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THE

LAW OF TRADE MARKS

AND THEIR REGISTRATION,
AND MATTERS CONNECTED THEREWITH;

INCLUDING

A CHAPTER ON GOODWILL.

TOGETHER

With Appendices

CONTAINING

PRECEDENTS OF INJUNCTIONS, ETC.;

THE TRADE MARKS REGISTRATION ACTS, 1875-7,
AND THE RULES AND INSTRUCTIONS THEREUNDER;

THE MERCHANDISE MARKS ACT, 1862,
AND OTHER STATUTORY ENACTMENTS;

THE UNITED STATES STATUTE, 1870,
AND THE TREATY WITH THE UNITED STATES, 1877.

WITH A COPIOUS INDEX.

BY

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TO

THE RIGHT HON. SIR GEORGE JESSEL,

MASTER OF THE ROLLS,

THE

Following Work

IS,

BY PERMISSION,

MOST RESPECTFULLY DEDICATED.

P R E F A C E.

IN this book an attempt is made to present a complete view of the Law of Trade Marks in this country. It is hoped that it may at least be found to be of some service to those who have to consider the numerous questions which are now constantly arising in connexion with that branch of Law.

Where practicable, the *ipsissima verba* of the various learned judges who decided the cases to which reference is made are given, as it is thought that their views are best expressed in the language they themselves advisedly employed. Where the same case, as frequently happens, is reported in several places, the version quoted is that which appears in the report of most authority. Two references are given for the same case only where the one report supplements the other. The cases cited are brought down to March, 1878, in order to effect which some cases have had to be quoted which are not as yet reported in the books; in such instances the quotations are usually made from the *Times* reports.

A considerable number of American cases have been cited, containing the decisions of acute and practised lawyers, delivered after full consideration of English as well as American authorities. Such decisions are, it is admitted, "intrinsically entitled to the highest respect" (a); and though they are, of course, not in

(a) Per Patteson, J., in *Beverley v. Lincoln Gas Light and Coke Co.*, 6 Ad. & E. 829-37; and see per V.-C. Bacon, in *Dawson v. Bank of Whitehaven*, L. R. 4 Ch. D. 639-48.

any way binding upon British Courts, it may reasonably be anticipated that English judges will in similar circumstances arrive at similar conclusions with the Courts of the United States. The American cases have generally been cited from the "Reports of Trade Mark Cases" (a), by Mr. ROWLAND COX, or, in the more recent instances, from the "American Reports" (b).

The Author's thanks are due to Mr. T. W. H. DAVIES, of the Trade Marks Registry Office, who most kindly gave his assistance in the revision of Appendix B, containing the recent Registration Acts, Rules, and Instructions.

In explanation of the considerable list of Addenda, and of the supernumerary pages in Appendix B, it may be mentioned that the book was in print before the end of November last, but has been kept back to await the re-issue, in an enlarged shape, of the Rules and Instructions, which was then in contemplation and has now been effected. The case of *Singer Manufacturing Co. v. Wilson*, in the House of Lords (p. xxxiv., *infra*), demands special attention.

L. B. S.

2, NEW SQUARE, LINCOLN'S INN,
March 1st, 1878.

(a) Robert Clarke & Co., Cincinnati, 1871. (b) J. D. Parsons, Albany.

TABLE OF CONTENTS.

CHAPTER I.

	PAGE
General Introduction	1

CHAPTER II.

What is a Trade Mark?	14
---------------------------------	----

CHAPTER III.

Acquisition, Transfer, and Discontinuance of Trade Marks	47
--------------------------------------------------------------------	----

CHAPTER IV.

Infringement	67
------------------------	----

CHAPTER V.

The Criminal Prosecution	82
------------------------------------	----

CHAPTER VI.

The Civil Remedy. I.	93
------------------------------	----

CHAPTER VII.

The Civil Remedy. II. Defences, Discovery and Inspection, Account, Damages, Costs	121
---------------------------------------------------------------------------------------------	-----

CHAPTER VIII.

Cases Analogous to those of Trade Mark	149
--------------------------------------------------	-----

CHAPTER IX.

Goodwill	180
--------------------	-----

APPENDIX A.

	PAGE
Precedents of Injunctions, &c.	203

APPENDIX B.

The Trade Marks Registration Acts and Rules	214
-------------------------------------------------------	-----

APPENDIX C.

Statutory Enactments with respect to Marks on Goods, &c.	277
------------------------------------------------------------------	-----

APPENDIX D.

Statutory Enactments with respect to Marks on Special Classes of Goods	291
-------------------------------------------------------------------------------------	-----

APPENDIX E.

The United States Statute, 1870	311
-------------------------------------------	-----

APPENDIX F.

The Treaty with the United States, 1877	314
---------------------------------------------------	-----

TABLE OF CASES.

American Cases are distinguished by an asterisk.

Name of Case.	Court.	Where reported.	Page where cited.
ABBOTT <i>v.</i> Bakers and Confectioners' Tea Association	V.-C. M. L. C.	W. N. 1871, p. 207 ; <i>Ib.</i> 1872, p. 31	... 75, 77
Ainsworth <i>v.</i> Bentley ...	V.-C. W.	14 W. R. 630;	118, 164, 208
Ainsworth <i>v.</i> Walmsley ...	V.-C. W.	L. R. 1 Eq. 518	6, 21, 23, 45, 51, 58, 72, 80, 118, 145, 215
Albert (Prince) <i>v.</i> Strange	V.-C. K.-B. L. C.	2 De G. & Sm. 652 ;	... 176, 208
Allsopp <i>v.</i> Walker ...	M. R. April 10, 1877	1 Mac. & G. 25 —	28, 217, 229, 234
Allsopp <i>v.</i> Wheatcroft ...	V.-C. Wick.	L. R. 15 Eq. 59	... 177
*Amoskeag Manufacturing Co. <i>v.</i> Garnier	Sup. Ct. of N. Y.	55 Barb. 151; R. Cox, 541	3, 42, 51, 112, 124
*Amoskeag Manufacturing Co. <i>v.</i> Spear	Sup. Ct. of City of N. Y.	2 Sandf. S. C. 599; R. Cox, 87	... 36, 79
Anglo - Swiss Condensed Milk Co. <i>v.</i> Swiss Condensed Milk Co.	V.-C. M.	W. N. 1871, p. 163	76, 127, 174
Ansell <i>v.</i> Gaubert ...	V.-C. W.	Seton, 4th ed. 235	... 178, 209
Apollinaris Co. <i>v.</i> Edwards	V.-C. B.	Seton, 4th ed. 237	3, 42, 107, 205
Apollinaris Co. <i>v.</i> Norrish	V.-C. B.	33 L. T. N. S. 242	3, 42, 77, 103, 205
Archbold <i>v.</i> Sweet...	K. B.	1 M. & Rob. 162	76, 162, 163
Attorney-General <i>v.</i> Sheffield Gas Consumers' Co.	L. JJ.	3 De G. M. & G. 327	... 124, 126
Aubin <i>v.</i> Holt ...	V.-C. W.	2 K. & J. 66	... 185, 198
Austen <i>v.</i> Boys ...	L. C.	27 L. J. Ch. 714	183, 184, 186, 201
BANKS <i>v.</i> Gibson ...	M. R.	34 Beav. 566	60, 61, 156, 187, 188, 190, 193, 194, 195, 198, 199
Barnard <i>v.</i> Pillow ...	M. R.	W. N. 1868, p. 94	... 76, 163
Barnett <i>v.</i> Leuchars ...	V.-C. S.	13 L. T. N. S. 495	37, 80, 84, 103, 114, 141
Barrows, <i>Ex parte</i> ...	M. R.	W. N. 1877, p. 119; L. J. Notes of Cas. 1877, p. 110	215, 217, 229

TABLE OF CASES.

Name of Case.	Court.	Where reported.	Page where cited.
Barrows, <i>In re</i>	V.-C. M. Ct. of App.	L. R. 5 Ch. D. 353	2, 16, 34, 45, 101, 214, 217, 221, 223, 235, 239, 259
*Barrows <i>v.</i> Knight	Sup. Ct. of Rhode Is- land	6 R. I. 434 ; R. Cox, 238 24
Bass <i>v.</i> Dawber	M. R.	19 L. T. N. S. 626	28, 70, 75, 107, 108, 144, 145
*Batchellors <i>v.</i> Batchellor... Batty <i>v.</i> Hill	Vermont V.-C. W.	12 Amer. Rep. 414, n. 1 H. & M. 264 153 5, 6, 35, 114, 221
Baxter <i>v.</i> Connolly	L. C.	1 Jac. & W. 580 189
Beard <i>v.</i> Turner	V.-C. W.	13 L. T. N. S. 746	29, 124, 127, 141
Bell <i>v.</i> Bell... ..	V.-C. B. Aug. 1, 1876	— 28, 78
*Bell <i>v.</i> Locke	Chancery of N. Y.	8 Paige, 75 ; R. Cox, 11 75, 170
Beverley <i>v.</i> Lincoln Light and Coke Co.	Gas K. B.	6 Ad. & E. 829 v
*Binniger <i>v.</i> Wattles	C. P. of City of N.Y.	28 How. Pr. R. 206 ; R. Cox, 318	... 35, 77, 153
Blackwell <i>v.</i> Crabb	V.-C. W.	36 L. J. Ch. 504	28, 38, 75, 77, 121
Blanchard <i>v.</i> Hill	L. C.	2 Atk. 484	4, 69, 100, 102
Blofeld <i>v.</i> Payne	K. B.	4 B. & Ad. 410	99, 136, 143
*Bloss <i>v.</i> Bloomer	Sup. Ct. of City of N. Y.	23 Barb. 604 ; R. Cox, 200	118, 124, 130
*Boardman <i>v.</i> Meriden Britannia Co.	Sup. Ct. of Conn.	35 Conn. 402 ; R. Cox, 490	... 38, 46, 79
Bond <i>v.</i> Milbourn	V.-C. B.	20 W. R. 197	60, 156, 188, 190, 193, 199
Boulnois <i>v.</i> Peake	V.-C. G.	W. N. 1868, p. 95	151, 154, 159
Bozon <i>v.</i> Farlow	M. R.	1 Mer. 459	... 184, 189
Bradbury <i>v.</i> Beeton	V.-C. M.	39 L. J. Ch. 57	... 103, 170
Bradbury <i>v.</i> Dickens	M. R.	27 Beav. 53	60, 171, 188, 189, 194, 197, 200
*Bradley <i>v.</i> Norton	Sup. Ct. of Conn.	33 Conn. 157 ; R. Cox, 331	... 24, 79, 103
Braham <i>v.</i> Bustard	V.-C. W.	1 H. & M. 447	2, 5, 16, 32, 36, 39, 64, 111, 122, 205
Broadhurst <i>v.</i> Barlow	V.-C. Wick.	W. N. 1872, p. 212 ; L. J. Notes of Cases, 1872, p. 183	... 40, 204
Brook <i>v.</i> Evans	V.-C. S.	2 L. T. N. S. 740	.. 145, 166
*Brooklyn White Lead Co. <i>v.</i> Masury	Sup. Ct. of N. Y.	25 Barb. 416 ; R. Cox, 210	... 76, 153
Broughton <i>v.</i> Broughton	M. R.	44 L. J. Ch. 526 198
Brown <i>v.</i> De Tastet	L. C.	Jac. 284 196
Browne <i>v.</i> Freeman (1)	V.-C. W.	12 W. R. 305	7, 18, 35, 37, 65, 173
Browne <i>v.</i> Freeman (2)	L. JJ.	W. N. 1873, p. 178	64, 65, 161, 173
Bryson <i>v.</i> Whitehead	V.-C. of E.	1 S. & S. 74	177, 187, 189, 192
Bullock <i>v.</i> Chapman	V.-C. K.-B.	2 De G. & Sm. 211	... 166, 193
Bunn <i>v.</i> Guy	K. B.	4 East, 190	180, 184, 185, 189

TABLE OF CASES.

xi

Name of Case.	Court.	Where reported.	Page where cited.
Burfield v. Rouch ...	M. R.	31 Beav. 241	... 195
Burgess v. Burgess ..	V.-C. K. L. JJ.	3 De G. M. & G. 89	19, 20, 23, 40, 72, 110, 124, 130, 153, 154, 158, 190
Burgess v. Hately ...	M. R.	26 Beav. 249	... 146, 147
Burgess v. Hills ...	M. R.	26 Beav. 244	70, 103, 135, 146
*Burke v. Cassin ...	Sup. Ct. of Cal.	45 Cal. 467; 13 Amer. Rep. 204	24, 35, 36, 64, 79
*Burnett v. Phalon ...	Ct. of App. of N. Y.	9 Bos. 192; R. Cox, 376	... 37, 78, 103
Burrows v. Foster ...	L. JJ.	Seton, 4th ed. 257	155, 157, 200, 211, 212
Bury v. Bedford ...	M. R. L. JJ.	32 L. J. Ch. 741 33 L. J. Ch. 465	23, 56, 57, 58, 59, 292
Byron (Ld.) v. Johnston ...	L. C.	2 Mer. 29	... 162, 164
CAMPBELL v. Hollins ...	H. L., April 26, 1877	—	... 154
*Canal Co. v. Clark ...	Sup. Ct. U. S.	13 Wallace, 311	... 43
*Candee, Swan & Co. v. Deere	Sup. Ct. of Ill.	54 Ill. 439; 5 Amer. Rep. 125	... 36, 43
Canham v. Jones ...	V.-C. of E.	2 V. & B. 218	69, 102, 177, 178
Carnrick v. Morson ...	V.-C. B.	L. J. Notes of Cases, 1877, p. 71	... 37, 78
Cartier v. Carlile ...	M. R.	31 Beav. 292	9, 28, 45, 65, 70, 75, 103, 107, 135, 140, 141, 142, 143
Cartier v. May ...	V.-C. W. July 12, 1861	—	... 110
Carver v. Pinto Leite ...	L. JJ.	L. R. 7 Ch. 90	... 138
*Caswell v. Davis ...	C. P. of City of N. Y.	4 Abb. Pr. R. N. S. 6; R. Cox, 429; Ct. of App. of N. Y. 13 Sickels, 223	... 35
Cave v. Myers ...	V.-C. G.	Seton, 4th ed. 238	... 159, 211
Chappell v. Davidson ...	V.-C. W.	2 K. & J. 123	68, 99, 144, 147, 171
Chappell v. Sheard ...	V.-C. W.	2 K. & J. 117	124, 171, 209
Cheavin v. Walker ...	V.-C. B. Ct. of App.	L. R. 5 Ch. D. 850	10, 34, 38, 72, 103, 133, 143, 174
Chissum v. Dewes ...	M. R.	5 Russ. 29	... 182, 187
*Choynski v. Cohen ...	Sup. Ct. of Cal.	39 Cal. 501; R. Cox, 593	... 160
Christie v. Christie ...	V.-C. M. L. C. & L. J. M.	W. N. 1873, p. 8; <i>Ib.</i> p. 70	108, 154, 155
*Christy v. Murphy ...	Sup. Ct. of N. Y.	12 How. Pr. R. 77; R. Cox, 164	... 153
Chubb v. Griffiths ...	M. R.	35 Beav. 127	108, 136, 147
Churton v. Douglas ...	V.-C. W.	Johns. 174	55, 56, 58, 130, 150, 151, 153, 154, 155, 157, 180, 181, 182, 183, 186, 188, 189, 190, 191, 193, 194, 198, 199, 215

Name of Case.	Court.	Where reported.	Page where cited.
*Clark v. Clark	Sup. Ct. of N. Y.	25 Barb. 76 ; R. Cox, 206	76, 103
Clark v. Freeman	M. R.	11 Beav. 112	114, 161, 163
Clark v. Leach	M. R.	32 Beav. 14	156, 157, 191, 193, 195, 199, 200
Clegg v. Edmonton	L. JJ.	8 De G. M. & G. 810	126
Clement v. Maddick	V.-C. S.	1 Giff. 98	70, 103, 169, 171, 207
Clover v. Royden	V.-C. M.	L. R. 17 Eq. 190	166
Clowes v. Hogg	V.-C. M. L. JJ.	W. N. 1870, p. 268 ; W. N. 1871, p. 40	118, 127, 168, 171
*Coats v. Holbrook	Chancery of N. Y.	2 Sandf. 686 ; R. Cox, 20	48, 115, 136, 137, 146, 147
Cocks v. Chandler	M. R.	L. R. 11 Eq. 446	28, 35, 127, 173
*Coffeen v. Brunton (1)	U. S. Circ. Ct.	4 McLean, 516 ; R. Cox, 82	10, 79, 99, 137
*Coffeen v. Brunton (2)	U. S. Circ. Ct.	5 McLean, 256 ; R. Cox, 132	113, 136, 137
Colburn v. Simms	V.-C. Wigr.	2 Hare, 560	146
Coles v. Sims	L. JJ.	5 De G. M. & G. 1	124
*Colladay v. Baird... ..	C. P. of Co. of Phila.	4 Phila. 139 ; R. Cox, 257	51, 75
Collins Co. v. Brown	V.-C. W.	3 K. & J. 423	23, 24, 48, 49, 103, 225
Collins Co. v. Cowen	V.-C. W.	3 K. & J. 428	11, 24, 47, 69, 103, 225
Collins Co. v. Reeves	V.-C. S.	28 L. J. Ch. 56	48, 103
Collins Co. v. Walker	V.-C. K.	7 W. R. 222	48, 109, 144, 146, 205
Colonial Life Assurance Co. v. Home and Colonial Assurance Co.	M. R.	33 Beav. 548	151
*Colton v. Thomas	C. P. of Co. of Phila.	2 Brews. 308 ; R. Cox, 507	75, 76, 158, 173
*Comstock v. White	Sup. Ct. of N. Y.	18 How. Pr. R. 421 ; R. Cox, 232	10, 129
Condy v. Mitchell. See Mit- chell v. Condy.			
*Congress & Empire Spring Co. v. High Rock Congress Spring Co.	Ct. of App. of N. Y.	57 Barb. 526 ; R. Cox, 599	3, 42, 55, 180
Cook v. Collingridge	L. C.	Jac. 607	196, 199
Cooper v. Hood	M. R.	26 Beav. 293	180, 187, 188, 189, 192, 215
Cooper v. Watson	K. B.	3 Doug. 414	137, 192
Cope v. Evans	V.-C. H.	L. R. 18 Eq. 138 ; 30 L. T. N. S. 292	39, 49, 71, 75, 105, 107, 137
Corns v. Griffiths	V.-C. M.	W. N. 1873, p. 93 ; Pemb. 2nd ed. 308	170, 207
Correspondent Newspaper Co. v. Saunders	V.-C. W.	11 Jur. N. S. 540	11, 171, 172
*Corwin v. Daly	Sup. Ct. of City of N. Y.	7 Bos. 222 ; R. Cox, 265	35
Cory v. Gertcken	V.-C. of E.	2 Madd. 49	136, 147
Coslake v. Till	M. R.	1 Russ. 376	187, 189
Cotton v. Gillard	M. R.	44 L. J. Ch. 90	7, 28, 37, 55, 59, 63, 113, 124, 178, 181, 215

TABLE OF CASES.

xiii

Name of Case.	Court.	Where reported.	Page where cited.
Cox v. Land and Water Journal Co.	V.-C. M.	L. R. 9 Eq. 324	... 109
Crawshay v. Collins ...	L. C.	15 Ves. 227	... 196, 197
Crawshay v. Thompson ...	C. P.	4 Man. & G. 357	27, 44, 67, 68, 96, 97, 121
Croft v. Day ...	M. R.	7 Beav. 84 ; 28 Leg. Obs. 378	61, 69, 72, 74, 103, 110, 155, 203
Crookes v. Petter ...	M. R.	6 Jur. N. S. 1131	... 165
Cruttwell v. Lye ...	L. C.	17 Ves. 335	151, 155, 182, 188, 190
*Curtis v. Bryan ...	C. P. of City of N. Y.	2 Daly, 212 ; R. Cox, 434	24, 40, 130
DAKIN v. Cope ...	L. C.	2 Russ. 170	... 187
*Dale v. Smithson ...	C. P. of City of N. Y.	12 Abb. Pr. R. 237 ; R. Cox, 282	... 103, 130
Darbey v. Whitaker ...	V.-C. K.	4 Dr. 139	... 186, 189
Davies v. Hodgson ...	M. R.	25 Beav. 177	... 187, 199
*Davis v. Kendall ...	Sup. Ct. of Rhode I.	2 R. I. 566 ; R. Cox, 112	10, 79, 103, 137
Davis v. Tylor ...	M. R. July 27, 1877	—	... 109
Dawson v. Bank of Whitehaven	V.-C. B.	L. R. 4 Ch. D. 639	... v
Day v. Binning ...	V.-C. of E.	C. P. Cooper, 489 ; 1 Leg. Obs. 205	5, 100, 173
*Dayton v. Wilkes ...	Sup. Ct. of City of N. Y.	18 How. Pr. R. 510 ; R. Cox, 224	171, 188, 194, 197
Del Valle v. Mayer ...	V.-C. J.	Seton, 4th ed. 236	... 116, 206
Delondre v. Shaw ...	V.-C. of E.	2 Sim. 237	114, 141, 164
Dence v. Mason (1) ...	V.-C. M.	W. N. 1877, p. 23	110, 155, 156, 193, 199
Dence v. Mason (2) ...	V.-C. M. Aug. 8, 1877	—	... 110
Dent v. Turpin ...	V.-C. W.	2 J. & H. 139	24, 35, 61, 107, 113, 142, 193
*Derringer v. Plate ...	Sup. Ct. of Cal.	29 Cal. 292 ; R. Cox, 325	11, 24, 56, 103, 181
Dixon v. Fawcus ...	Q. B.	3 Ll. & Ell. 537	23, 24, 70, 96, 98, 143
Dixon v. Holden ...	V.-C. M.	L. R. 7 Eq. 488	... 166
Dixon v. Jackson ...	Ct. of Sess.	Ct. of Sess. Cas. 3rd Ser. V. 326	... 49, 71
*Dixon Crucible Co. v. Guggenheim	C. P. of Co. of Phila.	2 Brews. 321 ; R. Cox, 559	7, 56, 75, 76, 103, 159, 180, 181
Du Boulay v. Du Boulay ...	P. C.	L. R. 2 P. C. 441	... 150
EDELSTEN v. Edelsten ...	L. C.	1 De G. J. & S. 185	9, 28, 65, 70, 77, 95, 103, 104, 107, 121, 135, 136, 137, 141, 142, 143, 144, 205
Edelsten v. Vick ...	V.-C. W.	11 Hare, 78	49, 69, 87, 103, 122, 128, 132, 133, 174, 205

Name of Case.	Court.	Where reported.	Page where cited.
Edgington v. Edgington ...	V.-C. W.	11 L. T. N. S. 299	.. 145, 155
Edmonds v. Benbow ...	V.-C. of E.	Seton, 3rd ed. 905	... 170, 207
Emperor of Austria v. Day	V.-C. S.	2 Giff. 628 ;	103, 161, 176,
	L. C. & L. JJ.	3 De G. F. & J. 217	209
England v. Downs ...	M. R.	6 Beav. 269	... 182, 189
Estcourt v. Estcourt Hop Essence Co.	L. C. & L. JJ.	L. R. 10 Ch. 276	124, 126, 130, 177, 178, 179
Evans v. Hughes ...	V.-C. W.	18 Jur. 691	... 194, 201
*FABER v. Faber ...	Sup. Ct. of N. Y.	49 Barb. 357 ; R. Cox, 401	... 19, 24
*Falkinburg v. Lucy ...	Sup. Ct. of Cal.	35 Cal. 52 ; R. Cox, 448	... 10, 75
Farina v. Cathery ...	V.-C. W.	L. J. Notes of Cases, 1867, p. 134	11, 71, 109, 115
Farina v. Gebhardt ...	V.-C. W.	3 Eq. Rep. 891	... 124
Farina v. Shaw ...	V.-C. P.	1 K. & J. 512 ; 3 Eq. Rep. 886	... 116
Farina v. Silverlock ...	V. C. W. L. C. V.-C. W.	1 K. & J. 509 ; 6 De G. M. & G. 214 ; 4 K. & J. 650	11, 25, 67, 81, 96, 103, 105, 107, 114, 116, 144, 206
Farr v. Pearce ...	V.-C. of E.	3 Madd. 74	184, 186, 195
Featherstonhaugh v. Fen- wick	M. R.	17 Ves. 298	187, 195, 196
*Ferguson v. Davol Mills	C. P. of Co. of Phila.	2 Brewster, 314 ; R. Cox, 516	... 45
*Fetridge v. Merchant ...	Sup. Ct. of City of N. Y.	4 Abb. Pr. R. 156 ; R. Cox, 194	... 35, 37, 38
*Fetridge v. Wells ...	Sup. Ct. of City of N. Y.	13 How. Pr. R. 385 ; R. Cox, 180	38, 128, 129, 145
Field v. Lewis ...	V.-C. W.	Seton, 4th ed. 237	... 38
*Filley v. Fassett ...	Sup. Ct. of Mo.	44 Mo. 173 ; R. Cox, 530	38, 75, 77, 103, 126, 136
Fisher v. Apollinaris Co. ...	L. JJ.	L. R. 10 Ch. 297	161, 166, 277
Flavel v. Harrison ...	V.-C. W.	10 Hare, 467	36, 108, 124, 132
Fleming v. Newton ...	H. L.	1 H. L. C. 376	... 160
Foot v. Lea ...	M. R. (Ireland)	13 Ir. Eq. 490	... 103, 159
Ford v. Foster ...	L. JJ.	L. R. 7 Ch. 611	7, 9, 10, 33, 36, 39, 64, 77, 111, 124, 130, 132, 135, 136, 142, 204, 206, 278
Foss, <i>Ex parte</i> ...	L. JJ.	2 De G. & J. 230	59, 171, 187, 188
Foster v. Megevand ...	M. R.	Pemb. 2nd ed. 393	... 206
*Fowle v. Spear ...	U. S. Circ. Ct.	7 Penn. L. J. 176 ; R. Cox, 67	... 129
Fradella v. Weller ..	M. R.	2 R. & M. 247	... 146
Franks v. Weaver ...	M. R.	10 Beav. 297 ; 8 L. T. Old S. 510	67 173, 210
Fullwood v. Fullwood ...	V.-C. M. L. JJ.	W. N. 1873, p. 93 ; <i>Ib.</i> p. 185	... 19, 24, 154

TABLE OF CASES.

XV

Name of Case.	Court.	Where reported.	Page where cited.
GEARY <i>v.</i> Norton	V.-C. K.-B.	1 De G. & Sm. 9	107, 135, 146, 147
Gee <i>v.</i> Pritchard	L. C.	2 Swanst. 413	... 161
*Genin <i>v.</i> Chadsey	New York	R. Cox, 567	... 159
Giblett <i>v.</i> Read	L. C.	9 Mod. 459	61, 140, 180, 188
*Gillis <i>v.</i> Hall (1)	C. P. of Co. of Phila.	2 Brews., § 2 ; R. Cox, 580	... 192
*Gillis <i>v.</i> Hall (2)	C. P. of Co. of Phila.	R. Cox, 596	19, 25, 79, 110, 154
*Gillott <i>v.</i> Esterbrook	Sup. Ct. of N. Y.	47 Barb. 455 ; R. Cox, 340 ;	2, 35, 46, 103, 125
*Gillott <i>v.</i> Kettle	Ct. of App. of N. Y. Sup. Ct. of City of N. Y.	3 Sickels, 374 3 Duer, 624 ; R. Cox, 148	... 2, 46, 80
*Glen and Hall Manufac- turing Co. <i>v.</i> Hall	Ct. of App. of N. Y.	16 Sickels, 226	107, 154, 159
*Glendon Iron Co. <i>v.</i> Uhler	Sup. Ct. of Penn.	75 Penn. St. 467 ; 15 Amer. Rep. 599	... 43
Glenny <i>v.</i> Smith	V.-C. K.	2 Dr. & Sm. 476	... 158, 210
Gordon <i>v.</i> Cheltenham Rail- way Co.	M. R.	5 Beav. 233	... 125
Gout <i>v.</i> Aleploglu	V.-C. of E.	6 Beav. 69 <i>n.</i> ; 5 Leg. Obs. 496	5, 39, 100, 102, 215
*Graham <i>v.</i> Plate	Sup. Ct. of Cal.	40 Cal. 593 ; 6 Amer. Rep. 639	... 98, 144
Graveley <i>v.</i> Winchester	V.-C. W.	Seton, 4th ed. 257	107, 143, 155, 157, 200, 211
Green <i>v.</i> Folgham	V.-C. of E.	1 S. & S. 398	25, 140, 177, 178
Green <i>v.</i> Rooke	V.-C. Wick.	W. N. 1872, p. 49 ; L. J. Notes of Cases, 1872, p. 54	... 109, 178
Green <i>v.</i> Shepherd... ..	Ct. of Sess.	Ct. of Sess. Cases, 3rd Ser. IV. 1028	... 109
Grillon <i>v.</i> Guénin	V.-C. B.	W. N. 1877, p. 14	... 39
Grimshaw, <i>Ex parte</i>	V.-C. H.	W. N. 1877, p. 26	54, 217, 229, 235
Guinness <i>v.</i> Ullmer	V.-C. of E.	10 L. T. Old S. 127	81, 115, 206
HALL <i>v.</i> Barrows	M. R. L. C.	32 L. J. Ch. 548 ; 33 L. J. Ch. 204	6, 7, 12, 23, 27, 45, 49, 51, 56, 57, 58, 60, 69, 80, 103, 104, 105, 180, 183, 188, 194, 197, 199, 215
Hall <i>v.</i> Hall	M. R.	20 Beav. 139	... 187, 195
Hammond <i>v.</i> Douglas	L. C.	5 Ves. 539	... 187, 196
Harper <i>v.</i> Pearson	V.-C. W.	3 L. T. N. S. 547	... 112, 157
Harrison <i>v.</i> Gardner	V.-C. of E.	2 Madd. 198	182, 190, 191, 194, 199
Harrison <i>v.</i> Taylor	V.-C. W.	11 Jur. N. S. 408	70, 127, 141, 205
Harter <i>v.</i> Souvazoglu	V.-C. H. L.JJ.	W. N. 1875, p. 11 ; <i>Ib.</i> p. 101	... 27, 29

Name of Case.	Court.	Where reported.	Page where cited.
*Heath v. Wright ...	U. S. Circ. Ct.	3 Wall Jr. ; R. Cox, 154	... 129
Heathcote v. Hulme ...	M. R.	1 Jac. & W. 122	... 196
Henderson v. Jorss ...	V.-C. W.	Seton, 4th ed. 236	... 28, 206
Hennessy v. Bohmann ...	V.-C. M.	W. N. 1877, p. 14	80, 109, 140
Hennessy v. Cooper ...	V.-C. M. April 26, 1877	—	... 80
Hennessy v. Kennett ...	V.-C. M. May 18, 1877	—	... 80
Henry v. Price ...	V.-C. of E.	1 Leg. Obs. 364	... 5, 100
Hine v. Lart ...	V.-C. of E.	10 Jur. 106	42, 48, 61, 71, 113, 198
Hirsch v. Jonas ...	M. R.	L. R. 3 Ch. D. 584	... 3, 113
Hirst v. Denham ...	V.-C. B.	L. R. 14 Eq. 542	2, 28, 36, 38, 103
Hitchcock v. Coker ...	K. B. Ex. Ch.	6 Ad. & E. 438	... 186
*Hobbs v. Français ...	Sup. Ct. of City of N. Y.	19 How. Pr. R. 567 ; R. Cox, 287	... 129
Hoffman v. Duncan ...	V.-C. W.	Seton, 4th ed. 256	... 156, 211
Hogg v. Kirby ...	L. C.	8 Ves. 215	5, 73, 129, 167, 208
Hogg v. Maxwell ...	L. JJ.	L. R. 2 Ch. 316	... 130
And see Maxwell v. Hogg.			
Holloway v. Holloway ...	M. R.	13 Beav. 209	19, 23, 110, 129, 130, 136, 151, 190
*Holmes, Booth & Haydens v. Holmes, Booth & At- wood Manufacturing Co.	Sup. Ct. of Conn.	37 Conn. 278 ; 9 Amer. Rep. 324	153, 154, 155
Hookham v. Pottage ...	L. JJ.	L. R. 8 Ch. 91	158, 191, 195, 198, 199, 211
Hopkins v. Hitchcock ...	C. P.	32 L. J. C. P. 154	... 45, 119
Hovenden v. Lloyd ...	V.-C. B.	18 W. R. 1132	... 62, 124
*Howard v. Henriques ...	Sup. Ct. of City of N. Y.	3 Sand. S. C. 725 ; R. Cox, 129	... 160
*Howe v. Howe Machine Co.	Sup. Ct. of N. Y.	50 Barb. 236 ; R. Cox, 421	... 19, 24
Howe v. McKernan ...	M. R.	30 Beav. 547	... 48, 138
*Howe v. Searing ...	Sup. Ct. of City of N. Y.	10 Abb. Pr. R. 264 ; R. Cox, 244	154, 187, 189, 193, 194
Hudson v. Bennett ...	V.-C. S.	12 Jur. N. S. 519	144, 146
Hudson v. Osborne ...	V.-C. J.	39 L. J. Ch. 79	58, 59, 130, 156, 159, 187, 190, 211
Hunt v. Maniere ...	M. R.	34 Beav. 157	... 117
INGRAM v. Stiff ...	V.-C. W. L. J.J.	5 Jur. N. S. 947	... 170, 207
Isaacson v. Thompson ...	V.-C. B.	20 W. R. 196	108, 124, 125, 126, 145, 153
JAMES v. James ...	M. R.	L. R. 13 Eq. 421	19, 25, 172, 177, 178, 211
Jendwine v. Slade...	N. P.	2 Esp. N. P. C. 572	... 119
Johnson v. Helleley ...	M. R. L. J.J.	34 Beav. 63 ; 2 De G. J. & S. 446	156, 199, 201

TABLE OF CASES.

xvii

Name of Case.	Court.	Where reported.	Page where cited.
*Jurgensen v. Alexander ...	C. P. of City of N. Y.	24 How. Pr. R. 269; R. Cox, 298	... 24, 107
KEENE v. Harris ...	Chancery.	17 Ves. 338	170, 171, 187, 188
Kelly v. Hooper ...	V.-C. K.-B.	1 Y. & C. Ch. 197	... 146, 147
Kelly v. Hutton ...	L. JJ.	L. R. 3 Ch. 708	11, 169, 171
Kennedy v. Lee ...	L. C.	3 Mer. 441	190, 195, 199
Kinahan v. Bolton ..	L. C. (Ireland)	15 Ir. Ch. 75	44, 67, 70, 103, 106, 124, 126
Knott v. Morgan ...	M. R.	2 Keen, 213	73, 160, 175, 210
LABOUCHERE v. Dawson ...	M. R.	L. R. 13 Eq. 322	182, 190, 191, 200, 211
Laferme (Compagnie) v. Hendrickx	M. R. July 20, 1876	--	... 12, 147
*Laird v. Wilder ..	Ct. of App. of Ken- tucky	9 Bush, 131; 15 Amer. Rep. 707	... 128, 129
Lamplough v. Balmer ...	V.-C. W.	W. N. 1867, p. 293	37, 132, 134
Lawson v. Bank of London	C. P.	18 C. B. 84	... 97, 152
Lazenby v. Lazenby ...	M. R.	Seton, 4th ed. 237	... 18, 25, 33
Lazenby v. White ...	M. R.	L. R. 11 Eq. 446	... 173
Lea v. Millar ...	M. R. July 26, 1876	Seton, 4th ed. 242	... 7, 42, 64
Leather Cloth Co. v. American Leather Cloth Co.	V.-C. W. L. C. H. L.	1 H. & M. 271 33 L. J. Ch. 199 11 H. L. C. 523	4, 7, 22, 23, 26, 36, 38, 50, 51, 55, 56, 57, 58, 67, 69, 76, 103, 104, 128, 129, 130, 133, 134, 157, 161, 164, 198
Leather Cloth Co. v. Hirschfeld (1)	V.-C. W.	1 H. & M. 295	... 139
Leather Cloth Co. v. Hirschfeld (2)	V.-C. W.	L. R. 1 Eq. 299	... 98, 143
Leather Cloth Co. v. Lorsont	V.-C. J.	L. R. 9 Eq. 352	132, 134, 177
Ledger v. Ray ...	Ct. of App. May 3, 1877	--	... 75, 170
Lee v. Haley ...	V.-C. M. L. J. G.	L. R. 5 Ch. 155	75, 108, 126, 131, 136, 151, 152, 211
Lehmann v. McArthur ...	L. JJ.	37 L. J. Ch. 625	... 126
*Lemoine v. Ganton ...	C. P. of City of N. Y.	2 E. D. Smith, 343; R. Cox, 142	48, 66, 80, 99
Lewis v. Langdon ...	V.-C. of E.	7 Sim. 421	188, 193, 194, 196, 198, 201
Liebig's Extract of Meat Co. v. Hanbury	V.-C. W.	17 L. T. N. S. 298	... 64, 107
Linoleum Manufacturing Co. v. Nairn	V.-C. H. Feb. 1, 1877	--	... 109
Llewellyn v. Rutherford ...	C. P.	L. R. 10 C. P. 456	182, 183, 187, 189
Lockett v. Lockett ...	L. JJ.	L. R. 4 Ch. 341	... 137

b

Name of Case.	Court.	Where reported.	Page where cited.
*Lockwood v. Bostwick ...	C. P. of City of N. Y.	2 Daly, 521 ; R. Cox, 555	... 37, 76, 78
London Assurance v. London and Westminster Assurance Corporation	V.-C. S.	32 L. J. Ch. 664	... 151
London and Provincial Law Assurance Society v. London and Provincial Joint-Stock Life Assurance Co.	V.-C. of E.	17 L. J. Ch. 37	... 151
Longman v. Tripp... ..	C. P.	2 Bos. & P. N. R. 67	59, 171, 187, 188
Longman v. Winchester ...	L. C.	16 Ves. 269	... 168
Lumley v. Wagner ...	V.-C. P. L. C.	5 De G. & Sm. 485 1 De G. M. & G. 604	... 118, 176
McANDREW v. Bassett ...	V.-C. W. L. C.	33 L. J. Ch. 561 ; <i>Ib.</i> 566	6, 7, 12, 16, 23, 27, 41, 42, 43, 49, 63, 69, 97, 103, 104, 106, 123, 144, 146, 149, 150, 169, 205, 215
*McCardel v. Peck ...	Sup. Ct. of N. Y.	28 How. Pr. R. 120 ; R. Cox, 312	... 160
McDonald v. Richardson ...	V.-C. S.	1 Giff. 81	187, 196, 197
McIntyre v. Belcher ...	C. P.	32 L. J. C. P. 254	... 194
Mack v. Petter ...	M. R.	L. R. 14 Eq. 431	... 171
*Marsh v. Billings ...	Sup. Ct. of Mass.	7 Cush. 322 ; R. Cox, 118	... 160, 175
Marshall v. Ross ...	V.-C. J.	L. R. 8 Eq. 651	87, 134, 135
Marshall v. Watson ...	M. R.	25 Beav. 501	... 188, 200
Martin v. Wright ...	V.-C. of E.	6 Sim. 297	... 161, 163
Massam v. Thorley's Cattle Food Co. (a)	V.-C. M.	W. N. 1877, p. 152	... 25, 177
*Matsell v. Flanagan ...	C. P. of City of N. Y.	2 Abb. Pr. R. N. S. 459 ; R. Cox, 367	... 170
Maxwell v. Hogg ... And see Hogg v. Maxwell	L. JJ.	L. R. 2 Ch. 307	11, 50, 63, 97, 103, 123, 149, 162, 164, 172, 215
Meikle, <i>In re</i> ...	V.-C. H.	24 W. R. 1067	101, 214, 221, 229, 235, 239
Mellersh v. Keen ...	M. R.	28 Beav. 453	... 199, 201
*Meneely v. Meneely ...	Ct. of App. of N. Y.	17 Sickels, 427	... 19, 25
*Meriden Britannia Co. v. Parker	Sup. Ct. of Conn.	39 Conn. 450 ; 12 Amer. Rep. 401	23, 25, 72, 79, 107, 130, 136
*Messerole v. Tynberg ...	C. P. of City of N. Y.	4 Abb. Pr. R. N. S. 410 ; R. Cox, 479	... 24
Mickle v. Emery ...	M. R.	Seton, 4th ed. 234	... 205
Millington v. Fox ...	L. C.	3 My. & Cr. 338	5, 9, 27, 44, 45, 69, 102, 104, 114, 127, 144, 146, 170, 205, 215

(a) Since reported at 46 L. J. Ch. 707.

TABLE OF CASES.

xix

Name of Case.	Court.	Where reported.	Page where cited.
Mitchell, <i>In re</i> ...	V.-C. H. Aug. 2, 1877	—	18, 46, 221
Mitchell <i>v.</i> Condy (a) ...	V.-C. B.	W. N. 1877, p. 153	71, 76, 156, 164, 193
Moet <i>v.</i> Clybourn ...	M. R. Jan. 19, 1877	—	... 45, 72
Moet <i>v.</i> Couston ...	M. R.	33 Beav. 578 ; 4 N. R. 86	9, 27, 103, 107, 108, 135, 141, 142, 143, 144, 146
Moet <i>v.</i> Pickering ...	Fry, J.	W. N. 1877, p. 193	... 116, 145
Montague <i>v.</i> Moore ...	V.-C. W.	Seton, 4th ed. 238	153, 157, 211
Moore <i>v.</i> Craven ...	L. C.	L. R. 7 Ch. 94, n.	... 137
Morgan <i>v.</i> McAdam ...	V.-C. W.	36 L. J. Ch. 228	36, 131, 132, 133, 134, 144, 281
Morison <i>v.</i> Moat ..	V.-C. T.	9 Hare, 241	124, 177, 178, 209
Morison <i>v.</i> Salmon ...	C. P.	2 Scott, N. R. 449 ; 2 Man. & G. 385	67, 68, 96, 97, 99, 143, 144
Morris <i>v.</i> Moss ...	M. R.	25 L. J. Ch. 194	... 187, 189
Motley <i>v.</i> Downman ..	L. C.	3 My. & Cr. 1	27, 44, 45, 68, 103, 109, 111, 124
Mulkern <i>v.</i> Ward ...	V.-C. Wick.	L. R. 13 Eq. 619	... 161
Myers <i>v.</i> Baker ...	Ex.	3 H. & N. 802	... 68, 96, 135
NEILSON <i>v.</i> Betts ...	H. L.	L. R. 5 H. L. 1	107, 142, 143
Newbery <i>v.</i> James... ..	L. C.	2 Mer. 446	... 177, 178
*Newby <i>v.</i> Oregon Central Railway Co.	U.S. Circ. Ct.	1 Deady, 609 ; 9 Amer. Rep. 331 n.	... 153
Newling <i>v.</i> Dobell... ..	V.-C. M.	38 L. J. Ch. 111	... 187, 192
*Newman <i>v.</i> Alvord ..	Sup. Ct. of N. Y.	49 Barb. 588 ; R. Cox, 404 ; 6 Sickels, 189	... 42, 114
Nichol <i>v.</i> Godts	Ct. of App. of N. Y. Ex.	10 Ex. 191	... 119
Nixey <i>v.</i> Roffey	V.-C. M.	W. N. 1870, p. 227	132, 134, 145
Nunn <i>v.</i> D'Albuquerque ...	M. R.	34 Beav. 595	142, 145, 146
OLDHAM <i>v.</i> James	M. R. (Ireland) L. C. & L. J. (Ireland)	13 Ir. Ch. 393 ; 14 Ir. Ch. 81	... 118, 124
Orr <i>v.</i> Diaper	V.-C. H.	L. R. 4 Ch. D. 92	117, 122, 133, 139, 174
PAGE <i>v.</i> Townsend ..	V.-C. of E.	5 Sim. 395	.. 114
*Palmer <i>v.</i> Harris	Sup. Ct. of Penn.	60 Penn. 156 ; R. Cox, 523	... 128, 129
Parsons <i>v.</i> Hayward ...	M. R.	31 Beav. 199	183, 187, 196
*Partridge <i>v.</i> Menck ...	L. C.	31 L. J. Ch. 666	...
Patching <i>v.</i> Dubbins ...	Ct. of App. of N. Y.	1 How. App. Cas. 558 ; R. Cox, 72	... 76, 136
	V.-C. W.	Kay, 11	... 125

(a) Since reported at 37 L. T. N. S. 268.

TABLE OF CASES.

