

in the possession of wharfingers, it was held by the Court of Appeal that they were entitled to their costs of being made defendants to an action for infringement, notwithstanding that they had submitted to act as the Court should direct only upon having their charges and costs paid or provided for (*a*).

Relief
refused,
no costs.

On the other hand, while the relief claimed by the plaintiff is refused, the defendant may still be left to pay his own costs, as where the plaintiff has lost his remedy by lapse of time (*b*), or improper use of the word "patentee" (*c*), or other similar reasons (*d*), 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 (*e*). Thus, where the Vice-Chancellor considered that the defendant had acted fraudulently, but thought himself bound by a decision of the Court of Appeal on the motion to dismiss the bill, he did so without costs (*f*). Where the defendant had filled with his own lime-juice bottles brought to him for the purpose, though they were stamped with the plaintiff's name, and the plaintiff brought an action, making charges which amounted to fraud, but which the Court did not consider to be justified, though the defendant had done that which he was not entitled to do, and the defendant gave an undertaking not to repeat the offence, no order was made, and each party was left to pay his own costs (*g*).

(*a*) *Moet v. Pickering*, 8 Ch. D. 372.

(*b*) *Rodgers v. Rodgers*, 31 L. T. N. S. 285; *Ripley v. Bandy*, 14 P. R. 591.

(*c*) *Nixey v. Roffey*, W. N. 1870, p. 227. And where a plaintiff company was held to be disentitled to an injunction by reason of the wrongful use of the word "patent," and the defendant, as having been the company's manager, was in some sense responsible for this, he was deprived of the costs which would otherwise have been given him: *Leather Cloth Co. v. Lonsont*, L. R. 9 Eq. 345.

(*d*) *E.g.*, *Fetridge v. Wells*, 13 How. Pr. 385; *R. Cox*, 180.

(*e*) *Edgington v. Edgington*, 11 L. T. N. S. 299; *Bass v. Dawber*, 19 *ib.* 626; *Ainsworth v. Walmsley*, L. R. 1 Eq. 518; *Wylam v. Clarke*, W. N. 1876, p. 68; *Robineau v. Charbonnel*, *ib.* p. 160; *Borthwick v. Evening Post, Ltd.*, 37 Ch. D. 449; *Thorneloe v. Hill*, (1894) 1 Ch. 569. And see *Newman v. Pinto*, 4 P. R.

508, and *Lever v. Bedingsfield*, 16 P. R. 3, where defendants who succeeded in the Appeal Court were left to pay their own costs of the action though allowed the costs of the appeal. See *Humphries v. Taylor Drug Co.* (2), 59 L. T. N. S. 820; also *Talcott v. Moore*, 13 N. Y. Sup. Ct. 106; *Degraves v. Whiteman*, 5 V. L. R. Eq. 304; *Hop Bitters Manufacturing Co. v. Luke*, 10 V. L. R. (E.) 234.

(*f*) *Wotherspoon v. Currie*. See L. R. 5 H. L. 510.

(*g*) *Rose v. Loftus*, 47 L. J. Ch. 576. And see *Perks v. Hall & Co.*, W. N. 1881, p. 111. So in N. S. W., where the successful party had untruly marked his goods as if the mark were registered: *Harris v. Ogg*, 5 N. S. W. Rep. (E.) 114. As to costs where fraud is charged but not made out, see *Baker v. Rawson*, 45 Ch. D. 519, 536; and *Hargreave v. Freeman*, (1891) 3 Ch. 39.

The costs of interlocutory proceedings are usually made costs in the cause (a).

In some cases a portion only of the relief asked for has been granted, and the costs have either been apportioned in a manner corresponding to the amount of success achieved, or each party has been left to pay his own costs. Thus, 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 (b). In *Day v. Neale* (c) no costs were given on either side, the plaintiffs having asked for an injunction in respect of several trade marks, in only two of which they had an exclusive right, and having delayed to take proceedings for more than two years, while the defendants were in the wrong as to the two marks. In *Metsler v. Wood* (d), the plaintiffs, who succeeded on the main question of imitation of the title of their publication, were deprived of half their costs, on the ground of their having made claims as to copyright which failed. Where a plaintiff succeeded in establishing a limited right in a word, and also that the defendant had acted fraudulently, but failed to show a general right in the word, and that certain labels used by the defendant were deceptive, the defendant was ordered by the Irish Court to pay the general costs of the suit, but the plaintiff was ordered to pay and set off against his own costs the costs of all the affidavits of the defendant's witnesses (except that of the defendant himself), since they had been addressed to the part of the case on which the plaintiff failed (e). On the other hand, where an action was brought for infringement of trade mark and for passing off, and fraud was proved on the part of the defendant, but infringement of trade mark was not proved, the defendant was ordered to pay the whole of the costs (f); but in another similar case the plaintiff was allowed his costs of the action except so far as they had been increased by the claim in respect of the trade mark (g). In a Bombay

Apportionment of costs.

(a) For example, see *Isaacson v. Thompson*, 41 L. J. Ch. 101; *Brook v. Evans*, 2 L. T. N. S. 740; *Wallis v. Wallis*, 4 Dr. 458.

(b) *Compagnie Laferme v. Hendrickx*, Dig. 512. And see *Jackson & Co. v. Napper*, 35 Ch. D. 162; and *Baker v. Rawson*, 45 ib. 519, 536.

(c) Bacon, V.-C., May 24th, 1881.

(d) 8 Ch. D. 606.

(e) *Wheeler v. Johnston*, 3 L. R. Ir. 284.

(f) *Rowland v. Mitchell*, 13 P. R. 457; *Hodgson v. Kynoch, Ltd.*, 15 ib. 465.

(g) *Lever v. Bedingsfield*, 15 P. R. 453.

case (a), in which six marks were in question, and the defendants succeeded as to all but one, which they had offered to give up within six days after the commencement of the suit, it was held that the defendants must only pay their own costs with regard to that mark, and one-sixth of the plaintiffs' costs up to and including the day on which the offer was made, and that all the remaining costs of both parties must be paid by the plaintiffs. Where a defendant had untruly alleged that he was the first to use a word in dispute, and that the plaintiff had copied from him, no costs were given, though the action was dismissed (b).

Costs of unfounded charges, &c.

If a plaintiff makes a charge 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 (c). 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 (d). So if he unsuccessfully persists in his claim for damages after the defendant has submitted to an injunction, he must pay the costs of such claim (e).

Scale of costs when defendant submits.

When a defendant in a trade mark action submits to a perpetual injunction with costs, the mere fact of his having submitted constitutes no special ground, under R. S. C., 1883, Order LXV. r. 9, for directing the costs to be taxed on the higher scale, but in such a case the Court will refuse to punish him for submitting at once, and will leave the costs to be taxed on the lower scale (f). But there may be cases in which costs will be given on the higher scale—*e.g.*, where the action has been fought out at great length (g).

Costs of motion to commit.

A motion to commit for breach of an injunction is not unfrequently made without any expectation of obtaining an order for

This case was, however, reversed on the facts, and judgment was entered for the defendants without costs. 16 P. R. 3.

(a) *Wallace & Co. v. King & Co.*, Bombay High Ct., April 30th, 1879.

(b) *Humphries v. Taylor Drug Co.* (2), 59 L. T. N. S. 820.

(c) *Pierce v. Franks*, 15 L. J. Ch. 122; *Standish v. Whitwell*, 14 W. R. 512; *Wylam v. Clarke*, W. N. 1876, p. 68; *Saxlehner v. Apollinaris Co.*, (1897) 1 Ch.

893; *Pneumatic Rubber Stamp Co. v. Lindner*, 15 P. R. 525.

(d) *Nunn v. D'Albuquerque*, 34 Beav. 595.

(e) *Magnolia Metal Co. v. Atlas Metal Co.*, 14 P. R. 389; *Hipkins v. Plant*, 15 *ib.* 294.

(f) *Hudson v. Osgerby*, 50 L. T. N. S. 323. But see *Grezier v. Ziemer*, 89 L. T. (Journal) 117.

(g) *Great Tower Street Tea Co. v. Smith*, 6 P. R. 165. But see *In re Apollinaris Co.*, (1891) 2 Ch. 186, 236.

actual committal, but the defendant can only be ordered to pay the costs of such a motion if the facts would have warranted a committal (a). But where an order for committal was rescinded by the Court of Appeal, no costs were given the defendant, on account of the equivocal conduct of some of his agents (a). Where a motion to commit was dismissed on the ground of delay, as well as that the actual terms of the injunction had not been disobeyed, though its spirit had been, Wood, V.-C., while refusing the motion, enlarged the injunction and made the defendant pay the costs (b). In a case in which the Supreme Court of New York had fined a defendant for contempt, the Court of Appeals, while considering itself bound by the decision of the Supreme Court as to the fact of the breach, yet thought the decision so doubtful that it gave no costs of the appeal (c).

The costs of appeals are usually governed by the same principle as those in the Courts of First Instance, and follow the event. Thus, in *McLean v. Fleming* (d), in which the U. S. Circuit Court considered the plaintiff to be entitled to an injunction and an account, but the Supreme Court reversed the decision with respect to the account, on the ground of the plaintiff's own laches, it was held that the plaintiff must have his costs in the Court below, but the defendant (appellant) his costs of the appeal. The costs of an unnecessary appeal must be paid by the appellant. Thus, 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 (e). And where, in an action for imitation of the name of the plaintiffs' journal, the plaintiffs brought on an appeal from the decision of the judge directing the motion for an injunction to stand to the hearing, after the defendants had changed the name of their publication, the plaintiffs were ordered to pay the costs of the appeal, notwithstanding that the defendants had refused to submit to an injunction, or to give an undertaking as to their original title (f). In *Newman v. Pinto* (g) the plaintiff, who had succeeded in the Court

Costs of
appeals.

(a) *E.g.*, *Dence v. Brand*, W. N. 1881, p. 31.

(b) *Cartier v. May*, Dig. 200.

(c) *Devlin v. Devlin*, 69 N. Y. 212.

(d) 96 U. S. 245.

(e) *Upmann v. Elkan*, L. R. 7 Ch. 130.

(f) *Dale v. Smith*, W. N. 1882, p. 145.

(g) 4 P. R. 508. Cf. *Lever v. Beddingfield*, 16 P. R. 3.

of First Instance, was held by the Court of Appeal to be disentitled to relief on the ground of misrepresentations contained in his trade mark; but the defendants, who had used the same trade mark, containing the same misrepresentations, were not allowed the general costs of the action, but only the costs of the appeal.

Costs in case
of compro-
mise.

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). Although, therefore, 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 (b), yet if he, immediately after the suit is commenced, is offered and may obtain all he seeks, and still thinks proper to go on with the suit, the Court may give him his decree, but will not give him the costs of the suit so unnecessarily prosecuted (c). 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 (d). Thus, 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, Knight Bruce, V.-C., gave the plaintiffs their costs at the hearing, since the defendants ought to have offered, on the injunc-

(a) *Per* Lord Cottenham, O., in *Millington v. Fox*, 3 My. & Cr. 338. See the order made in *Pinto v. Badman*, 8 P. R. 181, 192.

(b) *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. Ch. 586; *R. Cox*, 20; *Radway v. Coleman*, 15 Grant, Up. Can. Ch. 50; *Guardian Fire and Life Assurance Co. v. Guardian and General Insurance Co., Ltd.*, 50 L. J. Ch. 252.

(c) *Per* Wigram, V.-C., in *Colburn v. Simms*, 2 Hare, 560, commenting on *Millington v. Fox*. And see *McAndrew v. Bassett*, 4 De G. J. & S. 380; *Hudson*

v. Bennett, 12 Jur. N. S. 519; *Uppmann v. Elkan*, L. R. 12 Eq. 140; 7 Ch. 130; *Williams v. Osborne*, 13 L. T. N. S. 498; *Slazenger v. Pigott*, 12 P. R. 439.

(d) *Fradella v. Weller*, 2 R. & M. 247; *Kelly v. Hooper*, 1 Y. & C. Ch. 197; *Geary v. Norton*, 1 De G. & S. 9; *Burgess v. Hills*, 26 Beav. 244; *Burgess v. Hatley*, *ib.* 249; *Wallis v. Wallis*, 4 Dr. 458; *Collins' Co. v. Walker*, 7 W. R. 222; *Moet v. Cruston*, 33 Beav. 578; *Nunn v. D'Albuquerque*, 34 *ib.* 595; *Hipkins v. Plant*, 15 P. R. 294; *Coats v. Holbrook*, 2 Sandf. 586; *R. Cox*, 20; *Weed v. Peterson*, 12 Abb. Pr. N. S. 178; *Hutchinson v. Blumberg*, 51 Fed. Rep. 829.

tion 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*). But if an innocent infringer withdraws all marked articles from sale, and offers an undertaking immediately upon being served with the writ, and the plaintiff afterwards moves for an injunction, the motion may be refused with all costs, less the costs of the writ, which will have been incurred before the defendant's offer (*c*). On the other hand, where the infringement is not innocent the plaintiff is not bound to be satisfied with an undertaking (*d*); but where the defendant consents to an order in the terms of the writ to be obtained in chambers, the plaintiff will not be entitled to any additional costs incurred by his bringing the matter into Court (*e*).

It has been thought 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 (*f*); and if he does so, and a fair offer is made, he should not hasten to incur needless expense (*g*), or he may be punished in respect of costs. Lord Romilly, M. R., was, however, of opinion (*h*) 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* (*i*) 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 inquiry at all. In the later case of *Upmann v. Forester* (*k*), Chitty, J.,

Notice to
infringer.

(*a*) *Geary v. Norton*, 1 De G. & S. 9. See *Lochgelly Co., Ltd. v. Lumphinnans Iron Co.*, Ct. Sess. Cas. 4th Ser. VI. 482.

(*b*) *Kelly v. Hooper*, 1 Y. & C. Ch. 197.

(*c*) *Caruncho v. Highmoor*, 27 Sol. J. 199.

(*d*) *Smith v. Carron Co.*, 13 P. R. 108; *Slazenger v. Pigott*, 12 *ib.* 439.

(*e*) *Slazenger v. Pigott*, 12 P. R. 439.

(*f*) *Chappell v. Davidson*, 2 K. & J. 123; *Wallis v. Wallis*, 4 Dr. 458; *Zwentsche Stoom Bleekery Goor v. Ellinger & Co.*, 26 W. R. 70.

(*g*) *Williams v. Osborne*, 13 L. T. N. S. 498. And see the opinion of Jessel,

M. R., cited in *Upmann v. Forester*, 24 Ch. D. 231; and *In re Kuhn & Co.*, 53 L. J. Ch. 238.

(*h*) In *Burgess v. Hatchly*, 26 Beav. 249. In *Field v. Lewis*, Dig. 280, Wood, V.-C., granted an injunction with costs, though no notice had been given before bill filed. And see *Coats v. Holbrook*, 2 Sandf. Ch. 586; R. Cox, 20; and *Sawyer v. Kellogg*, 7 Fed. Rep. 721; 9 *ib.* 601.

(*i*) L. R. 12 Eq. 140; L. R. 7 Ch. 130.

(*k*) 24 Ch. D. 231.

decided in accordance with this opinion, giving costs to a plaintiff who had moved for an injunction without giving any previous notice, though the defendant had acted perfectly innocently, and would have submitted if notice had been given him. And he stated that this was also the opinion of Jessel, M. R. (a). The reason assigned by Chitty, J., for this decision appears to be that, if the plaintiff were to give notice to the defendant, and the defendant were to submit, the plaintiff would lose his costs; but it might be thought that the plaintiff would be sufficiently secured in this respect by the rule above stated, that an offer of submission must, to be effectual, include an offer of all costs occasioned to the plaintiff, and that no injustice would be done to the plaintiff, but a very possible injustice to an innocent defendant might be minimised, by requiring notice to be given. And in *Upmann v. Currey* (b), a case very similar to *Upmann v. Forester* (c), the innocent defendant offered in Court to empty and deliver up or destroy the boxes in which the cigars had been sold to him, and which were labelled (but without his knowledge) in imitation of the plaintiff's boxes, and Smith, J., refused an injunction, and gave no costs on either side. So in *American Tobacco Co. v. Guest* (d), where an action was brought without any previous notice against a retail dealer who had innocently sold a small quantity of infringing goods, and the defendant submitted to an injunction, Stirling, J., made no order as to costs, and expressed his opinion that proceedings ought in the first instance to be taken against those who placed the spurious goods upon the market. In an Irish case (e) where the infringement was not innocent, but the defendants asked for particulars of the acts complained of, and offered to insert any reasonable notices in the newspapers to show that they had no connection with the plaintiffs' firm and to pay the costs, and the plaintiffs took no notice of the offer, it was held by the Master of the Rolls that the plaintiffs, by declining to consider the defendants' suggestions, had lost their right to relief, the defendants having in the meantime inserted advertisements in the

(a) See *per* Jessel, M. R., in *In re Kuhn & Co.*, 53 L. J. Ch. 238; and *Barrett v. Gomm*, 74 L. T. (Journal) 388. Also *Fennessy v. Day*, 55 L. T. N. S. 161. So *Siegert v. Lawrence*, 11 V. L. R. 47, in Victoria.

(b) 29 Sol. J. 735.

(c) 24 Ch. D. 231.

(d) (1892) 1 Ch. 630.

(e) *Valentine v. Valentine*, 31 L. R. Ir. 488.

newspaper disclaiming all connection with the plaintiffs, and the action was dismissed without costs.

A plea of infancy will not excuse an infant infringer from paying the costs which his conduct has occasioned (a). And so with a married woman having separate estate (b). 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 the instrument of his fraud the costs of legal proceedings brought about by the infringement, including any sum which that person may have reasonably paid to compromise the matter (c). Costs occasioned to a third party by defendant's fraud.

(ii.) *In Registration Cases.*

When an application for the registration of a trade mark is opposed and brought before the Court, the costs are usually ordered to be paid by the unsuccessful party, as having been occasioned by his wrongful claim or opposition. Thus, where a claim was made to register and use a trade mark, which would have been an infringement of an existing mark, the persons who wrongly claimed the mark were ordered to pay the costs of cross-adjourned summonses, as well as of an action for an injunction which had been rendered necessary by the claim (d). And in *In re Rosing* (e), the Cutlers' Co. of Sheffield, who had opposed an application in what they believed to be the interest of the public (and whose opposition succeeded in the Court of Appeal), were ordered by V.-C. Bacon to pay the costs of their opposition, which failed before him. Costs in registration cases.

If, on the other hand, each party is partially successful, no costs will be given on either side (f). And where application was made for the registration of a label containing descriptive words, and the applicants disclaimed some of the descriptive words, but not all, and conducted their case on the footing that registration would give them an exclusive right to such words, the Court of Appeal held that though the registration must be granted, and No costs.

(a) *Cory v. Gertken*, 2 Madd. 49; *Chubb v. Griffiths*, 35 Beav. 127; *Woolf v. Woolf*, 43 Sol. J. 127. 24th, 1879. See *Jackson & Co. v. Napper*, 35 Ch. D. 162; *In re Grossmith*, 6 P. R. 180; *In re Burgoyne*, *ib.* 227.

(b) *Nicholls v. Kimpton*, 3 Times L. R. 674. (e) 54 L. J. Ch. 975.

(c) *Dixon v. Fawcus*, 3 Ell. & Ell. 537. (f) *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *In re Rosing*, 54 L. J. Ch. 975;

(d) *Davis v. Tylor*, Jessel, M. R., April *Mouson & Co. v. Boehm*, 26 Ch. D. 398.

would not have the effect of giving any such right, the litigation had nevertheless been caused by the applicants, and no costs could be given them (a). And in *In re Dunn* (b), in which the Court of Appeal reversed the refusal of the Court below to allow registration, they only gave costs of the appeal, and none of the hearing below.

Costs paid by
successful
applicant.

Where an applicant took advantage of the precise wording of the Act of 1875 to obtain registration as a part of his trade mark of words to the exclusive use of which he was not entitled, and the application was unsuccessfully opposed, Jessel, M. R., held that, notwithstanding the success of the applicant, he must still pay the costs of the application, as he was taking advantage of the Act to do that which the Act did not intend him to do (c).

Costs of
comptroller.

Where the comptroller (formerly the registrar) is served with notice of an application to the Court, he is entitled to appear on the hearing of the application, and to receive his costs of so doing, since it is proper that he should know what order is made (d).

When he
opposes.

Where the comptroller opposes an application, and his opposition fails, he will not usually be required to pay the costs of the successful applicant (e); and the rule has in fact been established that the comptroller will generally receive his costs, whether successful or unsuccessful (f), but where the case is a test case, each party may be left to pay his own costs (f). Formerly, it seems that costs might be given against him if he opposed in a case in which the Court pronounced the applicant's mark, not only to be distinct from the mark which the comptroller supposed it to resemble, but to be so distinct that the comptroller was acting wrongly in objecting (g). And in one case (h) in which the comptroller's objection succeeded no costs were given him, because he had not merely submitted the claim to the Court, but had actively disputed it and filed evidence. But no reliance can now be placed on these decisions. If the comptroller refuses to register on the ground of similarity to an earlier mark, and upon an appeal by the applicant to the Court, the proprietor of the earlier mark appears and opposes the applica-

(a) *In re Hudson*, 32 Ch. D. 311. And see *In re Swift Specific Co.*, 6 P. R. 352.

(b) 41 Ch. D. 444.

(c) *In re Maignen*, 28 W. R. 759.

(d) This has been repeatedly so laid down: e.g., *In re Orr-Ewing* (2), 28 W. R. 412.

(e) *In re Rotherham*, 14 Ch. D. 585.

(f) *In re Van Duzer*, 34 Ch. D. 623; *In re Leaf, Sons & Co.*, 34 Ch. D. 632; *In re Farbenfabriken Formals Fried. Bayer & Co.*, (1894) 1 Ch. 645.

(g) *In re Patent Plumbago Crucible Co.*, Jessel, M. R., August 1st, 1879.

(h) *In re Jones Bros.*, Hall, V.-C., July 10th, 1880.

tion, it seems that costs may be given against him if his opposition is unsuccessful (a).

Since, by the terms of the old Rule 16 (b), an opposed application did not stand for the determination of the Court until the comptroller informed the applicant that the opponent had given security, no costs incurred before that point in the proceedings, but only those incurred after it, could formerly be given by the Court or be included in an order to pay costs (c); and it has been held that the Court cannot even now give a successful opponent the costs of the proceedings in the Registry Office, under either § 69 or § 90 of the Patents Act, 1883 (d). In *In re Apollinaris Co.* (e), the Court of Appeal refused to give costs on the higher scale, though the case was one of unusual complexity and difficulty.

Extent of costs.

If a person registers as his property a trade mark to which he is not entitled, he will, as a rule, have to pay the costs of the necessary application to remove it from the register (f), though there may be exceptional cases in which this rule will not be followed: as if the mark was originally his property, but has become common through the common piracy of the trade, and they have delayed to apply for removal for some time after his registration, and have then done so without notice to him, he being a foreigner (g); or if the mark is removed from the register on the application of a person who has copied it, and who has only applied for rectification under stress of an action for infringement (h). Again, where a mark was removed from the register by the Court of Appeal on a ground which had not been raised in the Court below, and the applicant had acted in a fraudulent manner, no costs were given in either Court (i). So, also, a

Costs of application to remove.

(a) *In re Simpson*, L. J. N. of C. 1890, p. 143.

(b) Since repeated in § 69 of the Patents Act, 1883, as amended.

(c) *In re Brandreth*, 9 Ch. D. 618.

(d) *In re Australian Wine Importers, Ltd.*, 41 Ch. D. 278.

(e) (1891) 2 Ch. 186, 236.

(f) *In re Hyde & Co.*, 7 Ch. D. 724; *In re Palmer* (3), 24 *ib.* 504; *In re Kuhn & Co.*, 53 L. J. Ch. 238; *Burland & Co. v. Broxburn Oil Co., Ltd.* (2), 42 Ch. D. 274; *In re Vignier*, 6 P. R. 490; *In re Edge*, 8 *ib.* 207. Where the registered proprietor had given up business, and the benefit of his trade mark was claimed by his mortgagees, and an order was

made in the absence both of the registered proprietor and of the mortgagees for removal of the mark and payment of costs by the mortgagees, the registered proprietor was afterwards added at the instance of the mortgagees as one of the parties to pay costs: *In re Davis*, 14 P. R. 903.

(g) *In re Kuhn & Co.*, 53 L. J. Ch. 238.

(h) *In re Perry Davis & Son*, 5 P. R. 333; *Humphries v. Taylor Drug Co.* (2), 59 L. T. N. S. 820. See *In re Gianacis*, 6 P. R. 467; and *Richards v. Butcher* (2), 8 *ib.* 37, 49.

(i) *Thompson v. Montgomery*, 41 Ch. D. 35. And see *In re Bradley*, 9 P. R. 205.

successful applicant has been deprived of costs on the ground of delay (*a*), and on the ground of the unsatisfactory state of the evidence (*b*). Where an application to remove a trade mark from the register was refused in the Court of First Instance (though subsequently granted on appeal) on the ground that the party applying was not aggrieved at the time of the hearing, though he had been so at the time when the application was made, and until very shortly before the hearing, when a concession was made by the registered proprietor, Kekewich, J., while declining to remove the mark from the register, gave the applicant the costs up to the hearing (*c*). As a rule, a person who fails in an application to rectify will have to pay the costs of the application (*d*). It seems doubtful whether a respondent to an application to rectify, who is served with a notice of discontinuance, can treat such notice as entitling him to get his costs taxed, and therefore the notice should be accompanied by a statement that he shall have his costs (*e*).

Security for costs.

Where a firm of shipowners had been restrained, as carriers, from parting with cases of mineral waters containing bottles alleged to bear infringements of the plaintiffs' labels, and an American resident claimed to be the owner of the goods, and applied for leave to re-ship them to Hamburg, it was held that he must give security for the costs of his application (*f*). And where an application for the registration of a trade mark was made by a foreign resident and opposed, it was held that he must give security for costs, and that, unless he did so within seven days, his application must be refused without further order (*g*). A foreign company will not be required to give security for the costs of proceedings in England with reference to the registration of trade marks, or of an appeal, if it has substantial assets in England available to answer the costs (*h*).

Costs of opposition leading to abandonment of application.

When an application for registration is abandoned after notice of opposition, the comptroller has power to award costs to the opponent (*i*).

(*a*) *In re Talbot*, 11 P. R. 77; 63 L. J. Ch. 264.

(*b*) *In re European Blair Camera Co.*, 13 P. R. 603. And see *In re Thompson*, *ib.* 35.

(*c*) *In re Apollinaris Co.*, (1891) 2 Ch. 186, 199. See 63 L. T. N. S. 162, 168.

(*d*) *In re Atkins Filter and Engineering Co., Ltd.*, 3 P. R. 164.

(*e*) *In re Dyson*, 65 L. T. N. S. 488.

(*f*) *Apollinaris Co. v. Wilson*, 31 Ch. D. 632.

(*g*) *In re Hurter*, W. N. 1887, p. 71. But a registered proprietor residing abroad who desires to oppose a motion for rectification will not as a general rule be required to give security for costs: *In re La Société Anonyme des Verreries de l'Etoile* (1), 10 P. R. 290; cf. *In re La Compagnie Générale d'Eaux Minérales, &c.*, (1891) 3 Ch. 451.

(*h*) *In re Apollinaris Co.*, (1891) 1 Ch. 1.

(*i*) Patents Act, 1883, as amended by the Act of 1888, § 69 (5).

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 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 Patents Act, 1883 (*b*). Cases of true trade mark.

Where, however, there has been a representation that an article made by A. is made by B., 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.

The general principle is, as stated by Turner, L. J., in *Burgess v. Burgess* (*c*), that “no man can have any right to represent his goods as the goods of another person.” “The most obvious way,” said Lord Halsbury, C. (*d*), “in which a man would be infringing the rule laid down by Turner, L. J., is if he were to say in terms,

(*a*) *McAndrew v. Bassett*, 4 De G. J. & S. 380; *Maxwell v. Hogg*, L. R. 2 Ch. 307. See also *In re Leonard & Ellis*, 26 Ch. D. 288.

(*b*) See the Patents Act, 1883, § 77, as amended by the Act of 1888. Also *Edwards v. Dennis*, 30 Ch. D. 454; *In re*

Batt & Co., (1898) 2 Ch. 432.

(*c*) 3 De G. M. & G. 896.

(*d*) *Birmingham Vinegar Brewery Co. v. Powell*, (1897) A. C. 710. And see *Reddaway v. Banham*, (1896) A. C. 199, 204.

'these are the goods manufactured by' a rival tradesman; and it seems to be assumed that unless he says something equivalent to that, no action will lie. It appears to me that that is an entire delusion. By the course of trade, by the existence and technology of trade, and by the mode in which things are sold, a man may utter that same proposition, but in different words and without using the name of the rival tradesman at all. A familiar example, of course, is when, without using any name, by the identity of the form of the bottle, or the form of the label, or the nature of the thing sold in the package, he is making the statement, not in the express words, but in one of those different forms in which the statement can be made by something that he knows will be so understood by the public" (a).

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 (b), 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 (c), "we do not recognize 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 connection with a trade or business is familiar to our law; and any person using that name, after a relative right of this description has been acquired by another, is considered to have been guilty of a fraud, or at least of an invasion of another's right, and renders himself liable to an action, or he may be restrained from the use of the name by injunction." But a man who has never carried on business under a particular name cannot, even though he

(a) And see *Coats v. Merrick Thread Co.*, 149 U. S. 562; *Merriam v. Holloway Publishing Co.*, 43 Fed. Rep. 450; *Putnam Nail Co. v. Bennett*, *ib.* 800; and other cases. See also *Saxlehner v. Apollinaris Co.*, (1897) 1 Ch. 893, where this principle was applied to a case in which the

reputation acquired for the plaintiff's goods was due to the exertions of the defendant.

(b) *Per Wood*, V.-C., in *Churton v. Douglas*, Johns. 174.

(c) *Du Boulay v. Du Boulay*, L. R. 2 P. C. 441

has some kind of right to use that name, interfere with its being used by another. Thus, where the plaintiff was the mortgagee of the goodwill of a business, including the right to use the name under which the business was carried on, but had never exercised his right so to do (a).

There is another kind of trade name besides the trade name which is synonymous with firm name—viz., the trade name which is applied, not to the firm by whom the goods are manufactured and sold, but to the goods themselves; and it was with immediate reference to a trade name of this description (b), though the principles laid down by him are equally applicable to both classes of trade names, that Lord Blackburn (c), after referring to frauds committed by the infringement of trade marks, went on to say: “There is another way in which goods not the plaintiff’s may be sold as and for the plaintiff’s. A name may be so appropriated by user as to come to mean the goods of the plaintiff, though it is not, and never was, impressed on the goods or on the packages in which they are contained, so as to be a trade mark, properly so called, or within the recent statutes. Where it is established that such a trade name bears that meaning, I think the use of that name, or one so nearly resembling it as to be likely to deceive, as applicable to goods not the plaintiff’s, may be the means of passing off those goods as and for the plaintiff’s, just as much as the use of a trade mark; and I think the law (so far as not altered by legislation) is the same. And I think it settled by a series of cases that both trade marks and trade names are in a certain sense property, and that the right to use them passes with the goodwill of the business to the successors of the firm which originally established them, even though the name of that firm be changed so that they are no longer strictly correct.”

Name by which goods identified.

It cannot be said to be generally admitted that a right of property can be acquired in a trade name. The present Vice-Chancellor of Ireland said (d), “it has been repeatedly held that

Property in trade name questioned.

(a) *Beazley v. Soares*, 22 Ch. D. 660.

(b) “Singer” sewing machines.

(c) In *Singer Manufacturing Co. v. Loog* (3), 8 App. Cas. 15. And see *Reddaway v. Banham*, (1896) A. C. 199; *Grezier v. Autran*, 13 P. R. 1; *Rockingham Rail. Co. v. Allen*, 12 Times L. R. 345; *Powell v. Birmingham Vinegar Brewery Co.*, (1896) 2 Ch. 54; (1897) A. C. 710; *Coventry Machinists’ Co. v. Helsby*,

13 Times L. R. 92; *ib.* 161; *Edge & Sons, Ltd. v. Gallon*, 15 P. R. 689; *Nova Stearine Co. v. Mowling*, 9 V. L. R. (E.) 98; *Noera v. Williams’ Manufacturing Co.*, 158 Mass. 110; *Cady v. Schultz*, 19 R. I. 193; 61 Am. St. Rep. 763.

(d) *Bodega Co., Ltd. v. Owens*, 6 P. R. 236. And see *Reddaway v. Banham*, (1896) A. C. 199, 209, 210, *per* Lord Herschell.

there is no property in the name of a firm, or of an individual, or of a place of business; and that the only right of an individual or firm to the sole use of a trade name, as distinguished from a trade mark, is this, that when a name has become identified, by adoption and user, with a particular trade or manufacture or business, the person who has so used or adopted it can obtain the aid of this Court to restrain the use of it by others in such a way as to lead customers or the public to think that the trade or business of the person so using it is his trade or business." And he went on to say that in a registered trade mark there is a larger right. The distinction, however, does not appear to be of much practical importance, as it is now admitted on all hands that if a trade name is so imitated as to render deception probable, relief will be granted, and the test of infringement of a trade mark, in which the right of property is undoubted, is the production of such a probability of deception (a).

Unregistered
trade name
protected.

The non-registration of trade names of the kind primarily referred to by Lord Blackburn is no bar to an action for the wrongful imitation of them (b); and where a trade mark consisting of the words "Stone Ale" alone had been expunged from the register as not being registrable, an injunction to restrain the use of those words was nevertheless granted (c), and the same thing happened with respect to the words "Yorkshire Relish" (d).

*Reddaway v.
Banham.*

The recent case of *Reddaway v. Banham* (e), has established (f) that a name which in its primary sense is a correct description of

(a) *Per* Lord Westbury, in *Hall v. Barrows*, 4 De G. J. & S. 150. And see *Curtiss v. Messler*, 13 A. L. T. 127; *Crawford v. Bernard*, 11 P. R. 580; *Cady v. Schultz*, 19 R. I. 193; 61 Am. St. Rep. 763.

(b) *In re Sanitas Co., Ltd.*, 4 P. R. 533; *Reddaway v. Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; *Ino v. Dunn*, 10 P. R. 261; *Huntley & Palmer v. Reading Biscuit Co.*, *ib.* 277; *Reddaway v. Banham*, (1896) A. C. 199; *Rockingham Rail. Co. v. Allen*, 12 Times L. R. 345; *Daniel v. Whitehouse*, (1898) 1 Ch. 685; *Bowlay & Co. v. Hughes*, 15 P. R. 290.

(c) *Thompson v. Montgomery*, 41 Ch. D. 35; (1891) A. C. 217; *Thompson v. Bent's Brewery Co.*, 8 P. R. 479; *In re Thompson*, 13 *ib.* 35. And see *Magnolia Metal Co. v. Atlas Metal Co.*, 14 *ib.* 389; and *In re Magnolia Metal Co.*, (1897) 2 Ch. 371; *Godillot v. American Grocery Co.*,

71 Fed. Rep. 873; and *Sparks v. Harper*, 3 Queens. L. J. 158, 201. See also *Bayer v. Baird*, 15 P. R. 615, where a disclaimer of the exclusive right to certain initials as part of a trade mark was held in Scotland to be no bar to an action to restrain a rival trader from using those initials in such a way as to pass off his goods as the goods of the plaintiff. But see *Rosenthal v. Reynolds*, (1892) 2 Ch. 301; and compare *Packham & Co. v. Sturgess & Co.*, 15 P. R. 669.

(d) *In re Powell*, (1893) 2 Ch. 388; *Powell v. Birmingham Vinegar Brewery Co.*, (1896) 2 Ch. 54; (1897) A. C. 710.

(e) (1896) A. C. 199.

(f) This is quite in accordance with the cases relating to geographical words, e.g., "Glenfield Starch" (*Wotherspoon v. Currie*, L. R. 5 H. L. 508); "Stone Ale" (*Thompson v. Montgomery*, (1891) A. C. 217).

the goods to which it is applied, may acquire in the trade a technical signification identifying it with the goods of a particular manufacturer, so as to be entitled to protection upon the principles above stated. In that case the plaintiff had for many years manufactured a belting from yarn consisting mainly of camel's hair and sold it under the name of "camel hair belting." The defendant, who was formerly in the employment of the plaintiff, afterwards manufactured a similar belting on his own account, and sold it under the same name, and the correspondence showed that he did this *malâ fide*. The jury found that the phrase "camel hair belting" meant camel hair belting made by the plaintiff as distinguished from belting made by other manufacturers, and did not mean belting of a particular kind without reference to the maker, and that the defendant so described his belting as to be likely to mislead purchasers into buying his belting for the plaintiff's. Upon these findings, Collins, J., granted an injunction. This judgment was reversed by the Court of Appeal on the ground that a manufacturer could not be restrained from calling his goods by a name which correctly described them, but when the case came before the House of Lords the original judgment was restored. Lord Halsbury, C., after referring to the principle of law laid down by Turner, L. J., in *Burgess v. Burgess (a)*, said: "How far the use of particular words, signs, or pictures, does or does not come up to the proposition which I have enunciated in each particular case must always be a question of evidence, and the more simple the phraseology, the more like it is to be a mere description of the article sold, the greater becomes the difficulty of proof (b); but if the proof establishes the fact the legal consequences appear to follow." Lord Herschell dealing with the same point said: "The name of a person or words forming part of the common stock of language, may become so far associated with the goods of a particular maker that it is capable of proof that the use of them by themselves without explanation or qualification by another manufacturer, would deceive a purchaser into the belief that he was getting the goods of A., when he was really getting the goods of B. In a case of this description the mere proof by the plaintiff that the defendant was using a name,

(a) 3 De G. M. & G. 896. See *ante*,
p. 247.

15 P. R. 581, affirmed by the House
of Lords, Times, April 28th, 1899.

(b) See *Cellular Clothing Co. v. Riley*,

word, or device which he had adopted to distinguish his goods would not entitle him to any relief (a). He could only obtain it by proving further that the defendant was using it under such circumstances or in such manner as to put off his goods as the goods of the plaintiff. If he could succeed in proving this, I think he would, on well established principles, be entitled to an injunction. In my opinion, the doctrine on which the judgment of the Court of Appeal was based, that where a manufacturer has used as his trade mark a descriptive word, he is never entitled to relief against a person who so uses it as to induce in purchasers the belief that they are getting the goods of the manufacturer who has theretofore employed it as his trade mark, is not supported by authority, and cannot be defended on principle." Lord Herschell then dealt with the view taken by the Court of Appeal, that the defendants could not be liable to an action because in using the words "camel hair" in connection with their belting they were simply telling the truth. As to that he said: "I think the fallacy lies in overlooking the fact that a word may acquire in a trade a secondary signification differing from its primary one, and that if it is used to persons in the trade who will understand it, and be known and intended to understand it in its secondary sense, it will none the less be a falsehood that in its primary sense it may be true." But it seems that where a name primarily descriptive is accepted by the majority of the trade as a trade name for the goods of a particular manufacturer, but is known to a respectable minority solely in its primary sense, it may be considered no presumption will be raised against a trader from the mere use of the name as descriptive of the goods which he offers for sale (b).

Fraud not
necessary to
be proved.

It was formerly sometimes supposed, and was held by Sir G. Jessel, M. R., and the Court of Appeal, in *Singer Manufacturing Co. v. Wilson* (c), that for an action to restrain the use of a trade name to be successful fraud must be proved, on the ground that, when a trade mark was once affixed to the goods, it passed with the goods from hand to hand, thus silently repeating to each successive purchaser the original misrepresentation of the original

(a) See *Parsons v. Gillespie*, (1898) A. C. 239; *Cellular Clothing Co. v. Riley*, 15 P. R. 581; affirmed by the House of Lords, Times, April 28th, 1899; *Wanser & Co., Ltd. v. Armstrong & Co.*, 16 P. R. 167; *A. W. Gamage, Ltd. v. H. E. Ran-*

dall, Ltd., *ib.* 185.

(b) *Cellular Clothing Co. v. Riley*, 15 P. R. 581; affirmed by the House of Lords, Times, April 28th, 1899.

(c) 2 Ch. D. 434.

infringer, while the improper use of a name not affixed to the goods was not the necessary consequence of being in possession of marked goods, but was the individual act of each person who used it in respect of the goods; so that there might be held to be an infringement of a trade mark when, in analogous circumstances, there would be no infringement of a trade name. And when the case of *Singer Manufacturing Co. v. Wilson* was remitted by the House of Lords to the Court of First Instance (a), on the ground of insufficiency of evidence, some of the law peers seem to have thought that different principles of law might possibly be applicable to trade marks and trade names. But Lord Cairns, C. (b), said: "It may well be that if an imitated trade mark is attached to the article manufactured, there will from that circumstance be the certainty that it will pass into every hand into which the article passes, and be thus a continuing and ever present representation with regard to it; but a representation made by advertisements that the articles sold at a particular shop are articles manufactured by A. B. (if that is the legitimate effect of the advertisements, which is a separate question) must, in my opinion, be as injurious in principle, and may possibly be quite as injurious in operation, as the same representation made upon the articles themselves." And in *Singer Manufacturing Co. v. Loog* (c), Lord Blackburn took the view that the law of trade marks and trade names when not affected by legislation was the same.

Whether there is or is not property in a trade name, as Lord Blackburn suggested (d), 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 (e). The question is not whether the defendant's business is represented as being similar to the plaintiff's, but whether it is represented as being that very identical business (f). If such a false representa-

False representation sufficient.

(a) 3 App. Cas. 376.

(b) *Ib.* 389. And see *Bodega Co., Ltd. v. Owens*, 6 P. R. 236; 7 *ib.* 31; and *Reddaway v. Bentham Spinning Co.*, (1892) 2 Q. B. 639; *Powell v. Birmingham Vinegar Brewery Co.*, (1896) 2 Ch. 54; (1897) A. C. 710.

(c) 8 App. Cas. 15. See *Bowman v. Floyd*, 85 Mass. 76; *New England Awl &*

Needle Co. v. Marlborough Awl & Needle Co., 168 Mass. 154; *Cady v. Schultz*, 19 R. I. 193; 61 Am. St. Rep. 763.

(d) And see *per* the Court of Session in *Singer Manufacturing Co. v. Kimball & Morton*, Ct. of Sess. Cas. 3rd Ser. XI. 267; also *Boulnois v. Peake*, 13 Ch. D. 513.

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

(f) *Cruttwell v. Lye*, 17 Ves. 335;

tion has been made, whatever may have been the motive of the persons making it, when proceedings are taken in consequence of it, "all the Court requires is to be satisfied that the names are so similar as to be calculated to produce confusion between the two—so calculated to do it that, when it is drawn to the attention of those adopting the name complained of that that would be the result, it is not honest for them to persevere in their intention, though originally the intention might not have been otherwise than honest" (a).

Act originally innocent may become fraudulent.

"The question is this," said Cotton, L. J., in the Court of Appeal (b),—"whether the defendant has represented that the goods manufactured by him were manufactured by the plaintiffs, or whether he has done anything calculated so to represent. I quite agree that it is unnecessary that a fraudulent intention in issuing the circulars complained of should be established. If the natural consequence of those things, even in circumstances not known to him, is that they will represent the goods to be those of another person, it is wrongful, and, as this Court says, a fraud in him, to continue the user after those circumstances are brought to his knowledge. We must consider whether he has represented, or done that which is reasonably calculated to give that misrepresentation." In the same spirit, Wood, V.-C., had laid down long previously (c) that if the plaintiffs had represented to the defendants that the course which the latter had been taking was calculated to deceive the public, and, "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 Court, the Court would be justified in saying that that which was not fraudulent at first became so by the defendants' persisting in

Churton v. Douglas, Johns. 174; *Civil Service Supply Association v. Dean*, 13 Ch. D. 512; *Hirsch v. Hirsch & Co.*, 80 L. T. (Journal) 283; *Magnolia Metal Co. v. Tandem Smelting Co.*, 15 P. R. 701. See *Manchester Brewery Co. v. North Cheshire & Manchester Brewery Co.*, (1898) 1 Ch. 539, where an injunction was granted restraining the defendant company from using a name which suggested that the plaintiff company had been amalgamated with them.

(a) *Per James, L. J.*, in *Hendriks v. Montagu*, 17 Ch. D. 638. And see *Manchester Brewery Co. v. North Cheshire &*

Manchester Brewery Co., (1898) 1 Ch. 539; *Bayer v. Baird*, 15 P. R. 615.

(b) In *Singer Manufacturing Co. v. Loog* (3), 18 Ch. D. 417.

(c) In *Williams v. Osborne*, 13 L. T. N. S. 498. And see *McAndrew v. Bassett*, 4 De G. J. & S. 380; *Bodega Co., Ltd. v. Owens*, 6 P. R. 236; *Huntley & Palmer v. Reading Biscuit Co.*, 10 P. R. 277; *In re Paine* (2), (1893) 2 Ch. 567; *Pinet v. Maison Pinet* (2), (1898) 1 Ch. 179; *Bayer v. Baird*, 15 P. R. 615; *Magee Furnace Co. v. Le Barron*, 127 Mass. 115; and *Holt v. Menendez*, 128 U. S. 182.

the same course, and that therefore the plaintiffs would be entitled to the relief they claimed."

The circumstances must, however, be such as to satisfy the Court that deception is probable, and where that is not adequately made out, relief will be refused. Thus, in *Goodfellow v. Prince (a)*, a London wine merchant agreed with a firm of French wine growers to import from them a particular growth of champagne under a label bearing the assumed name "Le Court et C^{ie}, Reims," and sold considerable quantities of wine in England under the label, and another London wine merchant began to import champagne from a different French grower and to sell it in England under a label also bearing the assumed name of "Le Court et C^{ie}"; and it was held by the Court of Appeal that, whether the use of the name by the defendant might or might not represent that his wine was manufactured by the same French grower who manufactured the plaintiff's wine, there was nothing to show that it represented that the wine was imported by the same importer. And in *Bodega Co., Ltd. v. Owens (b)*, the V.-C. of Ireland held on motion that, there being in Ireland only one establishment of the plaintiff company known as a Bodega, which was in Dublin, there was no such probability of deception, if the defendant were allowed to open a "Bodega" in Belfast, as to call for an injunction to prevent the latter from so doing. But at the hearing of the action, on further evidence, an injunction was granted.

But deception must be probable.

Lapse of time may be material in considering whether deception is probable. Thus, where the Marquis of Londonderry and his predecessors in title, owners of the Londonderry collieries in the county of Durham, had for many years been in the habit of selling their coal in London, wholesale but not retail, and the defendant, a coal merchant, had, with the knowledge of the Marquis and his predecessors in title, been in the habit, since 1861, of selling retail a particular quality of coal, not obtained from the Londonderry collieries, under the name of "Londonderry Wallsend," or "Londonderry W. E.," and the Marquis had begun in February, 1885, to sell retail in London coal got from a particular seam under the name of "Londonderry Wallsend," an injunction to restrain the defendant from selling his coal by the names which he had been accustomed

This may be affected by lapse of time.

(a) 35 Ch. D. 9. And see *California Fig Syrup Co. v. Taylor Drug Stores*, 14 P. R. 564; *Attenborough v. Jay*, 14 Times

L. R. 439. Cf. *Richards v. Butcher* (1), 7 P. R. 288.

(b) 6 P. R. 236; 7 *ib.* 31.

to use was refused, on the ground that, having regard to the lapse of time, there was no misrepresentation, notwithstanding that the plaintiff's title formed part of the names, and that he was the owner of the Londonderry collieries (a).

Evidence of intention to deceive, when superfluous.

If in an action to restrain the use of a trade name the defendant's goods, on the face of them, and having regard to the surrounding circumstances, are calculated to deceive, "no evidence is required to prove the intention to deceive, nor ought time and money to be expended on any such defence. The sound rule is that a man must be taken to have intended the reasonable and natural consequences of his acts, and no more is wanted. If, on the other hand, a mere comparison of the goods, having regard to the surrounding circumstances, is not sufficient, then it is allowable to prove from other sources that what is or may be apparent innocence was really intended to deceive" (b).

Name of company.

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 probability of deception 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 (c), 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 (d), and by the London Assurance Company against The London and Westminster Assurance Corporation, Limited (e), the injunction was simply refused. In *Lee v. Haley* (f) the plaintiffs were coal merchants, trading under the name of The Guinea Coal

(a) *Marquis of Londonderry v. Russell*, 3 Times L. R. 360. And see *Ford v. Foster*, L. R. 7 Ch. 611, 628, per Mellish, L. J.

(b) *Saxlehner v. Apollinaris Co.*, (1897) 1 Ch. 893, per Kekewich, J. And see *Von Mun v. Frash*, 56 Fed. Rep. 830; *Martell & Co. v. Paarl Wine & Spirit Co.*, 12 Cape Good Hope, 326.

(c) *London & Provincial Law Assurance Society v. London & Provincial Joint Stock Life Assurance Co.*, 17 L. J. Ch. 37. In *Purser v. Brain*, 17 L. J. Ch. 141, it was held that the circulars of "The London Patent Manure Co." were clearly fraudulent imitations of those of "The London Manure Co.," but the case was sent to a jury for the purpose of deciding whether

the plaintiffs' user of their title had been sufficiently long. And in *Lawson v. Bark of London*, 18 C. B. 84, 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; but Willes, J., remarked that "he was not prepared to say that the defendant would not be liable if the cause of complaint were properly alleged."

(d) *Colonial Life Assurance Co. v. Home & Colonial Assurance Co.*, 33 Beav. 548.

(e) *London Assurance Co. v. London & Westminster Assurance Corporation*, 32 L. J. Ch. 664.

(f) L. R. 5 Ch. 155.

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 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. In a case (a) where

(a) *Brooklyn White Lead Co. v. Masury*, 25 Barb. 416; *R. Cox*, 210. And see *Churton v. Douglas*, Johns. 174. In *Hendriks v. Montagu*, 17 Ch. D. 638, an injunction was granted at the instance of "The Universal Life Assurance Society" to restrain the use of the name "The Universe Life Assurance Association, Ltd.," on the ground of similarity; in *Simpson v. Anglo-Indian Tea Co., Ltd.*, Bacon, V.-C., May 4th, 1883, the defendant company was not allowed to trade under the name which it had taken, which was the same as that under which the plaintiff was trading; in *Guardian Fire & Life Assurance Co. v. Guardian & General Insurance Co., Ltd.*, 50 L. J. Ch. 252, it was held that the defendant company's name was likely to deceive, but that the name of "The Guardian Horse, Vehicle and General Insurance Co." might fairly be taken; in *Capital & Counties Bank, Ltd. v. Capital & County Deposit Bank*, Chitty, J., Feb. 9th, 1884, an injunction was granted to restrain the use of the latter name; in *Accident Insurance Co., Ltd. v. Accident, Disease & General Insurance Corporation, Ltd.*, W. N. 1884, p. 191, Pearson, J., granted an injunction, and on appeal an order was taken by consent, the defendants agreeing to place some other word than "Accident" at the head of their title; in *Thompson v. Improved French Dye-Cleaning & Dyeing Co., Ltd.*, 30 Sol. J. 753, the plaintiff was carrying on business at Brixton as "The French Dyeing & Cleaning Co.," and the defendants were carrying on business in Great Portland Street under the name above, and using the address "Brixton" on their trade papers, and an injunction was granted. So, also, in *Sanitas Co., Ltd. v. Condy*, 4 P. R. 195, 533, in which the plaintiffs were "The Sanitas Co., Ltd.," and the defendant began to trade as "The Condisanitas Co." Injunctions were also granted in

Rendle v. Rendle & Co., Ltd., 63 L. T. N. S. 94; *Army & Navy Co-operative Society, Ltd. v. Army & Navy Civil Service Co-operative Society of India, Ltd.*, 8 P. R. 426, 472; *Premier Cycle Co., Ltd. v. Premier Tube Co., Ltd.*, 12 Times L. R. 481; *Brinsmead v. Brinsmead*, *ib.* 631; 13 *ib.* 3; *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop-Trussault Cycle & Tube Manufacturing Co.*, 40 Sol. J. 544; *Same v. Dunlop Lubricant Co.*, 16 P. R. 12; *Eastman Photographic Materials Co. v. Griffiths' Cycle Co.*, 15 P. R. 105, where the Kodak Cycle Co. were restrained from using "Kodak," which had become identified with the plaintiff company; *National Folding Box & Paper Co. v. National Folding Box Co.*, 43 W. R. 156, where the fact that the word "National" was intended to refer to different nations in the two cases was held immaterial, inasmuch as both companies sold their goods in this country; *Manchester Brewery Co. v. North Cheshire & Manchester Brewery Co.*, (1898) 1 Ch. 539, where the defendant company succeeded to the business of the North Cheshire Brewery Company, and the ground of the decision was that the name of the defendant company would induce the belief that it had been formed by an amalgamation of the plaintiff company with the North Cheshire Company, and that the plaintiff company had ceased to have any separate existence; in *Holmes, Booth & Haydens v. Holmes, Booth & Attwood Manufacturing Co.*, 37 Conn. 278, the defendants were restrained from using the names of Holmes and Booth. In *Newby v. Oregon Central Railway Co.*, 1 Deady, 609, it was held that the original Oregon Central Railway Co. would be entitled to restrain the assumption of its name by a new company, though a single bondholder in the former company was not entitled to sue until the company had

the 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.,"

refused to do so. And see *Braham v. Beacham*, 7 Ch. D. 848 ("Radstock Colliery Proprietors"); *Campbell v. Hollins*, Dig. 548 ("Minton & Co."); *Batchellors v. Batchellor Manufacturing Co.*, 12 Amer. Rep. 414, n.; *Gray v. Taper Sleeve Pulley Works*, 16 Fed. Rep. 436, where the defendants were restrained from trading under the name they had assumed, which had been previously used by the plaintiffs, though they were entitled to make and sell "taper sleeve pulleys"; *McGowan Bros.' Pump & Machine Co. v. McGowan*, 2 Cinc. 313; *Celluloid Manufacturing Co. v. Cellonite Manufacturing Co.*, 32 Fed. Rep. 94; *Chas. S. Higgins Co. v. Higgins Soap Co.*, 144 N. Y. 462; 43 Am. St. Rep. 769, where the names were as above; *Myers v. Kalamazoo Buggy Co.*, 54 Mich. 215 ("The Kalamazoo Waggon Co.," and "The Kalamazoo Buggy Co."); *Tuerk Hydraulic Power Co. v. Tuerk*, 99 N. Y. Sup. Ct. 65 ("Tuerk Water Motor Co." (the popular name of the plaintiff company), and "Tuerk Water Meter Co."); *International Trust Co. v. International Loan & Trust Co.*, 153 Mass. 271, where the names were as above. See *Plant Seed Co. v. Michel Plant Seed Co.*, 23 Mo. App. 519.

