webster*, 3 Swan. 490 (1791). Thurlow, L.C.; see Lindley on Partnerships, 7th ed., p. 483.

<sup>2</sup> *Churton v. Douglas*, Johnson, 174; 28 L. J. Ch. 841 (1859), Wood, V.-C.; see page 531; *Johnson v. Helleley*, 34 Beav. 63; 34 L. J. Ch. 32, 179; 2 De G. J. & S. 446 (1864), Romilly, M.R., and L.J.J.; *Labouchere v. Dawson*, L. R. 13 Eq. 322 (1872), Romilly, M.R.

<sup>3</sup> The grant would then pass the exclusive right to the name. *Mrs. Pomeroy, Ltd. v. Sculé*, 24 R. P. C. 177 (1907). See judgment of Parker, J. See also cases cited in last note.

<sup>4</sup> So finally decided in *Trego v. Hunt*, [1896] A. C. 7, overruling *Pearson v. Pearson*, 27 C. D. 145, on this point. See also *Gillingham v. Beddow*, [1900] 2 Ch. 242. The order made by the H. L. in the first case restrained the defendant from applying privately by letter, personally, or by a traveller, to any person who was, prior to the dissolution, a customer of the old firm, asking such customer to deal with him (the defendant) or not to deal with the plaintiffs.

<sup>5</sup> [1899] 1 Ch. 378.

general account should be taken for the purpose of determining the value of the share of the deceased partner which was to be paid by the survivor, who, under other provisions, took over the assets of the firm. A question arose whether the goodwill should be included in the account or not, and, if it were, upon what basis it should be valued. Romer, J., after reviewing all the authorities on the subject, decided that the goodwill must be included as part of the assets, and must be valued as on a sale upon the footing that, if it were sold, the surviving partner would be at liberty to carry on a rival business, but not to solicit any person who was a customer of the firm before the death of the partner, or to carry on business under the firm name, which was made up of the names of both partners.

Questions between the purchaser of a business and its former owners, or some of them, respecting the use of the firm name seldom arise except upon a dissolution of partnership, or after the sale of the goodwill of a debtor's business by his trustee in bankruptcy; for no careful purchaser would agree to buy the goodwill of a business without stipulating for the exclusive use of the trade name, and probably stipulating also that the vendor should not carry on a new competitive business.<sup>1</sup>

Sale in  
bankruptcy.

A trustee in bankruptcy has no power to contract on behalf of the bankrupt, and the bankrupt is not a grantor so as to be bound by the rule applied in *Trego v. Hunt*. The sale of the goodwill of his business in the bankruptcy, accordingly, throws no obligation upon the bankrupt trader other than the obligation of the general law, not to represent that the business is still carried on by him.<sup>2</sup> The purchaser can, however, restrain the bankrupt from using a firm name, but not from using his own name.<sup>3</sup>

The vendor  
must not  
represent that  
his business  
is the old  
business, or  
its successor.

But the late owner or partner must do nothing, other than make an honest use of his own name, which is calculated to suggest that he is carrying on the old business.<sup>4</sup>

<sup>1</sup> As to the registered trade marks on a dissolution, see sec. 23, and above, p. 352.

<sup>2</sup> *Walker v. Mottram*, 19 C. D. 355 (1881), C. A. In *Trego v. Hunt*, above, p. 529, note (4), *Id.* Macnaghten said: "There is all the difference in the world between the case of a man who sells what belongs to himself and receives the consideration, and a man whose pro-

perty is sold without his consent by his trustee in bankruptcy, and who comes under no obligation, express or implied, to the purchaser from the trustee."

<sup>3</sup> *Melrose Dricer, Ltd. v. Heddle*, 4 Fraser (Ct. of Sess., 5th series), 1120 (1902).

<sup>4</sup> As to the use of the word "late," see above, pp. 409, 485.

"It has been settled," James, V.-C., said, in *Hudson v. Osborne*,<sup>1</sup> "that there is no implied covenant of any kind in the sale by an individual himself of the goodwill of his business; but it seems to be settled that a trader, whose business, and the goodwill of whose business, have been sold by himself, or by any person deriving title under him, has no right to represent himself as carrying on that identical business; he has no right to use the trade marks which were the marks of that business, or, by the use of the name, or of a title of the firm, to represent himself as being the continuer of that identical business which has been sold."

And, in *Churton v. Douglas*,<sup>2</sup> a partner, who, after he had sold his share in the business of "John Douglas & Co." to his co-partners, continued to trade as "Churton, Bankart, and Hirst, late John Douglas & Co.," was restrained from trading as "John Douglas & Co.," or representing that his new business was a continuation of the old business.

The question whether a late partner, or other late owner of a business which has passed into the hands of the plaintiff, is representing that he is still carrying it on, or that his present business is its successor, or is only fairly working and advertising the latter business as his own, is often one of great nicety.<sup>3</sup> The case of *Mogford v. Courtenay*<sup>3</sup> is an illustration of this. There the partnership between the parties having expired by effluxion of time, and the goodwill passing under the partnership articles to the plaintiff, but without any restrictive covenant binding the defendant not to use the firm name or any similar name, the defendant was restrained from issuing a circular to the old customers stating the fact of dissolution, and that he had joined a new firm, and asking the customers for a "continuance" of their custom. This was held to be a suggestion that he was about to carry on, not merely a similar business, as he lawfully might, but the identical business which had passed to the plaintiff. It appears by the more recent authorities<sup>4</sup> that he

<sup>1</sup> 39 L. J. Ch. 79 (1869). This was, of course, before the decision in *Trego v. Hunt*.

<sup>2</sup> Page 529, note (2); *Witt v. Concoran*, 2 C. D. 69 (1873), Bacon, V.-C., is a similar case; *Benbow v. Low*, 44 L. T. 875; 29 W. R. 837 (1881), Bacon, V.-C.

<sup>3</sup> 45 L. T. N. S. 303 (1881). Fry, J. The decision that the defendant might not solicit the old customers has since been approved by the House of Lords, above, p. 529.

<sup>4</sup> *In re David and Matthews*, above, p. 529.

ought to have been restrained from privately soliciting the old customers to deal with him in any terms whatsoever.

### The right to Trade under one's own Name.

The general rule.

It is frequently stated, as a general rule, that any man may, so long as he acts honestly, trade under or describe his goods by his own name, or the names of himself and his partners, even though the similarity of such name or names to the name under which another person has previously been trading, or to the trade name of that other's goods, may occasionally lead to confusion or lead to the business or goods of the new-comer being mistaken for the business or goods of the earlier trader.<sup>1</sup>

Thus, Knight-Bruce, L.J., said, in a suit between father and son,<sup>2</sup> "all the Queen's subjects have a right to sell (their goods) in their own names, and not the less that they bear the same name as their father"; "but," he added, "if any circumstances of fraud had accompanied, and were continuing to accompany, the case, it would stand very differently." And in a recent Scotch case<sup>3</sup> Lord Kyllachy said, "Far as the law may have gone in its justifiable anxiety to prevent imposition upon the unwary purchaser, and content as it has sometimes been to pursue that object at the expense of encouraging the acquisition of virtual monopolies by traders and companies prepared to spend largely in systematic advertising and litigation, it has never as yet, at least so far as I know, gone the length of debarring any merchant or manufacturer from selling his own goods under his own name, unless there has been, in addition to the use of that name, some overt act or course of conduct plainly indicative of

<sup>1</sup> See the 5th and 6th rules stated by Kay, L.J., in *The Yorkshire Relish* case, printed in a note to this chapter (p. 550), and the judgment of Lindley, L.J., in the same case: [1896] 2 Ch. at p. 70; 13 R. P. C. at p. 270; the judgments of the C. A. in *Turton v. Turton*, 42 C. D. 128 (1889), and *Warner v. Warner*, 5 T. L. R. 327, 359. In *Reddaway v. Banham* (below, p. 534), however, Ld. Macnaghten said he was at a loss to know why *Turton v. Turton* was ever reported, and that the plaintiff's case was extravagant and absurd: [1896] A. C. at p. 220; 13

R. P. C. at p. 234.

<sup>2</sup> *Burgess v. Burgess*, 3 De G. M. & G. 896; 22 L. J. Ch. 675 (1853); see below, p. 533, note (4).

<sup>3</sup> *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Motor Co., Ltd.*, 23 R. P. C. 761 (1907), aff. in the H. L., [1907] A. C. 430; 24 R. P. C. 572, where the question was dealt with merely as one of fact. In *Abel Morrall, Ltd. v. Hessin*, 20 R. P. C. at p. 433. Romer, L.J., said: "The law is settled and it is merely a question of fact. If fairly and honestly done, it cannot be stopped."



fraud—that is to say, of dishonest effort to pass off his own goods as the goods of another.”

It is doubtful, however, whether any rule can now be laid down as an absolute rule of law. The inclination of the Courts is to treat the question whether the use of the name in question by a defendant is calculated to pass off his business or goods as that or those of the plaintiffs as one of fact in each particular case, as though there were no difference in principle between a man's own name and any other apparently descriptive word.<sup>1</sup> There is, as already stated, no reported instance, where, apart from fraud, a defendant has been absolutely restrained from using his own name, but in one case<sup>2</sup> an order was made restraining him from using it without taking reasonable precautions to distinguish his business and goods from those of the plaintiff, and orders have occasionally been made restraining the use of the name descriptively, e.g., as *Cash's Frillings*<sup>2</sup> or *Fowne's Gloves*.<sup>3</sup> But such orders will only be made in the rare and highly exceptional cases where it can be proved that a personal name has become so identified by use in a wide-spread and well-known business with a particular trader as to be necessarily deceptive when used without qualification by anyone else in the same trade.

Present state  
of authorities.

In the *Anchovy Sauce* case cited above,<sup>4</sup> Turner, L.J., said that “it is a mere question of evidence in each case whether there is a false representation or not,” and in the *Camel-hair Belting*

<sup>1</sup> *The Valentine Meat Juice Co. v. The Valentine Extract Co., Ltd.*, 17 R. P. C. 673 : 53 L. T. 259 (1900), C. A. As to the conditions under which a descriptive word can be monopolised, see above, pp. 508 *et seq.*

<sup>2</sup> *J. & J. Cash, Ltd. v. Cash*, 18 R. P. C. 213 (1901) ; 19 R. P. C. 181, Kekewich, J., and C. A. An absolute injunction restraining the use of *Cash* was granted in the first instance. The C. A. altered this by adding “without taking reasonable precautions to distinguish, &c.” It is said, as stated in the text, that the same rules are to apply to a personal name and any other *prima facie* descriptive word. One such rule is that the word must have wholly lost its ordinary descriptive meaning for the trade purposes under consideration (see

above, p. 509). How can this be the case while it remains the name and the only proper description of a person who is lawfully engaged in the trade?

<sup>3</sup> *Ryden v. Jones*, 22 R. P. C. 417 (1905), Eady, J.

<sup>4</sup> *Burgess v. Burgess*, 3 D. M. & G. 896 : 22 L. J. Ch. 675 (1853), Kindersley, V.-C., and Knight-Bruce and Turner, L.JJ., on an interlocutory application. The defendant, who had recently left the employment of his father, the plaintiff, and set up a rival business in King William Street, was restrained from describing his business as “late of 107, Strand.” his father's address; but the Court refused to restrain him from trading under his own name or describing his goods as “Burgess' Essence of Anchovies.”

case,<sup>1</sup> in which the matter was placed upon its modern footing by the opinions of the learned Law Lords, this statement was adopted and approved. Lord Halsbury, L.C., said<sup>2</sup> that no principle of law was laid down in the earlier cases which would have prevented an injunction, although the defendant's name was Burgess and although the article was described by a descriptive name, but that, in the view of the Lords Justices, the descriptive name there in question, *Burgess' Essence of Anchovies*, had not, as a matter of fact, acquired the technical signification of being only made by Burgess the father.

Lord Herschell said:<sup>3</sup> "the name of a person or words forming part of the common stock of language, may become so far associated with the goods of a particular maker that it is capable of proof that the use of them by themselves without explanation or qualification by another manufacturer would deceive a purchaser into the belief that he was getting the goods of A. when he was really getting the goods of B. In a case of this description the mere proof by the plaintiff that the defendant was using a name, word or device, which he had adopted to distinguish his goods, would not entitle him to any relief. He could only obtain it by proving further that the defendant was using it under such circumstances or in such manner as to put off his goods as the goods of the plaintiff."

These passages, and the passage from the judgment of Vaughan Williams, L.J., in *Jamieson v. Jamieson*, quoted below,<sup>4</sup> were cited by Lord Alverstone, M.R., in *The Valentine Meat Extract* case,<sup>5</sup> as establishing that the supposed exception to the general rule stated at the head of this chapter in the case of a man's own name does not exist.

It follows that it is no more essential, in theory, to prove a fraudulent intent in a passing-off case which depends upon the use by the defendant of his own name than in any other case.<sup>6</sup>

While, however, the possibility of such a monopoly of a personal

<sup>1</sup> *Reddaway v. Banham*, cited above, pp. 42 and 512.

<sup>2</sup> [1896] A. C. at p. 204; 13 R. P. C. at p. 225.

<sup>3</sup> [1896] A. C. at p. 210; 13 R. P. C. at p. 228.

<sup>4</sup> Page 536.

<sup>5</sup> Above, p. 533, note (1), and below, p. 537.

<sup>6</sup> *S. Chivers & Sons v. S. Chivers &*

*Co., Ltd.*, 17 R. P. C. 420 (1900), Farwell, J. The learned judge said that in order to make out that a personal name has acquired a secondary meaning, its use in the secondary sense must be shown to have become universal, and that, if this were so, the defendant must necessarily have known that his use of it for his own goods was deceptive and dishonest.

name being established as to prevent the honest use of his own name, without qualification, by the defendant is recognised, the degree of proof exacted is very high, and only one case has been reported in which this has been done.<sup>1</sup> There are, no doubt, many instances in which the deliberately fraudulent attempt of a defendant to make use of his own name, or, more commonly, an assumed name, in order to pass off his goods as another's, has been restrained,<sup>2</sup> or where a company constituted for the purpose of competing with an established business under a name chosen because of its resemblance to the firm name of such business has been compelled to take steps to prevent deception or to change its name.<sup>3</sup>

In *Jamieson & Co. v. Jamieson*,<sup>4</sup> the plaintiff failed because the Court of Appeal decided that the defendant was not bound to use extra precautions to avoid confusion between his goods and those of other persons in the trade, if such confusion arose solely from the similarity of his own name with theirs,<sup>5</sup> and from the use of

*Jamieson &  
Co. v.  
Jamieson.*

<sup>1</sup> *J. J. Cash, Ltd. v. Cash*, cited above, p. 533, and more fully below, p. 539, and see App., p. 738. In *Dewar, Ltd. v. Dewar*, 17 R. P. C. 341 (1900), Ct. of Sess. at p. 358, Ld. Kyllachy said: "I do not myself know of any case in which the use by a man of his own name has been successfully challenged except in circumstances which plainly involved fraud on the part of the user." In the *Dunlop* case he dealt more fully with the matter, see below, p. 540. In *Cellular Clothing Co. v. Maxton*, cited above at p. 513. Ld. Shand ([1899] A. C. at p. 341; 16 R. P. C., at p. 407) said the same thing of descriptive names in general. *The Valentine* case was similar to the *Tussaud* and *Pinel* cases, cited below, where a company was formed with a deceptive name for the purposes of competition.

<sup>2</sup> As *Morrall v. Hessin*, 19 R. P. C. 557; 20 *ib.* 429 (1902), Swinfen Eady, J., and C. A. (*Morrall's needles*); and see *Van Oppen & Co., Ltd. v. Leonard Van Oppen*, 20 R. P. C. 617 (1903), Swinfen Eady, J. *Holloway v. Holloway*, 13 Beav. 209 (1850), Langdale, M.R., was a case of fraudulent imitation of "get-up." The M.R. said: "The defendant's name being Holloway, he has a right to con-

stitute himself a vendor of Holloway's pills and ointment. I do not intend to say anything to abridge any such right."

<sup>3</sup> Above, p. 494.

<sup>4</sup> 15 R. P. C. 169 (1897), C. A., overruling *Byrne, J.* It should be noted that there were other Jamiesons engaged in the trade at Aberdeen besides the parties. It was a "get-up" case, but, in the view of the C. A., the only resemblance between the boxes of the plaintiff and defendant was due to the name and to features common to the trade.

<sup>5</sup> In *J. H. Brooks & Co., Ltd. v. Norfolk Cycle Co. and John Brookes*, 16 R. P. C. 523, the plaintiffs were makers of the well-known "Brooks" saddle. The defendant Brookes was a saddle maker who had newly entered the trade, but his father had sold saddles under his own name, and had been restrained at the instance of the plaintiffs from doing so. Stirling, J., said that knowing the facts and the probability of confusion, it was the defendant's duty to mark his goods so as to avoid all possibility of mistake between them and those of the plaintiffs. Instead of doing this he had imitated the plaintiff's manner of marking. An injunc-

features common to the trade.<sup>1</sup> But the Court, as will be seen from the quotations following, carefully distinguished from the case before them the case where the name of a particular trader has come to denote his goods in the market.

Lindley, L.J., after referring to *The Holloway Pill* case,<sup>2</sup> said, "When we are asked to restrain a man from carrying on business in his own name, we must take very great care what we are about. The principle applicable to the case, I take it, is this: the Court ought not to restrain a man from carrying on business in his own name simply because there are other people who are doing the same and who will be injured by what he is doing. It would be intolerable if the Court were to interfere, and to prevent people from carrying on business in their own names in rivalry to others of the same name. There must be something far more than that, viz. (there must be), that the person who is carrying on business in his own name is doing it in such a way as to pass off his goods as the goods of somebody else."<sup>3</sup> "It is said, because yours may be mistaken for ours you are bound to take extra precautions to prevent yours being mistaken for ours. I am not aware of any case that goes so far as that." "In all cases in which a person has been restrained from carrying on business in his own name he has done something more than use his name: he has copied something from somebody else in the trade, or he has gone out of his way to make his things look like those of a rival in the trade."<sup>4</sup>

Vaughan Williams, L.J., said: "I do not understand that there is any case, or ever has been any case, in which it has been laid down that a man who happens to bear a particular name is debarred from entering into any trade which he chooses to enter into merely because there is somebody else of the same name who has acquired a great reputation in the manufacture of the particular goods dealt with in the trade." Then, after referring to such well-known trade names as *Bass' Beer*,<sup>5</sup> *Colman's Mustard*, and *Pears' Soap*, the Lord Justice continued: "A plaintiff never can complain of the user by the defendant of

Mere similarity of firm name does not impose duty to take precautions.

tion restraining him from marking saddles "J. Brookes" without distinguishing, &c. was granted. *Jamieson & Co. v. Jamieson* does not appear to have been cited, but the case was obviously one of fraud, and possibly also one in which the name had become

a trade name of the goods.

<sup>1</sup> Above, p. 242.

<sup>2</sup> Page 535, note (2).

<sup>3</sup> 15 R. P. C. at p. 181.

<sup>4</sup> At p. 183.

<sup>5</sup> See below, p. 545.

either the plaintiff's personal name, or of any other name that he chooses to use for the purpose of denoting his goods, unless he first establishes that in the market his goods have come to be known by that name. The right and duty of the Court always is to restrain a man from using a name that has come to be recognised as the name of a particular trader's goods for his, the defendant's, goods so as to suggest that the defendant's goods are the plaintiff's goods, and to pass them off as such."<sup>1</sup>

The question has since come before the English Courts on several occasions.<sup>2</sup>

In *The Valentine Meat Juice Co. v. The Valentine Extract Co., Ltd.*,<sup>3</sup> the plaintiffs in the Court of Appeal obtained an injunction<sup>4</sup> to restrain the defendant company from carrying on business as manufacturers or vendors of extract of meat, and from selling any extract of meat, under a name of which *Valentine* formed part, and also an injunction to restrain the defendant, C. K. Valentine, from carrying on business, in such goods, under his name without distinguishing such business from that of the plaintiffs. The plaintiffs' business, although chiefly American, was well known in England, and their goods, a medicinal fluid extract of meat, were always described by a name comprising *Valentine*, and sometimes as *Valentine* simply. The defendant, C. K. Valentine, who had obtained a patent for putting up quite a different extract of meat, which was solid and was intended to be used as a food, promoted the defendant company as a purchaser of his invention, and became its managing director. He never had any business, although he purported to sell to the company "the goodwill of the business which is now being created by the vendor." There was evidence of actual deception, and the Court of Appeal came to the conclusion that C. K. Valentine adopted the name in dispute for his company for the

*The Valentine case.*

<sup>1</sup> At pp. 192, 193. This passage was cited with approval by Ld. Alverstone, M.R., in *Valentine Meat Juice Co. v. Valentine Extract Co., Ltd.*, 17 R. P. C., at p. 680 (1900), as an exposition of the law on the point.

<sup>2</sup> It has also come before the Court of Session in Scotland in *Dewar, Ltd. v. Dewar*, above, p. 535, note (1), and in *The Dunlop Motor* case, below, p. 540, which went to the H. L.

<sup>3</sup> 17 R. P. C. 1, Stirling, J.; 17 R. P. C. 673; 83 L. T. 259 (1901), C. A.

Stirling, J., refused the injunction partly because of the difference between the trades, but also on the ground that the defendant, C. K. Valentine, was entitled to promote a company to work his invention under his name, unless fraud were shown, and the learned judge did not find fraud.

<sup>4</sup> Appendix, p. 738. The form of the injunction was followed in *International Plasmon, Ltd. v. Plasmonade, Ltd.*, 22 R. P. C. 543.

purpose of getting the benefit of the plaintiffs' reputation.<sup>1</sup> The decision might therefore have been put upon the ground of fraud, and might have been arrived at without going beyond the earlier cases<sup>2</sup> cited below. The decision was, however, placed on the broad ground that the supposed distinction in law between personal names and other descriptive words does not exist.<sup>3</sup>

*Chivers v.  
Chivers.*

*Chivers & Sons v. Chivers & Co., Ltd.*,<sup>4</sup> is an example of the difficulties which may occur where the extension of a large business brings it into competition with one which is already established in a particular locality. In that case the plaintiffs carried on the business of jam and jelly makers at Histon, Cambridgeshire, and by very extensive advertising<sup>5</sup> for some years before the action they had developed a large trade in a particular class of their goods known as "table jellies," especially in the Eastern and Midland counties of England. It was not shown that they had any large or extensive trade in Wales. The goods in question were always described by the plaintiffs on the boxes in which all such goods were sold as *Chivers' Table Jellies*. The defendant company had been formed in the year 1895 by a firm of S. Chivers & Co., in which the senior partner, who became the principal managing director of the company, was Samuel Chivers. The firm, and after its incorporation the company, had carried on a substantial business at Cardiff and in South Wales as jam makers, and were locally well known. In the year 1898 the company commenced to make table jellies, the manufacture of which was, as the learned judge found, a bye-product of the jam trade. Their boxes were quite different in appearance<sup>6</sup> from those of the plaintiffs, but they placed upon them their name, S. Chivers & Co., Ltd., and it was this of which complaint was made. They did not themselves use the phrase *Chivers' Table Jellies*, but a number of witnesses, most of whom had never heard of the defendant company, were called to prove that in different parts of the country that phrase or *Chivers'*

<sup>1</sup> Per Id. Alverstone, M.R.

<sup>2</sup> *E.g.*, *Tussaud's* case and *Pinct's* case, above, pp. 501, 503.

<sup>3</sup> The defendants were also restrained from using the word *Valtine* which they had registered as a trade mark. It was subsequently removed from the Register, *Valentine's Tm.*, 18 R. P. C. 175 (1901). Farwell, J.

<sup>4</sup> 17 R. P. C. 420 (1900), Farwell, J.

<sup>5</sup> The learned judge said (at p. 431).

"Advertising distinguished from trade is nothing."

<sup>6</sup> They at first adopted a box which, in some particulars, closely resembled that of the plaintiffs. It had directions copied from the latter. In a previous action they had consented to an injunction in respect of this box.

*Jellies* was understood to mean the plaintiffs' goods, and that by the use of the defendant company's name their goods might and probably would be passed off as those of the plaintiffs. No case of fraud or of actual deception was made out. It was held that, as the plaintiffs had not established that the secondary meaning of the name *Chivers* for which they contended was universal in Wales as well as in England, or that its original meaning had been lost, they could not succeed. The learned judge said that if they could do so they could also prevent the use of the defendant's name for their old-established jam trade.

The subject was next discussed in the case of *J. and J. Cash, Ltd. v. Cash*.<sup>1</sup> *Cash v. Cash.* The plaintiffs and their predecessors in business had been for some years carrying on business under the name of Cash, in Coventry, and it was established that "Cash's Frillings," and "Cash's Woven Names," and "Cash's Initials" meant the plaintiffs' goods. The defendant, whose proper name was Joseph Cash, commenced to carry on business, also at Coventry, in goods which included frillings, woven names, and initials. He did not claim the right to describe these as "Cash's Frillings," etc., but to trade in such goods under the name of *Joseph Cash & Company* or *Joseph Cash*. Kekewich, J., said: "Is it possible for Joseph Cash to have a shop in Coventry, and there to sell frillings without those frillings being sold and known as 'Cash's Frillings' ? It seems to me, speaking as a jury, and simply applying such knowledge of the world as I can to the subject, that it is impossible that that can be done." And the learned judge granted an injunction restraining the defendant from carrying on the business of manufacturer or seller of the three kinds of article under the name of Cash, or any other name so as to mislead. The defendant appealed against this order, asking that it might be varied so far as it absolutely restrained him from trading in the article in question in his own name, and he succeeded. The order, as modified by the Court of Appeal, restrained the defendant from carrying on business in the three kinds of articles under the name "Cash" without taking reasonable precautions to clearly distinguish the business and articles of the defendant from those of the plaintiffs.<sup>2</sup>

<sup>1</sup> 18 R. P. C. 213; 19 *ib.* 181 (1902). Kekewich, J., and C. A.

<sup>2</sup> The order is printed at length in the Appendix, p. 738. In *B. Warsop & Sons, Ltd. v. Warsop*, 21 R. P. C. 481

(1904), the defendant traded as "*A. Warsop*," and this was held to be sufficiently distinguished from the plaintiffs' name, and from the plaintiffs' use of "*B. Warsop*" on the goods

*The Dunlop case.*

In *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Motor Company, Ltd.*,<sup>1</sup> the plaintiffs, manufacturers of tyres and motor accessories, but not of motors, sought to restrain the defendants from carrying on business under their registered name. The defendants had purchased a small retail business carried on at Kilmarnock by R. Dunlop and F. D. Dunlop, who became directors of the defendant company. They had sold and repaired motors and cycles. The defendant company was formed to acquire it and to manufacture and sell motors. The main objects of the businesses were different, the defendant company being mainly a motor company and the plaintiffs a tyre company, although in minor articles there was or might be a common production. The plaintiffs succeeded at the trial, but on appeal the Court of Session dissolved the interdict granted, and the House of Lords upheld their decision, holding that on the facts there was no probability of confusion. In the Court of Session Lord Kyllachy, in his judgment in the passage quoted above, expressed the view that as a matter of law a person could not be restrained from the use of his own name except in a case of fraud,<sup>2</sup> and said that if *The Valentine* case affirmed or implied any broader proposition, he did not agree with it.

*The Earlier cases.*

As the earlier cases on the subject are useful as illustrations of circumstances under which the Court has restrained or limited, or refused to restrain or limit, the use by a defendant of his own name, although they cannot now be relied on as laying down a general principle, the summary of them contained in the former edition of this book has been retained.

*Turton v. Turton.*

The subject had been previously discussed by the Court of Appeal in *Turton v. Turton*.<sup>3</sup> In that case the plaintiffs, Thomas Turton and Sons, Limited, were carrying on a widely known and extensive business acquired by the company in 1886, but established many years previously, under the name of *Thomas Turton and Sons*, in Sheffield, and one of the trade marks of the company

(cricket bats): both the plaintiffs' and defendant's bats bore the word "Marylebone," but they bore different devices.

<sup>1</sup> 22 R. P. C. 533; 23 R. P. C. 761; [1907] A. C. 430; 21 R. P. C. 572, Lord Ordinary, Ct. of Sess. and H. of L.

<sup>2</sup> See also Romer, L.J., in *Abel Morrall v. Hessin*, 20 R. P. C. at p. 433:

"The law is settled, it is merely a

question of fact. If fairly and honestly done, it cannot be stopped; and the judgment of Kennedy, L.J., in *The Daimler* case, 24 R. P. C. at p. 390.

<sup>3</sup> 42 C. D. 128 (1889), C. A., reversing North, J. In *Reddaway v. Banham*, Ld. Macnaghten said he was at a loss to know why this case was ever reported. The plaintiff's case was extravagant and absurd: [1896] A. C. at p. 220.



bore that name upon it. The defendants, John Turton and his two sons, were carrying on a business of a similar description in the same town. Their business had also been established for many years, although not for so long as that of the plaintiffs. For ten years before June, 1888, its style had been *John Turton & Co.*, but John Turton then took his sons into partnership, and changed the style to *John Turton and Sons*, the name the plaintiffs complained of. There was evidence that the plaintiff company were often referred to as *Turton and Sons*, and *Thomas*, or *T. Turton and Sons*, and there were conflicting affidavits by persons engaged in the trade as to whether the distinction between the trade names was sufficient to prevent mistakes being made. It was also shown that letters intended for the plaintiffs had, in some instances, been delivered to the defendants, but, apart from the adoption of the addition *and Sons*, in place of *and Co.*, there was no evidence that the defendants' conduct was intended or calculated to pass off their goods as those of the plaintiffs.

Mr. Justice North, at the trial, granted an injunction in the terms of that in *Hendriks v. Montagu*;<sup>1</sup> but the Court of Appeal reversed this order, and dismissed the action.

In the view of the facts taken by the Court of Appeal, the defendant, John Turton, was not shown to have done anything to give to the name objected to any other meaning than that he was carrying on business in partnership with his sons; he had not done anything with the intent or for the purpose of making the use of his simple name look as if his name were the name of the plaintiffs. "In some cases," Lord Esher said, "besides using the names, parties have, to use what, I think, is a happy phrase of my brother Cotton's, 'garnished that use'—that is, they have done things besides using the name, in order that the use of that name might look as if it were being used by the old firm. There is nothing of that kind here."

Lord Esher's  
judgment.

Notwithstanding the possibility of mistakes between the two firms being made by careless people, therefore, the Court held that the defendants were justified in adopting the name complained of, and in continuing its use after the possibility of mistake had been brought to their knowledge, and the action was accordingly dismissed. One may venture to regret that the Court did not adopt the slight extension of the principles appealed

<sup>1</sup> Ante, p. 496.

to which would have been necessary to forbid the defendants from choosing out of several alternative styles, all equally accurate as descriptions, and equally convenient according to business usage, the only one which was calculated to lead to mistake. If *Turton & Co.* did not suit the defendants, they might have been satisfied with *Turton*, *Turton and Turton* or, *Turton* preceded by the initials of the partners.

A man may describe his firm in the ordinary mercantile way ;

not necessarily by any "fancy" name.

*Massam v. Thorley.*

The foundation of the judgments of all the Lords Justices was that the statement comprised in the defendant's name was nothing other than a statement of the actual fact that their business was the business of Joseph Turton and his sons, expressed in the "ordinary mercantile way,"<sup>1</sup> and made "truly, honestly, and in the usual manner in which such statements are made in the course of business."<sup>2</sup> The case is, therefore, readily distinguishable from cases where a "fancy name" which is not descriptive of actual facts in ordinary language is appropriated,<sup>3</sup> such as, for instance, the name—the "Universal Life Assurance Association"—in *Hendriks v. Montagu*.<sup>3</sup> There is no justification for the adoption and use of any such name if it is calculated to deceive.

*Massam v. J. W. Thorley's Cattle Food Co., Ltd.*,<sup>4</sup> closely resembled the case of *Tussaud v. Tussaud* already referred to.<sup>5</sup> There the plaintiffs, as executors of one Joseph Thorley, were carrying on a well-known business in a special food for cattle established by their testator. The defendant company had engaged as their manager J. W. Thorley, who was a brother of Joseph Thorley, and having been in his employment some ten years previously, had become possessed of the recipe according to which the cattle food was made by the plaintiff's testator. J. W. Thorley was also the holder of a one-shilling share in the company. The defendants endeavoured to defend their use of the name which they had adopted on the ground of their relations with J. W. Thorley, but unsuccessfully, and the Court of Appeal were further of opinion that the defendants had imitated the get-up of the plaintiff's goods, and had intentionally acted so as to induce buyers to take their goods for them.

The injunction granted left the defendants at liberty to use

<sup>1</sup> Cotton, L.J., p. 142.

<sup>2</sup> Fry, L.J., p. 147.

<sup>3</sup> Ante, p. 496 ; and see the latter part of the judgment of Cotton, L.J., 42

C. D. 145.

<sup>4</sup> 14 C. D. 748 (1880), C. A., reversing Malins, V.-C.

<sup>5</sup> Ante, p. 501.

their name, and to use the word *Thorley* in connection with their goods (if they could) in any way not calculated to mislead the public.<sup>1</sup>

The injunction in this case might, in the view which the Lords Justices took of the facts, have been granted on the fraudulent intention of the defendants alone, for, as appears from the judgments quoted above, it is only the honest use of a man's own name which is ever a defence.<sup>2</sup>

And the justification only extends, in any case where it applies, to the use of a man's own name,<sup>3</sup> or that of his predecessor who founded his business and established it under the name which the defendant is using;<sup>4</sup> not to the use of that of his servant,<sup>5</sup> or of an alleged partner who has really no interest in his business, and has been brought into it only in aid of an attempt to cover the employment of a deceptive name.<sup>6</sup> Still less to the use of the name of a stranger,<sup>7</sup> even though it is alleged that he has authorised the defendant to use it.<sup>8</sup> Where a name has been

Name must be the defendant's own name;

not a bought name.

<sup>1</sup> See the form of injunction, 14 C. D. 762; and Appendix, p. 732.

<sup>2</sup> See also *Warner v. Warner*, 5 Times L. R. 327, 359; *Huntley and Palmer v. The Reading Biscuit Co.*, 10 R. P. C. 277 (1893), Chitty, J.; and *Clayton v. Day*, where one Day joined one Martin in a fraudulent attempt to carry on business as "Day and Martin," in unfair competition with the well-known firm, 26 Sol. J. 43 (1881). Chitty, J.

<sup>3</sup> In *Mrs. Pomeroy, Ltd. v. Seal*, 24 R. P. C. 177 (1907), the defendant contended that the name "Mrs Pomeroy," which had been adopted by her in her business had become for all practical purposes her own name, and that the plaintiffs who had purchased the business formerly carried on by her, could not restrain her from using it. It was held, however, that she had by express agreement precluded herself from using it in a similar business. In *Macmillan v. Ehrmann*, 21 R. P. C. 357, 647 (1904), Buckley, J., and C. A., the defendants were using a Scotch firm name, which they had adopted for their whisky business, it never having been the name of an actual firm; but, although disapproval was expressed of such a

practice, it was held that nothing that the defendants had done had tended to intercept the plaintiffs' trade.

<sup>4</sup> See *Pinct v. Maison Pinct, Ltd.*, ante, p. 503; *Turton v. Turton*, ante, p. 540; *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L.J.; *Truefitt v. Eduey*, 20 R. P. C. 321 (1903), Byrne, J.

<sup>5</sup> *Southorn v. Reynolds*, 12 L. T. N. S. 75 (1865), Wood, V.-C. (*Southorn's Broseley Pipes*); *Birmingham Vinegar Brewery Co. v. Liverpool Vinegar Co.*, W. N. (1888), 139, North, J., cited p. 494; *Tussaud v. Tussaud*, ante, p. 501.

<sup>6</sup> See *Croft v. Day*, infra; *Schweitzer v. Atkins*, 37 L. J. Ch. 847 (1868); *Dence v. Mason*, W. N. (1877), 23; (1878) 42 (*Braud's Essence of Beef*), both Malins, V.-C.

<sup>7</sup> *Isaacson v. Thompson*, 41 L. J. Ch. 101 (1871), Bacon, V.-C. (*Madame Elise*), defendant used his daughter's name, *E. Louise*; interim injunction refused on account of delay. *Pearks, Gunston and Tee, Ltd. v. Thompson, Talmey & Co., Ltd.*, 18 R. P. C. 185 (1901), Farwell, J.

<sup>8</sup> *Croft v. Day*, 7 Beav. 84 (1843), Langdale, M.R. (*Day and Martin*); *Shrimpton v. Laight*, 18 Beav. 164 (1854), Romilly, M.R.; *Melachrino & Co v. The Melachrino Egyptian Cigarette Co.*

acquired with a goodwill in one business, the purchaser will not be permitted to use it unfairly in another business, in which the use of it would be deceptive.<sup>1</sup>

or a name altered to resemble the plaintiff's;

Such practices are badges of fraud rather than grounds of defence. So, where the defendant has altered his name in such a way as to make it more nearly resemble the plaintiff's, the inference is almost inevitable that fraud is intended,<sup>2</sup> and whether it is or not, the rule in question only applies to the use of the defendant's name in its ordinary form.

but may be the defendant's name of repute.

But it is submitted that the name need not be that which the defendant received from his parents. A name which he has adopted and used until it has come to be his name by repute is as much his name as that by which his parents were known.<sup>3</sup> Of course, a new name adopted at the time of, or shortly before, the alleged deceptive user of it would generally be taken to have been adopted for fraudulent purposes, even if it could be shown by the date of the trial to have become the defendant's name by repute.

Addition of "limited" to a firm name.

The name of a company formed by the addition of "limited" to the firm name of a business which the company takes over stands in the same position as the firm name itself.<sup>4</sup>

It must be used *simpliciter*, not garnished to look like the plaintiff's.

In most of the reported cases in which a defendant has been restrained from passing off his goods as those of the plaintiff under cover of a similar name, the defendant has added the "circumstances of fraud," to which Knight-Bruce, L.J., referred, in *Burgess v. Burgess*,<sup>5</sup> or, in the phrase of Cotton, L.J., in

4 R. P. C. 215 (1887), Chitty, J. See also *Tussaud v. Tussaud* and *Rendle v. Rendle & Co.*, above, p. 501, note (1), and *The Talmey* case, p. 543, note (7).

<sup>1</sup> See the cases cited above, p. 503, note (4).

<sup>2</sup> *Taylor v. Taylor*, 23 L. J. Ch. 255 (1854), Wood, V.-C.; *James v. James*, L. R. 13 Eq. 421 (1872), Romilly, M.R. (*Robert Joseph James* called himself *Robert James*); and see *Slazenger v. Feltham*, 6 R. P. C. 531 (1839), C. A.

<sup>3</sup> See per James, L.J., and Bramwell, L.J., in *Massam v. Thorley, &c.*, 14 C. D. 757, 760. See also per North, J., in *Pinet v. Pinet*, 15 R. P. C. at p. 72. It has already been shown that a name of repute is protected as a trade name: above, p. 493. See also p. 543, note (3).

<sup>4</sup> *Chivers v. Chivers*, above, p. 538.

See also *Townsend v. Jarman*, above, p. 528, note (7). In *Fine Cotton Spinners &c. Association, Ltd. v. Hurwood, Cash & Co., Ltd.*, 24 R. P. C. 533 (1907), Joyce, J., said that a company with a title of which the name "A" forms part has none of the natural rights that an individual born with the name "A" would have. In that case the defendant company had taken the name of a mere promoter. Cf. in *The Daimler* case, 24 R. P. C. at p. 390, the judgment of Kennedy, L.J.

<sup>5</sup> Ante, p. 532; e.g., by adding & Co.; *Graveley v. Winchester*, Seb. Dig. p. 162 (1867), Giffard, V.-C.; *Churton v. Douglas, Johnson*, 174; 28 L. J. Ch. 841 (1859), Wood, V.-C.; *Witt v. Conewan*, 2 C. D. 69 (1873), Bacon, V.-C.

*Turton v. Turton*,<sup>1</sup> has "garnished the use of his name" by imitating the get-up of the plaintiff's goods,<sup>2</sup> or his labels and show-cards,<sup>3</sup> or has issued circulars or advertisements<sup>4</sup> calculated to foster the error which the resemblance of his name and that of the plaintiff's was calculated to produce.<sup>5</sup>

Thus, in *Moët v. Clybourn*,<sup>6</sup> the defendant claimed to be entitled to use the names *Meadows* and *Clybourn*, and, by virtue of such right, to brand upon the corks of his champagne bottles the letters *M. & C.* in a circle on the bottom, and the word *England* at the side, in obvious imitation of the plaintiff's practice. And in *Holt v. Smith*,<sup>7</sup> the defendant bought the business of H. Newman and changed its name to Newman & Co., in imitation of the plaintiff's trade name. In *Joseph Rodgers & Sons, Ltd. v. Joseph Rodgers Simpson*,<sup>8</sup> the defendant was trading as "Joseph Rodgers Simpson & Son," having in fact no son as partner, and he was held in this and other ways to have used his name in a manner calculated to pass off his cutlery as that of the plaintiffs, and an injunction was granted against such unfair use.

The proximity of the place where the defendant sets up his business to that where a well-known firm is already trading may be evidence to show that, although trading under his own name, the defendant is seeking to take fraudulent advantage of its similarity to the plaintiff's name. The case of somebody finding a man named *Bass* and setting up a brewery at Burton as *Bass & Co.*,<sup>9</sup> and the case of a man starting business as a banker in the Strand under the name of *Coutts*,<sup>10</sup> have been cited as instances in which it is scarcely conceivable that the use of the

Proximity  
may be a  
badge of  
fraud.

<sup>1</sup> Ante, p. 540.

<sup>2</sup> *Holloway v. Holloway*, 13 Beav. 209 (1850), Langdale, M.R., above, p. 536, *Taylor v. Taylor*, p. 544, n. (2); *Schweitzer v. Atkins*, p. 543, n. (6); *Fullwood v. Fullwood* (1), W. N. (1873), 93, 185, Malins, V.-C., and L.J.J.; *J. H. Brooks & Co., Ltd. v. Norfolk Cycle Co. and John Brookes*, 16 R. P. C. 523, Stirling, J., above, p. 535, n. (5).

<sup>3</sup> *Croft v. Day*; *Melachrino v. The Melachrino Egyptian Cigarette Co.*, p. 543, n. (8).

<sup>4</sup> *Massam v. J. W. Thorley's Cattle Food Co.*, above, p. 544, n. (3).

