

intention of extending his business at some future time to anything which he may think desirable? This question we answer in the negative." This case had been followed in several others, in which marks registered without any intention to use them, or without any intention to use them on some goods for which they were registered, have been removed from the Register as to the whole or part of the goods for which they were registered.¹ The matter is now expressly provided for by sec. 87 of the Act of 1907, which is dealt with in Chap. XI.²

The registered proprietor of a trade mark may himself apply under sec. 82 to the Registrar to have particular goods or classes of goods struck out from those for which the trade mark is registered, and this course may in some cases save a proprietor the costs of an application by another person to rectify the Register. It is provided by sec. 27 that where, under the provisions of the Act, user of a registered trade mark is required to be proved for any purpose, the tribunal may, if and so far as it shall think right, accept user of an associated registered trade mark,³ or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for such user; and, where parts of a registered trade mark are separately registered by the same proprietor under sec. 25 as combined trade marks,⁴ user of the whole trade mark is for the purposes of the Act to be deemed to be a user of such registered trade marks belonging to the same proprietor as it contains.

In practice, leave to register a mark is frequently given, and oppositions to registration are frequently withdrawn, or overruled, on the terms that the registration be restricted to part of a register class.⁵ The restriction has in some cases been effected by the entry of a note of the agreement upon the Register, and in a case where, without any formal opposition, it had been agreed between the applicant and an objector, that the registration

¹ See below, Chap. XI., Rectification, at p. 333; and cf. also *Hedley's Tms.*, 17 R. P. C. 719 (1900), where a mark, on which an applicant for rectification based his application, had been registered but not used, and any intention to use it had been given up. Cozens-Hardy, J., said it could probably be removed from the Register.

² See below, p. 327.

³ Associated Trade Marks, see p. 116.

⁴ Below, p. 117.

⁵ See, for instance, *Jelley's Application*, 51 L. J. Ch. 639, n. (1878), Jessel, M.R.; *Brady & Co.'s Applications*, 21 O. D. 222; 51 L. J. Ch. 637 (1882), North, J.; *Kenrick and Jefferson's Tm.*, 7 R. P. C. 821 (1890), Chitty, J.; and *König and Eblhardt's Tm.*, 13 R. P. C. 449 (1896), Stirling, J.

should be restricted to certain goods in the class for which it was effected, Pearson, J., on an *ex parte* application, directed the Comptroller to enter a note of the restriction on the Register.¹

Associated Trade Marks.

Associated trade marks.

Provision was made in the Act of 1883 for the registration of a series of trade marks resembling each other in material particulars but differing in certain respects, as, for instance, statements of quality. Series of trade marks may be registered under the Act of 1905, but they are made part of new species of trade mark introduced by the Act, which are called associated trade marks; these are divided into combined trade marks, series of trade marks and associated trade marks not falling within either of those descriptions. An associated trade mark must be a registrable trade mark under the Act,² and it only differs from an ordinary trade mark in its association with other registered trade marks of the same proprietor, and in the consequence of such association, namely, that it can only be assigned with such other trade marks.

Resembling marks belonging to the same proprietor.

It is enacted by sec. 24 of the Act of 1905 that "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."

The wording of this section should be compared with that of sec. 19,³ which relates to identical or similar marks belonging to different proprietors. It had been held in a case under the Acts of 1883 and 1888, in which an applicant asked for registration of a trade mark only slightly differing from a trade mark of his own registered for the same goods, that the registration ought to be refused, as to accede to the application would uselessly encumber the Register.⁴ The decision was an inconvenient one

¹ *Keep's Tm.*, 26 C. D. 187; 54 L. J. Ch. 687 (1884); but, as to the particular restriction in this case, see *Dewhurst's Application*, [1896] 2 Ch. p. 143; 13 R. P. C. p. 297, C. A., where the Court distinguished between a condition of registration and a note of an agree-

ment; see also Chap. XI., at p. 333, and Chap. X., at p. 225.

² See also sec. 27, below, p. 119.

³ Below, p. 247.

⁴ *Player & Sons' Application*, [1901] 1 Ch. 882; 18 R. P. C. 65, Cozens-Hardy, J.

from the commercial aspect, because it is necessary for an English trader in some foreign countries in order to attain registration to show that the mark is registered in this country. Moreover, a trader may desire to vary his trade mark in some slight respect, and the policy of the trade mark legislation should be that in general marks actually used should be on the Register. Sec. 24 therefore appears to effect an improvement in the law. It has been construed in the *Birmingham Small Arms Co.'s Application*,¹ in which the applicants having already on the Register in one class the trade mark "B. S. A." applied to register it in another class for goods of quite a different description, and the Registrar, as a condition of registration, required the marks to be associated. The applicants appealed, and it was held on appeal, that the Registrar's discretion was not an absolute one, but one to be exercised subject to the provisions of the Act, including sec. 24, and that the goods were of different descriptions, and that sec. 24 had nothing to do with the registration of identical trade marks, but applied only to cases where registration was sought for a 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"; and the Registrar was directed to proceed with the registration without the condition as to association.

Section 24 does not deal with the case of concurrent applications by the same proprietor for marks slightly differing, that being a matter falling under sec. 26.

The next kind of associated trade marks is that in which a whole mark is registered and also separate parts of it. These are called in the marginal note to sec. 25 combined trade marks. That section is as follows:—

Combined
trade marks.

"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

¹ [1907] 2 Ch. 836; 24 R. P. C. 563, Kekowich, J.

a user of such registered trade marks belonging to the same proprietor as it contains."

Parts of a trade mark which are separately registered are, on an application to register the whole mark, excepted from the provisions of the Act as to disclaimer which are contained in sec. 15.¹ Sec. 25 applies to the converse case of the proprietor of a registered trade mark seeking to register part of it, and probably also to concurrent applications for registration of the whole and the parts. It would seem also that where a proprietor is seeking to register a mark which includes parts already registered, the Registrar could under his general discretion require the marks to be associated. The provision at the end of the section that user of the whole trade mark is to be deemed to be user also of the included marks was no doubt inserted in view of sec. 37,² under which a trade mark may be removed from the Register by reason of non-user. Sec. 27 contains a more general provision, but gives the Court a discretion.

Series of
trade marks.

By sec. 26 it is provided that—

"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—

- (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."

This section replaces sec. 66 of the Act of 1883, but with the addition of (c) and (d), and of the last sentence making a series of trade marks a particular case of associated marks. The addition of (d), colour, is due to the fact that colour may now enter into the consideration of the distinctiveness of a trade mark.³ Paragraph (c) of this section should be compared with sec. 24, which appears to cover a case in which there are slight differences in

¹ Disclaimers, Chap. IX.; below, p. 236.

² Below, Chap. XI., p. 327.
³ Sec. 10, below, p. 233.

distinctive matter. Sec. 24 does not, however, apply to concurrent applications, but probably these could be dealt with under the general discretion of the Registrar by his requiring the marks to be associated.

Application for a series of trade marks must be made in conformity with Rule 27.¹

Section 27 provides as follows:—

“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 trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for such user.”

Assignment
of associated
trade marks.

The proviso seems to have special reference to the provisions of sec. 37² as to non-user, and possibly also to the rule that a trade mark can only be assigned with a goodwill in the goods for which it has been registered.³

Where a mark is registered as associated with any other mark or marks cross references are inserted by means of notes in the Register to the marks with which it is associated.⁴

¹ Below, p. 723. And see Rule 49 as to advertisement. Fees for registration, List of fees, 5a, p. 737.

² Below, p. 327.

³ Sec. 22.

⁴ Rule 65, p. 728. Fee one shilling for each note that a mark is associated with a newly registered mark; see List of fees, p. 737.

CHAPTER VI.

SHEFFIELD MARKS.

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Sheffield Marks and the Cutlers' Company.

THE care of the Register and the registration of marks to be used on metal goods registered under the present Act by a person carrying on business in Hallamshire, or within six miles thereof, is committed, by sec. 68 of the Act of 1905, as it was also by sec. 81¹ of the Act of 1883, to the Cutlers' Company.

The Cutlers'
Company.

This company was incorporated by the Act 21 Jac. I. c. 31, and its members and proceedings are regulated by several Cutlers' Company Acts, referred to below. But long before the seventeenth century Hallamshire had been noted for its cutlery manufactures, and from time to time a jury of cutlers was empannelled with the other juries of the local Court Leet to assign marks to the different manufacturers, wherewith to distinguish their respective wares; and in the Court Rolls of the Manor of Sheffield of the 7th of Elizabeth, and, again, in the Rolls of 1590, presentments of the regulations governing persons engaged in the knife-making and certain other cutlery trades are recorded.² The seventh of these regulations provided that no person should strike any mark upon his wares but that which was assigned him in the Lord's Court under a penalty of ten shillings. The cutlers had also a charter granted by the lords of the manor.³

The incorporating Act, the Cutlers' Company Act, 1623,⁴ laid down certain regulations for the control of persons engaged in

¹ See below, p. 125.

² Hunter's History of Sheffield, London, 1810, p. 118.

³ M. M. A. Report, 1862. Evidence of Mr. Jackson, Q. 104.

⁴ 21 Jac. I. c. 31, local.

the businesses of manufacturing knives, shears, scissors, or other cutlery wares, within the specified district, and incorporating the persons then so engaged, and it fixed the limits of the district concerned, as they have ever since remained, to be those of the lordship of Hallamshire and within six miles compass from it. The Act, in particular, provided that persons engaged in the businesses mentioned, in the said district, should strike such marks, and such marks only, as should be assigned to them by the company. These regulations were repealed by the Cutlers' Company Act of 1791,¹ and fresh regulations, chiefly relating to the admission of new freemen and to the taking of apprentices, were enacted. By sec. 17 of the Act last mentioned, members of the company, who alone were then permitted to manufacture the goods referred to,² were forbidden, under a penalty, to strike, engrave, or use any mark like, or counterfeiting, a mark assigned to any other person. The Cutlers' Company Act of 1801³ empowered any freeman of the company to bequeath his mark, as his other personalty, by his will, his widow not to be thereby prevented from carrying on the trade, or selling the right to the mark, for her lifetime, to any other person entitled to carry on the trade. The Cutlers' Company Act of 1814⁴ threw open the specified trades to all persons, and removed the existing restrictions as to taking apprentices. It provided, further (sec. 3), that all manufacturers, whether freemen or not, on application, should have marks assigned to them by the company, the marks not to be marks previously assigned, and at the time continuing to be the property of any persons other than the applicants, and not to consist of surnames; (sec. 4) that marks in common use should not be assigned; and (sec. 6) that an assigned mark might be bequeathed by will, and if it were not bequeathed, it should go to the widow and family of the proprietor on his death, but not so as to give power to more than one person in the family to use it at the same time. The last Cutlers' Company Act, that of 1860,⁵ extended the provisions of the Acts to all persons within the district using or exercising the trades of manufacturers of steel, makers of saws and edged tools, and other articles of steel, or steel and iron combined, having a cutting edge, and it enabled persons carrying on any of the trades within the Acts,

¹ 31 Geo. III. c. 58, local.

² 41 Geo. III. c. 97, local.

³ Knives, sickles, shears, scissors, razors, files, and forks, or any of them, sec. 3.

⁴ 54 Geo. III. c. 119, local.

⁵ 23 Vict. c. xlili.

and not being freemen of the company, to become freemen on payment of the proper fees, and to have marks assigned to them.

Corporate marks were assignable in gross.

It will be seen that, under these Acts, the old corporate marks were assignable personal property of the grantee; this was, at all events, the case where the marks were owned by non-freemen and where they did not comprise any personal elements calculated to make their use by others than the original grantees misleading.¹ In this respect they differed from ordinary trade marks, which are, and always have been, assignable or capable of transmission only in connection with the business in which they are used.

Grant of a corporate mark.

The right to the mark originated in the grant by the company, and lasted for the lives of the grantee and his widow. The grant was made upon the application of the grantee after a search, carried out by the searchers of the company, to ascertain whether the mark applied for was the subject of a then existing grant. Marks, as they lapsed, were re-granted over and over again.²

Recent legislation and the Cutlers' Company.

The rights and privileges of the Cutlers' Company were expressly saved by sec. 25 of the Merchandise Marks Act, 1862. There is no similar provision in the Merchandise Marks Act of 1887, but, except in so far as that Act restricts the use of particular marks as being forged trade marks, or false trade descriptions, it does not in any way affect the rights or privileges of the company. The Act of 1875³ empowered the owner of a Sheffield corporate mark to have it registered under that Act in the same manner and on the same terms as if it were not a Sheffield corporate mark. Under the Act of 1888 the old Register of corporate marks was closed on December 31st, 1888.⁴

Closing of the Register.

The Act of 1875.

The Act of 1875 left the Register of the Cutlers' Company, and the power of the Company to assign marks, untouched, except that it restricted the latter power in regard to marks identical with, or so nearly as to be calculated to deceive, resembling marks registered under the Act in the manner mentioned below.⁵ And it provided generally that:—

¹ *Bury v. Dedford*, 82 L. J. Ch. 741; 83 L. J. Ch. 465; 4 De G. J. & S. 852 (1868), M.R. and L.JJ.

² See the evidence of Mr. Jackson, Qq. 118, 117, 142, and Mr. Hunter,

Q. 1899; M. M. A. 1862.

³ Sec. 9 (6), set out below.

⁴ Sec. 81 (9).

⁵ Sec. 9 (5).

“(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.”

The Act provided¹ further, (1) for copies of all the Sheffield corporate marks in force being delivered to the Registrar; (2) for notices of new applications to the company for the assignment of corporate marks, and copies of the marks applied for, being delivered to the Registrar, and for notices of applications to the Registrar for registration under the Act of marks belonging to any goods or class of goods within the Cutlers' Company Acts,² and copies of the marks referred to, being delivered to the company;³ and (3) for notices of assignment and registration.

Sub-sections (4), (5), and (6) of sec. 9 of the Act of 1875 were in the terms following:—

“(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.⁴

Mark resembling a corporate mark not to be registered.

“(5.) The masters, 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.⁴

Corporate mark resembling registered mark not to be assigned.

“(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

Corporate mark might be registered.

¹ Sec. 9. Appendix, p. 718.

² See list below; p. 124.

³ The company sometimes opposed the registration of marks which they deemed to resemble too closely corporate

marks in use. See *Re Rosing*, 54 L. J. Ch. 975, n. (1878).

⁴ Cf. sec. 6 of the Act of 1875, sec. 72 of the Act of 1883, and sec. 19 of the Act of 1905.

registered the same if it were not a Sheffield corporate mark."

The Act of 1883.

The Act of 1883, on the other hand, provided for the closing, within five years from the commencement of the Act,¹ of the Register of corporate marks, and for the commencement of a new Register of trade marks to be kept at Sheffield by the Cutlers' Company, to which the corporate marks might be transferred; and it directed that all corporate marks entered on the Register of corporate marks and not entered on the new Register before the closing of the former, should be deemed to have been abandoned.²

The Act of 1888.

Section 81, the part of the Act of 1883 relating to the Sheffield marks and containing the provisions just referred to, was amended by sec. 20 of the Act of 1888, the principal alteration being occasioned by the substitution of, and the extension thereby of the section to, "metal goods," meaning "all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal," in place of "cutlery, edge tools, raw steel, goods made of steel, or of steel and iron combined, whether with or without a cutting edge." The last-mentioned class of goods had been inserted in the original section in the place of the list taken by the Act of 1875 from the Cutlers' Company Act of 1860, namely, knives, sickles, shears, scissors, razors, files, forks, saws, edge tools, or other articles of steel, or of steel or iron combined, having a cutting edge.

The effect of sec. 81.

The section, as amended by sec. 20 of the Act of 1888, is set out in the Appendix.³ The general effect of the section was to make the Sheffield Register a branch of the principal Register for trade marks used on metal goods and registered by persons carrying on business in Hallamshire or within six miles thereof, and to place the local Register under the charge of the Cutlers' Company. The duties of the company were, however, ministerial only as regards the registration of old corporate marks;⁴ as regards the registration of other marks, the Company were substituted for the Comptroller, subject to his veto upon any particular registration,⁵ unless such veto was overruled on appeal by the Court, and subject, in cases where the Comp-

Duties of the Cutlers' Company with regard to registrations.

¹ January 1st, 1884, sec. 3.

² Sec. 81 (9).

³ Page 700.

⁴ *Lambert's Tm.*, 5 R. P. C. 542; 6 R. P. C. 344 (1889), C. A.

⁵ Sub-sec. (5).

troller's veto was not exercised, to appeal from the Company to him and to a further appeal to the Court.¹

Section 81 of the Act of 1883 is now replaced by sec. 63 of the Act of 1905, which, however, differs only in a few respects from the repealed section. The differences consist mainly in the omission of some transitory² and obsolete provisions, or provisions which are now unnecessary having regard to the general provisions of the new Act.³ The principal alteration is the substitution of an appeal from the company direct to the Court for an appeal to the Comptroller, and from him to the Court.⁴ The Sheffield Register is continued and, save as otherwise provided, forms part of the Register.

The Act of 1905.

The former proviso saving the life interest of a widow of a holder of a corporate mark⁵ is omitted as being presumably obsolete. Certain provisions relating to penalties under the Cutlers' Company's Acts⁶ are also omitted, sufficient protection being now given by the Merchandise Marks Act, 1887.

Section 63 of the Act of 1905 is as follows:—

“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 of 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,⁷ 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,⁸ all the trade marks which shall have been assigned by the Cutlers'

¹ Sub-sec. (12).

of sec. 81 of the Act of 1883.

² For instance, the transfer to the Sheffield Register of marks previously registered, part of sub-sec. (2), as amended by the Act of 1888, sec. 20, and sub-sec. (9) referred to on p. 124, closing the register of corporate marks.

⁵ Sub-sec. (7) of sec. 81 of the Act of 1883, as amended by the Act of 1888.

⁶ Sub-sec. (13) of sec. 81 of the Act of 1883.

⁷ April 1st, 1906.

⁸ Metal goods are defined by sub-sec. (10), below.

³ Sub-secs. (10) and (11) of sec. 81.

⁴ Sub-sec. (9). Cf. with sub-sec. (12)

Company and actually used before the first day of January one thousand eight hundred and eighty-four,¹ but which have not been entered in such Register before the passing of this Act :²

- (3) An application for registration of a trade mark used on metal goods³ 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
- (4) Every application so made to the Cutlers' Company shall be notified to the Registrar in the prescribed manner,⁵ and, unless the Registrar within the prescribed time⁶ 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 :⁷
- (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 :⁸
- (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,

¹ Commencement of the Act of 1883.

² As regards the registration of old corporate marks, the duties of the company are ministerial only: *Lambert's Tm.*, 5 R. P. C. 542; 6 R. P. C. 344 (1889), C. A. The prescribed form is Sheffield No. 1, below, p. 755. Fee £5.

³ Metal goods are defined by sub-sec. (10), below.

⁴ The effect of this sub-section and sub-sec. (7) is to constitute the Sheffield Register a branch register for metal goods. The application must be on Form TM No. 2, Appendix, p. 742, and addressed to the Law Clerk to the Cutlers' Company, The Cutlers' Hall, Sheffield; see Rules 107 to 112, p. 733, and Instructions (18), p. 779.

⁵ A copy of the application is to be sent within seven days, with two representations of the mark for each class:

Rule 108.

⁶ The time is one month from receipt of notice: Rule 109.

⁷ *I.e.*, as an ordinary application is proceeded with by the Registrar, sub-sec. (7), Rule 112. 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: Rule 110.

⁸ The Court is defined by sec. 3. See also sub-sec. (9) and sec. 64, sub-sec. (5), which in the case of a cotton mark gives an appeal, alternatively to the Court or the Board of Trade at the option of the applicant.

and have the same effect as if the application had been made to the Registrar on that day :¹

- (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,² he shall in the prescribed manner³ notify the application and proceedings thereon to the Cutlers' Company :
- (9) Any person aggrieved⁴ by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner,⁵ appeal to the Court :⁶
- (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.⁷
- (11) For the purpose of legal proceedings in relation to trade

¹ Cf. sec. 16.

² See sub-sec. (10).

³ *I.e.*, by sending a copy of the official paper, the Trade Marks Journal, containing the application with a note distinguishing such application: Rule 111.

⁴ Cf. sec. 35, p. 311.

⁵ By motion, notice of motion to be given within one month from the date of the decision or within such further time as shall be allowed, Rule 121; see also sub-sec. (7).

⁶ For an instance of such an appeal, see *Andrew v. Kuehnrich*, 30 R. P. C. 93, Swinfen Eady, J.; opponent's appeal dismissed (ABC steel), reversed on appeal to Court of Appeal, Times, August 2nd, 1913. See Addenda.

⁷ For the list of goods to which the Cutlers' Company's Acts and the Act of 1875 applied, see p. 124; and for the list to which the unamended Act of 1883 applied, see the original sub-sec. (2), p. 700.

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.¹

A complete collection of representations of pending applications in classes 5, 6, 7, 11, 12, 13, 14, and 22 is now kept for public inspection at the Cutlers' Hall, Sheffield. On an application in any of those classes being made at the Patent Office, a copy of the Journal containing the application is forwarded by the Registrar to the Cutlers' Company.² The rules relating to Sheffield marks are Nos. 107 to 112.³ A request to enter a corporate mark of the Sheffield Register must be made on Form Sheffield No. 1.⁴

¹ The certificate is evidence: sec. 51; Rules 102 to 104, above, p. 67.

² Rule 111.

³ Below, p. 733.

⁴ Rule 107.

CHAPTER VII.

COTTON MARKS AND THE MANCHESTER BRANCH OFFICE.

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By the Rules issued under the Act of 1875,¹ marks for cotton goods in Classes 23, 24 and 25² were specially treated. An office was set up at Manchester for the exhibition of all devices, marks, &c., used in the cotton trade, and in the Rules called *cotton marks*, and every person using any cotton mark was required to send to the office three representations of it. A committee of persons versed in the usages of the cotton trade was appointed to consider the cotton marks, of which representations were sent in to the Manchester office, and to divide them into two classes: (a) those which were, in the opinion of the committee, trade marks within the meaning of the Act; and (b) those which were not; and power was given to the Commissioners of Patents to add any cotton marks to either class.³ It was provided that any proprietor of a cotton mark not specified in class (b) might apply to be registered as proprietor of the mark in the manner and subject to the conditions in and under which he might have applied to be registered in respect of any other trade mark, but that it should not be lawful to register any person as proprietor of any cotton mark in class (b) except in pursuance of an order of the Court.

The first Cotton Marks Rules.

The committee so appointed was held not to be a judicial tribunal, but merely a body appointed to consider and give an opinion on technical matters peculiarly within the knowledge of

The Cotton Marks Committee.

¹ Now repealed; see Chitty's Statutes, Rules 57—63a.

² Class (23), cotton yarn and thread (under the present Rules this is replaced by (a) cotton yarn, and (b) sewing cotton); (24) cotton piece goods of all kinds; (25) cotton goods not in-

cluded in Classes 23, 24, or 38. Class 38, articles of clothing. Under the Rules of 1890, Class 23 was divided as follows:—(a) cotton yarn and sewing cotton not on spools or reels, (b) sewing cotton on spools or reels.

³ Rule 58 (a) of March, 1883.

its members, and it was decided that its decisions could be reconsidered or disregarded by the Court, or by the Registrar by direction of the Court, notwithstanding that it had acted fairly and properly, and had not proceeded on any wrong principle in arriving at them.¹ And in a number of cases applications to the Court in respect of marks placed by the committee in class (b) were successful, and the marks were registered as trade marks.²

The Manchester Branch Office under Act of 1883.

The special rules were repealed and the committee of experts dissolved;³ but the Manchester Office was maintained and constituted a branch office of the Registry, and applications for the registration of marks in Classes 23, 24, and 25 were, under the Rules of 1890, addressed and sent to it.⁴

Special points of practice.

The system of deposit of cotton marks not registrable as trade marks, was also continued. This had the double advantage of acting as a warning to other traders of the marks being in use, and of enabling persons wishing to design new marks to see what marks were in actual use. Another practice, special to the Manchester Branch, was that of consulting the Trade and Merchandise Marks Committee appointed by the Manchester Chamber of Commerce in questions of difficulty arising in applications to register.

Effect of the Act of 1905.

The Act of 1905 gives statutory recognition to the Manchester Branch office, the chief officer of it being the Keeper of Cotton Marks, who acts under the direction of the Registrar.⁵ All applications for cotton marks, that is, for trade marks for goods in Classes 23, 24, and 25,⁶ except such as may be prescribed,⁷ must be made to the Manchester Branch; and the Register for trade marks for all such goods is called the Manchester Register, and a duplicate is kept at the Manchester

¹ *Orr-Ewing v. The Registrar of Tms.*, 4 App. Ca. 479; 48 L. J. Ch. 707 (1879); H. L. reversing the judgment of the C. A., 8 C. D. 794; 47 L. J. Ch. 807 (1877).

² *Exp. Ede & Co.*, 28 W. R. 436 (1878), Jessel, M.R.; *Re Dugdale*, 49 L. J. Ch. 303; 28 W. R. 436 (1880), Hall, V.-C.; *Re Ward, Sturt and Sharp*, 50 L. J. Ch. 347; 44 L. T. (N. S.) 97 (1881), Hall, V.-C.; *Re Sykes*, 43 L. T. 626; 29 W. R. 235 (1880), Hall, V.-C.

³ Lord Herschell's Committee refused to adopt a recommendation that honorary trade assessors be appointed to pass or reject cotton trade marks, on the

grounds that their appointment would diminish the sense of responsibility of the office, and that it did not feel sure that the creation of such a tribunal, reserving power to override its decisions, would give general satisfaction. Report of 1888, p. x.

⁴ Rule 8 of 1890.

⁵ Sec. 64 (1). The address of the Keeper of Cotton Marks is, Manchester Branch of the Trade Marks Registry, 48, Royal Exchange, Manchester.

⁶ Sec. 64 (2). See note (2), p. 129, as to the goods comprised in these classes.

⁷ No goods have been prescribed as exceptions under the Rules of 1906.

Branch.¹ When an application is made to the Manchester Branch, it is notified to the Registrar, and the Keeper of Cotton Marks reports to the Registrar on the application; and the Registrar may object to the application proceeding, subject to an appeal to the Court or the Board of Trade at the option of the applicant.² If the Registrar makes no objection, the application is advertised and proceeded with. Subject to the special Rules 113 to 117, the procedure is the same *mutatis mutandis* as that on an ordinary application.³ Where a trade mark applied for is already in use, the length of time of user must be stated in the application.⁴ The practices of deposit of marks and of consulting a committee of the Manchester Chamber of Commerce are sanctioned and continued by the Act.⁵ The Act enacts that certain features that might, under sec. 9, be registrable or distinctive in respect of other goods shall not be registered or deemed distinctive in respect of certain goods within the cotton classes,⁶ and this provision of the Act came into force immediately on the passing of the Act.⁷ In particular no exclusive use of a word can be obtained by registration of a cotton mark, and no word or words can be registered alone for cotton piece goods or cotton yarn; and line headings, that is, the coloured strips at the end of a piece, cannot be registered alone and are not to be deemed distinctive.

Section 64 of the Act of 1905 is as follows:—

“(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.

Manchester
Branch.

“(2) As regards cotton goods⁸ 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

Manchester
Register.

¹ Sec. 64 (2) and (3).

² Sec. 64 (4) and (5), and Rules 113 to 116. The application must be on form Cotton No. 1, below, p. 756, and four additional representations must be sent on form Cotton No. 2.

³ Rule 118.

⁴ Sec. 64 (9).

⁵ Sec. 64 (11) and (14). As to the Col-

lection of Refused Marks, see the Trade Mark Rules, 1912. See below, p. 134.

⁶ See sec. 10, which is set out fully below.

⁷ August 11th, 1905. The Act generally came into operation on April 1st, 1906.

⁸ As to the goods included in Classes 23, 24, and 25, see note (2), p. 129.

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.

Applications
for cotton
marks.

"(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.¹

"(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,² and unless the Registrar, after considering the report and hearing, if so required, the applicant, within the prescribed time³ 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.⁴

"(5) If the Registrar gives notice of objection as aforesaid the application shall not be proceeded with, but any person aggrieved⁵ may in the prescribed manner⁶ appeal to the Court or the Board of Trade, at the option of the applicant.

Registration.

"(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

Rectification
of the
Register.

"(7) When any mark is removed from or any cancellation or correction made in the Manchester Register⁸ notice thereof shall be given by the Registrar to the Keeper of Cotton Marks, who shall alter the duplicate Register accordingly.

Certificate.

"(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

¹ Form Cotton No. 1, Appendix, p. 756. The application is to be in duplicate, Rule 113.

² The search made by the Keeper of Cotton Marks includes the B list, see above, p. 129, and T. M. Rules, 1912, p. 766.

³ One month after the hearing, Rule 116, p. 734.

⁴ Rule 118, p. 735, and Chap. IV.,

Registration.

⁵ Cf. sec. 35, below, p. 311.

⁶ Rules 121 to 127, "The Court," see below, p. 134.

⁷ Cf. sec. 16.

⁸ See Chap. XI., Rectification of the Register, p. 309.

⁹ Sec. 51, Rules 102, 103, and 104, and Form MB No. 2, p. 759.

“(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. Length of user.

“(10) As from the passing of this Act¹—

(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 words² shall be deemed to be distinctive in respect of such goods: Words, line headings, &c.

(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.

“(11) The right of inspection of the Manchester Register³ 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,⁴ lapsed, expired, withdrawn, abandoned, cancelled, or pending.⁵ Inspection.
39 & 40 Vict.
c. 33.

“(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,⁶ 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.⁷ Certificate of mark on deposit.

“(13) As regards any rules or forms affecting cotton marks which are proposed by the Board of Trade to be made, the draft Rules.

¹ August 11th, 1905. The Act generally came into operation on April 1st, 1906.

² As to word marks generally, see p. 151.

³ Inspection of the Register, sec. 7.

⁴ As to refused marks, see the Rules of 1912, referred to below, p. 134. The statutory right of public inspection of

all refused marks is not, of course, affected by such Rules.

⁵ See above, p. 129.

⁶ 5s.

⁷ This is a certificate of an application having been made, Form MB, No. 1, p. 758. As to certificates, see sub-sec. (8) and sec. 51.

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.¹

Existing
practice
preserved.

“(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.”²

The Rules, Nos. 113 to 118, relating to cotton marks, have already been noticed in the text or the notes. They will be found fully set out in the Appendix,³ together with the Trade Marks Rules, 1912, which came into force on January 1st, 1912. The effect of the Rules of 1912 is that the search made by the Keeper of Cotton Marks upon an application does not extend to all marks which have been refused, but only to such as have been refused within fourteen years and to those refused upon applications of earlier date which have been continued for quotation in the collection of refused marks under the provisions of these Rules. A refused mark is not continued in such collection after fourteen years, except on payment of the prescribed fee, a similar fee being payable on each renewal at the expiration of every period of fourteen years. Rule 115 is repealed.

The Palatine
Court of
Chancery.

“The Court” is in England the High Court of Justice,⁴ but a co-ordinate jurisdiction with that of the High Court of Justice is vested in the Court of Chancery of the County Palatine of Lancashire in respect of any action or other proceeding in relation to trade marks, the registration whereof is applied for in the Manchester Office, subject to the ordinary right of appeal from decisions of that Court.⁵

The registration of oriental words as part of a mark, a matter which greatly concerns the cotton trade, will be dealt with later.⁶

¹ As to the power of the Board of Trade to make Rules, see sec. 60, and above, p. 63.

² See above, p. 130.

³ Pages 734, 766.

⁴ Sec. 3.

⁵ Sec. 71.

⁶ Rule 28 deals with marks con-

taining words in characters other than Roman, or in a language other than English; see p. 723. The Office formerly refused to register words in oriental character, except “Chop” and “Hong” marks, *i.e.*, firm names in Chinese; see *Dewhurst's Application*, [1896] 2 Ch. p. 141; 13 R. P. C. p. 292.

CHAPTER VIII.

WHAT MARKS MAY BE REGISTERED AS TRADE MARKS.

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THE marks which may be registered as trade marks were determined, from the commencement of the Register until the end of 1883, by sec. 10 of the Act of 1875; from the last-mentioned date until the end of 1888, by sec. 64 of the Act of 1883, from the beginning of 1889 to April 1st, 1906,¹ by the amended sec. 64, enacted by sec. 10 of the Act of 1888, and since the last-mentioned date by sec. 9 of the Act of 1905.² Section 9 is as follows:—

“ A registrable trade mark must contain or consist of at least one of the following essential particulars:— Registrable trade marks.

- (1) The name of a company, individual or firm represented in a special or particular manner;
- (2) The signature of the applicant for registration or some predecessor in his business;
- (3) An invented word or invented words;
- (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;
- (5) Any other distinctive mark, but a name, signature, or word or words, other than such as fall within the

¹ Except that certain changes of the law as to cotton marks took effect from August 11th, 1905.

² As to cotton marks, see also sec. 64 (10), above, p. 133.

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 :

“ 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.

“ 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.”

Sec. 10 of
Act of 1875.

Sec. 10 of the Act of 1875 (now repealed) was as follows :—

“ *For the purposes of this Act :*

A trade mark consists of one or more of the following essentials : 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 Act¹ may be registered as such under this Act.”

Sec. 64.

Sec. 64 of the Act of 1883, as amended by the Act of 1888, was, so far as relates to what might be registered, as follows :—

“ **64.** (1.) *For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars*

¹ August 13th, 1875.

- (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;¹ 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. . . .*
- (3.) *Provided as follows : . . .*
- (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 13th day of August, 1875, may be registered as a trade mark under this part of this Act."*

Comparing sec. 9 in a general way with the sections of the earlier Acts, it will be seen that names and signatures have been registrable under all the Acts ; that, except as to old marks, words were not essential particulars under the Act of 1875, and that paragraphs (3) and (4) owe their inception to an alteration made by the Act of 1888, and that devices, labels and tickets, if distinctive, have been registrable under all the Acts, for "mark" in the Act of 1905 includes these by virtue of the definition clause, sec. 3.

Before the Registration Acts it was necessary for the plaintiff in a trade mark action to plead that the mark in question had acquired a reputation and become known as his by user in connection with his goods ; but the Court did not require him to prove that the user had extended over any long or defined period, and it was therefore practically open to a trader to obtain protection against infringers of a newly-devised mark which had hardly been used at all.² The Acts have provided an additional mode of acquiring trade mark rights, for it has been held that marks which have never been used may be registered as trade marks, and a right of property thereby acquired in them.³ "In my opinion," Cotton, L.J., said, in *Hudson's* case, "the language (of

New marks may be registered.

¹ In the Act of 1883, there followed here, "or fancy word or words not in common use ;" (d) and (e) were introduced by the Act of 1888.

² *Hudson's Tm.*, 32 C. D. 311 ; 3 R. P. C. 155 (1886), C. A. ; *Great Tower Street Tea Co. v. Smith*, 6 R. P. C. 165 ; 5 T. L. R. 232 (1889), North, J.

³ See above, Chap. II., p. 36.

the Act of 1875), though not appropriate, means this, that a man who designs one of those special things pointed out in sec. 10, is, as designer, to be considered as the proprietor of it, and if there is no one else who has used it, or who can be interfered with by the registration and subsequent assertion of title to the mark, then he is to be considered as entitled within the meaning of the Act to the exclusive use of that which in fact he has never in any way used, but which has only been designed by him, and which he can be treated as the person entitled to register, if no one else had so used it as that his user would be interfered with by the registration." The Act of 1905 expressly includes in the definition of a trade mark contained in sec. 3 a mark "proposed to be used."

Applicant must intend to use the mark.

But the applicant for the registration of a new and unused mark must intend to use it as a trade mark, for it is not permitted to place marks on the Register merely to prevent other traders using and appropriating them.

This principle was laid down by the Courts in decisions before the Act of 1905, and is now embodied in sec. 37. It is more fully discussed in a subsequent chapter.¹

Section 9 of the Act of 1905.

This section governs all applications for registration, and all registrations made or taken to be made since the commencement of the Act, April 1st, 1906. As, however, decisions on the repealed Acts often have a bearing on the corresponding provisions of the Act of 1905, it is desirable to consider the terms of the sections in the earlier Acts corresponding to sec. 9, and to compare their provisions with those of that section.

What law is applicable to marks registered under repealed Acts.

Until quite recently every registered trade mark was open to attack if it was alleged that its original registration was invalid. Sec. 6 of the Act of 1905 expressly provides that the validity of the original entry of any trade mark upon the Register must be determined (subject to the provisions of secs. 36 and 41) in accordance with the law in force at the date of such entry.² Sec. 36 of the Act, however, provides that no trade mark which was upon the Register at the commencement of the Act

Section 36.

¹ Chap. XI., below, at p. 327.

² This was also the law under the earlier Acts. See *Ward, Sturt and Sharp's Tms.*, 50 L. J. Ch. 347; 44

L. T. 97 (1881), Hall, V.-C.; and *Re Bovril Tm.*, 13 R. P. O. 388 (1896); 2 Ch. 604, per Lindley, L.J.

and which under the 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; and "registrable trade mark" is defined as a trade mark which is capable of registration under the provisions of the Act.¹ Now, however, the original registration of a trade mark which was on the Register at the commencement of the Act cannot be attacked, except on certain special grounds, because the period of seven years mentioned in sec. 41² has expired in the case of all such trade marks, and the provisions of sec. 36 will rarely, if ever, be needed by the owner of such a mark to save it from being expunged from the Register.

The provisions of sec. 36 have come under the consideration of the Court on several occasions. Thus it was decided by Neville, J., that the proper construction to be put on this section is, not that a trade mark registered under a former Act must be judged of as if the Act of 1905 had been in force at the date of such registration, but that it must be ascertained whether, under the facts existing when the decision is given, the mark is capable of registration under the Act of 1905, and he held that a word which was at the date of the decision the name of an article was not saved from removal by the section.³ On appeal, Buckley, L.J., said that he thought one could read the section thus: "Take the facts of to-day and the law of to-day, and inquire whether if the mark were taken off it would on the facts of to-day and the law of to-day be entitled to go on again. If so, leave it alone." It did not mean, "Take the facts of 1884" (the date of registration of the mark in question), "assume the law of 1905 to have been the law in 1884, and see whether upon that assumption the registration could validly have been made in 1884."³ Kennedy, L.J., agreed with this judgment. Lord Alverstone, L.C.J., thought that there was a good deal of difficulty as to the meaning of sec. 36, and found that, whichever construction was given to it, the appeal failed. In a later case, Parker, J., suggested that the section might be interpreted as meaning that the facts existing at the commencement of the Act of 1905 and not those at the date of the decision were to be considered. But he did not decide the

Decisions on
Section 36.

¹ Sec. 3, above, p. 25.

² Chap. XII., below, p. 368.

³ *Gestetner's Tm.*, [1907] 2 Ch. 478;

24 R. P. C. 545; and on appeal, [1908]

1 Ch. 513; 25 R. P. C. 156.

point.¹ Section 36 concludes with a proviso that nothing contained in it shall subject any person to any liability in respect of any act or thing done before the commencement of the Act to which he would not have been subject under the Acts then in force. There is no saving as regards acts of infringement done after the commencement of the Act and before the decision that the trade mark is a registrable trade mark under the Act.

Sec. 9 is purely restrictive.

Section 9 is purely restrictive, as were also the corresponding sections of the earlier Acts, which it has replaced. They were intended to limit and curtail the numerous forms of words and other things which, before the Acts, were appropriated as trade marks.² The intention of the Legislature was in the Act of 1905 to enlarge the classes of registrable marks.³

No mark can be put upon the Register unless it complies with the terms of sec. 9, but the presence in it of one or more of the specified particulars does not make the mark a good trade mark,⁴ or, of necessity, entitle it to registration. Some restrictions on registration are imposed by the Act itself,⁴ and the Registrar has, as is shown elsewhere,⁵ some discretion to allow or refuse registration where all the conditions of the Acts are complied with.⁵ In the case of cotton marks some of the essential particulars enumerated in sec. 9, *e.g.* words, are excluded.⁶

Essential Particulars.

A registered trade mark must contain one or more of the essential particulars, or be an old mark.

No trade mark can be properly registered unless it contains one or more of the essential particulars enumerated in the Act under which the registration is made,⁷ or unless it is within the proviso relating to old marks. This is clear from the Acts, but it is also supported by judicial authority. Thus, in *The Orr-Ewing* case, Lord Cairns said:⁸ "I cannot think that the Vice-Chan-

¹ *Philippart v. Whiteley*, [1908] 2 Ch. 274; 25 R. P. C. 565. The section was applied by Eve, J., in *Re Orhwoola Tm.*, [1910] 1 Ch. 130; 26 R. P. C. 681, 850; but in the Court of Appeal it was held that the mark was not registrable under the Act of 1905, and it was expunged.

² Per Cotton, L.J., in *Van Duzer's Tm.*, 34 C. D. p. 634; 4 R. P. C. 31 (1887).

³ See *Apollinaris Application*, [1907] 2 Ch. 178; 24 R. P. C. 436, Kekewich, J.,

and *Crosfield and Sons, Ltd.'s Application*, [1910] 1 Ch. 118; 26 R. P. C. 837, per Fletcher Moulton, L.J.

⁴ Above, p. 24; also secs. 11, 19 and 20. See Chap. X., below, p. 246.

⁵ Chap. IV., p. 76.

⁶ Sec. 64 (16), and above, p. 131.

⁷ But see also sec. 36, above, p. 141.

⁸ *Orr-Ewing v. The Registrar of Tms.*, 4 App. Ca. p. 484; 48 L. J. Ch. 710 (1879).

cellor Hall sufficiently appreciated the object and provisions of the Act of Parliament when he said that he considered that, in each case, a device or label, registration of which is applied for, must be looked at as a whole, and that, if it appears to be such as in the ordinary course of business would be distinguished from other devices or labels, it should be registered. To some extent, no doubt, this is true; but I apprehend the first duty cast upon the Court is to ascertain whether some one, or more than one, of the essential particulars of a trade mark, as defined by the Act, is found to exist, so that the mark may be described with the one, or more than one, essential particular or particulars which distinguish it." And in a latter case, under the Act of 1883, Chitty, J., said:¹ "The argument is that, though neither of the particulars is within the 64th section, the mark must be looked at as a whole; and being looked at as a whole, it is brought within the sub-sec. (c) (as a device or label) because as a whole it is distinctive. This point was raised before Mr. Justice Pearson, in *Price's Patent Candle Co.'s* case,² and without success. It is quite true that the mark must be looked at as a whole, but we must find in the whole, one at least of the essential particulars; and not one of the essential particulars, in my opinion, can be found in this mark." So, in *The Birmingham Vinegar Brewery Co.'s Application*,³ Kekewich, J., in considering a label, set aside the argument that, although there were none of the essential particulars in detail, yet the combination of many particulars which were not essential might make the whole label into an essential particular. In *Wright, Crossley & Co.'s Application*,⁴ in which the applicants sought to register a label alleged to be distinctive, Byrne, J., after referring to the cases already quoted, and holding that the mark did contain an essential particular or particulars, inasmuch as it contained certain devices, said: "These devices, as and when used as part of the trade mark, with the rest of the label appear to me to make the whole label distinctive."⁵

¹ *Bradley's Tm.*, 9 R. P. C. p. 207 (1892). The mark in question consisted of the words *Worth's Corsets* printed in ordinary type, between two co-axial ovals.

² 27 C. D. 681; 54 L. J. Ch. 210 (1884). A conventional label with the words *National Sperm* printed on it. As to labels, see further, pp. 214 to 220.

³ 11 R. P. C. 195; 70 L. T. 646 (1894).

⁴ [1900] 2 Ch. 218; 17 R. P. C. 386.