In the following cases injunctions were refused:—*London & County Banking Co. v. Hampshire & North Wilts Bank*, Dig. 618, in which the defendant company was proposing to take the name of "The Capital & Counties Bank"; *Merchant Banking Co. of London v. Merchants' Joint Stock Bank, Ltd.*, 9 Ch. D. 560; *Army & Navy Co-operative Society, Ltd. v. Junior Army & Navy Stores, Ltd.*, Dig. 640; *Australian Mortgage, Land & Finance Co. v. Australian & New Zealand Mortgage Co.*, W. N. 1880, p. 6; *Midland Electric Light & Power Co. v. Brush Midland Electric Light & Power Co.*, 26 Sol. J. 465; *Provident Association of London, Ltd. v. London & Provincial Provident Association, Ltd.*, 30 Sol. J. 753; *Bumsted v. General Reversionary Co., Ltd.*, 4 Times L. R. 621, where the plaintiff sued on behalf of "The General Reversionary & Investment Co.," who carried on an extensive business in London, with country agents, and the defendants were setting up a small business at Liverpool; *Goodyear Rubber Co. v. Goodyear India-rubber Glove*

Manufacturing Co., 128 U. S. 598. And see *Condy v. Mitchell*, 37 L. T. N. S. 268, 766 ("Condy's Fluid Co."); *Massam v. Thorley's Cattle Food Co.*, 14 Ch. D. 748 ("Thorley's Cattle Food Co."); *Tussaud v. Tussaud*, 44 Ch. D. 67; *Saunders v. Sun Life Assurance Co. of Canada*, (1894) 1 Ch. 537, where the Sun Life Assurance Society failed to restrain the defendants from using their full name, but succeeded in restraining them from using any abbreviated form of it; *California Fig Syrup Co. v. Taylor's Drug Co.*, 14 P. R. 564, where the defendants assumed the name of "American Syrup of Figs Co."; *Ottoman Calvey Co. v. Dane*, 95 Ill. 203, in which the plaintiff company was held not entitled to restrain the defendants from trading under the same name in Illinois, notwithstanding that the defendants were incorporated in Michigan and the plaintiffs in Illinois, the defendants having been the first to trade under the name in Illinois; *Lehigh Valley Coal Co. v. Hamblen*, 23 Fed. Rep. 225, in which a Pennsylvania company, doing business in Illinois and other States, was held not entitled to restrain the formation of another company in Illinois under the same name; but it was intimated that the question would remain open whether relief would be granted if the new company should be formed and should improperly take away business from the plaintiffs. So, in *Drummond Tobacco Co. v. Randle*, 114 Ill. 412, the plaintiff company failed to restrain the incorporation of another company as "The Drummond-Randle Tobacco Co."; in *McNair v. Cleave*, 10 Phila. 155, the plaintiffs, trading as the "Galaxy Publishing Co.," were held not to be entitled to the exclusive use of the name, because it represented, contrary to the fact, that they were incorporated as a company. And see *Koehler v. Sanders*, 122 N. Y. 65, where an unsuccessful attempt was made to monopolise the words "International Banking Co."; *Nebraska Loan & Trust Co. v. Nine*, 27 Nebr. 507; 20 Am. St. Rep. 686, where it was held that the name of a state could not be monopolised as against rival traders of the same state; *In re United States Mortgage Co.*, 90 N. Y. Sup. Ct. 572, where the plaintiffs were allowed to change their name to "United States Mortgage & Trust Co.," notwithstanding the opposition of the United

changed the name to "Brooklyn White Lead and Zinc Company," it was held that, though he was entitled to continue to mark his goods "Brooklyn White Lead and Zinc," he had no right to add "Company" or "Co."

In *Australian Mortgage, Land & Finance Co. v. Australian & New Zealand Mortgage Co.* (a), the Court of Appeal pointed out the difficulty of monopolising the exclusive use of a name which correctly described the nature of a company's business, or the locality of its operations. And in *India & China Tea Co. v. Teede* (b), it was held that a firm of tea merchants were entitled to assume the name of "The India & China Packet Tea Co." notwithstanding that the name of the plaintiff company was as above, the name assumed by the defendants being simply descriptive, and there being no evidence of deception.

Descriptive name of company.

By § 20 of the Companies Act, 1862 (c), it is enacted 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" (d). This section does not authorise a company to use or register a name so nearly resembling one previously used by another company as to be calculated to deceive, even though the name of the earlier company has not itself been registered (e);

The Companies Act, 1862.

States Trust Co. of New York; *Employers' Liability Assurance Corporation v. Employers' Liability Insurance Co.*, 68 N. Y. Sup. Ct. 552; *Hygeia Water Ice Co. v. New York Hygeia Ice Co.*, 140 N. Y. 94, where the names were as above.

(a) W. N. 1880, p. 6. So, also, per the Supreme Court of the U. S. in *Goodyear Rubber Co. v. Goodyear India-rubber Glove Manufacturing Co.*, 128 U. S. 598. And see *Kochler v. Sanders*, 55 N. Y. Sup. Ct. 48 ("International Banking Co.").

(c) 25 & 26 Vict. c. 89.

(d) See *Manchester Brewery Co. v. North Cheshire & Manchester Brewery Co.*, (1898) 1 Ch. 539. As to the registration of names of companies under the U. S. Trade Marks Acts, see *In re Rowe & Post*, 9 U. S. Pat. Gaz. 496; *In re India Rubber Comb Co.*, 8 *ib.* 905; *India Rubber Comb Co. v. Meyer*, *ib.*; *India Rubber Comb Co. v. Rubber Comb & Jewellery Co.*, 45 N. Y. Super. Ct. 258; *In re Rubber Clothing Co.*, 10 U. S. Pat. Gaz. 111; and Appendix I., *infra*.

(e) *Hendriks v. Montagu*, 17 Ch. D. 638. See *Tussaud v. Tussaud*, 44 Ch. D. 678.

(b) W. N. 1871, p. 241.

and, on the other hand, since the section only affects the registration of the name of a company, the rights of a company to a name which has been registered cannot be attacked *under the section*, whatever may be the rights outside the section of another company which has previously used the name (a).

Name of individual.

If the trade name which has been imitated is that of 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 (b). But in *Olin v. Bate* (c), the plaintiff Olin failed to succeed in restraining the defendant Bate from carrying on the same profession (the medical) in the same town as himself under the name of Olin, the defendant having so done before the plaintiff came to the town in question. And where "Liebig's Extract of Meat" had come to be the proper designation of an article first invented by Baron Von Liebig, Field, J., affirmed by the Court of Appeal and the House of Lords, declined to restrain a manufacturer of the article from styling his preparation "Baron Liebig's Extract of Meat," and placing on the pots a photograph of the Baron (d).

Assumed name.

Sometimes the plaintiff's name is itself an assumed or fanciful one: thus the use of the name "Christy's Minstrels" has been restrained (e); and that of the name "The Oldfield Lane Doctor" (f); and in *Isaacson v. Thompson* (g) the plaintiff kept a millinery establishment, as "Madame Elise," which name being imitated by the defendant, an injunction would have been awarded, had not the plaintiff's own delay disentitled her to relief.

Man's own name. Use not restrained unless fraudulent.

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

(a) *Merchant Banking Co. of London v. Merchants' Joint Stock Bank, Ltd.*, 9 Ch. D. 560. In the U. S. similar statutory restrictions have been imposed upon the right to register the names of corporations, and in such cases a certificate of incorporation duly issued is held to be conclusive as to private persons of the right of the corporation to the corporate existence by the designated corporate name; *Boston Rubber Shoe Co. v. Boston Rubber Co.*, 149 Mass. 436; *Converse v. Hood*, *ib.* 471; *American Order of Scottish Clans v. Merritt*, 151 Mass. 558.

(b) Per Turner, L. J., in *Burgess v. Burgess*, 3 De G. M. & G. 896. See *Barber v. Manico*, 10 P. R. 93; *Pinet v. Maison Pinet*, (1898) 1 Ch. 179; *Binninger*

v. Wattles, 28 How. Pr. 206; R. Cox, 318; *Priestley v. Adams*, 66 N. Y. Sup. Ct. 380; *Shaw v. Pilling*, 175 Pa. 78.

(c) 98 Ill. 55; 38 Amer. Rep. 78.

(d) *Liebig's Extract of Meat Co. v. Anderson*, W. N. 1882, p. 147; *ib.* 1883, p. 185; H. L., July 16th, 1885. Cf. *Richmond Nervine Co. v. Richmond*, 159 U. S. 293; *Kathreiner's Malz Kaffee Fabriken, &c. v. Pastor Kucip Medicine Co.*, 82 Fed. Rep. 321.

(e) *Christy v. Murphy*, 12 How. Pr. 77; R. Cox, 164; *Montague v. Moore*, Seton, 5th ed. 539.

(f) *Milner v. Reed*, Dig. 328.

(g) 41 L. J. Ch. 101. And see *Davis v. Rogers*, 89 L. T. (Journal) 292.

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). It is not sufficient in such cases to show that the use of the name, though honest, may cause confusion. Thus, in *Turton & Sons, Ltd. v. Turton* (c) the plaintiffs carried on an old-established business in Sheffield as Thomas Turton & Sons, Ltd., and the defendant John Turton, who had for some years carried on a similar business in the same town as John Turton & Co., took his two sons into partnership, and changed his trade name to John Turton & Sons; and although some confusion was proved, the Court of Appeal held that, the name adopted being a true state-

(a) *Churton v. Douglas*, Johns. 174; *Burgess v. Burgess*, 3 De G. M. & G. 896; *Fullwood v. Fullwood*, W. N. 1873, pp. 93, 185; *Fullwood v. Fullwood* (2), 9 Ch. D. 176; *Holloway v. Holloway*, 13 Beav. 209; *Pullar v. Pullar*, Fry, J., April 9th, 1883; *Melachrino & Co. v. Melachrino Egyptian Cigarette Co.*, 4 P. R. 215; *M. Melachrino & Co. v. R. Melachrino & Co.*, Chitty, J., May 29th, 1888; *Nicholls v. Kimpton*, 3 Times L. R. 674; *Birmingham Vinegar Brewery Co., Ltd. v. Liverpool Vinegar Co., Ltd.*, 4 Times L. R. 613; *Atkinson v. Atkinson*, 85 L. T. (Journal) 229; *Warner v. Warner*, 5 Times L. R. 359; *Tussaud v. Tussaud*, 44 Ch. D. 678; *Rendle v. Rendle & Co.*, 63 L. T. N. S. 94; *Edge v. Harrison*, 8 P. R. 74; *Otard, Dupuy & Co. v. Otard de Montebello Cognac Co.*, 9 Times L. R. 295; 10 *ib.* 67; *Brinsmead v. Brinsmead*, 12 Times L. R. 631; 13 *ib.* 3; *Pinet v. Maison Pinet* (1), 14 P. R. 933; *Dunlop Pneumatic Tyre Co. v. Dunlop-Trussault Cycle & Tube Manufacturing Co.*, 40 Sol. J. 544; *Bayer v. Baird*, 15 P. R. 615, 627; *Holmes v. Holmes*, 37 Conn. 278; 9 Amer. Rep. 324; *Gillis v. Hall*, R. Cox, 596; *Devlin v. Devlin*, 69 N. Y. 212; *Shaver v. Shaver*, 54 Iowa, 208; *India Rubber Comb Co. v. Rubber Comb & Jewellery Co.*, 45 N. Y. Super. Ct. 258; *Landreth & Sons v. Landreth*, 22 Fed. Rep. 41; *Gage v. Canada Publishing Co.*, 11 Can. Sup. Ct. 306; *William Rogers Manufacturing Co. v. Rogers & Spurr Manufacturing Co.*, 11 Fed. Rep. 495; *Frazer v. Frazer Lubricator Co.*, 121 Ill. 147. See *Christie v. Christie*, L. R. 8 Ch. 499; *McGowan Bros. Pump & Machine Co. v. McGowan*, 2 Cinc. 313; *Pillsbury v. Pillsbury-Washburn Flour Mills Co.*, 64 Fed. Rep. 841; *William Rogers Manufac-*

turing Co. v. R. W. Rogers Co., 70 *ib.* 1017; *Hoff v. Tarrant & Co.*, 71 *ib.* 163; *Walter Baker & Co. v. Baker*, 77 *ib.* 181; *Garrett v. T. H. Garrett & Co.*, 78 *ib.* 472; *Walter Baker & Co. v. Sanders*, 80 *ib.* 889; *Baeder v. Baeder*, 59 N. Y. Sup. Ct. 170; *De Long v. De Long Hook & Eye Co.*, 96 *ib.* 406; *El Modello Cigar Manufacturing Co. v. Gato*, 25 Fla. 886; 23 Am. St. Rep. 72; *Chas. S. Higgins Co. v. Higgins Soap Co.*, 144 N. Y. 462; 43 Am. St. Rep. 769.

(b) *Per Turner, L. J.*, in *Burgess v. Burgess*, 3 De G. M. & G. 896. And see *Turton & Sons, Ltd. v. Turton*, 42 Ch. D. 128; *Reddaway v. Banham*, (1896) A. C. 199, 211; *Birmingham Vinegar Brewery Co. v. Powell*, (1897) A. C. 710; *Rogers v. Rogers*, 53 Conn. 121; and other cases.

(c) 42 Ch. D. 128. And see *Saunders v. Sun Life Assurance Co. of Canada*, (1894) 1 Ch. 537; *Crawford v. Bernard*, 11 P. R. 580; *Valentine v. Valentine*, 32 L. R. Ir. 488; *Jamieson & Co. v. Jamieson*, 15 P. R. 169; *Attenborough v. Jay*, 14 Times L. R. 365; *ib.* 439; *Rogers v. Rogers*, 53 Conn. 121; *Iowa Seed Co. v. Dorr*, 70 Iowa, 481; *William Rogers Manufacturing Co. v. Simpson*, 54 Conn. 527; *Brown Chemical Co. v. Meyer*, 139 U. S. 540; *Rogers v. William Rogers Manufacturing Co.*, 70 Fed. Rep. 1019; *American Cereal Co. v. Eli Pettijohn Cereal Co.*, 72 *ib.* 903; 76 *ib.* 372; *De Long v. De Long Hook & Eye Co.*, 96 N. Y. Sup. Ct. 406; *Duryea v. National Starch Manufacturing Co.*, 79 Fed. Rep. 651; *Fish Bros. Wagon Co. v. La Belle Wagon Works*, 82 Wisc. 546; 33 Am. St. Rep. 72; *Chas. S. Higgins Co. v. Higgins Soap Co.*, 144 N. Y. 462; *Scott Stamp & Coin Co. v. Scott Co.*, 58 N. Y. Super. Ct. 380; *Stuart v. F. C. Stewart Co.*, 85 Fed. Rep. 778.

ment of the composition of the firm, and there being no proof or even allegation of fraud, no injunction could be granted. Lord Esher, M. R., said: "If all that a man does is to carry on the same business (as another trader), and to state how he is carrying it on, that statement being the simple truth, and he does nothing more with regard to the respective names (*a*), he is doing no wrong. He is doing what he has an absolute right by the law of England to do; and you cannot restrain a man from doing that which he has an absolute right by the law of England to do." And Cotton, L. J., added: "The Court cannot stop a man from carrying on his own business in his own name, although it may be the name of a better known manufacturer, when he does nothing at all in any way to try and represent that he is that better known and successful manufacturer." But where a person has allowed another to use his name, and acquire a reputation under it, he will not afterwards be allowed himself to use his name so as to deceive, nor to empower others to use it so as to produce that result, nor will such others be permitted so to use it. Thus, where one Holbrook, an employé of the Birmingham Vinegar Brewery Co., Ltd., had allowed the company to use his name for twelve years as part of the title of their goods—*e.g.*, "Holbrook's Worcestershire Sauce," "Holbrook's London Relish," "Holbrook's Pure Pickles"—he was not allowed, on leaving their service and entering that of the Liverpool Vinegar Co., Ltd., to give the latter a right to use his name as part of the same titles, nor were they allowed so to use it (*b*).

Lending name
to third per-
son.

"There is no instance," said Kay, J., in *Rendle v. Rendle & Co. (c)*, "in which it has been held that a man can lend his name to a third person, and can induce that third person to start business in opposition to someone else who is using that name, and has an established business under that name. Take a well-known name—that of 'Christie' for instance—can a man whose name is Christie, who has never carried on business as an auctioneer on a large scale,

(*a*) See *Lewis's v. Lewis*, 45 Ch. D. 281, 284; and *Jamieson & Co. v. Jamieson*, 15 P. R. 169. Compare, however, *Reddaway v. Banham*, (1896) A. C. 199.

(*b*) *Birmingham Vinegar Brewery Co., Ltd. v. Liverpool Vinegar Co., Ltd.*, 4 Times L. R. 613. And see *Chas. S. Higgins Co. v. Higgins Soap Co.*, 144 N. Y. 462; *Le Page v. Russia Cement Co.*, 51 Fed. Rep. 941; *Symonds v. Jones*, 82 Maine, 302; 17

Am. St. Rep. 485; *Richmond Nervine Co. v. Richmond*, 159 U. S. 293; *Chattanooga Medicine Co. v. Thedford*, 73 U. S. Pat. Gaz. 2163. Cf. *Fish Bros. Wagon Co. v. La Belle Wagon Works*, 82 Wis. 546; 33 Am. St. Rep. 72; *Duryca v. National Starch Manufacturing Co.*, 79 Fed. Rep. 651.

(*c*) 63 L. T. N. S. 94.

say to another man, not having the name of Christie, 'I will lend you my name, and then you can say the business is Christie's, and the justification for your doing so is that I have sold you my name'? As the law of England stands, that will not be allowed. And what is the difference between that—namely, lending your name to an individual—and lending your name to a joint stock company? 'The fraud is transparent' (a).

Evidence of fraudulent intention was supplied in one case (b) 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."; and in another case (c), in which the same person was plaintiff, by a representation that the business of M. Fullwood and E. Fullwood, trading as "E. Fullwood & Co.," had been established in 1785, and was carried on at Hoxton, those facts being true of the business of R. J. Fullwood & Co., but not of that carried on by the defendants. In a third 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

Evidence of fraud.

(a) And see *Tussaud v. Tussaud*, 44 Ch. D. 678; *Melachrino v. Melachrino Egyptian Cigarette Co.*, 4 P. R. 215; *Otard, Dupuy & Co. v. Otard de Montebello Cognac Co.*, 9 Times L. R. 295; 10 *ib.* 67; *Dunlop Pneumatic Tyre Co. v. Dunlop-Truffault Cycle & Tube Manufacturing Co.*, 40 Sol. J. 544; *Brinsmead v. Brinsmead*, 12 Times L. R. 631; 13 *ib.* 3; *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Lubricant Co.*, 16 P. R. 12; *Rogers Manufacturing Co. v. Rogers*, 66 Fed. Rep. 56; 70 *ib.* 1017; *American Cereal Co. v. Eli Pettijohn Cereal Co.*, 72 *ib.* 903; 76 *ib.* 372; *Garrett v. T. H. Garrett & Co.*, 78 *ib.* 472; *De Long v. De Long Hook & Eye Co.*, 96 N. Y. Sup. Ct. 406; *Chas. S. Higgins Co. v. Higgins Soap Co.*, 144 N. Y. 462. Cf. *Attenborough v. Jay*, 14 Times L. R. 365; *ib.* 439; *Scott Stamp & Coin Co. v. Scott Co.*, 58 N. Y. Super. Ct. 380.

(b) *Fullwood v. Fullwood*, W. N. 1873, pp. 93, 185. So where the plaintiff carried on business as "Newman & Co." and the defendant bought a similar business carried on as "H. Newman," and changed the name to "Newman & Co.": *Holt v. Smith*, 4 Times L. R. 329. And where the plaintiff dealt in "Warner's Safe Cures," and the defen-

dant, who was also named Warner, bought the goodwill of "Ashton's Gout and Rheumatic Cure," and changed the name to "Warner's Gout and Rheumatic Cure": *Warner v. Warner*, 5 Times L. R. 359. And see *Valentine v. Valentine*, 31 L. R. Ir. 488, where the defendants set up a rival business in premises recently vacated by the plaintiffs. See, also, *Smith v. McBride*, Ct. Sess. Cas. 4th Ser. XVI. 36.

(c) *Fullwood v. Fullwood* (2), 9 Ch. D. 176. And see *Glen & Hall Manufacturing Co. v. Hall*, 61 N. Y. 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 & Tile Co.": *Campbell v. Hollins*, Dig. 548.

(d) *Churton v. Douglas*, Johns. 174. But see the American cases of *Howe v. Searing*, 10 Abb. Pr. 264; *R. Cox*, 244; *Reeves v. Denicke*, 12 Abb. Pr. N. S. 92; and *Booth v. Jarrett*, 52 How. Pr. 169.

business "John Douglas & Co.," and sent round circulars informing the public that his business 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 (a). But where the plaintiff had been for eight years in the habit of engaging Dr. Richter to conduct concerts in London, which the plaintiff advertised and made popular by the name of "Richter Concerts," and in 1887 Dr. Richter declined to continue to act with the plaintiff, and agreed to conduct concerts in London for the defendant, who began to advertise them as "Richter Concerts," it was held that the name "Richter Concerts" meant concerts conducted by Dr. Richter, and was properly applied to the proposed concerts, and that no injunction could be granted (b).

Change of
name copied.

Where the plaintiff had changed his name to Frank Leslie, and his son had, by his orders, assumed the same name, and the plaintiff had afterwards brought out "Frank Leslie's Illustrated News," and other publications of the titles of which his new name formed part, it was held that there was no ground for restraining the publication by the son of "Frank Leslie Junior's Sporting and Dramatic Times" (c). On the other hand, where Dr. Trust had changed his name to Gouraud, but his sons had not changed their name, the latter were restrained from selling a preparation with a statement that it was prepared by Dr. Gouraud's sons, there being a representation which, though not strictly false, was yet calculated to mislead (d).

Deceptive
circulars.

Again, a fraudulent intention may be shown to exist by 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 (e).

(a) *Boulton v. Peake*, 13 Ch. D. 513. And see *Cave v. Myers*, Dig. 304; *Atkinson v. Atkinson*, 85 L. T. (Journal) 229; *Davis v. Rogers*, 89 *ib.* 292; and *Glen & Hall Manufacturing Co. v. Hall*, 61 N. Y. 226.

(b) *Franke v. Chappell*, 57 L. T. N. S. 141.

(c) *England v. New York Publishing Co.*, 8 Daly, 375.

(d) *Gouraud v. Trust*, 10 N. Y. Sup.

Ct. 627.

(e) *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*, L. R. 8 Ch. 499; *Burrows v. Foster*, 1 N. R. 156; *Graceley v. Winchester*, Seton, 5th ed. 591; *Selby v. Anchor Tube Co.*, W. N. 1877, p. 191; *Rendle v. Rendle & Co.*, 63 L. T. N. S. 94; *Tuerk Hydraulic Power Co. v. Tuerk*,

Thus, in *Mogford v. Courtenay* (a), the defendant issued a circular of which the effect was to represent that he was carrying on the business which he had previously carried on in partnership with the plaintiff, although under the partnership articles the entire goodwill vested in the plaintiff on dissolution.

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). Thus, in *Clayton v. Day* (e), an ironmonger's assistant named Day, and a general shopkeeper named Martin, were not allowed to carry on the business of blacking manufacturers under the name of "Day and Martin," though they were left free to trade as "Martin and Day." Similarly, in *Melachrino v. Melachrino Egyptian Cigarette Co.* (f), the plaintiff's cigarettes being well known as "Melachrino Cigarettes," a person named Poulides took a brother of the plaintiff into his service, under an agreement by which Poulides was to have the right to use his name, and Poulides then opened a busi-

Fraudulent partnership.

99 N. Y. Sup. Ct. 65; *Simmons Medicine Co. v. Simmons*, 81 Fed. Rep. 163.

(a) 45 L. T. N. S. 303.

(b) *Scheile v. Brakell*, 11 W. R. 796; *Seton*, 5th ed. 584; *Witt v. Corcoran*, *ib.* 590; *England v. Curling*, 8 Beav. 129; *Vernon v. Hallam*, 34 Ch. D. 748.

(c) *Edgington v. Edgington*, 11 L. T. N. S. 299.

(d) *Croft v. Day*, 7 Beav. 84; *Moet v. Clybourn*, Dig. 533; *Schweitzer v. Atkins*, 37 L. J. Ch. 847; *Dence v. Mason*, Dig. 534; 41 L. T. N. S. 573; *Dence v. Brand*, W. N. 1881, p. 31; *Edge v. Harrison*, 8 P. R. 74; *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Lubricant Co.*, 16 P. R. 12; *Smith v. McBride*, Ct. Sess. Cas. 4th Ser. XVI. 36; *Holmes v. Holmes*, 37 Conn. 278; 9 Amer. R. 24.

(e) 26 Sol. J. 43; 76 L. T. (Journal) 79. But in America a fictitious partnership has been permitted to give to one of two partners, who had become the successor to the partnership business, a right to use the same trade name which had been formerly used by the partnership, and which consisted of the united names of the two former partners; although, apart from the fictitious partnership, he would have been prevented from so doing by the Massachusetts Gen. Stat. c. 56, which requires the consent of a former partner, or of his personal representative, to the continued use of his name in the business, and such consent was refused: *Hallett v. Cumston*, 110 Mass. 29.

(f) 4 P. R. 215.

ness close to the plaintiffs under the name of "The Melachrino Egyptian Cigarette Co.," and used the name "Melachrino" in various ways calculated to deceive, and an injunction was granted. Again, in *M. Melachrino & Co. v. R. Melachrino & Co. (a)*, Poulides, the defendant in the previous action, went to Egypt as soon as an interlocutory injunction had been granted in that action, and induced a person named Melachrino, who was not connected with the plaintiffs, but was a tobacconist in a small way of business in Alexandria, to enter into partnership with him and come to England to establish a business under the name of "R. Melachrino & Co.," the plaintiffs being "M. Melachrino & Co.," and they used various fraudulent devices. An injunction was again granted. Again, in *Edge v. Harrison (b)*, where the plaintiff had taken out a patent for an invention for wrapping up soluble blue, and the defendants, R. & S. Harrison and Mrs. Edge, the mother-in-law of the latter, conspired together to take out a patent in the name of Mrs. Edge for a similar invention, and used other devices to enable them to pass off their blue as the plaintiff's, damages were awarded and an injunction granted, and an order was made for revocation of the defendants' patent (c).

Vendor of
business may
recommence
business.

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 (d).

Dissolution of
partnership.

On the dissolution of a partnership, if the whole concern and the goodwill are sold, the trade name is sold with them (e). But if the partners merely divide the partnership assets, and there are

(a) Chitty, J., May 29th, 1888.

(b) 8 P. R. 74.

(c) And see *Le Page Co. v. Russia Cement Co.*, 51 Fed. Rep. 941.

(d) *Cruttwell v. Lye*, 17 Ves. 335; *Churton v. Douglas*, Johns. 174; *Johnson v. Helleley*, 34 Beav. 63; *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.

(e) *Banks v. Gibson*, 34 Beav. 566. See *Hoffman v. Duncan*, Seton, 5th ed. 589; *Witt v. Corcoran*, *ib.* 590.

no express stipulations in the articles as to the disposal of the trade name, then each is at liberty to use the whole name just as the partnership did before (a); at all events, if no injury will be thereby caused to a partner whose name the firm have used (b). Where there are express stipulations in a deed, the parties are of course bound. Thus, in *Day v. Finch* (c) a member of the dissolved firm of "Benjamin Finch & Co.," who had agreed to carry on business after the dissolution in his own name only, was restrained from continuing to use the words "and Co." after the name "Benjamin Finch." But where, on a dissolution of partnership, it was agreed that neither partner was to use the firm name, but that each was to be at liberty to manufacture the same articles as had been manufactured by the firm, and one of the partners set up in business on his own account and put up over his shop the name "Hodgson, late of Matthews & Hodgson," the words "late of" being in small type, it was held that no breach of the agreement had been committed (d); and where a business carried on as "Madame Élise" was purchased under an agreement which recited (inaccurately) that the business had been carried on as "Madame Élise & Co.," and gave the purchaser the right to use that name, it was held that the purchaser was not entitled to trade as "Madame Élise" simply (e).

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 (f), and the retiring partner is at liberty to set up a similar business in his own name, even on adjoining premises (g).

Rights of retiring partner.

In *Scott v. Scott* (h), R. & W. Scott carried on business in partnership in Nithsdale, and in Glasshouse Street, Regent Street, as "R. & W. Scott." The partnership being dissolved, the agreement for the dissolution contained no stipulation by either

Scott v. Scott.

(a) *Ib.* See *Clark v. Leach*, 32 Beav. 14; *Dence v. Mason*, Dig. 534; *Condy v. Mitchell*, 37 L. T. N. S. 268, 766; *Levy v. Walker*, 10 Ch. D. 436; *Rogers v. Taintor*, 97 Mass. 291; *Caswell v. Hazard*, 121 N. Y. 484.

(b) *Scott v. Rowland*, 20 W. R. 508; *Levy v. Walker*, 10 Ch. D. 436; *Fenton v. Levy*, 29 Sol. J. 735; *Chappell v. Griffith*, 53 L. T. N. S. 459; *Gray v. Smith*, 43 Ch. D. 208; *Caswell v. Hazard*, 121 N. Y. 484. See *Chatteris v. Isaacson*, 57 L. T. N. S. 177.

(c) 25 Sol. J. 354. And see *Tudor v. Tudor*, W. N. 1873, p. 72; *Vernon v. Hallam*, 34 Ch. D. 748; *Brewer v. Lamar*, 69 Ga. 656.

(d) *Matthews v. Hodgson*, 2 Times L. R. 899.

(e) *Chatteris v. Isaacson*, 57 L. T. N. S. 177.

(f) *Banks v. Gibson*, 34 Beav. 566.

(g) *Bond v. Milbourn*, 20 W. R. 197; *Mogford v. Courtenay*, 45 L. T. N. S. 303.

(h) 16 L. T. N. S. 143.

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 London 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 and Nixon, late R. & W. Scott of Nithsdale." Upon this W. Scott filed a bill 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*).

Representations that plaintiff has retired.

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 these misrepresentations (*b*); and 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.

Former firm or employer may be stated.

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

(*a*) See *Selby v. Anchor Tube Co.*, W. N. 1877, p. 191.

(*b*) *Harper v. Pearson*, 3 L. T. N. S. 547; also *Scott v. Scott*, 16 L. T. N. S. 143; *Stevens v. Paine*, 18 L. T. N. S. 600; *Reeves v. Denicke*, 12 Abb. Pr. N. S. 92; *Gouraud v. Trust*, 10 N. Y. Sup. Ct. 627. And as to a representation of one business being a continuation of another,

see *Churton v. Douglas*, Johns. 174; *Burrows v. Foster*, 1 N. R. 156; *Witt v. Corcoran*, Seton, 5th ed. 590; *Graveley v. Winchester*, *ib.* 591; *Montague v. Moore*, *ib.* 539; *Selby v. Anchor Tube Co.*, W. N. 1877, p. 191; *England v. Curling*, 8 Beav. 129; *Vernon v. Hallam*, 34 Ch. D. 748; *Hoxic v. Chanie*, 143 Mass. 592.

entitled, unless he has contracted not to do so (a), to derive what benefit he may from a fair statement of the fact of his former employment (b), 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" (c), the plaintiff is entitled to protection just as much as if there were intentional fraud.

In *Glenny v. Smith* (d) 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 & 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. Kindersley, V.-C., granted an injunction (e). *Glenny v. Smith.*

In *Hookham v. Pottage* (f), 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 *Hookham v. Pottage.*

(a) *Wolmershausen v. O'Connor*, 36 L. T. N. S. 921.

(b) See per Wood, V.-C., in *Leather Cloth Co. v. American Leather Cloth Co.*, 1 H. & M. 271; also *Clark v. Leach*, 32 Beav. 14; *Goodman v. Way*, 36 Sol. J. 830; *Emerson v. Badger*, 101 Mass. 82; *Boswell v. Mathie*, Ct. Sess. Cas. 4th Ser. XI. 1072; *Van Wyck v. Horowitz*, 46 N. Y. Sup. Ct. 237; *Wolfe v. Alsop* (1), 10 V. L. R. (E.) 41; and cases *infra*. But see *Selby v. Anchor Tube Co.*, W. N. 1877, p. 191.

Smith, 2 Dr. & Sm. 476. And see *Curtiss v. Messler*, 13 A. L. T. 127.

(d) 2 Dr. & Sm. 476.

(e) See, too, *Burgess v. Burgess*, 3 De G. M. & G. 896; *Dence v. Mason* (1), Dig. 534; *Colton v. Thomas*, 2 Brews. 308; R. Cox, 507; *Boswell v. Mathie*, Ct. Sess. Cas. 4th Ser. XI. 1072; *Wolfe v. Alsop*, 12 Vict. L. R. (E.) 421; *Garde v. Mitchell*, 17 V. L. R. 209; *Klotz v. Hecht*, 73 Fed. Rep. 822.

(f) L. R. 8 Ch. 91. And see *Selby v. Anchor Tube Co.*, W. N. 1877, p. 191.

(c) V.-C. Kindersley, in *Glenny v.*

put over his shop, "S. Pottage, from Hookham & Pottage." There was some evidence of deception, and Malins, V.-C., granted an injunction, which decision was upheld by the Court of Appeal.

Other cases.

In *Foot v. Lea* (a), an older case, the Master of the Rolls 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), 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 more 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^{ères} 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.

Name of establishment.

Deception of the same kind will be restrained when what is imitated is not a name of an individual or firm, 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" (e), "The Bodega" (f), "The New York Dental Rooms" (g). But in such cases the plaintiff must prove that there is something distinctive in the appellation which he has given to his establishment, since no relief can be given him if that appellation is merely descriptive, as "The Antiquarian Book Store" (h), "The Mammoth Wardrobe" (i), "The Tower Palace" (k), "Misfits Parlours" (l); and

(a) 13 Ir. Eq. 490. And see *Matthews v. Hodgson*, 2 Times L. R. 899.

(b) 13 L. T. N. S. 498.

(c) *Robineau v. Charbonnel*, W. N. 1876, p. 160.

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

(e) *Boulnois v. Peake*, 13 Ch. D. 513.

(f) *Bodega Co., Ltd. v. Owens*, 7 P. R. 31.

(g) *Sanders v. Utt*, 16 Mo. App. 322 (the rooms were in St. Louis, Mo.). See

Sanders v. Jacob, 20 Mo. App. 96; *Cady v. Schultz*, 19 R. I. 193; 61 Am. St. Rep. 763.

(h) *Choynski v. Cohen*, 39 Cal. 501; R. Cox, 593. See, however, *Weinstock, Lubin & Co. v. Marks*, 109 Cal. 529, when the name "Mechanics' Store" was protected.

(i) *Gray v. Koch*, 2 Mich. N. P. 119.

(k) *Armstrong v. Kleinhaus*, 1 Ky. L. Rep. 112; 82 Ky. 303.

(l) *Cohn v. Kahn*, 26 Alb. L. J. 342.

he must also prove that the result of the defendant's acts is to represent that his business is identical with that carried on by the plaintiff (a), as in *Cave v. Myers* (b), where the defendant, whose shop was in a corner house close to the establishment of the plaintiffs, Messrs. Cave, adopted for his shop the name of "Cavendish House," and had it so painted up that "Cave" appeared on the side of the street in which was the plaintiff's shop, and the remainder round the corner, and *Genin v. Chadsey* (c), where the plaintiff was the proprietor of "The Captain's Live-and-Let-Live Oyster and Dining Saloon," and the defendant set up "G. W. Chadsey & Co.'s Great Eastern Live-and-Let-Live Dining Saloon." On the other hand, it was held (d) that "Great I X L Auction Company" was not likely to be mistaken for "I X L General Merchandise Auction Store," and where the defendant had put up a sign with the words "Depôt of the Cherry Pectoral Company," and inside his premises a notice, "Ayer's Cherry Pectoral, One Dollar; Rushton's Cherry Pectoral, Fifty Cents. Which will you have?" it was held that the defendant had done no more than trade in fair competition with the plaintiff, as he was entitled to do (e); but when fraud is proved or admitted, it will be restrained (f).

In *Walker v. Alley* (g) it was decided that the name and sign of Signboard. "The Golden Lion" was so connected with the plaintiff's dry goods business that it could not be taken by another trader; and the Chancellor of Upper Canada said that "where it is clear to the Court that the defendant himself intended an advantage by the use of a particular sign or mark in use by another, and believes he has obtained it, or, in other words, that the defendant himself thought the use of it was calculated to advertise him at the expense of the plaintiff, and this was his object in using it, and where such has been the effect of the user, I think the Court should say to him, 'Remove that sign; its use by you may, as you intend, damage the plaintiff. It cannot be necessary or valuable to you

(a) See *Lyric Theatre, Ltd. v. Cordingley*, 90 L. T. (Journal) 122 ("Lyric Theatre" and "Lyric Opera House").

(b) Dig. 304.

(c) Cited in *Dixon Crucible Co. v. Guggenheim*, R. Cox, 567. And see *Hoby v. Grosvenor Library Co.*, 28 W. R. 366 ("Grosvenor Library"); *Wheeler v. Johnston*, 3 L. R. Ir. 284 ("Cromac

Springs"); and *Glen & Hall Manufacturing Co. v. Hall*, 61 N. Y. 226; 19 Amer. Rep. 278 ("No. 10, South Water Street, Rochester, New York").

(d) *Lichtenstein v. Mellis*, 8 Oreg. 464.

(e) *Ayer v. Rushton*, 7 Daly, 9.

(f) *Cohn v. Kahn*, 26 Alb. L. J. 342.

(g) 13 Grant, Up. Can. Ch. 366.

for any other purpose. You have your choice of many signs which, as a mere attraction, or to give your store a marked designation, must answer a fair business purpose equally well.' ”

No right in name of private house or telegraphic address.

Apart from a business of some kind, no exclusive right can be acquired in the name of a house, any more than in the name of a person, and no right of action arises from the annoyance occasioned by a person re-naming his residence after the neighbouring residence of another householder (a). And where an abbreviated telegraphic address (“Street, London”) had been used for many years by a business firm, and another firm of a different character afterwards adopted the same telegraphic address, it was held that the confusion which ensued was *damnum absque injuriâ*, and that no injunction could be granted (b).

Hotel.

The same principle which governs the names of business establishments 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” (c), “The What Cheer House” (d), “The McCardel House” (e), “The Palace Hotel” (f), and “The Columbia Hotel” (g), have been protected. In the last case the objection that the name was geographical was raised but was overruled.

Must be distinctive.

On the other hand, the Scotch Court of Session has held that the proprietor of “The Station Hotel” was not entitled to interfere with the use of the name “The Royal Station Hotel” for another hotel in the same neighbourhood, the plaintiff’s name not being distinctive, and the defendant’s name being sufficiently distinguished by the insertion of the word “Royal” (h).

Name goes with building.

But it seems that where a name has been attached to a building it passes with it, and cannot be retained or dealt with by the former owner apart from the building. Thus, in *Booth v. Jarrett* (i), the founder of “Booth’s Theatre,” who had gained a reputation for it by his skill in acting, and had named it after himself, attempted,

(a) *Day v. Brownrigg*, 10 Ch. D. 294.

(b) *Street v. Union Bank of Spain & England*, 30 Ch. D. 156.

(c) *Howard v. Henriques*, 3 Sand. S. C. 725; R. Cox, 129.

(d) *Woodward v. Lazar*, 21 Cal. 448; R. Cox, 300; *Gamble v. Stephenson*, 10 Mo. App. 581.

(e) *McCardel v. Peck*, 28 How. Pr. 120; R. Cox, 312.

(f) *Great North of Scotland Rail. Co. v. Mann*, Ct. Sess. Cas. 4th Ser. XIX. 1035.

(g) *Whitfield v. Loveless*, 64 U. S. Pat. Gaz. 442.

(h) *Charleson v. Campbell*, Ct. of Sess. Cas. 4th Ser. IV. 149. See *Great North of Scotland Rail. Co. v. Mann*, *ib.* XIX. 1035; *Crawford’s Trustees v. Lennox Co.*, *ib.* XXIII. 747.

(i) 52 How. Pr. 169.

without success, to prevent the continued use of the name by a person into whose possession the theatre had subsequently come, the name having passed to the defendant with the building and goodwill. Again, in *Mason v. Queen (a)*, the proprietor of the "Waverley Hotel," Glasgow, sold his premises to a railway company, who compensated him for the removal. He afterwards assigned the goodwill of his business and trade name to the plaintiff, who was carrying on another hotel in a different part of Glasgow, the name of which was thereupon changed to the "Waverley." The railway company did not require the actual site of the old hotel for their purposes, and subsequently let it to the defendant, who re-opened the hotel under the name of the "Old Waverley Hotel," and it was held that the plaintiff was not entitled to restrain the defendant from so doing. In *Woods v. Sands (b)*, it was held that the founder of "Woods' Hotel," who had sold and afterwards repurchased his interest in it, had recovered by the re-assignment his exclusive right in the name, and the use of it by another person was prohibited. So, in *Armstrong v. Kleinhaus (c)*, the tenant of a business house which he had called "The Tower Palace," was held to have no right in the name capable of being transferred to a different building elsewhere. And in *Pepper v. Labrot (d)* it was held that the name "Oscar Pepper's Old Crow Distillery" had become attached to the distillery, and that Oscar Pepper's son and successor in business, on whose bankruptcy the distillery was sold, was not entitled to interfere with the use by the purchaser of the name "Oscar Pepper" as part of the name of the distillery. But in one Canadian case (e) the purchasers of "The Western or Mason's Hotel" were protected in their exclusive right to the name, as against the vendor, who had re-occupied his former premises after the purchaser had been driven out by a fire.

In the same way, the proprietor of the "Prescott House" Hotel was held entitled to restrain the use of the name by a coach proprietor upon his coaches, an agreement between the latter and a former owner of the hotel being treated as having been in the

Name of hotel
on convey-
ances.

(a) 23 Scot. L. R. 641; and see *Cowan v. Millar*, Ct. Sess. Cas. 4th Ser. XXII. 833.

(b) Dig. 467. Cr. *Vonderbank v. Schmidt*, 44 La. Ann. 264; 32 Am. St. Rep. 336, where it was held that the proprietor of a hotel of his own name

did not, by selling the goodwill, give the right to his name as the designation of the hotel.

(c) 1 Ky. L. Rep. 112; 82 Ky. 303.

(d) 8 Fed. Rep. 28.

(e) *Mossop v. Mason*, 18 Grant, Up. Can. Ch. 453.

nature of a revocable licence, which had been revoked upon the sale of the hotel to the plaintiff (*a*). 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 (*b*).

Similar cases.

So, again, the name of a line of steamships (*c*), of collieries (*d*), and of particular waggons (*e*), has been protected.

Name not used in ordinary business.

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.

Where articles are produced under a certain name.

Where a person produces certain articles, and a representation is made by another that articles not the production of that person are in fact produced by him, there is an injury to the right of property in the name, which has in fact, though not used as a trade mark, yet come to be the producer's means of selling the articles produced.

Author.

Thus, an author is entitled to protection for the name which sells his works for him. In *Lord Byron v. Johnston* (*f*), the defendant, who had advertised for sale poems which he represented to be by the plaintiff, but as to which he declined to swear to his belief in their genuineness, was restrained by injunction. And in *Besant v. Moffatt & Paige* (*g*), a well-known writer was protected against the use of his name in connection with a book for which he was not responsible.

Humourist.

In *Clemens v. Such* (*h*), a humorous writer, whose works were published under the *nom de plume* of "Mark Twain," was held to be entitled to restrain the unauthorized use of that designation by

(*a*) *Deiz v. Lamb*, 29 N. Y. Super. Ct. 537.

(*b*) *Stone v. Carlan*, 13 Mo. L. R. 360; *R. Cox*, 115; *Marsh v. Billings*, 7 Cush. 322; *R. Cox*, 118. And compare *Knott v. Morgan*, 2 Keen, 213.

(*c*) *Winsor v. Clyde*, 9 Phila. 513 ("Keystone Line").

(*d*) *Braham v. Beachin*, 7 Ch. D. 848 ("Radstock Collieries").

(*e*) *Shaver v. Shaver*, 54 Iowa, 208 ("Shaver Waggons").

(*f*) 2 Mer. 29.

(*g*) 84 L. T. (Journal) 152.

(*h*) Dig. 429.

another person. And in *Clemens v. Belford* (a), it was held that the name might not be connected with matter not written by the plaintiff, though it might be attached to a reprint of matter written by him and not copyrighted.

So, again, a legal writer is entitled to prevent the issue as his of Legal writer. works or editions not of his production. In *Archbold v. Sweet* (b) the plaintiff was the author of a book on a legal subject, of which he had sold the copyright to the defendant. The plaintiff refusing to re-edit the book, the defendant had it edited by another, and the plaintiff thereupon came forward to complain of the inaccuracies which he alleged to be contained in the new edition. Lord Tenterden, C. J., after remarking on the close analogy between that case and those in which an inferior article was sold in the name of a well-known manufacturer, the injury being in the latter case to the sale of the goods, in the former to the character of the author, laid down to the jury that if the new edition, in the form in which it was put forth, would be understood by purchasers who paid reasonable attention to its contents to be by the plaintiff, their verdict must be in his favour.

So, again, a painter will be protected from having exhibited Painter. as his a picture which he has not painted (c), and a medical man Medical man. who compounds medicines from having spurious medicines sold as his (d).

In all such cases the plaintiff must of course show that deception Deception must be probable. is probable, or he cannot succeed in obtaining the relief he seeks. Thus, where an artist painted a picture, and another person exhibited a diorama imitated from it, it was held that there could be no deception or injury, though if the plaintiff's picture had been a diorama the case would have been different (e). So where a person who wrote songs under the name of Claribel sought to restrain the publication of a song described as "written by Claribel," no mention being made of the composer's name, though the music given was not that of Claribel, it was decided that the words "written by" did not imply that the music was also composed by Claribel, and the injunction was refused (f).

(a) 11 Biss. 459.

(b) 1 M. & Rob. 162. Cf. *Lee v. Gibbings*, 67 L. T. N. S. 263.

(c) *Martin v. Wright*, 6 Sim. 297.

(d) *Clark v. Freeman*, 11 Beav. 112.

(e) *Martin v. Wright*, 6 Sim. 297.

(f) *Barnard v. Pillow*, W. N. 1868, p. 94. And see *Secley v. Fisher*, 11 Sim. 581; and *Archbold v. Sweet*, 1 M. & Rob. 162.

*Clark v.
Freeman.*

The decision in *Clark v. Freeman* (a) has been much discussed with respect to the right a man has in his name. In that case the plaintiff, Sir James Clark, was an eminent physician, who filed a bill to restrain the advertisement and sale by the defendant of certain pills termed by him "Sir J. Clarke's Consumption Pills," the advertisements being so framed as to be calculated to induce the public to buy the pills as being of the plaintiff's invention. Lord Langdale, M. R., refused to grant the injunction, on the ground that there was no injury to property; but apparently not without some doubt, since he gave leave for the case to be mentioned again to him if cases in support of the bill could be produced. He did not, however, think the cases mentioned to him (b) sufficient to warrant him in granting the injunction, but at the same time he remarked that if "Sir James Clark had been in the habit of manufacturing and selling pills, it would have been very like the other cases in which the Court had interfered for the protection of property." The principle on which Lord Langdale's decision was based was that the Court would not interfere where the name pirated by the defendant had not become known to the public in connection with a manufactured article, but was merely a name under which an individual had acquired a certain reputation (c). It is evident, however, that the sale of quack medicines under the name of an eminent physician would tend to destroy his reputation and the confidence of his patients in him, and thereby to cause him a far more severe pecuniary loss than would be incurred by the sale of a few boxes of pills or copies of a book being lost to him. Later judges have, therefore, been of opinion that the case in question "might have been decided in favour of the plaintiff, on the ground that he had a property in his own name" (d).

(a) 11 Beav. 112.

(b) *Lord Byron v. Johnston*, 2 Mer. 29; and *Routh v. Webster*, 10 Beav. 561.

(c) See *Delondre v. Shaw*, 2 Sim. 237.

(d) *Per Cairns, L. J.*, in *Maxwell v. Hogg*, L. R. 2 Ch. 307. In *Springhead Spinning Co. v. Riley*, L. R. 6 Eq. 561, Malins, V.-C., went even farther. And in *In re Riviere*, 26 Ch. D. 48, 53, Lord Selborne, C., observed "that case has seldom been cited but to be disapproved; could not a professional man be injured in his profession by having his name associated with a quack medicine?" In *Wil-*

iams v. Hodge & Co., 84 L. T. (Journal) 134, a very similar case, Kay, J., said that the decision in *Clark v. Freeman* "was rather a surprising one, and one which he had always thought was not sufficiently considered"; but he did not feel himself at liberty to disregard it on an interlocutory application, in the absence of authority to the contrary. The expressions of opinion of Lord Cairns, Lord Selborne and Malins, V.-C., had apparently not been brought to his notice. Lord Westbury, C., however, spoke of the decision at all events with-

Whatever rights a man may, irrespective of contract, have in his own name, so as to be able to prevent the unauthorised use of it by another, it is always open to him to modify those rights by contract, whether by way of permitting others to use his name in a certain manner (a), or by way of restraining his own use of it to a certain extent (b). Thus, where a publisher had sold to the defendants the copyright of an annual, entitled "Beeton's Christmas Annual," he himself entering into their service, it was held that the defendants were entitled to continue the annual publication under that same name, even after the plaintiff had ceased to remain in their employ, and had become unwilling for his name to be used by them in connection with a work not of his production (c). But it seems that, although a contract by which a man binds himself to limit in some way his use of his own name can be enforced, a contract so binding him cannot be made by the representative of his estate in bankruptcy, and if such a contract has been entered into, the bankrupt will be entitled to disregard it (d).

Contracts in respect of names.

The name of the editor of a publication, appearing upon the title page, forms no part of the title. Romilly, M. R., refused, therefore, to restrain the proprietors of a paper, who had agreed with their editor not to alter the title of their paper without mutual consent, from omitting the publication on the title page of the editor's name as such (e).

Name of editor.

It is clear that a man has a right to prevent the unauthorised use of his name by another person, apart from any special manufacture, where such use of it might involve him in legal or other difficulties. Thus, in *Routh v. Webster* (f) a bill was filed to restrain the provisional directors of a joint-stock company, called "The Economic Conveyance Company," from using the plaintiff's name in their prospectuses as a trustee of their company without

Where name is used so as to mislead.

out disapprobation: *Leather Cloth Co.'s case*, 4 De G. J. & S. 137. *Clark v. Freeman* has been again observed upon by Kekewich, J., in *Lee v. Gibbings*, 67 L. T. N. S. 263, in which he said, "I do not think that after the observations of Malins, V.-C., Lord Cairns, and Lord Selborne, I ought to hold or regard it as otherwise than erroneously decided."