<sup>5</sup> In *Rigden v. Jones*, 22 R. P. C. 417, the defendant who had purchased a

retail business of glovers carried on as "F. & A. Fownes" was restrained from using the words "Fownes, Manchester" without prefixing "F. & A.," the plaintiffs being known as manufacturers of "Fownes' Gloves."

<sup>6</sup> S. e. b. Dig. p. 316 (1877), Jesse, M.R. (*Moët and Chandon*).

<sup>7</sup> 4 Times L. R. 329 (1888), Kay, J. Action stayed on the defendant undertaking to use *H.* and drop *Co.*; defendant to pay costs.

<sup>8</sup> 23 R. P. C. 297 and 348 (1906).

<sup>9</sup> James, L.J., in *Massam v. Thorley, &c.*, 14 C. D. p. 757; see above, p. 536.

<sup>10</sup> Chitty, J., in *Melachrino v. The Melachrino &c. Co.*, 4 R. P. C. p. 221.

name could be honest.<sup>1</sup> In *Turton v. Turton*,<sup>2</sup> the defendants were trading in the same town, Sheffield, as the plaintiff, but their presence there was reasonably accounted for, because their business had been established in the town long before the circumstances which led them to adopt the name complained of arose.

### 7. The Relief Granted.

The relief granted to the plaintiff, if he succeeds in a passing-off action, corresponds to that granted in the action for infringement of a registered trade mark to which the first-mentioned action is so closely allied. It comprises, therefore—(i.) an injunction;<sup>3</sup> (ii.) an order for the delivery up for destruction, or for the erasure of the names or other badges, of any goods already marked with the deceptive names or badges, and in the possession or under the control of the defendant;<sup>4</sup> and (iii.) damages in respect of the past interferences with the plaintiff's rights;<sup>5</sup> or (iv.) an account of the profits made by the defendant by the sale of goods under the deceptive names or badges,<sup>6</sup> or some one or more of these.

Injunction.

The general principles governing the grant of an injunction have been sufficiently considered in the last chapter.

Form of the injunction.

The form of the injunction granted varies considerably, according to the nature of the deceptive representation which the defendant is shown to have made use of, or threatened to make use of.

Where he has imitated or adopted the plaintiff's trade name, the order may be an absolute injunction that he shall not carry on business under that name.<sup>7</sup>

Injunction in *Massam v. Thorley*.

A very full form of order was adopted in *Massam v. Thorley's Cattle Food Co.*<sup>8</sup> It restrained the defendant company and their servants from selling, or procuring to be sold, and from in any manner representing any goods manufactured by them as

<sup>1</sup> *Lee v. Huley* is another illustration. There the plaintiff's late manager set up in business as the "Pall Mall Guinea Coal Co.," in the Strand, and afterwards removed to 46, Pall Mall. The plaintiffs traded, at 22, Pall Mall, as "The Guinea Coal Co." An injunction was granted; 21 L. T. N. S. 546; 22 *ib.* 251; L. R. 5 Ch. 155, Malins, V.-C., and Giffard, L.J.

<sup>2</sup> Page 540.

<sup>3</sup> Last chapter, p. 441. See below, and the orders collected in the Appendix, pp. 730, *et seq.*

<sup>4</sup> Page 450.

<sup>5</sup> Page 452.

<sup>6</sup> Page 454.

<sup>7</sup> As in *Hendriks v. Montagu*, 17 C. D. 638, set out above, p. 496.

<sup>8</sup> 14 C. D. p. 762, set out in the Appendix, p. 732.

the goods of the late Joseph Thorley or the plaintiffs, his successors; from in any manner representing, or doing anything which should lead to the belief that the defendant company were carrying on the business of the late Joseph Thorley; from affixing to their goods, or otherwise employing, any labels, wrappers, or marks used by him or the plaintiffs, or so contrived as to represent, or lead to the belief, that the goods manufactured or sold by the defendant company were his goods or those of the plaintiffs; and from using or circulating any circulars or advertisements, used or circulated by him or the plaintiffs, or which should in any manner represent or lead to the belief that the defendant company had been or were carrying on the business of the late Joseph Thorley, or were his successors.

But a device or name, which is not a trade mark or the trade name of the plaintiff, may always be used by the defendant in any way which is not calculated to deceive, if such way can be found; and the injunction in passing-off cases is usually drawn so as to preserve this right, the order not to use a particular device or word being qualified by the addition "so as to represent, or lead to the belief," that the defendant's goods are the plaintiff's.<sup>1</sup>

Only deceptive use of open word, &c. restrained.

Thus, in *Massam v. Thorley's Cattle Food Co.*, the Lords Justices refused to prohibit the defendants from using the word Thorley in connection with cattle food altogether.<sup>2</sup> And in *Slazenger v. Feltham*, the Court of Appeal modified the order of Kekewich, J., forbidding the defendants to stamp *Demotic* on their lawn-tennis bats, by adding the words "so as to represent that (they) are manufactured by the plaintiffs, or in any other way from passing off their lawn-tennis bats as the goods of the plaintiffs."

Where what is complained of is the deceptive use of an open word, which has come to be associated with the plaintiff's trade or goods, the form of injunction is now generally directed to prevent the defendant from using it "without clearly distinguishing his goods from the plaintiffs." This was the form adopted in the

<sup>1</sup> *Slazenger & Sons v. Feltham & Co.*, 6 R. P. C. 531 (1889); *Jay v. Ladler*, 40 C. D. p. 656; 6 R. P. C. 136 (1888), Kekewich, J.; *Magnolia Metal Co. v. Atlas Metal Co.*, 14 R. P. C. 389 (1897), Collins, J., and C. A. For a form of injunction in a trade name case in which

the plaintiffs had not an exclusive but only a qualified right in a particular word, see *Daimler Motor Co. (1904), Ltd. v. London Daimler Co., Ltd.*, 24 R. P. C. 379 (1907), C. A.

<sup>2</sup> 14 C. D. 763.

"Without distinguishing, &c."

*The Stone Ales* case.

Temporary or contingent prohibition.

infringement cases *Seixo v. Provezende*,<sup>1</sup> and *Johnston v. Orr-Ewing*,<sup>2</sup> and in *The Yorkshire Relish*,<sup>3</sup> and *The Stone Ales* cases. In the last-mentioned case several of the Lords of Appeal referred to it as the proper form to adopt unless the plaintiff had a claim to the exclusive use of the word, name, or other mark in question.<sup>4</sup>

In the last-mentioned case, however, the injunction to restrain the defendant (*inter alia*) from selling beer not of the plaintiff's manufacture, under the term *Stone Ales* or *Stone Ale*, or in any way so as to induce the belief that such ale was of the plaintiff's manufacture, was, under the circumstances, maintained, the Lords of Appeal holding that the *Seixo v. Provezende* form of injunction would be more stringent, as it would, in effect, prevent the defendant using the term *Stone Ale* at all.<sup>5</sup>

And the defendant has, in some instances, been restrained from using a word or words which could not be used by him at all, except deceptively, so long as this should continue to be the case; for instance, from calling his bitters *Angostura Bitters* until he should find out how to make the real *Angostura Bitters*;<sup>6</sup> or from using the name *Radstock Colliery Proprietors* until he should be able to sell coal from Radstock.<sup>7</sup>

The *Pinet* cases<sup>8</sup> illustrate the different cases to which the absolute and the limited forms of injunction are respectively applicable. In the first case it was supposed that the assignor to the defendant company had traded under his own name, "Pinet," and a limited injunction was granted. Subsequently it was discovered that this was not his own name, but a name adopted for the purpose of the fraud, and thereupon an absolute injunction was decreed.

<sup>1</sup> L. R. 1 Ch. 194 (1865), *Wood, V.-C.*, and *Cranworth, L. C.*

<sup>2</sup> 13 C. D. 434; 7 App. Ca. 219, *Fry, J., C.A.*, and *H. L.*

<sup>3</sup> Above, p. 489. *Bewlay & Co., Ltd. v. Hughes*, 15 R. P. C. 290 (1898), *North, J. (Dindigul Cigars)*; and *Grezier and Doyle v. Autran*, 13 R. P. C. 1 (1895), *Chitty, J.*, and *C. A.* and *Rey v. Lecouturier*, 25 R. P. C. 265 (1908), *C. A.* (both *Chartreuse*), are other examples. See also *Ld. Macnaghten's* judgment in *Reddaway v. Banham*, [1896] A. C. at p. 221; 13 R. P. C. at p. 234.

<sup>4</sup> *Id.* *Watson* and *Ld. Macnaghten: Montgomery v. Thompson*, [1891] A. C.

217; 8 R. P. C. 361; see also *Thompson v. Bent's Brewery Co., Ltd.*, 8 R. P. C. 479 (1891), *Chitty, J.* In *The Magnolia* case, p. 547, n. (1), *Collins, J.*, granted an injunction in this form, and the plaintiffs unsuccessfully appealed, asking for an absolute prohibition.

<sup>5</sup> See above, p. 517; and *Braham v. Beachim*, there cited.

<sup>6</sup> *Siegert v. Finllater*, 7 C. D. 801 (1878), *Fry, J.*

<sup>7</sup> See ante, p. 517.

<sup>8</sup> *Pinet v. Maison Pinet, Ltd.*, 14 R. P. C. 933 (1897), *C. A.*; *Same v. Maison Louis Pinet, Ltd.*, 15 R. P. C. 65, *North, J.*



No general rule can be laid down as to what additions to the objectionable matter will be sufficient to effect the requisite distinction.<sup>1</sup> It must depend upon the circumstances of each case.<sup>2</sup> Where the order is in respect of a word which has, in fact, become the trade name of the plaintiff's goods, the most careful differentiation of the get-up of the goods,<sup>3</sup> and the greatest possible prominence of the defendant's own name<sup>4</sup> upon his labels may not be enough. In such cases the limitation of the order is more likely to mislead the defendant than to protect him in his assumed right to use the word.

No rule as to what distinction is sufficient.

The injunction may be limited with reference to the use of the mark in a particular country or market.<sup>5</sup>

Limited to particular market

<sup>1</sup> "No Court has ever said how the distinction is to be made": per Stirling, J., in *Powell v. Birmingham Vinegar Co.*, [1896] 2 Ch. at p. 64. Also *Kerfoot v. Cooper*, 25 R. P. C. 508 (1908). But see the last chapter, p. 449. In France the Court sometimes settles what may be used: see *Grezier and Doyle v. Aufran*, 13 R. P. C. 1.

<sup>2</sup> Since the decision in *Reddaway v. Banham*, cited above, p. 512, there have been three cases as to "camel-hair" belting in which the question has arisen whether the defendant sufficiently distinguished, namely, *Reddaway v. Ahlers*, 19 R. P. C. 14 (1902), *Reddaway v. Frictionless Engine Packing Co.*, 19 R. P. C. 505, and *Reddaway v. Stevenson*, 20 R. P. C. 276 (1903). In the second of these cases it was held that the prefixing of the defendants' name was sufficient, although they were not manufacturers, but the result was different in the last case, where it was pointed out that each case must rest on its own facts. It is no answer to say that the custom of the trade is not to distinguish, see the first of the three cases. In *Grand Hotel Co. of Caledonia Springs v. Wilson*, [1904] A. C. 103; 21 R. P. C. 117, P. C., the plaintiffs being the owners of natural springs at Caledonia, Ontario, sold the water as "Caledonia Water" or "Caledonia Springs Water." They had, however, no exclusive right to the word "Caledonia," and the defendants who owned springs in the same neighbourhood and sold "Natural Saline Water from the New Springs at Caledonia" were held to

have sufficiently distinguished. See also *Warsop v. Warsop*, cited supra, p. 539, n. (2), where A. Warsop was held to be sufficiently distinguished from B. Warsop & Sons, Ltd.

<sup>3</sup> In the last case the bottles and labels of the defendants' *Yorkshire Relish* were totally different from those of the plaintiffs. They are shown in 13 R. P. C. pp. 237, 238, and 240.

<sup>4</sup> In *Daniel and Arter v. Whitehouse*, 16 R. P. C. 71 (1898), North, J., *F. Whitehouse's Brazilian Silver* was held to be an infringement of an order not to use *Brazilian Silver* without distinguishing, &c.

<sup>5</sup> *Carver v. Bowker*, Seb. Dig. p. 350 (1877), Little, V.-C., a trade mark case before the Acts; *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L.J.; the action succeeded only as to passing-off; the injunction was limited to Ireland. In *Société, &c. de l'Etoile's Tm.*, [1894] 1 Ch. 61; 10 R. P. C. 436, a registered trade mark case, Stirling, J., said that he did not think limiting the registration would give the applicants, under the circumstances of the case, complete relief. See above, pp. 232 and 444. In *Weingarten v. Bayer*, 20 R. P. C. 289 (1903), Joyce, J., refused to limit the injunction which he granted to England or the account of profits to sales in England. The case went to the Court of Appeal, 20 R. P. C. 649, and the House of Lords, 22 R. P. C. 341 (see the text, p. 550).

Interim  
injunctions.

Interim injunctions are granted in passing-off actions on the same terms and according to the same principles as in infringement actions.<sup>1</sup>

Damages or  
profits.

In *Weingarten v. Bayer & Co.*,<sup>2</sup> Vaughan Williams and Cozens-Hardy, L.JJ., expressed the opinion that, had the plaintiffs succeeded, it would have been a case for damages and not profits, but in the House of Lords, where it was held that the defendant had sold his goods as and for the plaintiffs' by the use of the descriptive name "Erect Form Corsets" in a special type and with a special scroll used by the plaintiffs and an injunction was granted limited to the use of the special form, an account of profits derived from the sale of corsets so distinguished was ordered. Lord Macnaghten stated that ever since the case of *Edelsten v. Edelsten*,<sup>3</sup> it had been the established rule that a plaintiff succeeding in a case of that sort might at his option take an inquiry as to damages or an account of profits.

### 8. Costs, Appeals, and Practice.

And the rules and principles in regard to costs,<sup>4</sup> appeals,<sup>5</sup> and practice,<sup>6</sup> are also the same in both actions, except in so far as they depend upon registration and the Registration Acts, which do not extend to or affect passing-off actions.

#### NOTE.

Rule.

First  
exception.

In *Porell v. Birmingham Vinegar Brewery Co.*, [1896] 2 Ch. at p. 79; 13 R. P. C. at p. 256, Kay, L.J., said: "The law relating to this subject may be stated in a few propositions: (1) It is unlawful for a trader to pass off his goods as the goods of another. (2) Even if this is done innocently it will be restrained (*Millington v. Fox*, 3 My. & Cr. 338). (3) *A fortiori* if done designedly, for that is a fraud. (4) Although the first purchaser is not deceived, if the article is so delivered to him as to be calculated to deceive a purchaser from him, that is illegal (*Sykes v. Sykes*, 3 B. & C. 541). (5) One apparent exception is that where a man has been describing his goods by his own name, another man having the same name cannot be prevented from using it, though this may have the effect of deceiving purchasers (*Burgess v. Burgess*, 3 De G. M. & G. 896; *Turton v. Turton*, 42 C. D. 128). (6) But this exception does not go far. A man may so use his own name as to infringe the rule of law. 'It is a question of evidence in each case whether there is false representation or not' (per Turner, L.J., *Burgess v. Burgess*, 3 De G. M. & G. 905). So he may be restrained if he associates another man with him, so that under their joint names he may pass off goods as the goods of another person (*Croft v. Day*, 7 Beav. 84; *Clayton v. Day*, 20 Sol. Jour. 43; *McLachlino v. The McLachlino Egyptian Cigarette*

<sup>1</sup> Chap. XV., p. 445.

<sup>2</sup> See note, p. 549 (5).

<sup>3</sup> 1 D. J. & S. 185.

<sup>4</sup> Page 458.

<sup>5</sup> Page 463.

<sup>6</sup> Page 469; forms of pleadings, p. 724.



## CHAPTER XVII.

### WARRANTY OF TRADE MARKS AND TRADE DESCRIPTIONS.<sup>1</sup>

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It is provided by sec. 17 of the Merchandise Marks Act, 1887, that:—

“ On the sale or in the contract for the sale of any goods to which a trade mark,<sup>2</sup> or mark, or trade description<sup>3</sup> has been applied,<sup>4</sup> the vendor shall be deemed to warrant that the mark is a genuine<sup>5</sup> trade mark and not forged<sup>6</sup> or falsely applied,<sup>7</sup> or that the trade description is not a false trade description<sup>8</sup> within the meaning of this Act, unless the contrary is expressed in some writing signed by or on behalf of the vendor and delivered at the time of the sale or contract to and accepted by the vendee.”

This section corresponds to sec. 19 of the Merchandise Marks Act, 1862, but the older section applied only to trade marks which were applied to goods sold, and the implied warranty was that the trade marks were “ genuine and true, and not forged or counterfeit, and not wrongfully used.”

**Trade mark.** Trade mark<sup>9</sup> here means registered trade mark or trade mark protected by law in any British possession or foreign state to

<sup>1</sup> The references in this chapter are to the Merchandise Marks Act, 1887, which is set out in the Appendix, p. 805. It is fully dealt with and commented on in the 2nd ed., Book II., p. 554.

<sup>2</sup> “Trade mark,” sec. 3 (1), see the text. *infra*.

<sup>3</sup> “Trade description,” sec. 3 (1). Page 570 of the 2nd edition.

<sup>4</sup> “Applied,” sec. 3 (2), and sec. 5 (1). Page 567 of the 2nd edition.

<sup>5</sup> “Genuine,” cf. sect. 2 (2) (a). Page 608 of the 2nd edition.

<sup>6</sup> “Forged,” sec. 4. Page 563 of the 2nd edition.

<sup>7</sup> “Falsely applied,” sec. 5 (3). Page 569 of the 2nd edition.

<sup>8</sup> “False trade description,” sect. 3 (1). Pages 570, 584, of the 2nd edition.

<sup>9</sup> “Trade mark,” sect. 3 (1). Page 566 of the 2nd edition.

which sec. 91 of the Patents and Designs Act, 1907, is applicable.<sup>1</sup> Section 17, however, imports a warranty of the genuineness of unregistered English trade marks, at any rate when the application of them to the goods is reasonably calculated to lead persons to believe that the goods are the manufacture or merchandise of the proprietor of the trade mark, and also of any trade mark, whether registered or not, which the mark applied to the goods purports to be, for in such cases the mark is a false trade description applied to the goods.<sup>2</sup> "Mark," where it first occurs in the section, can hardly include an unregistered trade mark, for the warranty implied is that the mark is a genuine trade mark, that is, a genuine registered trade mark, and that it does not purport to be. "Mark," where it occurs the second time, should be trade mark or mark.

The several terms occurring in the section have the meanings given to them respectively by the sections of the Merchandise Marks Act, 1887, which are referred to in the notes.<sup>3</sup> The general effect of the implied warranty is that the trade marks, or marks purporting to be trade marks, applied to the goods, are used with the assent of the proprietor of the trade marks which they purport to be, and that the statements made or implied by the trade descriptions are true.

The saving at the end of the section is, it will be observed, very carefully expressed. The statement required to prevent the implication of a warranty must be in writing, signed, delivered at the time of sale, and accepted by the vendee.<sup>4</sup> What

Statement in writing to the contrary.

<sup>1</sup> The reference is to sec. 103 of the Act of 1883, but by virtue of sec. 38 (1) of the Interpretation Act, 1889, see p. 654, the reference is now to the re-enactment. As to the trade marks so protected, see Chap. XX., p. 576, and the list in the Appendix, p. 741.

<sup>2</sup> Sec. 3 (2).

<sup>3</sup> See also Appendix and 2nd edition, Book II., Chap. I., p. 554.

<sup>4</sup> The Food and Drugs Act, 1875 (38 & 39 Vict. c. 63), s. 25, enables the vendor to set up as a defence that he purchased the adulterated goods under a written warranty and resold them unaltered. See *Laidlaw v. Wilson*, [1894] 1 Q. B. 74; *Robertson v. Harris*, [1900] 2 Q. B. 117; *Elliott v. Pilcher*, [1901] 2 K. B. 817; *Watts v. Stevens*, [1906]

2 K. B. 323; *Evans v. Weatheritt*, [1907] 2 K. B. 80, on the question where the warranty is not given in express reference to a particular consignment, what evidence is necessary to connect any particular consignment with the warranty. Sec. 20 of the Sale of Food and Drugs Act, 1899 (62 & 63 Vict. c. 51), requires notices of the intention to rely on the warranty as a defence to be given to the purchaser and to the person who has given the warranty. Giving a false warranty is an offence, sec. 27 of the Act of 1875, unless the person giving it had reason to believe the statements or descriptions to be true, sect. 20 of the Act of 1899. Sec. 9 makes any alteration in the article without disclosure to the purchaser an

“accepted by the vendee” means is not clear. It would probably be construed to import at least that the vendee understood that he was to get no warranty, and that he completed the purchase on that footing.

Implied  
warranty at  
common law.

Apart from the statutory warranties implied by the Merchandise Marks Act, it is held, at common law,<sup>1</sup> that when a purchaser orders goods from a firm who are manufacturers only of such goods, and not dealers in them, then, unless it is shown that in the particular trade, or as regards the particular goods, there is a custom for the manufacturer to supply the goods of other makers, the purchaser must be assumed to have contracted with the particular manufacturers in reliance on the general excellence of the work of their firm, and he is entitled (in the absence of any express stipulation to the contrary) to have goods of the manufacturer's own make delivered in performance of the contract.<sup>2</sup>

Warranty  
where goods  
are described  
by a trade  
mark.

It is a question of fact, or, if there is a written contract, of construction, whether a manufacturer or vendor has agreed to deliver the goods which are referred to by a trade mark in the contract, stamped with the mark, and being, therefore, goods of the kind properly denoted by it, or whether he has agreed only to deliver goods of the same quality as those which are denoted by the mark. Thus, in *Hopkins v. Hitchcock*,<sup>3</sup> where the contract was for iron described as “S. and H. (crown) bars,” and the vendors were Hopkins & Co., the successors of Snowden and Hopkins, iron marked “H. & Co.” with a crown was delivered, and the jury found that the mark was not a material

offence. A notice exhibited in the shop may be such a disclosure: *Spiers and Pond v. Bennett*, [1896] 2 Q. B. 65. Cf. *Pearks, Gunston and Tee, Ltd. v. Houghton*, [1902] 1 K. B. 889, and *Dawes v. Wilkinson*, [1907] 1 K. B. 279. Knowledge of the adulteration on the purchaser's part is not a defence: *Heywood v. Whitehead*, 76 L. T. 781 (1897). Under sec. 17 of the Merchandise Marks Act, such questions can hardly arise. The statement in writing must, if the construction in the text is adopted, be a term of the contract. Disclosure that, for example, a trade mark is not genuine without the statement in writing would not prevent a warranty being implied. Under the

Food and Drugs Act proof of scienter is necessary to a conviction for giving a false warranty, *Derbyshire v. Houlston*, [1897] 1 Q. B. 772.

<sup>1</sup> Warranties of the genuineness of marks are implied, in respect of *anchors and chain cables*, by 37 & 38 Vict. c. 51, s. 4, and in respect of *hops*, by 29 & 30 Vict. c. 37, s. 8.

<sup>2</sup> Per Cotton, L.J., in *Johnson v. Raylton*, 7 Q. B. D. 438 (1881). Cotton and Brett, L.J.J., Bramwell, L.J., dissenting; *Starey v. Chilworth Gunpowder Co.*, 24 Q. B. D. 90 (1889), Div. Court.

<sup>3</sup> 14 C. B. (N. S.) 65; 32 L. J. C. P. 154 (1863).

part of the bargain. Judgment was given for the vendors in an action for the price of the iron, and the Court of Queen's Bench upheld the judgment, on the ground that the contract was for iron of a particular quality, not for iron bearing a particular mark.

A somewhat similar question has arisen upon sales of pictures under the names of the supposed painters of them, and in such cases the matter to be decided is whether the use of the artist's name amounts to a warranty by the vendor that the picture in question is his, or merely to an expression of the vendor's opinion.

Pictures ascribed to particular artists.

In the case where pictures had been sold as "Views in Venice, Canaletto," and they were not by Canaletto,<sup>1</sup> the question was left to the jury; but where the supposed artist was an old master, Lord Kenyon, at *Nisi Prius*, held that it was impossible to make the case one of warranty. The pictures, he said, were the work of artists of some centuries back, and there being no way of tracing the picture itself, it could only be matter of opinion whether the picture in question was the work of the artist whose name it bore or not; the catalogue only expressed the opinion of the vendor, but left the determination to the buyer's own judgment.<sup>2</sup>

The remedy for breach of warranty, whether implied under the section set out above, or at common law,<sup>3</sup> or imported by express agreement in any contract in regard to goods sold or agreed to be sold, is an action for damages, reduction of the agreed price, or rescission of the contract. The rules determining the nature and extent of the remedy are now contained in the Sale of Goods Act, 1893,<sup>4</sup> from which the following sections are quoted:—

Remedy for breach of the warranty.

“53.—(1.) Where there is a breach of warranty by the seller, or where the buyer elects, or is compelled, to treat any breach of a condition on the part of the seller as a breach of warranty, the buyer is not by reason only of such breach of warranty entitled to reject the goods; but he may—

“(a.) Set up against the seller the breach of warranty in diminution or extinction of the price; or

“(b.) Maintain an action against the seller for damages for the breach of warranty.

<sup>1</sup> *Power v. Barham*, 7 C. & P. 356; 4 Ad. & E. 472; 5 L. J. K. B. (N. S.) 88 (1835) (Canaletto died in 1768). The jury found there was a warranty.

who died in 1694 and in 1682 respectively).

<sup>3</sup> See Benjamin on Sale, Book IV., Part II., Chap. I.

<sup>2</sup> *Jeuwine v. Slade*, 2 Esp. N. P. C. 572 (1797) (Teniers and Claud Lorraine,

<sup>4</sup> 56 & 57 Vict. c. 71.

“(2.) The measure of damages for breach of warranty is the estimated loss directly and naturally resulting, in the ordinary course of events, from the breach of warranty.

“(3.) In the case of a breach of warranty of quality such loss is *prima facie* the difference between the value of the goods at the time of delivery to the buyer and the value they would have had if they had answered to the warranty.

“(4.) The fact that the buyer has set up the breach of warranty in diminution or extinction of the price, does not prevent him from maintaining an action for the same breach of warranty if he has sustained further damage.

“(5.) Nothing in this section shall prejudice or affect the buyer’s right of rejection in Scotland as declared by this Act.”

“54. Nothing in this Act shall affect the right of the buyer or seller to recover interest or any special damages in any case where by law interest or special damages may be recoverable, or to recover money paid where the consideration has failed.”

The right to rescind the contract and return the goods is dealt with by an earlier section of the same Act.

Rescission of the contract for breach of warranty.

When condition is to be treated as warranty.

11.—(1) In England or Ireland—

“(a.) Where a contract of sale is subject to any condition to be fulfilled by the seller, the buyer may waive the condition, or may elect to treat the breach of such condition as a breach of warranty, and not as a ground for treating the contract as repudiated.

“(b.) Whether a stipulation in a contract of sale is a condition the breach of which may give rise to a right to treat the contract as repudiated, or a warranty the breach of which may give rise to a claim for damages, but not to a right to reject the goods and treat the contract as repudiated, depends in each case upon the construction of the contract. A stipulation may be a condition, though called a warranty in the contract.<sup>1</sup>

<sup>1</sup> See *Behn v. Burness*, 3 B. & S. 756 ; 32 L. J. Q. B. 204 (1863). Blackburn on Sale, 2nd ed., p. 198. Also *Nadel v. Martin*, 20 R. P. C. 129 and 723 ; 23 R. P. C. 41 (1906), H. of L. ; *Burchem v. Wren*, 21 R. P. C. 683 (1904), Dar-

ling, J. ; *Henderson v. Shie's*, 24 R. P. C. 109 (1907), Parker, J. ; in which questions arose whether on the construction of agreements for sale and licence of patents a guarantee of validity was a condition or a mere warranty.



“(c.) Where a contract is not severable, and the buyer has accepted the goods, or part thereof, or where the contract is for specific goods, the property in which has passed to the buyer, the breach of any condition to be fulfilled by the seller can only be treated as a breach of warranty, and not as a ground for rejecting the goods and treating the contract as repudiated,<sup>1</sup> unless there be a term of the contract, express or implied, to that effect.

“(2.) In Scotland, failure by the seller to perform any material part of a contract of sale is a breach of contract, which entitles the buyer either within a reasonable time to reject the goods and treat the contract as repudiated, or to retain the goods and treat the failure to perform such material part as a breach which may give rise to a claim for compensation or damages.

The Scotch rule.

“(3.) Nothing in this section shall affect the case of any condition or warranty, fulfilment of which is excused by law by reason of impossibility or otherwise.”

The warranty implied by the Merchandise Marks Act will accordingly operate to enable an innocent purchaser of goods which have been forfeited under that Act, or which have led to a prosecution, entailing expenses upon him, to recover damages in respect of the loss or expenses from the vendor, for such damages directly and naturally result in the ordinary course of events from the breach of warranty. It will also enable the purchaser to recover from the vendor any damages which may have been recovered from the purchaser by a sub-purchaser upon a resale by him, at any rate where the goods were known by the vendor to have been bought for the purpose of resale.<sup>2</sup>

Damages for breach of warranty of trade mark.

A manufacturer has at common law, and apart from any question of implied warranty, a right of indemnity by his customer, if, in compliance with the customer's orders, he innocently places a mark upon goods made for him, and the mark turns out to be an infringement of some third person's

Indemnity to manufacturer infringing a trade mark at his customer's request.

<sup>1</sup> *Street v. Blay*, 2 B. & Ad. 460 (1831); *Heyworth v. Hutchinson*, L. R. 2 Q. B. 447 (1867); *Hooper v. Balfour*, 62 L. T. 646 (1890); *Re Green and Balfour*, 63 L. T. 97, 325 (1890).

(1887), C. A.; *Agius v. Great Western Colliery Co.*, [1899] 1 Q. B. 413. See further, as to consequential damages, *The Argentino*, L. R. 13 P. D. 191 (1888), C. A.

<sup>2</sup> *Hammond v. Bussey*, 20 Q. B. D. 79

trade mark, so that the manufacturer is rendered liable to an action by the owner of the trade mark.<sup>1</sup>

Third party  
notice.

In an action for infringement of trade mark the defendant served a third party notice on his vendor, claiming to be indemnified by him against liability on the ground that the goods were innocently purchased by him in good faith from the third party in the ordinary way of trade, and that the third party supplied the same to him without notification of any such infringement or wrong as in the claim alleged in the action; and an order was made that the third party notice should be tried immediately after the action, and that the third party should have liberty to take such part in the action as the judge at the trial should think fit.<sup>2</sup>

<sup>1</sup> *Dixon v. Faucus*, 3 Ell. & Ell. 537 ; 30 L. J. Q. B. 137 (1861). As to the defence of the manufacturer in any such case upon proceedings under the Merchandise Marks Act, see sec. 2 (2), sec. 6, and sec. 19 (3) of that Act, Appendix, pp. 806, 808, and 813, and 2nd edition, Book II., Chap. I.

<sup>2</sup> *Hennessey v. Dompé*, 19 R. P. C. 338

(1903). At the trial, however, the third party was treated as a defendant, so that the action was tried as between the original plaintiff and both defendants, and, the plaintiff failing, he was ordered to pay the costs of both. On appeal, both defendants submitted to an order on terms, 20 R. P. C. 175 (1903).

## CHAPTER XVIII.

## TRADE LIBEL.

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UNDER sec. 36 of the Patents and Designs Act, 1907,<sup>1</sup> an action for damages or an injunction lies against any person claiming to be a patentee, who by circulars, advertisements, or otherwise, threatens any other person with legal proceedings or liability, at the instance of anyone who is aggrieved by the threats.<sup>2</sup> The section does not extend to threats in respect of the use of a trade mark or trade name, and there is no precisely corresponding right apart from it. So that the publication in good faith of a statement that the plaintiff is infringing the defendant's trade mark, and that the defendant intends to take proceedings against all persons dealing in the infringing goods, is not actionable, and cannot be restrained by injunction.<sup>3</sup> In

There is no threats action in respect of a trade mark ;

<sup>1</sup> Replacing sec. 32 of the Patents, &c. Act, 1883. The provisions are now extended to designs, Patents and Designs Act, 1907, sec. 61.

<sup>2</sup> Frost, Vol. I., p. 309, and Frost on Patents and Designs Act, 1907, Terrell, and Roberts and Moulton, on that Act. *Challender v. Royle*, 36 C. D. 425 ; 4 R. P. C. 363 (1887), C. A. ; *Johnson v.*

*Edge*, [1892] 2 Ch. 1 ; 9 R. P. C. 142, C. A. ; and *Skinner v. Shew*, [1893] 1 Ch. 413 ; and as to damages, *S. C.*, [1894] 2 Ch. 581 ; and *Skinner v. Perry*, 11 R. P. C. 406 (1894).

<sup>3</sup> *Colley v. Hart*, 44 C. D. 179 : 6 R. P. C. 17 (1888), North, J. (interim injunction refused as to the trade mark). Also at the trial, 7 R. P. C. 101, at p. 113.

a passing-off case,<sup>1</sup> a counterclaim which alleged threats merely without malice was ordered to be struck out as disclosing no reasonable cause of action.

but the threats may amount to libel or slander of title.

But disparaging statements calculated to injure the plaintiff's trade or to diminish the value of his goods, if they are not made in good faith, are actionable; and the continued publication of them after they have been shown, or have been held by the Court,<sup>2</sup> to be untrue may be restrained.<sup>3</sup> For they amount to libels on the plaintiff in the way of his trade, or to slander of title.<sup>4</sup>

A warning against infringements, &c., may be issued in good faith.

A fair warning to the public, or to probable purchasers of the goods, or to customers of the businesses concerned, by a trader that he regards the conduct of another as an infringement of his rights, if published in good faith, and in the belief that it is well founded, is not libellous,<sup>5</sup> although it may turn out to be mistaken.<sup>5</sup> So, anyone who thinks his trade name is likely to be confused with that of another business may publish a warning that there is no connection between his business and the other.<sup>6</sup> And this, notwithstanding the pendency of proceedings in which the right of the proprietor of the other to use the name or marks

<sup>1</sup> *Ripley v. Arthur & Co.*, 18 R. P. C. 82 (1901), Farwell, J.

<sup>2</sup> *Burnett v. Tuk*, 45 L. T. 743 (1882), Kay, J.

<sup>3</sup> *Wren v. Weild*, L. R. 4 Q. B. 730 (1869), a patent threats action before the Act of 1883. In *Halsey v. Brotherhood*, 19 C. D. p. 392 (1881), a similar action, Lindley, L.J., said: "*Wren v. Weild* comes to this: that if I am a patentee, so long as I act honestly, I am entitled to say, without running the risk of having an action for damages brought against me, that somebody is infringing my patent, or that somebody else's manufacture is an infringement of my patent. . . . If I say it dishonestly, I am so liable; and if I know that what I say is untrue, it would not take much to persuade a jury that I was acting dishonestly."

<sup>4</sup> A false and malicious statement in writing, printing, or by word of mouth, injurious to any person's title to property, and causing special damage, is an actionable slander of title. Tindal, C.J., in *Malachy v. Soyer*, 3 Bing. N. C. 371 (1835).

<sup>5</sup> In *Dicks v. Brooks*, 15 C. D. p. 40 (1880), Bramwell, L.J., said: "Although, according to our opinion, they would have been wrong in their law with respect to its being a piracy, I think their saying so would not have been actionable, because a man is not bound to be correct in his statement of law, though he is bound to be correct in his statement of facts." "To support such an action it is necessary for the plaintiffs to prove (1), that the statements complained of were untrue; (2), that they were made maliciously, *i.e.* without just cause or excuse; (3), that the plaintiffs have suffered special damage thereby": per Ld. Davey, in *Royal Baking Powder Co. v. Wright, Crossley & Co.*, 18 R. P. C. 95 (1901), H. of L. See also the passage as to *bona fides*, below, p. 563.

<sup>6</sup> *Thorley's Cattle Food Co. v. Massam*, 14 C. D. 763 (1880), C. A.; *William Coulson & Sons v. James Coulson & Sons*, 3 Times L. R. 740 (1887), Div. Court. In the last case the defendants added to their warning a statement that the plaintiff firm was lately bankrupt.

he has adopted comes into question.<sup>1</sup> But under pretence of the honest publication of a fair warning there is no excuse for an allegation that the goods of the other party are spurious,<sup>2</sup> or that he is foisting a fictitious article upon the public,<sup>3</sup> or is fraudulently endeavouring to pass off his goods as those of the person who issues the advertisement or circular complained of.<sup>4</sup>

Thus, in *Thorley's Cattle Food Co. v. Massam*,<sup>5</sup> the defendants had published an advertisement warning the public that any goods purporting to be Thorley's Cattle Food, and not signed by their trade name "Joseph Thorley," were not of their manufacture, and alleging that they were the only persons possessed of the secret recipe according to which the food was compounded, and had published also a circular stating that the plaintiffs were seeking to "foist upon the public an article which they pretend is the same as that manufactured by the late Joseph Thorley." The defendants were the executors of the late Joseph Thorley, the inventor of the cattle food, and they were carrying on his business; but the statement that they alone possessed the secret recipe, and the suggestion that the goods of the plaintiffs were not prepared according to it, were both false, for one Josiah Thorley, a brother of Joseph Thorley, who had obtained the recipe from him, was manager of the plaintiff company.<sup>6</sup> An injunction was granted at the trial to restrain the defendants from advertising, or representing, or suggesting in their advertisements or circulars, that they, or the proprietors of their testator's business, were alone possessed of the secret recipe, and from representing or suggesting, or doing anything calculated to represent or suggest, that the cattle food manufactured or sold by the plaintiffs was spurious or not genuine.

Suggestion that the plaintiff's goods are spurious.

And in *Thomas v. Williams*,<sup>7</sup> the publication of circulars suggesting that the goods of the plaintiff were not genuine, but were imitations of goods sold by the defendants, was restrained.

<sup>1</sup> *Coats v. Chadwick*, [1894] 1 Ch. 347. Chitty, J.; see p. 565, below; *Anderson v. Liebig, &c. Co.*, 45 L. T. 757 (1881), Chitty, J.

<sup>2</sup> *Thorley's case*, supra.

<sup>3</sup> See note (6), previous page.

<sup>4</sup> *Coats v. Chadwick*, supra.

<sup>5</sup> Supra; *Liebig, &c. Co. v. Anderson*, 55 L. T. 206 (1887), Chitty, J.

<sup>6</sup> A suit for an injunction by the executors to restrain the use of the name

*Thorley's Cattle Food* by the company had been abandoned, after an application in it for an interim injunction had failed; 6 C. D. 583, Malins, V.-C. But, subsequently, the executors succeeded in a trade name and passing-off action against the company, ante, p. 542.

<sup>7</sup> 14 C. D. 864 (1880), Fry, J.; *Liebig, &c. Co. v. Anderson*, note (1) "only genuine brand."

But a mere puff of the defendant's own goods, or a statement that they are superior to those of a rival trader, even if untrue and the cause of damage to the latter, is not actionable.<sup>1</sup> And it cannot be made actionable by proof of malice.<sup>1</sup>

Special  
damage must  
be proved.

In an action for a trade libel, as distinguished from an ordinary personal libel, proof of special damage—*i.e.*, that the publication of the libel has actually injured the business or property of the plaintiff—is essential.<sup>2</sup> If the libel is “in its very nature intended, or reasonably likely to produce,” and “in the ordinary course of business does produce, a general loss of business, as distinct from the loss of this or that known customer, evidence of such general decline of business is admissible” to prove special damage.<sup>3</sup>

If the injury proved is trifling and no threat to repeat the publication is proved, the action should be dismissed.<sup>4</sup>

The interruption of an illegal trade cannot be legal damage.<sup>5</sup>

<sup>1</sup> *Hubbuck v. Wilkinson*, [1899] 1 Q. B. 86, C. A., adopting the opinion expressed by Herschell, L.C., in *White v. Mellin*. In the latter case ([1894] 3 Ch. 276; [1895] A. C. 154), the defendant, a chemist, had placed upon the goods of the plaintiff, Mellin, which he sold, an advertisement of *Vance's Food*, a rival food for infants. The advertisement stated that *Vance's Food* was “far more nutritious and healthful” for infants and invalids “than any yet offered.” The plaintiff complained of this as a trade libel. Romer, J., dismissed the action at the close of his case. The C. A. ordered a new trial, but this order was reversed by the H. L. on the ground that neither the untruth of the statement complained of, nor that it had caused special damage to the plaintiff, had been proved. Both points were essential to the plaintiff's case. *Id.* Watson also held that, notwithstanding the manner in which the statement had been affixed to and sold with the plaintiff's goods, it was not, in any legal sense, published of and concerning them. *Id.* Herschell said (at p. 164): “I entertain very grave doubts whether any action can be maintained for an alleged disparagement of another's goods merely on the allegation that the goods sold by the party who is alleged to have dis-

paraged his competitor's goods are better either generally or in this or that particular respect than his competitor's are.” His lordship put aside the question of malice. The other learned lords concurred in this view. See also *Magnolia Metal Co. v. Tandem Smelting Syndicate*, 17 R. P. C. 477 (1900), H. of L.

<sup>2</sup> *White v. Mellin*, *supra*, approving *Evans v. Harlow*, 5 Q. B. 624 (1844); *British Empire Type Co. v. Linotype Co.*, 79 L. T. 8 (1898), C. A. *Royal Baking Powder Co. v. Wright, Crossley & Co.*, 18 R. P. C. 95 (1901), H. of L. The contrary had formerly been held: see cases cited in *White v. Mellin* and *Hayward v. Hayward*, *infra*.

<sup>3</sup> *Ratcliffe v. Evans*, [1892] 2 Q. B. 524, C. A.

<sup>4</sup> *Dicks v. Brooks*, 15 C. D. 22 (1879), C. A. There the defendants, who owned the copyright in an engraving of Millais' “Huguenots,” had threatened proceedings against persons who bought copies of the plaintiff's paper containing a wool-work pattern, wrongly alleged to be an infringement of the copyright. Only two or three numbers were shown to have been returned or not sold in consequence of the threats.

<sup>5</sup> Per *Id.* Robertson, in *Royal Baking Powder Co.'s case*, note (2).

And in a case where the only evidence of damage to the plaintiff, by the publication of a libellous circular misstating the result of an action for passing off the plaintiff's goods as those of the defendant, was the plaintiff's own affidavit alleging that his business had fallen off, and the plaintiff had delayed bringing his action for three months after he first knew of the publication, North, J., assessed the damages at £5, but granted an injunction, and gave the plaintiff the costs of the action.<sup>1</sup> But a disparaging statement with regard to a trader's goods may be an ordinary libel upon the trader personally and, accordingly, be actionable without proof of special damage. Such, for instance, would be the case if the goods were described as worthless<sup>2</sup> or spurious.<sup>3</sup> To write of a trader that he sells such goods is clearly defamatory.