Name of Case.	Court.	Where reported.	Page where cited.
Perry v. Truefitt	M. R.	6 Beav. 66	1, 9, 36, 69, 103, 128
*Peterson v. Humphrey	Sup. Ct. of N. Y.	4 Abb. Pr. R. 394; R. Cox, 212	189, 193, 195, 198
*Phalon v. Wright	C. P. of Co. of Phila.	5 Phila. 464; R. Cox, 307	... 10, 35, 120
Pickford v. Grand Junction Railway Co.	L. C.	3 Rlwy. Cas. 538	... 108, 125
Pidding v. How	V.-C. of E.	8 Sim. 477	... 9, 36, 128
Pierce v. Franks	V.-C. K.-B.	15 L. J. Ch. 122 145
Polhill v. Walter	K. B.	3 B. & Ad. 114 96
Ponsardin v. Peto	M. R.	33 Beav. 642	27, 108, 117
Potter v. Commissioners of Inland Revenue	Ex.	10 Ex. 147	181, 183, 187
Powell v. McNulty	V.-C. B. Nov. 27, 1876	— 42
Power v. Barham	K. B.	4 Ad. & E. 473 119
Prowett v. Mortimer	V.-C. S.	2 Jur. N. S. 414	... 170, 207
Prudential Assurance Co. v. Knott	L. C. & L.JJ.	L. R. 10 Ch. 142	... 161, 166
Purser v. Brain	V.-C. of E.	17 L. J. Ch. 141	49, 152, 155
RAJDE v. Norman... ..	V.-C. Wick.	L. R. 14 Eq. 348	3, 42, 71, 72, 78, 103, 109
Raggett v. Findlater	V.-C. M.	L. R. 17 Eq. 29	2, 16, 36, 64, 122
Ransome v. Bentall	V.-C. of E.	3 L. J. Ch. 161	... 25, 44
R. v. —	Assizes	Foster, Cr. Cas. 439	... 309, 310
R. v. Abbott	C. C. R.	1 Den. 273 90
R. v. Ardley	C. C. R.	L. R. 1 C. C. R. 301; 12 Cox, 23	... 90, 92, 298
R. v. Avery	Assizes	8 C. & P. 596 86
R. v. Ball	C. C. C.	C. & M. 249 89
R. v. Banks	N. P.	1 Esp. 144	... 309, 310
R. v. Bryan	C. C. R.	D. & B. 265; 7 Cox, 312	88, 89, 90, 91
R. v. Carter	C. C. R.	10 Cox, 642 92
R. v. Closs	C. C. R.	D. & B. 460; 7 Cox, 494	... 82, 83, 88
R. v. Cohen	C. C. C.	8 Cox, 41	... 309, 310
R. v. Collicott	Old Bailey	2 Leach, 1048 87
R. v. Dark	C. C. R.	1 Den. 276 90
R. v. Dundas	Assizes	6 Cox, 380	... 19, 78, 87
R. v. Elsworth	All the judges	2 East, P. C. 986 86
R. v. Fitzgerald	C. C. C.	43 C. C. C. Sess. Pap. 369 310
R. v. Foster	C. C. R.	13 Cox, 393 xxxi.
R. v. Garlick	C. C. R.	1 Den. 276 90
R. v. Goss	C. C. R.	Bell, 208; 8 Cox, 262	... 89, 90
R. v. Gray & Gosling	—	Lloyd, on Trade Marks, p. 11 88
R. v. Hall	C. C. C.	45 C. C. C. Sess. Pap. 451 89
R. v. Hunter	C. C. R.	10 Cox, 642 92
R. v. Jones	Middlx. Sessions	Lloyd, on Trade Marks, p. 11 88

TABLE OF CASES.

xxi

Name of Case.	Court.	Where reported.	Page where cited.
R. v. Lee (1)	Old Bailey	1 Leach, 416 298
R. v. Lee (2)	C. C. C.	8 Cox, 233 89
R. v. Lee (3)	C. C. R.	9 Cox, 480 92
R. v. Levine & Wood ..	C. C. C.	10 Cox, 374 89
R. v. Lewis... ..	All the judges	Foster's Cr. Cas. 116 86
R. v. Ogden	C. C. C.	6 C. & P. 631 298
R. v. Priestley	C. C. C.	63 C. C. C. Sess. Pap. 541 89
R. v. Ragg	C. C. R.	8 Cox, 265 85, 92
R. v. Ridgway	Assizes	3 F. & F. 838 92
R. v. Roebuck	C. C. R.	D. & B. 24; 7 Cox, 126 89, 90
R. v. Sherwood	C. C. R.	7 Cox, 270 85, 92
R. v. Silversides	Q. B.	3 Q. B. 406 310
R. v. Sleep	C. C. R.	8 Cox, 472; L. & C. 44 309, 310
R. v. Smith... ..	C. C. R. C. C. C.	D. & B. 566; 8 Cox, 32 47 C. C. C. Sess. Pap. 269; 48 <i>ib.</i> 8 82, 83, 88
R. v. Stevens	C. C. C.	1 Cox, 83 89
R. v. Sunley	C. C. R.	8 Cox, 179; Bell, 145 310
R. v. Suter & Coulson ...	C. C. R.	10 Cox, 577	87, 88, 89, 298
R. v. White	C. C. C.	72 C. C. C. Sess. Pap. 222 86
R. v. Willmett	Assizes	3 Cox, 281 309, 310
Richards v. Williamson ...	V.-C. B.	30 L. T. N. S. 746 24, 80
Rivero v. Norris	V.-C. G.	Seton, 4th ed. 236 116, 206
Robertson v. Quiddington...	M. R.	28 Beav. 529	187, 189, 197
Robineau v. Charbonnel ...	V.-C. M.	W. N. 1876, p. 160 145, 159
Rodgers v. Nowill	V.-C. Wigr. C. P. L. JJ.	6 Hare, 325 5 C. B. 109 3 De G. M. & G. 614	5, 9, 19, 25, 68, 69, 95, 96, 97, 99, 103, 110, 127
Rodgers v. Rodgers	L. JJ.	31 L. T. N. S. 285	71, 125, 126, 127, 145
Routh v. Webster	M. R.	10 Beav. 561	164, 165, 193, 213
*Rowley v. Houghton	C. P. of Co. of Phila.	2 Brews. 303; R. Cox, 486	50, 51, 74, 76
*Rudderow v. Huntington...	Sup. Ct. of City of N. Y.	3 Sand. S. C. 252; R. Cox, 106 98, 108
*SAMUEL v. Berger... ..	Sup. Ct. of N. Y.	24 Barb. 163 ; R. Cox, 178	118, 124, 130
Scheile v. Brakell	V.-C. S.	11 W. R. 796 ; Seton, 4th ed. 253 155, 212
*Schrauder v. Beresford ...	U. S. Patent Office, June 27, 1872	— 77
Schweitzer v. Atkins	V.-C. M.	37 L. J. Ch. 847 72, 78
Scott v. Mackintosh	L. C.	1 V. & B. 503 187, 192
Scott v. Rowland	V.-C. Wick.	20 W. R. 508	156, 187, 189, 193, 195, 199
Scott v. Scott	V.-C. W.	16 L. T. N. S. 143	156, 157, 198, 211
Sedon v. Senate	M. R.	2 V. & B. 220	174, 177, 190

Name of Case.	Court.	Where reported.	Page where cited.
Seeley <i>v.</i> Fisher	L. C.	11 Sim. 581	161, 163
Scixo <i>v.</i> Provezende	L. C.	L. R. 1 Ch. 192	2, 8, 27, 43, 73, 78, 203
Selby <i>v.</i> Anchor Tube Co... ..	V.-C. B.	W. N. 1877, p. 191	155, 157, 158, 191, 199, 200, 212
Shackle <i>v.</i> Baker	L. C.	14 Ves. 468	187, 190
Shipwright <i>v.</i> Clements	V.-C. M.	19 W. R. 599	7, 55, 58, 141, 180, 187, 190, 215
Shrimpton <i>v.</i> Laight	M. R.	18 Beav. 164	... 38, 76
Simpson <i>v.</i> Chapman	L. J.J.	4 De G. M. & G. 154	... 196, 198
Singer Manufacturing Co. <i>v.</i> Kimball	Ct. of Session.	Ct. of Sess. Cas. 3rd Ser. XI. 267 151
Singer Manufacturing Co. <i>v.</i> Wilson	M. R. Ct. of App.	L. R. 2 Ch. D. 434	5, 8, 10, 12, 14, 16, 18, 27, 30, 34, 51, 63, 66, 72, 73, 93, 96, 99, 101, 105, 106, 111, 121, 131, 151, 174
Singleton <i>v.</i> Bolton	K. B.	3 Doug. 293	4, 68, 96, 177
Smale <i>v.</i> Graves	V.-C. K.-B.	3 De G. & Sm. 706	186, 189
Smith <i>v.</i> Everett	M. R.	27 Beav. 446	187, 197, 199, 201
Smith <i>v.</i> Mason	V.-C. H.	W. N. 1875, p. 62	... 37, 103
*Smith <i>v.</i> Woodruff	Sup. Ct. of N. Y.	48 Barb. 438 ; R. Cox, 373	... 38, 129
*Snowden <i>v.</i> Noah	Chancery of N. Y.	Hopk. 347 ; R. Cox, 1	75, 170, 171, 188, 189
Southern <i>v.</i> Howe... ..	C. P.	3 Cro. 47 ; Poph. 144 ; 2 Rolle, 28	... 4, 94
Southern <i>v.</i> Reynolds	V. C. W.	12 L. T. N. S. 75	42, 61, 114
Sparagnapane <i>v.</i> Coombs	V.-C. J.	Seton, 4th ed. 246 205
Spicer <i>v.</i> James	M. R.	Coil. on Part. 2nd ed. 104 186
Spottiswoode <i>v.</i> Clarke	L. C.	2 Ph. 154	2, 49, 73, 109, 168
Spratt <i>v.</i> Jeffery	K. B.	10 B. & C. 249 187
Springhead Spinning Co. <i>v.</i> Riley	V.-C. M.	L. R. 6 Eq. 561	... 164, 166
Standish <i>v.</i> Whitwell	V.-C. W.	14 W. R. 512	... 28, 29, 145
Steinthal <i>v.</i> Samson	Ct. of App. April 16, 1877	—	... 29, 118
Stephens, <i>Ex parte</i> (1)	M. R.	24 W. R. 819	54, 216, 235
Stephens, <i>Ex parte</i> (2)	M. R.	L. R. 3 Ch. D. 659 ; 24 W. R. 963	6, 7, 17, 18, 24, 27, 30, 37, 65, 122, 221
Stephens <i>v.</i> Brett	V.-C. W.	10 L. T. N. S. 231 138
*Stephens <i>v.</i> De Conto	Sup. Ct. of City of N. Y.	7 Robertson, 343 ; R. Cox, 442	... 75, 170
Stephens <i>v.</i> Peel	V.-C. W.	16 L. T. N. S. 145	22, 23, 24, 78, 204
Stevens <i>v.</i> Keating	L. C.	2 Ph. 333 109
Stevens <i>v.</i> Paine	V.-C. G.	18 L. T. N. S. 600	... 155, 157

TABLE OF CASES.

xxiii

Name of Case.	Court.	Where reported.	Page where cited.
*Stewart v. Smithson ...	C. P. of City of N. Y.	1 Hilt. 119 ; R. Cox, 175	... 132
*Stokes v. Landgraff ...	Sup. Ct. of N. Y.	17 Barb. 608 ; R. Cox, 137	... 2, 36
*Stone v. Carlan ...	Sup. Ct. of City of N. Y.	13 Mo. L. R. 360 ; R. Cox, 115	... 160, 175
*Stonebreaker v. Stonebreaker	Ct. of App. Maryland	33 Maryland, 252	... 19
Strahan & Co. v. King & Co.	V.-C. M. Feb. 22, 1877		... 168
*Swift v. Dey ...	Sup. Ct. of City of N. Y.	4 Robertson, 611 ; R. Cox, 319	... 76, 110
Sykes v. Sykes ...	K. B.	3 B. & C. 541	4, 5, 8, 67, 68, 94, 96, 132, 136, 143
TAYLOR v. Ashton ...	Ex.	11 M. & W. 415	... 68, 95
*Taylor v. Carpenter (1) ...	U.S. Circ. Ct.	3 Story, 458 ; R. Cox, 14	11, 48, 136, 137, 225
*Taylor v. Carpenter (2) ...	U.S. Circ. Ct.	2 Wood. & M. 1 ; R. Cox, 32 ; 9 L. T. Old S. 514	48, 98, 225
*Taylor v. Carpenter (3) ...	Ct. of Errors of N. Y.	11 Paige, 292 ; 2 Sand. 603 ; R. Cox, 45	48, 136, 225
*Taylor v. Gillies ...	Ct. of App. of N. Y.	14 Sickles, 331	35, 114, 221
Taylor v. Taylor ...	V.-C. W.	23 L. J. Ch. 255	19, 23, 24, 42, 78
Thomas, Ex parte ...	Court of Review in Bkpty.	2 Mont. D. & De G. 294	... 183, 187
Thompson v. Dunn ...	L.JJ.	L. R. 5 Ch. 576	... 138
*Thomson v. Winchester ...	Sup. Ct. of Mass.	19 Pick. 214 ; R. Cox, 7	... 10, 35
Thorley's Cattle-Food Co. v. Massam (a)	V.-C. M.	W. N. 1877, p. 174	... 161
Thornbury v. Beville ...	V.-C. K.-B.	1 Y. & C. Ch. 554	... 185, 199
Tipping v. Clarke ...	V.-C. Wigr.	2 Haro, 383	... 177
Tonge v. Ward ...	M. R.	21 L. T. N. S. 480	24, 78, 107, 115, 144
*Town v. Stetson ...	C. P. of City of N. Y.	5 Abb. Pr. R. N. S. 218 ; R. Cox, 514	... 35
Tudor v. Tudor ...	V.-C. M.	W. N. 1873, p. 72	118, 156, 166
Turner v. Evans ...	V.-C. K. L.JJ. Q. B.	2 De G. M. & G. 740	... 192
Turner v. Major ...	V.-C. S.	3 Giff. 442	187, 193, 194, 201
Tweed v. Mills ...	C. P.	L. R. 1 C. P. 39	... 187
UPMANN v. Elkan ...	M. R. L. C.	L. R. 12 Eq. 140 ; L. R. 7 Ch. 130	107, 116, 117, 145, 146, 147, 206

(a) Since reported at 46 L. J. Ch. 713.

TABLE OF CASES.

Name of Case.	Court.	Where reported.	Page where cited.
WADE v. Jenkins ...	V.-C. S.	2 Giff. 509	187, 195
Walkden Aerated Waters Co., <i>In re</i>	M. R. June 8, 1877	—	28, 217
Wallis v. Wallis ...	V.-C. K.	4 Dr. 458	145, 146, 147
*Walton v. Crowley ...	U. S. Circ. Ct.	3 Bl. C. C. 440 ; R. Cox, 166	7, 56, 76, 77, 103, 215
Ward v. Beeton ...	V.-C. M.	L. R. 19 Eq. 207	118, 164, 165, 171
Wason v. Waring ...	M. R.	15 Beav. 151	... 124
Webster v. Webster ...	L. C.	3 Swanst. 490, n.	166, 193, 199
Wedderburn v. Wedderburn	M. R.	22 Beav. 104	... 197
Wedgwood v. Smith ...	V.-C. of E. 1848	—	... 23, 24
Welch v. Knott ...	V.-C. W.	4 K. & J. 747	... 25, 103
Wheeler & Wilson Manufacturing Co. v. Shakespear	V.-C. J.	39 L. J. Ch. 36	18, 34, 64, 124, 174, 212
Whittaker v. Howe ...	M. R.	3 Beav. 383	... 185, 192
Willett v. Blanford ...	V.-C. Wigr.	1 Hare, 253	... 196, 197
*Williams v. Johnson ...	Sup. Ct. of City of N.Y.	2 Bos. 1 ; R. Cox, 214	... 38, 79
Williams v. Osborne ...	V.C.- W.	13 L. T. N. S. 498	144, 146, 147, 150, 159, 169
*Williams v. Spence ...	Sup. Ct. of City of N.Y.	25 How. Pr. R. 366 ; R. Cox, 305	... 38
Williams v. Williams (1) ...	L. C.	3 Mer. 157	... 177, 179
Williams v. Williams (2) ...	L. C.	2 Swanst. 253	... 192
Witt v. Corcoran ...	V.-C. B.	Seton, 4th ed. 257	155, 156, 157, 211, 212
*Wolfe v. Barnett ...	Sup. Ct. of Louisiana	24 La. Ann. 97 ; 13 Amer. Rep. 111	... 11, 136
*Wolfe v. Burke ...	Ct. of App. of N. Y.	11 Sickels, 115	128, 129, 166
*Wolfe v. Goulard...	Sup. Ct. of N. Y.	18 How. Pr. R. 64 ; R. Cox, 226	... 35, 37, 64
Wolmershausen v. O'Connor	V.-C. B.	W. N. 1877, p. 113	... 192
*Woodward v. Lazar ...	Sup. Ct. of Cal.	21 Cal. 448 ; R. Cox, 300	103, 160, 189
Woollam v. Ratcliff ...	V.-C. W.	1 H. & M. 259	72, 75, 80, 122, 144, 174, 175
Worrall v. Hand ...	K. B.	Peake, 105	... 187
Wotherspoon v. Currie ...	H. L.	L. R. 5 H. L. 508	27, 41, 42, 76, 77, 79, 80, 121, 204
Wotherspoon v. Gray ...	Ct. of Session	Ct. of Sess. Cas. 3rd Ser. II. 38	... 111
Wylam v. Clarke ...	V.-C. B.	W. N. 1876, p. 68	... 75, 145
YOUNG, <i>Ex parte</i> ...	Ct. of Bkptey. Feb. 3, 1877	—	... 7, 45, 59
Young v. Macrae ..	V.-C. W.	9 Jur. N. S. 322	3, 31, 32, 37, 64
Yovatt v. Winyard ...	L. C.	1 Jac. & W. 394	... 177

TABLE OF DEFENDANTS.

American cases are distinguished by an asterisk.

ABBOTT—R. *v.*
Aleplöglu—Gout *v.*
Alexander—Jurgensen *v.*
*Alvord—Newman *v.*
American Leather Cloth Co.—Leather
Cloth Co. *v.*
Anchor Tube Co.—Selby *v.*
Apollinaris Co.—Fisher *v.*
Ardley—R. *v.*
Ashton—Taylor *v.*
Atkins—Schweitzer *v.*
Avery—R. *v.*

*BAIRD—Colladay *v.*
Baker—Myers *v.*
Baker—Shackle *v.*
Bakers and Confectioners' Tea Association
—Abbott *v.*
Ball—R. *v.*
Balmer—Lamplough *v.*
Bank of London—Lawson *v.*
Bank of Whitehaven—Dawson *v.*
Banks—R. *v.*
Barham—Power *v.*
Barlow—Broadhurst *v.*
*Barnett—Wolfe *v.*
Bassett—McAndrew *v.*
*Batchellor—Batchellors *v.*
Bedford—Bury *v.*
Beeton—Bradbury *v.*
Beeton—Ward *v.*
Belcher—McIntyre *v.*
Bell—Bell *v.*
Benbow—Edmonds *v.*
Bennett—Hudson *v.*
Bentall—Ransome *v.*
Bentley—Ainsworth *v.*
*Beresford—Schrauder *v.*

*Berger—Samuel *v.*
Betts—Neilson *v.*
Bevill—Thornbury *v.*
*Billings—Marsh *v.*
Binning—Day *v.*
Blanford—Willett *v.*
*Bloomer—Bloss *v.*
Bohmann—Hennessy *v.*
Bolton—Kinahan *v.*
Bolton—Singleton *v.*
*Bostwick—Lockwood *v.*
Boys—Austen *v.*
Brain—Purser *v.*
Brakell—Scheile *v.*
Brett—Stephens *v.*
Broughton—Broughton *v.*
Brown—Collins Co. *v.*
*Brunton—Coffeen *v.*
*Bryan—Curtis *v.*
Bryan—R. *v.*
Burgess—Burgess *v.*
*Burke—Wolfe *v.*
Bustard—Braham *v.*

*CARLAN—Stone *v.*
Carlile—Cartier *v.*
*Carpenter—Taylor *v.*
Carter—R. *v.*
*Cassin—Burke *v.*
Cathery—Farina *v.*
*Chadsey—Genin *v.*
Chandler—Cocks *v.*
Chapman—Bullock *v.*
Chapman—Simpson *v.*
Charbonnel—Robineau *v.*
Cheltenham Railway Co.—Gordon *v.*
Christie—Christie *v.*
*Clark—Canal Co. *v.*

- *Clark—Clark *v.*
 Clarke—Spottiswoode *v.*
 Clarke—Tipping *v.*
 Clarke—Wylam *v.*
 Clements—Shipwright *v.*
 Closs—R. *v.*
 Clybouw—Moet *v.*
 *Cohen—Choynski *v.*
 Cohen—R. *v.*
 Coker—Hitchcock *v.*
 Collicott—R. *v.*
 Collingridge—Cook *v.*
 Collins—Crawshay *v.*
 Commissioners of Inland Revenue —
 Potter *v.*
 Condy—Mitchell *v.*
 Connolly—Baxter *v.*
 Coombs—Sparagnapane *v.*
 Cooper—Hennessy *v.*
 Cope—Dakin *v.*
 Corcoran—Witt *v.*
 Couston—Moet *v.*
 Cowen—Collins Co. *v.*
 Crabb—Blackwell *v.*
 Craven—Moore *v.*
 *Crowley—Walton *v.*
 Currie—Wotherspoon *v.*
- D'ALBUQUERQUE—Nunn *v.*
 *Daly—Corwin *v.*
 Dark—R. *v.*
 Davidson—Chappell *v.*
 *Davis—Caswell *v.*
 *Daval Mills—Ferguson *v.*
 Dawber—Bass *v.*
 Dawson—Labouchere *v.*
 Day—Croft *v.*
 Day—Emperor of Austria *v.*
 *De Conto—Stephens *v.*
 *Deere—Candee, Swan & Co. *v.*
 Denham—Hirst *v.*
 De Tastet—Brown *v.*
 Dewes—Chissum *v.*
 *Dey—Swift *v.*
 Diaper—Orr *v.*
 Dickens—Bradbury *v.*
 Dobell—Newling *v.*
 Douglas—Churton *v.*
 Douglas—Hammond *v.*
 Downman—Motley *v.*
 Downs—England *v.*
 Dubbins—Patching *v.*
 Du Boulay—Du Boulay *v.*
 Duncan—Hoffman *v.*
 Dundas—R. *v.*
 Dunn—Thompson *v.*
- EDELSTEN—Edelsten *v.*
 Edgington—Edgington *v.*
 Edmonton—Clegg *v.*
 Edwards—Apollinaris Co. *v.*
 Elkan—Upmann *v.*
 Elsworth—R. *v.*
 Emery—Mickle *v.*
 Estcourt Hop Essence Co.—Estcourt *v.*
 *Esterbrook—Gillott *v.*
 Evans—Brook *v.*
 Evans—Cope *v.*
 Evans—Turner *v.*
 Everett—Smith *v.*
- *FABER—Faber *v.*
 Farlow—Bozon *v.*
 *Fassett—Filley *v.*
 Fawcus—Dixon *v.*
 Fenwick—Featherstonhaugh *v.*
 Findlater—Raggett *v.*
 Fisher—Seeley *v.*
 Fitzgerald—R. *v.*
 *Flanagan—Matsell *v.*
 Folgham—Green *v.*
 Foster—Burrows *v.*
 Foster—Ford *v.*
 Foster—R. *v.*
 Fox—Millington *v.*
 *Français—Hobbs *v.*
 Franks—Pierce *v.*
 Freeman—Browne *v.*
 Freeman—Clark *v.*
 Fullwood—Fullwood *v.*
- *GANTON—Lemoine *v.*
 Garlick—R. *v.*
 Gardner—Harrison *v.*
 *Garner—Amoskeag Manufacturing Co. *v.*
 Gaubert—Ansell *v.*
 Gebhardt—Farina *v.*
 Gertcken—Cory *v.*
 Gibson—Banks *v.*
 Gillard—Cotton *v.*
 *Gillies—Taylor *v.*
 Godts—Nichol *v.*
 Goss—R. *v.*
 *Goulard—Wolfe *v.*
 Grand Junction Railway Co.—Pickford *v.*
 Graves—Smale *v.*
 Gray—Wotherspoon *v.*
 Gray & Gosling—R. *v.*
 Griffiths—Chubb *v.*
 Griffiths—Corns *v.*
 Guénin—Grillon *v.*
 *Guggenheim—Dixon Crucible Co. *v.*
 Guy—Bunn *v.*

HALEY—Lee *v.*
 *Hall—Gillies *v.*
 *Hall—Glen & Hall Manufacturing Co. *v.*
 Hall—Hall *v.*
 Hall—R. *v.*
 Hanbury—Liebig's Extract of Meat Co. *v.*
 Hand—Worrall *v.*
 Harris—Keene *v.*
 *Harris—Palmer *v.*
 Harrison—Flavel *v.*
 Hately—Burgess *v.*
 Hayward—Parsons *v.*
 Helleley—Johnson *v.*
 Hendrickx—Laferme (Compagnie) *v.*
 *Henriques—Howard *v.*
 *High Rocks Congress Spring Co.—Congress and Empire Spring Co. *v.*
 Hill—Batty *v.*
 Hill—Blanchard *v.*
 Hills—Burgess *v.*
 Hirschfeld—Leather Cloth Co. *v.*
 Hitchcock—Hopkins *v.*
 Hodgson—Davies *v.*
 Hogg—Clowes *v.*
 Hogg—Maxwell *v.*
 *Holbrook—Coats *v.*
 Holden—Dixon *v.*
 Hollins—Campbell *v.*
 Holloway—Holloway *v.*
 *Holmes, Booth & Atwood Manufacturing Co.—Holmes, Booth & Haydens *v.*
 Holt—Aubin *v.*
 Home and Colonial Assurance Co.—Colonial Life Assurance Co. *v.*
 Hood—Cooper *v.*
 Hooper—Kelly *v.*
 *Houghton—Rowley *v.*
 How—Pidding *v.*
 Howe—Southern *v.*
 Howe—Whittaker *v.*
 *Howe Machine Co.—Howe *v.*
 Hughes—Evans *v.*
 Hulme—Heathcote *v.*
 *Humphrey—Peterson *v.*
 Hunter—R. *v.*
 *Huntington—Rudderow *v.*
 Hutton—Kelly *v.*

JACKSON—Dixon *v.*
 James—James *v.*
 James—Newbery *v.*
 James—Oldham *v.*
 James—Spicer *v.*
 Jeffery—Spratt *v.*
 Jenkins—Wade *v.*
 *Johnson—Williams *v.*
 Johnston—Byron (Lord) *v.*

Jonas—Hirsch *v.*
 Jones—Canham *v.*
 Jones—R. *v.*
 Jorss—Henderson *v.*

 KEATING—Stevens *v.*
 Keen—Mellersh *v.*
 *Kendall—Davis *v.*
 Kennett—Hennessy *v.*
 *Kettle—Gillott *v.*
 Kimball—Singer Manufacturing Co. *v.*
 King & Co.—Strahan & Co. *v.*
 Kirby—Hogg *v.*
 *Knight—Barrows *v.*
 Knott—Prudential Assurance Co. *v.*
 Knott—Welch *v.*

LAIGHT—Shrimpton *v.*
 Land and Water Journal Co.—Cox *v.*
 *Landgraff—Stokes *v.*
 Langdon—Lewis *v.*
 Lart—Hine *v.*
 *Lazar—Woodward *v.*
 Lazenby—Lazenby *v.*
 Lea—Foot *v.*
 Leach—Clark *v.*
 Lee—Kennedy *v.*
 Lee—R. *v.*
 Leuchars—Barnett *v.*
 Levine & Wood—R. *v.*
 Lewis—Field *v.*
 Lewis—R. *v.*
 Lincoln Gas Light and Coke Co.—Beverley *v.*
 Lloyd—Hovenden *v.*
 *Locke—Bell *v.*
 Lockett—Lockett *v.*
 London and Westminster Assurance Corporation—London Assurance *v.*
 London and Provincial Joint Stock Life Assurance Co.—London and Provincial Law Assurance Society *v.*
 Lonsont—Leather Cloth Co. *v.*
 *Lucy—Falkinburg *v.*
 Lye—Cruttwell *v.*

MCADAM—Morgan *v.*
 McArthur—Lehmann *v.*
 Mackintosh—Scott *v.*
 McKernan—Howe *v.*
 McNulty—Powell *v.*
 Macrae—Young *v.*
 Maddick—Clement *v.*
 Major—Turner *v.*
 Maniere—Hunt *v.*
 Mason—Dence *v.*

Mason—Smith *v.*
 Massam—Thorley's Cattle-Food Co. *v.*
 *Masury—Brooklyn White Lead Co. *v.*
 Maxwell—Hogg *v.*
 May—Cartier *v.*
 Mayer—Del Valle *v.*
 Megevand—Foster *v.*
 *Menck—Partridge *v.*
 *Meneely—Meneely *v.*
 *Merchant—Fetridge *v.*
 *Meriden Britannia Co.—Boardman *v.*
 Milbourn—Bond *v.*
 Millar—Lea *v.*
 Mills—Tweed *v.*
 Moat—Morison *v.*
 Moore—Montague *v.*
 Morgan—Knott *v.*
 Morson—Carnrick *v.*
 Mortimer—Prowett *v.*
 Moss—Morris *v.*
 *Murphy—Christy *v.*
 Myers—Cave *v.*

NAIRN—Linoleum Manufacturing Co. *v.*
 *Noah—Snowden *v.*
 Norman—Radde *v.*
 Norris—Rivero *v.*
 Norrish—Apollinaris Co. *v.*
 *Norton—Bradley *v.*
 Norton—Fleming *v.*
 Norton—Geary *v.*
 Nowill—Rodgers *v.*

O'CONNOR—Wolmershausen *v.*
 Ogden—R. *v.*
 *Oregon Central Railway Co.—Newby *v.*
 Osborne—Hudson *v.*
 Osborne—Williams *v.*

PAINE—Stevens *v.*
 *Parker—Meriden Britannia Co. *v.*
 Payne—Blofeld *v.*
 Peake—Boulnois *v.*
 Pearce—Farr *v.*
 Pearson—Harper *v.*
 *Peck—McCardel *v.*
 Peel—Stevens *v.*
 Peto—Ponsardin *v.*
 Petter—Crookes *v.*
 Petter—Mack *v.*
 *Phalon—Burnett *v.*
 Pickering—Moet *v.*
 Pillow—Barnard *v.*
 Pinto-Leite—Carver *v.*
 *Plate—Derringer *v.*
 *Plate—Graham *v.*

Pottage—Hookham *v.*
 Price—Henry *v.*
 Priestley—R. *v.*
 Pritchard—Gee *v.*
 Provezende—Seixo *v.*

QUIDDINGTON—Robertson *v.*

RAGO—R. *v.*
 Ratcliff—Woollam *v.*
 Ray—Ledger *v.*
 Read—Giblett *v.*
 Reeves—Collins Co. *v.*
 Reynolds—Southorn *v.*
 Richardson—McDonald *v.*
 Ridgway—R. *v.*
 Riley—Springhead Spinning Co. *v.*
 Rodgers—Rodgers *v.*
 Roebuck—R. *v.*
 Roffey—Nixey *v.*
 Rooke—Green *v.*
 Ross—Marshall *v.*
 Rouch—Burfield *v.*
 Rowland—Scott *v.*
 Royden—Clover *v.*
 Rutherford—Llewellyn *v.*

SALMON—Morison *v.*
 Samson—Steinthal *v.*
 Saunders—Correspondent Newspaper Co. *v.*
 Scott—Scott *v.*
 *Searing—Howe *v.*
 Senate—Sedon *v.*
 Shakespear—Wheeler & Wilson Manufacturing Co. *v.*
 Shaw—Delondre *v.*
 Shaw—Farina *v.*
 Sheard—Chappell *v.*
 Sheffield Gas Consumers' Co.—Attorney-General *v.*
 Shepherd—Green *v.*
 Silverlock—Farina *v.*
 Silversides—R. *v.*
 Simms—Colburn *v.*
 Sims—Coles *v.*
 Slade—Jeudwine *v.*
 Sleep—R. *v.*
 Smith—Glenny *v.*
 Smith—Wedgwood *v.*
 Smith—R. *v.*
 *Smithson—Dale *v.*
 *Smithson—Stewart *v.*
 Souvazoglu—Harter *v.*
 *Spear—Amoskeag Manufacturing Co. *v.*
 *Spear—Fowle *v.*

*Spence—Williams *v.*
 *Stetson—Town *v.*
 Stevens—R. *v.*
 Stiff—Ingram *v.*
 *Stonebreaker—Stonebreaker *v.*
 Strange—Albert (Prince) *v.*
 Sunley—R. *v.*
 Suter & Coulson—R. *v.*
 Sweet—Archbold *v.*
 Swiss Condensed Milk Co.—Anglo-Swiss
 Condensed Milk Co. *v.*
 Sykes—Sykes *v.*

TAYLOR—Harrison *v.*
 Taylor—Taylor *v.*
 *Thomas—Colton *v.*
 Thompson—Crawshay *v.*
 Thompson—Isaacson *v.*
 Thorley's Cattle-Food Co.—Massam *v.*
 Till—Coslake *v.*
 Townsend—Page *v.*
 Tripp—Longman *v.*
 Truefitt—Perry *v.*
 Tudor—Tudor *v.*
 Turner—Beard *v.*
 Turpin—Dent *v.*
 Tylor—Davis *v.*
 *Tynberg—Messerole *v.*

*UHLER—Glendon Iron Co. *v.*
 Ullmer—Guinness *v.*

VICK—Edelsten *v.*

WAGNER—Lumley *v.*

Walker—Ailsopp *v.*
 Walker—Cheavin *v.*
 Walker—Collins Co. *v.*
 Wallis—Wallis *v.*
 Waimesley—Ainsworth *v.*
 Walter—Polhill *v.*
 Ward—Mulkern *v.*
 Ward—Tonge *v.*
 Waring—Wason *v.*
 *Wattles—Binninger *v.*
 Watson—Cooper *v.*
 Watson—Marshall *v.*
 Weaver—Franks *v.*
 Webster—Routh *v.*
 Webster—Webster *v.*
 Wedderburn—Wedderburn *v.*
 Weller—Fradella *v.*
 *Wells—Fetridge *v.*
 Wheatcroft—Ailsopp *v.*
 Whitaker—Darbey *v.*
 *White—Comstock *v.*
 White—Lazenby *v.*
 White—R. *v.*
 Whitehead—Bryson *v.*
 Whitwell—Standish *v.*
 *Wilder—Laird *v.*
 *Wilkes—Dayton *v.*
 Williams—Williams *v.*
 Williamson—Richards *v.*
 Willmett—R. *v.*
 Wilson—Singer Manufacturing Co. *v.*
 Winchester—Graveley *v.*
 Winchester—Longman *v.*
 *Winchester—Thomson *v.*
 Winyard—Yovatt *v.*
 *Woodruff—Smith *v.*
 *Wright—Heath *v.*
 Wright—Martin *v.*
 *Wright—Phalon *v.*

ADDENDA ET CORRIGENDA.

PAGE

- 3, note (b), add "And a trade mark may belong to the exporter and not to the manufacturer, *Robinson v. Finlay*, W. N. 1877, p. 237."
- 8, ,, (c), for "notes (e) and (f)," read "notes (c) and (f)."
- 9, line 14, the ";" should be placed after "(d)."
- 10, the decision in *Singer Manufacturing Co. v. Wilson*, was reversed in the House of Lords. See *post*, p. xxxiv.
- 16, note (e), add "And an official stamp or brand can never become a private trade mark, *Chase v. Mayo*, 7 Lathrop, 343."
- 24, ,, (c), for "24 W. R. 819," read "L. R. 3 Ch. D. 659."
- 26, ,, (a); for "11 H. & C.," read "11 H. L. C."
- 34, ,, (c), add "And see *Liebig's Extract of Meat Co. v. Hanbury*, 17 L. T. N. S. 298; *James v. James*, L. R. 13 Eq. 421; *Mitchell v. Condy*, 37 L. T. N. S. 268; *Condy v. Mitchell*, *ib.* 766; *Massam v. Thorley's Cattle Food Co.*, L. R. 6 Ch. D. 574; *Linoleum Manufacturing Co. v. Nairn*, W. N. 1878, p. 29; and *post*, pp. 64, 172."
- 35, ,, (b), add "Where a person who had used and registered the word 'Valvoline' in connexion with his trade mark on oil, sought to restrain the registration by another person of the word 'Valvoleum' in connexion with his totally different trade mark for oil, the Master of the Rolls refused the application on the ground that both words simply meant 'valve oil,' and that such a term could not be appropriated by any individual, and he instanced a case where Lord Romilly, M.R. had dismissed a suit of *Rowlands v. Bereidenbach*, in which Mr. Rowlands sought to establish a right to the word 'Macassarine.' *In re Horsburgh*, February 2nd, 1878. In *Linoleum Manufacturing Co. v. Nairn*, W. N. 1878, p. 29, the Plaintiffs had invented and patented a new kind of floor covering which they named 'Linoleum;' in an action by them, after the expiration of the patents, to restrain the use of the name by other persons, Fry, J., refused to prohibit the use of the appropriate name of the article, saying that 'by using the name "linoleum" during the time when no one else could make the article the Plaintiffs had not acquired an exclusive right to it.' In *Bulloch, Lade & Co. v. Gray*, 19 Journ. of Jurisp. 218, the Sheriff of Lanarkshire held that 'Loch Katrine Whiskey' only meant whiskey made with water from that lake."
- 38, ,, (h), the reference for "*Cheavin v. Walker*" should be "L. R. 5 Ch. D. 850."
- 39, ,, (c), for "L. R. 18 Ex.," read "L. R. 18 Eq."
- 42, ,, (f), add "In *Siegert v. Findlater*, W. N. 1878, p. 14, Fry, J., restrained the use by the Defendant of the term 'Angostura Bitters,' by which the Plaintiffs' goods were known; and the fraudulent use of the words 'St. James' cigarettes' has been restrained in America, *Kinney v. Basch*, 1 'Trade Marks,' 183."
- 46, ,, (b), add "In *Carver v. Bowker*, Nov. 10th, 1877, 1 'Trade Marks,' 252, the V.-C. of Lancaster held that the plaintiffs' right to certain initials was proved, but that a true trade mark could not consist of mere numerals. On the other hand, the Supreme Court of New York has restrained the fraudulent use of the symbol '½,' *Kinney v. Basch*, *ib.* 183."
- 49, ,, (c), add "No length of exclusive user of an official stamp by an official person, in his official capacity, can give him a private right therein, *Chase v. Mayo*, 7 Lathrop, 343."
- 59, line 8, for "omitting," read "varying."
- 59, note (i), add "And see *Mitchell v. Condy*, 37 L. T. N. S. 268; *Condy v. Mitchell*, *ib.* 766."
- 60, ,, (d), for "*Millbourn*," read "*Milbourn*." Add "And see *Mitchell v. Condy*, 37 L. T. N. S. 268; *Condy v. Mitchell*, *ib.* 766."
- 62, ,, (b), add "See *In Re Powell*, 1 'Trade Marks,' 237."
- 67, line 4 from bottom, for "manufacturer," read "manufacture."

PAGE

- 68, note (c), add "In *Metzler v. Wood*, Dec. 17th, 1877, V.-C. Malins held that the title and general appearance of the title page of 'Hemy's new and revised edition of Jousse's Royal Standard Pianoforte Tutor,' was calculated to deceive persons intending to purchase 'Hemy's Royal Modern Tutor for the Pianoforte,' and an injunction was granted."
- 73, ,, (d), add "But see *Singer Manufacturing Co. v. Wilson*, in the House of Lords, p. xxxiv., *infra*."
- 75, ,, (c), add "*Mitchell v. Condry*, 37 L. T. N. S. 268; *Condry v. Mitchell*, *ib.* 766; *Wilson v. Maxfield*, L. J. Notes of Cases, 1875, p. 51."
- 78, ,, (k), for "L. R. 1 h.," read "L. R. 1 Ch."
- 90, ,, (c), add "And see *R. v. Foster*, 13 Cox, 393."
- 110, ,, (c), add "Where an auctioneer, in contempt of an injunction, offered for sale 'Vanity Fair' cigarettes, supposing the notice of injunction served on him not to be properly authenticated, but no sale was effected, V.-C. Malins made no order for committal, on the Defendant apologizing, submitting to the injunction, and paying all the costs. *Marcovitch v. Bramble, Wilkins, & Co.*, Jan. 24th, 1878."
- 112, line 9 from bottom, for "were," read "was."
- 113, note (a), add "In *Robinson v. Finlay*, W. N. 1877, p. 237, it was held that, under the circumstances, a certain trade mark on cotton cloths belonged to the exporter and not to the manufacturer."
- 115, ,, (a), add "And see *Twentsche Stoom Bleekery Goor v. Ellinger & Co.*, 26 W. R. 70."
- 124, ,, (d), add "Thus in *Re Hyde & Co.*, W. N. 1878, p. 10, it was held that the words 'Bank of England' had long ceased to be a trade mark in respect of sealing-wax, by reason of the user for six years of those words on sealing-wax by persons other than the original inventors, without interference by the latter, and the registration of the lapsed trade mark was accordingly rescinded."
- 147, ,, (d), add "*Twentsche Stoom Bleekery Goor v. Ellinger & Co.*, 26 W. R. 70."
150. It appears to be now unnecessary to prove actual fraud in cases of trade name: see *Singer Manufacturing Co. v. Wilson*, in the House of Lords, *post*, p. xxxiv.
- 153, note (a), add "And see *Mitchell v. Condry*, 37 L. T. N. S. 268; *Condry v. Mitchell*, *ib.* 766 (The Condry's Fluid Co.), and *Massam v. Thorley's Cattle Food Co.*, L. R. 6 Ch. D. 574 (Thorley's Cattle Food Co.), in both of which cases the injunction was refused."
- 153, ,, (f), add "In *Milner v. Reed*, Feb. 3rd, 1870, V.-C. Wickens (when Vice-Chancellor of Lancaster) restrained the use of the name 'The Oldfield Lane Doctor.' See Bryce on Trade Marks, p. 90; In *Braham v. Reachin*, Fry, J., W. N., 1878, p. 43, the principal Plaintiff and her trustees were owners of all the collieries within the parish of Radstock, which they had formerly designated 'The Radstock Coal Works,' but they had since used the term 'Radstock Collieries,' coupled with the Plaintiff's name. The Defendants, who had collieries within the Radstock coal district, but not in the parish, and raised coal of the quality known as 'Radstock coal,' called themselves 'The Radstock Colliery Proprietors,' and were restrained by injunction." (See p. xxxiv. for form of injunction.)
- 155, ,, (d), after *Dence v. Mason*, W. N. 1877, p. 23, add, "the injunction in this action was made perpetual by V.-C. Malins at the hearing, Feb. 12th, 1878."
- 160, ,, (b), add, "But in *Charleson v. Campbell*, Court of Session Cases, 4th Ser. IV. 149, the Scotch Court held that the proprietor of an hotel called 'The Station Hotel' was not entitled to restrain the use by the proprietor of another hotel in the same neighbourhood from calling his 'The Royal Station Hotel,' considering that the term 'Station Hotel' was a mere descriptive appellation, in which there could be no monopoly, and that, in any case, the addition of the word 'Royal' would afford sufficient distinction."
- 161, note (b), add "And see *Heinrichs v. Berndes* (M. R.), W. N. 1878, p. 10; L. J. Notes of Cases, 1878, p. 11."

- PAGE
- 166, „ (e), add “ In *Reid v. Sibbald*, 18 Journ. of Jurisp. 392, the Sheriff of Linlithgowshire restrained a tradesman, named Sibbald, from sending threatening letters to his debtors, signed “ Andrew Roberts,” or “ Roberts” with any other christian name, at the instance of a sheriff’s officer named ‘ William Roberts,’ who might be brought into discredit in the discharge of his duties.”
- 172, „ (d), add “ And see *Thorley’s Cattle Food Co. v. Massam*, L. R. 6 Ch. D. 582.”
- 173, „ (a), add “ In *Dence v. Mason*, V.-C. M. Feb. 12th, 1878, the Defendant was restrained from styling himself the ‘ original inventor,’ or ‘ original discoverer’ of the Essence of Beef, the V.-C. holding that even if he had been the first to actually compound the article, which was not satisfactorily proved, he was not entitled to make such statements, inasmuch as he was in the employ of the Plaintiff’s predecessor in business at the time when he said he made it for the first time.”
- 177, „ (a), add “ *Mitchell v. Condy*, 37 L. T. N. S. 268; *Condy v. Mitchell*, *ib.* 766.”
- 180, „ (c), add “ And as to the connexion between trade marks and goodwill, see *Dickson v. McMaster & Co.*, 18 Irish Jurist, 202.
- 181, „ (c), for “ p. 266,” read “ p. 267c.”
- 184, „ (b), add “ See *Smith v. Smith*, 4 Wend. 468.”
- 188, „ (c), add “ *Mitchell v. Condy*, 37 L. T. N. S. 268 ; *Condy v. Mitchell*, *ib.* 766.”
- 192, „ (a), add “ *Lee v. Ehrhart*, 19 L. T. N. S. 637 ; *Smith v. Smith*, 4 Wend. 468 ; *Sander v. Hoffman*, 19 Sickels, 248.”
- 192, „ (d), add “ Compare *Lee v. Ehrhart*, 19 L. T. N. S. 637, where it was held that there was no breach.”
- 192, „ (e), add “ And see *Smith v. Smith*, 4 Wend. 468 ; *Sander v. Hoffman*, 19 Sickels, 248.”
- 193, „ (e), add “ Where one R. Brand, who had been induced to enter into partnership with F. Mason, in order that his name might be used so as to deceive the public by its similarity to the name of ‘ Brand & Co.’ retired from the partnership and refused permission to F. Mason to continue the use of his name, it was held that the former partnership gave no right to its continued use. *Dence v. Mason*, V.-C. M. Feb. 12th, 1878. And see *Dickson v. McMaster & Co.*, 18 Irish Jurist, 202.—212.
- 195, „ (a), add “ And see *Mitchell v. Condy*, 37 L. T. N. S. 268 ; *Condy v. Mitchell*, *ib.* 766.”
- 195, „ (d), add *Dickson v. McMaster & Co.*, 18 Irish Jurist, 202.
- 199, „ (a), add “ The injunction was made perpetual at the hearing, V.-C. M. Feb. 12th, 1878.”
- 216, „ (b), add “ In *Re Hyde & Co.*, W. N. 1878, p. 10, on the motion of various firms aggrieved, the Master of the Rolls made an order rectifying the register by the removal therefrom of the words ‘ Bank of England,’ which had been registered as a trade mark on sealing wax, but were in fact common to the trade.”
- 217, „ (c), add “ In *Re Farina*, 26 W. R. 261, V.-C. Hall refused to restrain the registration by one person of a coat of arms which formed an important part of the registered trade mark of another person, on the ground that the simple medallion could not be mistaken for the opponent’s compound trade mark, and stated that in his opinion the question whether registration should be allowed or not ought to depend on this—whether the opponent would, independently of the Registration Acts, have been entitled to restrain the use by the applicant of the mark which he proposed to register. And see *Ex parte Orr Ewing & Co.*, 47 L. J. Ch. 180.”
- 217, „ (d), add “ The words ‘ calculated to deceive’ in this part of § 6 refer to an element of deception inherent in the mark itself, without regard to any comparison with other marks, such as an improper use of the word ‘ patent,’ so that a mark which is the first of a kind to be registered may yet contain words ‘ calculated to deceive’ within this. *Per* Sir G. Jessel, M.R. In *Re Horsburgh*, Feb. 2nd, 1878.”
- 232, at end of rule 29, add note (b). “ In *In re Powell*, 1 ‘ Trade Marks,’ 237, two owners of the same mark were registered by order of the Court.”

PAGE

235, note to rule 43, add "In *In re Salamon*, 1 'Trade Marks,' 135, where the question was one of title to a trade mark, and as to its user by the applicant, the Master of the Rolls directed an action to be brought to try the right, and said that each case should be mentioned to the Court for a direction; simple questions of law should be tried on special case; of fact, on motion; of directions as to carrying out the Act, by summons in chambers. Where the King of Saxony, as the registered proprietor of certain trade marks on porcelain, opposed the registration of certain marks by a person named Elb, V.-C. Hall directed the application on the part of the King to be made by way of motion, the applicant for registration to have liberty to move with notice that day week for a direction to have the matter brought on in some other way: *Ex parte the King of Saxony*, 1, 'Trade Marks,' 245. And see *Ex parte Orr Ewing & Co.*, 47 L. J. Ch. 180, and *In Re Farina*, 26 W. R. 261. So of an application to remove a mark from the register. *In Re Hyde & Co.*, W. N. 1878, p. 10. *In Re Horsburgh*, M. R. Feb. 2nd, 1878, came on as an adjourned summons; and so, too, *In Re Powell*, 1 'Trade Marks,' 237."

256, line 9 from bottom, for "1875-6," read "1875-7."

211. After form 22, add

22a. *BRAHAM v. BEACHIM*, Feb. 12th, 1878.

Name of Colliery.—Injunction until certain events.

Injunction restraining the Defendants, &c., "unless and until they shall acquire a colliery or coal mine within the parish of Radstock, in the county of Somerset, from trading under, or using the name or style of 'The Radstock Colliery Proprietors,' or any other name or style signifying or implying that the Defendants are the proprietors of any collieries or coal mines at Radstock. And an injunction restraining the Defendants, &c., until they shall have become authorized to sell or supply coal raised or gotten from a colliery or coal mine within the parish of Radstock, from using any name or style signifying or implying that they are selling or supplying, or are authorized to sell or supply, coal raised or gotten from any colliery or coal mine within the parish of Radstock, and from using any name or style of 'The Radstock Collieries,' or otherwise infringing the trade mark, or name, or style of 'The Radstock Collieries,' used or adopted by the Plaintiffs in respect of the business of their collieries and coal mines at Radstock aforesaid."—Fry, J.

<i>Massam v. Thorley's Cattle Food Co.</i>	is now reported at	L. R. 6 Ch. D. 574.
<i>Thorley's Cattle Food Co. v. Massam</i>	" "	L. R. 6 Ch. D. 582.
<i>Moët v. Pickering</i>	" "	L. R. 6 Ch. D. 770.
<i>In re Mitchell</i>	" "	L. R. 7 Ch. D. 36.
<i>Ex parte Orr Ewing & Co</i>	" "	47 L. J. Ch. 180.
<i>In re Walkden Aërated Waters Co.</i>	" "	1 "Trade Marks," 39.

In *Singer Manufacturing Co. v. Wilson*, on appeal, Dec. 13th, 1877, the House of Lords reversed the decision in the courts below (by which the Plaintiffs had been held to fail on their own evidence), without prejudice to any question in the case, and remitted the case to the Chancery Division, with liberty to the Defendants to apply for leave to adduce *virâ voce* evidence in reply to the Plaintiffs' evidence, and liberty to the Plaintiffs and Defendants to apply to cross-examine, and directed the Court to dispose of the case upon the whole of the evidence; thus holding, in effect, that where a name is used and known as indicating a particular maker's goods, there may be infringement without actual fraudulent intention on the part of the infringer, even though the latter has not placed the name upon his goods, if he has otherwise so acted as to produce deception; that in the case in question the Plaintiffs had shown a *prima facie* case, but that, inasmuch as the Plaintiffs' evidence only was before their Lordships, they were not in a position to decide finally whether the name "Singer" was really indicative of the Plaintiffs' manufacture or of a principle of construction, or whether the Defendants' conduct was in fact calculated to deceive.

The decision in *Condy v. Mitchell*, the cross suit to *Mitchell v. Condy*, 37 L. T. N. S. 268, has been affirmed on appeal, *ib.* 766.

THE LAW OF TRADE MARKS.

CHAPTER I.

GENERAL INTRODUCTION.

THE general principle upon which the Courts exercise jurisdiction in the case of trade marks is, that "a man is not to sell his own goods under the pretence that they are the goods of another man; he cannot be permitted to practise such a deception, nor to use the means which contribute to that end. He cannot, therefore, be allowed to use names, marks, letters, or other *indicia* by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another person" (a). "Supposing the rival trader to have obtained celebrity in his manufacture, he is entitled to all the advantages of that celebrity, whether resulting from the greater demand for his goods, or from the higher price which the public are willing to give for them, rather than for the goods of other manufacturers whose reputation is not so high. Where, therefore, a manufacturer has been in the habit of stamping the goods which he has manufactured with a particular mark or brand, so that thereby persons purchasing goods of that description know them to be of his manufacture, no other manufacturer has a right to adopt the same stamp. By doing so he would be substantially representing the goods to be of the manufacture of the manufacturers who had previously adopted the stamp or mark in question, and so would or might be

General principle of trade-mark law.

(a) Per Lord Langdale, M. R., in *Perry v. Truefitt*, 6 Beav. 66.

depriving him of the profit he might have made by the sale of the goods which, *ex hypothesi*, the purchaser intended to buy. The law considers this to be wrong towards the person whose mark is thus assumed, for which wrong he has a right of action, or, which is the more effectual remedy, a right to restrain by injunction the wrongful use of the mark thus pirated" (a).

Function of trade mark.

The function of the trade mark is to give the purchaser a satisfactory assurance of the make and quality of the article he is buying. Thus, it was said by Lord Cottenham, C. (b), "take a piece of steel; the mark of the manufacturer from whom it comes is the only indication to the eye of the customer of the quality of the article; so it is of blacking, or any other article of manufacture, the particular quality of which is not discernible by the eye." It is on the faith of the mark being genuine, and representing a quality equal to that which he has previously found a similar mark to indicate, that the purchaser makes his purchase.

Mere statement of quality no trade mark.

Yet, while the object of the trade mark is to indicate quality, a mere English adjective, or word in common use (c), which indicates quality and nothing more, not serving to connect the goods with any particular manufacturer or seller, cannot be appropriated as a trade mark, for no person can be permitted to exclude others from the use of words common to all, even in their application to goods, and without such exclusive appropriation, the mark is a mere statement, offering no guarantee, and making no one responsible for its correctness.

Exception.

Marks, however, which do serve to indicate the production of a certain manufacturer, though at the same time subject to variation for the purpose of denoting different qualities, are entitled to protection (d).

(a) Per Lord Cranworth, C., in *Scizo v. Proczende*, L. R. 1 Ch. 192.

(b) In *Spottiswoode v. Clarke*, 2 Ph. 154.

(c) *Braham v. Bustard*, 1 H. & M. 447; *Raggett v. Findlater*, L. R. 17 Eq. 29. See *In re Barrows*, L. R. 5 Ch. D. 353.

(d) *Hirst v. Denham*, L. R. 14 Eq. 542. See *Stokes v. Landygraff*, 17 Barb. 608; R. Cox, 137; *Gillott v. Kettle*, 3 Duer, 624; R. Cox, 148; *Gillott v. Esterbrook*, 47 Barb. 455; R. Cox, 340; 3 Sickels, 374.

The use of the trade mark is not in all cases to designate the maker of the substance to which it is attached, though that is usually so ; it may indicate some other person who has expended labour on the article, so that, as finished, it owes some portion of its value to him. Thus, in a case in the Supreme Court of New York (*a*) it was held that, where one person manufactured cotton cloths, and another printed them, the mark was indicative of the printer and not of the original manufacturer.

Trade mark not always indicative of actual manufacturer.

Again, a trade mark may be so composed as to indicate that the goods have been examined and selected by a person of known ability, so that they have attributed to them such value as his approval can give, and his reputation depends upon their corresponding to their alleged quality. In such a case, therefore, the trade mark belongs to the selector and not to the manufacturer (*b*).

May be indicative of selector.

To go farther, it is not necessary that the goods to which the mark is affixed should be manufactured goods at all ; it is sufficient if the vendors, whose property the trade mark is, have alone the opportunity of procuring the article in question, so that the trade mark indicates accurately the source from which the article is derived. This is particularly the case with mineral waters and similar productions (*c*). A mere name, however, for a natural product which is available by all the world, cannot be exclusively appropriated by an individual, who possesses no exclusive access to its source (*d*).

May indicate natural products.

The protection of trade marks is beneficial to the public, since it enables them to buy, with confidence that they are getting what they require ; at the same time it is

Advantages of use of trade marks.

(*a*) *Amoskeag Manufacturing Co. v. Garner*, 55 Barb. 151; R. Cox, 541.

(*b*) *Hirsch v. Jonas*, L. R. 3 Ch. D. 584.