(a) *Ward v. Beeton*, L. R. 19 Eq. 207. See *Condy v. Mitchell*, 37 L. T. N. S. 268, 766; *Hallett v. Cumston*, 110 Mass. 29; *Weed v. Peterson*, 12 Abb. Pr. N. S.

178; *Coe v. Bradley*, 9 U. S. 207; 541.

(b) *Ainsworth v. Bentley*, 10 W. R. 630; *Ward v. Beeton*, L. R. 19 Eq. 207. *Peltz v. Eichele*, 100 Mass. 207. *Bradley*, 9 U. S. 207; 541.

(c) *Ward v. Beeton*, L. R. 19 Eq. 207. See *Gage v. Canadian Publishing Co.*, 11 Can. Sup. Ct. 306.

(d) *Helmhold v. Helmholtz Manufacturing Co.*, 53 How. St. 103. And see *Walker v. Mottram*, 19 Ch. D. 355.

(e) *Crookes v. Petter*, 6 Jur. N. S. 1131.

(f) 10 Beav. 561.

his authority. The defendants setting up by way of defence that what had been done had been done inadvertently, and stating their intention of discontinuing their misrepresentations, the Master of the Rolls granted the injunction, holding that the defendants were not entitled "to use the name of any person they pleased, representing him as responsible in their speculations, and to involve him in all sorts of liabilities, and then to be allowed to escape the consequences by saying they had done it by inadvertence," and also that the plaintiff was in nowise bound to surrender his right to the injunction, trusting to the assurances of the defendants as to their intentions for the future. This decision has been generally approved as an "authority for preventing the improper use of a man's name against his will; not for the restraint of a libel, for no libel was involved" (a).

Trade libe...

Where, however, a man's name has been used against his will in such a manner as to be libellous, or where statements have been made disparaging the goods sold under his name or trade mark, or threatening persons dealing in his goods, a more difficult question is raised, and one which has not always been answered in the same way. With respect to libels, Lord Cottenham, C., said (b), that the Libel Act "appointed a jury as the proper tribunal for trial of injuries to the person by libel or defamation; and that the liberty of the press consisted in the unrestricted right of publishing, subject to the responsibilities attached to the publication of libels, public or private." The principle that the publication of a libel was a crime, and that the Court of Chancery had no jurisdiction to prevent the commission of crimes, except in such cases as those relating to the protection of infants, was laid down by Lord Eldon in 1818 (c), and after that time the Equity judges frequently stated that it was not within the proper scope of their authority to restrain the publication of libels (d). There were, indeed, cases

(a) *Per* Lord Cairns, C., in *Prudential Assurance Co. v. Knott*, L. R. 10 Ch. 142. In *Webster v. Webster*, 3 Swanst. 490, n., the injunction was refused because there was no injury to be apprehended. In *Tudor v. Tudor*, W. N. 1873, p. 72, there was an express contract. See *Bullock v. Chapman*, 2 De G. & Sm. 211; *Dixon v. Holden*, L. R. 7 Eq. 488; *Reid v. Sibbald*, 18 Journ. of Juris. 392; and cases *infra*.

(b) *Fleming v. Newton*, 1 H. L. C. 376.

This case was a Scotch one, and the Lord Chancellor was speaking with reference to the Scotch Libel Act, but his remarks are equally applicable to cases arising in England, and under Order XXXVI. rule 2, of the Rules of 1883, a defendant in a libel case can still insist upon a jury.

(c) *Gee v. Pritchard*, 2 Swanst. 413.

(d) *Martin v. Wright*, 6 Sim. 297; *Seeley v. Fisher*, 11 Sim. 581; *Clark v. Freeman*, 11 Beav. 112; *Emperor of*

in which it was thought that where an injury was occasioned or threatened to a right of property by a libellous statement, the Court had jurisdiction to interfere to protect that right of property (a), but, practically speaking, cases which involved the consideration of libellous statements were left to the Courts of Common Law (b).

The Judicature Act, 1873, however, introduced a new element into the discussion by enacting (§ 25, sub-s. 8) that "an injunction may be granted by an interlocutory order of the Court in all cases in which it shall appear to the Court to be just or convenient that such order should be made"; and in *Thorley's Cattle Food Co. v. Massam* (c), Vice-Chancellor Malins suggested that this enactment had conferred upon the Court more extensive powers than those which it previously possessed, and that an injunction might have been granted by virtue of those powers to restrain an injurious and unjust statement. Numerous cases have since been decided with respect to the effect of the section, in some of which expressions were employed which were calculated to lead to the belief that the power to grant injunctions where it was thought to be "just or convenient" conferred a power to grant injunctions in cases in which no legal remedy previously existed (d). It is now, however, settled—and this is not opposed to the observations before referred to—that the right view is that the section has enlarged the powers of the Court, not by enabling the Court to grant relief in cases where none was obtainable before in any of the Superior Courts, but by way of giving each branch of the High Court power to grant relief in cases which could previously be brought only in the same or a different form before some other

Effect of the
Judicature
Act, 1873.

Austria v. Day, 2 Giff. 628; 3 De G. F. & J. 217 (in particular *per* Turner, L. J.); *Mulkern v. Ward*, L. R. 13 Eq. 619; *Browne v. Freeman*, W. N. 1873, p. 178; *Prudential Assurance Co. v. Knott*, L. R. 10 Ch. 142; *Fisher v. Apollinaris Co.*, *ib.* 297. The same view has been taken in India: *Shepherd v. Trustees of the Port of Bombay*, Ind. L. R. 1 Bomb. 132; and in America: *Mauger v. Dick*, 55 How. Pr. 132.

(a) This was especially the view of Malins, V.-C. See *Dixon v. Holden*, L. R. 7 Eq. 488; *Springhead Spinning Co. v. Riley*, L. R. 6 Eq. 561; *Rollins v. Hinks*, L. R. 13 Eq. 355; *Axmann v.*

Lund, L. R. 18 Eq. 330. And see also *Emperor of Austria v. Day*, 3 De G. F. & J. 217; *Maxwell v. Hogg*, L. R. 2 Ch. 307; *James v. James*, L. R. 13 Eq. 421.

(b) For the principles by which the Courts of Common Law were guided, see *Wren v. Weild*, L. R. 4 Q. B. 730; *Western Counties Manure Co. v. Lawes' Chemical Manure Co.*, L. R. 9 Ex. 218; *Mellin v. White*, (1894) A. C. 154.

(c) 6 Ch. D. 582.

(d) See *Beddow v. Beddow*, 9 Ch. D. 89; *Quartz Hill Consolidated Gold Mining Co. v. Beall*, 20 Ch. D. 501.

branch of the Court (a); so that, as Cotton, L. J., said in the case of *North London Railway Co. v. Great Northern Railway Co.* (b), "where there is a legal right which was, independently of the Act, capable of being enforced either at law or in equity, there, whatever may have been the previous practice, the High Court may interfere by injunction in protection of that right."

Conditions
necessary for
injunction.

The injunction may be granted to restrain the continued publication of a libel which has been found to be so by the verdict of a jury (c), or it may be granted to restrain the publication of statements which have not been submitted to a jury (d). But where the Court is asked to grant an injunction, especially on an interlocutory application, without the assistance of a jury, the jurisdiction which it possesses so to do is one which must be exercised very carefully (e), and it ought not to be exercised unless the statements of which complaint is made are proved to be untrue (f), unless they are injurious to the plaintiff (g), with reference to his trade or property (h), and are so clearly libellous that a contrary verdict of a jury would be set aside as unreasonable (i), unless it is proved that the defendant intends to continue

(a) *Day v. Brownrigg*, 10 Ch. D. 294; *Ward v. Drat*, L. J. N. of C. 1878, p. 67; *Gaskin v. Balls*, 13 Ch. D. 324; *Dicks v. Brooks*, 15 Ch. D. 22 (*per* Bacon, V.-C.); *Mellin v. White*, (1895) A. C. 154, 163.

(b) 11 Q. B. D. 30.

(c) *Saxby v. Easterbrook*, 3 C. P. D. 339; *Hinrichs v. Berndes*, W. N. 1878, p. 11.

(d) As in *Thomas v. Williams*, 14 Ch. D. 864; *Collard v. Marshall*, (1892) 1 Ch. 571; *Pink v. Federation of Trades & Labour Union*, 67 L. T. N. S. 258. And see *Jarradale Timber Co. v. Temperley*, 11 Times L. R. 119; *ib.* 305. Cf. *Lee v. Gibbings*, 67 L. T. N. S. 263, and *Royal Baking Powder Co. v. Wright, Crossley & Co.*, 15 P. R. 677, and on appeal 16 P. R. 217.

(e) *Quartz Hill Consolidated Gold Mining Co. v. Beall*, 20 Ch. D. 501; *Armstrong v. Armit*, 2 Times L. R. 887; *Coulson & Sons v. Coulson & Co.*, 3 *ib.* 846; *Liverpool Household Stores Association v. Smith*, 37 Ch. D. 170. See *Marks v. Conservative Newspaper Co., Ltd.*, 3 Times L. R. 244; *Collard v. Marshall*, (1892) 1 Ch. 571; *Lipton, Ltd. v. Duncans*, Times, Nov. 26th, 1898.

(f) *Halsey v. Brotherhood*, 15 Ch. D. 514; 19 *ib.* 386; *Burnell v. Tate*, 45 L. T.

N. S. 743; *Anderson v. Liebig's Extract of Meat Co., Ltd.*, *ib.* 757; *Quartz Hill, &c. Co. v. Beall*, 20 Ch. D. 501; *Benbow v. Low* (1), 23 Sol. J. 819; *Roper's, &c. Co. v. Cope-man's, &c., Association, Ltd.*, 28 *ib.* 218; *Armstrong v. Armit*, 2 Times L. R. 887; *Coulson & Sons v. Coulson & Co.*, 3 *ib.* 846; *Liverpool Household Stores Association v. Smith*, 37 Ch. D. 170; *Poulett v. Chalton & Windus*, 32 Sol. J. 24; *Nähmaschinen Fabrik Vormals Frister & Rossmann Aktiengesellschaft v. Singer Manufacturing Co.*, 10 P. R. 310; *Incandescent Gas Light Co. v. New Incandescent Gas Lighting Co.*, 76 L. T. N. S. 47, which shows that it is a good defence that the statements are substantially true. And see *Clover v. Royden*, L. R. 17 Eq. 190.

(g) *Dicks v. Brooks*, 15 Ch. D. 22. And see *Brook v. Evans*, 2 L. T. N. S. 740; *Bullock v. Chapman*, 2 De G. & Sm. 211.

(h) See *per* Lindley, L. J., in *Coulson & Sons v. Coulson & Co.*, 3 Times L. R. 846, with which compare the statement by North, J., in *Pollard v. Photographic Co.*, 40 Ch. D. 345.

(i) *Coulson & Sons v. Coulson & Co.*, 3 Times L. R. 846; *Liverpool Household Stores Association v. Smith*, 37 Ch. D. 170.

to make them (a), and that the injury will be irreparable, *i.e.*, incapable of compensation by damages (b), and unless (in cases of privilege) express malice is also established (c). Thus, in *Halsey v. Brotherhood* (d) the defendant had threatened intending purchasers from the plaintiff, alleging that the plaintiff was manufacturing in infringement of his, the defendant's, patent rights; and Jessel, M. R., and the Court of Appeal held that an injunction could not be granted unless the defendant persisted in making the statements after they had been proved to be false. In *Colley v. Hart* (e), it was held by North, J., that there was no jurisdiction to restrain the defendant from issuing a circular to the plaintiff's customers, alleging that the plaintiff was infringing his trade marks, and threatening proceedings, but at the trial of the action he appears to have been disposed to hold that such an action might properly lie if malice were proved (f). And in *Anderson v. Liebig's Extract of Meat Co., Ltd.* (g), Chitty, J., refused to restrain the company (who were taking proceedings to stop the plaintiff from selling his goods as "Baron Liebig's Extract of Meat" and using on the pots a photograph of the Baron) from circulating letters among the plaintiff's customers, stating that he was using the name and photograph without authority, on the ground that the company was not shown to be acting otherwise than *bonâ fide*, or to be stating that which was untrue (h).

In *Lee v. Gibbings* (i), it was held by Kekewich, J., that an author of a book who had sold the copyright to a publisher, could not restrain him from publishing the book in a mutilated form except on the ground of injury to reputation, the remedy for which was an action for libel, and that the Court ought not, except in

(a) *Quartz Hill, &c. Co. v. Beall*, 20 Ch. D. 501.

(b) *Armstrong v. Armit*, 2 Times L. R. 887.

(c) *Quartz Hill, &c. Co. v. Beall*, 20 Ch. D. 501; *Burnett v. Tate*, 45 L. T. N. S. 473; *Armstrong v. Armit*, 2 Times L. R. 887; *Coulson & Sons v. Coulson & Co.*, 3 *ib.* 846; *Liverpool Household Stores Association v. Smith*, 37 Ch. D. 170; *Incandescent Gas Light Co. v. New Incandescent Gas Lighting Co.*, 76 L. T. N. S. 47.

(d) 15 Ch. D. 514; 19 *ib.* 386. See the New York case of *Wolfe v. Burke*, 56 N. Y. 115. The precise question raised in *Halsey v. Brotherhood* is now

settled by § 32 of the Patents Act, 1883, under which numerous cases have been decided, but the general question of injunctions to restrain trade libels remains. See *Incandescent Gas Light Co. v. New Incandescent Gas Lighting Co.*, 76 L. T. N. S. 47.

(e) 6 P. R. 17.

(f) *Colley v. Hart* (2), 7 P. R. 101.

(g) 45 L. T. N. S. 757.

(h) And see *Nähmaschinen Fabrik Vormals Frister & Rossmann Aktiengesellschaft v. Singer Manufacturing Co.*, 10 P. R. 310. Cf. *Coats v. Chadwick*, (1894) 1 Ch. 347.

(i) 67 L. T. N. S. 263.

the case of a trade libel, to grant an interlocutory injunction to restrain a libel. In *Mellin v. White* (a), it was held by the House of Lords, that in order to maintain an action for a false statement disparaging the goods of a rival trader, proof of special damage (b) was necessary, and that for this purpose it was immaterial whether the remedy sought was injunction or damages; and it was doubted by Lord Herschell whether such an action could be maintained where the only disparagement consisted in vaunting the superiority of the defendant's goods either generally or in some particular respect (c). "In order to constitute disparagement," said Lord Watson, "which is, in the sense of law, injurious, it must be shown that the defendant's representations were made of and concerning the plaintiff's goods; that they were in disparagement of his goods and untrue; and that they have occasioned special damage to the plaintiff"; though, where the statement complained of is not merely a disparagement of the plaintiff's goods but is capable of being read as a disparagement of the plaintiff in the way of his trade, it may be a trade libel (d), in which case proof of special damage is unnecessary (e). In accordance with the view above expressed by Lord Herschell, the Court of Appeal in a recent case in which the sole cause of action disclosed by the statement of claim was that the defendants, who were rivals in trade of the plaintiffs, had falsely and maliciously published a statement that their goods were superior to the plaintiffs', ordered the statement of claim to be struck out as disclosing no reasonable cause of action and dismissed the action on the ground that the statement complained of, coming from rival traders, did not constitute a cause of action, whether special damage were alleged or not (f).

When
granted.

On the other hand, where the necessary facts are present, an injunction will be granted, as in *Thorley's Cattle Food Co. v. Massam* (2) (g), where it was established that the plaintiffs and defendants were both in possession of and entitled to use the same

(a) (1895) A. C. 154.

(b) As to the meaning of special damage, see *Ratcliffe v. Evans*, (1892) 2 Q. B. 524. And see *Empire Typesetting Machine Co. of New York v. Linotype Co.*, 79 L. T. N. S. 8.

(c) And see *Cohn v. People*, 149 Ill. 486; 41 Am. St. Rep. 304; *Covell v. Chadwick*, 153 Mass. 263; 25 Am. St. Rep. 625.

(d) *Empire Typesetting Machine Co. of*

New York v. Linotype Co., 79 L. T. N. S. 8.

(e) *South Hetton Colliery Co. v. North Eastern News Association*, (1894) 1 Q. B. 133.

(f) *Hubbuck & Sons v. Wilkinson, Heywood & Clark*, (1899) 1 Q. B. 86.

(g) 14 Ch. D. 763. And see *Hill v. Hart-Davies*, 21 Ch. D. 798; *Hermann Loog, Ltd. v. Bean*, 26 Ch. D. 306; *Hay-*

secret recipe in their respective businesses, and Malins, V.-C., and the Court of Appeal granted an injunction to restrain the defendants from publicly advertising that they alone were acquainted with the secret.

Where the plaintiff in an action for slander of title to a trade mark and his property therein dies, the cause of action survives to his legal personal representative (a).

Survival of cause of action.

The same principle on which misrepresentations by an original manufacturer with respect to the goods and business of a subsequent manufacturer are restrained, applies with even greater force to similar misrepresentations by the latter, and while it is open to any one to manufacture an unpatented article with the process of manufacture of which he has become acquainted, and also to describe it by the name applied to it by the original inventor so soon as that name shall have become *publici juris*—that is to say, descriptive of a specific article, but not of a specific maker—yet at the same time such subsequent manufacturer is not entitled to carry on an unfair competition in trade with the original maker or his successors in business, by means of assertions or representations that his own article is the only genuine one, or that the article of the original maker or his successors is spurious (b).

Misrepresentations by subsequent manufacturer.

And where such an assertion or representation is embodied in the title of the later manufacturer's article by its being styled the "original"—an appellation which would naturally suggest the idea of the article in question being the make of the original manufacturer—such fraudulent representation will usually be restrained (c). But in the entire absence of evidence as to deception, Wood, V.-C., refused to grant an injunction in a similar case (d), and from the result of later litigation between the same parties (e), it is clear that the presumption against a person who styles an article of his own manufacture, but not of his invention,

"Original."

ward & Co. v. Hayward & Sons, 34 Ch. D. 198; *Punch v. Boyd*, 16 L. R. Ir. 476.

(a) *Hatchard v. Mège*, 18 Q. B. D. 771.

(b) *James v. James*, L. R. 13 Eq. 421; *Thomas v. Williams*, 14 Ch. D. 864; *Liebig's Extract of Meat Co., Ltd. v. Anderson (2)*, 55 L. T. N. S. 206; *Hirsch v. Hirsch & Co.*, 80 L. T. (Journal) 283; *Briton Life Association, Ltd. v. Roberts*, 2 Times L. R. 319.

(c) *Cocks v. Chandler*, L. R. 11 Eq. 446; *Lazenby v. White*, 41 L. J. Ch. 354. So in *M. Melachrino v. R. Melachrino & Co.*, Chitty, J., May 29th, 1888, where the defendants had placed on their labels the words "R. Melachrino & Co. Original Egyptian cigarettes." And see *Hagg v. Darley*, 47 L. J. Ch. 567.

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

(e) *Browne v. Freeman*, W. N. 1873,

“the original,” may be rebutted. In *Dence v. Mason* (1) (a), the defendant was restrained from styling himself the original maker of the “essence of beef,” Malins, 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 as those complained of, since 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. In *Fullwood v. Fullwood* (2) (b), the defendants attempted to represent their business to be the original one, by assuming for it the date of establishment of the business which was really the first.

False representation of agency.

A dealer may not represent, contrary to the fact, that he is agent for a manufacturer (c); neither may a manufacturer represent, contrary to the fact, that a dealer is acting as agent for him (d). A trader who manufactures according to a particular process cannot obtain an injunction to restrain another trader from stating untruly that he manufactures according to that process, so long as the latter does not represent that his goods are the goods of the plaintiff. In civil proceedings traders can only sue in protection of their own interests and not to prevent the public from being cheated (e).

Deceptive labels and notices.

In other cases the attempt to deceive has been made in different forms: thus, in an early case (f), the defendant attempted to attract to himself the custom intended for the plaintiffs by an ingenious variation of their labels, his own labels being facsimiles of those of the plaintiffs, with only the difference that, whereas theirs contained the sentence “Manufactured by Day and Martin,” his bore the words “Equal to Day and Martin’s,” the “Equal to” being in very small type. So, in an American case (g), a dentist formerly employed by the Colton Dental Association, on setting up in business for himself, described himself in his notice as

p. 178. This was, however, before the cases under the Judicature Act, 1873, which see, *supra*.

(a) Dig. 534; 41 L. T. N. S. 573.

(b) 9 Ch. D. 176. And see *Green v. Rooke*, W. N. 1872, p. 49; *Wheeler v. Johnston*, 3 L. R. Ir. 284; *Whitney v. Hickling*, 5 Grant, Up. Can. Ch. 605; *Mossop v. Mason*, 18 *ib.* 453; *Blackwell v. Wright*, 73 N. Car. 310; *Woods v. Sands*, Dig. 467.

(c) *Howe v. McKernan*, 30 Beav. 547.

(d) *Coleman v. Flavel*, 12 Sawy. 220.

(e) *Native Guano Co., Ltd. v. Sewage Manure Co.*, 8 P. R. 125. And see *Freeman v. Sharp Brothers & Co., Ltd.*, 16 P. R. 205.

(f) *Day v. Binning*, C. P. Cooper, 489; 1 Leg. Obs. 205. See *Wolfe v. Alsop* (1) & (2), 10 V. L. R. (E.) 41; 12 *ib.* 421.

(g) *Colton v. Thomas*, 2 Brews. 308; R. Cox, 507. And see *Klotz v. Hecht*, 73 Fed. Rep. 822; *Garde v. Mitchell*, 17 V. L. R. 209. And see cases collected at p. 135.

“formerly operator at the Colton Dental Rooms,” “formerly operator at the” being printed very small. And in another American case (a) a former partner in a firm of dentists trading as “Morgan and Schuyler,” continued to carry on business at the old premises as “B. F. Schuyler, successor to Morgan and Schuyler,” the words preceding the old firm name being in such small letters as to be almost invisible. In *Mallan v. Davis* (b), a dentist who had practised for several years in Praed St. with the words “Old-established dentist” over the door, left that address; and the defendant, who practised as a dentist at another house in Praed St., put up a notice stating that the old-established dentist could be consulted there; and it was held that he had acted in a way calculated to deceive, but no injunction was granted, there having been a delay of three months, and the defendant giving an undertaking to combine his own name in a conspicuous way with the description.

Again, in *Franks v. Weaver* (c), the plaintiff sold a medicine which he had invented, and which he termed “Franks’ Specific Solution of Copaiba,” in bottles enclosed in wrappers, on which were printed directions for use, and testimonials. The defendant, an agent of the plaintiff, sold a preparation of his own, labelled “Chemical Solution of Copaiba.” The label went on to state that the plaintiff had invented the “Specific Solution,” and then gave the testimonials printed by the plaintiff as commendatory of the plaintiff’s medicine, and also the same directions for use as those given by the plaintiff. In *Sedon v. Senate* (d), a person who had sold a medicine to another, set up a new medicine under a similar description, and in his advertisement adopted verses which had been attached to the original medicine. In all these cases, except *Mallan v. Davis* (e), injunctions were granted.

Franks v. Weaver.

With respect to directions for the use of the article, it seems that, as Malins, V.-C., said in *Massam v. Thorley’s Cattle Food Co.* (1) (f), if the article produced by one person is the same as that produced by another, and the former is quite at liberty to produce the same article, then the directions used by the latter are the correct directions for the use of the former’s article, and he can

Directions for use.

(a) *Morgan v. Schuyler*, 79 N. Y. 490.

(b) 3 Times L. R. 221.

(c) 10 Beav. 297. And see *Siegert v. Findlater*, 7 Ch. D. 801; *Siegert v. Ehlers*, Dig. 432; *Dunbar v. Glenn*, 42 Wisc. 118.

(d) 2 V. & B. 220. And see *Wother-*

spoon v. Gray, Ct. Sess. Cas. 3rd Ser. II. 38, where the interdict was refused.

(e) 3 Times L. R. 221.

(f) 6 Ch. D. 574, 581. And see per Cotton, L. J., in *In re Leonard & Ellis*, 53 L. J. Ch. 611; and *Gessler v. Grieb*, 80 Wisc. 21; 27 Am. St. Rep. 20.

only repeat them. In fact, if he could not give the appropriate directions for using the article which he is entitled to make, his liberty to manufacture would be unduly interfered with. The decision in the above case was, however, reversed by the Court of Appeal (a) on the general question of representation, the imitation of the directions being referred to as an indication of fraudulent intention, and any trader who uses the same directions as another ought to take great care to prevent the possibility of deception.

Name of
patentee.

To describe articles formerly patented by the name of the former patentee is not necessarily fraudulent, since the name may be used as indicative of a principle of construction (b); but in an American case (c) an injunction was granted to restrain the defendant from marking goods of his own make as being made under the plaintiff's subsisting patent, notwithstanding an allegation by the defendant that the patent was invalid.

Mode of
packing.

The imitation of a peculiar manner of making up and packing goods may, in combination with other circumstances, be held to prove a fraudulent intention; and it seems that, even in the absence of other circumstances of fraud, if the imitation is very significant, and the evidence very conclusive, an injunction will be awarded (d).

Imitation
of line of
omnibuses.

The manner in which the Court interferes by way of injunction to prevent unfair competition in trade is well illustrated by a case which has always attracted a good deal of attention—that of the omnibus companies (e). In that case the plaintiffs were the proprietors of a line of omnibuses painted in a particular manner, with the words "Conveyance Company" and "London Convey-

(a) 14 Ch. D. 748. And see *Simmons Medicine Co. v. Simmons*, 81 Fed. Rep. 163.

(b) *Wheeler & Wilson Manufacturing Co. v. Shakespear*, 39 L. J. Ch. 36; *Singer Manufacturing Co. v. Loog* (3), 8 App. Cas. 15; and other cases in Ch. 4.

(c) *Washburn & Moen Manufacturing Co. v. Haish*, 9 Biss. 141.

(d) See *Edelsten v. Vick*, 11 Hare, 78; *Woollam v. Ratcliff*, 1 H. & M. 259; *Anglo-Swiss Condensed Milk Co. v. Swiss Condensed Milk Co.*, W. N. 1871, p. 163; *Lever v. Goodwin*, 36 Ch. D. 1; *Edge v. Johnson*, 9 P. R. 134; *McLean v. Fleming*, 96 U. S. 245; *Frese v. Bachof* (1), 13 Bl. C. C. 234; S. C. (2), 14 *ib.* 432; *Cleveland Stone Co. v. Wallace*, 52 Fed. Rep. 431; *New England Awl & Needle Co. v. Marlborough Awl & Needle Co.*, 168 Mass. 154. See also *Orr v. Diaper*, L. R. 4 Ch.

D. 92; and *Buck's Stove & Range Co. v. Kiechle*, 76 Fed. Rep. 758. And see cases collected at p. 139.

(e) *Knott v. Morgan*, 2 Keen, 213. See also *London General Omnibus Co. v. Felton*, 12 Times L. R. 213; *London Road Car Co. v. Era Omnibus Association*, Times, June 23rd, 1898, where the defendants were restrained on motion by the Court of Appeal from running omnibuses with a flag affixed thereto and otherwise got up like the plaintiffs' omnibuses without more clearly distinguishing their omnibuses from the plaintiffs', and at the trial the injunction was made perpetual by Cozens-Hardy, J., Times, April 28th, 1899; *Stone v. Carlan*, 13 Mo. L. R. 360; R. Cox, 115; *Marsh v. Billings*, 7 Cush. 322; R. Cox, 118; *Deis v. Lamb*, 29 N. Y. Sup. Ct. 537.

ance Company" upon them. The defendant ran omnibuses similarly painted, and dressed his servants in livery imitated from that of the plaintiffs' employés. On his being required to alter this, he made some mere colourable alterations, but really left the matter as it stood at first. Lord Langdale, M. R., on the case coming before him on motion to dissolve an interlocutory injunction, said that he had not the least doubt that the defendant intended to represent his omnibuses to the public as those of the plaintiffs. He said "it was not to be said that the plaintiffs had any exclusive right to the words 'Conveyance Company' or 'London Conveyance Company,' or any other words; but they had a right to call upon that Court to restrain the defendant from fraudulently using precisely the same words and devices which they had taken for the purpose of distinguishing their property, and thereby depriving them of the fair profits of their business by attracting custom on the false representation that carriages, really the defendant's, belonged to and were under the management of the plaintiffs." This case was not at all a case of trade mark, though reference has been made to it as such; the Master of the Rolls expressly denied any exclusive right in the words painted on the vehicles, and personally altered the terms of the injunction so as to avoid creating such a right. In the language of Wood, V.-C. (a), "the defendant might have had those words painted on a yellow omnibus without objection, and so of the other resemblances; the wrong lay in their accumulation, not in any one of them alone." The value of the case really consists in the example it affords of the way in which the aggregation of a number of circumstances, individually comparatively harmless, may produce a result injurious to an individual and obnoxious to the law; and also of the manner in which the law will interfere to protect the interests of honest trade.

Where A. had surreptitiously obtained possession of some etchings by B., and had advertised them for exhibition, and a catalogue of them, Lord Cottenham, C., held that there was a title to relief alike on the ground of injury to property and on that of breach of trust (b).

As to the cases which have been decided in respect of trade secrets, the general rule may be stated as being that any person

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

(b) *Prince Albert v. Strange*, 1 Mac. &

G. 25. See *Pollard v. Photographic Co.*, 40 Ch. D. 345. And see *Lamb v. Evans*, (1893) 1 Ch. 218, 229, per Bowen, L. J.

who has, without the use of unfair means, become acquainted with the mode of compounding a secret unpatented preparation, may make and sell the compound, provided he does not lead the public to suppose that his preparation is the manufacture of the original discoverer or of his successors in business; and he may even call the compound made by himself by the same name as that given by the original discoverer to his, so long as he does not sell his own goods as and for those of another (a). On the other hand, where the knowledge of the secret process has been acquired by means of a breach of trust, neither the person who has committed the breach of trust, nor any one to whom he has imparted his discovery, will be allowed to make use of the information so surreptitiously acquired (b).

Contract not to use or divulge another's secret.

Again, "there is no doubt whatever that where a party who has a secret in a trade employs persons under contract express or implied, or under duty express or implied, those persons cannot gain the knowledge of that secret and then set it up against their employer" (c); and, stating it generally, where one person has entered into a contract, express or implied (d), with another person, to keep that other person's secret, and not to divulge it, nor to use it for his own advantage, he will be restrained by an injunction from so divulging or using the secret in question (e); and so will

(a) *James v. James*, L. R. 13 Eq. 421; *Liebig's Extract of Meat Co. v. Hanbury*, 17 L. T. N. S. 298; *Condy v. Mitchell*, 37 *ib.* 268, 766; *Carter v. Goetze*, 2 Keen, 581; *Singleton v. Bolton*, 3 Doug. 293; *Williams v. Williams*, 3 Mer. 157; *Cannah v. Jones*, 2 V. & B. 218. And see the comments on that case in *Morison v. Moat*, 9 Hare, 241. But, of course, when the name has become a trade mark, no one but the proprietor can use it. The question is whether the name is descriptive of the article or distinctive of the manufactory. See *Massam v. Thorley's Cattle Food Co.* (2), 14 Ch. D. 748.

(b) *Williams v. Williams*, 3 Mer. 157; *Youatt v. Winyard*, 1 Jac. & W. 394; *Tipping v. Clarke*, 2 Hare, 383; *Morison v. Moat*, 9 *ib.* 241; 21 L. J. Ch. 248; *Estcourt v. Estcourt Hop Essence Co.*, L. R. 10 Ch. 276; *Portal v. Hine*, 4 Times L. R. 330.

(c) Per Lord Cranworth, L. J., in *Morison v. Moat*, 21 L. J. Ch. 248. And see *Merryweather v. Moore*, (1892) 2 Ch. 518; *Lamb v. Evans*, (1892) 3 Ch. 462;

(1893) 1 Ch. 218; *Little v. Gallus*, 4 App. Div. N. Y. 569; *Simmons Medicine Co. v. Simmons*, 81 Fed. Rep. 163.

(d) See *Tipping v. Clarke*, 2 Hare, 383; *Weston v. Hemmons*, 2 V. L. R. Eq. 121.

(e) *Sedon v. Senate*, 2 V. & B. 220; *Bryson v. Whitehead*, 1 S. & S. 74; *Green v. Folgham*, *ib.* 398; *Tipping v. Clarke*, 2 Hare, 383; *Morison v. Moat*, 9 *ib.* 241; 21 L. J. Ch. 248; *Hagg v. Darley*, 47 *ib.* 567; *Portal v. Hine*, 4 Times L. R. 330; *Merryweather v. Moore*, (1892) 2 Ch. 518; *Whitney v. Hickling*, 5 Grant Up. Can. Ch. 605; *Weston v. Hemmons*, 2 Vict. L. R. Eq. 121; *Peabody v. Norfolk*, 98 Mass. 452; *Salomon v. Hertz*, 40 N. J. Eq. 400, where, however, it was held that the defendant ought not to be restrained from divulging where or from whom the plaintiff bought his materials, or to whom he sold his goods, or the prices at which he bought and sold. In *Newbery v. James*, 2 Mer. 446, Lord Eldon declined to issue an injunction, on the ground that the Court could have no

a person who is acting in collusion with him (a); and a contract by which, on the sale of a trade secret, the vendor has bound himself not to use that secret, is not invalid as being in restraint of trade (b). Where the defendant, who had become acquainted with a trade secret, stood by and allowed the plaintiff to purchase it, without disclosing that he was acquainted with it, it was held that he was estopped from setting up his previous knowledge against the plaintiff, and an injunction was granted to restrain him from using it (c).

Where the defendant is availing himself of a breach of faith or of contract by means of the use of a certain designation for his goods, in such a case the defendant will be restrained from the use of such designation, although the plaintiff may have no exclusive right in the same, apart from such special circumstances (d).

No one will be allowed to use the name of a well-known article, with the secret recipe of which he is unacquainted, upon goods of his own make, so as to represent the spurious goods to be genuine (e); nor is it a good defence to say that the purchasers of the article did not know the name of the original manufacturer, for "one man may quite well pass off his goods as the goods of another if he passes them off to people who will accept them as the manufacture of another, although they do not know that other by name at all" (f); but it seems that if a person has an equal right to the use of the name with the person who is acquainted with the secret in accordance with which the goods are manufactured, the latter, at all events, cannot restrain him from the use of the mark, whatever remedy may be open to the

Name of
secret manu-
facture.

Cannot be
used in
ignorance of
true recipe.

means of judging as to its infringement: *Little v. Gallus*, 4 App. Div. N. Y. 569.

(a) *Portal v. Hine*, 4 Times L. R. 330; *Peabody v. Norfolk*, 98 Mass. 452; *Salomon v. Hertz*, 40 N. J. Eq. 400.

(b) *Bryson v. Whitehead*, 1 S. & S. 74; *Hagg v. Darley*, 47 L. J. Ch. 567; *Jarvis v. Peck*, 10 Paige, 118. And see *Leather Cloth Co. v. Lonsont*, L. R. 9 Eq. 352; *Allsopp v. Wheatecroft*, L. R. 15 Eq. 59; *Brewer v. Lamar*, 69 Ga. 656. In *Vickery v. Welch*, 19 Pick. 523, the Sup. Ct. of Mass. held that a person who had agreed to sell a secret process ought to have covenanted to communicate the secret to the purchaser and to no one else.

(c) *Champlin v. Stoddart*, 37 N. Y.

Sup. Ct. 300.

(d) *Morison v. Moat*, 9 Hare, 241. And see *Green v. Folgham*, 1 S. & S. 398; *James v. James*, L. R. 13 Eq. 421; *Estcourt v. Estcourt Hop Essence Co.*, L. R. 10 Ch. 276; *Weston v. Hemmons*, 2 V. L. R. Eq. 121. In *Canham v. Jones*, 2 V. & B. 218, and *Green v. Rooke*, W. N. 1872, p. 49; L. J. N. of C. 1872, p. 54, no fraud was proved.

(e) *Cotton v. Gillard*, 44 L. J. Ch. 90; *Ansell v. Gaubert*, Dig. 163; *Birmingham Vinegar Brewery Co. v. Powell*, (1897) A. C. 710; *Daniel v. Whitehouse*, (1898) 1 Ch. 685.

(f) *Birmingham Vinegar Brewery Co. v. Powell*, (1897) A. C. 710, 715, per Lord Herschell.

public (a). If the person of whom complaint is made is acquainted with the secret process, and has been accustomed to use it, the objection to his use of the name does not arise (b), and such a person will not be restrained from using it at the suit of a person who has no right to use the recipe in the district in which the defendant trades (c).

Secret passes with owner's personal estate.

After the death of an inventor of a secret process, his son, who had learnt the secret in his employ, continued to make the article, but did not take out administration to the father, and it was held that without becoming his father's personal representative, he could acquire no right to prevent the use of the secret by another (d).

Green v. Folgham.

The manner in which the Court deals with a secret process is well exemplified by the case of *Green v. Folgham* (e). There the grandfather of the plaintiffs and defendant possessed the secret of a recipe for an ointment called "Dr. Johnson's Ointment for the Eyes." This secret he settled on his daughter at her marriage, and directed that at the death of the survivor of her and her husband it should be sold for the benefit of the children. The daughter communicated the secret to her eldest son and destroyed the recipe. On a bill being filed against the eldest son by the younger children, Leach, V.-C., decreed an account of the profits made by the defendant since his mother's death by the sale of the ointment, a reasonable allowance being made him for his time and trouble in preparing and vending the same. And the Vice-Chancellor went on to remark that if the secret could be made a subject of sale, the plaintiffs would be next entitled to ask from the Court that a sale should be directed accordingly. But inasmuch as the Court had no possible means either to communicate the secret to a purchaser with certainty, or to protect him in the enjoyment of it, a sale was, he said, impracticable (f). But, he continued, although the Court could not direct a sale, it had the power of taking a course which, in point of advantage, would be equivalent to the plaintiffs. It could inquire what would be the

(a) *Weston v. Ketcham* (1), 39 N. Y. Super. Ct. 54; S. C. (2), 51 How. Pr. 455.

(b) *Witthaus v. Braun*, 44 Md. 303. And see *Helmbold v. Helmbold Manufacturing Co.*, 53 How. Pr. 453; *Chadwick v. Covell*, 151 Mass. 190.

(c) *Manhattan Medicine Co. v. Wood*,

108 U. S. 218.

(d) *Hovenden v. Lloyd*, 18 W. R. 1132. And see *Singleton v. Bolton*, 3 Doug. 293; *Chadwick v. Covell*, 151 Mass. 190; and *Stewart v. Einstein v. Sawhill*, 64 U. S. Pat. Gaz. 1333.

(e) 1 S. & S. 398.

(f) See *Newbery v. James*, 2 Mer. 446.

value of the secret to sell, provided it could be made the subject of sale; and the annual profits which had actually been made by the sale of the ointment from the death of the mother would be a fair criterion by which that value might be estimated; and the Vice-Chancellor accordingly decreed the value to be ascertained at law, as at the date of the decree.

In connection with this subject it should be mentioned that when, as is frequently the case, the article manufactured by the secret process is a quack medicine, or an article intended to deceive the public, the Court will not struggle to protect the secret or to punish those who invade it (a). Fraudulent secret.

The rights which are possessed by the owner of a magazine, newspaper, or other literary publication, are of a very similar character to those which a person has in the goodwill of a business carried on by him. Just as a name affixed to a shop conveys to customers the idea of a certain degree of excellence, with which the articles sold by the person using that name are associated in their minds; so the title prefixed to a periodical, or its general appearance, conveys to those who take it up the impression that the contents of that publication will be found to be up to the standard to which former editions of the simulated publication have attained. Like goods bearing a trade mark, literary publications carry with them wherever they go the guarantee for their quality, and the representations conveyed by their titles are made to all into whose hands they may come, not merely to the original purchaser. With the doctrine of trade marks that of the titles of literary works has also progressed, so that in this also it has been said that "a publisher or author has either in the title of his work, or in the application of his name to the work, or in the particular marks which designate it, a species of property similar to that which a trader has in his trade mark, and may, like a trader, claim the protection of a Court of Equity against such a use or imitation of the name, mark, or designations as is likely, in the opinion of the Court, to be a cause of damage to him in respect of that property" (b). Literary production.

The earliest of the cases with respect to the titles of publications *Hogg v. Kirby*.

(a) *Williams v. Williams*, 3 Mer. 157; *Estcourt v. Estcourt Hop Essence Co.*, L.R. 10 Ch. 276; *Kohler Manufacturing Co. v. Beshore*, 59 Fed. Rep. 573; *Siebert*

v. Abbott (2), 79 N. Y. Sup. Ct. 243.

(b) *Per Miller, J.*, in *Robertson v. Berry*, 50 Md. 591. See, however, *Walter v. Emmott*, 54 L. J. Ch. 1059.

was *Hogg v. Kirby* (a), before Lord Eldon, C., in 1803. The plaintiff was the proprietor of a monthly magazine, called "The Wonderful Magazine," which was in fact edited by the plaintiff, though the defendant's name was used as that of the publisher. At the completion of the fifth number, the defendant refused to allow the longer use of his name, and the arrangement was accordingly discontinued, and the accounts between the parties finally settled. The plaintiff then put out a notice stating that he would publish the sixth number, which he did; but on the following day a new magazine was published by the defendant, under the same title as the old one, but with the addition of "New Series Improved, printed for Kirby & Scott," and it was announced that it was intended to issue this monthly. The plaintiff then instituted a suit to check the piracy, and was able to point to several circumstances, in addition to the title, which indicated an intention of inducing the belief that the work was in fact a continuation of the plaintiff's. Lord Eldon, in his judgment, after alluding to the circumstance that the plaintiff's counsel had argued the case on the several grounds of copyright, fraud, and contract, said that he should state the question to be, "not whether the defendant's work was the same as the plaintiff's, but, in a question between those parties, whether the defendant had not represented it to be the same,"—in fact, resting the case upon fraud on the part of the defendant. His Lordship held that the defendant's intention did appear to be to represent his work as a continuation of the plaintiff's, "taking the credit which had been acquired by that to his own" (b), and the injunction was accordingly granted, but in such terms as to extend only to the pretence of the defendant's work being a continuation of the plaintiff's (c).

*Spottiswoode
v. Clarke.*

In *Spottiswoode v. Clarke* (d), where the plaintiff published "The Pictorial Almanack," and the defendant "Old Moore's Pictorial Almanack," there being certain similarities between the wrappers

(a) 8 Ves. 215. And see the early Scotch cases of *In re Edinburgh Correspondent Newspaper*, Ct. Sess. Cas., 1st Ser. I. 407, n.; and *Constable & Co. v. Brewster*, *ib.* III. 215.

(b) See *Longman v. Winchester*, 16 Ves. 269, in which Lord Eldon explained his decision in the present case.

(c) In *Strahan v. King*, Dig. 539, the proprietors of the "Contemporary Re-

view" sought to restrain their publishers and a former assistant editor from issuing the "Nineteenth Century," alleging among other things that the defendants were representing the latter to be the plaintiffs' Review; the Vice-Chancellor, however, held that the charges failed, and refused to grant an injunction. And see *Clowes v. Hogg*, W. N. 1870, p. 268; *ib.* 1871, p. 40.

(d) 2 Ph. 154.

of the two works, Lord Cottenham, denying that trade marks had anything to do with the case, said that it was difficult to believe that no fraud was intended, but that if such were the case, the attempt was very clumsy. And he felt so much doubt as to the legal right that, on the balance of convenience, he dissolved the injunction which had been granted by the Vice-Chancellor of England, giving the plaintiff leave to bring an action, and ordering the defendant to keep an account.

In both of the above cases fraud was the *ratio decidendi*, the actions of the defendants being examined with a view to the discovery of their motives and intentions. But at the present date the rule is that even though one person may have adopted in ignorance and *bonâ fide* a name coincident or nearly coincident with that employed by another person, yet he is bound to discontinue the use of that name so assumed as soon as he is made acquainted with the fact of its earlier employment, and the previous employer of the name is entitled to obtain an injunction against him, unless by his own laches or other default he has lost the rights which he otherwise would have had. The principle enunciated by Wood, V.-C., in *McAndrew v. Bassett (a)*, would be equally applicable to the case of a title of a periodical: that is to say, that although A. may have innocently used the title employed by B., yet if he continues to trade upon B.'s reputation after being made aware of his error, he does so fraudulently.

Title of periodical.

The modern doctrine was thus stated by the L.JJ. in the "Sporting Life" case (*b*): "It appears to us that there is nothing analogous to copyright in the name of a newspaper, but that the proprietor has a right to prevent any other person from adopting the same name for any other similar publication." And in *Clement v. Maddick (c)*, in which case the plaintiffs were the publishers of "Bell's Life," and the defendants the originators of a "Penny Bell's Life," it was said by Stuart, V.-C., that "This is an application in support of the right to property. It has been argued on behalf of the defendants that, unless a fraudulent intention is made out, the plaintiffs are not entitled to an injunction. That is a view of the law to which I cannot accede. Lord Cottenham, in

Fraudulent intention need not be proved.

(a) 33 L. J. Ch. 561. And see *Williams v. Osborne*, 13 L. T. N. S. 498; and *Singer Manufacturing Co. v. Loog* (3),

8 App. Cas. 15 (*per* Lord Blackburn).

(b) *Kelly v. Hutton*, L. R. 3 Ch. 708.

(c) 1 Giff. 98.

the case of *Millington v. Fox* (a), has declared that where a trade mark has been innocently and even unconsciously made use of to the injury of another, the owner of the trade mark is entitled to the protection of this Court."—"The defendants' whole case appears to rest on the fact that they intended to commit no fraud; that they had no fraudulent intention in adopting the words 'Bell's Life,' and thought that by prefixing the word 'Penny' to the title they had sufficiently warned the public that they were not purchasing the plaintiffs' paper. But 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," and where deception is probable, an injunction will be granted (b). In

(a) 3 My. & Cr. 338.

(b) Thus, injunctions were granted in the following cases:—*Edmonds v. Benbow*, Dig. 33 ("The Real John Bull" imitated by "The Old Real John Bull"); *In re The Edinburgh Correspondent Newspaper*, Ct. of Sess. Cas. 1st Ser. I. (new ed.) 407, n. ("The Edinburgh Correspondent," name copied); *Constable & Co. v. Brewster*, Ct. of Sess. Cas. 1st Ser. III. 215 (new ed. 152) ("The Edinburgh Philosophical Journal" by "The New Series of the Edinburgh Philosophical Journal"); *Prowett v. Mortimer*, 2 Jur. N. S. 414 ("The John Bull and Britannia" by "The True Britannia"); *Ingram v. Stiff*, 5 Jur. N. S. 947 ("The London Journal" by "The London Daily Journal"); *Chance v. Sheppard*, Dig. 317 ("The Bedfordshire Express and General Advertiser for the Counties of Cambridge, Hertfordshire, Huntingdonshire, and Middlesex" by "The Bedfordshire Express and General Advertiser for the County"); *Corns v. Griffiths*, W. N. 1873, p. 93 ("The Iron Trade Circular—Ryland's" by "The Iron Trade Circular—edited by Samuel Griffiths"); *Metzler v. Wood*, 8 Ch. D. 606 ("Hemy's Royal Modern Tutor for the Pianoforte" by "Hemy's New and Revised Edition of Jousse's Royal Standard Pianoforte Tutor"); *Hutchings v. Sheard*, W. N. 1881, p. 20 ("The Violin School, by J. D. Loder" by "J. D. Loder's Celebrated Violin School, edited, revised, and enlarged by T. Westrop"); *Primrose Press Agency v. Knowles*, L. J. N. of C. 1886, p. 43 ("Church and State" in each case); *Reuter's Telegram Co. v. International Guide Syndicate*, 94 L. T. (Journal) 437, 460 (unauthorised

use of "Official" as applied to a guide to an exhibition); *Reed v. O'Meara*, 21 L. R. Ir. 216 ("The Grocer and Oil Trade Review" imitated by "The Grocer and Wine Merchant and Irish Brewer and Distiller." An injunction was granted to restrain the word "Grocer," into which the plaintiffs' title was commonly abbreviated, from being used as the first and principal part of the defendants' title); *Matsell v. Flanagan*, 2 Abb. Fr. N. S. 459; R. Cox, 367 ("The National Police Gazette" by "The United States Police Gazette"); *Potter v. McPherson*, 28 N. Y. Sup. Ct. 559 ("Payson, Dunton, and Scribner's National System of Penmanship" by "Independent National System of Penmanship"); *Gage v. Canada Publishing Co.*, 11 Can. Sup. Ct. 306 ("Beatty's Headline Copy Book" imitated by "Beatty's New and Improved Headline Copy Book"); *Carey v. Goss*, 11 Ont. Rep. 619 ("The Commercial Traveller and Mercantile Journal," commonly abbreviated to "The Commercial Traveller," and "The Traveller," by "The Traveller"). And see *Keene v. Harris*, 17 Ves. 338; *Walter v. Head*, 25 Sol. J. 742, 757 (imitations of "The Times"); and *American Grocer Publishing Association v. Grocer Publishing Co.*, 32 N. Y. Sup. Ct. 398 (imitations of "The American Grocer"); *Munro v. Beadle*, 62 N. Y. Sup. Ct. 312 (reversing 46 U. S. Pat. Gaz. 448), where an injunction was granted at the instance of a publisher of detective stories under the name of "The Old Sleuth Library" to restrain the use of the word "Sleuth" for similar stories (cf. *Munro v. Tonsey*, 129 N. Y. 38; and *Munro v. Smith*, 62 N. Y. Sup. Ct. 419);

Walter v. Emmott (a), however, the Court of Appeal did not take the same view as to the jurisdiction in such cases being founded on property, and Cotton, L. J., said that "the principle upon which the Court has to decide these cases is this: It is not a question of property; it is the question whether what has been done by the defendant is in reason calculated to induce people to take his goods as those of the plaintiff, or, in other words, to pass off his goods, whatever they may be, as the goods of the plaintiff." And Bowen, L. J., said, "The principle which is involved seems to me to be the right of the Court, and the duty of the Court, to prevent damage being done to the business of a person who is lawfully carrying on his business, by acts, conduct, or representations, consisting either of acts or language, which are calculated to deceive the public, and persons who otherwise would deal with the plaintiff." However, even in this case it was not suggested that a fraudulent intention was necessary to enable relief to be given; and if that is so, the question whether property is or is not involved seems of little practical importance. Even if the theory that there is property in the name of a newspaper is admitted, that right is not invaded without a probability of deception being produced.

While, however, the fact that the defendant has adopted a title calculated to deceive is sufficient to entitle the plaintiff to his remedy, without it being necessary for him to go into the defendant's motives, he must prove the probability of deception, and if he cannot do this he will fail, even though there may be circumstances pointing to a fraudulent intention. Thus, where the proprietors of the "Era," one of the principal writers in which paper used the pseudonym of "Touchstone," sought to restrain the publication of "Touchstone, or the New Era," and alleged certain further resemblances between the two papers, the Court of Appeal rescinded the injunction which had been granted, on the ground that no deception could occur (b). And where the plaintiff sought

But deception must be probable.

Social Register Association v. Howard, 60 Fed. Rep. 270 (imitations of "Social Register" for a list of residents); *Investor Publishing Co. of Massachusetts v. Dobinson*, 72 Fed. Rep. 603 ("The United States Investor" and "The Investor").

(a) 54 L. J. Ch. 1059.

(b) *Ledger v. Ray*, Dig. 550. And no injunctions were granted in *Bradbury v. Bevan*, 39 L. J. Ch. 57 ("Punch" and

"Punch and Judy"); *Dicks v. Yates*, 18 Ch. D. 76 ("Splendid Misery, or East End and West End, by C. H. Hazelwood," and "Splendid Misery, by the author of Lady Audley's Secret, Vixen, &c."); *Dale v. Smith*, W. N. 1882, p. 145 ("The Plumber and Decorator and Journal of Gas and Sanitary Engineering" and "The Decorator, Plumber, and Gasfitter's Journal"); *Dale v. General Newspaper Co.*, 1 Times

to restrain the defendant from using the name "Post Office Directory," and it was shown that the name had been used by others than the plaintiff, and that the defendant had had the assistance of post office servants, it was held that no injunction could be granted (a). So, where both plaintiff and defendant sold under the name of "Castle Album" albums illustrated with pictures of castles, it was held that the name was descriptive of the thing, and that, even if the name were capable of appropriation at all, no injunction would be granted to protect it, unless it were proved that it was recognised as denoting exclusively the plaintiff's albums (b). Even if the title is not descriptive, and has been taken without alteration by the defendant, no injunction will be granted unless the plaintiff's paper has been long enough on sale to have acquired some reputation under the name (c). And the plaintiff must come with clean hands (d).