⁵ But, although in *Clement et Cie.'s Tm.*, [1900] 1 Ch. 114; 16 R. P. C. 611, the Court of Appeal were considering a different question, namely, whether a word was part of a mark or an addition to it, they appear to have assumed that the label must be considered as a whole. See also *The Smokeless Powder*

These cases, so far as they decide that a trade mark must contain an essential particular, are still authorities applicable to the present Act. It should be borne in mind, however, that that Act contains no reference, as the Act of 1888 did, to additions or "added matter,"¹ and it seems to be the intention of the Act, that provided an essential particular is found in the mark, it should be registered as a whole, with such disclaimer only as may be necessary under sec. 15.

The sub-sections are alternative.

The five divisions into which essential particulars were by sec. 10 of the Act of 1888 divided, were held to be separate and distinct.² In the case of (d) and (e) a different conclusion was arrived at by the Court of Appeal in *The Somatose* case,³ where it was held that a word could not be registered as an "invented word" unless it also was a word "having no reference to the character or quality of the goods," but this construction of the Act was disapproved of by the House of Lords in *The Eastman Photographic Materials Co., Ltd.'s Application*,⁴ and the decision of the Court of Appeal was reversed. The divisions are likewise distinct under the Act of 1905. Therefore, although in construing one division the scope of another division may be material,⁵ the fact that a thing is not an essential particular under one heading will not prevent its being a proper essential particular under another heading. It follows, too, from this construction that qualification under more than one heading is possible—for instance, a word might be an invented word within (3), and also be a word having no direct reference to the character or quality of the goods within (4).

Additions now abolished.

The former enactments requiring an applicant for registration to state in his application the essential particulars of the trade mark, and also to disclaim any right to the exclusive use of added matter and of any addition are omitted in the Act of 1905, no mention of "added matter" or of "additions" being contained in the present Act. A wide power to require disclaimer is,

Co.'s Tm., [1892] 1 Ch. 590; 9 R. P. C. 109. See also below, "Label."

¹ Sec. 64 (2) and sec. 74 (2) of the Act of 1888, as amended.

² See Ld. Herschell's judgment in *Eastman & Co., Ltd.'s Application*, [1898] A. C. 571; 15 R. P. C. 476.

³ *Farbenfabriken Vormals F. Bayer & Co.'s Tm.*, [1894] 1 Ch. 645; 11

R. P. C. 84.

⁴ See note (2).

⁵ See, for instance, *Holl's Tm.*, [1896] 1 Ch. 711, 717; 13 R. P. C. 16 and 118 (1896), North, J., and C. A.; *Pirie v. Goodall*, [1892] 1 Ch. 35; 9 R. P. C. 17, Vaughan Williams, J.; and see *Benz's Application*, 30 R. P. C. 177 (1913).

however, conferred by sec. 15, where necessary, to define the rights of the proprietor of the trade mark.¹

(1) The name of a company, individual or firm represented in a special or particular manner. Name marks.

Names are highly valued as trade marks, or as essential particulars of trade marks, and they were often adopted and protected as such before the Acts.² Since 1875 the corresponding part of the earlier Acts had been as follows:—(a) *A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner.*³

It was pointed out that under the former wording the name of a body corporate might possibly not be included, the word “person” which would have included it not being used.⁴ In the present Act the word “company” is introduced.

The name need not be that of the company, individual or firm applying for registration, or that of a predecessor in business.⁵ But the name must be that of a real company, individual or firm as opposed to an imaginary company, individual or firm. Thus it was held in *Holt & Co.’s Trade Mark*,⁶ by Lindley and Smith, L.JJ. (Kay, L.J., dissenting), that *Trilby*, being the name of an imaginary person taken from a novel, was not within clause (a) of sec. 64 (1) of the Act of 1883; and Lindley, L.J., said: “Clause (a) does not say that the name to be registered need be the name of a living person, nor the name of the applicant for registration. In this respect clause (a) differs from clause (b). The reference to a firm, however, points rather to real persons than to imaginary persons. In metaphorical language, an imaginary person may perhaps be called an individual, but such a use of the word is unusual, and to my mind rather fanciful. It is hardly to be supposed that the Legislature meant ‘individual’ to be taken in a fanciful or metaphorical sense, or meant it to denote an imaginary person who has not and never had

Name of
imaginary
person.

¹ See Chap. IX., p. 236.

² “The name of a firm is a very distinctive word indeed”: per Jessel, M.R., in *Ex parte Stephens*, 3 C. D. p. 660; 46 L. J. Ch. p. 47 (1876).

³ Sec. 10 of the Act of 1875. Sec. 64 of the Act of 1883. No change was made by the Act of 1888.

⁴ *Colman’s Application*, [1894] 2 Ch. 127; 11 R. P. C. at p. 134.

⁵ Cf. para. (2), below, p. 149.

⁶ 13 R. P. C. 16 and 118, C. A., [1896] 1 Ch. 711, reversing North, J. It was argued that if the word fell under clause (a)—with the condition of which it did not comply, as it was not printed in any distinctive manner—it could not be registered under clause (c). The majority of the C. A. approved the argument, but held that the word did not fall under clause (a). For these clauses, see above, p. 139.

any real existence." The question whether clause (a) was satisfied if it can be shown that the name has at some time been the name of a real person or firm did not arise; but there is nothing in the judgments of Lindley and Smith, L.JJ., to indicate that they considered that such a name would not fall within clause (a).¹ The alteration in the present Act from "a name" to "the name" makes it more clear that a real company, individual or firm is intended. In a recent case Joyce, J., said that he took it to be clear that under this paragraph no one would be entitled to have his surname registered alone by itself, and on appeal, Farwell, L.J., agreed with this;² and where a company whose name included the word "Benz" applied to register a mark consisting substantially of that name, it was held that the word was not the name of an individual, nor of a company, and could not be registered under paragraph (1).³ A mere surname is not the name of an individual at all events unless it is shown that the individual is known in the trade merely by his surname.³

The practice of adopting trade names which are different from those of the traders or of the partners in the firm using them is very common—for instance, in the Scotch whiskey trade, in which it is a common practice to use a Scotch name. The practice is of itself perfectly lawful,⁴ and such a name so adopted, and although so adopted for one branch only of a business, would no doubt be within the clause; and as this practice is allowed, there seems to be no reason why a trader should not adopt as his trade mark the name of a real⁵ or imaginary individual. But the effect of the decision in *Holt's Trade Mark* as applied to the present Act is⁶ that if the name adopted be that of a real person or firm, it comes under paragraph (1), and must be represented in a special or particular manner; whilst if it be that of an imaginary person, it can be registered in ordinary lettering under

¹ In *Banks and James' Tm.*, 12 R. P. C. 333 (1895), Chitty, J., held that *Shakspeare* was not a "fancy word," one of his reasons being that there were many living persons of the name.

² *Lea's Application*, [1912] 2 Ch. 32; 29 R. P. C. 165; [1913] 1 Ch. 446; 30 R. P. C. 216. Farwell, L.J., excepted the case of a firm name. See also *Teofani v. Teofani*, 30 R. P. C. 446 (1913).

³ *Benz et Cie., Application of*, 29 R. P. C. 357; 30 R. P. C. 177, Joyce, J., and C. A. (1913).

⁴ See *Macmillan v. Ehrmann Bros., Ltd.*, 21 R. P. C. 647 (1904), C. A., where, however, Vaughan Williams, L.J., regretted the lawfulness of the practice.

⁵ Cf. *A. W. Gamage, Ltd. v. H. B. Randall, Ltd.*, 16 R. P. C. 185 (1899) (a passing-off case in which the plaintiffs failed. *Shorland* for cycling shoes). Makers of tennis racquets sometimes name their racquets after well-known players.

⁶ See note (6), p. 145.

paragraph (4), provided that it has no direct reference to the character or quality of the goods.¹ Names falling within clause (1) are not within clause (4).² Names, however, which do not fall within paragraphs (1) to (4) may, if distinctive, be registered under paragraph (5) on special application.³

It does not follow that every name of a company, individual or firm, represented as required by paragraph (1), which an applicant may select is entitled to registration, for, apart from the general restrictions expressly specified by the Act,⁴ the Registrar, in the exercise of his discretion, would,⁵ no doubt, reject any name which, contrary to the fact, tended to suggest that the goods on which it was used were the manufacture or merchandise of, or had some connection with, a particular company, person or firm, or were goods of a particular kind, especially if the name were not the proper name of the applicant or of his predecessors in trade.⁶ And if the name indicated a particular living person, who did not assent to the use of his name, the Registrar might in his discretion reject it, even although no connection of the person with the particular goods would be suggested.⁷

The name must be the mere name in the nominative case. Thus, where *Pirie's Parchment Bank* was registered as a trademark, and the two latter words were disclaimed, Lindley, L.J., held that *Pirie's* was not the name of a firm within the former sub-section.⁸

Name must be mere name in nominative case.

And as regards the registration of names in the possessive case, generally, Lord Herschell's Committee reported⁹ that

¹ See *infra*, p. 171.

² The principle of the decision in *Holt's* case, *supra*, would seem to apply under the present Act.

³ As to this, see *Lea's Application*, [1912] 2 Ch. 32; 29 R. P. C. 165; [1913] 1 Ch. 446; 30 R. P. C. 216.

⁴ Secs. 11, 19 and 20; Chap. X., p. 246.

⁵ See p. 76.

⁶ Cf. *Thorneloe v. Hill*, [1894] 1 Ch. 569; 11 R. P. C. 61 (*John Forrest*—passing-off case).

⁷ By Rule 15, where the names or representations of living persons appear on a trade mark, the Registrar shall, if he so require, be furnished with consents from such persons before proceeding to register the mark. The rule also provides that the Registrar may require the consents of legal personal

representatives in the case of persons recently dead. See also *Carroll's Application*, 16 R. P. C. 82 (1899), Kekewich, J. (*Princess Christian*). Portraits of well-known persons have, with their consent, been registered as trade marks.

⁸ *Pirie v. Goodall*, [1892] 1 Ch. 35; 9 R. P. C. 17; cf. *Colman's Tm.*, [1894] 2 Ch. 115; 11 R. P. C. 129, where Stirling, J., held that *Colman's* occurring in a label need not be disclaimed under sec. 64 (3) (1) of the Act of 1833, as amended by the Act of 1888. These cases were followed by Joyce, J., in *McEwan's Application* and *Lea's Application*, [1912] 2 Ch. 32; 29 R. P. C. 165. "*McEwan's*" and "*Boardman's*"; and see the judgments of the Court of Appeal, [1913] 1 Ch. 446; 30 R. P. C. 216.

⁹ Report of 1888, p. xii.

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

The report continues: “Evidence has been given that marks consisting of a combination of the applicant’s name with the article he manufactures or sells are highly valued. There can be no doubt that if a manufacturer or vendor has obtained for his goods a reputation amongst the public, he could, by process of law, quite apart from the Trade Marks Act, prevent goods that were not his from being offered to the public on the representation that they were so. But it would be quite a different thing to give, by virtue of registration under the Trade Marks Act, a right to prevent another manufacturer or merchant honestly describing his own goods by his own name.”¹ The effect of the decision in *Pirie v. Goodall*² was to put a stop to the registrations which the committee thought objectionable.

Special or
particular
manner.

The word “distinctive” has been dropped in the present Act. Every trade mark must be distinctive, that is, capable of distinguishing the goods from those of other persons. The word “special” has been, in conjunction with the word “distinctive,” construed by the Court as regards marks registered as old marks.³ There seems to be little difference in meaning between “special” and “particular.” The intention of the requirement that the name should be represented in a special or particular manner is obviously to prevent a name from being so taken as a trade mark that any trader might unintentionally infringe it by an honest use of his own name.⁴ This intention would be carried into

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

² See note (8), ante, p. 147.

³ See below, p. 180.

⁴ See the extract quoted above from the report of Ld. Herschell’s Committee. As to the right of a man to

effect by construing the words to mean "not ordinary, having regard to the practice in the trade concerned."¹

It was held under the old clause that a name printed in ordinary type,² or in type in ordinary use, as, for instance, capitals,³ or common ornamental letters,⁴ was not within the clause; and that the addition of marks which are common to the trade makes the words no better as a trade mark.⁵ Similar decisions would no doubt be given under the Act of 1905.

Ordinary type.

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

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

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

Under the Act of 1875 the latter words of the clause ran "of an individual or firm." The addition "applying for registration" was effected by the Act of 1883. A trader can now register the signature of his predecessor in business under this sub-section. Under the old clause (b) this could not have been done, but it is possible that a signature might have been registered under the old clause (a),⁶ and a signature of a predecessor could probably have been registered as an old mark.⁷ Of course, the signature of a predecessor in business, properly registered by him and assigned or transmitted as a trade mark, together with the goodwill of the business, is usually as available for use by the successors, and can be as readily protected, as if it had been originally registered by them.⁸ The words "written signature of a firm" were construed by the Comptroller to mean a signature (actually used in the

trade under his own name, see below, p. 593; but cf. *Hopkinson's Tm.*, note (1), p. 148.

¹ In *Benz et Cie., Application of*, 30 R. P. C. 177 (1913), Hamilton, L.J., said that he supposed that "represented in a special or particular manner" meant the opposite of represented in a general manner. In the view the Court took, the question whether "Benz" was in the trade mark applied for represented in a special or particular manner did not call for decision.

² *Carroll's Application*, 16 R. P. C. 82

(1899) (*Princess Christian* for needles).

³ *Gianaclis' Tm.*, 6 R. P. C. 467; 58 L. J. Ch. 782 (1889), North, J. (*Gianaclis Cigarettes*).

⁴ *Re Price's Patent Candle Co.*, 27 C. D. 681; 54 L. J. Ch. 210 (1884), Pearson, J.

⁵ *Ibid.*, and *Bradley's Tm.*, 9 R. P. C. 205 (1892), Chitty, J.; (*Worth's Corsets*) printed between two co-axial ovals.

⁶ This is discussed in the 2nd ed. of this work, p. 129.

⁷ As to old marks, see below, p. 222.

⁸ See Chap. XIII., p. 384, Assignment and Devolution of Trade Marks.

ordinary course of business) of the trading style under which the applicant had a *bonâ fide* right to trade, and which consisted of a *personal name* or of *personal names*, and not to include mere descriptive trading styles, such as *The Excellent Tea Co.* or *The London Stout Co.*¹ In a case under the Act of 1888, "Macfarlane & Co.," which had been registered as a signature, was ordered to be removed from the Register, it being admitted that it was an adopted trade name and not the signature of an existing firm.²

Requirements
for a good
trade mark.

Copies of written signatures were frequently protected as trade marks, or as material parts of trade marks, before the Acts.³ As a man's signature has for several centuries been the mark in universal use to authenticate documents which are his, it might have been expected that it would have been used also to authenticate his goods, and that signatures would have occupied a more prominent place among trade marks than they do. There are, however, several objections to a signature as a trade mark. A good trade mark must not only enable a customer to recognise the goods which bear it, when he sees them, as those of the manufacturer or trader with whom he wishes to deal, but must also enable him to describe and call for them. As regards the latter requirement, a signature is usually nothing more than a bare name mark, for the manner of writing it will rarely be such as to enable even a person who could read and recognise it at sight to recollect and describe it; and it is obvious that for customers—some foreigners, for instance—who are unable to read the signature, it, or indeed any name mark, fulfils neither of the requirements referred to. Another disadvantage of a signature as a trade mark is that the protection afforded is very narrow. Thus, a trade mark of which the signature of one of the complainers (it being a Scotch case), Daniel Crawford, was the essential particular was held not to be infringed by a facsimile of the signature of the respondent, Robert Crawford, and apparently the judgment would have been the same although the names had been identical. Lord Kyllachy, after pointing out that the case put forward was purely a trade mark case, said: "Now it is new to me that a man who has a registered trade mark

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

² *Macmillan v. Ehrmann Bros., Ltd.*, 21 R. P. C. 357 (1904), Buckley, J.

³ As in *Farina v. Silverlock*, 1 K. & J.

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

or facsimile of his own signature can complain of another trader using as a trade mark a facsimile of his own merely because the two names happen to be the same;" and, without hearing evidence, he decided that the case was not sustainable.¹

Word Marks.

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

Words as
trade marks.

Word marks were common enough before the Registration Acts, and provision has been made in all of these for the registration of any special and distinctive word or words used as trade marks before August 13th, 1875, the date on which the Act of 1875 came into operation, and also, under sections already considered, for the registration of the name of an individual or firm printed, &c., in some particular and distinctive manner, and of a written signature or copy of a written signature. Except such old marks, names, and signatures, no other word marks could be registered under the Act of 1875.² This was altered by the Act of 1883, which, under sec. 64 (1) (c), allowed the registration of "a fancy word or words not in common use." The expression "fancy word," however, gave rise to considerable differences of opinion as to its meaning, and after the report of Lord Herschell's Committee it was struck out of clause (c), and the two new clauses (d) and (e) were substituted for it.³ These clauses allowed the registration of: (d) "an invented word or invented words"; and (e) a "word or words having no reference to the character or quality of the goods, and not being a geographical name."

¹ *Crawford & Son v. Bernard & Co.*, 11 R. P. C. 580 (1894); and cf. *Barber v. Manico*, 10 R. P. C. 93 (1893), where Smith, L.J., sitting as a judge of first instance, held that the words *Edward Barber* were not an infringement of an old trade mark consisting of the words *Era James Barber, Sheffield*.

² *Ex parte Stephens*, 3 C. D. 659; 46 L. J. Ch. 46 (1876), Jossel, M.R. (*Acilyton*); *Rose v. Evans*, 48 L. J. Ch. 618 (1879), Hall, V.-C. (*Limetta*); see per Lindley, L.J., in *Van Duzer's Tm.*, 34 C. D. 623; 4 R. P. C. 31 (1887).

³ Act of 1883, sec. 10.

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

Geographical
names.

Translated
words.

Phonetic
equivalents.

The portion of the report above referred to, which relates to this subject, was as follows¹:—"It will be convenient to consider first what words ought to be allowed as trade marks. There can be no objection to permitting the registration of an invented word not to be found in the vocabulary of our own or any other country. It seems, further, that existing words may with advantage be permitted as trade marks, subject to limitations which at once suggest themselves. It is manifest that no one ought to be granted the exclusive use of a word descriptive of the quality or character of any goods. Such words of description are the property of all mankind, and it would not be right to allow any individual to monopolise them and exclude others from their use. Again, geographical words, which can be regarded as descriptive of the place of manufacture or sale of the goods, are open to obvious objections. One manufacturer or merchant cannot properly be allowed to prevent all his competitors from attaching to their goods the name of the place of their manufacture or sale. The mischief would not be the same where the person seeking to register was the first person who had manufactured or sold the goods in the place the name of which he seeks to appropriate as a trade mark. But there are objections to giving a monopoly even in that case, and to attempt to draw any such distinction would be likely to lead to difficulty and litigation.² We think, therefore, that geographical names ought only to be permitted where they clearly could not be regarded as indicative of the place of manufacture or sale. We would add upon this point that we think that where any English word would be rejected as not entitled to registration, no person ought to be permitted to register its translation into any other language. The question has been raised whether a word having the same sound as one entered on the Register, though spelt differently and with a different meaning, should be registered. The question in such a case would seem to be whether the resemblance between the old mark and that applied for was such as to be calculated to deceive; if it were, it ought, of course, to be rejected."

¹ Report of 1888, p. xi. On a question of construction of the Act of 1888, it is permissible to refer to this report in order to ascertain the evils which the Act was directed to remedy, per Ld. Halsbury, L.C., in *Eastman Pho-*

lographic Materials Co.'s Application, [1898] A. C. 571; 15 R. P. C. 476. The passage given in the text was from the words "It is manifest," quoted by Ld. Halsbury.

² See Chap. II., at p. 53.

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

Special restrictions as to the registration of words in the cotton classes are contained in sec. 64 (10) of the Act of 1905.¹

A Fancy Word or Words not in common use.²

This expression was contained in the Act of 1883, but by the amending Act of 1888, another expression was substituted for it, and, as the original registration of such a mark, registered whilst the expression had statutory force, must now be taken to be valid in all respects, unless certain special grounds of invalidity can be alleged,³ the decisions on the meaning of the expression are of interest rather as matters of the history of trade mark law, than as of practical importance. They are therefore stated more shortly than in the 3rd edition of this book, where they will be found fully discussed.

The meaning of the expression "fancy word or words not in common use" gave rise to considerable differences of opinion. Before the amending Act of 1888 had been passed, a definition of *fancy word* had been laid down by the Court of Appeal which seemed to be fairly clear and precise. In *Lloyd & Sons' Trade Mark*,⁴ Chitty, J., in the year 1893, summed up the result of the decisions to that time in the following passage: "To be a fancy word, the word must be obviously meaningless as applied to the article in question. On that principle the

Fancy words.

¹ See above, p. 133.

² A fancy word was a good trade mark before the Acts. "The more ridiculous it is, the better it is"; Wood, V.-C., in *Young v. Macrae*, 9 Jur. (N. S.) 322 (1862). The expression "fancy word" was well understood as being the antithesis of a descriptive word: see *Wotherspoon v. Currie*, L. R. 5 H. L. 508, Ld. Hatherley at p. 514

(1872); *Hirst v. Denham*, 14 Eq. 542 (1872), Bacon, V.-C.; *Blair v. Stock*, 52 L. T. 123 (1885), Kay, J.; *Alpine Tm.*, 29 C. D. 877 (1885), Chitty, J.

³ Sec. 41. The exceptions are of marks where the original registration was obtained by fraud, and of deceptive marks. See below, p. 371.

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

Court has held that the term *Gem*,¹ with reference to a gun, is not a registrable fancy word; with reference to hair restorer, that the word *Melrose*² is not a fancy word; with reference to velveteen, that the word *Electric*³ is not a fancy word; and with reference to lace, the opinion of Lord Justice Cotton appears to have been that the term *Alpine*⁴ was not a fancy word. These are some of the numerous illustrations that may be given of what may be thought by some to be the severe and strict construction which the Courts put upon the 64th section. There is another case, which I may also usefully mention, which is the case of *Jubilee* with reference to note paper.” The last-mentioned word was also held not to be a fancy word.⁴ The severity of construction, of which Chitty, J., spoke, was, however, somewhat relaxed by later decisions of the Court of Appeal, referred to below, which had the effect of confining the rules laid down by the earlier decisions of the Court to words which were either ordinary English words, or very slight modifications of such words,⁵ fancifully applied, or, perhaps it would be more correct to say, to words other than newly coined words.

Van Duzer's
case.

The leading cases are the consolidated appeals of *Van Duzer's Trade Mark* and *Leaf & Son's Trade Mark*,⁶ the appeals in *Re Trade Mark Bovril*,⁷ and in *Burroughs, Wellcome & Co.'s Trade Marks*,⁸ all in the Court of Appeal. The first case arose out of an application to register the words *Melrose Favorite Hair Restorer*, which had been adopted by the applicants in 1880, and were identified by reputation with their goods, and with theirs alone. The Court of Appeal refused to allow the application for registration to proceed, and the members of the Court laid down the following tests of a “fancy word.” Cotton, L.J., held that to be a *fancy word*, a word must be one “which obviously cannot have reference to any description or designation of where the article is made, or of what character it is.” So that it is not enough that it should be shown by

The fancy
word must
be obviously
meaningless.

¹ *Re Arbenz's Application*, 35 C. D. 248; 4 R. P. C. 143 (1887), Kay, J., and C. A.

² *Van Duzer's Tm.*, and *Leaf's Tm.*, *infra*.

³ 34 C. D. p. 639.

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

Chitty, J.

⁵ As *Reversi*, see below.

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

⁷ [1896] 2 Ch. 600; 13 R. P. C. 382, Lindley, Lopes and Rigby, L.JJ.

⁸ [1904] 1 Ch. 736; 21 R. P. C. 217.

evidence that it, in fact, has no such reference, and the incorrect or inappropriate user of a word which is descriptive does not make it a fancy word. Lindley, L.J., said: "To be a fancy word I think the word must either have, to ordinary English people, to whom this Act of Parliament is addressed, no meaning, like the word *Eureka* or the word *Acilyton*, or if it has any meaning at all, it must be obviously non-descriptive¹ when used as a trade mark"; and Lopes, L.J.,² laid down the following conditions as necessary in order that a word should come within the term:—It must be obviously meaningless as applied to the article in question; it must be fanciful in its application to the article to which it is applied, in the sense of being so obviously and notoriously inappropriate as to be neither deceptive nor descriptive, nor calculated to suggest deception or description; and, further, it must have "an innate and inherent character of fancifulness, which must not depend on evidence, and cannot be supported by evidence, to show that, in fact, it is neither deceptive nor descriptive, or calculated to be deceptive or descriptive." It must speak for itself. In *Leaf & Son's* case the Court, applying these criteria, held that *Electric* or velveteens was not a fancy word; and in *Waterman v. Ayres*,³ the Court of Appeal held, that *Reversi* was not a fancy word for a game.

However, in the later cases of *Re Trade Mark Bovril*, and in *Burroughs Wellcome & Co.'s Trade Marks*, where the words in question were *Bovril* and *Tabloids*, it was pointed out by the Court that these words were newly-coined words, whereas *Melrose* and *Electric* were ordinary English words, and not coined words, and the Court stated the conditions somewhat less rigorously.⁴

In *The Bovril* case,⁵ the word *Bovril* was new when registered, and had been on the Register for nine years in Class 42

The Bovril
case.

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

² Page 644.

³ 39 C. D. 29; 5 R. P. C. 368 (1888).

⁴ In *Densham's Tm.*, [1895] 2 Ch. 176; 12 R. P. C. 75 and 271, Romer, J., and the Court of Appeal had already

held *Mazawattee* to be a fancy word.

⁵ *Re Tm. Bovril*, [1896] 2 Ch. 600; 13 R. P. C. 382, Kekewich, J., and Lindley, Lopes and Rigby, L.JJ. The word is an obvious derivation from *Bos* and *Virilis*. Bovine and virility are ordinary English words. The word "vril" is found in Lord Lytton's novel "The Coming Race." It is curious that the Court which rejected *Somatose* (see below, p. 172) should have accepted *Bovril*.

for substances used as food. In an application to expunge the mark the Court held that as a fact *Bovril* was not descriptive. Lindley, L.J., after saying that it would be wrong to substitute for the words "fancy word" "a non-descriptive word," but that they must ask themselves fairly whether *Bovril* was a non-descriptive word, said: "I think it is eminently and purely a question of fact. Now, I ask myself this: Supposing that a jury were asked whether, on November 2nd, 1886, *Bovril* was a fancy word not in common use, and supposing they said, upon a direction from the judge, which I think it would be the duty of the judge to give, that, if they were of opinion that it really intelligibly described the thing sold, it would not do, could they, with that direction, screw themselves up to say that it was not a fancy word not in common use? I do not think they could. That really settles the matter." Lopes, L.J., also said: "I say to myself, What would an intelligent jury say if they were asked if *Bovril* was a fancy word? If I had had to try the case, I should have told them that they must keep in their minds that this word was placed upon the Register in 1886, and that they must regard it as it stood at that time. I should have told them that to be a good fancy word it must be nondescriptive and meaningless as applied to the article to which it was intended to be applied; and if I had so told them, I do not hesitate to say that I am confident that they would have come to the conclusion that the word was not descriptive, and that it was a good fancy word."

The Tabloid
case.

In *The Tabloid* case,¹ some manufacturing chemists, having for some time sold compressed drugs under the word *Tablet*, in 1884 registered for substances used in pharmacy the word *Tabloid*, which they invented for the purpose, and from that date they had sold compressed drugs under that name. With some hesitation the Court held that at the date of registration the word was a fancy word not in common use. They held that the "*Bovril*" case showed that it was not necessary that the word should be absolutely unsuggestive, and that, applying the test laid down by Lindley, L.J., referred to above, the word *Tabloid* was not one "really intelligibly describing the thing sold." Cozens-Hardy, L.J., said that the swing of the judicial pendulum had been very great, and the extreme point of that swing was to be found, he thought, in that case.

A list of words which have been held not to be "fancy words

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

not in common use" is given on a later page.¹ The following points which arose in cases on the meaning of the expression are briefly noticed.

The propositions laid down by the Court of Appeal in the cases cited do not amount to definitions from which tests to show affirmatively that any particular word is within the meaning of the Act can be drawn. They are negative propositions only. "To say that every word is a fancy word because it is unknown to an average Englishman, would be plainly to lay down a proposition which could not be for a moment maintained, (for) there are many good English words descriptive of articles which are unknown to an average Englishman, taking a rather high standard."²

The decisions are only restrictive.

A word descriptive³ of, or intelligibly suggesting a description of, the origin, qualities, or uses of the goods, is not a fancy word.⁴ The word *Gem*, therefore, having come into use to indicate excellence in the article to which it is applied, was held not to be a fancy word;⁴ and on an application to register it as a trade mark for air-guns, it was a further fatal objection that it had, by user, become descriptive of a particular class and make of gun.⁴

Descriptive words.

The Acts are directed to ordinary Englishmen,⁵ and the question whether the words put forward are obviously meaningless and non-descriptive in regard to the goods for which the mark is to be used, is to be tried, therefore, in the light of such information as ordinary Englishmen may be supposed to possess.

Words in a foreign language.

The name of the goods is not a good trade mark apart from any objection under the Acts,⁶ and it cannot, of course, be

Name of the goods in foreign language.

¹ Page 161, below.

² Per Chitty, J., in *Davis v. Stribolt*, 6 R. P. C. p. 211; 59 L. T. 854 (1888), *Bökol*, the name of a Norwegian beer, rejected as a trade mark for the beer.

³ "Descriptive" does not necessarily mean accurately so, but descriptive for practical and popular purposes, per Rigby, L.J., in *Reddaway v. Banham*, [1895] 1 Q. B. 297; 12 R. P. C. at p. 91.

⁴ *Arbenz's Tm.*, 35 C. D. 248; 4 R. P. C. 143 (1887), gem air guns. *Reversi*, *Satinine*, *Carnival*, *John Bull*, *Roadster*, *Cyclostyle*, and *Beatrice* are other instances, see below, p. 161.

⁵ See the judgments of Lindley, L.J., in *Van Duzer's* case, and Cotton, L.J.,

in *Waterman v. Ayres*, supra, and of Lindley, Lopes, and Rigby, L.JJ., in *Tm. Bovril*, supra, and of Kekewich, J., and Rigby, L.J., in *Magnolia Metal Co.'s Tms.*, [1897] 2 Ch. 371; 14 R. P. C. 265 and 621; *Lloyd & Sons' Tm.*, 10 R. P. C. 281 (1893) (*Carnival*); and *Burgoyne's Tm.*, 6 R. P. C. 227; 61 L. T. 39, *Oomoo*, cited below. Cf. the Report of Ld. Herschell's Committee, cited above, p. 152. Nevertheless, "Monobrut," *Vignier's Tm.*, 6 R. P. C. 490 (1889), and "Kokoko," *Jackson Co.'s Tm.*, 6 R. P. C. 80 (1888), were held not to be fancy words.

⁶ See Chap. II., at pp. 36 *et seq.*, and the judgment of Chitty, J., in *Barlow*

registered under them.¹ So that the introducers of a kind of beer, which was common in Sweden and Norway, were not allowed to retain on the Register the names by which it was ordinarily known in those countries, and under which it had been sold in England.² And a word which, though not English, carries a well-understood descriptive meaning,³ such as *Sanitas*⁴ or *Britannia*,⁵ is not a "fancy word." This rule did not, however, extend to exclude words taken from a barbarous language. So that the word *Oomoo*, which was said to mean "choice" or "select" among some of the Aborigines of Australia, was held by Chitty, J., to be a fancy word notwithstanding.⁶

The name suggested by a mark which is common to the trade is not a fancy word.⁷

Names of
common
marks.

Secondary
distinctive
meaning does
not constitute
a fancy word.

In *The Singer* cases, and other cases of word marks before the Acts, the contest was whether the name was that of the article merely, or whether it had acquired a secondary meaning identifying the article with the owners of the marks;⁸ but under the Acts of 1883 and 1888 such secondary meaning, so far as regards the right to registration,⁹ is immaterial in the case of marks not used as trade marks before August 13th, 1875. It cannot make a word a fancy word within the Act of 1883,¹⁰ or an invented word within the Act of 1888 or 1905; it may have an important bearing, however, under paragraph (5) of sec. 9 of the Act of 1905.¹¹

Geographical
words.

In *Van Duzer's* case both Cotton and Lindley, L.JJ., refused to hold that no geographical name could possibly be a fancy

v. *Johnson*, 7 R. P. C. 395 (1890); also *Gestetner's Tm.*, [1907] 2 Ch. 478; [1908] 1 Ch. 513; 24 R. P. C. 545; 25 R. P. C. 156.

¹ Per Fry, J., in *Waterman v. Ayres*, supra, p. 155, note (3).

² *Davis & Co. v. Stribolt & Co.*, 6 R. P. C. 207; 59 L. T. 854 (1888), Chitty, J. (*Bökol* and the Swedish form of that word).

³ Ld. Herschell's Committee reported that, in their opinion, "where any English word would be rejected as not entitled to registration, no person ought to be permitted to register its translation into any other language. See the whole passage cited above, p. 152.

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

⁵ *Hodgson v. Sinclair*, 9 R. P. C. 22 (1891), Chitty, J.

⁶ *Burgoyne's Tm.*, 6 R. P. C. 227 (1889).

⁷ *Jackson Co.'s Tm.*, 6 R. P. C. 80 (1888), Kay, J., *Kokoko*, meaning among an Indian tribe owl, which was a common mark; but with regard to the actual decision, cf. the last case cited.

⁸ Chap. II., at p. 40.

⁹ It may have an important bearing upon passing off cases, see *Reddaway v. Banham*, [1896] A. C. 199; 13 R. P. C. 213, and Chap. XVI., p. 565.

¹⁰ *Van Duzer's Tm.*, 34 C. D. 623; 4 R. P. C. 31 (1887), C. A.; *Sanitas Co.'s Tm.*, 4 R. P. C. 533; 58 L. T. 166 (1887); and see below, p. 205.

¹¹ See below, p. 179.

word. And Lindley, L.J., said:¹ "If you pick out some name which no Englishman ever heard of, such as *Penj Deh*, to which our attention was called some years ago, I do not know that that would not do. It conveys no meaning to an Englishman, and such a geographical name, for all I know, may be a fair and proper fancy word." But, as was held in that case, a name which is known to be that of a place from which the goods might come is not registrable.² So, in *The Apollinaris* case, the Court decided that the names of the springs from which the mineral waters came, and which were not the property of, or wholly controlled by, the traders who sought to appropriate the names as trade marks, could not be registered.³

The name of a person,⁴ even though the person be a mythical person,⁵ is not a fancy word, and the name of an individual registrable under (a) could not be registered under sec. 64 (1) (c) of the Act of 1883 as a fancy word.⁶

Name of a person.

A combination of words, each of which is common to the trade, is not a "fancy word."⁷

Combination of words.

Not in Common Use.

In order to come within sec. 64 (c) of the Act of 1883 the word or words not only must be a fancy word or fancy words, but must not be in common use. The time to be considered is the date of application.⁸

¹ 34 C. D. p. 643.

² See also *Batt's Tm.*, 6 R. P. C. 493 (1889), Chitty, J., *Brymbo*, for steel.

³ [1891] 2 Ch. pp. 203, 221; 8 R. P. C. 137, C. A. "*Apollinaris*" has now been held to be a word "deemed to be a distinctive mark" under para. (5) of sec. 9 of the Act of 1905, [1907] 2 Ch. 178; 24 R. P. C. 436, Kekewich, J. The word *Britannia* was held to be objectionable on the ground that it is a geographical word, *Hodgson v. Sinclair*, 9 R. P. C. 22 (1891), Chitty, J.

⁴ *Banks and James' Tm.*, 12 R. P. C. 333 (1895), *Shakspeare*, Chitty, J.; and *Harris' Tm.*, 9 R. P. C. 492 (1892), Stirling, J., where *Beatrice*, for shoes, was held not to be non-descriptive; see, however, as to this case, *Holl's Tm.*, [1896] 1 Ch. 711; 13 R. P. C. 118. The early case in which *The Lawford* was allowed to be registered seems to be clearly in conflict with the later

decisions; (1885), W. N. 124, Pearson, J.

⁵ *Hodgson v. Sinclair*, 9 R. P. C. 22 (1891), *Britannia*, Chitty, J. The C. A., by consent, reversed the order to expunge this mark. And cf. *Paine's Tm.*, 9 R. P. C. 130, where Kekewich, J., held the words *John Bull* not to be fancy words.

⁶ *Holl's Tm.*, [1896] 1 Ch. 711; 13 R. P. C. 16 and 118, North, J., and Lindley, Kay, and Smith, L.JJ.; the decision was on the Act of 1883, but the principle appears applicable also to the Acts of 1888 and 1905.

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

⁸ *Re Tm. Bovril*, [1896] 2 Ch. 600; 13 R. P. C. 382.

Common use,
whether in
the trade or
popularly.

In *The Alpine* case¹ Chitty, J., took the view that the use referred to is to be understood to be use in the trade, and this view has been adopted also in a Scotch case, in which Lord Craighill said that the term "common use," as employed in the statute, does not necessarily import that the word must have been used commonly by all members of the community, or by people in all parts of the country. "What is enough, in my opinion," he added, "to establish common use, in the sense of the statute, is this: if it shall be shown that the word has been commonly used by persons who had occasion to use it, and who are connected more or less directly with the use of the commodity to which the term has been applied."² But it is submitted that the condition suggested by the last phrase is not in accordance with the later decisions as to what are fancy words cited above,³ and that the construction adopted by Kekewich, J., in the case of *Paine's Trade Mark*,⁴ gave the correct meaning of the Act. "I cannot think," the learned judge said, "it means simply the use applied to this trade only. It cannot mean, I think, that words are not in common use if they are not used in the trade. It must mean something wider and larger than that, and seeing that *John Bull* are two words, or a combination of words, which are in common use wherever the English language is known, I think that I must hold them to be in common use within the meaning of the Act." In a later case Chitty, J., held that *Shakspeare* was a word in common use, as being the name of many living persons.⁵

The extent of user which amounts to "common use" has not been defined, but it was decided that the words *Tower Tea*, which were used by the plaintiff and the defendant in the case of the *Great Tower Street Tea Co. v. Smith*, and by three other persons in the tea trade, and of which the word *Tower* was used by several traders in other trades, were words in common use.⁶ On the other hand, the mere use by a single person, other than the applicant for registration, at an exhibition in this country, of a word which is not known in the trade concerned, does not

¹ 29 C. D. 877 (1885).

² *Stuart & Co. v. Scottish Val de Travers Paving Co.*, 13 Sess. Cas. 4 Ser. 1 (1885), *Granolithic* stone. The word was held to be in common use.

³ Pages 153 *et seq.*

⁴ 9 R. P. C. p. 133; 61 L. J. Ch. 365

(1892) (*John Bull* beer).

⁵ *Banks and James' Tm.*, 12 R. P. C. 333 (1895).

⁶ *Great Tower Street Tea Co. v. Smith*, 6 R. P. C. 165; 5 T. L. R. 292 (1889), North, J.

amount to common use within the clause.¹ The phrase may be compared with "common to the trade" in sec. 74 of the Act of 1883 and sec. 15 of the Act of 1905.²

The following words have been held not to be fancy words not in common use: APOLLINARIS water, *Apollinaris Co.'s Tm.*, [1891] 2 Ch. pp. 202, 221; 8 R. P. C. 137; BEATRICE shoes, *Harris' Tm.*, 9 R. P. C. 492 (1892);³ BEN LEDI whiskey, *Ainslie & Co.'s Tm.*, 4 R. P. C. 212 (1887); BÖKOL beer, *Davis v. Stribolt*, 6 R. P. C. 207 (1889); BRITANNIA soap, *Hodgson v. Sinclair*, 9 R. P. C. 22 (1892); BRYMBO iron (Brymbo being a place in Wales), *Batt's Tm.*, 6 R. P. C. 493 (1889); CARNIVAL cigarettes, *Lloyd & Sons' Tm.*, 10 R. P. C. 281 (1893); COMPACTUM for umbrellas, *Davis' Tm.*, 14 R. P. C. 903 (1897); CYCLOSTYLE (for stationery and duplicating apparatus), *Gestetner's Tm.*, [1907] 2 Ch. 478; [1908] 1 Ch. 513; 24 R. P. C. 545; 25 R. P. C. 156; ELECTRIC velveteen, *Leaf and Son's Tm.*, 34 C. D. 623; 4 R. P. C. 31 (1887); ELECTROID anti-fouling composition, *Hannay's Tm.*, 7 R. P. C. 46 (1890); EMOLLIO cream, *Grossmith's Tm.*, 6 R. P. C. 180 (1889); EMOLLIOLORUM dubbing, *Talbot's Tm.*, 11 R. P. C. 77; (1894), W. N. 12; FRIEDRICHSHALL water, *Apollinaris Co.'s Tm.*, [1891] 2 Ch. 186; 8 R. P. C. 137; GEM air-guns, *Arbenz's Application*, 35 C. D. 248; 4 R. P. C. 143 (1887); GRANOLITHIC stone, *Stuart v. Scottish Val de Travers Paving Co.*, 13 Sess. Cas., 4 Ser. 1 (1885); HAND GRENADE FIRE EXTINGUISHER, *Harden Star, &c. Co.'s Tm.*, 3 R. P. C. 132 (1886); HERBALIN (a medicine), *Humphries v. Taylor's Drug Co.*, 59 L. T. 820 (1888); HUNYADI JANOS water, *Apollinaris Co.'s Tm.*, supra; JOHN BULL and JOHN BULL BRAND beer, *Paine's Tm.*, 9 R. P. C. 130 (1892); JUBILEE note paper, *Tougood v. Pirie*, 4 R. P. C. 67 (1887); KOKOKO cotton goods, *Jackson Co.'s Tm.*, 6 R. P. C. 80 (1889); MANOR tin-plates, *Thompson's Tm.*, 6 R. P. C. 213 (1889); MELROSE hair restorer, *Van Duzer's Tm.*, 34 C. D. 623; 4 R. P. C. 31 (1887); MONOBRUT champagne, *Vignier's Tm.*, 6 R. P. C. 490 (1889); RED, WHITE AND BLUE coffee, *Hanson's Tm.*, 37 C. D. 112; 3 R. P. C. 130 (1886); REVERSI (for a card game), *Waterman v. Ayres*, 39 C. D. 29; 5 R. P. C. 368 (1888); ROADSTER (for boots), *Thompson's Tm.*, 13

Examples
from decided
cases.

¹ *Burgoyne's Tm.*, 6 R. P. C. pp. 230, 232; 61 L. T. 39 (1889), *Chitty, J. (Oomoo)*; and see *Ripley v. Bandey*, 14 R. P. C. 591 and 944 (1897).

² See Chap. IX., p. 286.

³ This was on the ground that a reference to the Princess would be imputed. See, however, *Holl's Tm.*, [1896] 1 Ch. 711; 13 R. P. C. 118 (*Tribby* for gloves, blouses, &c.).

R. P. C. 35 (1896); SANITAS (for a disinfectant), *Sanitas Co.'s Tm.*, 4 R. P. C. 533 (1887); SELF-WASHER and THE SELF-WASHER soap, *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887); SHAKSPERE (for cigarettes, &c.), *Banks and James' Tm.*, 12 R. P. C. 333 (1895); TOWER tea, *Great Tower Tea Co. v. Smith*, 6 R. P. C. 165 (1889); TRITICUMINA (for wheaten biscuits, &c.), *Meaby & Co., Ltd. v. Triticine, Ltd.*, 15 R. P. C. 1 (1898); WASHERINE soap, *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889); ZEPHYR ASIATIC WALNUT PIPE, *Friedlander's Tm.* (1885), W. N. 85.