(*c*) *Apollinaris Co. v. Norrish*, 33 L. T. N. S. 242 ; *Apollinaris Co. v. Edwards*, Seton, 4th ed. 237 (Apol-

linaris Water) ; *Radde v. Norman*, L. R. 14 Eq. 348 (Leopoldshall Kainit); *Congress and Empire Spring Co. v. High Rock Congress Spring Co.*, 57 Barb. 526; R. Cox, 599 (Congress Spring Water).

(*d*). *Young v. Macrae*, 9 Jur. N. S. 322.

beneficial to the manufacturer, since it affords him the means of securing the benefit of the custom which he deserves and which is intended for him. So advantageous did the adoption of a trade mark speedily prove to be that, in 1742, Lord Hardwicke, C., said, that "every particular trader had some particular mark or stamp" (a).

Southern v. Howe.

In the earliest case on record (b) damages were given for the infringement of a mark on cloth, though it is not clear from the reports whether the plaintiff was a cloth-maker whose mark had been pirated, or a purchaser who had been deceived into buying the wrong goods.

Blanchard v. Hill.

In *Blanchard v. Hill* (c), however, in 1742, Lord Hardwicke refused to protect the "Great Mogul" stamp on cards, deciding, in effect, that there was no right of property in a trade mark, though actual fraud might be restrained or punished, as in *Southern v. Howe* (d). The decision seems in great measure to have been founded upon a dread of setting up a monopoly, the distinction between a trade mark and a patent not being clearly present to his lordship's mind.

Singleton v. Bolton.

In *Singleton v. Bolton* (e), in the Court of King's Bench (1783), Lord Mansfield, C. J., said that if the defendant had sold a medicine of his own under the plaintiff's name or mark, that would be a fraud for which an action would lie; but the name of an original inventor being the trade mark in question, evidence was necessary of the medicine having been sold as if prepared by the plaintiff, a distinction being thus drawn between the transmissibility of a name and that of other trade marks, which has since, in Equity at least, been removed (f).

Sykes v. Sykes.

In 1824, it was for the first time perceived that goods sold with a pirated mark attached, though they might not

(a) *Blanchard v. Hill*, 2 Atk. 484, 485.

(b) *Southern v. Howe*, Poph. 141; 3 Cro. 471; 2 Rolle, 28.

(c) 2 Atk. 484.

(d) *Ubi supra*.

(e) 3 Doug. 293.

(f) See *Leather Cloth Co. v. American Leather Cloth Co.*, 1 H. & M. 271; 33 L. J. Ch. 199; 11 H. L. C. 523, and other cases.

deceive an immediate purchaser, yet might deceive an ultimate purchaser, who might have no notice of the fraud (a).

This case marks the last stage of development in the law of trade marks as recognised at Common Law (b); and the requisites necessary to entitle a plaintiff to recover damages are, in accordance with the judgment of Sir T. Wilde, C. J., in *Rodgers v. Nowill* (c), that he shall have been accustomed to use a certain mark upon goods of his manufacture to denote that that is so, that that mark is known in the trade (d), and that the defendant has imitated the mark and sold goods bearing it, as and for the plaintiff's goods, with intent to defraud (e).

Requisites to entitle to damages at Common Law.

In Equity, the protection to the manufacturer and the public was carried a stage farther in 1833 by the decision of Lord Cottenham, in *Millington v. Fox* (f), since which time it has not been necessary to prove an actual fraudulent intention, the remedy being obtainable if the defendant's conduct has been such as to produce the effects of fraud, though he may, in fact, have acted in perfect innocence.

Equity—*Millington v. Fox*.

It is, however, "no part of the duty of the Court to enforce the observance of the dictates of morality" (g), and, therefore, if a defendant "has an abstract right to do what he has done, the Court must permit it, however opposed to one's moral sense" (h). The Court will not interfere,

Limits to Court's interposition.

(a) *Sykes v. Sykes*, 3 B. & Cr. 541.

(b) See per Sir G. Mellish, L. J., in *Singer Manufacturing Co. v. Wilson*, L. R. 2 Ch. D. 434—454.

(c) 5 C. B. 109.

(d) Registration, provided the connexion with the goodwill of the business is observed, is now equivalent to public use of a mark: Trade Marks Act, 1875, § 2.

(e) See, however, the Judicature Act of 1873, § 25, by which the rules of Equity are to prevail.

(f) 3 My. & Cr. 338. In *Gout v. Aleploglu*, 5 Leg. Obs. 496, the Vice-Chancellor of England held that

"the plaintiff had acquired by long previous usage *the exclusive right*" to his trade marks, but the report is too brief to show whether that expression was employed in its full meaning. *Hogg v. Kirby*, 8 Ves. 215 (1803); and *Day v. Binning*, C. P. Cooper, 489, and 1 Leg. Obs. 205 (1831), were cases of fraudulent competition; and in *Henry v. Price*, 1 Leg. Obs. 364 (1831), there were circumstances of fraud.

(g) Per Sir W. P. Wood, V.-C., in *Batty v. Hill*, 1 H. & M. 264.

(h) *Braham v. Bustard*, 1 H. & M. 447.

simply on the ground that there is a misrepresentation, unless some right belonging to the plaintiff has been interfered with (a).

Acquisition of trade marks.

The mode of acquiring a right to a trade mark is now regulated by the Trade Marks Registration Acts, 1875-7 (b). The trade mark must accord with the definition contained in section 10 of the Act of 1875 (c), and not be obnoxious to the restrictions of section 6, and it must be registered, or, if it has been used before the passing of the Act, application must have been made for registration, and have been refused, in which case a certificate of refusal can be obtained from the registrar (d), and the unsuccessful applicant will retain whatever rights may have been his before the Act. For a mark to have been used before the Act, it is sufficient for a vendible article to have been actually in the market, bearing the mark in question; it is not necessary for this to have been the case for any length of time (e).

Appropriation to special classes of goods.

A trade mark must be registered as belonging to particular goods or classes of goods (f), according to the classification of goods contained in the First Schedule to the Rules under the Trade Marks Acts, and trade marks used before the Act of 1875 can only be protected in respect of the same general classes of goods as those to which they have been habitually applied, for no man could be so deceived as to suppose that he was buying A.'s linen, because he saw the same mark as A.'s on B.'s iron (g).

Assignment and transmission.

A trade mark is assignable and transmissible, but only in connexion with the goodwill of the business concerned

(a) See *Batty v. Hill*, *ubi supra*.

(b) 38 & 39 Vict. c. 91; 39 & 40 Vict. c. 33; 40 & 41 Vict. c. 37.

(c) Which, in the case of new marks, excludes mere words or combinations of letters and numerals: *Ex parte Stephens*, L. R. 3 Ch. D. 659.

(d) Section 2 of the Amendment

Act.

(e) Per Lord Westbury, C., in *McAndrew v. Barrett*, 33 L. J. Ch. 561.

(f) Trade Marks Act, 1875, § 2.

(g) *Hall v. Barrows*, 33 L. J. Ch. 204; *Ainsworth v. Wulmsley*, L. R. 1 Eq. 518.

with the goods or classes of goods to which it relates (*a*). A trade mark cannot exist in gross and unattached to specific articles (*b*), for, if that could be so, the mark might come to be an instrument of deception, instead of a guarantee of genuineness (*c*). In an assignment of the business and goodwill, the trade mark passes as a matter of course (*d*), or, if specially excepted, must cease to be available by the vendor. On the death of a registered proprietor, his legal personal representative acquires the title to the mark (*e*). Subsequent registered proprietors stand in the same position, under § 4 of the Trade Marks Act of 1875, as if their title were a continuation of the title of the first registered proprietor (*f*).

It has been held in bankruptcy that a trade mark passes Bankruptcy. to a trustee in bankruptcy, as being "goods and chattels" within § 15, sub-s. 5, of the Bankruptcy Act, 1869 (*g*).

A trade mark may be lost, as by its coming to be com- Trade mark
lost. monly applied to a special article, in which case it becomes *publici juris*; thus "Worcestershire sauce," which might at one time have been protected, could no longer be so when it had come into common use (*h*). So, too, if a person abandons a suit which he has undertaken to restrain infringement, he abandons his exclusive right (*i*). No trade mark, however, first used since the passing of the Act of 1875, can consist of a mere word (*k*), nor, there-

(*a*) Trade Marks Act, 1875, § 2; and see *Hall v. Barrows*, 33 L. J. Ch. 204; and *Dixon Crucible Co. v. Guggenheim*, 2 Brewster, 321; R. Cox, 559.

(*b*) *McAndrew v. Barrett*, 33 L. J. Ch. 561; *Leather Cloth Co. v. American Leather Cloth Co.*, *ib.* 199; 11 H. L. C. 523; *Dixon v. Guggenheim*, *ubi supra*.

(*c*) *Cotton v. Gillard*, 44 L. J. Ch. 90.

(*d*) *Shipwright v. Clements*, 19 W. R. 599.

(*e*) Rule 25.

(*f*) And see *Walton v. Crowley*,

3 Bl. C. C. 440; R. Cox, 166.

(*g*) *Ex parte Young*; *Re Lemon Hart & Son*, per Mr. Registrar Spring-Rice, sitting as C. J., Feb. 3, 1877; and see *Kelly v. Hutton*, L. R. 3 Ch. 708; *Hudson v. Osborne*, 39 L. J. Ch. 79; and cases at p. 59, note (*e*).

(*h*) *Lea v. Millar*, M. R. July 26, 1876, Seton, 4th ed. 242; and see per Sir G. Mellish, L. J., in *Ford v. Foster*, L. R. 7 Ch. 611.

(*i*) *Browne v. Freeman*, 12 W. R. 305.

(*k*) *Ex parte Stephens*, L. R. 3 Ch. D. 659.

fore, ever become a mere appellation. A registered trade mark may be removed from the register, after five years from registration, if the registered proprietor is not carrying on any business concerned with the goods in respect of which the mark was registered (*a*).

Infringement.

When once a person has acquired a right in a trade mark, any infringement of that right will form a ground for the interference of the Court. For the Court to interfere there must be fraud, for where there is no fraud there is no wrong to be redressed and no remedy applicable. But it is not necessary that there should be fraud in the sense that the infringer knowingly and wilfully makes a fraudulent attempt to appropriate to himself the fruits of another's reputation, if he acts so that custom intended for another is diverted to himself, and that the public buy and pay for one thing while intending to buy and pay for another, so that both vendor and purchaser are injured, there is fraud, and the animus of the infringer is unimportant (*b*). Even if the purchaser is told that the goods are the goods of the actual seller, but the imitated mark is upon them, there is ground for interference, since the goods may be resold bearing the mark, but without the information necessary to correct the statement thereby made (*c*). There is infringement if ordinary purchasers, purchasing with ordinary caution, are likely to be misled (*d*); on the one hand the Court will not strain its jurisdiction to protect fools and idiots (*e*); on the other hand, it will not require such minuteness of imitation as to deceive persons of unusual sagacity and information.

Remedies for infringement.

Infringement is criminally punishable under an indictment for obtaining money by false pretences (*f*), or in accordance with the special provisions of the Merchandise

(*a*) Rule 34.

(*b*) See cases collected at p. 103, note (*b*).

(*c*) *Sykes v. Sykes*, 3 B. & Cr. 541; and cases at p. 96, notes (*e*) and (*f*).

(*d*) *Seixo v. Provezende*, L. R. 1 Ch. 192.

(*e*) *Singer Manufacturing Co. v. Wilson*, L. R. 2 Ch. D. 434—47.

(*f*) See Ch. 5.

Marks Act, 1862 (*a*), expressly enacted to prevent such practices. The Common Law remedy is by an action on the case for damages caused by the offender's fraud (*b*). In Equity, the remedy is by injunction, together with an account, or damages, if preferred. The greater suitability of this form of remedy has occasioned the adjudication in Chancery of the great majority of trade-mark cases, and the carrying into operation of the Trade Marks Registration Acts is now further entrusted to the Chancery Division (*c*).

At Common Law, at all events until the Judicature Acts, it was necessary to prove knowledge of the plaintiff's rights and intentional deception on the part of the defendant (*d*) to obtain an injunction in Chancery; this has not been required since *Millington v. Fox* (*e*), in 1833. It may, however, be material with reference to the extent of the relief to be granted, since a plaintiff is only entitled to an account in respect of such user of his trade mark by the defendant as has been subsequent to the latter becoming aware of the prior ownership, or at least of the prior existence as a trade mark of the mark used by him (*f*).

A plaintiff who in other respects would be entitled to obtain a remedy against an infringer may yet be deprived of his right by reason of some fraudulent statement contained in his own trade mark (*g*), for "*ex turpi causâ non oritur actio*, and if the trade mark contains a false representation calculated to deceive the public, a man cannot by using that which is in itself a fraud obtain any right at all in the mark" (*h*).

(*a*) 25 & 26 Vict. c. 88.

(*b*) An injunction may now form part of the relief.

(*c*) Rule 42.

(*d*) *Rodgers v. Nowill*, 5 C. B. 109.

(*e*) 3 My. & Cr. 338.

(*f*) *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Cartier v. Carlile*, 31

Beav. 292; *Moct v. Couston*, 33 Beav. 578.

(*g*) See *Pidding v. How*, 8 Sim. 477; *Perry v. Truefitt*, 6 Beav. 66; and other cases at p. 127.

(*h*) Per Sir G. Mellish, L. J., in *Ford v. Foster*, L. R. 7 Ch. 611.

Fraudulent intention.

Plaintiff disentitled to relief.

When not
disentitled.

A mere collateral misrepresentation, not contained in the trade mark itself, and therefore not repeated at every transfer of the article, is not sufficient to disentitle the trade mark to protection (*a*).

Unauthorized
use of word
"patent," &c.
Distinction
between trade
mark and
patent.

A particular form of misstatement which has proved fatal in several cases has been the insertion or retention in a trade mark of the words "patent" or "patented," so as to indicate the protection of an existing patent, to which the article bearing the trade mark is not in fact entitled (*b*). The broad difference between a patent and a trade mark is that the public are prohibited and restrained from manufacturing any article protected by the former, so long as the protection exists, whereas the public are at full liberty to manufacture an unpatented article (*c*), and that according to the identical original process, and to say that they are so doing, and this is so whether the original makers use, or do not use, a trade mark upon their goods. What the subsequent manufacturers may not do is to put upon their goods the mark used by the original makers, so as to represent that such goods are the actual goods of the original makers and not merely equivalent goods made by others. The benefit conferred upon the public by the communication of a new invention, which after a limited period all can use, is the consideration in respect of which a monopoly of the invention is granted to the inventor for that limited period (*d*). Any attempt, therefore, to prolong the term of the patent by means of a trade mark will be discouraged (*e*).

As a trade mark is not the same thing as a patent, so it

(*a*) *Ford v. Foster, ubi supra.*

(*b*) See the cases in Ch. 7.

(*c*) This is quite clear in America as well as in this country. See *Thomson v. Winchester*, 19 Pick. 214; R. Cox, 7; *Coffeen v. Brunton*, 4 McLean, 516; R. Cox, 82; *Davis v. Kendall*, 2 R. I. 566; R. Cox, 112; *Comstock v. White*, 18 How.

Pr. R. 421; R. Cox, 232; *Phalon v. Wright*, 5 Phila. 464; R. Cox, 307; *Falkinburg v. Lucy*, 35 Cal. 52; R. Cox, 448.

(*d*) *Cheavin v. Walker*, L. R. 5 Ch. D. 850—63.

(*e*) See per Sir G. Mellish, L. J., in *Singer Manufacturing Co. v. Wilson*, L. R. 2 Ch. D. 434—56.

is not the same as a copyright (a). A copyright, like a patent, relates to the substance of an article, but differs in that it has reference to a literary instead of a material production. A trade mark does not protect the substance of the article to which it is attached from being imitated, but it identifies an article and indicates the source to which that article is to be attributed. Trade mark not being copyright, registration of a trade mark, or, what comes to be much the same thing, a title of a book or paper, under the Copyright Acts, is unnecessary and useless (b).

Since trade marks are recognised throughout the world, and not merely in the manufacturer's own country, as indicative of his goods, so that the subjects of any country are liable to be defrauded by goods bearing an imitation of a foreign trade mark, and any manufacturer is liable to suffer by the forgery of his marks abroad, the right of property in a trade mark is not limited by territorial bounds (c), and aliens' marks are protected in the English Court in precisely the same manner as if they belonged to British subjects (d). The same is the case in the United States (e).

No conflict of laws has as yet arisen in the English Courts with respect to trade marks, though on two occasions such appeared likely to be the case. In *Farina v. Cathery* (f) the question was raised whether a Prussian manufacturer could be punished in this country for using a trade mark which he was entitled to use under Prussian law. It was held, however, that the mark was not identical with that to which a right had been acquired in Prussia.

(a) *Farina v. Silverlock*, 6 De G. M. & G. 214; *Collins Co. v. Cowen*, 3 K. & J. 428; *Correspondent Newspaper Co. v. Saunders*, 11 Jur. N. S. 540; *Kelly v. Hutton*, L. R. 3 Ch. 708; *Taylor v. Carpenter*, 11 Paige, 292; 2 Sandf. 603; R. Cox, 45; *Wolfe v. Barnett*, 24 La. Ann. 97; 13 Amer. Rep. 111.

(b) *Maxwell v. Hogg*, L. R. 2

Ch. 307; *Kelly v. Hutton*, L. R. 3 Ch. 708.

(c) *Derringer v. Plate*, 29 Cal. 292; R. Cox, 325.

(d) *Collins Co. v. Cowen*, 3 K. & J. 428; and cases at p. 48, note (a).

(e) *Taylor v. Carpenter*, 3 Story, 458; R. Cox, 14; and cases at p. 48, note (a).

(f) L. J. Notes of Cases, 1867, p. 134.

In *Compagnie Laferme v. Hendrickx* (a) there was a question whether a German manufacturer could acquire a right in England to the exclusive use of a trade mark consisting of the word "Laferme," a mere word not being allowed in Germany to constitute a trade mark; but as the plaintiff failed to satisfy the Court that he had been the first to use the word in Germany, no decision was given on the point.

Cases analogous to trade-mark cases.

Besides cases of infringement of trade marks proper, there are some other classes of cases nearly akin to the former, but differing from them in some important particulars, which yet require notice in connexion with the subject of trade marks, as where there is an unfair competition in trade contrived, not by imitation of trade marks, but by other forms of representation that one man's goods are another's. In such cases there is no room, as in trade-mark cases proper, for punishable, though innocent, infringement, there must be actual, wilful fraud, without which being proved a plaintiff must fail (b).

Trade names.

In imitations of trade names, again, used as such and not as trade marks on goods, there is a difference from trade-mark cases proper; there is a false representation, but it is a representation, not that certain goods are certain other goods, but that a certain establishment is a certain other establishment, the object being that the one establishment should obtain custom intended for the other. Such cases are not cases of trade mark, not being concerned with marks placed on vendible articles in the market (c), but still the Court has to proceed on much the same lines.

Goodwill.

All such cases, whether of trade mark, or trade name, or other unfair use of another's reputation, are concerned with an injurious attack upon the goodwill of a rival business; customers are diverted from one trader to another, and

(a) M. R., July 20, 1876. (c) *McAndrew v. Bassett*, 33 L. J. Ch. 561.
 (b) *Singer Manufacturing Co. v. Wilson*, L. R. 2 Ch. D. 434.

orders intended for one find their way to the other. Trade marks are really a branch of the goodwill of the business with which they are connected, representing it in the market, while the trade name over the shop represents it to the passer-by. It is by the devolution of the goodwill that that of the trade marks is regulated (*a*), they are in fact included in, and valued as part of, the goodwill (*b*); severed from it they cannot exist. /

(*a*) § 2 of Trade Marks Act, 1875; and see Rule 27 and Forms E & F in the 3rd Schedule to the

Rules.

(*b*) *Hall v. Barrows*, 33 L. J. Ch. 204.

CHAPTER II.

WHAT IS A TRADE MARK ?

What is a trade mark ?

THE first point which has to be considered in regard to the law of trade marks is, "What is a trade mark ?" with what class of objects is this branch of law concerned ? On the answer to this question must necessarily depend the principles to be applied in any given case, the most important point perhaps consisting in this, that in a case of alleged infringement of a true trade mark the plaintiff "has nothing more to do than to show that the trade mark has been taken" (a), while in a case of false representation, which does not amount to the infringement of a trade mark proper, "there, as in every other case of fraud—for it must be fraud—the case must be proved" (b).

A true trade mark must be affixed to the article.

The most important criterion by which a case of trade mark may be distinguished from a case of false representation not amounting to an infringement of trade mark, was thus described by Sir G. Jessel, M. R. (c): "The classes which have come before the Courts may, I think, be conveniently divided into two classes. The first class, which is the most numerous, consists of cases where the goods manufactured are distinguished by some description or device in some way or other affixed to the article sold. It may be description—that is, it may consist of a name or names or a lengthy description consisting of names

(a) Per Sir G. Jessel, M. R., in *Singer Manufacturing Co. v. Wilson*, L. R. 2 Ch. D. 434—442.

(b) *Ib.* 444.

(c) *Ib.* 440.

with superadded words and that description may be either affixed to, or impressed upon, the goods themselves by means of a stamp or an adhesive label, or it may be made to accompany the goods by being impressed or made to adhere to an envelope or case containing the goods.

“An illustration of the first class would be the common trade mark, which is either the name or the image of some known or unknown thing, actually impressed upon, or worked into, the material, or made to adhere to the surface of the material, or it may be not what is commonly known as a trade mark, a distinguishing mark which, perhaps, to a legal mind would be a trade mark, but some form of the material itself.” His Lordship then instanced a case recently before him in which the trade mark consisted of certain lines woven into the fringe of a certain make of cloth and continued—

“Sometimes you do not find anything put on the goods themselves, the reason often being that the goods are not capable of it; for instance, when there are liquids, upon which, of course, you cannot put a mark, and therefore a mark is put on the bottle containing the liquid, or on the cork which is in the bottle and helps to retain the liquid. These are again true trade marks, whether affixed in the shape of a label on a bottle of liquid, or in the shape of a device on the cork, or in the case of other goods, such as cigars, affixed to the box which contains the cigars, or the string which encircles them, they are in some way or other attached to the goods, and go along with the goods on sale. That I call the first class.”

As to the second class, his lordship said that “they are always cases of fraud. They are cases where the defendant, without putting any trade mark at all on his goods, or putting a trade mark which is admittedly different in substance from the trade mark, if any, of the plaintiff on

the goods, has represented the goods as being goods manufactured by the plaintiff. Here, again, the Court has to try the question of representation. What the defendant has said or has done must amount to a representation that the goods to be sold are the goods of the plaintiff, or that they are manufactured by the plaintiff. What amount of representation will be sufficient for that purpose must again depend, of course, on the facts of each particular case."

Singer v. Wilson.

In the case in question the trade mark actually affixed to their goods by the plaintiffs had not been copied, no positive fraud was proved, and the bill was accordingly dismissed with costs. The Court of Appeal affirmed the decision, and endorsed the distinction drawn by the Master of the Rolls, Sir W. M. James, L. J., remarking that in a case not purely and simply of trade mark "actual fraud must be proved" (a).

Registration equivalent to public use.

For a trade mark to be protected, it must therefore not only be applicable, but be actually applied to a "vendible article" (b) in the market; the registration, however, of a trade mark under the Acts of 1875-77 (c) is equivalent to public use of the same (d).

Not every mark applied can be a trade mark.

But it is not everything that can be marked on goods that will constitute a valid trade mark, a mere descriptive adjective, for instance, cannot be appropriated from the rest of the world (e). It is necessary, therefore, to distinguish true trade marks from other marks, which, though affixed to goods, yet cannot be claimed as the exclusive trade marks of any individual.

Definition of trade mark in

For the purposes of the Merchandise Marks Act, 1862 (f),

(a) L. R. 2 Ch. D. 452.

(b) See per Lord Westbury, C., in *McAndrew v. Bassett*, 33 L. J. Ch. 561-566.

(c) 38 & 39 Vict. c. 91; 39 & 40 Vic. c. 33; 40 & 41 Vict. c. 37.

(d) § 2 of Act of 1875.

(e) Cf. *Raggett v. Findlater* L. R. 17 Eq. 29; *Braham v. Bustard*, 1 H.

& M. 447. As to trade marks composed of an essential particular with an addition varied to indicate different qualities, and how such marks should be registered, see *In re Barrows*, L. R. 5 Ch. D. 353.

(f) 25 & 26 Vict. c. 88, § 1.

a very wide definition was adopted for the word "trade mark," a definition too little precise to be of much practical use outside of that Act. Merchandise
Marks Act,
1862

The Trade Marks Registration Act of 1875 (a), however, contains a definition, which is not only valuable in itself, but is of great practical importance, qualifying, as it does, for registration and the accompanying advantages, all marks which satisfy its requirements. Definition in
Trade Marks
Registration
Act, 1875.

The definition in question is as follows :

"For the purposes of this Act a trade mark consists of one or more of the following essential particulars; that is to say—

A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

A written signature or copy of a written signature of an individual or firm; or

A distinctive device, mark, heading, label, or ticket (b); And there may be added to any one or more of the said particulars any letters, words, or figures (c), or combination of letters, words, or figures; also

Any special and distinctive word or words, or combination of figures or letters used as a trade mark before the passing of this Act may be registered as such under this Act."

The effect of this definition is to greatly restrict the variety of marks now capable of adoption for the first time by a manufacturer, for he will be unable to register or obtain protection under the Act for a new mark which does not comply with this definition by containing some one of the three first mentioned essential particulars, although Effect of this
definition.

(a) § 10.

(b) This does not include a mere word or combination of letters: *Ex*

parte Stephens, L. R. 3 Ch. D. 659.

(c) "Figures" means "numerals:" *Ex parte Stephens, ubi supra.*

previously to the Act it would have been perfectly good. However, a manufacturer is entitled under § 10 to register any distinctive mark used as such *before* the passing of the Act (*a*), so obtaining for it the benefits of the Act, or, in case of registration being refused, to demand a certificate of such refusal (*b*), the possession of which will place him in a position to exercise whatever rights he may have had before and independently of the Acts.

Its advantages.

But while valid existing trade marks are properly preserved, the effect of this definition in the future will be beneficial, since all new trade marks will necessarily possess distinctive features, and, in particular, the public will be free to apply to goods made after an unpatented model their appropriate name (*c*), though given them by the first inventor, and by which not the manufacturer, but the composition or principle has become known (*d*).

First class of trade marks.
—A name.

In accordance with the above definition, the first species of trade mark consists of a name of an individual or firm, printed, impressed, or woven in some particular and distinctive manner, to which essential particular may be added any letters, words, or figures, or combination of letters, words, or figures.

How names differ from other trade marks.

There is between a name of an individual or firm used as a trade mark, and a fancy name or arbitrary symbol used for the same purpose, a broad distinction, which was early perceived, and which caused some difficulty in the universal acceptance of a name as an efficacious trade mark. This difference is that a name is in its very nature

(*a*) *In re Mitchell*, V.-C. Hall decided (August 2, 1877) that a single letter could not be registered as a trade mark on pens, though long used as such, the wording of the Act being opposed to registration of a single letter not in combination.

(*b*) See the Amendment Act, 39 & 40 Vict. c. 33.

(*c*) In *Ex parte Stephens*, L. R. 3 Ch. D. 659, it was decided by the

Master of the Rolls that a mere word or combination of letters was not within the Act.

(*d*) Cf. *Browne v. Freeman*, 12 W. R. 305 (Chlorodyne); *Lazenby v. Lazenby*, Seton, 4th ed. 237 (Harvey's Sauce); *Wheeler & Wilson v. Shakespeare*, 39 L. J. Ch. 36 (Wheeler and Wilson Sewing Machines); *Singer Manufacturing Co. v. Wilson*, L. R. 2 Ch. D. 434 (Singer Sewing Machines).

generic, and is properly applied to designate, not one individual in the world, but, it may be, many thousands, to all of whom it is equally appropriate. The addition of the Christian to the surname does, indeed, diminish the number of persons to whom the appellation belongs; but the Christian name is commonly abbreviated to an initial letter, and, in any case, the surname is the important part of the name, beyond which many persons do not care to investigate.

The impossibility of a single manufacturer being allowed to arrogate to himself the exclusive use of a name which he shares in common with many other persons is apparent; and from this circumstance the rule was deduced that, while, as against persons bearing a different name, a manufacturer's right in his name trade mark is absolute and exclusive, as against persons bearing the same name no such exclusive right can be set up (a). This rule must, however, be qualified by the statement that where a person uses his own name for the purpose of fraud, and satisfactory evidence of fraudulent intention can be produced, such unfair conduct will be restrained, even though the free use of the man's own name may be thereby hindered (b). And the Criminal Law also admits of the punishment of such fraudulent user of a man's own name (c).

In *Holloway v. Holloway* (d) the defendant, Henry Holloway, sold pills and ointment in packets and pots similar to those in which his brother, the plaintiff, Thos. Holloway, sold his, and the defendant also affixed to his packets and pots similar labels and wrappers, but with

Consequently the right in a name used as a trade mark is less complete.

Holloway v. Holloway.

(a) *Burgess v. Burgess*, 3 De G. M. & G. 89, and *infra*, p. 20; *Faber v. Faber*, 49 Barb. 357; R. Cox, 401; *Mencely v. Mencely*, 17 Sickels, 427. See *Howe v. Howe Machine Co.*, 50 Barb. 236; R. Cox, 421.

(b) *Holloway v. Holloway*, 13 Beav. 209, and *infra*; *Rodgers v. Nowill*, 6 Hare, 325; 5 C. B. 109; *Taylor v.*

Taylor, 23 L. J. Ch. 255; *James v. James*, L. R. 13 Eq. 421; *Fullwood v. Fullwood*, W. N. 1873, p. 93-185; *Gillis v. Hall*, R. Cox, 596; *Stonebreaker v. Stonebreaker*, 33 Maryland, 252.

(c) *R. v. Dundas*, 6 Cox, 380.

(d) 13 Beav. 209.

“H. Holloway,” instead of simply “Holloway.” Thomas Holloway having filed a bill for an injunction, Lord Langdale, M.R., granted the injunction, saying, on the evidence, that it was as clear and as plainly avowed a fraud as he ever knew. He, however, expressly stated that “the defendant’s name being Holloway, he had a right to constitute himself a vendor of Holloway’s pills and ointment, and that he, the M.R., “did not intend to say anything tending to abridge such right ;” the defendant had, nevertheless, no right to do so with such additions to his own name as to deceive the public and make them believe that he was selling the plaintiff’s pills and ointment.

*Burgess v.
Burgess.*

The case of *Burgess v. Burgess* (a) was somewhat similar. There the plaintiff’s father, to whose business the plaintiff had succeeded, had invented “Burgess’ Essence of Anchovies.” He employed his two sons as his assistants, and the business was conducted by him and them at 107, Strand. After a time one of the sons, W. H. Burgess, took a house in King William Street, and setting up for himself, put on his shop front, “W. H. Burgess, late of 107, Strand.” He also headed his labels, “36, King William Street, City, London (Royal Arms), late of 107, Strand, Burgess’ Essence of Anchovies ;” plaintiff’s labels being headed, “107 (Royal Arms), Strand, corner of the Savoy Steps, John Burgess and Son, Original and superior Essence of Anchovies.” Sir R. T. Kindersley, V.-C., granted an injunction as to “late of 107, Strand,” and the continuance on the sides of the defendant’s shop door of a plate with the words “Burgess’ Fish Sauce Warehouse, late of 107, Strand ;” but the part of the motion which referred to the use of the words “Burgess’ Essence of Anchovies” being refused, the plaintiff appealed, and the Lords Justices then distinctly refused to deny a man the use of his own name. Sir J. L. Knight-Bruce, L.J., said, “all the Queen’s subjects have a right to sell their articles in their own names,

(a) 3 De G. M. & G. 89.

and not the less so that they bear the same name as their fathers. The defendant carries on business in his own name, and sells his essence of anchovies as 'Burgess' Essence of Anchovies,' which, in truth, it is;" and Sir G. Turner, L.J., added that, "where a person was selling goods under a particular name, and another person, not having that name, was using it, it might be presumed that he so used it to represent the goods sold by himself as the goods of the person whose name he used; but that where the defendant sold goods under his own name, and it did happen that the plaintiff had the same name, it did not follow that the defendant was selling his goods as the goods of the plaintiff;" if, however, a fraudulent intention had been proved, both judges agreed that the case would have been different.

The fact that according to these cases a man might with impunity, in the absence of proof of actual fraud, sell the same goods as another, under the same name, provided that his own name was the same as that of the rival manufacturer, who had been in the habit of using his name as his trade mark, not unnaturally produced doubts whether a trade mark which was not capable of protection against infringement in all cases could rightly be termed a trade mark at all; and in *Ainsworth v. Walmsley* (a), where the defendant had affixed to thread not of the plaintiff's make labels with the words, "Ainsworth's Thread," it was argued that such a case was no case of trade mark, and that, this being so, it became necessary for the plaintiff to prove the scienter on the part of the defendant. Sir W. P. Wood, V.-C., however, declined to adopt that argument, and intimated that in his opinion a man's name was "as strong an instance of trade mark as could be suggested," adding that it was subject "only to this inconvenience—that if a Mr. Jones or a Mr. Brown relied on his name, he might find it a very inadequate security,

*Ainsworth v.
Walmsley.*

(a) L. R. 1 Eq. 518.

because there might be several other manufacturers of the same name."

A name may be a true trade mark.

The decision in this case finally established the principle that the name of an individual or firm duly appended to the vendible article is a valid trade mark (a), subject to the inconvenience mentioned above.

A name now first used as a trade mark must be in a distinctive form.

That inconvenience has now been removed by the Trade Marks Registration Act, 1875, § 10, which requires that the name to be registered and treated as a trade mark shall be "printed, impressed, or woven in some particular or distinctive manner." For the future, a trade mark consisting of a name will be available against all the world, without exception, for with the mere collocation of letters there is to be combined some further element, in respect of colour, pattern, or some other such differentia, which shall effectually distinguish the trade mark from even a similar succession of letters from which that further characteristic shall be absent (b). The effect of this provision is to render necessary for the future a precaution which many manufacturers have already voluntarily adopted, and the employment of a mode of printing, the imitation of which would furnish an almost irrefutable presumption of fraud, may be instanced from *Stephens v. Peel* (c), before Sir W. P. Wood, V.-C., in which case the labels on the bottles containing the plaintiff's ink were printed in letters which are described as being in part white on a red ground, in part white on a blue ground, and in part blue on a white ground.

The name need not be that of the

There is no provision in the Act which requires that the name selected as the trade mark shall be the name of

(a) See per Lord Kingsdown, in *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. C. 523, where he treats a name as a good trade mark.

(b) In the same way, by the United States Statute of 1870, § 79, it is provided that the Com-

missioner of Patents shall not receive and record any proposed trade mark which is merely the name of a person, firm, or corporation only, unaccompanied by a mark sufficient to distinguish it from the same name where used by other persons.

(c) 16 L. T. N. S. 145.

the individual or firm by whom the goods to which the trade mark is to be attached are actually manufactured. Neither was this the case before the passing of the Act. In many instances, it is true, the name was that of the actual manufacturer; thus, the words "Ainsworth's Thread" (a) and "Taylor's Persian Thread" (b) were used as trade marks on thread produced by those makers, "Ramsay" was used on bricks by G. H. Ramsay (c), Thomas Holloway placed "Holloway's Pills" and "Holloway's Ointment" on his boxes and pots (d), and so in many cases more (e).

But where a name has once become a trade mark, by registration, or, if used before the passing of the Trade Marks Registration Act of 1875, by actual user on a vendible article (f), since followed by registration or the procurement of a certificate of refusal to register (g), it is assignable (h), subject to a connexion with the goodwill of the business (i), and may easily pass to and become the property of a person or firm whose own name is widely different. Thus, the trade mark "William Ash," in *Bury v. Bedford* (k), "1847, Rogers Bros. A 1," in *Meriden Britannia Co. v. Parker* (l).

Among trade marks used before the passing of the Trade Marks Act of 1875, instances are not unusual of marks consisting of a name which neither is nor ever has been borne by the present or any past manufacturer, but which either belongs to some person who actually exists

(a) *Ainsworth v. Walmsley*, L. R. 1 Eq. 518.

(b) *Taylor v. Taylor*, 23 L. J. Ch. 255.

(c) *Dixon v. Fawcus*, 3 Ell. & Ell. 537.

(d) *Holloway v. Holloway*, 13 Beav. 209.

(e) *Burgess v. Burgess*, 3 De G. M. & G. 89; *Wedgwood v. Smith* (Jewitt's "Wedgwoods"), 385; *Collins Co. v. Brown*, 3 K. & J. 423; *Stephens v. Peel*, 16 L. T. N. S. 145, &c.

(f) *McAndrew v. Bassett*, 33 L. J. Ch. 561.

(g) Amendment Act of 1876.

(h) *Hall v. Barrows*, 33 L. J. Ch. 204; *The Leather Cloth Companies' case*, 1 H. & M. 271 (V.-C. Wood); and 11 H. L. C. 523 (Lords Cranworth and Kingsdown).

(i) Trade Marks Registration Act, 1875, § 2.

(k) 32 L. J. Ch. 741, and 33 L. J. Ch. 465.

(l) 39 Conn. 450; 12 Amer. Rep. 401.

or has existed, or to some imaginary or symbolical personage, or character from a book. Thus, the names "Victoria," "Albert," &c., are very commonly used on a great variety of articles; thus "Bismarck" denoted paper collars (*a*), and "Roger Williams" long cloth (*b*), so too "Britannia," "Dolly Varden," &c. All such names, whether of real or fictitious characters, must, however, be treated as fancy names, and cannot therefore be registered unless in actual use before the passing of the Act (*c*). If used before the Act, they will be registered under the latter part of § 10, expressly framed to meet such cases.

Name sometimes used alone.

In some cases the name constituting the trade mark is used alone, as "Dent" in *Dent v. Turpin* (*d*), "Ramsay" in *Dixon v. Fawcus* (*e*), "Howe" in *Howe v. Howe Machine Co.* (*f*), "Wedgwood" in *Wedgwood v. Smith* (*g*), "Derringer" in *Derringer v. Plate* (*h*), "Jules Jurgensen" in *Jurgensen v. Alexander* (*i*), "A. W. Faber" in *Faber v. Faber* (*k*).

Sometimes in combinations.

In other cases the name is used in combination with other letters, words, or figures, or combinations of letters, words, or figures; thus "Collins & Co. Hartford Cast Steel, Warranted" (*l*), "Taylor's Persian Thread" (*m*), "Stephens' Blue Black Writing Fluid" (*n*), "Coe's Superphosphate of Lime" (*o*), "Wolfe's Aromatic Schiedam Schnapps" (*p*), "Mrs. Winslow's Soothing Syrup" (*q*),

(*a*) *Messerole v. Tynberg*, 4 Abb. Pr. R. N. S. 410; R. Cox, 479.

(*b*) *Barrows v. Knight*, 6 R. I. 434; R. Cox, 238.

(*c*) See *Ex parte Stephens*, 24 W. R. 819.

(*d*) 2 J. & H. 139.

(*e*) 3 Ell. & Ell. 537.

(*f*) 50 Barb. 236; R. Cox, 421.

(*g*) Jewitt's "Wedgwoods," 238.

(*h*) 29 Cal. 292; R. Cox, 324.

(*i*) 24 How. Pr. R. 269; R. Cox, 298.

(*k*) 49 Barb. 357; R. Cox, 401. And see *Richards v. Williamson*, 30 L. T. N. S. 746; *Fullwood v.*

Fullwood, W. N. 1873, p. 93—185; *Tonge v. Ward*, 21 L. T. N. S. 480.

(*l*) *Collins Co. v. Brown*, 3 K. & J. 423; *Collins Co. v. Cowen*, 3 K. & J. 428.

(*m*) *Taylor v. Taylor*, 23 L. J. Ch. 255.

(*n*) *Stephens v. Peel*, 16 L. T. N. S. 145.

(*o*) *Bradley v. Norton*, 33 Conn. 157; R. Cox, 331.

(*p*) *Burke v. Cassin*, 45 Cal. 467; 13 Amer. Rep. 204.

(*q*) *Curtis v. Bryan*, 2 Daly, 212; R. Cox, 434.

“1847, Rogers, Bros., A 1” (a), “Meneely’s West Troy, N. Y.” (b). Again, “J. Rodgers & Sons” was coupled with a crown between the initials of the sovereign (c), and “Ransomes & Co.” was followed by “H. H. G” (d).

The second class of trade marks to which the Act allows registration is really little else than a subdivision of the first class, consisting, as it does, of “a written signature, or copy of a written signature of an individual or firm,” to which there may be added, as before, “any letters, words, or figures, or combination of letters, words, or figures.” The signature of an individual or firm is in fact the name of the individual or firm printed or written in a “particular and distinctive manner,” and as such, even before the late Act, necessarily exhibited characteristics which could hardly be copied without the presumption being irresistible that the imitation was fraudulent and intended to invade the rights of the person whose signature was in question. In the cases of *Farina v. Silverlock* (e) and *Welch v. Knott* (f), the signature formed an important part of the trade mark concerned, and in America the signatures of individuals and firms have been admitted to registration on the same principle. For the future, when the signature is once registered as a trade mark, whether with or without additions, it will descend and be assignable just as any other trade mark, without its new owner being liable to any imputation of representing the person whose signature is employed to be still in charge of the business, although formerly the use of a mark of this description might not improbably have been held to convey some such repre-

Second-class
of trademarks.
—A signa-
ture.

(a) *Meriden Britannia Co. v. Parker*, 39 Conn. 450; 12 Amer. Rep. 401.

(b) *Meneely v. Meneely*, 17 Sickles, 427.

(c) *Rodgers v. Nowill*, 6 Hare, 325; 5 C. B. 109; 3 De G. M. & G. 614.

(d) *Ransome v. Bentall*, 3 L. J. Ch. 161. And see *Green v. Folg-*

ham, 1 S. & S. 398; *James v. James*, L. R. 13 Eq. 421; *Lazenby v. Lazenby*, Seton, 4th ed. 237; *Gillis v. Hall*, R. Cox, 596.

(e) 1 K. & J. 509; 6 De G. M. & G. 214; 4 K. & J. 650.

(f) 4 K. & J. 747. See *Massam v. Thorley’s Cattle Food Co.*, W. N. 1877, p. 152.

sentation to the public. To a case of this description Lord Cranworth's observations very directly apply, when, speaking of a buyer of a business using the name of a former maker, he said (a), "the question in every such case must be whether the purchaser in continuing the use of the original trade mark would, according to the ordinary usages of trade, be understood as saying more than that he was carrying on the same business as had been formerly carried on by the person whose name constituted the trade mark. In such a case I see nothing to make it improper for the purchaser to use the old trade mark, as the mark would in such a case indicate only that the goods so marked were made at the manufactory which he had purchased." The provision in the Act of 1875 (b) that a trade mark "shall be assigned and transmitted only in connexion with the goodwill of the business" will enable the purchaser to use the trade mark so acquired by him without his motives being open to question, and will at the same time ensure that marked goods purchased by the public shall, except in cases of punishable infringement, be produced at the works from which they purport to have come.

Third-class of trade marks.
—A distinctive device, &c.

The third class of marks comprises "a distinctive device, mark, heading, label, or ticket," to which again may be added "any letters, words, or figures, or combination of letters, words, or figures."

Distinctiveness required.

The important feature which is absolutely necessary in all the varieties of trade marks included in this class is that of distinctiveness; each mark must be such that, if a question of infringement arises, it shall be perfectly clear what it is that is being infringed, and that this something is quite different from all other marks used upon the same class of goods.

Composition of trade mark,

Of the words "device, mark, heading, label, or ticket,"

(a) *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. & C. 523.

(b) § 2.

some point more directly to the matter of which the trade mark is composed, others to the manner in which it is affixed to the vendible article. and manner of use alluded to.

“Device” and “mark” seem, at first sight, wide enough to include any of the symbols or combinations of which a trade mark could consist. It has, however, been held that they do not include a mere word, or collocation of letters, however strangely combined, or singular in their application (*a*), so that for the future it will be impossible to introduce as new trade marks fancy names such as have filled so large a space in the reports of trade-mark cases. “Device” and “mark.”

When used as indicative of the mode of application of the trade mark, these words will include such cases as where the mark is stamped on iron (*b*), or branded on casks of wine (*c*), or imprinted on sticks of liquorice (*d*), and, generally, any cases which do not come within the remaining and more exact terms. Mode of application indicated by them.

“Heading” applies to cases where, in addition to the ordinary label on the goods, there is a separate label affixed above it, on which the special mark is exhibited (*e*). It also applies to the kind of marks specially applicable to the case of textile fabrics, in which a heading of special pattern is inwoven into the edge of the goods (*f*). “Heading.”

“Label” indicates an impression of a trade mark upon a piece of paper, or some other thin substance, which is made to adhere to the goods to which it is applied, or to the vessel containing them. Thus, in *Wotherspoon v. Currie* (*g*), the label was affixed to packets of starch; in “Label.”

(*a*) *Ex parte Stephens*, L. R. 3 Ch. D. 659.

(*b*) *Molloy v. Downman*, 3 My. & Cr. 1; *Millington v. Fox*, *ib.* 338; *Crawshay v. Thompson*, 4 M. & G. 357; *Hall v. Barrows*, 32 L. J. Ch. 548; and 33 L. J. Ch. 204, &c.

(*c*) *Seixo v. Provezende*, L. R. 1 Ch. 192; *Moet v. Gouston*, 33 Beav. 578; *Ponsardin v. Peto*, 33 Beav. 642, &c.

(*d*) *McAndrew v. Bassett*, 33 L. J. Ch. 561.

(*e*) *Ex parte Stephens*, 24 W. R. 963.

(*f*) *Harter v. Souvazoglu*, W. N. 1875, pp. 11-101; and see per Sir G. Jessel, M. R., in *Singer Manufacturing Co. v. Wilson*, L. R. 2 Ch. D. 434.

(*g*) L. R. 5 H. L. 508.

Bass v. Dawber (a) to bottles of beer; in *Blackwell v. Crabb* (b), *Cocks v. Chandler* (c), *Cotton v. Gillard* (d), and other cases, to bottles of pickle.

“Ticket.”

“Ticket” points to a mark also impressed upon a separate material, but only loosely attached to the goods the make of which it indicates. Thus the trade mark of a wire manufacturer consisted of an anchor stamped on the tallies, or metal labels, attached to the bundles of his wire (e); the trade mark of a clothier was imprinted on a ticket pinned on to his wares (f).

Composition
of trade mark.

The question, “What is a trade mark?” is, however, less directed to the manner in which the trader’s symbol is attached to his goods than to its composition, and the varieties of mark which will merit and receive protection.

“Device.”

The original form of trade mark was probably the representation of some animal, or other natural object, or mathematical figure, as the Hall mark of the lion or leopard’s head, the Freemasons’ compasses, or the Government broad arrow. Such a mark would be independent of language, and would serve to distinguish goods of a certain make, even for the illiterate.

Examples.

Such marks are still frequently employed, and this clause specially includes them. To this class belong the marks of an anchor (g), an eagle (h), a lion (i), an elephant (i), a cross (k), a pyramid (l), a bell (m), a hand (n), or a cock (o).

- (a) 19 L. T. N. S. 626.
 (b) 36 L. J. Ch. 504.
 (c) L. R. 11 Eq. 446.
 (d) 44 L. J. Ch. 90.
 (e) *Edelsten v. Edelsten*, 1 De G. J. & S. 185.
 (f) *Hirst v. Denham*, L. R. 14 Eq. 542.
 (g) *Edelsten v. Edelsten*, *ubi supra*.
 (h) *Standish v. Whitwell*, 14 W. R. 512.
 (i) *Henderson v. Jorss*, Lloyd

- on Trade Marks, 2nd ed. 54; Seton, 4th ed. 236.
 (k) *Cartier v. Carlile*, 31 Beav. 292.
 (l) *Bass v. Dawber*, 19 L. T. N. S. 626.
 (m) *Bell v. Bell*, V.-C. B., August 1, 1876.
 (n) *Allsopp v. Walker*, M. R., April 10, 1877.
 (o) *In re Walkden Aerated Waters Co.*, M. R., June 8, 1877.

A crest is just as capable of becoming a trade mark as any other arbitrary device (a). In *Beard v. Turner* (b) Sir W. P. Wood, V.-C., said, "I am not prepared to say or hold that a man putting his crest should not so put it as to establish his right to say, 'Nobody shall use my crest.' It is incumbent on him, as on every plaintiff, to show that the crest is an essential part of his trade mark." The readiest way of proving this will now be by reference to the Register of Trade Marks.

In *Standish v. Whitwell* (c) an injunction was granted restraining the defendant from stamping what he alleged to be his own crest—an eagle—on his iron, the plaintiff having previously adopted an eagle as his trade mark on the same substance. *Standish v. Whitwell.*

It does not seem quite certain how far initials may compose a trade mark capable of registration and protection in this class of marks. Before the Trade Marks Act of 1875 a trade mark might consist of initials, either alone, or in combination with other ingredients (d). Now, however, it would be difficult to assert that initials alone, printed in the usual manner, and without any distinguishing peculiarities of shape, colour, &c., could be described as "a distinctive device, mark, heading, label, or ticket." Where the letters are combined together into the form of a monogram, or enclosed within a distinctive border, or are in any other way used in such a combination as to be distinguishable from the same letters used in the plain, ordinary way, there can be no objection to their recognition as a valid trade mark. Initials.

In *Harter v. Souvazoglu* (e) the trade mark consisted of a certain combination of purple, pink, and green threads, nine stripes in three gradations, which were woven as a heading into cotton goods, which were forwarded to the markets of *Harter v. Souvazoglu.*
"Heading."

(a) In *Steinthal v. Samson*, C. A., April 17, 1877, the trade mark consisted of the crest, arms, and motto of the plaintiff's family. See Instructions as to royal, national,

municipal, &c., arms.

(b) 13 L. T. N. S. 746.

(c) 14 W. R. 512.

(d) See p. 44, *infra*.

(e) W. N., 1875, pp. 11-101.

Turkey and the Levant. The owners of this mark having filed a bill for an injunction against a rival trader who had copied the mark, Sir C. Hall, V.-C., held "that a heading could be the subject of a trade mark, that the evidence in the case showed that this heading was distinguished from others in Turkey, and that it had become a trade mark, although it was sometimes associated with stamps on the goods, of the lion and the sun, and other devices. Customers had bought goods because of this particular heading, and he therefore considered that the plaintiffs who had adopted it were entitled to the protection they asked, and that no other persons could use it" (a).

Fourth class of trade marks.—Old marks.