Titles of literary works protected generally.

Although the title of a periodical publication as a newspaper, magazine, or almanack most closely resembles a trade mark, on account of its repeated and continued use from time to time upon articles of a certain class, the protection afforded by the Court is extended to the title of any kind of literary production. Thus, the publishers of "The Birthday Scripture Text Book" succeeded in obtaining an injunction against persons who had brought out

L. R. 177 (same as above, and "The Plumbing and Decorating, Sanitary, Water, and Gas Engineering Chronicle"); *Cowen v. Hulton*, 46 L. T. N. S. 897 ("The Newcastle Daily Chronicle" and "The Sporting Chronicle and Prophetic Bell"); *Walter v. Emmott*, 54 L. J. Ch. 1059 ("The Mail" and "The Morning Mail." Here the style and price of the two papers were very different); *Jaffray v. Emmott*, Bacon, V.-C., July 3rd, 1885 ("The Birmingham Daily Mail" and "The Morning Mail"); *Borthwick v. The Evening Post, Ltd.*, 37 Ch. D. 449 ("The Morning Post" and "The Evening Post"); *Brett v. Bowles*, L. J. N. of C. 1890, p. 43; affirmed by C. A. April 30th, 1890 ("The Princess' Novellettes" and "The Princess"); *Houlston v. Morley*, 90 L. T. (Journal) 40 ("Enquire Within upon Everything" and "Enquire Within"); *Snowden v. Noah*, Hopk. 347; R. Cox, 1 ("The National Advocate" and "The New York National Advocate"); *Bell v. Locke*, 8 Paige, 75; R. Cox, 11 ("The Democratic Republican New Era" and "The New Era");

Stephens v. De Conto, 30 N. Y. Super. Ct. 343; R. Cox, 442 ("La Cronica" and "El Cronista"); *Osgood v. Allen*, 1 Holmes, 185 ("Our Young Folks, an Illustrated Magazine for Boys and Girls," and "Our Young Folks' Illustrated Paper"); *Tullcot v. Moore*, 13 N. Y. Sup. Ct. 106 ("The Little Red Book" and "The Red and White Book"); *Dunaway Publishing Co. v. North-West Printing Co.*, 11 Oreg. 322 ("The New North-West" and "The North-West News"); *Stokes v. Allen*, 63 N. Y. Sup. Ct. 526 ("The Good Things of Life," consisting of illustrations from a serial called "Life," and "The Spice of Life," consisting of illustrations from the "Fliegende Blätter," the refusal being based upon the different meaning of the same word in the two publications).

(a) *Kelly v. Byles*, 13 Ch. D. 682.

(b) *Schore v. Schmincke*, 33 Ch. D. 546.

(c) *Licensed Victuallers' Newspaper Co. v. Bingham*, 38 Ch. D. 139.

(d) *Talbot v. Judges*, 3 Times L. R. 398.

"The Children's Birthday Text Book," Lord Romilly, M. R., remarking that the defendants were not entitled to publish a work "with such a title, or in such form as to binding or general appearance, as to be a colourable imitation of that of the plaintiffs" (a). And so, where the title of a song was imitated in such a manner as to be calculated to induce the public to buy the spurious publication in mistake for the genuine, the continuance of the fraud was restrained (b).

The right which exists in the title of a publication is a right of property (c), a chattel interest (d), capable of assignment (e) or bequest (f), passing, in the event of its proprietor's bankruptcy, to his trustee, but incapable of seizure by a sheriff (g), and which, in the event of a dissolution of partnership between joint proprietors, must be sold for the purpose of the proceeds of the sale being included in the assets of the partnership (h). Incidents of title of publication.

Although the term copyright has been sometimes applied to the right in the title of a publication (i), there "cannot in general be any copyright in the title or name of a book" (k), but copyright and trade mark are things "totally distinct" (l), and registration No copyright in title.

(a) *Mack v. Petter*, L. R. 14 Eq. 431. See *Weldon v. Dicks*, 10 Ch. D. 247. Also *Estes v. Williams*, 22 Bl. C. 364; *Estes v. Belford, Clarke & Co.*, 30 U. S. Pat. Gaz. 99; *Estes v. Leslie* (1), 23 Bl. C. C. 476; *ib.* (2), 29 Fed. Rep. 91; *Estes v. Worthington* (3), 24 Bl. C. C. 371; in all of which cases the plaintiffs were the American grantees from the original English publishers of an exclusive right in the publication.

(b) *Chappell v. Sheard*, 2 K. & J. 117; *Chappell v. Davidson*, *ib.* 123. But in *Isaacs v. Daly*, 39 N. Y. Super. Ct. 511, it was held that no injunction could be granted to restrain the use of the word "Charity" as the name of a play, the word being one of general application, and the use by the defendant *bonâ fide*.

(c) *Clement v. Maddick*, 1 Giff. 98; *Kelly v. Hutton*, L. R. 3 Ch. 708. But this was disputed in *Walter v. Emmott*, 54 L. J. Ch. 1059.

(d) *Per Wood*, L. J. in *Kelly v. Hutton*, L. R. 3 Ch. 708.

(e) *Longman v. Tripp*, 2 Bos. & P. N. R. 67; *Ex parte Foss*, 2 De G. & J. 230; *Kelly v. Hutton*, L. R. 3 Ch. 708; *Clowes v. Hogg*, W. N. 1870, p. 268; *ib.* 1871, p. 40; *Ward v. Beeton*, L. R. 19 Eq. 207; *Snowden v. Noah*, Hopk.

347; R. Cox, 1.

(f) *Keene v. Harris*, 17 Ves. 338. In *McCormick v. McCubbin*, Ct. Sess. Cas. 1, Ser. I. 541 (new ed. 496) it was held by the Court of Session that the executors of the proprietor of a half-share in a newspaper were entitled to proceed to a sale of his share.

(g) *Ex parte Foss*, 2 De G. & J. 230.

(h) *Bradbury v. Dickens*, 27 Beav. 53; *Dayton v. Wilkes*, 17 How. Pr. 510; R. Cox, 224.

(i) *E.g.*, *per* Lord Romilly, M. R., in *Mack v. Petter*, L. R. 14 Eq. 431; *per* Malins, V.-C., in *Weldon v. Dicks*, 10 Ch. D. 247; *per* Bacon, V.-C., in *Dicks v. Yates*, 18 Ch. D. 76.

(k) *Per James*, L. J., in *Dicks v. Yates*, 18 Ch. D. 76. And see *Kelly v. Hutton*, L. R. 3 Ch. 708; *Correspondent Newspaper Co. v. Saunders*, 11 Jur. N. S. 540; *Primrose Press Agency v. Knowles*, L. J. N. of C. 1886, p. 43; *Schove v. Schmincke*, 33 Ch. D. 546; *Licensed Victuallers' Newspaper Co. v. Bingham*, 38 Ch. D. 139; *Osgood v. Allen*, 1 Holmes, 185.

(l) *Per Jessel*, M. R., in *Dicks v. Yates*, 18 Ch. D. 76. In *Gage v. Canada Publishing Co.*, 11 Can. Sup. Ct. 306, it was said that the name of a newspaper was not a trade mark.

under the Copyright Acts gives no further right to protection than exists independently of such registration (a).

Must be
actual user.

Just as a trade mark must, in order to be entitled to protection, be affixed to a vendible article in the market (b), so a title of a publication must be actually used. The mere intention, previous to publication, of using a particular name as the title of a literary work, even if followed by the registration of the proposed title as copyright, the advertisement of the forthcoming work, or the actual preparation of its contents, confers no right to protection, for, "in the case of advertisement, followed by publication, the party publishing has given something to the world, and there is some consideration for the world's giving him a right; but in the case of mere advertisement, he has neither given, nor come under any obligation to give, anything to the world, so that there is a total want of consideration for the right which he claims" (c). So, in one case (d), the defendants had registered their newspaper at Stationers' Hall on December 24th, 1885, but did not publish the first number till January 16th, 1886; while in the meantime the plaintiffs had registered on January 1st, 1886, and begun to sell on January 2nd, 1886, a newspaper under the same name, and it was held that an injunction must be granted for the protection of the plaintiffs, who had been the first to actually use the title. The user must, however, be substantial (e). Where, on the other hand, a book has been once published under a particular title, it seems that the right in the title remains, notwithstanding that the book has been long out of print, and has, in fact, been treated as obsolete (f).

(a) *Maxwell v. Hogg*, L. R. 2 Ch. 307; *Barlow & Jones, Ltd. v. Johnson & Co.*, 7 P. R. 395, 399. In the American case of *Jollie v. Jaques*, 1 Bl. C. C. 618, it was, however, held that the right to the title of a work, the copyright of which turned out to be invalid, must fail with the copyright. See *Osgood v. Allen*, 1 Holmes, 185; *Isaacs v. Daly*, 39 N. Y. Super. Ct. 511; *Scoville v. Toland*, 6 West. L. J. 84; *Hirsch v. Jonas*, 3 Ch. D. 584; *Munro v. Beadle*, 62 N. Y. Sup. Ct. 312; *Munro v. Tonscy*, 129 N. Y. 38.

(b) Or registered, since the Trade Marks Act of 1875.

(c) Per Turner, L. J., in *Maxwell v. Hogg*, L. R. 2 Ch. 307. And see *Correspondent Newspaper Co. v. Saunders*, 11 Jur. N. S. 540.

(d) *Primrose Press Agency v. Knowles*, L. J. N. of C. 1886, p. 43.

(e) *Licensed Victuallers' Newspaper Co. v. Bingham*, 38 Ch. D. 139.

(f) *Weldon v. Dicks*, 10 Ch. D. 247. *Compère Estes v. Worthington* (3), 24 Bl. C. C. 371.

CHAPTER IX.

GOODWILL.

So early as the time of Lord Hardwicke (a) it was fully recognised that the goodwill of a trade might be of considerable value, and by the beginning of the present century it was said at the bar (b) to be a matter of common experience that contracts for the sale of a goodwill were enforced by actions at law at every sittings. Value of goodwill.

The connection between goodwill and trade marks is very intimate. Thus, where in a suit for specific performance of a contract for sale of a business (c), one of the subjects of the contract was "goodwill, &c.," Romilly, M. R., said that those words united such things as were necessarily connected with and belonged to the goodwill, many of which were easily pointed out; for instance, the use of trade marks. Such things would be included in the words "et cætera," and would be included in the conveyance. The sale of a business carries with it the goodwill and trade marks (d), and the sale of a business and goodwill carries with it the right to the trade name (e), and the words "assets and effects of every kind and nature," in a bill of sale of a business, cover the trade Connection between goodwill and trade marks.

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

(b) *Bunn v. Guy*, 4 East, 190.

(c) *Cooper v. Hood*, 26 Beav. 293.

(d) *Shipwright v. Clements*, 19 W. R. 599; *Singer Manufacturing Co. v. Loog* (3), 8 App. Cas. 15, 33 (per Lord Blackburn); *Currie v. Currie*, 15 P. R. 339; *Merry v. Hoopes*, 111 N. Y. 415; *Gage v. Canada Publishing Co.*, 11 Can. Sup. Ct. 306. And see *Hall v. Barrows*, 4 De G. J. & S. 150; *Brown Chemical Co. v. Meyer*, 139 U. S. 540; *Wilmer v. Thomas*, 74 Md. 485. But see *Young v. Jones Bros. & Co.*, 3 Hughes, 274. In *Churton v. Douglas*, Johns. 174, V.-C. Wood went so far as to say that the question of trade mark was in fact the same as the question of firm name, which, it was obvious,

was an important part of the goodwill. See, too, *England v. Curling*, 8 Beav. 129; *In re Roger* (2), 12 P. R. 149; *Dickson v. McMaster & Co.*, 18 Ir. Jur. 202; *Congress & Empire Spring Co. v. High Rock Congress Spring Co.*, 57 Barb. 526; *R. Cox*, 599; *Dixon Crucible Co. v. Guggenheim*, 2 Brews. 321; *R. Cox*, 559; *Solier v. Johnson*, 111 Mass. 238; *Witt- haus v. Braun*, 44 Md. 303; *Ex parte Young*, Dig. 537; *Fulton v. Sellers*, 4 Brews. 42; *Hazard v. Caswell*, 47 N. Y. Super. Ct. 537; *Batchelor v. Thomson*, 86 Fed. Rep. 630.

(e) Per James, L. J., in *Levy v. Walker*, 10 Ch. D. 436. See *Thompson v. Mackinnon*, 2 Steph. Dig. 726; *Attenborough v. Jay*, 14 Times L. R. 439.

marks used in the business (a). Again, a trade mark cannot exist in gross and apart from the goodwill of the business with which it has been connected (b).

Connection recognised by Registration Act of 1875, and Patents Act, 1883.

This close connection was fully recognised in the Trade Marks Registration Act, 1875 (c), by the second section of which it was provided that a registered trade mark should be assigned and transmitted only in connection with the goodwill of the business concerned in such particular goods or classes of goods, and should be determinable with such goodwill. By the third section the right of the registered proprietor to the exclusive use of the trade mark was made subject to the provisions in respect of its connection with the goodwill. These provisions are now repeated in §§ 70 and 76 of the Patents Act, 1883 (d).

What constitutes goodwill.

“Goodwill, I apprehend,” said Wood, V.-C., in the important case of *Churton v. Douglas* (e), “must mean every advantage, every positive advantage, if I may so express it, as contrasted with the negative advantage of the late partner not carrying on the business himself, that has been acquired by the old firm in carrying on its business, whether connected with the premises in which the business was previously carried on, or with the name of the late firm, or with any other matter carrying with it the benefit of the business.”—“Very frequently the goodwill of a business or profession, without any interest in land connected with it, is made the subject of sale, though there is nothing tangible in it” (f). And it carries with it the benefit of such matters as a covenant by a servant not to carry on a similar business within prescribed limits (g).

Formerly treated as always local.

Previously to the case of *Churton v. Douglas* (h), the language of various eminent judges as to what constituted “goodwill” had rather tended to connect the goodwill with the premises on which

(a) *Morgan v. Rogers*, 19 Fed. Rep. 596. And see *Russia Cement Co. v. Le Page*, 147 Mass. 266; *Hoxie v. Chaney*, 143 Mass. 592; *Mackinnon v. Thompson*, 5 Can. Leg. News, 396.

(b) *Cotton v. Gillard*, 44 L. J. Ch. 90; *In re Wellcome*, 32 Ch. D. 213; *Smith v. Fair*, 14 Ont. Rep. 729; *Dixon Crucible Co. v. Guggenheim*, 2 Brews. 321; *R. Cox*, 559; *Derringer v. Plate*, 29 Cal. 292; *R. Cox*, 324; *Witthaus v. Braun*, 44 Md. 303; *Taylor v. Bemis*, 4 Biss. 406; *Kidd v. Johnson*, 100 U. S. 617; *Weston v. Ketcham* (1), 39 N. Y. Super.

Ct. 54; S. C. (2), 51 How. Pr. 455; *Morgan v. Rogers*, 19 Fed. Rep. 596.

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

(d) 46 & 47 Vict. c. 57.

(e) *Johns*. 174. And see *per Hagens, J.*, in *McGowan Bros. Pump & Machine Co. v. McGowan*, 2 Cinc. 313.

(f) *Per Pollock, C. B.*, in *Potter v. The Commissioners of Inland Revenue*, 10 Ex. 147.

(g) *Jacoby v. Whitmore*, 49 L. T. N. S. 335; *Showell v. Winkup*, 60 *ib.* 389.

(h) *Johns*. 174.

the business was carried on, than with the business carried on there, probably because that language, though in general terms, was directed to the circumstances of the case then in course of decision (a). Thus, Lord Eldon, C., in *Cruttwell v. Lye* (b), describes goodwill as "nothing more than the probability that the old customers will resort to the old place" (c). Leach, M. R., describes it (d) as "an advantage attaching to the possession of the house" in which the business had been carried on; and Lord Langdale, M. R. (e), as "the chance or probability that custom will be had at a certain place of business in consequence of the way in which that business has been previously carried on" (a). In *King v. Midland Railway Co.* (f), Giffard, V.-C., gave effect to this view by holding that the assignees in liquidation of a mortgagor, whose business premises were taken by a railway company, were entitled to no part of the purchase-money, as having been paid in respect of the goodwill of the business, as against the mortgagee of the premises, whose debt exceeded the purchase-money; but that the goodwill was incident to the mortgaged premises and passed with them.

The judgment in *Churton v. Douglas*, which has been accepted by the House of Lords in the recent case of *Trego v. Hunt* (g), has now established that the dictum of Lord Eldon in *Cruttwell v. Lye* (h) must be read as meaning that goodwill is the probability that the old customers will buy the old goods from the old firm or their successors in business, whether the means of identification be the place of business or otherwise (i). "It is the whole advantage, whatever it may be, of the reputation and connection of the firm" (k). The customers of a large wholesale house cannot be supposed to pay much attention to the exact site of the establishment; and "there may even be a species of goodwill which may be the subject of bargain and sale, although not

(a) See *Churton v. Douglas*, Johns. 174.

(b) 17 Ves. 335.

(c) In this case Sir A. Piggott, in the course of his argument, said that "goodwill" was "the advantage belonging to a house long accustomed to carry on a particular trade." See, too, *per Plumer, V.-C., in Harrison v. Gardner*, 2 Madd. 198.

(d) In *Chissum v. Dewes*, 5 Russ. 29.

(e) In *England v. Downs*, 6 Beav. 269,

adopted in *Vonderbank v. Schmidt*, 44 La. Ann. 264; 32 Am. St. Rep. 336.

(f) 17 W. R. 113. See *Rutter v. Daniel*, 30 W. R. 724, 801; *Mitchell v. Read* (2), 26 N. Y. Sup. Ct. 418.

(g) (1896) A. C. 7, 17.

(h) 17 Ves. 335.

(i) And compare *Labouchere v. Dawson*, L. R. 13 Eq. 322; *Cooper v. Metropolitan Board of Works*, 25 Ch. D. 472.

(k) *Per Lord Macnaghten in Trego v. Hunt*, (1896) A. C. 7, 24.

dependent on the business being carried on in any particular place: for instance, in the case of what are called quack medicines" (a).

Local
connection
important.

While, however, there may be a species of goodwill not intimately connected with a particular spot, in many trades there can hardly be any goodwill apart from the premises on which business has been carried on. Thus, "it is quite plain that the goodwill of a public-house passes with the public-house. In such a case the goodwill is the mere habit of the customers resorting to the house. It is not what is called a personal goodwill" (b). Such a goodwill carries with it the public-house licences, since without them the business cannot be carried on (c). And wherever there is a connection between the goodwill and a particular locality it will be of great consequence; and a house of little value in itself, at a rack-rent, may have a peculiar value attached to it from the fact of a long-established business having been carried on there (d).

Another view
of goodwill.

Looked at from another point of view, the goodwill may be said to be the money value of what has just been described as the goodwill (e).

Goodwill
in learned
professions.

While the value of most businesses is determined partly by the personal qualifications of the proprietor, partly by those of his subordinates, partly (sometimes principally) by local situation, partly, it may be, by yet other considerations, there is one class of business in which the personal character and ability of the head of the establishment are of paramount and almost exclusive importance. That class comprehends the medical and legal, or "learned" professions.

Division into
personal and
local.

Adverting to this distinction, Sir J. Cross, in *Ex parte Thomas* (f), divided goodwill into personal and local, adding that there might

(a) Brett, J., in *Llewellyn v. Rutherford*, L. R. 10 C. P. 456. The goodwill of a newspaper is another example. See *Boon v. Moss*, 70 N. Y. 465, and the observations of Lindley, M. R., in his work on Partnership. See, too, *Potter v. The Commissioners of Inland Revenue*, 10 Ex. 147; *Ginesi v. Cooper*, 14 Ch. D. 596; *Trego v. Hunt*, (1896) A. C. 7, 17, 24; *Donald v. Hodgart's Trustees*, Ct. Sess. Cas. 4th Ser. XXI. 246; *Huwer v. Dannenhoffer*, 82 N. Y. 499; and *Barker v. Connecticut Mutual Life Insurance Co.*, 15 Fed. Rep. 312.

(b) Per Jessel, M. R., in *Ex parte Punnett*, 16 Ch. D. 226; *Philp's Executor*

v. Philp's Executor, Ct. Sess. Cas. 4th Ser. XXI. 482. See *Mitchell v. Read* (2), 26 N. Y. Sup. Ct. 418; and *Mason v. Queen*, 23 Scot. L. Rep. 641.

(c) *Rutter v. Daniel*, 30 W. R. 724, 801.

(d) *Parsons v. Hayward*, 31 L. J. Ch. 666; *Llewellyn v. Rutherford*, L. R. 10 C. P. 456. See *Cooper v. Metropolitan Board of Works*, 25 Ch. D. 472, per Cotton, L. J.

(e) *Austen v. Boys*, 2 De G. & J. 626; *Llewellyn v. Rutherford* (Brett, J.), L. R. 10 C. P. 456.

(f) 2 Mont. D. & De G. 294. And see *Ex parte Punnett*, 16 Ch. D. 226.

be a goodwill partly personal and partly local (*a*). But the employment of the word "local" as descriptive of one of the two principal heads under which goodwill falls seems open to objection, on the ground that it tends to produce the misconception exposed and removed by Vice-Chancellor Wood in *Churton v. Douglas* (*b*), and to unduly narrow the meaning to be assigned to "goodwill," which, as has been seen, comprehends, not merely the advantage of local situation, but every positive advantage connected with an established trade.

The two classes of goodwill may more satisfactorily be distinguished, from the classes of pursuit to which they respectively relate, as the goodwill of a profession on the one hand, and that of a trade on the other. It is, indeed, true that the goodwill of a trade, the more usual kind, possesses so many characteristics which that of a profession has not, that the latter has been thought to be hardly entitled to the name of goodwill at all (*c*), and in *Arundell v. Bell* (*d*), Jessel, M. R., went so far as to say that "there is nothing analogous to the goodwill in an ordinary trade, which you can sell, in the case of a partnership of living solicitors"; but, on the other hand, there are points of resemblance in which both classes are governed by the same general rule, and there is a convenience in following an established phraseology.

In *Bunn v. Guy* (*e*), the Lord Chancellor (Lord Eldon) was impressed by the difference between the goodwill of a profession and that of a trade, and caused the opinion of the Court of King's Bench to be taken as to whether a contract by a practising attorney (among other things) to relinquish his business and recommend his clients to two other attorneys, for valuable consideration, and not to practise within certain limits, and to permit them to use his name for a certain time, was good at law, so that the vendor could recover in an action. The answer was that the contract was good in law.

This decision did not long remain uncriticised. In *Bozon v. Farlow* (*f*), Grant, M. R., refused to grant specific performance of

Division into goodwill of profession and of trade.

Contract by attorney to transfer goodwill enforced.

Decision doubted.

(*a*) This division corresponds to that of trade marks into personal and local, made by Romilly, M. R., in *Hall v. Barrows*, 32 L. J. Ch. 548, which, however, was not indorsed by Westbury, C. See 4 De G. J. & S. 150.

(*b*) Johns. 174.

(*c*) See *Austen v. Boys*, 2 De G. & J. 326; and *Bain v. Munro*, Ct. Sess. Cas.

4th Ser. V. 416, *per* Lord Curriehill.

(*d*) 52 L. J. Ch. 537. And see *per* Denman, J., in *James v. James* (2), 60 L. T. N. S. 569.

(*e*) 4 East, 190, in 1803. See the medical cases of *Rawlinson v. Clarke*, 14 M. & W. 187; *Smith v. Smith*, 4 Wend. 468; *Butler v. Burlison*, 16 Vt. 176.

(*f*) 1 Mer. 459.

an agreement for the sale of an attorney's business, the terms of the agreement not being sufficiently specified to enable the Court to give the purchaser the proper return for his money, and he took the opportunity of questioning the propriety of a sale of an attorney's business, which depended so much on the incumbent's own character. And in *Farr v. Pearce* (a), Leach, V.-C., strongly supported the personal character of a profession as contrasted with a commercial business.

Sale of solicitor's practice.

Where, however, a solicitor had actually sold his practice for valuable consideration, and undertaken not to practise as a solicitor in Great Britain for twenty years, Lord Langdale, M. R., granted an injunction to restrain him from so practising, and from endeavouring to induce any persons who were the clients of the former and then present firm to cease to employ that firm (b). But an assignment of the goodwill of a solicitor's practice does not carry with it the right to his clients' papers (c).

Thornbury v. Bevill.

In a case (d) which was "not quite a case of dissolution of partnership, but something between a dissolution of the partnership and a purchase of an attorney's business and firm name," Knight-Bruce, V.-C., having refused specific performance of the alleged contract, on the ground of non-acceptance by the plaintiff, said that, "notwithstanding the case of *Bunn v. Guy* (e), from which he did not mean to express dissent, decided as it was by judges of high authority, he was not prepared to say that it was fit that a Court of Equity should enforce an agreement between two solicitors that one on retiring from the business should permit the other to carry on the business in his name. Whether such an agreement were or were not within the strict policy of the law, it might be doubtful whether the Court of Chancery ought to assist it."

Partnership between solicitors dissolved.

But where, on a dissolution by two solicitors of a *bonâ fide* partnership between them, it was agreed that one should carry on the business under the old firm name, paying the other certain annuities, it was held by Wood, V.-C., that the agreement contained nothing illegal or contrary to the public policy (f).

Rights on dissolution.

Again, on a dissolution of a professional partnership, a retiring partner is not entitled to compensation in respect of his share in

(a) 3 Madd. 74.

(b) *Whittaker v. Howe*, 3 Beav. 383.

(c) *Per Denman, J.*, in *James v. James*, 60 L. T. N. S. 569.

(d) *Thornbury v. Bevill*, 1 Y. & C. Ch. 554.

(e) 4 East, 190.

(f) *Aubin v. Holt*, 2 K. & J. 66.

the goodwill (a), and a surviving partner may continue the business (b).

In *Spicer v. James* (c), a country attorney having died intestate, his administrator carried on the business until the intestate's son came of age, when he handed over the business to the son. The son becoming insolvent, a bill for an account of profits, and insisting that a sum was due to the intestate's estate in respect of the goodwill, was filed against the administrator by a creditor of the son, but was dismissed by Leach, M. R., on the ground that the goodwill of an attorney's business was not a subject of administration. So, in *Arundell v. Bell* (d), the Court of Appeal decided that the estate of a solicitor, who had retired from a partnership and shortly afterwards died, was not entitled to any allowance in respect of his interest in the goodwill of the business; and Jessel, M. R., said that "as a general rule there is nothing in the nature of a partnership asset to be sold which can fairly be termed goodwill in an ordinary partnership between solicitors."

Goodwill of deceased solicitor.

Where, however, the widow of a surgeon dentist, being one of his executors, sold the goodwill of his business with an introduction to patients, Knight-Bruce, V.-C., held that either the whole, or, at all events, some part of the price paid, belonged to the testator's estate (e). But in the similar Scotch case of *Bain v. Munro* (f), it was held by the Lord Ordinary and Court of Session that the price which was paid was in fact the price of the widow's recommendation, and that she was entitled to retain it for her own benefit.

Estate of professional man interested in proceeds of goodwill.

The goodwill of a professional business may, in short, be sold, and a breach of a contract to sell may be a ground for damages, but the authorities are against the enforcement of the specific performance of such a contract, though when the sale is complete, the terms of the sale will be carried into execution. Such a goodwill, in the case of a partnership, survives to the surviving partner, and is not a subject of compensation to an outgoing partner. Special stipulations, will, however, be enforced. Such a goodwill will not be considered in the administration of the proprietor's estate unless

Goodwill of professional business.

Recapitulation.

(a) *Austen v. Boys*, 2 De G. & J. 626; *Farr v. Pearce*, 3 Madd. 74.

(b) *Ib.* And see *Milner v. Reed*, Dig. 328; *Chappell v. Griffith*, 53 L. T. N. S. 459.

(c) Collyer on Partnership, 2nd ed. p. 104.

(d) 52 L. J. Ch. 537.

(e) *Smale v. Graves*, 3 De G. & S. 706.

(f) Ct. Sess. Cas. 4th Ser. V. 416.

actually sold; but if that has been done, the price paid, or some part of it may be attributed to the estate.

Goodwill of a trade.

“The goodwill of a trade,” said Tindal, C. J. (a), “is a subject of value and price. It may be sold (b), bequeathed (c), or become assets in the hands of the personal representatives of a trader” (d). A sale may be conditional (e), and may be effected by a mortgagee (f). Though incapable, by reason of its incorporeal nature, of seizure by a sheriff (g), goodwill is “goods and chattels within the Bankruptcy Acts (h), and may be dealt with by the trustee in bankruptcy just as the bankrupt’s other property” (i). It is also “property” within the Stamp Acts (j).

Universally valuable.

The valuable character of goodwill is not confined to a few trades, but is recognised throughout the commercial world. Thus, among the cases on this subject which have come before the Courts, instances are to be found in which the traders were public-house keepers (k), brewers (l), bankers (m), tailors (n), mercers (o), dyers (p), milliners (q), upholsterers (r), pencil-makers (s), tobacco-brokers (t), snuff-makers (u), paper-makers (v), provision merchants (w), cheesemongers (x), glass-blowers (y), glass-stainers (z),

(a) In *Hitchcock v. Coker*, 6 Ad. & E. 438, 454.

(b) See *Darbey v. Whitaker*, 4 Dr. 139; *Churton v. Douglas*, Johns. 174; *Cooper v. Hood*, 26 Beav. 293; *Hudson v. Osborne*, 39 L. J. Ch. 79; *Shipwright v. Clements*, 19 W. R. 599; *Howe v. Searing*, 10 Abb. Pr. 264; R. Cox, 244.

(c) See *Keene v. Harris*, 17 Ves. 338; *Robertson v. Quiddington*, 28 Beav. 529.

(d) See *Worral v. Hand*, Peake, 105; *Dakin v. Cope*, 2 Russ. 170; *Chissum v. Dewes*, 5 Russ. 29; *McCormick v. McCubbin*, Ct. Sess. Cas. 1st Ser. I. 541; *Donald v. Hodgart's Trustees*, Ct. Sess. Cas. 4th Ser. XXI. 246.

(e) *Boon v. Moss*, 70 N. Y. 465.

(f) *Ex parte Punnett, In re Kitchin*, 16 Ch. D. 226.

(g) *Ex parte Foss*, 2 De G. & J. 230; *Helmere v. Smith*, 35 Ch. D. 436.

(h) *Longman v. Tripp*, 2 Bos. & P. N. R. 67; *Ex parte Foss*, 2 De G. & J. 230.

(i) See *Hudson v. Osborne*, 39 L. J. Ch. 79; *Hammond v. Malcolm Brunker & Co.*, 9 P. R. 301; *In re Bolanachi's Empire Chocolate Co.*, 89 L. T. (Journal) 273; *Hegeman & Co. v. Hegeman*, 8 Daly, 1; *Iowa Seed Co. v. Dorr*, 70 Iowa, 481.

(j) *Potter v. The Commissioners of Inland Revenue*, 10 Ex. 147. And see

Morgan v. Perhamus, 36 Ohio St. 517.

(k) *Coslake v. Till*, 1 Russ. 376; *Spratt v. Jeffery*, 10 B. & C. 249; *Ex parte Thomas*, 2 Mont. D. & De G. 294; *Tweed v. Mills*, L. R. 1 C. P. 39; *Llewellyn v. Rutherford*, L. R. 10 C. P. 456; *Ex parte Punnett, In re Kitchin*, 16 Ch. D. 226; *Philp's Executor v. Philp's Executor*, Ct. Sess. Cas. 4th Ser. XXI. 482.

(l) *Cooper v. Watson*, 3 Doug. 413; *Wade v. Jenkins*, 2 Giff. 509; *Hall v. Hall*, 20 Beav. 139.

(m) *Smith v. Everett*, 27 Beav. 446.

(n) *Newling v. Dobell*, 38 L. J. Ch. 111; *Parsons v. Hayward*, 31 L. J. Ch. 666.

(o) *Morris v. Moss*, 25 L. J. Ch. 194.

(p) *Bryson v. Whitehead*, 1 S. & S. 74.

(q) *Shackle v. Baker*, 14 Ves. 468.

(r) *Chissum v. Dewes*, 5 Russ. 29.

(s) *Banks v. Gibson*, 34 Beav. 566.

(t) *Davies v. Hodgson*, 25 Beav. 177.

(u) *Hammond v. Douglas*, 5 Ves. 539.

(v) *Potter v. The Commissioners of Inland Revenue*, 10 Ex. 147.

(w) *Scott v. Mackintosh*, 1 V. & B. 503.

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

(y) *Featherstonhaugh v. Fenwick*, 17 Ves. 298.

(z) *Scott v. Rowland*, 20 W. R. 508.

manufacturing chemists (*a*), commission agents (*b*), iron-masters (*c*), carriers (*d*). The goodwill of a newspaper or magazine, consisting of the right to use the title under which reputation has been acquired by a publication, is another instance of valuable goodwill (*e*).

"The name of a firm," says Wood, V.-C., in *Churton v. Douglas* (*f*), "is a very important part of the goodwill of the business carried on by the firm. A person says, 'I have always bought good articles at such a house of business; I know it by that name, and I send to the house of business identified by that name for that purpose.' There are cases every day in this Court with reference to the use of the name of a particular firm, connected generally, no doubt, with the question of trade mark. But the question of trade mark is in fact the same question. The firm stamps its name on the articles. It stamps the name of the firm which is carrying on the business on each article, as a proof that they emanate from the firm; and it becomes the known firm to which applications are made, just as much as when a man enters a shop in a particular locality. And when you are parting with the goodwill of a business, you mean to part with all that good disposition which customers entertain towards the house of business identified by the particular name or firm, and which may induce them to continue giving their custom to it. You cannot put it anything short of that. That the name is an important part of the goodwill of a business is obvious, when we consider that there are at this moment large banking firms, and brewing firms, and others, in this metropolis, which do not contain a single member of the individual name exposed in the firm" (*g*).

Firm name
part of
goodwill.

Goodwill is a subject of sale (*h*), and may fetch a considerable Sale of goodwill.

(*a*) *Turner v. Major*, 3 Giff. 442.
 (*b*) *Macdonald v. Richardson*, 1 Giff. 81.
 (*c*) *Cooper v. Hood*, 26 Beav. 293; *Hall v. Barrows*, 4 De G. J. & S. 150.
 (*d*) *Cruttwell v. Lye*, 17 Ves. 335.
 (*e*) *Giblett v. Read*, 9 Mod. 459; *Keene v. Harris*, 17 Ves. 338; *Longman v. Tripp*, 2 Bos. & P. N. R. 67; *Ex parte Foss*, 2 De G. & J. 230; *Marshall v. Watson*, 25 Beav. 501; *Bradbury v. Dickens*, 27 ib. 53; *McCormick v. McCubbin*, Ct. Sess. Cas. 1st Ser. I. 541; *Snowden v. Noah*, Hopk. 347; *R. Cox*, 1; *Dayton v. Wilkes*, 17 How. Pr. 510; *R. Cox*, 224.
 (*f*) *Johns*. 174.

(*g*) And see *Lewis v. Langdon*, 7 Sim. 421; *Banks v. Gibson*, 34 Beav. 566; *Bond v. Milbourn*, 20 W. R. 197; *Scott v. Rowland*, 20 ib. 508; *Condy v. Mitchell*, 37 L. T. N. S. 268, 766; *Levy v. Walker*, 10 Ch. D. 436; *Beazley v. Soares*, 22 ib. 660; *Gray v. Smith*, 43 ib. 208; *Rogers v. Taintor*, 97 Mass. 291; *Sohier v. Johnson*, 111 Mass. 238; *Peterson v. Humphrey*, 4 Abb. Pr. 394; *R. Cox*, 212; and *Howe v. Searing*, 10 Abb. Pr. 264; *R. Cox*, 244. See *Currie v. Currie*, 15 P. R. 339, where the goodwill was sold minus the right to use the firm name.

(*h*) See, among other cases, *Bunn v. Guy*, 4 East, 190; *Smale v. Graves*, 3 De

price. There was formerly a doubt whether a contract for the sale of a goodwill would be specifically enforced in Equity (a), but this question was set at rest by Kindersley, V.-C., in *Darbey v. Whitaker* (b). "It is said there can be no specific performance of a contract to purchase a goodwill. No doubt you cannot have a specific performance of a contract to purchase a goodwill alone, unconnected with business premises, by reason of the uncertainty of the subject-matter. But when a goodwill is entirely or mainly annexed to the premises, and the contract is for the sale of the premises and goodwill, there is not the slightest ground for doubt that such a contract is a fit matter for a decree in a suit for specific performance." It seems, however, that there may be cases in which a contract for sale of a goodwill would be specifically enforced, the business and goodwill being included together, though there was no such dependence on the business premises (c). Such would be the case with the goodwill of a quack medicine or a newspaper, which is practically independent of locality (d). The connection between the business and the goodwill is such that the sale of the business (e), or of a share in the business (f), as a going concern, carries with it the goodwill, or the corresponding share in the goodwill, even without its being specifically mentioned, and so does the sale of a hotel or public-house (g). And if the goodwill is sold, the trade name goes with it (h).

G. & S. 706; *Cooper v. Hood*, 26 Beav. 293; *Bradbury v. Dickens*, 27 *ib.* 53; *Churton v. Douglas*, Johns. 174; *Ex parte Punnett*, *In re Kitchin*, 16 Ch. D. 226; *Buckingham v. Waters*, 14 Cal. 246; *Williams v. Wilson*, 4 Sandf. Ch. 379; *Barker v. Connecticut Mutual Life Insurance Co.*, 15 Fed. Rep. 312.

(a) *Baxter v. Connolly*, 1 Jac. & W. 580. And see *Costlake v. Till*, 1 Russ. 376; *Bozon v. Farlow*, 1 Mer. 459; *Cassidy v. Metcalf*, 1 Mo. App. 593.

(b) 4 Dr. 139. As to the relation between the lease of a trader's premises and the goodwill of his business, see *Dougherty v. Van Nostrand*, Hoff. 68.

(c) Thus, Romilly, M. R., says, in *Robertson v. Quiddington*, 28 Beav. 529: "Goodwill is never a tangible thing unless it is connected with the business itself, from which it cannot be separated. I never knew a case in which it has been so treated." In *England v. Downs*, 6 Beav. 269, and *Morris v. Moss*, 25 L. J. Ch. 194, the goodwill of a business was

held, under the circumstances, to pass with the stock, and not with the premises. And see *Woodward v. Lazar*, 21 Cal. 448; R. Cox, 300. In *Llewellyn v. Rutherford*, L. R. 10 C. P. 456, the price of the goodwill was held to belong to the previous lessee, under the contract between him and the lessor.

(d) See *Bryson v. Whitehead*, 1 S. & S. 74; *Llewellyn v. Rutherford*, L. R. 10 C. P. 456 (*per* Brett, J.); *Snowden v. Noah*, Hopk. 347; R. Cox, 1.

(e) *Shipwright v. Clements*, 19 W. R. 599. And see *Rolt v. Bulmer*, W. N. 1878, p. 119; *Reynolds v. Bullock*, 47 L. J. Ch. 773; *Boon v. Moss*, 70 N. Y. 465.

(f) *Churton v. Douglas*, Johns. 174; *Currie v. Currie*, 15 P. R. 339.

(g) *Ex parte Punnett*, *In re Kitchin*, 16 Ch. D. 226.

(h) *Banks v. Gibson*, 34 Beav. 566; *Churton v. Douglas*, Johns. 174; *Levy v. Walker*, 10 Ch. D. 436; *Gray v. Smith*, 43 Ch. D. 208; *Brown Chemical Co. v. Meyer*, 139 U. S. 540.

As to the rights of the vendor after the sale of his business and goodwill, "it has been settled that there is no implied covenant of any kind" (a), and in the absence of any express restrictive covenant, the vendor is at liberty to set up a business of precisely the same description as that of which he had sold the goodwill, and that next door to the place where his former business was carried on, and to state his connection with that former business (b); but he is not entitled to represent that he is carrying on the same identical business, either by direct representations, or by assuming the trade name under which the business he has sold acquired its reputation, or the trade mark by which its goods have become known in the market (c); nor can he after the sale give a right to others to use the trade marks (d). If the trade name consisted simply of the vendor's own name, the restraint upon his continuing to use that name will have to depend upon the evidence of that user being fraudulent (e), but in the absence of such evidence, the *bonâ fide* use by a man of his own name will not be prohibited (f). But where the trade name in question consisted of the name of the defendant, John Douglas, with the addition "& Co.," it was held that the use of that was an important ingredient in the case, as proving fraudulent intention (g). And so where the name of the firm had been "Benjamin Finch & Co.," and on dissolution B. Finch agreed to carry on business only under his own name, he was restrained from trading as "Benjamin Finch & Co." (h).

Rights of vendor of goodwill.

After sale may set up new business.

(a) *Hudson v. Osborne*, 39 L. J. Ch. 79. And see *Harrison v. Gardner*, 2 Madd. 198; *Churton v. Douglas*, Johns. 174.

(b) *Clark v. Leach*, 32 Beav. 14; *Hookham v. Pottage*, L. R. 8 Ch. 91; *Shipwright v. Clements*, 19 W. R. 599; *Cassidy v. Metcalfe*, 1 Mo. App. 593.

(c) *Shackle v. Baker*, 14 Ves. 468; *Cruttwell v. Lye*, 17 Ves. 335; *Kennedy v. Lee*, 3 Mer. 441, 452; *Sedon v. Senate*, 2 V. & B. 220; *Harrison v. Gardner*, 2 Madd. 198; *Churton v. Douglas*, Johns. 174; *Hudson v. Osborne*, 39 L. J. Ch. 79; *Labouchere v. Dawson*, L. R. 13 Eq. 322; *Ginesi v. Cooper*, 14 Ch. D. 596; *Leggott v. Barrett*, 15 *ib.* 306; *Walker v. Mottram*, 19 *ib.* 355; *Smith v. McBride*, Ct. Sess. Cas. 4th Ser. XVI. 36; *Dawson v. Beeson*, 22 Ch. D. 504; *Mossop v. Mason*, 18 Grant Up. Can. Ch. 453; *Peltz v. Eichele*, 62 Mo. 171; *Bergamini v. Bastian*, 35 La. Ann. 60; *Myers v. Kalamazoo Buggy Co.*, 54 Mich. 215; *Hoxie v.*

Chancy, 143 Mass. 592; *Frazier v. Frazier Lubricator Co.*, 121 Ill. 147; *Porter v. Mumford & Gorman*, 65 Ga. 11; *Batchelor v. Thomson*, 86 Fed. Rep. 630.

(d) *Sohl v. Geisendorf*, 1 Wils. (Ind.) 60.

(e) *Churton v. Douglas*, Johns. 174; *Holloway v. Holloway*, 13 Beav. 209.

(f) *Burgess v. Burgess*, 3 De G. M. & G. 896; *Bond v. Milbourn*, 20 W. R. 197; *Turton v. Turton*, 42 Ch. D. 128.

(g) *Churton v. Douglas*, Johns. 174. And see *Fullwood v. Fullwood* (1), W. N. 1873, p. 185; *Devlin v. Devlin*, 69 N. Y. 212; *Zimmerman v. Erhard*, 83 N. Y. 74; *Hegeman & Co. v. Hegeman*, 8 Daly, 1. In *Bond v. Milbourn*, 20 W. R. 197 (very shortly reported), it seems that the plaintiff would have been entitled to an injunction at all events against the use of the words "& Co." by the defendant, if that had been the relief prayed.

(h) *Day v. Finch*, 25 Sol. J. 354.

Solicitation
of former
customers.

The rights of the vendor of a business and goodwill with respect to soliciting his former customers and dealing with them has been the subject of much difference of judicial opinion. In *Labouchere v. Dawson* (a) Lord Romilly, M. R., laid down a stringent rule, saying that when the vendor of a goodwill has established a new firm for the purpose of carrying on a business similar to that which has been sold, "the new firm is entitled to publish any advertisement he pleases in the papers, stating that he is carrying on such business. He is entitled to publish any circulars to all the world to say that he is carrying on such a business; but he is not entitled, either by private letter, or by a visit, or by his traveller or agent, to go to any person who was a customer of the old firm, and solicit him not to continue his business with the old firm, but to transfer it to him, the new firm (b). And Jessel, M. R., was of opinion that this doctrine should be extended so as to entitle the purchaser of the goodwill of a business to restrain the vendor from having any dealings with his former customers, irrespective of whether he had solicited their custom or not (c).

Leggott v. Barrett.

On the other hand, in *Leggott v. Barrett* (d), the Court of Appeal held that, assuming the vendor could be restrained from soliciting his old customers in accordance with the order of the Court below, which was not appealed from on this point, he could not be restrained from dealing with his old customers, even though he had solicited them prior to the date of the injunction.

Walker v. Mottram.

The question next arose with reference to the case in which the goodwill had not been voluntarily alienated by the person entitled to it, and the distinction between this case and the case of a voluntary sale was clearly pointed out in *Walker v. Mottram* (e), in which Jessel, M. R., and the Court of Appeal held that a trader, the goodwill of whose business had been sold by his trustees in liquidation, could not be prevented from actually soliciting his former customers. "An assignment of a business and its goodwill, without more, appears to us," said Lush and Lindley, L. JJ., "to pass now just as much as and no more than in the days of

(a) L. R. 13 Eq. 322. See *Selby v. Anchor Tube Co.*, W. N. 1877, p. 191. Also *Angier v. Webber*, 14 Allen, 211; *Dwight v. Hamilton*, 113 Mass. 175; *Munsey v. Butterfield*, 133 Mass. 492.

(b) As to the surrender of a business by A. "for the benefit" of B., see *Clark*

v. Leach, 32 Beav. 14; and also *Harrison v. Gardner*, 2 Madd. 198; and *Churton v. Douglas*, Johns. 174.

(c) *Ginesi v. Cooper & Co.*, 14 Ch. D. 596.

(d) 15 Ch. D. 306.

(e) 19 Ch. D. 355.

Lord Eldon (a). As against the assignor it confers on the assignee the exclusive right to carry on the business assigned, and, as incidental to this, it also confers on him the exclusive right to represent himself as carrying on that business, and consequently the right, not only to sue the assignor for damages if he has infringed these rights, but also to restrain him from infringing them if he manifests an intention to infringe them. Moreover, to this extent a bankrupt who does not concur in his trustee's assignment is in no better position than a bankrupt who does. Every bankrupt, whether he concurs or not, is bound by every lawful disposition of his property by the trustee, and whatever rights such a disposition confers on a purchaser must be respected by the bankrupt, whether he joins in the conveyance or not. But, in our opinion, the right of a purchaser of the goodwill of a business from the trustee in bankruptcy does not extend to restrain the bankrupt (even if he joins in the conveyance) from *bonâ fide* commencing a fresh business, and from seeking assistance in it from his old friends and customers. It would, in our opinion, be contrary to the policy of the bankruptcy laws to extend *Labouchere v. Dawson* (b) to such a case. It is not necessary to overrule that decision; we leave it where it is, that is to say, it will still be applicable to voluntary sales. But we do not think it ought to be extended to alienations which are compulsory" (c). On this principle it was held by the Court of Appeal in *Dawson v. Beeson* (d) that an expelled partner was entitled to solicit the customers of his old firm.

In *Pearson v. Pearson* (e), it was definitely laid down by Bag-
gallay and Cotton, L. JJ., Lindley, L. J., dissenting, that *Labouchere*
v. Dawson (b) was wrongly decided, and that a vendor of a business
and goodwill cannot, in the absence of an express restrictive cove-
nant, be restrained from soliciting the old customers of the business.

This much-debated question has at length been set at rest by
the decision of the House of Lords in *Trego v. Hunt* (f), in which
the view expressed by Lord Romilly in *Labouchere v. Dawson* (g)

(a) Cf. *Trego v. Hunt*, (1896) A. C. 7, in which Lord Herschell criticises the language of Lord Eldon in *Cruttwell v. Lye*, 17 Ves. 335, 346. And see p. 301.

(b) L. R. 13 Eq. 322.

(c) See *Helmbold v. Helmbold Manufacturing Co.*, 53 How. Pr. 453; *Hegeman & Co. v. Hegeman*, 8 Daly, 1; *Iowa Seed Co. v. Dorr*, 70 Iowa, 481.

(d) 22 Ch. D. 504.

(e) 27 Ch. D. 145. See *Vernon v. Hallam*, 34 Ch. D. 748. And compare *Bergamini v. Bastian*, 35 La. Ann. 60; *Bassett v. Percival*, 87 Mass. 345; *Hoxie v. Chaney*, 143 Mass. 592.

(f) (1896) A. C. 7.

(g) L. R. 13 Eq. 322.

was unanimously approved, and the view of the majority of the Court in *Pearson v. Pearson* (a) was overruled. The decision of the House of Lords finally establishes that the vendor of the goodwill of a business is not entitled to canvass the customers of the old firm, although it was treated as settled law that the sale of the goodwill did not, in the absence of special covenants, prevent the vendor from setting up a rival business in the same neighbourhood. The distinction between the two cases is thus pointed out by Lord Herschell: "If a person who has previously been a partner in a firm sets up in business on his own account and appeals generally for custom, he only does that which any member of the public may do, and which those carrying on the same trade are already doing. It is true that those who were former customers of the firm to which he belonged may of their own accord transfer their custom to him; but this incidental advantage is unavoidable, and does not result from any act of his. He only conducts his business in precisely the same way as he would have done if he had never been a member of the firm to which he previously belonged. But when he specifically and directly appeals to those who were customers of the previous firm, he seeks to take advantage of the connection previously formed by his old firm, and of the knowledge of that connection which he had previously acquired, to take that which constitutes the goodwill away from the persons to whom it has been sold and to restore it to himself." The principle of *Trego v. Hunt* equally applies where, on the creation of a partnership, it has been agreed that the goodwill shall belong exclusively to one of the partners (b); and the same principle has since been extended to a case where a partnership was dissolved by consent upon the terms that the continuing partner should, on payment of a money consideration to the retiring partner, retain the assets, no express mention being made of the goodwill (c). The decision of the House of Lords is only directed to voluntary transactions, and cannot be said to impeach the authority of *Walker v. Mottram* (d).

Vendor restrained, though no express covenant.

Although there is no implied covenant on the sale of a goodwill, without more, that the vendor will not set up a similar business in the same neighbourhood, yet where a vendor had received in payment for his share of a goodwill a sum calculated by arbitrators

(a) 27 Ch. D. 145.

(b) *Per* Lord Herschell, (1896) A. C. 21.

(c) *Jennings v. Jennings*, (1898) 1 Ch. 378.

(d) 19 Ch. D. 355.

upon the understanding (to which he had assented) that he would not carry on business in the same street, it was held to be contrary to Equity that he should carry on business in that street, and he was accordingly enjoined (a).

In the sale of a business and goodwill, it is customary to insert an express restrictive covenant, which will be binding on the vendor, restraining him from setting up the same trade within a certain limit of time or space, or using his name or allowing it to be used for that purpose (b); and this has become so usual that where (c), in a contract for sale, one of the items was "goodwill, &c.," Romilly, M. R., held that in the "&c." would be included, amongst other things, a covenant by the vendor not to carry on a similar business in Great Britain, for a reasonable time, to be limited in the conveyance, having regard to the nature of such undertakings. Such a covenant may even have the effect of compelling the vendor to quit his trade altogether for the period specified, as was held by Lord Mansfield, C. J., and the Court of King's Bench, in *Cooper v. Watson* (d); and it has been held that a breach of a covenant "not to carry on or be concerned or interested in" a certain business, was committed by the inventor entering into the service of a nephew, who carried on the same trade, under the same name, within the prescribed limits (e). Again, a covenant not to carry on a certain business directly or indirectly within the counties of C., A., and M., was broken by soliciting orders on three occasions within C., though the offices of the new business were outside the limits (f). A vendor of a business who had covenanted

Express restrictive covenant usual.

(a) *Harrison v. Gardner*, 2 Madd. 198. See *Cassidy v. Metcalf*, 1 Mo. App. 593.