Statement may be a personal libel.

In an action brought for falsely and maliciously publishing passages in a book depriving the plaintiff of the credit of being the first inventor of a machine, the statement of claim was struck out on the ground that the passages complained of were not libellous, and that no reasonable cause of action was shown. But Vaughan Williams, L.J., said that he must not be supposed in any way to be affirming such a proposition as that you cannot libel anyone by denying his title to a reputation which he may have obtained as an inventor or as a man of science.<sup>4</sup>

Libel on inventor.

It is essential, in order to entitle the plaintiff to redress in respect of the publication of a threat or warning, that he should make out that the statements complained of are not published in good faith. He must show that the defendant was not saying what he did in defence of his own right, or, as he believed, in defence of his own right—for the defendant might make a mistake.<sup>5</sup> Upon an application, therefore, for an interim injunction to restrain the publication of threats by the defendant, it is not sufficient proof, if it is any evidence at all, of want of good faith, to show that he has commenced an action

A threat or warning may be made, if *bona fide*.

<sup>1</sup> *Hayward & Co. v. Hayward & Sons*, 34 C. D. 198 (1886).

<sup>2</sup> *British Empire Type Co. v. Linotype Co.*, 79 L. T. 8 (1898). The defendants published a statement that the plaintiffs' machines had been removed, after a very short time, from several newspaper offices. The plaintiffs got a verdict at the trial, and the C. A. refused a new trial on the ground stated in the text.

<sup>3</sup> See *The Liebig* case, above, p. 561.

<sup>4</sup> *Wilde v. Thompson*, 20 R. P. C. 361, 775 (1903), Buckley, J., and C. A.

<sup>5</sup> Per Lindley, M.R., in *Royal Baking Powder Co. v. Wright, Crossley & Co.*, 16 R. P. C. 217 (1899), C. A. In the House of Lords the decision was unanimously affirmed, the majority of the learned lords holding that special damage was not proved, 18 R. P. C. 95.

for infringement of trade mark, or for passing off goods against the plaintiff, but has neglected to apply in it for an interlocutory injunction ;<sup>1</sup> nor to show even a long delay in bringing an action for infringement, if the delay is reasonably explained.<sup>2</sup>

Misleading report of a trade mark action.

The publication of a misleading report of a trade mark action, or of an order obtained by the successful party therein either at the trial or on an interlocutory application, may be a trade libel falling within the principles of the cases referred to in this chapter. Thus, where an action for passing-off had failed and been dismissed without costs, because the evidence showed only a few instances of representations that the defendant's goods were those of the plaintiffs, and also that these representations were made by the defendant's agents without his knowledge or authority, the defendant offered an undertaking that he would never make such representations, and this undertaking was inserted in the order at the desire of the judge. The plaintiffs then published a circular headed "Caution," which, referring to the action, alleged that :--

"By the judgment the defendant was ordered to undertake not to represent that his firm is, or that the plaintiff's firm is not, the original firm of Richard Hayward & Co.," and added that the plaintiffs, "finding that serious misrepresentations were in circulation to their prejudice, felt themselves compelled to bring the above action." In a subsequent action,<sup>3</sup> brought by the former defendants against the former plaintiffs, the circular was held to be untrue and libellous, and to have been published maliciously, and an injunction was granted to restrain its further publication.

True statements are not libellous.

So far as the case against an advertisement or other publication rests upon its being a libel, proof that the statements complained of in it are, in fact, true, is an answer to any action for damages, or an injunction in respect of its publication.<sup>4</sup> It makes no difference that ignorant readers might misunderstand it.<sup>5</sup>

Accordingly, an action for publishing a statement that certain persons, meaning the plaintiff company, had wrongfully used the word *Singer* to designate machines not manufactured by the

<sup>1</sup> *Anderson v. Liebig's Extract of Meat Co.*, 45 L. T. N. S. 757 (1881), Chitty, J.

<sup>2</sup> *Incandescent Gas Light Co. v. Sunlight Incandescent Co.*, 14 R. P. C. 180 (1897), Stirling, J.

<sup>3</sup> *Hayward & Co. v. Hayward & Sons*, 34 C. D. 198 (1886), North, J. ; *Liebig's*,

*Ac. Co. v. Anderson*, 55 L. T. 206 (1887), Chitty, J.

<sup>4</sup> *Nähmaschinen Fabrik, &c. v. Singer Manufacturing Co.*, 10 R. P. C. 310 (1893), Romer, J. ; and the *Baking Powder* case, p. 563, note (5).



*Singer* company, which came on for trial after the *Singer* company had established, in a passing-off action against the plaintiff company, that the use of the word by the the latter was actually wrongful, was dismissed with costs.<sup>1</sup>

The meaning of the statements complained of is determined by the Court itself, and unless circumstances are proved tending to show that their actual meaning, in the particular case, is different from the natural meaning, evidence cannot be adduced to prove that they were not understood according to it.<sup>2</sup>

A solicitor who has made the publication merely as agent for the real defendants should not be joined as a defendant.<sup>3</sup> So the publication of an apology actually made by the plaintiffs to the defendants is justifiable, though it may have been extracted from the plaintiffs under duress of civil or criminal proceedings in respect of the false marking of their goods.<sup>4</sup>

But the publication of a statement which turns out to be true may be improper pending legal proceedings in which the matters it refers to are in issue, not as being libellous, but as contempt of Court, if it tends to interfere with the fair trial of the action, or to embarrass one of the parties in the preparation or conduct of his case. And such contempt may be punished by imprisonment,<sup>5</sup> fine, or sequestration of goods, or the publication may be restrained by injunction, upon a summary application by motion in the action.<sup>6</sup> The reluctance of the Court to interfere by interlocutory injunction to restrain the further publication of an alleged libel which the defendant justifies, does not extend to such cases as these. As already stated, the parties are at liberty to warn the trade as much as they like, notwithstanding the pendency of the action; but they are bound to refrain during its pendency from public discussion on the merits or demerits of

Evidence to construe the libel.

Solicitor.

Publication of an apology.

But a statement pending proceedings, whether true or not, may be a contempt of Court.

<sup>1</sup> Note (4), above, p. 564.

<sup>2</sup> Note (2), above, p. 563.

<sup>3</sup> Note (2), above, p. 564.

<sup>4</sup> *Fisher v. Apollinaris Co.*, L. R. 10 Ch. 297 (1875), L.J.J.

<sup>5</sup> *Roach v. Hall*, 2 Atk. 469 (1742), Hardwicke, L.C. The respondents were imprisoned for publishing statements calling some of the witnesses "affidavit men." *Kitcat v. Sharp*, 31 W. R. 227 (1883), Fry, J. (defendant restrained from publishing the statement of claim and correspondence).

<sup>6</sup> *Coats v. Chadwick*, [1891] 1 Ch. 347, Chitty, J. The plaintiffs, in an action for passing-off, were restrained from publishing a circular charging the defendants with fraudulent imitation of their goods. In some subsequent cases the Court has expressed the opinion that the actual decision went too far, *R. v. Payne*, [1896] 1 Q. B. 577, Ld. Russell and Wright, J.; *In re New Gold Coast Exploration Co.*, [1901] 1 Ch. 860, Cozens-Hardy, J. See also *Goulard v. Lindsay*, 4 R. P. C. 189 (1887), Kay, J. (a patent case).

the case.<sup>1</sup> "You can warn as much as you like," Kay, J., said, in *Goulard v. Lindsay*, "but can you advertise: 'I have brought an action against A. B. which is certain to succeed'?"<sup>2</sup> And the learned judge added that to advertise a positive statement that the defendants had infringed the plaintiff's patent was wrong.

Moreover a misrepresentation by one party to the prejudice of other parties of the result of proceedings is a contempt of Court, whether the action or proceedings have come to an end or not. Where a motion for an interlocutory injunction had been refused on the ground of the plaintiff's delay, and the defendants thereupon put up a notice in their shop window which would in the opinion of the Court have led an ordinary customer to the conclusion that the defendants had been held to be entitled to do what was complained of, it was held that there had been an attempt to represent to the prejudice of the plaintiff's what had taken place in Court, and that therefore a contempt of Court had been committed.<sup>3</sup>

Statement in  
reply to one  
published by  
the other side.

It is no answer to an application for an injunction in respect of a publication alleged to be a contempt of Court, to say that it was made in reply to a statement published by the applicant himself with reference to the same matter, although this circumstance may influence the Court in dealing with the costs of the application.<sup>4</sup>

But every publication bearing upon the matters in question *pendente lite* is not a contempt. A fair and accurate report of interlocutory proceedings, for instance, is allowable.<sup>5</sup> And the Court may refuse to restrain a report which it thinks unfair or discreditable to the persons responsible for it, if not convinced that the report is calculated to obstruct the course of justice, or to prejudice the public mind.<sup>6</sup>

<sup>1</sup> Per Chitty, J., [1894] 1 Ch. 350.

<sup>2</sup> 4 R. P. C. 189 (1887). But see *British Vacuum Cleaner Co., Ltd. v. Suction Cleaners, Ltd.*, 21 R. P. C. 300 (1904), Swinfen Eady, J.; *Haskell Golf Ball Co. v. Hutchison*, 21 R. P. C. 497 (1904), Buckley, J. These were all patent cases.

<sup>3</sup> *Gillette Safety Razor Co. v. A. W. Gamage, Ltd.*, 24 R. P. C. 1 (1907), Warrington, J.

<sup>4</sup> *Coleman v. West Hartlepool Ry. Co.*, 8 W. R. 734 (1860), Wood, V.-C.

<sup>5</sup> A newspaper report published con-

temporarily, if otherwise libellous, would be privileged under the Law of Libel Amendment Act, 1888.

<sup>6</sup> *Brook v. Evans*, 29 L. J. Ch. 616 (1860), Stuart, V.-C., and L.JJ. The plaintiffs advertised that they had established that they first used the word *Glacé*, but that the defendants relied on the lapse of time as an answer to the motion, although the plaintiffs had constantly protested against the defendants' use of the word. The defendants, in fact, had not been called upon on the motion.

Where the publication of a statement *pendente lite* is restrained as being a contempt of Court, the applicant is not required to give an undertaking to be answerable in damages to the respondent for any loss occasioned by the injunction if it turns out that the respondent was in the right,<sup>1</sup> as is usual upon the grant of an interlocutory injunction, for the publication is wrong in any event, whether the statements are found in the end to be false or to be well-founded.

Undertaking  
as to damages

The rule under which the publication of biassed comments reflecting on matters in issue in pending litigation and calculated to interfere with the fair trial of the action, is restrained, is of general application, and it is not confined to publications made by, or at the instance of, interested parties. Applications under it to commit the editors of newspapers were very frequent a few years ago, and, in spite of the constantly expressed reluctance of the judges to interfere where it is not necessary to protect the fair prosecution of the action,<sup>2</sup> the applications generally result in the costs incurred, or part of them,<sup>3</sup> and sometimes a substantial fine,<sup>4</sup> being thrown upon the respondents if they have ventured at all beyond a mere accurate report, or a colourless account of the proceeding.

Contempts by  
newspaper  
editors.

Before the Judicature Act the Courts had no jurisdiction to restrain the publication of a libel, even though it affected the plaintiff's trade or property;<sup>5</sup> but the jurisdiction is conferred by that Act upon all the divisions of the High Court, and it has been exercised in many cases.<sup>6</sup>

Injunction to  
restrain  
trade libels.

The Court has also jurisdiction to interfere by interlocutory

Interlocutory  
injunction.

<sup>1</sup> *Fenner v. Wilson*, [1893] 2 Ch. 656, Kekewich, J.

<sup>2</sup> In *Re Clements*, 46 L. J. Ch. 383 (1877), Jessel, M.R., said: "I say that a judge should be most careful to see that the cause cannot be fairly prosecuted to a hearing unless this extreme mode of dealing with persons brought before him on accusations of contempt should be adopted." And see *R. v. Layne*, [1896] 1 Q. B. 577, Ld. Russell and Wright, J. In *The Plating Co. v. Farquharson*, 17 C. D. 49 (1881), the C. A. dismissed an application to commit the editor of a paper in respect of an advertisement asking for subscriptions and evidence to assist the appeal in a patent case. In *Re Martindale*, [1894]

3 Ch. 193, North, J., refused with costs motions to commit the editors of several papers who had innocently copied from another paper.

<sup>3</sup> See *Duncan v. Sparling*, *The Times*, 9th March, 1894.

<sup>4</sup> *Re The Crown Bank*, 44 C. D. 649 (1890) (a bad case of contempt).

<sup>5</sup> *Prudential Assurance Association v. Knott*, L. R. 10 Ch. 142 (1875), Cairns, L. C. and L.JJ.

<sup>6</sup> *Thorley's Cattle Food Co. v. Massam*, 6 C. D. 582 (1877), Malins, V.-C.; 14 C. D. 763 (1880), Malins, V.-C., and C. A.; *Thomas v. Williams*, 14 C. D. 564 (1880), Fry, J.; *Saxby v. Easterbrook*, 3 C. P. D. 339 (1878), Div. Court, and the cases cited below.

injunction to restrain the further publication of an alleged trade libel, which is the subject of an action, until the hearing.<sup>1</sup> But it will only do so if it is satisfied, upon the facts and evidence before it, that the statements complained of are false,<sup>2</sup> however much the balance of convenience may be in favour of staying the publication,<sup>3</sup> and only in the clearest cases<sup>4</sup>—where, as it has been put, the plaintiff's case is so strong that if the jury at the trial found for the defendant, their verdict would be set aside as unreasonable.<sup>5</sup>

For the question, libel or no libel, is peculiarly a question for a jury; and in order to interfere before the hearing the Court must determine that question in advance, without the jury's assistance.<sup>6</sup> The reluctance to interfere by interlocutory injunction is so strong, that the cases cited of *Bonnard v. Perryman*,<sup>6</sup> and *Monson v. Tussaud*,<sup>7</sup> seem to show that, where the defendant alleges justification and reserves the particulars of his case and the evidence in support of it, the injunction ought never to be granted. In any case, the probability of very serious injury to the plaintiff if the libellous statements are allowed to continue must be made out.<sup>8</sup>

An action in respect of a trade mark for slander of title, unlike a mere personal libel, survives to the executors since it occasions an injury to the estate of the testator.<sup>9</sup>

Action survives to executors.

<sup>1</sup> *Lec v. Gibbings*, 67 L. T. 263 (1892), Kekewich, J., and the cases next cited.

<sup>2</sup> *Collard v. Marshall*, [1892] 1 Ch. 571, Chitty, J. The libel was that the plaintiffs were "sweaters," and that their work was not properly executed. The defendants said the statements were, in substance, true, but did not suggest that they had any further evidence not before the Court. They were willing to treat the motion as the trial. An interim injunction was granted. *Punch v. Boyd*, 16 L. R. Ir. 476 (1885).

<sup>3</sup> *Société des Manufactures des Glaces v. Tilghman's Patent Sand Blast Co.*, 25 C. D. 1 (1883), C. A.

<sup>4</sup> *Monson v. Tussaud*, [1894] 1 Q. B. D. 671, C. A., per Davey, L.J. (case of a personal libel).

<sup>5</sup> Per Ld. Esher, M.R., in *Coulson v. Coulson*, 3 Times L. R. 846, adopted in *Bonnard v. Perryman*, [1891] 2 Ch. 269. C. A.; *Lec v. Gibbings*, supra.

<sup>6</sup> See note (5).

<sup>7</sup> Note (4). These were not, however, trade libels, but the rule was applied in *Champion & Co. v. The Birmingham Vinegar Brewery Co.*, 10 Times L. R. 163 (1893), Div. Court, which was a trade case.

<sup>8</sup> *Salomons v. Knight*, [1891] 2 Ch. 294, North, J., and C. A.; *Mogul Steamship Co. v. McGregor, Gow & Co.*, 15 Q. B. D. 476 (1885), Coleridge, L.C.J., and Fry, L.J.

<sup>9</sup> *Hatchard v. Mege*, 18 Q. B. D. 771 (1887), Div. Court.

## CHAPTER XIX.

### TRADE SECRET AND TRADE NAME.

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It has been shown that anyone is entitled to use a name or mark for the goods to which that name or mark is properly applied.<sup>1</sup> Thus, anyone who is in possession of goods made or sold by the owner of a trade mark or trade name, may apply the proper trade name or trade mark to them,<sup>2</sup> and may, for instance, replace the old labels upon the goods by new ones.<sup>3</sup> So, the name of a secret preparation may be used by anyone for goods actually prepared according to the recipe,<sup>4</sup> for they are the goods

Use of the  
trade name  
of a secret  
preparation.

<sup>1</sup> See Chap. II., p. 33, and Chap. XV., p. 394.

<sup>2</sup> *Condy v. Taylor*, 56 L. T. 891 (1887), Kekewich, J. But he must not apply a mark denoting a superior quality of goods of the owner of the mark to an inferior quality, see above, p. 394.

<sup>3</sup> *Farina v. Silverlock*, 6 De G. M. & G. 214; 26 L. J. Ch. 11 (1856), Cranworth, L.C., cited, p. 33. See also p. 394.

<sup>4</sup> *Canham v. Jones*, 2 V. & B. 218; 13 R. R. 70 (1813), Plumer, V.-C. (*Veluo's Vegetable Syrup*) The case was decided on demurrer, although the bill alleged facts which would now be held sufficient to support a passing-off case like that of *The Yorkshire Relish*, p. 570, note (1). *James v. James*, L. R. 13 Eq. 421 (1872), Romilly, M.R. (*Lieutenant James' Horse Blister*); *Condy v. Mitchell*, 37 L. T. N. S. 268, 766 (1877), Bacon,

V.-C., and C. A. (*Condy's Fluid*); and see the injunction in *Siegert v. Findlater*, 7 C. D. 801 (1878), Fry, J., cited p. 394 (*Angostura Bitters*). In *Benbow v. Low*, 44 L. T. N. S. 875 (1881), Bacon, V.-C., held that an outgoing partner who retained the receipt could use the name of a secret preparation. The question whether the defendant could have used the name in *The Yorkshire Relish* case (next note), if he had discovered the secret, was left open by the H. L. Ld. Davey ([1897] A. C. at p. 717; 14 R. P. C. at p. 732) said he saw no reason to differ from the opinion of Fry, J., in *The Angostura Bitters* case, and of Lindley, L.J., in the case in question, that he could have done so. See also *Rcy v. Lecouturier*, 25 R. P. C. 265 (1908), C. A. (*Chartreuse*), where in the Court of Appeal, all the members of the Court adverted in their judgments

indicated by the name, whether prepared by the original inventor of the recipe, or his successors in business, or not. Until the secret is discovered or betrayed the goods of the original inventor or his successors can be the only goods to which the name is applicable, or which are denoted by it;<sup>1</sup> but when other people can make them, the difficult question of fact, discussed in previous chapters of this book<sup>2</sup> arises, whether the name is merely that of the goods themselves, or that of goods of the kind prepared or sold by the original inventor or his successors in business. This was clearly put by Fry, J., in *The Angostura Bitters* case.<sup>3</sup> "I cannot say," the learned judge said, "that Meinhard<sup>4</sup> may not, if he can, make a bitter identical with the plaintiffs', and, if he does, I cannot prevent him from selling it as *Angostura Bitters*. It is to be observed that the person who produces a new article, and is the sole<sup>5</sup> maker of it, has the greatest difficulty (if it is not an impossibility) in claiming the name of that article as his own, because, until somebody else produces the same article, there is nothing to distinguish it from. No distinction can arise from using the name of the class so long as the class consists of only one species, for then the name of the species and the name of the class will be the same."

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

But, as regards any particular person, the use of a mark or name which is open to the world at large may be restrained by reason of a contract which he has entered into, or of circumstances which make it contrary to conscience for him to avail himself of the general right. Putting aside cases of express contract,—as where, for instance, a partner or servant has covenanted not to use the firm name, or any particular name or marks, or not to engage in any particular business, after the determination of the partnership or employment,—the most important cases of this kind are cases of trade secrets. The

to the fact that the process of the monks (plaintiffs) was a secret one. See also the form of the injunction, judgment of Buckley, L.J.

<sup>1</sup> Thus, in *Birmingham Vinegar Brewery Co. v. Powell*, [1897] A. C. 710; 14 R. P. C. 720, the defendants were restrained from describing their sauce as *Yorkshire Relish* without clearly distinguishing it from the plaintiff's sauce. They had not succeeded in discovering the recipe, but only in making a wonderful match. See above, p. 489.

<sup>2</sup> Above, pp. 37 *et seq.*, and p. 507.

<sup>3</sup> *Siegert v. Findlater*, 7 C. D. 801, at p. 813.

<sup>4</sup> The maker of the defendant's bitters.

<sup>5</sup> On the principle of *Dent v. Turpin* (above, p. 385), if there were two or three makers only, each of them might claim to restrain an outsider from using the name. See observations of Ld. Watson during the argument in *The Yorkshire Relish* case, 14 R. P. C. at p. 726. Cf. sec. 39 of the Trade Marks Act, 1905.

law relating to trade secrets does not properly fall within the scope of this book, but as it touches upon the limitation of trade mark and trade name rights referred to above, it is convenient shortly to refer to the leading cases on the subject.

Wherever secret information has been obtained under circumstances which import a contract not to disclose or make use of it, or by breach of confidence, or under other circumstances which make the disclosure, or the use of the information, contrary to conscience, the Court will restrain the person who has obtained it, or anyone to whom it has been communicated by him, from using or disclosing it.<sup>1</sup>

Thus, in *Prince Albert v. Strange*,<sup>2</sup> the publication of a catalogue of a number of etchings made by the late Queen and Prince Albert for their private use and amusement, and never published or authorised to be published by them, and the exhibition of the etchings, was restrained, the copies of the etchings which had passed into the defendant's possession having been obtained surreptitiously and in breach of confidence from or through a printer employed to print them. And in *Morison v. Moat*<sup>3</sup> the defendant, who had obtained the secret of manufacturing *Morison's Universal Medicine* from his father, was restrained from using it. Both the defendant and his father had formerly been in partnership with the plaintiff, but the father of the defendant, to whom alone the original inventor had disclosed the secret, had entered into a bond not to divulge it to any other person. The injunction restrained the defendant, his agents, &c., from selling, under the title of *Morison's Universal Medicine*, any medicine made by him or under his directions, and also from making any medicines according to the secret, or in any manner using the secret of compounding the medicines, or any part thereof.

Injunctions have been granted on the same principles to

Information obtained by breach of contract or of confidence.

Information obtained by a clerk ;

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

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

<sup>3</sup> 9 Hare, 241 ; 20 L. J. Ch. 513 ; 21 *ib.* 248 (1851), Turner, V.-C., and Knight-Bruce and Id. Cranworth, L.JJ., App., p. 730. The case of *Canham*

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

table of dimensions by engineer's draftsman ;

book of advertisements by canvasser ; lectures ;

private letters ; copies of pictures by lithographer ;

photographs of the plaintiff.

The jurisdiction rests on implied contract.

restrain the use or publication of secret information obtained by a clerk or servant in the course of his employment<sup>1</sup>—and it is said that “every clerk employed in a merchant's counting-house is under an implied contract that he will not make public that which he learns in the execution of his duty as a clerk”<sup>2</sup>—of a list of the names and addresses of the plaintiff's customers copied by the defendant from his books when employed as his manager ;<sup>3</sup> of a table of details of the dimensions of machinery designed by, or for the plaintiffs, collected from their plans by one of their draftsmen, although the details could all have been gathered from the machines made according to the designs and sold, if access could have been obtained to them ;<sup>4</sup> of materials for the construction of a book of advertisements collected by the plaintiff's advertising canvassers ;<sup>5</sup> of lectures delivered to a class of students, and not published or authorised to be published by the lecturer ;<sup>6</sup> of private letters written by the plaintiff, or by a person whose estate the plaintiff represents ;<sup>7</sup> of copies of the plaintiffs' pictures, delivered to the defendants for the making of copies, in excess of the number made for and delivered to the plaintiffs ;<sup>8</sup> and of prints from a photographic negative likeness of the plaintiff, which the defendants had been employed by the plaintiff to take.<sup>9</sup>

“Different grounds have been assigned for the exercise of the jurisdiction. In some cases it has been referred to property, in others to contract, and in others, again, it has been treated as founded upon trust or confidence, meaning, as I conceive, that the Court fastens the obligation on the conscience of the party, and enforces it against him in the same manner as it enforces, against a party to whom a benefit is given, the obligation of

<sup>1</sup> *Youatt v. Winyard*, 1 Jac. & W. 394 (1820), Eldon, L.C.

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

<sup>3</sup> *Robb v. Green*, [1895] 2 Q. B. 1, 315, Hawkins, J., and C. A. ; damages for breach of the implied contract to observe good faith were also recovered.

<sup>4</sup> *Merryweather v. Moore*, [1892] 2 Ch. 518, Kekewich, J. The defendant had been apprenticed to the plaintiffs, and had remained in their employment after his articles expired ; cf. *Reuter's*

*Telegram Co. v. Byron*, cited below, p. 373, note (2).

<sup>5</sup> *Lamb v. Evans*, [1892] 3 Ch. 462 ; [1893] 1 Ch. 218, Chitty, J., and C. A.

<sup>6</sup> *Abernethy v. Hutchinson*, 3 L. J. Ch. (O. S.) 214 (1824), Eldon, L.C. ; *Caird v. Sime*, 12 App. Ca. 326 (1887).

<sup>7</sup> *Perceval v. Phipps*, 2 Ves. & B. 19 (1813), Plumer, V.-C. ; *Earl of Lytton v. Drey*, 54 L. J. Ch. 293 (1884), Bacon, V.-C.

<sup>8</sup> *Tuck & Sons v. Pricster*, 19 Q. B. D. 629 (1887), C. A.

<sup>9</sup> *Pollard v. Photographic Co.*, note (2).



performing a promise, on the faith of which the benefit has been conferred."<sup>1</sup> But it is submitted that the true ground is always implied contract,<sup>2</sup> for if information, which both parties understand the present possessor intends to be kept, and to remain secret, is communicated by him to another, or the means of obtaining it are placed by him within the reach of another, for particular purposes, for instance, in the course of an employment, an undertaking not to use or disclose the information ought almost necessarily to be inferred.

As already stated, the jurisdiction extends to enable the Court to restrain a third party from using secret information which has been, to his knowledge, obtained or communicated in breach of faith<sup>3</sup> or contract. On similar grounds the right of a person, who has collected information and supplied it for the sole use of his customers, to restrain them from disclosing it to others,<sup>4</sup> and to restrain others from surreptitiously obtaining it from the subscribers, has been protected.<sup>5</sup>

The mere existence of a contract for service does not *per se* disqualify a servant from taking out a patent for an invention made by him during his term of service, even although the invention may relate to subject-matter germane to and useful for his employers in their business; and that, even although the servant may have made use of his employers' time and servants and materials in bringing his invention to completion, and may have allowed his employers to use the invention while in their employment, but all the circumstances must be considered in each case. Thus it was held by Byrne, J., in a case in which he summed up the principle established by the authorities in the above words, that the confidential agent and manager in this country of an American corporation, who had taken out two patents in this country, could not, having regard to the nature and scope of his employment, to the obligations and duties arising therefrom, to the trust imposed in him, and to his own conduct in endeavouring to establish a trade for them in the

Patents taken out by agent in breach of confidential relation towards principal.

<sup>1</sup> Per Turner, V.-C., in *Morison v. Mout*, 20 L. J. Ch. p. 522. So, per Kekewich, J., in *Merryweather v. Moore*, [1892] 2 Ch. p. 522.

<sup>2</sup> *Merryweather v. Moore*, *supra*; *Reuter's Telegram Co. v. Byron*, 43 L. J. Ch. 661 (1874), Jessel, M.R.; *Robb v. Green*, p. 572, note (3), was decided on

the ground that there is an implied contract to keep good faith on the part of a servant.

<sup>3</sup> Page 571, notes (2) and (3).

<sup>4</sup> *Exchange Telegraph Co. v. Gregory*, [1896] 1 Q. B. 147, C. A.

<sup>5</sup> *Exchange Telegraph Co. v. Central News*, [1897] 2 Ch. 48, Stirling, J.

articles in question, hold the patents as against the corporation, and he was declared to be a trustee for them of the two patents.<sup>1</sup>

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

*Reuter's Co. v. Byron.*

The mere fact that the defendant obtained information as and while he was the agent of the plaintiff, is not a sufficient ground for restraining him from using it, provided there is nothing of a secret character in the information itself, or confidential or surreptitious in the manner in which it was communicated or obtained, so that a contract not to communicate or use it can be implied. "The plaintiffs here do not seek to restrain the defendant from publishing anything," Jessel, M.R., said, in *Reuter's Telegram Co. v. Byron*,<sup>2</sup> "but from making use of knowledge acquired while the relation of principal and agent subsisted, after that relation had terminated. Now I am not aware of any authority in which this has been done in the absence of a contract, expressed or implied." And he added, "the jurisdiction of the Court cannot be stretched on an interlocutory application. I do not mean to say it cannot be done at all." The circumstances of the case just cited were, that the plaintiffs had invented a large number of telegraphic cyphers indicating the names of their customers, which were communicated to the defendant while he was the plaintiffs' agent, and after he had left their employment, and started a rival business, he sent circulars to the customers, stating that he had their cyphers, and soliciting their custom. It was said that the defendant had committed no breach of confidence with regard to the cyphers, because these were known to the customers, and could have been obtained by the defendant from such of them as chose to do business through him. It may be doubted whether the importance of having access to the large number of cyphers invented or collected by the plaintiffs was fully appreciated in this case, and whether the decision is consistent with the reasoning accepted in the later cases of *Lamb v. Erans*, and *Merryweather v. Moore*, cited above.<sup>3</sup> It was, however, as appears from the judgment of the learned Master of the Rolls, a decision on an interlocutory application only. The principle stated in the judgment, and quoted above, is undoubtedly sound, whatever may be thought of its application to the facts of the case.

<sup>1</sup> *Worthington Pumping Engine Co. v. Moore*, 20 R. P. C. 41 (1902). A claim as to a third patent was dropped. See also *Richmond & Co., Ltd. v. Wrightson*, 22 R. P. C. 25 (1905),

*Buckley, J., and Edisonia, Ltd. v. Forse*, 25 R. P. C. 546 (1908), Warrington, J.

<sup>2</sup> See n. (2), ante, p. 573.

<sup>3</sup> Page 572, notes (4), (5).

Following the ordinary rule in regard to injunctions, no injunction to restrain the communication of a secret will be granted unless by reason of a threat or otherwise the Court is satisfied that there is a danger of the communication being made.<sup>1</sup>

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

Section 15 of the Patents and Designs Act, 1907, contains provisions protecting a true and first inventor against applications for patents in fraud of his rights and from the consequences of use or publication subsequent to a fraudulent application during the period of provisional protection.

<sup>1</sup> *Morison v. Moat*, 20 L. J. Ch. p 529.

## CHAPTER XX.

### REGISTRATION OF FOREIGN AND COLONIAL TRADE MARKS.

BEFORE the introduction of the Register of trade marks a foreigner, not being an alien enemy, was allowed to sue for the infringement of his trade mark in the English Courts,<sup>1</sup> provided that the trade mark had become his trade mark in England by user, or to prevent or obtain damages for the passing off the goods of others as his goods, in the same way and on the same terms as an English subject. And many treaties existed by which this country agreed to give to the subjects of other countries the same right of protection, in respect of their trade marks, as it gave to its own subjects.<sup>2</sup> The prohibition contained in sec. 42 of the present Act, and the corresponding sections of the Acts of 1883 and 1875, restraining actions in respect of the infringement of unregistered trade marks,<sup>3</sup> however, apply to the trade marks of foreigners,<sup>4</sup> and therefore actions for infringement could not, since 1875 (in general),<sup>5</sup> be brought by a foreigner without his trade mark being registered in England; actions for passing-off, to which the prohibitory sections of the former or the present Acts do not apply,<sup>5</sup> remaining as before.

A foreigner, or any resident in a British possession, may apply for and obtain registration under sec. 12; but if he does not reside or carry on business in the United Kingdom at the time of making the application, he must, if so required, give an address for service in the United Kingdom;<sup>6</sup> and under sec. 91 of the Patents and Designs Act, 1907, replacing secs. 103 and 104 of the Act of

<sup>1</sup> *The Collins Co. v. Reeves*, 28 L. J. Ch. 56 (1858), Stuart, V.-C.

<sup>2</sup> See a paper presented to Parliament, 1872, C. 633. For later instances of similar treaties, see the Convention between Great Britain and Guatemala, July 20, 1898 (1899, C. 9504), which withdrew from the International Convention during 1895, and the Convention between Great Britain and Luxemburg,

Jan. 25, 1900 (1900, C. 31).

<sup>3</sup> For the precise effect of the section, see its terms, and Chap. XII., p. 334.

<sup>4</sup> *Goodfellow v. Prince*, 35 C. D. 9 (1887). C. A.; decided under the Act of 1883, sec. 77, see above, pp. 337, 344.

<sup>5</sup> Sect. 45.

<sup>6</sup> Rule 9, corresponding to Act of 1888, s. 8.

1883,<sup>1</sup> further provisions are made in his favour if he is a subject of a State in respect of which, or a British subject resident in a British possession to which the provisions of the section have been, by Order in Council, declared to be applicable.

Section 91, so far as it relates to trade marks,<sup>2</sup> provides that—

“(1.) If His Majesty is pleased to make any arrangement with the government of any foreign state for mutual protection of trade marks, then any person who has applied for protection for any trade mark in that state, shall be entitled to registration of his trade mark under the Trade Marks Act, 1905, in priority to other applicants; and the registration shall have the same date as the date of the application in the foreign state.

International  
and colonial  
arrangements.

Provided that—(a) the application is made, in the case of a trade mark, within four months from the application for protection in the foreign state; and

(b) Nothing in this section shall entitle the proprietor of the trade mark to recover damages for infringements happening prior to the actual date on which his trade mark is registered in this country.<sup>3</sup>

(2.) The registration of . . . a trade mark shall not be invalidated (c) . . . in the case of a trade mark, by reason only of the use of the trade mark in the United Kingdom or the Isle of Man during the period specified in this section as that within which the application may be made.

(3.) The application for the registration of a trade mark under this section must be made in the same manner as an ordinary application under the Trade Marks Act, 1905:<sup>4</sup> Provided that (b), in the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under the Trade Marks Act, 1905.<sup>5</sup>

(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which His

<sup>1</sup> Sec. 65 of the Trade Marks Act of 1905 made those sections applicable to trade marks registrable under the Act of 1905. And see p. 578, note (3).

<sup>2</sup> The words referring only to patents or designs are here omitted.

<sup>3</sup> The ordinary rule is, that where trade mark rights exist, damages for infringements before the registration

may be recovered: *Barlow v. Johnson*, 7 R. P. C., p. 411 (1890), Chitty, J., ante, p. 337. Cf. with this sub-section the International Copyright Act. See *Moul v. Groenings*, [1891] 2 Q. B. 443; and *Schaer v. Field*, [1893] 1 Ch. 35; *Sarpy v. Holland*, [1908] 1 Ch. 443.

<sup>4</sup> Sec. 12, Chap. IV., p. 78.

<sup>5</sup> See p. 583.

Majesty by Order in Council declares them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state.<sup>1</sup>

(5.) Where it is made to appear to His Majesty that the legislature of any British possession has made satisfactory provision for the protection of (inventions, designs, and) trade marks, (patented or<sup>2</sup>) registered in this country, it shall be lawful for His Majesty, by Order in Council, to apply the provisions of this section to that possession with such variations or additions, if any, as may be stated in the Order."

Section 88 of the same Act provides that "An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but may be revoked or varied by a subsequent order."<sup>1</sup>

The provisions of sec. 103 and 104 of the Act of 1883, as amended by sec. 6 of the Act of 1888 were to the like effect, although the wording and arrangement have been altered in the later sections.<sup>3</sup>

The Inter-  
national  
Convention.

At the time when the section of the Act of 1883 was passed into law, the International Convention for the Protection of Industrial Property, as it was originally settled at Paris, had been drawn up and agreed to by several of the countries which are parties to it, and in the following year<sup>4</sup> this country acceded to the Convention. Practically all civilised States, except Austria and Russia, have now acceded to the original Convention.<sup>5</sup>

International  
registration of  
trade marks.

At a subsequent conference at Madrid, in 1891, besides an agreement to endow the International Bureau at Berne, two Conventions were signed by most of the States of the Union. Of these, one, which was signed by Great Britain,<sup>6</sup> related to false indications of origin; the other, signed by Belgium, Brazil, France, Italy, the Netherlands, Portugal, Spain, Switzerland, and Tunis, but not by Great Britain, established a system for the international registration of trade marks.<sup>7</sup> The principles of

<sup>1</sup> For list of States and Possessions to which the section applies see Appendix, p. 741.

<sup>2</sup> The brackets are not part of the Act: see note (2), above, p. 577.

<sup>3</sup> Section 98 of the Act of 1907, which repeals the Acts of 1883 and 1888, provides that the repeal shall not affect any convention or Order in Council having effect under any enactment so repealed,

but any such convention or Order in Council in force at the commencement of the Act shall continue in force, and may be repealed, altered or amended, as if it had been made under that Act.

<sup>4</sup> March 20th, 1883.

<sup>5</sup> Germany adhered to it in 1903.

<sup>6</sup> See post, p. 749.

<sup>7</sup> The text of this arrangement will be found in the Appendix, p. 751.

this system are admirably explained by M. Frey-Godet, Secretary to the International Bureau at Berne, in a paper read by him before the London Congress of the International Association for the Protection of Industrial Property, in 1898.<sup>1</sup> "The proprietor of the trade mark makes an application for international registration to the Government of his native country, which then forwards his request to the International Office at Berne. The latter registers the trade mark, and notifies this registration to all the States which have become parties to the Arrangement of Madrid, and afterwards publishes a description of the trade mark, with all the data in connection with it, in a publication entitled *Les Marques Internationales*, which forms an appendix to *La Propriété Industrielle*, the official organ of the Office.

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

"The effect of international registration lasts for twenty years; but it can only be invoked so long as the trade mark remains protected in the country of origin. Nevertheless, if a trade mark has been temporarily deprived of protection in that country owing to delay in renewing the application, it is sufficient to make a fresh application in order again to set in operation the international protection which had remained in abeyance. This is, then, only an expansion of the protection which the trade mark enjoys in the country of origin. Consequently every modification relating to the property of an international trade mark (annulment, erasure, renunciation, transfer, &c.) must be notified by the national Government to the International Office, which makes a memorandum of this and forwards the information to the various contract States.

"Whoever wishes to effect the international registration of a trade mark must pay a fee of 100 francs, which goes to the

<sup>1</sup> Trans. Inter. Assoc. for the Protection of Ind. Prop., Vol. II. (1898), p. 102.

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

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

Obstacles to  
Great  
Britain's  
accession.

The objection of Great Britain to accede to this arrangement is based on several grounds with which M. Frey-Godet deals in succession. It does not appear that the point has ever been taken on behalf of this country that international registration, by diminishing the number of national applications for registration of foreign trade marks, would at the same time reduce the registration fees collected by the British Government. But if such an argument were advanced, M. Frey-Godet's answer is twofold. In the first place, Great Britain would not grudge the expenditure of a few thousand francs in order to be assured of a valuable advantage to her commerce. In the second place, it is by no means certain that the fee collected by Great Britain on international applications effected by British subjects, added to that derived from the surplus receipts of the service of registration, would not make up for the diminution in the number of ordinary registrations. A second objection, and one which has greater weight, may be put in this way : British trade mark law is based on a registration effected by a national government. To a system of this kind it is impossible to assimilate one of registration carried out in a foreign country. M. Frey-Godet's answer is that our internal legislation by which copyright is only granted to literary works if they have been entered at Stationers' Hall, does not apply to works produced in the countries forming part of the Literary and Artistic Union. It may be noted in passing, that Article V. of the Madrid Arrangement preserves



the right of the contracting States to reject any trade mark presented for registration under the international scheme to which it could object if an application were made for its registration in the ordinary course. The Patent Office would, therefore, be free to examine trade marks for which international registration was desired, and to reject those which were inadmissible on the ground of internal legislation. Our internal legislation, however, gives rise to several difficulties of its own. Under sec. 15 of the Act of 1905 an applicant may be required to make a disclaimer for the purpose of defining his rights under the registration. This difficulty, however, is now less than it was under sec. 64, sub-sec. (2) of the Act of 1883, which required every applicant in his application for registration to indicate the essential elements of his trade mark, and to disclaim what is non-essential. Disclaimers are now the exception and not the rule. Again, sec. 8 of the Act of 1905<sup>1</sup> provides that "a trade mark must be registered in respect of particular goods or classes of goods"; and in this country trade marks must be published in the official journal of the Patent Office. How are these provisions to be severally adjusted to the system of international registration? As regards disclaimers, M. Frey-Godet's suggestion was that the applicant might be required expressly to disclaim the non-essential parts of his trade mark before embarking on a law suit. A similar procedure is, no doubt, in force in this country in regard to patents. But this solution of the problem does not deal with the inconvenience that would be caused to applicants for national (or even international) registration by the uncertainty as to what were the essential parts of marks already on the Register of Trade Marks.<sup>2</sup> The difficulty as to publication might be met, as M. Frey-Godet points out, by the annexation to the national publication of a trade mark either of the publication of the Berne Office or, preferably, of an authenticated translation of it.

The text of the International Convention of Paris to which, as already stated, this country is a party, and a list of the countries and British possessions to which the above sections have been made applicable by Orders in Council, are set out in the Appendix.<sup>3</sup>

The International Convention.

The Convention and the accession thereto of this country may

<sup>1</sup> Corresponding to sec. 65 of the Act of 1883.

extent as to trade marks registered under the Act of 1905.

<sup>2</sup> The uncertainty exists to some

<sup>3</sup> Pages 741, 743.

be referred to by the Court as a matter of history, in order to enable it to understand under what circumstances the sections of the Act were passed;<sup>1</sup> but the terms of the Convention cannot be employed as a guide to interpret the sections,<sup>2</sup> for a treaty with a foreign State binds the subjects of the Crown only in so far as it has been embodied in legislation passed into law in the ordinary way.<sup>3</sup>

Foreign  
trade mark  
may be refused  
registration.