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

Invented words.

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

This paragraph is the same as clause (d), which was, with clause (e),⁴ substituted for "fancy word or words not in common use" by sec. 10 of the Act of 1888, upon the recommendation of Lord Herschell's Committee which has been already quoted.⁵ The leading authority on the present clause is *The Solio* case⁶ in the House of Lords, in which several points were decided. Lord Halsbury, L.C., in his speech referred to the report of that Committee, and both he and Lord Herschell considered that the decisions on the expression "fancy word"

The Solio case.

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

² In the *Melrose* case, *Van Duzer's Tm.*, 34 R. P. C. 623; 4 R. P. C. 31 (1887).

³ See above, p. 160.

⁴ A word or words having no reference to the character or quality of the goods, and not being a geographical name.

⁵ Above, p. 152.

⁶ *Eastman Photographic Materials Co., Ltd.'s Application*, [1898] A. C. 571; 15 R. P. C. 476.

had no bearing on the interpretation of the provisions substituted by the Act of 1888.¹ The House of Lords further overruled the decisions in several earlier cases, including that of the Court of Appeal² in *The Somatose* case, to the effect that clauses (d) and (e) of sec. 10 of the Act of 1888 must be read conjunctively, and not as alternatives. *The Solio* case came before the Courts on an appeal from the Comptroller's refusal to register the word *Solio* for photographic paper, the refusal being on the grounds (*inter alia*) that the mark did not consist of an essential particular, and that it had reference to the quality or character of the goods. Kekewich, J., and the Court of Appeal upheld the refusal to register,³ on the ground that the word suggested the sun, and had reference to the character and quality of the goods, and that therefore (following the decision of the Court in *The Somatose* case) it was not registrable as an invented word. The Lord Chancellor did not deal with the point explicitly, but all the other members of the House who took part in⁴ the decision⁴ said that clauses (d) and (e) must be treated as independent clauses, and there is no reason to suppose that the Lord Chancellor differed from their judgments. Lord Herschell said that he could not find any justification for qualifying the provision "(d) an invented word or words" by the condition that they should have no reference to the character or quality of the goods, and he went on to point out that under (e) any word in the English language might serve as a trade mark, and that different considerations therefore arose under clauses (d) and (e). "If, then, the use of every word in the language was to be permitted as a trade mark, it was surely essential to prevent its use as a trade mark where such use would deprive the rest of the community of the right which they possessed to employ that word for the purpose of describing the character or quality of goods. But with regard to words

(d) not qualified by (e)

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

² *Farbenfabriken, &c. Co.'s Tm.*, supra, note (1), Lindley, Kay, and Smith, L.JJ., all concurring on this point; the other cases overruled are *Meyerstein's Application*, 43 C. D. 604; 7 R. P. C. 114 (1890), Kay, J.; and *Talbot's Tm.*, 11 R. P. C. 77; (1894), W. N. 12 (*Emolliolorum*), in which

Stirling, J., followed the decision of Kay, J. In *Densham & Son's Tm.*, [1895] 2 Ch. 176; 12 R. P. C. 271, Lindley, Lopes, and Kay, L.JJ., took the same view, although, having regard to the facts, the point did not call for decision.

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

⁴ Lds. Herschell, Macnaghten, Morris, and Shand.

which are truly invented words—words newly coined—which have never heretofore been used, the case is, as it seems to me, altogether different; and the reasons which required the insertion of the condition are altogether wanting. If a man has rightly invented a word to serve as his trade mark, what harm is done, what wrong is inflicted if others be prevented from employing it, and its use is limited in relation to any class or classes of goods to the inventor? So far, then, from seeing no reason for a distinction between the particulars designated in (d) and (e), there seems to me abundant reason for not interpolating in (d) words which the Legislature has used only in relation to (e).”

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

Quantum of invention.

Foreign word not necessarily debarred.

The determination of the standard of invention to be applied is both an important and difficult matter. It is clear from *The Solio* case that the mere fact that the word exists in a foreign language, whether modern or classical, is not sufficient to exclude a word, if it really is invented. Thus, neither the fact of the existence of an Italian word *solio* meaning throne, or of a Latin word in the ablative case with the same meaning, prevented *Solio*, which had, in fact, been invented for the purpose of a trade mark, from being entitled to registration.² On the other hand, the fact that the word is a foreign word does not make it an invented word in England.³ It was said in the same case that

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

² See also *Field, Ltd. v. Wagel Syndi-*

cate, Ltd., 17 R. P. C. 266 (1900), Buckley, J. (*Savonol*).

³ See Lord Herschell's judgment quoted below, p. 165.

words which are in sound ordinary English words, but are misspelt, are not eligible.¹ The following are passages from the judgments in *The Solio* case on this point. Lord Halsbury said: "I desire to give my opinion with reference to the particular word, and not to go behind it. I can quite understand suggesting other words—compound words, or foreign words—as to which it would be impossible to say that they were invented words, although, perhaps, never seen before, or that they did not indicate the character or quality of the goods, although as words of the English tongue they had never been seen before. Suppose a person were to attempt to register as a single English word *Cheupandgood*, or even without taking so gross an example, using a word so slightly differing from an ordinary and recognised word as to be neither an invented word nor, avoiding the prohibited choice of a word, indicating character or quality. The line must be sometimes difficult to draw; but, to my mind, the substance of the enactment is intelligible enough, and the Comptroller has to make up his mind whether in substance there has been an infringement of the rule." Lord Herschell, referring to the observation of Kay, J., in *The Satinine* case,² that there was extremely little invention, said: "It may be that the word *Satinine*, which was there in question, was objectionable on other grounds, but if the word be an 'invented' one, I do not think the quantum of invention is at all material. An invented word is allowed to be registered as a trade mark, not as a reward of merit, but because its registration deprives no member of the community of the rights which he possesses to use the existing vocabulary as he pleases. It may, no doubt, sometimes be difficult to determine whether a word is an invented word or not. I do not think the combination of two English words is an invented word, even although the combination may not have been in use before; nor do I think that a mere variation of the orthography or termination of a word would be sufficient to constitute an invented word, if to the eye or ear the same idea would be conveyed as by the word in its ordinary form."³ Again, I do not think that a foreign word is an invented word simply because it has not been current in our language. At the same time, I

¹ See especially Ld. Halsbury's judgment and that of Ld. Herschell. The point had been so decided by Kekewich, J., and the Court of Appeal in *Ripley's Application*, 15 R. P. C. 151

(1898) (*Pirle*). See also the cases cited below, p. 170.

² *Meyerstein's Tm.*, 43 C. D. 604; 7 R. P. C. 114 (1890).

³ See *Unecda* case, p. 166.

am not prepared to go so far as to say that a combination of words from foreign languages so little known in this country that it would suggest no meaning except to a few scholars, might not be regarded as an invented word. It is in this respect that I desire to qualify my assent to Lord Justice A. L. Smith's proposition that an invented word can never have a meaning." A passage from Lord Macnaghten's judgment is quoted above.¹ Lord Shand said: "I agree . . . in thinking, especially after the decision to be given in this case, that the Comptroller-General will be fully warranted in taking care that there shall not be admitted, under the guise or cover of words called 'invented' by the applicant, words really in ordinary use, which might, in a disguised form, have reference to the character or quality of the goods. There must be invention, and not the appearance of invention only. It is not possible to define the extent of invention required, but the words, I think, should be clearly and substantially different from any word in ordinary and common use. The employment of a word in such use, with a diminutive or a short and meaningless syllable added to it, or a mere combination of two known words, would not be an 'invented' word, and a word would not be 'invented' which, with some trifling addition or very trifling variation, still leaves the word one which is well known or in ordinary use, and which would be quite understood as intended to convey the meaning of such a word." In a subsequent case,² much reliance was placed on the last-quoted passage by the applicants, who were applying to expunge the registration of the word *Savonol*, which had in 1890 been registered for common and soft soaps. They contended that the French word *savon* was used in the soap trade in this country, and that *Savonol*, being merely the word *savon* with a termination, was not an invented word. Buckley, J., held the word to be an invented word, even although *savon* had been used as alleged, and said that he did not understand Lord Shand as meaning to express anything differing from the other Lords.

The word "Uneeda" has been held not to be an invented word, being a mere misspelling of "You need a," and registration of it was refused.³ So also "Orlwoola" registered in the clothing class was expunged from the Register as being neither

Variations
of ordinary
words.

¹ Page 164.

² *Field, Ltd. v. Wagel Syndicate, Ltd.*, 17 R. P. C. 266 (1900).

³ *National Biscuit Co.'s Application*,

[1901] 1 Ch. 550; [1902] 1 Ch. 783; 18 R. P. C. 170; 19 R. P. C. 281, Cozens-Hardy, J., and C. A.

an invented word nor a distinctive word.¹ Before the decision in *The Solio* case, registration of a word as an invented word was difficult to obtain, but it afterwards under the Act of 1888 became the practice at the Patent Office to accept for registration, as invented words, words which had very little invention indeed, but were merely ordinary English words having a slight variation in or a slight addition to them.² In such cases, however, the Comptroller required a disclaimer of the part formed by the common word, thus *Fireproofine* has been accepted with a disclaimer of "fireproof." It would seem that a disclaimer of the kind referred to does not help to qualify a word as an invented word,³ although it may protect the public from what would otherwise be the consequence of registration.⁴ Thus an application to remove from the Register the word *absorbine*, which had been registered and used for an absorbent preparation, the exclusive use of "absorb" being disclaimed, was successful. The word was held to be a mere variation of the word absorb.⁵

Disclaimer of
part of a word.

The result of the cases is that a mere ordinary addition to, or misspelling or variation of, a word in use in the English language does not make the word so formed an invented word, but the question in each case is one of fact.

Before the Act of 1905, letters not being essential particulars, the Comptroller objected to register names of letters;⁶ however, since the definition of "mark" in sec. 3 includes "letter,"⁷ it

¹ *Re Orwoola Tms.*, [1910] 1 Ch. 130; 26 R. P. C. 683, 850.

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

³ See the case next cited.

⁴ In *Wilks' Application*, 29 R. P. C. 21 (1912), where the opponents' registered trade mark included the word "repellus," but the exclusive use of the word "repel" had been disclaimed, Parker, J., said that the disclaimer of the word "repel" alone did not help the public or other traders. What was really wanted, he supposed, was a dis-

claimer not only of the word "repel," but of any fancy variation thereof.

⁵ *Christy v. Tipper*, [1904] 1 Ch. 696; [1905] 1 Ch. 1; 21 R. P. C. 97 and 755, Joyce, J., and C. A.; and cf. *Application of the Compagnie Industrielle des Petroles*, [1907] 2 Ch. 435; 24 R. P. C. 585, Warrington, J., *Motorine* upheld under para. (4) of sec. 9; and the judgment of Kennedy, L.J., in *Application of Société de Ferment*, 29 R. P. C. 497 (*Lactobacilline*).

⁶ *Vezet*, the Dutch equivalent of the letters V, Z, was allowed to be registered under special circumstances, and subject to a condition: *Verschure and Zoon's Application*, 22 R. P. C. 568 (1905), Warrington, J.

⁷ As to the registration of a letter or combination of letters as a distinctive mark, see below, p. 220.

is assumed that there would not be the same objection under the present Act, provided, of course, that the mark was distinctive.

Inventor.

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

In *Holt's Trade Mark*,¹ Kay, L.J., expressed an opinion that, if the person who is seeking to register a word as an invented word has not been the inventor, or first user, he is not entitled to register it.² The Lord Justice was, however, dealing with a case in which there had been entirely independent prior use of the word. In the *Linotype Co.'s Application*,³ Cozens-Hardy, J., held that it was not necessary that the applicant for registration should be the inventor of the word applied for. In that case the word, namely "Tachytype," had been invented by an American Company to distinguish their goods and had been used as part of the name of the Company, which had assigned such rights as it had in the United Kingdom in connection with the mark or name to the applicants. As to the point of time to be regarded, it was held in the case last cited that it was not necessary that there should have been no prior publication of the word in the United Kingdom before the application to register. Further, Swinfen Eady, J., decided in *The Kodak* case⁴ that "if a word is really a newly-invented word when adopted as a trade mark, the mark does not become invalidated because of an interval between its first user and its registration." In that case "Kodak" had been registered for photographic cameras in 1888, and had been used from that date for cameras and films, but it was not registered for films until 1891. It was held that the registration for films was good. In this case the goods, namely cameras and films, were of the same general description, namely, photographic, and the word had been applied to both substantially about the same time. In a later case⁵ Warrington, J., held that in order that a word may be an "invented word," it must be coined for the first time for the

Date of
invention

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

² See also the judgment of Smith, L.J., but Lindley, L.J. (and perhaps Smith, L.J.), decided the point on the ground that the word had become a well-known word.

³ [1900] 2 Ch. 238; 17 R. P. C. 380.

⁴ *Kodak, Ltd. v. London Stereoscopic, &c. Co., Ltd.*, 20 R. P. C. 337 (1903). Cf. the judgment of Lopes, L.J., in *The Bovril* case, above, p. 155.

⁵ *Hommel v. Gebrüder Bauer & Co.*, 21 R. P. C. 576 (1904) (*Hæmatogen*).

purpose of being applied to the goods in question, or in other words, for the purpose of its use as a trade mark in this country; but he expressed a doubt, without deciding the point, whether the word must not be newly coined substantially at the date of the application to register it.

The point recently came before the Court of Appeal, which held that the word "Lactobacilline" was registrable as an invented word, although it had been used by the applicants for some years before the date of the application to register in connection with their particular lactic preparation. The Master of the Rolls said that a trader does not lose the right to claim registration of a word merely because he has used it for some years before the application, there being no concurrent user of the mark by anybody else before the application to register was made.¹ If, on an application to expunge a word mark, sec. 36 of the Act of 1905, which provides a saving for a trade mark registrable under that Act, is relied on, the proprietor of the mark must show that it is then registrable, and therefore, although the word may have been an "invented word" when first used for the goods, if it has become the name of the article, the section does not assist to save the mark from removal.²

A word already in existence cannot properly be said to be an "invented word," merely because the person claiming to have invented it was not aware of its existence.³

The following words have been held to be invented words within the meaning of the Act:—KODAK, *Kodak, Ltd. v. London Stereoscopic Co.*, 20 R. P. C. 337 (1903); KYNITE, *Kynoch & Co.'s Tm.*, 14 R. P. C. 905 (1897); LACTOBACILLINE, p. 171, *Application of Société de Ferment*, 29 R. P. C. 497; MAZAWATTEE, *Densham's Tm.*, [1895] 2 Ch. 176; 12 R. P. C. 75 and 271; NEOSTYLE, *Neostyle Manufacturing Co.'s Tm.*, 20 R. P. C. 329 (1903);⁴ SAVONOL, p. 162, *J. C. & J. Field, Ltd. v. Wagel Syndicate, Ltd.*, 17 R. P. C. 266 (1900); SOLJO, pp. 162 to 164, *Eastman Photographic Materials Co.'s Application*, [1898] A. C. 571; 15 R. P. C. 476; TACHYTYPE, p. 168, *The Linotype Co.'s*

¹ *Application of Société de Ferment*, 29 R. P. C. 497.

² *Gestetner's Tm.*, [1907] 2 Ch. 478; 24 R. P. C. 545; [1908] 1 Ch. 513; 25 R. P. C. 156, Neville, J., and G. A. But see the judgment of Parker, J., in the *Diabolo* case, cited p. 171.

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

⁴ The mark was, on appeal, removed from the Register on other grounds, 20 R. P. C. 803.

Application, [1900] 2 Ch. 238; 17 R. P. C. 380; VEZET, *Verschure and Zoon's Application*, 22 R. P. C. 568 (1905).

The following words have been held not to be invented words within the meaning of the Act:—ABSORBINE, *Christy v. Tipper*, [1904] 1 Ch. 696; [1905] 1 Ch. 1; 21 R. P. C. 97 and 755; APOLLINARIS,* *Apollinaris Co.'s Tms.*, [1891] 2 Ch. 186; 8 R. P. C. 137;¹ BIOSCOPE, *Warwick Trading Co. v. Urban*, 21 R. P. C. 240 (1904);² CYCLOSTYLE, *Gestetner's Tm.*, [1907] 2 Ch. 478; 24 R. P. C. 545;³ DIABOLO, *Philippart v. Whiteley, Ltd.*, 25 R. P. C. 565 (1908); EBOLINE,* *Sir Titus Salt & Co.'s Application*, [1894] 3 Ch. 166; 11 R. P. C. 517;⁴ ELECTROZONE,* *British Electrozone Co.'s Application*, 13 R. P. C. 447 (1896);⁵ EMOLLIOLORUM,* *Talbot's Tm.*, 11 R. P. C. 77; (1894), W. N. 12;⁶ FORMALIN, *Formalin Hygienic Co.'s Application*, 17 R. P. C. 486 (1900);⁷ HÆMATOGEN, *Hommel v. Gebrüder Bauer & Co.*, 21 R. P. C. 576; 22 R. P. C. 43 (1904);⁸ ORLWOOLA, *In re Orwoola Tms.*, [1910] 1 Ch. 130, 26 R. P. C. 683, 850; PANORAM, *Kodak, Ltd. v. London Stereoscopic Co.*, 20 R. P. C. 337 (1903); PIRLE,* *Ripley & Son's Application*, 15 R. P. C. 151 (1898);⁹ SATININE,* *Meyerstein's Tm.*, 43 C. D. 604; 7 R. P. C. 114 (1890);¹⁰ SOMATOSE,* *Farbenfabriken, &c. Co.'s Application*, [1894] 1 Ch. 645; 11 R. P. C. 84;¹¹ TRILBY,* *Holt's Tm.*, [1896] 1 Ch. 711; 13 R. P. C. 113;¹² UNEEDA, *National Biscuit Co.'s Application*, [1901] 1 Ch. 550; 18 R. P. C. 170.¹³ The cases in which an asterisk is placed against the word, were decided before the decision in *The Solio* case in the House of Lords.

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

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

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

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

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

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

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

⁸ On the particular facts.

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

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

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

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

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

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

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

Act of 1888.

Clause (e) of sec. 64 (1) of the Act of 1883, as that section was amended by the Act of 1888, was as follows:—"A word or words having no reference to the character or quality of the goods, and not being a geographical name." The object of this clause was to permit ordinary English words to be registered subject to the maintenance of the right of the public to employ them in their ordinary meaning.¹ The decisions on the clause, however, and especially those prior to *The Solio* case,² tended to prevent the registration of words having a merely indirect reference to the character or quality of the goods; the framers of the Act of 1905 therefore introduced the word "direct" to qualify "reference" with the object of extending the class of registrable words,³ or at all events of making the object of the Legislature more clear. Very few decisions on paragraph (4) of the Act of 1905 have been given by the Court. In the case of the word "motorine" registered in 1901 for lubricating oil with a disclaimer of the exclusive use of the word "motor," Warrington, J., applying sec. 36 of the Act of 1905, and therefore testing the word by the requirements of that Act, held that it had no direct reference to the character or quality of the goods.⁴ Again, in *The Diabolo* case, Parker, J., held that, whether that word was tested by the Act of 1888, under which it was registered, or by the Act of 1905, it ought to be removed from the Register,⁵ and in *The Lactobacilline* case, although the decision of the Court of Appeal was that the word was an invented word, Cozens-Hardy, M.R., and Farwell, L.J., also intimated that the word had, in their opinion, no direct reference to the character of the goods.⁶ In *The Orwoola* case⁷ no attempt practically was made to

Alteration made by Act of 1905.

¹ See the judgment of Ld. Herschell in *The Solio* case, *Eastman Photographic Materials Co.'s Application*, [1898] A. C. 571; 15 R. P. C. 476, quoted *supra*, p. 165.

² See note (1).

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

trade marks which could not otherwise be registered.

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

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

⁶ *Application of Société de Ferment*, 29 R. P. C. 497.

⁷ *Orwoola Tm.*, [1910] 1 Ch. 130; 26 R. P. C. 683, 850.

support that word as one having no direct reference to the character or quality of the goods, but it was held not to be registrable either under the Act of 1888 or that of 1905. In *Colgate & Co.'s Application*, it was held that the word "ribbon" had a direct reference to the character of the goods, dentifrice of a flat ribbon shape.¹

As the decisions under the Act of 1888 have a bearing on the construction of paragraph (4), they are shortly stated here.

Test applied
under Act of
1888.

The question under clause (e) was not whether the word which it was sought to place or retain on the Register had in fact any reference to the character or quality of the goods, but whether it had such a reference in appearance. For if it had, it must be either descriptive or deceptive, and in either case it was not entitled to be on the Register.² Under the Act of 1905 a deceptive mark is equally debarred from registration.³ A large number of the earlier decisions on clause (e) were in relation to words which, under the decision in *The Solio* case,⁴ could be registered as invented words independently of the question whether or not they have a reference to the character or quality of the goods; and such decisions have now to some extent lost their importance. But in *The Solio* case,⁵ Lords Halsbury, Herschell, and Macnaghten, differing from the view adopted by the Court of Appeal⁶ that *Solio* would suggest the sun, and had therefore some reference to the character or quality of the goods for which it was used, namely, photographic paper, held that it had no such reference; and, in substance, the House of Lords overruled the earlier decision in *The Somatose* case,⁷ of the Court of Appeal⁸ that, having regard to the Greek word *σωμα*, meaning *body*, *Somatose* was not a word having no reference to the character or quality of the goods, which included preparations made from meat. On the other hand, the Court of Appeal had held that *Mazawattee*, which was compounded of the Cingalese word for *garden* and part of a Hindustani word meaning *luscious*, had no reference to the character or quality of the goods,

¹ 30 R. P. C. 262 (1913), Parker, J.

² *Edge's Tm.*, 8 R. P. C. 207 (1891) (*Filtered Blue*), Stirling, J.; and see *Re Orwoola Tm.*, [1910] 1 Ch. 130; 26 R. P. C. 683, 850.

³ Sec. 11.

⁴ See clause (d), p. 162.

⁵ *Eastman Photographic Materials*

Co.'s Application, [1898] A. C. 571; 15 R. P. C. 476.

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

⁷ *Farbenfabriken Co.'s Application*, [1894] 1 Ch. 645; 11 R. P. C. 84.

⁸ Smith and Kay, L.J.J., Lindley, L.J., dissenting.

which included tea.¹ Although clause (e) made it a condition of registration that the word should have no reference to the character or quality of the goods, this meant that in the general understanding of ordinary English people it must bear no such reference.² And the fact that an ingenious mind, knowing the class of goods to which the word is applied, can find some reference through etymology or otherwise to the character or quality of the goods is not fatal to registration.³ Thus, the suggestion that *Trilby*, the name of the heroine in Du Maurier's book of the same name, when used as a mark for gloves, blouses, &c., would be taken to have a reference to such articles as were fit for such a person as the book describes, was said by Lindley, L.J., to be too fanciful and far-fetched.⁴ Another example is the word *Kynite*, which has been held not to contain, by reason of the resemblance of the first syllable to the root of the word *kinetic*, a reference to the character of the goods in question, namely, explosives.⁵ If a word, not originally importing a reference such as the clause contemplates, comes to be known as the name of the article, it does not, by that fact, come to have a reference to the character or quality of the goods within the meaning of the section;⁶ thus, although *Magnolia* had come to be known as the name of an alloy, it was held not to refer to the character or quality of the goods. But, of course, a word which is descriptive of the goods, when tendered for registration, is not entitled to registration.⁷ And the business of the proposed user of the word may be regarded as well as the goods; thus, Kekewich, J., held that *Typograph*, a dictionary word meaning a type-making and type-setting machine, would, if registered by the Linotype Company for metals used in manufacture, have reference to the character or quality of the goods.⁸ Words that would be understood to be commendatory were held

¹ *Densham's Tm.*, [1895] 2 Ch. 176; 12 R. P. C. 75 and 271.

² See the judgment of Rigby, L.J., in *Eastman Photographic Materials Co.'s Application*, 14 R. P. C. 487, and of Kekewich, J., in *The Linotype Co.'s Application*, 14 R. P. C. 900 (1897) (*Typograph*).

³ See the judgment of Ld. Herschell in *The Solio* case, *supra*, p. 165.

⁴ *Holt & Co.'s Tm.*, [1896] 1 Ch. 711; 13 R. P. C. 118; and see *Ellis & Co.'s*

Tms., 21 R. P. C. 617 (1904) (*Quaker*).

⁵ *Kynoch's Tm.*, 14 R. P. C. 905 (1897), Kekewich, J.

⁶ *Magnolia Metal Co.'s Tms.*, [1897] 2 Ch. 371; 14 R. P. C. 621, Lindley, Lopes, and Rigby, L.J.J., differing from Kekewich, J., on this point.

⁷ Thus, *Filtered Blue* for laundry blue is inadmissible: *Edge's Tm.*, 8 R. P. C. 207 (1891), Stirling, J.

⁸ *Linotype Co.'s Application*, 14 R. P. C. 900 (1897).

not to satisfy the condition imposed by clause (e),¹ and a word that is a mere misspelling of a word that is not capable of registration is not admissible.²

Decisions
under Act
of 1888.

The following words were held not to be within clause (e), on the ground that they could not be said to have no reference to the character or quality of the goods:—*APOLLINARIS*,* for natural mineral waters, *Apollinaris Co.'s Tms.*, [1891] 2 Ch. 186; 8 R. P. C. 137;³ *BIOSCOPE*, for cinematograph apparatus, *Warwick Trading Co. v. Urban*, 21 R. P. C. 240 (1904);⁴ *CENTURY*, for machinery, *Printing Machinery Co.'s Application*, 23 R. P. C. 38 (1906); *EDGE'S FILTERED BLUE*,* for laundry blue, *Edge's Tm.*, 8 R. P. C. 207 (1891);⁵ *EMOLLIOLORUM*,* for harness, &c., *Talbot's Tm.*, 11 R. P. C. 77 (1894); *HÆMATOGEN*, for a medicine, *Hommel v. Gebrüder Bauer & Co.*, 21 R. P. C. 576 (1904); *JOHN BULL*,* for fermented liquors and spirits, *Paine's Tm.*, 9 R. P. C. 130 (1892);⁶ *NECTAR*,* for tea, coffee and cocoa, *Harrisons & Crosfield's Application*, 18 R. P. C. 34 (1901); *PANORAM*, for a panoramic camera, *Kodak, Ltd. v. London Stereoscopic Co.*, 20 R. P. C. 337 (1903); *PIRLE*,* for cloth, &c., *Ripley's Application*, 15 R. P. C. 151 (1898);⁷ *SATININE*,* for starch and soap, *Meyerstein's Application*, 43 C. D. 604; 7 R. P. C. 114 (1890); *SOMATOSE*,* for a pharmaceutical product principally consisting of ingredients of meat, *Farbenfabriken Co.'s Application*, [1894] 1 Ch. 645; 11 R. P. C. 84; *TYPOGRAPH*,* for metals and certain machinery, *Linotype Co.'s Application*, 14 R. P. C. 900 (1897); *UNEEDA*, for biscuits and other goods in Class 42, *National Biscuit Co.'s Application*, [1901] 1 Ch. 550; 18 R. P. C. 170; [1902] 1 Ch. 783; 19

¹ See the observations of Rigby, L.J., in *Ripley & Son's Application*, 15 R. P. C. 151 (*Pirle*); *Harrisons and Crosfield's Application*, 18 R. P. C. 34 (1901), Byrne, J. (*Nectar*); *National Biscuit Co.'s Application*, [1901] 1 Ch. 550; [1902] 1 Ch. 783; 18 R. P. C. 170; 19 R. P. C. 281, Cozens-Hardy, J., and C. A. (*Unceda*); and *Printing Machinery Co.'s Application*, 23 R. P. C. 38 (1906), Farwell, J. (*Century*).

² See the *Pirle* and *Unceda* cases cited in the last note, and the judgments in *Eastman Photographic Materials Co.'s Application*, [1898] A. C. 571; 15 R. P. C. 476, also *The Absorbine* case above, p. 167.

³ The mark was intended to be used

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

⁴ On the facts as to previous user.

⁵ This mark was registered under the Act of 1883; the argument, as in *Talbot's Tm.*, *infra*, must therefore have been that, as it was good under the Act of 1888, it ought not to be expunged.

⁶ The mark was actually registered under the Act of 1883, but see note (1).

⁷ As being equivalent to pearl.

R. P. C. 281. The cases in which an asterisk is placed against the word, were decided before the decision of *The Solio* case in the House of Lords. In an appeal from Canada to the Privy Council it has been held that the word STANDARD was not properly registered in Canada, it being a common English word having reference to the character and quality of the goods.¹

The following words have been held to have no reference to the character or quality of the goods:—BROWNIE, BULLSEYE, and KODAK, for films, *Kodak, Ltd. v. London Stereoscopic Co.*, 20 R. P. C. 337 (1903);² KYNITE, for explosives, *Kynoch's Tm.*, 14 R. P. C. 905 (1897); MAGNOLIA, for a metal alloy known by that name, *Magnolia Metal Co.'s Tms.*, [1897] 2 Ch. 371; 14 R. P. C. 621; MAZAWATTEE, for tea, *Densham's Tm.*, [1895] 2 Ch. 176; 12 R. P. C. 75, 271; QUAKER, for fermented liquors, *Ellis & Co.'s Tms.*, 21 R. P. C. 617 (1904);³ SOLIO, for photographic paper, *Eastman, &c. Co.'s Tm.*, [1898] A. C. 571; 15 R. P. C. 476; ⁴ TRILBY, for gloves, blouses, &c., *Holt's Tm.*, [1896] 1 Ch. 711; 13 R. P. C. 118; VEZET, *Verschure and Zoon's Application*, 22 R. P. C. 568 (1905).⁵ In addition to these decisions, in *Pinto v. Badman*, 8 R. P. C. 181 (1891), it was objected that the words *El Destino* on a label for cigars indicated, by the fact that the words were Spanish or Mexican, the character or quality of the goods, but this objection failed both at the trial and in the Court of Appeal. Also, Chitty, J., in *Burgoyne's Tm.*, 6 R. P. C. 227 (1889), came to the conclusion that, if the Act of 1888 applied, which he held was not the case, the word *Oomoo* would have been capable of registration under it, and presumably, therefore, he considered that it had no reference to the character or quality of the goods.

The only decisions of the Court on para. (4) of the Act of 1905 are those referred to on pp. 171 and 172.

It is a further condition that the word should not, according to its ordinary signification, be a geographical name. The qualification "according to its ordinary signification" was

Not being a geographical name.

¹ *Standard Ideal Co. v. Standard Sanitary Manufacturing Co.*, 27 R. P. C. 789 (1910).

² It was urged that the names were descriptive of films suitable for particular types of camera.

³ It was urged that the name suggested goods suitable for Quakers, a suggestion that Farwell, J., described

as fantastic.

⁴ Per Ld. Halsbury, L.C., and Lds. Herschell and Macnaghten, although this was not the ground of the decision, which was that the word was an invented word within (d).

⁵ The objection to the word was that it was equivalent to the letters "V, Z," in the Dutch language.

added in the Act of 1905, and gives express effect to the decision in *The Magnolia* case referred to below.

In some instances geographical words were before the Registration Acts protected as trade marks,¹ and where a geographical word has gained a secondary meaning in relation to particular goods, indicating that they are the goods of a particular trader, that trader can obtain practical protection by means of a passing off action.² But, when the Act of 1883 allowed the registration of fancy words not in common use, an objection to a word on the ground of its being geographical was, in many cases, upheld.³ Lord Herschell's Committee reported on this subject as follows:—

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

The Act, however, contains no such limitation of the prohibition. The words “geographical name” are not equivalent to the “name of any place,” and a word does not become a geographical name simply because some place of the earth's surface has been called by it. In *The Magnolia* case,⁵ it appeared that in the United States, whence the metal had been imported, there were several places known by the name “Magnolia,” but it did not appear that the goods had any connection with any of those places. Rigby, L.J., said: “It is, no doubt, shown by the evidence, that there are places in the United States called by the name ‘Magnolia,’ and if ‘geographical name’ in

¹ See above, p. 49.

² See below, p. 575.

³ See below, pp. 158, 159.

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

⁵ *Magnolia Metal Co.'s Tms.*, [1897] 2 Ch. 371; 14 R. P. C. 265 and 621, Kekewich, J., and Lindley, Lopes, and Rigby, L.JJ.; decided under the Act of 1883.

sec. 64, sub-sec. (e), were equivalent to the name of any place, 'Magnolia,' as the name of places mentioned in the evidence, would fall within the exception. But in our judgment, the phrase 'geographical name' in sec. 64, sub-sec. (e), ought not, in general, to receive so wide an interpretation. It must, we think, in the absence of special circumstances, be interpreted so as to be in accordance, in some degree, with the general and popular meaning of the words, and a word does not become a geographical name simply because some place upon the earth's surface has been called by it. For example, we agree with Mr. Justice Kekewich that the word 'Monkey' is not proved to be a geographical name by showing merely that a small and by no means generally known island has been called by that name. If, indeed, in its primary and obvious meaning, the word has reference to a locality, as the word *Melrose* in *Van Duzer's* case, or the word *Eboli* in *Sir Titus Salt & Co.'s* case (from which Mr. Justice Chitty declined to distinguish the derivative *Eboïne*), it may well be a geographical name within the meaning of the sub-section. Even when the primary signification is not geographical, if the name is really a local name (however little known the locality may be), and the name is given because of the connection of the article with the locality, whether that be real or imputed only by those who give the name, it may well be a geographical name within the meaning of the sub-section. An instance of this is to be found in the case of the word *Apollinaris*, given to the water from a spring known as the Apollinaris Spring. So, if 'Magnolia' had been the name of a place where the metal was manufactured, we should have been by no means inclined to say that it would not be a geographical name when applied to the article manufactured in the place having the name." In *Clement et Cie.'s Trade Mark*,¹ Kekewich, J., held *St. Raphael* not to be geographical, as it was not shown that the words were adopted with the intention of referring to any place of that name. It would seem that under the Act of 1905 the ordinary signification of a word must be considered apart from its application to the particular goods, but it may be that, where the ordinary signification depends on the context, the application to the particular goods is material.

¹ [1900] 1 Ch. 114; 16 R. P. C. 173, 611, Kekewich, J. (*St. Raphael*). On the appeal, it was not necessary, in the

view the Court took, to decide the point whether the words were geographical.

The prohibition of the registration of a geographical name is not confined to the noun substantive, but extends to the adjectival form.¹ The mere fact that part of a word is a foreign word, and might therefore have some reference to the country where the word is known, does not make the word a geographical name.² And it seems that the name of the factory from which the goods bearing the mark come is not a geographical word.³ The words "Crystal Palace" which had been registered by a well-known firm of firework manufacturers, who had held the contract for displaying fireworks there, was objected to as being geographical, as well as on other grounds, but the registration was upheld.⁴

In some cases geographical words which could not have been admitted to registration under paragraph (4) have been allowed to be registered under paragraph (5) as distinctive words.⁵

The following words were held to be geographical names under the Act of 1888:—*APOLLINARIS*, *Apollinaris Co.'s T'ms.*, [1891] 2 Ch. 186; 8 R. P. C. 137;⁶ *EBOLINE*, *Sir Titus Salt & Co.'s Application*, [1894] 3 Ch. 166; 11 R. P. C. 517. The following words have, on the other hand, been held not to be geographical names: *MAGNOLIA*, p. 176,⁷ *supra*; *MAZAWATTEE*, *Densham's T'm.*² Also in *Pinto v. Badman*, 8 R. P. C. 181, the words *EL DESTINO* on a label were objected to on the ground of being geographical, but this objection was overruled.

Not being a
surname.

A new statutory condition is introduced by the Act of 1905 under paragraph (4) that the word should not, according to its ordinary signification, be a surname, but in practice the Comptroller refused under the Act of 1888 to register surnames.⁸

Other Distinctive Words.

In addition to the classes of names, signatures and words, which may under paragraphs (1), (2), (3) and (4) of sec. 9 be essential particulars, the Act of 1905 allows registration of any

¹ *In re Sir Titus Salt's Application*, [1894] 3 Ch. 166; 11 R. P. C. 517, Chitty, J. (*Eboline*).

² *Re Densham & Son's T'm.*, [1895] 2 Ch. 176; 12 R. P. C. 75 and 271 (*Mazawattee*).

³ *Pinto v. Badman*, 8 R. P. C. 181 (1891), C. A.; and see *Hall v. Barrows*, 4 De G. J. & S. 150; 32 L. J. Ch. 548; 33 L. J. Ch. 204 (1863), Romilly, M.R.,

and Westbury, L.C.

⁴ *Brock & Co.'s Crystal Palace Fireworks, Ltd. v. Pain*, 28 R. P. C. 461, 697, Warrington, J., and C. A. (1912).

⁵ Below, p. 179.

⁶ See also *In re Apollinaris T'm.*, [1907] 2 Ch. 178; 24 R. P. C. 436.

⁷ See above, p. 176.

⁸ See official notice, 2nd ed. of this work, p. 731.

distinctive name, signature, word or words not falling within such paragraphs, but an order of the Board of Trade or the Court declaring that the name, signature, word or words is or are to be deemed distinctive is necessary.¹ "Distinctive" is defined to mean adapted to distinguish the goods of the proprietor of the trade mark from those of other persons. The rules made under the Act provide a special mode of application for registration of such marks.² The proper form of order under para. (5) has been recently a matter under discussion and cannot be said to be settled. In one case Swinfen Eady, J., made an order simply that the application be accepted,³ but in a subsequent case Parker, J., made a declaration that for the purpose of the application to the Registrar the mark applied for was to be deemed a distinctive one within section 9, paragraph (5), and that the Registrar accept the application and proceed with the same accordingly.⁴ The matter very recently came before the Court of Appeal, but, although discussed at some length, it did not call for decision, the judgment of the Court being against the applicants.⁵ The order is not conclusive as to the distinctiveness of the mark. Thus in the *Perfection* case⁶ an order had been made by the Board of Trade under the paragraph, but in an opposition to registration it was held that the word "Perfection" was not distinctive.

Distinctive words are more fully considered under the next paragraph (5) along with distinctive marks generally.

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

The policy of the Act is, stating it broadly, that *de facto* trade marks shall be registrable; paragraphs (1), (2), (3) and (4) are

¹ Sec. 9 (5), coupled with the definition of "mark" in sec. 3.

² See Chap. IV., Registration of Trade Marks, above, at p. 88.

³ *Hjorth & Co.'s Application*, [1910] 2 Ch. 64; 27 R. P. C. 461.

⁴ *Itala Fabbrica di Automobili's Application*, 27 R. P. C. 493 (1910), Parker, J.

⁵ *Lea's Application*, note (6).

⁶ *Crosfield & Sons, Ltd.'s Application*, [1910] 1 Ch. 118; 26 R. P. C. 561

(at p. 584) and 837, Swinfen Eady, J., and C. A.; and *Thorne & Co., Ltd. v. Sandow*, 29 R. P. C. 440 (1912), Neville, J., where the word "Health," which had been registered for cocoa and chocolate, was ordered to be removed from the register. Also *Teofani & Co., Ltd. v. A. Teofani*, 30 R. P. C. 446 (1913), C. A., reversing Warrington, J. See also *Lea's Application*, [1913] 1 Ch. 446; 30 R. P. C. 205, C. A.

therefore supplemented by this general provision. By sec. 3 "mark" shall include a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof. Practically all permanent symbols are covered by these words, but if there be any not expressly mentioned, it may nevertheless come within the meaning of "mark," for the word "include," and not the word "mean," is used. It is not a fatal objection that the mark is capable of registration as a design.¹

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

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

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

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

Definition of "distinctive."

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

Sec. 9 further provides as follows:—

"In determining whether a trade mark is so adapted, the tribunal may, in the case of a trade mark in actual use, take in 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."

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

The word "distinctive" standing alone in clause (c) of the Act of 1883, and coupled with *special* in relation to old marks,⁵

Meaning of "distinctive," under the earlier Acts.

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

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

R. P. C. 17, C. A.

³ See the judgment of Kekowich, J., in *In re Apollinaris Tm.*, [1907] 2 Ch. 178; 24 R. P. C. 436.

⁴ See Chap. II., p. 24; *Orr-Ewing v. The Registrar of Tms.*, 4 App. Ca. 479; 48 L. J. Ch. 707 (1879), and *Hopkinson's Tm.*, [1892] 2 Ch. p. 121; 9 R. P. C. 102, Kekowich, J.

⁵ Below, p. 222. Cf. the meaning

had, before the Act of 1905 came into force, been construed in a number of cases. In *Leonard and Ellis' case*, Fry, L.J., expressed an opinion that the words *special and distinctive* of sub-sec. (3) (ii.) of sec. 64 "import the specialising of the make and manufacture of a particular maker from all other manufacturers, and distinguishing the manufacture of one person from the manufacture of all others."¹ In *Wood v. Butler*,² Lindley, L.J., said that distinctive trade mark must mean some mark which distinguishes the goods to which it is attached as those made or sold by the person who uses the mark"; and Fry, L.J., repeated his definition from the earlier case. The whole Court held that it was not sufficient for the mark to be distinctive as regards the trade; it must be distinctive in the eyes of the ultimate customers, the consumers. "It ought," said Lopes, L.J., "to be a special and distinctive mark, not only recognisable by the trade, but also recognisable by the consumer, as connecting the article with the manufacturer." So that, as the proprietor of the mark had put upon the boxes in which his goods were enclosed words suggesting that they were made, not by him, but by a foreigner, although the suggestion was, as the trade knew, false, he had by his own act prevented the mark from being distinctive.

Lord Halsbury, in *Perry-Davis & Son v. Harbord*,³ defined the word in similar language to that of Fry, L.J., quoted above; distinctive, he said, "means distinguishing a particular person's goods from somebody else's,—not a quality attributed to the particular article, but distinctive in that respect that it means that it is a manufacture of his distinguished from somebody else's." And he held that the word *Pain-killer*, as applied to a patent medicine, was neither special nor distinctive.⁴

"The essence of a trade mark," said Kay, J., in *Richards v. Butcher*, "is that it is some distinctive thing which points out that the goods are the goods of A. B."⁵

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

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

² 32 C. D. 247; 3 R. P. C. 81 (1886), *Eton* for cigarettes, claimed as an old mark; followed in *Wolff v. Nopitsch*, 17 R. P. C. 321 (1900), Cozens-Hardy, J. (*Spanish graphite pencils*), a pass-

ing-off case; see the decision of C. A., 18 R. P. C. 27.

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

⁴ So also did Ld. Morris, in the House of Lords, and Fry and Lopes, L.JJ., in the Court of Appeal.

⁵ [1891] 2 Ch. p. 536; 8 R. P. C. 249, Kay, J., and C. A. *Monopole* for

And in *Hopkinson's Trade Marks*¹ Kekewich, J., said: "In order to protect a trade mark before the Act, you were obliged . . . to prove by evidence, and satisfy the Court, that the words used as a trade mark were known in the market, and—I think it is Lord Westbury's phrase²—gave a vendible character to the articles to which they were attached, made these articles recognised as coming from a particular manufactory, and so gave them a character different from every other article in the trade. Therefore it seems to me that the Legislature here³ did no more than adopt the language of the cases."

Farwell, J., has differentiated the cases of old and new marks thus: "In the case of an old trade mark the word 'distinctive' means that it does in fact distinguish the goods of the plaintiff as his manufacture or selection from the goods of all other persons. That of course is a question of historical fact which can be determined by circumstances which have gone before. In the case of a new mark, of course, that cannot be so, but it means that the mark must be capable of distinguishing the goods of the plaintiff as his manufacture, or selection, from the goods of all other persons."⁴

James' Tm.