(b) *Cooper v. Watson*, 3 Doug. 413; *Bryson v. Whitehead*, 1 S. & S. 74; *Williams v. Williams*, 2 Swanst. 253; *Whittaker v. Howe*, 3 Beav. 383; *Turner v. Evans*, 2 De G. M. & G. 740; *Newling v. Dobell*, 38 L. J. Ch. 111; *Wolmershausen v. O'Connor*, 36 L. T. N. S. 921; *Rawlinson v. Clarke*, 14 M. & W. 187; *Rolfe v. Rolfe*, 15 Sim. 88; *Shipwright v. Clements*, 19 W. R. 599; *Lee v. Ehrhart*, 19 L. T. N. S. 637; *Hagg v. Darley*, 47 L. J. Ch. 567; *Davis v. Smaggasgale*, W. N. 1890, pp. 158, 169; *Vickery v. Welch*, 19 Pick. 523; *Smith v. Smith*, 4 Wend. 468; *Sander v. Hoffman*, 64 N. Y. 248; *Feltz v. Eichele*, 62 Mo. 171; *Butler v. Burlison*, 16 Vt. 176; *Baumgarten v. Broadway*, 77 N. Car. 8; *Woods v.*

Sands, Dig. 467; *Morgan v. Perhamus*, 36 Ohio St. 517; *Williams v. Wilson*, 4 Sandf. Ch. 279; *Gillis v. Hall*, 2 Brews. 342; R. Cox, 580; and similarly upon the sale of a trade mark together with the right to manufacture according to a secret recipe: *Filkins v. Blackman*, 13 Bl. C. C. 440.

(c) *Cooper v. Hood*, 26 Beav. 293. See *Jacoby v. Whitmore*, 49 L. T. N. S. 335.

(d) 3 Doug. 413.

(e) *Newling v. Dobell*, 38 L. J. Ch. 111. See *Rolfe v. Rolfe*, 15 Sim. 88; and compare *Lee v. Ehrhart*, 19 L. T. N. S. 637, where there was held to be no breach.

(f) *Turner v. Evans*, 2 De G. M. & G. 740. And see *Smith v. Smith*, 4 Wend. 468; *Butler v. Burlison*, 16 Vt. 176; *Sander v. Hoffman*, 64 N. Y. 248.

not to carry on such a business, will not be allowed to do so under the pretext of acting as a commission merchant (a), and the fact that former customers have requested the vendor to supply them does not prevent his so doing from being a breach of his covenant (b). But where the defendant was shown to have so acted in a few instances only, and with the plaintiff's knowledge and consent, and in fact at his request, it was held that there was no breach (c).

Damages in respect of improper solicitation.

In an American case (d) it was held that a person who had retired from a firm by sale of his interest, and had agreed not to trade in C. under the old firm name, but had nevertheless traded there under the same name, and had solicited former customers of the firm, must pay damages calculated, not upon the total amount of improper solicitation of such customers, but upon the amount of business which could be proved to have been lost through such solicitation.

Covenant to make profitable.

"Where a man sells the goodwill of a trade, and covenants to make it as profitable as he can, the actual profit made is not that which the vendee is bound to take; but he will have an action of covenant, if he can establish his title to more, through the default of the vendor" (e). But no such covenant will be implied where it is not expressed; thus the sale of the goodwill of a school involves no personal effort on the part of the vendor to influence the attendance of pupils (f). Where a servant has covenanted not to carry on a business similar to his master's within certain limits, the benefit of the covenant passes to a purchaser of the goodwill of the business (g).

Rights of purchaser of goodwill.

The purchaser of a business and goodwill is entitled to all the advantages of the reputation and connection of the business as previously conducted, except such benefit as the vendor, on setting up a *bonâ fide* new business, as he is at liberty to do if there is no covenant to the contrary, may derive from the fact of his being known to have belonged to the former business; and the purchaser is entitled to restrain the vendor by injunction from interfering

(a) *Richardson v. Peacock*, 26 N. J. Eq. 40.

(b) *Sander v. Hoffman*, 64 N. Y. 248.

(c) *Rawlinson v. Clarke*, 14 M. & W. 187.

(d) *Burckhardt v. Burckhardt*, 36 Ohio St. 261.

(e) *Per Lord Eldon, C.*, in *Scott v. Mackintosh*, 1 V. & B. 503.

(f) *McCord v. Williams*, 96 Penn. St. 78.

(g) *Jacoby v. Whitmore*, 49 L. T. N. S. 335; *Showell v. Winkup*, 60 L. T. N. S. 389.

with what he has sold. With respect to the right of the purchaser to continue to trade under the old trade name, it has been thought that, at all events if it consisted in whole or in part of the name of the vendor, injury (a), or at least inconvenience (b), might result to the latter from its continued use by the purchaser, and in *Scott v. Rowland* (c) Wickens, V.-C., granted an injunction to restrain the purchaser of the business of "John Scott & Co." from trading under that name. So in *Thynne v. Shove* (d), where the business had been carried on in the name of "A. Thynne." In *Banks v. Gibson* (e), however, Romilly, M. R., said that the firm name was an asset of the business, and would pass as a trade mark upon a sale of the business and goodwill; and it seems that the question of the purchaser's right to use the name, where it can be done without injury to the vendor, must now be taken to be settled in the affirmative by the decision of the Court of Appeal in *Levy v. Walker* (f), in which Jessel, M. R., and James and Bramwell, L.JJ., denied that any liability could be occasioned to the vendor by the use of his name, and held that the plaintiff (Mrs. Levy), who, while Miss Charbonnel, had traded in partnership with the defendant as "Charbonnel & Walker," was not entitled to restrain the defendant, who had bought the goodwill of the business as a going concern, from continuing to use the old name. James, L. J., said: "It should never be forgotten in these cases

*Levy v.
Walker.*

(a) *Per* Wickens, V.-C., in *Scott v. Rowland*, 20 W. R. 508, and Hall, V.-C., in *Levy v. Walker*, 10 Ch. D. 436. See *Chatteris v. Isaacson*, 57 L. T. N. S. 177; *Thynne v. Shove*, 45 Ch. D. 577.

(b) *Per* Wood, V.-C., in *Churton v. Douglas*, Johns. 174.

(c) 20 W. R. 508. And see *Lewis v. Langdon*, 7 Sim. 421; *Turner v. Major*, 3 Giff. 442; *Dence v. Mason*, 41 L. T. N. S. 573; *Dickson v. McMaster & Co.*, 18 Ir. Jur. 202, 212; *Howe v. Searing*, 10 Abb. Pr. 264; R. Cox, 244; *Peter-son v. Humphrey*, 4 Abb. Pr. 394; R. Cox, 212; *McGowan Bros. Pump and Machine Co. v. McGowan*, 2 Cinc. 313; *Reeves v. Denicke*, 12 Abb. Pr. N. S. 92. In *Tudor v. Tudor*, W. N. 1873, p. 72, and *Probasco v. Bouyon*, 1 Mo. App. 241, there was an express contract. For decisions on the Massachusetts Gen. Stat. c. 56, requiring the concurrence of an ex-partner or his personal representatives in the continued use of his name by the continuing or surviving partners,

see *Bowman v. Floyd*, 85 Mass. 76; *Rogers v. Taintor*, 97 *ib.* 291; *Morse v. Hall*, 109 *ib.* 409; *Hallett v. Cumston*, 110 *ib.* 29; *Solier v. Johnson*, 111 *ib.* 238. By the New York statute the purchaser of a business and goodwill is not entitled to trade under the old name, but only to describe himself as successor to the old firm. See *Hegeman & Co. v. Hegeman*, 8 Daly, 1.

(d) 45 Ch. D. 577.

(e) 34 Beav. 566.

(f) 10 Ch. D. 436. And see *Webster v. Webster*, 3 Swanst. 490, n.; *Clark v. Leach*, 32 Beav. 14; *Bond v. Milbourn*, 20 W. R. 197; *Condy v. Mitchell*, 37 L. T. N. S. 268, 766; *Coulson & Sons v. Coulson & Co.*, 3 Times L. R. 846; *Tussaud v. Tussaud*, 44 Ch. D. 678; *Attenborough v. Jay*, 14 Times L. R. 439; *Smith v. McBride*, Ct. Sess. Cas. 4th Ser. XVI. 36; *Phelan v. Collender*, 13 N. Y. Sup. Ct. 244; *Booth v. Jarrett*, 52 How. Pr. 169; *Woods v. Sands*, Dig. 467; *Mossop v. Mason*, 18 Grant, Up. Can. Ch. 453.

that the sole right to restrain anybody from using any name that he likes in the course of any business he chooses to carry on is a right in the nature of a trade mark: that is to say, a man has a right to say, 'You must not use a name, whether fictitious or real—you must not use a description, whether true or not—which is intended to represent, or calculated to represent, to the world that your business is my business, and so, by a fraudulent misstatement, deprive me of the profits of the business which would otherwise come to me.' That is the principle, and the sole principle, on which this Court interferes. The Court interferes solely for the purpose of protecting the owner of a trade or business from a fraudulent invasion of that business by somebody else. It does not interfere to prevent the world outside from being misled into anything. If there is any misleading, that may be for the Criminal Courts of the country to take notice of, or for the Attorney-General to interfere with; but an individual plaintiff can only proceed on the ground that, having established a business reputation under a particular name, he has a right to restrain any one else from injuring his business by using that name. . . . But there is another point upon which I myself cannot entertain any doubt: which is this—that the assignment of the goodwill and business of Charbonnel & Walker did convey the right to use the name of Charbonnel & Walker, and the exclusive right to use that name, as between the vendor and the purchaser of that business. Whether it would prevent another person from afterwards using the name of Charbonnel, I do not say; but the trade name, made up of parts of two real names, as the Master of the Rolls says, the trade name of Charbonnel & Walker (whether it was entirely a fictitious name can make no difference) was the name of the business, and that business was sold. That was a name with which every article sold might have been impressed, just as in the case of *Millington v. Fox (a)*, where the name was continued as part of the designation of the article sold. I think it right to say that the sale of the goodwill and business conveyed the right to the use of the partnership name as a description of the articles sold in that trade, and that that right is an exclusive right as against the person who sold it, and an exclusive right as against all the world, so that no other person could represent himself as carrying on the

(a) 3 My. & Cr. 338.

same business" (a). The result of the authorities seems to be that the old firm name may be used in any way which does not expose the vendor to liability (b). But where a partner retires without assigning the goodwill to the continuing partner, the latter cannot continue to use the name of the retiring partner (c), and the sale of the goodwill and business of a company in the course of winding up has been held by Kay, J., not to include the right to use the name of the company (d).

The purchaser of the goodwill is, *a fortiori*, entitled to represent himself as continuing the old business: thus, where the business of John Douglas & Co. was sold, it was held that the purchasers alone had the right to describe themselves as "late John Douglas & Co.," and the vendor was restrained from calling his new firm "John Douglas & Co.," that being an interference with that right (e). But a purchaser has no right to use the name of the business he has bought in such a way as to create confusion in the minds of the public (f); and it is a fraud for a person to purchase the goodwill of a small business in order to gain a right to use a name generally identified with a different and important business (g). In *Warner v. Warner* (h) it was held that not only had the purchaser of the goodwill of a business in proprietary medicines the right to continue to use the old name, but that the change of the name to the purchaser's own name, so as to assimilate it to the name of an old rival business, should be restrained by injunction. And where a business has been carried on under a name somewhat resembling that under which a similar old-established business is carried on, the purchaser of the newer business must not change the name of his business so as to assimilate it to that of the older business (i). The mortgagee of the goodwill of a business, including the right to use the name under which the business is carried on, has no such right in that name as to be able to restrain

Rights of purchaser.

(a) And see *Thorneloe v. Hill*, (1894) 1 Ch. 569.

(b) *Thynne v. Shove*, 45 Ch. D. 577.

(c) *Gray v. Smith*, 43 Ch. D. 208. And see *Vonderbank v. Schmidt*, 44 La. Ann. 264; 32 Am. St. Rep. 336. Cf. *Caswell v. Hazard*, 121 N. Y. 484.

(d) *In re Bolanachi's Empire Chocolate*, 89 L. T. (Journal) 273.

(e) *Churton v. Douglas*, Johns. 174. And see *Lewis v. Langdon*, 7 Sim. 421; *McGowan Bros. Pump and Machine Co. v.*

McGowan, 2 Cinc. 313; *Phelan v. Colender*, 13 N. Y. Sup. Ct. 244. But see *Howe v. Searing*, 10 Abb. Pr. 264; R. Cox, 244; *Reeves v. Denicke*, 12 Abb. Pr. N. S. 92; *Young v. Jones Bros. & Co.*, 3 Hughes, 274.

(f) *Chinn v. Thomas*, 5 V. L. R. Eq. 188.

(g) *Perks v. Hall & Co.*, W. N. 1881, p. 111.

(h) 5 Times L. R. 359.

(i) *Holt v. Smith*, 4 Times L. R. 329.

the use of it by another person, if he has himself never traded under it (*a*).

Implied contract to keep up business.

Where, on a purchase of a business and goodwill, it was agreed that the purchaser should pay the vendor at the end of each of the first ten years a certain proportion of the profits, but there was no special agreement by the purchaser to keep up the business, it was held by Erle, C. J., and the Court of Common Pleas, that the purchaser had entered into an implied contract to keep up the business, at all events for the ten years over which the instalments were to extend (*b*). It seems that while such an implied contract would give a right to damages if broken, it could not be specifically enforced in Equity (*c*), though carrying on a similar business under a different style could be restrained (*d*).

Goodwill of mortgaged property.

In some cases questions have been raised with respect to the ownership of the goodwill of a business carried on on mortgaged premises. This has most frequently been when the mortgaged premises have been taken under compulsory powers, so that it has been necessary to decide to whom, or in what proportions, the purchase-money was payable. The principle which governs such cases was thus laid down by Cotton, L. J. (*e*). "Goodwill is a word of which few people understand the meaning. It is obvious that to certain kinds of goodwill a mortgagee will be entitled. The goodwill which attaches to a house increases the value of that house, and therefore the mortgagee is entitled to that. By that I mean, for instance, there is a well-known public-house, and from its position being well known, people go it; or a well-known shop, from its being situated in a good thoroughfare, people go to it. The goodwill is attaching to the house, and adds to the value of the house. But there may be other goodwills attaching to the personal reputation which a man has made for himself. That, of course, does not go to the mortgagee, but is a thing personal to the man whose skill and whose name have acquired that goodwill. It does not follow at all that because it is called 'goodwill' the mortgagee will be entitled to it. So far as it is incident to the

(*a*) *Beazley v. Soares*, 22 Ch. D. 660.

(*b*) *McIntyre v. Belcher*, 14 C. B. N. S. 654. Compare *Harrison v. Gardner*, 2 Madd. 198.

(*c*) *Lewis v. Langdon*, 7 Sim. 421.

(*d*) *Evans v. Hughes*, 18 Jur. 691. And see *Turner v. Major*, 3 Giff. 442.

(*e*) *Cooper v. Metropolitan Board of Works*, 53 L. J. Ch. 109 (this passage is given rather less fully at 25 Ch. D. 479), and see *Chissum v. Dewes*, 5 Russ. 29; *King v. Midland Railway Co.*, 17 W. R. 113; *Pile v. Pile*, 3 Ch. D. 36; *Ex parte Punnett, In re Kitchin*, 16 ib. 226.

house, and is connected with the house, and increases the value of the house, it goes as part of the value of the house to the mortgagee."

In a case of partnership, the goodwill of a business, newspaper, &c., including the firm name, is partnership assets, and, on a sale of the partnership business, must be sold with it, for the benefit of the partners or their creditors (a), and a receiver may be appointed until the sale (b).

Goodwill is partnership assets.

On a dissolution of partnership the business and goodwill may be disposed of in three different ways: by sale, for the benefit of the partners or their creditors; by the whole concern, including the trade name, being taken by one partner at a valuation; or by a simple division of the tangible assets of the partnership, in which case each is at liberty to use the trade name just as the partnership did previously (c), or at all events to state his connection with the old firm (d). But where a partnership was entered into for a certain term, an injunction was granted to restrain one of the partners from carrying on business with others under the old partnership name, the partnership term not having expired (e).

Disposal on dissolution.

On a dissolution of a partnership governed by articles, the retiring partner will not be entitled to compensation for his share in the goodwill except in accordance with the articles (f). Thus, in a case where provision was not made for such compensation, it was held that the premises on which the business had been carried on for many years, and which the continuing partner was entitled on dissolution to take at a valuation, were to be valued without regard to the fact of previous occupation, as, if that were taken into account, it would have the effect of making the partner in question pay for the goodwill (g).

Compensation governed by articles.

(a) *Bradbury v. Dickens*, 27 Beav. 53; *Banks v. Gibson*, 34 Beav. 566; *Hall v. Barrows*, 4 De G. J. & S. 150; *McCormick v. McCubbin*, 1 Ct. Sess. Cas. 1st Ser. I. 541; *Dayton v. Wilkes*, 17 How. Pr. 510; *R. Cox*, 224.

(b) *Marten v. Van Schaick*, 4 Paige, 479; *Williams v. Wilson*, 4 Sandf. Ch. 379.

(c) *Banks v. Gibson*, 34 Beav. 566; *Condy v. Mitchell*, 37 L. T. N. S. 268, 766; *Levy v. Walker*, 10 Ch. D. 436; *Fenton v. Levy*, 29 Sol. J. 735; *Chappell v. Griffith*, 53 L. T. N. S. 459; *Weston v. Ketcham* (1), 39 N. Y. Super. Ct. 54; S. C. (2), 51 How. Pr. 455; *Myers v.*

Kalamazoo Buggy Co., 54 Mich. 215; *Smith v. Imus*, 32 Alb. L. J. 455.

(d) *Clark v. Leach*, 32 Beav. 14; *Hookham v. Pottage*, L. R. 8 Ch. 91; *Dickson v. McMaster & Co.*, 18 Ir. Jur. 202; *Peterson v. Humphrey*, 4 Abb. Pr. 394; *R. Cox*, 212. See *Matthews v. Hodgson*, 2 Times L. R. 899.

(e) *England v. Curling*, 8 Beav. 129.

(f) *Hall v. Hall*, 20 Beav. 139; *Kennedy v. Lee*, 3 Mer. 441, 452; *Farr v. Pearce*, 3 Madd. 74; *Steuart v. Gladstone*, 10 Ch. D. 626.

(g) *Burfield v. Rouch*, 31 Beav. 241. But see *Dougherty v. Van Nostrand*, Hoff. 68.

What terms include goodwill.

But for a retiring partner to be entitled to compensation for his share in the goodwill, it is not necessary for the word "goodwill" to be mentioned in the article governing the distribution of the partnership property. In *Hall v. Hall* (a), indeed, it was held that a provision in the articles for the valuation, on the determination of the partnership, of the "property, credits, and effects," and "the stock in trade and effects," did not include the goodwill; and so, in *Dickson v. McMaster & Co.* (b), with respect to the term "stock in trade, goods, chattels, and effects." But those cases must be taken to be overruled by the cases in which the terms "stock belonging to the partnership" (c), "property and effects" (d), and "effects and things" (e), have been held to include goodwill.

Stewart v. Gladstone.

Where, however, the partnership articles of a firm of commission merchants provided that a retiring partner should receive the share in the partnership property to which he was entitled upon the basis of annual accounts taken, under another article, of the partnership "estate and effects," provision being made thereby for a fair valuation and appraisal of all the particulars included in such accounts, which might be in their nature susceptible of valuation, but no mention being made of the goodwill of the business, it was held by the Court of Appeal that, the share of partners in the goodwill of a commission business not being ordinarily estimated in calculating their annual shares of profits, and that not having been the practice in the case before them, the goodwill could not be taken into account and valued as being included in the partnership "estate and effects" (f).

Goodwill included in valuation.

On the other hand, where the articles of partnership provided that the goodwill should belong to the partners in the proportion of their shares in the business, but should not be taken into account in the accounts of the partnership, and that on the determination of the partnership a general account and valuation of the property and effects of the partnership should be taken, the partnership

(a) 20 Beav. 139.

(b) 18 Ir. Jur. 202.

(c) *Hall v. Barrows*, 4 De G. J. & S. 150.

(d) *Reynolds v. Bullock*, 47 L. J. Ch. 773. And see *Wilmer v. Thomas*, 74 Md. 485 ("all the estate and property wherever situated").

(e) *Barrow v. Barrow*, 27 L. T. N. S.

431; *Rolt v. Bulmer*, W. N. 1878, p. 119; and see *Shipwright v. Clements*, 19 W. R. 599. Where the interest of a deceased partner is purchased by the surviving partner at a valuation, under the Ohio statute, the value of the goodwill must be included. *Rammelsberg v. Mitchell*, 29 Ohio St. 22.

(f) *Stewart v. Gladstone*, 10 Ch. D. 626.

being dissolved by the death of one of the partners, it was held by Stuart, V.-C., that the goodwill must be included in the valuation of the partnership property (a).

In *Featherstonhaugh v. Fenwick* (b), it was decided that on a dissolution of a partnership, not provided for by articles, one partner could not secure to himself the whole benefit of the goodwill by claiming to take the share of the other at a valuation, or requiring him to remove his proportion from the premises, or clandestinely obtaining a renewal to himself of the lease of the premises occupied by the partnership; but where the goodwill goes with the premises, it has been held in America that the partners who quit the premises have no claim in respect of goodwill against a partner who remains on the premises (c); and where, under a power contained in the articles, a majority of the partners in a firm expelled another partner, it was decided that in the valuation of the amount to which he was entitled, the value of the goodwill could not be taken into account (d).

One partner cannot monopolise goodwill, when no articles.

If, after a dissolution of partnership by the death of a partner, "the surviving partners think proper to make that which is in Equity the joint property of the deceased and them the foundation and plant of increased profit, if they do not think proper to settle with the executors and put an end to the concern, they must be understood to proceed upon the principle which regulated the property before the death of their partner" (e); that is to say, capital belonging to the estate of the deceased partner having been risked, such a proportion of the total profits as are attributable to that capital will belong to that estate.

Estate of dead partner shares in partnership profits until settlement.

But in the computation of what profits are attributable to that capital a variety of circumstances have to be taken into consideration: thus, "the nature of the trade, the manner of carrying it on, the capital employed, the state of the account between the partnership and the deceased partner at the time of his death, the

Subject to circumstances.

(a) *Wade v. Jenkins*, 2 Giff. 509.

(b) 17 Ves. 298; and so in *Mitchell v. Read* (1), 61 N. Y. 128. As to a trade mark, see *Weston v. Ketcham* (1), 39 N. Y. Super. Ct. 54.

(c) *Musselman and Clarkson's Appeal*, 62 Penn. St. 81.

(d) *Stewart v. Gladstone*, 10 Ch. D. 626.

(e) Per Lord Eldon, C., in *Crawshay v. Collins*, 15 Ves. 227. And see *Featherstonhaugh v. Fenwick*, 17 Ves. 298; *Heathcote v. Hulme*, 1 Jac. & W. 122; *Brown v. De Tastet*, Jac. 284; *Cook v. Collingridge*, Jac. 607; *Macdonald v. Richardson*, 1 Giff. 81; and *Parsons v. Hayward*, 31 L. J. Ch. 666.

conduct of parties after his death, all of which may materially affect the rights of the parties" (a).

Similarly with goodwill.

In the same manner, on the death of a partner, the goodwill ought, if there is no provision regulating its destination in such an event, to be sold for the benefit of the partnership, and if that is not done, the continuing partners will have to account to the estate of the deceased partner for his share in the goodwill.

Goodwill does not survive.

There is, indeed, a distinct decision (b) by Lord Loughborough, C., that upon a dissolution of a partnership without articles the goodwill survives to the surviving partner. This position was, however, doubted by Lord Eldon, C., in *Crawshay v. Collins* (c); and it is now thoroughly established that the goodwill is partnership assets. "The goodwill of a trade, although inseparable from the business, is an appreciable part of the assets of a concern, both in fact and in the estimation of a Court of Equity. Accordingly, in reported cases, Lord Eldon held that a share of it properly and as of right belonged to the estate of the deceased partner. It does not survive to the remaining partners, unless by express agreement; but it may by agreement, as it may be agreed that any particular portion of the partnership assets shall so survive. Goodwill manifestly forms a portion of the subject-matter which produces profits, which constitutes partnership property, and which is to be divided between the surviving partners and the estate of the deceased partner, according to the terms of the contract, and when that is silent, according to their shares in the concern" (d). The share of the deceased partner in the concern is not, however, the sole guide to the interest of his estate in the goodwill. The various circumstances alluded to by Wigram, V.-C., in *Willett v. Blandford* (e) must be considered. Thus, where at the time of the death of one of two partners the partnership was insolvent,

(a) *Per* Wigram, V.-C., in *Willett v. Blandford*, 1 Hare, 253. And see *Simpson v. Chapman*, 4 De G. M. & G. 154, where these remarks were highly approved by Turner, L. J., and it was held that under the circumstances of the case, nothing was due to the estate of the deceased partner.

(b) *Hammond v. Douglas*, 5 Ves. 539. And see *Lewis v. Langdon*, 7 Sim. 421; *Robertson v. Quiddington*, 28 Beav. 529; *Young v. Jones Brothers & Co.*, 3 Hughes, 274.

(c) 15 Ves. 227.

(d) *Per* Romilly, M. R., in *Wedderburn v. Wedderburn*, 22 Beav. 84. And see *Macdonald v. Richardson*, 1 Giff. 81; *Bradbury v. Dickens*, 27 Beav. 53; *Smith v. Everett*, 27 Beav. 446; *Hall v. Barrows*, 4 De G. J. & S. 150; *McCormick v. McCubbin*, Ct. Sess. Cas. 1st Ser. I. 541; *Dougherty v. Van Nostrand*, Hoff. 68; *Dayton v. Wilkes*, 17 How. Pr. 510; *R. Cox*, 224; cf. *Stewart v. Einstein & Saurhill*, 64 U. S. Pat. Gaz. 1333.

(e) 1 Hare, 253.

and the deceased partner indebted to the partnership, and the surviving partner subsequently carried on the business with such energy and success that he was able at a later period to sell the goodwill for £1,700, it was held by Jessel, M. R., that the surviving partner was only liable to account to the estate of his deceased partner for the value of a moiety of the goodwill at the time of the latter's death (a).

With respect to the trade name, Shadwell, V.-C., in *Lewis v. Firm name. Langdon* (b), expressed an opinion that it survived, but the decision in that case only amounted to this: that one of three executors of a deceased partner in the firm of "Brookman & Langdon" had no right to set up in business as "Brookman & Langdon," and that the surviving partner, who was carrying on business as "James Lewis & Co., successors to Brookman & Langdon," had sufficient interest in the name of the old firm to restrain an unauthorised use of it (c); and it seems that one member of a firm cannot, on the death of his partner, monopolise all the benefit to be derived from the use of the firm name (d), although, if he purchases the interest of his deceased partner from the latter's executors, he will be entitled to the exclusive use of the old firm name (e).

When, on a dissolution of partnership, the goodwill of the business becomes the property of some of the former partners, with it they acquire the right of representing their remodelled business as being the continuation of the old one; and they are at liberty to express this by styling themselves "B. & C., late A. and B.," or "B. & C., successors to A. & B.," or by using any similar words (f). If they continue to use the style of the old business, "A. & B.," as before, then, as regards the partner by whose retirement or death the dissolution has been brought about, it does not appear that he or his estate will be exposed to loss or inconvenience, Firm continued by certain partners.

(a) *Broughton v. Broughton*, 44 L. J. Ch. 526. And compare *Simpson v. Chapman*, 4 De G. M. & G. 154.

(b) 7 Sim. 421. See *Milner v. Reed*, Dig. 328.

(c) In this respect *Hine v. Lart*, 10 Jur. 106, and *Dent v. Turpin*, 2 J. & H. 139, seem to be in point, as in those cases the plaintiff had a certain right, but not an exclusive right, in the trade marks. See *Scott v. Scott*, 16 L. T. N. S. 143.

(d) A decided opinion to this effect is expressed in *Lindley on Partnership*.

And see *Fenn v. Bolles*, 7 Abb. Pr. 202.

(e) *Phelan v. Collender*, 13 N. Y. Sup. Ct. 244.

(f) *Churton v. Douglas*, Johns. 174; *Lewis v. Langdon*, 7 Sim. 421; *Hookham v. Pottage*, L. R. 8 Ch. 91; *Peterson v. Humphrey*, 4 Abb. Pr. 394; *R. Cox*, 212; *McGowan Brothers' Pump & Machine Co. v. McGowan*, 2 Cinc. 313; *Phelan v. Collender*, 13 N. Y. Sup. Ct. 244; *Young v. Jones Brothers & Co.*, 3 Hughes, 274. But see *Reeves v. Denicke*, 12 Abb. Pr. N. S. 92.

or that he or his representatives have any ground for complaint (a); and, as regards the public, it seems that the use of the old name does not, as a rule, constitute any false representation, the only statement being that the new firm is carrying on the business of the old one (b). Such continued user, however, will not be permitted when it can be only for an improper and fraudulent purpose, and in order to deceive the public (c); nor where the partnership has been only contrived with a view to giving the purchaser of a professional business the means of appropriating to himself the personal reputation of the vendor (d).

Rights on
dissolution
by retirement
or by death
and sale of
goodwill.

When a partner has retired from a business, his share and interest therein being taken over by the continuing partners, or when, on the death of a partner, the partnership business has been sold, the retiring or surviving partner, as the case may be, has full liberty to set up a precisely similar business to that which the partnership carried on, but he must not represent it to be the same business (e). To use the language of Fry, J., in *Mogford v. Courtenay* (f) "the rights of a late partner who has no interest in the goodwill of the old business, to carry on trade are somewhat refined. They amount shortly to this—that he may carry on a similar trade or similar business; he cannot carry on the identical business. He is at liberty to do everything which flows from the right to carry on a similar business; he is prohibited or liable to be restrained from doing anything which conduces to his carrying on the identical business; but what acts come within either of those classes is a question of very considerable nicety." To this extent the rights of an expelled partner are the same as if he had retired voluntarily (g). In the valuation, therefore, of the share of a retiring or dead partner, which is to be taken over by the

(a) See *Levy v. Walker*, 10 Ch. D. 436, and cases at p. 315, *supra*.

(b) *Banks v. Gibson*, 34 Beav. 566; *Aubin v. Holt*, 2 K. & J. 66. And see *Leather Cloth Co. v. American Leather Cloth Co.*, 1 H. & M. 271; 4 De G. J. & S. 137; 11 H. L. C. 523; *Phelan v. Collender*, 13 N. Y. Sup. Ct. 244; *Probasco v. Bouyon*, 1 Mo. App. 241; *Oakes v. Tonsmierre*, 4 Woods, 547.

(c) *Dence v. Mason*, Dig. 534; 41 L. T. N. S. 573.

(d) *Thornbury v. Beville*, 1 Y. & C. Ch. 554. And see *Oakes v. Tonsmierre*, 4 Woods, 547.

(e) *Kennedy v. Lee*, 3 Mer. 441, 452; *Harrison v. Gardner*, 2 Madd. 198; *Churton v. Douglas*, Johns. 174; *Hall v. Barrows*, 4 De G. J. & S. 150; *Clark v. Leach*, 32 Beav. 14; *Bond v. Milbourn*, 20 W. R. 197; *Hockham v. Pottage*, L. R. 8 Ch. 91; *Selby v. Anchor Tube Co.*, W. N. 1877, p. 191; *Wolmershausen v. O'Connor*, 36 L. T. N. S. 921; *Leggott v. Barrett*, 15 Ch. D. 306; *Rammelsberg v. Mitchell*, 29 Ohio St. 22; *Cottrell v. Babcock Printing Press Manufacturing Co.*, 35 Alb. L. J. 129.

(f) 45 L. T. N. S. 303.

(g) *Dawson v. Beeson*, 22 Ch. D. 504.

surviving partner, this fact should be taken into consideration, as it may materially affect and even destroy the value of the share (a); and when the business is to be sold, that fact should be stated in the particulars of sale, in order that the purchaser may be able to buy with a full knowledge of the facts (b). In *Smith v. Everett* (c), the survivor of two partners in a banking business sold the business, and it was held that the estate of the deceased partner was entitled to a share of so much of the purchase-money as was attributable to the goodwill. Romilly, M. R., directed that this value should be ascertained, regard being had to the facts that: 1st, the partnership premises belonged to the survivor; 2ndly, the survivor had the right to carry on the business of a banker on the same premises after the sale of the goodwill; 3rdly, the sole right of issuing bank notes survived to him.

Unless he has specially contracted not to do so (d), a retiring or surviving partner may advertise generally the facts that he was connected with the former business, and that he is establishing a new business (e), and he may style himself "formerly" or "late" of the firm, and, if he occupies the premises formerly occupied by the firm, may state that they were so occupied; but he may not describe himself as "successor to" the old firm.

Retiring or surviving partner may state former connection.

A retiring partner may advertise the discontinuance of his participation in a periodical issued by the partnership, but he is not at liberty to advertise its discontinuance generally, any more than he might represent the partnership to have ceased to carry on business, upon his own retirement (f). And where an ex-partner knowingly allowed his former firm to continue to use his name, it was held that he was estopped from denying his partnership as against a person who had acted in the belief that he was still a partner (g).

And the termination of that connection.

(a) *Mellersh v. Keen*, 28 Beav. 453; *Davies v. Hodgson*, 25 Beav. 177; *Ramnielsberg v. Mitchell*, 29 Ohio St. 22.

(b) *Cook v. Collingridge*, Jac. 607; *Hall v. Barrows*, 4 De G. J. & S. 150. And see the form settled by the L.J.J. in *Johnson v. Helleley*, 2 De G. J. & S. 446.

(c) 27 Beav. 446.

(d) *Wolmershausen v. O'Connor*, 36 L. T. N. S. 921.

(e) *Bradbury v. Dickens*, 27 Beav. 53; *Clark v. Leach*, 32 Beav. 14; *Labouchere v. Dawson*, L. R. 13 Eq. 322; *Graveley v.*

Winchester, Seton, 5th ed. 591; *Burrows v. Foster*, 1 N. R. 156; *Selby v. Anchor Tube Co.*, W. N. 1877, p. 191; *Leggott v. Barrett*, 15 Ch. D. 306; *Walker v. Mottram*, 19 *ib.* 355; *Dawson v. Beeson*, 22 *ib.* 504; *Morgan v. Schuyler*, 79 N. Y. 490.

(f) *Bradbury v. Dickens*, 27 Beav. 53. In *England v. Curling*, 8 Beav. 129, an injunction was granted to restrain a partner from publishing notices of the dissolution of the partnership during the term for which it was to subsist.

(g) *Richards v. Hunt*, 65 Ga. 342. So in *Backus v. Taylor*, 84 Ind. 503.

Necessary announcements may be made.

While, however, a retiring partner is not at liberty to depreciate the property, his share in which has passed to others (a), a partner who has bought the share of his partner may, even before the purchase is in all respects completed, publish statements which are necessary to induce others to join him, and to enable him to carry on the business, though, in the opinion of the selling partner, that may have a prejudicial effect on what is still, in a sense, the partnership property (b).

Business carried on in separate districts.

Where two partners, having been in the habit of carrying on the partnership business, each in a separate district, agreed to dissolve partnership, the premises, stock, and goodwill to be sold, or until sale to vest in a receiver, Stuart, V.-C., restrained one partner from carrying on the business on his own account in one district, and directed him to account for the profits (c).

Right of election protected.

Again, where it was provided by the partnership articles that, on the death of one of the partners, his personal representative should have the right to elect, within three months, to take the deceased partner's share in the business, Wood, V.-C., restrained the surviving partner from carrying on the business under any other firm or style than that used in the lifetime of the deceased partner, for three months, or until election by his representative (d). But it seems that though the Court can restrain the surviving partner from carrying on the business in any other name, it has no means of compelling him to carry it on in the original name (e).

Valuation of goodwill.

The value of a goodwill, or share of a goodwill, is usually estimated at so many years' purchase upon the amount of the profits (f); thus, in *Mellersh v. Keen* (g), it was fixed at one year's purchase of the net annual profits, calculated on an average of three years (h).

(a) *Bradbury v. Dickens*, 27 Beav. 53.

(b) *Marshall v. Watson*, 25 Beav. 501.

(c) *Turner v. Major*, 3 Giff. 442.

(d) *Evans v. Hughes*, 18 Jur. 691.

(e) *Lewis v. Langdon*, 7 Sim. 421.

(f) *Austen v. Boys*, 2 De G. & J. 626.

(g) 28 Beav. 453; and see *Donald v. Hodgart's Trustees*, Ct. Sess. Cas. 4th Ser. XXI. 246.

(h) As to other circumstances to be considered, see *Smith v. Everett*, 27 Beav. 446; *Johnson v. Helleley*, 34 Beav. 63; 2 De G. J. & S. 446.

APPENDIX A.

THE PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888, AND THE RULES AND INSTRUCTIONS THEREUNDER.

THE PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883 (a). 46 & 47 VICT. c. 57.

*An Act to amend and consolidate the Law relating to Patents for
Inventions, Registration of Designs, and of Trade Marks.*
[25th August, 1883.]

BE it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords spiritual and temporal, and Commons, in this present Parliament assembled, and by the authority of the same as follows :

(a) The parts of this Act which have been expunged by the later Acts are printed in italics, and the provisions which have been introduced are printed in brackets.

PART I.

PRELIMINARY.

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| <p>1. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1883.</p> <p>2. This Act is divided into parts, as follows :—
 Part I.—PRELIMINARY.
 Part II.—PATENTS.
 Part III.—DESIGNS.
 Part IV.—TRADE MARKS.
 Part V.—GENERAL.</p> <p>3. This Act, except where it is otherwise expressed, shall commence from and immediately after the thirty-first day of December, one thousand eight hundred and eighty-three (a).</p> | <p>Part I.
Preliminary.
Short title.
Division of Act into parts.
Commence-ment of Act.</p> |
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(a) The Act of 1888, except where otherwise provided, commenced on the 1st January, 1889 (§ 28).

PART II. (SECTS. 4—46.)

PATENTS.

PART III. (SECTS. 47—61.)

DESIGNS (a).

(a) For § 51, requiring articles bearing a registered design to be marked so as to denote the fact of registration, see Appendix G., p. 608.

PART IV.

TRADE MARKS.

Registration of Trade Marks.

Application
for registra-
tion.

62.—(1.) The comptroller (a) may, on application by or on behalf of any person (b) claiming to be the proprietor (c) of a trade mark (d), register the trade mark (e).

(2.) The application (f) must be made in the form set forth in the first schedule to this Act, or in such other form (g) as may be from time to time prescribed (h), and must be left at, or sent by post to the *Patent Office in the prescribed manner* [such place and in such manner as may be prescribed] (i).

(3.) The application must be accompanied by the prescribed number of representations (k) of the trade mark, and must state the particular goods or classes of goods (l) in connection with which the applicant desires the trade mark to be registered.

(4.) The comptroller may, if he thinks fit (m), refuse to register a trade mark (n); but any such refusal shall be subject to appeal to the Board of Trade (o), who shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions (p), if any, registration is to be permitted.

(5.) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court; and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid (q).

[(6.) Where an applicant for the registration of a trade mark otherwise than under an International Convention is out of the United Kingdom at the time of making the application, he shall give the comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given (r)].

The amendments in this section were made by § 8 of the Act of 1888.

(a) The Comptroller General of Patents, Designs, and Trade Marks: § 117.

(b) "Person" includes a body corporate: § 117, Rule 41. There is no limitation to British subjects, and the practice hitherto has been to grant registration to aliens. See, however, *In re Riviere & Co.*, 26 Ch. D. 48. By § 103, a certain priority is given to foreign applicants who have applied for registration in their own countries.

(c) By "claiming to be the proprietor" nothing more is meant than "claiming to be the first to adopt," whether there has been any user or not. The doubt expressed in *In re Anderson*, 54 L. J. Ch. 1084; *Edwards v. Dennis*, 30 Ch. D. 454; and *In re Lyndon*, 32 Ch. D. 109, is now removed: *In re Hudson*, 32 Ch. D. 311. And see *In re Hicks*, 22 V. L. R. 636, a decision upon a similar provision in the Trade Marks Act of Victoria. But "a person who puts another's trade mark on the register cannot be a person entitled within the Act": *per Fry, L. J.*, *In re Apollinaris Co.*, (1891) 2 Ch. 186, 226; and an importer cannot register as his own

a trade mark of the foreign producer, at all events, unless he has the control of the entire output: *Id.* Again, a person cannot register a trade mark without any intention of using it in his business: *In re Apollinaris Co.*, (1891) 2 Ch. 186, 234, 235; *In re Batt*, (1898) 2 Ch. 432. For registration to be good a title must be shown which is good according to the law of England, so that a mark which has been assigned in gross abroad ought not to be registered: *Pinto v. Badman*, 8 P. R. 181—192, 193; nor a mark which, though registered abroad, does not contain any of the essential particulars required by this Act: *In re Carter Medicine Co.*, (1892) 3 Ch. 472. Since by § 77 a trade mark within that section cannot be protected until either it has been registered or registration has been refused, it hardly seems that there can be any effective proprietorship until registration has been granted, or, in the case of an old mark—*i.e.*, a mark used before August 13th, 1875—refused.

(d) As to what is a trade mark, see § 64, *infra*, and Ch. II.

(e) As to the mode of registration, see Rules 32—35; *infra*, pp. 401—413, where the Rules now in force, *viz.*, the Rules of 1890 as amended by the Rules of 1897 and 1898, are set out. By Rule 33, if an applicant dies before registration, the trade mark may be registered for the successor to the goodwill of his business.

(f) For the mode of making application, see Rules 7—16. By § 81 (3), applications for registration of Hallamshire cutlery marks must be made to the Cutlers' Company.

(g) Form F. in the Second Schedule to the Rules is substituted for Form F. in the Schedule to the Act. See Rules, 4, 5.

(h) "Prescribed," *i.e.*, by the Rules. See § 117.

(i) See Rule 16.

(k) Four in classes 23—35; three in other classes. See Rule 13, and Form G.

(l) The application may be for any goods in a class. See Form F. But it should be only for the particular goods for which the applicant has used or is about to use the mark: *Edwards v. Dennis*, 30 Ch. D. 454; *Hargreave v. Freeman*, (1891) 3 Ch. 39. Similarly, an application for the whole of a class by a person who does not deal or intend to deal in goods in that class is improper: *In re Batt & Co.*, (1898) 2 Ch. 432. For the classification of goods, see Rule 6 and the Third Schedule to the Rules; also Guide to Classification, *infra*, p. 424.

(m) The comptroller's discretion to allow the registration of a trade mark is limited by §§ 69, 72, 73. See *per* Cotton, L. J., in *In re Australian Wine Importers, Ltd.*, 41 Ch. D. 278, and *per* Pearson, J., in *In re Price's Patent Candle Co.*, 27 Ch. D. 681. And, further, "the question whether the comptroller shall, in the exercise of the discretion which the Act gives to him, register a trade mark, is a very different question from any of the questions upon a trade mark that can be raised. He is quite within his duty, and he is quite entitled, if he thinks that—either because there are words in it, the exclusive use of which would be calculated to deceive, or otherwise—there is a sufficient reason, to say 'No; I do not think it is proper to register this trade mark'": *per* Kay, J., in *In re Dunn*, 41 Ch. D. 439. And see the same case in the House of Lords, 15 App. Cas. 252; *In re Marks & Tellefsen*, 63 L. T. N. S. 234; *In re Speer*, 55 L. T. N. S. 880; *In re Farrow*, 7 P. R. 260; and *In re Turney*, 11 P. R. 37. It is to be observed that in *Orr-Ewing v. Registrar of Trade Marks*, 4 App. Cas. 497, Lord Blackburn, referring to § 5 of the Act of 1875, by which it was provided that the Court "may" direct registration of a trade mark to which a claimant is entitled, said: "I cannot construe this section as meaning anything else than that, where the Court of Chancery is satisfied that the applicant is a person who is for the time being entitled to the exclusive use of a trade mark in accordance with law, and that the trade mark is one within the definition in the Act, the Court is, *ex debito justitiæ*, to rectify the register, just as it would, before the Act of 1875, have been bound *ex debito justitiæ*, on similar proof, to prevent any one infringing the trade mark shown to be his property." And his lordship went on to say that, though the burden of proof lay upon the person making the application, yet if he did produce such proof as would, in the opinion of the Court, entitle him to an injunction, he did not think that the Court had any discretion to consider whether the registration would be inconvenient. If the comptroller has an absolute discretion to reject any mark he thinks fit, the result may be, in the case of an old mark, to destroy a very valuable property without redress. These statements must, however, be taken in connection with the dicta in the House of Lords in *Eno v. Dunn*, 15 App. Cas. 252, *e.g.*, *per* Lord Herschell, at p. 261, where he said: "Those sections" (*i.e.*, §§ 72 and 73) "prohibit the registration of a trade mark in certain specified cases; but there is no duty cast upon the comptroller of registering every other trade mark that may be applied for. On

the contrary, whilst he is in certain cases prohibited from registering, a discretion whether to register or not appears to me to be in all cases plainly conferred. Of course, this discretion must be reasonably and not capriciously exercised." It is to be observed that Lord Blackburn was primarily referring to an old mark, and Lord Herschell to a new one. In any event the comptroller is forbidden to refuse registration without giving the applicant an opportunity of being heard: § 94. Whether the comptroller is justified in registering oriental words as a trade mark, *quære*: *In re Newhurst & Sons, Ltd.*, (1896) 2 Ch. 137.

(n) Before refusing to register a mark, the comptroller is to give the applicant ten days' notice of a time when he may be heard personally or by his agent: § 94 and Rules 17—19.

(o) See Rules 20—26 and Form H.

(p) As to limited registration, see note (e) to § 72, *infra*.

(q) The Court is the High Court of Justice in England: § 117. The Court has no jurisdiction to deal with an application which the comptroller has refused, except upon an appeal to the Board of Trade and a reference of the matter by the Board to the Court: *In re Normal Co., Ltd.*, 35 Ch. D. 231. But the Board should refer the matter to the Court: *ib.* On the matter coming before the Court all objections can be taken, whether originally raised by the comptroller or not: *In re Sanitas Co., Ltd.*, 4 P. R. 533. When the comptroller refuses an application, and the matter is taken to the Court, the usual rule is to make the applicant pay the comptroller's costs, whether successful or unsuccessful: *In re Van Duzer*, 34 Ch. D. 623. Where the Court was moved to direct the comptroller to proceed with an application to register notwithstanding the existence on the register of a mark belonging to a foreign company, and notice was sent to the company, but was not acknowledged, the Court directed the comptroller to proceed in the company's absence without prejudice to any opposition, the applicant undertaking to give due notice to the company of the advertisement: *In re Stringer*, 8 P. R. 445. See Rule 44 as to entering orders of the Court on the register.

(r) As to the address for service, see *per* Lindley, L. J., in *In re King & Co.*, (1892) 2 Ch. 462, 378; also *In re Robertson, Sanderson & Co.*, 9 P. R. 213.

Limit of time for proceeding with application.

63. Where registration of a trade mark has not been or shall not be completed within twelve months from the date of the application, by reason of default on the part of the applicant, *the application shall be deemed to be abandoned* (a) [the comptroller shall give notice of the non-completion to the agent employed on behalf of the applicant, and if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant, and if at the expiration of the latter fourteen days, or such further time as the comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned].

(a) This provision was first made by the edition of March, 1883, of the Rules under the old Acts. The amendments in this section were made by § 9 of the Act of 1888. By the combined operation of this section and § 113 all applications not completed within the prescribed time by the applicant's default lapse, whether they were pending at the date of this Act or have been made subsequently: *In re Hayward & Co.*, 54 L. J. Ch. 1003. And this is so, though the default was occasioned by the neglect of the applicant's agent, and not of the applicant himself: *Jackson & Co. v. Napper*, 35 Ch. D. 162. But a trade mark registered in 1885, in pursuance of an application made in 1879, was allowed to remain on the register, subject to certain disclaimers, and to the entry of a note on the register making the five years for the purposes of § 76 run from 1885 and not from 1879: *In re Hayward & Co.*, 54 L. J. Ch. 1003. An application which has been abandoned may afterwards be renewed, at all events where the applicants are not personally in default: *Jackson & Co. v. Napper*, 35 Ch. D. 162; *In re Bancroft & Co.*, 5 P. R. 209. In *In re United Vineyards Proprietors' Co.*, Stirling, J., Nov. 8th, 1889, an application made in 1876 had lapsed in consequence of the applicants having failed to comply with a request from the registrar for the payment of the final fee, the letter containing such request having miscarried. The applicants supposed that the mark had been registered, and took no further step. In 1882 a somewhat similar new mark was registered

for the same goods by another firm. In 1889 the mistake was discovered by the original applicants, and they at once made a fresh application. The matter was referred to the Court, and it was held that, the mark having been used long before 1875, the registration should proceed, notwithstanding that the firm registered in 1882 refused to consent, while not appearing to actively oppose. So, also, in *In re Loftus*, (1894) 1 Ch. 193, a renewed application was allowed to proceed.

- 64.—(1.) *For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars (a):* Conditions of registration of trade mark.
- (a.) *A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner (b); or*
 - (b.) *A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark (c); or*
 - (c.) *A distinctive (d) device, mark, brand (e), heading (f), label (g), ticket, or fancy word or words not in common use (h).*
- (2.) *There may be added to any one or more of these particulars any letters, words or figures, or combination of letters, words or figures, or of any of them.*
- (3.) *Provided that any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures used as a trade mark before the thirteenth day of August, one thousand eight hundred and seventy-five, may be registered as a trade mark under this part of this Act.*

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

- (a.) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or
 - (b.) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark; or
 - (c.) A distinctive device, mark, brand, heading, label, or ticket; or
 - (d.) An invented word or invented words (i); or
 - (e.) A word or words having no reference to the character or quality of the goods, and not being a geographical name (j).
- (2.) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them (k); but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register (l).
- (3.) Provided as follows:
- (i.) A person (m) need not under this section disclaim his own name (n) or the foreign equivalent thereof, or his place of business (o); but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof;
 - (ii.) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures, used as a trade mark before the thirteenth day of August,

one thousand eight hundred and seventy-five, may be registered as a trade mark under this part of this Act (p).]

The amendments in this section were made by § 10 of the Act of 1888.

(a) This section is enlarged from § 10 of the Act of 1875. The essential particular is that which causes a mark which, without it, would not be a registrable trade mark, to be a registrable trade mark; it is that by virtue of which registration is granted to a mark; and when the validity of an alleged trade mark is being considered by the Court, "the first duty cast upon the Court is to ascertain whether some one or more than one of the essential particulars of a trade mark, as defined by the Act, is found to exist, so that the mark may be described with one or more than one essential particular or particulars which distinguish it": *per* Earl Cairns, C., in *Orr-Ewing v. Registrar of Trade Marks*, 4 App. Cas. 479. This being so, it is provided by § 92 that, though non-essential particulars of registered trade marks may be altered with the leave of the Court, essential particulars may not be. Where, therefore, two trade marks had been registered, one of which contained the name of the firm in ordinary type, and the other contained it printed in the form of a signature, Jessel, M. R., allowed a firm who had acquired the trade mark by assignment to substitute their own name for the name printed in ordinary type, but refused to allow any alteration of the signature in the second mark: *In re Dewhurst*, M. R., June 11th, 1880. See also *In re Murphy & Co.*, 7 P. R. 163. A trade mark which does not contain any essential particular, and is therefore not registrable, does not become a good trade mark by remaining five years on the register: *In re Palmer* (1), 21 Ch. D. 47; (3), 24 Ch. D. 504; *In re Ralph*, 25 Ch. D. 194; *In re Leonard & Ellis*, 26 Ch. D. 288; *In re Lloyd & Sons*, 27 Ch. D. 646; *In re Wragg*, 29 Ch. D. 551; *Edwards v. Dennis*, 30 Ch. D. 454; *Wood v. Lambert*, 32 Ch. D. 247; *In re Spencer*, 54 L. T. N. S. 659; *In re Apollinaris Co.*, (1891) 2 Ch. 186. So in Victoria: *Lewis v. Klapproth*, 11 V. L. R. (E.) 214; *Wolfe v. Alsop* (2), 12 V. L. R. (E.) 421; *Wolfe v. Lang & Co.*, 13 V. L. R. 752. The definition section in the Canada statute is wider, so that cases on this section must be applied with caution in Canada: *Smith v. Fair*, 14 Ont. Rep. 729.

(b) See *ante*, p. 23. The words "individual or firm" in clause (a) as in clause (b) mean a real human being and a real firm, the names of fictitious persons falling under clause (c), and if the name falls under clause (a) it is excluded from clause (c), and *vice versa*: *per* Smith, L. J., *In re Holt*, (1896). 1 Ch. 711, 724, 725. The name of a living public character unconnected with the business falls under this clause and cannot be registered if printed in ordinary type: *In re Carroll*, 16 P. R. 82. The name of an individual in ordinary type is not made distinctive by having the descriptive name of the goods added: *In re Gianacis*, 6 P. R. 467; *In re Hannay*, 7 P. R. 46; *In re Edge*, 8 P. R. 207. And see *Pirie v. Goodall*, (1892) 1 Ch. 35, where Lindley, L. J., stated that "Pirie's" in the genitive was not the name of an individual or firm for the purposes of this clause.