The provisions of the section, in fact, do not carry out the international agreements constituted by the Convention, for, by Art. VI. of the Convention, it is agreed that "every trade mark duly registered in the country of origin shall be admitted for registration, and protected in the forms originally registered in all other countries of the Union"<sup>4</sup>; and by clause 4 of the final protocol, it is explained that this article "is to be understood as meaning that no trade mark shall be excluded from protection in any State of the Union, from the fact alone that it does not satisfy, in regard to the signs composing it, the conditions of the legislation of the State, provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in the said country of origin"; but it was, nevertheless, decided under the Act of 1883 that, in order to be qualified for registration, a mark tendered under sec. 103, just as any other mark sought to be registered, must fall within the descriptions of sec. 64 of that Act. So that the words *Syrup of Figs*,<sup>5</sup> and the words *Carter's Little Liver Pills*,<sup>1</sup> were refused registration as trade marks, although registration of them respectively had been duly applied for and actually obtained in the United States, one of the States to which sec. 103 had been applied. No alteration in this respect is made by the Act of 1905, although that Act enlarges the classes of registrable trade marks.

The effect of the decisions just referred to is to reduce the operation of the Convention, in regard to trade marks<sup>6</sup> in this country, to very narrow limits. As between applicants for the

<sup>1</sup> *Carter Medicine Co.'s Tm.*, [1892] 3 Ch. 472; 9 R. P. C. 401, North, J.

<sup>2</sup> *Californian Fig Syrup Co.'s Tm.*, 40 C. D. 620; 6 R. P. C. 126 (1888), Stirling, J.

<sup>3</sup> See last case, and *Waiker v. Baird*, [1892] A. C. 491.

<sup>4</sup> *I.e.*, the union of the contracting States for the protection of industrial property.

<sup>5</sup> *Californian Fig Syrup Co.'s Tm.*, 40 C. D. 620; 6 R. P. C. 126 (1888), Stirling, J.

<sup>6</sup> Another part of the convention, relating to false marking and false trade description and the seizure on importation of falsely marked goods, has been carried into effect by the Merchandise Marks Act, see p. 811, below.

registration of new marks, or marks acquired as trade marks since the application for protection in a foreign State within the Union, the applicant in the foreign State is to have priority, provided that he makes his application in this country within four months from the date of the foreign application on which he relies. And this priority is not affected by the success or failure of the foreign application.

The proviso that use of the trade mark in this country during the period of four months shall not invalidate the registration, is surplusage, if it is directed to use by the applicant himself, as it seems intended to be, for the publication or use of a mark by the applicant before registration in no case prejudices a right to registration. The proviso might have some useful meaning and operation, if it were construed to prevent an opponent, who had first used the trade mark in question in this country after the application in a foreign State by the applicant for registration, from relying on his use of the mark, or the title acquired by him in consequence of that use, as an objection to the registration of the applicant.<sup>1</sup> But so long as the Convention is not embodied in legislation, as already stated, it can have no operation upon the right to registration at all. It might, however, it is submitted, properly affect the Registrar's discretion.

Publication of  
foreign  
trade mark.

The last clause of sub-sec. (3), providing that "any trade mark the registration of which has been duly applied for in the country of origin may be registered under this Act," does not give an independent or new right of registration under the Act,<sup>2</sup> and it seems to bear no other construction than that suggested on behalf of the Comptroller in *The Carter Medicine Co. case*,<sup>2</sup> namely, that "may be registered" is to be read as "may be the subject of application for registration," although this construction reduces it also to surplusage.

The application of the sections to any foreign State can, under no circumstances, afford any answer to a motion under sec. 35 to remove from the Register a mark which was originally registered without sufficient cause.<sup>3</sup>

<sup>1</sup> The first user might acquire a right under the proviso to sec. 41, see above, p. 331.

<sup>2</sup> *Californian Fig Syrup Co.'s Tm.*, and *Carter Medicine Co.'s Tm.*, supra. In *Vidal's Patent*, 15 R. P. C. 721 (1898), Sir R. Webster, A.-G., said:—"I am clearly of opinion that, when a person

claims under those articles, he cannot claim greater privileges than a national applicant, and that he is liable to the same restrictions as a subject or citizen of the country in which he is making the application."

<sup>3</sup> *Vignier's Tm.*, 6 R. P. C. 490 (1889), Kay, J. (*Monobrut Champagne*).

## CHAPTER XXI.

### MISCELLANEOUS MATTERS.

#### *False Representation as to Registration of Trade Mark.*

Penalty on  
falsely repre-  
senting a  
trade mark as  
registered.

By sec. 67 of the Trade Marks Act, 1905:—

“(1.) Any person who represents a trade mark as registered which is not so, shall be liable for every offence on summary conviction<sup>1</sup> to a fine not exceeding five pounds.

(2.) A person shall be deemed, for the purposes of this enactment, 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 offences here dealt with are applications of false trade descriptions,<sup>3</sup> but the liability to punishment under the M. M. A. would afford no answer to a prosecution under the above section.<sup>4</sup>

And an infringement of the section is not necessarily a bar to an application for the registration of the trade mark which has been wrongly described as registered.<sup>5</sup> The use of the word “Registered” has been held to indicate registration in the United Kingdom.<sup>6</sup>

#### *False Representation as to Patent or Design.*

By sub-sec. (2) of sec. 89 of the Patents and Designs Act 1907, it is an offence for any person falsely to represent that any

<sup>1</sup> As to the Isle of Man, see sec. 70 ; and as to Scotland, sec. 72.

<sup>2</sup> This corresponds to and substantially re-enacts, so far as relates to trade marks, sec. 105 of the Patents, &c. Act, 1883.

<sup>3</sup> See M. M. A. 1887, s. 3 (n), Appendix, p. 807.

<sup>4</sup> M. M. A. s. 19 (1), Appendix, p. 812.

<sup>5</sup> *James' Tm.*, 33 C. D. 392 ; 3 R. P. C. 340 (1886), C. A. ; “registered shape” ; and *Altman's Application*, 21 R. P. C. 753 (1904), Kekewich, J., and *Lyle and Kinahan's Application*, 24 R. P. C. 37 and 249 (1907), Kekewich, J., and C. A.,

in both of which cases the use of the word “registered” before registration was proved to have been by a *bonâ fide* mistake ; see also above, pp. 72, 437.

<sup>6</sup> *Wright, Crossley & Co. v. William Dobbin & Co.*, 15 R. P. C. 21 (1898), in Ireland. *MacSymons' Stores, Ltd. v. Shuttleworth*, 15 R. P. C. 748 (1898), in England. The use of the words “Trade Mark,” in relation to an unregistered trade mark, is not necessarily an offence under the section : *Sen Sen Co. v. Britten*, [1899] 1 Ch. 692 ; 16 R. P. C. 137.

article sold by him is a patented article, or falsely to describe any design applied to any article sold by him as registered; and by sub-sec. (3), if any person sells an article having stamped, engraved, or impressed thereon, or otherwise applied thereto, the word "patent," "patented," or "registered," or any other word expressing or implying that the article is patented or that the design applied thereto is registered, he shall be deemed for the purposes of the section to represent that the article is a patented article or that the design applied thereto is a registered design.<sup>1</sup> The introduction in sub-sec. (2) of the word "falsely" probably prevents the sub-section applying to a case in which no patent has ever existed but the word "patent" has become part of the trade name of the goods and has been used by the manufacturer in his description of them.<sup>2</sup> It also saves the use of such ordinary names of commerce as "patent leather" and "patent medicine."<sup>3</sup> It is submitted that a limitation must be placed upon the literal meaning of the enactment which will exclude these cases from the section.<sup>4</sup>

#### *Falsification of the Register of Trade Marks.*

By sec. 66 of the above-mentioned Act of 1905:—

"If any person makes or causes to be made a false entry in the Register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such Register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor."<sup>5</sup>

Falsification of entries in Register.

#### *False Representation as to Royal Warrant.*

By sec. 20 of the M. M. A. of 1887:—

"Any person who falsely represents that any goods are made

False representation as to Royal warrant.

<sup>1</sup> These provisions replace sec. 105 of the Act of 1883, which section was not qualified by the word "falsely."

<sup>2</sup> *Edelsten v. Vick*, 11 Hare, 78 (1858), Wood, V.-C. (*Taylor & Co.'s Patent Solid-headed Pins*); see further, Chap. XV., p. 401; *Gridley v. Swinborne*, 52 J. P. 739, 791; 5 T. L. R. 71 (1888), Div. Court, *Swinborne's Patent Refined Isinglass*, held not to be a false trade description.

<sup>3</sup> See above, p. 431.

<sup>4</sup> Application for a patent, or provisional protection, does not authorise the use of the word patent; but, it is submitted, the acceptance of the complete specification of a patent does. See *R. v. Townsend*, 13 R. P. C. 265 (1896). Cf. *Grueber's case*, Times, Nov. 22, 1894.

<sup>5</sup> Replacing, as to the Trade Mark Register, sec. 93 of the Patents, &c. Act, 1883. As to the Registers of Patents and Designs, see now sec. 89 (1) of the Patents and Designs Act, 1907.

by a person holding a Royal warrant, or for the service of Her Majesty, or any of the Royal Family, or any Government department, shall be liable, on summary conviction,<sup>1</sup> to a penalty not exceeding £20."

*Unauthorised Assumption of Royal Arms.*

By sec. 90 of the Patents and Designs Act of 1907 :—

"(1.) The grant of a patent under this Act shall not be deemed to authorise the patentee to use the Royal Arms or to place the Royal Arms on any patented article.

Unauthorised  
assumption of  
Royal Arms.

(2.) If any person, without the authority of His Majesty, uses in connection with any business, trade, calling, or profession, the Royal Arms (or arms so nearly resembling them as to be calculated to deceive) in such a manner as to be calculated to lead to the belief that he is duly authorised to use the Royal Arms, he shall be liable on conviction, under the Summary Jurisdiction Acts,<sup>2</sup> to a fine not exceeding £20.

Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing such arms to continue to use such trade mark."

Sub-sec. (1) is new. Sub-sec. (2) corresponds to sec. 106 of the Patents, &c. Act, 1883, but it requires the authority to be that of His Majesty, omitting the former words "or of any of the Royal Family, or of any Government department." Its provisions are now supplemented by those of sec. 68 of the Trade Marks Act, 1905, which were introduced into that Act at the suggestion of the Association of Royal Warrant Holders. The section is as follows :—

"If any person, without the authority of His Majesty, uses in connection with any trade, business, calling, or profession, the Royal Arms (or arms so closely resembling the same as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised so to use the Royal Arms, or if any person without the authority of His Majesty or of a member of the Royal Family, uses in connection with any trade, business, calling, or profession, any device, emblem, or title in such manner as to be calculated to lead to the belief that he is

<sup>1</sup> In Scotland, in the Sheriff Court (sec. 21); and in the Dublin police district, the Courts of the justices under the Petty Sessions Act, 1851 (sec. 22).

<sup>2</sup> As to the Isle of Man, see sec. 96, and as to Scotland, see sec. 94 of the same Act.

employed by or supplies goods to His Majesty or such member of the Royal Family he may, at the suit of any person who is authorised to use such arms or such device, emblem, or title, or is authorised by the Lord Chamberlain to take proceedings in that behalf, be restrained by injunction or interdict from continuing so to use the same: Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing any such arms, device, emblem, or title to continue to use such trade mark."

This section adds to the remedy by summary prosecution now provided by sec. 90 of the Patents and Designs Act, 1907, a civil remedy by injunction applicable not only to the misuse of the Royal Arms, but also to the use of any device, emblem, or title in such manner as to be calculated to lead to the belief that the person using the same is employed by, or supplies goods to, His Majesty, or a member of the Royal Family. The class of persons who may institute proceedings under the section without the authority of the Lord Chamberlain will, in some instances, *e.g.*, the use of the Royal Arms, be a rather wide one. It will be in the discretion of the Court to refuse relief if the plaintiff is not likely to be in any way damnified.<sup>1</sup>

With regard to the proviso, it may be noticed that, except in the case of marks used before August 13th, 1875, the Registrar is not to register (1) the Royal Arms or crests, or arms or crests so nearly resembling them as to lead to mistake, (2) representations of any member of the Royal Family, (3) representations of British Royal Crowns, (4) the British national flags, (5) the word Royal, (6) any other words, letters or devices calculated to lead persons to think that the applicant has Royal patronage or authorisation.<sup>2</sup>

In a prosecution under sec. 106 of the Patents, &c. Act, 1883, the defendant unsuccessfully contended that he was entitled to use the Royal Arms as he held a patent for an invention which he was using in his business, and the Patent Office was a Government department.<sup>3</sup> A defence in another case that the defendants were contractors to Government departments, also failed.<sup>4</sup>

<sup>1</sup> An injunction was granted by consent under the section in *Royal Warrant Holders' Association v. Slade & Co., Ltd.*, 25 R. P. C. 245 (1908).

<sup>2</sup> Rules 11 and 12, p. 657.

<sup>3</sup> *Webber & Co.'s case*, Times, February 2, 1897.

<sup>4</sup> *Wood's case*, Times, May 14th, 1903.

*Cutlery Marks.*

The Cutlers'  
Marks Act,  
1819.

By the Act 59 Geo. 3, c. 7, it is forbidden to mark cutlery and the other goods mentioned in the Act with the figure of a hammer, unless the goods have been wrought or forged, or to place false marks of quality upon such goods, or to falsely mark them as London made; and the offences created by the Act extend to selling, or having in possession for the purposes of sale, such goods marked in breach of the Act. The material provisions of the Act<sup>1</sup> may be summarised as follows:—

Hammer  
marks.

1. Where any knives, knife-blades, forks, razors, razor-blades, scissors, shears, and other articles of cutlery, edge tools and hardware requiring a cutting edge, of wrought steel, or of iron and steel, are made by means of the hammer, the maker may mark the figure of a hammer upon them before they are ground.

3. No one may mark such figure on any of the goods enumerated not so made, before the *bonâ fide* sale of the goods to the user, or have in his possession for the purpose of sale, or sell any such goods not so made, and being marked with such figure, under penalty of forfeiture of the goods and a fine of £5 for every dozen.

Quality  
marks.

4. No one may mark on any of the goods enumerated, whether made with the hammer or cast in a mould, before the *bonâ fide* sale of the same to the user, "any word or words which shall or may denote or indicate the quality of such articles to be otherwise than the real and true quality thereof," or have in his possession for the purpose of sale, or sell any such goods so marked, under penalties as aforesaid.

London  
made.

5. No one may mark on any of the goods enumerated whether made with the hammer or cast in a mould, before the *bonâ fide* sale of the same to the user, the word or words *London* or *London made*, or any word or words having any similitude thereto, unless the goods were made in the City of London, or within twenty miles distance therefrom, or have in his possession, &c., or sell (as before) under a penalty of forfeiture and fine of £10 a dozen articles.

Innocent  
purchasers.

7. Any one having in his possession for the purposes of sale, or selling any of the goods aforesaid contrary to the Act, who shall, before information or complaint laid against him, prove

<sup>1</sup> Sec. 17 has been repealed by the Stat. Law Rev. Act, 1873, and sect. 2 by the Stat. Law Rev. Act, 1874, secs. 8-10

in part, and secs. 11-13 and 15 wholly, repealed by 47 & 48 Vict. c. 43, s. 4.



satisfactorily by oath before one or more justice or justices that he purchased the goods with the marks thereon without knowing they were marked contrary to the Act, and shall discover to two or more justices the name of the person from whom he bought, so that the latter shall be prosecuted to conviction, shall not be liable to penalties himself,<sup>1</sup> but shall be entitled to two-thirds of the penalty recovered from his vendor, as any other informer.

The Cutlers' Co. Act of 1814 contains a provision inflicting penalties upon any person who counterfeits or imitates assigned corporate marks; and by sec. 81 (13) of the Patents, &c. Act of 1883, this provision was extended to any mark entered in the Sheffield Register,<sup>2</sup> but the Trade Marks Act of 1905 contains no such provision, no doubt because it was considered that sufficient protection is now given by the Merchandise Marks Act, 1887. The section of the first-mentioned Act is as follows<sup>3</sup> :—

Counterfeit-  
ing Sheffield  
corporate  
marks.

“ If any member or members of the Cutlers' Company, or any other person or persons using, exercising, or carrying on any of such arts or trades as aforesaid within the said lordship or liberty, or six miles compass of the same, shall at any time after the passing of this Act strike, engrave, impress or use, or cause or procure to be stricken, engraved, impressed or used upon his or their goods, wares, or manufactures, any mark, device, stamp, or impression, with intent to counterfeit or imitate any mark or device assigned, or which may hereafter be assigned, by the said master, wardens or searchers and assistants of the said company, to be used by any other person, the person or persons so offending shall, for every such offence, forfeit and pay (in lieu of the penalty imposed by the said last recited Act)<sup>4</sup> any sum not exceeding £20, one moiety whereof shall be paid to the person whose mark shall have been so counterfeited or imitated, and the other moiety to the said master and wardens of the said company; and the provisions in the said last recited Act<sup>4</sup> contained for the recovery and application of the penalty thereby imposed shall be used, applied, and put in force for the recovery and application of the penalty hereby made payable, as fully and effectually as if the same provisions were in this Act severally and separately repeated and re-enacted.”

<sup>1</sup> Cf. M. M. A. sec. 2 (2), “ unless he proves,” p. 806.

<sup>3</sup> 54 Geo. 3, c. 119, s. 5 (local).

<sup>4</sup> The Cutlers' Co. Act of 1791, see above, p. 113.

<sup>2</sup> Above, p. 626.

The sections of the Cutlers' Co. Act of 1791,<sup>1</sup> which are referred to and incorporated by the last-mentioned section, provide (sec. 26) that the penalties may be sued for by the company, or (sec. 27) recovered summarily before a justice or justices of the West Riding of York, or of the county of Derby, who shall have power to award costs, and to issue a distress warrant, or, if the goods of the offender are insufficient, to commit him to the House of Correction for one month to enforce payment of the penalty. Section 28 contains a form of conviction, and sec. 29 gives an appeal to quarter sessions.

Statutes  
relating to  
particular  
goods.

A number of statutes of little general importance, requiring special marks to be placed upon particular classes of goods, are summarised in the Appendix, p. 816.

<sup>1</sup> 31 Geo. 3. c. 58 (local).

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# APPENDIX I.

## TRADE MARKS ACT, 1905.

[5 EDW. VII. CHAP. 15.]

TABLE SHOWING THE ARRANGEMENT OF SECTIONS WITH THE  
CORRESPONDING SECTIONS OF THE ACT OF 1883, AS AMENDED  
BY THE ACT OF 1888.

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<i>Definitions.</i>	
3. Definitions . . . . .	New. The Court, 117 (1).
<i>Register of Trade Marks.</i>	
4. Register of trade marks . . . . .	§ 78, § 82 (3), is not repealed by the Act of 1905. <sup>1</sup>
5. Trust not to be entered on register . . . . .	§ 85.
6. Incorporation of existing register . . . . .	§ 114 and cf. § 113; last para. new.
7. Inspection of and extract from register . . . . .	§ 88.
<i>Registrable Trade Marks.</i>	
8. Trade mark must be for particular goods . . . . .	§ 65.
9. Registrable trade marks . . . . .	§ 64; last two paras new.
10. Coloured trade marks . . . . .	New, cf. § 67.
11. Restriction on registration . . . . .	§§ 73, 86.
<i>Registration of Trade Marks.</i>	
12. Application for registration . . . . .	§ 62, (5), new; (6), § 91 (a), (d).
13. Advertisement of application . . . . .	§ 68.
14. Opposition to registration . . . . .	§ 69, costs, new, cf. § 69 (5).
15. Disclaimers . . . . .	§§ 64 (2), (3), 74 (2); end new.
16. Date of registration . . . . .	§ 75.
17. Certificate of registration . . . . .	New, cf. § 88.
18. Non-completion of registration . . . . .	§ 63.

<sup>1</sup> Sec. 82 is repealed by the Patents and Designs Act, 1907, and is replaced by sec. 62 of that Act.

*Identical Trade Marks.*

Section.		Corresponding Sections of Acts of 1889-8.
19.	Identical marks . . . . .	§ 72.
20.	Rival claims to identical marks . . . . .	§ 71.
21.	Concurrent user . . . . .	New, cf. § 72 (1).

*Assignment.*

22.	Assignment and transmission of trade marks . . . . .	§ 70; end new.
23.	Apportionment of marks on dissolution of partnership . . . . .	New.

*Associated Trade Marks.*

24.	Associated trade marks . . . . .	New.
25.	Combined trade marks . . . . .	New.
26.	Series of trade marks . . . . .	§ 66.
27.	Assignment and user of associated trade marks . . . . .	New. § 66.

*Renewal of Registration.*

28.	Duration of registration . . . . .	§ 79.
29.	Renewal of registration . . . . .	§ 79.
30.	Procedure on expiry of period of registration . . . . .	§ 79.
31.	Status of unrenewed trade mark . . . . .	§ 79 (5).

*Correction and Rectification of the Register.*

32.	Correction of register . . . . .	§ 91 (b) (c); end new.
33.	Registration of assignments, &c. . . . .	§ 87, end new, cf. § 90.
34.	Alteration of registered trade mark . . . . .	§ 92.
35.	Rectification of register . . . . .	§ 90, part new.
36.	Trade marks registered under previous Acts . . . . .	New.
37.	Non-user of trade mark . . . . .	New, cf. § 90.

*Effect of Registration.*

38.	Powers of registered proprietor . . . . .	§ 87.
39.	Rights of proprietor of trade mark . . . . .	§ 76; end new.
40.	Registration to be <i>prima facie</i> evidence of validity . . . . .	§ 76.
41.	Registration to be conclusive after seven years . . . . .	§ 76; proviso new.
42.	Unregistered trade mark . . . . .	§ 77.
43.	Infringement . . . . .	New.
44.	User of name, address, or description of goods . . . . .	New, cf. § 64.
45.	"Passing-off" action . . . . .	New.

*Legal Proceedings.*

46.	Certificate of validity . . . . .	§ 77 (a).
47.	Registrar to have notice of proceeding for rectification . . . . .	New, cf. old rule, 49.

*Costs.*

48.	Costs of proceedings before the Court . . . . .	New
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*Evidence.*

49.	Modes of giving evidence . . . . .	New.
50.	Sealed copies to be evidence . . . . .	§§ 84, 89.
51.	Certificate of Registrar to be evidence . . . . .	§ 101.
52.	Certificate of Board of Trade to be evidence . . . . .	§ 102a.

## APPENDIX I.

## PART II.

*Powers and Duties of Registrar of Trade Marks.*

Section.		Corresponding Sections of Acts of 1883-8.
53.	Exercise of discretionary power by Registrar . . . . .	§ 94.
54.	Appeal from Registrar . . . . .	New.
55.	Recognition of agents . . . . .	Old rule 9.
56.	Registrar may take directions of law officers . . . . .	§ 95.
57.	Annual reports from Comptroller . . . . .	§ 102.

*Powers and Duties of the Board of Trade.*

58.	Proceedings before Board of Trade . . . . .	§ 102a (1).
59.	Appeals to Board of Trade . . . . .	Cf. §§ 62 (5), 69 (4).
60.	Power of Board of Trade to make rules . . . . .	§ 101.

*Fees.*

61.	Fees . . . . .	§ 80.
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*Special Trade Marks.*

62.	Standardisation, &c., trade marks . . . . .	New.
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*Sheffield Marks.*

63.	Sheffield marks . . . . .	§ 81.
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*Cotton Marks.*

64.	Cotton marks . . . . .	New, cf. old rules, 8, 13.
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*International and Colonial Arrangements.*

65.	International and Colonial arrangements . . . . .	§§ 103, 104, not repealed by Act of 1905. <sup>1</sup>
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*Offences.*

66.	Falsification of entries in register . . . . .	§ 93.
67.	Penalty on falsely representing a trade mark as registered . . . . .	§ 105.

*Royal Arms.*

68.	Unauthorised assumption of Royal Arms . . . . .	§ 106, not repealed by Act of 1905. <sup>2</sup>
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*Courts.*

69.	General saving for jurisdiction of courts . . . . .	§ 111.
70.	Isle of Man . . . . .	§ 112.
71.	Jurisdiction of Lancashire Palatine Court . . . . .	§ 112 (a).
72.	Offences in Scotland . . . . .	§ 108.

*Repeal ; Savings.*

73.	Repeal and saving for rules, &c. . . . .	Cf. § 113, § 27, of 1888.
74.	Application of 46 & 47 Vict. c. 57, ss. 82-84 . . . . .	§§ 82-84. <sup>3</sup>

## SCHEDULE.

<sup>1</sup> Sections 103 and 104 have since been repealed by the Patents and Designs Act, 1907 ; see now sec. 91 of that Act.

<sup>2</sup> Since repealed by the Patents and

Designs Act, 1907 ; see now sec. 90 of that Act.

<sup>3</sup> Since repealed by the Patents and Designs Act, 1907 ; see now sec. 62-64 of that Act.

## APPENDIX II.

### TABLE SHOWING THE CORRESPONDING SECTIONS OF THE PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883, AS AMENDED BY THE ACT OF 1888, WITH THE TRADE MARKS ACT, 1905.

#### PART IV. — TRADE MARKS.

##### *Registration of Trade Marks.*

Sections of the Acts 1883-8 relating to Trade Marks.	Corresponding Sections in Trade Marks Act, 1905.
62. Application for registration . . . . .	§§ 12, 16.
63. Limit of time for proceeding with application . . . . .	§ 18.
64. Conditions of registration of trade mark . . . . .	§ 9 (2), cf. § 15; as to sub-sec. 3 (i), cf. § 44.
65. Connexion of trade mark with goods . . . . .	§ 8.
66. Registration of a series of marks . . . . .	§ 26, also part 27.
67. Trade marks may be registered in any colour . . . . .	Cf. § 10.
68. Advertisement of application . . . . .	§ 13.
69. Opposition to registration . . . . .	§§ 14 (4), 59.
70. Assignment and transmission of trade mark . . . . .	§ 22.
71. Conflicting claims to registration . . . . .	§ 20.
72. Restrictions on registration . . . . .	§§ 19, 20, 21.
73. Further restriction on registration . . . . .	§ 11.
74. Saving for power to provide for entry on Register of common marks as additions to trade marks . . . . .	Cf. § 15.

##### *Effect of Registration.*

75. Registration equivalent to public use . . . . .	Omitted.
76. Right of first proprietor to exclusive use of trade mark . . . . .	§§ 39, 40, 41.
77. Restrictions on actions for infringement, and on defence to action in certain cases . . . . .	§ 42, cf. § 45.
77a. Certificate as to exclusive use and costs thereon . . . . .	§ 46.

##### *Register of Trade Marks.*

78. Register of trade marks . . . . .	§ 4.
79. Removal of trade mark after fourteen years unless fee paid . . . . .	§§ 28-31.

##### *Fees.*

80. Fees for registration, &c. . . . .	§ 61.
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##### *Sheffield Marks.*

81. Registration by Cutler's Company of Sheffield marks . . . . .	§ 63.
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## PART V.—GENERAL.

*Patent Office and Proceedings thereat.*

Sections of the Acts 1883-8 relating to Trade Marks.		Corresponding Sections in Trade Marks Act, 1903.
82.	Patent Office . . . . .	Continued, § 74. <sup>1</sup>
83.	Officers and clerks . . . . .	"
84.	Seal of Patent Office . . . . .	" <sup>2</sup> and § 50.
85.	Trust not to be entered in Registers . . . . .	§ 5.
86.	Refusal to register a trade mark in certain cases . . . . .	§ 11.
87.	Entry of assignments and transmissions in Registers . . . . .	§§ 33, 38.
88.	Inspection of and extracts from Registers . . . . .	§ 7.
89.	Sealed copies to be received in evidence . . . . .	§ 50.
90.	Rectification of Registers by court . . . . .	§ 35.
91.	Power of Comptroller to correct clerical errors . . . . .	§§ 12, 32.
92.	Alteration of registered mark . . . . .	§ 34.
93.	Falsification of entries in Registers . . . . .	§ 66.
94.	Exercise of discretionary power by Comptroller . . . . .	§ 53.
95.	Power of Comptroller to take directions of law officers . . . . .	§ 56.
96.	Certificate of Comptroller to be evidence . . . . .	§ 51.
97.	Applications and notices by post . . . . .	See rule 7.
98.	Provision as to days for leaving documents at office . . . . .	See rule 100.
99.	Declaration by infant, lunatic, &c. . . . .	Omitted.
101.	Power for Board of Trade to make general rules for classifying goods and regulating business of patent office . . . . .	§ 60.
102.	Annual reports of Comptroller . . . . .	§ 57.
102a.	Proceedings of Board of Trade . . . . .	§§ 52, 58.

*International and Colonial Arrangements.*

103.	International arrangements for protection of trade marks . . . . .	Continued by § 65.
104.	Provision for colonies and India . . . . .	" "

*Offences.*

105.	Penalty on falsely representing trade marks to be registered . . . . .	§ 67.
106.	Penalty on unauthorised assumption of Royal arms . . . . .	Not repealed, § 68. <sup>4</sup>

*Scotland ; Ireland ; &c.*

108.	Summary proceedings in Scotland . . . . .	§ 72.
111.	General saving for jurisdiction of courts . . . . .	§ 69.
112.	Isle of Man . . . . .	§ 70.
112a.	Jurisdiction of Lancashire Palatine Court . . . . .	§ 71.

*Repeal ; Transitional Provisions ; Savings.*

113.	Repeal and saving for past operation of repealed enactments, &c. . . . .	Cf. § 6. <sup>5</sup>
114.	Former Registers to be deemed continued . . . . .	§ 6.
115.	Saving for existing rules . . . . .	Cf. § 73.

*General Definitions.*

117.	General definitions . . . . .	Cf. §§ 3, 4.
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<sup>1</sup> Sections 82 and 83 are now replaced by secs. 62 and 63 of the Patents and Designs Act, 1907.

<sup>2</sup> But now replaced by sec. 64 of the Patents and Designs Act, 1907.

<sup>3</sup> Sections 103 and 104 have now been repealed by the Patents and Designs

Act, 1907, and are replaced by sec. 91 of that Act.

<sup>4</sup> Section 106 has now been repealed by the Patents and Designs Act, 1907, and is replaced by sec. 90 of that Act.

<sup>5</sup> And see Interpretation Act, 1889, sec. 38, post, p. 654



## APPENDIX III.

### TRADE MARKS ACT, 1905.

[5 EDW. VII. CHAP. 15.]

#### ARRANGEMENT OF SECTIONS.

Section.

1. Short title.
2. Commencement of Act.

#### PART I.

##### *Definitions.*

3. Definitions.

##### *Register of Trade Marks.*

4. Register of trade marks.
5. Trust not to be entered on register.
6. Incorporation of existing register.
7. Inspection of and extract from register.

##### *Registrable Trade Marks.*

8. Trade mark must be for particular goods.
9. Registrable trade marks.
10. Coloured trade marks.
11. Restriction on registration.

##### *Registration of Trade Marks.*

12. Application for registration.
13. Advertisement of application.
14. Opposition to registration.
15. Disclaimers.
16. Date of registration.
17. Certificate of registration.
18. Non-completion of registration.

##### *Identical Trade Marks*

19. Identical marks.
20. Rival claims to identical marks.
21. Concurrent user.

##### *Assignment.*

22. Assignment and transmission of trade marks.
23. Apportionment of marks on dissolution of partnership.

##### *Associated Trade Marks.*

24. Associated trade marks.
25. Combined trade marks.
26. Series of trade marks.
27. Assignment and user of associated trade marks.

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*Renewal of Registration.*

Section.

- 28. Duration of registration.
- 29. Renewal of registration.
- 30. Procedure on expiry of period of registration.
- 31. Status of unrenewed trade mark.

*Correction and Rectification of the Register.*

- 32. Correction of register.
- 33. Registration of assignments, &c.
- 34. Alteration of registered trade mark.
- 35. Rectification of register.
- 36. Trade marks registered under previous Acts.
- 37. Non-user of trade mark.

*Effect of Registration*

- 38. Powers of registered proprietor.
- 39. Rights of proprietor of trade mark.
- 40. Registration to be *prima facie* evidence of validity.
- 41. Registration to be conclusive after seven years.
- 42. Unregistered trade mark.
- 43. Infringement.
- 44. User of name, address, or description of goods.
- 45. "Passing-off" action.

*Legal Proceedings.*

- 46. Certificate of validity.
- 47. Registrar to have notice of proceeding for rectification.

*Costs.*

- 48. Costs of proceedings before the Court.

*Evidence.*

- 49. Mode of giving evidence.
- 50. Sealed copies to be evidence.
- 51. Certificate of Registrar to be evidence.
- 52. Certificate of Board of Trade to be evidence.

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*Powers and Duties of Registrar of Trade Marks.*

- 53. Exercise of discretionary power by Registrar.
- 54. Appeal from Registrar.
- 55. Recognition of agents.
- 56. Registrar may take directions of law officers.
- 57. Annual reports of Comptroller.

*Powers and Duties of the Board of Trade.*

- 58. Proceedings before Board of Trade.
- 59. Appeals to Board of Trade.
- 60. Power of Board of Trade to make rules.

*Fees.*

- 61. Fees.

*Special Trade Marks.*

- 62. Standardisation, &c., trade marks.

*Sheffield Marks.*

Section.

63. Sheffield Marks.

*Cotton Marks.*

64. Cotton marks.

*International and Colonial Arrangements*

65. International and Colonial arrangements.

*Offences.*

66. Falsification of entries in register.

67. Penalty on falsely representing a trade mark as registered.

*Royal Arms.*

68. Unauthorised assumption of Royal Arms.

*Courts.*

69. General saving for jurisdiction of Courts.

70. Isle of Man.

71. Jurisdiction of Lancashire Palatine Court.

72. Offences in Scotland.

*Repeal ; Savings.*

73. Repeal and saving for rules, &c.

74. Application of 46 & 47 Vict. c. 57, ss. 82—84.

SCHEDULE.

*An Act to consolidate and amend the Law relating to Trade Marks.*

[11th August, 1905.]

BE it enacted by the King's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :—

1. This Act may be cited as the Trade Marks Act, 1905.

Short title.

2. This Act shall, save as otherwise expressly provided, come into operation on the first day of April one thousand nine hundred and six.

Commencement of Act.

“Save as otherwise expressly provided.” See sec. 64, sub-sec. (10). Repeals and savings, sec. 73. See also Interpretation Act, 1889, sec. 38, below, p. 654.

PART I.

*Definitions.*

3. In and for the purposes of this Act (unless the context otherwise requires) :—

Definitions.

A “mark” shall include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof :

Definition of a Trade Mark, Chap. II., p. 22.

Mark, p. 24.

Device, p. 184.

Brand, p. 189.

Heading, p. 191.

Label, p. 192.

Ticket, p. 197.

Name, p. 136.

Signature, p. 140.

Word marks, p. 142.

Letter, p. 198.

Numeral, p. 198.

A "trade mark" shall mean a mark used or proposed to be used upon or in connexion with goods for the purpose of indicating that they are the goods of the proprietor of such trade mark by virtue of manufacture, selection, certification, dealing with, or offering for sale :

Trade mark, p. 24.  
 Proposed to be used, p. 25.  
 In connection with goods, pp. 30 and 328.  
 Indication of origin, p. 35.  
 Certification, p. 53. See sec. 62.  
 Offered for sale in the market, p. 33.

A "registrable trade mark" shall mean a trade mark which is capable of registration under the provisions of this Act :

"Registrable trade mark," p. 26. Sec. 9.  
 What marks may be registered as trade marks, Chap. VIII., p. 127.

"The register" shall mean the register of trade marks kept under the provisions of this Act :

The Register, Chap. III., p. 57.  
 Sheffield Register, p. 112.  
 Manchester Register, p. 121.  
 Entries to be made in the Register, sec. 4, pp. 57, 59.  
 Trusts not to be entered in the Register, sec. 5, p. 59.  
 Incorporation of existing Register, sec. 6, p. 57.  
 Inspection of Register, sec. 7, p. 61.  
 Registration of assignments, sec. 33, p. 357.  
 Rectification of the Register, Chap. XI., p. 278.

A "registered trade mark" shall mean a trade mark which is actually upon the register :

"Prescribed" shall mean, in relation to proceedings before the Court, prescribed by rules of court, and in other cases, prescribed by this Act or the Rules thereunder :

"Prescribed," p. 94, n. Rules of Court, *ibid.*  
 Rules under the Act, Trade Mark Rules, 1906, Appendix, p. 655.

"The Court" shall mean (subject to the provisions for Scotland, Ireland, and the Isle of Man) His Majesty's High Court of Justice in England.

The Court, pp. 94 and 303.  
 Scotland, sec. 69 and sec. 72, p. 303.  
 Ireland, sec. 69, p. 303.  
 Lancashire Palatine Court, sec. 71, p. 126.  
 Isle of Man, sec. 70, p. 624.

#### *Register of Trade Marks.*

Register of  
trade marks.

4. There shall be kept at the Patent Office for the purposes of this Act a book called the Register of Trade Marks, wherein shall be entered all registered trade marks with the names and addresses of their proprietors, notifications of assignments and transmissions, disclaimers, conditions, limitations, and such other matters relating to such trade marks as may from time to time be prescribed. The register shall be kept under the control and management of the Comptroller-General of

Patents, Designs, and Trade Marks, who is in this Act referred to as the Registrar.

The Register, Chap. III., p. 57.

Assignments and devolution, Chap. XIII., p. 345. Sec. 33.

Disclaimers, Chap. IX., p. 212. Sec. 15, rule 34.

Conditions, secs. 12, 13, 14, pp. 76 and 98, and secs. 21 and 23, pp. 264 and 352.

Limitations, sec. 10, colour, p. 209; sec. 21, concurrent user, p. 264, and see above "Conditions."

As to the Sheffield Register, sec. 63, see Sheffield Marks, Chap. VI., p. 112.

As to the Manchester Register, sec. 64, see Cotton Marks, Chap. VII., p. 121.

Registration is as of the date of application, sec. 16, p. 81.

"Prescribed," date of registration, goods, trade, &c., of proprietor and such other particulars as the Registrar shall think necessary, Rule 64, pp. 59 and 664.

Removal from the Register and cause to be entered, Rule 74, p. 374.

Patent office, secs. 62 and 63 of the Patents and Designs Act, 1907.

The Registrar, p. 58. Acts under the Board of Trade, p. 58. Sec. 62 of the Patents and Designs Act, 1907.

5. There shall not be entered in the register any notice of any trust expressed, implied, or constructive, nor shall any such notice be receivable by the Registrar.

Trust not to be entered on register.

The registered proprietor can make a good title to a purchaser without notice, sec. 38, p. 353.

A purchaser with notice of an equitable title in a third person takes subject to his rights, p. 356.

As to notices in the nature of caveats, see *Viola v. Sharpe*, 22 R. P. C. 23 (1905), a patent case.

This section does not prevent the entry on the Register of conditions and limitations, which are recognised by the Act, see notes to sec. 4.

6. The register of trade marks existing at the date of the commencement of this Act, and all registers of trade marks kept under previous Acts, which are deemed part of the same book as such register, shall be incorporated with and form part of the register. Subject to the provisions of sections thirty-six and forty-one of this Act the validity of the original entry of any trade mark upon the registers so incorporated shall be determined in accordance with the statutes in force at the date of such entry, and such trade mark shall retain its original date, but for all other purposes it shall be deemed to be a trade mark registered under this Act.

Incorporation of existing register.

"Original Date." A trade mark is registered as of the date of application, Sec. 75 of the Act of 1883, as amended by sec. 17 of the Act of 1888. See also under this Act, sec. 16, pp. 81 and 324.

Sec. 36 gives a trade mark already on the Register the benefit of this Act without re-registration, p. 132.

Sec. 41 saves the original registration from attack on the ground of its invalidity after seven years from its date or from the passing of the Act, whichever shall last happen, and subject to certain exceptions, p. 330.

7. The register kept under this Act shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

Inspection of and extract from Register.

Inspection, searches and indexes, pp. 61 and 62.

Hours of inspection, Rule 96. Searches, Rule 95. Form of request for official search, TM No. 28, p. 691.

Fees for inspection or searching, 1s. for every quarter of an hour; for office copy of documents, for every 100 words (but never less than 1s.) 4d.; for certifying office copies, MS. or printed, 10s. See list of fees, p. 673.

*Registrable Trade Marks.*

Trade mark  
must be for  
particular  
goods.

**8.** A trade mark must be registered in respect of particular goods or classes of goods.

Classification of goods, Chap. V., p. 103. List of classes, p. 697.

A trade mark is assignable only in connection with the goodwill of the business concerned in the goods for which it has been registered, sec. 22, p. 346.

Registration for part of a class, pp. 104 and 229.

Associated trade marks, secs. 24 to 27, p. 107.

Registrable  
trade marks.

**9.** A registrable trade mark must contain or consist of at least one of the following essential particulars :—

A registrable trade mark is one capable of registration under the provisions of the Act, sec. 3.

As to what marks may be registered as trade marks, see Chap. VIII., p. 127.

For comparison with repealed sections, see p. 131.

Essential particulars, p. 134.

(1) The name of a company, individual, or firm represented in a special or particular manner ;

Name marks, p. 136. Trade name, p. 492.

Name of imaginary person not included, p. 137.

Special or particular manner, p. 140.

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

Signature, p. 140.

(3) An invented word or invented words ;

Word marks, p. 142. Paragraph (3) not qualified by (4), p. 159.

Invented word, p. 158. List of decisions, pp. 164 and 165.

Under the Act of 1883, before amendment by the Act of 1888, a fancy word not in common use might be registered, as to these, see pp. 144 to 157.

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

Page 165. List of decisions, pp. 168 and 169.

Descriptive words, pp. 37 and 150 *et seq.*, pp. 183 *et seq.*

Secondary meaning of word *prima facie* descriptive, pp. 37, 152, 183 and 508.

Geographical names, p. 170. Decisions, p. 172.

Surname, p. 172.

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

“ Mark,” sec. 3, p. 24 and 173.

Distinctive, pp. 174 to 184. Loss of distinctiveness, p. 363.

Special applications under paragraph (5) pp. 82 and 172, Rules 35 to 41, pp. 660 and 661.

Instances of words allowed by the Board of Trade under paragraph (5) below p. 820.

Provided always 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 the thirteenth day of August one thousand eight hundred and seventy-five, which has continued to be used (either in its original form or with additions or alterations not substantially affecting the identity of the same) down to

the date of the application for registration shall be registrable as a trade mark under this Act.

Old marks, p. 198.