In *The Dome Black Lead* case⁵ Lopes, L.J., put a somewhat different interpretation on the word *distinctive*. It means, he said, "that it must be a mark or device of such a kind as, in case of infringement, it shall be clear what it is that is being infringed, and that the mark is something distinct from all other marks used in the same class of goods." And the Court of Appeal there held that, upon the evidence, a sketch of a short cylinder terminated by a hemisphere was a distinctive design for black-lead, which was in fact made up for sale in pieces of the shape shown by the sketch. There is, however, no disagreement between the two interpretations, and on consideration it will be seen that the first assumes the second, for no mark can dis-

wines. In each of the three cases last referred to, the marks were claimed as special and distinctive words used as trade marks before August 13th, 1875. They were all rejected.

¹ [1892] 2 Ch. p. 121; 9 R. P. C. 102. *J. & J. Hopkinson* for pianos, claimed and allowed as an old mark. In *Dewar & Son, Ltd. v. J. H. Dewar*, 17 R. P. C. 341 (1900), Lord Kyllachy said he was not satisfied that the words *Dewar's Whisky* were, assuming use prior to

1875, "special and distinctive."

² *The Leather Cloth Co. v. The American Leather Cloth Co.*, 4 De G. J. & S. 137; 33 L. J. Ch. 199 (1863), cited above, p. 56.

³ *I.e.*, by the use of the phrase "special and distinctive" in the old mark clauses of the Acts.

⁴ *Louise & Co., Ltd. v. Gainsborough*, 20 R. P. C. 61 (1903).

⁵ *James' Tm.*, 33 C. D. 392; 3 R. P. C. 340 (1886), C. A.

tinguish the goods which bear it from all similar goods, or can create a species within the genus, unless it has itself some recognisable and characteristic peculiarity to separate it from other marks which may be found upon some or all of them. Moreover, a mark which satisfies the second test, and possesses such a peculiarity as is referred to, if this is recognised with sufficient readiness as a peculiarity, must of necessity, when it becomes known, distinguish the goods which bear it in the manner required by the test suggested by the *dicta* first cited. In the case of new marks which have, and can have, acquired no connection by reputation with their owner, all that can be demanded of the mark is that it shall be capable of distinguishing the goods to which it is applied in the required manner, and this accords with the old law.¹

The definition of the word "distinctive" contained in the Act of 1905 and the provision with regard to trade marks in actual use both above set out have been considered and applied by the Courts in numerous cases. The definition and provision are not confined to words but extend generally to the meaning of "distinctive" in paragraph (5), but the decisions of the Court have been mainly on words for registration of which an order of the Court or of the Board of Trade is necessary.

The purpose of para. (5) of the Act of 1905, so far as it concerns words, was to extend the statutory provisions relating to the registration of words, and to admit a word to registration, notwithstanding that it is not an invented word and is a word having direct reference to the character or quality of the goods, or is a geographical name, provided only that it is distinctive. The Act in this respect made a new departure. The change is thus stated by Lord Fletcher Moulton:—"Under previous Acts registrability, if granted at all, was confined to certain classes of words, and no word outside those specified classes could obtain registration as a trade mark. The questions which, under those Acts, came to the Courts for decision were purely legal questions, as to whether the particular words came within the classes thus privileged. But under the present Act—though it retains these privileged classes in a somewhat extended form—the fact that a word is not within any of the privileged classes is not decisive as to its registrability. If the permission of the Board of Trade or the Court, can be obtained,

Meaning of
"distinctive"
under the Act
of 1905.

The Act of
1905 made
a new
departure.

¹ See Chap. II., p. 36.

words become capable of registration as Trade Marks which do not belong to these classes." And, after stating that the provisions in paragraph (5) were chiefly directed to remedy two well-known defects in the working of the previous legislation, he states those defects and the remedies as follows:—"In the first place the exclusion of the words under that legislation was by whole classes. But though it might be desirable in general to exclude from registration words of a particular class, it by no means follows that every individual word in that class would be objectionable as a trade mark in the case of every kind of goods. For example, few would doubt the desirability of excluding geographical terms as a class; but if, as suggested during the argument, a trader desired to register Monte Rosa for cigarettes, or Tenerife for boiler plates, no practical inconvenience would arise from his doing so. The second defect was more difficult to remedy, but, on the other hand, it affected cases that had strong claims on their merits. It often occurs in trade that by continued user words get recognised as denoting the goods of a particular firm. These words may, in themselves, be unsuitable to be chosen as trade marks, but they have, in fact, become so. The oft-quoted case of 'Yorkshire Relish' is one example of this, and the words 'Worcester Sauce' would almost certainly have been another example had the original makers of the article exercised due vigilance in protecting their rights. Apart from the Trade Marks Acts, there would be nothing to prevent such trade marks in the eyes of the law, and it was an obvious defect in the earlier legislation that it failed to give the benefits of registration to such marks when they had become duly established. The present Act seeks to remedy these defects by abandoning the policy of absolute exclusion of all the members of specified classes of words, and substituting therefore a judicial examination of the merits of each individual case and leaving the Court free to pronounce the word or words to be eligible for registration, if, on such an examination, it holds it proper to do so."¹

Policy of
the Act.

Before the decision in *The Perfection* case,¹ which is fully referred to below, it was thought that it was the policy of the Act to admit to registration all marks, which had by user become in fact trade marks, that is to say, distinguished the goods of the proprietor of the mark from those of other traders, even although in the case of a word mark that result was only

¹ *Crosfield & Sons, Ltd.'s Application*, [1910] 1 Ch. 118; 26 R. P. C. 561, 837.

due to the word having acquired a secondary meaning different from or additional to its ordinary or primary meaning; and, before the decision referred to, a very considerable number of orders had been made, in most instances by the Board of Trade, for the registration of words under paragraph (5), which bore such a secondary meaning. Since that decision, however, it has become much more difficult to obtain registration of a word as a distinctive word, especially in cases in which a secondary meaning is sought to be established. For, as will be seen below, one point decided by the Court in this and other cases is that, even although the applicant may have the right to a common law protection in respect of a word, it does not follow that he is entitled to obtain registration of it.

The Perfection case¹ was the first case under paragraph (5) which came before the Court of Appeal. Two other cases, *The California Fig Syrup* case² and *The Orwoola* case,³ were decided at the same time and, in giving judgment in the three cases, the Court laid down the general principles which it held should guide the Court in its exercise of jurisdiction under paragraph (5). The first mentioned case came before the Court on appeal from the Registrar in an opposition to an application by Joseph Crosfield & Sons, Ltd., to register the word "Perfection" as a trade mark for common soap. The Board of Trade had made an *ex parte* order under the paragraph that the Registrar should proceed with the application, but when the mark had been advertised Lever Bros., Ltd., entered an opposition, and the Registrar refused the application to register and the applicants appealed to the Court. On the hearing of the appeal before Swinfen Eady, J., a very large amount of evidence was given on behalf of both sides on the question whether the word "Perfection" had by user become in fact distinctive of the applicants' soap, and Swinfen Eady, J., found it established that in a considerable part of England—Fletcher Moulton, L.J., stated it as about half—to a large number of persons "Perfection Soap" meant and indicated the applicants' and no other. On the other hand he found that in other parts of England and in Scotland and Ireland the applicants' soap was almost entirely

*The
Perfection
case.*

¹ *Crosfield & Sons, Ltd.'s Application*, [1910] 1 Ch. 118; 26 R. P. C. 561, 837, Swinfen Eady, J., and C.A.

² *California Fig Syrup Co.'s Application*, [1909] 2 Ch. 99; [1910] 1 Ch. 139;

26 R. P. C. 436, 846, Warrington, J., and C. A. See p. 195.

³ *Orwoola Tm.*, [1910] 1 Ch. 130; 26 R. P. C. 683, 850, Eve, J., and C. A. See p. 193.

unknown; and he held that even taking into consideration the evidence of user, the word "Perfection" was not adapted to distinguish the goods of the applicants. The Court of Appeal dismissed an appeal to it, holding that an ordinary laudatory term such as "Perfection" was not "adapted to distinguish" the goods of the applicants from the goods of other persons. In delivering judgment, the Court dealt with several questions arising under paragraph (5). In the first place, it was pointed out that the duty of the tribunal in making an order under that paragraph was not to declare that the mark ought to be registered, but merely to give liberty to proceed with the application, and that the rights of opposing parties were in no way prejudiced. Secondly, the Court decided that a wide discretion is vested in the tribunal, the provision as to evidence of user being that the tribunal "may" take into consideration the extent to which user has rendered the trade mark distinctive.¹ Thirdly, all the members of the Court (Cozens-Hardy, M.R., Fletcher Moulton and Farwell, L.J.J.) referred to the statutory definition of the word "distinctive" set out above, and pointed out that what the Court has to find before it can make an order under the paragraph is, as well in a case where there has been actual use of a word as in the case of a new mark, that the word is "adapted to distinguish"; and it held that of some words it is impossible to state, notwithstanding that there may have been extensive user, that, they are "adapted to distinguish" and that "Perfection" was such a word. Thus the judgment of the Master of the Rolls contained the following passage:—"Now it is apparent that no word can be registered under this sub-section unless it is 'distinctive,' that is to say, is 'adapted' to distinguish the goods of the proprietor from the goods of other persons. There are some words which are incapable of being so 'adapted,' such as 'good,' 'best,' 'superfine.' They cannot have a secondary meaning as indicating only the goods of the applicant. There are other words which are capable of being so 'adapted,' and as to such words the tribunal may be guided by evidence as to the extent to which use has rendered the word distinctive. It is easy to apply this sub-section to geographical words, and it is possible to suggest words having direct reference to character or quality which might be brought within it. But

¹ See also the judgments of the Court of Appeal in *Cassella's Application*, [1910] 2 Ch. 240; 27 R. P. C. 453.

an ordinary laudatory epithet ought to be open to all the world and is not, in my opinion, capable of being registered. It may be that within a particular area the applicant might succeed in a passing-off action against a trader who used the epithet without sufficiently distinguishing his goods from the goods of the applicant. But that would not justify the Court in giving the applicant a monopoly throughout the United Kingdom in the use of a laudatory epithet. Whether in any particular case the word is or is not something more than a laudatory epithet is for the tribunal to decide." And the Lords Justices gave judgment to the same effect, giving other instances of words which in their opinion no amount of user could induce the Court to register. The meaning of the phrase "adapted to distinguish" was especially dealt with by Fletcher Moulton, L.J., in the following passage in which he lays down that the phrase does not imply that a registrable word must necessarily have an innate quality of distinctiveness, but that quality may be acquired:—"The exact issue is formulated in the sub-section and if the tribunal is of opinion that the nature of the word is such that it is adapted to distinguish those particular goods of the trader from those of other persons, it will be its duty—in the absence of special circumstances—to allow the registration to proceed. But the applicant is not confined to arguments drawn from the word itself. He may support his application (in the case of a mark already in use) by showing that by user the mark has in fact become more or less completely identified with the goods by having been continuously used in connection therewith, and the statute expressly provides that the Court may take this into consideration for the purpose of its decision. To my mind this provision can bear but one interpretation. It recognises that distinctiveness, *i.e.* being adapted to distinguish the goods from those of other traders, is not necessarily an innate quality of the word. It may be acquired."¹ The particular point was not stated so specifically by the other members of the Court, but they do not appear to have differed in any way from this proposition. And this construction of the Act has been followed in other cases.² In a later case² Buckley, L.J., said that the

¹ See also Parker, J., in *Gramophone Co.'s Application*, [1910] 2 Ch. 423; 27 R. P. C. 689 at p. 695.

² *Cassella & Co.'s Application*, [1910] 2 Ch. 240; 27 R. P. C. 453. See also the judgment of the same Lord Justice in

W. & G. Du Cros, Ltd.'s Application, [1912] 1 Ch. 644; 29 R. P. C. at p. 75; and of Parker, J., in *Gramophone Co.'s Application*, [1910] 2 Ch. 423; 27 R. P. C. 689, at p. 697.

Act seemed to contemplate that the word which it is sought to register was one which, as a word, was adapted to distinguish the goods, and not a word which may by user acquire the capacity of distinguishing the goods. And again "The Act meant that a trader may take a word which from something in the word itself—say the fact that no one had ever heard the word before, that it was an invented word, or that it indicated the particular trader as distinguished from another trader, but always from something found in the word itself as distinguished from the way in which it is used—is such as to answer the description of being adapted to distinguish the goods." But the Lord Justice pointed out that the Act provided that in a particular case, namely that in which there has been actual user as a trade mark, the tribunal may take into consideration the extent to which user has rendered the trade mark distinctive.¹

Descriptive meaning may to some extent remain.

It has been said that in the case of a word having a meaning which is ordinarily or *primâ facie* descriptive, a trader cannot establish the right to have it as his trade mark or to common law protection in respect of it, unless it has lost its descriptive meaning; but it is doubtful whether that proposition represents the present state of the law. In his judgment in *The Perfection* case,² Fletcher Moulton, L.J., made some general observations on the meaning of the word "distinctive" in connection with trade marks with reference to an argument to that effect. "Much of the argument before us on the part of the opponents and the Board of Trade was based on an assumption that there is a natural and innate antagonism between distinctive and descriptive as applied to words, and that if you can show that a word is descriptive you have proved that it cannot be distinctive. To my mind this is a fallacy. Descriptive names may be distinctive or *vice versâ*. No words are, as a class, more directly and intentionally distinctive than proper names, and yet originally they were usually, if not invariably, descriptive in all languages. They still are so among savage peoples, and although among civilised nations the original significations of proper names are not remembered, or regarded, we see that the natural tendency to use descriptive words as names still exists, since nick-names—the only names that are invented—are usually descriptive. There is therefore no natural or necessary incompatibility

¹ See also *Lea's Application*, [1913] 1 Ch. at p. 458; 30 R. P. C. at p. 224, cited below, pp. 196, 197.

² See p. 185, note (1).

between distinctiveness and descriptiveness in the case of words used as trade marks. The notion that there is such an incompatibility is confined to lawyers, and is, in my opinion, due to the influence of the earlier Trade Marks Acts. By these Acts, which are now repealed, the fact that words were descriptive of the goods was fatal to their registration as trade marks, and thereby being treated by the law as distinctive of the goods of a particular maker. But the question whether a word is or is not capable of becoming distinctive of the goods of a particular maker is a question of fact, and is not determined by its being or not being descriptive. 'The law has never refused to recognise that this is the case, or to give protection to descriptive trade marks when once duly established in fact, although (except in the case of old marks) they refused registration and left the owners to obtain protection in another form of action.' And the Lord Justice goes on to point out that under paragraph (5) a descriptive word, *e.g.* a word having a direct reference to the character or quality of the goods, may in a proper case be permitted to be registered. In a passing-off action decided shortly before *The Perfection* case, Parker, J., said that, if the word there under discussion had come to distinguish the plaintiffs' goods from those of others, it had done so by acquiring a secondary meaning without losing its descriptive character, and that he did not agree with the argument that a word cannot be at the same time both descriptive and distinctive.¹ It would seem, therefore, that a word which is *primâ facie* descriptive, may be or become distinctive in connection with particular goods without having lost its descriptive meaning; but it must, of course, in order to become so distinctive, have a new and secondary meaning, different from its primary one,² and thus cease to be purely descriptive.

The fact that an applicant may be able practically to protect himself by a common law action for passing off by the use of the word applied for, does not of itself confer on him any right to registration, although it is no doubt a very important matter for consideration. Thus in *The Perfection* case,³ the judgments

Common law marks not necessarily registered.

¹ *Burberrys v. J. C. Cording & Co., Ltd.*, 26 R. P. C. 691, at p. 704 (1909). The passage is quoted more fully below, p. 566 (under passing off).

² See, for instance, the judgment of Lord Herschell in *Reddaway v. Banham*,

[1896] A. C. p. 209; 13 R. P. C. p. 229.

³ See above, p. 185, note (1). The word has since been protected by an injunction in a passing-off action, *Joseph Crosfield & Sons, Ltd. v. Caton*, 29 R. P. C. 47 (1912), Joyce, J.

assumed that the applicants might succeed in a passing-off action against another person who used the word "Perfection" in connection with soap without sufficiently distinguishing, at all events, within particular areas; but that was held to be insufficient to establish their case, for they were asking to obtain by registration a monopoly; and to this the Court held them not to be entitled. In the arguments on behalf of applicants in that and other cases, sec. 44 of the Act of 1905, which preserves the rights of a person using a *bonâ fide* description of the character or quality of his goods, has been much relied on, it being urged that this qualification of the monopoly given by registration is ample protection for the public. The argument has not however prevailed, and the provisions of sec. 44 have been applied as affording the Court useful guidance and as suggesting the question:—Will the registration of the trade mark cause substantial difficulty or confusion in view of these rights of user by other traders?¹

Extent of
user.

The proviso in sec. 9 relating to marks in actual user provides that the tribunal may take into consideration the "extent" to which the user has rendered the trade mark in fact distinctive. In *The Perfection* case, Farwell, L.J., after finding that "Perfection Soap" was almost entirely unknown in the south and south-west of England, and was very little known in London, said that it might well be that universal knowledge throughout the United Kingdom need not be required by the tribunal, but the "extent" referred to in the section must be something very different from that proved in that case. But Fletcher Moulton, L.J., said that had the word been less objectionable in itself the case proved would have influenced him greatly, for it showed that throughout about half of England the past user of the word had identified it in the eyes of the public with the goods of the applicants. One result of *The Perfection* case was that, in cases which afterwards came before the Board of Trade, there was considerably more stringency than previously in regard to the area over which evidence in support of the application should extend, objection being often taken if the user did not extend to Scotland and Ireland as well as England. It is submitted that it is not necessary that an applicant's trade under the mark should extend to the three countries of the

¹ See the *Perfection* case above, p. 185, especially the judgment of Fletcher Moulton, L.J.; and *Gramophone Co.'s Application*, [1910] 2 Ch. 423; 27

R. P. C. 689, where Parker, J., refers to the argument as double-edged. See, however, *Teofani v. Teofani*, 30 R. P. C. 446 (1913).

Union in order that he may have the benefit of paragraph (5), but that it is sufficient that it extends over a considerable area, and that in that area the mark is distinctive of his goods, not to all persons nor to the public generally, but to the public concerned in the class of goods in question. Thus Neville, J., made an order under paragraph (5) in a case in which he held that the word under consideration had throughout a very great portion of the United Kingdom for twenty years been associated with the applicants' dyes, and had been known throughout the trade as indicative of the fact that the dyes in question were the produce of the applicants.¹ In an application to register the letters "W. & G." in a special script for motor vehicles, there having been three years user of the mark in and round London, Cozens-Hardy, M.R., held that the evidence of user for three years, though limited in area and not large in amount, was sufficient to entitle the applicants to be allowed to proceed with their application; and the Court made an order to that effect.²

The question of area again arose in an application to register the word "Boardman's" for tobacco, in which the Court of Appeal held that the evidence as to distinctiveness was insufficient. Farwell, L.J., said that it fell far short of that universality which was required for distinctiveness within sec. 9.³

It is further to be observed that the user which the tribunal is authorised to take into consideration is user of the trade mark applied for *as a trade mark*; therefore where there has been no actual user as a trade mark, although there may have been user in other ways, the Court cannot, it would seem, take into consideration such other user.⁴

A word may be a mere commendatory epithet when applied to some goods, and yet distinctive when applied to others, thus

¹ *Cassella's Application*, [1910] 2 Ch. 240; 27 R. P. C. 453 (*Diamine*). But the Court of Appeal refused the word as descriptive.

² *Du Cros' Application*, [1912] 1 Ch. 611; 29 R. P. C. 65. This was not on a special application. Reversed on appeal to the House of Lords, see Addenda.

³ *Lea's Application*, [1912] 2 Ch. 32; [1913] 1 Ch. 446; 29 R. P. C. 165; 30 R. P. C. 216, Joyce, J., and C. A.; he pointed out that Glasgow was the only place in Scotland and Belfast in Ireland, and there was no place in Wales; there

was one firm at Whitechapel, but no one else in London: one at Sandgate, one in Cambridge, many large towns in the north and northern midlands, but no one at all in the south of England, the southern midlands, or the west, except one retailer in Bristol. The user was substantially confined to the north of England, subject to the addition of Bristol and Cambridge, and to some extent London.

⁴ *Gramophone Co.'s Application*, [1910] 2 Ch. 423; 27 R. P. C. 689; and *Lea's Application*, note (3).

the word "Health" has been held not to be distinctive for cocoa and chocolate, but Neville, J., who so decided, said that he could imagine a case in which the Court might come to the conclusion that that word had become distinctive of a make of fishing-rods.¹

Name of article cannot be registered.

The mere name of the article cannot be "distinctive" within the meaning of paragraph (5), and cannot be a good trade mark, for it has not the essential properties of a trade mark.² Thus the words "Bowden Wire" were refused registration under paragraph (5), because they were the name of mechanism which had been patented. Although there is an additional ground for the rule where the article has been patented, for it is not allowable to extend the monopoly afforded by a patent by registering the name of the patented article as a trade mark, the rule is not limited to such articles. So where the evidence showed that the word "gramophone" connoted to the trade the applicants' talking machines, but to the public denoted merely talking machines, with disc as opposed to cylinder records, Parker, J., held that the word was not registrable as a distinctive word.³ After expressing his opinion that "user" for the purpose of the section must be user as a trade mark, the learned judge drew attention to the fact that in their advertisements of gramophones the applicants had used the word "gramophone" as the name of the article, and not to distinguish the article when made by them from the same article when made by others, and he remarked that was the very reverse of user as a trade mark. And he went on to point out that in some cases it was to the interest of a trader after registering a word as a trade mark to use it in such a manner that the word became known as the name of the article itself. "It may, therefore, be in the interests of the registered proprietor of a word mark (subject of course to any question arising under sec. 37 of the Act of 1905) that the word should lose its distinctiveness so far as the public are concerned, and become the popular name for the article. He thus obtains a practical and perpetual monopoly in the article itself, other manufacturers being precluded by the mark on the Register from selling their goods under the name by which they are commonly known. To induce the public to adopt a catching word as the name of the article to which it is applied, especially if the article be comparatively new, it is only necessary to

The Gramophone case.

¹ *Thorne & Co., Ltd. v. Sandow*, 29 R. P. C. 440, at p. 451 (1912).

² *Gramophone Co.'s Application*, [1910] 2 Ch. 423; 27 R. P. C. 689.

³ See above, p. 36.

advertise the article on a sufficiently large scale under that name, and this can be done by any rich corporation. Such a procedure would be or might have been fatal to any remedy based upon common law rights, but (subject to sec. 37) does not affect the value of a registered mark, the distinctiveness of which is assumed and never need be proved." In contrast to *The Gramophone* case is *The Lawson Tait Bedstead* case,¹ where Eve, J., held that the name Lawson Tait had become distinctive of a particular pattern of bedstead of the manufacture of the applicants. It appeared that the physician of that name had given this pattern of bedsteads his approval, and had entered into an agreement with the applicants to allow them to apply his name to their bedsteads of this pattern. The applicants had afterwards become entitled to certain patents for improvements in bedsteads, and had applied the improvements both to Lawson Tait Bedsteads and to other bedsteads of their manufacture, and there were some instances of their having advertised "Patent Lawson Tait" Bedsteads, but they had not attempted to claim any patent rights in the particular type of bedstead, and in fact other manufacturers made bedsteads of the same type. Eve, J., made an order under paragraph (5), but confined it to bedsteads of the pattern referred to in the agreement.

*The Lawson
Tait Bedstead
case.*

In *The Orlooola* case,² which was decided in the Court of Appeal at the same time as *The Perfection* case, Eve, J., had held that the word "Orlooola," which had been registered in 1899 under the Act of 1888 for goods including clothing, was not an invented word, but he held that the evidence established the fact that the word had become identified with the goods of the registered proprietors, that the actual commercial user of the mark had rendered it distinctive for the goods in respect of which it was registered. The Court of Appeal, however, whilst confirming the decision on the first point, held that the word was not registrable as a distinctive word under the Act of 1905, being practically a mere mis-spelling of "all wool," and that if the word was applied to goods wholly made of wool, it was descriptive, but, if otherwise, it was deceptive; and the mark was ordered to be removed from the Register. Farwell, L.J., in giving his judgment, said: "'All Wool' or 'All Woolly' cannot possibly be regarded as adapted to distinguish

*The Orlo-
oola case.*

¹ *Whitfield's Bedsteads Application*, [1909] 2 Ch. 373; 26 R. P. C. 657.

² *Orlooola Tm.*, [1910] 1 Ch. 130; 26 R. P. C. 683, 850, Eve, J., and C. A.

woollen goods; they are purely descriptive of their nature. I doubt if any amount of evidence could prove that they had lost their primary and acquired a secondary meaning. It can make no difference whether the words are spelt phonetically, fantastically, or conventionally; they are registered in respect of all wool goods and to the ear they mean all wool. It is said that to the eye 'Orlwoola' and 'All Wool' are quite distinct; but that is not enough; the mark is not pictorial but verbal, and the words are meant to be spoken as well as read, and the pronunciation of words by the British public is at the present day somewhat various." The principle of *The Perfection* case is not confined to laudatory epithets, but extends so as to forbid the appropriation by one trader of any word forming part of the common stock of the English language, unless the word is one "adapted to distinguish" the goods in the sense attributed by the Courts to those words.¹

Deceptive word will not be registered.

The question of deceptiveness also arose as a subsidiary point in *The Perfection* case, where Cozens-Hardy, M.R., and Farwell, L.J., held that the sanction of a Government department ought not to be given to the use of such a laudatory epithet which, however much then deserved, might, at some future time, become false and misleading. Moulton, L.J., did not believe that anyone buying soap would suppose it was perfection merely because the maker called it so; but he thought that this showed that the word was one that probably would be used by others in the description of their soap. The *Perfection* and *Orlwoola* cases show, therefore, that in exercising its discretion under para. (5), the Court will take into account the probability of the word being deceptive or being used deceptively, and will even examine it somewhat critically in this respect.² And in an earlier case Parker, J., had decided that the words "Royal Worcester," which were applied for in respect of corsets *prima facie* suggested Royal patronage (which did not exist), and might thus be calculated to deceive, and an order under paragraph (5) was on this and other grounds refused.³

Geographical names.

A word is not debarred from registration as a distinctive word merely because it is geographical. If a word is a geographical

¹ *Cassella's Application*, [1910] 2 Ch. 240; 27 R. P. C. 453, C. A.; especially the judgment of Buckley, L.J. The word "Diamine," then in question, was only intelligible to persons possessing some knowledge of chemistry.

² Cf. *Whitfield's Bedsteads Ltd.'s*

Application, [1909] 2 Ch. 373; 26 R. P. C. 657, where the contention that the mark might be deceptive failed.

³ *Royal Worcester Corset Co.'s Application*, [1909] 1 Ch. 459; 26 R. P. C. 185.

name,¹ it cannot be registered under para. (4), but it may, nevertheless, be registrable under para. (5).² Thus "Apollinaris," which, being the name of the spring from which mineral waters called by that name came, was held under the Act of 1883 to be geographical, was held to be registrable under the Act of 1905 as a distinctive word.³ In *The California Syrup of Figs* case, Warrington, J., refused to make an order under para. (5) on the ground that the name was geographical, and that to allow registration would be to exclude other persons desiring to sell syrup made from California figs from truly describing it as made from figs grown in California. An appeal in that case was heard by the Court of Appeal at the same time as *The Perfection* case. The Court held that a *prima facie* case of identification of the words with the goods of the applicants had been made out, and that the registration of them would not give a monopoly of the use of the word "California," and the application was allowed to proceed.⁴ In several other cases applications for geographical words have been allowed by the Courts to proceed under para. (5), for instance, "Oswego" for corn flour, that word being the name of a place in the United States where the applicants had their factories⁵ as well as the name of their goods; "Itala" for motor cars;⁶ "Karlsbader Wasser" for Karlsbad Waters.⁷ On the other hand, the words "Royal Worcester" for corsets, which were in fact made at Worcester, Massachusetts, were refused registration, but this was on the grounds that those words were not distinctive by themselves without other words referring to the American origin of the goods, and might in fact be deceptive.⁸

Proper names may be registered under para. (5) of section 9, if distinctive; but an order of the Court or Board of Trade must be obtained. It is only in exceptional circumstances that an application for a proper name ought to be allowed to proceed.⁹ A

Proper
names.

¹ As to geographical names, see above, p. 175.

² The principle of *Holt's Tm.*, [1896] 1 Ch. 711; 13 R. P. C. 13 and 118, is probably not applicable to para. (5); but see *Lea's Application*, [1912] 2 Ch. 32; 29 R. P. C. 165.

³ *In re Apollinaris Tms.*, [1907] 2 Ch. 178; 24 R. P. C. 436.

⁴ *California Fig Syrup Co.'s Application*, [1909] 2 Ch. 99; [1910] 1 Ch. 139; 26 R. P. C. 436, 846.

⁵ *National Starch Co.'s Application*,

[1908] 2 Ch. 693; 25 R. P. C. 802.

⁶ *Application of Itala Fabbrica di Automobile*, 27 R. P. C. 493 (1910).

⁷ *Application of City of Karlsbad*, 29 R. P. C. 162 (1912). An undertaking was required to use the trade mark only in respect of the waters from the springs of Karlsbad.

⁸ *Royal Worcester Corset Co.'s Application*, [1909] 1 Ch. 459; 26 R. P. C. 185.

⁹ *Teofani v. Teofani*, 30 R. P. C. 446 (1913), C. A.

considerable number of names have been registered by the Board of Trade, but in all the three applications for registration which have come before the Court, the applicants have failed. In the first of these,¹ *Pope's Electric Lamp Company* applied for the registration of the word "Pope" in respect of incandescent electric lamps, and the Board of Trade referred the application for an order under para. (5) to the Court. There was evidence of extensive use and advertisement for many years of the word; and it was found as a fact that it had been used as a trade mark, and that in the trade it indicated the lamps of the applicants, but that there was no evidence that among the public it had that meaning. Warrington, J., in his judgment said, "In my opinion this name (I say nothing whatever about other names), being for all essential purposes the name of the manufacturer, is not adapted to distinguish the goods of that manufacturer from the goods of all other manufacturers, or rather from the goods of other persons. There are many persons of the name of 'Pope,' and the name of one man named 'Pope' is not adopted to distinguish his goods from those manufactured by other persons of the name of 'Pope.'² It seems to me, therefore, that the name, to begin with, is not in its nature adapted to distinguish the goods of the proprietor of the trade mark from those of other persons, and, if it is not in its nature so adapted, then it seems to me that it cannot become so adapted by any amount of user, and I think that that is in accordance exactly with what was said by Fletcher Moulton, L.J., in *The Crosfield* case² in reference to such words as laudatory epithets. He was there only dealing with one particular class of words which are not in their nature adapted to distinguish the goods, but his remarks would apply to any other kind of word which is not adapted to distinguish the goods." It was also held that, even if the evidence established that the name had become distinctive, the Court ought not in its discretion to make the order asked for. Applications for orders in respect of the words "Boardman's" for tobacco and "McEwan's" for beer, subsequently came before Joyce, J., who held that in neither case did the evidence of user prove user as a trade mark, although it showed the great repute of the respective goods, and following the decision of Warrington, J.,

"Boardman's" and "McEwan's" cases.

¹ *Pope's Electric Lamp Co., Ltd.'s Application*, [1911] 2 Ch. 382; 28 R. P. C. 629, Warrington, J.

² See also the judgments in *Benz et*

Cie., Application of, 30 R. P. C. 177 (1913) C. A.; where it was said that the surname "Benz" by itself was not the name of any individual or company.

in *Pope's* case, he held that the names were not distinctive, and he refused the applications.¹ In effect the decision was that a mere surname could not be distinctive. The applicants for the registration of "Boardman's" appealed, and on the appeal it was not contended for the Registrar that no surname could be distinctive, but it was held that the evidence did not show that "Boardman's" was adapted to distinguish. It appeared that the use of the word had originated many years ago by the applicants supplying a smoking mixture to a licensed victualler called "Boardman"; the mixture was sold as "Boardman's Smoking Mixture," and there was evidence of the use of the word "Boardman's" on wrappers. The members of the Court of Appeal do not seem to have been in agreement on the point whether there had been actual use of the word by itself as a trade mark, nor did the Court decide whether "Boardman's" should be treated as a name or as an elliptical sentence equivalent to "Boardman his tobacco," although Buckley, L.J., said that the mark was not a surname. All the members of the Court, however, agreed that on the evidence the mark was not distinctive within the meaning of section 9 (5). Buckley, L.J., expressly said that Boardman's was not as a word adapted to distinguish the goods sold by the applicant; this also was the view of the other members of the Court. But it was contended that, although the evidence did not establish any actual user as a trade mark, evidence was admissible to prove that the mark was "adapted to distinguish." Without deciding that point, the Court held that the evidence was insufficient to establish that the mark was "adapted to distinguish." In deciding a case on a special application the Court is warranted in taking into account the fact that it has to act on one-sided evidence.

Very recently the Court of Appeal has refused to remove from the Register a trade mark consisting of the surname "Teofani," which had been in use for twenty years, and had been registered under an order of the Board of Trade.² The "Teofani" case.

Distinctiveness under para. (5), has also been considered by the Court of Appeal in relation to letters, and to a mark consisting of a name printed in a peculiar manner and surrounded by a wreath, and alleged to be registrable as a device. The decisions are considered below under the headings "letter" and "device."³

¹ *R. J. Lea, Ltd.'s Application*, and *William McEwan & Co., Ltd.'s Application*, [1912] 2 Ch. 32; 29 R. P. C. 165; and on appeal in the former case, [1913] 1 Ch. 446; 30 R. P. C. 216.

² *Teofani v. Teofani*, 30 R. P. C. 446 (1913).

³ Pages 220 and 206.

WHAT MARKS MAY BE REGISTERED AS TRADE MARKS.

In the cases of the following words orders have been made by the Court that the words should be deemed distinctive for the purpose of an application to register, namely:—

APOLLINARIS, *In re Apollinaris Trade Marks*, [1907] 2 Ch. 178; 24 R. P. C. 436; CALIFORNIA SYRUP OF FIGS, *California Fig Syrup Co.'s Application*, [1910] 1 Ch. 130; 26 R. P. C. 846 (C. A.); ITALA for motor cars, *Application of Itala Fabbrica di Automobili*, [1910] W. N. 170; 27 R. P. C. 493; KARLSBADER WASSER for water from the Karlsbad springs, *Application of the City of Karlsbad*, 29 R. P. C. 162, [1912]; LAWSON TAIT for bedsteads of a particular type, *Whitfield's Bedsteads, Ltd.'s Application*, [1909] 2 Ch. 373; 26 R. P. C. 657; OSWEGO, *National Starch Co.'s Application*, [1908] 2 Ch. 698; 25 R. P. C. 802; PRIMUS for stoves, *Hjorth's Application*, [1910] 2 Ch. 64; 27 R. P. C. 461.

In the case of the following words orders under para. (5) have been refused by the Court:—

BOARDMAN'S¹ for manufactured tobacco, *R. J. Lea, Ltd.'s Application*, [1912] 2 Ch. 32; 29 R. P. C. 165; [1913] 1 Ch. 446; 30 R. P. C. 216; BOWDEN WIRE,² *Application of E. M. Bowden's Patents Syndicate, Ltd.*, 26 R. P. C. 205, [1909]; DIAMINE,³ *Cassella's Application*, [1910] 2 Ch. 240; 27 R. P. C. 453; GRAMOPHONE, *Gramophone Co.'s Application*, [1910] 2 Ch. 423; 27 R. P. C. 689; McEWAN'S¹ for beer, *William McEwan & Co.'s Application*, [1912] 2 Ch. 32; 29 R. P. C. 165; PERFECTION for soap, *Crosfield & Sons' Application*, [1910] 1 Ch. 118, 130; 26 R. P. C. 561, 837; POPE¹ for lamps, *Pope's Electric Lamp Co.'s Application*, [1911] 2 Ch. 382; 28 R. P. C. 629; ROYAL WORCESTER for corsets made in America,⁴ *Royal Worcester Co.'s Application*, [1909] 1 Ch. 459; 26 R. P. C. 185.

In addition to the above decisions the word "ORLWOOLA" was removed from the Register on the ground that it was not registrable under the Act of 1888 nor as a distinctive word under the Act of 1905; *Re Orlwoola Tm.*, [1910] 1 Ch. 130; 26 R. P. C. 850; and the word "Health," which had been registered for cocoa and chocolate, was held to be in reference to such articles merely a commendatory epithet, and the registration was expunged, *Thorne & Co., Ltd. v. Sandow*, 29 R. P. C. 440 (1912).

¹ *Pope, Boardman, and McEwan* were surnames.

² On the ground that this was the name of an article which had been patented.

³ On the ground that it was a well-known technical word, indicating in

chemistry the presence of two amine groups.

⁴ On the ground that apart from words indicating American origin, the words were not distinctive, and might be deceptive.

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

Distinctiveness."

Questions to be considered.

1. What Marks are to be distinguished.

In many trades there are a great number of common marks, which have been generally adopted for ornament or some similar purpose, or which—having been in the first instance appropriated as trade marks—by abandonment,² by widespread piracy,³ or, in the case of word marks, by becoming the names,⁴ and therefore descriptive, of the goods, have become *publici juris*. And a mark, to be distinctive, must be distinguishable from all of these.

Common marks.

Thus the committee of experts appointed under the Act of 1875,⁵ to classify the marks tendered for registration in respect of cotton goods, rejected some marks bearing arrangements of elephants, lions, and crowns, on the ground that such devices or symbols in themselves, and by reason of the extensive use by the trade of lions and demi-lions, and crowns and elephants, were not private property, and did not possess a distinctive character; and on the appeal from the Registrar's refusal to register, evidence was given that among the marks rejected by the committee were 31 crowns used by 18 different firms, 52 elephants used by 30 different firms, and 137 lions and demi-lions used by 64 different firms.⁶ In the same case it was shown

The Orr-Ewing case.

¹ Chap. X., at p. 260. As to question (2), see also below, p. 204.

² See below, p. 412.

³ See *Ford v. Foster*, 7 Ch. 611; 27 L. T. (N. S.) 219 (1872), C. A. See p. 40, above; also *Ripley v. Bandey*, 14 R. P. C. 591 and 944 (1897), Kekewich, J., and C. A.; and Chap. XIV., p. 401.

⁴ See Chap. II., p. 39.

⁵ See Chap. VII., p. 129.

⁶ *Orr-Ewing v. The Registrar of Tms.*, 4 App. Ca. p. 485; 48 L. J. Ch. 707 (1879); and see *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238, n. (1878); and *Hyde & Co's Tm.*, 7 C. D. 724; 54 L. J. Ch. 395, n. (1878), both Jessel, M.R.

that triangular tickets in green and gold were in common use in the cotton trade.

In the early years of the existence of the Register, a number of common marks were accepted and placed upon it in ignorance of their true character. The committee of experts, to which reference has been made, was instituted to assist the Registrar, and, after 1884, the Comptroller, in determining what marks were common in the cotton class, and it was the practice of these officers in other cases to consult the representatives of the trade concerned on the subject.¹

It is clear that such marks as those above referred to, which are in common use in the trade, must be standards of comparison by which the distinctiveness of a new mark may be tested ;² and some assistance in determining when a mark is to be taken to be in common use may be obtained from decisions on the repealed Acts. Thus, sec. 64 (1) (c) of the Act of 1883, repealed by the Act of 1888, allowed "fancy words not in common use" to be registered, and on this it was held, that use by several firms in the trade in question, and by others in different trades, was common use.³ In *The Washerine* case⁴ Chitty, J., held, that marks might be *common to the trade* within sec. 74 of the Act of 1883, though not publicly used by more than three persons, as required by sub-sec. (3), and that the words did not mean "in common use in the trade," but "open to the trade," and this interpretation was adopted by Kekewich, J., in *The Apollinaris* case.⁵ Chitty, J., gave as an example the case of a mark widely

¹ Per Jessel, M.R., in *Kuhn's* case, *supra*. See also sec. 64 (14) of the Act of 1905.

² See *Bryant and May's Tm.*, 8 R. P. C. 69; 59 L. J. Ch. 763 (1890), North, J.; the cases cited in note (6), p. 199; *Anderson's Tm.*, 26 C. D. 409; 53 L. J. Ch. 664, Chitty, J.; affirmed on appeal, 54 L. J. Ch. 1084 (1884); *Thewlis and Blakey's Tm.*, 10 R. P. C. 369 (1893), North, J., *Ancross* rejected because anchors were common in the trade; and *Hudson's Application*, 24 R. P. C. 582 (1907), Joyce, J., "*The Thunderer*" for whistles; *Anglo-Swiss Condensed Milk Co. v. Pearks, Gunston and Tee, Ltd.*, 20 R. P. C. 509; 21 R. P. C. 261 (1904), Joyce, J., and C. A., "*Milkmaid*" for butter.

³ *Great Tower Street Tea Co. v. Smith*, 6 R. P. C. p. 172; 5 T. L. R. p. 232, North, J. (1889), *Tower Tea*; and see above, p. 159. Cf. also sec. 74 of the Act of 1883, and the decisions on "distinctive" and "common to the trade" in that section. Distinctive there meant *prima facie* distinctive: *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J. (*Washerine*); *Thompson v. Miller*, 13 R. P. C. 35 (1895), Stirling, J. (*Roadster*); *Faulder's Tm.*, [1902] 1 Ch. 125; 18 R. P. C. 37, 535, Kekewich, J., and C. A. (*Silverpan*).

⁴ *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889).

⁵ [1891] 2 Ch. p. 209; 8 R. P. C. 137.

used and then abandoned by all but two or three persons in the trade. In *The Apollinaris* case the word in question was the name of a mineral water which might have been sold by the proprietors to other traders than the claimants of the mark, although they were, for the time, the sole importers of it. And in *The Herbalin* case¹ the word had been extensively used before registration both by the plaintiff and by the defendant. The cases cited in this paragraph were all cases of descriptive words.

In *The Stone Ales* case² Lindley, L.J., expressed an opinion that a mark used by one person in the trade only could not be common to the trade.

A mark may be distinctive although there are in use in the trade a number of marks embodying somewhat the same idea. Thus in a case in which the use of a star was held to be *publici juris* in the tobacco trade, the registration of a particular form of star was upheld,³ and in another case it was held that, although a diamond was present as part of a complex figure in many marks used in the trade, a simple diamond was a good trade mark.⁴ Where a mark has been long registered the *onus* of proving that it was common when registered is not discharged by proving occasional and slight user by other persons.⁵

If a trade mark contains matter common to the trade or otherwise of a non-distinctive character, the Registrar or the Board of Trade, or the Court, may require, as a condition of the mark being upon the Register, that the proprietor shall disclaim any right to the exclusive use of all or any portion of such matter or make such disclaimer as they shall think needful for the purpose of defining his rights under such registration.⁶

¹ *Humphries v. Taylor Drug Co.*, 59 L. T. 820; 5 T. L. R. 41, Kekewich, J. (1888).

² *Thompson v. Montgomery*, 41 C. D. p. 49; 6 R. P. C. 404 (1889). In *Ripley v. Bandey*, 14 R. P. C. 591 (1897) (*Oval Blue*), the defendants were proceeded against for selling blue in an oval shape similar to that employed by the plaintiff, from which his goods had acquired the name *Oval Blue*. Kekewich, J., held that the name had not fallen into common use, although the oval shape had been used by three other persons, but he also held that the plaintiff failed owing to his neglect to enforce his rights against the other users—a result tanta-

mount to holding the shape to be common. On an appeal the case was settled: 14 R. P. C. 944.

³ *Dexter's Tm. and Wills' Tms.*, [1893] 2 Ch. 262; 10 R. P. C. 269.