(c) See *ante*, p. 31; and *In re Dewhurst*, M. R., June 11th, 1880. Registration of a signature, together with a descriptive word, gives no exclusive right in the descriptive word: *Watt v. O'Hanlon*, 4 P. R. 1.

(d) See *ante*, p. 32. The word "distinctive" applies to all the varieties of marks mentioned in this sub-section: *per* Cotton, L. J., in *Waterman v. Ayres*, 39 Ch. D. 29; and *per* Chitty, J., in *Burland & Co. v. Broxburn Oil Co., Ltd.* (2), 42 Ch. D. 274; and see *Pirie v. Goodall*, (1892) 1 Ch. 35. The distinctiveness which is required cannot consist solely in colour: *In re Hanson*, 37 Ch. D. 112. To entitle a mark to registration it must at the date of registration distinguish the goods of the person registering it from all others: *In re Apollinaris Co.*, (1891) 2 Ch. 186, 226, 230; and an importer cannot register as his own the trade mark of the foreign producer, at all events, unless he has the control of the entire output: *Ib.*

(e) To be registrable, a brand cannot consist of words unless they are capable of registration as such: *Pirie v. Goodall*, (1892) 1 Ch. 35; nor does the addition of the word "brand," as part of a trade mark, to words which are not capable of registration validate the trade mark: *In re Paine*, 9 P. R. 130. *Semble*, a water-mark woven into the texture of paper may be a brand: *per* Williams, J., in *Pirie v. Goodall*, (1892) 1 Ch. 35.

(f) A word used alone is not a heading: *per* Earl of Selborne, C., in *In re Leonard & Ellis*, 26 Ch. D. 288, 295.

(g) The label itself must be distinctive, so that a label with the name of the proprietors in ordinary type and words descriptive of the goods is not a distinctive

label: *In re Price's Patent Candle Co.*, 27 Ch. D. 681; *In re Bradley*, 9 P. R. 205; *In re Birmingham Vinegar Brewery Co.*, 11 P. R. 195; nor can words which are descriptive or common to the trade be such a label: *Great Tower St. Tea Co. v. Smith*, 6 P. R. 165. It has been thought that a distinctive label must contain elements capable of themselves of constituting essential particulars within the Act, and that a novel combination of old elements, none of which fall within this description, will not do: *In re Bryant & May, Ltd.*, 8 P. R. 69; but in *In re Bradley*, 9 P. R. 205, Chitty, J., while holding that a mark when looked at as a whole must contain at least one of the essential particulars, thought that a novel combination of devices not in themselves distinctive, because in common use, would be capable of registration: cf. *In re Birmingham Vinegar Brewery Co.*, 11 P. R. 195. The label is the entire combination: *Pinto v. Badman*, 8 P. R. 181, 191, per Lord Esher, M. R.; see *In re Apollinaris Co.*, (1891) 2 Ch. 186; *In re Smokeless Powder Co.*, (1892) 1 Ch. 590. A label was held to be distinctive in *In re Bryant & May, Ltd.*, 4 Times L. R. 675; and see *Bryant & May v. Heyde*, 7 N. S. W. Rep. (E.) 72. The registration of a distinctive label does not give an exclusive right to descriptive words appearing on it: *In re Hudson*, 32 Ch. D. 311; *In re Atkins Filter & Engineering Co., Ltd.*, 3 P. R. 164; *Symington & Co. v. Foolman, Pretty & Co.*, 56 L. T. N. S. 696; *Watt v. O'Hanlon*, 4 P. R. 1; *Lewis's v. Goodbody*, 67 L. T. N. S. 194; *Rugby Portland Cement Co. v. Rugby & Newbold Cement Co.*, 8 P. R. 241; 9 P. R. 46; cf. *In re Paine (2)*, (1893) 2 Ch. 567; nor to words common to the trade registered in connection with it: *British Tea & Trading Association, Ltd. v. Cooke, Bacon, V.-C.*, June 8th, 1886. And where applicants applied for registration of a label containing descriptive words, and contended that their registration would give them a right to the descriptive words, the opinion of the Court of Appeal negating the claim was stated in the order of the Court allowing the registration to proceed: *In re Hudson*, 32 Ch. D. 311.

(h) See *ante*, p. 38. Fancy words were not registrable under the old Act: *Ex parte Stephens*, 3 Ch. D. 659; and see *Rose v. Evans*, 48 L. J. Ch. 618. A fancy word cannot be made out of that which is not one by prefixing the word "the": *In re Stapley & Smith*, 29 Ch. D. 877; nor can words which, used separately, are not fancy words, become so by being used in combination: *Pirie v. Goodall*, (1892) 1 Ch. 35. In determining whether a word is a fancy word the time to be looked at is the date of registration, and the word must not be criticised by the light of subsequent events: *In re Bovril T. M.*, (1896) 2 Ch. 600, 605, 607, per Lindley and Lopes, L. J. An old mark is not considered to be in common use unless it has been used by more than three firms, but the leave of the Court is necessary for the second or third registration of the same, or substantially the same, old mark. See note (e) to § 72, and note (f) to § 74.

(i) See *ante*, p. 41. The new clauses (d) and (e) were inserted on the recommendation of a select committee appointed to inquire into the working of the Act of 1883 for the purpose of obviating the difficulty which had been experienced in construing the term "fancy word." Nevertheless, for some years the Courts showed a disposition to construe the new term "invented word" by the light of the decisions upon fancy words. It was accordingly held that the term "invented word" was impliedly subject to the qualification expressly imposed by the legislature in clause (e) in the case of known words, viz., that it should have no reference to the character or quality of the goods, and great ingenuity was exercised in discovering some covert reference to character or quality in words which, to the ordinary purchaser, would convey no meaning. Thus, registration was refused by Kay, J., to "Satinine" for starch (*In re Meyerstein*, 43 Ch. D. 604), by North, J., and the C. A. to "Somatose" for an extract of meat (*In re Farbensfabriken*, (1894) 1 Ch. 615), and by Kekewich, J., and the C. A. to "Solio" for photographic paper: *In re Eastman Photographic Materials Co.*, 14 P. R. 487. This last decision, however, has been recently reversed by the House of Lords ((1898) A. C. 571), whose decision finally establishes, first, that it is not essential that an invented word should have no reference to the character or quality of the goods; secondly, that the decisions upon "fancy words" are no guide in construing the substituted clauses (d) and (e). But, as was said by Lord Shand, "there must be invention and not the appearance of invention only. It is not possible to define the extent of the invention required; but the words should be clearly and substantially different from any word in ordinary and common use. The employment of a word in such use, with a diminutive or a short and meaningless syllable added to it, or a mere combination of two known words, would not be an invented word; and a word would not be 'invented' which, with some trifling addition or very trifling varia-

tion, still leaves the word one which is well-known or in ordinary use, and which would be quite understood as intended to convey the meaning of such a word." Registration has also been refused by Kekewich, J., to the word "Electrozone" (*In re British Electrozone Co.*, 13 P. R. 447) on the ground that it was a word known in the United States, and by the same learned judge and the C. A. to "Pirle" (*In re Ripley*, 15 P. R. 154) on the ground that it was the equivalent of "pearl"; and these cases appear to be unaffected by the decision of the House of Lords. Again, the word "Eboline" (*In re Salt*, (1894) 3 Ch. 166) has been held incapable of registration by Chitty, J., as being a geographical name owing to the existence in Italy of a town called "Eboli": cf. *In re Magnolia Metal Co.*, (1897) 2 Ch. 285. On the other hand, the word "Mazawattee" which was compounded of two words of different foreign languages, viz., Hindustani and Cingalese, was held to have been properly registered for tea: *In re Deusham*, (1895) 2 Ch. 176. With regard to the admissibility of foreign words Lord Herschell said, in *In re Eastman Photographic Materials Co.*, (1898) A. C. 571, 581, "I do not think that a foreign word is an invented word simply because it has not been current in our language. At the same time I am not prepared to go so far as to say that a combination of words from foreign languages so little known in this country that it would suggest no meaning, except to a few scholars, might not be regarded as an invented word."

(j) See *ante*, p. 13. The reason for inserting in clause (e) the condition that the word shall have no reference to the character or quality of the goods is explained by Lord Herschell in *In re Eastman Photographic Materials Co.*, (1898) A. C. 571, to be that "the vocabulary of the English language is common property; it belongs alike to all, and none ought to be permitted to prevent the other members of the community from using for purposes of description a word which has reference to the character or quality of the goods," and upon this point there is no difference between the policy of the Act of 1883 and the Act of 1888. Thus, in *In re Dunn*, 41 Ch. D. 439, where an application under the Act of 1883 to register the words "Fruit Salt" for baking powder was opposed by Eno, who had used the name for a medicine, Fry, L. J., said, "I cannot help regarding Mr. Eno's attempt as an instance of that perpetual struggle which it seems to me is going on, to enclose and appropriate as private property certain little strips of the great open common of the English language." But, as was subsequently pointed out by Lord Herschell, this reason does not apply to an invented word—a word which is newly coined. Names of imaginary persons, such as the characters in a romance, are included under this clause, and do not fall under clause (a): *In re Holt*, (1896) 1 Ch. 711.

In *In re Magnolia Metal Co.*, (1897) 2 Ch. 371, it was held that the word "Magnolia" which had become the name of a composite metal had no reference to the character or quality of the metal. The objection was also taken that "Magnolia" was a geographical name by reason of the existence of certain places of that name in the United States. The Court of Appeal in affirming the decision of Kekewich, J., overruling this objection, interpreted the term "geographical name" as follows:—"It must, we think, in the absence of special circumstances, be interpreted so as to be in accordance in some degree with the general and popular meaning of the words, and a word does not become a geographical name simply because some place upon the earth's surface has been called by it. For example, we agree with Kekewich, J., that the word 'Monkey' is not proved to be a geographical name by showing merely that a small and by no means generally known island has been called by that name. If, indeed, in its primary and obvious meaning the word has reference to locality, as the word 'Melrose' in *Van Duzer's Case* (34 Ch. D. 623), or the word 'Eboli' in *Sir Titus Salt & Co.'s Case* ((1894) 3 Ch. 166) (from which Chitty, J., declined to distinguish the derivative 'Eboline'), it may well be a geographical name within the meaning of the sub-section. Even where the primary signification is not geographical, if the name is really a local name (however little known the locality may be), and the name is given because of the connection of the article with the locality, whether that be real or imputed only by those who give the name, it may well be a geographical name within the meaning of the sub-section. An instance of this is to be found in the case of the word 'Apollinaris,' given to the water from a spring known as the Apollinaris Spring. So, if 'Magnolia' had been the name of a place where the metal was manufactured, we should have been by no means inclined to say that it would not be a geographical name when applied to the article manufactured in the place having the name." See also *per* Kekewich, J., in *In re Apollinaris Co.*, (1891) 2 Ch. 186, and *In re Clement & Cie.*, 16 P. R. 173.

(k) "Figures" mean numerals. See *Ex parte Stephens*, 3 Ch. D. 659. When it is wished to register the same essential (or "material," by which nearly the same thing

appears to be meant) particular, with a number of varying additions, the proper course is to register the marks as a series, under § 66, *q.v.* See also note (e) to § 72, *infra*. Inasmuch as the parts of a combination mark which are not within the definition of "essential particulars" are not entitled to registration or protection when standing alone, it seems that there cannot well be infringement of a combination mark unless the essential particular is taken. See *In re Hudson*, 32 Ch. D. 311; *In re Atkins' Filter & Engineering Co., Ltd.*, 3 P. R. 164; *Burland & Co. v. Broxburn Oil Co., Ltd.* (2), 42 Ch. D. 274; *Watt v. O'Hanlon*, 4 P. R. 1. In *In re Horsburgh*, 53 L. J. Ch. 237, where a registered trade mark consisted of a distinctive device and a descriptive word, it was held that substantially the same descriptive word might be registered by another firm with a different device, from which it follows that the use of the second trade mark would be no infringement of the first.

There will not be registered as new marks or prominent parts of new marks—(See Instructions, par. 30, *infra*):—

The Royal Arms, or arms so nearly resembling them as to be calculated to deceive.

Representations of the Queen, or of any member of the Royal Family.

Representations of the Royal Crown.

The National Arms or Flags of Great Britain. (See *Ex parte Davids & Co.*, 16 U. S. Pat. Gaz. 94, as to the American practice.)

Prize or exhibition medals were also formerly excluded, but are now admitted. (As to these, see *Batty v. Mill*, 1 H. & M. 264; *Taylor v. Gillies*, 59 N. Y. 331; *In re Bush & Co.*, 10 U. S. Pat. Gaz. 164; *In re Brook*, 26 W. R. 791; *In re Farina* (2), 27 W. R. 456. But they cannot be treated as constituting an essential particular: *In re Bryant & May, Ltd.*, 8 P. R. 69.)

(l) If the essential particular claimed is a distinctive label, it seems very doubtful whether the applicant can be called on to disclaim anything contained in it. "The truth is that the label does not consist of each particular part of it, but consists in the combination of them all": *per* Lord Esher, M. R., *Pinto v. Badman*, (1891) 2 Ch. 186, 191. And see *per* Fry, L. J., at p. 188; also in *In re Apollinaris Co.*, (1891) 2 Ch. 186, 233; and *per* Chitty, J., in *In re Smokeless Powder Co.*, (1892) 1 Ch. 590; also *In re Clement & Cie.*, 16 P. R. 173. A disclaimer under the Act has been held to be an answer to an interlocutory application for an injunction by the registered proprietor founded on his common law right to restrain the use of the disclaimed matter in a manner calculated to deceive: *Rosenthal v. Reynolds*, (1892) 2 Ch. 301; but this case has been questioned in Scotland, and an injunction has been granted under similar circumstances: *Bayer v. Baird*, 15 P. R. 615. And see *Packham & Co. v. Sturgess & Co.*, 15 P. R. 652, a passing-off action in which North, J., himself recognized that the defendants were not entitled to use a name, the exclusive right to which the plaintiffs had disclaimed as being descriptive, so as to represent that the defendant's goods were the plaintiffs'; and the fact that the application in *Rosenthal v. Reynolds*, (1892) 2 Ch. 301, was interlocutory must be borne in mind. Cf. *In re Loftus*, (1894) 1 Ch. 193.

(m) "Person" includes "company," and under this section, as amended, added words which, if used alone, might require to be disclaimed, need not be disclaimed if used as part of the name of the company owning the trade mark: *In re Smokeless Powder Co.*, (1892) 1 Ch. 590. And see *In re Clement & Cie.*, 16 P. R. 173.

(n) It is not necessary that the full name, either in the case of a single trader, or in the case of a firm, should be placed upon the trade mark, if it is used fairly and *bona fide* in such a way that it cannot be mistaken for anything else than the name of the manufacturer of the goods to which the mark relates; nor is it necessary that the name should be the private name of the owner if he trades under another name; and it is also no objection that the name should be used in the possessive case. Accordingly it was held by Stirling, J., explaining *Pirie v. Goodall*, (1892) 1 Ch. 35, that the firm of J. & J. Colman were not bound to disclaim the word "Colman's": *In re Colman*, (1894) 2 Ch. 115. But a firm describing themselves as successors to another firm must disclaim the name of their predecessors: *In re Birmingham Vinegar Brewery Co.*, 11 P. R. 195.

(o) "The names of foreign springs, when added to a trade mark tendered for registration by a limited company with a registered office in England, are not protected against the requirement of a disclaimer by the exception in favour of a 'place of business'": *In re Apollinaris Co.*, (1891) 2 Ch. 186, 211, *per* Kekewich, J.

(p) See *ante*, p. 44. The wording of this subsection is wider than that of the Old marks. corresponding provision in § 10 of the Act of 1875. *E.g.*, a single letter may now be registered as an old mark, though it was formerly excluded from registration:

In re Mitchell (1), 7 Ch. D. 36. An old mark must be registered as a whole, and in the exact form in which it has been actually used. Thus, in *In re Royal Baking Powder Co.*, W. N. 1880, p. 49, the applicants were not allowed to register the word "Royal," or the words "Royal Baking Powder," apart from the rest of the label with which they had been used. So in *In re Simpson, Davies & Sons*, Jessel, M. R., January 12th, 1881, the registration of a trade mark consisting of a cross would have been held to be wrongful, by reason of the points of the cross registered being differently shaped from the points of the cross used, had it not been proved that there had been user in both forms. So in *Russell & Sons, Ltd. v. Smith*, Jessel, M. R., June 18th 1880, it was held that registration was wrongful because the user had been of a rough outline of a crown, and the registration was of an elaborate crown, with all the shading filled in. And see cases at pp. 45, 46. On the other hand, in *Orr-Ewing v. Registrar of Trade Marks*, 4 App. Cas. 479, the House of Lords directed registration of the essential particular, omitting the immaterial additions. Now, by §§ 64, 74, the entire mark would be registered, with a disclaimer of the additions. See *Baker v. Rawson*, 45 Ch. D. 519; *In re Mecus*, (1891) 1 Ch. 41; *In re Fuente*, (1891) 2 Ch. 166; *In re Phillips*, (1891) 3 Ch. 139. A mark must not be registered as an old mark if it was only used before 1875 as part of a mark: *Baker v. Rawson*, 45 Ch. D. 519; *In re Fuente*, (1891) 2 Ch. 166; *Richards v. Butcher* (2), (1891) 2 Ch. 522; *In re Kinahan*, 10 P. R. 393; nor if used only on packing cases to identify the contents: *In re Powell*, (1893) 2 Ch. 388; (1894) A. C. 8. And see *Richards v. Butcher*, (1891) 2 Ch. 522. And if a device has been registered as an old mark, but was never used *per se*, the registration is bad and will be rectified upon the application of a party aggrieved: *Baker v. Rawson*, 45 Ch. D. 519, 528. See also *In re Fuente*, (1891) 2 Ch. 166.

Where it is sought to register as a new trade mark a mark which, though not used before 1875, has yet been used for some years with fraudulent misstatements contained in it, registration will be refused, even though the misstatements are corrected in the mark as tendered for registration: *In re Fuente*, (1891) 2 Ch. 166.

Where blanks are left in the marks as registered, there is nothing to prevent the proprietor from filling them up in actual use: *Newman v. Pinto*, 4 P. R. 508, *per Kekewich, J.*; *Melachrino v. Melachrino Egyptian Cigarette Co.*, 4 P. R. 215; *M. Melachrino & Co. v. R. Melachrino & Co.*, Chitty, J., May 29th, 1888.

The words "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To Counterfeit this is Forgery," will not be registered under the Acts. See Instructions, par. 29, *infra*. Nor will pictorial representations of goods to which the marks are to be applied, or names of persons in the possessive case in combination with the names of goods. See p. 467, *infra*. As to ornamental or coloured groundwork, see Instructions, par. 28.

Connection
of trade mark
with goods.

65. A trade mark must be registered for particular goods or classes of goods (a).

(a) This comes from § 2 of the Trade Marks Registration Act, 1875. The appropriation of a trade mark to particular goods or classes of goods was not new. See *Hall v. Barrows*, 4 De G. J. & S. 150; *Ainsworth v. Walmsley*, L. R. 1 Eq. 518; *Somerville v. Schembri*, 12 App. Cas. 453. See Rule 6 and Schedule 3 to the Rules with respect to the classification of goods for the purposes of the Act, also *per Pearson, J.*, in *In re Lyndon*, 32 Ch. D. 109; and *per North, J.*, in *Hart v. Colley*, 44 Ch. D. 193. The Third Schedule divides the various descriptions of goods into fifty classes. By the Rules under the Act of 1875, it was provided that where a trade mark was registered, a similar trade mark should not be registered in the name of another proprietor for any goods in the same class without the leave of the Court; but this requirement of the leave of the Court is now limited to cases in which the second application is in respect of the same goods or description of goods. See § 72. Under the old Act, registration for part of a class was granted to old marks: in *Ex parte Barrows*, W. N. 1877, p. 119; L. J. N. of C. 1877, p. 110; *In re Lysaght*, Dig. 623; *In re Rabone*, Dig. 643; *In re Ashton & Sons*, Hall, V.-C., February 26th, 1881; and to new marks in *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *In re Braby & Co.*, 21 Ch. D. 223; and *In re Clark & Co.*, 27 Sol. J. 396, though in this case the mark was common for other goods in the class; and refused to a new mark in *In re Hargreaves*, 11 Ch. D. 669. And see *In re De Otadny*, W. N. 1885, p. 177; *In re Metcalf*, 31 Ch. D. 454. Registration ought to be applied for only in respect of goods for which the mark is used or intended to be

used: *Edwards v. Dennis*, 30 Ch. D. 454; *Hargreave v. Freeman*, (1891) 1 Ch. 39; *In re Batt & Co.*, (1898) 2 Ch. 432. In cases of Sheffield marks within § 81(2), the Cutlers' Co. are to register old marks for all the metal goods in § 81, though they may have been used for some only of such goods: *per North, J.*, in *In re Lambert*, 5 P. R. 542. If a mark is used for other goods than those in respect of which it is registered, even though in the same class, such user may be restrained if a similar mark has been used and registered by another firm in respect of those other goods: *Upper Assam Tea Co. v. Herbert & Co.*, 7 P. R. 183. In America, registration of the same mark in the same class may be granted to different persons if the goods are different: *Sorg v. Welsh*, 16 U. S. Pat. Gaz. 910. It has been held under the United States Statute of 1870 (now replaced by that of 1881) that registration in respect of too wide a class of goods is bad altogether: *Smith v. Reynolds* (2), 10 Bl. C. C. 100; S. C. (3), 13 *ib.* 458.

66. When a person claiming to be the proprietor of several trade marks which, while resembling each other in the material particulars thereof, yet differ in respect of (a) the statement of the goods for which they are respectively used or proposed to be used, or (b) statements of numbers, or (c) statements of price, or (d) statements of quality, or (e) statements of names of places, seeks to register such trade marks, they may be registered as a series in one registration. A series of trade marks shall be assignable and transmissible only as a whole, but for all other purposes each of the trade marks composing a series shall be deemed and treated as registered separately (a).

Registration
of a series of
marks.

(a) This section is entirely new, but a mode of registration bearing a resemblance to that for which provision is here made was suggested by the Court of Appeal as the right one in *In re Barrows*, 5 Ch. D. 353, and was occasionally adopted. See note (c) to § 72, *infra*, and cases there cited. In some cases, however, this form of registration was not considered satisfactory by the applicant, usually because, the different combinations not being individually registered, the registered proprietor was unable to get such a certificate of registration as would enable him to obtain registration in foreign countries. In *In re Fox & Co.*, Hall, V.-C., May 7th, 1881, the V.-C. allowed a person who had registered a device together with a word (which, under the Act of 1875, could not be an essential particular in a new trade mark) to obtain a separate registration of the same device with a different word, so that the same one essential particular was separately registered twice over, with additions which, for the purposes of the Act, were immaterial. After this decision, separate registration was generally granted by the registrar to marks which would more properly have been registered in a series, or, as it was more generally called, by representation. The concluding words of this section render separate registration unnecessary, but there is nothing to prevent it. It should, however, be noted that in *Baker v. Rawson*, 45 Ch. D. 519, 530, North, J., appears to have considered that a mark already registered should not be allowed to be registered over again with a mere addition common to the trade and consequently disclaimed. See *In re Phillips*, (1891) 3 Ch. 139.

The only rules specially relating to applications for registration of a series of trade marks are Rule 14 (by which a representation of each trade mark included in the series is to be placed on the application form and on each of the forms containing the additional representations required by Rule 13), and Rule 30, relating to the mode of advertisement.

67. A trade mark may be registered in any colour [or colours], and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour [or colours] (a).

Trade marks
may be regis-
tered in any
colour.

The amendments in this section were made by § 11 of the Act of 1888.

(a) In the old Acts and Rules no mention was made of colour, on account of the difficulty of properly advertising marks applied for in colour. See *per Jessel, M. R.*,

in *In re Robinson*, 29 W. R. 31. A trade mark registered in black and white consisted of the device registered, whatever might be the colour in which it was used, and it was therefore regarded as entitled to protection in whatever colour it might be used, and against rival marks in whatever colour: *Nuthall v. Vining*, C. A., Jan. 21st, 1880. There it was said that, in cases of alleged infringement, the true test of comparison was to compare the designs of the two trade marks in the same size and free from colour, and that similarities in respect of colour would only be regarded in order either to prove fraud, or to turn the scale when the question of infringement, leaving colour out of sight, was very difficult to decide. In *Hanson v. British Tea and Trading Association, Ltd.*, Bacon, V.-C., April 9th, 1884; C. A., June 19th, 1884, a label had been used, which, as registered under the Act of 1875, was divided into three parallel stripes of equal width, of which the outer ones were shaded and the middle one was left white, and which had the words "Red, white, and blue' label" printed across it, and the name of the plaintiffs at the foot, and which, in actual use, was coloured with the French tricolour; and though it was registered without colour, an injunction was granted to restrain the use of a label similarly coloured and containing the same words. But where a fresh application was made to register the same label for other goods under this Act, registration was refused by the comptroller, and his refusal was upheld by the Court, on the ground that the distinctiveness required in a mark tendered for registration could not consist solely in colour: *In re Hanson*, 37 Ch. D. 112. When the question was whether a trade mark sent in for registration was too similar to one already registered for registration to be permitted, and the trade mark already on the register was in practice used in colour, the question was taken into consideration whether the subsequent trade mark, if similarly coloured, would be likely to cause deception: *In re Worthington*, 14 Ch. D. 8. In *In re Jeffrey & Co.*, Stirling, J., May 18th, 1888, the applicants for registration were allowed to bind themselves by a note on the register not to use the trade mark in black colour, nor in so dark a hue as to resemble black; and in *In re Johnson, Philpott & Co.*, North, J., Feb. 21st, 1888, the register was rectified by consent by adding a note that the registered proprietor was only to use his mark in blue and white.

In Canada, the same effect as that provided by this section is given to registration in colour: *Smith v. Fair*, 14 Ont. Rep. 729; and in the United States also a trade mark cannot consist in colour alone: *Ex parte Landreth*, 31 U. S. Pat. Gaz. 1441; *Fleischmann v. Starkey*, 25 Fed. Rep. 127.

In some exceptional cases, under the Act of 1875, trade marks were found to be incapable of advertisement or registration in black and white, the only peculiarity being the combination of colours, e.g., where coloured threads were twisted in the wick of a candle, or combined in the selvage of a piece of stuff. In such cases the marks were registered by deposit, actual specimens of the marked article being sent in to the registrar and deposited by him at the Patent Museum. For instance, there were so deposited specimens of certain marks for worsted stuffs in Class 34, numbered 5844 to 5850, and consisting of selvages containing distinctive coloured threads. See "Trade Marks Journal," Vol. II., No. 51, p. 88. The use of colour being very frequently of importance in the cotton trade, it was decided that all marks for goods in the cotton classes (23—25) should be registered by deposit. When a trade mark was thus registered by deposit, the actual thing deposited, colour included, constituted the trade mark, so that in questions of infringement the point was whether the device, plus colour, was imitated in the offending mark with sufficient exactness to deceive. And the same rule was applied in registration cases, colour being taken into consideration in estimating the degree of resemblance. Thus, in *In re Robinson*, 29 W. R. 31, a device of a silver rupee being already registered, another applicant sought to obtain registration of a device of a gold mohur, and this was granted, on the ground that all that was registered was a silver coin, notwithstanding that if the second mark were to be coloured silver, deception would be probable. In such cases it was held that the proper manner of regarding the colour was a question for the trade, and that if, in the opinion of the trade, deception might arise, the Court would act on that opinion: *Mitchell v. Henry*, 15 Ch. D. 181. See also *In re Christiansen*, 3 P. R. 54, as to the opinion of the trade. Besides the cases above referred to, see *In re Orr-Ewing*, 8 Ch. D. 798; 4 App. Cas. 479; *In re Brook*, 26 W. R. 791; and *In re Jones Bros. & Co.*, Hall, V.-C., July 10th, 1880.

The present section appears to have the effect of giving trade marks registered by deposit at the Patent Office Library, or registered in pursuance of an application

accompanied by coloured representations, the same advantages as registration in black and white, so that for the future the colour of a trade mark registered in colour will not, except in very exceptional cases, such as that of the coloured selvage, be a part of the mark, but after one trade mark is so registered, another will not be entitled to be used or registered, if it would be likely to be mistaken for the first, on the supposition that the first mark was used in any different colour from that in which it was registered.

See Rules 13 and 27 as to the deposit of specimens of trade marks.

68. Every application for registration of a trade mark under this part of this Act shall as soon as may be after its receipt be advertised by the comptroller (a), [unless the comptroller refuse to entertain the application] (b). Advertisement of application.

The amendments in this section were made by § 12 of the Act of 1888.

(a) "The object of the advertisement is to give to persons who might be claimants of the trade mark proposed to be registered the opportunity of coming forward and objecting": *per* Hall, V.-C., *In re Meikle*, 24 W. R. 1067. Consequently, as was there held, when a refusal of the comptroller to register a trade mark is overruled, the only order that can be made is an order for him to proceed with the application, so that the usual course of advertisement, &c., may be followed. This course was adopted by Hall, V.-C., in *In re Orr-Ewing*, 8 Ch. D. 794, and subsequent cases. For a similar reason a mark which has been wrongfully registered will be removed from the register, even though a new application might be successfully made to register it: *In re Apollinaris Co.*, (1891) 2 Ch. 186, 231. It is not, however, incumbent on persons to see the advertisement, so that if a common mark has been registered, in consequence of the firms interested in opposing it having failed to see the advertisement of the application, they are able to obtain the removal of the mark from the register, with costs, on application within a reasonable time after the registration was brought to their knowledge: *In re Hyde & Co.*, 7 Ch. D. 724. See *In re Palmer* (3), 24 Ch. D. 504; *In re Kuhn & Co.*, 53 L. J. Ch. 238; *Edwards v. Dennis*, 30 Ch. D. 454; *In re Lloyd & Sons*, 27 Ch. D. 646; *In re Wragg*, 29 Ch. D. 551; *Wood v. Lambert*, 32 Ch. D. 247; *In re Spencer*, 54 L. T. N. S. 659; *In re Apollinaris Co.*, (1891) 2 Ch. 186.

As to the mode of advertisement, see Rules 27—30.

(b) This exception was no doubt inserted in consequence of the case of *Ex parte Saxlehner*, Q. B. D., July 7th, 1887, in which the comptroller refused to advertise applications by Saxlehner for the registration of certain trade marks, on the ground that similar marks were already registered in the name of the Apollinaris Co., so that registration could not be granted and advertisement was useless; but on application by Saxlehner the Q. B. Div. granted a rule to show cause why a mandamus to advertise should not issue. The matter does not appear to have been further contested, and the marks were advertised in the "Trade Marks Journal" for July 27th, 1887.

69.—(1.) Any person (a) may within *two months* [one month or such further time, not exceeding three months, as the comptroller may allow (b)] of the *first* advertisement of the application, give notice in duplicate at the Patent Office of opposition (c) to registration of the trade mark, and the comptroller shall send one copy of such notice to the applicant. Opposition to registration.

(2.) Within *two months* [one month] after receipt of such notice or such further time as the comptroller may allow, the applicant may send to the comptroller a counter-statement (d) in duplicate of the grounds on which he relies for his application, and if he does not do so, shall be deemed to have abandoned his application.

(3.) *If the applicant sends such counter-statement, the comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall require him to give security in such manner and to such amount*

as the comptroller may require for such costs as may be awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement was made or such further time as the comptroller may allow, the opposition shall be deemed to be withdrawn.

(4.) If the person who gave notice of opposition duly gives such security as aforesaid, the comptroller shall inform the applicant thereof in writing, and thereupon the case shall be deemed to stand for the determination of the Court (e).

[(3.) If the applicant sends such counter-statement, the comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall, after hearing (f) the applicant and the opponent, if so required, decide whether the trade mark is to be registered (g); but his decision shall be subject to appeal to the Board of Trade, who shall, if required, hear (f) the applicant and the opponent and the comptroller, and may make an order determining whether, and subject to what conditions (if any), registration is to be permitted.

(4.) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court, and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid (h).

(5.) If the applicant abandons his application after notice of opposition in pursuance of this section, he shall be liable to pay to the opponent such costs in respect of the opposition as the comptroller may determine to be reasonable.

(6.) Where the opponent is out of the United Kingdom he shall give the comptroller an address for service in the United Kingdom.]

(a) This section comes from the old rules. The amendments were made by § 13 of the Act of 1888.

There is no limitation of the right of opposing to persons who can themselves claim registration: *In re Riviere & Co.*, 26 Ch. D. 48; and "the statute allows any person to oppose an application for registration, whether he has or has not a personal interest in the result": *per* Lord Macnaghten, in *Eno v. Dunn*, 15 App. Cas. 252, 262; nor is there any limitation of the right of opposing on the ground of similarity to proprietors of trade marks registered for the same goods, or even for goods in the same class, as the goods for which the applicant is seeking to register. But an opposition on this ground would, of course, not succeed unless the two marks would come into collision in some way when being used. Thus, in *In re Simpson, Davies & Sons*, Jessel, M. R., Jan. 12th, 1881, the application was for registration in class 22 for railway waggons, and the successful opposition was by a firm registered in class 4 for coal, whose trade mark was used by placing it on the waggons in which the coal was conveyed and sold. In *In re Australian Wine Importers, Ltd.*, 41 Ch. D. 278, a mark applied for in respect of wines was not allowed to be registered on account of its similarity to a mark already registered for spirits; and in the similar case of *In re Turney*, 11 P. R. 37, beer and rum were for this purpose held to be the same description of goods. In *In re Dunn*, 41 Ch. D. 439; 15 App. Cas. 252, the opposition failed in the Court of Appeal, because a mark used for baking-powder was thought not to be capable of being mistaken for a mark used for powder for an effervescing drink, but in the House of Lords the opposition succeeded. Registration has also been refused on the ground of fraudulent misstatements contained in the mark as previously used for several years, though corrected in the mark as tendered for registration: *In re Fuente*, (1891) 2 Ch. 166. The opposition may be by a person with whom the applicant has covenanted not to use the mark. See the Victorian case of *Ex parte Grist & Bowring*, 11 V. L. R. 630.

It has been thought that if what is desired is not to have the registration altogether refused, but to have it limited by the addition of a note stating, *e.g.*, that the mark is only to be used in trade with a particular country, and the applicant is willing to consent to such limitation, it is not necessary to go through the process

of entering a notice of opposition, but that an order directing that the mark, if registered, is to be registered with the addition of a note to the desired effect, may be obtained by the applicant on an *ex parte* application: *In re Keep Brothers*, 26 Ch. D. 187. The entry of such notes is, however, now objected to by the comptroller, and has not been allowed in recent cases.

(b) The period allowed seems to be at most three months from the date of the advertisement, not three months after one month, *i.e.*, four months. See *In re Moet*, 7 P. R. 226, 230.

(c) See pp. 474, 494 for notice of opposition. The practice in opposition cases is prescribed by Rule 31. The notice of opposition may be amended under Rule 54, even after the counter-statement has been put in: *In re Moet*, 7 P. R. 226.

(d) pp. 485, 497, *infra*.

(e) This being the time at which the case stood for the determination of the Court, it was held that the costs of the previous proceedings in the office could not be given to a successful opponent: *In re Brandreth*, 9 Ch. D. 618; *In re Australian Wine Importers, Ltd.*, 41 Ch. D. 278. Where a claim had been wrongfully set up to use a certain trade mark, the claimants were ordered to pay the costs of cross adjourned summonses, as well as of an action which had been brought to enforce the right, even though they had not actually used the mark in question: *Davis v. Tylor*, Jessel, M. R., April 24th, 1879. In *In re Hudson*, 32 Ch. D. 311, no costs of an opposed application were given to successful applicants, on the ground that they had caused the litigation by the manner in which they had put forward their case. By the rules under the Act of 1883 the proceedings subsequent to the case standing for the determination of the Court were to take the form of an application by the applicant to the Court by summons for leave to register. Now the proceedings are assimilated to those in the case of an unopposed application for registration, and the rights of the parties are decided by the comptroller, with an appeal to the Board of Trade, who may refer the case to the Court. Under the old Acts and Rules the opponent was required to take out a summons for directions, which almost always resulted in the applicant being directed to apply for leave to register. See *In re Simpson, Davies & Sons*, 15 Ch. D. 525; also *In re Johnston*, 43 L. T. N. S. 672. See Rule 46 as to notifying the order of the Court to the comptroller.

(f) The position which the comptroller ought to take up is thus defined by the Law Peers who formed the majority in *Eno v. Dunn*, 15 App. Cas. 252. Lord Watson said, "The statute nowhere confers an absolute right to register a trade mark. The comptroller, by § 62, may, if he thinks fit, refuse to register, his refusal being subject to an appeal to the Board of Trade, who may either hear the parties, and decide whether and subject to what conditions, if any, registration is to be permitted, or may refer the matter to the Court for its determination. § 72 (2) prohibits the registration, with respect to the same goods or description of goods, of a trade mark so nearly resembling a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive. That provision is supplemented by the broader enactments of § 73 to the effect that 'It shall not be lawful to register, as part of or in combination with a trade mark, any words the exclusive use of which would, by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a court of justice, or any scandalous design.' These prohibitory clauses cast upon the applicant the duty of satisfying the comptroller, or the Court, that the trade mark which he proposes to register does not come within their scope. In an inquiry like the present, he does not hold the same position which he would have occupied if he had been defending himself against an action for infringement. There the onus of showing that his trade mark was calculated to mislead rests, not on him, but upon the party alleging infringement; here he is *in petitorio*, and must justify registration of his trade mark by showing affirmatively that it is not calculated to deceive. It appears to me to be a necessary consequence that, *in dubio*, his application ought to be disallowed." Lord Herschell said, "The case was argued on behalf of the respondent as if he had an absolute right to have any trade mark registered which was not proved to fall within the terms of either the 72nd or 73rd section of the Act. I do not so read the statute. Those sections prohibit the registration of a trade mark in certain specified cases; but there is no duty cast upon the comptroller of registering every other trade mark that may be applied for. On the contrary, whilst he is in certain cases prohibited from registering, a discretion whether to register or not appears to me to be in all cases plainly conferred. Of course this discretion must be reasonably and not capriciously exercised: but it is,

in my opinion, a reasonable exercise of it to refuse registration when it is not clear that deception might not result from it." See, however, *per* Lord Blackburn in *Orr-Ewing v. Registrar of Trade Marks*, 4 App. Cas. 479, as to old marks. In accordance with the principles above laid down by Lord Herschell, registration of a device was refused by Kekewich, J., on the ground that a similar device was used by the opponent as an advertisement though not registered as a trade mark, notwithstanding that the case did not fall within either § 72 or § 73: *In re Sphincter Grip Armoured Hose Co.*, 10 P. R. 84; and North, J., came to a similar decision in the case of a label: *In re Roger* (2), 12 P. R. 149. The comptroller has also power to deal with oppositions based on the alleged fraud of the applicant for registration: *In re Moct*, 7 P. R. 226.

(g) It seems that if, for any reason, an opponent is not heard, his course is to apply for a mandamus: see *per* Bowen, L. J., in *In re Lambert*, 6 P. R. 344.

(h) See Rules 20—26, and compare § 62. It is convenient that unless other directions are given by the Court or the Board of Trade, the appeal to the Court should be heard on the same evidence as before the comptroller: *In re Farrow*, 7 P. R. 260. But there is no binding limitation. See also *In re Roger*, 11 P. R. 637; and *In re Kingsford & Sons*, 15 P. R. 197, as to evidence where an appeal is referred to the Court. On an opposed application coming before the Court, the Court has full jurisdiction to decide as to the validity of the mark, notwithstanding that the comptroller has originally, under § 62, passed it for registration: *In re Arbenz*, 35 Ch. D. 248. And where an application is duly opposed, all questions as to the validity of the mark are open to the consideration of the Court; but the Court will not readily overrule the comptroller: *In re Farrow*, 7 P. R. 260. The Court has no power to give leave to amend the notice of opposition, nor, after the appeal has been presented, has the comptroller, he being *functus officio*: *In re Robertson, Sanderson & Co.* (2), (1892) 2 Ch. 245. Where an opponent appeals against the comptroller, upon an application made by a Scotch or Irish firm having no address for service in the United Kingdom, and the appeal is referred to the Court, he may address the notice of motion to the comptroller only, and give informal notice of the proceedings to the applicant: *In re Robertson, Sanderson & Co.* (1), 9 P. R. 213. And see *In re King & Co.*, (1892) 2 Ch. 462. Where an opponent's appeal is referred to the Court, but before the hearing the parties agree to its dismissal without costs, the registrar will not proceed with the registration without an order of the Court; and in order to obtain the order, it is not sufficient for the applicant to produce the written consent of the parties, but the Court will require the production of a consent brief: *In re Crossfield*, 15 P. R. 754. It remains to be decided what costs the Court now has power to award; but it would appear that the Court can give the costs of the appeal, but not of the proceedings before the comptroller. See note (e) *supra*.

Assignment
and trans-
mission of
trade mark.

70. A trade mark, when registered, shall be assigned and transmitted (a) only in connection with the goodwill (b) of the business concerned in the particular goods or classes of goods for which it has been registered (c), and shall be determinable with that goodwill (d).

(a) This section comes from § 2 of the Act of 1875. As to assignment and transmission, see Rules 36—40 and 61, and Form K. in the Second Schedule to the Rules. See, too, Ch. III., *supra*.

Assignments and transmissions are to be entered in the register: see §§ 78, 87, *infra*. By § 4 of the Act of 1875, it was enacted that every proprietor registered in respect of a trade mark subsequently to the first registered proprietor should, as respected his title to that trade mark, stand in the same position as if his title were a continuation of the title of the first registered proprietor. This enactment is not now repeated, the same result being effected by generalising the language of § 76. Compare the American case of *Walton v. Crowley*, 2 Bl. C. C. 440; R. Cox, 166.

(b) As to the connection between trade marks and the goodwill of the business, see *Cooper v. Hood*, 26 Beav. 293; *Churton v. Douglas*, Johns. 174; *Shipwright v. Clements*, 19 W. R. 599; *Cotton v. Gillard*, 44 L. J. Ch. 90; *Pinto v. Badman*, 8 P. R. 181; *Hammond v. Malcolm, Brunner & Co.*, 9 P. R. 301; *In re Magnolia Metal Co.*, (1897) 2 Ch. 371; and the American cases of *Sohier v. Johnson*, 111 Mass. 238; *Witthaus v. Braun*, 44 Md. 303; *Taylor v. Bemis*, 4 Biss. 406; *Weston v. Ketcham* (1), 39 N. Y. Super. Ct. 54, and S. C. (2), 51 How. Pr. 455; *Morgan v. Rogers*,

19 Fed. Rep. 596; *McVeagh v. Valencia Cigar Factory*, 32 U. S. Pat. Gaz. 1124; *Oakes v. Tonsmierre*, 4 Woods, 547; *Smith v. Fair*, 14 Ont. Rep. 729. "The main object of the restriction upon assignments imposed by the Act would seem to be to prevent confusion or deception by suggesting that the articles to which the mark is applied continue to have some connection or other with the original registered owner": *per* Court of Appeal in *In re Magnolia Metal Co.*, (1897) 2 Ch. 371, 396; and it seems that in considering the sufficiency of the connection of the trade mark with the goodwill, regard must be had to this object. Where a trade mark has been placed on the register, but no business exists in which it is used, the mark cannot be assigned, since there is no goodwill to be assigned with it: *Ex parte Lawrence Bros.*, 44 L. T. N. S. 98. See *In re Farina* (4), 44 L. T. N. S. 99. In *In re Wellcome*, 32 Ch. D. 213, the English agents of an American firm had registered in their own names two trade marks used by the latter, and subsequently assigned them to them; and it was held by Chitty, J., that the assignment being an assignment to the persons entitled to the goodwill of the business for the purposes of which the trade marks had been registered, it was an assignment of the trade marks in connection with the goodwill, within this section, notwithstanding that the persons originally registered had no interest in the goodwill; and where a member of a firm erroneously obtains registration in his own name of a mark belonging to the firm, the proper course is to assign to the firm, and the comptroller ought to register the assignment: *In re Greenlees*, 9 P. R. 93; cf. cases on rectification at p. 373. As to goodwill, see Ch. IX., *ante*.

(c) "An assignee has no exclusive right to a trade mark unless the assignment is of a business co-extensive with the trade mark as registered": *per* Fry, L. J., in *Edwards v. Dennis*, 30 Ch. D. 454. And an assignment of a trade mark with a goodwill consequently gives the assignee no right in the trade mark in connection with any goods other than those to which the goodwill extends: *Ib.*

(d) It would appear that, since a trade mark is to determine when the goodwill of the business in connection with which it has been used determines, the registration should also be determined upon that event happening. So long as the registration continues, there is, under § 75, public use of the mark, which might be thought to imply the existence of a goodwill. It will be noticed that sub-section 1 of § 90 only gives power to expunge an entry *made* without sufficient cause, so that it would appear that an entry made at a time when a goodwill was in existence is not within the wording of the sub-section. See, however, *In re Batt & Co.*, (1898) 2 Ch. 432. However this may be, registration of a trade mark is, by § 76, only evidence of the proprietor's right, *subject to the provisions of the Act*. Rule 34 of the old Trade Mark Rules (re-numbered 33 in the edition of March 1883) gave power to the Court, on the application of any person aggrieved, to remove any trade mark from the register on the ground, after the expiration of five years from the date of the registry thereof, that the registered proprietor was not engaged in any business concerned in the goods within the same class as the goods with respect to which the trade mark was registered; and under this rule a trade mark was removed from the register in *In re Ralph*, 25 Ch. D. 194.

A patentee is carrying on business, and has, therefore, an existing goodwill, as long as he receives royalties from licensees, though he does not himself manufacture: *In re Ralph*, 25 Ch. D. 194. This rule is not re-enacted, but there is no reason to suppose that this omission is due to an intention to allow a trade mark to be protected after the goodwill has determined, and after, by this section, the mark has itself determined.

71. Where each of several persons claims to be registered as proprietor of the same trade mark, the comptroller may refuse to register any of them until their rights have been determined according to law, and the comptroller may himself submit or require the claimants to submit their rights to the Court (a). Conflicting claims to registration.

(a) This section comes from § 5 of the Act of 1875. Rules 42—45 direct that the mode of submission to the Court shall be by special case. This was also provided by the Rules under the old Acts, and *Allsopp v. Walker*, Dig. 545, was heard on special case, and in *Ex parte Grimshaw*, W. N. 1877, p. 21, Hall, V.-C., refused to order otherwise. It was, however, found to be so difficult in practice to settle the

statement of facts that in all cases of rival claim the practice was adopted of applying to the Court by way of motion or summons, asking at the same time for the leave of the Court to have the matter decided in that way, and it is believed that after the first year or two from the passing of the Act of 1875 there is no instance of a special case to be found. *Allsopp v. Walker* was a case in which the registration of a trade mark was objected to on the ground of its similarity to another trade mark, but the cases which this section and the rules under it appear to be really intended to govern are cases in which not similar, nor even identical, trade marks are claimed, but in which *the same* trade mark is claimed, *e.g.*, where a partnership has been dissolved and a question has arisen between the former co-partners as to the way in which the trade marks of the partnership have been transmitted.

Restrictions
on registra-
tion.

72.—(1.) Except where the Court has decided (*a*) that two or more persons are entitled to be registered as proprietors of the same trade mark, the comptroller shall not register (*b*) in respect of the same goods or description of goods (*c*) a trade mark identical with one already on the register with respect to such goods or description of goods.

(2.) [Except as aforesaid] (*d*) the comptroller shall not register (*b*) with respect to the same goods or description of goods (*c*) a trade mark *so nearly resembling* [having such resemblance to] a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive (*e*).

The amendments in this section were made by § 14 of the Act of 1888.

(*a*) This section comes from § 6 of the Act of 1875, by which the "special leave" of the Court was required for such subsequent registration. Of this leave of the Court, Jessel, M. R., said in *In re Jelley, Son & Jones*, 51 L. J. Ch. 639, that it "is not a capricious leave. It merely means that the second man must show his title." The same principle will still govern the decisions of the Court, which will be obtained on motion or adjourned summons. It is for the Court to judge as to the similarity, so that registration may be granted notwithstanding the adverse decision of the Manchester Committee of Experts (see notes to cotton rules, *infra*), or refused, notwithstanding the favourable decision of a foreign Court: *In re Farina* (2), 27 W. R. 456. "The Court," being the High Court of Justice, an order of the House of Lords should be made an order of the High Court of Justice. See *In re Orr-Ewing* (2), 28 W. R. 412.

(*b*) The comptroller's discretion to allow registration is limited by this section: *In re Price's Patent Candle Co.*, 27 Ch. D. 681; *In re Australian Wine Importers, Ltd.*, 41 Ch. D. 278; *Eno v. Dunn*, 15 App. Cas. 252.

(*c*) The prohibition of § 6 of the old Act was of registration "in respect of the same goods or *classes* of goods." The alteration in the language confines the prohibition to cases in which the goods are substantially the same, so that it no longer applies to cases of different goods which happen to be grouped together in the same class. Even under the old Act registration was sometimes granted to similar marks for different goods included in the same class, when no clashing could take place. See note (*a*) to § 65, and note (*a*) to § 69.

(*d*) Before the introduction of these words by the Act of 1888 the prohibition was absolute; but it was held that the Court had a certain discretion where the case was not precisely covered by this section: *In re Australian Wine Importers, Ltd.*, 41 Ch. D. 278.

"Calculated
to deceive."

(*e*) The meaning of the words "calculated to deceive" was considered in *In re Lyndon*, 32 Ch. D. 109, in which Fry, L. J., said that "the words 'calculated to deceive' import at first sight a design to deceive; but I think it plain, from the rest of the section and the decisions of the Courts, that a mark is within the section 'calculated to deceive' when that mark, fairly used, is so like a mark on the register, also fairly used, as that the one is likely to be mistaken for the other." And Bowen, L. J., said "a trade mark is calculated, by its resemblance to another already on the register, to deceive, if in the course of its legitimate use in the trade it is likely to do so." In *In re Farina* (1), 26 W. R. 261, Hall, V.-C., appears to have thought that a mark ought only to be refused registration as being "calculated

to deceive" if it bore such a resemblance to the earlier mark that an injunction would be granted to restrain the use of it; but in *In re Marks & Tellefsen*, 63 L. T. N. S. 234, Pearson, J., considered that the question in such cases was, not whether an injunction would necessarily be granted to restrain the use of the mark applied for, but whether it so nearly resembled the earlier mark as to be likely in futuro to give rise to litigation; and in *In re Speer*, 4 P. R. 521, Kay, J., took the same view, and went on to explain that the comptroller would be right in refusing to register a mark which was so composed as to be likely to cause the goods to which it was applied to be known by the same name in the market as the goods to which the older mark was applied. And see also *per* Kay, J., in *In re Dunn*, 41 Ch. D. 439, and *per* Stirling, J., in *In re Baschiera & Co.*, 33 Sol. J. 469. The House of Lords has now decided in favour of this view: *Eno v. Dunn*, 15 App. Cas. 252. Again, in *In re La Société Anonyme des Verreries de L'Etoile*, (1894) 1 Ch. 61; (1894) 2 Ch. 26, Stirling, J., thus lays down the duties of the comptroller:—"If," he said, "it is brought to his notice by the evidence adduced by an opponent that, even though the two marks are not physically similar, there is a reasonable probability of the public being misled into buying one thing when they think they are buying another, I apprehend that it would be his duty to refuse registration;" and on appeal, Lindley, L. J., intimated that if a device could not be registered as being calculated to deceive, a description of it in words could not be registered, inasmuch as regard ought to be had to the appeal to the ear as well as to the appeal to the eye. And see *Reiners, Von Laer & Co. v. Fehr*, 9 Cape of Good Hope, 306. In *In re Dewhurst & Sons, Ltd.*, (1896) 2 Ch. 137, the same principle was extended to a description in Burmese characters; and it was held further, that the consent of the owner of a mark already on the register was not conclusive on the question whether a mark was calculated to deceive. And see *In re Ehrmann*, (1897) 2 Ch. 495. The provisions of this section exist not merely for the benefit of the owners of trade marks, but for the protection of the public, viz., to prevent confusion and deception, and the like principle will govern the Court in considering whether it ought to encourage concurrent applications. *Per* Stirling, J., in *In re Ehrmann*, (1897) 2 Ch. 495, where applications by two persons who had dissolved partnership were refused although each consented to the other's application. Cf. *In re König & Ebhardt*, (1896) 2 Ch. 236, where the existence on the register of several marks containing a particular device for a variety of goods in a particular class was held no bar to registration of a mark containing a similar device for other goods in the same class subject to a note of disclaimer of the exclusive right to the device, the previous owners consenting or not objecting. If the essential and permanent particulars of the two marks are too similar, it is immaterial that there are differences in the non-essential and changenble elements: *In re Murphy & Co.*, 7 P. R. 163; *In re Currie*, 13 P. R. 681. It has been held in Victoria, that when A. and B. have for years used marks bearing a certain resemblance to one another, A. cannot afterwards register a mark still more similar to B.'s mark: *In re Rowley & Pym*, 9 V. L. R. (L.) 307; and in Canada, the use of a heart-shaped label which the proprietor erroneously believed to be properly registered was held to be a bar to the registration of a label of a similar shape and general appearance: *De Kuyper v. Van Dulken*, 24 Can. Sup. Ct. Rep. 114.