August 13th, 1875, the date of the commencement of the first Registration Act.

Special or distinctive, p. 198.

Used as a trade mark, p. 203, and Chap. II., p. 22.

Statutory declaration as to user, Rule 20, p. 658.

Additions or alterations not substantially affecting the identity of the trade mark, cf. sec. 26, sec. 27 and sec. 34.

Alteration of old registered mark, p. 317.

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

In determining whether a trade mark is so adapted, the tribunal may, in the case of a trade mark in actual use, take into consideration the extent to which such user has rendered such trade mark in fact distinctive for the goods with respect to which it is registered or proposed to be registered.

Distinctive, pp. 35 and 174.

As to descriptive marks, see generally, pp. 37, 152, 165, 183 and 507.

Colour, sec. 10.

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

Coloured trade marks.

Colour, p. 209.

Limitations, pp. 76, 264.

**11.** 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.

Restriction on registration.

Deceptive marks, Chap. X., p. 266.

The prohibition is not limited to marks inherently deceptive, &c., p. 267.

Marks otherwise disentitled to protection, p. 274.

### *Registration of Trade Marks.*

**12.** (1) Any person claiming to be the proprietor of a trade mark who is desirous of registering the same must apply in writing to the Registrar in the prescribed manner.

Application for registration.

Registration of trade marks, Chap. IV., p. 65.

Who may apply to register, pp. 67 and 658.

Application by firm, partnership or body corporate, p. 67.

Prescribed manner, ordinary application, Rules 17 to 34, p. 658, Form TM No. 2, p. 678; application under sec. 9 (5), Rules 35 to 41, p. 660. Form TM No. 5, p. 680; application under sec. 62, Rules 42 to 46, p. 661, Form TM. No. 6, p. 681; application for a cotton mark, Rules 113 to 120, p. 670, Form Cotton No. 1, p. 692; applications to Cutlers' Co., Rules 107 to 112, p. 669; application to enter corporate mark on Sheffield Register, Form Sheffield No. 1, p. 691.

List of fees, p. 673; fees also marked on Forms.

Applications by agents, pp. 63 and 70.

(2) Subject to the provisions of this Act the Registrar may refuse such application, or may accept it absolutely or subject to conditions, amendments, or modifications.

The Registrar's discretion, p. 70.

Applicant entitled to be heard before refusal, sec. 53, p. 76.

Conditions, amendments or modifications, p. 76.

(3) In case of any such refusal or conditional acceptance the Registrar shall, if required by the applicant, state in writing the grounds of his decision and the materials used by him in arriving at the same, and such decision shall be subject to appeal to the Board of Trade or to the Court at the option of the applicant.

Request for statement of grounds of decision, Form TM No. 4, p. 679.

(4) An appeal under this section shall be made in the prescribed manner, and on such appeal the Board of Trade or the Court, as the case may be, shall, if required, hear the applicant and the Registrar, and shall make an order determining whether, and subject to what conditions, amendments, or modifications, if any, the application is to be accepted.

Appeal from the Registrar, p. 92.

Appeal to the Court, p. 94.

Appeal from Registrar to Board of Trade, Rules 122 to 127, p. 671. Form TM No. 29, p. 698.

Conditions, amendments or modifications, p. 76.

(5) Appeals under this section shall be heard on the materials so stated by the Registrar to have been used by him in arriving at his decision, and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Registrar, other than those stated by him, except by leave of the tribunal hearing the appeal. Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of costs on giving notice as prescribed.

Appeal from the Registrar, p. 92.

Costs, p. 99.

(6) The Registrar or the Board of Trade or the Court, as the case may be, may at any time, whether before or after acceptance, correct any error in or in connection with the application, or may permit the applicant to amend his application upon such terms as they may think fit.

Amendments, pp. 84 and 97.

Advertise-  
ment of  
application.

**13.** When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions, the Registrar shall, as soon as may be after such acceptance, cause the application as accepted to be advertised in the prescribed manner. Such advertisement shall set forth all conditions subject to which the application has been accepted.

Advertisement, p. 80.

Rules 47 to 49, p. 661.

Date of registration, sec. 16, pp. 51 and 324.

Certificate of registration, sec. 17, p. 81.



14. (1) Any person may, within the prescribed time from the date of the advertisement of an application for the registration of a trade mark, give notice to the Registrar of opposition to such registration. Opposition to registration.

Opposition to registration, p. 85.

Prescribed time, one month, Rule 51, p. 662. Enlargement of time, Rule 99, p. 688.

Summary of procedure on an opposed application, p. 89.

(2) Such notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

Notice of opposition, p. 88. Form TM No. 7, p. 681.

If registration is opposed on the ground of resemblance to registered marks, the numbers of such marks and of the journals in which they have been advertised are to be set out, Rule 52, p. 662.

Precedent of notice of opposition, p. 718.

(3) The Registrar shall send a copy of such notice to the applicant, and within the prescribed time after the receipt of such notice, the applicant shall send to the Registrar, in the prescribed manner, a counter-statement of the grounds on which he relies for his application, and, if he does not do so, he shall be deemed to have abandoned his application.

Counter-statement, p. 85. Form TM No. 8, p. 682. Precedent, p. 718.

"Prescribed time," one month from the date of receipt of the duplicate notice of opposition, Rule 53, p. 662.

The applicant should set out what facts, if any, alleged in the notice of opposition he admits, *ibid.*

Abandonment of application, p. 80.

(4) If the applicant sends such counter-statement, the Registrar shall furnish a copy thereof to the persons giving notice of opposition, and shall, after hearing the parties, if so required, and considering the evidence, decide whether, and subject to what conditions, registration is to be permitted.

Evidence, p. 87. Rules 54 to 58, p. 662.

Hearing by Registrar, p. 87. Rule 59, p. 663.

Conditions, p. 76.

(5) The decision of the Registrar shall be subject to appeal to the Court or, with the consent of the parties, to the Board of Trade.

(6) An appeal under this section shall be made in the prescribed manner, and on such appeal the Board of Trade or the Court, as the case may be, shall, if required, hear the parties and the Registrar, and shall make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

Appeal from the Registrar, p. 92.

Appeal to the Court, p. 94. "Prescribed manner," by motion within one month from the date of decision, Rule 121.

Appeal to the Board of Trade, p. 92. Rules 122 to 127, p. 671. Form TM No. 29, p. 695. Time, within one month from the date of decision, Rule 122, p. 671. Precedent of appellant's case, p. 719.

Reference by Board of Trade to Court, sec. 59, p. 92.

Directions by Board of Trade, p. 721. Rule 125, p. 672.

Notice of hearing of appeal by Board of Trade, Rule 126, p. 672.

(7) On the hearing of any such appeal any party may either in the manner prescribed or by special leave of the tribunal bring forward further material for the consideration of the tribunal.

(8) In proceedings under this section no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the

opponent or the Registrar other than those stated by the opponent as herein-above provided except by leave of the tribunal hearing the appeal. Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.

Prescribed manner, directions by Board of Trade, Rule 125, p. 672.

Costs, p. 99.

(9) In any appeal under this section, the tribunal may, after hearing the Registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity of such trade mark, but in such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.

Modification of trade mark, p. 97, cf. sec. 12 (2) and (4). "Not substantially affecting the identity of such trade mark," cf. sec. 9, old marks, sec. 26, sec. 27 and sec. 34.

Advertisement, p. 80.

(10) The Registrar, or, in the case of an appeal to the Board of Trade, the Board of Trade, shall have power in proceedings under this section to award to any party such costs as they may consider reasonable, and to direct how and by what parties they are to be paid.

Costs before the Registrar, p. 89.

Costs on appeal to the Board of Trade, p. 101.

(11) If a party giving notice of opposition or of appeal neither resides nor carries on business in the United Kingdom, the tribunal may require such party to give security for costs of the proceedings before it relative to such opposition or appeal, and in default of such security being duly given may treat the opposition or appeal as abandoned.

Security for costs, p. 102. Rule 61, p. 663.

#### Disclaimers.

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

Disclaimers, Chap. IX., p. 212.

Effect of disclaimer, p. 219.

Essential particulars, p. 134.

Parts of a trade mark may be separately registered, see Associated Trade Marks pp. 109 and 214, and sec. 25.

Matter common to the trade, p. 215.

The three mark rule, p. 215.

A disclaimer may be required in rectification proceedings under sec. 35 as a condition of the trade mark remaining on the register, p. 297.

The proviso renders obsolete the decision in *Rosenthal v. Reynolds*, [1892] 2 Ch. 301; 9 R. P. C. 189, which was to the contrary effect, see p. 219.

A disclaimer is not to be required, unless some special reason for it is made out, p. 214.

**16.** When an application for registration of a trade mark has been accepted and has not been opposed, and the time for notice of opposition has expired, or having been opposed the opposition has been decided in favour of the applicant, the Registrar shall, unless the Board of Trade otherwise direct, register the said trade mark, and the trade mark, when registered, shall be registered as of the date of the application for registration, and such date shall be deemed for the purposes of this Act to be the date of registration.

Date of registration.

Where a trade mark has been accepted by error the Registrar may withdraw his acceptance subject to appeal, Rule 63, p. 663.

Date of registration, p. 81. Cf. as to marks registered under prior Acts, secs. 6 and 36, and see p. 132.

**17.** On the registration of a trade mark the Registrar shall issue to the applicant a certificate in the prescribed form of the registration of such trade mark under the hand of the Registrar, and sealed with the seal of the Patent Office.

Certificate of registration.

Prescribed form. Rule 67, p. 664. Form O., No. 2, p. 683. No fee. As to other certificates, see secs. 50 and 51, and Rules 102 and 104, and table of forms, p. 676. There is a general right to have a certified copy of any entry in the register on payment of the prescribed fee, sec. 7.

**18.** Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in such notice.

Non-completion of registration.

Abandonment of application, p. 80. It is no bar to a fresh application, *Jackson v. Napper*, 35 C. D. 162; 4 R. P. C. 145 (1886), Stirling, J.

The ordinary length of notice is fourteen days, but the Registrar may give a further time where the applicant lives at a distance, Rule 62, p. 663.

### *Identical Trade Marks.*

**19.** Except by order of the Court or in the case of trade marks in use before the thirteenth day of August one thousand eight hundred and seventy-five, no trade mark shall be registered in respect of any goods or description of goods, which is identical with one belonging to a different proprietor which is already on the register with respect to such goods or description of goods or so nearly resembling such a trade mark as to be calculated to deceive.

Identical marks.

Duplicate marks, p. 221.

Mark resembling a registered mark, p. 234.

"Except, &c." See also secs. 20 and 21. Old marks, p. 198. Three mark rule, p. 224.

An application to the Court must be served on the Registrar and an office copy of an order under the section must be left at the Patent Office, rule 129, p. 672.

For procedure, see p. 225.

Belonging to a different proprietor, cf. sec. 24.

Same goods or description of goods, p. 228.

**20.** Where each of several persons claims to be proprietor of the same trade mark, or of nearly identical trade marks in respect of the same goods or description of goods, and to be registered as such proprietor, the Registrar may refuse to register any of them until their rights have

Rival claims to identical marks.

been determined by the Court, or have been settled by agreement in a manner approved by him or (on appeal) by the Board of Trade.

Duplicate registration, pp. 225 and 264.

Concurrent claims, p. 225.

Same goods or description of goods, p. 228.

"Determined by the Court," procedure, p. 225.

"Settled by agreement," p. 226.

Concurrent user.

**21.** In case of honest concurrent user or of other special circumstances which, in the opinion of the Court, make it proper so to do, the Court may permit the registration of the same trade mark, or of nearly identical trade marks, for the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any, as to mode or place of user or otherwise, as it may think it right to impose.

Duplicate registration, pp. 228 and 264.

Concurrent user, p. 264.

Same goods or description of goods, p. 228.

Conditions and limitations, pp. 76, 265.

As to rights of proprietors of duplicate marks, sec. 39, p. 325.

#### *Assignment.*

Assignment and transmission of trade marks.

**22.** 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. 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.

Assignment and devolution, Chap. XIII., p. 345.

Registration of assignments, &c., sec. 33. See notes to that section. Rules 76 to 81, p. 665.

A trade mark must be registered in respect of particular goods or classes of goods, sec. 8; and the exclusive right to the use of it conferred by registration is confined to the goods in respect of which it is registered, sec. 36, p. 327.

The registered proprietor has power to assign a trade mark and give receipts for any consideration, sec. 38, p. 353.

Determination of trade mark rights, Chap. XIV., p. 362.

Goodwill, pp. 359 and 367.

As to the proviso, see p. 351.

Apportionment of marks on dissolution of partnership.

**23.** 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 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.

Rights on dissolution of partnership, Chap. XIII., p. 352.

Rules 87 to 89, p. 666. A note of the apportionment and the date of the decision is to be entered on the register.

Appeal to the Board of Trade, rules 122 to 127, p. 671.

The Board of Trade may refer an appeal to the Court, sec. 59, p. 618.

Associated trade marks, secs. 24 to 27.

*Associated Trade Marks.*

**24.** If application be made for the registration of a trade mark so closely resembling a trade mark of the applicant already on the register for the same goods or description of goods as to be calculated to deceive or cause confusion if used by a person other than the applicant, the tribunal hearing the application may require as a condition of registration that such trade marks shall be entered on the register as associated trade marks. Associated trade marks.

Associated trade marks, p. 107. They comprise (1) a set of marks associated under this section; (2) series of trade marks, sec. 26; and (3) a set of trade marks constituted by the registration of a trade mark and of one or more parts of it, sec. 25.

The section has nothing to do with the registration of identical marks belonging to the same proprietor, per Kekewich, J., in *Birmingham Small Arms Application*, [1907] 2 Ch. 396; 24 R. P. C. 563. Cf. secs. 19 and 20, as to marks belonging to different proprietors. This section was inserted to meet the difficulty caused by the decision in *Players & Sons' Application*, [1901] 1 Ch. 382; 18 R. P. C. 65.

The fact of association is to be noted on the register against each mark, rule 65, p. 664.

Associated trade marks are only assignable or transmissible as a whole, sect. 27.

**25.** If the proprietor of a trade mark claims to be entitled to the exclusive use of any portion of such trade mark separately, he may apply to register the same as separate trade marks. Each such separate trade mark must satisfy all the conditions and shall have all the incidents of an independent trade mark, except that when registered it and the trade mark of which it forms a part shall be deemed to be associated trade marks and shall be entered on the register as such, but the user of the whole trade mark shall for the purposes of this Act be deemed to be also a user of such registered trade marks belonging to the same proprietor as it contains. Combined trade marks.

See notes to sec. 24.

A trade mark, e.g., a label, often contains distinctive parts, which under this section may be registered subject to the condition of association. A part separately registered cannot be required to be disclaimed under sec. 15.

The proviso was inserted in view of sec. 37, enabling a trade mark to be removed from the register on the ground of non-user, see p. 109.

**26.** When a person claiming to be the proprietor of several trade marks for the same description of goods which, while resembling each other in the material particulars thereof, yet differ in respect of— Series of trade marks.

- (a) statements of the goods for which they are respectively used or proposed to be used; or
- (b) statements of number, price, quality, or names of places; or
- (c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or
- (d) colour;

seeks to register such trade marks, they may be registered as a series in one registration. All the trade marks in a series of trade marks so registered shall be deemed to be, and shall be registered as, associated trade marks.

Series of trade marks, p. 110.

Application for a series of trade marks, rule 27, p. 659.

Fee, Ia. List of Fees, p. 673.

Advertisement of a series, rule 49, p. 662.

See also notes to sec. 24, as to associated trade marks generally.

Assignment  
and user of  
associated  
trade marks.

**27.** Associated trade marks shall be assignable or transmissible only as a whole and not separately, but they shall for all other purposes be deemed to have been registered as separate trade marks. Provided that where under the provisions of this Act user of a registered trade mark is required to be proved for any purpose, the tribunal may if and so far as it shall think right accept user of an associated registered trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for such user.

Assignment of trade marks, Chap. XIII., p. 345.

Associated trade marks, p. 107. See notes to sec. 24.

Rules as to assignment, rules 76 to 81, p. 665.

As to the proviso, see sec. 37, non-user of trade mark.

"Not substantially affecting the identity," cf. sec. 9, old marks, secs. 14 (9), 26 and 34.

#### *Renewal of Registration.*

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, p. 372. Rules 68 to 75, pp. 664, 665.

And see notes to secs. 29 and 30.

**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."

"Prescribed period," not less than two months nor more than three months before expiration, rule 68, p. 664.

Renewal is to be advertised in the Journal, rule 75, p. 665.

Procedure on  
expiry of  
period of  
registration.

**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.

Removal of mark from the register, p. 372.

Renewal of registration, p. 372.

The rules provide for two notices by the Registrar and an advertisement in the Journal before removal, rules 70 to 74, pp. 664, 665. See also the summary of prescribed procedure, p. 374. The forms are there referred to.

What conditions may be required, p. 375.

The cause of removal is to be entered on the register, rule 74, p. 665.

Status of un-  
renewed trade  
mark.

**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 *bond fide* trade user of such trade mark during the two years immediately preceding such removal.

Under this section a trade mark, though removed from the register, may be a ground of refusal of registration for an identical or similar mark, see secs. 19 and 20 and p. 375.

"No *bond fide* trade user, &c." Cf. sec. 37.

*Correction and Rectification of the Register.*

**32.** The Registrar may, on request made in the prescribed manner by the registered proprietor or by some person entitled by law to act in his name,— Correction of register.

- (1) Correct any error in the name or address of the registered proprietor of a trade mark; or
- (2) Enter any change in the name or address of the person who is registered as proprietor of a trade mark; or
- (3) Cancel the entry of a trade mark on the register; or
- (4) Strike out any goods or classes of goods from those for which a trade mark is registered; or
- (5) Enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of such trade mark.

Any decision of the Registrar under this section shall be subject to appeal to the Board of Trade.

Correction and cancellation of entries at the proprietor's request, p. 313.

As to changes of proprietorship, see sec. 33. As to alteration of a trade mark, see sec. 34.

"Goods or classes of goods," sec. 8.

Disclaimers, Chap. IX., p. 212.

Rules 82, and 90 to 92. Form for alteration of address, TM No. 20, p. 688. Form for entry of change of name, TM No. 23, p. 689. Form for cancellation of entry, TM No. 24, p. 689. Form of request to strike out particular goods, TM No. 25, p. 690. Form of request to enter a disclaimer or memorandum, TM No. 26, p. 690.

An appeal may be referred by the Board of Trade to the Court, sec. 59, p. 618.

**33.** 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.

Assignment and devolution of trade marks, Chap. XIII., p. 345.

Registration of assignment, p. 357.

"Subject to the provisions of this Act," secs. 22 and 27.

As to the power of the registered proprietor to assign, and as to notice of equities, see notes to sec. 38.

As to changes of name and address, see sec. 32.

"Prescribed manner," rules 76 to 81, p. 665. Form of joint request by registered proprietor and assignee to register assignee, TM No. 16, p. 686. Declaration in support, TM No. 17. Request by subsequent proprietor only to register him, Form TM No. 18. A case is to accompany the request, rule 78, p. 665. Declaration in support, TM No. 19, p. 687.

**34.** The registered proprietor of any trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter such Alteration of registered trade mark.

trade mark in any manner not substantially affecting the identity of the same, and the Registrar may refuse such leave or may grant the same on such terms as he may think fit, but any such refusal or conditional permission shall be subject to appeal to the Board of Trade. If leave be granted, the trade mark as altered shall be advertised in the prescribed manner.

Alteration of registered trade mark, p. 316.

"Prescribed manner," rules 93 and 94, p. 667. Form TM No. 27, p. 690.

Advertisement. Cf. sec. 13.

The Board of Trade may refer an appeal to the Court, sec. 59.

Rectification  
of Register.

**35.** Subject to the provisions of this Act—

- (1) The Court may on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, make such order for making, expunging, or varying such entry, as it may think fit:
- (2) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of the register:
- (3) In case of fraud in the registration or transmission of a registered trade mark, the Registrar may himself apply to the Court under the provisions of this section:
- (4) Any order of the Court rectifying the register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner who shall upon receipt of such notice rectify the register accordingly.

Rectification of the Register, Chap. XI., p. 276.

As a defence, p. 410.

"Subject to the provisions of this Act," see especially secs. 40 and 41.

"The Court," p. 303.

"Person aggrieved," p. 279.

Costs, p. 311. Security for costs by a foreigner, p. 312.

Procedure, p. 303.

The Registrar must be served, rule 129, and see sec. 47. An office copy of any order made must be left at the Office, Form TM 30, rule 129.

Form, p. 723.

Trade marks  
registered  
under  
previous  
Acts.

**36.** No trade mark which is upon the register at the commencement of this Act and which under this Act is a registrable trade mark shall be removed from the register on the ground that it was not registrable under the Acts in force at the date of its registration. But nothing in this section contained shall subject any person to any liability in respect of any act or thing done before the commencement of this Act to which he would not have been subject under the Acts then in force.

Page 132.

"Registrable trade mark," see sec. 3, p. 26.

The facts at the date of the decision are to be considered with reference to the law at that date, *Gestelner's Tm.*, [1907] 2 Ch. 478; [1908] 1 Ch. 513; 24 R. P. C. 545; 25 R. P. C. 156. See, however, the judgment of Parker, J., in *Philippart v. Whiteley, Ltd.*, [1908] 2 Ch. 274; 28 R. P. C. 565.

The trade mark, if upheld, retains its original date, sec. 6, p. 601.

Non-user of  
trade mark

**37.** A registered trade mark may, on the application to the Court of any person aggrieved, be taken off the register in respect of any of the



goods for which it is registered, on the ground that it was registered by the proprietor or a predecessor in title without any *bonâ fide* intention to use the same in connection with such goods, and there has in fact been no *bonâ fide* user of the same in connection therewith, or on the ground that there has been no *bonâ fide* user of such trade mark in connection with such goods during the five years immediately preceding the application, unless in either case such non-user is shown to be due to special circumstances in the trade, and not to any intention not to use or to abandon such trade mark in respect of such goods.

Removal on the ground of non-user, p. 292.

"Person aggrieved." p. 279.

Abandonment, p. 370.

User of trade marks associated with that in question may under some circumstances be accepted as equivalent to user of the trade mark, secs. 25 and 27.

### *Effect of Registration.*

#### **38. Subject to the provisions of this Act—**

- (1) The person for the time being entered in the register as 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.

Powers of registered proprietor.

Assignment and devolution of trade marks, Chap. XIII., p. 345.

Registration of assignments, &c., sec. 33, p. 357.

"Subject to the provisions of this Act," sec. 22, trade marks are only assignable with goodwill, p. 345. and sec. 27, associated trade marks are not separately assignable. p. 108.

Equities, p. 356.

Notice of trusts is not to be entered on the register. p. 59.

**39. 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 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.**

Rights of proprietor of trade mark.

Effect of registration. Chap. XII., p. 321.

Registration, evidence of validity, *primâ facie*, sec. 40, p. 329, and after seven years conclusive, sec. 41, p. 330.

Limitations and conditions. see secs. 10, 12, 14, 21, and the notes thereto.

Test of infringement where the registered trade mark is actually copied, p. 397.

For deceptive resemblance. see pp. 234 *et seq.* and pp. 400 *et seq.*

Concurrent registration. pp. 225 and 400.

Definition of rights by the Court, see secs. 20 and 21.

The exclusive right conferred by this section is subject to the savings contained in sec. 44, as to the *bonâ fide* use by a person of his own name or place of business and *bonâ fide* descriptions of goods.

Registration to be *prima facie* evidence of validity.

**40.** In all legal proceedings relating to a registered trade mark (including applications under section thirty-five of this Act) the fact that a person is registered as proprietor of such trade mark shall be *prima facie* evidence of the validity of the original registration of such trade mark and of all subsequent assignments and transmissions of the same.

Effect of registration, Chap. XII., p. 321.  
See notes to secs. 39 and 41.  
Sec. 35, Rectification, Chap. XI., p. 276.

Registration to be conclusive after seven years.

**41.** 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, 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.

Registration conclusive evidence of validity, p. 330.

The first part of the section cannot come into operation until August 11th, 1912.  
Fraud, p. 332. Sec. 11, p. 266.

As to the proviso, see concurrent user, pp. 264, 411, and concurrent registration, pp. 225, 264.

Unregistered trade mark.

**42.** 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 the thirteenth of August one thousand eight hundred and seventy-five, and has been refused registration under this Act. The Registrar may, on request, grant a certificate that such registration has been refused.

Registration as a condition precedent to an action for infringement, pp. 334, 386.

The prohibition does not affect actions for passing-off, sec. 45, p. 338. It applies to foreigners, p. 337.

August 13th, 1875, is the date of the commencement of the first Registration Act. Old marks, p. 198.

Form of request for certificate of refusal, TM No. 32, p. 696.

Infringement.

**43.** 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.

Infringement, Chap. XV., p. 377.  
Evidence as to get-up, &c., p. 405.

User of name, address, or

**44.** No registration under this Act shall interfere with any *bona 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. description of goods.

Page 419.

Right to honest use of one's own name, pp. 419, 532.

Descriptive words, pp. 37, 183, 252, 507.

**45.** Nothing in this Act contained 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. "Passing-off" action.

Passing-off, Chap. XVI., p. 477.

Non-registration not a bar to an action for passing-off, pp. 338, 481.

Cf. sec. 42.

*Legal Proceedings.*

**46.** 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. Certificate of validity.

Certificate of validity, pp. 309, 466. May be given in rectification proceedings, p. 310.

**47.** In any legal proceeding in which the relief sought includes alteration or rectification of the register, the Registrar shall have the right to appear and be heard, and shall appear if so directed by the Court. Unless otherwise directed by the Court, the Registrar in lieu of appearing and being heard may submit to the Court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting the same or of the practice of the office in like cases, or of such other matters relevant to the issues, and within his knowledge as such Registrar, as he shall think fit, and such statement shall be deemed to form part of the evidence in the proceeding. Registrar to have notice of proceeding for rectification.

Notice of every application to the Court under the Act is to be served on the Registrar, rule 129, p. 672.

Rectification, Chap. XI., p. 277.

Alteration of trade marks, p. 316.

Evidence, p. 307.

In cases under secs. 23, 32, 33 or 34, the matter would come before the Registrar in the first instance. The words "the grounds of any decision" appear, however, not to be confined to the decision (if any) under appeal, but would include, *e.g.*, a decision when the mark was registered.

The Court may review any decision of the Registrar relating to the entry in question, sec. 54, p. 617.

*Costs.*

**48.** In all proceedings before the Court under this Act the costs of the Registrar shall be in the discretion of the Court, but the Registrar shall not be ordered to pay the costs of any other of the parties. Costs of proceedings before the Court.

Costs in applications to register, p. 99.

Costs in rectification proceedings, p. 311.

The Registrar is entitled as a general rule to have his costs, p. 99.

*Evidence.*

Mode of  
giving  
evidence.

**49.** In any proceeding under this Act before the Board of Trade or the Registrar, the evidence shall be given by statutory declaration in the absence of directions to the contrary, but, in any case in which it shall think it right so to do, the tribunal may (with the consent of the parties) take evidence *viva voce* in lieu of or in addition to evidence by declaration. Any such statutory declaration may in the case of appeal be used before the Court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

In case any part of the evidence is taken *viva voce* the Board of Trade or the Registrar shall in respect of requiring the attendance of witnesses and taking evidence on oath be in the same position in all respects as an Official Referee of the Supreme Court.

Evidence in applications to register, pp. 87, 93, 94.

As to the powers of an official referee to require the attendance of witnesses and to take evidence on oath, see Order XXXVI., r. 49, and the Arbitration Act, 1889.

As to the Registrar's power to dispense with evidence, see Rule 97, p. 668.

"On oath" and "affidavit," see Interpretation Act, 1889, sec. 3, p. 652.

Sealed copies  
to be evidence.

**50.** 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.

Pages 62, 63. Cf. sec. 51.

The Register, sec. 4, p. 57. Inspection and extracts, sec. 7, p. 61.

Seal of the Patent Office, Patents and Designs Act, 1907, sec. 64, replacing sec. 84 of the Act of 1883.

Fees, see sec. 7.

Certificate of  
Registrar to  
be evidence.

**51.** 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 not done.

Pages 62, 63. Cf. sec. 50.

See also rule 102, and certificate of registration under sec. 17 (on registration), Form O., No. 2, p. 683.

Request for general certificate, Form TM No. 31, p. 696. Request for certificate of refusal to register, Form TM No. 32, p. 696. Request for certificate of registration for use in obtaining registration abroad, Form TM No. 33, p. 697. Request for certificate of registration to be used in legal proceedings, Form TM No. 34, p. 697. Request for certificate under sec. 64(12) (deposit of cotton mark), Form Cotton No. 3, p. 693. Certificate under same Form. MB No. 1, p. 694. Request for certificate of Keeper of Cotton Marks of registration, Form Cotton No. 4, p. 694. General certificate of Keeper of Cotton Marks, Form MB No. 2, p. 695.

Fees marked on Forms, or see List of Fees, p. 673.

Certificate of  
Board of Trade  
to be evidence.

**52.** (1) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

(2) A certificate signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.

PART II.

*Powers and Duties of Registrar of Trade Marks.*

**53.** Where any discretionary or other power is given to the Registrar by this Act or rules made thereunder he shall not exercise that power adversely to the applicant for registration or the registered proprietor of the trade mark in question without (if duly required so to do within the prescribed time) giving such applicant or registered proprietor an opportunity of being heard.

Exercise of discretionary power by Registrar.

“ Prescribed time,” one month from the date when the matter has arisen, rules 83 to 86.

**54.** Except where expressly given by the provisions of this Act or rules made thereunder there shall be no appeal from a decision of the Registrar otherwise than to the Board of Trade, but the Court, in dealing with any question of the rectification of the register (including all applications under the provisions of section thirty-five of this Act), shall have power to review any decision of the Registrar relating to the entry in question or the correction sought to be made.

Appeal from Registrar.

As to appeal to the Court direct, see secs. 12, 14, 33, 63 (9) (Sheffield Marks), and 64 (5) (Cotton Marks).

The Board of Trade may refer an appeal to the Court, sec. 59.

Rectification of the Register, sec. 35, p. 276; and in appeals direct from the Registrar under sec. 33, p. 357; and in referred appeals under sec. 32 (p. 313) or sec. 34 (p. 316).

By rule 63 (p. 663) an appeal is given where registration is refused on the direction of the Board of Trade after acceptance.

**55.** Where by this Act any act has to be done by or to any person in connection with a trade mark or proposed trade mark or any procedure relating thereto, such act may under and in accordance with rules made under this Act or in particular cases by special leave of the Board of Trade be done by or to an agent of such party duly authorised in the prescribed manner.

Recognition of agents.

Agents, p. 63.

Authorisation of agents, rule 2, p. 655.

As to agents generally, rule 10, p. 656. Form of authorisation, TM No. 1, p. 677.

**56.** The Registrar may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to His Majesty's Attorney-General or Solicitor-General for England for directions in the matter.

Registrar may take directions of law officers.

Pages 58, 77.

**57.** The Comptroller General of Patents, Designs, and Trade Marks shall in his yearly report on the execution by or under him of the Patents, Designs, and Trade Marks Act, 1883, and Acts amending the

Annual reports of Comptroller, 46 & 47 Vict. c. 57.

same, include a report respecting the execution by or under him of this Act as though it formed a part of or was included in such Acts.

The Comptroller, p. 58.

The official reports of Patents, Designs and Trade Marks are published under sec. 46 of the Patents and Designs Act, 1907.

*Powers and Duties of the Board of Trade.*

Proceedings  
before Board  
of Trade.

**58.** All things required or authorised under this Act to be done by to or before the Board of Trade may be done by to or before the President or a secretary or an assistant secretary of the Board or any person authorised in that behalf by the President of the Board.

Appeals to  
Board of  
Trade.

**59.** Where under this Act an appeal is made to the Board of Trade, the Board of Trade may, if they think fit, refer any such appeal to the Court in lieu of hearing and deciding it themselves, but, unless the Board so refer the appeal, it shall be heard and decided by the Board, and the decision of the Board shall be final.

Rights of appeal to the Board of Trade are given by secs. 12, 14 (by consent), 20, 23, 32, 33 and 34. In some of these cases, there is an alternative appeal to the Court.

Power of  
Board of  
Trade to make  
rules.

**60.** (1) Subject to the provisions of this Act the Board of Trade may from time to time make such rules, prescribe such forms, and generally do such things as they think expedient—

(a) For regulating the practice under this Act:

(b) For classifying goods for the purposes of registration of trade marks:

(c) For making or requiring duplicates of trade marks and other documents:

(d) For securing and regulating the publishing and selling or distributing in such manner as the Board of Trade think fit, of copies of trade marks and other documents:

(e) Generally, for regulating the business of the office in relation to trade marks and all things by this Act placed under the direction or control of the Registrar, or of the Board of Trade.

(2) Rules made under this section shall, whilst in force, be of the same effect as if they were contained in this Act.

(3) Before making any rules under this section the Board of Trade shall publish notice of their intention to make the rules and of the place where copies of the draft rules may be obtained in such manner as the Board consider most expedient, so as to enable persons affected to make representations to the Board before the rules are finally settled.

(4) Any rules made in pursuance of this section shall be forthwith advertised twice in the Trade Marks Journal, and shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament.

(5) If either House of Parliament within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of

anything done in the meantime under such rules or rule or to the making of any new rules or rule.

The Rules of 1906, which came into force after March 31st, 1906, that is to say, with the commencement of the Act, are printed below, p. 655. Table of Fees, p. 673. Forms, pp. 676 *et seq.* Classification of goods, pp. 697 *et seq.*

"Prescribed" where it occurs in the Act, and except in relation to proceedings before the Court, means prescribed by this Act or the rules thereunder, sec. 3.

*Fees.*

**61.** There shall be paid in respect of applications and registration and other matters under this Act, such fees as may be, with the sanction of the Treasury, prescribed by the Board of Trade. Fees.

Table of Fees, p. 673.

*Special Trade Marks.*

**62.** Where any association or person undertakes the examination of any goods in respect of origin, material, mode of manufacture, quality, accuracy, or other characteristic, and certifies the result of such examination by mark used upon or in connection with such goods, the Board of Trade may, if they shall judge it to be to the public advantage, permit such association or person to register such mark as a trade mark in respect of such goods, whether or not such association or person be a trading association or trader or possessed of a goodwill in connection with such examination and certifying. When so registered such trade mark shall be deemed in all respects to be a registered trade mark, and such association or person to be the proprietor thereof, save that such trade mark shall be transmissible or assignable only by permission of the Board of Trade. Standardisation, &c., trade marks.

Standardisation Marks, pp. 83, 208.

Procedure, p. 84; rules 42 to 46, p. 661.

"Person" includes any body of persons corporate or incorporate. Interpretation Act, 1889, sec. 19, p. 652.

*Sheffield Marks.*

**63.** With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called the Cutlers' Company), and the marks or devices (in this Act called Sheffield marks) assigned or registered by the master, wardens, searchers, and assistants of that company, the following provisions shall have effect:— Sheffield marks.

(1) The Cutlers' Company shall continue to keep at Sheffield the register of trade marks (in this Act called the Sheffield register) kept by them at the date of the commencement of this Act, and, save as otherwise provided by this Act, such register shall for all purposes form part of the register:

(2) The Cutlers' Company shall, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal goods as defined in this section, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January one thousand eight hundred and eighty-four, but which have not been entered in such register before the passing of this Act:

- (3) An application for registration of a trade mark used on metal goods shall, if made after the commencement of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company :
- (4) Every application so made to the Cutlers' Company shall be notified to the Registrar in the prescribed manner, and, unless the Registrar within the prescribed time gives notice to the Cutlers' Company of any objection to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner :
- (5) If the Registrar gives notice of an objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may in the prescribed manner appeal to the Court :
- (6) Upon the registration of a trade mark in the Sheffield register the Cutlers' Company shall give notice thereof to the Registrar, who shall thereupon enter the mark in the register of trade marks ; and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the Registrar on that day :
- (7) The provisions of this Act, and of any rules made under this Act with respect to the registration of trade marks, and all matters relating thereto, shall, subject to the provisions of this section (and notwithstanding anything in any Act relating to the Cutlers' Company), apply to the registration of trade marks on metal goods by the Cutlers' Company, and to all matters relating thereto ; and this Act and any such rules shall, so far as applicable, be construed accordingly with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield register, for the Registrar, the Patent Office, and the Register of Trade Marks respectively ; and notice of every entry, cancellation, or correction made in the Sheffield register shall be given to the Registrar by the Cutlers' Company :
- (8) When the Registrar receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade mark used on metal goods, he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company :
- (9) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the Court :
- (10) For the purposes of this section the expression "metal goods" means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal :
- (11) For the purpose of legal proceedings in relation to trade marks entered in the Sheffield register a certificate under the hand of the Master of the Cutlers' Company shall have the same effect as the certificate of the Registrar.

Sheffield marks, Chap. VI, p. 112.

Procedure, p. 118 ; rules 107 to 112, pp. 669.

"The Court" means in England the High Court of Justice, sec. 3.

"Person aggrieved, cf. sec. 35, and see p. 279.

Certificate of the Registrar, sec. 51.



*Cotton Marks.*

**64.** (1) The Manchester Branch of the Trade Marks Registry of the Patent Office (hereinafter called "the Manchester Branch") shall be continued according to its present constitution. A chief officer of the Manchester Branch shall be appointed who shall be styled "The Keeper of Cotton Marks," and shall act under the direction of the Registrar. The present keeper of the Manchester Branch shall be the first Keeper of Cotton Marks. Cotton marks.

(2) As regards cotton goods which have hitherto constituted classes 23, 24, and 25, under the classification of goods under the Patents, Designs, and Trade Marks Acts, 1883 to 1902, the Register of Trade Marks for all such goods, except such as may be prescribed, shall be called "the Manchester Register," and a duplicate thereof shall be kept at the Manchester Branch.

(3) All applications for registration of trade marks for such cotton goods in the said classes (hereinafter referred to as "cotton marks") shall be made to the Manchester Branch.

(4) Every application so made to the Manchester Branch shall be notified to the Registrar in the prescribed manner together with the report of the Keeper of Cotton Marks thereon, and unless the Registrar, after considering the report and hearing, if so required, the applicant, within the prescribed time gives notice to the Keeper of Cotton Marks of objection to the acceptance of the application, it shall be advertised by the Manchester Branch and shall be proceeded with in the prescribed manner.

(5) If the Registrar gives notice of objection as aforesaid the application shall not be proceeded with, but any person aggrieved may in the prescribed manner appeal to the Court or the Board of Trade, at the option of the applicant.

(6) Upon the registration of a trade mark in the Manchester Register the Keeper of Cotton Marks shall upon notice thereof from the Registrar thereupon enter the mark in the duplicate of the Manchester Register, and such registration shall bear date as of the day of application to the Manchester Branch, and shall have the same effect as if the application had been made to the Registrar on that day.

(7) When any mark is removed from or any cancellation or correction made in the Manchester Register notice thereof shall be given by the Registrar to the Keeper of Cotton Marks, who shall alter the duplicate register accordingly.

(8) For the purpose of all proceedings in relation to trade marks entered in the Manchester Register a certificate under the hand of the Keeper of Cotton Marks shall have the same effect as a certificate of the Registrar.

(9) In every application for registration of a cotton mark, if such mark has been used by the applicant or his predecessors in business prior to the date of application, the length of time of such user shall be stated on the application.

(10) As from the passing of this Act—

(a) In respect of cotton piece goods and cotton yarn no mark consisting of a word or words alone (whether invented or otherwise) shall be registered, and no word or words shall be deemed to be distinctive in respect of such goods:

(b) In respect of cotton piece goods no mark consisting of a line heading alone shall be registered, and no line heading shall be deemed to be distinctive in respect of such goods :

(c) No registration of a cotton mark shall give any exclusive right to the use of any word, letter, numeral, line heading, or any combination thereof.

39 & 40 Viet.  
c. 33.

(11) The right of inspection of the Manchester Register shall extend to and include the right to inspect all applications whatsoever that have been since the passing of the Trade Marks Registration Act, 1875, and hereafter shall have been made to the Manchester Branch in respect of cotton goods in classes 23, 24, and 25, whether registered, refused, lapsed, expired, withdrawn, abandoned, cancelled, or pending.

(12) The Keeper of Cotton Marks shall, on request, and on production of a facsimile of the mark, and on payment of the prescribed fee, issue a certified copy of the application for registration of any cotton mark, setting forth in such certificate the length of time of user (if any) of such mark as stated on the application, and any other particulars he may deem necessary.

(13) As regards any rules or forms affecting cotton marks which are proposed by the Board of Trade to be made, the draft of the same shall be sent to the Keeper of Cotton Marks and also to the Manchester Chamber of Commerce. And the said Keeper, and also the said Chamber, shall, if they or either of them so request, be entitled to be heard by the Board of Trade upon such proposed rules before the same are carried into effect.

(14) The existing practice whereby the keeper of the Manchester Branch consults the Trade and Merchandise Marks Committee appointed by the Manchester Chamber of Commerce upon questions of novelty or difficulty arising on applications to register cotton marks shall be continued by the Keeper of Cotton Marks.

Cotton Marks. Chap. VII., p. 121.

Classes 23, 24 and 25, under the former classification included the same goods as the present Classes 23, 24 and 25, see p. 121; but Class 23 was differently subdivided, see p. 121.

Procedure, p. 122; Rules 113 to 120, p. 670.

"Person aggrieved." cf. sec. 35, and see p. 279.

"Passing of the Act," August 11th, 1905. The Act generally only came into force on April 1st, 1906.

"The Court" means in England the High Court of Justice, sec. 3, but as regards cotton marks, the Court of Chancery of the County Palatine of Lancaster has a co-ordinate jurisdiction, sec. 71.

Request for certificate under sub-sec. (12), Form Cotton No. 3, p. 693; certificate, Form MB No. 1, p. 694. Request for general certificate, Form Cotton No. 4, p. 694; certificate, Form MB No. 2, p. 695.

#### *International and Colonial Arrangements.*

International  
and Colonial  
arrangements.  
48 & 49 Viet.  
c. 63.

**65.** The provisions of sections one hundred and three and one hundred and four of the Patents, Designs, and Trade Marks Act, 1883 (as amended by the Patents, Designs, and Trade Marks (Amendment) Act, 1885), relating to the registration of trade marks both as enacted in such Acts and as applied by any Order in Council made thereunder, shall be construed as applying to trade marks registrable under this Act.

Registration of foreign and colonial trade marks, Chap. XX., p. 576.