⁴ *Bass, Ratcliffe and Gretton, Ltd.'s Tm.*, [1902] 2 Ch. 579; 19 R. P. C. 129, 529, C. A. See also *Star Cycle Co., Ltd. v. Frankenburgs*, 24 R. P. C. 46, 405 (1907), a passing-off case.

⁵ *Boord & Son v. Thom and Cameron, Ltd.*, 24 R. P. C. 697 (1907), Inner House, Scotland. And see the judgment of Moulton, L.J., in *Star Cycle Co. v. Frankenburgs*, supra.

⁶ Sec. 15.

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

Other trade marks, registered or unregistered.

Where any marks already in use are trade marks, whether registered or unregistered, it is clear that they are obstacles to the registration of any mark which so closely resembles them as to be calculated to deceive, unless the applicant has an independent trade mark right in the mark he puts forward.¹ This is expressly enacted by sec. 19, in regard to registered trade marks;² and it follows, in the case of unregistered trade marks, from the prohibition placed by sec. 11 upon the registration of any matter, the use of which, by reason of its being calculated to deceive or otherwise, would be deemed disentitled to protection in a Court of Justice.³ But if the applicant's mark has by long user become his trade mark he cannot be prevented from registering his mark by the recent user of another person, nor is he bound first to establish his right to restrain such user.⁴ Apart from the sections referred to, however, the marks in use in the trade at the date of registration may have to be regarded in considering whether a particular mark is distinctive. In *Bass'* case the Court was considering whether *Bass'* diamond which had been registered as an old mark was distinctive when registered, and it was objected that a diamond was in common use in the trade. Vaughan Williams, L.J., in giving judgment, said, after stating that the question was whether *Bass'* mark of the simple diamond was distinctive: "In order to judge whether it is distinctive, you must look at the other trade marks which, it is alleged, were in use at that time. I do not know that they need be actual marks. Probably they could not very easily be trade marks if they were very similar and used by several

¹ Cf. Chap. XV., pp. 456 *et seq.*, Infringement, and see sec. 21 as to concurrent user.

² Chapter X., p. 247.

³ Page 297.

⁴ *Kenrick & Jefferson, Ltd.'s Application*, 26 R. P. C. 641, Neville, J. (1909); *Southall Bros. and Barclay, Ltd.'s Tm.*, 28 R. P. C. 481, Neville, J. (1911). See also *Hoemouller's Tm.*, 28 R. P. C. 249, Joyce, J. (1911), a rectification case.

Cf. *J. H. Andrew & Co., Ltd. v. Kuehnrich*, 30 R. P. C. 93, Swinfen Eady, J., and *Times*, August 2, 1913, C.A., where the defendant's opposition to the plaintiffs' application to register ABC for steel succeeded on appeal, his user of those letters being held not to have been an infringement of the rights of the plaintiffs, who had not in fact used this combination of letters. See Addenda.

persons—three or four or whatever the number might be—because they might indicate apparently any one of those four manufacturers of beer; but you have to compare the simple diamond trade mark as used by Messrs. Bass before they registered with the marks which were in use at that time.”¹ A mark which is calculated to deceive the public by leading them to believe that it is the trade mark of some person other than its proprietor, or that the goods sold under it are the goods of another person, cannot generally be distinctive in accordance with the explanations of the term given in the judgments cited above.² In the very extraordinary circumstances of the case of *Mouson v. Boehm*,³ it was held that a trade mark which had been registered at a time when a similar and previously acquired unregistered trade mark for the same goods was in existence might be allowed to remain on the Register, on the ground that the later mark had been registered in good faith and in ignorance of the earlier unregistered mark, and had remained unchallenged on the Register for two years, during which time it had been extensively used in its proprietor’s business; but the case was treated as exceptional, and the earlier trade mark was admitted upon the Register also.⁴

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

Besides common marks and trade marks, there are, however, other marks used by traders in their businesses; for instance, marks employed in advertisements, or in the “get up” of his goods by a single trader. Are these to be taken as standards in estimating the distinctiveness of a new mark? This, it is submitted, depends upon the extent to which they are known and used. Thus in *Louise v. Gainsborough*⁶ it was held that the celebrated “Duchess of Devonshire” picture was not rightly

Abandoned
trade mark.

Marks used
in advertise-
ments.

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

² See below, Deceptive Marks, pp. 297 *et seq.*

³ 26 C. D. 398; 53 L. J. Ch. 932 (1884), Chitty, J. The facts are stated below, p. 456. Cf. *Verity’s Tm.*, 19 R. P. C. 58.

⁴ See sec. 21 as to concurrent user, below, p. 294.

⁵ See *Mouson v. Boehm*, cited *supra*,

note (3), and *Paine & Co. v. Daniells & Sons’ Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 217, C. A. (*John Bull beer*).

⁶ 20 R. P. C. 61 (1903). Farwell, J., held that it had been used in a way which would be an infringement; as to this, see below, p. 438. See also *Anglo-Swiss Condensed Milk Co. v. Tmks, Gunston and Tee, Ltd.*, 21 R. P. C. 261, C. A. (1904), where some of the users were merely as ornamentations.

registered as a trade mark for hats, &c., because it had at the date of registration been in common use in the trade in almost every way except by impression on the goods. And it would be a great hardship to compel a rival trader to omit a material part of a well-known advertisement of his trade, because someone had registered it as a trade mark. If a mark is well known in connection with a particular trader, though not used as a trade mark by him, its use upon the goods of another would be likely to identify them with him rather than with the latter, and it would not, therefore, be distinctive in regard to such goods, in the sense explained. So Kekewich, J., refused to direct the registration, as a trade mark for wire-bound india-rubber hose, of a device consisting of a sketch of an elaborate knot of the hose, on the ground that it too closely resembled a picture of similar hose printed by the opponents in their price lists, notwithstanding that the device in question had been employed as an advertisement by the applicants in their own price lists, and was registered as their copyright design.¹ The matter is, however, different where no deception can result. Thus the mere user in a different locality of a mark on the outside of a price list which contained a variety of goods including aerated waters was held not to invalidate the subsequent registration of the mark for aerated waters by another trader.² It would be very onerous on a trader to expect him to discriminate all the marks used by his fellow traders, otherwise than as recognised trade marks, in connection with their businesses, on peril of having his trade mark removed from the Register.³

2. What Degree of Distinctiveness is required.

What degree of distinctiveness is required.

The question, what degree of difference from other marks will entitle a mark to be registered, is considered in the chapter dealing with restrictions on registration, and, in particular, with sec. 19.⁴ In addition to what is there said, it may be pointed out that, although a mark offered for registration may be fairly distinguish-

¹ *Sphincter Co.'s Tm.*, 10 R. P. C. 84 (1893).

² *Verity's Tm.*, 19 R. P. C. 58, Buckley, J. (1902). The trade mark had at the date of the application to rectify been on the Register for thirteen years. But query, whether the ground of the decision was not that there had been

no user as a trade mark upon aerated waters.

³ As to cases where the opponent's user is recent and the applicant's user sufficient for acquiring trade mark rights, see above, p. 202, note (4).

⁴ Page 260.

able from each of several others, yet the existence of these, if they are in use, opposes a cumulative weight of objection to any new mark which has an apparent resemblance to a number of them.¹

A secondary meaning acquired by user in connection with the applicant's goods, which would have sufficed to create trade mark rights in an apparently descriptive mark before the Acts,² did not enable such a mark to be registered under the repealed Registration Acts, unless it was used as a trade mark before August 13th, 1875. In *The Stone Ales* case³ the mark *Stone Ale* was removed from the Register on the ground that there was no evidence of its separate user as a trade mark before the date mentioned, although its secondary meaning was not only fully established, but was the basis of the injunction granted against the defendant in the case. Now, however, it is possible to register a word which has acquired a secondary meaning as indicating the goods of the applicant only if it can be shown that by reason of actual use it is distinctive, that is, adapted to distinguish his goods from the goods of others.⁴

Secondary
distinctive
meaning.

If a trade mark is limited in whole or in part to one or more specified colours, in such case the fact that it is so limited is, under the Act of 1905,⁵ to be taken into consideration by any tribunal having to decide on the distinctive character of the mark. This provision is a new one, and reverses the practice under the previous Acts.⁶ Apart from any such limitation, a trade mark is to be deemed registered for all colours.⁵

Colour.

Descriptive Marks.

According to the construction placed upon the Acts, mark which is merely descriptive cannot be distinctive. So that any mark which merely describes the goods, their quality, or the purpose to which they are to be applied, is not registrable, and this rule has been applied far more strictly than that which rejected mere descriptive words as trade marks before the Acts.⁷

Descriptive
marks.

¹ Cf. below, p. 275.

² Chap. II., at p. 39.

³ *Thompson v. Montgomery*, 41 C. D. 35; 6 R. P. C. 404 (1889). There was no appeal on this point to the House of Lords. As to old marks, see below, p. 224.

⁴ Sec. 9 (5), above, p. 179.

⁵ Sec. 10.

⁶ *Hanson's Tm.*, 37 C. D. 112; 5

R. P. C. 130 (1887), *Kay, J.*, red, white, and blue in three parallel stripes. See as to old marks, *Bass, Ratcliff and Grelton's Tms.*, [1902] 2 Ch. 579; 19 R. P. C. 529, where the Court reserved the question whether colour could enter into the distinctiveness of old marks. And see below, pp. 233 to 235.

⁷ Chap. II., at p. 39.

The subject is discussed under the head of Word Marks, above.¹

Device.

Devices as
trade mark.

Devices have been registrable under all the Acts. They are the oldest, and, in many ways, they form the most valuable, kind of trade marks. Before the description of shops and factories by street and number became the common and convenient method of identification, every trader had his characteristic "sign," and it was an obvious and natural step to transfer the sign from the shop to goods which it was desired to show had come out of it. And this was done in very early days. Fragments of classic pottery bear the potter's mark of their maker, and, to come to later times, the early editions of the Aldine Classics bear the device of a dolphin wound round an anchor.² A good trade mark which has a device as its central feature has this peculiar advantage, that its use is not restricted to customers who speak any one language. It is not, of course, necessarily equally useful or distinctive everywhere. For instance, pictures of a stag and a buffalo, though perfectly distinct to people who are acquainted with the forms of both animals, might well be indistinguishable by the inhabitants of some of the Pacific islands where no quadruped is known which is larger than a pig, and who would have no name for either. The chief objection to a device trade mark is the difficulty of choosing one which shall be sufficiently simple and striking to fix itself in the customer's memory, and shall readily suggest a name or description by which it can be referred to, and yet, at the same time, be distinguishable from the other marks in use for the same goods or description of goods.

Word or
letter is not
a device.

It was decided under the Act of 1875, which did not, except in the case of old marks, provide for the registration of words, that a collection of English letters,³ or a single letter,⁴ could not, but that a word printed in Oriental characters might, be registered as a device.⁵ Under the Act of 1905, letters and numerals are included in the term "mark,"⁶ and can be registered, if

¹ Pages 151 *et seq.* As to descriptive devices, see p. 209.

² Salaman on Trade Marks, p. 1.

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

⁴ *Mitchell's Tm.*, 7 C. D. 36; 46 L. J. Ch. 876 (1877), Hall, V.-C., application to register A., as an old mark for

pens, refused.

⁵ *Rotherham's Tm.*, 11 C. D. 250; 14 C. D. 585; 49 L. J. Ch. 511 (1878), Bacon, V.-C., and C. A. (*Tod* in Arabic). Cf. *Gout v. Aleploglu*, 6 Beav. 69, n. (1833) (*Pessendede* (i.e.) warranted in Turkish).

⁶ Sec. 3.

distinctive,¹ and a mark consisting of letters in a special script may be a device.² But a mark consisting of the surname "Benz" in fanciful lettering surrounded by a wreath within concentric circles was held not to be a distinctive device, the name, which for the purpose of the application had to be taken to be non-distinctive, being the material part of the mark, and the rest of it being commonplace embellishment.³ But in the same case it was said by Buckley, L.J., that it did not follow from the decision that "Benz" might not be so delineated or expressed as to amount to a device.

The portrait of a person, for instance the portrait of the manufacturer of the goods in question, may be a distinctive device, and as such capable of registration.⁴ But a particular portrait may be common to the trade, for instance if it is that of the inventor of a process of manufacture which is open to the public, and if goods made according to the process are known and described by reference to the inventor. Thus in *Anderson's case*⁵ a device consisting of a portrait of Baron Liebig, with the words *Brand* above and *Baron Liebig* below it, was rejected as a trade mark for Liebig's extract of meat, on the ground that the words *Baron Liebig* were open to the trade,⁶ and that the portrait of the inventor of the goods was descriptive of the goods. In this case, Chitty, J., found⁷ that it was a common practice for those engaged in trade to place a photograph of the inventor on the particular article in order to show that he was the inventor, or to show in the particular case that the article was made according to his invention. But it would appear that, having regard to *Rowland v. Mitchell*,⁸ if such a practice is relied on to show that

Portrait of
inventor.

¹ Sec. 9 (5). The Comptroller, under the repealed Acts, refused to register words in sound merely equivalent to the names of letters, but the reason for this, namely, that letters could not be registered, is now gone. Under special circumstances the Court allowed the registration of "Vozet" in *Verschure and Zoon's Application*, 22 R. P. C. 568 (1905).

² *W. & G. du Cros, Ltd.'s Application*, [1912] 1 Ch. 644; 29 R. P. C. 65, C. A. See, however, *Addenda*.

³ *Benz et Cie, Application of*, 29 R. P. C. 357; 30 R. P. C. 177 [1913], Joyce, J., and C. A.

⁴ *Rowland v. Mitchell*, [1897] 1 Ch.

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

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

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

⁷ Basing his finding on the judgment of the Court of Appeal, and particularly of Cotton, L.J., in an action of *Liebig's Extract of Meat Co., Ltd. v. Anderson*, 55 L. T. 203.

⁸ See judgment of Lindley, L.J., [1897] 1 Ch. 74; 14 R. P. C. 41.

a portrait is not distinctive, it must be proved to exist in the particular trade. Registration of a portrait as a trade mark would only confer on the proprietor the right to stop the use of another portrait as being an infringement, if there was not a substantial difference between the two portraits.¹ Portraits of living persons or of persons recently dead cannot be registered without the consent of such persons or their legal representatives, as the case may be, if the Registrar require such consents.²

Part of mark
common to
the trade.

Under the Act of 1905, the system of the Act of 1888, by which an applicant had to disclaim the exclusive use of matter added to an essential particular,³ is discontinued. But matter common to the trade is liable to be required to be disclaimed,³ as it was under the earlier Acts.⁴ In *Baker v. Rawson*,⁵ where a lighthouse, surrounded by two concentric circles, with initials and a date between them, had been registered in 1877 as a new mark, although the circles were in fact common to the trade, an application was made to remove the mark from the Register. North, J., held that the circles ought not to have been registered, but as the whole mark had been used for a number of years, instead of ordering its removal, he directed a note, stating that the circles were common to the trade, to be put upon the Register. It will be noticed that the mark had been registered under the Act of 1875, which contained no provision for disclaimer at all, but registration with disclaimer had been approved under it.⁶

Combination
device.

A combination of devices which are common to the trade may form a new and distinctive device.⁷ The test by which any such combination must be tried is, it is submitted, correctly stated in the following passage from the report of Lord Herschell's Committee.⁸ The Committee say: "In this connection we may

¹ See note (4), p. 207.

² Rule 15 below, p. 721. See also *Carroll's Application*, 16 R. P. C. 82 (1899), Kekowich, J. (*Princess Christian*).

³ Secs. 64 (2) and 74 of the Act of 1888, as amended by the Act of 1888.

⁴ Sec. 15. See Chap. IX., p. 236.

⁵ 45 C. D. p. 533; 8 R. P. C. 89 (1890); see also *Kuhn's Tm.*, 53 L. J. Ch. 238, n. (1878), Jessel, M.R., where registration with a disclaimer was approved under the Act of 1875. See now sec. 15, Chap. IX., p. 236.

⁶ By Jessel, M.R., in *Kuhn's Tm.*, 53 L. J. Ch. 238, n. (1878).

⁷ The mark must be looked on as a whole; see Chap. X., at p. 266, and below, p. 214, "Label," and, for an instance, where a number of common and some distinctive elements combined together did not form, as wholes, distinctive combinations: see *Orr-Ewing v. The Registrar of Tms.*, 4 App. Ca. 479; and Ld. Cairns' judgment, p. 481 (quoted above, p. 142); 48 L. J. Ch. 707, 708 (1879); and see the order made, 4 App. Ca. p. 503.

⁸ Report of 1888, p. ix. The passage follows that upon the "idea of a trade mark," cited at pp. 263 to 265.

refer to a point which has been the subject of considerable controversy, namely, how far registered or common marks when combined together are to be regarded as a new mark. We think that the juxtaposition of two or more such marks is not, if there be nothing more than this, a combination constituting a new mark. An important test appears to be whether the existing marks are so combined as to suggest a new idea. For instance, assuming a cat and a fiddle to be each an old mark, we do not think that the mere representation of a cat and a fiddle together would be a new mark, but the representation of a cat playing upon a fiddle, the idea conveyed by which would be neither the cat nor the fiddle, but a cat playing upon a fiddle, would be a good combination, and might properly be registered. We think that this view differs somewhat from that which has been at times, at all events, entertained by the Board of Trade, but it appears to us to be the sound one."

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

In some judgments relating to word marks there are passages to the effect that descriptiveness is inconsistent with distinctiveness,² and it would seem to follow generally, that marks which are descriptive of the goods to which they are to be applied are not within the Acts. In the opinion of Lord Herschell's Committee,³ such marks are not legitimate, and after the Committee's report the Comptroller refused to accept them. This opinion is in accordance with the judgment of Pearson, J., in *James' case*,⁴ holding that a representation of the goods on which the mark was to be used was not a good mark. In that case the mark in question was a sketch of a cylinder with a dome top, which had been registered in 1861 as a design, and as a

Devices
descriptive of
the goods.

James' case.

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

quoted or referred to above, pp. 188, 189.

² Report of 1888, p. xii.

⁴ 31 C. D. 340; 55 L. J. Ch. 915 (1885). It also accords with a number of American decisions: see Sebastian, 5th ed., p. 51. The Court of Appeal, however, thought that little assistance was to be obtained from the American cases; 33 C. D. 392; 3 R. P. C. 340.

² See, however, the judgments of Fletcher Moulton, L.J., and Parker, J.,

trade mark in 1877. It was used as a trade mark for black-lead, which was generally, but not exclusively, sold in blocks of the shape shown by the sketch, and upon which the words "registered shape" were stamped. The Court of Appeal reversed the decision of Pearson, J., but Cotton and Lindley, L.JJ., apparently differed from the learned judge in their view of the facts only. They held that the mark was not a mere representation of the goods, and they laid stress on the circumstances that it might be used, and it had occasionally been used, on blocks of shapes other than that shown by the sketch.¹ Lindley, L.J., said: "I cannot see why, according to English law, a fish may not be a distinctive mark for a fishing-line, though I can understand that a picture of a fish may not be a distinctive mark of that particular kind of fish. Why a pig should not be, according to English law, a distinctive mark for lard, or something made out of a pig, I do not know. Supposing you tanned a pigskin into leather, I do not know why a pig should not be a good trade mark for tanned pig's hide." Lopes, L.J., took the same view of the facts; but in the course of his judgment he asked: "Why is it (the mark) the less a distinctive device or mark because it represents the thing upon which it appears?" The suggestion of this question is not only at variance with the opinion cited above, but also with the statement of Lindley, L.J., that a fish would not be a good trade mark for fish of the same kind.²

Devices
comprising
pictures of
the goods.

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

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

² See *The Sphincter Co.'s Tm.*, 10 R. P. C. 84 (1893), Kekewich, J.; and cf. *Ripley v. Bandey*, 14 R. P. C. 591 and 944 (1897), Kekewich, J., and C. A., where Kekewich, J., held the plaintiff to have established that *Oval Blue* meant his laundry blue, which was of an oval shape, but held that, owing to laches, he

could not complain of the use of the oval shape by other traders. In the Court of Appeal the case was settled. An interlocutory injunction was granted by Buckley, J., to restrain a defendant from selling cigars made in the plaintiff's distinctive shape without clearly distinguishing, *Elliott & Co., Ltd. v. Hodgson*, 19 R. P. C. 518 (1902); *query*, however, whether the decision went too far.

the wire woven up into a knot of new and striking design, or of several barrels or bats arranged in a particular and original manner.¹ Recently a representation of a looped piece of Bowden wire with the word Bowden within it, the exclusive use of the word being disclaimed, has been held to be distinctive.²

In a case in which the word *Magnolia* had been registered as a trade mark, and also a representation of a magnolia flower as another trade mark, and the word at the time of its registration was the name of the alloy in respect of which it was registered, and that registration was therefore bad, it was held that nevertheless the registration of the flower was good.³

Device representing name of goods.

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

The rules prohibit the registration of certain devices of a national character as trade marks or prominent parts of new trade marks,⁴ and as regards certain other devices, *e.g.* the arms of a foreign State or of a city, the Registrar may require justification or consent.⁵

Brand.

The word was introduced by the Act of 1883, in consequence of the ruling of Jessel, M.R., that cigar marks burnt into the ends of the boxes could not be registered under the Act of 1875, and in order to allow such marks to be registered;⁶ but it has not been restricted in practice to marks burnt into the goods or their envelope. Thus, a number of word marks were at one time accepted and registered in the tin-plate trade as brands,

¹ The question was discussed, but not decided, in *The Spinnaker's Co.'s Tm.*, 10 R. P. C. 84 (1893). The Registrar refuses to accept for registration as trade marks, pictorial representations of goods to which the marks are to be applied.

² *Bowden Wire, Ltd. v. Bowden Brake Co., Ltd.*, 30 R. P. C. 45 (1913), Swinfen Eady, J. See also the judgment of Hamilton, L.J., on appeal, July 10, 1913.

³ *Magnolia Metal Co.'s Tms.*, [1897]

⁴ Ch. 371; 14 R. P. C. 265, 621, Keke-wich, J., and C. A.

⁵ See Rules 11 and 12, below, p. 721.

⁶ Rules 13 and 14, below, p. 721.

* See the evidence of the Comptroller before Ld. Herschell's Committee, Q. 2993. The Comptroller stated that he did not see any reason for keeping up the distinction between brand and design or mark. Q. 3295.

which would not have been accepted under any of the other heads,¹ because the words were geographical words.

Brand.

Lord Herschell's Committee said, in their report²: "Some controversy has arisen with reference to the meaning of the word *brand* as distinguished from the other words employed. There can be no doubt that the term derives its origin from the practice of producing some mark by means of burning, but it appears now to be in use in certain trades for the purpose of describing trade marks no longer produced in this way, and differing in no respect from the labels and tickets mentioned in the section; nevertheless, a distinction has been made in the practice of the Office, and trade marks have been allowed registration in certain trades as brands when they would not have been accepted in other classes as labels or tickets. We see no reason for this distinction. It does not appear to us to receive support from the language of the Act, and we think that, in future, brands should be dealt with in precisely the same way as labels or tickets."

Pirie v. Goodall.

This opinion corresponds with that expressed in the judgments delivered in *Pirie v. Goodall*.³ There the plaintiffs had, in 1885, registered the words *Pirie's Parchment Bank* for paper, disclaiming the exclusive use of both *parchment* and *bank*, which were words in common use in the trade. The defendants in an action for infringement moved to remove the mark from the Register, and the plaintiffs tried to support it (*inter alia*) as a brand. Vaughan Williams, J., held, that the word *brand* must be limited in some way; it could not include all words, whether, for instance, they were *fancy words*⁴ or not. "I think," he said, "that before you can register anything as a brand, there must be evidence that, in point of fact, it is as a brand, and as a brand only, that it is used." The use of the words as a watermark on paper was not, the learned judge thought, user as a brand; but, he added, "I see no reason why a brand should not be woven into the goods just as much as stamped on to them or burnt into them." He ordered the trade mark in question to be removed from the Register. This decision was affirmed on appeal, and Lindley, L.J., who delivered the judgment of the Court, said he did not see why *mark*⁵ did not include *brand*, and he held that word

¹ *Ibid.*, Q. 3294.

² Report of 1888, p. xi.

³ [1892] 1 Ch. 85; 9 R. P. C. 17.

⁴ The mark had been registered under

the Act of 1883.

⁵ "Mark" was mentioned in sec. 64 (1) (c) of the Act of 1883.

marks¹ could only be registered when they came within those parts of the section (64) which expressly relate to words, and consequently that they could not be registered as *brands*.²

In *Paine's* case,³ the words *John Bull Brand*, registered in 1885 as a trade mark for beer, were ordered to be removed. An attempt was made to support the mark as a brand, but Kekewich, J., pointed out that the mark claimed was the three words, not the first two, and that the addition of the last word did not make the whole a brand. Some question was raised in the cases cited above as to whether a brand mark must not be registered as a brand, but there is no machinery for such registration, as no distinction is made between the different heads referred to in the section upon the Register. In a later case, in which the device of a milkmaid was held to be common for butter, the addition in the plaintiffs' mark of the words "Milkmaid Brand" did not enable them to retain their mark.⁴

The term *brand* was sometimes applied, before the Acts, to trade marks branded on metal goods, or on wine casks, or corks,⁵ and its use to denote a class of some kinds of goods, as cigars, for instance, is very common; but these uses seem to have nothing to do with its meaning in the Act.

Heading.

The meaning of this term is not at all clear. The word is ordinarily used of a sentence or words placed at the top of a document either as a title or to describe the matter contained in it; and it has been held that the words *Family Salve*, printed thus, *Reinhardt's Celebrated Family Salve*, at the top of a wrapper used for patent medicine bottles, formed a distinctive heading.⁶

¹ That is, marks consisting of a word or words, not headings, labels, or tickets, which comprise words.

² Cf. *Ld. Solborne's* judgment in *Leonard & Ellis's Tm.*, 26 C. D. p. 295; and the judgments in *Holt's Tm.*, 13 R. P. C. 16 and 118; [1896] 1 Ch. 711, C. A., as to words that are also names.

³ W. N. (1892), p. 56; and 9 R. P. C. 130, Kekewich, J. The action in which the question arose is further reported: *Paine & Co. v. Daniells & Sons' Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 71, 217, Kekewich, J., and C. A.

⁴ *Anglo-Swiss Condensed Milk Co. v. Pearks, Gunston and Tee, Ltd.*, 20 R. P. C. 509; 21 R. P. C. 261 (1904), Joyce, J., and C. A.

⁵ Sebastian, 5th ed. p. 48; *Millington v. Fox*, 3 My. & Cr. 388 (1838); *Seixo v. Provezende*, L. R. 1 Ch. 192 (1865).

⁶ *Reinhardt v. Spalding*, 49 L. J. Ch. 57 (1879), Hall, V.-C. The mark had been registered in 1876 as an old mark. It would, under the later decisions, have been refused as descriptive, and also because it was not the whole mark used before the Act.

But it was held also, under the Act of 1875, which did not provide for the registration of words, that the single word *Valvoline* did not form a heading, on the ground that word marks were specially provided for in the Act.¹ If the first decision can be relied on, and if it indicates the whole significance of the word in the section, the operation of the section under this head is very limited, for documents attached to the goods or their envelope can themselves be registered as labels.

Line heading
for cotton
goods.

In the cotton trades a line heading means the pattern or marking woven at the end of a piece of cloth;² and in *The Great Tower Street Tea Co. v. Smith*,³ North, J., said that this was what he understood by *heading* as used in this section. These line headings are of great importance in the Manchester trade, but were not registrable under the Acts of 1875, 1883 or 1888, since they are essentially colour marks. Under the Act of 1905 colour may be taken into consideration as affecting distinctiveness, and line headings can be registered as part of a combination,⁴ but no line heading can be registered alone in respect of cotton piece goods, and even if registered as part of a mark a line heading is not to be deemed distinctive, and the registration confers no exclusive right to the use of it.⁵

Label.

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

A single word or several words, not registrable alone, and not forming any sentence, will not become registrable by being printed on a plain piece of paper. Thus North, J., said:⁶ "The plaintiffs would not be in any better position at all if they had put the words *Tower Tea* upon a piece of paper, otherwise blank,

¹ *Leonard & Ellis's Tm.*, 26 C. D. p. 295 (1884), C. A.; see the judgment of Selborne, L.C.

² *Harte v. Souvazoglu* (1875), W. N. 11, 101; *Ca. ver v. Bowker*, Seb. Dig. p. 350 (1877); *Robinson v. Finlay*, 9 C. D. 487 (1877).

³ 6 R. P. C. p. 163 (1889).

⁴ See above, p. 133.

⁵ Sec. 61 (10) (b) and (c).

⁶ *The Great Tower Street Tea Co. v. Smith*, 6 R. P. C. p. 170 (1889). Cf. Ld. Selborne's judgment in *Leonard & Ellis's Tm.*, 26 C. D. 288 (1884). So a black label, bearing the descriptive word *Monobrut* in its centre, was removed from the Register in *Vignier's Tm.*, 6 R. P. C. 490; 61 L. T. 495 (1889), Kay, J.

and fixed it on to their packages, than if they had, as they have done, impressed the words *Tower Tea* upon the packages themselves." And it would make no difference that the paper was surrounded by a conventional border, or was occupied by other indistinctive matter, not altogether forming a distinctive combination. Romer, L.J., in his judgment in *Re Clement et Cie.'s Trade Mark*,¹ in which the Court of Appeal decided that certain words formed part of a label and not additions to it, said: "I desire to add that our judgment must not be understood as sanctioning the registration of words which in themselves would not constitute a proper trade mark, merely because some flourishes were colourably placed round them with the view of making out a distinctive or compound label, when, in fact, what was really intended to be registered was the words alone." In that case it was held that a description of the qualities of the article, and directions for use, although in form contained in a label, were an addition to a proper label, and this decision has been followed by Farwell, J., in a subsequent case.² The name of a firm printed in common letters on an ordinary label does not make a distinctive label.³

Lord Herschell's Committee reported⁴ that "it is said that there is often a desire to register short phrases, such as proverbs, &c., and that owing to the difficulty of finding new marks, it is expedient that they should be allowed. We see, they added, "no objection to this, provided they be in no way descriptive of the character or quality of the goods, or of their place of origin, sale, or manufacture." Probably such phrases may be registrable under the present Act as "words having no direct reference to the character or quality of the goods";⁵ and, even if they have such reference,⁶ they could be registered as distinctive marks, if by use they have in fact become distinctive of the goods.

Phrases and proverbs.

An ordinary arrangement of parts which are in common use,

Ordinary arrangement of common parts.

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

² *Royal Baking Powder Co.'s Application*, 19 R. P. C. 261 (1902).

³ *Price's Patent Candle Co.*, 27 C. D. p. 686 (1884), Pearson, J.; and *Bradley's Tm.*, 9 R. P. C. 205 (1892), Chitty, J., *Worth's Corsets*, between co-axial ovals. In *The Birmingham Vinegar Co.'s Tm.*, 11 R. P. C. 195; 70 L. T. 646 (1891), Kekewich, J., a label comprising a

large H, some common words, and a small device, was held not to be, as a whole, a distinctive label.

⁴ Report of 1888, p. xii.

⁵ Sec. 9 (4).

⁶ Under the Act of 1888, *Unecda* was held equivalent to "you need a," and not registrable: *National Biscuit Co.'s Application*, [1902] 1 Ch. 783; 18 R. P. C. 170; 19 R. P. C. 281, Cozens-Hardy, J., and C. A.

each part remaining as a separate feature in the combination does not form a distinctive label.¹ So a label for match-boxes, bearing representations of a prize medal, with the words *Bryant & May's Royal Wax Vestas* printed in ordinary type, medals being common marks in the trade, was held not to be distinctive;² and so also was a label bearing two co-axial ovals, with the words *Worth's Corsets* in ordinary type, and four dots arranged as a star at each end printed between them, ovals being common marks in the trade.³ In the last case, Chitty, J., held that the addition of the trade name of the owner of the mark made it neither better nor worse, and he approved and followed *Price's* case.⁴

The Act permits the registration of a distinctive label, and it is, therefore, a sufficient qualification for a mark that it is such a label, but some difficulty arises when the question what is sufficient to render a label distinctive is considered. Ought the label to be looked at as a whole, or should it be analysed, in order to ascertain whether it contains one or more features which are in themselves distinctive? And, further, what must be the nature of such features? The decisions which have already been cited⁵ are to the effect that the label must be examined, and that to qualify for registration some separately distinctive feature must be found in it. Some of the decisions⁶ seem to go further, however, and to lay down the rule that such a distinctive feature must itself be an "essential particular" (other than a label) within the meaning of the Act. It is submitted, however, that this is not the true view and is contrary to the general rule of construction of the Act of 1888 laid down by the House of Lords in *The Solio* case,⁷ and that it is sufficient if there be found some

¹ Cf. "combination of devices," above, p. 208, and the passage from the report there cited; also *Jamieson v. Jamieson*, 15 R. P. C. 169 (1898), Byrne, J., and C. A., a passing-off case, in which the Court of Appeal reversed the judgment of Byrne, J., for the plaintiff, on the ground that the similarity of the get-up of the defendant's goods to that of the plaintiff's was solely due to features common to the trade.

² *Bryant & May's Tm.*, 8 R. P. C. 69; 59 L. J. Ch. 763 (1890), North, J.

³ *Bradley's Tm.*, 9 R. P. C. 205 (1892), Chitty, J.

⁴ 27 C. D. 681; cited p. 215.

⁵ *Orr-Ewing v. Registrar of Tms.*, 4 App. Ca. 479; *Price's Patent Candle Co.'s case*, 27 C. D. 681; *Birmingham Vinegar Brewery Co.'s Application*, 11 R. P. C. 195; *Wright, Crossley & Co.'s Application*, [1900] 2 Ch. 218; 17 R. P. C. 386. See the quotations given above, pp. 142, 143.

⁶ See the cases in note (5), other than *Price's case*. Chitty, J., in *Bradley's Tm.*, note (3), supra, expressly distinguished the case of a combination distinctive as a whole.

⁷ *Eastman Photographic Materials Co.'s Application*, [1899] A. C. 571; 15 R. P. C. 476; see supra, p. 162.

distinctive feature or features in the label, which operate to make it, as a whole, distinctive. The Court of Appeal has not been called on to give a direct decision on the point, but it has on several occasions determined that a label must be looked at as a whole.¹

A good many of the difficulties which arose in connection with the registration of labels under the Acts of 1883 and 1888 were due to the provisions of those Acts with respect to additions to essential particulars and disclaimers.² Section 64 of the Act of 1883 contained provisions for enabling certain matter to be added to essential particulars, and the Act of 1888 required such matter to be disclaimed. Section 74 of the Act of 1883 enabled certain marks common to the trade to be registered as an addition to a trade mark, but disclaimer of the addition was required by the section, as it originally stood, and as amended by the Act of 1888.

Additions under the Acts of 1883 and 1888.

Under the Act of 1905, the whole system of additions has been swept away. A trade mark must, as before, contain or consist of an essential particular, but it is registered as a whole, and an applicant has no longer to point out in his application for registration what the essential particular is. The applicant may, however, be required to make such disclaimer as may be necessary to define his rights under the registration.³ The position is thus much simplified by the Act of 1905. Nevertheless, it is necessary, on account of previous registrations, to consider the law under the Acts of 1883 and 1888.

Additions abolished by Act of 1905.

No disclaimer of any part of a distinctive label was required by the Acts of 1883 and 1888, for the whole label is an essential particular.⁴ Under sec. 64 (2), as amended by the Act of 1888,

Disclaimer in regard to labels under previous Acts.

¹ *Apollinaris Co.'s Tms.*, [1891] 2 Ch. 186; 8 R. P. C. 137; *Pinto v. Badman*, 8 R. P. C. 181; and *Clement et Cie.'s Tm.*, [1900] 1 Ch. 114; 16 R. P. C. 173 and 611; of these, two were decisions on disclaimers and the third—*Pinto v. Badman*—on novelty. The passage cited from the judgment of Ld. Cairns in *The Orr-Ewing* case, *supra*, p. 142, must, however, be borne in mind. The actual decision was that the Registrar should proceed with the application to register the distinctive device on the labels, with the name and address of the appellant's firm, it being found that the marks contained devices which were *prima facie* dis-

tinctive. The case was under the Act of 1875.

² *Clement et Cie.'s Tm.*, [1900] 1 Ch. 114; 16 R. P. C. 173 and 611, and *Smokeless Powder Co.'s Tm.*, [1892] 1 Ch. 590; 9 R. P. C. 109, may be instanced out of the many cases cited above.

³ Sec. 15. The section is set out fully below, p. 236.

⁴ *Apollinaris Co.'s Tms.*, [1891] 2 Ch. 186; 8 R. P. C. 137; *Smokeless Powder Co.'s Tm.*, [1892] 1 Ch. 590; 9 R. P. C. 109; *Clement et Cie.'s Tm.*, [1900] 1 Ch. 114; 16 R. P. C. 173, 611; and see *Pinto v. Badman*, 8 R. P. C. 181.

certain additions to the essential particulars in a mark might be registered, subject to a disclaimer of the exclusive use of the added matter; but, since a distinctive label is itself an essential particular, that sub-section did not apply to anything forming part of the label.¹ Moreover, common words, that is, words which any one is at liberty to use, appearing in a label, did not need to be disclaimed under sec. 74 of the Act of 1883, for that section applied only to additions to the trade mark, and the whole label is itself the trade mark.² So, in *The Apollinaris* case, it was held, by the Court of Appeal, that the name *Friedrichshall* occurring on a label need not be disclaimed,³ and this was followed by Chitty, J., in the case of *The Smokeless Powder Co.'s* trade marks, where he refused to order the words *Smokeless Powder* to be disclaimed on the application of rival makers of similar powder.⁴ A dictum of Cotton, L.J., in an earlier case,⁵ decided under the Act of 1875, that such words ought to be disclaimed, was cited in the last-mentioned case; but Chitty, J., declined to follow it. The decision of Stirling, J., in *Edge's* case,⁶ that the words *Filtered Blue*, which he held to be bad as a separate trade mark, must be disclaimed when registered on a label, is also in conflict with the rule stated above. None of the above-mentioned cases were, however, cited in *Edge's* case, and it was

¹ It is submitted that this statement of the law is in accordance with and follows from the decision of the Court of Appeal in *Clement et Cie.'s Tm.*, infra, note (2). In that case the label was registered under the Act of 1883, but the amendment of sec. 64 by the Act of 1888 does not appear to affect the decision so far as it has a bearing on that section. See also *Royal Baking Powder Co.'s Application*, 19 R. P. C. 261 (1902), Farwell, J., where the "additional matter" was outside the real label. But in *Birmingham Vinegar Brewery Co.'s Application*, 11 R. P. C. 193; 70 L. T. 646 (1895), Kekewich, J., affirmed the Comptroller's decision requiring an applicant to state that, not his label, but a device contained in it, was the essential particular of the mark, and to disclaim the exclusive use of the other matter. And in *Wright, Crossley & Co.'s Application*, [1900] 2 Ch. 218; 17 R. P. C. 386, Byrne, J., held that there ought to have been in

the application a statement of the essential particular and a disclaimer of added matter. He did not decide what form the statement and disclaimer should have taken.

² *Pinto v. Badman*, 8 R. P. C. pp. 188, 191 (1891), and *Clement et Cie.'s Tm.*, [1900] 1 Ch. 114; 16 R. P. C. 173, 611. As to the registration under the Acts of 1883 and 1888 of common marks as added matter or additions, see Chap. IX., p. 236.

³ [1891] 2 Ch. p. 233; 8 R. P. C. 137; see also *Atkins' Tm.*, 3 R. P. C. 164 (1866), Bacon, V.-C., C. A.; and *Paine & Co. v. Daniells & Sons' Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 71, 217, Kekewich, J., and C. A.

⁴ [1892] 1 Ch. 590; 9 R. P. C. 109. See also *Faulder's Tm.*, [1902] 1 Ch. 125; 18 R. P. C. 37 and 535, Kekewich, J., and C. A. (*Silverpan*).

⁵ *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886), C. A.

⁶ 8 R. P. C. 207 (1891).

not cited in *The Smokeless Powder* case. *Burland v. Broxburn Oil Co.*,¹ where the point does not appear to have been argued, and *Thompson v. Miller*,² are also in conflict with the rule. The point came before the Court of Appeal again in *Clement et Cie.'s Trade Mark*,³ where the Court refused to order a disclaimer of the words *St. Raphael*, on the ground that the words formed part of and were not an addition to the mark.⁴ A distinctive label may accordingly be properly registered, although it contains words or names to the exclusive use of which no claim could be maintained.⁵

The presence of common words in a registered label does not prevent any trader registering a different label with the same or similar words. Thus *Valvoleum* printed across a label with a particular device was allowed, although *Valvoline* was already registered upon a label with a different device,⁶ Jessel, M.R., holding that each word was merely equivalent to *valve oil*.

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

It is a common practice to register labels with blank spaces which in use are filled up by matter which is either not capable of registration, or which for some other reason it is not convenient to register, because, for example, it is changed from time to time.⁷ The practice is unobjectionable, and the use of the added matter, which forms, of course, no part of the trade mark protected by registration, does not interfere with the protection of the label as registered.⁷ But in considering whether a mark is a proper mark to register, regard must be had to the appearance it will present in actual use.⁸

Blanks in registered labels.

Section 10 of the Act of 1905 provides that a trade mark may Colour.

¹ 6 R. P. C. 482; 41 Ch. D. 542 (1889), Chitty, J. (*Washerine*).

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

³ *Supra*, note (2), p. 218.

⁴ Cf. also *Wright, Crossley & Co.'s Application*, p. 218, note (1), above.

⁵ *Hudson's Tm., Atkins' Tm., and Paine & Co. v. Daniells & Sons' Breweries*, *supra*. See also *Application of Albert Baker & Co. (1898), Ltd.*, [1908] 2 Ch. 86; 25 R. P. C. 513, Eve, J.

⁶ *Re Horsburgh & Co.'s Application*, 53 L. J. Ch. 237 n. (1878); see *Leonard & Ellis' Tm.*, 26 C. D. 288 (1884), C. A.; *Loftus' Tm.*, [1894] 1 Ch. 193; 11 R. P. C. 29; North, J. (*unco' guid*

whisky).

⁷ *Hammond v. Malcolm Brunner & Co.*, 9 R. P. C. 301 (1892); *Melachrino & Co. v. Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215 (1887), both Chitty, J., and see Chap. X., at p. 272. A possible difficulty might arise if the whole mark, as filled up, were described upon the goods as a "registered trade mark." See "misrepresentation" below, pp. 483 *et seq.* See rule 15 as to variations of name or description of goods.

⁸ *Christiansen's Tm.*, 3 R. P. C. 54; 2 T. L. R. 317 (1886), C. A., the *Tændstikker Match* case, and *Lyle and Kinahan's Application*, 24 R. P. C. 37 and 249 (1907), Kekewich, J., and C. A. And see Chap. X., at p. 270.

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

Ticket.

The only difference between a label and a ticket seems to be that a label is attached by sticking it on to the goods or their envelope, and a ticket by tying.¹

Name, Signature, Word.

These have been considered above under paragraphs (1), (2), (3) and (4), as well as under "distinctive words."

Letter.

In some cases before the Registration Acts, marks consisting of letters were held to be trade marks, and were protected from infringement.² Under the earlier Acts, however, a single letter was not an essential particular;³ and a combination of English letters was held not to constitute a device,⁴ except in the case of an old mark.⁵ Letters could only be registered as additions under sec. 64 (2) of the Act of 1883, or as part of a distinctive label or ticket. Under the Act of 1905, the definition of "mark" in sec. 3 includes "letter," and a distinctive letter, or a distinctive combination of letters, is registrable under paragraph (5). And, in fact, combinations of letters have been registered, *e.g.* B.S.A. being the initial letters of Birmingham Small Arms,⁶ and K.M.S. the initial letters of Kalium Meta Sulphite.⁷ In both these instances there had been long user of the mark. In a recent case⁸ before the Court of Appeal, the applicants had applied for two marks, one consisting of the letters "W. and G." in ordinary type, of which mark there had been no user, the other of the same combination of letters in a special script, of which

¹ The words are used alternatively in *Orr-Ewing v. The Registrar of Tms.*, 4 App. Ca. 479; and *Great Tower Tea Co. v. Smith*, 6 R. P. C. 165.