The fourth class of trade marks allowed to be registered under the Trade Marks Acts consists of "any special and distinctive word or words, or combination of figures or letters used as a trade mark before the passing of the Act of 1875."

What this class includes.

This clause is designed to extend the benefits conferred by registration under the new Acts to trade marks which, though protected by the Courts as such before the passing of those Acts, yet do not come within the more restricted definition which it has been thought right to apply to marks adopted and used for the first time since that date. The class of existing trade marks whose registration this clause is intended to permit is to be composed of marks consisting of a word or words, or a combination of figures (*i.e.* numerals) (b) and letters. Other existing trade marks can be registered under some one of the former heads.

Fancy names.

The principal class of trade marks intended by this consists of fancy names, which are peculiar in their application to the goods manufactured at a certain establishment, and which are understood by the public as ascribing the article to which they are applied to the manufacture of that

(a) And see per Sir G. Jessel, M. R., in *Singer Manufacturing Co. v. Wilson*, L. R. 2 Ch. D. 434.

(b) *Ex parte Stephens*, L. R. 3 Ch. D. 659.

establishment, and that only. Whether, however, a name selected for this purpose is really and truly a fancy name is often a question of extreme nicety.

The word may be purely descriptive, that is to say, it may express accurately and appropriately the material or mode of composition of the goods to which it is affixed, and unless the exclusive manufacture of such goods is protected by a patent, and the same result cannot be attained without infringement of the patent, all the world has the right to make and sell such goods; and further, when the goods are manufactured and in course of sale, not only has the right, but is in duty bound to describe them, for the proper information and protection of the public, in such manner as will convey the most correct idea. Hence the original maker can claim no exclusive right in the properly descriptive name. Descriptive names.

The reasoning of Sir W. P. Wood, V.-C., *Young v. Macrae* (a), affords a good example of the just way of considering cases of this description. In that case the plaintiffs, who held a patent for manufacturing a kind of oil which they called "Paraffin oil," filed a bill against the defendant, who sold a substance which he styled "Kerosene oil," or "American Paraffin Oil." The case coming on on motion for injunction, the Vice-Chancellor said, "In the patent the process is described as 'a distillation of coal so as to obtain oil containing paraffin, and from this oil I obtain paraffin.' So he calls it paraffin oil because it contains paraffin. Here is a well-known substance called 'paraffin.' A chemist discovers that by the same process by which paraffin is produced, an oil containing paraffin, and from which paraffin can again be produced, is obtainable. Therefore, it being an oil containing paraffin, and producing paraffin, he calls it 'paraffin oil.' It is not a fanciful or whimsical name, but it describes the thing which he has produced. A man cannot take out a patent for a natural substance, but he *Young v. Macrae.*

(a) 9 Jur. N. S., 322.

can take out a patent for arriving at that natural substance, and he may christen it, putting aside all other people, having called it by that name." The Vice-Chancellor then put the case of a man extracting sugar from beet-root by a patented process, and calling the extract "beet-root sugar" for a period of ten years. In such a case, when beet-root sugar was asked for, it would be known that his was meant, because he was the only man who made it. "The name," the Vice-Chancellor said, "does not become a trade mark, but it gets fixed to his sugar simply because nobody else could make it. Then, suppose that another man found out another method of making sugar from beet-root, and so extracted it, not wanting to patent it, and, described it as 'beet-root sugar, may he not call it 'beet-root sugar' because the other gentleman for ten years has been the manufacturer of it, and sold it as such? I think the question of the fancifulness of the name is a question whether it is taken by way of trade mark or not. All he (*i.e.* the plaintiff) has done here is this, he has found out an article which is a natural product, and he has given that natural product a name." "This is not like the case of the 'Medicated Mexican Balm,' which is a name extravagantly ridiculous. I therefore should not assume *mala fides* against a person who calls the thing what it is. It is paraffin and it is oil, therefore paraffin oil. There is paraffin in it, and paraffin to be obtained from it, and it is American." Injunction refused.

In a later case (*a*) the same Vice-Chancellor referred to the above case of *Young v. Macrae* (*b*), and remarked that "if the evidence had gone to show that the plaintiff had been the first to apply the name 'paraffin' to the oil, he would have granted an injunction; but that he had there had it proved that the name 'paraffin oil' had long been known as the scientific name of the article, and that the defendant could not well have called it anything else."

(*a*) *Braham v. Bustard*, 1 H. & M. 447. (*b*) 9 Jur. N. S. 322.

Again, a word which was first applied to, or was even invented for the sole and express purpose of designating a new substance or composition may prove, on investigation, to have ceased to retain the characteristic which it once possessed, of conveying the idea of the goods being of a particular manufacture, in which case the person first using the word, though its inventor, will cease to have any exclusive rights in it, since it will have become purely descriptive of an article which all may freely make. The name thus becomes *publici juris*, and not only can be, but ought to be employed by all who manufacture and sell an article which they are at perfect liberty to manufacture and sell, and of which the name in question is generally recognised as the appropriate designation.

The registration as a trade mark of a name of this description will somewhat complicate the question, as such registration is to be *prima facie* evidence, and after five years' registration, conclusive evidence of the right of the registered owner to the exclusive use of such trade mark (a); but this enactment does not preclude a defence on the ground that the name so registered is in fact no trade mark, and was registered, or is continued on the register by error, and the remarks of Sir G. Mellish, L. J., in *Ford v. Foster* (b), appear to be equally applicable since the Act as before it. "There is no doubt, I think, that a word which was originally a trade mark, to the exclusive use of which a particular trader, or his successor in trade, may have been entitled, may subsequently become *publici juris*, as in the case which has been instanced of Harvey's sauce (c). Then, what is the test by which a decision is to be arrived at whether a word which was originally a trade mark has become *publici juris*? I think the test must be, whether the use of it by other persons is still

Name become
publici juris.

Effect of
registration.

(a) Trade Marks Act, 1875, § 3.

(b) L. R. 7 Ch. 611.

(c) With respect to this example, an injunction appears to have been

granted by Sir J. Romilly, M. R., in 1858, to restrain the infringement of this designation. See *Lazenby v. Lazenby*, Seton, 4th ed. 237.

calculated to deceive the public, whether it may still have the effect of inducing the public to buy goods not made by the original owner of the trade mark as if they were his goods. If the mark has come to be so public and in such universal use that nobody can be deceived by the use of it, or can be induced from the use of it to believe that he is buying the goods of the original trader, it appears to me, however hard to some extent it may appear on the trader, yet practically, as the right to a trade mark is simply a right to prevent a trader from being cheated by other persons' goods being sold as his goods through the fraudulent use of the trade mark, the right to the trade mark must be gone" (a).

Name indicative of a principle of construction.

In the case of *The Wheeler & Wilson Manufacturing Co. v. Shakespeare* (b), Sir W. M. James, V.-C., and in *The Singer Manufacturing Co. v. Wilson* (c), Sir G. Jessel, M.R. (affirmed by the Court of Appeal), refused to grant an injunction to restrain the use in connexion with sewing machines in the one case of the words "Wheeler and Wilson," in the other case of the word "Singer," the Court holding in each case that the name had become descriptive of the principle on which the machines were respectively constructed, and that the Court would not assist an attempt at continuing the monopoly in the articles in question after the expiration of the patent, by a claim to the exclusive use, by way of trade mark, of the name by which the peculiar principle of construction had come to be generally known.

Actual fraud.

Of course, in either of these cases, any element of actual intentional fraud will be taken into consideration, and the

(a) Thus, the marks of the crown and horseshoe were proved to be common to the iron trade: in *In re Burrows*, L. R. 5 Ch. D. 353; and see § 9 of the Merchandise Marks Act, 1862.

(b) 39 L. J. Ch. 36.

(c) L. R. 2 Ch. D. 434. In this

case, however, the name was not placed by the defendant upon his machines. The Court of Appeal decided in the same sense in *Cheavin v. Walker* (Cheavin's filters) reversing the decision of V.-C. Bacon, L. R. 5 Ch. D. 850.

Court will, in the exercise of its general jurisdiction for the repression of fraud, award an injunction or damages in a case in which, but for the fraud, no remedy would have been given. Thus, for instance, in a case in which the infringer might have taken with impunity the name of an article invented by another, but not content with so doing, described his own manufacture as "the original" article, he was restrained by injunction from the use of that misleading epithet. (a).

The general principle, however, is that where a name used by way of a trade mark either was originally, or has since come to be, purely descriptive of the article to which it is attached, so that while serving to indicate what the article is, it does not serve to connect it with any particular manufacturer or manufacturing establishment, that name cannot be protected as a trade mark (b), or registered as special and distinctive.

Again, where a mark, though not descriptive, yet does not serve to distinguish the person using it from a number of other persons who use or are entitled to use it, it cannot be a valid trade mark, since it is common, if not to the whole world, at all events to a class of persons. Thus "prize medal" (c), "gold medal" (d). The objection, however, will not prevail where the class is very limited (e).

(a) *Cocks v. Chandler*, L. R. 11 Eq. 446. The presumption of fraud may, however, be refuted, as by a fair statement of the maker's own name: *Browne v. Freeman*, 12 W. R. 305.

(b) Among the American cases, see *Corwin v. Daly*, 7 Bos. 222; R. Cox, 265 ("Club House Gin"); *Phalon v. Wright*, 5 Phila. 464; R. Cox, 307 ("Extract of Night Blooming Cereus"); *Binninger v. Wattles*, 28 How. Pr. R. 206; R. Cox, 318 ("Old London Dock Gin"); *Caswell v. Davis*, 13 Sickels, 223 ("Ferrophosphorated Elixir of Calisaya

Bark"); *Town v. Stetson*, 5 Abb. Pr. R. N. S. 218; R. Cox, 514 ("Desiccated Codfish"); also *Thomson v. Winchester*, 19 Pick. 214; R. Cox, 7; *Gillott v. Esterbrook*, 47 Barb. 455; R. Cox, 340; *Petridge v. Merchant*, 4 Abb. Pr. R. 156; R. Cox, 194; *Wolfe v. Goulard*, 18 How. Pr. R. 64; R. Cox, 226; and *Burke v. Cassin*, 45 Cal. 467, 13 Amer. Rep. 204.

(c) *Batty v. Hill*, 1 H. & M. 264.

(d) *Taylor v. Gillies*, 14 Sickels, 331.

(e) *Dent v. Turpin*, 2 J. & H. 139. And see p. 61, note (f).

Adjective denoting quality only, no trade mark.

Again, an ordinary adjective in the common language of the country, descriptive of the quality of the article, and not designating it to be of the manufacture of a certain individual or establishment, as "superior" (a), "superfine" (a), "nourishing" (b), cannot be exclusively appropriated as a trade mark. And the same is the case with a word or symbol which is understood generally, or in the trade, to indicate quality and not a special manufacturer. Thus "A, No. 1," "A X, No. 1" (c).

Fraudulent trade mark.

Again, a trade mark which contains false representations, so as to deceive the public, will not be protected in equity as a valid trade mark (d), and cannot be registered as such under the Registration Act of 1875 (e). But mere collateral misrepresentations do not disqualify (f).

Extravagance an advantage in fancy names.

It may be stated as a general rule that the more extraordinary and extravagant the name that is adopted by way of trade mark, the better will the object be attained, and the protection of the Courts and of the Registration Office secured, for the more uncommon the designation is, the less obnoxious is the exclusive claim of the manufacturer, and the more conclusive the evidence of fraud supplied by an infringement. Thus, Sir W. P. Wood, V.-C., said, "I have not the least doubt that if the plaintiff (if I doubted I should be going quite contrary to the Mexican Balm case and other cases in which ridiculous names have been used) had invented a fanciful and ridiculous name—and the more ridiculous, the better it is for his purpose—and has used it for eight or ten years in his trade, that the Court would

(a) *Braham v. Bustard*, 1 H. & M. 447.

(b) *Raggett v. Findlater*, L. R. 17 Eq. 29.

(c) *Candee, Swan & Co. v. Deere & Co.*, 54 Ill. 439; 5 Amer. Rep. 125; and see *The Amoskeag Manufacturing Co. v. Spear*, 2 Sand. S. C. 599; R. Cox, 87; *Burke v. Cussin*, 45 Cal. 467; 13 Amer. Rep. 204; and *Stokes v. Landgraff*, 17 Barb. 608;

R. Cox, 137; with which last compare *Hirst v. Denham*, L. R. 14 Eq. 542.

(d) *Pidding v. How*, 8 Sim. 477; *Perry v. Truefitt*, 6 Beav. 66; *Flavel v. Harrison*, 10 Hare, 467; *Leather Cloth Co. v. American Leather Cloth Co.*, 33 L. J. Ch. 199; *Morgan v. McAdam*, 36 L. J. Ch. 228.

(e) See § 6.

(f) *Ford v. Foster*, L. R. 7 Ch. 611.

take care that nobody else should use that absurd name; for such user could only be a user for the express purpose of imitating the plaintiff's, and so defrauding the plaintiff, by representing goods manufactured by one person to be goods manufactured by another" (a).

In many cases the fancy name used as a trade mark is an entirely new word, invented for the occasion by the manufacturer of the material or composition to which it is applied, and such a name may be registered and otherwise treated as a valid trade mark, if invented and used before the passing of the Act of 1875 (b). Fancy names specially invented.

Thus "Pectorine" (c) and "Lactopeptine" (d) were protected as names for medical compounds; "Cocaine" (e) and "Boviline" (f) for pomades. "Chlorodyne" (g) was only not protected because the proprietor, on a mistaken view of his rights, consented to have his bill for an injunction dismissed with costs (h). Examples.

In many other cases the trade mark consists, not of a newly coined word, but of a word, or a combination of words, already in common use, but which for the purpose of the trade mark is or are used and applied in a manner quite different from the ordinary use and application, so different that it is seen at the first glance that the word or combination of words is or are being used quite out of the common signification and in the nature of a fancy name designatory of the goods. Thus, "Pharaoh's Serpents" (i), applied to a toy; "The Licensed Victuallers' Relish" (k), to Existing words composing a fancy name.

(a) *Young v. Macrae*, 9 Jur. N. S. 322; and see *Petridge v. Merchant*, 4 Abb. Pr. R. 156; R. Cox, 194.

(b) *Ex parte Stephens*, L. R. 3 Ch. D. 659.

(c) *Smith v. Mason*, W. N. 1875, p. 62.

(d) *Carrick v. Morson*, L. J. Notes of Cases, 1877, p. 71.

(e) *Burnett v. Phalon*, 9 Bos. 192; R. Cox, 376.

(f) *Lockwood v. Bostwick*, 2 Daly, 521; R. Cox, 555.

(g) *Browne v. Freeman*, 12 W. R.

305.

(h) And see *Young v. Macrae*, 9 Jur. N. S. 322, in which "Paraffin Oil," *Lamplough v. Balmer*, W. N. 1867, p. 293, in which "Pyretic Saline," and *Wolfe v. Goulard*, 18 How. Pr. R. 64, R. Cox, 555, in which "Schiedam Schnapps," was not protected for special reasons only.

(i) *Barnett v. Leuchars*, 13 L. T. N. S. 495.

(k) *Cotton v. Gillard*, 44 L. J. Ch. 90.

a sauce; "Turin," "Sefton," "Leopold," and "Liverpool" (*a*) to cloth; "United Service" (*b*) and "Genuine Yankee" (*c*) to soap; "Sweet Opoponax of Mexico" (*d*), and "Balm of Thousand Flowers" (*e*) to perfume; and "Charter Oak" to stoves (*f*).

Inscriptions
or advertise-
ments.

Occasionally it has been sought to protect as a trade mark, and to claim exclusive rights in, an inscription or advertisement composed of ordinary English words, used in their ordinary sense, and only peculiar from the length of the sequence. Usually, indeed, there is in such cases some feature which might be really distinctive, but of which the plaintiff, for some reason or other, is unable to avail himself; this failing, the whole inscription is claimed. Such cases, however, are in fact "advertisements of the character and quality of the goods" (*g*), in which advertisements no exclusive rights can be claimed, as was expressly decided by the Court of Appeal in *Cheavin v. Walker* (*h*), where the inscription was "G. Cheavin's improved patent, gold-medal, self-cleaning, rapid water filter, Boston, England," the name Cheavin having become indicative of a principle of construction. In *Shrimpton v. Laight* (*i*), the use of the words "graduated, grooveless, drill-eyed, ground-down" needles was also accompanied by that of the maker's name, and this being obviously imitated by the defendant, the injunction was granted.

Words taken
from the dead
languages.

Sometimes a word taken from a dead language has been applied to goods and protected as a valid trade mark, as

(*a*) *Hirst v. Denham*, L. R. 14 Eq. 542.

(*b*) *Field v. Lewis*, Seton, 4th ed. 237.

(*c*) *Williams v. Johnson*, 2 Bos. 1; R. Cox, 214; *Williams v. Spence*, 25 How. Pr. R. 366; R. Cox, 305.

(*d*) *Smith v. Woodruff*, 48 Barb. 438; R. Cox, 373.

(*e*) *Petridge v. Merchant*, 4 Abb. Pr. R. 156; R. Cox, 194; but see *Petridge v. Wells*, 13 How. Pr. R. 385; R. Cox, 180.

(*f*) *Filley v. Passett*, 44 Mo. 173; R. Cox, 530.

(*g*) Per Lord Westbury, C., in *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. C. 523, which see.

(*h*) V.-C. B. 35 L. T. N. S. 757; Ct. of App. May 9, 1877. And see *Blackwell v. Crabb*, 36 L. J. Ch. 504.

(*i*) 18 Beav. 164. And see *Boardman v. Meriden Britannia Co.*, 35 Conn. 402; R. Cox, 490, where an injunction was given.

the Latin word "Excelsior" in respect of soap (a), or the Greek word "Eureka" on shirts (b).

In some instances words taken from modern foreign languages have been protected, though the precise extent to which trade marks so composed will be acknowledged has not yet been authoritatively decided. Where the name employed is a fancy name which happens to be in a foreign language, or framed in imitation of the forms of a foreign language, there is no doubt that there is just as good a trade mark as if it had been in English or framed on English forms, thus, "Flor Fina Prairie Superior Tabac" (c) was allowed to be a good trade mark, though the defendant was held not to have infringed, and "Tamar Indien" (d) was actually protected.

Or from modern foreign languages.

When, however, the foreign words are used in their ordinary sense, or in a sense not widely remote therefrom, the case is different. In *Gout v. Aleploglu* (e), the plaintiff was a maker of watches for the Turkish market. These watches he marked in Turkish with his own name (Ralph Gout) with the word "Pessendede" ("warranted"), with his initials "R. G." and a crescent, and also with a sprig and crescent. The defendant procured watches to be made, in which the minor features of the marks used by the plaintiff were omitted, but in which the main characteristics, the name ("Ralph Gout") and the word "Pessendede," in Turkish characters, were reproduced, the style of engraving being copied. Such watches were then sent by the defendant to Constantinople, and there sold, to the prejudice of the plaintiff's business. This was a clear case of fraud, and so it was held to be by the Vice-Chancellor of England, Sir L. Shadwell, who, however, did express an opinion that the plaintiff had acquired an exclusive right in the word "Pessendede" (f). But the point that had to

Foreign words in their ordinary signification. *Gout v. Aleploglu.*

(a) *Braham v. Bustard*, 1 H. & M. 138.
447.

(b) *Ford v. Foster*, L. R. 7 Ch. p. 14.
611.

(c) *Cope v. Evans*, L. R. 18 Ex.

(d) *Grillon v. Guénin*, W. N. 1877,

(e) 6 Beav. 69 ; 5 Leg. Obs. 496.

(f) 5 Leg. Obs. 496.

be decided was not simply whether the word "warranted," in Turkish, could be protected, and indeed, when it is considered that the watches were to be sold in Turkey, the case does seem to be just the same as if the word had been engraved in English on watches to be sold in this country, when such a proposition would be clearly untenable. But not only the word, but the manner of engraving it was copied, and not only that word, but the name of the maker; and what the Vice-Chancellor actually decided was that here there was a clear case of attempted fraud, which was quite sufficient ground for the issue of an injunction, without its being necessary to consider whether the imitation of one single feature would have been sufficient to entitle the plaintiff to that remedy. The use of the name "Ralph Gout" alone by the defendant, whose own name was entirely different, would indeed have been sufficient to entitle the plaintiff to an injunction (a), but the case with respect to "Pessendede" was different.

Broadhurst v. Barlow.

In *Broadhurst v. Barlow* (b), the case was again a far more complicated one than that of a single foreign word, or even a succession of words taken from the same foreign language. Here the plaintiffs were spinners and manufacturers at Manchester and Bolton, who exported to the East large quantities of pieces of Spanish shirting, which they marked with their proper trade mark, a lion in a border, and with the words "Spanish shirting" in a scroll, and "No. 120." To this they had added "exactly 12 yards," in Turkish, Armenian, and Greek, the same statement being repeated in the three languages, placed one below the other (c). The defendants were discovered to be preparing Spanish shirting for export, similarly marked, except that there were five lines instead of four, and that

(a) See per Sir G. Turner, L. J., in *Burgess v. Burgess*, 3 De G. M. & G. 89.

(b) W. N. 1872, p. 212; and L. J. Notes of Cases, 1872, p. 183.

(c) In *Curtis v. Bryan*, 2 Daly, 212; R. Cox, 434; a label was used, with an inscription in English, French, German, and Spanish.

an elephant was used in place of the lion. Sir J. Wickens, V.-C., held that "though an elephant was used by the defendants, the three sentences in the same languages in the same order was an infringement of the plaintiffs' rights," and he therefore granted the injunction to restrain the use of the words in the three languages in the order used by the plaintiffs.

The true principle appears to be that, while foreign words employed in their ordinary signification may, even when used on goods intended for consumption in the country where that foreign language is spoken, form a part of a combination trade mark, the infringement of which will be restrained, the exclusive use of such words themselves, apart from fraud, will not be protected in this country, any more than that of an ordinary English adjective. Actual fraud will always be restrained. Conclusion.

Under the head of "Fancy Names" should properly be included trade marks consisting of geographical names. Geographical names. When such names are used as trade marks they are in that application to be understood, not as ascribing the goods to which they are affixed to any special section of the earth's surface, but as expressing the works at which, or the manufacturer by whom, those goods have been produced. So Sir W. P. Wood, V.-C., in the "Anatolia" liquorice case (a), said that "the plaintiffs had established beyond all doubt the connexion of their name with that mark, that was beyond dispute," and that "he could not treat the word as being otherwise than a designation mark, which the plaintiffs had caused to be attached to that particular article of liquorice which they so manufactured, and which they had a right to consider, in that qualified sense, property." Lord Westbury, C., in that case (b) strongly confirmed the opinion of the Vice-Chancellor; and in the later case of *Wotherspoon v. Currie* (c),

(a) *McAndrew v. Bassett*, 33 L. J. Ch. 561.

(b) *Ib.* 566.

(c) L. R. 5 H. L. 508.

where the subject of dispute was the word "Glenfield" applied to starch, he stated that that word had acquired a secondary signification or meaning in connexion with a particular manufacture: in short, it had become the trade designation of the starch made by the appellants. It was wholly taken out of its ordinary meaning, and in connexion with starch had acquired that peculiar secondary signification to which he had referred. The word "Glenfield," therefore, as a denomination of starch, had become the property of the appellants. It was their right and title in connexion with the starch.

Rules as to
geographical
names.

In some cases there is no pretence for saying that the name is used in its ordinary geographical sense. Thus no one could affirm that the use of the names "Persian thread" (a) or "Ethiopian stockings" (b) had induced him to suppose that the articles in question were imported from those countries. In other cases, however, the name is less purely arbitrary, and was originally, at least, indicative of local origin. For instance, the pipes marked with "E. Southorn, Broseley" (c), were manufactured at a village of that name; Glenfield starch (d), in the same manner, came from Glenfield; Anatolia liquorice (e); and Leopoldshall Kainit (f), from those respective places. This fact, however, does not deprive the trade mark of the right to protection. It is true that the name of an existent place cannot for all purposes be appropriated (g), and that

(a) *Taylor v. Taylor*, 23 L. J. Ch. 255.

(b) *Hine v. Lart*, 10 Jur. 106.

(c) *Southorn v. Reynolds*, 12 L. T. N. S. 75.

(d) *Wotherspoon v. Currie*, L. R. 5 H. L. 508.

(e) *McAndrew v. Bassett*, 33 L. J. Ch. 561.

(f) *Radde v. Norman*, L. R. 14 Eq. 348; and see *Apollinaris Co. v. Edwards*, Seton, 4th ed. 237; and *Apollinaris Co. v. Norrish*, 33 L. T. N. S. 342 (*Apollinaris Water*); *Congress and Empire Spring Co. v. High Rock*

Congress Spring Co. 57 Barb. 526, R. Cox, 599 (*Congress Spring Water*); *Amoskeag Manufacturing Co. v. Garner*, 55 Barb. 151; R. Cox, 541 (*Amoskeag*); *Newman v. Alford*, 6 Sickels, 189 (*Akron*); *Lea v. Millar*, Seton, 4th ed. 242 (*Worcestershire Sauce*); and *Powell v. McNulty*, V.-C. B. Nov. 27, 1876 (*Yorkshire Relish*).

(g) "Property in the word for all purposes cannot exist," per Lord Westbury, C., *McAndrew v. Bassett*, 33 L. J. Ch. 566.

any one who manufactures at a place the name of which has become another's trade mark, indicative of that other's productions, may still describe his goods as made on that spot. But by English law he cannot stamp that name on his goods in the character of a trade mark of his own (a). In *Seixo v. Provezende* (b), where it was urged by the defendants that parts of their vineyards were known by the name of Seixo, the Lord Chancellor (Lord Cranworth) said that even assuming that to be true, "that did not justify the defendants in adopting a device or brand, the probable effect of which was to mislead the public when purchasing their wine, to suppose that they were purchasing wine produced from the vineyards, not of the defendants, but of the plaintiff. Cases might be imagined, though very unlikely to arise, in which a person bringing into the market for the first time the produce of a newly established manufacture, to come into competition with one already established, might really be embarrassed as to the mode in which he should describe it, so as not to interfere with the description adopted by a manufacturer who had been before him." And he added that if such a case should arise, it would have to be dealt with on its own merits.

Again, in *McAndrew v. Bassett* (c), Lord Westbury, C., said, "I am told that the word 'Anatolia,' being a general geographical expression—being, in point of fact, the geographical designation of a whole country—is a word common to all, and that in it, therefore, there can be no property. That is nothing in the world more than a

McAndrew v. Bassett.

(a) Though this is the English rule, the Supreme Court of the United States, in *The Canal Co. v. Clark*, 13 Wallace, 311, in 1871, held that the defendants might use the name "Lackawanna" on coal produced in that district, though the plaintiffs had previously so used it; and in *Candee, Swan & Co. v. Deere*, 54 Ill. 439, 5 Amer. Rep. 125, the

Supreme Court of Illinois refused to prohibit the *bona fide* use of the name "Moline" on goods from that place, though it had been already occupied. And see *Glendon Iron Co. v. Uhler*, 75 Penn. St. 467; 15 Amer. Rep. 599.

(b) L. R. 1 Ch. 192.

(c) 33 L. J. Ch. 566.

repetition of the fallacy which I have frequently had occasion to expose. Property in the word for all purposes cannot exist; but property in that word, as applied by way of stamp upon a stick of liquorice, does exist the moment the liquorice goes into the market so stamped, and obtains acceptance and reputation in the market, whereby the stamp gets currency as an indication of superior quality, or of some other circumstances that render the article so stamped acceptable to the public."

Initials.

In some cases initials, either with or without additions, have been treated as trade marks. Among the earliest of these cases are *Motley v. Downman* (a) and *Millington v. Fox* (b); in the first of which cases "M. C.," and in the second "J. H." was branded on iron. Still earlier than these cases, in the year 1834, "H. H. 6" formed part of a trade mark protected by injunction (c). In *Crawshay v. Thompson* (d), "W. C." in an oval was employed, and infringement being alleged through the use of "W. O." in a similar oval, a verdict was given by the jury for the defendants. The question of whether initial letters could form a trade mark, alone or in conjunction with other symbols, was definitely raised before the Lord Chancellor of Ireland, in *Kinahan v. Bolton* (e). In that case the alleged trade mark consisted of the letters "L L" (standing for "Lord Lieutenant"), with a ducal coronet, which mark, it was alleged, had been adopted at a time when there was a ducal Lord Lieutenant of Ireland. The case of the defendants was that "L L" could no more compose a trade mark than "X X," but was a mere mark of quality. The Lord Chancellor, saying that there was no doubt as to this mark being a trade mark "in the strictest sense," went on to observe: "A most competent witness says that this whisky, under the name of 'L L,' is a well-known

(a) 3 My. & Cr. 1.

(b) 3 My. & Cr. 338.

(c) *Ransome v. Bentall*, 3 L. J.

Ch. 161.

(d) 4 M. & G. 357.

(e) 15 Ir. Ch. 75.

article of commerce, that it has no other name than 'L L,' that under this name it has acquired a special reputation, and that for the long period of forty years this name has been applied to it. What is a trade mark more than that? It is proved that these two letters designate this whisky. The letters of themselves mean nothing; no one *a priori* could know the meaning of such a trade mark: it is merely like a diamond, an anchor, or a crown, stamped on any article, the mark by which the vendor enables the public to recognise his wares."—"There can be no doubt, and indeed it is not disputed, that two letters may constitute a trade mark." Reference was then made to the cases of *Motley v. Downman* (a) and *Millington v. Fox* (b), and the injunction was granted. Since that time "S. and H." with a crown (c), "B. B. H." with a crown (d), or in any other combination (e), "C. B." with a cross (f), "M. and C." in a circle (g), and "L. II. and S." (h) have been treated as undoubted trade marks. The letter F inclosed in circular lines, which was not protected in *Ferguson v. Davol Mills* (i), has since been registered in America.

In the result, while initials used as a trade mark for the first time since the Act of 1875 must be combined with some distinctive feature, it seems clear that, if used as such before the Act, they will, even standing alone, be entitled to protection, though probably not as against persons having the same initials and using them without fraud (k). Conclusion.

That single letters, though long used as trade marks prior to the Act of 1875, cannot be registered or protected Single letters.

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|-------------------------------------------------------|---------------------------------------------------------------------------------------------------------------|
| (a) 3 My. & Cr. 1. | 292. |
| (b) 3 My. & Cr. 338. | (g) <i>Moet v. Clybourn</i> , M. R. Jan. 19, 1877. |
| (c) <i>Hopkins v. Hitchcock</i> , 32 L. J. C. P. 154. | (h) <i>Ex parte Young</i> , Court of Bankruptcy, Feb. 3, 1877. |
| (d) <i>Hall v. Barrows</i> , 32 L. J. Ch. 548. | (i) 2 Brewster, 314; R. Cox, 526. |
| (e) <i>Re Barrows</i> , L. R. 5 Ch. D. 353. | (k) The case is much the same as that of a maker's name. See <i>Ainsworth v. Wainmsley</i> , L. R. 1 Eq. 518. |
| (f) <i>Cartier v. Carlile</i> , 31 Beav. | |

under that Act, was decided by Sir C. Hall, V.-C., in *Re Mitchell*, Aug. 2, 1877.

Numerical
figures.

With respect to numerals, they can only be registered in connexion with a new mark, when combined with some essential particular (*a*), and although there have been cases in which the imitation of numerals placed on goods has been restrained (*b*), those cases involve actual fraud, and cannot support a claim to treat numerals alone as a trade mark, independently of the Acts.

(*a*) See Trade Marks Act, 1875,
§ 10.

(*b*) *Gillott v. Kettle*, 3 Duer. 624 ;
R. Cox 148 ; *Gillott v. Esterbrook*, 3

Sickels, 374 ; *Boardman v. Meriden
Britannia Co.*, 35 Com. 402 ; R. Cox,
490.

CHAPTER III.

ACQUISITION, TRANSFER, AND DISCONTINUANCE OF TRADE MARKS.

1. *Acquisition.*

As a general rule, any person capable of acquiring any other species of property is capable of acquiring a right to a trade mark, and this is equally the case with artificial persons, as corporations, as with physical persons, or individuals. ^{Who may acquire.}

A question has, however, been raised as to whether an alien was capable of acquiring a right to a trade mark, but when raised was at once finally decided by Sir W. P. Wood, V.-C., in accordance alike with justice and expediency. The plaintiffs in *The Collins Co. v. Cowen* (a), were an American firm of edge-tool manufacturers, whose trade marks appear to have been systematically infringed by English rivals. In the case in question the defendants, who had copied the plaintiffs' stamp of "Collins & Co., Hartford, cast steel, warranted," demurred. The Vice-Chancellor overruled the demurrer, and observed in the course of his judgment, "I apprehend that every subject of every country, not being an alien enemy—and even to an alien enemy the Court has extended relief in cases of fraud—has a right to apply to this Court to have a fraudulent injury to his property arrested. And here the plaintiffs have the right, a right recognised, I imagine, everywhere in the world, or at least in every civilized community, of saying, 'We, being the manufacturers of certain goods, claim that another man shall not manufacture goods and

(a) 3 K. & J. 428.

put upon them our trade mark, and then pass them off as manufactured by us.' It would be most grievous if any Court should hold that there was an incapacity of affording relief in a case where a fraud has been committed upon a subject of any country. I speak, of course, of a fraud so far connected with property as to be not a shadowy but a substantial injury. If you use the name of another for the purpose of securing to yourself, in the disposition of property, advantages which belong to him, the fraud is complete, and the remedy ought to be complete, as in the case of a libel, where the action is allowed to a foreigner. I cannot in my own mind entertain the slightest misgiving in this case, whether it be new or not" (a).

It is true that in the above case the Vice-Chancellor was not viewing the matter in the light of an acquisition of property by an alien; but at all events no question can now arise on this point, since the rules under the Trade Marks Registration Act, 1875, distinctly provide for the registration of his trade mark by any person, whether a British subject or an alien (b).

Length of
user formerly
required.

There was for some time a doubt as to the circumstances under which one person could acquire a sufficient right to a trade mark to be entitled to restrain another from infringing it. The right to redress being treated as founded on the defendant's intentional fraud, it was thought that a plaintiff who claimed an injunction against a defendant ought to show that he (the plaintiff) had acquired for the mark indicating his manufacture such a reputation (c) as would raise a presumption that the defendant

(a) See also *Collins Co. v. Brown*, 3 K. & J. 423; *Collins Co. v. Walker*, 7 W. R. 222; *Collins Co. v. Reeves*, 28 L. J. Ch. 56; *Howe v. McKernan*, 30 Beav. 547. The same rule obtains in America: *Taylor v. Carpenter*, 3 Story, 458; R. Cox, 14; *Same v. Same*, 2 Wood. & M. 1, R. Con. 32; *Same v. Same*, 11 Paige, 292; R. Cox, 45; *Coats v. Holbrook*,

2 Sandf. Ch. R. 586; R. Cox, 20; and *Lemoine v. Ganton*, 2 E. D. Smith, 343; R. Cox, 142.

(b) See Rule 5. Compare Merchandise Marks Act, 1862, § 1.

(c) In *Hine v. Lart*, 10 Jur. 106, Sir L. Shadwell, V.-C. of Eng., thought that the imitation by a defendant of a plaintiff's trade mark afforded a presumption of that mark having

in adopting a similar mark had done so with the intention of availing himself of that reputation to divert to himself the plaintiff's custom, or at all events that the plaintiff ought to show that he had used the mark long enough to render it probable that such a reputation had been acquired (a).

But when it came to be recognised that there was a right of property in a trade mark, intentional fraud being unnecessary to justify restraint, it was at once seen that, as was stated by Sir J. Romilly, M.R., "the interference of a Court of Equity could not depend on the length of time the manufacturers had used it" (b), but that, "from the time of their commencing the user of their trade mark they became entitled to the protection of the Court against any other persons using the same, so that purchasers might be induced to purchase the goods of other persons as theirs" (c).

Lord Westbury, C., said, in *McAndrew v. Bassett* (d), that the elements of the right to property in a trade mark might be represented as being the fact of the article being in the market as a vendible article with that stamp or trade mark at the time when the defendants imitated it; and he went on: "The essential qualities for constituting that property probably would be found to be no other than these: first, that the mark has been applied by the plaintiffs properly (that is to say, that they have not copied any other person's mark, and that the mark does not involve any false representation) (e); secondly, that the article so marked is actually a vendible article in the market; and thirdly, that the defendants knowing that to

acquired a reputation; and see *Dixon v. Jackson*, Court of Session Cases, 3rd Series V. 326, per the Lord Justice Clerk.

(a) See *Purser v. Brain*, 17 L. J. Ch. 141; *Edelsten v. Vick*, 11 Hare, 78; *Collins Co. v. Brown*, 3 K. & J. 423; and compare *Spottiswoode v.*

Clarke, 2 Ph. 154.

(b) *Hall v. Barrows*, 32 L. J. Ch. 548.

(c) Per Sir C. Hall, V.-C., in *Cope v. Evans*, L. R. 18 Eq. 138.

(d) 33 L. J. Ch. 566.

(e) Compare the latter part of § 6 of the Trade Marks Act, 1875.

be so, have imitated the mark for the purpose of passing off in the market other articles of a similar description "(a).

The mark must be on a vendible article.

From this judgment it follows, and it was expressly recognised in *Maxwell v. Hogg* (b), that no property could be acquired in a trade mark, except through the process of sale, or offering for sale, in the market, of the article to which the trade mark was affixed (c). And in the last-mentioned case it was held that no expenditure during the course of manufacture in advertisements or other announcements to the public of the article so in course of manufacture could give any right in the mark or name by which it was intended that the article should be known when completed and in the market.

Acquisition by registration.

By the Trade Marks Registration Act, 1875, a new manner of acquiring a right to a trade mark is introduced (d), and with respect to new marks (e), substituted for the earlier method, without registration no infringement of a new trade mark can now be restrained (f), but such registration, when effected, is *prima facie* evidence of the right of the registered proprietor to the exclusive use of the trade mark, and is, after the expiration of five years from the date of registration, to be conclusive evidence of his right (g).

Goods classified.

A trade mark must be registered as belonging to particular goods or classes of goods (h), as arranged in the First Schedule to the Rules; the class to which the goods belong being determined, in case of doubt, by the registrar (i). This requirement is no alteration of the rules of the existing law, but is merely a statement of one of those rules as bearing upon registration under the Act. It had

(a) Compare remarks of Lord Kingsdown in the *Leather Cloth Companies' case*, 11 H. L. C. 523.

(b) L. R. 2 Ch. 307.

(c) And see *Rowley v. Houghton*, 2 Brewster, 303; R. Cox, 486.

(d) § 1.

(e) As to old ones see the Amendment Act, 1876

(f) § 1 of Acts of 1875-6-7.

(g) § 3. This is, however, subject to the provisions of the Act as to the connexion of the trade mark with the goodwill of the business. See § 2.

(h) § 2 of Act of 1875.

(i) Rule 3.

been already fully recognised that a particular trade mark could be protected as such only in connexion with particular goods or classes of goods. Thus, Lord Westbury, C., says, "Property in a trade mark is the right to the exclusive use of some mark, name, or symbol, in connexion with a particular manufacture or vendible commodity; consequently, the use of the same mark in connexion with a different article is not an infringement of such a right of property" (a). And again, "An ironfounder who uses a particular mark for his manufactures in iron could not restrain the use of the same mark when impressed upon cotton or woollen goods; for the property in a trade mark consists in the exclusive right to the use of that mark as applied to some particular manufacture" (b). And V.-C. Wood similarly says, that, "This Court has taken upon itself to protect a man in the use of a certain trade mark as applied to a particular description of article. He has no property in that mark, *per se*, any more than in any other fanciful denomination he may assume for his own private use, otherwise than with reference to his trade. If he does not carry on a trade in iron, but carries on a trade in linen, and stamps a lion on his linen, another person may stamp a lion on iron; but when he has appropriated a mark to a particular species of goods, and caused his goods to circulate with this mark upon them," his right to the mark so applied will be protected (c).

The requirement that a trade mark shall be registered as belonging to particular goods or classes of goods is followed up by the provision contained in § 6 of the Act of 1875, by which the registration of a mark identical

Provisions in the Registration Acts and Rules.

(a) *Leather Cloth Co. v. American Leather Cloth Co.*, 33 L. J. Ch. 199.

(b) *Hall v. Barrows*, 33 L. J. Ch. 204.

(c) *Ainsworth v. Wulmsley*, L. R. 1 Eq. 518; and see *Singer Manufacturing Co. v. Wilson*, L. R. 2 Ch.

D. 434—43; *Colladay v. Baird*, 4 Phila. 139; R. Cox, 257; *Rowley v. Houghton*, 2 Brewster, 303; R. Cox, 486; *Amoskeag Manufacturing Co. v. Garner*, 55 Barb. 151; R. Cox, 511.

with, or nearly similar to a mark already registered, is prohibited, not generally, but in connexion with such goods or classes of goods as those in respect of which the mark already on the register is registered (*a*). And, with a view to the protection of the public, this prohibition is extended over a period of five years after the removal of the mark once registered from the register for non-payment of a continuance fee, during which period of five years the renewed mark in question is to be still deemed to be registered for this purpose only (*b*).

Steps necessary to obtain registration.

A person desirous of having his trade mark registered must make an application to the registrar in the prescribed form, by sending to him a statement (*c*), dated, signed, and in the required shape (*d*), together with a declaration (*e*), verifying the statement, and declaring that, to the best of the applicant's knowledge and belief, he is lawfully entitled to use the trade mark (*f*); and also the prescribed fee (*g*).

The statement.

The statement has to contain the following particulars :

- A.* The name, address, and calling of the applicant; and
- B.* The description or reference to a description of the trade mark to be registered (*h*); and
- C.* The class or classes of goods (being some one or more of the classes mentioned in the First Schedule), and the particular description or descriptions of goods in such class or classes, with respect to which he desires the trade mark to be registered; and
- D.* In the case of a trade mark used before the passing of the Act, a description of the goods in respect of which it has been used, and the length of time during which it has been so used (*i*).

(*a*) And see Rule 19, and the original Rule 19 now cancelled.

(*b*) Rule 33.

(*c*) Rule 5.

(*d*) Rules 6 and 7; and see Forms A and B in the Third Schedule to the Rules.

(*e*) See Forms C and D in the

Third Schedule.

(*f*) Rule 9.

(*g*) See Scale of Fees in Second Schedule

(*h*) As to mode of description, see Rule 8.

(*i*) And see Forms A, and B in Third Schedule.

Where the application is made on behalf of a corporate or quasi-corporate body, the statement and declaration are to be made by the secretary or other principal officer, and evidence of his authorization may be required by the registrar (*a*).

Where the application is made on behalf of a firm or partnership, the statement and declaration may be made by any one member of the firm or partnership, or by any person authorized, the registrar being entitled to require proof of due authorization (*b*).

All that remains to be done by the applicant for registration, after sending in his application, is to await an acknowledgment of its receipt by the registrar (*c*), and then to insert in the *Trade Marks Journal* an advertisement during such time and in such form and manner as the registrar shall require, and distinguishing whether the mark was or was not used before August 13, 1875 (*d*). Advertisement, &c.

At the expiration of three months from the date of the first advertisement in the *Trade Marks Journal* the registrar *may*, if satisfied of the applicant's title, register the trade mark (*e*) as from the date of the receipt of the application for registration (*f*), and upon registration is to send notice thereof to the registered proprietor, with a reference, where practicable, to the *Trade Marks Journal* (*g*). Registration.

Marks on cotton goods, or "cotton marks," are governed by special rules (*h*), under which a Manchester office is appointed, to which representations of the mark have to be sent. Cotton marks may be registered at the expiration of three weeks from their first advertisement. Cotton marks.

There are also special rules for marks to be registered in respect of goods within the Cutlers' Company Acts (*i*). Marks on cutlery.

(*a*) Rule 10.

(*b*) Rule 11.

(*c*) Rule 12.

(*d*) Rules 13, 14, 15.

(*e*) Rule 17.

(*f*) Rule 20.

(*g*) Rule 21.

(*h*) Rules 57—63, and Additional Rules of Feb. 1877.

(*i*) Rules 46—56.

When opposi-
tion is made.

If notice of opposition has been sent to the registrar, the applicant may send in a counter-statement within three weeks, or such time as the registrar may allow. If no such counter-statement is sent, the application is deemed to be withdrawn; if it is sent, the person giving notice of opposition will be required to give security for costs, which if he does not do within fourteen days the opposition is deemed to be withdrawn. If he does give the required security, the registrar is to send him a copy of the counter-statement of the applicant for registration, and thereupon the case stands for the determination of the Court (a), *i. e.* the Chancery Division. That determination will properly be given upon an application by the applicant in the shape of a motion to rectify the register by the insertion of the trade mark in dispute (b).

Conflicting
claims.

And where each of several persons claims the same trade mark in respect of the same goods or class of goods, the registrar may register all or any of the marks, and with or without conditions, at his discretion, or may submit or require the claimants to submit their rights to the Court (c) in the form (unless the Court shall otherwise order) of a special case (d), agreed to by the parties, or, in case of difference, settled by the registrar (e).

Issue may be
directed.

The Court may direct an issue to be tried for the decision of any question of fact which may require to be decided for the purposes of these proceedings (f).

Alteration of
registered
trade mark.

Subsequently to registration, the proprietor of a trade mark may, by leave of the Court, alter his trade mark and procure an alteration of the register accordingly, but the alteration must not extend to any of the "essential particulars" of the trade mark (g).

(a) Rule 16.

(b) Rule 43, and § 5 of the Act of 1875. And see *Ex parte Stephens*, 24 W. R. 819.

(c) Act of 1875, § 5, and Rule 18.

(d) Rule 44; and see *Ex parte*

Grimshaw, W. N. 1877, p. 26.

(e) Rule 45.

(f) Act of 1875, § 5.

(g) Rule 35; and as to what are "essential particulars" see Act, § 10.

No notice of any trust, expressed, implied, or constructive, can be received by the registrar, or entered in the register (a). No notice entered on register.

2. *Transfer.*

A trade mark is capable of being assigned during the life of its proprietor, and of being transmitted at his death; but it can be assigned and transmitted only in connexion with the goodwill of the business concerned with the particular goods or classes of goods in respect of which it has been registered (b). Assignment and transmission.

Even apart from the Act there is no doubt that the trade mark cannot be severed from and used independently of the goodwill. If that could be done, the *inducium* of genuineness might only serve to mislead. This view was clearly put by Lord Westbury, C., in the *Leather Cloth Companies' case* (c), when he suggested the case of a firm of clothiers in Wiltshire, trading as A. B. & Co., for fifty years, and acquiring a great reputation for their broad cloth marked "A. B. & Co. Wilts"; then, he asked, supposing A. B. & Co. to discontinue their business, and to sell the right to use the mark to C. D. & Co., clothiers in Yorkshire, would the latter be protected in Equity in their claim to the exclusive use of the mark? and he answered the question in the negative. Trade mark cannot be severed from goodwill.

To such an extent is a trade mark an accessory of the goodwill, that in *Shipwright v. Clements* (d), Sir R. Malins, V.-C., held that in the sale of the latter the trade mark would pass, whether specially mentioned or not (e). Trade mark passes with goodwill.

In a case before the New York Court of Appeal (f), the expression was adopted that "a property in trade mark might be obtained by transfer from him who had made the primary acquisition, though it was essential that the Same principle adopted in America.

(a) Rule 22.

(b) Act of 1875, § 2; and as to declaration to be made by assignee or transmittee on applying to be registered, see Rule 27, and Forms E and F in Third Schedule to Rules.

(c) 33 L. J. Ch. 199; and see

Cotton v. Gillard, 44 L. J. Ch. 90.

(d) 19 W. R. 599.

(e) And see *Churton v. Douglas*, Johns. 174.

(f) *Congress & Empire Spring Co. v. High Rock Congress Spring Co.*, 57 Barb. 526; R. Cox, 99.

transferee should be possessed of the right either to manufacture or sell the merchandise to which the trade mark had been attached." And in another American case (*a*), the statement that the "property or right to a trade mark might pass by an assignment or by operation of law," was followed by this limitation, "to any one who took at the same time the right to manufacture or sell the particular merchandise to which the trade mark had been attached."

Personal
trade mark.

It is possible that occasionally, though rarely, a trade mark may be so framed as not to be merely a simple indication of quality, or a guide to the place of manufacture, but to have the effect of ascribing the article to which it is attached to the personal skill or supervision of an individual. In such a case the question arises whether the trade mark which, when originally adopted, contained no assertion which was incorrect, is capable of transfer to another person so as to enable him to apply it to his own goods and to prevent a similar use of it by others, the personal skill and supervision of its former proprietor having ceased to be applied.

Name of
former
proprietor.

It is, indeed, settled that the mere fact of the trade mark consisting of or containing the name of its former proprietor, who originally conducted the business with which the trade mark is connected, is not of itself sufficient to disentitle the transmittee or assignee of the business to continue to use the mark, since the mere name of the maker will be deemed to be indicative rather of a business, in whosever hands it may be, than of an individual proprietor of it (*b*).

When trade
mark is
personal.

It is, however, conceivable that a trade mark may be "so completely personal as of necessity to import that the

(*a*) *Dixon Crucible Co. v. Guggenheim*, 2 Brewster, 321; *R. Cox*, 559; and see *Walton v. Crowley*, 3 Bl. C. C. 440; *R. Cox*, 166; and *Derringer v. Plate*, 29 Cal. 292; and *R. Cox*, 325.

(*b*) *Bury v. Bedford*, 33 L. J.

Ch. 465; *Churton v. Douglas*, Johns. 174; *Hall v. Barrows*, 33 L. J. Ch. 204; *Leather Cloth Co. v. American Leather Cloth Co.*, 1 H. & M. 271; 33 L. J. Ch. 199; 11 H. L. C. 523.

goods sold under it have been manufactured by a particular individual" (a), as if it contains not only the name of the proprietor, but also some reference to his personal qualifications, or an allusion to particular workmen in his employ (b), in which case the mark will already become deceptive even while the business remains in the same hands, if the proprietor should cease to give his personal attention, or to employ the same workmen.

In such a case, independently of the Registration Acts of 1875-6-7, it is clear that no protection will be given to a mark become deceptive. Thus, Lord Westbury, C., was of opinion that the Court would not sell and transfer the right to use a mark of personal character simply and without alteration (c).

No protection
of deceptive
marks.

The objection to the use of a trade mark become deceptive, which, independently of the Acts, applied rather to the use of the mark assigned than to the power of assigning it (d), should now, as it appears, more properly apply to the registration of the assignee or transmittee, by which the latter acquires, at least, a *prima facie* right to practise deceit. The Act of 1875, indeed, contains no provision expressly directed to meet a case of this kind, the sixth section being only aimed at an attempted registration of a mark disentitled from the beginning to protection, by reason of being calculated to deceive, and not to a registration of a subsequent proprietor of a mark which has lost its right to protection through a change of circumstances. The spirit of the Act is, however, to favour the general assignability of trade marks together with the goodwill to which they are attached,

The Registra-
tion Acts.