Secs. 103 and 104 of the Patents, &c. Act, 1883, and the amending section are

repealed by the Patents and Designs Act, 1907, and replaced by sec. 91 of that Act, which so far as relates to trade marks is set out above, p. 577.

The International Conventions of 1883 (signed at Paris, March 20th, 1883, ratified June 6th, 1884) and 1891 (signed at Madrid, April 14th, 1891, ratified June 15th, 1892) are printed at p. 743, and the list of foreign States and British Possessions to which sec. 91 is applicable at p. 741.

Definition of "British Possession," Patents and Designs Act, 1907, sec. 93.

Great Britain did not sign the arrangement relating to the International Registration of trade marks of 1891.

*Offences.*

**66.** If any person makes or causes to be made a false entry in the register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

Falsification of entries in register.

Page 585.

**67.** (1) Any person who represents a trade mark as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

Penalty on falsely representing a trade mark as registered.

(2) A person shall be deemed, for the purposes of this enactment, 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.

Page 584. Cf. Rule 11, p. 657.

*Royal Arms.*

**68.** If any person, without the authority of His Majesty, uses in connection with any trade, business, calling, or profession, the Royal Arms (or arms so closely resembling the same as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised so to use the Royal Arms, or if any person without the authority of His Majesty or of a member of the Royal Family, uses in connection with any trade, business, calling, or profession any device, emblem, or title in such manner as to be calculated to lead to the belief that he is employed by or supplies goods to His Majesty or such member of the Royal Family, he may, at the suit of any person who is authorised to use such arms or such device, emblem, or title, or is authorised by the Lord Chamberlain to take proceedings in that behalf, be restrained by injunction or interdict from continuing so to use the same: Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing any such arms, device, emblem, or title to continue to use such trade mark.

Unauthorised assumption of Royal Arms.

Pages 386 and 535.

*Courts.*

**69.** The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in any proceedings relating to trade marks: and with reference to any such

General saving for jurisdiction of Court.

proceedings in Scotland the term "the Court" shall mean the Court of Session; and with reference to any such proceedings in Ireland the term "the Court" shall mean the High Court of Justice in Ireland.

"The Court" is by sec. 3 defined to mean (subject to the provisions for Scotland, Ireland and the Isle of Man) the High Court of Justice in England.

As to rectification of the Register in or under proceedings in Scotland or Ireland, see p. 303.

Isle of Man.

**70.** This Act shall extend to the Isle of Man, and—

- (1) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man in proceedings for infringement or in any action or proceeding respecting a trade mark competent to those Courts:
- (2) The punishment for a misdemeanor under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour and with or without a fine not exceeding one hundred pounds, at the discretion of the Court:
- (3) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Pages 94, 303.

Jurisdiction of Lancashire Palatine Court.

**71.** The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade marks, the registration whereof is applied for in the Manchester Branch, have the like jurisdiction under this Act as His Majesty's High Court of Justice in England, and the expression "the Court" in this Act shall be construed and have effect accordingly:

Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that Court in other cases.

"The Manchester Branch," Chap. VII., p. 121.

"Other proceeding" includes the special jurisdiction on rectification under sec. 35, and also jurisdiction upon appeals under sec. 64 (5).

Offences in Scotland.

**72.** In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the Sheriff Court.

#### *Repeal ; Savings.*

Repeal and saving for rules, &c.

**73.** The enactments described in the schedule to this Act are repealed to the extent mentioned in the third column, but this repeal shall not affect any rule, table of fees, or classification of goods made under any enactment so repealed, but every such rule, table of fees, or classification of goods shall continue in force as if made under this Act until superseded by rules, tables of fees, or classification under this Act.

The repeal is of all parts of the Acts of 1883 and 1888, which relate to trade marks, except secs. 103 and 104 (International and Colonial Arrangements) which are now repealed and are replaced by sec. 91 of the Patents and Designs Act, 1907, sec. 106 (penalty on unauthorised use of Royal Arms, replaced by sec. 90 of the Patents

and Designs Act, 1907 (see also sec. 68 of the Act of 1905), and secs. 82, 83 and 84, which related to the constitution and seal of the Patent Office, which are now replaced by secs. 62, 63 and 64 of the Patents and Designs Act, 1907.

The former rules of 1890, and the amending rules of 1897 and 1898, and the forms, table of fees, and classification of goods thereunder, were from March 31st, 1906, superseded by the Trade Mark Rules, 1906, with new forms, table of fees and classification; these are printed below, pp. 655 to 701.

The commencement of the Act, except where otherwise provided, was April 1st, 1906.

The general saving provisions of sec. 38 of the Interpretation Act, 1889, apply, see p. 654.

74. The provisions of sections eighty-two to eighty-four of the Patents, Designs, and Trade Marks Act, 1883, as amended by any subsequent enactment, shall continue to apply with respect to the administration at the Patent Office of the Law relating to the registration of trade marks, and shall accordingly be construed as if this Act formed part of that Act.

Application of  
46 & 47 Vict.  
c. 57, ss. 82-84.

See notes to sec. 73.

SCHEDULE.

Section 73.

ENACTMENTS REPEALED.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Sections sixty-two to eighty-one, and, so far as they respectively relate to trade marks, sections eighty-five to ninety-nine, one hundred and one, one hundred and two, one hundred and five, one hundred and eight, and one hundred and eleven to one hundred and seventeen.
51 & 52 Vict. c. 50.	The Patents, Designs, and Trade Marks Act, 1888.	Sections eight to twenty, and, so far as they respectively relate to trade marks, sections twenty-one to twenty-six.

## APPENDIX IV.

### THE PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.<sup>1</sup>

AS AMENDED BY THE ACT OF 1888.

#### ARRANGEMENT OF SECTIONS.

SECTION

#### PART I.—PRELIMINARY.

1. Short title.
2. Division of Act into parts.
3. Commencement of [the Acts].

#### PART IV.—TRADE MARKS.

##### *Registration of Trade Marks.*

62. Application for registration.
63. Limit of time for proceeding with application.
64. Conditions of registration of trade mark.
65. Connexion of trade mark with goods.
66. Registration of a series of marks.
67. Trade marks may be registered in any colour.
68. Advertisement of application.
69. Opposition to registration.
70. Assignment and transmission of trade mark.
71. Conflicting claims to registration.
72. Restrictions on registration.
73. Further restriction on registration.
74. Saving for power to provide for entry on Register of common marks as additions to trade marks.

##### *Effect of Registration.*

75. Registration equivalent to public use.
76. Right of first proprietor to exclusive use of trade mark.
77. Restrictions on actions for infringement, and on defence to action in certain cases.
- [77a. Certificate as to exclusive use and costs thereon.]

##### *Register of Trade Marks.*

78. Register of trade marks.
79. Removal of trade mark after fourteen years unless fee paid.

##### *Fees.*

80. Fees for registration, &c.

##### *Sheffield Marks.*

81. Registration by Cutlers' Company of Sheffield marks.

<sup>1</sup> Now repealed by the Act of 1905, or, as to sections not so repealed, namely, sections 82 to 84, 103, 104, and 106, by the Patents and Designs Act, 1907. For tables of corresponding sections see above, pp. 592 *et seq.*

PART V.—GENERAL.

- SECTION *Patent Office and Proceedings hereat.*
- 82. Patent Office.
  - 83. Officers and clerks.
  - 84. Seal of Patent Office.
  - 85. Trust not to be entered in Registers.
  - 86. Refusal to grant patent, &c. in certain cases.
  - 87. Entry of assignments and transmissions in Registers.
  - 88. Inspection of and extracts from Registers.
  - 89. Sealed copies to be received in evidence.
  - 90. Rectification of Registers by court.
  - 91. Power for Comptroller to correct clerical errors.
  - 92. Alteration of registered mark.
  - 93. Falsification of entries in Registers.
  - 94. Exercise of discretionary power by Comptroller.
  - 95. Power of Comptroller to take directions of law officers.
  - 96. Certificate of Comptroller to be evidence.
  - 97. Applications and notices by post.
  - 98. Provision as to days for leaving documents at office.
  - 99. Declaration by infant, lunatic, &c.
  - 100. Transmission of certified printed copies of specifications, &c.
  - 101. Power for Board of Trade to make general rules for classifying goods and regulating business of patent office.
  - 102. Annual reports of Comptroller.
  - [102a. Proceedings of Board of Trade.]

*International and Colonial Arrangements.*

- 103. International arrangements for protection of inventions, designs, and trade marks.
- 104. Provision for colonies and India.

*Offences.*

- 105. Penalty on falsely representing articles to be patented.
- 106. Penalty on unauthorised assumption of Royal arms.

*Scotland ; Ireland ; &c.*

- 107. Saving for courts in Scotland.
- 108. Summary proceedings in Scotland.
- 109. Proceedings for revocation of patent in Scotland.
- 110. Reservation of remedies in Ireland.
- 111. General saving for jurisdiction of courts.
- 112. Isle of Man.
- [112a. Jurisdiction of Lancashire Palatine Court.]

*Repeal ; Transitional Provisions ; Savings.*

- 113. Repeal and saving for past operation of repealed enactments, &c.
- 114. Former Registers to be deemed continued.
- 115. Saving for existing rules.
- 116. Saving for prerogative.

*General Definitions.*

- 117. General definitions.

The FIRST SCHEDULE.—Forms of application, &c.

The THIRD SCHEDULE.—Enactments repealed.

46 & 47 VICT. c. 57.

*An Act to amend and consolidate the Law relating to Patents for Inventions, Registration of Designs, and of Trade Marks.*  
[25th August, 1883.]

51 & 52 VICT. c. 50.

*An Act to amend the Patents, Designs, and Trade Marks Act, 1883.*  
[24th December, 1888.]

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\* \* The general text of the Act of 1883 is adhered to. The parts repealed by the Act of 1888 are printed in italics, and the additions in square brackets. The amending Act and section are quoted in the margin. The whole Act is now repealed, see above, p. 626, n. (1); for tables of corresponding sections of the Act of 1905 and of the repealed Acts, see above, pp. 592 and 595.

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BE it enacted by the Queen's Most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :

#### PART I.—PRELIMINARY.

Short title:

1. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1883.

Division of Act into parts.

2. This Act is divided into parts, as follows :—

Part I.—PRELIMINARY.

II.—PATENTS.

III.—DESIGNS.

IV.—TRADE MARKS.

V.—GENERAL.

Commence-  
ment of Act.

3. This Act, except where it is otherwise expressed, shall commence from and immediately after the thirty-first day of December one thousand eight hundred and eighty-three.

Act, 1888,  
s. 28.

[The Act of 1888 shall, except so far as is thereby otherwise specially provided, commence and come into operation on the first day of January one thousand eight hundred and eighty-nine.]

#### PART IV.—TRADE MARKS.

##### *Registration of Trade Marks.*

Application  
for registra-  
tion.

62. (1.) The Comptroller may, on application by or on behalf of any person claiming to be the proprietor of a trade mark, register the trade mark.

(2.) The application must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed, and must be left at, or sent by post to *the Patent Office in the prescribed manner* [such place and in such manner as may be prescribed].

Act, 1888,  
s. 8.

(3.) The application must be accompanied by the prescribed number of representations of the trade mark, and must state the particular



goods or classes of goods in connexion with which the applicant desires the trade mark to be registered.

(4.) The Comptroller may, if he thinks fit, refuse to register a trade mark, but any such refusal shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the Comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(5.) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court; and in that event the Court shall have jurisdiction to hear and determine the appeal and may make such order as aforesaid.

[(6.) Where an applicant for the registration of a trade mark otherwise than under an international convention is out of the United Kingdom at the time of making the application he shall give the Comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given.]

Act, 1888,  
s. 8.

**63.** Where registration of a trade mark has not been or shall not be completed within twelve months from the date of the application, by reason of default on the part of the applicant, *the application shall be deemed to be abandoned* [the Comptroller shall give notice of the non-completion to the agent employed on behalf of the applicant, and, if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant, and if at the expiration of the latter fourteen days, or such further time as the Comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned].

Limit of time for proceeding with application.  
Act, 1888,  
s. 9.

**64.** (1.) *For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars:—*

Conditions of registration of trade mark.  
Repealed.  
Act, 1888,  
s. 10.

(a) *A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner, or*

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

(c) *A distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use.*

(2.) *There may be added to any one or more of these particulars any letters, words, or figures, or combination of letters, words, or figures, or of any of them.*

(3.) *Provided that any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures used as a trade mark before the thirteenth day of August one thousand eight hundred and seventy-five may be registered as a trade mark under this part of this Act.*

**64.** [(1.) *For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars:—*

Conditions of registration of trade mark.  
Act, 1888,  
s. 10.

(a) *A name of an individual or firm printed, impressed, or woven in some particular or distinctive manner; or*

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

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

(d) *An invented word or invented words; or*

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

[(2.) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them, but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the Register.]

[(3.) Provided as follows :

(i) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof :

(ii) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures, used as a trade mark before the thirteenth day of August one thousand eight hundred and seventy-five, may be registered as a trade mark under this part of this Act.]

**65.** A trade mark must be registered for particular goods or classes of goods.

**66.** When a person claiming to be the proprietor of several trade marks which, while resembling each other in the material particulars thereof, yet differ in respect of (a) the statement of the goods for which they are respectively used or proposed to be used, or (b) statements of numbers, or (c) statements of price, or (d) statements of quality, or (e) statements of names of places, seeks to register such trade marks, they may be registered as a series in one registration. A series of trade marks shall be assignable and transmissible only as a whole, but for all other purposes each of the trade marks composing a series shall be deemed and treated as registered separately.

**67.** A trade mark may be registered in any colour [or colours], and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour [or colours].

**68.** Every application for registration of a trade mark under this part of this Act shall as soon as may be after its receipt be advertised by the Comptroller [unless the Comptroller refuse to entertain the application].

**69.** (1.) Any person may within *two months* [one month or such further time, not exceeding three months, as the Comptroller may allow] of the *first* advertisement of the application, give notice in duplicate at the Patent Office of opposition to registration of the trade mark, and the Comptroller shall send one copy of such notice to the applicant.

(2.) Within *two months* [one month] after receipt of such notice or such further time as the Comptroller may allow, the applicant may send to the Comptroller a counter statement in duplicate of the grounds on which he relies for his application, and if he does not do so, shall be deemed to have abandoned his application.

(3.) *If the applicant sends such counter statement, the Comptroller shall furnish a copy thereof to the person who gave notice of opposition, and*

Connection of trade mark with goods.

Registration of a series of marks.

Trade marks may be registered in any colour.

Act, 1888, s. 11.

Advertisement of application.

Act, 1888, s. 12.

Opposition to registration.

Act, 1888, s. 13,

sub-ss. 1, 2.

Act, 1888,

s. 13, sub-s. 3.

Repealed.

shall require him to give security in such manner and to such amount as the Comptroller may require for such costs as may be awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement was made or such further time as the Comptroller may allow, the opposition shall be deemed to be withdrawn.

Act, 1888,  
s. 13, sub-s. 4.

(4.) If the person who gave notice of opposition duly gives such security as aforesaid, the Comptroller shall inform the applicant thereof in writing, and thereupon the case shall be deemed to stand for the determination of the Court.

[(3.) If the applicant sends such counter statement the Comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall, after hearing the applicant and the opponent, if so required, decide whether the trade mark is to be registered, but his decision shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the opponent and the Comptroller, and may make an order determining whether, and subject to what conditions (if any), registration is to be permitted.]

Act, 1888,  
s. 13, sub-s. 4.

[(4.) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court, and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid.]

[(5.) If the applicant abandons his application after notice of opposition in pursuance of this section, he shall be liable to pay to the opponent such costs in respect of the opposition as the Comptroller may determine to be reasonable.]

[(6.) Where the opponent is out of the United Kingdom, he shall give the Comptroller an address for service in the United Kingdom.]

**70.** A trade mark, when registered, shall be assigned and transmitted only in connexion with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that goodwill.

Assignment and transmission of trade mark.

**71.** Where each of several persons claims to be registered as proprietor of the same trade mark, the Comptroller may refuse to register any of them until their rights have been determined according to law, and the Comptroller may himself submit or require the claimants to submit their rights to the Court.

Conflicting claims to registration.

**72.** (1.) Except where the Court has decided that two or more persons are entitled to be registered as proprietors of the same trade mark, the Comptroller shall not register in respect of the same goods or description of goods a trade mark identical with one already on the register with respect to such goods or description of goods.

Restrictions on registration.

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

Act, 1888,  
s. 14.

**73.** It shall not be lawful to register as part of or in combination with a trade mark any words the exclusive use of which would by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a court of justice, or any scandalous design.

Further restriction on registration.  
Act, 1888,  
s. 15.

**74.** (1.) Nothing in this Act shall be construed to prevent the Comptroller entering on the Register, in the prescribed manner, and

Saving for power to pro-

vide for entry on Register of common marks as additions to trade marks.

subject to the prescribed conditions, as an addition to any trade mark—

(a) In the case of an application for registration of a trade mark used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive device, mark, brand, heading, label, ticket, letter, word, or figure, or combination of letters, words, or figures, though the same is common to the trade in the goods with respect to which the application is made ;

(b) In the case of an application for registration of a trade mark not used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive word or combination of words, though the same is common to the trade in the goods with respect to which the application is made ;

Repealed.  
Act, 1888,  
s. 16.

(2.) *The applicant for entry of any such common particular or particulars must, however, disclaim in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the Register.*

Act, 1888,  
s. 16.

[(2.) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the Register.

Provided that a person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof.]

(3.) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words, or figures, which was or were, before the thirteenth day of August one thousand eight hundred and seventy-five, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods.

#### *Effect of Registration.*

Registration equivalent to public use.  
Act, 1888,  
s. 17.

**75.** *Registration of a trade mark shall be deemed to be equivalent to public use of the trade mark.*

[Application for registration of a trade mark shall be deemed to be equivalent to public use of the trade mark, and the date of the application shall for the purposes of this Act be deemed to be, and as from the first day of January one thousand eight hundred and seventy-six to have been, the date of the registration.]

Right of first proprietor to exclusive use of trade mark.

**76.** The registration of a person as proprietor of a trade mark shall be prima facie evidence of his right to the exclusive use of the trade mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade mark, subject to the provisions of this Act.

Restrictions on actions for infringement,

**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.

and on defence to action in certain cases.

[77a. In an action for infringement of a registered trade mark the Court or a judge may certify that the right to the exclusive use of the trade mark came in question, and if the Court or a judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or judge trying the subsequent action certifies that he ought not to have the same.]

Certificate as to exclusive use and costs thereon.

Act, 1888, s. 18.

*Register of Trade Marks.*

78. There shall be kept at the patent office a book called the Register of Trade Marks, wherein shall be entered the names and addresses of proprietors of registered trade marks, notifications of assignments and of transmissions of trade marks, and such other matters as may be from time to time prescribed.

Register of trade marks.

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

Removal of trade mark after fourteen years, unless fee paid.

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

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

(4.) Where after the said three months a trade mark has been removed from the Register for non-payment of the prescribed fee, the Comptroller may, if satisfied that it is just so to do, restore such trade mark to the Register on payment of the prescribed additional fee.

(5.) Where a trade mark has been removed from the Register for non-payment of the fee or otherwise, such trade mark shall nevertheless for the purpose of any application for registration during *the five years* [one year] next after the date of such removal, be deemed to be a trade mark which is already registered [unless it is shown to the satisfaction of the Comptroller that the non-payment of the fee arises

Act, 1888, s. 19, sub-s. 1.

Act, 1888, s. 19, sub-s. 2.

from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade mark].

*Fees.*

Fees for  
registration,  
&c.

**80.** There shall be paid in respect of applications and registration and other matters under this part of this Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of her Majesty's Exchequer in such manner as the Treasury may from time to time direct.

*Sheffield Marks.*

Registration  
by Cutlers'  
Company of  
Sheffield  
marks.

**81.** With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called the Cutlers' Company) and the marks or devices (in this Act called Sheffield marks) assigned or registered by the master, wardens, searchers, and assistants of that company, the following provisions shall have effect:

Act, 1888,  
s. 20, sub-s. 1.

(1.) The Cutlers' Company shall establish and keep at Sheffield a new Register of trade marks (in this Act called the Sheffield Register):

(2.) *The Cutlers' Company shall enter in the Sheffield Register, in respect of cutlery, edge tools, or raw steel and the goods mentioned in the next sub-section all the trade marks entered before the commencement of this Act in respect of cutlery, edge tools, or raw steel and such goods in the Register established under the Trade Marks Registration Act, 1875, belonging to persons carrying on business in Hallamshire, or within six miles thereof, and shall also enter in such Register, in respect of the same goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the commencement of this Act, but which have not been entered in the Register established under the Trade Marks Registration Act, 1875:*

Act, 1888,  
s. 20, sub-s. 1.

[(2.) The Cutlers' Company shall enter in the Sheffield Register, in respect of metal goods as defined in this section, all the trade marks entered before the first day of January one thousand eight hundred and eighty-nine in respect of metal goods either in the Register established under the Trade Marks Registration Act, 1875, or in the Register of trade marks under this Act, belonging to persons carrying on business in Hallamshire or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield Register, in respect of metal goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January one thousand eight hundred and eighty-four, but which have not been entered in either of the said other Registers:]

38 & 39 Vict.  
c. 91.

(3.) An application for registration of a trade mark used *on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel*

*and iron combined, whether with or without a cutting edge* [on metal goods] shall, if made after the commencement of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company : Act, 1888,  
s. 20, sub-s. 2.

(4.) Every application so made to the Cutlers' Company shall be notified to the Comptroller in the prescribed manner, and unless the Comptroller within the prescribed time gives notice to the Cutlers' Company that he objects to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner :

(5.) If the Comptroller gives notice of objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the Court :

(6.) Upon the registration of a trade mark in the Sheffield Register the Cutlers' Company shall give notice thereof to the Comptroller, who shall thereupon enter the mark in the Register of trade marks; and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the Comptroller on that day :

(7.) *The provisions of this Act, and of any general rules made under this Act, with respect to application for registration in the register of trade marks, the effect of such registration, and the assignment and transmission of rights in a registered trade mark shall apply in the case of applications and registration in the Sheffield Register; and notice of every entry made in the Sheffield Register must be given to the Comptroller by the Cutlers' Company, save and except that the provisions of this sub-section shall not prejudice or affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield Register :* Act, 1888,  
s. 20, sub-s. 3.

[(7.) The provisions of this Act and of any general rules made under this Act with respect to the registration of trade marks, and all matters relating thereto, shall, subject to the provisions of this section, apply to the registration of trade marks on metal goods by the Cutlers' Company, and to all matters relating thereto; and this Act and any such general rules shall, so far as applicable, be construed accordingly with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield Register, for the Comptroller, the Patent Office, and the Registrar of Trade Marks, respectively; and notice of every entry, cancellation, or correction made in the Sheffield Register shall be given to the Comptroller by the Cutlers' Company: provided that this section shall not affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield Register :]

(8.) Where the Comptroller receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade mark used *on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel*

Act, 1888,  
s. 20, sub-s. 2.

- and iron combined, whether with or without a cutting edge* [on metal goods], he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company :
- (9.) At the expiration of five years from the commencement of this Act the Cutlers' Company shall close the Cutlers' register of corporate trade marks, and thereupon all marks entered therein shall, unless entered in the Sheffield Register, be deemed to have been abandoned :
- (10.) A person may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield Register as proprietor of two or more trade marks :
- (11.) A body of persons, corporate or not corporate, may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield Register as proprietor of a trade mark or trade marks :
- (12.) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the Comptroller, who shall have power to confirm, reverse or modify the decision, but the decision of the Comptroller shall be subject to a further appeal to the Court :
- (13.) So much of the Cutlers' Company's Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate marks, that is to say, the fifth section of the Cutlers' Company's Act of 1814, and the provisions in relation to the recovery and application of the penalty imposed by such last-mentioned section contained in the Cutlers' Company's Act of 1791, shall apply to any mark entered in the Sheffield Register :
- Act, 1888,  
s. 20, sub-s. 4. [(14.) For the purposes of this section the expression "metal goods" means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal.]
- [(15.) For the purpose of legal proceedings in relation to trade marks entered in the Sheffield Register a certificate under the hand of the master of the Cutlers' Company shall have the same effect as the certificate of the Comptroller.]

#### PART V.—GENERAL.

##### *Patent Office and Proceedings thereat.*

Patent Office.

**82.** (1.) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.

(2.) Until a new patent office is provided, the offices of the Commissioners of Patents for inventions and for the registration of designs and trade marks existing at the commencement of this Act shall be the patent office within the meaning of this Act.

(3.) The Patent Office shall be under the immediate control of an officer called the Comptroller-General of patents, designs, and trade



marks, who shall act under the superintendence and direction of the Board of Trade.

(4.) Any act or thing directed to be done by or to the Comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorised by the Board of Trade.

83. (1.) The Board of Trade may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the Comptroller-General of patents, designs, and trade marks, and so many examiners and other officers and clerks with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

Officers and clerks.

(2.) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by Parliament.

84. There shall be a seal for the Patent Office, and impressions thereof shall be judicially noticed and admitted in evidence.

Seal of patent office.

85. There shall not be entered in any Register kept under this Act, or be receivable by the Comptroller, any notice of any trust expressed, implied, or constructive.

Trust not to be entered in Registers.

86. The Comptroller may refuse to grant a patent for an invention, or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality.

Refusal to grant patent, &c. in certain cases.

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade mark, the Comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design, or trade mark, in the Register of patents, designs, or trade marks, as the case may be. The person for the time being entered in the Register of patents, designs, or trade marks, as proprietor of a patent, copyright in a design or trade mark, as the case may be, shall, subject to [the provisions of this Act and to] any rights appearing from such Register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the same and to give effectual receipts for any consideration for such assignment, licence, or dealing. Provided that any equities in respect of such patent, design, or trade mark may be enforced in like manner as in respect of any other personal property.

Entry of assignments and transmissions in Registers.

Act, 1888, s. 21.

88. Every Register kept under this Act shall at all convenient times be open to the inspection of the public, subject to [the provisions of this Act and to] such regulations as may be prescribed; and certified copies, sealed with the seal of the patent office, of any entry in such Register shall be given to any person requiring the same on payment of the prescribed fee.

Inspection of and extracts from Registers.

Act, 1888, s. 22.

89. Printed or written copies or extracts, purporting to be certified by the Comptroller and sealed with the seal of the patent office, of or from patents specifications disclaimers and other documents in the patent office, and of or from Registers and other books kept there, shall be admitted in evidence in all Courts in her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

Sealed copies to be received in evidence.

Rectification  
of Registers  
by Court.  
Act, 1888,  
s. 23.

**90.** (1.) The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person [or of any other particulars] from any Register kept under this Act, or by any entry made without sufficient cause in any such Register, make such order for making, expunging, or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.

(2.) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for the rectification of a Register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

(3.) Any order of the Court rectifying a Register shall direct that due notice of the rectification be given to the Comptroller.

Power for  
Comptroller  
to correct  
clerical errors.

**91.** The Comptroller may, on request in writing accompanied by the prescribed fee—

(a) Correct any clerical error in or in connexion with an application for a patent, or for registration of a design or trade mark; or

(b) Correct any clerical error in the name, style, or address of the registered proprietor of a patent, design, or trade mark.

(c) Cancel the entry or part of the entry of a trade mark on the Register: provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on the Register as the proprietor of the said trade mark.

Act, 1888,  
s. 24.

[(d) Permit an applicant for registration of a design or trade mark to amend his application by omitting any particular goods or classes of goods in connexion with which he has desired the design or trade mark to be registered.]

Alteration of  
registered  
mark.

**92.** (1.) The registered proprietor of any registered trade mark may apply to the Court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act, and the Court may refuse or grant leave on such terms as it may think fit.

(2.) Notice of any intended application to the Court under this section shall be given to the Comptroller by the applicant; and the Comptroller shall be entitled to be heard on the application.

(3.) If the Court grants leave, the Comptroller shall, on proof thereof and on payment of the prescribed fee, cause the Register to be altered in conformity with the order of leave.

Falsification  
of entries in  
Registers.

**93.** If any person makes or causes to be made a false entry in any Register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such Register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanour.

Exercise of  
discretionary  
power by  
Comptroller.

**94.** Where any discretionary power is by this Act given to the Comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

**95.** The Comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers for directions in the matter.

Power of Comptroller to take directions of law officers.

**96.** A certificate purporting to be under the hand of the Comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

Certificate of Comptroller to be evidence.

**97.** (1.) Any application, notice, or other document authorised or required to be left, made, or given at the patent office or to the Comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

Applications and notices by post.

(2.) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

**98.** Whenever the last day fixed by this Act, or by any Rule for the time being in force, for leaving any document or paying any fee at the patent office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days if two or more of them occur consecutively.

Provision as to days for leaving documents at office.

**99.** If any person is, by reason of infancy, lunacy or other inability, incapable of making any declaration or doing anything required or permitted by this Act or by any Rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed by any Court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted.

Declaration by infant, lunatic, &c.

**100.** Copies of all specifications, drawings, and amendments left at the patent office after the commencement of this Act, printed for and sealed with the seal of the patent office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the patent office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

Transmission of certified printed copies of specifications, &c.

**101.** (1.) The Board of Trade may from time to time make such general rules and do such things as they think expedient, subject to the provisions of this Act—

Power for Board of Trade to make general rules for classifying

(a) For regulating the practice of registration under this Act :

goods and  
regulating  
business of  
patent office.

- (b) For classifying goods for the purposes of designs and trade marks :
- (c) For making or requiring duplicates of specifications, amendments, drawings, and other documents :
- (d) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, amendments and other documents :
- (e) For securing and regulating the making, printing, publishing and selling of indexes to, and abridgments of, specifications and other documents in the patent office ; and providing for the inspection of indexes and abridgments and other documents :
- (f) For regulating (with the approval of the Treasury) the presentation of copies of patent office publications to patentees and to public authorities, bodies and institutions at home and abroad :
- (g) Generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the Comptroller, or of the Board of Trade.

(2.) Any of the forms in the First Schedule to this Act may be altered or amended by rules made by the Board as aforesaid.

(3.) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.

(4.) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the Comptroller.

(5.) If either House of Parliament, within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.

**102.** The Comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

[**102a.** (1.) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.]

[(2.) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in

Annual  
reports of  
Comptroller.

Proceedings  
of Board of  
Trade.

Act, 1888,  
s. 25.

evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.]

[(3.) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.]

*International and Colonial Arrangements.*

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

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

Act, 1885, s. 6.

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

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade mark in this country, as the case may be.

(2.) The publication in the United Kingdom, or the Isle of Man, during the respective periods aforesaid, of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade mark:

(3.) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act: provided that, in the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under this Act:

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

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

Provision for colonies and India.

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

*Offences.*

Penalty on falsely representing articles to be patented.

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

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

Penalty on unauthorised assumption of Royal arms.

**106.** Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any Government Department, assumes or uses in connexion with any trade, business, calling, or profession, the Royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds.

*Scotland, Ireland, &c.*

Saving for Courts in Scotland.

**107.** In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the Court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the Courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those Courts.

For the purposes of this section "Court of Appeal" shall mean any Court to which such action is appealed.

Summary proceedings in Scotland.

**108.** In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the sheriff court.

Proceedings for revocation of patent in Scotland.

**109.** (1.) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.

(2.) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

Reservation of remedies in Ireland.

**110.** All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.

General saving for jurisdiction of Courts.

**111.** (1.) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland

in any proceedings relating to patents or to designs or to trade marks ; and with reference to any such proceedings in Scotland, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either division of the said Court ; and with reference to any such proceedings in Ireland, the terms "the Court" and "the Court of Appeal" respectively mean the High Court of Justice in Ireland and Her Majesty's Court of Appeal in Ireland.

(2.) If any rectification of a Register under this Act is required in pursuance of any proceeding in a Court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification, shall be served on the Comptroller, and he shall rectify the Register accordingly.

**112.** This Act shall extend to the Isle of Man, and—

Isle of Man.

(1.) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade mark competent to those Courts ;

(2.) The punishment for a misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court ;

(3.) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

[**112a.** The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade marks the registration whereof is applied for in the Manchester Office, have the like jurisdiction under this Act as Her Majesty's High Court of Justice in England, and the expression "the Court" in this Act shall be construed and have effect accordingly.

Jurisdiction of Lancashire Palatine Court.

Act, 1888, s. 26.

Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that Court in other cases.]

*Repeal, Transitional Provisions, Savings.*

**113.** The enactments described in the Third Schedule to this Act are hereby repealed. But this repeal of enactments shall not—

Repeal and saving for past operation of repealed enactments, &c

(a) Affect the past operation of any of those enactments, or any patent or copyright or right to use a trade mark granted or acquired, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act ; or

(b) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed ; or

(c) Take away or abridge any protection or benefit in relation to any such action or proceeding.

Former  
Registers to  
be deemed  
continued.

**114.** (1.) The Registers of patents and of proprietors kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the Register of patents kept under this Act.

(2.) The Registers of designs and of trade marks kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the Register of designs and the Register of trade marks kept under this Act.

Saving for  
existing rules.

**115.** All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed altered or amended by the Board of Trade, as if they had been made by the Board under this Act, but so that no such repeal alteration or amendment shall take effect before the commencement of this Act; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act.

Saving for  
prerogative.

**116.** Nothing in this Act shall take away abridge or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

#### *General Definitions.*

General  
definitions.

**117.** (1.) In and for the purposes of this Act, unless the context otherwise requires,—

“Person” includes a body corporate:

“The Court” means (subject to the provisions for Scotland, Ireland, and the Isle of Man) Her Majesty’s High Court of Justice in England:

“Law officer” means Her Majesty’s Attorney-General or Solicitor-General for England:

“The Treasury” means the Commissioners of Her Majesty’s Treasury:

“Comptroller” means the Comptroller General of Patents, Designs, and Trade Marks.

“Prescribed” means prescribed by any of the Schedules to this Act, or by general rules under or within the meaning of this Act:

“British possession” means any territory or place situate within Her Majesty’s dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man, and all territories and places under one legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act:

“Legislature” includes any person or persons who exercise legislative authority in the British possession; and where there are local legislatures as well as a central legislature, means the central legislature only.

In the application of this Act to Ireland, “summary conviction” means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District, the Acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.



SCHEDULES.

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THE FIRST SCHEDULE.

FORMS OF APPLICATION, &c.

FORM F.

Section 62.

FORM OF APPLICATION FOR REGISTRATION OF TRADE MARK.

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THE THIRD SCHEDULE.

*Enactments repealed.*

Section 113.

- 38 & 39 Vict. c. 91. The Trade Marks Registration Act, 1875.  
[1875.]
- 39 & 40 Vict. c. 33. The Trade Marks Registration Amendment Act, 1876.  
[1876.]
- 40 & 41 Vict. c. 37. The Trade Marks Registration Extension Act, 1877.  
[1877.]

## APPENDIX V.

### THE TRADE MARKS REGISTRATION ACTS, 1875—77.

#### THE TRADE MARKS REGISTRATION ACT, 1875.

38 & 39 VICT. C. 91.

An Act to establish a Register of Trade Marks.

[13th August, 1875.]

*Be it enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:—*

Registration  
of trade  
marks.

**1.** *A Register of trade marks as defined by this Act, and of the proprietors thereof shall be established under the superintendence of the Commissioners of Patents, and from and after the first day of July one thousand eight hundred and seventy-six a person shall not be entitled to institute any proceeding to prevent the infringement of any trade mark as defined by this Act until and unless such trade mark is registered in pursuance of this Act.*

Character-  
istics of  
registered  
trade mark.

**2.** *A trade mark must be registered as belonging to particular goods, or classes of goods; and when registered shall be assigned and transmitted only in connection with the goodwill of the business concerned in such particular goods or classes of goods, and shall be determinable with such goodwill, but subject as aforesaid registration of a trade mark shall be deemed to be equivalent to public use of such mark.*

Title of first  
proprietor of  
a trade mark.

**3.** *The registration of a person as first proprietor of a trade mark shall be prima facie evidence of his right to the exclusive use of such trade mark, and shall, after the expiration of five years from the date of such registration, be conclusive evidence of his right to the exclusive use of such trade mark, subject to the provisions of this Act as to its connection with the goodwill of a business.*

Title of  
proprietor  
claiming by  
transmitted  
proprietor-  
ship.

**4.** *Every proprietor registered in respect to a trade mark subsequently to the first registered proprietor shall, as respects his title to that trade mark, stand in the same position as if his title were a continuation of the title of the first registered proprietor.*

Rectification  
of Register.

**5.** *If the name of any person who is not for the time being entitled to the exclusive use of a trade mark in accordance with this Act, or otherwise in accordance with law, is entered on the Register of trade marks as a proprietor of such trade mark, or if the Registrar refuses to enter on the Register as proprietor of a trade mark the name of any person who is for*

*the time being entitled to the exclusive use of such trade mark in accordance with this Act, or otherwise in accordance with law, or if any mark is registered as a trade mark which is not authorised to be so registered under this Act, any person aggrieved may apply in the prescribed manner for an order of the Court that the Register may be rectified; and the Court may either refuse such application, or it may, if satisfied of the justice of the case, make an order for the rectification of the Register, and may award damages to the party aggrieved.*

*Where each of several persons claims to be registered as proprietor of the same trade mark, the Registrar may refuse to comply with the claims of any of such persons until their rights have been determined by the Court, and the Registrar may himself submit or require the claimants to submit in the prescribed manner their rights to the Court.*

*The Court may, in any proceeding under this section, decide any question as to whether a mark is or is not such a trade mark as is authorised to be registered under this Act, also any question relating to the right of any person who is party to such proceeding to have his name entered on the Register of trade marks, or to have the name of some other person removed from such Register, also any other question that it may be necessary or expedient to decide for the rectification of the Register.*

*The Court may direct an issue to be tried for the decision of any question of fact which may require to be decided for the purposes of this section.*

*Whenever any order has been made rectifying the Register the Court shall by its order direct that due notice of such rectification be given to the Registrar.*

*6. The Registrar shall not, without the special leave of the Court, to be given in the prescribed manner, register in respect of the same goods or classes of goods a trade mark identical with one which is already registered with respect to such goods or classes of goods, and the Registrar shall not register with respect to the same goods or classes of goods a trade mark so nearly resembling a trade mark already on the Register with respect to such goods or classes of goods as to be calculated to deceive.*

Restrictions on registry of trade marks.

*It shall not be lawful to register as part of or in combination with a trade mark any words the exclusive use of which would not, by reason of their being calculated to deceive or otherwise, be deemed entitled to protection in a Court of Equity; or any scandalous designs.*

*7. Subject as aforesaid, a Register office shall be established from and after such time (not being later than the first day of January one thousand eight hundred and seventy-six), in such manner and with such officers, and at such salaries, to be paid out of moneys provided by Parliament, as the Lord Chancellor may, with the consent of the Treasury, direct; and the Lord Chancellor may from time to time, with the assent of the Treasury as to fees, make, and, when made, alter, annul, or vary, such general rules as to the registry of trade marks, and as to notices to be given by advertisement before the registration of trade marks, and as to the classification of goods for the purposes of this Act, and as to the registration of first and subsequent proprietors of trade marks, and as to the fees to be charged for registration, and also for the continuance of a trade mark on the Register or otherwise, and as to the removal from the Register of any trade mark, as to notices, and as to the persons entitled to inspect the Register, and as to any proceedings to be taken to obtain the judgment or leave of the Court in*

Establishment of registry and general rules.

any matter in which the judgment or leave of the Court is required to be obtained under this Act, and generally for the purpose of carrying into effect this Act, as he may deem expedient.

Any rules made in pursuance of this section shall be laid before both Houses of Parliament if Parliament be then sitting, or if not then sitting, then within ten days from the then next assembling of Parliament, and shall be of the same validity as if they had been enacted by Parliament; provided that if either House of Parliament resolve, within one month after such rules have been laid before such House, that any of such rules ought not to continue in force, any rule in respect of which such resolution has been passed shall, after the date of such resolution, cease to be of any force, without prejudice, nevertheless, to the making of any other rule in its place, or to anything done in pursuance of any such rules before the date of such resolution.

Certificate of Registrar to be evidence.

8. The certificate of the Registrar as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be evidence of such entry having been made, and of the contents thereof, and of such matters and things having been done or left undone.

Provision as to Cutlers' Company and Sheffield corporate marks.

9. With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called "the Cutlers' Company"), and the marks or devices (in this Act called "Sheffield corporate marks") assigned or to be assigned by the master, wardens, searchers, and assistants of that company, be it enacted as follows:—

- (1.) Within the prescribed time and in the prescribed manner the Cutlers' Company shall at their own expense deliver to the Registrar under this Act copies of all Sheffield corporate marks in force at the time of such delivery:
- (2.) When any person, after the passing of this Act, applies to the said master, wardens, searchers, and assistants to assign to him any mark or device, notice of such application, with a copy of such mark or device, shall, within the prescribed time and in the prescribed manner, be delivered to the Registrar under this Act; and such mark or device shall not be assigned until after the expiration of the prescribed period from the giving of such notice. In like manner, when any person applies for the registration under this Act of a trade mark as belonging to any goods or class of goods specified in section two of the Cutlers' Company's Act of 1860, notice of such application, with a copy of such trade mark, shall, within the prescribed time and in the prescribed manner, be delivered to the Cutlers' Company; and such trade mark shall not be registered until after the expiration of the prescribed period from the giving of the last-mentioned notice:
- (3.) Upon the assigning of any such mark or device, or the registration of any such trade mark as aforesaid, notice of the assignment or registration shall, within the prescribed time and in the prescribed manner, be given to the Registrar under this Act, or to the Cutlers' Company, as the case may be:
- (4.) The Registrar under this Act, without the special leave of the Court, to be given only in cases where the applicant proves his right, shall not in respect of any goods or classes of goods with

respect to which a Sheffield corporate mark shall have been assigned and actually used, and of which mark a copy or description or notice of the assigning whereof shall have been delivered or given to the Registrar as aforesaid, register a trade mark identical with such Sheffield corporate mark, or so nearly resembling the same as to be calculated to deceive :

- (5.) The master, wardens, searchers, and assistants of the Cutlers' Company, shall not assign to any person a mark or device identical with any trade mark registered under this Act, and notice of the registration whereof shall have been given to the Cutlers' Company as aforesaid, or so nearly resembling the same as to be calculated to deceive :
- (6.) Any person to whom a Sheffield corporate mark legally belongs shall be entitled to have the same mark registered also as a trade mark under this Act, in respect of any particular goods or classes of goods, in the same manner and upon the same terms and conditions in and upon which he might have registered the same if it were not a Sheffield corporate mark :
- (7.) Nothing in this Act shall prejudice or affect the rights and privileges of the Cutlers' Company, nor, save as is otherwise in this Act expressly provided, shall any of the provisions of this Act apply to or in the case of any Sheffield corporate mark.