² *Millington v. Fox*, 3 My. and Cr. 338 (1838), Cottenham, L.C.; *Kinahan v. Bolton*, 15 Ir. Ch. 75 (1863).

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

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

⁵ See below, p. 222.

⁶ See *Birmingham Small Arms Co.'s Application*, [1907] 2 Ch. 896; 24 R. P. C. 563.

⁷ See *Boake Roberts & Co., Ltd. v. Wayland & Co.*, 26 R. P. C. 249 (1909).

⁸ *W. & G. Du Cros, Ltd.'s Application*, [1912] 1 Ch. 644; 28 R. P. C. 413; 29 R. P. C. 65, Eve, J., and C. A.

mark there had been three years user in London and the neighbourhood. It was held by a majority of the Court that the first mark was not a distinctive mark, but the Court held that the application for the second ought to be allowed to proceed.¹ Cozens-Hardy, M.R., and Farwell, L.J., thought that the Comptroller, in refusing both marks, had not laid down a principle that under no circumstances could two letters be distinctive; and expressed the view that such a general ruling would be wrong. Cozens-Hardy, M.R., said that it might well be that some combination of two letters—such as “Z. and Y.”—might be so peculiar and so unlikely to represent the initials of a firm as to induce the tribunal to conclude that it was *prima facie* distinctive, although a different conclusion might be arrived at with reference to “W. and G.”; each case must depend on its particular facts. Whenever there was some substantial evidence of distinctiveness in fact, the *prima facie* view that letters were not distinctive might require further consideration; and Farwell, L.J., expressed himself substantially to the same effect. Both he and the Master of the Rolls adverted to the possibility of other existing or future firms having the letters W. and G. as the initials of their firm name, and being prevented from a legitimate use of them. Fletcher Moulton, L.J., however, delivering a dissenting judgment as regards the letters in ordinary type, held that quite apart from any evidence of user, such a combination was distinctive unless the circumstances of the trade showed it not to be so. He pointed out that in the case of letters, no order of the Board of Trade or Court was necessary for registration as in the case of distinctive words. In some instances letters in ordinary type have been registered.²

Numeral.

“Numeral” is substituted for the word “figure” which was used in the Act of 1883 with the meaning of numeral.³ A “numeral,” however, did not constitute an essential particular

¹ Reversed on the second point in the House of Lords. See Addenda. The applicants recently succeeded in a passing-off action in which it was held that the defendant had imitated the get-up of their cabs, of which the letters “W and G” in this form were an important

element, *W. & G. Du Cros, Ltd. v. Gold*, 30 R. P. C. 117 (1913), Swinfen Eady, J.

² For instance, the letters B. S. A., see *Birmingham Small Arms Co.’s Application*, 24 R. P. C. 563 (1907).

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

under that Act, and, except in the case of an old mark, could only be registered as an addition under sec. 64 (2), or as part of a distinctive label or ticket.

Old Marks.

Old marks.

Section 9 contains the following proviso :—

“ Provided always that any special or distinctive word or words, letter, numeral,¹ or combination of letters or numerals, used as a trade mark by the applicant or his predecessors in business before the 18th day of August, 1875,² which has continued to be used (either in its original form or with additions or alterations not substantially affecting the identity of the same) down to the date of the application for registration shall be registrable as a trade mark under this Act.”

Special and distinctive.

All the Registration Acts have contained provisions enabling certain classes of old marks, that is marks used before the commencement of the Act of 1875, to be registered, notwithstanding that they do not conform to the standard required of new marks by containing an essential particular. By sec. 10 of the Act of 1875 “ any special and distinctive word or words, or combination of figures or letters, used as a trade mark before the passing of this Act may be registered as such under this Act.”³ With a slight alteration the same provision was retained in the Acts of 1883⁴ and 1888.⁴ It was decided that, under the sub-section as it originally stood, a single letter, although an old mark, could not be registered,⁵ and to meet this the words “ figure, letter ” were added by the Act of 1883 before the words “ or combination of figures or letters.”

It has been said that it was the intention of the Act to allow to be registered anything which was protected as a trade mark under the old law, and could not be registered under the other clauses of the section.⁶ But it was decided under the Act of 1888 that the proviso did not extend to all old marks, and that

¹ *Figure* was the term used in the previous Acts, but it was held to mean *numeral*, per Jessel, M.R., in *Ex parte Stephens*, 3 C. D. 659 (1876); *Wright, Crossley & Co.'s Application*, [1900] 2 Ch. 218; 17 R. P. C. 386.

² Date of commencement of the Act of 1875.

³ Sec. 64 (3).

⁴ Sec. 10.

⁵ *Mitchell's Tm.*, 7 C. D. 36 (1877), Hall, V.-C., *A.*, for steel pens.

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

an old mark, consisting of, or even containing, a device, did not come within the proviso, and was not entitled to registration unless it consisted of or contained one of the essential particulars enumerated, and that it was, in that case, subject to the requirements of sub-sec. (2) of sec. 64 as to disclaimer of added matter.¹ And, similarly, it would seem that any old mark registered under the Act of 1875 or 1883, if not within the corresponding proviso, must conform to the general requirements of the Act under which it was registered. This decision was contrary to the previous practice of the Patent Office, which had treated all old marks as having a right to registration, and as free from the requirements of sub-sec. (2), and, as pointed out by Byrne, J., in his judgment, some of the results to which the language of the clause leads are anomalous.

It is difficult to understand why a change was made in the Act of 1905 from "special and distinctive" to "special or distinctive," for every proper trade mark must be distinctive; but the practical effect is that an old mark may be registered, if distinctive, although it may not be "special." The word "special" might therefore have been dropped altogether. It was said by Kekewich, J., in *Re Hopkinson's Trade Marks*,² that the requirement that the mark should be "special and distinctive" only embodied the old law.³ *Special* means of such a character that the mark "separates the article to which it is applied from all others of the same class or character; something which points out the article as standing alone, which makes the man who sees or reads the word understand that the article has a special standing, a special existence, and is not one of the general class, for instance, of pianos, but belongs to a class of a particular character."³ *Distinctive* means that the mark is a distinctive thing which points out that the goods are the goods of A. B.⁴ Thus, in *The Eton Cigarette* case, Fry, L.J., said: "It appears to me, that to satisfy the requirement of (this) definition the

¹ *Wright, Crossley & Co.'s Application*, [1900] 2 Ch. 218; 17 R. P. C. 386, Byrne, J., who also held that sec. 74 did not apply in that case, if the mark could be registered under sec. 64(3) (ii). It is settled that if the application is to register as an old mark, the words must have been used alone, see below, p. 229.

² *Re Hopkinson's Tm.*, [1892] 2 Ch. 116; 9 R. P. C. 102, Kekewich, J.; see

as to this, ante, p. 180.

³ See above, pp. 180 *et seq.*

⁴ *Richards v. Butcher*, [1891] 2 Ch. p. 536; 8 R. P. C. 249, Kay, J.; and per Halsbury, L.C., in *Perry, Davis & Son v. Harbord*, 15 App. Ca. p. 320; 7 R. P. C. 336 (1890). See also the definition of distinctive contained in sec. 9, considered above, p. 183.

word or words must be distinctive in this sense, that they distinguish the manufacture of the person who has registered the trade mark from the manufacture of all other persons."¹

Deceptive
mark not
distinctive.

Where, therefore, a cigarette manufacturer has registered the word *Eton* as an old mark, but had sold the cigarettes in boxes bearing the words *St. Petersburg—P. Mavrogordato & Co.*, as well as *Eton*, thereby suggesting to purchasers that the goods were not of his manufacture, but were made in Russia, although the mark was known in the trade as, in fact, indicating his manufacture, it was held that he was not entitled to have it registered, and it was accordingly ordered to be removed.¹

Descriptive
words.

It follows that words which were merely descriptive of the goods to which they are applied cannot be registered as old trade marks under the clause, for, in fact, they could not be trade marks at all.² So, where fusees were manufactured under a patent which expired in 1881, and were called *braided fixed stars* (*fixed stars* being a common name for fusees, and *braided* descriptive of the process by which the particular goods were manufactured), and the words were registered as an old mark in 1877, they were ordered to be removed from the Register, on this as well as on other grounds,³ and in a case in which it was found as a fact that "Swanbill" was descriptive of a corset with a busk of a particular shape, it was held not to be a special and distinctive word.⁴

Word with
a secondary
distinctive
meaning.

Before the Acts words which were *primâ facie* descriptive might be acquired as trade marks, if, by use as such, in connection with the goods of a particular trader, they, in fact, acquired a secondary distinctive meaning distinguishing the goods as his;⁵ and such words may still be so acquired as a "common law trade mark" apart from registration.⁶ And it is

¹ *Wood v. Lambert*, 32 O. D. p. 262; 3 R. P. C. 81 (1886); followed as to the effect of the plaintiff himself putting the name of a third person on the goods by Cozens-Hardy, J., in *Wolff v. Nopitsch*, 17 R. P. C. 321 (1900), a passing-off case, affirmed on other grounds by C. A., 18 R. P. C. 27. Also followed by Buckley, L.J., in *Bowden Wire, Ltd. v. Bowden Brake Co., Ltd.* (No. 1), July 10, 1913.

² See Chap. II., at pp. 39 *et seq.*

³ *Palmer's Tm.*, 24 O. D. 504 (1882), C. A.; and see *Chesebrough Manufacturing Co.'s Tms.*, [1902] 2 Ch. 1; 18

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

⁴ *Bourne's Tms.*, [1903] 1 Ch. 211; 20 R. P. C. 105, Farwell, J.

⁵ See Chap. II., at p. 39.

⁶ *Reddaway v. Banham*, [1896] A. C.

submitted that wherever such words had been used and acquired as trade marks before August 13th, 1875, they are "special or distinctive," and therefore capable of registration within the clause. It was directly decided by Kekewich, J., in a case under the Act of 1875, that such secondary distinctive meaning made a word "special and distinctive"; and *à fortiori* such a word would be qualified under the present Act as "special or distinctive." In the case referred to¹ Kekewich, J., held the words *J. & J. Hopkinson*, printed in ordinary type, to be "special and distinctive," and to be properly registered as an old mark. "In order to protect a trade mark before the Act," he said, "you were obliged to prove by evidence and satisfy the Court that the words used as a trade mark were known in the market, and, to use Lord Westbury's expression in *Leather Cloth Co. v. American Leather Cloth Co.*,² gave a 'vendible' character to the articles to which they were attached, made those articles recognised as coming from a particular manufactory, and so gave them a character different from that of every other article in the trade. Therefore, it seems to me, that the Legislature in the Act of 1875 did no more than adopt the language of the cases, by reducing them into a compressed form, and say really that what the Court would have held to be a trade mark independently of the Act should now be capable of registration as a trade mark under the Act, provided only that the mark had been used as a trade mark before the passing of the Act." And this accords with the opinions expressed by several other judges.³ *The Monopole* case was discussed⁴ on the assumption that the word, though in itself descriptive, could be registered if it were shown to have been used before the Act of 1875 as a trade mark; and in *The Stone Ale* case⁵ the only ground upon which the Court of Appeal proceeded in removing the mark *Stone Ale* was the want of proof of such user.

199; 13 R. P. C. 218 (*Camel Hair Belting*). See below, p. 565.

¹ *Hopkinson's Tms.*, [1892] 2 Ch. 116; 9 R. P. C. 102.

² Above, p. 58.

³ Malins, V.-C., in *Barrow's Tm.*, 5 C. D. 353 (1877); and Porter, M.R., in *Watt v. O'Hanlon*, 4 R. P. C. p. 15 (1887); and Chatterton, V.-C., in *Bodega Co. v. Owens*, 6 R. P. C. 241 (1888), both Irish cases. In *Leonard & Ellis' Tm.*, 26 C. D. p. 295 (1884), Ld. Selborne said: "As to the word *Valvoline*, I for

my part am not disposed to doubt that, if that word had been used in the United Kingdom as a trade mark before the passing of the Act, it might have been registered under the Act." See also p. 226, note (4).

⁴ Fry, L.J., expressly reserved this question, *Richards v. Butcher*, [1891] 2 Ch. p. 547; 8 R. P. C. 249, Kay, J., and C. A.

⁵ *Montgomery v. Thompson*, 41 C. D. 35; 6 R. P. C. 404 (1889), C. A.

On the other hand, in *Perry, Davis & Son v. Harbord*,¹ the question was treated as an open one by two of the Lords Justices, for Fry, L.J., said: "It is not necessary now to inquire whether the words must be special and distinctive from their own proper nature and internal force *ex vi terminorum*, or whether they may acquire a distinctive character by user as applied to the goods"; and Lopes, L.J., made use of similar language, and added: "Speaking for myself, I should be inclined to think (the word tended for registration as an old mark) must be inherently special and distinctive."² And on the further appeal, Halsbury, L.C., and Lord Morris held that the words in question in the case, *Pain Killer* for a medicine, were not special and distinctive; the Lord Chancellor, on the ground that they were descriptive of a quality attributed to the goods to which they were applied.³ This decision is not in conflict with the conclusion stated above, for there was no finding or evidence that the medicine of the plaintiffs was distinguished from the same medicine made by others by use of the words *Pain Killer*; on the contrary, it appeared that there was no competition in its manufacture. It is submitted that the proper construction was that adopted by Kekewich, J., and, as already pointed out, under the present Act all that is required is to show that a word used before August 13th, 1875, was and is distinctive within the meaning of sec. 9.

A geographical word may be registered if it was used as a trade mark and had acquired a secondary distinctive meaning before August 13th, 1875.⁴

In order that a word should be registered as a special and [or] distinctive word, it must be such at the date of registration.⁵

¹ 5 R. P. C. 393, Kay, J., and C. A. (1888); and 15 App. Cas. 316; 7 R. P. C. 336, H. L.

² The question was also referred to by Kay, J., in *Grossmith's Tm.*, 6 R. P. C. 180; 60 L. T. 612 (1889) (*Emollio Cream*). Cf. *Wright, Crossley & Co.'s Tm.*, 15 R. P. C. 181 (1898), where Romer, J., held that *Wright, Crossley & Co.*, which had been registered as an old mark, was not on the face of it an illegal or improper mark. In the Court of Appeal this point was not decided; 15 R. P. C. 377.

³ Cf. *The Nourishing Stout* case,

Raggett v. Findlater, L. R. 17 Eq. 29 (1873), Malins, V.-C.

⁴ See the judgments of Cotton, L.J., in *Van Duzer's Tm.*, 34 C. D. p. 635; 4 R. P. C. 31 (1887); and of Kay, J., in *Compagnia General de Tabacos v. Rehder*, 5 R. P. C. 61 (1887) (*Cavité*). In *Brook & Co.'s Crystal Palace Fireworks, Ltd. v. James Pain & Sons*, 28 R. P. C. 461, 697, Warrington, J., and C. A. (1911), the words "Crystal Palace" were held not to be a geographical name in connection with fireworks.

⁵ *Wood v. Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A.

So that where the registration of an old mark has lapsed and it is necessary to make a fresh application, the word must be then special or distinctive.¹ If an application fail before the Registrar for want of evidence, that does not necessarily prevent a further application.²

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

Examples of
old word
marks.

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

Used as a Trade Mark.

What is use as a trade mark has already been considered in Chapter II. The following paraphrase by Lord Esher⁴ of the judgment of the Court of Appeal in *Palmer's case*⁵ sums up the rules there stated: "Let us see what was used in the trade, and let us see whether any article was ever in the market made by these people with these words only on them. If we find these words on goods in the market, which are said to be distinguishing marks on the goods, and on the same goods other marks, and never on any goods these words alone, then the conclusion of fact is that what was used upon the goods to distinguish them

Used as a
trade mark.

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

² *Hunt's Tms.*, 28 R. P. C. 302, Parker, J. (1911).

³ In *Dewar & Sons, Ltd. v. J. H. Dewar*, 17 R. P. C. 341 (1900), a Scotch case, Ld. Kyllachy said that he was not satisfied that the words *Dewar's Whisky* were sufficiently "special and distinctive," but did not decide the point. And in *Day v. Riley*, 17 R. P. C. 517, the

question was discussed, but not decided, whether the words "Day & Son's Black Drink" were special and distinctive. Cf. *Taylor v. Taylor*, 23 L. J. Ch. 255 (1854) (*Taylor's Persian Thread* in a label).

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

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

was all that was on the goods; and we are not going to inquire whether part of what was put on all the goods to distinguish them was at one end of the goods or at the other end of the goods, or whether they were an inch or half an inch apart, or even whether part was at the top and lapping over the side, or whether part was on one side and part on the other. If you find that they are on goods for the purpose of distinguishing the goods, that makes the user one user."¹

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

Use on bottles
or boxes only.

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

Where the
applicant has
another
trade mark.

The use by the applicant of a trade mark other than and distinct from the marks which he is seeking to place or maintain on the Register as an old mark is a circumstance to be considered

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

² *Hayward's Tm.*, 54 L. J. Ch. 1003 (1885), Kay, J. (*Coker Canvas*); *Talbot v. Webley*, 3 R. P. C. 276 (1886), Bacon, V.-O. (*Baffle Safes*); *Montgomery v. Thompson*, 41 C. D. 35; 6 R. P. C. 404 (1889), C. A. (*Stone Ale*); *Powell's Tm.*, [1893] 2 Ch. 388; 10 R. P. C. 63, 195 (*Yorkshire Relish*), Chitty, J., and C. A., aff. by H. L., [1894] A. C. 8; 11 R. P. C. 4. And see below, p. 563.

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

⁴ *Richards v. Butcher*, [1891] 2 Ch.

522; 8 R. P. C. 249, Kay, J., and C. A.

⁵ *Powell's Tm.*, supra, note (2).

⁶ *Day v. Riley*, 17 R. P. C. 517 (1900), Buckley, J.; and see *European Blair Camera Co.'s Tm.*, 13 R. P. C. 600 (1896), below, p. 230, note (7).

⁷ *Kinahan's Tm.*, 10 R. P. C. 393, (1893), above, p. 32.

⁸ Chap. II., at p. 32, and see *Louise v. Gainsborough*, 20 R. P. C. 61, at p. 64, where it appeared that the plaintiffs relied on the use of the Duchess of Devonshire's picture on labels affixed to the boxes in which the hats were delivered. Farwell, J., doubted if that was sufficient.

⁹ *Powell's Tm.*, supra, note (2).

in determining whether he used the mark in question as a trade mark, but it is not conclusive that he did not, for traders often have numerous trade marks and they not infrequently use two or more of them on the same goods at once.¹

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

The Act of 1905 requires that the use of the trade mark should continue down to the application to register. Under the previous Acts the owner of an old trade mark was entitled to register unless it had been abandoned; mere discontinuance of user, not coupled with an intention to abandon, and not such that an intention to abandon would be inferred, was no disqualification.¹⁰ It would probably be held under the Act of 1905 that

Old mark must have been used as registered and alone.

Use must continue until application to register.

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

² Pages 227 and 228.

³ *Meeus' Application*, [1891] 1 Ch. 41; 8 R. P. C. 25, Chitty, J. (*Key Brand, Geneva*); *Fuente's Tm.*, [1891] 2 Ch. 166; 8 R. P. C. 214, Romer, J., both combination marks. See, however, below, p. 353.

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

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

⁶ *Palmer's Tm.*, 24 C. D. 504 (1883), C. A. (*Braided Fixed Stars*); and see *The Stone Ale* and *Yorkshire Relish*

cases, supra, p. 228, note (2).

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

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

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

¹⁰ *Mouson v. Boehm*, 26 C. D. 398 (1884), Chitty, J.; *Wright, Crossley & Co.'s Application*, [1900] 2 Ch. 218; 17 R. P. C. 386, Byrne, J.

the use since August 13th, 1875, must be substantially continual, and that, in deciding whether this condition has been complied with, the circumstances of the trade must be considered.¹

Slight variations permitted.

The continued use need not be of the trade mark exactly in its original form, but may be, as sec. 9 provides, with additions or alterations not substantially affecting the identity of the trade mark.² The Act does not expressly provide that the mark may be registered otherwise than in its original form, but the intention of the proviso appears to be to treat the original mark and the mark as used with additions or alterations not substantially affecting its identity as one and the same. The present Rules provide that an application for an old mark must contain a statement of the time during which and by whom it has been used in respect of the goods mentioned in the application; and the Registrar may require a statutory declaration verifying such user with exhibits showing the mark as used.³

Use for the same goods.

The mark must have been used as a trade mark for the class of goods in respect of which it is to be registered,⁴ for it is only in respect of them that it is an old mark; and if registration is applied for in other classes the application, so far as regards such other classes, must be treated on the footing that the mark was not used before August 13th, 1875.⁵ But use on goods essentially the same as those in the class to which the application relates, although they pass under a different name owing to slight variations in size or shape, is sufficient to qualify a mark as an old mark. Thus a mark used on hatchets and augers has been admitted as an old mark for axes and gimlets.⁶

Use in the United Kingdom.

The use must have been use as a trade mark in the United Kingdom,⁷ and mere importation into a British port for the purpose of re-shipment and transportation is not sufficient.⁷

¹ *Mouson v. Boehm*, 26 D. C. 398. Cf. sec. 37.

² Cf. secs. 14 (9), 26, 27 and 34.

³ Rule 20, below, p. 722.

⁴ Chap. V., p. 112.

⁵ *Jelley, Son & Jones' Application*, 51 L. J. Ch. 639, n.; 46 L. T. 381, n. (1878), Jessel, M.R.; and see *Leonard & Ellis' Tm.*, 26 C. D. 288 (1884), C. A., cited pp. 219 and 225, note (3); *Harrison v.*

Woodroffe, 42 C. D. 691; 7 R. P. C. 25 (1889), Kekewich, J., and *Batts' Tm.*, (1889) A. C. 428; 16 R. P. C. 411.

⁶ *Jackson & Co. v. Napper*, 35 C. D. 162; 4 R. P. C. 45 (1886), Stirling, J.

⁷ *Meeus' Application*, [1891] 1 Ch. 41; 8 R. P. C. 25, Chitty, J.; *Monck's Application*, 50 L. T. 12 (1884), Chitty, J. In *Jackson & Co. v. Napper*, 35 C. D. p. 177; 4 R. P. C. 45 (1886),

User which was commenced and continued in fraud of the rights of the owner of another trade mark cannot qualify a mark for registration.¹ The registration of the mark in such case would, besides, almost necessarily be within the prohibition of sec. 11 or sec. 19, as calculated to deceive.

Fraudulent user.

The owner of an old trade mark does not lose his title to register merely because other traders have infringed his right,² unless the infringements have been so extensive as to make the mark common³ or non-distinctive.⁴

Effect of infringements.

Slight evidence of user as an old mark will be accepted, it is said, even the production of a single label,⁵ at any rate after the mark has been registered and used for a long time. Moreover, the onus of proving that a mark registered as an old trade mark was not used before August 13th, 1875, is on the person applying to remove the mark from the Register, at all events where the mark has been long registered.⁶ And where a mark

Slight evidence of user sufficient.

Stirling, J., said: "You must make out user *in England*"; but the learned judge probably used the name of the only part of the United Kingdom in which user had been suggested, without intending to exclude user in Scotland or Ireland. The question whether foreign user was sufficient was raised as early as *Leonard & Ellis' Tm.*, 26 C. D. 288 (1884), C. A. In *The European Blair Camera Co.'s Tm.*, 13 R. P. C. 600 (1896), Stirling, J., a foreigner sold to an importer and sent the goods into this country in cases bearing the word *Bull's-eye* and his trade name, and also used the word in pamphlets sent with the goods; the importer himself sold the goods apart from the cases, and to the public the word had become known only in connection with goods sold by the importer. It was held that there had been such use of the word in connection with the goods in this country as would have entitled the foreigner to oppose the registration of the word by the importer, and the registration which had been effected in the name of the latter was expunged. The case does not decide that there was user of the word as a trade mark. See also *Neostyle Manufacturing Co., Ltd.'s Tm.*, 20 R. P. C. 329 and 803 (1903), C. A., where a

person who had manufactured goods in this country and exported them marked with the word "Neostyle" was held to be a "person aggrieved" by the registration of the word by another person. As to user on cases, see p. 228.

¹ *Heaton's Tm.*, 27 C. D. 570 (1884), Kay, J. (*Hoop & Iron*); *Monck's Application*, p. 230, note (7). Cf. *Paterson v. Kit Coffee Co.*, 27 R. P. C. 594 (1910), Lord Salvesen, an action in Scotland for rectification and passing-off in which the plaintiffs alleged that by misrepresentations by the defendants' predecessors in title their "Kit" coffee had become confused with the plaintiff's "Camp" coffee, but the action was dismissed on the pleadings for irrelevancy.

² See *Heaton's Tm.*, supra.

³ Chap. XIV., p. 404.

⁴ Above, p. 224.

⁵ *Chorlton and Dugdale's Tm.*, 53 L. T. 337 (1888), Pearson, J.; *Palmer's Tm.*, 21 C. D. 47; 24 C. D. 504 (1882), Chitty, J., and C. A. The usual evidence is the production of old prints and dies or blocks for printing.

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

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

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

Standardisation Trade Marks.

By sec. 62 of the Act of 1905—

Standardisation,
&c.,
trade marks.

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

¹ *Edgington's Tm.*, p. 231, note (6).

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

heard no more of it for ten years afterwards.

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

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

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

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

The general rule of sec. 22 that a trade mark is assignable only in connection with the goodwill of the business in the goods is, of course, inapplicable to marks registered under sec. 62. The permission of the Board of Trade is required to an assignment or transmission in order to prevent a standardisation mark being passed on to somebody in whose hands it would have a meaning different from that it had come to import. The procedure on application to register is dealt with above, p. 91.

Colour.

By sec. 10—

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

Trade marks may be limited to specified colours.

Under the Act of 1875, colours could not be registered.² Sec. 67 of the Act of 1883 was as follows:—"A trade mark may be registered in any colour or colours,³ and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any

¹ See the definition, above, p. 25.

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

resemble a silver coin is inconsistent with the later authorities.

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

Registration
in colours.

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

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

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

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

The colours in which a mark is actually used, or is likely to be used, have often a material bearing upon questions of alleged resemblance calculated to deceive, or of infringement;⁶ for

Bearing of
colour upon
the resem-
blance of
marks.

¹ See note (3) previous page.

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

British Tea, &c. Association (1884), Bacon, V.-C., and C. A.; Sebastian, 5th ed. p. 602.

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

⁴ Rule 103, below, p. 733.

⁵ Above, p. 214.

⁶ *Mitchell v. Henry*, 15 C. D. 181

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

Trade marks for the same description of goods, which while resembling each other in the material particulars thereof differ in colour amongst other things, may be registered in a series.⁴

In some cases under the earlier Acts marks have been allowed to be entered or retained on the Register upon the proprietors undertaking to use them in particular colours only, a note of the undertaking being placed on the Register.⁵ But some disapproval of notes on the Register limiting a registration was expressed in a subsequent case under the Act of 1888.⁶ Under the present Act, however, a limitation of colour is expressly recognised, in addition to which the Registrar and the Court have full powers to impose conditions on applicants.⁷

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

¹ *Worthington's Tm.*, 14 C. D. 8 (1880), C. A.; *Biegel's Tm.*, 4 R. P. C. 525; 57 L. T. 247 (1887), Chitty, J., *Turney & Sons' Tm.*, note (6), above.

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

³ *Société, &c. de l'Etoile's Tm.*, [1894] 2 Ch. 61; 2 Ch. 26; 10 R. P. C. 436; 11 R. P. C. 142; Stirling, J., and C. A.

⁴ Sec. 26.

⁵ *Re Jeffrey & Co.*, May 18th, 1888, Stirling, J., registration allowed with note binding applicants not to use mark in black, or any colour so dark as to resemble black; *Re Johnson, Philpott & Co.*, Feb. 21st, 1888, North, J., Register rectified by consent, by adding note that the proprietor was only to use his mark in blue and white. Both cases are cited Sebastian, 5th ed. p. 602.

⁶ *Dewhurst's Application*, above, note (2).

⁷ Secs. 12 (2), (6) and 14 (5), (6).

CHAPTER IX.

DISCLAIMERS.

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Sec. 15 of the Act of 1905.
Disclaimers.

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

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

Mark may contain non-distinctive matter.

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

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

Added matter
in Acts of
1883 and
1888.

¹ Sec. 64 (2). The Act is fully set out below, pp. 663 to 691.

² Sec. 74 (1) (b).

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

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

⁵ Act of 1883, sec. 74; Act of 1888,

sec. 16.

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

⁷ [1902] 1 Ch. 125; 18 R. P. C. 37 and 585, C. A.

Scheme of
the Act of
1905 as to
disclaimers.

by the owners of the mark the word "Silverpan" was held to be a fancy word identified with the plaintiffs' firm, and an injunction was granted against the defendants restraining the use of a circular in which the words "Silver Pan" were prominent. The system of additions with disclaimers above referred to has been swept away by the Act of 1905,¹ and the scheme of that Act is that, provided that a mark is qualified for registration by the possession of one or more essential particulars, it should be registered as a whole, subject only in exceptional cases, where necessary for the protection of public or private rights, to a disclaimer having the effect of defining the rights of the owner of the mark. The alteration of the law is especially important where registration abroad is desired, since some countries do not register a foreign owner of a trade mark unless it is registered in his own country. In a recent case² *Eve, J.*, said that the object of the Legislature was to relieve traders from the necessity of disclaiming, and that the condition was one for the imposition of which some good reason ought to be established rather than one which ought to be imposed, unless some good reason to the contrary was made out; and he held that an unsuccessful claim to a monopoly of a combination of letters was not a ground necessarily for requiring a disclaimer of them. In that case there were two applications before the Court. The Aerated Bread Company applied to register a mark comprising the letters A.B.C. in the tobacco class, having the mark already registered in other classes, and having used and being well known by those letters, but they stated in their application that they were willing to disclaim the exclusive use of them. *Albert Baker Co. (1898), Limited*, applied for registration in the same class of a label also comprising the letters A.B.C., which label they had used for some years, and they claimed a monopoly of the use of those letters in connection with tobacco. Both applications were refused by the Registrar, and each applicant appealed from the refusal to register its own mark and opposed

¹ It will be found fully discussed in the 2nd edition of this work, Chap. IX., p. 197, but, as it is practically obsolete, the full discussion is here omitted; and as to additions or added matter, see *Faulder's Tm.*, [1902] 1 Ch. 125; 18 R. P. C. 535, G. A.; and *Royal Baking Powder Co.'s Application*, 19

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

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

the appeal of the other. It was found as a fact that the letters A.B.C. were common to the trade, and it was held that the letters would not have been treated under the earlier Acts as additions to the mark of Baker & Co., and that their application ought to proceed without a disclaimer of the letters, although they had claimed the right to the exclusive use of such letters. It was further held that the Aerated Bread Company had shown that the concurrent use of the same letters by the two companies had not led to confusion and would not be likely to do so in the future, and their application was also directed to proceed, but with a disclaimer of the exclusive right to the letters, as they had throughout offered such disclaimer.

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

In what cases disclaimers may be required.

(1) A combination trade mark or a label may, and often does, contain a mark which may be separately registered, as, for instance, a distinctive device; and it is expressly provided by sec. 25 that, if the proprietor of a trade mark claims to be entitled to the exclusive use of any portion of such trade mark separately, he may apply to register the same as separate trade marks (*sic*). Each such separate trade mark must satisfy all the conditions and have all the incidents of an independent trade mark, except that when registered it and the trade mark of which it forms part are to be entered on the Register as associated marks, with the result that they are not separately assignable. A disclaimer may be required of parts of a mark not so separately registered subject to this, that the parts required to be disclaimed must be parts to the exclusive use of which the tribunal holds the proprietor not to be entitled, or the disclaimer must be necessary for the purpose of defining the rights of the proprietor of the mark under the registration; and these particular words of the section seem to apply to a case in which a mark contains matter, not common to the trade or otherwise of a non-distinctive character, but of which the owner of the mark cannot claim a right of exclusive use by reason, for instance, of another trader having the right to use the same.

Parts not separately registered.

(2) Matter common to the trade or otherwise of a non-distinctive character. The expression "common to the trade"

Matter common to the trade.

occurred in sec. 74 of the Act of 1883, which allowed the registration as an addition to a trade mark of certain distinctive matter, although the same was common to the trade in the goods with respect to which the application was made, but a disclaimer of the exclusive use of such matter was required.¹ Matter which is really distinctive cannot at the same time be "common to the trade," so that the word distinctive in this section was held to mean *prima facie* distinctive,² and the section was held to apply to additions which would be distinctive if they were not common to the trade. The expression "common to the trade" is capable of two meanings, namely, in common use in the trade,³ or open to the trade to use. Sub-sec. (3) of sec. 74 (which enacted that any device, &c., which was, before August 13th, 1875, publicly used by more than three persons on the same or a similar description of goods, should, for the purposes of that section, be deemed common to the trade in such goods) provided a test of what was common in the trade. It was in fact a statutory recognition of a rule, known as the three mark rule, originally introduced by the Commissioners of Patents under the Act of 1875, and recognised by the Courts before the Act of 1883 was passed.⁴ It applied whether the marks used by the three persons were precisely, or only substantially, similar, and whether they had been used as trade marks or otherwise, provided that they had been used on the same or a similar description of goods,⁴ but use abroad did not fall within the rule.⁵ The Act of 1905 contains no similar

The three
mark rule.

¹ The section is fully set out below, pp. 697, 698. It was held under the Act of 1875 that registration of a distinctive label conferred no exclusive right to words common to the trade, *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886); and as to infringement of a label containing such matter, see *Hennessy v. Dompè*, 19 R. P. C. 333; 20 R. P. C. 175 (1903), and *Hennessy & Co. v. Keating*, 24 R. P. C. 485; 25 R. P. C. 125 and 361 (1908), H. L.

² *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J. (*Washerine*); *Thompson v. Miller*, 13 R. P. C. 35 (1896), Stirling, J. (*Roadster*); *Faulder's Tm.*, [1902] 1 Ch. 125; 18 R. P. C. 87 and 535, Keekewick, J., and C. A. (*Silverpan*).

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

⁴ See *Jelley's Application*, 51 L. J. Ch. 639, n. (1878); *The Walkden, &c. Co.'s Application*, 54 L. J. Ch. 394, n. (1877), both Jessel, M.R.; *Wragg's Tms.*, 29 C. D. 551 (1885), Pearson, J.; *Benbow v. Low*, 44 L. T. 875 (1881), Bacon, V.-C.; and the judgment of Chitty, J., in *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889); also *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1891), North, J.

⁵ See *Münch's Application*, 50 L. T. 12 (1884), Chitty, J.

provision, but the same test of what is common in the trade would no doubt be applied. But as regards additions to new marks, the words "common to the trade" in the earlier part of sec. 74 were held not to be confined to such matter, but to mean "open to the trade to use."¹ This would, of course, apply to all merely descriptive matter, but, as pointed out above, the section dealt with matter *primâ facie* distinctive, and the expression "common to the trade" was said in one case² to be applicable in the sense of "open to the trade to use" to a word once largely used in the trade, but which had subsequently fallen out of use by all but one or two persons, or to a word descriptive of the goods, if *primâ facie* distinctive.³ In the Act of 1905 the expression is probably wide enough to include, not only matter in common use in the trade, but matter *primâ facie* distinctive, which for some reason, as, for instance, that suggested in *The Washetine* case, is open to the trade to use.⁴ Matter which is merely descriptive is clearly covered by the words "or otherwise of a non-distinctive character" in sec. 15. Such matter, however, will not as a general rule be required to be disclaimed. The rights of other traders will generally be sufficiently protected by sec. 44, which provides that no registration under the Act shall interfere with any *bonâ fide* use by a person of his own name or place of business or that of any of his predecessors in business or the use by any person of any *bonâ fide* description of the character or quality of his goods.⁵ Apart from this special enactment, the registration of a label distinctive as a whole does not give to the proprietor the right to the exclusive use of merely descriptive matter contained in it; at least this was so held under the Act of 1875 by the Court of Appeal,⁶ and the principle of the decision seems to be still applicable.

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

² *The Washetine* case, note (1).

³ *Humphries v. Taylor Drug Co.*, 59 L. T. 820 (1888), Kekewich, J. (*Herbalin*), and the *Washetine* and *Roadster*

cases, note (1).

⁴ In *Application of Albert Baker & Co. (1898), Ltd.*, [1908] 2 Ch. 86; 25 R. P. C. 513, Eve, J., seems to have so construed the section.

⁵ Cf. sec. 64 (3) (ii.) and sec. 74 (2) of the Act of 1883, as amended by that of 1888, below, pp. 696, 698.

⁶ *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886). See also cases referred to above, p. 240, note (1).

Label distinctive as a whole.

It was settled under the Acts of 1883 and 1888 that words common to the trade or common matter contained in a distinctive label need not be disclaimed,¹ for a distinctive label is itself an essential particular, and consists of the combination of all the parts.² A distinction must be made between such a label and a mere word or device coupled with mere flourishes or a conventional border.³ Under sec. 15 of the Act of 1905 there seems to be power to require a disclaimer of part of a distinctive label; but the fact that under the old system of compulsory disclaimer a part of a label would not have required a disclaimer is an element not to be disregarded.⁴

In any case coming within the terms of the first part of the section a disclaimer may be required of the right to the exclusive use (1) of any part or parts of such trade mark to the exclusive use of which the tribunal holds the proprietor not to be entitled, or (2) of all or any portion of matter, common to the trade or otherwise of a non-distinctive character, to the exclusive use of which the tribunal hold the proprietor not to be entitled.⁵ The words marked (1) seem to refer especially to the words in the earlier part of the section relating to parts of the mark not separately registered, and the words marked (2) to common or non-distinctive matter; but it may be that the construction ought not to be strictly *reddendo singula singulis*. Lest the parts of the section already quoted do not meet the case, the tribunal is under it given an express power to require such other disclaimer as it may consider needful for the purpose of defining the rights of the proprietor under such registration; but the case must fall within the opening words of the section, otherwise no dis-

¹ *Smokeless Powder Co.'s Tms.*, [1892] 1 Ch. 590; 9 R. P. C. 109, Chitty, J.; *Apollinaris Co.'s Tms.*, [1891] 2 Ch. 186; 8 R. P. C. 137, C. A.; *Clement et Cie.'s Tm.*, [1900] 1 Ch. 114; 16 R. P. C. 173 and 611, Kekewich, J., and C. A.; and *Application of Albert Baker & Co. (1898), Ltd.*, 25 R. P. C. 513 (1908), Eve, J. A contrary opinion seems to have been expressed in the earlier case of *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886). The *Washerine* and *Roadster* cases, p. 241, note (1), were not, perhaps, cases of labels distinctive as a whole.

² Per Esher, M.R., in *Pinto v.*

Badman, 8 R. P. C. 181 (1891).

³ *Clement et Cie.'s Tm.*, note (1); and in *Royal Baking Powder Co.'s Application*, 19 R. P. C. 261 (1902), Farwell, J., a part of the label separated from the distinctive part by a border, and containing the name of the article and directions for use, &c., was held to be "added matter."

⁴ *Application of Albert Baker & Co. (1898), Ltd.*, [1908] 2 Ch. 86; 25 R. P. C. 513, Eve, J.

⁵ The words "to the exclusive use," etc., seem to apply both to (1) and (2). See the section set out above, p. 236.

claimer can be required under it. By Rule 34 the Registrar may call on an applicant to insert in his application such disclaimer as the Registrar may think fit in order that the public generally may understand what the applicant's rights, if his mark is registered, will be. It will be noticed that the wording of this Rule does not follow that of sec. 15. The Comptroller has in an unreported case stated that in his view the circumstances to be considered in asking for disclaimers are (1) whether it is intended that the mark registered will suggest a wider right than is actually given or will lead to a wider right being claimed; (2) whether it is intended that the mark will cause confusion and may interfere with the rights of parties who are shown by evidence to use or desire to use the special features or words in question; (3) whether the words or features in question are *prima facie* distinctive and that therefore lead to a false impression being created.¹

It was held, both under the Act of 1883 and that of 1888, that a disclaimer required by the Acts must be made on application for registration, and that therefore the Court on an appeal from the Comptroller could not allow an amendment of the application by disclaimer,² and, although the Court in a few cases did make an order for disclaimer on a motion for rectification,³ the power of the Court so to do was questioned by the Court of Appeal.⁴ It is quite clear that under sec. 15 of the Act of 1905 a disclaimer may be required by the Registrar on an application to register, or by the Board of Trade or the Court on an appeal from the Registrar in an application to register, or on such an application as a condition of registration of a standardisation mark under sec. 62, or by the Court on an application to rectify the Register under sec. 35. Full powers of allowing amendment of applications to register are conferred on the Registrar, the Board of Trade and the Court, by sec. 12 (6). In an application for rectification the proprietor could elect to

Time at which disclaimer may be required.

¹ *Vegetable Butter Co's Application, Schlinck's Opposition.*

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

König and Ebhardt's Tm., [1896] 2 Ch. 236; 13 R. P. C. 449.

³ *Hayward's Tm.*, 54 L. J. Ch. 1003 (1885), Kay, J.; *Edge's Tm.*, 8 R. P. C. 207 (1891), Stirling, J.; *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482, Chitty, J.; *Thompson v. Miller*, 13 R. P. C. 35 (1896), Stirling, J.

⁴ *Faulder's Tm.*, [1902] 1 Ch. 125; 18 R. P. C. 535.

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

Disclaimer
at the
instance of
the pro-
prietor.

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

Effect of
registration
with dis-
claimer.

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

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

² Sec. 32. See also below, p. 351.

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

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

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

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

⁶ Sec. 45.

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

Registration
with blanks.

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

In a recent case, where a mark containing the word "repellus" had been registered with a disclaimer of the exclusive use of the word "repel," Parker, J., expressed the view that such a disclaimer was insufficient to protect the public, since it did not cover any fancy variation of the word "repel," *e.g.* "repela."⁵

¹ *Loftus' Tm.*, [1894] 1 Ch. 193; 11 R. P. C. 29, North, J. (*Unco' Guid* in each of two quite distinct labels); and the cases in note (3), p. 244.

² See Chap. X., p. 267.

³ *Melachrino & Co. v. The Melachrino Egyptian, &c. Co.*, 4 R. P. C. 215 (1887); *Hammond v. Bruncker*, 9 R. P.

C. 301 (1892), both Chitty, J.; and see Chap. XV., at p. 466.

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

⁵ *Wilks' Application*, 29 R. P. C. 21 (1912).

CHAPTER X.

RESTRICTIONS ON REGISTRATION.

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

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

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

I. Identical or Resembling Marks.

Sec. 19 is as follows:—

“Except by order of the Court or in the case of trade marks in

Identical or resembling marks.

¹ Page 135, secs. 9 and 62, see “reasons for refusal,” p. 76. are imposed by Rules 11 to 16 inclusive; see below, p. 721.

² Certain restrictions on registration

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."

And sec. 20 provides:—

Rival claims
to identical
marks.

"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 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."