(a) Per Sir G. Turner, L. J., in *Bury v. Bedford*, 33 L. J. Ch. 465.

(b) And compare the reference by Lord Kingsdown to an artist's special skill, in *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. C. 523.

(c) *Hall v. Badrows*, 33 L. J. Ch. 204. See, too, the *Clothiers' case*,

suggested by him in the *Leather Cloth Cos.' case*, 33 L. J. Ch. 199; and the remarks of Lord Cranworth in that case in the House of Lords, 11 H. L. C. 523; and those of the L. J. in *Bury v. Bedford*, 33 L. J. Ch. 465.

(d) Per L. J. Turner, *Bury v. Bedford*, 33 L. J. Ch. 465.

and it may be expected that such elements in a trade mark as would impede this assignability will very rarely, if ever, survive the original process of registration now necessary.

Trade marks generally transferable.

Subject only to the provision prohibiting the severance of a trade mark from the goodwill of the business with which it is connected, the trade mark is freely assignable. "The right to a trade mark may, in general, treating it as property, or an accessory of property, be sold and transferred upon a sale and transfer of the manufactory of the goods on which the mark has been used to be affixed, and may be lawfully used by the purchaser" (a). If this were not so the value of a very valuable and important part of the goodwill of the business carried on by a person (b) would be seriously diminished. And for a similar reason, and in the interest alike of the owner of a trade mark himself and of his assignee, the original owner will, subsequently to assignment, be restrained from the use of his former trade mark, equally with persons who have never had an interest in it (c). The same will be the case if the sale has been made, not by the owner himself, but by his trustee in bankruptcy (d). Any transmittee may assign his interest in a registered mark, though he has never been registered as proprietor of it (e); and in the sale of a business a trade mark will pass to the purchaser without special mention (f).

Steps necessary for assignment of

A person claiming to be registered as an assignee is required to send to the registrar, with his application, an

(a) Per Lord Cranworth in *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. C. 523; and see per V.-C. Wood in *Ainsworth v. Walsley*, L. R. 1 Eq. 518; also *Hall v. Barrows*, 33 L. J. Ch. 204; and *Hudson v. Osborne*, 39 L. J. Ch. 79.

(b) Compare the observations of Sir W. P. Wood, V.-C., as to the sale of a trade name, in volving the

same considerations, in *Churton v. Douglas*, Johns. 174.

(c) *Bury v. Bedford*, 33 L. J. Ch. 465; and see *Churton v. Douglas*, Johns. 174.

(d) *Hudson v. Osborne*, 39 L. J. Ch. 79.

(e) Rule 25.

(f) *Shipwright v. Clements*, 19 W. R. 599.

assignment by deed (*a*), executed both by assignor and assignee, or a certified copy of such assignment, and a declaration verifying the fact of such assignment having been made (*b*), and stating the name and address of the applicant, and that he is entitled to the goodwill of the business, or some part of it (*c*). If the application is made in the form suggested in the Instructions (*d*), the declaration will be in accordance with Form D, omitting paragraphs (2) and (3).

registered
trade marks.

On the owner of a trade mark becoming bankrupt, his trade mark is transmitted with his business to his trustee in bankruptcy, and will, together with the business and goodwill, be dealt with by him (*e*). A person claiming to be registered as transmittee under a bankruptcy must send to the registrar, together with his application, a statement of the manner in which the trade mark has been transmitted, and a declaration verifying such statement (*f*). The declaration must state the same matters as that made by an assignee (*g*).

Transmission
on bank-
ruptcy.

In cases in which a trade mark belonging to a woman passes with her other personalty on marriage to her husband, the latter must, on applying for registration, send to the registrar a similar statement and declaration (*h*).

Trade mark
of woman.

Upon the formation of a partnership, one member of which is the proprietor of a trade mark, the trade mark will, in the absence of express provisions, pass into and become part of the partnership assets, for the trade mark is but an element of the trade (*i*). In that case it seems that the partner who has newly acquired an interest in the

Formation of
partnership.

(*a*) See Form E, in Third Schedule to Rules.

(*b*) Rule 24.

(*c*) Rule 27.

(*d*) Instructions, *infra*.

(*e*) *Hudson v. Osborne*, 39 L. J. Ch. 79; *Cotton v. Gillard*, 44 L. J. Ch. 90; *Bury v. Bedford*, 33 L. J. Ch. 465; *Ex parte Young*, Court of Bankruptcy, Feb. 3, 1877. And see *Longman v. Tripp*, 2 Ros. &

P. N. R. 67; and *Ex parte Foss*, 2 De G. & J. 230.

(*f*) Rule 25. And see Form F, in the Third Schedule to the Rules.

(*g*) Rule 27. As to evidence, see Rule 26—(1)—C.

(*h*) Rules 25 and 27, and Form F, in the Third Schedule. As to evidence, see Rule 26—(1)—B.

(*i*) *Bury v. Bedford*, 33 L. J. Ch. 465, per Sir G. Turner, L. J.

trade mark will be entitled to registration as joint-proprietor with his partner who is already on the register (a).

Dissolution of partnership.

Upon the dissolution of a partnership among whose property a trade mark is included, whether that dissolution be brought about by the mutual agreement of the partners, or by the death of one of them, the trade mark, as forming part of the partnership assets, and also on account of its close connexion with the goodwill of the business, must be treated in the same way as the business and goodwill are treated, unless there is an express agreement for its discontinuance. If the business and goodwill are sold, the trade mark will be included in the sale (b); if the share of the retiring or deceased partner is, by arrangement, taken over by the continuing or surviving partner or partners, the retiring or deceased partner's interest in the trade mark must be included in the valuation of his share of the business (c); if the partners merely agree to divide the partnership assets, so that each in effect carries on the same business, though they carry it on severally instead of jointly, then each is at liberty to use the mark as he did before (d).

Registered proprietors alone recognised.

By Rule 28, where two or more persons are registered as joint proprietors of the same registered trade mark, those proprietors, or the survivors or survivor of them, or their or his assignee or transmittee, are alone to be recognised by the registrar as having any title to the mark. This does not take away from other persons any rights which they might have independently of the statute, but aims at keeping the register free from complicated questions, just as trusts are forbidden to be entered therein (e).

(a) See Rule 28. As to the evidence, see Rule 26—(1)—C.

(b) *Bradbury v. Dickens*, 27 Beav. 53; *Hall v. Barrows*, 38 L. J. Ch. 204; *Banks v. Gibson*, 34 Beav. 566.

(c) *Banks v. Gibson*, 34 Beav.

566; *Hall v. Barrows*, 38 L. J. Ch. 204.

(d) *Banks v. Gibson*, 34 Beav. 566. And see *Bond v. Millbourn*, 20 W. R. 197.

(e) Rule 22.

By Rule 25, where a trade mark has been transmitted by the death of the registered proprietor, his legal personal representative shall be recognised as having the title to the mark. So long since as the reign of King George II., Lord Hardwicke, C., decided (*a*) that shares in the goodwill of a newspaper, entitled *The St. James's Evening Post*, were to be considered as part of the personal property of the proprietor; and that, on the death of the proprietor, his trade mark passes to his personal representative with the remainder of his personal property has never been questioned (*b*).

Transmission
on death.

In order to obtain registration, the legal personal representative of a deceased proprietor has to make such a declaration as is contained in Form F, in the Third Schedule to the Rules (*c*).

Registration
of personal
representa-
tive.

The proprietor of a trade mark may bequeath it according to pleasure (*d*), but this is subject to the provision prohibiting its transmission otherwise than in connexion with the goodwill of his business (*e*).

Bequest of
trade mark.

By means of bequest, dissolution of partnership, &c., it is possible for more than one person to become severally entitled to the same trade mark at the same time (*f*), and in a case where divers persons so claim, such persons, or any of them, may, if they all consent thereto, and on the production of the proper evidence, and on payment of the prescribed fee, be registered separately as separate proprietors of such trade mark (*g*). But, if all of such persons so entitled do not so consent, the registrar shall not,

Several
proprietors.

(*a*) *Giblett v. Read*, 9 Mod. 459.

26—(1)—A.

(*b*) Thus, in *Croft v. Day*, 7 Beav. 84, 28 Leg. Obs. 378, the successful plaintiffs were the executors of the former proprietor of the business and trade mark.

(*d*) *Dent v. Turpin*, 2 J. & H. 139.

(*e*) Act of 1875, § 2.

(*c*) By way of evidence he must produce the probate of the will of the deceased proprietor, or the letters of administration to his estate, or an official extract therefrom. Rule

(*f*) *Hine v. Lart*, 10 Jur. 106; *Dent v. Turpin*, 2 J. & H. 139; *Banks v. Gibson*, 34 Beav. 566; and see *Southorn v. Reynolds*, 12 L. T. N. S. 75.

(*g*) Rule 29.

without the leave of the Court (a), register any of them as separate proprietors of such trade mark (b).

Position of subsequent proprietors.

By the 4th section of the Act of 1875, every proprietor registered in respect of a trade mark subsequently to the first registered proprietor is, as respects his title to that trade mark, to stand in the same position as if his title were a continuation of the title of the first registered proprietor (c).

When opposition.

In case of opposition being offered to the registration of any assignee or transmittee (d), the person opposing must send notice of his intention to the registrar, with the prescribed fee. The registrar has then to give notice to the applicant for registration, and may, if he thinks fit, require security for costs from the opponent. Finally, he may, if he thinks fit, require the parties interested to submit their claims to the Court (e).

3. *Discontinuance.*

When trade mark protected.

In order for a trade mark to be entitled to protection, it is now necessary either that the trade mark shall be registered under the Registration Acts (f), or that, if an old mark is in question, a certificate of refusal to register shall have been obtained under the Amendment Act of 1876 (g). The protection of a mark once registered terminates, therefore, with the cessation of registration.

Duration of registration.

The original registration of a trade mark is for a period of fourteen years, and unless previously to the expiration of that period the fee (h) for continuance is paid, the registrar may, after the end of three months from such expiration, remove the mark from the register, and in the same way from time to time at the expiration of every fresh period of fourteen years (i). No difficulty need in ordinary

(a) Obtained on application to rectify the register, under Rule 43.

(b) Rule 29.

(c) Compare *Hovenden v. Lloyd*, 18 W. R. 1132.

(d) Rule 38.

(e) See Rule 44, as to the

method.

(f) 38 & 39 Vict. c. 91; 39 & 40 Vict. c. 33; 40 & 41 Vict. c. 37.

(g) See § 1 of Act of 1876.

(h) £2. See Second Schedule to Rules.

(i) Rule 30.

cases be apprehended in the prolongation of registration, for the exclusive use of a trade mark is no injury or deprivation to the public, but a protection against fraud.

If subsequently to the expiration of the fourteen years, but before the expiration of the additional three months, the proprietor pays the increased fee (*a*), the registrar may accept the fee as if paid before the expiration of the fourteen years, and allow the mark to remain on the register (*b*).

Even after the removal from the register for non-payment of the fee, the mark may be restored to the register by the Commissioners of Patents, or one of them, if they are satisfied that it is just, on payment of an additional fee (*c*) and compliance with conditions prescribed by the Commissioners (*d*).

Restoration to register.

Independently of the Trade Marks Registration Acts, no trade mark can exist as such unless there is actually existent in the market a vendible article to which the mark is in some way affixed or attached (*e*).

Must be a vendible article with trademark attached

The necessity of proving the existence of such an article so marked, in the case of registered marks, now no longer exists, since, subject to the connexion with the goodwill of the business, registration is to be deemed to be equivalent to public use (*f*).

Registration now equivalent to public use.

In order, therefore, to prevent the continuance of restrictions which no longer serve any useful purpose, it is provided by the 34th Rule that the Court, *i. e.* the Chancery Division, may, on the application of any person aggrieved, remove any trade mark from the register, on

Removal on ground of non-user.

(*a*) £1 in addition. See Second Schedule to Rules.

(*b*) Rule 31.

(*c*) £2 in addition. See Second Schedule to Rules.

(*d*) Rule 32.

(*e*) *McAndrew v. Bassett*, 33 L. J. Ch. 561; *Maxwell v. Hogg*, L. R. 2 Ch. 307. And see *Singer Manufacturing Co. v. Wilson*, L. R. 2 Ch. D. 434. In *Cotton v. Gillard*, 44 L. J.

Ch. 90, the plaintiffs had bought from the trustee in bankruptcy the interest of the bankrupt in a certain sauce and in his trade mark, but the sauce being compounded according to a secret which the trustee could not communicate, Sir G. Jessel, M. R., held that the plaintiff could not use or protect the trade mark.

(*f*) § 2 of the Act of 1875.

the ground, after the expiration of five years from the registration, that the registered proprietor is not engaged in any business concerned in the goods with respect to which the trade mark is registered; that is to say, that there is in the market no vendible article of the proprietor of the trade mark marked therewith.

Old marks
become
descriptive.

Under the law of trade marks previously to the Registration Acts, a trade mark might be composed in a manner not now admissible for new marks: for instance, it might consist of a fancy word or words. Such marks may now be registered under the Registration Acts, but only in cases in which they have been used as trade marks previously to the Act of '875 (a). With respect to such trade marks it has occasionally happened that they have ceased to denote the manufacture of any particular person, and have become simply descriptive of a certain article or a certain principle of manufacture. When that has become the case, such words have ceased to be capable of protection as trade marks, having become *publici juris*, open to the use of all (b). Where a name, which it has been attempted to appropriate as a trade mark, has been in fact descriptive throughout, the case can hardly be said to have arisen of a discontinuance of a trade mark, inasmuch as it was invalid throughout (c).

Trade mark
not abandoned
by habitual
user in com-
bination with
name.

In *Braham v. Bustard* (d), and *Ford v. Foster* (e), it was held that the habitual use of the manufacturer's name (which was alone a sufficient trade mark), before the special and distinctive appellation of "Excelsior" in the one case, and "Eureka" in the other, did not amount to an

(a) § 10 of Act of 1875.

(b) Per Sir G. Mellish, L. J., in *Ford v. Foster*, L. R. 7 Ch. 611. And see *Wheeler & Wilson Manufacturing Co. v. Shakespeare*, 39 L. J. Ch. 56; *Liebig's Extract of Meat Co. v. Hanbury*, 17 L. T. N. S. 298; *Browne v. Freeman*, W. N. 1873, p. 178; *Lea v. Millar*, M. R., July 26, 1876; and *Seton*, 4th ed. 242; *Wolfe*

v. Goulard, 18 How. Pr. R. 64; R. Cox, 226; *Burke v. Cassin*, 45 Cal. 467; 13 Amer. Rep. 204. See also the Merchandise Marks Act, 1862, § 9.

(c) *Young v. Macrae*, 9 Jur. N. S. 322; *Raggett v. Findlater* L. R. 17 Eq. 29.

(d) 1 H. & M. 447.

(e) L. R. 7 Ch. 611.

abandonment of the manufacturer's right in those appellations when used without the name, but that the manufacturer remained entitled to his essential mark.

Under the Registration Acts, a new trade mark cannot now well become *publici juris*, for since "the distinctive device, mark, heading, label, or ticket" (a), does not include special and distinctive words not used as a trade mark before the Act (b), such a symbolical device as will generally be employed cannot well become descriptive, or *publici juris*, though such phrases as "anchor-brand wire" (c), "cross cotton" (d), may possibly be employed. If the name of the manufacturer is used, it will only constitute a trade mark when in the form of a signature or some other particular and distinctive shape (e), so that the trade mark will not be infringed unless, not only the name, but the mode of printing, &c., be imitated. In short, from the framing of § 10 of the Act of 1875, a mere word cannot be registered as a new trade mark, and consequently no new trade mark will be of such a nature as to be capable of innocent common user. Whether or not distinct evidence of fraudulent intentions and representations, apart from strict trade mark law, can be produced, is of course another question.

In *Browne v. Freeman* (f), it was held that the plaintiff having previously commenced a suit against an infringer of his trade mark, and then having got his bill dismissed with costs, in consequence of being advised that his right was doubtful, had lost all rights in the trade mark. Under the Registration Acts such a loss of trade mark can hardly occur except in the case of unregistered though certified marks, since the rights of a proprietor of a registered mark are such that it is impossible to suppose that such a

Marks new since the Registration Acts incapable of becoming descriptive.

Abandonment by dismissal of suit.

(a) § 10 of Act of 1875.

(b) *In re Stevens*, L. R. 3 Ch. D. 292.

659.

(c) *Edelsten v. Edelsten*, 1 De G. J. & S. 185.

(d) *Cartier v. Carlile*, 11 Beav.

292.

(e) § 10 of Act of 1875.

(f) 12 W. R. 305; and see W. N. 1873, p. 178.

proprietor would resign his claims without a struggle. With respect to marks unregistered, or even uncertified, there does not appear to be anything in the Act to prevent proof of the imitation of such marks being given in support of an action for unfair competition in trade carried on by means of actual intentional fraud, and not depending solely on the similarity of the marks (a).

Abandonment
of registered
marks not to
be anticipated.

On the whole, it may be expected that, while with respect to unregistered marks things will remain much as they were, with respect to registered ones there will be in the future no discontinuance or abandonment, except where registration has been discontinued, in consequence of non-compliance on the part of the registered proprietor with the requirements of the Act with respect to prolonged registration.

Infringement
of disused
mark.

In *Lemoine v. Ganton* (b), a plaintiff was allowed to recover nominal damages for the infringement by the defendant of a trade mark which the plaintiff had formerly used, but had ceased to use for a year. By Rule 33, a registered trade mark removed from the register is to be deemed for five years after such removal to be a trade mark already registered, so far as is necessary in order to prevent the registration for that period by another person of the same or a similar mark for goods in the same class.

(a) Compare the remarks on the second class of cases by Sir G. Jessel, M.R., in *Singer Manufacturing Co.*

v. *Wilson*, L. R. 2 Ch. D. 443.

(b) 2 E. D. Smith, 343; R. Cox, 142.

CHAPTER IV.

INFRINGEMENT.

WHEN an action has been commenced, having for its object the restraint of an unfair competition in trade, carried on by means of an employment by the defendant of a trade mark identical, or nearly identical, with the plaintiff's, there must be established, in order for the action to be successful, the existence of the trade mark, the plaintiff's exclusive right therein, the fact of an imitation, and the absence of licence or acquiescence on the part of the plaintiff (a). Requisites for infringement.

Assuming, then, the validity of the trade mark and the rights of the plaintiff therein to be established, the next and most important point for the plaintiff to prove is the fact of infringement. The plaintiff has no right to say that the defendant shall not sell exactly the same article, better or worse, or an article looking exactly like his own unpatented article, but he has a right to say that the defendant shall not sell such article in such a way as to steal (so to call it) the plaintiff's trade mark, and make purchasers believe that it is the manufacturer to which that trade mark was originally applied (b). In the language of the Common Law, the defendant has no right to sell his goods "as and for" those of the plaintiff (c). Fact of infringement.

(a) See *Kinahan v. Bolton*, 15 Ir. Ch. 75; and *Leather Cloth Co. v. American Leather Cloth Co.*, 33 L. J. Ch. 199.

(b) See per Lord Cranworth, C., in *Farina v. Silverlock*, 6 De G. M. & G.

214; and per Lord Langdale, M.R., in *Franks v. Weaver*, 10 Beav. 297.

(c) *Sykes v. Sykes*, 3 B. & Cr. 541; *Morison v. Salmon*, 2 Man. & G. 385; *Crawshay v. Thompson*, 4 Man. & G. 357.

Fraudulent
intention.

The question of how far a fraudulent intention in the mind of the defendant was necessary to entitle the plaintiff to obtain redress from him long remained a subject of discussion in connexion with trade marks. The doctrine of the Common Law was that, inasmuch as the only manner in which the Common Law could be set in motion to repair the wrongful proceedings of an infringer was by the institution of an action on the case (a), an allegation of intentional fraud (b), supported by evidence, was necessary to enable the plaintiff to bring his action to a successful conclusion (c).

First pur-
chaser not
deceived.

While, however, it was necessary at Common Law for a fraudulent intention to be proved, it was not required that the defendant should have represented to his immediate purchaser that the goods marked were of the plaintiff's manufacture, it was sufficient to bring the case within the reach of the law if he had sold the goods for the purpose of their being resold as and for goods of the plaintiff's manufacture, which object the mark attached to them by the defendant would be calculated to facilitate (d).

Early doctrine
in Chancery.

When plaintiffs in trade-mark cases began to seek redress in the Court of Chancery, desirous of obtaining the more convenient remedy by way of injunction and account, which was superior to the damages to be gained at Common Law alike in the compensation for the past and in the security for the future, the Chancery judges held that the Courts in which they presided could act only in aid of, and as ancillary to the legal right (e). And acting upon this same principle, they held that the rules by which they had to judge of infringement must be identical with those of the Common Law, the plaintiff's right to his remedy

(a) See *Crawshay v. Thompson*, 4 Man. & G. 357.

(b) I.e. that the defendant had acted knowingly—*scienter*.

(c) *Singleton v. Bolton*, 3 Doug. 293; *Morison v. Salmon*, 2 Man & G. 385; *Crawshay v. Thompson*, 4 Man. & G. 357; *Rodgers v. Nowill*,

5 C. B. 109; and *Myers v. Baker*, 3 H. & N. 802. See, too, per Parke, B., in *Taylor v. Ashton*, 11 M. & W. 415.

(d) *Sykes v. Sykes*, 3 B. & Cr. 541; and see *Chappell v. Davidson*, 2 K. & J. 123.

(e) See per Lord Cottenham, C., in *Motley v. Downman*, 3 My. & Cr. 1.

being considered to be based, not on any right of property in him, but on the fraudulent proceedings of the defendant (a). The cases which were frequently sent by Chancery judges to be tried at Common Law by a jury were, of course, tried in accordance with Common Law principles (b).

It is however, apparent that the seriousness of the injury inflicted on the manufacturer who has acquired a reputation for excellence in a particular class of goods, denoted by a special trade mark, by the offering for sale in the market of other goods, side by side with his, bearing the same mark, is not affected by the question whether such rival goods are made and marked by a person who is aware of the reputation of the original goods and desirous of attracting to himself some of the profits of that reputation, or by one who is actuated by no such motives and is even ignorant of the prior use of the mark. The first maker is defrauded, even though his rival's conduct be not intentionally fraudulent.

Same injury caused, whether actual fraud or not.

In 1838, Lord Cottenham, C., awarded a perpetual injunction in a case in which he rejected any imputation of intentional fraud (c), and this is not now necessary to obtain redress in Equity. The principles in accordance with which relief will be given in Equity were summed up as follows by Lord Westbury, C.:—"At Law the proper remedy is by an action on the case for deceit, and proof of fraud on the part of the defendant is of the essence of the action; but the Court will act on the principle of protecting property alone, and it is not necessary for the injunction to prove fraud in the defendant, or that the credit of the

Later doctrine in Chancery.

(a) *Blanchard v. Hill*, 2 Atk. 484; *Canham v. Jones*, 2 V. & B. 218; *Perry v. Truefitt*, 6 Beav. 66; *Croft v. Day*, 7 Beav. 84; and see the observations of V.-C. Wood in *Edelsten v. Vick*, 11 Hare, 78; *Collins Co. v. Cowen*, 3 K. & J. 428; *Leather Cloth Co. v. American Leather Cloth*

Co., 1 H. & M. 271; *Hall v. Barrows*, 32 L. J. Ch. 548; and *McAndrew v. Bassett*, 33 L. J. Ch. 561.

(b) *E.g.*, *Rogers v. Nowill*, 5 C. B. 109.

(c) *Millington v. Fox*, 3 My. & Cr. 338.

plaintiff is injured by the sale of an inferior article. The injury done to the plaintiff in his trade by loss of custom is sufficient to support his title to relief. Neither will the plaintiff be deprived of remedy in Equity, even if it be shown by the defendant that all the persons who bought from him goods bearing the plaintiff's trade mark were well aware that they were not of the plaintiff's manufacture. If the goods were so supplied by the defendants for the purpose of being sold again in the market the injury to the plaintiff is sufficient. Again, it is not necessary for relief in Equity that proof should be given of persons having been actually deceived, and having bought goods with the defendant's mark, under the belief that they were of the manufacture of the plaintiff, provided that the Court be satisfied that the resemblance is such as would be likely to cause the one mark to be mistaken for the other" (a). It is not necessary for the plaintiff to show that the defendant knew whose trade mark his resembled (b), nor, in fact, to show that the defendant knew that his trade mark resembled any existing mark (c). In short, "the absence of fraudulent intention is no defence against an application to the Court for an injunction by the person whose property has been injured" (d).

Indulgence to
innocent
offender.

It was, however, suggested by Lord Romilly, M.R., that the Court would not require a person to completely change a trade mark which he had taken *bonâ fide*, and without any intention of deception, but which did in point of fact resemble the trade mark of another person, since the complete change of trade mark might be of so serious consequence to the unintentional offender (e).

(a) *Edelsten v. Edelsten*, 1 De G. J. & S. 185. That the rule of the Court of Chancery was as here stated, was recognised by the Court of Queen's Bench in *Dixon v. Fawcus*, 3 Ell. & Ell. 537.

(b) *Cartier v. Carlile*, 31 Beav. 292.

(c) *Kinahan v. Bolton*, 15 Ir. Ch.

75; *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Burgess v. Hills*, 20 Beav. 244; *Harrison v. Taylor*, 11 Jur. N. S. 408.

(d) Per Sir J. Stuart, V.-C., in *Clement v. Maddick*, 1 Giff. 98.

(e) *Bass v. Dawber*, 19 L. T. N. S. 626.

It is also important to prove the fact of fraudulent intention, having regard to the account to be obtained, which may not be given in respect of sales by the defendant during such time as he continued in ignorance that he was infringing the plaintiffs' rights (a). Fraudulent intention, as affecting account.

Again, in *Rodgers v. Rodgers* (b), Sir G. Mellish, L.J., expressed an opinion that, in a case in which the application for an injunction would, in the absence of proof of actual fraud, have to be rejected on the ground of long user by the defendants without assertion by the plaintiffs of their right, yet if it were clearly made out that the use of the trade mark by the defendants was fraudulent, and that it had the practical effect of deceiving the public, then that in such a case the intentional fraud would operate to prevent the application for the injunction from being defeated on the ground of lapse of time. Fraudulent intention in case of delay.

Further, in *Radde v. Norman* (c), it was held by Sir J. Wickens, V.-C., to be quite obvious that much less absolute proof of the plaintiffs' title would be required where there was reason to doubt the defendants' good faith; and in *Cope v. Evans* (d), Sir C. Hall, V.-C., said that where fraudulent intention was proved, the Court would restrain the defendants without further enquiry. In other respects.

In default of direct proof of fraudulent intention, there are various circumstances which may serve to point to the conclusion that such intention has existed: thus, the exact imitation of peculiar characteristics (e); the addition to an existing mark of a feature taken from the plaintiff's mark (f); the removal, one by one, of points of difference, which originally served to distinguish the defendant's mark from the plaintiff's (g); the marking goods in obedience to an order to imitate the plaintiff's Circumstances pointing to fraudulent intention.

(a) *Edelsten v. Edelsten*, 1 De G. J. & S. 185.

(b) 31 L. T. N. S. 285.

(c) L. R. 14 Eq. 348.

(d) L. R. 18 Eq. 138. And see *Mitchell v. Condy*, W.N. 1877, p. 153.

(e) *Hine v. Lart*, 10 Jur. 106.

(f) *Dixon v. Jackson*, Court of Session Cases, 3rd series, V. 326 (a star added).

(g) *Farina v. Cathery*, L. J. Notes of Cases, 1867, p. 134.

mark (*a*); the adoption of an essential part of the plaintiff's mark, with a trifling and colourable alteration (*b*); the use by the defendant of a name not his own (*c*), possibly under the authority of some person who bore the same name as the plaintiff (*d*); and the formation of a partnership with another person, whose name or initial was such as to enable the defendant to imitate the plaintiff's mark with some specious pretence of legality (*e*)—have all been held to afford ground for reasonable suspicion of the presence of an *animus fraudandi*.

Circumstances pointing to absence of fraud.

On the other hand, if the defendant uses, on the goods which he is alleged to be endeavouring to pass off as the plaintiff's, a distinct and obvious trade mark of his own, or if he states plainly and in fair sized and clear type that such goods are in fact manufactured by himself, there is a strong indication that the defendant has no intention of attempting deception (*f*).

Fraudulent intention in user of name.

With respect to trade marks used before the passing of the Trade Marks Registration Act, 1875 (*g*), and consisting of a name printed or stamped in ordinary characters, which might be the case independently of the Act, it has been held that it is not necessary, in order to obtain an injunction, to prove the *scienter* where the infringer does not bear the name he has assumed (*h*), but that on the other hand, where he does bear that name, such evidence must be produced (*i*).

Infringement of new registered marks.

With respect to names first used as trade marks after

(*a*) *Woollam v. Ratcliff*, 1 H. & M. 259.

(*b*) *Radde v. Norman*, L. R. 14 Eq. 348 ("Leopoldsalt," for "Leopoldshall").

(*c*) *Ainsworth v. Walmsley*, L. R. 1 Eq. 518.

(*d*) *Meriden Britannia Co. v. Parker*, 39 Conn. 450; 12 Amer. Rep. 401.

(*e*) *Croft v. Day*, 7 Beav. 84 (Day & Martin); *Moet v. Clybourn*, M. R., Jan. 19, 1877 (M. & C.). And

see *Schweitzer v. Atkins*, 37 L. J. Ch. 847.

(*f*) *Singer Manufacturing Co. v. Wilson*, L. R. 2 Ch. D. 434—444; so, too, in *Cheavin v. Walker*, L. R. 5 Ch. D. 850, where the goods were stated to be manufactured by the defendants.

(*g*) 38 & 39 Vict. c. 91.

(*h*) *Ainsworth v. Walmsley*, L. R. 1 Eq. 518.

(*i*) *Burgess v. Burgess*, 3 De G. M. & G. 89.

the passing of the Act, the requirement that they shall be "printed, impressed, or woven, in some particular and distinctive manner" (a), renders the mere use of the same name no infringement, unless the particular and distinctive manner is also copied, in which case evidence of actual intentional fraud will be unnecessary, whatever may be the name of the infringer.

"When it is not a case pure and simple of trade mark, it must depend upon actual fraud; that is, the defendant must be shown to have said or done something which, as between him and the person with whom he was dealing, amounted to a fraudulent representation that his goods were the goods of the person who is complaining of his act or word. Actual fraud must be proved" (b), and "if nobody is deceived, no wrongful act is committed" (c). This is so, whether the defendant in such a case of quasi-trade mark has imitated something which might have been a trade mark if used as such (d), or has simulated any other appearances which have had the effect of gaining for him the custom which the public intended for the plaintiff (e).

When no trade mark, infringement must be fraudulent.

That a registered trade mark is property, and evidence of fraudulent intention unnecessary, is now established by the Registration Act, 1875, § 3, in accordance with which the registration of a person as first proprietor of a trade mark is *prima facie* evidence of his right to the exclusive use of such trade mark, and shall, after the expiration of five years from the date of such registration, be conclusive evidence of his right to the exclusive

Infringement of registered trade mark without actual fraud.

(a) § 10 of the Act.

(b) Per James, L.J., *Singer Manufacturing Co. v. Wilson*, L. R. 2 Ch. D. 484—52.

(c) Per Mellish, L.J., *ib.* 455.

(d) Thus, where the possible mark has not been applied to a vendible article in the market.

(e) In such cases, for instance, as *Knott v. Morgan*, 2 Keen, 213, where

a variety of circumstances were imitated, so as to produce in the defendant's omnibus a similarity to the plaintiff's; *Hogg v. Kirby*, 8 Ves. 215, where the question had reference to the general appearance and contents of a magazine; or *Spottiswoode v. Clarke*, 2 Ph. 154, where it related to the arrangement of the title-page of an almanac.

use of such trade mark, subject to the provisions of the Act as to its connexion with the goodwill of a business. And by § 4 the title of a subsequent proprietor is to be treated as a continuation of the title of the first registered proprietor.

What is infringement.

The real question which the Court has to try in a case of alleged infringement of trade mark, is whether what the defendant has done is calculated to deceive, whether there is so much imitation that goods bearing the one mark may be readily mistaken for goods bearing the other.

Croft v. Day.

In *Croft v. Day* (a), it was remarked by Lord Langdale, M.R., that two things were necessary for the accomplishment of a fraud such as was there contemplated: "First, there must be such a general resemblance of the forms, words, symbols, and accompaniments as to mislead the public; and, secondly, a sufficient distinctive individuality must be preserved, so as to procure for the person himself the benefit of that deception which the general resemblance was calculated to produce. To have a copy of the thing would not do, for, though it might mislead the public in one respect, it would lead them back to the place where they were to get the genuine article, an imitation of which was improperly sought to be sold. For the accomplishment of such a fraud, it was necessary in the first instance to mislead the public, and in the next place to secure a benefit to the party practising the deception by preserving his own individuality" (b). In that case, however, a deliberate attempt was made to represent the defendant's establishment as the plaintiff's, and the injury done to the plaintiff by the sale of goods bearing the spurious marks instead of his genuine goods is ordinarily sufficient to entitle him to his remedy, independently of any habit induced in the customer to resort to the defendant instead of to the plaintiff.

(a) 7 Beav. 84.

(b) And see *Rowley v. Houghton*, 2

Brewster, 303 ; R. Cox, 486.

By what test, then, has it to be determined whether there is such a degree of similarity as to require the interference of the Court? Tests of infringement.

In the first place, where one person has adopted the trade mark of another, or a mark nearly resembling it, and there is evidence of actual deception; that is to say, "that any one has in fact been thereby induced to buy the defendant's goods as being the goods of the plaintiff," the Court will restrain the defendant without further enquiry (a). Actual deception. The question of resemblance has been decided by the test of facts. It is not, indeed, necessary that there shall have been actual deception (b); but since, unless that can be proved, the case which the Court has to try is a hypothetical case, in which honest evidence as to probability of deception can be procured on both sides, it is always safer for a plaintiff to obtain proof of actual deception if possible, and a certain degree of delay to enable him to obtain such proof will be excused (c).

In most cases, however, there is not produced any evidence of actual deception, and the plaintiff then has to satisfy the Court or jury that the defendant has used a mark either identical with, or only colourably differing from his own (d). Probable deception. It is not sufficient for the plaintiff to produce evidence tending to show that in the opinion of the witnesses deception may occur: he has to convince the Court or jury that there is such reasonable probability of deception as to justify interference with the defendant (e).

(a) *Cope v. Evans*, L. R. 18 Eq. 138; and see *Woollam v. Ratcliff*, 1 H. & M. 259.

(b) *Abbott v. Bakers and Confectioners' Tea Association*, W.N. 1871, p. 207; and see *Filley v. Fassett*, 44 Mo. 173; R. Cox, 530; and *Dixon Crucible Co. v. Guggenheim*, 2 Brews. 321; R. Cox, 559.

(c) *Lee v. Haley*, L. R. 5 Ch. 155.

(d) See *Cartier v. Carlile*, 31 Beav. 292; and *Cope v. Evans*, L. R. 18 Eq. 138.

(e) *Blackwell v. Crabb*, 36 L. J.

Ch. 504; *Bass v. Dawber*, 19 L. T. N. S. 626; *Cope v. Evans*, L. R. 18 Eq. 138; *Snowden v. Noah*, Hopk. 347; R. Cox, 1; *Colladay v. Baird*, 4 Phila. 139; R. Cox, 257; *Colton v. Thomas*, 2 Brewster 308; R. Cox, 507; *Falkinburg v. Lucy*, 35 Cal. 52; R. Cox, 448; *Bell v. Locke*, 8 Paige, 75; R. Cox, 11; *Ledger v. Ray*, Court of Appeal, May 3, 1877; *Stevens v. De Conto*, 7 Robertson, 343; R. Cox, 442; *Wylam v. Clarke*, W. N. 1876, p. 68.

When is
deception
probable.

It is obvious that in these cases questions of considerable nicety may arise; and, in the language of Lord Cranworth, C., in *Siexo v. Provezende* (a), "it is hardly necessary to say that, in order to entitle a party to relief, it is by no means necessary that there should be absolute identity (b). What degree of resemblance is necessary, is, from the nature of things, a matter incapable of definition *d priori*. All that Courts of Justice can do is to say that no trader can adopt a trade mark so resembling that of a rival as that *ordinary purchasers, purchasing with ordinary caution*, are likely to be misled (c).

"It would be a mistake, however, to suppose that the resemblance must be such as would deceive persons who should see the two marks placed side by side. The rule so restricted would be of no practical use. If a purchaser looking at the article offered to him would naturally be led, from the mark impressed on it, to suppose it to be the production of the rival manufacturer, and would purchase it in that belief, the Court considers the use of such a mark to be fraudulent. But I go farther. I do not consider the actual physical resemblance of the two marks to be the sole question for consideration. If the goods of a manufacturer have, from the mark or device he has used, become known in the market by a particular name, I think that the adoption by a rival trader of any

(a) L. R. 1 Ch. 192.

(b) As to this, see per Lord Chelmsford in *Wotherspoon v. Currie*, L. R. 5 H. L. 508; and per Sir R. Malins, V.-C., in *Anglo-Swiss Condensed Milk Co. v. Swiss Condensed Milk Co.*, W. N. 1871, p. 163.

(c) As to this criterion, see *Archbold v. Sweet*, 1 Mo. & Rob. 162; *Shrimpton v. Laight*, 18 Beav. 164; *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. C. 523 (per Lord Cranworth); *Barnard v. Pillow*, W. N. 1868, p. 94; *Anglo-Swiss Condensed Milk Co. v. Swiss Condensed Milk Co.*, W. N. 1871, p. 163; *Wotherspoon v. Currie*, L. R.

5 H. L. 508; *Mitchell v. Condy*, W. N. 1877, p. 153; *Partridge v. Menck*, 1 How. App. Cas. 558; R. Cox, 72; *Walton v. Crowley*, 3 Bl. C. C. 440; R. Cox, 166; *Clark v. Clark*, 25 Barb. 76; R. Cox, 206; *Brooklyn White Lead Co. v. Masury*, 25 Barb. 416; R. Cox, 210; *Swift v. Dey*, 4 Robertson, 611; R. Cox, 319; *Rowley v. Houghton*, 2 Brewster 303; R. Cox, 486; *Colton v. Thomas*, 2 Brewster, 308; R. Cox, 507; *Lockwood v. Bostwick*, 2 Daly, 521; R. Cox, 555; *Dixon Crucible Co. v. Guggenheim*, 2 Brewster, 321; R. Cox, 559.

mark which will cause his goods to bear the same name in the market (a), may be as much a violation of the rights of that rival as the actual copy of his device."

The infringement may consist in the adoption of the essential part of the plaintiff's trade mark by the defendant, as the word "Eureka" (b), or "Glenfield" (c), or "Apollinaris" (d), or in the imitation of the general appearance of the plaintiff's mark. Where both trade marks are of a composite character, it is possible that, though no one particular mark has been exactly imitated, the combination may be very similar and likely to deceive, and will therefore be restrained by injunction (e).

"For the purpose of establishing a case of infringement it is not necessary to show that there has been the use of a mark in all respects corresponding with that which another person has acquired an exclusive right to use, if the resemblance is such as, not only to show an intention to deceive, but also such as to be likely to make unwary purchasers suppose that they are purchasing the article sold by the party to whom the right to use the trade mark belongs" (f). It is seldom that the mark employed by the infringer does correspond in all respects with that of the person whose rights he is attacking; the usual practice is to introduce some colourable variation, which may supply the infringer with a plausible excuse for his

Infringement of essential part.

Infringer's mark need not be identical with mark infringed. Colourable differences.

(a) Thus, in *Edelsten v. Edelsten*, 1 De G. J. & S. 185, the defendant had called his wire "Anchor Wire," without using the figure of an anchor, the plaintiff's wire having acquired the name of "Anchor Wire" because of the trade mark being an anchor. In the U. S. Patent Office there was held to be a fatal conflict between two trade marks for hams, of which the one consisted of the word "Bouquet," the other of a bouquet of flowers: *Schrauder v. Beresford & Co.*, U. S. Patent Office, June 27, 1872.

(b) *Ford v. Foster*, L. R. 7 Ch. 611.

(c) *Wotherspoon v. Currie*, L. R. 5 H. L. 508.

(d) *Apollinaris Co. v. Norrish*, 33 L. T. N. S. 242; and see *Walton v. Crowley*, 3 Bl. C. C. 440; R. Cox, 166; *Binniger v. Wattles*, 28 How. Pr. R. 206; R. Cox, 318; and *Filley v. Fussett*, 44 Mo. 173; R. Cox, 530.

(e) *Abbott v. Bakers and Confectioners' Tea Association*, W. N. 1871, p. 207; but see *Blackwell v. Crabb*, 36 L. J. Ch. 504.

(f) Per Lord Chelmsford, in *Wotherspoon v. Currie*, L. R. 5 H. L. 508.

fraud. "In every case," however, "the Court must ascertain whether the differences are made *bonâ fide* in order to distinguish the one article from the other; whether the resemblances and the differences are such as naturally arise from the necessity of the case, or whether, on the other hand, the differences are simply colourable, and the resemblances are such as are obviously intended to deceive the purchaser of the one article into the belief of its being the manufacture of another person. Resemblance is a circumstance which is of primary importance for the Court to consider, because if the Court finds, as it almost invariably does find in such cases as this, that there is no reason for the resemblance, excepting for the purpose of misleading, it will infer that the resemblance is adopted for the purpose of misleading" (a).

Examples.

Thus, it was held that "Cacaotine" was a colourable imitation of "Cocoatina" (b), "Steel pens" of "Stephens" (c), "Tung's" of "Tonge's" (d), "Leopoldsalt" of "Leopoldshall" (e), "Lactopepsine" of "Lactopeptine" (f), "Cocoine" of "Cocoaine" (g), "Bovina" of "Bovilene" (h). Again, a beehive was held to be a colourable imitation of a bell of a similar shape, similarly printed on a label (i).

Seixo v. Provezende.

In *Seixo v. Provezende* (k) the plaintiff, a Portuguese nobleman and wine grower, sold his wine in casks branded on the head with a crown and eagle, and the letters "B. S.," and also at the bung-hole with a crown,

(a) Per Sir W. P. Wood, V.-C., *Taylor v. Taylor*, 23 L. J. Ch. 255; and in the case of a prosecution for obtaining money by false pretences, see per Erle, J. in *R. v. Dundas*, 6 Cox, 380.

(b) *Schweitzer v. Atkins*, 37 L. J. Ch. 847.

(c) *Stephens v. Peel*, 16 L. T. N. S. 145.

(d) *Tonge v. Ward*, 21 L. T. N. S. 480.

(e) *Radde v. Norman*, L. R. 14 Eq. 348.

(f) *Carnrick v. Morson*, V.-C. B., March 22, 1877; L. J., Notes of Cases, 1877, p. 71.

(g) *Burnett v. Phalon*, 9 Bos. 192; R. Cox, 376.

(h) *Lockwood v. Bostwick*, 2 Daly, 521; R. Cox, 555.

(i) *Bell v. Bell*, V.-C. B., August 1, 1876.

(k) L. R. 1 h. 192

the word "Seixo," and the year of vintage. This wine had acquired a reputation as "Crown Seixo Wine," when the defendant began to sell wine which he called "Seixo de Cima," and placed in casks branded in a somewhat similar manner to the plaintiff's. The injunction was granted and affirmed, although the defendants contended that parts of their own vineyards were called "Seixo," and that the name was an ordinary Portuguese adjective, signifying "stony."

In *Wotherspoon v. Currie* (a), the plaintiffs manufactured starch, which, under the name of "Glenfield Starch"—a name derived from a small place near Paisley, where it was made—acquired a great reputation. They subsequently removed their works to Paisley, and there continued to make "Glenfield Starch." The defendants, also starch manufacturers at Paisley, bought a small plot of land at Glenfield, and began selling "Glenfield Starch." It was held by V.-C. Malins and the House of Lords that the use of the word "Glenfield" in connexion with starch had the effect of inducing people to buy the defendants' manufacture, under the impression that it was the plaintiffs', and that there was a colourable imitation of the mark to which the plaintiffs were entitled (b).

Where the goods of one manufacturer are so packed or arranged as externally to resemble those of others engaged in the same trade, as where starch was put up commonly in the trade in packets of a certain colour and appearance, the similarity common to all does not of itself expose the manufacturer to an action, but it makes it incumbent

Wotherspoon v. Currie.

Similarity of packing.

(a) L. R. 5 H. L. 508.

(b) See also the American cases, *Coffeen v. Brunton*, 4 McLean, 516, R. Cox, 82; *Amoskeag Manufacturing Co. v. Spear*, 2 Sand. S. C. 599, R. Cox, 87; *Davis v. Kendall*, 2 R. L. 566, R. Cox, 112; *Williams v. Johnson*, 2 Bos. 1, R. Cox, 214; *Bradley*

v. Norton, 33 Conn. 157, R. Cox, 331; *Boardman v. Meriden Britannia Co.*, 35 Conn. 402, R. Cox, 490; *Gillis v. Hall*, R. Cox 596; *Meriden Britannia Co. v. Parker*, 39 Conn. 450, 12 Amer. Rep. 401; *Burke v. Clossin*, 45 Cal. 467, 13 Amer. Rep. 204.

upon him to take care that his distinguishing mark is really distinguishing (*a*).

Not conclusive.

However, where a defendant had, in obedience to express directions, put up his silk in imitation of the plaintiff's bundles, his execution of the order was held not to be conclusive against him (*b*). So, too, where a defendant packed inferior brandy in the plaintiff's cases at the express request of an agent of the plaintiff, who was seeking to entrap him, Sir R. Malins, V.-C., refused the injunction with costs (*c*).

Infringement must be by use on same class of goods.

The use by one manufacturer of a trade mark resembling or even identical with that used by another, is not an infringement of that other's rights, unless the class of goods on which the two marks are used is the same (*d*).

Infringement of disused mark.

It has been held in America that the use by a manufacturer of a mark previously used by another manufacturer, but discontinued by him for a year, is an infringement of the rights of the latter (*e*).

Infringement by improper use of genuine mark.

It is an infringement to use a genuine trade mark of a manufacturer upon goods to which that manufacturer did not intend it to be applied, even though the goods upon which the infringer uses it are of the make of the owner of the mark (*f*).

Infringement by engraver.

It is an infringement for an engraver to prepare and supply to one person printing blocks engraved with the trade mark, or an important part of the trade mark of another, inasmuch as the piracy would be impossible without the blocks; and Sir L. Shadwell, V.-C. of E., went

(*a*) See per Lord Hatherley, C., *Wotherspoon v. Currie*, 5 H. L. 508.

(*b*) *Woollam v. Ratcliff*, 1 H. & M. 259.

(*c*) *Hennessy v. Kennett*, V.-C. M., May 18, 1877.

(*d*) *Hall v. Barrows*, 33 L. J. Ch. 204; *Ainsworth v. Walmsley*, L. R. 1 Eq. 518.

(*e*) *Lemoine v. Ganton*, 2 E. D. Smith, 343, R. Cox, 142.

(*f*) *Barnett v. Leuchars*, 13 L. T. N. S. 495 (boxes for "Pharaoh's Serpents"); *Richards v. Williamson*, 30 L. T. N. S. 746 (gun stamps); *Hennessy v. Bohmann*, W. N. 1877, p. 14; *Hennessy v. Cooper*, V.-C. M., April 26, 1877; *Hennessy v. Kennett*, V.-C. M., May 18, 1877 (cases for brandy); *Gillott v. Kettle*, 3 Duer, 624, R. Cox, 148 (labels on pen boxes).

so far as to say that if a thing contained twenty-five parts, and one only was taken, such an imitation would be sufficient to contribute to a deception, and the law would hold those responsible who had contributed to the fraud. (a.) The principle is the same where the engraver, though retaining the blocks in his own possession, yet facilitates fraud by the dissemination of labels bearing pirated trade marks (b). Lord Cranworth, C., thought, however, that a man who had A.'s goods, but none of his labels, might rightfully employ a printer or engraver to supply him with imitated labels, and that A. could have no ground of complaint against the sale of his goods with something on them to represent his trade mark, though not his genuine mark (c).

(a) *Guinness v. Ullmer*, 10 L. T. J. 509; 6 De G. M. & G. 214; 4 K. (Old Series) 127. & J. 650.

(b) *Parina v. Silverlock*, 1 K. & (c) *Ib.* 6 De G. M. & G. 214.

CHAPTER V.

THE CRIMINAL PROSECUTION.

Remedies for
fraudulent
imitations.

“IN cases like the present” (*i.e.* in cases of imitation of a wrapper imprinted with a trade mark), “the remedy,” said Willes, J., “is well known. The prosecutor may, if he pleases, file a bill in Equity to restrain the defendant from using the wrappers, or he may bring an action at law for damages, or he may indict him for obtaining money under false pretences” (*a*).

Infringement
of trade mark
not forgery at
Common Law.

At Common Law the imitation of a trade mark or of a trade wrapper is not a forgery. “A forgery must be of some document or writing” (*b*); “it is the forging of a false document to represent a genuine document” (*c*). In a case in which the prisoner had imitated the label used on Borwick’s baking powder, and was indicted for forgery (*d*), the Court of Crown Cases Reserved, consisting of Pollock, C.B., Willes and Byles, JJ., and Bramwell and Channell, BB., decided that the conviction for forgery was not sustainable, though an indictment for false pretences would have been good. The grounds of the decision are thus stated by Bramwell, B.: “I think that this was not a forgery. Forgery supposes the possibility of a genuine document, and that the false document is not so good as the genuine document, and that the one is not so

(*a*) *R. v. John Smith*, D. & B. 566; 8 Cox, 32. This was in 1858, before the Merchandise Marks Act of 1862.

(*b*) Per Cockburn, C.J., *R. v.*

Closs, D. & B. 460; 7 Cox, 494.

(*c*) Per Willes, J., *R. v. John Smith*, *ubi supra*.

(*d*) *R. v. John Smith*, *ubi supra*.

efficacious for all purposes as the other. In the present case, one of these documents is as good as the other; the one asserts what the other does; the one is as true as the other; but one gets improperly used. But the question is whether the document itself is a false document. It is said that the wrapper is so like one used by somebody else, that it may mislead; but that is not material to the question we have to decide. The prisoner may have committed a gross fraud in using the wrappers for that which was not the genuine powder, and may possibly be indicted for obtaining money by false pretences, but I think he cannot be convicted of forgery" (a).