The restriction imposed on the registration of similar trade marks does not extend to similar marks of the same owner, but when one person applies for the registration of an essential particular, or combination of essential particulars, together with varying additions, the proper course is to register the marks as a series under § 66, *ante*. The old Act contained no provision corresponding to those of § 66, but the same course was considered to be the right one, viz., either to register the essential particular, omitting the additions, but stating that there were to be such, or else to register the essential particular with one form of addition, but stating that that might be varied. See *In re Barrows*, 5 Ch. D. 353; *In re Brook*, 26 W. R. 791; *In re William Dixon Ltd.*, Jessel, M. R., April 4th, 1879; *Davis v. Tylor*, Jessel, M. R., April 24th, 1879; *In re Clippens Oil Co.*, Jessel, M. R., March 11th, 1881; *In re Siedman*, L. J. N. of C. 1883, p. 83; though occasionally separate registration was granted to marks which differed only in non-essential respects, as in *In re Fox & Co.*, Hall, V.-C., May 7th, 1881; but see *Baker v. Rawson*, 45 Ch. D. 519, 530. See the observations of Jessel, M. R., in *In re Kuhn & Co.*, 53 L. J. Ch. 238, as to registration with a note of disclaimer. Also *infra*.

When the second of two trade marks which it is thought may conflict is claimed by a different person from the registered proprietor of the first one, it makes a con-

Registration
as a series.

Old marks
favoured.

siderable difference whether the second mark is an old one or a new one; for it is the duty of a manufacturer, when adopting a new mark, to take especial care to select a distinctive one, and the Court will be far more strict in deciding whether this has been done, than it will be in deciding as to similarities between old marks. So that old marks bearing a certain similarity to each other may sometimes be allowed to be registered, though if the mark last applied for were a new one, registration would be refused to it: *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *In re Rosing*, 54 L. J. Ch. 975; *In re Lambert*, 6 P. R. 344; and see *per* Lord Blackburn in *Orr-Ewing v. Registrar of Trade Marks*, 4 App. Cas. 499.

The "Three Mark Rule."

When the Act of 1875 came into operation it was soon discovered that trade marks which were for practical purposes indistinguishable had in various instances been used by two or more firms, generally in different parts of the country, for the same or substantially the same goods, and the injustice of giving an exclusive right to the first of these firms was felt to be so great that what is known as the "Three Mark Rule" was promulgated by the Commissioners of Patents. The first public announcement of the new rule was made by Jessel, M. R., in *In re Walkden Aerated Waters Co.* (54 L. J. Ch. 394), when he stated that the Lord Chancellor was of opinion that the number of times that a device or emblem might be registered as a trade mark for articles of the same class ought, for the sake of distinctiveness, in no case to exceed three. That was a case in which the application was for the registration of a mark similar in its main features to two others already on the register. The mark was a new one, and the application was only allowed upon condition of the consent of both the previously registered proprietors being produced. On account of the mark in that case having been a new one, an idea arose that the rule was only applicable to new marks, but in *In re Hyde & Co.* (54 L. J. Ch. 395) the Master of the Rolls took another opportunity of referring to the rule, and stated that the Lord Chancellor had personally come to the decision that not more than three registrations of the same, or practically the same, mark should be allowed, and that this was also his own decision; and, in fact, that of the Commissioners of Patents, having been communicated to the Attorney and Solicitor-General. This decision was intended to cover old marks, and not merely new ones. A mark used in substance by more than three firms could not be registered, but must be treated as open. The rule therefore is, that where a mark has been used by more than three firms it is common to the trade and incapable of registration; that where a mark has been used by two firms or three firms before the 13th of August, 1875 (the date of the passing of the Act of 1875), it is the old mark of each firm, and each firm is entitled to registration, almost as of right, on proof of the facts; but that where a mark has been registered by one firm or two firms, another firm will not be allowed to register substantially the same mark for the same goods as a new mark, except by the consent of the previously registered proprietors. See *In re Leonardt*, Dig. 610; *In re Mitchell* (2), Dig. 611; *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *In re Brook*, 26 W. R. 791; *In re Powell*, Dig. 589; *Ex parte Sales, Pollard & Co.*, Dig. 620; *In re Kuhn & Co.*, 53 L. J. Ch. 238; *Benbow v. Low* (4), 44 L. T. N. S. 875; *Mouson & Co. v. Boehm*, 26 Ch. D. 398; and *In re Vergaras, Hall, V.-C.*, June 3rd, 1881, in which last case the same mark was allowed to be registered by three separate firms as a new mark, all consenting. In *In re Walkden & Co.*, 54 L. J. Ch. 394, the mark was allowed to be registered as a new mark with the consent of two other firms who had registered similar marks as their old marks. The tendency of recent cases, however, appears to be to attach less importance than formerly to the consent of previous owners, and to prohibit altogether the registration of a new mark similar to an old one; since the section, it is said, is framed for the protection of the public as well as of the trade mark owners. *In re Dewhurst & Sons, Ltd.*, (1896) 2 Ch. 137, and *In re Ehrmann*, (1897) 2 Ch. 495, where registration was refused; and see *In re König & Ebhardt*, (1896) 2 Ch. 236. An old mark may be registered under the Three Marks Rule, notwithstanding that another similar mark has been on the register for upwards of five years: *Jackson & Co. v. Napper*, 35 Ch. D. 162; *In re Bancroft & Co.*, 5 P. R. 209. And to entitle a mark to such registration it is not necessary to show user on the identical goods for which it is sought to register; it is sufficient to show actual user before August, 1875, on substantially identical goods—*e.g.*, hatchets and axes, gimlets and augers, coopers' drawing-knives and carpenters' drawing-knives: *Jackson & Co. v. Napper*, 35 Ch. D. 162. In *In re United Vineyards Proprietors' Co.*, Stirling, J., Nov. 8th, 1889, the company applied in 1876 for the registration of a device of a salamander with the words "The Salamander" as their old mark for brandy, used upwards of twenty years before 1876; but the application

lapsed in consequence of the applicants having never received a letter from the registrar requesting the final fee to be forwarded. The applicants supposed the mark to have been registered. In 1882 another firm obtained the registration of a different device of a salamander as their new mark for fermented liquors and spirits. In 1889 the original applicants became aware of the non-registration, and at once made a fresh application for registration of their original mark as their old mark for brandy, used since 1850. The firm registered in 1882 refused to consent to the application, but did not appear to oppose it; and it was held that the registration should proceed, the mark being an old one. Where a new mark had been registered and much used, and another similar mark which had not been much used was proved to be an old mark and was allowed to be registered, the new mark was not removed from the register, but was allowed to remain there side by side with the old one: *Mouson & Co. v. Boehm*, 26 Ch. D. 398. But where the word "Emollio" had been used for several years prior to 1870, but had been abandoned from that year till 1881, when the user was recommenced in a different form, and there had been considerable use of the word "Emollino" by another firm since 1876, "Emollio" was not allowed to be registered: *In re Grossmith*, 6 P. R. 180. In *In re Sone & Fleming Manufacturing Co.*, 30 Ch. D. 505, the applicants had used the mark in England and America since 1872, and had registered it in America in 1881. On their applying for registration in 1885 registration was refused by the comptroller on account of a somewhat similar mark having been registered by another firm in 1877, but that firm not appearing to oppose, though served with notice of the application, and the mark being an old one, registration was granted. So in *In re Bancroft & Co.*, 5 P. R. 209; *In re Kenrick & Jefferson*, 7 P. R. 321. To bring a mark within the rule and entitle it to registration, notwithstanding a previous similar registration for the same goods, foreign user is insufficient, and there must have been user within the United Kingdom: *In re Münch*, 50 L. T. N. S. 12; with which compare *In re Riviere & Co.*, 26 Ch. D. 48; *Leonard & Ellis v. Wells & Co.*, 26 Ch. D. 288, per Fry, L. J.; and *Berliner Brauerei Gesellschaft Tirol v. Knight, Stocks & Co.*, W. N. 1883, p. 70. And the mere passage of marked goods through England, without any sale or exposure for sale, is not user of the mark in England: *Jackson & Co. v. Napper*, 35 Ch. D. 162; *In re Meens*, (1891) 1 Ch. 41. And see *Newman v. Pinto*, 4 P. R. 508, per Kekewich, J. The user within the United Kingdom must have been substantial, and not merely nominal and unknown to the other proprietor: *In re Hodson & Co.*, 26 Sol. J. 43. A mark will be held to have been in common use, and to be consequently incapable of registration in any name, if the substantial part of it was so, though the minor parts were sometimes varied; e.g., in *In re Wragg*, 29 Ch. D. 551, the device of a syphon, hand and glass, was held to be common to the mineral waters trade, though in the six cases relied on the three elements appeared together in three only, the syphon and hand in one, and the syphon and glass in two. From the same case it appears that the cases of user, which make the mark common, need not all have been on the goods, as in three out of the six cases the user was only on invoices and circulars, and not on the bottles.

In some cases the similarity between marks has been got over by registering for different goods, though in the same class (see note (a) to § 65, ante; also *In re Kenrick & Jefferson*, 7 P. R. 321; *In re König & Ebhardt*, (1896) 2 Ch. 236); or restricting the manner of user in respect of colour (*In re Johnson, Philpott & Co.*, North, J., Feb. 21st, 1888; *In re Jeffrey & Co.*, Stirling, J., May 18th, 1888); or otherwise (*In re Whiteley*, 43 L. T. N. S. 627; *In re Sykes*, 43 L. T. N. S. 626; *In re Farina* (3), Dig. 654; see *In re De Otaduy*, W. N. 1885, p. 177); or the locality within which the mark is to be used (*In re Rabone*, Dig. 643; *In re Keep Brothers*, 26 Ch. D. 187; *In re Mitchell & Co.*, 28 Ch. D. 666; *In re Johnson, Philpott & Co.*, North, J., Feb. 21st, 1888; *In re Steel*, Chitty, J., Jan. 12th, 1893. Where registration is granted with a limitation, the nature and extent of the limitation should appear on the face of the register, so as to be ascertainable by persons searching the register: *In re Mitchell & Co.*, 28 Ch. D. 666. See *In re De Otaduy*, W. N. 1885, p. 177. And in the same spirit, the improper grant of an exclusive right in common elements has been avoided by the use of disclaimers (*In re Leonardt*, Dig. 610; *In re Mitchell* (2), Dig. 611; *In re Hubbuck*, Jessel, M. R., June 20th, 1879; *Ex parte Sales, Pollard & Co.*, Dig. 620; *In re Kuhn & Co.*, 53 L. J. Ch. 238; *In re Hoyle & Sons, Ltd.* (2), Chitty, J., Nov. 30th, 1883; *In re Davies*, Chitty, J., March 9th, 1885; *In re König & Ebhardt*, (1896) 2 Ch. 236; and see *In re Dewhurst & Sons, Ltd.*, (1896) 2 Ch. 137; see also, § 74); and permission to use a mark has been reserved to

Registration with a note.

certain persons, on registration against all others being granted: *Ex parte Hemming & Son*, Jessel, M. R., April 27th, 1881. In *In re Dewhurst & Sons, Ltd.*, (1896) 2 Ch. 137, the Court of Appeal held that registration subject to a condition imposing a geographical limit ought not to be allowed, and it seems that the cases in which special notes have been made on the register can no longer be regarded as precedents, at all events in the case of new marks.

Marks compared as used.

In considering whether there is in fact such similarity between two marks as to exclude the second from registration, it is very important to compare them in the actual mode of user—*e.g.*, as branded on metal goods: *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *In re Rosing*, 54 L. J. Ch. 975; *Nuthall v. Fining*, C. A. Jan. 21st, 1860. And compare *Davis v. Reid*, 17 Grant, Up. Can. Ch. 69. And if there are blanks in the new mark, as tendered for registration or registered, regard will be had to the manner in which these are filled up in practice (*In re Christiansen*, 3 P. R. 54); and the manner of arrangement of parts common to the trade will also be taken into consideration: *ib.* And see *In re Farrow*, 7 P. R. 260. And it has been held that, if one trade mark has been registered without colour, but is in practice used in a particular colour, and another trade mark is offered for registration which is distinguishable without colour, but might by the addition of colour be made to resemble the first mark, registration will be refused (*In re Worthington*, 14 Ch. D. 8); and *à fortiori*, where it is proved that the proposed new mark was intended to be used in the same colour as the opponent's mark: *In re Turney*, 11 P. R. 37. And see *In re Biegel*, 4 P. R. 525; and *In re La Société Anonyme des Verreries de l'Etoile*, (1894) 2 Ch. 26, in which case, it being conceded that where a device of a star had been registered for glass a device of a red star could not be registered, a mark consisting of the words "Red Star Brand" was removed from the register. Although a trade mark must now be distinctive, irrespective of colour (*In re Hanson*, 37 Ch. D. 112), it may now be registered in colour (§ 67), an advantage which was previously reserved for cotton marks and other marks of a special character requiring registration by deposit. In such a case it was formerly held that the colour was part of the mark, so that a gold coin might be registered for goods for which a silver coin was already registered, though if both were in gold, or both in silver, there would be a similarity (*In re Robinson*, 29 W. R. 31); but, having regard to the provisions of § 67, it hardly seems that this decision could now be repeated. In *In re Lyndon*, 32 Ch. D. 109, it was held by the Court of Appeal that a mark tendered for registration must be compared with a mark already registered, not as actually used, but as registered, and on the footing that the applicant's mark will be fairly used; and "it is established now that when two marks are being compared together for the purpose of seeing to what extent one resembles the other with reference to the question of registering or not, the Court must presume a fair user of the mark; and at the same time it is established that the Court must look, in deciding such a question as this, to the mode in which the mark would be stamped or affixed, the character of the goods upon which it is affixed, and generally to all the circumstances of the case with respect to the placing on of the mark and the user of it. But, though the circumstances are to be looked at, it is a cardinal proposition that the Court must presume a fair user": *per* Chitty, J., in *In re Haines, Butcher & Co.*, 5 P. R. 669. In the same way Cotton, L. J., said, in *In re Lambert*, 6 P. R. 344, 351: "In considering whether the mark is calculated to deceive, we must consider what would be the ordinary use, without fraud, of the mark, and not go into the question of what might be done by a fraudulent user. If that were done—if there were a fraudulent user—then the Court would interfere, not because the man had not got the trade mark, but because he was using that trade mark fraudulently, so as to pass off his goods for those of another. That matter of fraud is not to be considered in dealing with the question whether the mark is so like another as to be calculated to deceive. In dealing with that question you must assume that it is fair and right." And see *In re Farrow*, 7 P. R. 260; and *In re Kutnow*, 10 P. R. 401. It has been held in Victoria (*Ex parte Kennedy*, 9 Vict. L. R. (L.) 335), and the same would appear to hold good in this country, that the marks ought to be compared taken apart, and not as seen side by side, and that the question is whether it is or is not probable that an incautious person would be deceived.

Cotton marks.

In the case of cotton marks which were brought before the Manchester Committee of Experts, due weight should be given to their opinion as to the distinctiveness of the marks (*Orr-Ewing v. Registrar of Trade Marks*, 4 App. Cas. 479), but they seem to have given somewhat too wide an interpretation to the expression "substantial

similarity" in their instructions. See *In re Brook*, 26 W. R. 791. The cotton rules being now repealed, a B. list mark may be registered without an application to the Court, if the comptroller considers that a mistake has been made.

For instances of cases in which registration has been refused on the ground of similarity, reference may be made to *Allsopp v. Walker*, Dig. 545, in which the first mark was a man's hand held upwards, and the second was a female hand pointed horizontally; *In re Jelley, Son, & Jones*, 51 L. J. Ch. 639, in which the first mark was a pointer at a point, with the word "Staunch," and the second was a pointer feeding out of a porridge pot; *In re Rosing*, 54 L. J. Ch. 975, in which the first mark was a plain horn with a looped cord, and the second was a sprig of two roses with a twisted horn; *Barrows v. Feisall Coal and Iron Co.*, Dig. 530, in which the marks were a crown with "B. B. H." in Roman letters, and a crown with "B. B. S." in italics; *In re Worthington & Co.*, 14 Ch. D. 8, a plain triangle, and a triangle containing a church with an inscription; *In re Barker & Son*, 53 L. T. N. S. 23, where each label consisted of a sporting scene; *In re Marks & Tellefsen*, 63 L. T. N. S. 234, in which the general arrangement of the two marks was very similar; *In re Speer*, 4 P. R. 521, a dog, tower and harp, in each case; *In re Sanitas Co., Ltd.*, 4 P. R. 533, where the application was for the word "Sanitas," which was included in two previous marks; *In re Grossmith*, 6 P. R. 180, where "Emollio" was thought too similar to "Emolline"; *In re Australian Wine Importers, Ltd.*, 41 Ch. D. 278, where each mark contained prominently a device of a golden fleece; *In re Baschiera & Co.*, 33 Sol. J. 469, a lion and a winged lion; *In re Murphy & Co.*, 7 P. R. 163, a lion rampant with a crown and a lion rampant with a sheaf; *In re Dunn*, 41 Ch. D. 439; 15 App. Cas. 252, "Fruit Salt" for producing a beverage and "Fruit Salt" baking powder; *In re Farrow*, 7 P. R. 260, a bull's head and a bison; *In re Goodall*, 42 Ch. D. 566, a similar arrangement of common words; and see *In re Farina* (2), 27 W. R. 456; *In re Hargreaves*, 11 Ch. D. 669; *In re Meyerstein & Co.*, 43 Ch. D. 604; *In re Turney*, 11 P. R. 37; *In re Dewhurst and Sons, Ltd.*, (1896) 2 Ch. 137, and other cases; also *Ex parte Kennedy*, 9 V. L. R. (L.) 335, in Victoria.

For instances of cases in which registration has not been refused on the ground of similarity, see *In re Farina* (1), 26 W. R. 261, where a label had been registered with a small seal in one corner, and application was made for the registration of the same seal alone; *In re Lyndon*, 32 Ch. D. 109, a man's head surmounting the word "way," and a helmeted female head surmounting the word "Athena"; *In re Haines, Batchelor & Co.*, 5 P. R. 669, a shaded device of a pointer at a point, facing to the left, and surmounting the word "Staunch," and an outline device of a pig, facing to the left, and surmounting the initials "H. B. & Co."; *In re Burgoyne*, 6 P. R. 227, "Emu" and "Oomoo"; *In re Simpson*, L. J. N. of C. 1890, p. 143; *In re Loftus*, (1894) 1 Ch. 193. See also *Orr-Ewing v. Registrar of Trade Marks*, 4 App. Cas. 479, and the other cotton cases mentioned in the notes to the cotton rules. Except in the cases of cotton marks the opposition has usually been successful, and registration has either been refused altogether or only granted subject to limitations.

Under the similar section in the United States Act, registration was refused where the first mark was the figure of a star and the second was the word "star" (*In re The American Lubricating Oil Co.*, 9 U. S. Pat. Gaz. 687); where the first mark was the name "Haxall," and the principal part of the second consisted of the same name and a maltese cross (*In re Coggin, Kidder & Co.*, 11 U. S. Pat. Gaz. 1109); where the marks were the word "Swan" and the words "Black Swan" (*Ex parte Cairn*, 15 U. S. Pat. Gaz. 248); so where a trade mark was tendered which consisted of three parts, each of which was already registered, one by the applicant and the others by other firms (*In re Bush & Co.*, 10 U. S. Pat. Gaz. 164), and where the new mark consisted of "A. S. California Family * Soap," and "California" and "*" were already on the register (*Ex parte Smith* (1), 16 U. S. Pat. Gaz. 679); and see *Ex parte Weisert Bros.*, 16 U. S. Pat. Gaz. 680. In *In re Cornwall* (1), 12 U. S. Pat. Gaz. 138, registration was granted to a star and crescent, a star being on the register; and see *In re Imbs*, 10 U. S. Pat. Gaz. 463. And see cases collected at p. 645, notes (d) and (e).

The comptroller is entitled to his costs of opposing an application on the ground of similarity to a registered mark; at all events, unless the marks are very clearly distinct. See *In re Patent Plumbago Crucible Co.*, Jessel, M. R., Aug. 1st, 1879.

See Rule 46 as to notifying the order of the Court to the comptroller.

Where the Registrar had refused to register on the ground of similarity

Cases of refusal.

Cases of non-refusal.

American cases.

to a registered mark, and the marks did not appear to be similar, but the owner of the registered mark had not been served with the notice of motion of the person applying for the registration of the second mark, Chitty, J., directed the registered owner to be served, and on that being done, and no objection being made, ordered the registration to proceed: *In re Milne & Co.*, Chitty, J., July 6th, 1882. And where the comptroller objects to register a mark on the ground of similarity to a registered mark, the usual practice now is to require notice of the application to be given to the proprietor of the registered mark: *In re Sone & Fleming Manufacturing Co.*, 30 Ch. D. 505; *In re Bancroft & Co.*, 5 P. R. 209; *In re Baschiera & Co.*, 33 Sol. J. 469.

Further restriction on registration.

73. It shall not be lawful to register as part of or in combination with a trade mark any words the *exclusive* use of which would, by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a Court of Justice (a), or any scandalous design.

(a) This section is taken from § 6 of the Act of 1875, and was amended by § 15 of the Act of 1888. The wording of the original enactment was "would not be deemed entitled," and the present wording, "would be deemed disentitled," seems less open to misinterpretation. That the original enactment only referred to deceptiveness inherent in the mark itself, and not to liability to be mistaken for another mark, was held by Jessel, M. R., in *In re Horsburgh*, 53 L. J. Ch. 237. Kay, J., however (*In re Grossmith*, 6 P. R. 180; *In re Dunn*, 41 Ch. D. 439), and Stirling, J. (*In re Swift Specific Co.*, 6 P. R. 352), appear to have thought that words were within this section which bore a resemblance to words included in an earlier mark. And Cotton, L. J., took this view in *In re Dunn*, 41 Ch. D. 439. But in that case Lindley, L. J., expressly concurred in the view taken by Jessel, M. R., and Fry, L. J., did not dissent from it. And in *In re Australian Wine Importers, Ltd.*, 41 Ch. D. 278, the observations of Cotton, L. J., incline rather in the same direction.

However, after the decision of the House of Lords in *Eno v. Dunn*, 15 App. Cas. 252, which was considered on the footing that the section applied to words tendered for registration which were calculated to deceive by reason of similarity to words previously in use by a different trader, the wider construction will, no doubt, be given to the enactment. See *In re Hill*, 10 P. R. 113; *In re Thewlis & Blakey*, *ib.* 369. This much seems to be clear, that the comptroller is necessarily bound to refuse marks which offend against either §§ 72 or 73, whether he himself discovers the objection, or whether his attention is called to it in the course of an opposition, that the comptroller has a discretion either to register or not in cases which do not offend against these sections, though he should not reject an application without some adequate legal or moral reason, and that he can exercise this discretion either of his own motion under § 62, or on an opposition under § 69, which contains no limitation of the grounds upon which a mark may be opposed. The question as to what is the exact meaning of § 73 is somewhat academical, when it is remembered that the comptroller has a judicial discretion to register or not, and that even if an objectionable mark escapes his vigilance, it may be removed from the register under § 90 as having been registered without sufficient cause.

There is no doubt that § 73 applies to cases in which a trade mark contains a false statement of origin (*In re Horsburgh*, 53 L. J. Ch. 237); or in which the trade mark untruly states that the proprietors are the "sole makers" (*In re Hayward & Sons*, 54 L. J. Ch. 1003); or in which it untruly states the name and address of the maker (*In re Hill*, 10 P. R. 113); or in which the mark is habitually used as part of a deceptive whole: *Wood v. Lambert*, 32 Ch. D. 247. If a trade mark tendered for registration contains the words "trade mark" so placed as to be likely to mislead the public into the belief that a particular part of the trade mark, and not the whole of it, is claimed and registered, registration ought to be refused under this section: *In re Apollinaris Co.*, (1891) 2 Ch. 186, 233, 235; *In re Wills*, (1893) 2 Ch. 262. See *Hammond v. Malcolm, Brunner & Co.*, 9 P. R. 301; *In re Colman*, (1891) 2 Ch. 402; *In re Phillips*, (1891) 3 Ch. 139. The onus of proving that a mark is not calculated to deceive under this section is on the applicant for registration (*Eno v. Dunn*, 15 App. Cas. 252; *In re Thewlis & Blakey*, 10 P. R. 369); but a mark is not calculated to deceive merely because it includes the capability of being used by the

party registering it for purposes of deception: *per* North, J., in *In re Kutnow*, 10 P. R. 401. Thus, in *In re Smokeless Powder Co.*, (1892) 1 Ch. 590, it was held that the words "Smokeless Powder" used as part of the name of the company were not calculated to deceive the public into the notion that the company had a monopoly in smokeless powder. But registration was refused to a mark which, as previously used, contained fraudulent misstatements, though they were corrected in the mark as tendered for registration: *In re Fuente*, (1891) 2 Ch. 166.

Where it is sought to register as a trade mark a word or words which are or may be appropriate to the article to which the trade mark is to be applied, the applicant is in the dilemma that the alleged trade mark is either descriptive or deceptive; if the word or words are properly applicable to the article and may be truly used with respect to it, they are descriptive and are not within § 64; if they may be read as stating something with respect to the article which is untrue, they are deceptive within the present section; so that *quæcunque viâ* the application must fail. Thus, in *In re Saunton & Co.*, Dig. 625, where the mark was "Anglo-Portugo Oysters," either the oysters were of Anglo-Portuguese origin, in which case any one had a right to say that they were so, or they were not of such origin, in which case no one had a right to say so; and this was adopted by Lopes, L. J., in *In re Van Duzer*, 34 Ch. D. 623. And see *In re Hannay*, 7 P. R. 46; *In re Edge*, 8 P. R. 207. There are numerous similar cases under the U. S. Acts. Thus, *In re American Sardine Co.*, 3 U. S. Pat. Gaz. 495 ("American Sardines"); *In re Dole Bros.*, 12 *ib.* 939 ("Egg Macaroni"); *In re Warburg & Co.*, 13 *ib.* 44 ("Cachemire Milano"); *Ex parte Marsching*, 15 *ib.* 294 ("French" paints); *Ex parte Knapp*, 16 *ib.* 318 ("London" Animal Foods); *Ginter v. Kinney Tobacco Co.*, 12 Fed. Rep. 782 ("Straight-cut" Cigarettes); *Ex parte Grove*, 67 U. S. Pat. Gaz. 1447 ("Bromo-Quinine"). And see *California Fig Syrup Co. v. Putnam*, 69 Fed. Rep. 740; *Same v. Stearns*, 73 *ib.* 812 ("Fig Syrup"). Compare *In re Green*, 8 U. S. Pat. Gaz. 729 ("German Sirup"), where registration was allowed.

Words which are descriptive or deceptive.

In the American case of *Ex parte Cigar Makers' Association*, 16 *ib.* 958, it was held that a mark could not be registered which was intended to be used by any member of an association on goods of any quality, nor one which was intended to be used for the furtherance of a scheme in restraint of trade. And in *Schneider v. Williams*, 44 N. J. Eq. 391, the Court refused to protect such a mark at the instance of a member of such an association. See also *Cigar Makers' Protective Union v. Conhaim*, 40 Minn. 243; 12 Am. St. Rep. 726; *McVey v. Brendel*, 144 Penn. St. 235; 27 Am. St. Rep. 625; *Weener v. Brayton*, 152 Mass. 101; *State v. Bishop*, 128 Mo. 373; 49 Am. St. Rep. 569. But see *Strasser v. Moonelis*, 108 N. Y. 611; *People v. Fisher*, 57 N. Y. Sup. Ct. 552; *Allen v. Macarthy*, 37 Minn. 347; *Bloete v. Simon*, 19 Abb. N. C. 88; *Cohn v. Feople*, 149 Ill. 486; 41 Am. St. Rep. 304; *Gravel Roofers' Exchange v. Turnbull*, 64 U. S. Pat. Gaz. 441. And in *Ex parte Bloch & Co.*, 40 *ib.* 443, registration was refused in America to a mark which contained the words "Knights of Labour," the applicants having no connection with the society of that name.

As to what will be deemed to disentitle to protection in a court of justice, see further Ch. 7, *ante*.

74.—(1.) Nothing in this Act shall be construed to prevent the controller entering on the register, in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade mark (a)—

Saving for power to provide for entry on register of common marks as additions to trade marks.

(a.) In the case of an application for registration of a trade mark used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive (b) device, mark, brand, heading, label, ticket, letter, word, or figure, or combination of letters, words, or figures, though the same is common to the trade (c) in the goods with respect to which the application is made;

(b.) In the case of an application for registration of a trade mark not used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive (b) word or combination of words, though the

same is common to the trade (c) in the goods with respect to which the application is made;

(2.) *The applicant for entry of any such common particular or particulars must, however, disclaim (d) in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the register.*

[(2.) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

Provided that a person need not, under this section, disclaim his own name or the foreign equivalent thereof, or his place of business (e); but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof.]

(3.) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words or figures, which was, or were, before the thirteenth day of August one thousand eight hundred and seventy-five, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods (f).

The amendments in this section were made by § 16 of the Act of 1888.

(a) This section was new in 1883, and is not very clearly expressed, but what is intended appears to be that when a trade mark sent in for registration contains, together with an essential particular, a feature which is in common use in the trade, that common feature must be disclaimed, so that the rest of the trade may not be deprived of their right to use it. The additions to which this section relates are apparently not quite the same as the additions to an essential particular referred to in § 64 (2), but such as would be capable of distinguishing the goods, were it not that in point of fact they have been used by several different firms. Thus, if a device of an animal were registered in combination with the words "First quality," for iron, the case would be within § 64; but if the same device were to be registered in combination with a crown, the case would be within the present section, the crown being *prima facie* distinctive, but in point of fact common to the trade. Long user does not entitle members of a trade to register a particular device as part of their trade marks when the user was fraudulent in its inception and is still calculated to deceive (*In re Heaton*, 27 Ch. D. 570); and if words forming part of a trade mark are calculated to deceive, the person claiming the mark cannot assist his application for registration by disclaiming the objectionable words: *Eno v. Dunn*, 15 App. Cas. 252. It seems that where a distinctive label is registered as a whole, words which are included in the label are a part of the label, and not additions to it, and need not consequently be disclaimed under this section: *In re Apollinaris Co.*, (1891) 2 Ch. 186, 233; *Pinto v. Badman*, 8 P. R. 181, 188, 191; *In re Smokeless Powder Co.*, (1892) 1 Ch. 590; *In re Clement & Cie.*, 16 P. R. 173.

(b) The word "distinctive" is applicable to all the matters here mentioned: *per Chitty, J.*, in *Burland & Co. v. Broxburn Oil Co., Ltd.* (2), 42 Ch. D. 274. And see *per Cotton, L. J.*, in *Waterman v. Ayres*, 39 Ch. D. 29. There is at first sight a contradiction in terms here, as a mark common to the trade cannot, of course, be distinctive; but what is intended appears to be that any mark which is *prima facie* distinctive, but which is really common to the trade, must be disclaimed when registered as part of a combination. The epithet "distinctive" would thus be here applied to every mark which is not inherently incapable of appropriation by an individual. This view was approved by Chitty, J., in *Burland & Co. v. Broxburn Oil Co., Ltd.* (2), 42 Ch. D. 274. From the dicta in the Court of Appeal in *In re Hudson*, 32 Ch. D. 311, and *In re Atkins Filter & Engineering Co., Ltd.*, 3 P. R. 164, it would appear that their attention had not been directed to this word.

(c) The words "common to the trade" have been construed to mean "open to the trade": *Humphries v. Taylor Drug Co.* (2), 59 L. T. N. S. 820; and *Burland & Co. v. Broxburn Oil Co. Ltd.* (2), 42 Ch. D. 274; *In re Apollinaris Co.*, (1891) 2 Ch. 186, 209, 210; and this seems to be what is meant. In *Thompson v. Montgomery*, 41 Ch. D. 35, Lindley, L. J., said that "nothing can be common to the trade which is used only by one person in the trade": but in § 64, where it was intended to exclude from registration fancy words "in common use," that expression was employed, and the difference of language seems to show that the phrase here means that which is of common right, whether in common use or not. When it is alleged adversely to an applicant for registration, that the whole or a part of his trade mark is common to the trade, the onus is upon the person alleging that this is so to prove it, not upon the applicant for registration to prove the contrary: *In re Leonard & Ellis*, 26 Ch. D. 288; *In re Edgington*, 6 P. R. 513; and see *Pinto v. Badman*, 8 P. R. 189. And the entries in the registry office books of applications for registration do not prove that a mark is in common use, as they only prove that the applications entered have been made, not that they have all been properly made, or upon true allegations, or that the marks applied for have in fact been used: *Orr-Ewing & Co. v. Johnston & Co.*, 13 Ch. D. 431. A mark is not made common to a particular trade by the fact that persons engaged in different trades have used it on goods of a different character (*Somerville v. Schembri*, 12 App. Cas. 453), nor by fraudulent user by infringers (*Barlow & Jones, Ltd. v. Johnson & Co.*, 7 P. R. 414, 419), nor by the fact that goods marked with it have passed through England from one foreign country to another, without any offering for sale in England: *Newman v. Pinto*, 4 P. R. 508 (*per Kekewich, J.*). And see *Jackson & Co. v. Napper*, 35 Ch. D. 162; *In re Meeus*, (1891) 1 Ch. 41. In a number of cases since the Registration Acts marks have been found to be common to different trades: thus, a number of words and devices to the iron trade: *In re Barrows*, 5 Ch. D. 353; *In re Davies*, Chitty, J., March 9th, 1885; the words "Bank of England," to the sealing-wax trade: *In re Hyde & Co.*, 7 Ch. D. 724; the word "Selected," and other words and devices, to the steel-pen trade: *In re Leonardt*, Dig. 610; *In re Mitchell* (2), Dig. 611; *In re Kuhn & Co.*, 53 L. J. Ch. 238; the letters "S. P." to the snuff trade: *Ex parte Sales, Pollard & Co.*, Dig. 620; the Eton arms to the hat trade: *Lucke v. Webster*, Jessel, M. R., April 4th, 1879; the words "Braided Fixed Stars," to the match trade: *In re Palmer* (3), 24 Ch. D. 504; the words "La Minerva, Habana," "La Pureza," and "Gold Leaf," to the cigar and tobacco trade: *In re Lloyd & Sons*, 27 Ch. D. 646; *Newman v. Pinto*, 4 P. R. 508; *Partlo v. Todd*, 12 Ont. Rep. 171; a device of a syphon, hand, and glass to the mineral-water trade: *In re Wragg*, 29 Ch. D. 551; the words "Extra," "Extra G.," "Coker," to the canvas trade: *In re Hayward & Sons*, 54 L. J. Ch. 1003; the words "Mandarin Tea" to the tea trade: *British Tea & Trading Association, Ltd. v. Cooke*, Bacon, V.-C., June 8th, 1886; the words "Old Innishowen" to the whiskey trade: *Watt v. O'Hanlon*, 4 P. R. 1; the words "Parchment" and "Bank" to the paper trade: *In re Goodall*, 42 Ch. D. 566; *Pirie v. Goodall*, (1892) 1 Ch. 35; various animals, devices, and colours to the cotton trade: *Orr-Ewing & Co. v. Johnston & Co.*, 7 App. Cas. 219; *Wallace & Co. v. King & Co.*, Bombay High Ct., April 30th, 1879; *In re Hoyle & Sons, Ltd.* (2), Chitty, J., Nov. 30th, 1883. And see *Orr-Ewing & Co. v. Registrar of Trade Marks*, 4 App. Cas. 479; and *In re Brook*, 26 W. R. 791.

Common marks.

(d) The practice of entering disclaimers in the register appears to have originated with the cases of *In re Leonardt*, Dig. 610, and *In re Mitchell* (2), Dig. 611. In those cases the consent of the owner of the mark was required, but in *In re Kuhn & Co.*, 53 L. J. Ch. 238, an order for a disclaimer was made notwithstanding that the owner did not formally consent, and in other cases the registration was subjected to limitations entered on the register. See cases cited in note (c) to § 72, *supra*. The practice has been carried so far, that in *In re Hoyle & Sons, Ltd.* (2), Chitty, J., Nov. 30th, 1883, a trade mark, consisting of a pheasant sitting on a gate, was registered with a disclaimer of the bird, leaving only the gate. See the order of the House of Lords in *Orr-Ewing v. Registrar of Trade Marks*, 4 App. Cas. 479; and see also the statement by Jessel, M. R., in *In re Kuhn & Co.*, 53 L. J. Ch. 238; and *Baker v. Rawson*, 45 Ch. D. 519, 530.

Disclaimers under the Act of 1875.

In *In re Hudson*, 32 Ch. D. 311, the Court of Appeal appears to have thought that a disclaimer could not be compulsorily enforced under the Act of 1875; but there does not seem to have been much argument on the point, and the case was decided on the ground that the words of which it was sought to compel a disclaimer

were descriptive, and could not in any event be claimed as a result of the registration of the label. The words not being *prima facie* distinctive, the question as to disclaimer could not really arise. The same was the case in *In re Atkins Filter & Engineering Co., Ltd.*, 3 P. R. 164. In *In re Hayward & Sons*, 54 L. J. Ch. 1003, Kay, J., held that the Court had power under the Act of 1875 to order a compulsory disclaimer, and he accordingly ordered a disclaimer to be entered of the words "Extra G," which were common to the trade. And see *Baker v. Rawson*, 45 Ch. D. 519, 530.

Disclaimers
under the
Acts of 1883
—1888.

The provision in the present Acts being that the common particular must be disclaimed *in the application*, the question has been raised whether such a disclaimer can be made at a later date, and North, J., in *In re Goodall*, 42 Ch. D. 566, decided that this could not be done, and that an application from which a necessary disclaimer had been omitted was simply null and void. So also Chitty, J., in *In re Mecus*, (1891) 1 Ch. 41, and Kekewich, J., in *In re Apollinaris Co.*, (1891) 2 Ch. 186, 212. In *In re Swift Specific Co.*, 6 P. R. 352, Stirling, J., refrained from deciding whether an application defective in this respect was invalid, but directed a disclaimer to be entered on the register; and see *per* North, J., in *Baker v. Rawson*, 45 Ch. D. 519, 530. Subsequent disclaimers have also been directed under these Acts by Kay, J.: *In re Hayward & Co.*, 54 L. J. Ch. 1003 ("Extra," "Coker"); by Kekewich, J.: *Humphries v. Taylor Drug Co.* (2), 59 L. T. N. S. 820 ("Herbalin"); and by Chitty, J.: *Burland & Co. v. Broxburn Oil Co., Ltd.* (2), 42 Ch. D. 274 ("Washerine"); *In re Edge*, 8 P. R. 207 ("Filtered Blue"). It has also been held by Kekewich, J., that the fact that a common word has been registered as part of a trade mark, without a disclaimer, does not necessarily disentitle the owner of the mark to his costs in an action against a person who has adopted the same trade mark: *Newman v. Pinto*, 4 P. R. 508. Where a distinctive device has been registered, together with words which are in fact common to the trade, but without any disclaimer, no right is acquired in the common word, even after the lapse of five years from registration: *British Tea and Trading Association, Ltd. v. Cooke*, Bacon, V.-C., June 8th, 1886 ("Mandarin Tea"). Inasmuch as the section only provides for disclaimer of matters common to the trade, a trader will not be allowed to register, as an addition to a device, words which are not necessarily of common right, and which have, in fact, been used by one firm only besides himself, with a disclaimer of any exclusive right to such words, for the purpose of avoiding a conflict with the longer user of the other firm. If he has a concurrent right with the other firm, he must register without a disclaimer; if he has not, he cannot register the words at all: *In re Mecus*, (1891) 1 Ch. 41.

(e) See notes (n) and (o) to § 64 (3) (i); and *In re Apollinaris Co.*, (1891) 2 Ch. 186, 211.

(f) The intention of this sub-section is to introduce here the "Three Mark Rule," as to which see note (e) to § 72, *supra*. That rule is that registration of the same or substantially the same mark may be granted to not more than three persons, who can prove real user before August 13th, 1875, but that proof of user by more than three persons before that date debars all persons from registering. For there to have been "public user" by more than three persons, it would seem that the user by each must have been substantial (*In re Hodson & Co.*, 26 Sol. J. 43), and such as came or ought to have come to the knowledge of each of the others. But the marks used need not have been absolutely identical, nor in all cases on the actual goods: *In re Wragg*, 29 Ch. D. 551. It will be noticed that this sub-section only relates to old marks. In the case of new marks a second registration of the same device would not be granted under § 72, except by the consent of the previously registered proprietor, and a disclaimer might even then be required as a condition of his consent. User is not proved by the books of applications for registration, as the allegations therein contained are not proved: *Orr-Ewing & Co. v. Johnston & Co.*, 13 Ch. D. 434.

Effect of Registration.

Registration
equivalent to
public use.

75. *Registration of a trade mark shall be deemed to be equivalent to public use of the trade mark (a).*

[Application for registration of a trade mark shall be deemed to be equivalent to public use of the trade mark, and the date of the appli-

ation shall for the purposes of this Act be deemed to be, and as from the first day of January one thousand eight hundred and seventy-six to have been, the date of the registration (b).]

(a) The original § 75, for which the present section was substituted by § 17 of the Act of 1888, came from § 2 of the Act of 1875, the provision in which Act was made expressly subject to the existence of a connection with goodwill. This is not expressly stated in the present section, but must, in the view of the Court of Appeal, be implied, for the words registration of a trade mark shall be equivalent to public use of the trade mark "did not and could not mean that continued registration was equivalent to continued use": *per* Lindley, M. R., *In re Batt*, (1898) 2 Ch. 432. Registration does not entitle to an injunction in respect of goods for which the mark has not been used, though it has been registered for them, at all events unless the mark has been exactly copied: *Edwards v. Dennis*, 30 Ch. D. 454; *Hargreave v. Freeman*, (1891) 3 Ch. 39. And see *Apollinaris Co. v. Snook*, 7 P. R. 474; 8 P. R. 166. In the United States also registration is equivalent to public use. See *In re Dutcher Temple Co.*, U. S. Pat. Comm. Decis., 1871, 248. Apart from the legislation on the subject, public use of a trade mark gives a property in it. See *per* Lord Blackburn, in *Orr-Ewing v. Registrar of Trade Marks*, 4 App. Cas. 496. It has been decided that to constitute public use it is not sufficient for the marked goods to be advertised; they must be actually in the market. But so long as that is the case, length of user is not necessary. See *McAndrew v. Bassett*, 4 De G. J. & S. 380; *Maxwell v. Hogg*, L. R. 2 Ch. 307; *Wheeler v. Johnston*, 3 L. R. Ir. 284; *In re Simpson, Davies & Sons*, Jessel, M. R., Jan. 12th, 1881. And see the remarks of Chitty, J., on this section in *Barlow & Jones, Ltd. v. Johnson & Co.*, 7 P. R. 395, 404.

(b) The last part of this clause, as now altered, comes from Rule 32 of the Rules of 1883, and originally from the old rules. The principle that registration dated from the receipt of the application prevailed throughout. Now a slight alteration is made by substituting the date of the application for the date of the receipt of it.

76. The registration of a person as proprietor of a trade mark shall be *prima facie* evidence (a) of his right to the exclusive use (b) of the trade mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence (a) of his right to the exclusive use of the trade mark, subject to the provisions of this Act (c). Right of first proprietor to exclusive use of trade mark.

(a) This section comes from § 3 of the Act of 1875. Until the end of five years from registration the only effect of it is, as was said in the Court of Appeal in *Nuthall v. Vining*, C. A., Jan. 21st, 1880, to qualify the registered proprietor for suing infringers—in other words, registration is "simply a condition precedent to suing," *per* Chitty, J., in *Mouson & Co. v. Boehm*, 26 Ch. D. 398; and in *Barlow & Jones, Ltd. v. Johnson & Co.*, 7 P. R. 395, 405; *In re Hudson*, 32 Ch. D. 325; and see *Sen-Sen Co. v. Britten*, (1899) 1 Ch. 692; and it seems that when an action is brought to restrain an alleged infringement of a trade mark which has been registered for less than five years, the defendant may rebut the *prima facie* evidence of the plaintiff's right afforded by his registration, without moving to rectify the register by expunging the mark. See *In re Palmer* (1), 21 Ch. D. 47; *Lever v. Goodwin*, 4 P. R. 492; *Weaver v. Sanitary Engineering and Ventilation Co.*, L. J. N. of C., 1887, p. 144; *Weaver v. Stiff & Sons*, *ib.* After the expiration of five years from registration, the title of the registered proprietor is, for the purposes of an action for infringement, an absolute right, and cannot be disputed except upon an application under § 90 to rectify the register: *Edwards v. Dennis*, 30 Ch. D. 454; *Apollinaris Co., Ltd. v. Herrfeldt*, 4 P. R. 478. Compare *Evans v. Smith*, 3 Times L. R. 390, and *Bodega Co., Ltd. v. Owens*, 6 P. R. 236, where this principle does not appear to have had full effect given to it. This applies also to cases of colourable imitation, as well as to cases of direct copying: *Rodgers & Sons, Ltd. v. Rottgen*, 5 Times L. R. 678. The lapse of five years from registration is, however, no bar to proceedings brought for the purpose of rectifying the register. It seems that the description of goods given on registration is not conclusive: *Hargreave v. Freeman*, (1891) 3 Ch. 39. In *Apollinaris Co. v. Snook*, 7 P. R. 474, the validity of a registered trade mark Effect of registration.

was not allowed to be questioned in an action for infringement, there being no motion to rectify, but the fact that the mark had been registered for less than five years, so that the registration was only *prima facie* and not conclusive evidence of the right of the registered proprietor, does not seem to have been pointed out. The action was dismissed on appeal (see 8 P. R. 166), in consequence of the mark having been removed from the register in other proceedings, so that the decision of the Court of Appeal on the point here raised was not taken. The question came before the Court of Appeal in *Pinto v. Badman*, 8 P. R. 181, where a mark recently registered was alleged to have been infringed, and although there was no valid application to rectify, and the mark was, in fact, left on the register, yet the action was dismissed on the ground of want of title in the plaintiffs. Lord Esher, M. R., said (p. 189): "The 76th section of the Act says that the registration is *prima facie* evidence of the plaintiff's right to the exclusive use of the label, but it is only *prima facie* evidence. It follows that it can be met. That is not denied"; and Fry, L. J., said (p. 193): "It is undoubted that under the Statute of 1883, when a trade mark has been registered, it gives a *prima facie* title to the registered owner to sue for an infringement of it; but that right is *prima facie* only, and may be repelled by evidence of the defendant, or may be repelled by evidence which the plaintiff himself puts in." The view originally entertained as to the effect of this section, and the corresponding section of the Act of 1875 upon applications to rectify, appears to have been that during the first five years from registration the mark remained liable to removal from the register, *e.g.*, on application by the true proprietor of it, when it had been wrongfully registered in the name of another person, as in *Ex parte Lawrence Bros.*, 44 L. T. N. S. 98; *In re Australian Wine Co., Ltd.*, 61 L. T. N. S. 427; but that after the expiration of five years from registration the title of the registered proprietor was secure against individual rival claimants, but as "the Act only says that after five years the person who has registered a trade mark shall be entitled to the trade mark, but does not say that the mark as registered shall be deemed to be a trade mark"—see *per* Jessel, M. R., in *In re Palmer* (1), 21 Ch. D. 47; and compare the Victorian cases of *Lewis v. Klapproth*, 11 V. L. R. (E.) 214; *Wolfe v. Alsop* (2), 12 V. L. R. (E.) 421; *Wolfe v. Lang & Co.*, 13 V. L. R. 752—the trade mark remained liable to removal for inherent defects in it—*e.g.*, that it contained no one of the essential particulars specified by § 64. Thus in *In re Palmer* (1), 21 Ch. D. 47; and (3) 24 *ib.* 504, the words "Braided fixed stars," registered for matches, were expunged, on the ground that at the date of the registration and ever since they had been merely descriptive of matches prepared in a particular way. So where the word "Valvoline" had been registered, though it had been used as a descriptive term: *In re Leonard & Ellis*, 26 Ch. D. 288. And see *In re Ralph*, 25 Ch. D. 194; *In re Lloyd & Sons*, 27 Ch. D. 646; *In re Wragg*, 29 Ch. D. 551; *Wood v. Lambert*, 32 Ch. D. 247; *In re Spencer*, 54 L. T. N. S. 659. Since the case of *Edwards v. Dennis*, 30 Ch. D. 454, however, it has been generally recognized that § 90 (§ 5 of the Act of 1875) overrides the provisions of this section (§ 3 of the Act of 1875), and that even after the lapse of five years the registration of a mark which is for any reason wrongful may be rectified. In that case Cotton, L. J., said that "the third section (of the Act of 1875) is intended to afford assistance to a person who is bringing an action against another person for passing off his goods as the goods of the person who brings the action. In such a case, if the plaintiff shows that he has been on the register for five years, that dispenses with the necessity of his adducing evidence of exclusive use of his trade mark. But the third section is no bar to an application under the fifth section for rectification of the register, and in the case of such an application the Court is bound to consider whether the trade mark is properly on the register; for, although it may have been on for five years, if it ought not to have been on at all, then it can be taken off." And in this the other Lords Justices concurred. That there is no distinction for this purpose between the Acts of 1875 and 1883 was held by North, J., in *Baker v. Rawson*, 45 Ch. D. 519, 531. Where words common to the trade—*e.g.*, "Mandarin Tea"—have been registered in combination with a distinctive device, or in connection with a distinctive label, for upwards of five years, no exclusive right is thereby acquired in the words: *British Tea and Trading Association, Ltd. v. Cooke, Bacon*, V.-C., June 8th, 1886; *In re Wills*, (1893) 2 Ch. 262; and the same principle as to the lapse of five years has been applied in Scotland: *Cowie v. Herbert*, 14 P. R. 436; and a corresponding provision in the Victorian Act has received a similar construction: *Mitchell & Co. v. Joshua Bros.*, 17 V. L. R. 736. In *Lamplough v. Beedler*, C. A., Nov. 12th, 1880, it was held that the registered words "Pyretic Saline"

were purely descriptive. See *Reinhardt v. Spalding*, 49 L. J. Ch. 57; and *Wheeler v. Johnston*, 3 L. R. Ir. 284. In *In re Hayward & Co.*, 54 L. J. Ch. 1003, a note was entered on the register that in the case of a mark registered in 1885 the five years were to run from that date, and not from the date of the application, which was in 1879.

In the United States, registration only affords *prima facie* evidence of ownership (Act of 1881, § 7), and amounts to nothing more than a mere record of a claim: *Yale Cigar Manufacturing Co. v. Yale*, 30 U. S. Pat. Gaz. 1183; and it has been there held that registration of descriptive words confers no right in them: *Van Beil v. Prescott*, 82 N. Y. 630; and that the use of a registered mark may be restrained: *Glen Cove Manufacturing Co. v. Ludeman*, 23 Bl. C. C. 46; *Schumacher & Ettlinger v. Schwenke* (2), 36 U. S. Pat. Gaz. 457. In Canada it has been repeatedly held that registration can be invalidated by proof that the registered proprietor was not the first to use the mark: *McCall v. Theal*, 28 Grant Up. Can. Ch. 48; *Partlo v. Todd*, 12 Ont. Rep. 171; *Watson v. Westlake*, 12 Ont. Rep. 449. But it has also been held that, for this to be so, the user by others must have been before the registered proprietor used the mark, not merely before he registered it: *Smith v. Fair*, 14 Ont. Rep. 729. Under the Canadian Statute it has been held that registration gives no right of action for anything done before registration: *Morse v. Martin*, Quebec Super. Ct., Feb. 28th, 1882; but neither the Quebec Court of Queen's Bench (3 Dorion, 353) nor the Canada Supreme Court (Cassel's Dig. 509) decided the point. In New South Wales the right to registration depends, not on priority of application, but on priority of user: *Harris v. Ogg*, 5 N. S. W. Rep. (E.) 114; and although registration has been held to be from the outset conclusive proof of the right of the registered proprietor: *Walker v. Cargill*, 5 N. S. W. Rep. (E.) 243, the use of a registered mark has been restrained by injunction: *Harris v. Ogg*, 5 N. S. W. Rep. (E.) 114; *Bryant & May v. Heyde*, 7 N. S. W. Rep. (E.) 72.