**10.** For the purposes of this Act—

Definitions.

A trade mark consists of one or more of the following essential particulars ; that is to say,

A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner ; or

A written signature or copy of a written signature of an individual or firm ; or

A distinctive device, mark, heading, label, or ticket ;

and there may be added to any one or more of the said particulars any letters, words, or figures, or combination of letters, words, or figures ; also

Any special and distinctive word or words or combination of figures or letters used as a trade mark before the passing of this Act may be registered as such under this Act.

“ Prescribed ” means prescribed by general rules made in pursuance of this Act ; and

“ Court ” means any of Her Majesty's superior Courts of law or equity at Westminster, or any Court to which the jurisdiction of such Courts may be transferred, or any one or more of such Courts which may be declared to be the Court for the purposes of this Act by such general rules as aforesaid ; but the provisions of this Act conferring a special jurisdiction on the Court as above defined shall not, excepting so far as such jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in causes, actions, suits, or proceedings relating to trade marks ; and if the Register requires to be rectified in consequence of any proceedings in any such Court in Scotland or Ireland, due notice of such requirements shall be given to the Registrar, and he shall rectify the Register accordingly.

**11.** This Act may be cited for all purposes as the Trade Marks Registration Act, 1875.

Short title of Act.

**THE TRADE MARKS REGISTRATION AMENDMENT  
ACT, 1876.**

39 & 40 VICT. c. 33.

An Act for the Amendment of the Trade Marks Registration Act,  
1875. [24th July, 1876.]

38 & 39 Vict.  
c. 91.

*Whereas by the Trade Marks Registration Act, 1875, in this Act referred to as the principal Act, it is provided that from and after the first day of July one thousand eight hundred and seventy-six, a person shall not be entitled to institute any proceeding to prevent the infringement of any trade mark as defined by the principal Act until and unless such trade mark is registered in pursuance of that Act :*

*And whereas by reason of the number of trade marks, and especially by reason of the difficulties attending the registration of trade marks in relation to textile fabrics, it has been found impossible to complete the registration of existing trade marks within the time specified by the said section ; and it is therefore expedient to prolong the time for the completion of such registration as aforesaid, and otherwise to amend the principal Act :*

*Be it therefore enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :—*

Amendment  
of s. 1 of the  
principal Act.

**1.** *There shall be repealed so much of section one of the principal Act as provides that from and after the first day of July one thousand eight hundred and seventy-six, a person shall not be entitled to institute any proceeding to prevent the infringement of any trade mark as defined by that Act until and unless such trade mark is registered in pursuance of that Act, and in place thereof be it enacted that—*

*From and after the first day of July one thousand eight hundred and seventy-seven, a person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of any trade mark as defined by the principal Act until and unless such trade mark is registered in pursuance of that Act, or until and unless, with respect to any device, mark, name, combination of words, or other matter or thing in use as a trade mark before the passing of the principal Act, registration thereof as a trade mark under the principal Act shall have been refused as hereinafter is mentioned.*

Saving of  
marks and  
devices not  
capable of  
being  
registered  
under Act.

**2.** *When an application by any person to register as a trade mark a device, mark, name, word, combination of words, or other matter or thing proposed for registration as a trade mark, which has been in use as a trade mark before the passing of the recited Act, has been refused, it shall be the duty of the Registrar, on request, and on payment of the prescribed fee, to give to the applicant a certificate of such refusal, and a certificate so granted shall be conclusive evidence of such refusal.*

Short title.

**3.** *This Act may be cited for all purposes as the Trade Marks Registration Amendment Act, 1876.*

THE TRADE MARKS REGISTRATION EXTENSION  
ACT, 1877.

40 &amp; 41 VICT. c. 37.

An Act for extending the Time for the Registration of Trade Marks,  
in so far as relates to Trade Marks used in Textile Industries.

[6th August, 1877.]

Whereas by section one of the Trade Marks Registration Amendment Act, 1876, it is provided that from and after the first day of July one thousand eight hundred and seventy-seven, a person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of any trade mark as defined by the Trade Marks Registration Act, 1875 (referred to in such Amendment Act and in this Act as the principal Act), until and unless such trade mark is registered in pursuance of the principal Act, or until and unless, with respect to any device, mark, name, combination of words, or other matter or thing in use as a trade mark before the passing of the principal Act, registration thereof as a trade mark under the principal Act shall have been refused, as is in the said Act thereafter mentioned:

39 & 40 Vict.  
c. 33.38 & 39 Vict.  
c. 91.

And whereas by reason of the difficulties attending the registration of trade marks used in the textile industries it has been found impossible to complete the registration of such trade marks within the time specified by the said section, and it is therefore expedient to prolong such time as aforesaid:

Be it therefore enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

1. In so far as relates to the registration of trade marks used in the textile industries, but not further or otherwise, section one of the Trade Marks Registration Amendment Act, 1876, shall be construed as if for the words "from and after the first day of July one thousand eight hundred and seventy-seven" there were substituted the words "from and after the first day of January one thousand eight hundred and seventy-eight, or such further time as Her Majesty may by Order in Council determine."

Extension of  
time for regis-  
tration of  
trade marks  
used in textile  
industries.

2. The expression in this Act "Trade Marks used in the textile industries" means the trade marks relating to goods comprised in Classes 23 to 35, both inclusive, of the First Schedule to the Rules under the Trade Marks Registration Acts, 1875-76, dated September, 1876.

Definition of  
"trade marks  
used in the  
textile  
industries."

3. This Act may be cited for all purposes as "The Trade Marks Registration Extension Act, 1877," and this Act and the Trade Marks Registration Amendment Act, 1876, and the Trade Marks Registration Act, 1875, may be cited together as "The Trade Marks Registration Acts, 1875-77."

Short title of  
Act.

## APPENDIX VI.

### INTERPRETATION ACT, 1889, EXTRACTS FROM.

SEC. 1.—(1) In this Act and in every Act passed after the year 1850, whether before or after the commencement of this Act, unless the contrary intention appears,

(a) Words importing the masculine gender shall include females ;  
and

(b) Words in the singular shall include the plural, and words in the plural shall include the singular.

SEC. 2.—(1) In the construction of every enactment relating to an offence punishable on indictment or on summary conviction, whether contained in an Act passed before or after the commencement of this Act, the expression "person" shall, unless the contrary intention appears, include a body corporate.

SEC. 3.—In every Act passed after the year 1850, whether before or after the commencement of this Act, the following expressions shall, unless the contrary intention appears, have the meanings hereby respectively assigned to them, namely,

The expression "month" shall mean calendar month ;

The expressions "oath" and "affidavit" shall, in the case of persons for the time being allowed by law to affirm or declare instead of swearing, include affirmation and declaration, and the expression "swear" shall, in the like case, include affirm and declare.

SEC. 12.—(3) The expression "High Court," when used with reference to England or Ireland, shall mean Her Majesty's High Court of Justice in England or Ireland, as the case may be.

SEC. 14.—In every Act passed after the commencement of this Act, unless the contrary intention appears, the expression "rules of court" when used in relation to any court shall mean rules made by the authority having for the time being power to make rules or orders regulating the practice and procedure of such court, and as regards Scotland shall include Acts of adjournal and Acts of sederunt.

The power of the said authority to make rules of court as above defined shall include a power to make rules of court for the purpose of any Act passed after the commencement of this Act, and directing or authorising anything to be done by rules of court.

SEC. 19.—In this Act and in every Act passed after the commencement of this Act, the expression "person" shall, unless the contrary intention appears, include any body of persons corporate or unincorporate.

SEC. 20.—In this Act and in every other Act, whether passed before or after the commencement of this Act, expressions referring to writing



shall, unless the contrary intention appears, be construed as including references to printing, lithography, photography, and other modes of representing or reproducing words in a visible form.

Sec. 21.—In this Act and in every other Act, whether passed before or after the commencement of this Act, the expression “Statutory declaration” shall, unless the contrary intention appears, mean a declaration made by virtue of the Statutory Declarations Act, 1835.

Sec. 31.—Where any Act, whether passed before or after the commencement of this Act, confers power to make, grant, or issue any instrument, that is to say, any order in Council, order, warrant, scheme, letters patent, rules, regulations, or bye-laws, expressions used in the instrument, if it is made after the commencement of this Act, shall, unless the contrary intention appears, have the same respective meanings as in the Act conferring the power.

Sec. 32.—(1) Where an Act passed after the commencement of this Act confers a power or imposes a duty, then, unless the contrary intention appears, the power may be exercised and the duty shall be performed from time to time as occasion requires.

(2) Where an Act passed after the commencement of this Act confers a power or imposes a duty on the holder of an office as such, then, unless the contrary intention appears, the power may be exercised and the duty shall be performed by the holder for the time being of the office.

(3) Where an Act passed after the commencement of this Act confers a power to make any rules, regulations, or bye-laws, the power shall, unless the contrary intention appears, be construed as including a power exercisable in the like manner and subject to the like consent and conditions, if any, to rescind, revoke, amend, or vary the rules, regulations, or bye-laws.

Sec. 36.—(1) In this Act and in every Act<sup>1</sup> passed either before or after the commencement of this Act, the expression “commencement,” when used with reference to an Act, shall mean the time at which the Act comes into operation.

(2) Where an Act passed after the commencement of this Act or any order in Council, order, warrant, scheme, letters patent, rules, regulations, or bye-laws made, granted, or issued under a power conferred by any such Act, is expressed to come into operation on a particular day, the same shall be construed as coming into operation immediately on the expiration of the previous day.

Sec. 37.—Where an Act passed after the commencement of this Act is not to come into operation immediately on the passing thereof, and confers power to make any appointment, to make, grant, or issue any instrument, that is to say, any order in Council, order, warrant, scheme, letters patent, rules, regulations, or bye-laws, to give notices, to prescribe forms, or to do any other thing for the purposes of the Act, that power may, unless the contrary intention appears, be exercised at any time after the passing of the Act, so far as may be necessary or expedient for the purpose of bringing the Act into operation at the date of the commencement thereof, subject to this restriction, that any instrument made under the power shall not, unless the contrary intention appears in the Act, or the contrary is necessary for bringing the Act into operation, come into operation until the Act comes into operation.

Sec. 38.—(1) Where this Act or any Act passed after the commencement of this Act repeals and re-enacts, with or without modification, any provisions of a former Act, references in any other Act to the provisions so repealed shall, unless the contrary intention appears, be construed as references to the provisions so re-enacted.

(2) Where this Act or any Act passed after the commencement of this Act repeals any other enactment, then, unless the contrary intention appears, the repeal shall not—

- (a) revive anything not in force or existing at the time at which the repeal takes effect ; or
- (b) affect the previous operation of any enactment so repealed or anything duly done or suffered under any enactment so repealed ; or
- (c) affect any right, privilege, obligation, or liability acquired, accrued, or incurred under any enactment so repealed ; or
- (d) affect any penalty, forfeiture, or punishment incurred in respect of any offence committed against any enactment so repealed ; or
- (e) affect any investigation, legal proceeding, or remedy in respect of any such right, privilege, obligation, liability, penalty, forfeiture, or punishment as aforesaid ;

and any such investigation, legal proceeding, or remedy, may be instituted, continued, or enforced, and any such penalty, forfeiture, or punishment may be imposed, as if the repealing Act had not been passed.

## APPENDIX VII.

### TRADE MARKS RULES, 1906.<sup>1</sup>

By virtue of the provisions of the Trade Marks Act, 1905, the Board of Trade do hereby make the following Rules :—

#### PRELIMINARY.

1. These Rules may be cited as the Trade Marks Rules, 1906, and shall come into operation from and immediately after the 31st day of March, 1906.

#### INTERPRETATION.

2. In the construction of these Rules any words herein used the meaning of which is defined by the said Act or the Interpretation Act, 1889,<sup>2</sup> shall have the meanings thereby assigned to them respectively. Interpreta-  
tion.

“Agent” means an agent duly authorised to the satisfaction of the Registrar.

“Office” means Patent Office, Trade Marks Branch, 25, Southampton Buildings, London, W.C.

“Journal” means “Trade Marks Journal.”

#### FEEES.

3. The fees to be paid in pursuance of the said Act shall be the fees specified in the First Schedule to these Rules. Fees.

#### FORMS.

4. The forms herein referred to are the forms contained in the Second Schedule to these Rules, and such forms shall be used in all cases to which they are applicable, and shall be modified as directed by the Registrar to meet other cases. Forms.

#### CLASSIFICATION OF GOODS.

5. For the purposes of trade marks registration and of these Rules goods are classified in the manner appearing in the Third Schedule hereto. Classification  
of goods.

If any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the Registrar.

<sup>1</sup> Statutory Rules and Orders, 1906, No. 233.

<sup>2</sup> A selection of extracts from this Act is printed above, p. 652.

## DOCUMENTS.

Size, &amp;c., of documents.

6. Subject to any other directions that may be given by the Registrar, all applications, notices, counter-statements, papers having representations affixed, or other documents required by the said Act or by these Rules to be left with or sent to the Registrar or to the Keeper of Cotton Marks or to the Cutlers' Company, shall be upon foolscap paper of a size of approximately 13 inches by 8 inches, and shall have on the left-hand part thereof a margin of not less than one inch and a half.

Service of documents.

7. Any application, statement, notice, or other document authorised or required to be left, made, or given at the Office, or to or with the Registrar, or with or to any other person may be sent through the post by a prepaid or official-paid letter; any document so sent shall be deemed to have been delivered at the time when the letter containing the same would be delivered in the ordinary course of post, and in proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post. A letter addressed to a registered proprietor of a trade mark at his address as it appears on the register, or address for service, or to any applicant for or person opposing the registration of a trade mark at the address appearing in the application or notice of opposition or given for service as hereinafter provided shall be deemed to be sufficiently addressed.

Address.

8. Where any person is by the said Act or these Rules bound to furnish the Registrar with an address the following provisions shall apply:—

The address given shall in all cases be as full as possible, for the purpose of enabling any person easily to find the place of business of the person whose address is given.

When a person does not reside in a town with streets, the Registrar may require the address to include all indications which he thinks necessary for such purpose so far as it can be attained.

When an applicant resides in a town where there are streets, the address given shall include the name of the street, and the number in the street or name of premises, if any.

Address for service.

9. Every applicant for the registration of any trade mark, and every opponent to such registration, and every agent, who does not reside or carry on business in the United Kingdom, shall, if so required, give an address for service in the United Kingdom, and such address may be treated as the actual address of such applicant, opponent, or agent for all purposes connected with such application for registration or the opposition thereto.

The Registrar may require the proprietor of a registered trade mark who does not reside or carry on business within the United Kingdom to give an address for service within the United Kingdom, and such address may be treated as the actual address of the proprietor for all purposes connected with such trade mark.

## AGENTS.

Agency.

10. An application for registration and an opposition to registration and all other communications between an applicant, an opponent and the Registrar, or the Board of Trade, and between the proprietor of a

registered trade mark and the Registrar, or the Board of Trade, or any other person, may be made by or through an agent.

Any such applicant, opponent, or proprietor may appoint an agent to represent him in the matter of the trade mark by signing and sending to the Registrar an authority in writing to that effect in the Form TM No. 1, or in such other form as the Registrar may deem sufficient. In case any proprietor of a registered trade mark shall appoint such an agent, service upon such agent of any document relating to such trade mark shall be deemed to be service upon the person so appointing him, and all communications directed to be made to such person in respect of such trade mark may be addressed to such agent.

The Registrar shall not be bound to recognise as such agent any person who has been convicted criminally or struck off the Roll of Solicitors, or whose name, by reason of his having been adjudged guilty of disgraceful professional conduct, has been erased from the Register of Patent Agents, kept under the provisions of the Patents, Designs, and Trade Marks Act, 1888,<sup>1</sup> relating to the registration of Patent Agents, and not since restored.

REGISTRABLE TRADE MARKS.

11. The Registrar may refuse to accept any application upon which the following appear:—

Registrable trade marks.

(a) The words "Patent," "Patented," or "By Royal Letters Patent," "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To counterfeit this is forgery," or words to like effect.

(b) Representations of Their Majesties or of any member of the Royal Family.

12. Representations of the Royal Arms or Royal crests, or arms or crests so nearly resembling them so as to lead to mistake, or of British Royal crowns, or of the British national flags, or the word Royal or any other words, letters, or devices calculated to lead persons to think that the applicant has Royal patronage or authorisation, may not appear on trade marks the registration of which is applied for. Provided always that nothing contained in this rule shall preclude the Registrar from allowing the registration as an "old mark," that is as a mark which was used by the applicant or his predecessors in business before the 13th August, 1875, of any mark which was capable of being so registered before the Trade Marks Act, 1905, came into operation.

Royal Arms.

13. Where representations of the arms of a foreign State or place appear on a mark the Registrar may call for such justification as he may deem necessary for their use.

Arms of foreign state.

14. Where a representation of the arms or emblems of any city, borough, town, place, society, body corporate, or institution appears on a mark, the applicant shall, if so required, furnish the Registrar with a consent from such official as the Registrar may consider entitled to give consent to the use of such arms or emblems.

Arms of city, &c.

15. Where the names or representations of living persons appear on a trade mark, the Registrar shall if he so require be furnished with consents from such persons before proceeding to register the mark. In the case of persons recently dead the Registrar may call for consents from

Representations of living person or persons recently dead.

<sup>1</sup> See now sec. 84 of the Patents and Designs Act, 1907.

their legal representatives before proceeding with registration of a trade mark on which their names or representations appear.

**Name or description of goods.** 16. Where the name or a description of any goods appears on a trade mark the Registrar may refuse to register such mark in respect of any goods other than the goods so named or described.

Where the name or description of any goods appears on a trade mark which name or description in use varies the Registrar may permit the registration of the mark with the name or description upon it for goods other than those named or described, the applicant stating in his application that the name or description varies.

#### APPLICATION FOR REGISTRATION.

**Application by firm.** 17. If application for registration of a trade mark be made by a firm or partnership it may be signed in the name or for and on behalf of the firm or partnership by any one or more members thereof.

If the application be made by a body corporate it may be signed by a director or by the secretary or other principal officer of such body corporate.

Any application may be signed by an agent.

**Address of application.** 18. Where application is made for registration of a cotton mark the applicant shall address and send his application to the Keeper of Cotton Marks at the Manchester Branch, 48, Royal Exchange, Manchester. Other applications (except applications which under sec. 63 of the said Act should be made to the Cutlers' Company) shall be addressed and sent to the Registrar at the Office.

**Acknowledgment of application.** 19. On or after receipt of the application the Registrar shall furnish the applicant with an acknowledgment thereof.

**Application for old mark.** 20. Where application is made to register a trade mark which was used by the applicant or his predecessors in business before the 13th of August, 1875, the application shall contain a statement of the time during which and by whom it has been used in respect of the goods mentioned in the application. The Registrar may require a statutory declaration verifying such user with exhibits showing the mark as used.

**Contents of form of application.** 21. Every application for registration of a trade mark shall contain a representation of the mark affixed to it in the square which the Form TM No. 2 contains for that purpose.

Where the representation exceeds such square in size the representation shall be mounted upon linen, tracing cloth or other material that the Registrar may consider suitable. Part of the mounting shall be affixed in the space aforesaid and the rest may be folded over.

**Additional representations.** 22. There shall be sent with every application for registration of a trade mark four additional representations of such mark on the Form TM No. 3, exactly corresponding to that affixed to the application Form TM No. 2, and noted with all such particulars as may from time to time be required by the Registrar or by the Keeper of Cotton Marks. Such particulars shall, if required, be signed by the applicant or his agent.

**Representations to be durable.** 23. All representations of marks must be of a durable nature, but the applicant may in case of need supply in place of representations on the Form TM No. 3, half sheets of strong foolscap of the size aforesaid with the representations affixed thereon and noted as aforesaid.

24. Applications for the registration of the same mark in different classes shall be treated as separate and distinct applications, and in all cases where a trade mark is registered under the same official number for goods in more than one class, the registration shall henceforth for the purpose of fees and otherwise be deemed to have been made on separate and distinct applications in respect of the goods included in each class. Separate applications.

25. The Registrar, if dissatisfied with any representation of a mark, may at any time require another representation satisfactory to him to be substituted before proceeding with the application. Representations to be satisfactory.

26. Where a drawing or other representation or specimen cannot be given in manner aforesaid, a specimen or copy of the trade mark may be sent either of full size or on a reduced scale, and in such form as the Registrar may think most convenient. Specimens of trade marks in exceptional cases.

The Registrar may also, in exceptional cases, deposit in the Office a specimen or copy of any trade mark which cannot conveniently be shown by a representation, and may refer thereto in the register in such manner as he may think fit.

27. When application is made for the registration of a series of trade marks under sec. 26 of the said Act, a representation of each trade mark of the series shall be affixed, as aforesaid, to the application upon Form TM No. 2, and to each of the accompanying Forms TM No. 3. Series of trade marks.

28. When a trade mark contains a word or words in other than Roman characters, there shall be indorsed on the application in Form TM No. 2, and on each of the accompanying representations in Form TM No. 3, a sufficient transliteration and translation to the satisfaction of the Registrar of each of such words, and every such indorsement shall be signed by the applicant or his agent. Transliteration and translation.

Where a trade mark contains a word or words in a language other than English, the Registrar may ask for an exact translation thereof, and if he so requires such translation shall be indorsed and signed as aforesaid.

PROCEDURE ON RECEIPT OF APPLICATION.

29. Subject to the provisions for special applications under paragraph 5 of sec. 9 of the said Act, upon receipt of an application for registration the Registrar shall cause a search to be made amongst the registered Marks and pending applications for the purpose of ascertaining whether there are on record any Marks for the same goods or description of goods identical with the Mark applied for or so nearly resembling it as to be calculated to deceive. Search.

30. If after such search and a consideration of the application the Registrar thinks there is no objection to the Mark being registered, he may accept it absolutely or subject to conditions, amendments, and modifications which he shall communicate to the applicant in writing. Acceptance.

31. If after such search and consideration of the application any objections appear, a statement of those objections shall be sent to the applicant in writing, and unless within one month the applicant applies for a hearing, he shall be deemed to have withdrawn his application. Objections.

32. If the Registrar accepts an application subject to any conditions, amendments, or modifications, and the applicant objects to such conditions, amendments, or modifications, he shall within one month from Hearings.

the date of the communication notifying such acceptance apply for a hearing, and if he does not do so he shall be deemed to have withdrawn his application. If the applicant does not object to such conditions, amendments, or modifications, he shall forthwith notify the Registrar in writing.

Decision of Registrar.

33. The decision of the Registrar at such hearing as aforesaid shall be communicated to the applicant in writing, and if he objects to such decision, he may within one month apply upon Form TM No. 4, requiring the Registrar to state in writing the grounds of his decision and the materials used by him in arriving at the same.

Upon receipt of such form the Registrar shall send to the applicant such statement as aforesaid in writing, and the date when such statement is sent shall be deemed to be the date of the Registrar's decision for the purpose of appeal.

Disclaimers.

34. The Registrar may call on an applicant to insert in his application such disclaimer as the Registrar may think fit, in order that the public generally may understand what the applicant's rights, if his mark is registered, will be.

#### SPECIAL APPLICATIONS UNDER PARAGRAPH 5 OF SEC. 9.

Special applications under sec. 9, paragraph 5. Search.

35. An application to register a name, signature, or word or words under paragraph 5 of sec. 9 of the said Act shall be made on the Form TM No. 5, and not otherwise.

36. Upon receipt of such an application the Registrar shall cause a search to be made amongst the registered marks and pending applications for the purpose of ascertaining whether there are on record any marks for the same goods or description of goods identical with the mark applied for or so nearly resembling it as to be calculated to deceive.

Result of search.

37. If after such search the Registrar thinks there are no such marks, he shall notify the applicant accordingly, but if after such search any such marks appear, he shall notify to the applicant the numbers of those marks and the journals (if any) in which they have been advertised.

Appeal by applicant.

38. Within one month from the receipt of such notification the applicant shall send to the Registrar in writing a case in duplicate stating at length the grounds upon which he relies in support of his application, and whether he desires to be heard by the Board of Trade or by the Court. If he fails to do so his application shall be deemed to be withdrawn. If he desires to be heard by the Board of Trade, he shall send with his case Form TM No. 10. If the Board think fit to refer the appeal to the Court, the Registrar may certify the spoilt fee on such form for allowance.

Hearing.

Upon receipt of such case the Registrar shall send the same to the Board of Trade for their information, together with a copy of all communications that have passed between the Registrar and the applicant.

39. Upon receipt of such case the Board of Trade shall if the applicant desires to be heard by them fix a day for such hearing at which the applicant and the Registrar may attend and be heard, and the Board shall make an order determining whether and subject to what conditions, amendments, or modifications, if any, the application is to be accepted, or may require the applicant to apply to the Court and limit a time for that purpose.



40. If the applicant desires to obtain an order of the Court he shall within one month from sending to the Registrar his case as aforesaid bring the matter before the Court by motion, and if he does not do so he shall be deemed to have withdrawn his application. Order of the Court.

41. If the application is accepted either by the Board of Trade or the Court it shall be advertised and proceedings thereafter shall be had in respect of it as if it had been accepted by the Registrar in the ordinary course. Advertisement, &c., of application.

SPECIAL TRADE MARKS UNDER SEC. 62.

42. Where an association or person desires to register a mark under sec. 62 of the said Act they shall apply to the Registrar in writing upon the Form TM No. 6. Application under sec. 62.

43. Such application shall be in duplicate and shall be accompanied by six copies of the mark applied for. Mode of application.

44. Upon the receipt of such application the Registrar shall as soon as may be notify the same to the Board of Trade together with his report upon the application, and shall at the same time send a copy of the application together with three copies of the mark applied for to the Board. The Registrar shall also send the applicants a copy of his report, and within one month from the receipt of such report the applicants shall send the Board in duplicate a case setting out the grounds upon which they rely in support of their application, and if they fail so to do their application shall be deemed to be abandoned. Report by Registrar.

45. Upon receipt of such case the Board may call for such evidence, if any, as they think fit and shall, if necessary, hear the applicants and the Registrar, and make an order determining whether and subject to what conditions, amendments, or modifications, if any, the application may be permitted to proceed. Hearing.

46. If such application is permitted to proceed the mark shall be advertised and the application shall be treated in all respects as if it were an ordinary application, and it shall be open to opposition in the same way and all such proceedings shall be had thereon as if it were an application under sec. 12 of the said Act. Advertisement, &c.

ADVERTISEMENT OF APPLICATION.

47. Every application when accepted shall be advertised by the Registrar in the Journal during such time and in such manner as the Registrar may direct. Advertisement of application.

If no representation of the trade mark be inserted in connection with the advertisement of an application, the Registrar shall refer in such advertisement to the place or places where a specimen or representation of the trade mark is deposited for exhibition.

48. For the purposes of such advertisement the applicant may be required to furnish a wood block or electrotype (or more than one, if necessary) of the trade mark, of such dimensions as may from time to time be directed by the Registrar, or such other information or means of advertising the trade mark as may be required by the Registrar; and the Registrar, if dissatisfied with the block or electrotype furnished by the applicant or his agent, may require a fresh block or electrotype before proceeding with the advertisement. Wood block or electrotype.

Advertisement of series.

49. When an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in sec. 26 of the said Act, the applicant may be required to furnish a wood block or electrotype (or more than one, if necessary) of any or of each of the trade marks constituting the series; or the Registrar may, if he thinks fit, insert with the advertisement of the application a statement of the manner in respect of which the several trade marks differ from one another.

Advertisement under sec. 14 (9).

50. Advertisements under sec. 14 (9) of the said Act shall *mutatis mutandis* be made in the same manner as advertisements relating to an application for registration.

#### OPPOSITION TO REGISTRATION.

Opposition.

51. Any person may within one month from the date of any advertisement in the Journal of an application for registration of a trade mark give notice in writing at the Office of opposition to the registration.

Notice of opposition.

52. Such notice shall be in Form TM No. 7, and shall contain a statement of the grounds upon which the opponent objects to the registration. If registration is opposed on the ground that the mark resembles marks already on the register, the numbers of such marks and the numbers of the Journals in which they have been advertised shall be set out. Such notice shall be accompanied by a duplicate which the Registrar will forthwith send to the applicant.

Counter-statement.

53. Within one month from the receipt of such duplicate the applicant shall send to the Registrar a counter-statement (Form TM No. 8) in writing setting out the grounds on which he relies as supporting his application. The applicant shall also set out what facts, if any, alleged in the Notice of Opposition he admits. Such counter-statement shall be accompanied by a duplicate in writing.

Evidence in support of opposition.

54. Upon receipt of such counter-statement and duplicate the Registrar will forthwith send the duplicate to the opponent and within one month from the receipt of the duplicate the opponent shall leave at the Office such evidence by way of statutory declaration as he may desire to adduce in support of his opposition and shall deliver to the applicant copies thereof.

Evidence in support of application.

55. If an opponent leaves no evidence, he shall be deemed to have abandoned his opposition, but if he does, then within one month from the receipt of the copies of declarations the applicant shall leave at the Office such evidence by way of statutory declaration as he desires to adduce in support of his application and shall deliver to the opponent copies thereof.

Evidence in reply by opponent.

56. Within fourteen days from the receipt by the opponent of the copies of the applicant's declarations the opponent may leave at the Office evidence by statutory declaration in reply, and shall deliver to the applicant copies thereof. Such evidence shall be confined to matters strictly in reply.

Further evidence.

57. In any proceedings before the Registrar, he may at any time, if he thinks fit, give leave to either the applicant or the opponent to file any evidence upon such terms as to costs or otherwise as the Registrar may think fit.

58. Where there are exhibits to declarations filed in an opposition, copies or impressions of such exhibits shall be sent to the other party on his request, or, if such copies or impressions cannot conveniently be furnished, the originals shall be sent to the Office, so that they may be open to inspection. The original exhibits shall be produced at the hearing unless the Registrar otherwise directs. Exhibits.

59. Upon completion of the evidence the Registrar shall give notice to the parties of a date when he will hear the arguments in the case. Such appointment shall be for a date at least fourteen days after the date of the notice, unless the parties consent to a shorter notice. Within seven days from the receipt of such notice both parties shall file Form TM No. 9. A party who receives such notice and who does not, within seven days from the receipt thereof, give notice on Form TM No. 9 that he intends to appear, may be treated as not desiring to be heard and the Registrar may act accordingly. Hearing.

60. Where in opposition proceedings any extension of time is granted to any party, the Registrar may thereafter, if he thinks fit, without giving the said party a hearing, grant any reasonable extension of time to the other party in which to take any subsequent step. Extension of time.

61. Where a party giving notice of opposition neither resides or carries on business in the United Kingdom, the Registrar may call upon him to give a security in such form as the Registrar may deem sufficient for the costs of the proceedings before the Registrar, for such amount as to the Registrar may seem fit, and at any stage in such opposition may require further security to be given at any time before giving his decision in the case. Security for costs.

#### NON-COMPLETION.

62. Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar shall give notice to the applicant in writing in the Form O No. 1 of such non-completion, and if the applicant has an agent, shall send a duplicate of such notice to such agent. If after fourteen days from the date when such notice was sent the registration is not completed, the application shall be deemed to be abandoned, but the Registrar may with such notice, where the applicant lives at a distance, give a further time after such fourteen days for the completion of such application. Non-completion within 12 months.

#### REFUSAL AFTER ACCEPTANCE.

63. In pursuance of sec. 16 of the said Act the Board of Trade hereby direct that in cases where a mark has been accepted by error, the Registrar need not register the mark but may withdraw his acceptance and refuse to register, but any such refusal shall be deemed to be a refusal under sub-sec. 2 of sec. 12 of the said Act, and an applicant shall have thereafter the same right of being heard, and of appealing, as he would have had if the mark had been refused immediately upon its receipt. In any other case the Board, having regard to any special facts, will give special directions under sec. 16 of the said Act. Refusal after acceptance.

## ENTRY ON THE REGISTER.

Entry on register.

64. As soon as may be after the expiration of one month from the date of the advertisement in the Journal of any application, the Registrar shall, subject to any opposition and the determination thereof, and subject to the provisions of Rule 63, and upon payment of the prescribed fee, on Form TM No. 11, enter the trade mark on the register. The entry of a trade mark on the register shall give the date of the registration, the goods in respect of which it is registered, and all particulars named in sec. 4 of the Act, together with particulars of the trade, business, profession, or occupation, if any, of the proprietor, and such other particulars as the Registrar may deem necessary.

Associated marks.

65. Where a mark is registered as associated with any other mark or marks the Registrar shall note upon the register in connection with such mark the numbers of the marks with which it is associated and shall also note upon the register in connection with each of the associated marks the number of the newly registered mark as being an associated mark with each of them.

Death of applicant before registration.

66. In case of the death of any applicant for a trade mark after the date of his application, and before the trade mark applied for has been entered on the register, the Registrar, after the expiration of the prescribed period of advertisement, may, on being satisfied of the applicant's death, enter on the register, in place of the name of such deceased applicant, the name, address, and description of the person owning the goodwill of the business, on such ownership being proved to the satisfaction of the Registrar.

Certificate of registration.

67. Upon the registration of a trade mark the Registrar shall issue to the applicant a certificate in the Form O No. 2.

## RENEWAL.

Renewal of registration.

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. 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.

Notification of receipt of renewal fee.

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.

Notice before removal of trade mark from register.

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 shall send to the registered proprietor at his registered address a notice in the Form O No. 3.

Second notice before

71. At a time not less than 14 days and not more than 28 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.

removal of trade mark from register.  
Advertisement 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, together with an additional fee upon Form TM No. 14, is received, he may renew the registration without removing the mark from the 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, 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.

Removal of trade mark from register.

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.

Removal of mark from register.

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.

Notice and advertisement of renewal.

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. If the Registrar so require, the assignee shall furnish a declaration in Form TM No. 17.

Joint request for entry of assignment.

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 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, 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.

Request for entry of assignment by subsequent proprietor.

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.

## APPENDIX VII.

Statutory  
declaration in  
support 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) 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.

Proof of title.

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.

### ALTERATION OF ADDRESS.

Alteration of  
address in  
register.

82. Every registered proprietor of a trade mark who alters his address shall forthwith apply to the Registrar on the Form TM No. 20 to insert the new address on the register, and the Registrar shall alter the register accordingly.

### DISCRETIONARY POWER.

Hearing.

83. Before exercising any discretionary power given to the Registrar by the said Act adversely to any person, the Registrar shall, if so required, hear the person who will be affected by the exercise of such power.

Application  
for hearing.

84. An application for a hearing shall be made within one month from the date when the matter on which the Registrar is called on to exercise discretionary power has arisen.

Notice of  
hearing.

85. Upon receiving such application the Registrar shall give the person applying ten days' notice of a time when he may be heard by himself or his agent.

Notification of  
decision.

Within five days from the date when such notice would be delivered in the ordinary course of post the person applying shall notify the Registrar whether or not he intends to be heard on the matter.

86. The decision of the Registrar in the exercise of any such discretionary power as aforesaid shall be notified to the person affected.

### APPLICATIONS UNDER SEC. 23.

Application  
under  
sec. 23.

87. All applications to the Registrar under sec. 23 of the said Act shall be upon the Form TM No. 21. Such application shall be accompanied by a case setting out fully the facts relating to the marks which the Registrar is requested to permit an apportionment of.

Registrar to  
enquire and  
decide.

88. Upon receipt of such request and of such case the Registrar shall enquire into the facts and call for such evidence as he may deem necessary upon the subject of such application. Before giving his decision the Registrar shall, if necessary, give the parties an opportunity of attending before him at a hearing either by themselves or by their agents.

The decision of the Registrar shall be in writing.

Note in  
register.

89. Upon any apportionment of marks under this section the Registrar shall insert in the register a note in connection with each of the registered trade marks of the fact of such apportionment, and shall

in such note refer to the date of the decision under which such apportionment has taken place.

APPLICATIONS UNDER SEC. 32.

90. Applications under sec. 32 to the Registrar may be made by the registered proprietor, or by the trustee in bankruptcy of the registered proprietor, or where the registered proprietor is a company in liquidation by the liquidator, and in other cases by such person as the Registrar may decide to be entitled to act in the name of the registered proprietor. Application under sec. 32.

91. Where such application is made the Registrar may require such evidence by statutory declaration or otherwise as he may think fit as to the circumstances in which the application is made. Evidence.

92. Where application is made, on Form TM No. 26, to enter a disclaimer or memorandum relating to a trade mark, the Registrar, before deciding upon such application, shall advertise the application in the Journal for one month in order to enable any person desiring so to do to state any reasons in writing against the applicant being allowed to make such disclaimer or enter such memorandum. Advertisement of application.

APPLICATIONS UNDER SEC. 34.

93. Where a person desires to apply under sec. 34 to alter a trade mark he shall make his application in writing on Form TM No. 27, and shall furnish the Registrar with six copies of the mark as it will appear when altered. Alteration of trade mark.

94. Before proceeding with such application the Registrar may call on the applicant to furnish a block suitable to advertise in the Journal the fact that such application has been made, or, if he think fit, the Registrar, without calling for a block, may insert an advertisement describing the alteration proposed in words so that it can be understood by persons interested in the matter. Advertisement of alteration.

Where leave is granted the Registrar may, if he is not already in possession of a block showing the trade mark as altered, cause the applicant to furnish a block showing the trade mark as altered for advertisement in the Journal, and upon receipt of such block shall forthwith advertise the mark as altered in the Journal.

SEARCH.

95. The Registrar, if requested so to do in writing upon a Form TM No. 28, may cause a search to be made in any class to ascertain whether any marks are on record at the date of such search which may resemble any mark sent in duplicate to him by the person requesting such search and may cause that person to be informed of the result of such search. Searches.

HOURS OF INSPECTION.

96. The Office shall be open to the public every weekday, except Saturday, between the hours of ten and four, and on Saturday between the hours of ten and one, except on the days following:— Hours of inspection.

Christmas Day; Good Friday; the day observed as His Majesty's

birthday; the days observed as days of public fast or thanksgiving, or as holidays at the Bank of England; and days which may from time to time be notified by a placard posted in a conspicuous place at the Office.

#### POWER TO DISPENSE WITH EVIDENCE.

Dispensing  
with evidence.

97. Where under these Rules any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the Registrar, or at the Office, and it is shown to the satisfaction of the Registrar that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Registrar, and upon the production of such other evidence, and subject to such terms as he may think fit, to dispense with any such act or thing, document, declaration, or evidence.

#### AMENDMENTS.

Amendment  
of documents.

98. Any document or drawing or other representation of a trade mark may be amended, and any irregularity in procedure which in the opinion of the Registrar may be obviated without detriment to the interests of any person may be corrected, if the Registrar think fit, and on such terms as he may direct.

#### ENLARGEMENT OF TIME.

Enlargement  
of time.

99. The time prescribed by these Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the Registrar, if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct, and such enlargement may be granted though the time has expired for doing such act or taking such proceeding.

Excluded  
days.

100. Whenever the last day fixed by the said Act, or by these Rules, for leaving any document or paying any fee at the Office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days if two or more of them occur consecutively.

Fees paid late  
by persons  
living at  
distances from  
Office.

101. Where a time for paying a fee is limited by these Rules and the person who is bound to pay such fee resides at such distance from the Office that he cannot reasonably be expected to pay the fee on the date limited by the Rule, the Registrar, if satisfied that the omission to pay the fee has not been from any want of diligence on the part of the person whose business it is to pay it, may accept the fee even though the date for paying the fee has passed, and treat it as if received on the correct date, provided always that the fee is actually paid with such promptitude as can be expected in the circumstances.



CERTIFICATES.

102. The Registrar, when required otherwise than under sec. 17 of the said Act to give a certificate as to any entry, matter, or thing which he is authorised by the said Act or any of these Rules to make or do, may, on receipt of a request in writing, and on payment of the prescribed fee, give such certificate, but every certificate of registration so given shall have specified on the face thereof whether the same is to be used in legal proceedings, or for the purpose of obtaining registration abroad, or for purposes other than use in legal proceedings or obtaining registration abroad.

Certificates by Registrar.

103. Where a mark is registered without limitation of colour it shall be lawful for the Registrar to grant a certificate of its registration for the purpose of obtaining registration abroad either in the colour in which it appears upon the register or in any other colour or colours.

Marks registered without limitation of colour.

104. Where a certificate of registration is desired for use in obtaining registration abroad, the Registrar shall affix to the said certificate a copy of the mark, and shall state in such certificate such particulars concerning the registration of the mark as to him may seem fit, and may omit therefrom reference to any disclaimers appearing on the register.

Certificates for use in obtaining registration abroad.

DECLARATIONS.

105. The statutory declarations required by the said Act and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows:—

Manner in which, and person before whom, declaration is to be taken.

(a) In the United Kingdom before any justice of the peace, or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding ;

(b) In any other part of His Majesty's dominions, before any court, judge, justice of the peace, or any officer authorised by law to administer an oath there for the purpose of a legal proceeding ; and

(c) If made out of His Majesty's dominions, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice-Consul, or other person exercising the functions of a British Consul, or a notary public, or before a judge or magistrate.

106. Any document purporting to have affixed, impressed, or subscribed thereto or thereon the seal or signature of any person hereby authorised to take such declaration in testimony of such declaration having been made and subscribed before him, may be admitted by the Registrar without proof of the genuineness of any such seal or signature, or of the official character of such person or his authority to take such declaration.

Notice of seal of officer taking declaration to prove itself.

CUTLERS' COMPANY.

107. All applications to the Cutlers' Company for registration of a trade mark, under sec. 63 of the said Act, shall be in duplicate, accompanied by the prescribed fees and representations. Requests to

Applications.

enter old corporate marks on the Sheffield Register, under sec. 63 (2), should be made on Form Sheffield No. 1.

Notice to Registrar.

108. The Cutlers' Company shall, within seven days of the receipt by them of an application to register a trade mark, send the Registrar one copy of such application, by way of notice thereof, together with two representations of the mark for each class for which the applicant seeks registration.

Objections by Registrar to acceptance.

109. The time within which the Registrar shall give notice to the Cutlers' Company of any objection he may have to the acceptance of an application for registration made to the said Company shall be one month from the date of the receipt by the Registrar of the notice from the said Company of the making of the application.

Advertisement of application.