It might be thought that where the trade mark consisted of a signature, an imitation of this would amount to forgery; but this has been decided not to be so, in the case of *R. v. Closs* (b), in which the prisoner imitated the signature of the artist, J. Linnell, in the corner of a spurious picture. Cockburn, C.J., in delivering the judgment of the Court of Crown Cases Reserved, said that the stamp was merely in the nature of a mark put upon the painting with a view to identifying it, and was no more than if the painter put any other arbitrary mark as a recognition of the painting being his, and in the course of the argument he expressed a similar opinion with respect to the imitation of a signature stamped on a gun.

Under the Merchandise Marks Act, 1862 (c), the forgery of trade marks is now made a misdemeanour, and the Criminal Law made to cover such offences as those committed in *R. v. John Smith* (d), and *R. v. Closs* (e).

By that Act the following offences are made punishable:

(a) Taking the same view, Pollock, C.B., said that the real offence was the enclosing the false powder in the false wrapper; that the issuing of the wrapper without the stuff within it would be no offence; but that the real offence was the issuing

them with the fraudulent matter in them.

(b) D. & B. 460; 7 Cox, 494.

(c) 25 & 26 Vict. c. 88.

(d) D. & B. 566; 8 Cox, 32.

(e) D. & B. 460; 7 Cox, 494.

Not even if the mark consists of a signature.

The Merchandise Marks Act, 1862.

What offences are punishable

under that
Act.

1. Forging or counterfeiting a trade mark, with intent to defraud (*a*).
2. Applying any trade mark, or any forged trade mark (*b*), with intent to defraud, to any article not being the manufacture, &c., of any person denoted or intended to be denoted by such trade mark, or by such forged trade mark, or not being the manufacture, &c., of any person whose trade mark shall be so forged (*a*).
3. Applying any trade mark, or forged trade mark, with intent to defraud, to any article not being the particular or peculiar description of manufacture, &c. (*c*), denoted or intended to be denoted by such trade mark or forged trade mark (*a*).
4. Applying any trade mark, or forged trade mark, with intent to defraud, to any cask, &c., in, on, or with which any article shall be intended to be sold, or shall be sold, or uttered, or exposed for sale, or intended for any purpose of trade or manufacture (*d*).
5. Enclosing or placing, with intent to defraud, any article in, upon, under, or with any cask, &c., to which any trade mark shall have been falsely applied, or to which any forged trade mark shall have been applied (*d*).
6. Applying or attaching, with intent to defraud, to any article, any case, &c., to which any trade mark shall have been falsely applied, or to which any forged trade mark shall have been applied (*d*).
7. Enclosing, placing, or attaching, with intent to defraud, any article in, upon, under, with, or to any cask, &c., having thereon any trade mark of any other person (*d*).
8. Selling, uttering, or exposing, either for sale, or for

(*a*) § 2 of the Merchandise Marks Act.

(*b*) As to what is included in a "forged trade mark," see § 5.

(*c*) See *Barnett v. Leuchars*, and cases at p. 80, note *f*.

(*d*) § 3 of the Merchandise Marks Act.

any purpose of trade or manufacture, any article, together with any forged trade mark, which he shall know to be forged, or together with the trade mark of any other person applied or used falsely or wrongfully, or without lawful authority or excuse, knowing such trade mark of another person to have been so applied or used; and that, whether such trade mark or forged trade mark shall be in, upon, about, or with such article, or in, upon, about, or with any cask, &c., in, upon, about, or with which such article shall be so sold, &c. (a).

9. Putting, with intent to defraud, or to enable another to defraud, upon any article, or upon any cask, &c., together with which any article shall be intended to be or shall be sold, or uttered, or exposed for sale, or for any purpose of trade or manufacture, or upon any case, &c., in or by means of which any article shall be intended to be or shall be exposed for sale, any false description, statement, or other indication, of or respecting the number, quantity, measure, or weight (b) of such article, or any part thereof, or of the place or country in which such article shall have been made, manufactured, or produced (c).

10. Putting, with intent to defraud, or to enable another to defraud, upon such article, cask, &c., any word, letter, figure, signature, or mark, for the purpose of falsely indicating such article, or the mode of manufacturing or producing the same, or the ornamentation, shape, or configuration thereof, to be the subject of any existing patent (d), privilege, or copyright.

11. Selling, uttering, or exposing for sale, or for any purpose of trade or manufacture, any article upon which shall have been, to the offender's knowledge,

(a) § 4 of the Merchandise Marks Act.

Lee, 9 Cox, 460.

(c) § 7.

(b) See *R. v. Sherwood*, 7 Cox, 270; *R. v. Ragg*, 8 Cox, 265; *R. v.*

(d) See § 9, and the cases cited in Ch. 7.

put, or upon any cask, &c., together with which such article shall be sold or uttered, or exposed for sale, or other purpose as aforesaid, shall have been so put, or upon any case, &c., used to expose or exhibit such article for sale, shall have been so put, any false description, statement, or other indication of or respecting the number, quantity, measure, or weight, of such article or any part thereof, or the place or country in which such article shall have been made, manufactured, or produced (a).

13. Aiding, abetting, counselling, or procuring the commission of any offence made a misdemeanour by the Merchandise Marks Act (b).

Intention of defrauding a particular person not necessary.

By sect. 12, there is no necessity to allege in the indictment, or to prove any intention to defraud any particular person. In the same way it seems that on the principle that "the making of any false instrument which is the subject of forgery, with a fraudulent intent, although in the name of a non-existing person, is as much a forgery as if it had been made in the name of one who was known to exist, and to whom credit was due" (c); the making and using a fictitious trade mark, with intent to defraud, by representing it to be the known trade mark of a person of established reputation, would be punishable.

Fraudulent additions to and alterations of marks.

By sect. 5, fraudulent additions to and alterations of a trade mark are made forged trade marks within the Act. At Common Law "it is forgery to alter a material part of a true instrument" (d). Thus, where in a bill of exchange "0" was added to "£8," and "y" to "eight," so as to make it appear to be for £80 (e).

Expressions generally

It is not an offence for persons to use any name, word,

(a) § 8
 (b) § 13.
 (c) 2 East Pleas of the Crown, 957; and see *R. v. Lewis, Foster, Cr. Cas.* 116; *R. v. Avery*, 8 C. & P. 576; *R. v. White*, 72 C. C. C. Sessions Papers, 222.
 (d) 2 East, Pleas of the Crown, 978.
 (e) *R. v. Elsworth*, 2 East, P. C. 986.

or expression generally used for indicating the article with which it is used to be of some particular class or description of manufacture only (a). Thus, patent leather, patent thread (b), patent pins (c).

understood
may be em-
ployed.

A conviction under this Act does not take away or affect any civil remedy of the person aggrieved (d).

Civil remedy
not affected by
conviction.

“An exact resemblance, or facsimile, is not required to constitute the crime of forgery, for if there be a sufficient resemblance to show that a false making was intended, and that the false stamp is so made as to have an aptitude to deceive, that is sufficient” (e).

Exact fac-
simile not re-
quired.

While, apart from the Merchandise Marks Act, the fraudulent imitation of a trade mark is not forgery, such an imitation, when it has been intended to be and has been the means of inducing persons to part with their money, in the belief that they were buying one thing, when in fact they were buying another, is sufficient to support a conviction on an indictment for obtaining money by false pretences. This affords sufficient protection to the innocent purchaser of goods falsely marked; the Act gives protection to the manufacturer who has suffered in his custom and in his reputation by piracies.

Where decep-
tion succeeds,
indictment for
false pretences
will lie.

“There is no difference in principle between a misrepresentation of a mark, and one that an acceptance was the acceptance of John Jones or any other person” (f); and it is established that the fraudulent imitation of a trade mark will be punished in the same way, where the necessary circumstances exist. Thus, in *R. v. Dundas* (g), the prisoner, who asserted his own name to be Everett, sold blacking in bottles labelled “Everett’s Premier,” in a similar manner, with only trifling variations, to the bottles of a well-known manufacturer of that name.

Convictions.

(a) § 9.
(b) *Marshall v. Ross*, L. R. 8 Eq.
651.
(c) *Edelsten v. Vick*, 11 Hare, 78.
(d) § 11.

(e) Per Grose, J., in *R. v. Collicott*,
2 Leach, 1048, a Stamp case.
(f) Per Kelly, C.B., in *R. v. Suter*
& *Coulson*, 10 Cox, 577
(g) 8 Cox, 380.

Erle, J., told the jury that "with respect to the difference between the labels, the jury should consider whether it was a small and colourable difference only, and intended to deceive. It was of little consequence whether the man's name was Everett, as he had stated, or not, for even if it were, and he went about the country and offered blacking for sale as 'Everett's Premier,' representing it to be the well-known article of that name, knowing that it was not so, and intending to cheat the prosecutor by passing upon him a spurious article as the true one, his conduct was equally fraudulent." The prisoner was convicted. In *R. v. Smith (a)*, the conviction for forgery being quashed, the prisoner afterwards pleaded guilty to an indictment for false pretences (*b*). In *R. v. Suter & Coulson (c)*, it was held by the Court of Crown Cases Reserved that a representation that a mark of "18" on a watch was a genuine hall-mark of the Goldsmiths' Company was clearly a false pretence within the statute (*d*).

R. v. Bryan.
Question as to
misrepresenta-
tion of quality.

The case of *R. v. Bryan (e)* gave rise to some differences of opinion in respect to the Law of False Pretences. The prisoner in that case was found by the jury to have obtained money from pawnbrokers on spoons which he had fraudulently represented to have as much silver on them as Elkington's "A" spoons. They also found that he had represented the foundations to be of the best material, knowing that to be untrue, and that in consequence of this he obtained the moneys mentioned in the indictment. The Recorder of London reserved the case for the consideration of the Court of Crown Cases Reserved. Twelve judges heard the case, and of these ten held that

(a) D. & R. 566 ; 8 Cox, 32.

(b) 8 Cox, 37 ; and 48 C. C. C. Sessions Papers, 8.

(c) 10 Cox, 577.

(d) And in *R. v. Gray & Gosling*, referred to in Lloyd on Trade Marks, at p. 11, the imitation of Messrs. Allsopp's labels was punished ; and

in *R. v. S. Jones*, referred to at the same place, and also in Poland, on the Merchandise Marks Act, at p. 33, the imitation of Mr. Borwick's wrappers. See, too, *R. v. Closs*, D. & B. 460 ; 7 Cox, 494.

(e) D. & B. 265 ; 7 Cox, 312.

the conviction must be quashed, Willes, J. and Bramwell, B., dissenting. The language employed by some of the judges on that occasion, and in particular by Lord Campbell, C. J. (*a*), led to an impression that in the opinion of the judges it was impossible to convict under the Statutes of False Pretences, when the misrepresentation had reference only to quality and not to substance; that is to say, that where, for instance, an infinitesimal quantity of gold was found in a ring represented to be of eighteen carat gold, the presence of that infinitesimal quantity of gold prevented the false representations from supporting a criminal charge (*b*). Where the jewellery contained no metal of the kind specified, the prisoner was convicted (*c*). Anticipating such a result, Bramwell, B., said (*d*) that the result of the decision would be that the prisoner would be indictable if Elkington's spoons had half an ounce of silver, and his none, but not if Elkington's had one ounce and his a quarter of an ounce.

The interpretation thus put upon the decision in *R. v. Bryan* was unfortunate, tending, as it did, to encourage an idea of fraud being possible with impunity; and some of the judges who had decided *R. v. Bryan* (*e*) took opportunities of explaining what the real principle of the judgment was (*f*). It was also difficult to reconcile such a conclusion with such cases as those in which the prisoner

(*a*) He said, for instance, that the conviction proceeded upon "a mere misrepresentation, during the bargaining for the purchase of a commodity, of the quality of that commodity." "If the seller were criminally liable for unduly exaggerating the value of the article, the buyer would be for unduly depreciating." He "found no case in which a mere misrepresentation at the time of sale of the quality of the goods had been held to be an indictable offence."

(*b*) *R. v. Suter & Coulson*, 10 Cox, 577; and see *R. v. Lee*, 8 Cox, 233; *R. v. Levine & Wood*, 10 Cox, 374.

Previously to *R. v. Bryan*, D. & B. 265, 7 Cox, 312, in *R. v. Hall*, 45 C. C. C. Sessions Papers 451, the prisoner was convicted, though there was a minute quantity of gold.

(*c*) *R. v. Roebuck*, 7 Cox, 126; D. & B. 24; and see *R. v. Ball*, C. & M. 249; *R. v. Stevens*, 1 Cox, 33; and *R. v. Priestley*, 63 C. C. C. Sessions Papers, 541.

(*d*) *R. v. Bryan*, D. & B. 265, 7 Cox, 312.

(*e*) D. & B. 265; 7 Cox, 312.

(*f*) See, for instance, per Erle, C. J., in *R. v. Goss*, Bell, 208; 8 Cox, 262; and per Willes, J., in *R. v. Suter & Coulson*, 10 Cox, 577.

sold a cheese, by means of the representation that a taster taken from a cheese of superior quality was in fact taken from the one in question (a). There was, indeed, in those cases, a certain misrepresentation as to substance, but the real grievance was that a cheese was sold as being of one quality, when it was in fact of another (b).

R. v. Ardley. The whole question is now fully explained and set at rest by the judgment in *R. v. Ardley* (c). There the prisoner obtained money for a watch chain which he represented to be of fifteen carat gold, stamped on every link, but which representation was untrue. In giving judgment, Bovill, C.J., said: "The case which has been most pressed upon us is *R. v. Bryan* (d). The representation in that case was that certain plated spoons were 'equal to Elkington's A.' *Prima facie* that representation would seem to be a mere matter of opinion, and the Court held that it was not sufficient to support the conviction. But many of the judges expressed the opinion that there might well be cases in which misrepresentations, though as to quality, would be within the statute. Cockburn, C.J., says, 'If the prisoner had represented these articles as being of Elkington's manufacture, when in point of fact they were not, and he knew it, that would be an entirely different thing.' Pollock, C.B., says, 'I think if a tradesman or a merchant were to concoct an article of merchandise expressly for the purpose of deceit, and were to sell it as and for something very different even in quality from what it was, the statute would apply.' It is plain that these learned judges considered that a specific representation of quality, if known to be false, would be within the statute. Coleridge, J., expressly concurs in the observations of

(a) *R. v. Abbott*, 1 Den. 273; *R. v. Dark*, 1 Den. 276; *R. v. Garlick*, 1 Den. 276; *R. v. Goss*, Bell, 208; 8 Cox, 262.

(b) And on this ground Lord Campbell, C. J., in *R. v. Roebuck*,

7 Cox, 126, D. & B. 24, dissented from *R. v. Abbott*.

(c) L. R. 1 C. C. R. 301, 12 Cox 23.

(d) D. & B. 265; 7 Cox, 312.

Pollock, C.B. Erle, J., at the close of his judgment says, 'No doubt it is difficult to draw the line between the substance of the contract and the praise of an article in respect of a matter of opinion ; still it must be done, and the present case appears to me not to support a conviction, upon the ground that there is no affirmation of a definite triable fact in saying the goods were equal to Elkington's "A," but the affirmation is of what is mere matter of opinion, and falls within the category of untrue praise in the course of a contract of sale, where the vendor has in substance the article contracted for, namely, plated spoons.' Crompton, J., also considered that the statute applies 'where the thing sold is of an entirely different description from what it is represented to be.' Willes, J., who dissented from the judgment of the Court, goes the whole length of saying that a representation as to quality, if known to be false, is enough to support a conviction. And Bramwell, B., leans to the same opinion.

"Applying these observations to the present case, the statement here made is not in form an expression of opinion or mere praise. It is a distinct statement, accompanied by other circumstances, that the chain was fifteen carat gold. That statement was untrue, was known to be untrue, and was made with intent to defraud. How does that differ from the case of a man who makes a chain of one material and fraudulently represents it to be of another? Therefore, whether we look at the whole of the evidence, or only at that which goes to the quality of the chain, the conviction is good. The case differs from *R. v. Bryan* (a), because here there was a statement as to a specific fact within the actual knowledge of the prisoner, namely, the proportion of pure gold in the chain."

From this case it follows that where a person has made a false statement in regard to a specific question of fact, knowing that statement to be false, with intent to defraud, **Intentional misstatement as to fact punishable.**

(a) D. & B. 265 ; 7 Cox, 312.

and he does defraud by means of that statement, then, even though the statement have reference to the quality of the article, he will be liable to be convicted.

Wrongful user
of trade
marks.

Placing a forged trade mark on goods not the make of the manufacturer whom the trade mark denotes will amount to such a statement, and it seems that the shifting a genuine label from goods of superior quality to goods of inferior quality, though of the same maker, will also come within the principle of *R. v. Ardley (a)*.

False pre-
tences as to
weight.

In the sale of goods by weight, if money is obtained by representing the weight sold to be greater than it really is, an indictment for false pretences will be good, and it will make no difference that the goods were sold as a whole, for instance, by the load, if the price was calculated on the assumption that the load was of the weight represented by the prisoner (*b*).

Words are not necessary to constitute the false representation. Thus, where hewers at a colliery placed in their tubs of coal tokens to represent a greater weight of coal than they had in fact worked, it was held that they were properly convicted (*c*).

(a) L. R. 1 C. C. R. 301 ; 12 Cox,
23.

(b) *R. v. Sherwood*, 7 Cox, 270 ;
R. v. Ridgway, 3 F. & F. 838 ; *R.*

v. Ragg, 8 Cox, 265 ; *R. v. Lee*, 9
Cox, 460.

(c) *R. v. Hunter*, 10 Cox, 642 ;
R. v. Carter, *ib.*

CHAPTER VI.

THE CIVIL REMEDY. I.

THE proper remedy at Common Law for a fraud committed Common Law. by means of the infringement of a trade mark belonging to a rival trader is by an action on the case for deceit. The manner in which that form of action was made applicable to cases of trade mark and developed to meet the necessities of such cases, which in some respects differ from other cases of fraudulent misrepresentation, may be well stated in the language employed by Sir G. Mellish, L.J., who says (a), "In my opinion, all actions of this nature must be founded upon false representations. Originally, I apprehend, the right to bring an action in respect of the improper use of a trade mark arose out of the Common Law right to bring an action for a false representation, which, of course, must be a false representation made fraudulently. It differed from an ordinary action for false representation in this respect, that an action for false representation is generally brought by the person to whom the false representation is made; but in the case of the improper use of a trade mark, the Common Law Courts noticed that the false representation which is made by putting another man's trade mark, or the trade name of another manufacturer, on the goods which the wrongdoer sells, is calculated to do an injury, not only to the person to whom the false or fraudulent representation is made,

(a) *Singer Manufacturing Co. v. Wilson*, L. R. 2 Ch. D. 434—53.

but to the manufacturer whose trade mark is imitated; and, therefore, the Common Law Courts held that such a manufacturer had a right of action for the improper use of his trade mark. Then the Common Law Courts extended that doctrine one step farther; first, if I recollect rightly, in the case of *Sykes v. Sykes* (a). There it was held that, although the representation was perfectly true as between the original vendor and the original purchaser, in this sense, that the original purchaser knew perfectly well who was the real manufacturer of the goods, and therefore was not deceived into believing that he had bought goods manufactured by another person; yet if the trade mark was put on the goods for the purpose of enabling that purchaser, when he came to resell the goods, to deceive any one of the public into thinking that he was purchasing the goods of the manufacturer to whom the trade mark properly belonged, then that was equally a deception, a selling of goods with a false representation, which would give the original user of the trade mark a right of action. That was the Common Law right."

Action may be brought by manufacturer defrauded.

An action on the case for deceit at Common Law may then be brought not only by the person who has been induced to purchase goods manufactured by one maker in the faith that they have been manufactured by another, but also by the maker of whose manufacture the goods in question have falsely been represented to be. It seems at least probable that this principle was recognised as early as the reign of Queen Elizabeth. In *Southern v. Howe* (b) a case was quoted by Doderidge, J., in which, in that reign, a clothier of Gloucester, who manufactured better cloth than any other person in the trade, had invented and applied to his cloth a special mark to denote his manufacture. Another clothier then pirated this mark and applied it to his own inferior cloth, and it was held

(a) 3 B. & Cr. 541.

(b) 3 Cro. 47; Poph. 144; 2 Rolle, 28.

in the Court of Common Pleas that an action on the case for deceit would lie against the fraudulent clothier. Whether the action was brought by the buyer of the cloth or by the rival clothier cannot be determined, since the reporters differ on this point; but this much is clear, that Chief Justice Popham reported the case as establishing the right of the defrauded clothier to compensation for the injury done him.

Whatever the circumstances in that particular case may have been, the principle that a person who has suffered by reason of his trade mark being intentionally imitated by another has a right at Common Law to redress from the infringer has been repeatedly acted on, and is thus clearly stated by Coltman, J., in *Rodgers v. Nowill* (a), where, after expressing his agreement with the law laid down by Williams, J., that no man had a right to sell goods of his own manufacture upon a false and deceitful representation that they were of the manufacture of another, he says: "To this I would add that an action is clearly maintainable by the party whose name is so fraudulently used, if any damage results to him from the false representation." Right to redress.

According to the strict principles of the Common Law, for an action in respect of a trade mark to be successful, it must be proved that the defendant acted with fraudulent intention. "Proof of fraud on the part of the defendant," says Lord Westbury, C., "is of the essence of the action" (b). The general law on the subject of false representations is summed up by Parke, B., in *Taylor v. Ashton* (c), as being that, independently of any contract between the parties, no one can be made responsible for a representation of such kind as there was in that case (*i.e.*, a false representation of the flourishing state of a bank, which had induced the plaintiff to take shares), unless it be fraudulently made. The law so enunciated was applied in a succession At Common Law, fraudulent intention must be proved.

(a) 5 C. B. 109.

J. & S. 185.

(b) *Edelsten v. Edelsten*, 1 De G.

(c) 11 M. & W. 415.

of trade mark cases at Common Law (*a*), the effect of which was stated by Lord Westbury as above.

Defendant must have expected deception.

It has been held that intentional fraud cannot be inferred from the fact alone that the plaintiff has informed the defendant that in his opinion the defendant was using a trade mark calculated to deceive, nor even from the fact being that the trade mark so used is really calculated to deceive; there must be evidence that the defendant believed such deception to be probable (*b*); in other words, that the defendant has sold his goods "as and for" the plaintiff's goods (*c*).

Deception of first purchaser not necessary.

It is not necessary, in order for the plaintiffs to recover, for them to show that the defendants made fraudulent representations directly to the persons to whom they sold the goods, "although they did not themselves sell them as goods of the plaintiffs' manufacture, yet if they sold them to retail dealers for the express purpose of being resold as goods of the plaintiffs' manufacture" (*d*), thus "scattering over the world the means of enabling parties to commit frauds upon the plaintiffs" (*e*), proof of that would be sufficient for the plaintiffs' case (*f*).

(*a*) See, among other cases, *Singleton v. Bolton*, 3 Doug. 293; *Crawshay v. Thompson*, 4 Man. & G. 357; *Rodgers v. Nowill*, 5 C. B. 109; *Myers v. Baker*, 3 H. & N. 802. In *Crawshay v. Thompson*, Coltman, J., expressed himself thus: "It appears to me that an intention to deceive is a necessary ingredient in this case. The intention is for the jury; and fraud must be made out by proof of an intention existing in the mind of the party that the iron should pass as the iron of the plaintiff."

(*b*) *Crawshay v. Thompson*, 4 Man. & G. 357.

(*c*) *Sykes v. Sykes*, 3 B. & Cr. 541; *Morison v. Salmon*, 2 Scott, N. R. 449, 2 Man. & G. 385; *Crawshay v. Thompson*, *ubi supra*. In Equity, it is not necessary to prove fraudulent intention, otherwise than

by proving that the defendant has used a mark which is, in fact, calculated to deceive, and this was recognised by the Court of Queen's Bench in *Dixon v. Faucus*, 3 Ell. & Ell. 537. Since by the Judicature Act of 1873, § 25, the rules of Equity are to prevail where they conflict with those of the Common Law, it appears that at least nominal damages should be recoverable in the Common Law Divisions on proof of such facts as would be satisfactory to a Court of Equity.

(*d*) *Sykes v. Sykes*, 3 B. & Cr. 541.

(*e*) Per Sir W. P. Wood, V.-C., in *Farina v. Silverlock*, 1 K. & J. 509.

(*f*) Compare the language of the Court of King's Bench in *Polhill v. Walter*, 3 B. & Ad. 114; and see *Singer Manufacturing Co. v. Wilson*, L. R. 2 Ch. D. 434--42--51--53.

In proceedings under the Merchandise Marks Act, 1862,^{Merchandise Marks Act.} where it is necessary to allege or mention an intent to defraud, or to enable another to defraud, it is sufficient to allege or mention that the defendant acted with intent to defraud or to enable some other person to defraud, without alleging an intention hostile to any particular person (a).

The question of fraudulent intention is for the jury,^{Questions for jury.} with whom it rests to say whether or not such intention is proved by the evidence before them (b). And the plaintiff's pleadings must allege with sufficient distinctness a false representation on the part of the defendant (c), when it will be left to the jury to say whether the defendant has adopted the particular mode of deceit charged (d).

In order to entitle the plaintiff to recover, it must be shown that the defendant's conduct has injuriously affected the plaintiff, and the plaintiff's pleadings must be so framed as to disclose a sufficient cause of action, so that where a banking business was established in London under the same name as a previously existing bank, it was held that the proprietor of the earlier bank could not recover, since he had not averred that he was a banker or had ever carried on a banking business (e). This case was decided on the same principle on which it was held in the Court of Chancery, that there was no infringement of trade mark unless there was actually in the market a vendible article to which the mark was in some way attached, and that no right to an injunction existed before the article had in fact been produced, even though it had been repeatedly advertised, and considerable outlay so incurred (f).^{Plaintiff must be injured.}

By section 22 of the Merchandise Marks Act, 1862,^{Merchandise Marks Act.} "every person aggrieved" by the forgery of a trade mark,

(a) 25 & 26 Vict. c. 88, § 12.

(b) *Crawshay v. Thompson*, 4 Man. & G. 357; *Rodgers v. Nowill*, 5 C. B. 109.

(c) *Morison v. Salmon*, 2 Scott, N. R. 449; 2 Man. & G. 885.

(d) *Rodgers v. Nowill*, 5 C. B. 109.

(e) *Lawson v. Bank of London*, 18 C. B. 84.

(f) *McAndrew v. Bassett*, 33 L. J. Ch. 561; *Maxwell v. Hogg*, L. R. 2 Ch. 307.

or use of a forged trade mark, is entitled to maintain an action for damages for the injury done him by the wrongful act, and for an injunction to prevent the repetition or continuance of the same or a similar act.

Costs incurred by defendant's fraud recovered from him.

Where A. ordered from B. a quantity of fire-bricks, marked with the name of C., who used it as his own trade mark, and the order was being executed by B. in ignorance of C.'s rights, C. filed a bill in Chancery to restrain B., who compromised the matter on paying a sum amounting in all, including costs, to over £200. On B. bringing an action against A. to recover the sum which he had so been compelled to pay, it was held by the Court of Queen's Bench that he was entitled to recover that sum, C. being entitled to an injunction in Equity on mere proof of the imitation, though at Common Law he would have had to prove fraud on the part of B. (a).

Innocent vendor of goods falsely marked.

It has been held in America that an innocent vendor of goods falsely marked, the genuineness of which he has not warranted, is entitled to maintain an action to recover the price of the goods from a person to whom he has sold them (b).

Damages.

Although it cannot be assumed by the Court, in default of evidence, that the same quantity of goods which a defendant has sold under a trade mark imitated from that of the plaintiff would have been sold by the plaintiff, but for the defendant's unfair competition (c), yet, where the whole profit made by an infringer upon the sale of the goods wrongfully marked was awarded by the jury as damages, the American Court held that this was not excessive, and said that the fact that it was impossible to apportion the profit, rendered it just that the infringer should lose the whole (d). And in *Taylor v. Carpenter* (e), when the defendant, against whom a verdict had been

(a) *Dixon v. Faucus*, 3 Ell. & Ell. 537.

(b) *Rudderow v. Huntington*, 3 Sand. S. C. 252, R. Cox, 106.

(c) *Leather Cloth Co. v. Hirschfeld*,

L. R. 1 Eq. 299.

(d) *Graham v. Plate*, 40 Cal. 593, 6 Amer. Rep. 639.

(e) 2 Wood. & M. 1; 9 L. T. (Old Series) 514; R. Cox, 32—42.

found with substantial damages, moved for a new trial, urging, among other arguments, that the jury should have been told that if the defendant's goods were not inferior to the plaintiffs', the latter could not recover, or at all events could recover only nominal damages, it was held that the plaintiffs were not only not debarred from recovering at all, but that they could recover substantial damages, "since the actual damage suffered by loss of sales by the plaintiffs, which was the ground of recovery, was just as great as if the thread had been inferior, though the credit of their mark and thread might not suffer as much thereby, if it did at all."

That a plaintiff is entitled to recover some damages where his trade mark has been infringed, appears clearly from *Blofeld v. Payne* (a), in which Lord Denman, C.J., told the jury that even if the defendants' hones were not inferior, the plaintiff was still entitled to some damages, inasmuch as his right had been invaded by the fraudulent act of the defendants. The jury found a verdict for the plaintiff, with a farthing damages, and also found that the defendants' hones were not inferior to the plaintiff's. The verdict was upheld by the Court of King's Bench, Little-dale, J., saying that "the act of the defendants was a fraud against the plaintiff, and that even if it occasioned him no specific damage, it was still, to a certain extent, an injury to his right." It is evident that in this case, although the plaintiff did not suffer in reputation by the sale of inferior hones as his, yet he suffered in another way, his custom being diminished to an undetermined extent by goods being sold as his, so as to compete with those really of his make (b).

Nominal damages where right infringed.

The first recorded case of trade mark brought before the Equity—

(a) B. & Ad. 410.

(b) See per Erskine, J., in *Morison v. Salmon*, 2 Scott, N. R. 449; 2 Man. & G. 385; and per Wilde, C.J., in *Royers v. Nowbill*, 5 C. B. 109; also *Coffeen v. Brunton*, 4 McLean, 516;

R. Cox, 82; *Lemoine v. Ganton*, 2 E. D. Smith, 313, R. Cox, 142; *Chappell v. Davidson*, 2 K. & J. 123; and *Singer Manufacturing Co. v. Wilson*, L. R. 2 Ch. D. 434—42—51—54.

Blanchard v. Hill.

judicial notice of the Court of Chancery was that of *Blanchard v. Hill* (a), in 1742, which, however, resulted in a statement by Lord Hardwicke, C., that he did not know "any instance of granting an injunction in Chancery to restrain one trader from using the same mark with another," and that he thought "it would be of mischievous consequence to do it."

Growth of jurisdiction of Chancery.

In *Henry v. Price* (1831) (b), and *Gout v. Aleploglu* (1833) (c), however, injunctions were granted to restrain the infringement of the plaintiffs' trade marks, and from this time the steadily increasing number of such cases coming before the Court of Chancery shows the growing favour with which that Court was regarded by suitors, the chief incentive no doubt being the more beneficial character of the remedy awarded, by injunction and account, as compared with the Common Law remedy of damages. By degrees the Court of Chancery absorbed the jurisdiction in trade-mark cases, until such cases were rarely if ever tried in the Common Law Courts, except when they were remitted for trial of the Common Law right by a Chancery judge. That practice was discontinued in consequence of Sir John Rolt's Act (d), and the effect has been, notwithstanding the extended power given to the Common Law Courts by the Merchandise Marks Act of the same year (e), to confine the consideration of this class of cases more strictly, if possible, than before to the Court of Chancery.

Registration Acts administered by Chancery Division. Commissioners of Patents.

This fact has been recognised by the Chancery Division being appointed to administer the Trade Marks Registration Acts (f).

The registrar appointed under the Acts is, however, subject to the superintendence of the Commissioners of Patents (g), the extent of whose jurisdiction is not yet

(a) 2 Atk. 484.

(b) 1 Leg. Obs. 364.

(c) 5 Leg. Obs. 496, and 6 Beav. 69 n.; and see *Day v. Binning*, C. P. Cooper, 489; and 1 Leg. Obs. 205.

(d) 25 & 26 Vict. c. 27.

(e) 25 & 26 Vict. c. 88, § 21.

(f) 38 & 39 Vict. c. 91; 39 & 40 Vic. c. 33; and 40 & 41 Vict. c. 37. See Rule 42.

(g) Rule 68.

clearly ascertained, though it may be presumed that cases of difficulty will be reserved for the consideration of the Court (a).

The principles on which the Courts of Equity have long acted in cases of true trade mark, *i. e.*, where a valid mark has been affixed to the goods or to wrappers or vessels containing them—principles by which those cases must, as it seems, be governed for the future, before whichever branch of the High Court of Justice they may come (b)—are thus explained by Sir G. Jessel, M.R., in *Singer Manufacturing Co. v. Wilson* (c).

Principles adopted in Equity with respect to trade marks.

“It is quite immaterial that the maker of the goods to which what I will call, for sake of shortness, the trade mark is affixed, did not know that it was a trade mark, and had not the slightest intention of defrauding anybody. He must not put as a mark on goods, even though he intends to establish it as his own trade mark, that which is the known trade mark of other people, and he would be restrained by injunction, though he thought he himself had invented the trade mark, and *bonâ fide* intended it to designate goods of his own manufacture. And the reason is obvious, because the goods pass from hand to hand, and though he may act with the utmost *bonâ fides*, yet the ultimate purchasers might believe that they were the real goods, that is to say, that they were manufactured by the person entitled to the original trade mark. Therefore, in that case, knowledge that he is doing anything wrong is immaterial, even in the maker.

“Another element which is sometimes imported into these cases has also no material bearing; that is, that if the maker knows that they are not the goods of the person entitled to use the trade mark, and communicates that knowledge to the immediate purchaser, it makes, as I have

(a) See *In re Meikle*, 24 W. R. 1067; and *In re Barrows*, L. R. 5 Ch. D. 353.

(b) See Judicature Act of 1875, § 25.

(c) L. R. 2 Ch. D. 434.

said, no difference ; and even if he does not know it, and tells the immediate purchaser that the goods are of his own manufacture, it will still not save him from an injunction, because, although the immediate purchaser from him is aware that the goods in question are not manufactured by any other person than the vendor, yet, as he passes them on, the representation does not necessarily pass on with them, and therefore the next purchaser, or the following or some other purchaser, or the public at large, who are the ultimate purchasers, would be as much deceived as if no such communication took place. Consequently, whenever you get to a case of the first class (*i. e.* of true trade mark), you have nothing more to do than to show that the trade mark has been taken.”

At first,
Equity fol-
lowed the
Common Law.

When trade-mark cases were first brought into the Court of Chancery, they were treated on the same principle as they were at Common Law, and redress was refused where actual intentional fraud was not alleged and substantiated. The existence of anything that could be called a right of property in a trade mark was denied, and a fear expressed that, if that should be admitted, a stronger monopoly than even a patent-right would be created (*a*).

Millington v.
Fox.

In the year 1838, however, when the case of *Millington v. Fox* (*b*) came before Lord Cottenham, C., the Lord Chancellor perceived that when goods made by one man were put upon the market bearing the trade mark of another, the same evil effects were produced, whether the mark was so affixed for fraudulent purposes or with innocent intentions, since purchaser's would buy A.'s goods in the belief that they were B.'s, and B. would be deprived of the custom intended for him ; so that A., whether by his own contrivance or not, would profit at the expense of B. and the public. In that case it was accordingly held by the Lord Chancellor that the plaintiffs were entitled to an injunction,

(*a*) *Blanchard v. Hill*, 2 Atk. 484 ; *Canham v. Jones*, 2 V. & B. 218.

(*b*) 3 My. & Cr. 338 ; and see the earlier case of *Gout v. Aleploglu*, 5 Leg. Obs. 496.

although he stated in express terms that he saw no reason for thinking that there had been any fraudulent user by the defendant of the plaintiffs' mark.

The decision in this case gave rise to some difference of opinion among the judges, some holding that the jurisdiction of the Court of Chancery in these cases, like that of the Common Law Courts, was founded on intentional fraud, and denying any exclusive right in trade marks (*a*), while others held that, intentional fraud not being necessary for the injunction, the jurisdiction must be held to be founded on the protection of a right of property in the trade mark (*b*).

In *Motley v. Downman* (*c*), it was laid down broadly that the jurisdiction of the Court of Chancery was merely ancillary to that of the Common Law, and that the right to redress must be determined by the rules of the Common Law; and accordingly cases were frequently referred to the Common Law Courts for the determination of the right, before the equitable remedy was awarded (*d*). That

Question as to
foundation of
jurisdiction.

Deference to
Common Law

(*a*) *Perry v. Truefitt*, 6 Beav. 66; *Croft v. Day*, 7 Beav. 84; *Foot v. Lea*, 13 Ir. Eq. 490; *Edelsten v. Vick*, 11 Hare, 78; *Collins Co. v. Brown*, 3 K. & J. 423; *Collins Co. v. Cowen*, 3 K. & J. 428; *Leather Cloth Co. v. American Cloth Co.*, 1 H. & M. 271; *McAndrew v. Bassett*, 33 L. J. Ch. 561; *Walton v. Crowley*, 3 Bl. C. C. 440, R. Cox, 166.

(*b*) *Farina v. Silverlock*, 6 De G. M. & G. 214; *Burgess v. Hills*, 26 Beav. 244; *Clement v. Maddick*, 1 Giff. 98; *Emperor of Austria v. Day*, 3 De G. F. & J. 217; *Welch v. Knott*, 4 K. & J. 747; *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Hall v. Barrows*, 33 L. J. Ch. 204; *Cartier v. Carlile*, 31 Beav. 292; *Moet v. Couston*, 33 Beav. 578; *Leather Cloth Co.'s case*, 33 L. J. Ch. 109; 11 H. L. C. 523; *McAndrew v. Bassett*, 33 L. J. Ch. 566; *Kinahan v. Bolton*, 15 Ir. Ch. 75; *Barncott v. Leuchars*, 13 L. T. N. S. 495; *Maxwell v. Hogg*, L. R. 2 Ch. 307; *Bradbury v. Beeton*, 39 L. J. Ch. 57; *Radde v. Norman*, L. R. 14

Eq. 348; *Collins Co. v. Reeves*, 28 L. J. Ch. 56; *Hirst v. Denham*, L. R. 14 Eq. 542; *Smith v. Mason*, W. N. 1875, p. 62; *Apollinaris Co. v. Norris*, 33 L. T. N. S. 242; *Cheavin v. Walker*, L. R. 5 Ch. D. 850; *Davis v. Kendall*, 2 R. I. 566, R. Cox, 112; *Clark v. Clark*, 25 Barb. 76, R. Cox, 206; *Dale v. Smithson*, 12 Abb. Pr. R. 237, R. Cox, 282; *Woodward v. Lazar*, 21 Cal. 448, R. Cox, 300; *Derringer v. Plate*, 29 Cal. 292, R. Cox, 325; *Bradley v. Norton*, 33 Conn. 157, R. Cox, 331; *Gillott v. Esterbrook*, 47 Barb. 455; R. Cox, 340, 3 Sickels, 374; *Burnett v. Phalon*, 9 Bos. 192, R. Cox, 376; *Filley v. Fassett*, 44 Mo. 173, R. Cox, 530; *Dixon Crucible Co., v. Guggenheim*, 2 Brewster, 321, R. Cox, 559.

(*c*) 3 My. & Cr. 1.

(*d*) *Perry v. Truefitt*, 6 Beav. 66; *Rodgers v. Nowill*, 6 Hare, 325; *Foot v. Lea*, 13 Ir. Eq. 490; *Farina v. Silverlock*, 1 K. & J. 509; and others.

practice, however, gradually died out as the principle of interference in the absence of intentional fraud came to be recognised, and Sir John Rolt's Act (a) finally put an end to it.

Principle of
Millington v.
Fox explained
by V.-C. Wood.

The explanation given of the decision in *Millington v. Fox* (b) and other cases in which relief was given without proof of fraudulent user by Sir W. P. Wood, V.-C., was, that it was on the principle "that although a person had used another man's trade mark perfectly innocently, yet if he continued for one moment after he had been told of it to use another man's trade mark, he did so fraudulently, and if he sought to keep in his pocket profits which he had made by representing, however innocently, that his goods were another person's, after he had been told of the fact, it was fraud" (c).

By Lord
Westbury.

From this view Lord Westbury, C., dissented (d), and the view now generally accepted as to the principles governing the action of the Courts of Equity was thus stated by him, in the *Leather Cloth Cos.' case* (e): "The representation which the defendant is supposed to make that his goods are the goods of another person is not actually made otherwise than by his appropriating and using the trade mark which such other person has an exclusive right to use in connexion with the sale of some commodity; and if the plaintiff has an exclusive right to use any particular mark or symbol, it becomes his property for the purposes of such application, and the act of the defendant is a violation of such right of property, corresponding with the piracy of copyright or the infringement of a patent. I cannot therefore assent to the dictum that there is no property in a trade mark. It is correct to say that there is no exclusive ownership of the symbols which

(a) 25 & 26 Vict. c. 27.

(b) 3 My. & Cr. 338.

(c) *McAndrew v. Bassett*, 33 L. J. Ch. 561.

(d) *Hall v. Barrows*, 33 L. J. Ch.

204; *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Leather Cloth Cos.' case*, 33 L. J. Ch. 199; *McAndrew v. Bassett*, 33 L. J. Ch. 566.

(e) 33 L. J. Ch. 199.

constitute a trade mark, apart from the use or application of them, but the word 'trade mark' is the designation of marks or symbols when applied to a vendible commodity, and the exclusive right to make such user or application is rightly called 'property.' " "The true principle, therefore, seems to be that the jurisdiction of the Court in the protection given to trade marks rests upon property; and that the Court interferes by injunction, because that is the only mode by which such property can be effectually protected. The same things are necessary to constitute a title to relief in Equity in the case of the infringement of the right to a trade mark as in the case of the violation of any other kind of property. First, the plaintiff must prove that he has an exclusive right to use some particular mark or symbol in connexion with some manufacture or vendible commodity; and secondly, that this mark or symbol has been adopted or is used by the defendant so as to prejudice the plaintiff's custom and injure him in his trade or business."

Still, even though it be admitted that the Law of Trade Marks is based upon a right of property, fraud also is necessary to entitle the owner of the trade mark to redress (a). But the fraud does not consist in an intention to deceive on the part of the defendant, but in an actual deception, or in the creation of a probability of deception (b), independently of any fraudulent intention. "Imposition on the public," says Lord Westbury (c), "is indeed necessary for the plaintiff's title; but in this way only, that it is the test of the invasion by the defendant of the plaintiff's right of property; for there is no injury done to the plaintiff if the mark used by the defendant be not such as may be mistaken, or is not likely to be mistaken, by the public for the mark

In what sense
fraud is re-
quired in
Equity

(a) See per Sir G. Mellish, L.J., in *Singer Manufacturing Co. v. Wilson*, L. R. 2 Ch. D. 434—53

(b) Compare per Sir C. Hall, V.-C., in *Cope v. Evans*, L. R. 18 Eq. 138.

(c) *Hall v. Barrows*, 33 L.J. Ch. 204; and see per Lord Cranworth, C., in *Parina v. Silverlock*, 6 De G. M. & G. 214.

of the plaintiff. But the true ground of the Court's jurisdiction is property."

Intention im-
material in
Equity.

The exact language in which the principle on which the Court of Chancery has acted is to be described is really immaterial, and in fact "merely a question of nomenclature" (a), since the important and substantial point is completely established, that in cases of true trade mark nothing more has to be done "than to show that the trade mark has been taken" (b).

Right of
property in
registered
mark

There can at least be no doubt that the right in a trade mark registered under the Trade Marks Acts is strictly a right of property, the person entitled to it is the proprietor (c); he is entitled to the exclusive use of it (d); and though his rights in regard to it are in some respects less unlimited than those of owners of other kinds of property, e. g., the inability to transfer it except in connexion with the goodwill of the business (e), still, subject to the provisions of the Act, he is entitled to deal with it as he chooses.

Elements
necessary to
found jurisdic-
tion.

In trade-mark cases, "in order to found the jurisdiction of the Court," says the Lord Chancellor of Ireland (f), "there must be established, first, the existence of the trade mark; next, the fact of an imitation, whether a direct imitation, or one with such variations that the Court must regard them as merely colourable; and thirdly, the fact that the imitations were made without licence, or anything that the Court could regard as acquiescence in their use."

Proceedings
in Equity.

In order to ensure a full disclosure of the facts bearing upon these points, the Court will grant, if necessary, discovery and inspection, and upon the satisfactory

(a) Per Sir W. P. Wood, V.-C., *McAndrew v. Bassett*, 33 L. J. Ch. 561.

(b) Sir G. Jessel, M.R., in *Singer Manufacturing Co. v. Wilson*, L. R. 2 Ch. D. 434; and see the cases

collected at note (b) on p. 103 *supra*.

(c) §§ 3, 4, 5 of the Act of 1875.

(d) *Ibid.* § 3.

(e) *Ibid.* § 2.

(f) *Kinahan v Bolton*, 15 Ir. Ch. 75.

establishment of the plaintiff's case, will award its appropriate remedy of an injunction (a), framed in such terms as best to counteract the illicit designs of the infringer. The liability to account for profits is usually, as Sir J. Romilly, M.R., said in *Cartier v. Carlile* (b), incident to the injunction (c), or the plaintiff may, at his option, have an enquiry as to damages in lieu of the account, but not both (d). The Court will further, where necessary, order the delivery up and destruction of the spurious labels, cards, or tickets (e), or the production of the goods wrongfully marked, for the purpose of the erasure and cancellation of the spurious marks (f).

While, however, the Court will give protection where it is required, "it must not be forgotten that such protection by injunction when granted is, or may be, attended with loss to the defendant in rendering useless or depreciating in value articles to which the trade mark has already been affixed, and in compelling him otherwise to vary the mode in which he has been carrying on business" (g). And it seems that where it is proved that a defendant has adopted a trade mark in *bonâ fide* ignorance of its infringing the

Consideration shown for innocent infringer.

(a) In *Glen & Hall Manufacturing Co. v. Hall*, 16 Sickels, 226, a case of the class analogous to trade-mark cases, an injunction was granted against the original plaintiffs, on counter-claim. The injunction will be granted, notwithstanding an offer of submission by the defendants: *Geary v. Norton*, 1 De G. & Sm. 9; *Tonge v. Ward*, 21 L. T. N. S. 480.

(b) 31 Beav. 292.

(c) Unless the defendant can prove that he was not aware of the existence of any such trade mark as he is shown to have infringed: *Edelsten v. Edelsten*, 1 De G. J. & G. 185; *Moet v. Couston*, 33 Beav. 578.

(d) *Neilson v. Betts*, L. R. 5 H. L. 1.

(e) *Parina v. Silcrlock*, 1 K. & J. 509, 6 De G. M. & G. 214, 4 K. & J.

650; *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Apollinaris Co. v. Edwards*, Seton, 4th ed. 237; *Graveley v. Winchester*, *ib.* 257.

(f) *Dent v. Turpin*, 2 J. & H. 139; *Upmann v. Elkan*, L. R. 12 Eq. 140, L. R. 7 Ch. 130; *Jurgensen v. Alexander*, 24 How. Pr. R. 269, R. Cox, 298. In *Meriden Britannia Co. v. Parker*, 39 Conn. 450, 12 Amer. Rep. 401, it was held that goods already stamped might be sold, subject to the remedy at law. See also the Merchandise Marks Act, 1862 (25 & 26 Vict. c. 88), § 21, as to the powers thereby given to the Court.

(g) *Cope v. Evans*, L. R. 18 Eq. 138; and see *Liebig's Extract of Meat Co. v. Hanbury*, 17 L. T. N. S. 298; and *Bass v. Dawber*, 19 L. T. N. S. 626.

plaintiff's rights, the Court will be satisfied with the least amount of alteration of the defendant's mark which will effectually distinguish it from the plaintiff's (a).

But innocent infringement checked.

Sufficient distinction must, however, be made; and in the even harder case, where a man has not affixed the spurious mark to his own goods at all, but has bought goods already stamped with a mark which he did not know to belong to any one, he must submit to an injunction, though he will not have to account for profits, if he does not delay his submission (b). Where, however, A. has, without notice of fraud, advanced money on goods fraudulently marked, he will not be prevented from asserting his rights by reason of the illicit mark (c).

Scandal and impertinence.

In asking for his remedy a plaintiff must not make scandalous and impertinent charges against the defendant. Where such charges were made exceptions for scandal and impertinence were allowed (d), and under the present practice the defendant would succeed on a motion to strike out such statements, under Order xxvii., Rule 1.

Interlocutory injunction.

It is usual for the plaintiff in trade-mark cases to apply for an interlocutory injunction at an early period. When such application is to be made, it is the duty of the plaintiff to make it speedily (e), and delay on his part in coming to the Court is liable to be construed as signifying that the case is one which he does not consider to be of an urgent nature, and which therefore does not deserve the special favour of the Court (f). The plaintiff is, however, entitled to delay long enough to secure the necessary evidence to establish his case (g); and even if no interlocutory injunction is asked for, as, for instance, where it is

(a) *Bass v. Dawber*, 19 L. T. N. S. 626.

(b) *Moet v. Couston*, 33 Beav. 578.

(c) *Ponsardin v. Peto*, 33 Beav. 642. See *Rudderow v. Huntington*, 3 Sand. S. C. 252; *R. Cox*, 106

(d) *Christie v. Christie*, W. N. 1873, pp. 8—70.

(e) Per Sir J. Romilly, M.R., in *Chubb v. Griffiths*, 35 Beav. 127.

(f) *Pickford v. Grand Junction Railway Co.*, 3 Railway Cas. 538; *Flavel v. Harrison*, 10 Hare, 467; *Isaacson v. Thompson*, 20 W. R. 196.

(g) *Lee v. Haley*, L. R. 5 Ch. 135.

rendered unnecessary by reason of the defendant having discontinued the acts of which the plaintiff is complaining, the plaintiff is not precluded from his right to a perpetual injunction, if in other respects he has such a right (a).

In the older cases (b), the tendency of the Court was to refuse to grant an injunction on an interlocutory application, unless the clearest evidence of the plaintiff's right was producible, but rather to send that right to be tested at Common Law. That course of proceeding being now extinct (c), some relaxation has taken place, and, in particular, where there is reason to suspect intentional deceit on the part of the defendant, much less absolute proof of the plaintiff's title is required (d). The interlocutory injunction will, however, not be granted where there is any considerable conflict (e), nor yet in a case where the Court is without the means of testing the obedience given to its orders (f).