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

Sec. 71.—"*Where each of several persons claims to be registered as proprietor of the same trade mark, the Comptroller may refuse to register any of them until their rights have been determined according to law, and the Comptroller may himself submit or require the claimants to submit their rights to the Court.*

"72.—(1) *Except where the Court has decided that two or more persons are entitled to be registered as proprietors of the same trade mark, the Comptroller shall not register in respect of the same goods or description of goods a trade mark identical with one already on the Register with respect to such goods or description of goods.*

"(2) *Except as aforesaid, the Comptroller shall not register with respect to the same goods or description of goods a trade mark having such resemblance to a trade mark already on the Register with respect to such goods or description of goods as to be calculated to deceive.*"

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

expression suggests a closer resemblance than the latter one does.¹

The special exception made in sec. 19 in the case of a trade mark in use before August 13th, 1875, the commencement of the first Registration Act,² enables the Registrar to accept such a trade mark, although it is identical with one already on the Register for the same goods or description of goods. Under the repealed Acts, an order of the Court was required by sec. 72. Before the introduction of registration, when trade mark rights could, except in a few special trades and in particular places,³ be acquired only by user, the duplication of marks for use in connection with the same description of goods, by use in different districts, was very common, and many duplicate old marks have been admitted on to the Register. A limit was put to the number of such duplicates which would be accepted by the adoption of the three mark rule which has been already referred to.⁴ According to the rule, three, but not more than three, identical or substantially identical⁵ old marks may be registered for use upon the same, or substantially the same, class or description of goods, provided that the marks have been honestly and lawfully acquired and used. So that a mark which was originally unlawfully copied from another could not claim registration along with the other under cover of the rule.⁶ If more than three such marks had been so acquired and used before August 13th, 1875, they were all treated as common to the trade;⁷ but the use of a mark abroad did not fall within the rule.⁸ Leave to register a second old mark is granted as of course, if an independent and honestly acquired title to the mark as a trade mark is shown. In *Jelley's case*,⁹ Jessel, M.R., said: "I have often had the case of a man in one town not knowing that another man in another town has the same mark, and he has got his trade mark registered. The second applicant must prove his title, that is all. The leave of the Court mentioned in sec. 6¹⁰ is not a capricious leave. The

Old marks.

The three mark rule.

Application of the rule.

¹ See the report of Ld. Herschell's Committee, quoted below, p. 263.

² Trade Marks Registration Act, 1875, printed below, p. 712.

³ *E.g.*, the cutlery trade in Sheffield.

⁴ Chapter IX., p. 240; Act of 1883, s. 74 (3).

⁵ *White Rose Tm.*, 30 C. D. 505 (1885), Kay, J.

⁶ *Jelley's Application*, 51 L. J. Ch.

639, n. (1878), Jessel, M.R.

⁷ See *Burland v. Broxburn Oil Co.*, 42 C. D. at p. 280; 6 R. P. C. 482 (1889), Chitty, J.

⁸ *Mitnch's Application*, 50 L. T. 12 (1884), Chitty, J.; and see *Jackson & Co. v. Napper*, 35 C. D. at p. 178; 4 R. P. C. 45 (1886), Stirling, J.

⁹ 51 L. J. Ch. 639, n. (1878).

¹⁰ *I.e.*, of the Act of 1875.

rule of the Court which I have just stated is always followed, and it merely means that the second man must show his title. You cannot deprive him of his trade mark. Look at the monstrous injustice that would be done if a man who had a trade mark for, perhaps, forty years, should lose it, because another man who had it for four years had happened to register it first." It was held that registration of an old mark might be allowed, although a similar mark had been on the Register for more than five years.¹

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

Sec. 20.
Duplicate
claims.

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

¹ *Jackson & Co. v. Napper*, 35 C. D. 162; 4 R. P. C. 45; *Bancroft & Co.'s Tm.*, 5 R. P. C. 209 (1888), both Stirling, J.

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

Stirling, J.

³ Sec. 42.

⁴ Below, p. 294.

⁵ Rule 29, below, p. 723.

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

under the section, the application was by one of the claimants that the registration might proceed notwithstanding the other application; this was in accordance with the usual directions given by the Court under the earlier Acts and the rules thereunder.¹ In the case referred to Joyce, J., entertained the motion in the absence of objection, but without laying down a general rule that the procedure adopted was right.² In a subsequent case in which each of the rival claimants entered an opposition to the application of the other, and the Registrar declined to proceed with either application until the rights of the claimants had been determined by the Court, the matter came before the Court on motions by the several claimants that the Registrar might be ordered to proceed with their respective applications.³ And in a later case where an opponent appealed to the Court alleging substantial user by him of the mark, the appeal stood over to enable him to make an application to register, and finally was heard with his appeal to the Court from the refusal of the Registrar to register his mark.⁴

Registration by agreement of identical or nearly identical marks is now authorised, with the limitation that the approval of the Registrar, or (on appeal) of the Board of Trade, is required. Probably no agreement will be approved where the applicants have no existing rights in the marks arising from user or otherwise; the language of the section seems to imply that the applicants have some claims to the respective trade marks other than merely being applicants for registration. The Court has under sec. 21 power to permit duplicate registrations in the case of honest concurrent user,⁵ and probably what may be done by the Court under that section may be done by agreement under sec. 20.

In deciding cases under secs. 19 and 20 the Court will consider public interests as well as the rights of the applicants *inter se*, and, unless the former are protected, will not give effect to an agreement for concurrent registrations of identical new

Public interests to be considered.

¹ *Simpson, Davies & Son's Tm.*, 15 C. D. 525 (1880), Jessel, M.R. Rule 44 of 1890 provided, however, that the claims should be submitted to the Court by a special case, unless the Court otherwise ordered.

² *Hudson's Application*, 24 R. P. C. 582 (1907). On the hearing of the motion the mark was held to be *publici*

juris.

³ *Application of Albert Baker & Co.* (1898), *Ltd.*, [1908] 2 Ch. 86; 25 R. P. C. 513, Eve, J.

⁴ *Applications of Javal and Parquet and Piesse and Lubin*, 29 R. P. C. 627 (1912), Warrington, J. In the result both appeals were dismissed with costs.

⁵ See below, p. 294.

marks, at all events in the absence of special circumstances.¹ In *Ehrmann's Trade Marks*² the applicants had formerly been partners, and certain registered marks had been used by the firm. The partnership was dissolved by an agreement that one partner should carry on business under one trade name which had been used by the firm, and the others under another trade name which had also been used by the firm, and each party was to be entitled to use the firm's marks with certain alterations to be made by them respectively, and applications were to be made by each party for registration of such marks; the agreement also provided for the cancellation of the former registrations if that should be necessary for the fresh registrations. On the applications for registration being made, the Comptroller required the respective applicants to submit their rights to the Court, whereupon the applicants appealed. On the appeals being referred to and coming before the Court, the Comptroller raised objections to registration—first, on the ground of the existing registrations, but, having regard to the view which the Court took, this was not finally dealt with; and secondly, on the ground that identical new marks ought not to be registered in the names of different persons; whilst the applicants relied on the special circumstances as giving them the right to the registrations. Stirling, J., held that in such a case the Court should consider the protection of the public, and ought to be satisfied that there was no reasonable probability of harm resulting, and he dismissed the appeals.³

The words "except by order of the Court" refer presumably to cases in which, either on concurrent applications under sec. 20, or under the powers conferred by sec. 21, the Court shall have made an order permitting identical or resembling trade marks to be registered by different proprietors for the same goods or description of goods.⁴

The operation of sec. 19 is not limited by the classes into which goods are divided for the purposes of registration.⁵ Thus, in *The Australian Wine Importers'* case, which was decided under the Act of 1883, the question arose whether an application

Sec. 19 is not limited by the register classes.

¹ See below, Concurrent User, p. 294.

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

³ See now sec. 23 as to apportionment of the trade marks of a firm on dissolution, below, p. 393.

⁴ See below, pp. 294 to 297.

⁵ In the Act of 1875 the words "goods or classes of goods" were used instead of "goods or description of goods" used in the Acts of 1883 and 1905.

to register a label containing a device and the words *Golden Fleece* for wine could be opposed on the ground of the prior registration of what were held to be similar labels for spirits, both wine and spirits being in the same register class (42), and Kay, J., held that, whether sec. 72 of the Act of 1883 applied or not, the use of the mark tendered, having regard to the presence on the Register of the other marks, would be calculated to deceive within the meaning of the next section, and that it ought not to be registered. The Court of Appeal affirmed the decision, and Lindley, L.J., said¹: "For the purpose of deciding whether two sets of goods are of the same description, we must not, it appears to me, lay too much stress on the classification in the schedule to the rules. You find there goods of the same description in different classes, and goods of different descriptions in the same class. For example, if you turn to classes 26—29, you will find that flax and hemp are in one class, and jute in another, though all of them are fibrous, and more or less of the same description for trade purposes. Then, if you turn to class 22, you will find bicycles and railway carriages in the same class. Now, for trade purposes, can you have any goods more different than bicycles and railway carriages? Of course, they are utterly different things, and yet they are put by the framers of these rules into the same class, so that we cannot be guided by their classification in construing the words 'same goods or description of goods,' which are the words used in sec. 72." And the judges were all inclined to think that wines and spirits were of the same description of goods, although they did not decide the point. And North, J., in a subsequent case, expressed the opinion that beer and rum are the same description of goods within the meaning of the section.² In a later case³ Romer, J., found as a fact that there was an intimate connection between the bicycle and camera trades, and he ordered a trade mark, which had been registered in class 22 for bicycles, to be expunged on the application of a company which had used the

The same goods or description of goods.

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

² *Turney & Sons' Tm.*, 11 R. P. C. 37; 10 Times L. R. 175 (1893), North, J.

³ *Eastman, &c. Co., Ltd. v. John Griffith's Cycle Corporation, Ltd.*, 15 R. P. C. 105 (1898) (*Kodak*). As to this case see also below, p. 300, and see *Eno*

v. Dunn, 15 App. Cas. 252; 7 R. P. C. 311 (1890), where the registration of "Dunn's Fruit Salt Trade Mark Baking Powder" was refused for baking powder in class 42 by reason of a prior use of the words "fruit salt" for a medicinal drink; and *Eno v. Dunn*, 10 R. P. C. 261 (1893).

mark for bicycle cameras and had registered marks containing the word in question in classes other than class 22.¹ On the other hand, in *Braby & Co.'s Applications*, North, J., allowed a new mark to be registered for galvanised iron sheets, although a similar mark was already registered and used for bar iron and wire, which goods were within the same register class as the iron sheets.² In a recent case the applicants, a Canadian company, which had exported and sold india-rubber boots and shoes in this country under a trade mark consisting of a Maltese cross, applied to register the mark in class 38 in respect of such goods. An English company, which was the registered owner of a trade mark, also consisting of a Maltese cross registered in class 40 in respect of india-rubber goods not included in any other class, and therefore not including boots and shoes, opposed the application. It did not manufacture boots and shoes, but it

¹ In *Finlay v. Shamrock Co.*, 22 R. P. C. 301 (1905), Porter, M.R., Ireland, an infringement case, the defendants' washing powder, which contained no soap, and the plaintiff's washing powder, sold as an extract of soap, were held to be the same description of goods. In *Compagnie Industrielle des Petroles' Application*, [1907] 2 Ch. 435; 24 R. P. C. 585, Warrington, J., expressed the opinion that lubricating oil suitable for motors and petrol spirit were goods of the same description within the meaning of sec. 19. In *Warwick Tyre Co., Ltd. v. New Motor and General Rubber Co., Ltd.*, 27 R. P. C. 161 (1910), Neville, J., held the tyre trade to be one trade, so that the use by the defendants of the name "Warwick" for motor tyres, which was known in connection with the plaintiffs' cycle tyres, was calculated to deceive. The judgment of Swinfen Eady, J., in *Bowden Wire, Ltd. v. Bowden Brake Co., Ltd.*, 30 R. P. C. 45 (1913), that pedal-cycle brakes were not goods of the same description as the goods of the plaintiffs, i.e. brakes and accessories for motor cycles, was reversed on appeal, July 10th, 1913. A difference in the nature of the goods is often an important element in passing-off cases; see below, p. 584.

² 21 C. D. 223 (1882); and see

Jelley's Application, 51 L. J. Ch 639, n. (1878), Jessel, M.R.; see also *Edwards v. Dennis*, 30 C. D. 454, where a mark which had been used only for sheet iron was held not to be infringed by use of a somewhat similar mark for wire: and cf. *König and Ebhardt's Tm.*, 13 R. P. C. 449; [1896] 2 Ch. 236, where Stirling, J., allowed registration of a mark in class 39 on the application being confined to account books, ruled paper, and other paper for use in books. In *Suter, Hartmann & Rahtjen's Composition Co.'s Tm.*, 19 R. P. C. 42 (1902), Byrne, J., expressed the opinion that glue and gelatine were not the same description of goods as anti-corrosion and anti-fouling compositions, all being within Class I. In *Leiner's Application*, 20 R. P. C. 253 (1903), Byrne, J., registration for gelatine was allowed notwithstanding the use of an unregistered mark for tapioca and sago (Class 42). In *Lake and Elliott's Application*, 20 R. P. C. 605 (1903), Kekewich, J., the application was to register "Millenium" for carriages; the opponents who were flour millers had registered the same word for "food," and had sold flour and bread under the name "Millenium" out of carts bearing prominently that name, and alleged that some confusion would be caused, but their opposition failed.

sold them, although not under this mark. It was held by Neville, J., and the Court of Appeal that the applicants' mark would or might be calculated to deceive. There was evidence that rubber boots and shoes were sold in the same shops as other rubber goods, and the Court held that confusion would result if the applicants' and opponents' goods were so sold under the same mark.¹ The matter should be looked at from a business and commercial point of view.² The true test would seem to be supplied by the question—Are the two sets of goods so commonly dealt in by the same trader that his customers, knowing his mark in connection with one set and seeing it upon the other, would be likely to suppose that it was used upon them also to indicate that they were his goods?³ It has already been stated that the proprietor of a mark used for only part of a register class, even though it be registered for the whole, and *à fortiori* if the registration as well as the user is limited within the class, cannot by virtue of his registration prevent the use of the mark by other traders upon other descriptions of goods, although they may be included in the same register class.⁴ But the fact that an opponent of an application for registration could not get an injunction to restrain the use which the registration sought is intended to cover is by no means conclusive upon the question of the right to registration.⁵

Use or registration for part of a register class.

A second mark has often been admitted to registration by agreement with the proprietor of a mark already registered, who might otherwise have opposed it, on the terms that it shall be limited to part only of the register class. The limitation was effected by placing a note on the Register.⁶ And in the same way marks have been allowed to be registered on the terms of being used in a particular manner, so as not to be confused with a mark already registered,⁷ or for use in a particular district.⁸ And the Comptroller has in some cases been directed to put a note, in accordance with the agreement, upon the Register.⁸

Registration of a second mark by agreement.

¹ *Gutta Percha and Rubber Manufacturing Co. of Toronto's Applications*, [1909] 2 Ch. 10; 26 R. P. C. 84 and 428.

² Per Cozens-Hardy, M.R., in the case last cited.

³ See per Kay, J., 41 C. D. at p. 281, in the *Australian Wine Importers'* case.

⁴ See p. 112, sec. 8; and see *Hargreaves v. Freeman*, [1891] 3 Ch. 39; 8 R. P. C. 237, Chitty, J.

⁵ See *The Australian Wine Importers'* case, *supra*, and p. 252, above.

⁶ See *Re Rabone Bros. & Co.*, Seb. Dig. p. 395 (1879), Jessel, M.R.

⁷ *Whiteley's Tm.*, 43 L. T. 627, n. (1879), Jessel, M.R.; *Sykes & Co.'s Tms.*, *ibid.*, p. 626 (1880), Hall, V.-C. For restrictions as to colour, see Chap. VIII., at p. 233.

⁸ *Keep's Tm.*, 26 C. D. 187 (1884),

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

Where identical or similar marks are registered for different goods in the same register class, it is an infringement for the proprietor of either to use his mark upon the goods for which the other is registered.⁴

The provisions of sec. 19 embody the old rule, that a mark which from its resemblance to an existing trade mark is calculated to deceive cannot be protected as a trade mark, for its use is an infringement of the other mark, which would be restrained by the Court.⁵ But the restriction extends beyond the rule, and it does not follow, because an opponent could not obtain an injunction against the use by the applicant of the mark which he tenders for registration, that it is not calculated to deceive within this sub-section. Thus, in *Speer's* case,⁶ Kay, J., said: "I could quite conceive a case in which the similarity would not be such as would induce the Court, on

Sec. 19 extends beyond infringing marks.

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

¹ *Dewhurst's Application*, [1896] 2 Ch. 137; 13 R. P. C. 288 (Lindley, Lopes, and Kay, L.JJ.); and cf. *Ehrmann's Tms.*, above, p. 252, and *Hall and Woodhouse's Application*, 19 R. P. C. 58 (1902), Buckley, J., where the registration of a second mark was refused although both marks were local and their districts wide apart.

² Sec. 12 (2) and (4); sec. 14 (4) and (6). See also the similar power given by sec. 23 on an apportionment of trade

marks where the goodwill of a business has become divided.

³ See *Concurrent User*, below, p. 294.

⁴ *Upper Assam Tea Co. v. Herbert*, 7 R. P. C. 183 (1890), C. A.

⁵ *Scizo v. Provezende*, L. R. 1 Ch. 192 (1866), Cranworth, L.O.; and see *Cope v. Evans*, L. R. 18 Eq. 158 (1874), Hall, V.-C., and the cases there cited. Deceptive trade marks are not protected, see Chap. XV., at p. 472.

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

that fact alone, to grant an injunction, but in which the Comptroller would still be entirely within his duty in saying that these marks are so nearly resembling one another, at any rate, that I will not, by allowing the registration, encourage the use of a mark which may lead to litigation hereafter. It seems to me that is a matter which the Comptroller ought to consider." And this is fully in accord with the judgments of the law lords in *The Fruit Salt* case;¹ and the distinction has often been noticed.

The law under the corresponding section of the Act of 1883 was summed up by Parker, J.,² in a case involving the comparison of two words, as follows: "You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion—that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods—then you may refuse the registration, or rather you must refuse the registration in that case."

The restrictions on registration of deceptive marks are not only for the protection of owners of marks on the Register, but also of the public, and therefore, notwithstanding the consents of owners who might oppose the registration, a mark may be refused on the ground of the likelihood of confusion with their marks, and the consents are only some evidence as to the probability of deception.³ Consents of proprietors.

The words "belonging to a different proprietor," in sec. 19 limit the operation of the section by excluding from it a case in which an applicant has already on the Register for the same goods or description of goods a trade mark similar to the one

¹ *Eno v. Dunn*, 15 App. Ca. 252; 7 R. P. C. 311 (1890). See also *Société, &c. de l'Étoile's Tm.*, below, p. 258, note (4).

² *Pianotist Co., Ltd.'s Application*, 23 R. P. C. 774, at p. 777 (1906).

³ *Dewhurst's Application*, [1896] 2 Ch. 137; 13 R. P. C. 288, C. A. See also *König & Ebhardt's Tm.*, [1896] 2 Ch. 236; 13 R. P. C. 449, Stirling, J. And as to compromise on an application to expunge, see below, p. 322.

which he is applying to register. In one case under the Act of 1888 an objection by the Registrar founded on such a similarity was upheld by the Court.¹ In such a case the Registrar may under the Act of 1905 require the marks to be registered as associated trade marks.²

Expired
trade marks.

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

Marks used in different Markets.

Limitation
to particular
market.

The question has been raised whether a mark which is sufficiently distinguishable from an opponent's mark everywhere except in a particular country or market, but has there such resemblance to it as to be calculated to deceive, on account of the local circumstances of the trade, for instance, because goods bearing the latter mark have locally acquired a particular name,³ falls within the section, and ought, therefore, to be refused registration.⁴ The question has not been directly decided,⁵ but it is submitted that the objection would be sufficient to justify the rejection of the mark, unless the justice of the case could be met by a limitation as to area placed on the Register.⁶ The authorities cited below⁷ show that probability of deception in England only is not all that is to be considered in cases of infringement; and it cannot be supposed that a mark would be admitted on to the Register if it were shown that the proprietor would forthwith, upon the application of the opponent, be restrained from using it. It is true that, where old marks have

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

² Secs. 24 and 25. See above, p. 116.

³ See p. 277, below.

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

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

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

⁶ See the case last cited.

⁷ Page 261.

been in use simultaneously for years in different markets, the injunctions granted in infringement cases have occasionally been locally limited,¹ and such limitations have the support of a dictum of Cotton, L.J., in *Johnston v. Orr-Ewing*;² but in that case, on appeal, Lord Selborne expressed a doubt whether the rightful and *bonâ fide* trade mark of the trader using it could be excluded by injunction from particular markets (though unimpeachable everywhere else), merely because in those markets it might be liable to be called by a name which the mark of another had already acquired there.³ And it seems clear that the principle upon which the limitation of the injunctions in the cases referred to was based cannot avail to enable a new mark to be registered, which is deceptive in any market, by reason of the existence of a mark with which it might there be confused. Moreover, as regards registered marks, registration confers in the absence of an express limitation rights unlimited as to locality; and, although the owner of a previously registered mark may not yet have extended his trade to the particular market in question, it is open to him to do so.⁴ Thus, in *The John Bull Beer* cases, where the two marks concerned were used by the plaintiffs and the defendants respectively in different districts of England, the more lately adopted mark was refused registration, and subsequently an injunction was granted to restrain the use of it.⁵ So, too, in *The Jackson Co.'s* case,⁶ registration of a word was refused because it was the name of a common mark in the cotton trade among the Chippeway Indians, to whom the English cotton trade had not then extended. In *Dewhurst's Application*,⁷ the Court of Appeal refused registration of a mark, having as an essential particular the words *The Golden Fan Brand* in the Burmese language and characters, on the ground of the presence on the Register, in respect of the

¹ *Carver v. Bowker*, Seb. Dig. p. 350 (1877), Little, V.-C.; *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L.J., a passing-off case. See below, p. 491.

² 13 C. D. p. 464.

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

⁴ See *Dewhurst's Application*, p. 258, note (5).

⁵ *Paine & Co. v. Daniells & Sons' Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 71, 217. In *Grant v. Levitt*, 18 R. P. C. 361 (1901), Porter, M.R., Ireland (*Globe Furnishing Company*), the defendants contended that an injunction should not be granted on the ground that the plaintiffs did not largely trade in Ireland, but this defence failed.

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

⁷ [1896] 2 Ch. 137; 13 R. P. C. 288.

same goods, of a fan which in fact, as used, was coloured gold. In this case the owner of the latter mark had consented to the registration, and the applicants were willing to submit to a condition that the mark should only be put on goods exported to Burma, and they adduced evidence that part of the mark was already known there as *The Golden Fan Trade Mark*. The broad ground on which the Court acted was that a second mark should not be placed on the Register containing a mere verbal description of an existing mark, because of the danger of purchasers being deceived.¹

In the case of honest concurrent user or other special circumstances which in the opinion of the Court make it proper so to do, the Court may under sec. 21 permit registration of the same trade mark or nearly identical trade marks under conditions which may include a limitation as to place of user²; but, except in cases falling within this section or sec. 20, registration of a new mark with such a limitation will probably not be allowed, at all events where it is opposed by the owner of a trade mark registered for the same goods or description of goods.

Deceptive Resemblance.

Calculated
to deceive.

“Calculated to deceive” may mean either “intended to deceive” or “likely to deceive,” and the prohibition applies where the case falls within either meaning,³ although the latter, which is, of course, the more inclusive meaning, is sufficient to dispose of most, if not all, of the questions that arise under the section. The words are not equivalent to “capable of being used to deceive,”⁴ for it must be assumed, until the contrary is shown, that the applicant will make an honest use of his mark.⁵ A trade mark is calculated, by its resemblance to another already on the Register, to deceive, if in the course of its legitimate use in the trade it is likely to do so.

Two important questions are suggested by the section:
A. Who are the persons whom the resemblance must be

¹ The decision expressly left it open for the Comptroller, if he thought fit to do so, to allow the words to be registered as additional words subject to a disclaimer. In the application the words had been claimed as an essential particular.

² Sec. 21, below, p. 294.

³ *Kutnow's Tm.*, 10 R. P. C. 401 (1893), North, J. (*Carlsbad Salts*); and see the next case.

⁴ *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1896), C. A.

calculated to deceive? and, B. What rules of comparison are to be adopted in judging whether such resemblance exists?

A. What Persons are to be considered.

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

Whom the mark must be calculated to deceive.

It is clearly not enough for the applicant to show that retail dealers buying his goods for resale would not be deceived, since they might themselves fraudulently or carelessly make use of the ambiguous character of the trade mark to deceive their customers, the ultimate purchasers.² In fact, dealers who buy from the manufacturers in order to sell by retail are generally aware of attempted infringements, and are parties to the fraud.³ Nor is the inquiry to be confined to England, or to persons acquainted with the English language, in cases where the goods in question have a foreign market.⁴ It must not be assumed

The ultimate purchasers.

Foreigners.

¹ *Christiansen's Tm.*, 3 R. P. C. 54 (1886). See per Esher, M.R., p. 62, quoted below, p. 266.

² *Wilkinson v. Griffith*, 8 R. P. C. at p. 374 (1891), Romer, J. See the judgment of Mellish, L.J., in *Ford v. Foster*, L. R. 7 Ch. 616 (1872); and the judgment of Ld. Selborne in *The Singer Manufacturing Co. v. Loog*, 8 App. Ca. 15 (1882); and *Powell v. Birmingham Vinegar Brewery Co.*, [1896] 2 Ch. 54; 12 R. P. C. 496; 13 R. P. C. 235; and in the House of Lords, [1897] A. C. 710; 14 R. P. C. 720; especially the judgment of Kay, L.J., 13 R. P. C. 250; *Hubbuck v. Brown*, 17 R. P. C. 645 (1900), C. A.; and *William Edge & Sons, Ltd. v. William Nicolls & Sons, Ltd.*, [1911] 1 Ch. 5; [1911] A. C. 693; 27 R. P. C. 671; 28 R. P. C. 58 and 582, House of Lords, reversing the decision of the Court of Appeal.

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

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

⁴ *Johnston v. Orr-Ewing*, 7 App. Ca. 219 (1882); *Wilkinson v. Griffith*, supra, note (2); *Price's Patent Candle Co., Ltd. v. Ogston and Tennant, Ltd.*, 26 R. P. C. 797 (1909); and *Andrew v. Kuehnrich*, 30 R. P. C. 93 (1913).

Persons of ordinary ability and carefulness.

that a very careful or intelligent examination of the mark will be made,¹ and if it were shown that the class of persons who bought the goods were illiterate, that would be a material fact in cases where printing entered into the marks;² but, on the other hand, it can hardly be a bar to the admission of a mark that unusually stupid people,³ "fools or idiots,"⁴ may be deceived.⁵ And if the goods are expensive and not of a kind usually selected without deliberation, and the customers generally educated persons, these are all matters to be considered.⁶ If some parts

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

² See *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492. "The poorer classes, who buy this class of goods, do not seem to distinguish the goods by the label, but by the general appearance which the articles present." Per Ld. Gorell, in *William Edge & Sons, Ltd. v. William Nicolls & Sons, Ltd.*, cited above, p. 261, note (2), where the goods, washing-blue, were made up in penny packets, and chiefly sold over the counter to washerwomen, cottagers, and other persons in a humble position in life. The proposition is not contrary to the following passages from the judgments in *Singer Manufacturing Co. v. Loog*, where the fact of illiteracy of the customers was not established. "Whatever be the class of persons who

buy these things (sewing machines), we must at all events assume that they are persons capable of reading and writing, or of reading, at all events": per James, L.J., 18 C. D. p. 413. "The possibility of such a mistake is not a cause of action (for passing-off). The same thing might happen if the defendant issued circulars that his were *not* Singer sewing machines. For however large he printed the *not*, some one might not see it": per Ld. Bramwell, 8 App. Ca. p. 42. In one case in which the goods (lemonade powders) were largely bought by children, and it was suggested that they would be more easily deceived than adults, Byrne, J., expressed the opinion that, having regard to the nature of the goods, which they would be likely to purchase for themselves, they would be less likely to be deceived than grown-up people: *Clark v. Sharp*, 15 R. P. C. at p. 149 (the case was settled on appeal, 15 R. P. C. 268 (1898)).

³ *Payton & Co., Ltd. v. Titus Ward & Co., Ltd.*, 17 R. P. C. at p. 67, Romer, L.J. (1900); and Ld. Pearson in *Scottish Union and National Insurance Co. v. Scottish National Insurance Co., Ltd.*, 26 R. P. C. 105 at p. 112 (1909), Ct. of Sess.

⁴ Jessel, M.R., 2 C. D. at p. 447.

⁵ See note (2), ante.

⁶ *Pianotist Co.'s Application*, 23 R. P. C. 774 (1907), Parker, J. (*Neola, Pianola*); and see *Claudius Ash, Sons & Co. v. Invicta Manufacturing Co.*, 28 R. P. C. 597, 29 R. P. C. 465 (1912), C. A. and H. of L., where the customers were dentists and their assistants.

of the mark are common, one must consider whether people who know the distinguishing characteristics of the opponent's mark would be deceived.¹ The cases cited are nearly all cases of infringement or passing off, and, as already said, a weaker case than would entitle a plaintiff to succeed in an action for infringement will enable an opponent to object successfully to the registration of a new mark.

B. Rules of Comparison.

It is impossible to discover from the decided cases any criterion as to the amount of resemblance which will suffice to cause the rejection of a mark more definite than that expressed in the section itself, and probably no test could usefully be stated;² but it is settled that the onus of proving that there is no reasonable probability of deception is cast on the applicant.³ In comparing the marks, the Registrar must, as appears from the authorities referred to below, take into account all the circumstances of the case, and must consider whether, as a whole, the applicant's mark is substantially different from the opponent's. The report of Lord Herschell's Committee on this point admirably states what are conceived to be the critical tests, and it shows also what the amendment of the Act of 1883⁴ by the Act of 1888 was intended to effect; but it must be borne in mind that the Legislature has in the Act of 1905 reverted in this respect to the language of the Act of 1883. It will be useful to set out the whole passage.

What amount of resemblance is calculated to deceive.

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

"We have given very careful consideration to the evidence which has been laid before us by those interested in the trade of Lancashire. The number of marks registered in classes 23,

Lord Herschell's Committee on the principle of comparison.

¹ See the judgments of Romer, L.J., in *Payton & Co., Ltd. v. Snelling & Co., Ltd.*, 17 R. P. C. at p. 57; and *Same v. Titus Ward & Co., Ltd.*, 17 R. P. C. at p. 67 (1900) (passing-off cases); the former judgment being approved by the H. of L. on appeal, 17 R. P. C. 628; also *Alaska Packers' Association v. Crooks*, and *Marshall v. Sidebotham*, p. 262, note (1), above.

necessary (to constitute an infringement) is, from the nature of things, a matter incapable of definition *à priori*": per Cranworth, L.C., in *Seixo v. Provezende*, L. R. 1 Ch. 192 (1886).

³ *Eno v. Dunn*, 15 App. Ca. 252; 7 R. P. C. 311 (1890). See also *Capsuloid Co., Ltd.'s Application*, 23 R. P. C. 782 (1906), Swinfen Eady, J.

⁴ Substituting "having such resemblance" for "so nearly resembling."

² "What degree of resemblance is

24, and 25, which are commonly described as the Cotton Classes, is very large; and the administration of the Act in relation to these classes is of great importance to the trade. There can be no doubt that the working of the Trade Marks Act has not given satisfaction in Lancashire. Even if at times there may have been a disposition to expect too much, we think there have been substantial grounds for the dissatisfaction which has prevailed. The great bulk of the goods manufactured in Lancashire, in respect of which trade marks are used, is exported to other countries, and there can be no doubt that these marks fulfil important functions in the trade between Lancashire and India and other countries. One chief complaint has been that the usages of the trade and the character of the markets where the marks are intended to serve their purpose have not been sufficiently kept in view by the Patent Office. By sec. 72, sub-sec. (2), the Comptroller is directed not to register, with respect to the same description of goods, a trade mark so nearly resembling a trade mark already on the Register with respect to such description of goods as to be calculated to deceive. It is on the question whether marks do so nearly resemble one another as to be calculated to deceive, and what extent of resemblance to an old mark ought to cause the rejection of an application, that the chief difference has arisen between the trade and those to whom the administration of the Act has been entrusted. The tendency of the Office has been to construe the words of the Act more favourably towards applicants for new marks than the trade have thought right. We think the difference has arisen in part from the wording of the Act. The Comptroller has felt unable to say that two marks 'so nearly' resemble each other as to be calculated to deceive. He has thus not considered himself at liberty to take into consideration to the extent he otherwise might, the character of the market in which the mark is to serve its purpose. Two marks, when placed side by side, may exhibit many and various differences, yet the main idea left on the mind by both may be the same; so that a person acquainted with the mark first registered, and not having the two side by side for comparison, might well be deceived, if the goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted. Take, for example, a mark representing a game of football; another mark may show players in a different dress,

The idea of each mark to be considered.

and in very different positions, and yet the idea conveyed by each might be simply a game of football.¹ It would be too much to expect that persons dealing with trade-marked goods, and relying, as they frequently do, upon marks, should be able to remember the exact details of the marks upon the goods with which they are in the habit of dealing.

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

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

Thus, in *Johnston v. Orr-Ewing*,² where both the plaintiff's and the defendant's marks consisted of tickets bearing pictures of two elephants with a banner between them, the figures being differently arranged, Lord Selborne said:³ "Although the mere appearance of these two tickets could not lead anyone to mistake one of them for the other, it might easily happen that they might both be taken by natives of Aden or of India, unable to read and understand the English language, as equally symbolical of the plaintiff's goods. To such persons, or at least to many of

The principle is adopted by the Court.

The Two Elephant case.

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

² 7 App. Ca. 219 (1882).

³ At p. 225. See also *Baschiera's Tm.*, 33 Sol. J. 469; 5 T. L. R. 480

(1889), Chitty, J., where the ground of rejection was that "the dominating portion of each mark was a lion, and the goods were designated by the prevailing feature according to the custom of the trade."

them, even if they took notice of the differences between the two labels, it might probably appear that they were only differences of ornamentation, posture, and other accessories, leaving the distinctive and characteristic symbol substantially unchanged. Such variations might not unreasonably be supposed to have been made by the owners of the plaintiff's trade mark themselves for reasons of their own."

The Taendstikker case.

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

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

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

There may be general resemblance with many differences in details.

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

² *I.e.*, the blank spaces.

he has fallen into this fallacy—he takes each thing by itself, and says either it is common or it is the same, and leaves out altogether the mode in which the things are put together in the two pictures."

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

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

Included common marks are not to be disregarded.

Farrow's case⁴ is a good illustration of Lord Esher's rule.⁵ There both the applicant and the opponent were mustard merchants, and both used square boxes covered with yellow labels printed in black and red, for these boxes were common to the trade. The applicant placed upon his labels a picture of a charging buffalo, and the opponent a picture of a bull's head;

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

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

² *Christiansen's Tm.*, 3 R. P. C. 54 (1886), above, p. 266; and see *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1890), North, J.

³ 4 App. Ca. 479 (1879).

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

⁵ Page 266, above. In *Hennessy & Co. v. Dompe*, 19 R. P. C. 333; 20 R. P. C. 175 (1903), where some features of the marks were common to the trade, but one of them in its particular form had apparently been copied from the plaintiff's label in composing the defendant's, Kekewich, J., held that there was no infringement, but on appeal the defendant consented to an injunction. See also *Hennessy & Co. v. Keating*, 24 R. P. C. 485; 25 R. P. C. 125 and 361 (1908), H. L.

both pictures were contained within silver rings, and these rings were also common to the trade. Stirling, J., said that the buffalo and the bull's head, as printed in the *Trade Marks Journal*, were very different, but when they were placed upon the coloured labels, the applicant's label too closely resembled that of the opponent to be admitted to the Register.

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

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

cases; *Marshall v. Sidebotham*, and *Alaska Packers' Association v. Crooks*, above, p. 262, note (1) (trade mark and passing-off). See also *Hubbuck & Son, Ltd. v. Brown*, 17 R. P. C. 148 and 638 (1900); and *Wolf v. Nopitsch*, 17 R. P. C. 321 and 18 R. P. C. 27 (1901).

² 17 R. P. C. 52.

³ 17 R. P. C. 63.

by the defendants. A defendant may take it more or less. It is very seldom that he copies it. Of course he does not do that, but if he so nearly takes it that when you look at it as a whole you can say that the defendant's goods are calculated to be taken for the plaintiff's goods when properly looked at—if you can say that—then the plaintiff is entitled to succeed." In the former case, Romer, L.J., pointed out that where a person used certain leading features, which are common, another person commencing to use the same leading features ought to be careful that his goods can, by their own distinguishing features, be distinguished. If this is not done, the later comer would certainly not be entitled to register his mark.

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

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

Ear as well as eye to be considered.

A good illustration of the principle that the idea of the marks must be considered is afforded by *Currie & Co.'s Application*.⁵ There the registered mark included the words *The Cock o' the North*, with the picture of a cock in a defiant attitude, and the

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

² *Société Anonyme des Verreries de l'Étoile's Tm.*, [1894] 1 Ch. 61; 10 R. P. C. 436, Stirling, J.; [1894] 2 Ch. 26; 11 R. P. C. 142, Lindley, Kay and Smith, L.JJ. (*Red Star Brand*). In *Ouvah Ceylon Estates, Ltd. v. Uva Ceylon Rubber Estates, Ltd.*, 27 R. P. C. 645, 753 (1910), Joyce, J., and C. A.,

the plaintiffs obtained an injunction against the defendants' use of their name, the first word in each being, in fact, a different spelling of the name of the same district.

³ *Dewhurst's Application*, [1896] 2 Ch. 137; 13 R. P. C. 288, Lindley, Lopes and Kay, L.JJ.

⁴ *Application of Pomril, Ltd.*, 18 R. P. C. 181 (1901), Joyce, J.

⁵ 13 R. P. C. 681 (1896), Kekewich, J. (*Cock o' the North* label).

applicant's mark also included a somewhat similar cock, both marks being for Scotch whisky. They contained other prominent features which were different in the two marks, but Kekewich, J., held that the Comptroller was justified in refusing registration of the applicants' mark, as it included in a central position the thing which caught the eye in the registered mark.

The *Cat and Barrel* cases¹ are also good illustrations of the same principle. In these cases it was found that the plaintiffs' trade mark had come to be known as the "Cat and Barrel Brand," and the marks held to be infringements included combinations of a cat and barrel differing to a considerable extent from that which appeared in the plaintiffs' mark.¹ On the other hand, an application for a mark consisting of the head of a Red Indian was allowed to proceed to advertisement notwithstanding the presence on the Register of a mark consisting of a Red Indian on horseback and the words Red Indian, which were disclaimed, but this was on the ground that there had been substantial user of the applicant's mark.²

2. The Marks are to be compared as fairly used in Practice.

Marks not to be merely compared side by side on a view;

It is also clear that the Registrar ought not merely to look at the marks as they stand side by side, for, from the nature of the case, they will not be so put before any customer whom it is sought to deceive by means of either of them. He can only contrast the mark upon the goods offered to him with his recollection of the mark used upon those he is seeking to buy, and allowance must be made for this in estimating the probability of deception. Any other rule would be of no practical use.³ Moreover, variations in details might well be supposed by customers to have been made by the owners of the trade mark they are already acquainted with for reasons of their own.⁴

but as seen and remembered in actual use.

In comparing the marks, therefore, regard must be had not

¹ *Boord & Son v. Huddart*, 21 R. P. C. 149 (1904), Swinfen Eady, J.; *Same v. Thom and Cameron, Ltd.*, 24 R. P. C. 697 (1907), Inner House, Scotland. The *Eastern Dye Works* case, *Application of Chemische Fabrik Greisheim Electron*, 27 R. P. C. 201 (1910), Neville, J., is a recent illustration of the principle.

² *Carborundum Co.'s Application*, 26 R. P. C. 504 (1909), Joyco, J.

³ *Seixo v. Provezende*, L. R. 1 Ch. 192 (1866), Cranworth, L.C.; *Wilkinson v. Griffith*, 8 R. P. C. 370 (1891), Romer, J., and *Ld. Alverstone, M.R.*, in *Hubbuck v. Brown*, 17 R. P. C. at p. 645.

⁴ *Johnston v. Orr-Ewing*, 7 App. Ca. 219 (1882), *Ld. Selborne*, ante, p. 265.

only to their form as they appear on the Register,¹ but also to the appearance they would present in actual use when fairly and honestly used; to the nature of the goods upon which they are to be employed; to the character and size of the marks themselves, and to the probability of their becoming partially or wholly blurred or modified as ordinarily stamped or printed, or by ordinary wear and tear.²

For instance, a mark which is used for hardware goods, and is stamped upon them with a die, is not likely to appear so definitely or to be so readily distinguishable from a similar mark as one which is engraved or printed upon a paper label, and so attached to the goods.³ In the former case, too, the mark will necessarily be used in a small size only.⁴ As regards size, however, even under circumstances in which, from the nature of the goods, large sizes showing the design distinctly can be, and generally are used—since it is open to a registered proprietor to use his mark in any size—size would not seem to be a material element in the comparison.⁴ It must not be assumed against the applicant or registered proprietor that he is going to use his mark unfairly, in the sense that he is going to use something different,⁵ by leaving out or obliterating any parts of the mark, for instance, so as to make it more like that of the opponent,⁶ for the Court presumes that a trade mark will be used fairly and without fraud.⁷ But the Registrar must consider any alterations

Size of mark.

Alteration of mark as used

¹ Jessel, M.R., held, in several cases, that the Register only should be looked at: *Re Jelley*, 51 L. J. Ch. (N. S.) 639, n. (1878); *Robinson's Tm.*, 29 W. R. 31 (1880); *Mitchell v. Henry*, 15 C. D. 181 (1880); but in the latter case the C. A. dissented from his opinion and overruled his decision: *Christiansen's Tm.*, 3 R. P. C. 54 (1886), Chitty, J.; *Lyle and Kinahan's Application*, 24 R. P. C. 37 and 249 (1907), Kekewich, J., and C. A.

² *Rosing's Application*, 54 L. J. Ch. 975, n. (1878), C. A.; *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1885), C. A.; *Haines, Batchelor & Co.'s Tm.*, 5 R. P. C. 669 (1888), Chitty, J.; *Lambert's Tm.*, 5 R. P. C. 542; 6 R. P. C. 344; 61 L. T. 138 (1889), C. A. In *Hubbuck v. Brown*, 17 R. P. C. 148 and 638, the plaintiffs relied to some extent on the effect of stencilling, and see the judg-

ment of Collins, L.J. See also *Price's Patent Candle Co., Ltd. v. Ogston and Tennant, Ltd.*, 26 R. P. C. 797 (1909), cited, p. 272, note (6), where an addition to the registered mark was taken by the defendants.

³ See the two cases cited in the previous note before *Hubbuck v. Brown*, in which, however, the opposition failed; and see *Re Jelley*, 51 L. J. (N. S.) Ch. 639 n. (1878), Jessel, M.R.

⁴ *Speer's Tm.*, 4 R. P. C. 521; 55 L. T. 880 (1887), Kay, J.

⁵ *Biegel's Tm.*, 4 R. P. C. 525; 57 L. T. 247 (1887), Chitty, J.

⁶ *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1886), C. A.

⁷ *Lambert's Tm.*, 6 R. P. C. 344; 61 L. T. 138 (1889), C. A.; *Haines, Batchelor & Co.'s Tm.*, 5 R. P. C. 669 (1888), Chitty, J.; *Kutnow's Tm.*, 10 R. P. C. 401 (1893), North, J. (*Carlsbad Salts*).

from mark as registered to be considered.