110. If no such objection is made by the Registrar, the Cutlers' Company shall require the applicant to send the Registrar a wood block or electrotype as the Registrar may direct, and the Registrar shall, if satisfied with such wood block or electrotype, advertise the application in the same manner as an application made to him at the Office.

Notification to Cutlers' Company of application.

111. The manner in which the Registrar shall notify to the Cutlers' Company an application and proceedings thereon made as mentioned in sub-sec. 8 of sec. 63 of the said Act shall be by sending to the Cutlers' Company a copy of the Journal containing the application of which notice is required to be given, with a note distinguishing such application.

Similarity of proceedings in London and Sheffield.

112. The provisions of these Rules as to forms, representations, the proceedings on opposition to registration, registration, and all subsequent proceedings, shall, as far as the circumstances allow, apply to all applications to register made to the Cutlers' Company, and to all proceedings consequent thereon.

#### COTTON MARKS.

Application.

113. An application to the Manchester Branch for registration of a trade mark under sec. 64 of the said Act shall be in duplicate. The special Forms for cotton marks contained in the Second Schedule to these Rules shall be used. One of the Forms of application shall be stamped and the other unstamped.

One representation to be sent to Registrar.  
Search.

114. The Keeper of Cotton Marks shall forthwith, on receipt of such application, send the Registrar one representation of the mark applied for.

115. As soon as may be after receiving any application the Keeper of Cotton Marks shall make a search amongst the marks on the Manchester register, in the B List, and those which have been refused and those which are pending, and shall notify to the Registrar the application and the marks, if any, which he has found so nearly resembling the mark applied for as to be calculated to deceive, and together with such notification shall send a report upon the application.

Hearings.

116. Upon considering such report, if the Registrar thinks it will be necessary to object to the acceptance of the application, he shall give notice to the applicant of a time when he can be heard, and within one month after hearing the applicant, may give notice to the Keeper of Cotton Marks of objection to the acceptance of the application, or that he has no objection, as the case may be. If no notice of objection, or if

notice of no objection is received from the Registrar, the application shall be advertised in the Journal by the Manchester Branch.

If the applicant, being notified as aforesaid of a time for hearing, does not attend, his application shall be deemed to be refused.

117. If the mark is advertised by the Manchester Branch and is not opposed, the Keeper of Cotton Marks may call upon the applicant for the prescribed fee for the registration of such trade mark, and upon receipt thereof shall report to the Registrar, who shall forthwith, if he think fit, register the same. Registration.

118. Where under the said Act or these Rules an application has to be made to the Keeper of Cotton Marks, such application shall be made and such proceedings shall be had thereon as if in these Rules the expression "Manchester Branch, 48, Royal Exchange, Manchester," were substituted for the word "Office," and the expression "Keeper of Cotton Marks" were substituted for the word "Registrar." Procedure.

119. Where any document is by these Rules directed to be served upon the Registrar it shall, in respect of cotton marks, be served in duplicate upon the Keeper of Cotton Marks, who shall forthwith transmit one copy to the Registrar. Service of documents.

120. Where under Rule 95 a search has to be made by the Keeper of Cotton Marks, such search shall cover all marks of which there is a right of inspection under sec. 64(11) of the said Act. Search under Rule 95.

#### APPEALS TO THE COURT.

121. When any person intends to appeal to the Court, such appeal shall be made by motion in the usual way, and no such appeal shall be entertained unless notice of motion be given within one month from the date of the decision appealed against or within such further time as the Registrar shall allow. Appeal to Court.

#### APPEALS TO BOARD OF TRADE.

122. When any person intends to appeal to the Board of Trade he shall, before doing so, apply to the Registrar for a hearing and obtain a decision from him upon the point raised. Within one month from the date of such decision he shall, if he is advised to appeal to the Board of Trade in any case in which an appeal is given by the said Act, leave at the Office a notice of such his intention, on Form TM No. 29. Appeal to Board of Trade.

Such notice shall be accompanied—

(1) In case the appeal concerns an application not yet advertised, by a copy of the form of application and six representations of the mark applied for and a copy of the grounds of the Registrar's decision.

(2) In case of an opposition by a copy of the decision of the Registrar, and if the appeal is by the applicant also by a copy of the form of application and six representations of the mark opposed.

(3) In other cases by a copy of the decision of the Registrar and a statement of the date of the hearing before him.

123. Such notice shall also be accompanied by a statement in writing of the grounds of appeal, and of the appellant's case in support thereof. Grounds of appeal to be stated.

Transmission of notice.

124. A copy of the notice and all the accompanying documents shall also be forthwith sent by the appellant to the Secretary of the Board of Trade, No. 7, Whitehall Gardens, London; and where there has been an opposition before the Registrar to the opponent or applicant as the case may be.

Directions by Board.

125. The Board of Trade may thereupon give such directions (if any) as they may think fit with respect to parties and evidence, or otherwise, for the purpose of the hearing of the appeal by the Board of Trade, or for the purpose of their referring the appeal to the Court to hear and determine the same.

Hearing of appeal.

126. Where the Board of Trade intend to hear the appeal, seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing, shall be given to the Registrar and to the appellant, and where there has been an opposition before the Registrar to the opponent or applicant as the case may be.

No appeal unless notice duly given.

127. No appeal shall be entertained of which notice has not been given within one month from the date of the decision appealed against, or such further time as the Registrar may allow, except by special leave of the Board of Trade.

#### WITHDRAWAL OF APPEALS.

Withdrawal of appeal.

128. Where under sec. 12 (5) or sec. 14 (8) of the said Act an appellant is entitled to withdraw his appeal, such withdrawal shall be effected by notice given to the Registrar and to the other parties, if any, to such appeal within seven days after the leave referred to in such sections has been obtained.

#### APPLICATIONS TO AND ORDERS OF THE COURT.

Order of Court.

129. Where an order has been made by the Court in any case under the said Act, the person in whose favour such order has been made, or such one of them, if more than one, as the Registrar may direct, shall forthwith leave at the Office an office copy of such order, together with Form TM No. 30 if required. The register may, if necessary, thereupon be rectified or altered by the Registrar.

Every application to the Court under the said Act shall be served on the Registrar.

Publication of order of Court.

130. Whenever an order is made by the Court under the said Act, the Registrar may, if he thinks that such order should be made public, publish it in the Journal.

Dated this 24th day of March, 1906.

*D. Lloyd-George,*

President of the Board of Trade.

SCHEDULES.

*First Schedule.*

FEEs.

The following fees shall be paid in connection with applications, registrations, and other matters under the Act. Such fees must in all cases be paid before or at the time of the doing of the matter in respect of which they are to be paid :—

	—	Corre- sponding Form.
	£ s. d.	
1. On application not otherwise charged to register a trade mark for one or more articles included in one class ... ..	0 10 0	T.M. No. 2 or 5, Cotton No. 1
1 <i>a</i> . On application not otherwise charged to register a series of trade marks for one or more articles included in one class ... ..	0 10 0	T.M. No. 2 or 5, Cotton No. 1
1 <i>b</i> . On request to the Cutlers' Company to enter a mark on the Sheffield Register under section 63, sub-section (2) ... ..	5 0 0	Sheffield No. 1
1 <i>c</i> . On application to the Board of Trade under section 62 for leave to register a mark for goods in one class... ..	0 10 0	T.M. No. 6
1 <i>d</i> . On application to the Board of Trade under section 62 for leave to register a mark for goods in more than one class— In respect of every class ... ..	0 10 0	T.M. No. 6
Total fee in no case to exceed £10 for any number of classes.		
2. On an application to Registrar to state grounds of decision and materials used under section 12, sub-section 3 ... ..	0 10 0	T.M. No. 4
3. On request to be heard by the Board of Trade on application to register a name, signature, word or words under section 9, paragraph (5)... ..	1 0 0	T.M. No. 10
4. On notice of opposition for each application opposed, by opponent ... ..	1 0 0	T.M. No. 7
4 <i>a</i> . On filing a counter-statement in answer to a notice of opposition, by the applicant for each application opposed ... ..	0 10 0	T.M. No. 8
4 <i>b</i> . On the hearing of each opposition, by applicant and by opponent respectively ... ..	1 0 0	T.M. No. 9
5. For registration of a trade mark for one or more articles included in one class ... ..	1 0 0	T.M. No. 11
5 <i>a</i> . For registration of a series of marks for one or more articles included in one class— For the first mark ... ..	1 0 0	T.M. No. 11
And for every other mark of the series ... ..	0 5 0	
5 <i>b</i> . For registration under section 62 of a mark for goods in more than one class— In respect of every class ... ..	1 0 0	T.M. No. 11
Total fee in no case to exceed £20 for any number of classes.		

	—	Corre- sponding Form.
6. Upon each entry in the register of a mark of a note that the mark is associated with a newly registered mark ... ..	£ s. d. 0 1 0	—
7. On application to register a subsequent proprietor in cases of assignment or transmission of a single mark ... ..	1 0 0	T.M. No. 16 or 18
7a. On application to register a subsequent proprietor of more than one mark standing in the same name, the devolution of title being identical in each case— For the first mark ... ..	1 0 0	T.M. No. 16 or 18
And for every other mark ... ..	0 2 0	
8. On application to change the name of a proprietor of a single mark where there has been no alteration in the proprietorship... ..	0 5 0	T.M. No. 23
8a. On application to change the name of a proprietor of more than one mark standing in the same name, the change being the same in each case— For the first mark ... ..	0 5 0	T.M. No. 23
And for every other mark ... ..	0 1 0	
9. For renewal of registration of a mark at expiration of last registration... ..	1 0 0	T.M. No. 12 or 13
9a. For renewal of registration of a series of marks at the expiration of last registration— For the first mark of the series ... ..	1 0 0	T.M. No. 12 or 13
And for every other mark of the series ... ..	0 2 0	
9b. For renewal of a mark registered under section 62 for goods in more than one class— In respect of every class ... ..	1 0 0	T.M. No. 12 or 13
Total fee in no case to exceed £20 for any number of classes.		
10. Additional fee under Rule 72 ... ..	0 10 0	T.M. No. 14
11. Additional fee under Rule 73 ... ..	1 0 0	T.M. No. 15
12. For altering a single entry of the address of a registered proprietor ... ..	0 5 0	T.M. No. 20
12a. For altering more than one entry of the address of a registered proprietor where the address in each case is the same and is altered in the same way— For the first entry ... ..	0 5 0	T.M. No. 20
And for every other entry ... ..	0 1 0	
13. For every entry in the register of a rectification thereof or an alteration therein, not otherwise charged ... ..	0 10 0	T.M. No. 30
14. For cancelling the entry or part of the entry of a trade mark upon the register on the application of the owner of such trade mark ... ..	0 5 0	T.M. No. 24 or 25
15. On request, not otherwise charged, under section 12 (6) or under section 32 ... ..	0 5 0	T.M. No. 22 or 26
16. For a search under Rule 95 ... ..	0 10 0	T.M. No. 28
17. For certificate of Registrar of registration to be used in legal proceedings... ..	1 0 0	T.M. No. 34
18. For certificate of Registrar of the registration of a trade mark to be used for the purpose of obtaining registration abroad ... ..	0 5 0	T.M. No. 33

	—	Corre- sponding Form.
	£ s. d.	
18a. For certificate of Registrar of the registration of a series of marks for the purpose of obtaining registration abroad ... ..	0 10 0	T.M. No. 33
19. For certificate of Registrar other than certificate under section 17 or certificate of registration to be used in legal proceedings, or for the purpose of obtaining registration abroad... ..	1 0 0	T.M. No. 31 or 32
20. For certificate of Keeper of Cotton Marks ...	0 5 0	Cotton No. 3 or 4
21. On appeal from Registrar to Board of Trade in respect of each decision appealed against by appellant ... ..	1 0 0	T.M. No. 29
22. On an application to the Registrar under section 23	5 0 0	T.M. No. 21
23. On an application to the Registrar for leave to add to or alter a single mark ... ..	1 0 0	T.M. No. 27
23a. On an application to the Registrar for leave to add to or alter more than one mark of the same proprietor, the addition or alteration to be made in each case being the same—		
For the first mark ... ..	1 0 0	T.M. No. 27
And for every other mark ... ..	0 10 0	—
24. For inspecting register in connection with any particular trade mark, for every quarter of an hour... ..	0 1 0	—
25. For making a search amongst the classified representations of trade marks, for every quarter of an hour ... ..	0 1 0	—
26. For office copy of documents, for every 100 words (but never less than 1s.) ... ..	0 0 4	—
27. For certifying office copies MS. or printed matter	0 10 0	—
28. In cases where the wood block or electrotype of the trade mark exceeds 2 inches in breadth or depth, or in breadth and depth—		
For every inch or part of an inch over 2 inches in breadth ... ..	0 2 0	—
For every inch or part of an inch over 2 inches in depth ... ..	0 2 0	—

The fees to be paid on any proceeding at the Manchester Branch and at Sheffield (except as specially provided above) shall be the same as for the similar proceeding at the London office.

For the purpose of these fees (except as specially provided above) every mark of a series under section 66 of the Patents, Designs and Trade Marks Act, 1883, or section 26 of this Act, shall be deemed to be a mark separately registered.

Dated this 24th day of March, 1906.

(Sd.)

*D. Lloyd-George,*  
President of the Board of Trade.

Approved

(Sd.) *J. Herbert Lewis,*  
*Cecil Norton,*  
Lords Commissioners  
of His Majesty's Treasury.

*Second Schedule.*

## FORMS.

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<sup>1</sup> The pages here inserted are those of this book, and not those actually inserted in the published Rules. The indicating

letters and numbers of the forms are not in the Table of Forms as issued by the Patent Office.



	Page.	Corre- sponding Fee.
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TRADE MARKS ACT, 1905.

Form TM No. 1.

*Form of Authorisation.*

SIR,  
I BEG to inform you that I have appointed (a) of to act as my agent  
for (b)

I am, Sir,  
Your obedient Servant

(c) \_\_\_\_\_  
Address

Dated the day of 19 .

To the Registrar, Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.

- (a) Here insert name and address of agent.
- (b) Here state the particular purpose for which the agent is appointed.
- (c) To be signed by the person appointing the agent.

(TRADE MARKS.  
10s.)

TRADE MARKS ACT, 1905.

Form TM No. 2.

*Application for Registration of Trade Mark (other than Cotton Mark).*

One representation to be fixed within this square, and four others to be sent on separate Forms TM No. 3.

Representations of a larger size may be folded, but must then be mounted upon linen and affixed hereto.

Application is hereby made for Registration of the accompanying Trade Mark in Class \_\_\_\_\_, in respect of (a) \_\_\_\_\_ in the name of (b) \_\_\_\_\_ of [address and description] trading as \_\_\_\_\_ who claims to be the proprietor thereof (c). \_\_\_\_\_ do not claim the registration of this Trade Mark under the special provisions of paragraph 5 of sec. 9 of the Trade Marks Act, 1905, in regard to names, signatures, or words.

(Signed) \_\_\_\_\_.

Dated the \_\_\_\_\_ day of \_\_\_\_\_ 19 \_\_\_\_\_.

*To the Registrar, Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.*

(a) Only goods contained in one and the same class should be set out here. A separate Application Form is required for each separate class.

(b) Here insert legibly the full name, address and description of the individual, firm, or company. Add trading style (if any).

(c) Alter to "claim to be the proprietors thereof" in the case of a firm or company.

TRADE MARKS ACT, 1905.

Form TM No 3.

*Additional Representation of Trade Mark, to accompany Application for Registration (other than Cotton Mark).*

One representation of the trade mark to be affixed within this square.

It must correspond *exactly* in all respects with the representation affixed to the Application Form.

Any representation of a larger size than foolscap may be folded, but must then be mounted upon linen and affixed hereto.

FOUR of these ADDITIONAL REPRESENTATIONS of the Trade Mark must accompany each Form of Application.

(TRADE MARKS.  
10s.)

TRADE MARKS ACT, 1905.

Form TM No. 4.

*Request for Statement of Grounds of Decision under Sec. 12 (3).*

You are hereby requested under sub-sec. 3 of sec. 12 of the Trade Marks Act, 1905, and Rule 33 made thereunder to state in writing the grounds of your decision, dated the        day of        19    , after the hearing on the        day of        19    , and the materials used by you in arriving at such decision.

Signed \_\_\_\_\_.

Dated the        day of        19    .

To the Registrar, Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.

(TRADE MARKS.  
10a.)

TRADE MARKS ACT, 1905.

Form TM No. 5.

*Special Application for Registration of Trade Mark under Paragraph  
5 of Sec. 9.*

One representation to be fixed within this square, and  
four others to be sent on separate Forms TM No. 3.

Application is hereby made for Registration of the accompanying Trade Mark in  
Class \_\_\_\_\_, in respect of (a) \_\_\_\_\_ in the name of (b) \_\_\_\_\_ of [address and  
description] trading as \_\_\_\_\_ who claims to be the proprietor thereof (c) and  
desires an order of the Board of Trade or the Court directing Registration of the  
same.

(Signed) \_\_\_\_\_.

Dated the \_\_\_\_\_ day of \_\_\_\_\_ 19 \_\_\_\_\_.

*To the Registrar, Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.*

(a) Only goods contained in one and the same class should be set out here. A  
separate Application Form is required for each separate class.

(b) Here insert legibly the full name, address and description of the individual,  
firm, or company. Add trading style (if any).

(c) Alter to "claim to be the proprietors thereof" in the case of a firm or  
com any.

(TRADE MARKS.  
Fee 1c or 1d.)

TRADE MARKS ACT, 1905.

Form TM No. 6.

*Special Application for Registration of Trade Mark under Sec. 62.*

*(To be accompanied by an unstamped duplicate.)*

One representation to be fixed within this square, and six others to be sent on separate half-sheets of foolscap.

Representations of a larger size may be folded, but must then be mounted upon linen and affixed hereto.

Application is hereby made for Registration of the accompanying Trade Mark in Class \_\_\_\_\_, in respect of (a) \_\_\_\_\_ in the name of \_\_\_\_\_ of \_\_\_\_\_ [address and description] who desire the Board of Trade under sec. 62 of the said Act to permit the registration thereof.

(Signed) \_\_\_\_\_.

Dated \_\_\_\_\_ day of \_\_\_\_\_ 19 \_\_\_\_  
To the Registrar, Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.

(a) Only goods contained in one and the same class should be set out here. A separate Application Form is required for each separate class.

(TRADE MARKS.  
£1.)

TRADE MARKS ACT, 1905.

Form TM No. 7.

*Notice of Opposition to Application for Registration.*

*(To be accompanied by an unstamped duplicate.)*

In the matter of an application, No. \_\_\_\_\_ by \_\_\_\_\_ of \_\_\_\_\_  
I, (a) \_\_\_\_\_ hereby give notice of my intention to oppose the Registration of the  
Trade Mark advertised under the above number for Class \_\_\_\_\_ in the Trade Marks  
Journal of the \_\_\_\_\_ day of \_\_\_\_\_, 19 \_\_\_\_, No. \_\_\_\_\_, page \_\_\_\_\_.

The grounds of opposition are as follows:—

(Signed) \_\_\_\_\_.

Dated the \_\_\_\_\_ day of \_\_\_\_\_, 19 \_\_\_\_  
Address for Service:—

To the Registrar, Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.

(a) Here state full name and address.



FORM O No. 1.

*Notice of Non-Completion of Registration.*

No. .

The Registrar has to call your attention to Sec. 18 of the Trade Marks Act, 1905, and to Rule 62 of the Trade Marks Rules made thereunder. The Section and the Rule are printed on the back hereof.

Your application numbered as above was made on the            day of            19 .  
Registration has not been completed by reason of your default. Unless it is completed within            days from this date the application will be treated as abandoned.

Dated this            day of            19 .

To

*The Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.*

(TRADE MARKS.  
Fee 5 or 5a.)

TRADE MARKS ACT, 1905.

FORM TM No. 11.

*Fee for Registration of a Trade Mark.*

SIR,

In reply to your request I hereby transmit the prescribed fee for the registration of the Trade Mark No.            in Class            .

I am, Sir,  
Your obedient Servant,

Dated the            day of            19 .

(a) ———.

*To the Registrar, Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.*

(a) Signature.

TRADE MARKS ACT, 1905.

FORM O No. 2.

*Certificate of Registration under Sec. 17.*

To

I hereby certify, pursuant to Rule 67 of the Rules under the above Act, that the Trade Mark in your Application No.            was duly advertised in the Trade Marks Journal and has been registered in your name in Class            , in respect of the goods specified by you.

Witness my hand this            day of            , 19 .

(Seal of Patent Office.)

Registrar.

*The Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.*

## APPENDIX VII.

(TRADE MARKS.                      TRADE MARKS ACT, 1905.  
Fee 9 or 9a.)

## FORM TM No. 12.

*Renewal of Registration before Notice given.*

I hereby leave the proscribed fee of                      for the renewal of the registration of  
the Trade Mark No.                      , in Class                      .

Dated the                      day of                      , 19                      .

*To the Registrar, Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.*

N.B.—This Form must be indorsed with the name and address of the  
person leaving the same.

## TRADE MARKS ACT, 1905.

## FORM O No. 3.

*Notice before Removal of Trade Mark from the Register,  
under Sec. 30.*

The Registrar hereby gives you notice that, in conformity with the provisions of  
Sec. 30 of the above Act (printed at back hereof), your Trade Mark No.                      ,  
registered in Class                      , will be removed from the Trade Marks Register, unless  
the proscribed fee of                      (payable by Form TM No. 13) be received at this Office  
before the                      day of                      19                      , on which date the existing registration will  
expire.

A stamped Form TM No. 13, for payment of the fee, may be obtained as directed  
at the back of this Notice, *but cannot be obtained from this Office.*

Dated this                      day of                      19                      .

To

*The Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.*

Cheques, Money Orders, or Cash cannot be accepted in payment of Fees.

## TRADE MARKS ACT, 1905.

## FORM O No. 4.

## SECOND NOTICE.

*Notice before Removal of Trade Mark from the Register,  
under Sec. 30.*

The Registrar hereby gives you notice that, in conformity with the provisions of  
Sec. 30 of the above Act (printed at back hereof), your Trade Mark No.                      ,  
registered in Class                      , will be removed from the Trade Marks Register, unless  
the proscribed fee of                      (payable by Form TM No. 13) be received at this Office  
before the                      day of                      19                      , on which date the existing registration will  
expire.

If the above fee be not paid *before* the date above named, the Trade Mark will,  
after the end of one month from the date on which the omission to pay the fee has



been advertised in the Trade Marks Journal, be removed from the Trade Marks Register, unless an *additional* fee of 10s. (payable by Form TM No. 14) be remitted.

Stamped forms for payment of renewal fees may be obtained as directed at the back of this Notice, *but cannot be obtained from this Office.*

Dated this        day of        19   .

To

*The Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.*

Cheques, Money Orders, or Cash cannot be accepted in payment of fees.

(TRADE MARKS.                    TRADE MARKS ACT, 1905.  
Fee 9 or 9a.)

Form TM No. 13.

*Renewal of Registration of Mark after Notice.*

SIR,

IN pursuance of the notice received from you, I hereby transmit the prescribed fee of        for Renewal of Registration of the Trade Mark No.        , in Class        .

Dated the        day of        19   .

*To the Registrar, Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.*

N.B.—This Form must be indorsed with the name and address of the person transmitting the same.

(TRADE MARKS.                    TRADE MARKS ACT, 1905.  
10s.)

Form TM No. 14.

*Additional Fee of 10s. to accompany Renewal Fee (Form TM No. 13), within One Month after Advertisement of Non-payment of Renewal Fee.*

SIR,

IN pursuance of the notices issued by you, I hereby transmit the additional fee of 10s. (along with Form TM No. 13) for the Renewal of the Registration of the Trade Mark No.        in Class        .

Dated the        day of        19   .

*To the Registrar, Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.*

N.B.—This Form must be indorsed with the name and address of the person transmitting the same.

## APPENDIX VII.

(TRADE MARKS.                      TRADE MARKS ACT, 1905.  
£1.)

Form TM No. 15.

*Restoration of Trade Mark where Removed for Non-payment of Fee.*

[To accompany Form TM No. 13.]

SIR,

IN pursuance of the notices issued by you, I hereby transmit the additional fee of £1 (along with Form TM No. 13) for restoration to the Trade Marks Register of the Trade Mark No.                      in Class                      .

Dated the                      day of                      19                      .

*To the Registrar, Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.*

N.B.—This Form must be indorsed with the name and address of the person transmitting the same.

(TRADE MARKS.                      TRADE MARKS ACT, 1905.  
Fee 7 or 7a.)

Form TM No. 16.

*Joint Request by Registered Proprietor and Assignee to Register the Assignee as Subsequent Proprietor of a Trade Mark.*

We, (a)                      of (b)                      , and (c)                      , of (d)                      , hereby request, under Rule 76, that the name of (e)                      , carrying on business as (f)                      , at (g)                      , may be entered in the Register of Trade Marks as proprietor of the Trade Mark No.                      in Class                      .

(h)                      \_\_\_\_\_  
(i)                      \_\_\_\_\_

*To the Registrar, Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.*

- (a) Name of Registered Proprietor
- (b) Address of Registered Proprietor.
- (c) Name of Assignee.
- (d) Address of Assignee.
- (e) Name of Assignee.
- (f) Trade or business of Assignee.
- (g) Address of Assignee.
- (h) Signature of Registered Proprietor
- (i) Signature of Assignee.

TRADE MARKS ACT, 1905.

Form TM No. 17.

*Form of Declaration (only to be furnished when requested by Registrar)  
by Assignee in support of Form TM No. 16*

I (a)                      of (b)                      do hereby solemnly and sincerely declare that the Trade Mark No.                      in Class                      has been assigned to me by (c)                      of (d)

together with the goodwill of the business concerned in the goods for which it has been registered, and that I have accepted such Assignment.

(c) And I make this solemn declaration conscientiously believing the same to be true and by virtue of the provisions of the Statutory Declarations Act, 1835.

Declared at this day of 19 . f) \_\_\_\_\_  
 Before me (g) \_\_\_\_\_  
 (h) \_\_\_\_\_

- (a) Name of Assignee.
- (b) Address of Assignee.
- (c) Name of Assignor.
- (d) Address of Assignor.
- (e) This paragraph is not required when the declaration is made out of the United Kingdom.
- (f) Signature of Assignee.
- (g) Signature of Authority.
- (h) Title of Authority.

(TRADE MARKS. TRADE MARKS ACT, 1905.  
 Fee 7 or 7a.)

Form TM No. 18.

*Request to enter Name of Subsequent Proprietor of Trade Mark upon the Register.*

I, (a) hereby request that you will enter (b) name (c) in the Register of Trade Marks as proprietor of the Trade Mark No. in Class (d) entitled to the said Trade Mark and to the goodwill of the business concerned in the goods with respect to which the said Trade Mark is registered. Accompanying this Request is a statement of (e) case.

Dated this day of , 19 . (f) \_\_\_\_\_

To the Registrar, Patent Office, Trade Marks Branch,  
 25, Southampton Buildings, Chancery Lane, London, W.C.

- (a) Or We. Here insert name, address, and description.
- (b) My or our.
- (c) Or names.
- (d) I am or We are,
- (e) My or our.
- (f) Signature.

TRADE MARKS ACT, 1905.

Form TM No. 19.

*Form of Declaration (only to be furnished when requested by Registrar) in Support of Statement of Case Accompanying Form TM No. 18.*

I, of do hereby solemnly and sincerely declare that the particulars set out in the statement of case, exhibit marked and left by me in connection with my request to be registered as subsequent proprietor of the Trade Mark No. .

in Class \_\_\_\_\_, are true and comprise every material fact and document affecting the proprietorship of the said Trade Mark as above claimed.

(a) And I make this solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

Declared at \_\_\_\_\_ this \_\_\_\_\_ day of \_\_\_\_\_ 19 \_\_\_\_ . (b) \_\_\_\_\_.

Before me, (c) \_\_\_\_\_.

*To the Registrar, Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.*

(a) This paragraph is not required when the declaration is made out of the United Kingdom.

(b) To be signed here by the person making the declaration.

(c) Signature and title of the authority before whom the declaration is made.

(TRADE MARKS. TRADE MARKS ACT, 1905.  
Fee 12 or 12a.)

Form TM No. 20.

*Notice of Application for Alteration of Address on Register of  
Trade Marks.*

In the matter of the Trade Mark, No. \_\_\_\_\_ registered in Class \_\_\_\_\_  
I \_\_\_\_\_ of \_\_\_\_\_ the registered proprietor of the Trade Mark numbered as above,  
desire that my address on the Register of Trade Marks be altered to \_\_\_\_\_.

Dated this \_\_\_\_\_ day of \_\_\_\_\_ 19 \_\_\_\_ . (a) \_\_\_\_\_

*To the Registrar, Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.*

(a) Signature of Proprietor.

(TRADE MARKS. TRADE MARKS ACT, 1905.  
£5.)

Form TM No. 21.

*Application to Permit an Apportionment of Trade Marks.*

In the matter of the Registered Trade Marks Nos. \_\_\_\_\_  
We, being the parties interested within the meaning of Section 23 of the Trade  
Marks Act, 1905, in certain marks of \_\_\_\_\_ who has ceased to carry on business,  
request you to permit an apportionment of those marks amongst the persons in fact  
continuing the business. With this application we send a case in pursuance of  
Rule 87.

Signed \_\_\_\_\_.  
Signed \_\_\_\_\_.

Dated this \_\_\_\_\_ day of \_\_\_\_\_ 19 \_\_\_\_ .

*To the Registrar, Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.*

TRADE MARKS RULES, 1906.

689

(TRADE MARKS. TRADE MARKS ACT, 1905.  
5s.)

Form TM No. 22.

*Form of Request for Correction of Clerical Error or for Permission to amend Application under Sec. 12 (6) or Sec. 32 (1).*

SIR,  
I HEREBY request that

(a) ———

Dated this        day of        19        .

*To the Registrar, Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.*

(a) Signature.

—

(TRADE MARKS. TRADE MARKS ACT, 1905.  
Fee 8 or 8a.)

Form TM No. 23.

*Request to Enter Change of Name of Registered Proprietor of Trade Mark upon the Register.*

I, (a) hereby request that you will enter (b) name (c) in the Register of Trade Marks as proprietor of the Trade Mark No. in Class (d) entitled to the said Trade Mark and to the goodwill of the business concerned in the goods with respect to which the said Trade Mark is registered.

There has been no change in the actual proprietorship of the said Trade Mark, but (e).

(f) ———.

Dated this        day of        19        .

*To the Registrar, Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.*

(a) Or We. Here insert name, address, and description.

(b) My or Our.

(c) Or Names.

(d) I am or We are.

(e) Here state the circumstances under which the change of name took place.

(f) Signature.

—

(TRADE MARKS. TRADE MARKS ACT, 1905.  
5s.)

Form TM No. 24.

*Form of Application by Proprietor of Registered Trade Mark to Cancel Entry on Register.*

Trade Mark No.        , Class        , advertised in Trade Marks Journal, No.        page  
Name of Registered Proprietor  
Place of Business  
Description

I, the undersigned,        of        [or, I the undersigned,        a member of the Firm of        of        on behalf of my said Firm] apply that the entry upon

T.M.

## APPENDIX VII.

the Register of Trade Marks of the Trade Mark No.                      in Class                      may be cancelled.

(a) \_\_\_\_\_.

Dated this                      day of                      19                      .

*To the Registrar, Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.*

(a) Signature. \_\_\_\_\_

(TRADE MARKS.                      TRADE MARKS ACT, 1905.  
5s.)

Form TM No. 25.

*Request to strike out Goods from those for which a Trade Mark is Registered.*

I,                      of                      hereby request that you will strike out                      from the goods for which the Trade Mark No.                      is registered in Class                      .

(a) \_\_\_\_\_

Dated this                      day of                      19                      .

*To the Registrar, Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.*

(a) Signature. \_\_\_\_\_

(TRADE MARKS.                      TRADE MARKS ACT, 1905.  
5s.)

Form TM No. 26.

*Request to Enter Disclaimer or Memorandum relating to a Trade Mark.*

I,                      of                      , hereby request that you will enter in the Register in connection with Trade Mark No.                      in Class                      the following                      , namely—

(a) \_\_\_\_\_.

Dated this                      day of                      19                      .

*To the Registrar, Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.*

(a) Signature. \_\_\_\_\_

(TRADE MARKS.                      TRADE MARKS ACT, 1905.  
Fee 23 or 23a.)

Form TM No. 27.

*Application under Sec. 34 to Add to or Alter a Trade Mark.*

In the matter of the Trade Mark No.                      in Class                      .  
Application is hereby made on behalf of the registered proprietor of the Trade Mark numbered as above to alter it in the following particulars that is to say—

(Here fill in full particulars.)

Six copies of the mark as it will appear when so altered are filed herewith.

(Signed) \_\_\_\_\_

Dated this                      day of                      19                      .

*To the Registrar, Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.*

TRADE MARKS RULES, 1906.

691

(TRADE MARKS.  
10s.)

TRADE MARKS ACT, 1905.

Form TM No. 28.

*Request for Search under Rule 95.*

You are hereby requested to search under Rule 95 in Class \_\_\_\_\_ to ascertain whether any Trade Marks are on record which resemble the Trade Mark sent herewith in duplicate each mounted on a half-sheet of foolscap.

(a) \_\_\_\_\_  
(b) \_\_\_\_\_

Dated this \_\_\_\_\_ day of \_\_\_\_\_ 19 .

To the Registrar, Patent Office, Trade Marks Branch,  
25, Southampton Buildings, Chancery Lane, London, W.C.

(a) Signature.  
(b) Address.

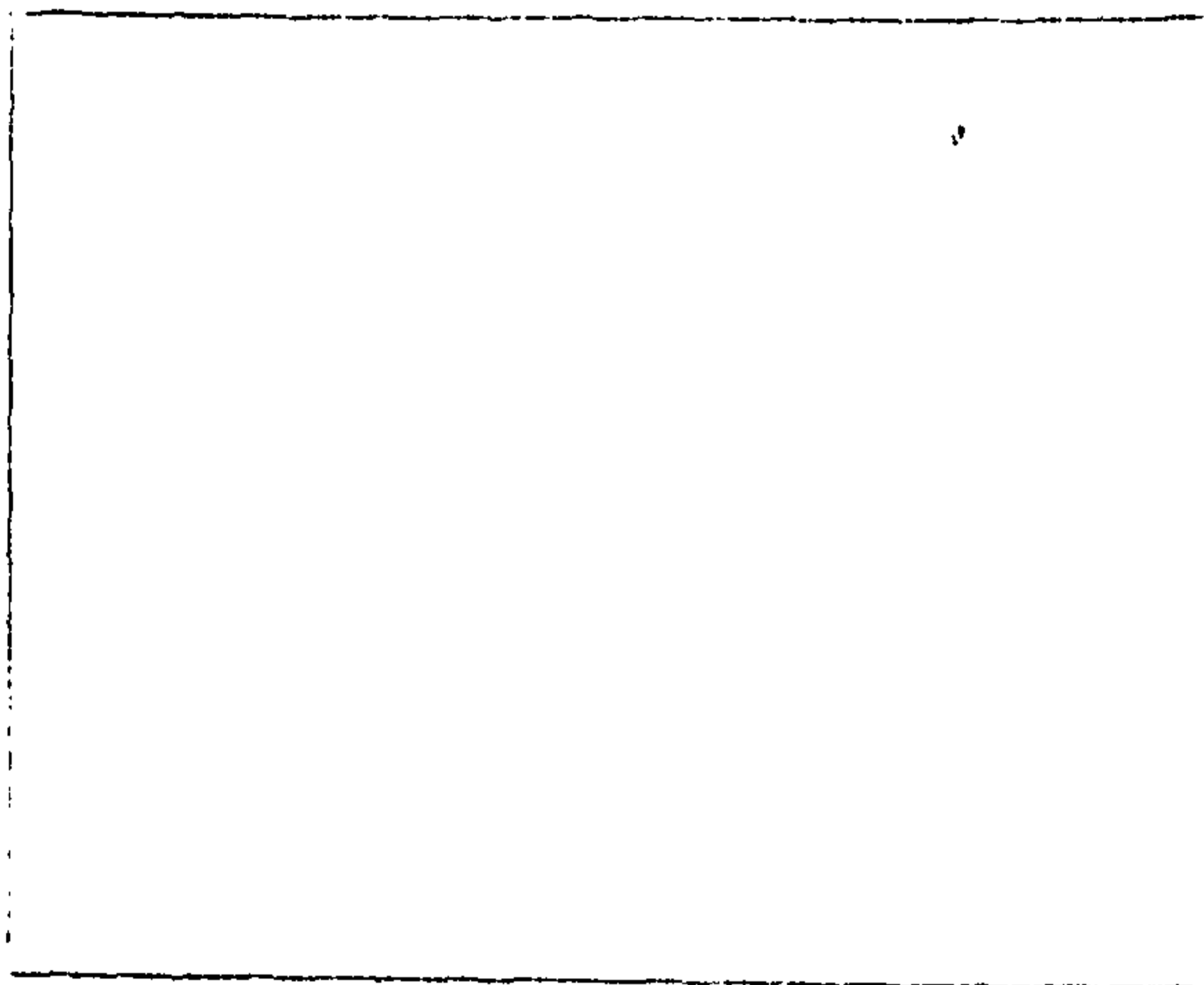
\_\_\_\_\_

(CORPORATE MARK.  
£5.)

TRADE MARKS ACT, 1905.

Form Sheffield No. 1.

*Request to Enter a Mark under Sec. 63, Sub-sec. (2).*



You are hereby requested to register the accompanying Old Corporate Mark in Class \_\_\_\_\_ in respect of \_\_\_\_\_ in the name of \_\_\_\_\_, who claims to be the proprietor thereof.

(Signed) \_\_\_\_\_

Dated this \_\_\_\_\_ day of \_\_\_\_\_ 19 .

To the Cutlers' Company,  
Cutlers' Hall, Sheffield.

(COTTON MARKS.  
STAMP 10s.)

TRADE MARKS ACT, 1905.

Cotton No. 1.

*Application for Registration of Trade Mark.*

*(See the annexed Extracts from the Trade Marks Act.)*

*(To be accompanied by an unstamped duplicate of this Form, and also by four Additional Representations on Form Cotton No. 2.*

One representation to be fixed within the square.

Representations of a larger size may be folded, but must then be mounted upon cloth and affixed hereto.

Application is hereby made for Registration of the accompanying Trade Mark in Class (a) in respect of (b) in the Name of Address and description (c) Trading as who claim to be the Proprietor thereof.

No claim of exclusive right is made to any of the letterpress appearing on the said Trade Mark except in so far as it consists of the applicant's own name and address, or the foreign equivalent thereof.

The said Trade Mark has not hitherto been used by the Applicant upon or in connection with the above-mentioned goods, but is proposed to be so used [or (d)

The said Trade Mark has been used by the applicant [<sup>and</sup>/<sub>or</sub> by the predecessors in business of the applicant ] upon or in connection with the above-mentioned goods since the 19 ].

(Signed) \_\_\_\_\_.

Dated the        day of        19 .

*To the Keeper of Cotton Marks, Manchester Branch of the Trade Marks Registry,  
48, Royal Exchange, Manchester.*

(a) Insert the class.

(b) Insert "all goods included in this class" or, if it is not desired that the registration should cover the whole class, the description of the goods.

Only goods contained in one and the same class may be set out here. A separate Application Form is required for each separate class.

(c) If the applicant is outside the U.K. an address for service in the U.K. must be given before the application can be proceeded with.

(d) Strike out the alternative paragraph which does not apply to the case.



(COTTON MARKS.)

TRADE MARKS ACT, 1905.

Cotton No. 2.

*Additional Representation of Trade Mark to accompany Application for Registration.*

One representation of the Trade Mark to be affixed within this square.

It must correspond *exactly*, in all respects, with the representation affixed to the Application on "Form Cotton No. 1."

Any representation of a larger size than foolscap may be folded, but must then be mounted upon cloth and affixed hereto.

Class  
Description of Goods  
Length of User (if any)  
Name of Applicant  
Address  
Description

No claim of exclusive right is made to any of the letterpress appearing on the Mark except in so far as it consists of the applicant's own name and address or the foreign equivalent thereof.

Four of these Additional Representations of the Trade Mark must accompany each Form of Application.

(COTTON MARKS.  
STAMP 5s.)

TRADE MARKS ACT, 1905.

Cotton No. 3.

*Request for Certificate under Sub-sec. (12) of Sec. 64.*

SIR,

You are hereby requested to issue a certified copy of the application numbered \_\_\_\_\_ and dated the \_\_\_\_\_ day of \_\_\_\_\_, 19\_\_\_\_, for registration in Class \_\_\_\_\_ of the Cotton Mark of which a fac-simile is sent herewith, setting forth in such certificate the length of time of user (if any) of such Mark as stated on the application, and any other particulars you may deem necessary.

Dated this \_\_\_\_\_ day of \_\_\_\_\_, 19\_\_\_\_.

(Signed) \_\_\_\_\_  
Address \_\_\_\_\_

*To the Keeper of Cotton Marks, Manchester Branch of the Trade Marks Registry,  
48, Royal Exchange, Manchester.*

## APPENDIX VII.

(COTTON MARKS.  
STAMP 5s.)

TRADE MARKS ACT, 1905.

Cotton No. 4.

*Request for Certificate of Keeper of Cotton Marks as to a Trade Mark  
entered in the Manchester Register.*

In the matter of the Trade Mark No.            in Class            .

SIR,

I HEREBY request you to furnish me with your Certificate of Registration of the  
Mark numbered as above for use (a).

Dated this            day of            19   .

(Signed) \_\_\_\_\_  
Address            \_\_\_\_\_.*To the Keeper of Cotton Marks, Manchester Branch of the Trade Marks Registry,  
48, Royal Exchange Manchester.*(a) Here state the purpose for which the Certificate is required, i.e., whether for  
use in legal proceedings, or for obtaining registration abroad, or for what other  
purpose.

—

(COTTON MARKS.)

TRADE MARKS ACT, 1905.

MB No. 1.

*Certificate under Sub-sec. (12) of Ser. 64.*Manchester Branch of the Trade Marks Registry,  
48, Royal Exchange, Manchester.It is hereby certified by the Keeper of Cotton Marks, that a true copy of the  
application numbered            and dated the            day of            19   , for registration  
in Class            of the Cotton Mark therein referred to is contained in the paper  
hereto annexed and that a fac-simile of the said Mark is attached thereto, and that  
the length of time of user of such Mark as stated on the application is (a)            and  
that the said Mark is on deposit at this office.

WITNESS my hand this            day of            19   .

(Seal of Patent Office.)

Keeper of Cotton Marks.

(a) Space for any other particulars the Keeper may deem necessary.

—