Where an injunction was granted on motion, but the defendant alleged that he had not had sufficient time to answer the affidavits on the other side, Lord Langdale, M.R., directed that the order should be prefaced by a

When granted

Liberty given to move to dissolve.

(a) *Collins Co. v. Walker*, 7 W. R. 222.

(b) *E. g. Spottiswoode v. Clarke*, 2 Ph. 154; *Stevens v. Keating*, 2 Ph. 338; *Motley v. Downman*, 3 My. & Cr. 1.

(c) Since Sir John Rolt's Act, 25 & 26 Vict. c. 27.

(d) *Radde v. Norman*, L. R. 14 Eq. 348.

(e) *Green v. Rooke*, W. N. 1872, p. 49, L. J. Notes of Cases, 1872, p. 54; *Farina v. Cathery*, L. J. Notes of Cases, 1867, p. 134; *Hennessy v. Bohmann*, W. N. 1877, p. 14; *Linoleum Manufacturing Co. v. Nairn*, V.-C. H. Feb. 2, 1877, and other cases. If an interlocutory injunction is asked for on the ground that the defendant claims a right to use the plaintiff's trade mark, but

there is no evidence that he is in fact using the mark or threatening an immediate exercise of his alleged right of user, the motion will be refused, with costs, as in *Davis v. Tylor*, M.R. July 27, 1877 ("Ferndale" coal).

(f) *Cox v. The Land and Water Journal Co.*, L. R. 9 Eq. 324. In the Scotch case of *Green v. Shepherd*, Court of Session Cases, Third Series, IV. 1028, the plaintiff having by his summons asked for damages and an interdict, the Court refused a motion for an interim interdict, on the ground that the summons was framed on the footing that there was no case for an interim interdict, and that the plaintiff must first establish his right by recovering damages.

statement to that effect, and giving the defendant leave to move to dissolve the injunction (*a*).

Appeal.

In the case of an appeal delay is no less fatal than in the proceedings in the Court below (*b*).

Committal
for contempt.

Where a defendant in a trade-mark action continues to use the prohibited mark after an injunction has been issued against him, he renders himself liable to committal (*c*). In order to support the motion to commit, "it should appear clearly that the ordinary mass of customers, paying that attention which persons usually do in buying the article in question, would be easily deceived" (*d*). It was said by Lord Langdale, M.R., in *Croft v. Day* (*e*), that "if the defendants were willing to make a proper distinction, and the plaintiffs refused to attend to their proposal, the Court would itself determine whether the proposed distinction was sufficient." If the defendant sets up acquiescence on the part of the plaintiff, he must make out a case amounting almost to such a licence as to entitle him to proceed against other infringers, such acquiescence, in fact, as to create a new right in him; and in default of such a licence, the order for committal will be made, unless the defendant satisfies the Court of his intention to use a trade mark which will not interfere with the plaintiff's rights (*f*). Where by a series of ingenious devices the defendants contrived to secure the benefit of the fraud, and yet avoided committing a breach of the injunction, V.-C. Wood enlarged the terms of the injunction, so as to effectually put a stop to the fraud (*g*).

(*a*) *Holloway v. Holloway*, 13 Beav. 209.

(*b*) See per Sir J. L. Knight-Bruce, L.J., in *Burgess v. Burgess*, 3 De G. M. & G. 89.

(*c*) *Rodgers v. Nowill*, 3 De G. M. & G. 614; *Gillis v. Hall*, R. Cox, 596. On August 8, 1877, V.-C. Malins made an order to commit the defendant in *Dence v. Mason* (W. N. 1877, p. 23), who had, notwithstanding the injunction, continued to sell goods and issue labels using the name

"Brande" thus—"Frank Mason & Co.'s ('Brande's') Essence of Beef," and so on.

(*d*) *Swift v. Dey*, 4 Robertson, 611, R. Cox, 319-24; and see per Lord Langdale, M.R., in *Croft v. Day*, 28 Leg. Obs. 378.

(*e*) *Ubi supra*.

(*f*) *Rodgers v. Nowill*, 3 De G. M. & G. 614.

(*g*) *Cartier v. May*, V.-C. W. July 12, 1861, cited in *Lloyd on Trade Marks*, 2nd ed. pp. 55-77.

It has sometimes happened that more marks than one ^{Where two marks used.} have been used by a person on his goods, the infringement of either of which would be visited by the Court with the penalties at its command. Thus, where A.'s soft soap was denoted, not only by a specific device, but also by the name "Excelsior," it was held that the infringement of the latter alone was punishable by the Court, the Vice-Chancellor remarking that he could not hold it to be any justification for a defendant to say that the plaintiff had two ways of identifying the goods, and he (the defendant) had only stolen one (a).

Moreover, the habitual use of his own name in combination with his verbal trade mark by the manufacturer of the "Eureka" shirts was held not to disentitle him to relief against defendants who had made use of the word "Eureka," though in combination with the name of their own firm (b). ^{Name used with trade mark.}

Where, however, a manufacturing company affixed their special device to their machines, and also their name, the Master of the Rolls declined to restrain another company who manufactured similar goods bearing their own mark and name, but did not affix to them the plaintiff's name, from using the plaintiff's name as descriptive of the principle on which the machines were constructed (c). ^{Singer v. Wilson.}

Courts of Equity have sometimes had to decide somewhat nice questions as to who should be recognised as having a right to protection in Equity in respect of a trade mark, such questions being usually raised by the right of the plaintiff in an action to restrain infringement being contested. ^{Questions of title to trade marks.}

In *Motley v. Downman* (d), Lord Cottenham, C., was of opinion that a trade mark habitually applied to the iron ^{Between landlord and}

(a) *Braham v. Bustard*, 1 H. & M. 447.

(b) *Ford v. Foster*, L.R. 7 Ch. 611. In Scotland, on the contrary, it was held that the fact that one firm called their goods "Wotherspoon's Victoria Lozenges," could not pre-

vent another firm from styling theirs "Gray's Victoria Lozenges:" *Wotherspoon v. Gray*, Court of Session Cases, 3rd Series II. 38.

(c) *Singer Manufacturing Co. v. Wilson*, L.R. 2 Ch. D. 234.

(d) 3 My. & Cr. 1.

tenant of iron works.

manufactured at certain works, could not be sold with the business by the tenants of the works, so as to give the purchasers an exclusive right as against the landlord of the works, or as against tenants of the works who had leased them after the purchasers of the business and trade mark had removed from those works, and gone elsewhere.

Successive lessees of brick works.

In another case (*a*) A., having for some time leased certain brick works, and also certain mines, from which fire-clay was taken for manufacture at the works, removed his business elsewhere, whereupon B. commenced business at the brick works in question, but did not lease the same mines. A. having filed a bill against B., as fraudulently representing (in effect) that the latter had succeeded to his business, Vice-Chancellor Wood, in the course of his judgment in favour of the plaintiff, took occasion to intimate that it would have been almost a matter of course to have granted an injunction to the owner of the mines of fire-clay used by A. but not by B., if he had made application for it. This was, indeed, rather a case of fraudulent misrepresentation than of trade mark.

Manufacturer and printer of cotton cloths.

Where manufacturers of cotton cloths which were afterwards printed elsewhere sought to restrain other manufacturers who made and printed similar cloths, and marked them similarly to the goods made by the plaintiffs, it was held that the mark on the plaintiffs' goods were indicative of the printer and not of the manufacturer (*b*).

Principal and agent.

Where a London tradesman, who dealt in goods supplied to him by a foreign manufacturer, had invented a trade mark for those goods which stated the name of the foreign manufacturer, but made no reference to the London vendor, it was held by the Master of the Rolls that the latter could not restrain the use of the mark by a subsequent consignee of the same goods, though if the trade

(*a*) *Harper v. Pearson*, 3 L., T. N. S. 547.

v. Garner, 55 Barb. 151, R. Cox, 541.

(*b*) *Amoskeag Manufacturing Co.*

mark had referred to the goods having been of his selection, the case might have been different (a).

Again, in *Cotton v. Gillard* (b), it was decided by the same learned judge that a man had no right to use a trade mark applied to a sauce with the composition of which he was unacquainted, even though he had, as he believed, bought that right from the person entitled to the same; it followed that he could not prevent its use by the person acquainted with the secret, of which he had in fact been the inventor. Secret recipe.

With respect to registered trade marks, such difficulties can hardly arise in the future, since it is the registered proprietor who is to have, *prima facie*, the exclusive right to the mark, and after five years to have that right conclusively (c). Registered trade marks.

It occasionally happens that a trade mark becomes vested in more than one person. The question then arises whether either of these is entitled to succeed in a suit against an infringer, to which the other person entitled is not a party. In a case of this description, Sir L. Shadwell, V.-C., gave it as his opinion, that whether the plaintiff had the right in himself, or jointly with some other persons, he still had sufficient right to bring forward the case (d). In *Dent v. Turpin* (e), Sir W. P. Wood, V.-C., decided in accordance with this view, saying that the plaintiff had a clear right to an injunction and the erasure of the spurious marks, without making the other person interested a party, while as to the account, only the plaintiff's share having been prayed for, that, though it might be difficult to ascertain, was yet ascertainable. In any case, the wrong-doer had no right to complain of any technical difficulty arising from his own wrongful act, though the result was to involve him in two suits More than one proprietor.

(a) *Hirsch v. Jonas*, L. R. 3 Ch. D. 584.

(b) 44 L. J. Ch. 90. Compare *Coffeen v. Brunton*, 5 McLean, 256,

R. Cox, 132.

(c) 38 & 39 Vict. c. 91, § 3.

(d) *Hine v. Lart*, 10 Jur. 106.

(e) 2 J. & H. 139.

instead of one. In *Southorn v. Reynolds* (a), he decided in the same way, saying that his previous decision had not been interfered with (b).

Delondre v. Shaw.

In *Delondre v. Shaw* (c), it was held that, inasmuch as one of the plaintiffs had no interest in the account (d), he was improperly joined as a co-plaintiff, the injunction being thus made ancillary to the account. In *Farina v. Silverlock* (e), the same question was raised, but without success, and no such objection would prevail at the present day (f).

Prize medallist.

In *Batty v. Hill* (g), an attempt was made by a prize medallist at the Exhibition of 1862, to restrain the use by the defendant, who had not been awarded a medal, of a label which had been prepared before the award, bearing the words "Prize Medal, 1862." The Vice-Chancellor was, however, of opinion that he could not interfere merely on the ground of a misrepresentation, and that the plaintiff was not entitled to claim the label as a trade mark for various reasons, among which was the fact that whatever rights the plaintiff could have must be shared with all those who had been awarded medals (h).

Infringement by servants.

The person sought to be enjoined in a trade-mark case is commonly a rival manufacturer, who is using the spurious

(a) 12 L. T. N. S. 75.

(b) And see *Newman v. Alford*, 49 Barb. 588; R. Cox, 404; 6 Sickels, 189.

(c) 2 Sim. 237; and see *Page v. Townsend*, 5 Sim. 395.

(d) It should be observed that the reason given by Mr. Bickersteth (afterwards Lord Langdale and M.R.), who argued the case, for the joinder of Pelletier as a co-plaintiff, was that though having no interest in the medicine, he yet was entitled to prevent his name being used. It is further to be observed, that the subsequent decision of Lord Langdale, in *Clark v. Freeman*, does not conflict with the position taken up by him in *Delondre v. Shaw*, since

Pelletier not only manufactured the medicine, but supplied it to Delondre, so that he had a pecuniary interest in the maintenance of his reputation. *Clark v. Freeman* was decided on the point that the plaintiff did not manufacture or sell pills.

(e) 1 K. & J. 509; 6 D. & G. 214; 4 K. & J. 650.

(f) In *Millington v. Fox*, 3 My. & Cr. 338, the account was waived; and see *Barnett v. Leuchars*, 13 L. T. N. S. 495; and other cases.

(g) 1 H. & M. 264.

(h) See Exhibition Medals Act, 1863 (26 & 27 Vict. c. 119); also *Taylor v. Gillics*, 14 Sickels, 331.

mark to promote the sale of his own commodities. The fact that the fraud has been committed by a servant of the trader makes no difference, for principals "are bound to know what their agents do, and if they do not know, they are responsible exactly as if they did know." Hence, where a defendant's manager had affixed to his master's goods, without the knowledge of the latter, as he alleged, a ticket infringing the rights of the plaintiff, an injunction was granted against the master, with costs (a).

And English agents of foreign traders will be restrained **Agents.** from selling goods received from their principals falsely marked, to the injury of other manufacturers (b). So, too, commission merchants, selling with the knowledge that the goods they sell are so marked as to deceive (c).

The remedy will, however, not only be awarded against **Engravers.** such persons as are to profit directly by the perpetration of a fraud, but also against all who connect themselves with and assist in the same. Thus, persons who engrave or print a trade mark for one not entitled to use it may be restrained.

In *Guinness v. Ullmer* (d), where the defendants had supplied to one Taylor blocks engraved with the main part of the plaintiffs' trade mark, including their names, from which blocks Taylor had printed labels similar to the plaintiffs', the Vice-Chancellor of England, Sir L. Shadwell, was of opinion, that, as the matter complained of could not have happened without the prints which had been made from the blocks, the defendants had made themselves ancillary to the piracy, and he accordingly granted the injunction. It had been contended for the defendants that it had been only with a part of the plaintiffs' mark that they had been concerned; but the Vice-Chancellor thought that if a thing contained twenty-five parts, and

(a) *Tonge v. Ward*, 21 L. T. N. S. 480.

(b) *Farina v. Cathery*, L. J., Notes of Cases, 1867, p. 134.

(c) *Coats v. Holbrook*, 2 Sandf. 586, R. Cox, 20.

(d) 10 L. T. (Old Series), 127

one only was taken, such an imitation would be sufficient to contribute to a deception, and that the law would hold those responsible who had contributed to the fraud. In *Farina v. Shaw* (a), and *Farina v. Silverlock* (b), injunctions were granted to restrain the printing of labels similar to those used by the plaintiff. In the latter case, on appeal (c), Lord Cranworth, C., dissolved the injunction, and sent the right to be tried at law (d); but this can no longer be done (e).

Spurious goods
in innocent
hands.

A different combination of circumstances arises when the goods improperly marked are in the charge of an innocent third party, for purposes of conveyance, storage, or the like. In such a case, although that person be merely a carrier receiving goods, which, though fraudulently marked, are not for his own use, nor to be sold by him for his own benefit, but have been received by him merely for the purpose of transmission to the persons to whom they are consigned, yet an injunction will issue to restrain the defendant from parting with the goods spuriously marked (f). "It is the duty of the person in charge of the marked goods at once to give all the information required, and to undertake that the goods shall not be removed or dealt with, unless the spurious brand has been removed, and to offer to give all facilities to the person injured for that purpose." He should also on discovering the fraud at once inform his correspondent abroad (g). If, on the other hand, the carrier declines to give information required by the injured party for the purpose of an action against the author of the fraud, even after the marked goods have passed out of his control, the

(a) Decided by V.-C. Parker, and referred to in *Farina v. Silverlock*, 1 K. & J. 509-12. See 3 Eq. Rep. 886-90.

(b) 1 K. & J. 509.

(c) 6 De G. M. & G. 214.

(d) Where the plaintiff obtained a verdict, see 4 K. & J. 650.

(e) 25 & 26 Vict. c. 27.

(f) *Upmann v. Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. 130; and see *Rivero v. Norris*, Seton, 4th ed. 236; *Del Valle v. Mayer*, *ib.*; *Moet v. Pickering*, W. N. 1877, p. 193.

(g) Per Sir J. Romilly, M. R., and Lord Hatherley, C., in *Upmann v. Elkan*, L. R. 12 Eq. 140; and L. R. 7 Ch. 130.

person injured is entitled to succeed in an action brought against him to compel discovery (a). Supposing the carrier, &c., to give the required information and undertaking, and to seek to facilitate the proceedings, then, "if, after that, the person injured files a bill, though he will be entitled to all that he seeks in the shape of relief, as he might have got it all without suit, he will not get from the defendants the costs of the suit, and he may have to pay them (b). On the fact of the fraudulent mark being discovered, it is no redress for the carrier, &c., to send back the goods, or to offer to do so, for that would only put it in the power of the consignor to repeat his fraud; but if the carrier, &c., offers as an alternative to erase the mark, he has done all he can be reasonably required to do" (c).

Where wines bearing a spurious trade mark were in the custody of a dock company, and an innocent third party had advanced money on the security of the wines, it was ordered by Sir J. Romilly, M. R., that the wines should be delivered to the mortgagee, on the spurious brands being removed and destroyed (d). Innocent mortgagee.

In *Hunt v. Maniere* (e), where warehousemen, at the request of the owners of a certain brand on wines, refused to deliver (f) to the indorsee of the dock warrants wines improperly marked with that brand, the same learned judge restrained the indorsee from proceeding with an action at law against the warehousemen for their refusal. The jurisdiction of the old Court of Chancery to restrain actions at law is now gone, but the warehousemen would have a good defence in the Common Law Divisions to an action there commenced (g). Warehousemen.

(a) *Orr v. Diaper*, L. R. 4 Ch. D. 92.

(b) *Upmann v. Elkan*, L. R. 12 Eq. 140.

(c) Per Lord Hatherley, C., in *Upmann v. Elkan*, L. R. 7 Ch. 130.

(d) *Ponsardin v. Peto*, 33 Beav.

642.

(e) 34 Beav. 157.

(f) On the same day, but subsequently, an injunction was granted to restrain them from doing so.

(g) Judicature Act, 1873, § 24.

Questions of contract.

In exercising its jurisdiction to restrain breach, and enforce specific performance of contract, the Court has sometimes had to deal with questions of trade mark, or akin thereto. Thus, where an injunction was granted to restrain the use of a man's name (*a*) otherwise than in accordance with a contract into which he had entered, or of an initial (*b*), or of a singer's voice (*c*), or of a publication (*d*).

Steinthal v. Samson.

Where, among other symbols, the arms, crest, and motto (the latter being the word "Excelsior") of one of the partners were used as trade marks of a partnership, and on dissolution of the partnership it was agreed that the other partner might use all the trade marks of the firm, except such private arms, crest, and motto, it was held that no breach of the agreement had been committed by the continuing partner in using the word "Excelsior," apart from the arms and crest, on some of his goods, since it had been so used alone previously as a trade mark, and it was not then used as a motto, but as a trade mark (*e*).

Fraudulent agreement.

The Court will not specifically enforce an agreement the object of which is to defraud the public by putting goods spuriously marked on the market (*f*), nor will it protect a person who has intended to commit fraud by buying the right to stamp on his own goods the name of another person who has acquired a reputation in the trade (*g*). And where an action for damages was brought against a person who had filled with inferior seeds seed-bags which he had bought from the plaintiffs, marked with their labels, it was held on demurrer that the plaintiffs, having knowingly been parties to a fraud upon the public, were not entitled to recover (*h*).

(*a*) *Ainsworth v. Bentley*, 14 W. R. 630; *Ward v. Becton*, L. R. 19 Eq. 207.

(*b*) *Tudor v. Tudor*, W. N. 1873, p. 72.

(*c*) *Lumley v. Wagner*, 5 De G. & Sm. 485; 1 De G. M. & G. 604; and see *Ainsworth v. Walmsley*, L. R. 1 Eq. 518, as to a singer's voice.

(*d*) *Clowes v. Hogg*, W. N. 1870,

p. 268.

(*e*) *Steinthal v. Samson*, Court of Appeal, April 16, 1877.

(*f*) *Oldham v. James*, 13 Ir. Ch. 393; 14 *ib.* 81.

(*g*) *Samuel v. Berger*, 24 Barb. 163, R. Cox, 178.

(*h*) *Bloss v. Bloomer*, 23 Barb. 604 R. Cox, 200.

Where a contract has been entered into for the purchase of goods of a particular stamp, the question arises whether the stamp was specified as indicative of a particular quality, or as possessing some value in itself, so that the goods would be of less value if stamped differently. Thus, in *Hopkins v. Hitchcock* (a), where iron stamped with "S. & H." and a crown had been contracted for, and iron stamped with "H. & Co." and a crown was supplied, the firm having become differently constituted, and having consequently marked their iron of the quality originally denoted by the former brand with the latter stamp in substitution for the former, it was decided that the contract turned upon the quality of the iron and not upon the brand (b); if, however, the brand had possessed a special value, and the object of the purchase had been to resell the iron at a price which would have had to be lowered in the absence of the special mark, or even if it had been clear that the defendant had contracted for the brand for its own sake and not as indicative of quality, it seems that the decision would have been the other way. Such questions must, however, depend in each case upon the terms in which the intention of the contracting parties is expressed.

Contract for purchase of goods with a specified mark.

In the case of paintings, described in a catalogue as being the work of Claude Lorraine and Teniers, it was held by Lord Kenyon, C. J., that the description was merely an expression of the vendor's opinion, and not a warranty of the authenticity of the paintings (c); in a similar case, however, where the painter was said to be Canaletto, it was held by the Court of King's Bench to be for the jury to say whether or not the description amounted to a warranty (d). The paintings being so much more modern, it was more reasonable in this case to suppose that the

Painter's name on paintings.

(a) 32 L. J. C. P. 154.

P. C. 572.

(b) Compare *Nichol v. Godts*, 10 Ex. 191.

(d) *Power v. Barham*, 4 Ad. & E. 473.

(c) *Jeudwine v. Slade*, 2 Esp. N.

vendor intended to make an assertion as to the fact of their authenticity, as within his own knowledge.

**Merchandise
Marks Act.**

By the Merchandise Marks Act, 1862, any person selling or contracting to sell any article bearing a trade mark (*a*), or any description, &c., of its number, quantity, measure, weight, or place of production (*b*), is held to warrant the genuineness of the trade mark, or the correctness of the description, &c., unless he expresses the contrary in signed writing, delivered to and accepted by the vendee.

By section 21 the Court has power to direct the destruction or other disposal of goods wrongfully marked, to award an injunction, and to make an order for inspection.

By section 11 the punishment of an offender under that Act does not take away the civil remedy to which any person aggrieved by his conduct is entitled.

(*a*) 25 & 26 Vict. c. 88, § 19.

(*b*) *Ibid.* § 20.

CHAPTER VII.

THE CIVIL REMEDY. II.

DEFENCES, DISCOVERY AND INSPECTION, ACCOUNT, DAMAGES, COSTS.

Defences.

THE possible defences to an action to restrain an infringement of trade mark are numerous, some being of a somewhat special character. The following are some of the most important. Defences.

1. *Non-infringement.*

The first and usual defence is that the conduct on the part of the defendant, of which the plaintiff complains, has not been, in fact, such as to have for its object or its result the appropriation by the defendant of what was the plaintiff's due, the fruits of his enterprise and reputation; shortly, that the defendant has not infringed (a). 1. Non-infringement.

2. *Plaintiff's Trade Mark bad in itself.*

This defence must for the future be founded mainly on the definition of a trade mark in sect. 10 of the Act of 1875 (b). A newly adopted *quasi* trade mark, which possesses none of the essential particulars therein enumerated, or one used before the Act which contains no special and distinctive feature, even though it should, by some 2. Plaintiff's trade mark bad.

(a) *E. g. Crawshay v. Thompson*, 4 Man. & G. 357; *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Blackwell v. Crabb*, 36 L. J. Ch. 504; *Wother- spoon v. Currie*, L. R. 5 H. L. 508; *Singer Manufacturing Co. v. Wilson*, L. R. 2 Ch. D. 434.

(b) 38 & 39 Vict. c. 91.

oversight, obtain registration, will yet be incapable of protection. The process of registration cannot make that a trade mark which does not contain the necessary elements. Thus, any mere word not used as a trade mark before the passing of the Act cannot be registered (*a*), or if registered, could not be upheld as a valid trade mark. Thus, too, at no time could a mere adjective used in its ordinary sense be protected, as the word "nourishing" applied to stout (*b*), "superfine" or "superior" to soap (*c*). So, too, any scandalous design (*d*).

3. *No Registration or Certificate of Non-registration.*

3. No registration or certificate.

The trade mark, so called, may present some one or more of the essential particulars required by the Act, and may not be objectionable in itself, but yet the fact of non-registration under the Acts will, if it is a new mark, effectually debar the person who has used it from obtaining the injunction which would otherwise be awarded as a matter of course (*e*). If it is an old mark, a certificate of refusal to register will preserve the existing right to protection. However, it does not at all appear that, when a case of actual intentional fraud can be proved, there is anything in the Acts to prevent proof of imitation of marks, though unregistered, &c., being given as corroborative evidence of the fraud. In such a case the state of things would be similar to that in which it is a mode of packing that has been imitated (*f*). The injunction which would not be granted to restrain the infringement of the unregistered and uncertified trade mark would, as it seems, be granted to restrain the intentional fraud, in which the imitation of marks was a mere incident.

(*a*) *Ex parte Stephens*, L. R. 3 Ch. D. 659.

(*b*) *Raggett v. Findlater*, L. R. 17 Eq. 29.

(*c*) *Braham v. Bustard*, 1 H. & M. 447.

(*d*) See § 6 of the Act of 1875.

(*e*) See the Act of 1876, 39 & 40 Vict. c. 33.

(*f*) *Woollam v. Ratcliff*, 1 H. & M. 259; *Eidelsten v. Vick*, 11 Hare, 78; *Orr v. Diaper*, L.R. 4 Ch. D. 92.

4. *The Plaintiff not the Registered Proprietor.*

By section 3 of the Act of 1875 (a), it is provided that “the registration of a person as first proprietor of a trade mark shall be *prima facie* evidence of his right to the exclusive use of such trade mark, and shall, after the expiration of five years from the date of such registration, be conclusive evidence of his right to the exclusive use of such trade mark, subject to the provisions of this Act as to its connexion with the goodwill of a business.”

4. Plaintiff
not the
registered
proprietor.

The effect of this seems to be to prevent a person, whose established trade mark has been registered without his knowledge or laches in the name of another, from taking steps to prevent infringement until he has first secured the rectification of the register (b). However, a legal transmittee of a registered trade mark may assign his interest, and hence, it appears, protect it also, before his name has been inserted in the register in place of that of the former proprietor (c).

The trade mark being duly registered, the objection which formerly prevailed, by which a trade mark was excluded from protection when there were no vendible goods in the market stamped therewith (d), will be avoided, for registration will for the future, subject to the provisions in the Act as to goodwill, be equivalent to public use of the mark (e).

5. *Trade Mark severed from Goodwill.*

It is a good defence to an action for infringement of trade mark, to prove that the plaintiff is not the owner of the business and goodwill concerned in the particular

5. Trade mark
severed from
goodwill.

(a) 38 & 39 Vict. c. 91, § 3.

(b) See § 5 of the Act of 1875.

(c) Rule 25.

(d) *McAndrew v. Bassett*, 33 L. J.

Ch. 561; *Maxwell v. Hogg*, L. R. 2

Ch. 307.

(e) § 2 of Act of 1875.

goods or classes of goods in respect of which the trade mark is registered (a).

6. Licence.

6. Licence.

The defendant may plead a licence from the plaintiff. However, the Court would not allow a licensee to defraud the public by the sale of goods the mark on which was similar to that on the licensor's own goods, while the goods themselves were not the goods or goods equivalent to the goods of the licensor (b).

7. Delay and Acquiescence.

7. Delay and acquiescence.

A man may by his own laches lose his right to that protection which he would have obtained at once, had he come to the Court with reasonable promptitude (c). In fact, that which has originally been a valid trade mark, the property of an individual or firm, entitled to protection, may become *publici juris*, that is to say, the use of it may be thrown open to the public, by its proprietor allowing his right to be so habitually infringed that the trade mark no longer conveys to those who see it the impression that the goods to which it is attached are of his manufacture (d).

Principle of this defence.

The principle on which the Court allows the plaintiff's delay to be pleaded by way of defence is thus stated by Sir W. P. Wood, V.-C., in *Beard v. Turner* (e). "By not

(a) See §§ 2—3 of Act of 1875. There can be no trade mark in gross: *Cotton v. Gillard*, 44 L. J. Ch. 90.

(b) *Oldham v. James*, 13 Ir. Ch. 293; 14 *ib.* 81; *Bloss v. Bloomer*, 33 Barb. 604, R. Cox, 200; *Samuel v. Berger*, 24 Barb. 163, R. Cox, 178.

(c) *Motley v. Downman*, 3 My. & Cr. 1; *Morison v. Moat*, 9 Hare, 241; *Flavel v. Harrison*, 10 Hare, 467; *Wason v. Waring*, 15 Beav. 151; *Attorney-General v. Sheffield Gas Consumers' Co.*, 3 De G. M. & G. 327; *Burgess v. Burgess*, 3 De G. M. & G., 89; *Farina v. Gebhardt*,

3 Eq. Rep. 891; *Chappell v. Sheard*, 2 K. & J. 117; *Coles v. Sims*, 5 De G. M. & G., 1; *Kinahan v. Bolton*, 15 Ir. Ch. 75; *Hovenden v. Lloyd*, 18 W. R. 1132; *Isaacson v. Thompson*, 20 W. R. 196; *Estcourt v. Estcourt Hop Essence Co.*, L. R. 10 Ch. 276; *Amoskeag Manufacturing Co. v. Garner*, 55 Barb. 151; R. Cox, 541; and other cases cited below.

(d) *Ford v. Foster*, L. R. 7 Ch. 611; *Wheeler & Wilson v. Shakespeare*, 39 L. J. Ch. 36.

(e) 13 L. T. N. S. 746.

complaining at the time when you might complain (I do not say that it is your intention, we must judge of the intention by the necessary result) you are lying by, the man continuing to use your property, with the hope (and such is the prayer of your bill filed two or three years afterwards) of obtaining those profits which you stood by, allowing him to make under this designation, without apprising him of your intention to make any such use of it. On that ground it falls within the principle enunciated by Lord St. Leonards in the Irish case referred to, in which it is stated that it is a fraud to allow a plaintiff to avail himself of delay to obtain benefit for himself. In that case you will not grant him relief."

In the case of a motion for an injunction "the argument as to acquiescence is no doubt very important. A short acquiescence may properly induce the Court not to interfere *ex parte*. A longer acquiescence may, under the circumstances, throw serious doubt upon the right of the plaintiff, and induce the Court not to interfere by any interlocutory order, even when applied for on notice" (a). And it is not sufficient for the plaintiff to commence proceedings promptly; if he wishes for an interlocutory injunction he must bring on his motion at once, or the Court will hold that he has shown by his own conduct that he does not consider such interference to be imperative (b).

On motion for injunction.

Where, however, the case has arrived at the hearing, or is being argued on demurrer, the degree of delay or acquiescence must be much greater; there must be such an acquiescence as to amount, not only to a positive licence, but to an implication of an actual grant, before the parties can be for ever deprived of their rights (c).

At the hearing or on demurrer.

(a) Per Lord Langdale, M. R., in *Gordon v. Cheltenham Railway Co.*, 5 Beav. 233; and see *Isaacson v. Thompson*, 20 W. R. 196, where an interlocutory injunction was refused on the ground of delay.

(b) *Pickford v. The Grand Junc-*

tion Railway Co., 3 Railway Cas. 538.

(c) *Patching v. Dubbins*, Kay, 11; *Gordon v. The Cheltenham Railway Co.*, 5 Beav. 233; *Rodgers v. Rodgers*, 31 L. T. N. S. 285; and see *Gillott v. Esterbrook*, 47 Barb.

Rights must
be actively
defended.

It is not a sufficient answer to a plea of delay on the part of the plaintiff for the plaintiff to allege continual assertions of his right. He must take some more decided measures. "What the plaintiffs mainly relied on was the continual claim on their part," says Sir G. Turner, L. J. (a), "and no doubt they have not ceased to assert their claim; but I cannot agree to a doctrine so dangerous as that the mere assertion of a claim, unaccompanied by any act to give effect to it, can avail to keep alive a right which would otherwise be precluded" (b).

Delay for
purpose of
securing evi-
dence.

Inasmuch as in a case where no proof of actual deception is produced, the Court has to try a hypothetical case, turning on the probabilities of deception, as to which witnesses could probably be brought forward by both sides, a person who believes others to be infringing his trade mark is entitled to wait until he can collect a sufficient number of cases to prove to the Court that the proceedings of which he complains do actually deceive the public; and his right to protection is not gone by reason of such delay (c). It seems that in *Rodgers v. Rodgers* (d), and *Estcourt v. Estcourt Hop Essence Co.* (e), the delay would have been condoned had it resulted in the production of satisfactory evidence of deception. On the other hand, where a plaintiff delayed his motion until December, having been in possession of sufficient evidence in May, the delay was fatal to the motion (f).

Delay in
regard to
motion to
commit.

Where an injunction has been granted by the Court, there must, in order to deprive the party who has obtained the injunction of his right to move for committal upon

455; R. Cox, 340; 3 Sickles, 374; *Filley v. Fassett*, 44 Mo. 173; R. Cox, 530.

(a) *Clegg v. Edmonton*, 8 De G. M. & G. 810.

(b) This dictum was approved and followed by Wood and Selwyn, L. JJ., in *Lehmann v. McArthur*, 37 L. J. Ch. 625; but see *Attorney-General*

v. Sheffield Gas Consumers' Co., 3 De G. M. & G. 327; and *Kinahan v. Bolton*, 15 Ir. Ch. 75.

(c) *Lee v. Haley*, L. R. 5 Ch. 155.

(d) 31 L. T. N. S. 285.

(e) L. R. 10 Ch. 276.

(f) *Isaacson v. Thompson*, 20 W. R. 196.

the breach of it, be a case made out almost amounting to such a licence to the party enjoined to do the act enjoined against as would entitle him to maintain an action against others for doing that act (a).

Even if the delay has not been such as to disentitle the plaintiff to his injunction, it may yet obtain some indulgence for the defendant; as, for instance, the permission to dispose of the wares on which he expended money in consequence of the plaintiff's delay (b).

Indulgence to defendant, plaintiff having delayed.

Or, the injunction may be granted and the account of profits, by which it is usually accompanied, withheld (c).

Account withheld.

Lastly, the delay of the plaintiff may be punished by his being left to pay his own costs, though successful in his main contention (d). On the other hand, a defendant who has only defeated the plaintiff's claim by pleading the latter's delay, may fail to obtain thereby the costs of the proceedings occasioned by his own fraud (e).

Costs not given.

8. Plaintiff's Misrepresentation.

"The administration of Equity is founded on perfect truth" (f), and "when the owner of a trade mark applies for an injunction to restrain the defendant from injuring his property by making false representations to the public, it is essential that the plaintiff should not, in his trade mark, or in the business connected with it, be himself guilty of any false or misleading representation; for if the plaintiff makes any material false statement in connexion with the property which he seeks to protect, he loses, and

8. Plaintiff's misrepresentation.

(a) Per Sir G. Turner, L. J., in *Rodgers v. Nowill*, 3 De G. M. & G. 614.

(b) *Clowes v. Hogg*, W. N. 1870, p. 268; S. C. on appeal, W. N. 1871, p. 40; *Anglo-Swiss Condensed Milk Co. v. Swiss Condensed Milk Co.*, W. N. 1871, p. 163.

(c) *Harrison v. Taylor*, 11 Jur. N. S. 408; and see *Beard v. Turner*,

13 L. T. N. S. 746.

(d) See *Millington v. Fox*, 3 My. & Cr. 338; *Beard v. Turner*, 13 L. T. N. S. 746.

(e) *Rodgers v. Rodgers*, 31 L. T. N. S. 285.

(f) Per Lord Romilly, M. R., in *Cocks v. Chandler*, L. R. 11 Eq. 446.

very justly, his right to claim the assistance of a Court of Equity. He must come there with clean hands" (a).

It is impossible to define what misrepresentation will disentitle the plaintiff to relief; all that can be said is, that "he that hath committed iniquity shall not have equity" (b).

Misstatements
in plaintiff's
marks.

The trade marks, labels, &c., of the plaintiff, who is complaining of fraud on the part of another, may themselves contain statements calculated to mislead and defraud the public, who are induced by such statements to buy goods which otherwise they would not buy. Thus, in *Pidding v. How* (c), the plaintiff sold tea, which he termed "Howqua's Mixture," and which he put up in packets labelled with extravagant and false statements as to its origin and quality. Sir L. Shadwell, V.-C., declined to protect the plaintiff until he had established his title in a Court of Law, saying that it was a clear rule laid down by Courts of Equity not to extend their protection to persons whose case was not founded in truth.

Perry v.
Truefitt.

In *Perry v. Truefitt* (d), the plaintiff sold "Perry's Medicated Mexican Balm," the secret of which he had bought from a Mr. Leathart. On his show-cards he falsely stated that the hair-mixture in question was made from a recipe of Von Blumenbach, and he also alleged in the same way that it was compounded from Mexican plants, which was not in the least borne out by evidence at the trial. Lord Langdale, M.R., agreeing with the observations of the Vice-Chancellor of England, in *Pidding v. How* (c), did not think it a favourable case for the interposition of the

(a) Per Lord Westbury, C., in *Leather Cloth Co. v. American Cloth Co.*, 33 L. J. Ch. 199; and see *Edelsten v. Vick*, 11 Hare, 78; *Petridge v. Wells*, 13 How. Pr. R. 385, R. Cox, 180; *Palmer v. Harris*, 60 Penn. 156, R. Cox, 523; *Laird v. Wilder*, 9 Bush. 131, 15 Amer. Rep. 707; *Wolfe v. Burke*, 11 Sickles, 115. A trade mark which

would not be entitled to protection in Equity, by reason of its being calculated to deceive, is not to be registered under the T. M. R. Act, § 6.

(b) *Palmer v. Harris*, 60 Penn. 156; R. Cox, 523.

(c) 8 Sim, 477.

(d) 6 Beav. 66.

Court, and ordered the matter to stand over, with liberty to bring an action.

In *The Leather Cloth Co. v. The American Leather Cloth Co.* (a), the House of Lords sustained the judgment of Lord Westbury, C. (b), and declined to protect the plaintiffs, who used a label or advertisement containing false statements as to the character and manufacture of their goods. Lord Westbury, C. (b), remarked, that he "could not receive it as a rule either of morality or of equity, that the plaintiffs were not answerable for a fraud because it might be so gross and palpable that no one was likely to be deceived by it. If there was a wilfully false statement, he would not stop to enquire whether it was too gross to mislead."

Leather Cloth Cos.' case.

In short, the Court will not protect a trademark, label, &c., which contains, or has attached to it, a serious misstatement calculated to deceive; mere puffing, however, or exaggerated statements as to the value, &c., of patent medicines, and similar preparations, will not disentitle their owners, since every one knows how to estimate the value of such statements correctly (c).

Puffing.

If the misrepresentation is in other respects such as to disentitle, the fact of its being made in a foreign language does not necessarily prevent the plaintiff from losing the rights which he would have had if no such statements had been made (d).

False statement in foreign language.

In *Hogg v. Kirby* (e), the defendant, who had brought out what he intended to be taken for a continuation of the

Hogg v. Kirby

(a) 11 H. L. C. 528

(b) 33 L. J. Ch. 199.

(c) *Holloway v. Holloway*, 18 Beav. 209; *Comstock v. White*, 18 How. Pr. R. 421; R. Cox, 232; *Smith v. Woodruff*, 48 Barb. 438; R. Cox, 373. In America puffing has been treated somewhat more severely: *Fowle v. Spear*, 7 Penn. L. J. 176; R. Cox, 67; *Heath v. Wright*, 3 Wall. Jr.; R. Cox, 154; *Petridge v.*

Wells, 13 How. Pr. R. 385; R. Cox, 180; *Hobbs v. Français*, 19 How. Pr. R. 567; R. Cox, 287; *Phalon v. Wright*, 5 Phila. 464; R. Cox, 307; *Laird v. Wilder*, 9 Bush 131; 15 Amer. Rep. 707; *Wolfe v. Burke*, 11 Sickels, 115.

(d) *Palmer v. Harris*, 60 Penn. 156; R. Cox, 523.

(e) 8 Ves. 215.

plaintiff's magazine, set up in his defence the fact that the plaintiff's magazine untruly professed to be by "William Granger, Esq." Lord Eldon granted the injunction, and it is certainly improbable that any one could be injured by the use of a name previously unknown (*a*).

Use of predecessor's name.

It is clear that the use of the name of his predecessor by one who has succeeded him in business, when such use will not lead to any other supposition than that the business is the same (*b*), or the use of his own name, without more, by one whose name happens to be the same as that of another manufacturer (*c*), is not such a misrepresentation as to disentitle such a person to relief against fraud.

Collateral misrepresentations.

Collateral misrepresentations made by the plaintiff, as, for instance, in an advertisement in the newspapers, do not necessarily disentitle him to protection (*d*).

Fraudulent speculation.

It is not the province of the Court, however, to protect speculations which aim at inducing the public to buy one thing when they think they are buying another, and therefore, where both plaintiffs and defendant were engaged in speculations of that character, although the Court refused, on the ground of the plaintiffs' delay, to grant the injunction they prayed, it declined to give costs to the defendant, who was *in pari delicto* (*e*).

Hogg v. Maxwell.

In *Hogg v. Maxwell* (*f*), the plaintiff registered, under the Copyright Acts, the title of an intended magazine in 1863, but did not bring out the work. In June, 1866, the defendant registered the same name. The plaintiff discovered this in August. He then hastened on his own

(*a*) And see *Dale v. Smithson*, 12 Abb. Pr. R. 237; R. Cox, 282; *Meriden Britannia Co. v. Parker*, 39 Conn. 450; 12 Amer. Rep. 401.

(*b*) *Leather Cloth Cos.' case*, 1 H. & M. 271; 33 L. J. Ch. 199; 11 H. L. C. 523; *Churton v. Douglas*, Johns. 174; *Hudson v. Osborne*, 39 L. J. Ch. 79.

(*c*) *Holloway v. Holloway*, 13 Beav. 209; *Burgess v. Burgess*, 3

De G. M. & G. 89.

(*d*) *Curtis v. Bryan*, 2 Daly, 212; R. Cox, 434; and see *Ford v. Foster*, L. R. 7 Ch. 611.

(*e*) *Estcourt v. Estcourt Hop Essence Co.*, L. R. 10 Ch. 276; and see *Samuel v. Berger*, 24 Barb. 163; R. Cox, 178; *Bloss v. Bloomer*, 33 Barb. 604; R. Cox, 200.

(*f*) L. R. 2 Ch. 316.

publication, which was first announced on September 24, and published next day. In the meantime the plaintiff had, on the 19th, undertaken to advertise the defendant's intended magazine, but retracted the undertaking, and gave the defendant notice of his claim to the title on the 25th. Proceedings were taken by both parties with a view to an injunction, which was refused in both cases, the Court being of opinion, in *Hogg v. Maxwell*, that the plaintiff had got beforehand by improper means, which disentitled him to relief.

The Court will not protect persons in carrying on a Short weight. trade in which short weight is given systematically and knowingly (a).

9. Word "Patent" improperly used by Plaintiff.

"It is impossible not to see," says Sir G. Mellish, L.J., 9. Improper use of word "patent." "that persons do try to use their right in trade marks for the purpose of getting a monopoly in particular articles, just as if they had a patent for the goods which they manufacture" (b). A special form of misrepresentation consists in the use by persons in their trade marks of words inducing the belief that they have a patent for the articles to which those trade marks are affixed, and the tendency which the use of such words has to procure for the persons using them an unfair monopoly, or to prolong a monopoly granted only for a limited time, causes it to be regarded with special disfavour. The importance of the point is forcibly pointed out by Sir W. P. Wood, V.-C., in *Morgan v. McAdam* (c). He says: "All those who are induced to buy these crucibles thus described as 'Patent Plumbago Crucibles,' are to a certain extent deceived, because they are led to believe that the article is protected by a patent, and thus may be induced to purchase it from the plaintiffs, under the belief that there is a patent, and that

(a) See per Sir G. M. Giffard, L.J., in *Lee v. Haley*, L. R. 5 Ch. 155.

(b) *Singer Manufacturing Co. v. Wilson*, L. R. 2 Ch. D. 434-56.

(c) 36 L. J. Ch. 228.

the plaintiffs, or at least some limited number of persons, are the only persons authorized to sell it; and further, they are led to believe that if they should be minded to set up any manufactory of the same kind for themselves, they would be unable to do so in consequence of the plaintiffs being the possessors, either by way of licence or ownership, of a patent preventing the world at large from imitating the article which is sold by them under this particular designation" (a).

Plaintiff
disentitled.

Where, therefore, the plaintiff has used in his trade mark the word "patent," or words to that effect, although, in point of fact, he has never had a patent for the goods to which the mark is applied, the Court will refuse to extend to him the protection which he has forfeited. Previously to Sir John Rolt's Act (b), liberty was given to the plaintiff to bring an action at Law (c); but since then the action has been simply dismissed, with or without costs (d). And the course would be the same if the words were first inserted in the trade mark, after the expiration of a patent which had existed (e). In *Sykes v. Sykes* (f), a patent had been taken out by the plaintiff's father. That patent was held to be invalid, on account of a defect in the specification, but the use of the word "patent" was not held to disqualify the plaintiff from recovering at Law. The question does not seem, however, to have been fairly raised in that early case.

Retention of
word after
expiration of
patent.

There has been some apparent difference of opinion in regard to the case in which the word "patent" has been inserted in the trade mark while the article was still

(a) And see per the same learned judge, in *Flavel v. Harrison*, 10 Hare, 467.

(b) 25 & 26 Vict. c. 27.

(c) *Flavel v. Harrison*, 10 Hare, 467.

(d) *Morgan v. McAdam*, 36 L. J. Ch. 228; *Lamplough v. Bulmer*, W. N. 1867, p. 293; *Leather Cloth Co. v. Lonsont*, L. R. 9 Eq. 352;

Nixey v. Roffey, W. N. 1870, p. 227; and see *Ford v. Foster*, L. R. 7 Ch. 611. In *Stewart v. Smithson*, 1 Hilt. 119, R. Cox, 175, the Court of C.P. of New York refused to recognise this as a defence.

(e) *Edelsten v. Vick*, 11 Hare, 78.

(f) 3 B. & Cr. 541.

patented, and has been retained there after the patent has run out. In such a case (a), Sir W. P. Wood, V.-C., held that the plaintiffs were entitled to recover, the blocks for the labels having been made during the existence of the patent, when the representation was perfectly true. Lord Kingsdown, in discussing this judgment (b), said that he agreed with it, if the word "patent" were only used as part of the designation of an article, but that he could not do so if the trade mark represented the article as protected by an existing patent. In a subsequent case (c), the Vice-Chancellor explained his meaning as being in harmony with that of Lord Kingsdown. "If originally you have a patent, and the article is in the market as a patent article, and you stamp all your goods which are sent out with these words 'patent pins,' or 'patent wire,' or whatever the particular article might be, at the end or the expiration of the patent, it is not necessary, as I thought, to call in the whole of the previous stamps, and remodel the whole of your stamps, and have a new form of packing your article, in order that you may inform the world that the patent, which did exist, has expired. Of course, it would be better, and those who are inclined to act with scrupulous honesty would take care, to put the date of their patent, which would obviate all difficulty, upon the articles which they designate as patented." In a very recent case (d), it was clearly established that the principle enunciated by Lord Kingsdown is the rule of the Court, and that the use of the word "patent," so as to indicate an existing patent, is equally fatal, whether there has never been a patent for the article in question, or the patent which did exist has expired (e).

(a) *Edelsten v. Vick*, 11 Hare, 78.

(b) *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. C. 523.

(c) *Morgan v. McAdam*, 36 L. J. Ch. 228.

(d) *Cheavin v. Walker*, L. R. 5 Ch. D. 850.

(e) The penalties inflicted under 5 & 6 Wm. 4, c. 83, § 7, for the improper use of the word "patent," are not, however, incurred by the continued use of the word upon goods for which a patent has previously been possessed.

Word so used
as not to
deceive.

As has been seen, Lord Hatherley, when V.-C. (*a*), and Lord Kingsdown (*b*), were of opinion that when the word "patent" formed part of the name of an article, and did not operate so as to induce a belief in the existence of a patent, the trade mark in which the word appeared might be protected. A distinct decision to this effect was pronounced by Sir W. M. James, V.-C., in *Marshall v. Ross* (*c*), where "patent thread" was compared by the learned judge to "patent leather boots" (*d*).

Grossness of
misrepresenta-
tion no excuse.

The fact that the misrepresentation is so gross as hardly to be capable of deceiving will not exonerate the person making it from the consequences. Thus, the use on untanned leather cloth of the words "tanned patented" was a ground for refusing assistance (*e*).

"Manufactur-
er and
patentee."

Where a plaintiff described himself on his labels as "manufacturer and patentee," it was held that this was equivalent to describing the article as "patent," and the bill was dismissed, without costs (*f*).

Lamplough v.
Balmer.

When a plaintiff used on his stopper labels with the words "Royal Letters Patent," the explanation that he had for twenty-five years paid the stamp duty on "patent medicines," and that he was only continuing to use the labels he had had on hand when he discovered his medicines did not belong to that class, was not accepted as satisfactory, and his motion for an injunction to restrain an imitator was refused (*g*).

Collateral
use of word.

If, however, the plaintiff's trade is a perfectly honest trade, and the trade mark is a perfectly honest trade mark, the fact that the plaintiff has committed a purely collateral misrepresentation, by describing himself, though not in the

(*a*) *Morgan v. McAdam*, 36 L. J. Ch. 228.

(*b*) *Leather Cloth Cos.' case*, 11 H. L. C. 523.

(*c*) L. R. 8 Eq. 651.

(*d*) See the observations on this case, in *Leather Cloth Co. v. Lonsont*,

L. R. 9 Eq. 352.

(*e*) *Leather Cloth Cos.' case*, 33 L. J. Ch. 199; 11 H. L. C. 523.

(*f*) *Nixey v. Roffey*, W. N. 1870, p. 227.

(*g*) *Lamplough v. Balmer*, W. N. 1867, p. 293.

trade mark itself, as "patentee," will not disentitle him to his remedy (a).

With respect to trade marks not used before the passing of the Trade Marks Registration Act, 1875, the improper use of the word "patent" will not in the future form a subject for consideration, since that word will not be registered in connexion with such a trade mark (b). Word "patent" not registered.

A penalty is assigned for the improper use of the name of a patentee, or designation of an article as patent, by 5 & 6 Wm. IV. c. 83, § 7 (c). Penalty for use of patentee's name.

By the Merchandise Marks Act, 1862, § 7 (d), a penalty is imposed upon every one who shall mark, &c., upon any goods any word, &c., for the purpose of falsely indicating such goods, or the mode of manufacturing them, or the ornamentation, shape, or configuration thereof, to be the subject of any existing patent, privilege, or copyright. Merchandise Marks Act.