Variation in the use of the opponent's mark.

which the applicant lawfully might make, without altering the essential features of his mark or losing the protection which would be conferred by registration.¹ Thus he may, unless he has under the Act of 1905 registered with a limitation as to colour,² use the mark in any colour, and in *Worthington's* case³ a triangular frame with the picture of a church inside was rejected on the ground that it would, if the whole were coloured red, too nearly resemble Bass' well-known solid red triangle. And if it is shown that the applicant does actually use, or intend to use, his mark so altered as more nearly to resemble that of the opponent, as, for example, in *The Taendstikker* case,⁴ by filling up blanks left in the mark as registered, the mark so altered will, as against the applicant, be treated as the mark to be considered.⁵ On the other hand, such alteration of the opponent's mark, being something other than the ordinary effects of its lawful user in the registered form, is immaterial as against the applicant,⁶ for no one can extend the protection given to his registered mark by departing from the registered form. The fact that the objector uses his mark in a form different from that in which it appears on the Register is, however, no answer to an objection if the mark in question so nearly resembles the objector's mark, as it there appears, as to be calculated to deceive,⁷ for such use is legal, although, so far as the mark used

¹ *I.e.*, making his mark so different as to be practically an unregistered mark.

² Sec. 10.

³ 14 C. D. 8 (1879), Jessel, M.R., and C. A.; and see *Hanson's Tm.*, 37 C. D. 112 (1887), Kay, J.; see "colour," p. 233.

⁴ *Christiansen's Tm.*, cited above, p. 266. Also *Lyle and Kinahan's Application*, 24 R. P. C. 37, 249 (1907), C. A. In this case, however, the applicants established a long concurrent user of the name which it was proposed to insert in the blank, that name being the basis of the opponent's objection.

⁵ *Christiansen's Tm.*, 3 R. P. C. 54 (1886), Chitty, J. But if a trade mark by itself is not calculated to deceive, it will not be removed from the Register because it has been used as part of a deceptive get-up. *Coleman v. Stephen Smith & Co.*, 28 R. P. C. 645 (1911), Swinfen Eady, J. The Court of Appeal

held the get-up not to be deceptive, 29 R. P. C. 81 (*Carvino*).

⁶ *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1886), C. A. Cf. *Price's Patent Candle Co., Ltd. v. Ogston and Tennant, Ltd.*, 26 R. P. C. 797 (1909), where Ld. Johnston, in an infringement case in Scotland, held that he was entitled in judging of the degree of imitation, to have regard to the fact that the defendants, as well as the plaintiffs, had printed the words "London Candles" on their labels as indicating the purpose of the imitation and as giving a much closer imitative effect; but, apart from this, he held that there was infringement.

⁷ *Melachrino v. Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215 (1887), Chitty, J.; *Hammond v. Malcolm, Brunner & Co.*, 9 R. P. C. 801 (1892), Chitty, J.; *Rowland v. Mitchell*, 13

is substantially different from the mark registered, it is not protected. Even if the user were illegal, it could hardly act as an estoppel;¹ and if the opponent were using his mark improperly, for instance, in aid of a fraudulent or illegal trade, or if his mark as used by him were calculated to deceive,² the applicant's proper course would be to remove the mark out of the way by an application to rectify the Register under sec. 35, if that remedy be not under the circumstances of the case barred from him by sec. 41.

Alteration of the opponent's registered mark in use cannot increase the objection.

Differences in the nature or origin of the goods to which the trade marks are to be applied, though the goods are of the same description, are elements to be taken into consideration.³

3. The Essential Particulars are to be specially attended to.

Regard must be specially directed to the essential particulars of the marks to be compared. In *Murphy's Trade Mark*⁴ it was pointed out that the remaining matter in any of them might, subsequently to registration, be changed on an application under sec. 92 of the Act of 1883.⁵ On this ground Stirling, J., refused to allow a mark consisting of a lion carrying a sheaf, together with other matter, to be registered, there being already on the Register another mark comprising a lion bearing a crown, because the lions were the sole essential particulars of both, although each mark had additional matter, and the general appearances of the two were different. The applicants in this case offered an undertaking that they would use their mark only in the form tendered for registration, but this was not deemed sufficient by the proprietors of the opposing mark, and, as the mark was a new one, the judge refused to accept the offer as an answer to the difficulty raised by the resemblance of the essential particulars.⁶

Undertaking not to vary registered mark in use.

R. P. C. 457; 14 R. P. C. 37 (1897), Romer, J., and C. A.; all cases of infringement.

¹ See *James' Tm.*, 33 C. D. 392; 3 R. P. C. 340 (1886), C. A.

² See *Newman v. Pinto*, 4 R. P. C. 508; 57 L. T. 81 (1887), C. A.

³ *Leiner's Application*, 20 R. P. C. 253 (1903), Byrne, J.; *Pianotist Co.'s Application*, 23 R. P. C. 774 (1906), Parker, J.; and the passing-off cases cited below, note (6).

⁴ 7 R. P. C. 163 (1890).

⁵ See below, Chap. XI. at p. 353.

⁶ And of. *Jamieson v. Jamieson*, 15 R. P. C. 169 (1898); *Clark v. Sharp*, 15 R. P. C. 141 (1898); *Payton & Co., Ltd. v. Snelling, Lampard & Co., Ltd.*, 16 R. P. C. 283; 17 R. P. C. 48 and 628; and *Same v. Titus Ward & Co., Ltd.*, 16 R. P. C. 424; 17 R. P. C. 58 (1900); all passing-off cases, in which a prominent and distinctive feature of the plaintiffs' get-up had not been taken; also *Marshall v. Sidebotham*, 18 R. P. C. 43 (1901), trade mark and passing-off.

The section of the Act of 1883 referred to above is now replaced by sec. 34 of the Act of 1905, which permits alterations not substantially affecting the identity of the trade mark, but this does not affect the reasons for the decision in *Murphy's* case, for changes in non-essential particulars will be more easily obtainable than changes in essential particulars.

4. All the Circumstances of the Trade to be considered.

Further, the Court must have regard to all the circumstances of the trade in which the marks in question are employed, or are to be employed, and in particular to the nature of the market, whether a home or a foreign one; to the number of other trade marks similar to the contrasted marks already circulating in connection with the same description of goods¹; to the common marks which are or may be combined with the contrasted marks or either of them; and, generally, to the customs and usages of the trade.

Marks
deceptive in
particular
markets.

It is obvious that marks which are readily distinguishable by Englishmen, or persons who can read English, may so resemble each other as to be calculated to deceive foreigners whose language is not only different from English, but written in different characters and in a different manner.² For them, if they are ignorant of English, the words upon a mark are only subordinate devices not readily distinguishable from other words occupying corresponding positions in any contrasted mark, and being of about the same length. But if the possible confusion between the marks in a particular market would arise entirely from a device, the use of which is open to the applicant for registration, *e.g.*, the Royal Arms, the opponent would fail.³

The fact that a mark only becomes deceptive owing to the presence in it of words in a foreign language and only when the

¹ Cf. the provision of sec. 43 that in an action for infringement the Court shall admit evidences of the usages of the trade in respect to the get-up of the goods and of any trade marks legitimately used in connection with such goods by other persons. See Chap. XV., Infringement, p. 419.

² *Johnston v. Orr-Ewing*, 7 App. Ca. 219 (1882); *Wilkinson v. Griffith*, 8 R. P. C. 370 (1891), Romer, J.

³ *Hubbuck v. Brown*, 17 R. P. C. 156,

Kekewich, J., an infringement and passing-off case, in which the plaintiffs alleged that their goods were known in Spanish-speaking markets as *Dos Leones*, by reason of their use of the Royal Arms. In the Court of Appeal, 17 R. P. C. 638, the decision was affirmed, it being held that there had not been a deliberate copying of the plaintiffs' particular form of the Royal Arms. The particular case could not now occur with a new mark, see Rule 12, below, p. 721.

meaning of those words is understood, will not help the applicant, and the mark will be refused registration if the translation of the words in English would be deceptive, even although the language used is an Oriental one.¹

In cases where there are a large number of marks similar to the mark propounded on the Register, the Court may think that, though the applicant's mark might be fairly distinguishable from the opponent's if there were no other, and perhaps also from each of the others taken alone, yet the extension of the number of such marks may lead to deception.² Thus in *Hargreaves* case,³ there being four anchor marks already on the Register in the same class, Hall, V.-C., refused to allow another anchor mark to be added to them, notwithstanding that the new mark was sought to be registered for bacon and hams, while those already registered were used for different articles of food, such as biscuits, potted meat, &c., and that it was said to be distinguishable from them all. But the extent of the class is a matter to be considered.⁴ The registration of other marks belonging to the applicant himself would not generally be material to defeat his application, since a trader often desires to register slightly differing marks to distinguish goods which are of different qualities or prices;⁵ but a condition may be required that the trade marks be entered on the Register as associated trade marks.⁶ Of course, the objection referred to in the present paragraph is much more material in the case of a new trade mark than in that of an old one.⁷

Numerous marks of the same kind on the Register.

Similar marks belonging to the applicant.

In some cases, on the other hand, the existence of a number of marks, either as common marks or as trade marks, may operate to render a finer distinction allowable than would

The distinction between the marks may be of a well-known kind.

¹ *Dewhurst's Application*, [1896] 2 Ch. 137; 13 R. P. C. 288.

² Cf. the provision of sec. 43 that in trying a question of infringement the Court shall admit evidence of any trade marks legitimately used in connection with the goods by other persons, above, p. 274, note (1).

³ 11 C. D. 669 (1879); *Thewlis and Blakey's Tm.*, and *Hughes and Young's Tm.*, 10 R. P. C. 369 (1893), North, J.; and see *Orr-Ewing v. The Registrar of Tms.*, 4 App. Ca. 479 (1879). Cf. *Bass, Ratcliff and Gretton's, Ltd.'s Tms.*, [1902], 2 Ch. 579; 19 R. P. C. 129, 529,

where a simple diamond was held to be distinctive notwithstanding the existence of many complex marks including diamonds.

⁴ *König and Ebhardt's Tm.*, [1896] 2 Ch. 286; 13 R. P. C. 449.

⁵ "Series," sec. 26, Chap. V., at p. 118, and per Cotton, L.J., in *Mitchell v. Henry*, 15 C. D. at p. 193 (1880).

⁶ Sec. 24, above, p. 116.

⁷ See Ld. Blackburn's judgment in *The Orr-Ewing* case, 4 App. Ca. 499 (1879); and that of Stirling, J., in *Murphy's Tm.*, 7 R. P. C. p. 166 (1890).

otherwise be the case, for the persons concerned in the trade in question may have had their attention directed to the kind of distinction which exists between the mark propounded and any of the others, because it is analogous to the known distinctions existing between the latter. Thus, in *König and Ebhardt's Trade Mark*¹ the mark applied for included a crown, and the evidence showed that there were twenty-seven marks registered in the same class which consisted of, or included a crown or coronet, but the registration was allowed with a limitation of the goods for which it was registered² and a disclaimer of the crown. And in *Mitchell v. Henry*,³ an action for infringement, the reasoning which led Jessel, M.R., to dismiss an application by the plaintiffs for an interlocutory injunction, was summed up by Cotton, L.J., as follows: "What is claimed by the plaintiffs is a double thread on a white selvage; if that is distinctive, then what the defendants are using, namely a triple thread upon a white selvage, must be a distinctive trade mark, and therefore I cannot restrain the defendants."⁴

Line
headings.

The case just referred to forcibly illustrates the difficulties which led Lord Herschell's Committee to recommend that the line headings woven at the ends of lengths of piece goods should not be admitted as trade marks upon the Register.⁴ As they are all constructed by weaving coloured threads into a narrow strip at the end of the piece, the range of possible variation is very closely limited, while the number of existing headings is extremely great, so that it was considered practically impossible to maintain effective distinctions between them, or to sufficiently identify and describe them on the Register. It is now by the Act of 1905 expressly enacted that a line heading shall not be deemed distinctive or registered alone.⁵

Marks com-
mon to the
trade may be
material in
estimating
resemblance.

The bearing of marks common to the trade upon the distinctiveness of a mark propounded for registration has been already discussed;⁶ but besides affecting the right to registration in that way, the nature and number of the common marks with which it will be associated or contrasted may cause the mark

¹ *König and Ebhardt's Tm.*, [1896] 2 Ch. 296; 13 R. P. C. 449. Cf. also *The Star Tobacco* case, on p. 282.

² See also the judgment of North, J., in *Baker v. Rawson*, 8 R. P. C. at p. 107 (1891).

³ 15 C. D. at p. 194 (1880). The

application of this reasoning to the particular case was disapproved by the C. A.

⁴ Report of 1888, p. ix.

⁵ Sec. 64 (10). See Chap. VII., at p. 133.

⁶ Page 199, above.

propounded to be more or to be less distinguishable from a particular mark than if they did not exist. It is clear, therefore, that the Registrar must have regard to the marks common to the trade in applying sec. 19.¹

5. Where the Opponent's Goods are known by a Name suggested by the Mark.

Where the goods of a particular trader have become known by a name derived from his trade mark,² any other mark which would be likely to suggest the use of the same name for the goods on which it is used, so resembles the former as to be calculated to deceive.

Thus, where the trade mark of the plaintiff was a crown and the word *Seixo*, and his goods had in consequence come to be known in the market as *Crown-Seixo* wine, the defendants were restrained from using marks which led their wine to be described by the same name,³ although evidence was given that *Seixo* was a common word in Portuguese. "The plaintiff," said Lord Cranworth, "had adopted a device or trade mark which had caused his wines to obtain celebrity under a name descriptive of that trade mark. The defendants have adopted a trade mark which could not fail to lead purchasers to attribute to the wines so marked the same name as that under which the plaintiff's wines were known, and so to believe that in purchasing them they would be purchasing the wines of the plaintiff. Against the use of such a trade mark the plaintiff has, I think, a right to have the injunction of this Court." So where a trade mark consisting of the full-length figure of a milkmaid carrying two pails,

Seixo v. Provezende.

The Dairy-maid Milk case.

¹ Per Cotton, L.J., in *Mitchell v. Henry*, 15 C. D. 193 (1880), decided under the Act of 1875.

² A mere surmise that they may have become so known, is not sufficient. *Holbrooks, Ltd.'s Application*, 26 R. P. O. 791 (1909); where the opponents' goods were sold under a name other than that suggested by the applicants' mark. And see *Angus Watson & Co.'s Application*, 28 R. P. C. 313 (1911), Parker, J., where the applicants being the registered owners of the trade mark "Skipper" for sardines, and the opponents of the same word for all other goods in the

same class, including tinned salmon, the applicants sought to register for such goods a label with the word "Sailor" prominently appearing under a picture of a sailor, and the opponents alleged that goods sold under that label would by reason of the applicants' own user of the word "Skipper" for sardines, become known as "Skipper" salmon; on appeal to the Court the opposition was disallowed, the applicants consenting to amend by altering the word "Sailor" to "Sailor Brand."

³ *Seixo v. Provezende*, L. R. 1 Ch. 192 (1866).

one on her head and one in her right hand, with the words *milkmaid brand* above it, was registered for condensed milk, coffee and milk, cocoa and milk, chocolate and milk, and essence of coffee, and the goods upon which it was used were known as the *milkmaid* or *dairymaid* brand, and subsequently another trade mark consisting of a half-length figure of a woman carrying a pail under her right arm, with the words *dairy-maid* at the side of the figure, was registered for butterine and other fatty substances used as food or as ingredients in food, an order was made to rectify the Register by confining the second registration to goods other than those included in the first, and to restrain the use of the second mark upon any of the goods for which the first was registered.¹

The objection is equally strong if the word suggested by the new trade mark, although not the same as a word suggested by the older mark, yet so nearly resembles it, as to be calculated to deceive.²

The cases just cited are cases where the name applied to the opponent's or plaintiff's goods was taken from the device used as a trade mark. The rule applies also to cases where the name is taken from some word or words appearing upon the mark. *The*

¹ *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 C. D. 454; 3 R. P. C. 28 (1886), Kay, J. But cf. *Same v. Pearks, Gunston and Tee, Ltd.*, 20 R. P. C. 509; 21 R. P. C. 261 (1904), Joyce, J., and C. A. *Orr-Ewing v. Johnston*, 13 C. D. 434; 7 App. Ca. 219 (1879), Fry, J., C. A., and H. L. (*Two Elephant Yarn*); *Speer's Tm.*, 4 R. P. C. 521; 55 L. T. 880 (1887), Kay, J. (*Dog, Tower, and Harp Linen*); *Read v. Richardson*, 45 L. T. 54 (1881), C. A. (*Dog Head Beer*); *Baschiera's Tm.*, 33 S. J. 469; 5 T. L. R. 480 (1889), Chitty, J. (*Lion Matches*); *Société Anonyme des Verreries de l'Étoile*, 10 R. P. C. 436; [1894] 1 Ch. 61; 11 R. P. C. 142; [1894] 2 Ch. 26, Stirling, J., and C. A. (*Red Star Glass*); *Wilkinson v. Griffith*, 8 R. P. C. 370 (1891), Romer, J. (*Red Medal Polish*); *Dewhurst's Application*, [1896], 2 Ch. 137; 13 R. P. C. 288, C. A. (*Golden Fan Cotton*); *Currie & Co.'s Application*, 13 R. P. C. 681 (1896), Kekewich, J. (*Cock o' the North Whisky*); the *Cat and*

Barrel cases, and the *Eastern Dye Works* case, cited above, p. 270, are to the same effect. In *Cowie Bros. v. Herbert*, 14 R. P. C. 436 (1897), Court of Session, such a case was set up by the plaintiffs, but failed (*El Musjid*), as also did the plaintiffs in *Lever Bros., Ltd. v. Bedingfield*, 16 R. P. C. 3 (1899), where the plaintiffs had a small picture of a laundry-maid on the label, and the defendant had the words *Red Maid*, and the plaintiffs relied (*inter alia*) on that. See also the *Ship Brand* case, *Price's Patent Candle Co. v. Jeyes' Sanitary Compound Co.*, 19 R. P. C. 17 (1902), compromised on the plaintiffs' appeal. Cf. also *Application of Pomril, Ltd.*, 18 R. P. C. 181 (1901), Joyce, J. (*Apple Brand* cider).

² *E.g.*, *Ancross* for umbrellas in a new mark, was rejected because there were several old anchor marks: *Thewlis and Blakey's Tm.*, 10 R. P. C. 369 (1893), North, J.

Osman Towel case¹ is an illustration of this;² *The Milkmaid* case;³ *The Lion Soap* case;⁴ and *Currie & Co.'s Application*,⁵ already cited, and *Meeus' Application*,⁶ are instances belonging to both classes.

The cases referred to above include instances both of the applicant's (or defendant's) mark containing⁶ and of its suggesting⁷ a word contained in or suggested by the opponent's or plaintiff's mark.

The name given by the public to the goods may be different from that which is given to them by the owner of the goods, but if it is proved that the plaintiff's goods, and his alone, are known by the name given by the public, the Court will protect it.⁸ And in a case where, on an application to register "State-room" in the tobacco class, the opponents, who were the registered proprietors of the trade mark "State Express" registered in the same class, proved that their "State Express" cigarettes were asked for as "State Cigarettes," at any rate, in certain localities, the application to register was refused.⁹ On the other hand, the fact that either the opponents or the applicants sell their goods under a name other than the one said to be suggested by the mark is a material element to be considered.¹⁰

Where the alleged resemblance is put upon the probability of the application of the same name to the goods of both the applicant and the opponent, it is often contended in reply,

Answers to objections founded upon names derived from marks.

¹ *Barlow v. Johnson*, 7 R. P. C. 395, W. N. (1890), 110, C. A.

² So also are *Hodgson and Simpson v. Kynoch, Ltd.*, 15 R. P. C. 465 (1898), Romer, J. (*Lion Soap*), a trade mark and passing-off case, the plaintiff failing as to the former; *Cochrane v. McNish*, [1896] A. C. 225; 13 R. P. C. 100, P. C. (*Club Soda*), infringement and passing-off; *Powell v. Birmingham Vinegar Brewery Co.*, [1897] A. C. 710; 14 R. P. C. 720, passing-off. See also *Application of Pomril, Ltd.*, 18 R. P. C. 181 (1901), Joyce, J. (*Apple Brand*).

³ *Supra*, p. 278, note (1).

⁴ See note (2).

⁵ [1891] 1 Ch. 41; 8 R. P. C. 25 (1890), Chitty, J. (*Key Brand Geneva*).

⁶ *Anglo-Swiss Condensed Milk Co. v. Metcalf*; *La Société Anonyme des Verrieres de l'Étoile*; *Dewhurst's Application*; *Cochrane v. McNish*; *Saxlehner*

v. Apollinaris Co.; *Barlow v. Johnson*; *Meeus' Application*; *Powell v. Birmingham Vinegar Brewery Co.*; all *supra*.

⁷ *Orr-Ewing v. Johnston*; *Speer's Tm.*; *Read v. Richardson*; *Wilkinson v. Griffith*; *Currie's Application*; *Application of Pomril, Ltd.*; above, p. 278, note (1).

⁸ *Orr-Ewing v. Johnston*, 7 App. Ca. 219 (*Two Elephant Yarn*) was of this nature, as well as others of the cases cited above. And see *Fels v. Christopher Thomas & Brothers, Ltd.*, 21 R. P. C. 85 (1904), C. A. (*Naptha Soap*), in which, however, the plaintiffs failed to establish a secondary meaning.

⁹ *United Kingdom Tobacco Co.'s Application*, 29 R. P. C. 489 (1912), Parker, J.

¹⁰ See the cases cited above, p. 277, note (2).

(a) that the name is in fact the name or description of the goods themselves; (b) that it is suggested by words, or devices, comprised in the marks, which are common to the trade, or is itself a word or the name of a mark which is common to the trade; or (c) that the proprietor of the opposing mark is seeking to secure a monopoly in the word under cover of his mark.

(a) Where the name is descriptive of the goods.

(a) The first objection is really included in the second, but may conveniently be stated separately. It is a question of fact whether the name concerned is the name of the goods or of some quality¹ attributed to them, having no reference to the traders by whom they are made or dealt in, or whether it conveys a representation that the goods are made or dealt in by the proprietors of the opposing mark. The question has already been discussed.² All the authorities relevant to it before 1890 were discussed and commented on in *The Osman Towel* case³ by Chitty, J., and the Court of Appeal. As has been shown elsewhere,⁴ where a name was first given by a trader to goods in the manufacture or sale of which he had a monopoly, whether as of right under a patent,⁵ or in fact because he was the first inventor or introducer of the goods,⁶ the Court will more readily

Where the opponent has had a monopoly in the goods.

¹ *E.g.*, excellence: *Arbens' Application*, 35 C. D. 248; 4 R. P. C. 148 (1887), C. A. (*Gem Air-guns*); or size: *Wood v. Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A. (*Eton cigarettes*); or a particular characteristic: *Gramophone Co.'s Application* (1910), 2 Ch. 428; 27 R. P. C. 689, 795, Parker, J., where "gramophone" was held to mean to the public a talking machine with disc records.

² Chap. II., at p. 39; see per Ld. Salborne, in *Singer v. Wilson*, 3 App. Ca. p. 376 (1878).

³ *Barlow v. Johnson*, 7 R. P. C. 395; W. N. (1890), 110.

⁴ Chap. II., at pp. 45 *et seq.*

⁵ *Wheeler & Wilson Co. v. Shakespear*, 39 L. J. Ch. 86 (1869), James, V.-C.; *Linoleum Co. v. Nairn*, 7 C. D. 834 (1878), Fry, J.; and *Palmer's Tm.*, 24 C. D. 504 (1882), Chitty, J., and C. A.; *Slazenger v. Feltham*, 6 R. P. C. 531; 5 T. L. R. 365 (1889), C. A. (*Demon Racquets*) (a case of an invalid patent); *Magnolia Metal Co.'s Tms.*, [1897] 2 Ch. 371; 14 R. P. C. 265 and

621, Kekewich, J., and C. A. (*Magnolia Metal*); *Meaby & Co., Ltd. v. Triticine, Ltd.*, 15 R. P. C. 1 (1897), North, J. (*Triticumina biscuits*); *Formalin Hygienic Co.'s Application*, 17 R. P. C. 486; (1900), Farwell, J. (*Formalin*); *Gestetner's Tm.*, [1907] 2 Ch. 478; [1908] 1 Ch. 518; 24 R. P. C. 545; 25 R. P. C. 156, Neville, J., and C. A.; *Application of E. M. Bowden's Patent Syndicate, Ltd.*, 26 R. P. C. 205 (1909), Neville, J.; and see the "gramophone" case cited above, note (1), which word had at one time designated a patented article.

⁶ *Leonard and Ellis' Tm.*, 26 C. D. 288 (1884), C. A. (*Valvoline*); *Arbens' Application*, 35 C. D. 248; 4 R. P. C. 148 (1887), C. A. (*Gem Air-guns*); *Waterman v. Ayres*, 39 C. D. 29; 5 R. P. C. 868 (1888), C. A. (*Reversi*); *Chesebrough Co.'s Tm.*, [1902] 2 Ch. 1; 18 R. P. C. 191; 19 R. P. C. 342 (*Vaseline*), Buckley, J., and C. A., where, however, Vaseline was held to be a good trade mark.

infer that the name is the name of the goods merely, and that it connotes no connection between them and the trader, and the probability that this is the case is nearly, although not quite, as strong where, in similar circumstances, the public themselves have taken the name from the trader's marks and applied it to the goods. Of course, it is much more difficult to make out that the name has no such connotation if it is not the only name applied to the goods in the market.

If the fact is made out that the name suggested by the marks is merely descriptive, and there is no other resemblance which is calculated to deceive, the second mark is not disentitled to registration. Thus, in *Horsburgh & Co.'s Application*, Leonard and Ellis, in 1873 had adopted, and subsequently registered, a trade mark comprising the word *valvoline*; four years later the applicants sought to register a different mark comprising the word *valvoleum*. The words were held to be substantially the same, and each of them to be descriptive of the valve oil in connection with which both marks were to be used, and Jessel, M.R., allowed the second mark to be registered.¹

Section 44 of the Act of 1905 enacts that no registration under the Act shall interfere (*inter alia*) with the use by any person of any *bonâ fide* description of the character or quality of his goods.²

(b) Where the name is suggested by words or devices which are common to the trade and which occur in the trade mark offered for registration, the words or devices may be required to be disclaimed,³ and, if they form part of the opponent's mark, cannot be, by themselves, relied on to support the opposition;⁴ and, if not disclaimed by him, a disclaimer of them may possibly

(b) Where the name is suggested by matter in the mark common to the trade.

¹ 53 L. J. Ch. 237, n. (1878). The opponents had also registered *Valvoline* alone as a trade mark. It was subsequently removed from the Register; *Leonard and Ellis' Tm.*, 26 C. D. 288 (1884), C. A. *Blair v. Stock*, 52 L. T. 123 (*Strathmore Blend Whisky*); *Loftus' Tm.*, [1894] 1 Ch. 193; 11 R. P. C. 29, North, J. (*Unco' Guid Whisky*).

² The effect of this section has to be considered when an application is made to register a word as "distinctive," see above, p. 190.

³ Sec. 15, Chap. IX., p. 236. Formerly the disclaimer had to be in the application to register, *Meeus' Application*, [1891] 1 Ch. 41; 8 R. P. C. 25,

Chitty, J. (Key Brand Geneva). Cf. *Players' Application*, [1901] 1 Ch. 382; 18 R. P. C. 65, Cozens-Hardy, J.

⁴ *Loftus' Tm.*, above, note 1. An injunction cannot be obtained in respect of disclaimed matter, except in a passing-off action (sec. 45); *Pirie v. Goodall*, [1892] 1 Ch. 35; 9 R. P. C. 17, C. A. (*parchment bank paper*); *Rosenthal v. Reynolds*, [1892] 2 Ch. 301; 9 R. P. C. 189, North, J. (*W. R. Corsets*); *Watt v. O'Hanlon*, 4 R. P. C. 1 (1886), Porter, M.R., an Irish case (*Old Innishowen*); *Hubbuck v. Brown*, 17 R. P. C. 148 and 638 (1900), Kekewich, J., and C. A. See, however, p. 244, above.

The opponent cannot rely on disclaimed matter or words in his mark.

be obtained by an application to rectify the register.¹ The rule may also be applicable if a word or device was at the date of registration saved from disclaimer only by being part of an essential particular, as, for instance, occurring in a distinctive label.² In one case, where there was no disclaimer on the Register, and no application to rectify, North, J., notwithstanding evidence that part of the opponent's registered mark was common to the trade, held that it was used distinctively.³ The presence of the common elements in both marks may be an element in creating a general resemblance between them looked at as wholes.⁴

Where the name is common to the trade.

The Star Tobacco Mark case⁵ is an authority to show that the suggestion both by the mark of the applicant and by that of the opponent of a word which is common to the trade, because it is a name or description for the goods in connection with which both marks are used, is not a sufficient reason for refusing the application to register. There the opponents had registered as an old mark a characteristic eight-pointed star, and also, as a new mark, a label with the star, another device and the word *star*, and they asserted that their goods were frequently sold and ordered as star goods. The applicant's mark consisted of a sea-picture within a ring, having a small six-pointed star in the clouds at the top, and a conspicuously drawn anchor in the lower part of the picture, and the words *star of hope*. The judge found that the device of a star, although not the particular star of the opponents' old mark, was common to the trade, and he allowed the registration. "I think," he said, "that the use of the word *star* and the use of the figure of a star are matters *publici juris*, and have been *publici juris* at all material times, except so far as some particular trader may have appropriated a particular phrase in which *star* is used in some special manner, or may have appropriated a particular design in which the figure of a star has assumed a special form, or has been so combined with other matters as to produce a specific thing different from what may be called the ordinary image of a star."⁶

¹ Secs. 95 and 15. The disclaimer sections of the Act of 1883 were sec. 64 (2) and sec. 74 (2). These were amended by secs. 10 and 16 of the Act of 1888.

² *Semble*, per Romer, L.J., during the argument in *Clement et Cie.'s Tm.*, 16 R. P. C. 611 (1899).

³ *Goodall's Tm.*, 42 C. D. 566 (1889), North, J. (*parchment bank paper*).

⁴ See p. 276.

⁵ *Re Dexter's Application, Re Wills' Tm.*, [1893] 2 Ch. 262; 10 R. P. C. 269, Wright, J.

⁶ As to such exceptions, see above, p. 201.

In *Hubbuck v. Brown*¹ the plaintiffs sought to establish that in certain foreign countries their goods had acquired the name *Dos Leones*, and that the defendant's mark would deceive, but they were in the difficulty that their goods had acquired the name from the presence of the Royal Arms in their mark, and that they could not restrain the use of such Arms by the defendant without setting up a monopoly in them to which they were not entitled.²

(c) The third ground of reply has also been dealt with in several cases, and it is settled that a trader will not be allowed to acquire or use a mark which will probably lead to his goods being mistaken for those of another, even though this may make it difficult for him to truly describe the place of origin of his goods, or to present them to purchasers in the form in which they expect to receive goods of the class.³ Thus, in *Wilkinson v. Griffith*,⁴ an infringement case, Romer, J., in restraining the defendants from using their label, relied upon evidence that the plaintiff's goods were known as red stamp polish from the figures upon his labels, although it was urged on the defendants' behalf that the plaintiff's claim practically involved a claim to a monopoly in red labelled goods. The judge, however, expressly stated that the plaintiff was not entitled to any such monopoly. "I by no means hold, nor do I think the evidence as a whole can fairly be said to establish," he said, "that any red mark on a label of the defendant would render that label deceptive. I can imagine many red marks, or even red medals, being so used to prevent deception." But it is for the applicant for registration of the mark which is alleged to be deceptive to make it clear that such is not the case.

(c) Where the name is said to give a practical monopoly.

The Red Medal Polish case.

Evidence.⁵

It follows that upon any question with respect to the registration of a mark which arises under sec. 19 it is material for the

Evidence material to the question

¹ 17 R. P. C. 148 (1899), Kekewich, J. (*Dos Leones*); affirmed by C. A., 17 R. P. C. 638.

² Cf. also *Phillips v. Ogden*, 12 R. P. C. 325 (1895), Wills, J., a passing-off case, in which both plaintiffs and defendants had the right to use *Guinea Gold* for cigarettes, and otherwise the boxes were sufficiently distinguished.

³ *Wotherspoon v. Currie*, L. R. 5 H. L. 508 (1872) (*Glenfield Starch*); *Montgomery v. Thompson*, [1891] A. C. 217;

8 R. P. C. 361 (*Stone Ales*). It is to be noted, however, that these were both cases of attempted frauds. *Johnston v. Orr-Ewing*, 7 App. Ca. 219 (1892), H. L. (*Two Elephant Yarns*). See also the last paragraph.

⁴ 8 R. P. C. 370 (1891), Romer, J. (*Red Stamp Polish*).

⁵ As to the evidence upon applications to register generally, see Chap. IV., at pp. 104 and 105.

of resom-
blance.

tribunal to be furnished with evidence of the matters of fact involved in the propositions stated above wherever it is alleged that they tend to increase or diminish the resemblance referred to in the sub-section.

Expert
evidence as to
probability
of deception.

Besides this evidence, the evidence of persons who are well acquainted with the trade concerned was formerly constantly tendered by the parties to show that in the opinion of such persons, as experts, the alleged resemblance between the contrasted marks was, or was not, calculated to deceive, and it was formerly constantly admitted,¹ although judges often expressed much impatience of evidence of this class,² and certainly it frequently presents in an eminent degree the characteristic vices of expert testimony. It consists in general of opinions formed after the dispute has arisen; not upon any judicial balance of the opposing contentions, but upon a scrutiny of the subject directed to discover what can be said in favour of one side only. And where the question is as to the degree of a resemblance between two words or designs, or as to whether a difference in particular parts of two contrasted labels is substantial or immaterial, reasons can rarely be found by the witnesses to recommend an opinion to anyone who has not conceived it for himself without their assistance. Since the decision of the House of Lords in *North Cheshire Brewery Co. v. Manchester Brewery Co.*³ judges have in many cases refused to allow to be put to a witness, or have disapproved the question whether the public would be or would be likely to be deceived.⁴ In that case Lord Halsbury, L.C., said: "Is this name so nearly resembling the name of another firm as to be likely to deceive?"

¹ For instance, in *Johnston v. Orr-Ewing*, cited above, p. 283, note (3), Ld. Selborne, in his judgment at p. 226, referred to evidence given in that case, that deception would be liable to occur at all events with the more ignorant classes of customers, particularly in the up-country districts (in India).

² *Re Jelley*, 51 L. J. Ch. 639, n., Jessel, M.R. (1878); *Pinto v. Badman*, 8 R. P. C. 181 (1891), C. A.

³ [1899] A. C. 83 (a trade name case).

⁴ *Alaska Packers' Association v. Crooks & Co.*, 18 R. P. C. 129 (1900), Kekewich, J.; *Hennessy v. Dompér*, 19 R. P. C. 333,

at p. 339, Kekewich, J. (1902); *Lambert and Butler v. Goodbody*, 19 R. P. C. 377 (1902), Farwell, J.; *Bourne v. Swan and Edgar, Ltd.*, [1903] 1 Ch. 211; 20 R. P. C. 105, Farwell, J.; *Fairbank Co. v. Cocos Butter Manufacturing Co.*, 21 R. P. C. 23, at p. 26 (1904), Swinfen Eady, J. See also *Hennessy v. Keating*, 24 R. P. C. 485, 25 R. P. C. 125, 361 (1907), Porter, M.R., and C. A., Ireland, and H. L.; and *Royal Warrant Holders' Association v. Deane*, 28 R. P. C. 721, at p. 725 (1911), Warrington, J. But a witness may be asked whether he himself would be deceived, see below, p. 286.

That is a question upon which evidence, of course, might be given as to whether or not there was another brewery either in the one place or in the other, or whether there were several breweries nearly resembling it in name; what the state of the trade was, and whether there was any trade name. All those are matters which are proper to be dealt with upon evidence; but upon the one question which your Lordships have to decide, whether the one name is so nearly resembling another as to be calculated to deceive, I am of opinion that no witness would be entitled to say that, and for this reason: that that is the very question which your Lordships have to try." And in *Payton & Co., Ltd. v. Snelling, Lampard & Co., Ltd.*,¹ Lord Macnaghten, commenting on the evidence and on questions having been put to witnesses whether a person going into a shop as a customer would be deceived, said: "But that is not a matter for the witness; it is a matter for the judge. The judge, looking at the exhibits before him, and also paying the attention to the evidence adduced, must not surrender his own independent judgment to any witness whatever." The question of evidence as to probability of deception in such cases subsequently came before the Court of Appeal in *London General Omnibus Co. v. Larrell*.² In that case Farwell, J., who tried the case, had after a view of the rival omnibuses arrived at the conclusion that there was a resemblance intentionally designed and that the ordinary user of omnibuses would very probably be deceived, but no evidence was given of actual deception, and only the secretary of the company and a painter of their omnibuses were called as to the probability of deception. In allowing the defendant's appeal, the Court pointed out that there were considerable differences in the two omnibuses, and that, with the exception of one alteration made about five years before the trial, the defendant's omnibus had been running without alteration for ten years, and it held that the evidence for the plaintiffs was insufficient to prove probability of deception. In commenting on the lack of evidence, the members of the Court referred to the Court being required to make an assumption as to the habits of people travelling in omnibuses and of such matters, of the absence of evidence by persons in the habit of using omnibuses, and by officers of the company in the habit of checking the user of omnibuses and seeing passengers as they

¹ 17 R. P. C. 628 (alleged passing-off by got-up); the passage referred to is at p. 635.
² [1901] 1 Ch. 135; 18 R. P. C. 74.

got in and out, and hearing complaints of deception. This decision has been the subject of considerable discussion in some subsequent cases,¹ but it is to be noticed that none of the members of the Court of Appeal intimated that a witness could be asked directly whether the defendant's omnibus would be calculated to deceive, and, as already stated, such a question, at all events if objected to, has in recent cases been disallowed. Expert evidence as to the circumstances usually attending the sale of the goods in the particular trade, and as to the ordinary class of customers served, their intelligence and education, what they particularly look for in purchasing the plaintiff's goods, and, if the goods are sold abroad, their knowledge of the meaning of English words in the marks, and such like matters, is no doubt admissible.² The judge must in the end act upon his own view on a comparison of the marks, having regard to the matters of fact referred to above. To quote a recent authority, in *Schweppes, Ltd. v. Gibbens*,³ Warrington, J., whose judgment was approved by the majority of the Court of Appeal and by the House of Lords, said: "It seems to me that each of these cases must be looked at by itself, and the judge looking at the label, or the get-up, or the device, whatever it may be that is complained of, with such assistance as to the practice of the trade as he can get from witnesses, must decide for himself whether the article complained of is calculated to deceive or not."

But a witness may be asked whether he himself would be deceived,⁴ but as pointed out by Farwell, J., it is extremely

¹ Particularly in *Bourne v. Swan and Edgar, Ltd.*, [1903] 1 Ch. 211; 20 R. P. C. 105. Farwell, J., in this case refers to the omnibus case as having been treated as a common law action of deceit. This is no doubt the phrase used in the Court of Appeal, but it is the name generally applied to an action brought by the person deceived himself, in which sense, of course, it could not have been used. It is difficult to see in what respects the action differed from an ordinary action for passing-off.

² See *Hubbuck v. Brown*, 17 R. P. C. 148 (1900), Kekewich, J., as an instance of a case in which some evidence of this nature was given.

³ 22 R. P. C. 113, 601 (1905). The passage quoted above is also quoted in

Hennessy v. Keating, cited p. 284, note (4), in which the same result appears to have been arrived at, at all events in the House of Lords. The question is to be decided partly by the judge's eyesight, and partly by his view of the evidence: *Farrow's Tm.*, 7 R. P. C. 260; 63 L. T. 233 (1890), Stirling, J. See, however, *Mitchell v. Henry*, 15 O. D. at p. 195 (1880); and *Christiansen's Tm.*, 3 R. P. C. 54 (1885), Chitty, J., and C. A.

⁴ *Bourne v. Swan and Edgar, Ltd.*, [1903], 1 Ch. 211; 20 R. P. C. 105; *Claudius Ash, Sons & Co., Ltd. v. Invicta Manufacturing Co., Ltd.*, 28 R. P. C. 252, and 597; 29 R. P. C. 465, especially the judgment of Buckley, L.J., 28 R. P. C. at p. 608; and of Earl Loreburn, L.C., 29 R. P. C. at p. 475. *Royal*

difficult to get any such evidence on behalf of a plaintiff.¹ Trade witnesses would not usually be deceived except in a case of grossly fraudulent imitation. Evidence of ordinary members of the public who are not acquainted with the usages of the trade involved, that they think they would or would not be deceived by the resemblance of one mark to another, is of little assistance in the determination of questions of alleged deceptive similarity.²

Direct evidence of probability of deception.

If one or more cases of actual deception are made out to the satisfaction of the Court, this will, of course, afford very strong evidence that the resemblance of the marks in question is so close as to be calculated to deceive. But the absence of evidence of actual deception is a circumstance which varies greatly in weight according to the nature of the case. It is conceived that it can never be conclusive by itself;³ but where the marks have been circulating side by side in the market where deception is alleged to be probable, the fact that no one appears to have been misled is very material,⁴ unless the absence of such evidence is satisfactorily explained by the difficulty of procuring witnesses from a distant foreign market,⁵ or otherwise. On the other hand, if one or both of the marks is new or nearly new, there

Evidence of actual deception.

Warrant Holders' Association v. Deane, [1912] 1 Ch. 10, 29 R. P. C. 721 at p. 725, Warrington, J., where in an action for an injunction to restrain the defendant from using the Royal Arms, the following question was allowed to be put to a witness, namely:—"What was the conclusion in your mind from the fact that the defendants exhibited the Royal Arms on their business premises?"

¹ *Bourne v. Swan and Edgar, Ltd.*, cited above, p. 286, note (4).

² See *Kutnow's Tm.*, 10 R. P. C. 401 (1893), North, J. (*Carlsbad Salts*), and note (4) p. 284, supra. In *Turton v. Turton*, Fry, L.J., compared this evidence to the oaths of compurgators in a mediæval trial: 45 C. D. at p. 149.

³ *Edelsten v. Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, L.C.; *Compania General de Tabacos v. Rehder*, 5 R. P. C. 61 (1887), Kay, J.; *Reddaway & Co. v. Bentham Hemp Spinning Co.*, [1892] 2 Q. B. 639; 9 R. P. C. 503, C. A.; *Paine & Co. v. Daniell & Sons' Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 217, C. A.

⁴ *Cope v. Evans*, 18 L. R. Eq. 138 (1874), Hall, V.-C.; *Rodgers v. Rodgers*, 31 L. T. 285 (1874), Mellish, L.J.; *Estcourt v. The Estcourt Hop Essence Co.*, L. R. 10 Ch. 276 (1875), C. A.; *Lambert's Tm.*, 5 R. P. C. 556; 61 L. T. 138 (1888), North, J.; and *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. at p. 107 (1889), North, J.; *Talbot's Tm.*, 11 R. P. C. 77 (1894); *Phillips v. Ogden*, 12 R. P. C. 325 (1895), Wills, J.; but see *Liebig's Extract of Meat Co. v. Chemists' Co-operative Society*, 13 R. P. C. 635, 736 (1896), Kekowich, J., and C. A. In *Carborundum Co.'s Application*, 26 R. P. C. 504 (1909), Joyce, J., ordered an application to proceed partly on the ground that the applicants had used their mark for a considerable time. Also *Holbrooks, Ltd.'s Application*, 26 R. P. C. 791 (1909), Joyce, J.

⁵ *Wilkinson v. Griffith*, 8 R. P. C. 370 (1891), Romer, J. In *Cowin v. Herbert*, 14 R. P. C. 436 (1897), the Scotch Court of Session commented on the absence of such evidence.