Under § 9, however, the use of the word "patent" and words of that class is not punishable under the 7th section, when used in such combinations as "patent thread," in *Marshall v. Ross* (e), or "patent leather boots."

Among the defences which have occasionally been set up in actions for infringement of trade mark, but without success, are the following : Inoperative defences.

Ignorance of the plaintiff's rights. This will not suffice to prevent the issue of the injunction (f); although it may have the effect of relieving the defendant from the necessity of accounting (g). Ignorance.

Mere exaggerated statements of the merits of medical or other compounds on the part of the plaintiff, which do Puffing.

(a) *Ford v. Foster*, L. R. 7 Ch. 611. 244; *Geary v. Norton*, 1 De G. & S. 9; *Cartier v. Carlile*, 31 Beav. 292; *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Moet v. Couston*, 33 Beav. 578; and other cases.
 (b) See Instructions.
 (c) And see *Myers v. Baker*, 3 H. & N. 802.
 (d) 25 & 26 Vict. c. 88.
 (e) L. R. 8 Eq. 651.
 (f) *Burgess v. Hills*, 26 Beav. *Moet v. Couston*, *ubi supra*;
 (g) *Edelsten v. Edelsten*, *ubi supra*;

not amount to fraud, will not exonerate the defendant from the consequences of his own fraud (*a*).

Equality in quality.

It is no defence to say that the spurious goods are equal in quality to the genuine ones, for the plaintiff's right is equally invaded (*b*).

Infancy.

Infancy is no defence, for "if an infant practises a fraud, he is liable for the consequences" (*c*), and he will be in the same position as an adult with respect to the payment of costs (*d*).

Colourable authority.

A fraud will not escape punishment by an authority being produced to use the name of a person having the same name as the plaintiff (*e*).

Slight delay.

The defendant will not escape by alleging laches on the part of the plaintiff in prosecuting his suit, if no greater delay has taken place than was requisite to obtain necessary evidence (*f*).

Infringement by others.

Nor by showing that the plaintiff's trade marks have been infringed by others without his knowledge or acquiescence (*g*).

Immediate purchasers not deceived.

Nor by proving that all the persons who bought from the defendant goods bearing the plaintiff's mark were well aware that they were not of the plaintiff's manufacture (*h*).

No proof of actual deception.

Nor by the absence of proof of actual deception or fraudulent intention, if in the opinion of the Court or

(*a*) *Holloway v. Holloway*, 13 Beav. 209. But see the American cases, at p. 129, note (*c*).

(*b*) *Blofeld v. Payne*, 4 B. & Ad. 410; *Edelsten v. Edelsten*, 1 De G. J. & S. 185 (per Lord Westbury, C. "It is not necessary, for the injunction, to prove . . . that the credit of the plaintiff is injured by the sale of an inferior article. The injury done to the plaintiff in his trade by loss of custom is sufficient to support his title to relief"); *Coats v. Holbrook*, 2 Sandf. 586, R. Cox, 20; *Taylor v. Carpenter*, 11 Paige, 292; 2 Sandf. 603; R. Cox, 45; *Partridge v. Menck*, 2 Barb. 101; 1 How. App. Cas. 558; R. Cox, 72;

Coffeen v. Brunton, 5 McLean 256; R. Cox, 132.

(*c*) Per Sir T. Plumer, V.-C., in *Cory v. Gertcken*, 2 Madd. 49.

(*d*) *Chubb v. Griffiths*, 35 Beav. 127.

(*e*) *Meriden Britannia Co. v. Parker*, 39 Conn. 450; 12 Amer. Rep. 401; *Wolfe v. Barnett*, 24 La. Ann. 97; 13 Amer. Rep. 111.

(*f*) *Lee v. Haley*, L. R. 5 Ch. 155.

(*g*) *Ford v. Foster*, L. R. 7 Ch. 611; *Taylor v. Carpenter*, 3 Story, 458; R. Cox 14; *Filley v. Fassett*, 44 Mo. 173; R. Cox, 530.

(*h*) *Sykes v. Sykes*, 3 B. & Cr. 541; *Edelsten v. Edelsten*, 1 De G. J. & S. 185.

jury there is such imitation as to be calculated to deceive (a).

Discovery and Inspection.

The plaintiff in a trade-mark case sometimes thinks it **Discovery.** advisable, for the purposes of his action, to obtain from the defendant a disclosure of certain particulars of his business, as, for instance, of the names of customers to whom the goods alleged to be marked with the plaintiff's trade mark have been sold, or, on whose account such goods have been conveyed.

The principles on which this advantage is given or withheld are thus stated by Lord Hatherley, C. (b): "The Court does not, when discovery is a matter of indifference to the defendant, weigh in golden scales the question of materiality or immateriality; but where the nature of the discovery required is such that the giving of it may be prejudicial to the defendant, the Court takes into consideration the special circumstances of the case, and whilst, on the one hand, it takes care that the plaintiff obtains all the discovery which can be of use to him, on the other, it is bound to protect the defendant against undue inquisition into his affairs. The question of materiality must be tested by reference to the case made by the plaintiff's pleadings, and to what will be in issue at the hearing." **Principle on which given.**

"The more strict the Court is in compelling a full answer, the more necessary it is that the Court should be vigilant in seeing that the process of the Court is not made use of in an oppressive manner" (c). Where, therefore, the L.JJ. were of opinion that the discovery asked was such as the plaintiff, even if he failed at the hearing, **Not given where oppressive.**

(a) *Edelsten v. Edelsten*, *ubi supra*;
Cope v. Evans, L. R. 18 Eq. 138;
Coats v. Holbrook, *ubi supra*;
Taylor v. Carpenter, *ubi supra*;
Coffeen v. Brunton, 4 McLean, 516,
 R. Cox, 82; S. C. 5 McLean, 256; R.

Cox, 132; *Davis v. Kendall*, 2 R. I. 566, R. Cox, 112; and see Ch. 4, on Infringement.

(b) *Moore v. Craven*, L. R. 7 Ch. 94.

(c) Per Sir C. J. Selwyn, L.J., in *Lockett v. Lockett*, L. R. 4 Ch. 341.

might yet afterwards use in a manner prejudicial to the defendant, and were not satisfied that there was any real prospect of its being of material service to the plaintiff at the hearing, they reversed the order of the Duchy Court of Lancaster by which such discovery had been granted (a).

Given when
necessary.

On the other hand, "the Court, while it takes care that no oppressive use is made of its forms of procedure, must take care that parties are not allowed to refuse discovery which they ought to make" (b). Where, therefore, a defendant, who, having been the agent in London of the plaintiff, an American sewing-machine maker, continued, after dismissal, to advertise himself as the plaintiff's agent, and to sell as "the Howe Sewing Machine" machines not made by the plaintiff, and refused to give discovery of all the machines sold by him, with the prices, profits, names of purchasers, and other particulars, on the ground that he would thereby disclose the names of his customers and the secrets of his trade, Sir J. Romilly, M.R., held that the discovery might be extremely material to the plaintiff, and ordered it to be given (c). Again, where the plaintiff obtained an injunction against the defendants, and the defendants offered to submit to an injunction and pay costs, and then moved to stay proceedings, the answer to the plaintiff's interrogatories not having yet been given, Sir W. P. Wood, V.-C., said that the plaintiff had a right to ascertain the facts in his own way, by the answer of the defendants to his interrogatories, and that until the defendants had put in their answer, it was impossible for the Court to say whether or not he had done rightly in rejecting the terms offered by the defendants. The motion was dismissed, with costs (d).

(a) *Carver v. Pinto Leite*, L. R. 7 Ch. 90. "If the Court sees that all fair and legitimate purposes will be answered by a restricted discovery, it will so restrict it;" per Sir C. Hall, V.-C., in *Orr v. Diaper*, L. R. 4 Ch. D. 92, commenting on this case.

(b) Per Sir G. M. Giffard, L. J., in *Thompson v. Dunn*, L. R. 5 Ch. 576.

(c) *Howe v. McKernan*, 30 Beav. 547.

(d) *Stephens v. Brett*, 10 L. T. N. S. 231.

In *Leather Cloth Co. v. Hirschfeld* (a), a decree having been made directing the defendant to account for all goods sold by him with a particular stamp, it was decided by the same learned judge that the defendant was compellable to disclose the names of all persons to whom he had sold any such goods, and that if he could not say to which of his customers the stamped goods were sold, he was then (but not otherwise) compellable to disclose the names of all customers to whom he had sold goods which he would not swear positively were unstamped.

In *Orr v. Diaper* (b) the plaintiffs discovered that the defendants, who were shippers, had exported large quantities of goods packed and marked in imitation of others, for certain persons unknown. Being unable to discover the infringers, they applied to the defendants for discovery, and this being refused, instituted an action against them, in which discovery was prayed. The defendants having demurred, on the ground that no relief was prayed or intended to be prayed against them, Sir C. Hall, V.-C., held that the fact that the plaintiffs required the information for the purposes of an action against the infringers was sufficient, without their intending to bring an action against the shippers, and granted the discovery.

By the Merchandise Marks Act, 1862 (c), any person who has sold, &c., any goods marked with a spurious trade mark, is bound, within forty-eight hours after delivery of a demand in writing, to give full information in writing of the name and address of the person from whom he obtained the goods, and of the time when he obtained them. In case of refusal, a justice of the peace may summon and fine the person refusing, and such refusal is *prima facie* evidence that the person refusing was acquainted with the illegal circumstances.

Again, by sect. 21, the Court or a judge is empowered,

(a) 1 H. & M. 295.

(b) L. R. 4 Ch. D. 92.

(c) 25 & 26 Vict. c. 88, § 6.

in a trade mark case, "to make such order as such Court or judge shall think fit for the inspection of every or any manufacture or process carried on by the defendant in which any such forged or counterfeit trade mark, or any such trade mark as aforesaid, shall be alleged to be used or applied as aforesaid, and of every or any chattel, article, and thing in the possession or power of the defendant alleged to have thereon or in any way attached thereto any forged or counterfeit trade mark, or any trade mark falsely or wrongfully applied, and every or any instrument in the possession or power of the defendant used or intended to be or capable of being used for producing or making any forged or counterfeit trade mark, or trade mark alleged to be forged or counterfeit, or for falsely or wrongfully applying any trade mark; and it is provided that any person who shall refuse or neglect any such order shall be guilty of a contempt of court."

Inspection
under Judica-
ture Act.

In *Hennessy v. Bohmann* (a), Sir R. Malins, V.-C., granted inspection under Supreme Court of Judicature Act, 1875, Order LII., rule 3.

Account.

Account.

A most important part of the remedy given in Equity for the infringement of the rights of the owner of a trade mark is the account of the profits, by which such profits as have been dishonestly acquired by a defendant by means of the reputation of another are restored to the plaintiff, whose they ought to have been at first. The principle is the same as where a man is made to account for the profits which he has improperly received, arising from the fraudulent manufacture of a secret medicine (b), or the publication of a newspaper (c).

Incident to
injunction.

"The liability to account for the profits is incident to the injunction" (d), and "on authority and principle it is

(a) W. N. 1877, p. 14.

(b) *Green v. Polgham*, 1 S. & S. 398.

(c) *Giblett v. Read*, 9 Mod. 459.

(d) Per Sir J. Romilly, M.R., in *Cartier v. Carlile* 31 Beav. 292.

clear that if a man manufactures goods and knowingly marks them with the trade mark of another person, he is accountable for the profits so made" (a).

So long as the defendant is aware that he is using a trade mark which is not his, the fact that he does not know to whom the trade mark which he has copied belongs, does not in the slightest degree affect the right of the owner to an injunction and an account of profits (b).

If, however, the defendant has marked goods, or sold them already marked, in ignorance that he was using a trade mark at all, although the plaintiff will be entitled to his injunction, he will not be entitled to an account, except in respect of any user by the defendant after he became aware of the prior ownership (c).

In many cases the main object of the action is to obtain the injunction, the account being of very secondary importance (d), and occasionally the injury suffered by the plaintiff, and the profits received by the defendant, have been so small that the account has not formed part of the relief awarded, so that the old rule that the injunction was subordinate to the account (e) no longer holds good.

As a plaintiff may be disentitled by reason of his own laches to his injunction, so he may be disentitled by the same reason to the account of profits. If he permits the defendant to continue his infringement for a prolonged period, he will not then be allowed to treat him as his salesman, and claim an account (f).

Where a defendant offered, among other things, to account for profits, but the plaintiff, declining the offer of submission, insisted upon his own terms, including an account, the Court granted the account, but only upon the

(a) Per Sir J. Romilly, M.R., in *Moet v. Couston*, 33 Beav. 578.

(b) *Cartier v. Carlile*, *ubi supra*; *Moet v. Couston*, *ubi supra*.

(c) *Edelsten v. Edelsten* 1 De G. J. & S. 185; *Moet v. Couston*, 33 Beav. 578.

(d) *Barnett v. Leuchars*, 13 L. T. N. S. 495; *Shipwright v. Clements*, 19 W. R. 599, &c.

(e) *Delondre v. Shaw*, 2 Sim. 237.

(f) *Beard v. Turner*, 13 L. T. N. S. 746; *Harrison v. Taylor*, 11 Jur. N. S. 408.

plaintiff's request, and at his peril in respect of costs, in case it should turn out that the account furnished by the defendant of his own accord was accurate (a).

Subdivided
account.

In *Dent v. Turpin* (b), where a defendant had infringed a trade mark, which had become by devise the property of two different persons, and those persons brought distinct actions against the defendant, the prayer in each case including an account and payment of such share of the profits as should be shown to be attributable to the individual plaintiff's share, it was held that such an account and payment could be granted.

Extent of
account.

As to the extent of the account, it will not be given for a period of more than six years before the commencement of the action, and it will not include every species of profit made by the defendant during that period, but only so much as is properly attributable to the use of the plaintiff's trade mark (c). If the defendant was at first ignorant that he was using a trade mark, the account will commence from the date when he became aware of that fact (d); and where the defendant had himself been guilty of misrepresentation, and the defendant's business was carried on on so much larger a scale than the plaintiff's as to render it impossible to suppose that the use of the plaintiff's mark had alone brought the defendant his customers, the account was only given from the date of filing the bill, and not earlier (e).

Election
between
account and
damages.

The acceptance of an account of profits by the plaintiff operates as a condonation of the infringement, so that a plaintiff must elect between the account and an inquiry as to damages, but cannot claim both (f).

Damages.

Damages.

It is in the option of a successful plaintiff in a trade-mark

(a) *Nunn v. D'Albuquerque*, 34 Beav. 595. 578; *Edelsten v. Edelsten*, 1 De G. J. & S. 185.

(b) 2 J. & H. 139.

(e) *Ford v. Foster*, L. R. 7 Ch. 611.

(c) *Cartier v. Carlile*, 31 Beav. 292.

(f) *Neilson v. Betts*, L. R. 5 H.

(d) *Moet v. Couston*, 33 Beav.

L. 1.

action to elect between an account of profits and an inquiry as to damages, although, as before stated, he cannot have both (a). Damages being the appropriate remedy at Common Law, while the account of profits was peculiar to Equity, the result, and probably the cause of the great majority of trade-mark cases being brought into Equity, has been that an account has been commonly awarded and not damages. This has been the case notwithstanding that the Courts of Equity have had the power of giving relief in the shape of damages (b), since in most cases the account forms the most convenient remedy.

Some of the remarks made in reference to the account apply in respect of damages : thus, the defendant is liable in damages for improper user of what he has reason to know, or suppose to be, a trade mark, though he may be ignorant of the owner ; but not for use of a mark which he did not know to be a trade mark at all (c).

For damages to be recovered, it is not necessary that special damage should be proved ; it is sufficient to show that the plaintiff's right has been invaded, in which case some damages, even if only nominal, will be given (d).

The measure of damages which can be recovered when special damage is proved is not yet clearly settled by authority ; but in *Leather Cloth Co. v. Hirschfeld* (e), it was held by Sir W. P. Wood, V.-C., that it would not be assumed in the absence of evidence that the amount of goods sold by the defendant under the fraudulent trade mark would have been sold by the plaintiff but for the defendant's unlawful use of the plaintiff's trade mark, for how could the Court assume that the persons who bought what the plaintiff

(a) *Neilson v. Betts*, L. R. 5 H. L. 1.

(b) Thus, inquiries as to damages were given in *Cheavin v. Walker*, L. R. 5 Ch. D. 850-61 ; and *Graveley v. Winchester*, Seton, 4th ed. 257.

(c) *Edelsten v. Edelsten*, 1 De G. J. & S. 185 ; *Cartier v. Carlile*, 31

Beav. 292 ; *Moct v. Couston*, 33 Beav. 578.

(d) *Blofeld v. Payne*, 4 B. & Ad. 410 ; and see *Sykes v. Sykes*, 3 B. & Cr. 541 ; *Morison v. Salmon*, 2 Scott, N. R. 449 ; 2 Man. & G. 385 ; and cases at p. 99, n. (b).

(e) L. R. 1 Eq. 229.

averred were inferior articles, at an inferior price, would necessarily, if they had not done so, have bought the superior articles at the higher prices (a).

Offer of submission.

Where a defendant offered submission in terms which were rejected by the plaintiff, the latter was allowed an inquiry as to damages at his own risk (b).

Merchandise Marks Act.

By sect. 22 of the Merchandise Marks Act, 1862 (c), a person who forges a trade mark, or applies a forged trade mark to goods for the purpose of sale, or in any other of certain specified ways attempts to pass off spurious goods as genuine, is liable in damages to every person aggrieved by such wrongful acts.

Costs.

General rule as to costs—follow event.

The same general principles on which costs are given in other cases prevail in those in which a question of trade mark is at issue. Thus, the primary rule is that costs follow the event; that is to say, that where a plaintiff succeeds, he will get his costs (d); where he is unsuccessful, he will have to pay costs (e). And the fact that merely nominal damages have been awarded will not deprive a successful plaintiff of his right to his costs, since a question of his right has been involved (f).

Sometimes otherwise.

Costs, however, being in the discretion of the Court, the Court will, under some circumstances, grant the injunction, but without costs, as where the plaintiff has persisted in litigation which had become unnecessary (g). On the other hand, while the relief claimed by the plaintiff is

(a) See, however, *Graham v. Plate*, 40 Cal. 593, 6 Amer. Rep. 639.

(b) *Tonge v. Ward*, 21 L. T. N. S. 480.

(c) 25 & 26 Vict. c. 88.

(d) *Chappell v. Davidson*, 2 K. & J. 123; *Farina v. Silverlock*, 1 K. & J. 509; 6 De G. M. & G. 214; 4 K. & J. 650; *Collins Co. v. Walker*, 7 W. R. 222; *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *McAndrew v. Bassett*, 33 L. J. Ch. 561.

(e) *Woollam v. Ratcliff*, 1 H. & M. 259; *Williams v. Osborne*, 13 L. T. N. S. 498; *Morgan v. McAdam*, 36 L. J. Ch. 228; *Bass v. Dawber*, 11 L. T. N. S. 626.

(f) *Morison v. Salmon*, 2 Scott. N. R. 449; 2 M&N. & G. 385.

(g) *Millington v. Fox*, 3 My. & Cr. 338; *Moet v. Couston*, 33 Beav. 578; *Hudson v. Bennett*, 12 Jur. N. S. 519.

refused, the defendant may still be left to pay his own costs, as where the plaintiff has lost his remedy by lapse of time (*a*), or improper use of the word "patentee (*b*)," or other similar reasons (*c*), the defendant's fraudulent intention being evident, or, more commonly, where the defendant's conduct, though not so clearly fraudulent as to entitle the plaintiff to an injunction, has yet been so suspicious and uncandid as to call for some punishment (*d*). In some cases the costs of interlocutory proceedings will be made costs in the cause, as where, on motion for injunction, the plaintiff failed on the score of delay (*e*). Where a respondent appeared at the hearing of an appeal, after having received notice from the appellant that no alteration would be asked in the order in the Court below, with respect to his costs, which the appellant had been ordered to pay, that respondent was left to pay the costs of such appearance (*f*). If a plaintiff makes charges which he is unable to substantiate, he may obtain an injunction with costs, and yet have to pay all costs occasioned by the making of that charge (*g*). In the same way, if a plaintiff insists upon having an account taken, after the defendant has given full information, the plaintiff will have to pay the costs of that account, if it turn out to have been unnecessary (*h*).

Where wharfingers were in possession of wines spuriously branded, and resisted an action by the injured party by setting up a claim to a lien on the wines, they, as well as the actual offender, were ordered to pay costs (*i*).

Costs given
against wharf-
ingers.

(*a*) *Rodgers v. Rodgers*, 31 L. T. N. S. 285.

(*b*) *Nixey v. Roffey*, W. N. 1870, p. 227.

(*c*) *E.g. Pettridge v. Wells*, 13 How. Pr. R. 385; R. Cox, 180.

(*d*) *Edgington v. Edgington*, 11 L. T. N. S. 299; *Bass v. Dawber*, 19 L. T. N. S. 626; *Ainsworth v. Walmsley*, L. R. 1 Eq. 518; *Wylam v. Clarke*, W. N. 1876, p. 68; *Robineau v. Charbonnel*, W. N. 1876, p. 160.

(*e*) *Isaacson v. Thompson*, 20

W. R. 196. And see *Brook v. Evans*, 2 L. T. N. S. 740; *Wallis v. Wallis*, 4 Dr. 458.

(*f*) *Upmann v. Elkan*, L. R. 7 Ch. 130.

(*g*) *Pierce v. Franks*, 15 L. J. Ch. 122; *Standish v. Whitwell*, 14 W. R. 512; *Wylam v. Clarke*, W. N. 1876, p. 68.

(*h*) *Nunn v. D'Albuquerque*, 34 Beav. 595.

(*i*) *Moet v. Pickering*, W. N. 1877, p. 193.

Costs in case of compromise.

One of the main objects which the Court has in view in the exercise of its jurisdiction is "to repress unnecessary litigation, and to keep litigation within those bounds which are essential to enable the parties to vindicate and establish their rights" (a). When, therefore, "a plaintiff, immediately after the suit is commenced, is offered and may obtain all he seeks, and still thinks proper to go on with his suit, the Court may give him his decree, but will not give him the costs of the suit so unnecessarily prosecuted" (b). The defendant is, however, the aggressor, since the litigation has been first occasioned by his unwarrantable interference with the plaintiff's rights in respect of his trade mark, and this is equally the case whether the aggression was made with knowledge or in ignorance of those rights of the plaintiff. The defendant must therefore offer all the plaintiff has a right to obtain, and the offer must include all the costs which have been occasioned by his improper conduct (c). A plaintiff whose rights have been attacked is not bound to rely on the assurance of his assailant that the act will not be repeated, but is entitled to the protection of an injunction (d).

Costs of unnecessary litigation thrown on party causing them.

Where in a patent case an injunction was granted, the defendants having previously promised to commit no further infringement and to pay the costs of preparing the bill, Sir J. L. Knight Bruce, V.-C., gave the plaintiffs their costs at the hearing, since the defendants ought to have

(a) Per Lord Cottenham, C., in *Millington v. Fox*, 3 My. & Cr. 338.

(b) Per Sir J. Wigram, V.-C., in *Colburn v. Simms*, 2 Hare, 560, commenting on *Millington v. Fox*; and see *McAndrew v. Bassett*, 33 L. J. Ch. 561; *Hudson v. Bennett*, 12 Jur. N. S. 519; *Upmann v. Elkan*, L. R. 12 Eq. 140, 7 Ch. 130; *Williams v. Osborne*, 13 L. T. N. S. 498.

(c) *Fradella v. Weller*, 2 R. & M. 247; *Kelly v. Hooper*, 1 Y. & C. 197; *Geary v. Norton*, 1 De G. & S.

9; *Burgess v. Hills*, 26 Beav. 244; *Burgess v. Hatley*, 26 Beav. 249; *Wallis v. Wallis*, 4 Dr. 458; *Collins Co. v. Walker*, 7 W. R. 222; *Moet v. Couston*, 33 Beav. 578; *Nunn v. D'Albuquerque*, 34 Beav. 595; *Coats v. Holbrook*, 2 Sandf. 586; R. Cox, 20.

(d) *Geary v. Norton*, 1 De G. & S. 9; *Routh v. Webster*, 10 Beav. 561; *Tonge v. Ward*, 21 L. T. N. S. 480; *Coats v. Holbrook*, 2 Sandf. 586; R. Cox, 20.

offered, on the injunction being obtained, to pay all costs up to that time (a). The same result followed where a defendant, who had offered to pay the taxed costs as between party and party, but refused to pay them as between solicitor and client, put in his answer, and then, the plaintiff offering to accept the costs as between party and party, declined to pay the costs of the answer (b).

Where a plaintiff company succeeded on the question of imitation of labels and wrappers, but failed as to trade mark, the plaintiffs were given their costs up to the motion for injunction, each party having to bear his own after that (c). Apportionment of costs.

It seems that a person whose trade mark has been infringed should give notice to the infringer of his intention to take proceedings, so as to give him an opportunity of explaining his conduct or submitting (d); and that, a fair offer being made, he should not hasten to incur needless expense (e), or he may in either case be punished in respect of costs. Lord Romilly, M. R., was, however, of opinion (f) that the defendant having been the aggressor, the plaintiff would be justified in filing his bill, without making any application to the defendant; and in *Upmann v. Elkan* (g) he indicated his adherence to the same view, saying that he did not mean to lay down that the person whose trade mark had been imitated might not file a bill without making any enquiry at all. Notice to infringer.

A plea of infancy will not excuse an infant infringer from paying the costs which his conduct has occasioned (h). Infancy does not excuse from costs.

A person who has induced another person to manufacture for him goods marked with the trade mark of a third person is liable to repay to the person he has made Costs occasioned to a third party by defendant's fraud.

(a) *Geary v. Norton*, *ubi suprd.*

(b) *Kelly v. Hooper*, 1 Y. & C. 197.

(c) *Compagnie Laferme v. Hendrickx*, M. R. J. 20, 1876.

(d) *Chappell v. Davidson*, 2 K. & J. 123; *Wallis v. Wallis*, 4 Dr. 458.

(e) *Williams v. Osborne*, 13 L. T. N. S. 498.

(f) In *Burgess v. Hately*, 26 Beav. 249. And see *Coats v. Holbrook*, 2 Sandf. 586; R. Cox, 20.

(g) L. R. 12 Eq. 140; L. R. 7 Ch. 130.

(h) *Cory v. Gertcken*, 2 Madd. 49; *Chubb v. Griffiths*, 35 Beav. 127.

the instrument of his fraud the cost of legal proceedings brought about by the infringement, including any sum which that person may have reasonably paid to compromise the matter (a).

(a) *Dixon v. Faureus*, 3 Ell. & Ell. 537.

CHAPTER VIII.

CASES ANALOGOUS TO THOSE OF TRADE MARK.

IN addition to the cases in which there has been an infringement of trade mark properly so called, a variety of cases have been decided in which the Court has restrained the practice of fraud by one person at the expense of another, the means adopted to perpetrate the fraud resembling to some extent the infringement of a trade mark, but yet being distinguishable therefrom. Cases not strictly trade-mark cases.

A trade mark is a highly technical matter, and for there to be an infringement of trade mark there must be a valid trade mark in existence; that is to say, there must not only be such a device in existence as is capable of forming a trade mark, but it must be actually attached to vendible articles in the market (*a*), or must, at least, if first used since the Trade Marks Act of 1875, be properly registered under the Registration Acts (*b*). Cases of true trade mark.

Where, however, there has been a representation that one thing is another, by means of which one person has secured custom intended for another, so that both the purchaser and the genuine trader have been defrauded, there the Court will interfere and protect the right of both parties to trade freely without fraudulent deceptions, although the fraud has taken another form than that of imitating a trade mark. Cases not of true trade mark.

(*a*) *McAndrew v. Bassett*, 33 L. J. Ch. 561; *Maxwell v. Hogg*, L. R. 2 Ch. 307,

(*b*) See the Registration Act of 1876, 39 & 40 Vict. c. 33.

Trade name.

An important class of cases of this description consists of cases in which there has been a wrongful assumption by one person or firm of the trade or firm name under which a reputation has been gained by another person or firm, and which has therefore become a very important part of the goodwill of the business of such person or firm (a), although when used as a name, and not as a mark on vendible goods, it is not used as a trade mark. The imitation of such a name falsely represents not merely a certain class of goods, but the entire business to be that of one not the true proprietor.

No exclusive right in name apart from business.

“In this country,” says Lord Chelmsford (b), “we do not recognise the absolute right of a person to a particular name, to the extent of entitling him to prevent the assumption of that name by a stranger. The right to the exclusive use of a name in connexion with a trade or business is familiar to our law; and any person using that name, after a relative right of this description has been acquired by another, is considered to have been guilty of a fraud, or at least of an invasion of another’s right, and renders himself liable to an action, or he may be restrained from the use of the name by injunction.”

Fraud must be proved.

For an action to restrain the use of a trade name to be successful, fraud must be proved: there is no question of goods despatched about the world with a false indication of origin. In a case of this description it was said by Sir W. P. Wood, V.-C. (c), that “the Court must not only be satisfied that the course which had been taken by the defendants had been calculated to deceive the public, but that it had been represented to them by the plaintiffs as having that effect. If, after such representation, the defendants persisted in continuing the use of the name in the same manner, then, on the plaintiffs bringing the case before the

(a) Per Wood, V.-C., in *Churton v. Douglas, Johns*. 174.

(b) *Du Boulay v. Du Boulay*, L. R. 2 P. C. 441.

(c) *Williams v. Osborne*, 13 L. T. N. S. 498. And see *McAndrew v. Bassett*, 33 L. J. Ch. 561.

Court, the Court would be justified in saying that that which was not fraudulent at first became so by the defendants persisting in the same course, and that therefore the plaintiffs would be entitled to the relief they claimed." The principle is, not that there is property in the name (a), but that it is a fraud on the part of one person to attract to himself the custom intended for another, by a false representation, direct or indirect, that the business carried on by himself is identical with that of the other person by whose ability and exertions the name has acquired the reputation it possesses (b). The question is not whether the defendants' business is represented as being similar to the plaintiffs', but whether it is represented as being that very identical business (c).

When the name which is alleged to have been imitated is that of a company, and is composed of such words as are in ordinary use in the language, very clear evidence indeed of fraud will be required for an action for infringement to be successful. Thus, where a bill was filed by The London and Provincial Law Assurance Society against The London and Provincial Joint Stock Life Assurance Company (d), the injunction was refused, an action at law being directed; and in suits by The Colonial Life Assurance Company against The Home and Colonial Assurance Company, Limited (e), and by The London Assurance Company against The London and Westminster Assurance Corporation, Limited (f), the injunction was simply refused. Where

Name of company.

(a) In *Singer Manufacturing Co. v. Kimball*, Court of Session Cas. 3rd Series XI. 267, the Scotch Court appears to have held that there was some sort of right of property in the name of a company; but in *Singer Manufacturing Co. v. Wilson*, L. R. 2 Ch. D. 434, the English Courts refused to follow that decision. And see per Sir G. M. Giffard, V.-C., in *Boulnois v. Peake*, W. N. 1868 p. 95.

(b) *Lee v. Haley*, L. R. 5 Ch. 155.

(c) *Cruttwell v. Lye*, 17 Ves. 335; *Churton v. Douglas*, Johns. 174.

(d) *London and Provincial Law Assurance Society v. London and Provincial Joint Stock Life Assurance Co.*, 17 L. J. Ch. 37.

(e) *Colonial Life Assurance Co. v. Home and Colonial Assurance Co.*, 33 Beav. 548.

(f) *London Assurance Co. v. London and Westminster Assurance Corporation*, 32 L. J. Ch. 664.

a bill was filed by a person representing The London Manure Company, against another person representing The London Patent Manure Company (a), the Vice-Chancellor of England, on motion to dissolve an injunction, held that the defendants' circulars were clearly fraudulent imitations of the plaintiffs', but dissolved the injunction, and sent the case to a jury for the purpose of deciding whether the plaintiffs' user of their title had been sufficiently long. In *Lawson v. The Bank of London* (b), a case at Common Law, the plaintiff was defeated on the ground of a want of averment in the declaration that he was a banker or had ever carried on that business; Willes, J., however, remarked that "he was not prepared to say that the defendants would not be liable, if the cause of complaint were properly alleged." In *Lee v. Haley* (c), the plaintiffs were coal merchants, trading under the name of The Guinea Coal Company, and having their business premises at No. 22, Pall Mall. The defendant had been in their service as manager, and on leaving them set up in business at Beaufort Buildings, Strand, under the name of The Pall Mall Guinea Coal Company. From Beaufort Buildings he removed to No. 48, Pall Mall. In that case fraud was held to be proved, and the injunction was granted, but there being no property in the name, and the Court being of opinion that the only reasonable chance of successful deceit depended upon the residence of the defendant in Pall Mall, the injunction against the user by the defendant of his trade name as above was restricted to Pall Mall. Where a plaintiff company sold white lead in kegs marked "Brooklyn White Lead Company," or "Co.," and the defendant, who had formerly marked his "Brooklyn White Lead, pure, 100 lbs.," changed the name to "Brooklyn White Lead and Zinc Company," it was held that, though he was entitled to continue to

(a) *Purser v. Brain*, 17 L. J. Ch. 141.

(b) 18 C. B. 84.

(c) L. R. 5 Ch. 155.

mark his goods "Brooklyn White Lead and Zinc," he had no right to add "Company" or "Co." (a)

By sect. 20 of the Companies Act, 1862 (b), it is enacted ^{The Companies Act, 1862.} that "no company shall be registered under a name identical with that by which a subsisting company is already registered, or so nearly resembling the same as to be calculated to deceive, except in a case where such subsisting company is in the course of being dissolved, and testifies its consent in such manner as the registrar requires; and if any company, through inadvertence or otherwise, is, without such consent as aforesaid, registered by a name identical with that by which a subsisting company is registered, or so nearly resembling the same as to be calculated to deceive, such first-mentioned company may, with the sanction of the registrar, change its name" (c).

If the trade name which has been imitated is that of ^{Name of individual.} an individual, and this has been assumed by another person of different name, little is required to prove the fraud. In fact, the assumption of another's name is almost sufficient proof if taken alone (d).

Sometimes the plaintiff's name is itself an assumed or ^{Assumed name.} fanciful one; thus the use of the name "Christy's Minstrels" has been restrained (e); and in *Isaacson v. Thompson* (f) the plaintiff kept a millinery establishment, as "Madame Elise," which being imitated by the defendant, an injunction would have been awarded, had not the plaintiff's own delay disentitled her to relief.

(a) *Brooklyn White Lead Co. v. Masury*, 25 Barb. 416; R. Cox, 210. And see *Churton v. Douglas*, Johns. 174.

(b) 25 & 26 Vict. c. 89.

(c) In *Newby v. Oregon Central Railway Co.*, 1 Deady, 609, 9 Amer. Rep. 331 n., the adoption of the name "The Oregon Central Railway Co." was restrained, there being a subsisting corporation of that name. See also *Holmes, Booth & Haydens v. Holmes, Booth & Att-*

wood Manufacturing Co., 37 Conn. 278; 9 Amer. Rep. 324; *Batchellors v. Batchellor Manufacturing Co.*, 12 Amer. Rep. 414 n., as to imitation of names of companies.

(d) Per Sir G. J. Turner, L. J., in *Burgess v. Burgess*, 3 De G. M. & G. 89. See *Binninger v. Wattles*, 28 How. Pr. R. 206; R. Cox, 318.

(e) *Christy v. Murphy*, 12 How. Pr. R. 77; R. Cox, 164; *Montague v. Moore*, Seton, 4th ed. 238.

(f) 20 W. R. 196.

Man's own
name.

In some cases the use of a man's own name may be such as to deceive, and where this is so the person aggrieved is entitled to obtain an injunction against such use of the name (a), but he must prove clearly the fraudulent intent, and "it is a question of evidence in each case whether there is false representation or not" (b).

Evidence of
fraud.

Such evidence was supplied in one case (c) by a removal by the defendant into the neighbourhood in which the plaintiff was carrying on his business, and the addition of "and Co." to the name, "H. Fullwood," the plaintiff's trade name being "R. J. Fullwood & Co." In another case (d), the defendant, who had sold his business and the goodwill, including the name, "John Douglas & Co.," recommenced business, and employing the three managing men of his former business, styled his new business, "John Douglas & Co.," and sent round circulars informing the public that his firm was so well known that it was unnecessary to say anything about it; thus, in fact, "representing himself to be the owner of that which he had sold." So, too, it was held to be fraud for a person who had recently come into the neighbourhood of the "Carriage Bazaar" in Baker street, and set up a "Carriage Repository," to change that name to "The New Carriage Bazaar," with some incorrect additions (e).

Deceptive
circulars.

Again, a fraudulent intention may be shown to exist by

(a) *Churton v. Douglas*, Johns. 174; *Burgess v. Burgess*, 8 De G. M. & G. 89; *Fullwood v. Fullwood*, W. N. 1873, pp. 93—185; *Holloway v. Holloway*, 13 Beav. 209; *Holmes v. Holmes*, 37 Conn. 278; 9 Amer. Rep. 324; *Gillis v. Hall*, R. Cox, 596. See *Christie v. Christie*, W. N. 1873, pp. 8—70.

(b) Per L. J. Turner, in *Burgess v. Burgess*, *ubi suprd.*

(c) *Fullwood v. Fullwood*, W. N. 1873, pp. 93—185. And see *Glen & Hall Manufacturing Co. v. Hall*, 16 Sickels, 226. Where Robert Minton Taylor, formerly a member of the firm of Minton, Hollins & Co., set up

for himself as Robert Minton Taylor & Co., and, on being threatened with legal proceedings, undertook to trade only as Robert Minton Taylor, it was held that a purchaser of R. M. Taylor's business could not carry it on under the style of "The Minton Brick and Tile Co.:" *Campbell v. Hollins*, H. L. April 26, 1877.

(d) *Churton v. Douglas*, Johns. 174. But see the American case of *Howe v. Searing*, 10 Abb. Pr. R. 264; R. Cox, 244.

(e) *Boulnois v. Peake*, W. N. 1868 p. 95. And see *Glen & Hall Manufacturing Co. v. Hall*, 16 Sickels, 226.

the production of deceptive circulars so framed by the defendant as to represent his business to be identical with, or a continuation of that carried on by the plaintiff; and such a fraud will be restrained (a).

So, too, one person will not be allowed to defraud another by opening letters addressed to him, and executing orders intended for him (b). Where, however, various acts of misrepresentation by the defendant were alleged, pointing to an intention to simulate the plaintiff, but only one case was made out, in which the defendant had opened a letter addressed to the plaintiff, answered it in his own name, and endeavoured to obtain the custom offered by that letter to the plaintiff, it was held that, though this raised grave suspicion of the defendant's motives, yet it was not sufficient ground for an injunction. The defendant, however, was refused his costs (c).

Opening letters.

Nor will fraud be permitted to be perpetrated under cover of a partnership got up for the purpose of fraud (d).

Fraudulent partnership.

On the sale of the goodwill of a business, the vendor, in the absence of a special stipulation on the point, retains the right of recommencing business, even in his own name, however similar that may be to the trade name of the business the goodwill of which has been sold; provided that he scrupulously abstains from doing anything to induce the public to believe that his new business is in fact the old one which he has sold. If, however, he does anything calculated to induce the belief that his new business is not merely similar to, but is identical with the old one, the purchaser of the old business is entitled to restrain him by injunction (e).

Vendor of business may recommence business.

(a) *Churton v. Douglas*, Johns. 174; *Stevens v. Paine*, 18 L. T. N. S. 600; *Purser v. Brain*, 17 L. J. Ch. 141; *Christie v. Christie*, W. N. 1873, pp. 8—70; *Burrows v. Poster*, Seton, 4th ed. 257; *Graveley v. Winchester*, *ib.*; *Selby v. Anchor Tube Co.*, W. N. 1877, p. 191.

(b) *Scheile v. Brakell*, 11 W. R. 796; Seton, 4th ed. 253; *Witt v.*

Corcoran, *ib.* 257.

(c) *Edgington v. Edgington*, 11 L. T. N. S. 299

(d) *Croft v. Day*, 7 Beav. 84; *Dence v. Mason*, W. N. 1877, p. 28; *Holmes v. Holmes*, 37 Conn. 278; 9 Amer. Rep. 324.

(e) *Cruttwell v. Lyc*, 17 Ves. 835; *Churton v. Douglas*, Johns. 174; *Johnson v. Helleley*, 34 Beav. 63;

Dissolution of partnership.

On the dissolution of a partnership, if the whole concern and the goodwill are sold, the trade name is sold with it (a). But if the partners merely divide the partnership assets, and there are no express stipulations in the articles as to the disposal of the trade name, then each is at liberty to use the old name just as the partnership did before (b); at all events, if no injury will be thereby caused to a partner whose name the firm have used (c). If, again, on the dissolution of partnership, one partner takes over the whole concern by arrangement, he must compensate the other partner for his interest in the trade name (d), and the retiring partner is at liberty to set up a similar business in his own name, even on adjoining premises (e).

Scott v. Scott.

In *Scott v. Scott* (f), R. & W. Scott carried on business in partnership at Nithsdale, and Glasshouse Street, Regent Street, as "R. & W. Scott." The partnership being dissolved, the agreement for the dissolution contained no stipulation by either party not to continue the business, but neither of the parties was to use the name of the firm, except so far as might be necessary for winding up the partnership affairs. W. Scott retiring from the business, and setting up for himself in the neighbourhood of Nithsdale, R. Scott retained the business premises of the late firm, and made them over with his business to the defendants, Scott & Nixon. The inscription used by the late firm over their house at Glasshouse Street having been "R. & W. Scott, of Nithsdale," the defendants replaced this by "Scott & Nixon, late R. & W. Scott, of Nithsdale." Upon this W. Scott filed a bill

Hudson v. Osborne, 39 L. J. Ch. 79.
Tudor v. Tudor, W. N. 1873, p. 72,
depended on an express stipulation
in the deed under which the plaintiff
retired from the business.

(a) *Banks v. Gibson*, 34 Beav. 566. See *Hoffman v. Duncan*, Seton, 4th ed. 256; *Witt v. Corcoran*, *ib.* 257.

(b) *Ib.* See *Clark v. Leach*, 32

Beav. 14; *Dence v. Mason*, W. N. 1877, p. 23; *Mitchell v. Condy*, *ib.* 153.

(c) *Scott v. Rowland*, 20 W. R. 508.

(d) *Banks v. Gibson*, 34 Beav. 566.

(e) *Bond v. Milbourn*, 20 W. R. 197.

(f) 16 L. T. N. S. 143.

against them, and on motion for injunction, the injunction was granted to restrain the defendants from permitting that inscription to remain, and from representing their business to be in continuance of that carried on by the late partnership of R. & W. Scott (a).

The injury caused by the defendants to the plaintiffs is even greater than in an ordinary case of misappropriation of a trade name, when the representations made by the defendants go to show that the plaintiffs have retired from business, and that the defendants have succeeded to the business formerly carried on by them. Thus, where the defendants had acquired a lease of works at which the plaintiffs had formerly manufactured bricks, but not of the mines from which the brick-clay used by the plaintiffs had been obtained, and then issued cards and circulars, styling themselves "E. J. & J. Pearson (late Harpers & Moore)," and otherwise representing themselves to have succeeded to the business of the plaintiffs, who were, as a matter of fact, carrying on their business on other works, the defendants were restrained by injunction from their misrepresentations (b); and Sir W. P. Wood, V.-C., expressed an opinion that, on application by the owner of the mines of fire-clay used by the plaintiffs, but not by the defendants, the issue of an injunction would have been almost a matter of course.

Representations that plaintiff has retired.

A person who has been a member or employé of a firm of reputation, and who sets up in business on his own account, is entitled to derive what benefit he may from a fair statement of the fact of his former employment (c),

Former firm or employer may be stated.

(a) See *Selby v. Anchor Tube Co.*, W. N. 1877, p. 191.

(b) *Harper v. Pearson*, 8 L. T. N. S. 547; also *Scott v. Scott*, *ubi supra*; and *Stevens v. Paine*, 18 L. T. N. S. 600. And as to a representation of one business being a continuation of another, see *Churton v. Douglas*, Johns. 174; *Burrows v. Foster*, Seton, 4th ed. 257; *Witt v. Corcoran*, *ib.* 257; *Gravley v. Win-*

chester, *ib.* 257; *Montague v. Moore*, *ib.* 238; *Selby v. Anchor Tube Co.*, W. N. 1877, p. 191.

(c) See per Sir W. P. Wood, V.-C., in *Leather Cloth Co. v. American Leather Cloth Co.*, 1 H. & M. 271; also *Clark v. Leach*, 32 Beav. 14; and cases *infra*. But see *Selby v. Anchor Tube Co.*, W. N. 1877, p. 191.

which is usually expressed by the addition after his own name of the name of his former firm or employer, with the words "late of," or "late with." But such statement must be made in an unambiguous way, and not in such a manner as to induce the belief that the tradesman in question is selling the goods of his former firm or employer. For the purposes of the plaintiff's right to relief it is a matter of indifference whether or not the defendant has acted with a fraudulent intention; if what he has done is, though unintentionally, calculated to deceive "the unwary, the heedless, the incautious portion of the public" (a), the plaintiff is entitled to protection just as much as if there were intentional fraud.

Glenny v. Smith.

In *Glenny v. Smith* (b), the defendant, who had been in the plaintiff's service, opened a shop in Oxford Street, where he placed his own name over the door, but on the brass plates and on the awning the words, "from Thresher and Glenny," "from" being in much smaller letters than the plaintiff's name. It further appeared that the defendant's own name over the door was quite hidden when the awning was let down. Sir R. T. Kindersley, V.-C., granted an injunction (c).

Hookham v. Pottage.

In *Hookham v. Pottage* (d), the parties had been tailors in partnership at Oxford, the defendant having been formerly the plaintiff's manager, and afterwards taken into partnership by him. On the dissolution of the partnership it was arranged that the plaintiff was to continue the business, the defendant receiving from the plaintiff such an amount as should be found to be due to him. The plaintiff, in continuing the business, styled himself, "Hookham & Co.," and the defendant, setting up close to him, put over his shop, "S. Pottage, from Hookham & Pottage."

(a) V.-C. Kindersley, in *Glenny v. Smith*, 2 Dr. & Sm. 476.

(b) *Ubi supra*.

(c) See, too, *Burgess v. Burgess*, 3 De G. M. & G. 89; and *Colton v.*

Thomas, 2 Brewster, 308; R. Cox 507.

(d) L. R. 8 Ch. 91. And see *Selby v. Anchor Tube Co.*, W. N. 1877, p. 191.

There was some evidence of deception, and Sir R. Malins, V.-C., granted an injunction, which decision was upheld by the Court of Appeal.

In *Foot v. Lea* (a), an older case, the Master of the Rolls Other cases. in Ireland was of opinion that there was no attempt to deceive on the part of the defendant, who had used show-boards and labels on which his own name was followed by "late of Lundy Foot & Co.," the latter name being of equal size with the defendant's, and he accordingly refused the injunction, with leave to bring an action at Law. In *Williams v. Osborne* (b), Sir W. P. Wood, V.-C., was of a similar opinion, and dismissed the bill, and, on account of the extreme haste with which it had been filed, with costs. In a very recent case (c), the defendants, who had been forewomen in the plaintiff's shop in Paris, used on their window blinds, in Bond Street, the words "Ex 1^{eres} de la," in small letters, followed by "Maison Boissier de Paris," in large letters, to signify their former employment; and although V.-C. Malins declined to restrain the use of those words, notwithstanding that they were not generally understood in London as equivalent to "From," he left the defendants to pay their own costs.

Deception of the same kind will be restrained when what is imitated is not a name of an individual or firm, Name of establishment. but a designation of the place at which the business of an individual or firm is carried on, and by which it is known and recognised. Thus, "Osborne House" (d), "The Carriage Bazaar," &c. (e). But in such cases the plaintiff must prove that the result of the defendant's acts is calcu-

(a) 13 Ir. Eq. 490.

(b) 13 L. T. N. S. 498.

(c) *Robineau v. Charbonnel*, W. N. 1876, p. 160.

(d) *Hudson v. Osborne*, 89 L. J. Ch. 79.

(e) *Boulnois v. Peake*, W. N. 1868, p. 95. And see *Cave v. Myers*, Seton, 4th ed. 238. In an American case, *Genin v. Chadsey*, cited in *Dixon*

Crucible Co. v. Guggenheim, R. Cox, 567, an injunction was granted to the proprietor of "The Captain's Live - and - Let - Live Oyster and Dining Saloon," to restrain a person who had set up "G. W. Chadsey & Co's Great Eastern Live-and-Let-Live Dining Saloon." See, too, *Glen & Hall Manufacturing Co. v. Hall*, 16 Sickles, 226.

lated to represent his business as identical with the plaintiff's, and that there is something distinctive about the appellation of his own establishment (a).

Hotel.

In America the same principle has been extended to hotels, and a proprietor of one already established has been held entitled to protection against the setting up of hotels in the same neighbourhood under a similar title. Thus, "The Irving House," "The What Cheer House," and "The McCardel House" have been protected (b). And not only the proprietors of such establishments have been protected in respect of the names by which they have been known, but other persons who have contracted with such proprietors for the exclusive conveyance of visitors to and from their hotels have been held entitled to restrain the use by others not so authorized upon their vehicles and servants' clothing of the name of the establishment with which they were connected (c).

Name not
trade name.

Closely connected with the cases which concern the rights of an individual or firm in the trade name under which his or their business is carried on, are the cases in which it has been sought by one person to restrain the unauthorized use of his name by another, though he does not himself use that name over a shop, or, in fact, as a trade name usually so called.

Libel.

The first point in cases of this description is that such an improper use by one person of the name of another person as to amount to a libel upon that other person raises a question which must be decided by the verdict of a jury. Lord Cottenham, C., said (d) that the Libel Act

(a) Thus, in *Choynski v. Cohen*, 39 Cal. 501, R. Cox, 593, it was held that there was nothing in the title "The Antiquarian Book Store" to entitle its proprietor to an injunction against "The Antiquarian Book and Variety Store."

(b) *Howard v. Henriques*, 3 Sand. S. C. 725; R. Cox, 129;

Woodward v. Lazar, 21 Cal. 448; R. Cox, 800; *McCardel v. Peck*, 28 How. Pr. R. 120; R. Cox, 312.

(c) *Stone v. Carlan*, 18 Mo. L. R. 360; R. Cox, 115; *Marsh v. Billings*, 7 Cush, 322; R. Cox, 118. And compare *Knott v. Morgan*, 2 Keen, 213.

(d) *Fleming v. Norton*, 1 H. L. C. 376. This case was a Scotch one