(b) The right to the exclusive use of a trade mark, first asserted in *Gout v. Aleploglu*, 5 Leg. Obs. 495, and *Millington v. Fox*, 3 My. & Cr. 338, and after much discussion affirmed by the Chancery judges (see Ch. 6, *ante*), is now given by statute upon registration.

(c) See § 70 as to the connection with goodwill.

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

Restrictions on actions for infringement, and on defence to action in certain cases.

(a) This part of this section comes from § 1 of the Act of 1876. By § 1 of the Act of 1875, failure to obtain registration was fatal to the owner of a trade mark, whether old or new. The effect of the alteration introduced by the Act of 1876 was clearly explained by Lord Blackburn in the House of Lords in *Orr-Ewing v. Registrar of Trade Marks*, 4 App. Cas. 498, in which he said: "This alters the Act of 1875 in two respects: it renders registration a condition precedent to a proceeding to recover damages, as well as to a proceeding to prevent infringement; and it provides that if the proprietor of a trade mark in use before the passing of the principal Act has been refused registration, he may, notwithstanding such refusal, institute proceedings, either for prevention of, or damages for, the infringement of such trade mark, and need not wait till he has got the register rectified." And again he said: "It seems to me that the effect of the Act of 1876 is, that if one who says he is the proprietor of a trade mark wishes to institute proceedings against some one who, as he says, is infringing it, he must first try to have his trade mark registered. If the registration is refused for any reason, he may apply (under § 5 of the Act of 1875) to have the register rectified, and then the Court will have to determine as the principal question whether the reason of the refusal was sufficient. But he

Necessity for applying for registration.

may also seek for more speedy redress. He may obtain a certificate of the refusal, and then institute proceedings to prevent the infringement, and then the Court will have to determine whether he was the proprietor of the trade mark." See, also, *Malins, V.-C.*, in *In re Barrows*, 5 Ch. D. 353, 359, and *Twentsche Stoom Bleekery Goor v. Ellinger & Co.*, 26 W. R. 70. The present section differs from § 1 of the Act of 1876, in that by that section the alternative of registering or procuring a certificate of refusal was given to an owner of any old mark, whether the old mark was or was not capable of being registered, so that an owner of such a mark might safely be content with a certificate of refusal, however obviously wrong the refusal might be. In the present section it will be seen that this alternative is no longer given to owners of old marks capable of being registered. Such marks must now be registered or left unprotected. New marks which are incapable of being registered under § 64 need not apparently be either registered or refused registration. The effect of the present section is, as Fry, L.J., said, in *In re Hudson*, 32 Ch. D. 325, of § 1 of the earlier Act, to "put a fetter upon the right of suing" of the proprietor of a trade mark; and see *Mouson & Co. v. Boehm*, 26 Ch. D. 388; *Barlow & Jones, Ltd. v. Johnson & Co.*, 7 P. R. 395, 405; and *Sen-Sen Co. v. Britten*, (1899) 1 Ch. 692; and if the owner of a trade mark for which registration or refusal to register is required is unable, when suing an infringer, to produce a certificate of registration or of refusal to register, his remedy is barred: *Goodfellow v. Prince*, 35 Ch. D. 9; even though he has made application for registration, and has only failed to obtain it because of delay in the office (*Hazzopulo v. Kaufmann*, 23 Sol. J. 819); and where a trade mark is registered in the name of a foreign producer, an importer, even with an exclusive contract for the United Kingdom, cannot sue in his own name: *Richards v. Butcher* (1), 7 P. R. 288. In *Hart & Colley*, 44 Ch. D. 193, North, J., decided that a trade mark which had been registered for some only of the goods in a class could not be protected in respect of other goods in the same class for which it had not been registered, and this decision appears to be in accordance with the spirit of the Act. It has been held that where a mark has been properly registered under the Act, persons to whom it has been assigned with the goodwill are not precluded under this section from suing on it before transfer of the registration into their names: *Ihle v. Henshaw*, 31 Ch. D. 323; and see *Reveliere v. Gateley*, 89 L. T. (Journal), 314; and the same has been decided in Canada: *Carey v. Goss*, 11 Ont. Rep. 619.

It appears that there is nothing in this section to preclude, in the absence of registration, the granting of an injunction where the get-up of goods has been imitated: *Lever v. Goodwin*, 36 Ch. D. 1 (with which compare the Canadian case of *Smith v. Fair*, 14 Ont. Rep. 729); nor where special words have been imitated, apart from trade mark: *Sanitas Co., Ltd. v. Condy*, 4 P. R. 530; *Barlow & Jones, Ltd. v. Johnson & Co.*, 7 P. R. 395, 411, per Cotton, L. J.; nor where a distinctive name or mark has been imitated, under which the plaintiff's goods have become known in the market: *In re Sanitas Co., Ltd.*, 4 P. R. 533; *Rodgers & Sons, Ltd. v. Rottgen*, 5 Times L. R. 678; *Jay v. Ladler*, 40 Ch. D. 649; nor where the registered trade mark is usually placed with other matters on a label or wrapper: *Great Tower St. Tea Co. v. Langford & Co.*, 5 P. R. 66; *Ascough v. Johnson & Co.*, 3 Times L. R. 735; nor where spaces left blank in the trade mark as registered are in practice filled in: *Newman v. Pinto*, 4 P. R. 508, per Kekewich, J.; *Melachrino & Co. v. Melachrino Egyptian Cigarette Co.*, 4 P. R. 215; *M. Melachrino & Co. v. R. Melachrino & Co.*, Chitty, J., May 29th, 1888.

Under the Canadian statute it has been held that registration only qualifies for suing in respect of acts done after registration, and not in respect of earlier acts: *Morse v. Martin*, Quebec Super. Ct., Feb. 28th, 1882. But the point was not decided either by the Quebec Ct. of Q. B. (3 Dorion, 353) or by the Supreme Court of Canada (Cassel's Dig. 509); and in *Smith v. Fair*, 14 Ont. Rep. 729, it was held that the account granted in cases of infringement should not be limited to the period of registration, at all events where fraud was proved. In the last-mentioned case it was also held that a plaintiff who has failed in an action for infringement by reason of non-registration is not debarred by that fact from bringing a fresh action after he has effected registration. In California an exclusive right to the use of a name or trade mark cannot now be acquired without registration as provided by the State Code: *Whittier v. Dietz*, 66 Cal. 78.

By § 1 of the Act of 1875, as amended by § 1 of the Act of 1876, the disability for suing without registration was to begin from July 1st, 1877. The time thus allowed for registration was extended, in the case of marks used in respect of any

goods in Classes 23 to 35 ("textiles," by § 1 of the Act of 1877, and Orders in Council of Dec. 12th, 1877, and June 29th, 1878, to Dec. 31st, 1878); and in the case of marks used in respect of cotton piece goods, by further Orders in Council of Nov. 27th, 1878, and May 17th, 1879, to July 31st, 1879. Since the date last mentioned, a certificate of registration or of refusal to register has been a *sine qua non* in all cases within the Acts.

(b) See § 96, Rule 60, and Forms L. & T'. See, also, *per* Chitty, J., in *In re Normal Co., Ltd.*, 35 Ch. D. 231.

[77A. In an action for infringement of a registered trade mark (a) the Court or a judge may certify that the right to the exclusive use of the trade mark came in question; and if the Court or a judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or judge trying the subsequent action certifies that he ought not to have the same.]

Certificate as to exclusive use and costs thereon.

This new section was introduced by § 18 of the Act of 1888.

(a) This new provision for the benefit of trade mark owners does not seem likely to be of much use to them, inasmuch as it only provides for a certificate being given where the right to a trade mark has come in question in an action for infringement; whereas the right to a trade mark is almost invariably contested on a motion to rectify, and the result of the action follows the result of the motion. Kay, J., has held that this provision does not apply to such a case: *B. Edgington, Ltd. v. John Edgington & Co.*, 6 P. R. 513, and this appears to be so. In *Barlow & Jones, Ltd. v. Johnson & Co.*, 7 P. R. 395, 411, a certificate was given; also in *Apollinaris Co. v. Snook*, 7 P. R. 474; and in *Pinto v. Badman*, 8 P. R. 181, 186. It seems that a certificate granted under this section is unappealable. See *Pinto v. Badman*, 8 P. R. 181, 188; *Haslam Co. v. Hall*, 20 Q. B. D. 491.

Register of Trade Marks.

78. There shall be kept at the Patent Office a book called the Register of Trade Marks (a), wherein shall be entered the names and addresses of proprietors of registered trade marks, notifications of assignments and of transmissions of trade marks, and such other matters as may be from time to time prescribed.

Register of trade marks.

(a) The register of trade marks was previously kept under the authority of § 1 of the Act of 1875. As to entries in the register, see §§ 87, 91, and 92, and Rules 32—34, and 46—48, *infra*.

79.—(1.) At a time not being less than two months nor more than three months before the expiration of fourteen years (a) from the date of the registration of a trade mark, the comptroller shall send notice to the registered proprietor that the trade mark will be removed from the register unless the proprietor pays to the comptroller before the expiration of such fourteen years (naming the date at which the same will expire) the prescribed fee (b); and if such fee be not previously paid, he shall at the expiration of one month from the date of the giving of the first notice send a second notice to the same effect.

Removal of trade mark after fourteen years unless fee paid.

(2.) If such fee be not paid before the expiration of such fourteen years the comptroller may after the end of three months from the expiration of such fourteen years remove the mark from the register (c), and so from time to time at the expiration of every period of fourteen years.

(3.) If before the expiration of the said three months the registered proprietor pays the said fee together with the additional prescribed fee (*d*), the comptroller may, without removing such trade mark from the register, accept the said fee as if it had been paid before the expiration of the said fourteen years.

(4.) Where after the said three months a trade mark has been removed from the register for non-payment of the prescribed fee, the comptroller may, if satisfied that it is just so to do, restore such trade mark to the register on payment of the prescribed additional fee (*e*).

(5.) Where a trade mark has been removed from the register for non-payment of the fee or otherwise, such trade mark shall nevertheless, for the purpose of any application (*f*) for registration during *the five years* [one year] next after the date of such removal, be deemed to be a trade mark which is already registered [unless it is shown to the satisfaction of the comptroller that the non-payment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade mark].

(*a*) This section comes from the old rules. The amendments were made by § 19 of the Act of 1888.

(*b*) *I.e.*, £1. See First Schedule. Also Form X.

(*c*) The removal and its cause are to be recorded, under Rule 47.

(*d*) *I.e.*, 10s. See First Schedule. Also Form Y.

(*e*) *I.e.*, £1. See First Schedule. Also Form Z.

(*f*) The effect of this is that (under § 72) the comptroller cannot, for one year after a mark has been removed from the register, place another similar mark on the register for similar goods, except under the circumstances stated in the words added to the sub-section.

Fees.

**Fees for re-
gistration, &c.** 80. There shall be paid in respect of applications and registration and other matters under this part of this Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade (*a*); and such fees shall be levied and paid to the account of Her Majesty's Exchequer in such manner as the Treasury may from time to time direct.

(*a*) Under § 7 of the Act of 1875, these fees were fixed by the Lord Chancellor, with the assent of the Treasury. For the list of fees now fixed by the Board of Trade, see the First Schedule to the Rules. Also Rule 3. As to mode of payment, see Notice as to Fees, *infra*, p. 415.

Sheffield Marks.

**Registration
by Cutlers'
Company of
Sheffield
marks.**

81. With respect to the Master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called the Cutlers' Company), and the marks or devices (in this Act called Sheffield marks) assigned or registered by the Master, wardens, searchers, and assistants of that Company (*a*), the following provisions shall have effect:

(1.) The Cutlers' Company shall establish and keep at Sheffield a new register of trade marks (in this Act called the Sheffield register):

- (2.) *The Cutlers' Company shall enter (b) in the Sheffield register, in respect of cutlery, edge tools, or raw steel, and the goods mentioned in the next sub-section, all the trade marks entered before the commencement of this Act in respect of cutlery, edge tools, or raw steel and such goods in the register established under the Trade Marks Registration Act, 1875, belonging to persons carrying on business in Hallamshire, or within six miles thereof, and shall also enter in such register, in respect of the same goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the commencement of this Act, but which have not been entered in the register established under the Trade Marks Registration Act, 1875 (c).*
- [(2.) The Cutlers' Company shall enter in the Sheffield register, in respect of metal goods as defined in this section, all the trade marks entered before the first day of January one thousand eight hundred and eighty-nine, in respect of metal goods, either in the register established under the Trade Marks Registration Act, 1875, or in the register of trade marks under this Act, belonging to persons carrying on business in Hallamshire or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January one thousand eight hundred and eighty-four, but which have not been entered in either of the said registers (d).]
- (3.) An application for registration of a trade mark used *on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge*, [on metal goods] shall, if made after the commencement of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company (e).
- (4.) Every application so made (f) to the Cutlers' Company shall be notified to the comptroller in the prescribed manner (g), and unless the comptroller within the prescribed time (h) gives notice to the Cutlers' Company that he objects to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner (i):
- (5.) If the comptroller gives notice of objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the Court:
- (6.) Upon the registration of a trade mark in the Sheffield register the Cutlers' Company shall give notice thereof to the comptroller, who shall thereupon enter the mark in the register of trade marks; and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the comptroller on that day:
- (7.) *The provisions of this Act, and of any general rules made under this Act, with respect to application for registration in the register of trade marks, the effect of such registration, and the assignment and transmission of rights in a registered trade mark, shall apply*

in the case of applications and registration in the Sheffield register (j); and notice of every entry made in the Sheffield register must be given to the comptroller by the Cutlers' Company, save and except that the provisions of this sub-section shall not prejudice or affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register (k):

- [(7.) The provisions of this Act, and of any general rules made under this Act, with respect to the registration of trade marks, and all matters relating thereto, shall, subject to the provisions of this section, apply to the registration of trade marks on metal goods by the Cutlers' Company, and to all matters relating thereto; and this Act and any such general rules shall, so far as applicable, be construed accordingly, with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield Register, for the comptroller, the Patent Office, and the Register of Trade Marks respectively; and notice of every entry, cancellation, or correction made in the Sheffield Register shall be given to the comptroller by the Cutlers' Company: provided that this section shall not affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield Register (l).]
- (8.) Where the comptroller receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade mark used on *cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without cutting edge*, [on metal goods] he shall in the prescribed manner (m) notify the application and proceedings thereon to the Cutlers' Company (n):
- (9.) At the expiration of five years from the commencement of this Act the Cutlers' Company shall close the Cutlers' register of corporate trade marks, and thereupon all marks entered therein shall, unless entered in the Sheffield register, be deemed to have been abandoned:
- (10.) A person may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of two or more trade marks:
- (11.) A body of persons, corporate or not corporate, may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of a trade mark or trade marks (o):
- (12.) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal (p) to the comptroller, who shall have power to confirm, reverse, or modify the decision, but the decision of the comptroller shall be subject to a further appeal to the Court:
- (13.) So much of the Cutlers' Company's Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate

marks, that is to say, the fifth section of the Cutlers' Company's Act of 1814, and the provisions in relation to the recovery and application of the penalty imposed by such last-mentioned section contained in the Cutlers' Company's Act of 1791, shall apply to any mark entered in the Sheffield register (*g*).

- [(14.) For the purposes of this section, the expression "metal goods" means all metals whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal.
- (15.) For the purpose of legal proceedings in relation to trade marks entered in the Sheffield register a certificate under the hand of the Master of the Cutlers' Company shall have the same effect as the certificate of the comptroller.]

The amendments in this section were made by § 20 of the Act of 1888.

(*a*) As to the Cutlers' Company, the old Sheffield corporate marks, and the system which prevailed with respect to Sheffield marks under the Trade Marks Registration Act, 1875, see Appendix G., *infra*. The specified goods now form a much wider class than formerly. The present section provides for the closing of the old Cutlers' register, and the immediate establishment of a new one, which will be an exact duplicate of the general register, so far as it relates to marks used for the specified goods within the specified limits.

(*b*) Under this sub-section the Cutlers' Company are performing a mere ministerial act in registering marks which come within this sub-section, whether the marks are registered on the Company's own motion or on the application of a party claiming to be the proprietor of the marks, and there is no appeal from their action under sub-s. (12), nor any *locus standi* for an opposition to an application to them to register a mark under this sub-section, and they are directed to register marks within the sub-section for all the goods mentioned in the sub-section, though they may have been used for some only of those goods. And they are authorised to register, under this sub-section, marks which have been assigned by the proprietor on the Sheffield register to another, but which have not been surrendered by him to the Company and re-assigned by them to the assignee: *In re Lambert*, 5 P. R. 542; 6 *ib.* 344.

(*c*) By § 9 (6) of the Act of 1875, Sheffield corporate marks were allowed to be registered in the trade marks register in the same manner and upon the same terms and conditions in and upon which they might have been registered if they were not corporate marks. Under this provision it was held that where a corporate mark had been assigned by its proprietor, but had not been surrendered to the Company and re-assigned by them to the assignee, he must perfect his title with the Company before he could obtain registration under the Act: *In re Rabone*, Dig. 643. There was, however, no requirement for corporate marks to be registered.

(*d*) See form of application at end of Second Schedule to Rules, *infra*, p. 484.

(*e*) This sub-section relates to new marks not within sub-s. (2), and it appears that applications to register such marks may be opposed by other persons in the trade (*In re Lambert*, 5 P. R. 542, *per* North, J.); and that if the Cutlers' Company refuse to hear such opposition the opponent's proper remedy is by mandamus: *ib.* 6 P. R. 344, *per* Bowen, L. J. Applications under this sub-section are to be made in duplicate, accompanied by the prescribed fees and representations: Rule 56.

(*f*) This and the two next sub-sections relate to new marks: *In re Lambert*, 5 P. R. 542.

(*g*) By sending to the comptroller one copy of the application and two representations of the mark for each class, within seven days after receipt of the application: Rule 57.

(*h*) One month from the receipt by the comptroller of the notice from the Company: Rule 58 (1).

(*i*) The Company is to require the applicant to send the comptroller a wood block or electrotype, and the comptroller is to advertise the application as in other cases: Rule 58 (2).

(*j*) It appears that this first part of this sub-section relates to new marks only: *In re Lambert*, 5 P. R. 542.

(k) This latter part of this sub-section relates to all Sheffield marks, new or old: *In re Lambert*, 5 P. R. 542. See Rule 59, by which the proceedings at Sheffield are assimilated to those in London.

(l) It has been held that the company ought not to allow the register to be amended upon a change of name of the proprietor of a Sheffield mark without an order of the Court: *In re Burgon & Wilkinson*, 40 Sol. J. 336.

(m) By sending a copy of the official paper, with a note distinguishing the application: Rule 58 (3).

(n) In *In re Rosing*, 54 L. J. Ch. 975, the Company opposed the registration of a trade mark on the ground of similarity to a corporate mark, but, the objection failing in the Court of First Instance, were ordered to pay the costs of the motion. On appeal, however, the objection taken by the Company was supported.

(o) Compare Rule 41.

(p) This sub-section applies to all cases in which the Cutlers' Company have arrived at a decision, but not to cases in which the Company have performed a mere ministerial act—*e.g.*, by registering an old mark under sub-section (2), in which case there is no appeal: *In re Lambert*, 5 P. R. 542. For Form of Notice of Appeal, see Form W.

(q) These provisions are, shortly, that a counterfeiter may be fined not exceeding 20*l.* by a justice or justices of the peace, subject to an appeal to Quarter Sessions. See Appendix H., *infra*.

PART V.

GENERAL.

Patent Office and Proceedings thereat.

Patent Office. 82.—(1.) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office:

(2.) Until a new Patent Office is provided, the offices of the Commissioners of Patents of inventions and for the registration of designs and trade marks existing at the commencement of this Act (a) shall be the Patent Office within the meaning of this Act.

(3.) The Patent Office shall be under the immediate control of an officer called the comptroller-general of patents, designs, and trade marks (b), who shall act under the superintendence and direction of the Board of Trade.

(4.) Any act or thing directed to be done by or to the comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorised by the Board of Trade.

(a) This is in Southampton Buildings, Chancery Lane, W.C.

(b) Under the Trade Marks Registration Acts the registrar was at the head of the Registry Office.

Officers and clerks.

83.—(1.) The Board of Trade (a) may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the comptroller-general of patents, designs, and trade marks, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

(2.) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the

same and the other expenses of the execution of this Act shall be paid out of money provided by Parliament.

(a) The authority given by this section to the Board of Trade was formerly possessed by the Lord Chancellor, under § 7 of the Act of 1875.

84. There shall be a seal for the Patent Office, and impressions thereof shall be judicially noticed and admitted in evidence. Seal of Patent Office.

85. There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust expressed, implied or constructive (a). Trust not to be entered in registers.

(a) This section, so far as it relates to trade marks, comes from the old Rules. Under this section an order to rectify the register by adding to the registration of a trade mark a note stating that the user was restricted by an agreement of which the date only was given, was varied so that the terms of the agreement should appear on the face of the register (*In re Mitchell & Co.*, 28 Ch. D. 666); and in another case a similar agreement was allowed to be stated in the register so far as it restricted the goods on which a registered trade mark was to be used, but not so far as it regulated the manner of user or the way in which orders were to be executed: *In re De Otaluy*, W. N. 1886, p. 177. And the entry of such notes is not now regarded favourably.

86. The comptroller may refuse to grant a patent for an invention, or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality (a). Refusal to grant patent, &c. in certain cases.

(a) This is a new section, and, so far as it relates to trade marks, does not seem to carry much farther the provisions of § 6 of the Act of 1875, now re-enacted in § 73, *supra*, prohibiting the registration of a scandalous design as a trade mark.

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade mark, the comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design, or trade mark, in the register of patents, designs, or trade marks, as the case may be (a). The person for the time being entered in the register of patents, designs, or trade marks, as proprietor of a patent, copyright in a design, or trade mark, as the case may be, shall, subject to [the provisions of this Act and to] any rights appearing from such register to be vested in any other person, have power absolutely to assign (b), grant licences (c) as to, or otherwise deal with, the same, and to give effectual receipts for any consideration for such assignment, licence, or dealing. Provided that any equities in respect of such patent, design, or trade mark may be enforced in like manner as in respect of any other personal property (d). Entry of assignments and transmissions in registers.

The amendment in this section was made by § 21 of the Act of 1888.

(a) As to the mode of obtaining registration as a subsequent proprietor, see Rules 36—40 and Form K. Though § 4 of the Act of 1875 is not re-enacted, it seems that a subsequent proprietor will still, as regards his title to the trade mark, be in the same position as if his title were a continuation of the title of the first registered proprietor. In *In re Bryant & May, Ltd.*, 4 Times L. R. 675, a question was raised as to a title by assignment, and it was held that an agreement to assign the goodwill and trade marks was sufficient. Where a registered proprietor changes his name, the comptroller has power under this section to make the requisite alteration in the register, and it seems that if he refuses, the Court may interfere under § 90: *In re New Ormonde Cycle Co.*, (1896) 2 Ch. 520.

(b) A trade mark can be assigned only in connection with the goodwill of the business. See § 70, *supra*. Also *In re Wellcome*, 32 Ch. D. 213; and Ch. III. ("Transfer").

(c) The power of granting licences must not be exercised so as to deceive the public, *e.g.*, so as to authorise the use of the mark on inferior goods. Nor does a licence to use a trade mark give any right to the exclusive use of a part only of the mark, which part would not of itself be capable of registration: *Lewis's v. Goodbody*, 67 L. T. N. S. 194. See Ch. VII. The power of granting licences at all seems, in the case of trade marks, rather to conflict with § 70; the intention of which appears to be that only the person entitled to the goodwill shall have the right of using the trade mark.

(d) This proviso prevents the power of licensing from being used so as to defeat an agreement between former partners giving a restricted right to each to use the firm marks, such power being inconsistent with the purpose of the agreement: *Hanson v. Game, Harrison & Larner, Ltd.*, 9 P. R. 186.

Inspection of
and extracts
from registers.

88. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to [the provisions of this Act and to] such regulations as may be prescribed (a); and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee (b).

The amendment in this section was made by § 22 of the Act of 1888.

(a) This section is taken from the old Rules. See Rule 52 for the present regulations. The fee for inspection is 1s. for every quarter of an hour.

(b) See First Schedule.

Sealed copies
to be received
in evidence.

89. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, disclaimers and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all courts in Her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

Rectification
of registers by
Court.

90.—(1.) The Court may on the application (a) of any person aggrieved (b) by the omission without sufficient cause of the name of any person [or of any other particulars] (c) from any register kept under this Act, or by any entry made without sufficient cause in any such register (d), make such order for making (e), expunging (f), or varying (g) the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit (h).

(2.) The Court may, in any proceeding under this section, decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

(3.) Any order of the Court rectifying a register shall direct that due notice of the rectification be given to the comptroller (i).

This section comes from § 5 of the Act of 1875, but is in rather different terms. The amendment was made by § 23 of the Act of 1888.

Mode of pro-
cedure for
rectification.

(a) The register cannot be rectified on counterclaim, and it seems questionable whether it can be rectified in an action: *Pinto v. Badman*, 8 P. R. 181, 187, 190. See, however, *Pinto v. Trott*, 8 P. R. 173. The Act is silent as to the procedure to be followed upon an application to expunge a mark registered in the name of a person domiciled out of the jurisdiction, and it seems that if sufficient notice of the

nature of the application is given to the registered proprietor, the form of the notice is immaterial, but the usual course is to address the notice of motion to the comptroller only, and to send a copy of such notice to the registered proprietor with a letter informing him of the nature of the proceedings: *In re King & Co.*, (1892) 2 Ch. 462; *In re La Compagnie Générale d'Eaux Minérales et de Bains de Mer*, (1891) 3 Ch. 451; *In re Royal Baking Powder Co.*, 14 P. R. 425. It further appears that an application under this section is not subject to all the technical rules which apply to notices of motion, and therefore the alteration of the notice is a matter of detail, so that the striking out the name of the registered proprietor as respondent, or changing the date of the hearing, does not make it a new notice of motion requiring to be re-marked with the name of the judge in rotation. As a general rule the foreign proprietor who desires to appear on a motion for rectification will not be required to give security for costs: *In re La Société Anonyme des Verreries de l'Etoile* (1), 10 P. R. 290; but see *In re La Compagnie Générale d'Eaux Minérales et de Bains de Mer*, (1891) 3 Ch. 451.

(b) The first question on an application to rectify the register under this section is whether the applicant is or is not a "person aggrieved." This question usually has to be considered with reference to cases in which it is alleged that a mark which is on the register ought not to be there; and it has been said that in such cases "any person interested in the same trade as the registered proprietor" is a person aggrieved (*Rose v. Evans*, 48 L. J. Ch. 618); and that "the course of decision before the Act of 1883 was passed was that any person interested in the same trade might, without showing any special damage, be treated as a 'person aggrieved' by any improper or inaccurate registration": *In re Hayward & Sons*, 54 L. J. Ch. 1003. This principle was also acted on in *In re Edge*, 8 P. R. 207. That there must be some legal damage was laid down by Lord Selborne, C., in *In re Riviere*, 26 Ch. D. 48, where he pointed out that what was necessary to constitute a "person aggrieved" was that the thing complained of should be one of the grievances mentioned in the section, and that it should tend to his injury, to inflict upon him some damage, in a legal sense. Similarly, on the further hearing of the same case (53 L. T. N. S. 239), it was said by Fry, L. J., that "'any person aggrieved' means 'every person who will in reasonable probability suffer any injury or loss'—using those words in a legal and not in a sentimental sense—from the other persons claiming to use it": and *per Lindley, L. J. (S. C.)*, that the person must be aggrieved "in the sense of sustaining legal damage, either immediate or prospective." The question was much considered in the case of *In re Apollinaris Co.*, (1891) 2 Ch. 186, in which the Vichy Co. sought to expunge certain marks registered by the Apollinaris Co., and Fry, L. J., in delivering the judgment of the Court of Appeal said (p. 224), "Are the Vichy Co. persons aggrieved? Now we approach this question on the assumption, which is necessary, of course, to answer this question, that the trade mark was wrongly on the register, and further, with these two observations in the first place, that the question is merely one of *locus standi*, and in the second, that the words 'person aggrieved' appear to us to have been introduced into the statute to prevent the action of common informers or of persons interfering from merely sentimental motives, but that they must not be so read as to make evidence of great and serious damage a condition precedent to the right to apply. Further, we are of opinion that whenever one trader, by means of his wrongly-registered trade mark, narrows the area of business open to his rivals, and thereby either immediately excludes, or with reasonable probability will in the future exclude, a rival from a portion of that trade into which he desires to enter, that rival is 'an aggrieved person.' Again, if the effect produced, or likely to be produced, by the wrongful trade mark is not the exclusion, but the hampering, of a rival trader, that rival trader, again, is in our opinion a person aggrieved. A man in the same trade as the one who has wrongfully registered a trade mark, and who desires to deal in the article in question, is *prima facie* 'an aggrieved person.' This may be rebutted by showing that, by reason of some circumstances entirely independent of the trade mark, the person complaining never could carry on any trade in the article; but the burden of tendering such proof is on the man who claims the mark, and here that burden has not been discharged." That case was discussed in *In re Powell*, (1893) 2 Ch. 388, in which Bowen, L. J., says "persons who are aggrieved are persons who are in some way or other substantially interested in having the mark removed from the register, or persons who would be substantially damaged if the mark remained. It is very difficult to frame a nearer definition than that. In the *Apollinaris Case*, (1891) 2 Ch. 186, it was pointed out, not as a complete or exhaustive definition, that people would be aggrieved if they were in the same trade and dealt

"Person
aggrieved."

in the same article. To my mind, it is equally true that persons would be aggrieved if they are in the same trade, and might reasonably be expected to deal in the same article, though not prepared to prove at the moment that they had formed a clear determination to do so." *In re Powell* was affirmed by the House of Lords ((1894) A. C. 8), and Lord Herschell there said: "Wherever it can be shown that the applicant is in the same trade as the person who has registered the trade mark, and wherever the trade mark, if remaining on the register, would or might limit the legal rights of the applicant so that, by reason of the existence of the entry upon the register, he could not lawfully do that which, but for the appearance of the mark upon the register, he could lawfully do, it appears to me that he has a *locus standi* to be heard as a person aggrieved." And see *In re Talbot*, 11 P. R. 77. But an applicant, in order to show that he is a "person aggrieved," must show that in some possible way he may be damaged or injured if the trade mark is allowed to stand, the word "possible" being used in a practical sense and not fantastically: *per* Romer, J., approved by the Court of Appeal in *In re Wright, Crossley & Co.*, 15 P. R. 131: *ib.* 377. And where the mark sought to be removed is the name of the registered proprietor who has for many years carried on business under his own name, it can make no difference to an applicant having no right to the name that the name has been registered as a trade mark: *ib.* Where the grievance of the applicant is not that he can possibly be damaged by the particular entry on the register, but that he may be damaged by the respondent having any mark on the register, he is not a "person aggrieved": *per* Lindley, M. R., in *In re Wright, Crossley & Co.*, 15 P. R. 377. The observations of Lord Herschell in *In re Powell*, (1894) A. C. 8, do not justify the statement that the mere fact that a man is engaged in the same trade is sufficient to make him a person aggrieved. That is contrary to the principle of the decision in the House of Lords: *per* Rigby, L. J., *In re Wright, Crossley & Co.*, 15 P. R. 377.

Grievance by
use of the
trade mark in
legal proceed-
ings.

The commonest case is where the proprietor of a registered trade mark brings an action for infringement of it, and the defendant applies to have it removed from the register, on the ground that it never ought to have been placed there. In such cases it has been repeatedly held that the person sued is entitled to apply as a "person aggrieved": *In re Ralph*, 25 Ch. D. 194; *In re Leonard & Ellis*, 26 Ch. D. 288; *Lloyd & Sons v. Bottomley*, 27 Ch. D. 646; *In re Wragg*, 29 Ch. D. 551; *Edwards v. Dennis*, 30 Ch. D. 454; *Wood v. Lambert*, 32 Ch. D. 247; *In re Spencer*, 54 L. T. N. S. 659; *In re Lever*, Chitty, J., Dec. 3rd, 1886; *In re Towgood*, 4 P. R. 67; *In re Ainslie*, 4 P. R. 212; *In re Perry Davis & Son*, 5 P. R. 333; 15 App. Cas. 316; *Baker v. Rawson*, 45 Ch. D. 519, 529; *Richards v. Butcher* (2), (1891) 2 Ch. 522. In *In re Gianacis*, 6 P. R. 467, this was held to be so, though no relief was claimed in the action as for infringement of trade mark, seeing that the registration was set out in detail in the statement of claim, thus showing that it was intended to make some use of it. And in *Thompson v. Montgomery*, 41 Ch. D. 35, words registered as a trade mark were removed from the register on the application of a person who was restrained by the same judgment from using them, and Lindley, L. J., said that "it is the duty of the Court, where its attention is called to an improper entry upon the register, to rectify upon an application being made." A similar result was brought about in the Yorkshire Relish case: *Powell v. Birmingham Vinegar Brewery Co.*, (1894) A. C. 8; *Birmingham Vinegar Brewery Co. v. Powell*, (1897) A. C. 710. Somewhat similarly it was held in *In re Ainslie*, 4 P. R. 212, that the fact that the applicants for rectification had contracted with the proprietors of the registered words "Ben Ledi," to sell no whiskey but theirs under that name, did not prevent them from applying as persons aggrieved. Equally a person is aggrieved when the presence of a mark on the register is used by the registered proprietor to support an application for the registration of a fresh mark, which is opposed by the person aggrieved. This was the case in *In re Apollinaris Co.*, (1891) 2 Ch. 186, in which Fry, L. J., said (p. 229): "In our opinion, when one trader uses the fact of his registration as any part of his case against another trader in any legal proceedings, that second trader is aggrieved, and this is not the less so because that trader may have other means of defending himself. If the owner of the registered trade mark says to a defendant in a litigation 'I am the owner of this registered trade mark, and therefore you are doing me a wrong,' the person attacked ought to be at liberty to reply two things: first, 'You ought not to be on the register,' and secondly, 'Even if you ought, I have done you no wrong.' The completeness of the second line of defence ought not to preclude the attacked person from availing himself of the first. If I am assailed with the conclusion of a syllogism, I am at liberty, both in logic and in law, to defend myself by denying

both or either of the two propositions which are alleged in support of the conclusion, and I am aggrieved if I am unjustly deprived of that right. This liberty of defence is a matter of great importance to a litigant." In *In re Vignier*, 6 P. R. 490, the applicants were aggrieved, they having registered and used the word "Monopole" for champagne, and the respondents having registered the similar word "Monobrut." But where the alleged grievance consists in registering a mark which is not too similar to an earlier mark, there is no grievance: *In re Lambert*, 6 P. R. 344. In *In re Batt & Co.*, 6 P. R. 493, the applicants had used the word "Brymbo" on iron and steel, and the respondents had registered the words "The Brymbo Special" for the whole of Class 5, having used it only for tin-plates; and although the respondents offered to limit their registration to tin-plates, it was held that the applicants, being aggrieved by the registration as it stood, and the mark being bad in itself, it must come off altogether. There is no ground for thinking that only a person who is himself entitled to registration can be a person aggrieved (*In re Riviere*, 26 Ch. D. 48), and it is not impossible for a person who only carries on a foreign trade to be aggrieved by a wrongful registration. *Id.* If a registered proprietor becomes insolvent while proceedings to rectify his registration are pending, his representative in bankruptcy may be added as a respondent to the application for rectification: *In re Rowe*, 48 L. T. N. S. 388.

(c) These words, now inserted, remove the possibility of any question whether the Court is enabled under this section to direct any other entry than that of a name to be made. It has been decided that the Court has power to direct the correction of any entry which has been improperly made in the register, whether of a name or of a mark: *In re Arbenz*, 35 Ch. D. 248.

(d) With reference to the words "entry made without sufficient cause," it was said by Fry, L. J., in *In re Apollinaris Co.*, (1891) 2 Ch. 186, 234, 235, that: "The object of the statute is to protect trade marks, that is, marks placed on goods to indicate their origin, or their selection, or their importation, or some other trade qualification, and thereby to give information with regard to those goods to all persons trading in them. They are marks under which the trader trades. It may well be that in the case of new marks the intention to use as a trade mark may be presumed; but when it is apparent, as it is here, by the evidence and admissions at the bar, that there is no such intention, but that the registration is directed to a different end, then the entry has, within the meaning of § 90, been made without sufficient cause, and ought to be expunged." Further, it has been held by the Court of Appeal that these words are to be read, not as if they were "made without sufficient cause at the time of registration," but as including any entry at any time on the register without sufficient cause, however it got there: *In re Batt & Co.*, (1898) 2 Ch. 432.

(e) It seems that the Court has no jurisdiction to rectify the register under this section, unless some entry has been made in it; and it cannot rectify the register by directing a mark to be registered after it has been refused registration by the comptroller, except upon an appeal from the comptroller to the Board of Trade, referred by the Board to the Court under § 62: *In re Normal Co., Ltd.*, 35 Ch. D. 231. An application to register, which is opposed by another trader, is not an application to rectify under this section, but is governed by § 69: *In re Australian Wine Importers, Ltd.*, 41 Ch. D. 278. The jurisdiction to rectify by making an entry is, therefore, confined to small matters of detail.

Rectification by registration.

(f) On an application to remove a mark from the register, the question whether it was entitled to registration must be decided as at the date when registration was effected: *Wood v. Lambert*, 32 Ch. D. 247; *Barlow & Jones, Ltd. v. Johnson & Co.*, 7 P. R. 395, 400; *In re Apollinaris Co.*, (1891) 2 Ch. 186, 230; *In re Borril T. M.*, (1896) 2 Ch. 609. But see *In re Batt*, (1898) 2 Ch. 432. The burden of proof is upon the applicant for removal, but he may prove his case by the statements in or omissions from the evidence tendered on behalf of the registered proprietor: *In re Leonard & Ellis*, 26 Ch. D. 288; *Pinto v. Badman*, 8 P. R. 189. Consequently, if the mark is one which was inherently capable of being used as a trade mark, and the application for removal is based on an allegation that it was not used as a trade mark, but as a descriptive term, the burden of proving that it was not used as a trade mark is on the applicant. See *per Cotton, L. J.*, in *In re Leonard & Ellis*, 26 Ch. D. 288. And where a word was registered in 1878 as an old mark, and an application was made in 1889 to remove it from the register on the ground that it had not been used as a trade mark before 1875, and the original proprietor and his family were dead, and his successors in business failed to prove user of the

Rectification by removal.

Burden of proof.

word *per se* as a trade mark on the goods before 1875, though they proved user in various other ways before that date, Kay, J., while refusing to receive in evidence the statutory declaration made by the original proprietor on applying for registration, held that the applicants for removal after so great a lapse of time had not discharged the burden which rested on them, and that the mark could not be directed to be removed from the register: *B. Edgington, Ltd. v. J. Edgington & Co.*, 6 P. R. 513. "The Court is not bound, upon the application of an unmeritorious applicant, to displace an entry on the register which, on the face of it, is not illegal, because the original registration might have been opposed on the ground of prior user by a third person who never opposed it on any such ground, and who at the time of the motion to rectify has discontinued such user:" *per* Bowen, L. J., in *In re Paine* (2), (1893) 2 Ch. 567; and see *In re Wright, Crossley & Co.*, 15 P. R. 131, 377; though it seems that if the mark were in itself illegal or improper the Court would expunge the entry in the interests of trade whatever the demerits of the applicant: *In re Paine* (2), (1893) 2 Ch. 567. And see *In re Hill*, 10 P. R. 113; *In re Talbot*, 11 P. R. 77.

Comparison of marks.

Where it is sought to remove a trade mark from the register on the ground of its too great similarity to an earlier mark, it is necessary, when comparing the two marks, to take into consideration (1) the manner in which blanks left in the earlier mark as registered are filled in in practice; (2) the manner in which the parts common to the trade are arranged; (3) the opinion of the trade as to the probability of deception: *In re Christiansen*, 3 P. R. 54, in which Lopes, L. J., said, as to the second point: "In dealing with matters which are common to the trade, I think we must look at the combination of those different matters common to the trade, their collocation and arrangement, and if we find things that are common to the trade all inserted in a similar position, in a similar form, and in similar arrangements, so as to make the whole so similar as to be calculated to deceive, I think that is enough." As to the third point, see *Mitchell v. Henry*, 15 Ch. D. 181. It is, however, necessary, when making such a comparison, to deal with the two marks on the footing that both will be fairly used (*In re Lambert*, 6 P. R. 344, *per* Cotton, L. J.; *In re Kutnow*, 10 P. R. 401); and it is not a ground for expunging a mark that a fraudulent use might be possible: *In re Wright, Crossley & Co.*, 15 P. R. 131. In considering the probability of deception, the length of time during which a mark has been on the register is material: *In re Talbot*, 11 P. R. 77. And see notes to § 72. In determining whether an application to expunge should not be granted if an opposition to registration would have been successful, two things ought to be considered: (1) What was the reason of the delay in the application to expunge; (2) Has there been any substantial injury caused to the respondent through the application not having been made until after registration: *per* Romer, J., in *Eastman Photographic Materials Co. v. Griffiths Cycle Co.*, 15 P. R. 105, in which case a mark identical with a previous mark but registered in another class was ordered to be removed from the register on the ground that an opposition to registration would have been successful according to the principles laid down in *Eno v. Dunn*, 15 App. Cas. 252.

Cases of removal.

The cases in which marks have been removed from the register are numerous, and the grounds of removal may be classified as follows:—

- (i.) Name not printed in a distinctive manner (§ 64 (1) (a)): *In re Gianacis*, 6 P. R. 467 ("Gianacis Cigarettes"); *In re Hannay*, 7 P. R. 46 ("Hannay's Electroid Anti-fouling Composition"); *In re Edge*, 8 P. R. 207 ("Edge's Filtered Blue"); *Pirie v. Goodall*, (1892) 1 Ch. 42 ("Pirie's Parchment Bank" note-paper).
- (ii.) Device not distinctive, being in common use in the trade (§ 64 (1) (c)); *In re Wragg*, 29 Ch. D. 551 (Syphon, hand and glass).
- (iii.) Words not distinctive or fancy words, being in common use in the trade (§ 64 (1) (c), § 64 (3)): *In re Hyde & Co.*, 7 Ch. D. 724 ("Bank of England" sealing-wax); *In re Lloyd & Sons*, 27 Ch. D. 646 ("La Minerva Habana" cigars); *Great Tower St. Tea Co. v. Smith*, 6 P. R. 165 ("Tower Tea").
- (iv.) Words not distinctive or fancy words, being descriptive (§ 64 (1) (c), § 64 (3)): *In re Palmer* (3), 24 Ch. D. 504 ("Braided Fixed Stars" cigar-lights); *In re Harden Star, &c. Co., Ltd.*, 3 P. R. 132 ("Hand Grenade Fire Extinguisher"); *In re Stock*, 52 L. T. N. S. 123 ("Strathmore" whiskey); *In re Lever*, Chitty, J., Dec. 3rd, 1886, following *Lever v. Goodwin*, 36 Ch. D. 1 ("The Self Washer" soap); *In re*

Vaughan-Jones, North, J., June 21st, 1884 ("Glenlivet" whiskey); *In re Towgood Bros.*, 4 P. R. 67 ("The Jubilee" note-paper); *In re Ainslie*, 4 P. R. 212 ("Ben-Ledi" whiskey); *In re Laing*, L. J. N. of C. 1887, p. 102 ("Glengowrie Blend of fine old Highland Whiskey"); *In re Arbenz*, 35 Ch. D. 248 ("Gem" air-guns); *In re Waterman*, 39 Ch. D. 29 ("Reversi" game); *In re Perry Davis & Son*, 5 P. R. 333; 15 App. Cas. 316 ("Pain-Killer" medicine); *In re Davis & Co.*, 6 P. R. 207 ("Boköl" beer); *Humphries v. Taylor Drug Co.* (2), 5 P. R. 687 ("Herbalin" medicine); *Great Tower St. Tea Co. v. Smith*, 6 P. R. 165 ("Tower Tea"); *Burland & Co. v. Broxburn Oil Co., Ltd.* (2), 42 Ch. D. 274 ("Washerine" soap); *In re Vignier*, 6 P. R. 490 ("Monobrut" champagne); *In re Batt & Co.*, 6 P. R. 493 ("The Brymbo Special" metal goods); *In re Hannay*, 7 P. R. 46 ("Elephant" anti-fouling composition); *In re Apollinaris Co.*, (1891) 1 Ch. 186, 281 ("Apollinaris," "Richshall" and "Hunyadi János" mineral waters and products); *In re Edge*, 8 P. R. 207 ("Filtered Blue"); *In re Good*, (1892) 1 Ch. 42 ("Parchment Bank" note-paper); *In re Talbot*, 10 P. R. 281 ("Carnival" cigarettes); *In re Talbot*, 11 P. R. 77 ("Emolliolorum" saddle paste); *In re Banks & James*, 44 W. R. 32 ("Shakspeare" cigars); *In re Davis*, 14 P. R. 903 ("Compactum" umbrellas); *Meaby & Co. v. Triticine, Ltd.*, 15 P. R. 1 ("Triticumina" food); *In re Magnolia Metal Co.*, (1897) 2 Ch. 371, 391 ("Magnolia" metal).

- (v.) Words not being words having no reference to the character or quality of the goods (§ 64 (1) (c)): *In re Edge*, 8 P. R. 207 ("Filtered Blue"); *In re Talbot*, 11 P. R. 77 ("Emolliolorum" saddle paste); *In re Magnolia Metal Co.*, (1897) 2 Ch. 371 ("Magnolia" metal).
- (vi.) Words registered as old mark, but not used as a trade mark *per se* on the goods before 1875 (§ 64 (3)): *In re Palmer* (3), 41 Ch. D. 504 ("Braided Fixed Stars" cigar-lights); *In re Spencer*, 3 P. R. 73 ("Diamond Cast Steel"); *In re Hayward & Sons*, 54 L. J. Ch. 1003 ("Hayward's Ocker Canvas"); *In re Perry Davis & Son*, 5 P. R. 333; 15 App. Cas. 316; ("Pain-Killer Medicine"); *In re Eno*, 41 Ch. D. 439 ("Fruit Salt" medicine); *Thompson v. Montgomery*, 41 Ch. D. 35 ("Stone Ale"); *In re Powell* (2), (1893) 2 Ch. 388; (1894) A. C. 8 ("Yorkshire Relish"); *In re Gordon & Dilworth*, 13 P. R. 629 ("Tomato Catsup"); *In re Royal Baking Powder Co.*, 14 P. R. 225 (a label containing the words "Royal Baking Powder").
- (vii.) Device registered as old mark but not used as a trade mark *per se* on goods before 1875 (§ 64 (3)): *Baker v. Rawson*, 45 Ch. D. 519, 528. *In re Huet*, Kekewich, J., Dec. 6th, 1898, the mark was registered with a claim of user of 183 years, instead of three years, before 1875, and was expunged on that account.
- (viii.) Words registered as old mark, but used descriptively and not as a trade mark (§ 64 (3)): *In re Leonard & Ellis*, 26 Ch. D. 288 ("Valvoline" oil); *In re Harrison, McGregor & Co.*, 42 Ch. D. 691 ("Alison" tools); *Richards v. Butcher* (2), (1891) 2 Ch. 522 ("Monopole" champagne); *In re Powell* (2), (1894) A. C. 8 ("Yorkshire Relish").
- (ix.) A mark registered for goods for which it was not used or intended to be used (§ 65): *Edwards v. Dennis*, 39 Ch. D. 454 ("Neptune" brand metal goods); *In re Apollinaris Co.*, (1891) 2 Ch. 186 (mark for Friedrich's mineral water); *In re Batt & Co.* (2), (1898) 2 Ch. 492 (device of butterfly for food substances).
- (x.) Registered proprietor carrying on business before 1876, now repealed): *In re Ralph*, 25 Ch. D. 194 ("Hornsea" brand genuine).
- (xi.) Marks registered, though too numerous to name marks (§§ 69, 72): *In re Barker & Son*, 53 L. T. N. S. 32 (a repeating device in each case); *In re Christiansen*, 3 P. R. 54 (marks for loaves); *In re Hayward & Sons*, 54 L. J. Ch. 1003 ("Hayward's Ocker Canvas"); *In re Milkmaid*, 31 Ch. D. 454 ("Milkmaid" brand and "Dairymaid" brand condensed milk); *In re Biegel*, 4 P. R. 525 (three different devices for beer); *In re Vignier*, 6 P. R. 490 ("Monopole" and "Monobrut" champagne); *In re Batt & Co.*, 6 P. R. 493 ("Brymbo" and "The Brymbo Special" metal goods); *In re La Société Anonyme des Ferreries de l'Etoile*, (1894) 2 Ch. 26 (the device of a star and the words "Red Star Brand").

- (xii.) A mark identical with previous mark, but registered in another class, it being proved that the later mark was calculated to deceive (§§ 65, 69, 72): *Eastman Photographic Materials Co. v. Griffiths Cycle Co.*, 15 P. R. 105 ("Kodak" for cameras and for cycles).
- (xiii.) Marks inherently deceptive (§ 73): *In re Hayward & Sons*, 54 L. J. Ch. 1003 ("Sole Makers Extra Coker" canvas); *Wood v. Lambert*, 32 Ch. D. 247 ("Eton" cigarettes, made in London, but used with addresses in St. Petersburg and Constantinople); *In re Apollinaris Co.*, (1891) 2 Ch. 186, 233; *In re Wills* (2), (1893) 2 Ch. 262 (words "Trade Mark" used deceptively); *In re Hill*, 10 P. R. 113 ("Forrest" watches registered by a person having no connection with "Forrest" a London watchmaker).
- (xiv.) Mark registered by servant of owner: *Ex parte Lawrence Bros.*, 44 L. T. N. S. 98 (mark for printers' rollers).
- (xv.) Marks belonging to foreign producer registered by importer: *In re Apollinaris Co.*, (1891) 2 Ch. 186 (marks for Apollinaris, Friedrichshall and Hunyadi Janos mineral waters and products); *In re European Blair Camera Co.*, 13 P. R. 600 ("Bull's-Eye" cameras).

In some of the above cases the marks were not absolutely expunged, but some lesser step was taken: but in *In re Hill*, 10 P. R. 113, Chitty, J., considering the mark as a whole to be dishonest, ordered the whole mark to be expunged, although part of it was not objected to. Where a trade mark has been wrongly registered, it may be expunged forthwith, without waiting for the trial of an action to meet which the application is made: *In re Gianaclis*, 6 P. R. 467. Five years' registration is no bar to the removal of the mark: *Edwards v. Dennis*, 30 Ch. D. 454. And see cases in note to § 76.

Applications for rectification were refused on various grounds in the following cases: *In re Riviere*, 53 L. T. N. S. 237; *Mouson & Co. v. Boehm*, 26 Ch. D. 398; *In re Chorlton and Dugdale*, 53 L. T. N. S. 337; *In re James*, 33 Ch. D. 392; *In re Talbot*, 3 P. R. 276; *In re Lambert*, 6 P. R. 344; *In re B. Edgington, Ltd.*, 6 P. R. 513; *Barlow & Jones, Ltd. v. Johnson & Co.*, 7 P. R. 395; *In re Densham*, (1895) 2 Ch. 176; *In re Holt*, (1896) 1 Ch. 711; *In re Borril T. M.*, (1896) 2 Ch. 600; *Rowland v. Michell*, (1897) 1 Ch. 71; *Cowie v. Herbert*, 14 P. R. 436; *In re Wright, Crossley & Co.*, 15 P. R. 131, 377; *In re Clement & Cie.*, 16 P. R. 173; *Freeman Bros. v. Sharpe Bros. & Co.*, 16 P. R. 205.

In *In re Palmer* (2), 22 Ch. D. 88, when the Court of Appeal had decided that the fact of five years' registration was not a legal bar to an application to expunge a mark, they refused to stay the hearing of the case with the evidence till after the determination by the House of Lords of an appeal from their decision on the point of law. It seems that an appeal from a decision upon an application for the removal of a trade mark from the register will not be treated as an interlocutory appeal, but that the case must be heard by three judges: *In re Riviere & Co.*, 26 Ch. D. 48; *In re Leonard & Ellis*, *ib.* 288. Where a mark is registered in the name of a domiciled Scotchman, it has been held in Scotland that the Scotch Courts have jurisdiction to order its removal: *Cowie v. Herbert*, 14 P. R. 436. On the other hand, it has been held in Ireland that the Irish Courts have no jurisdiction to order any alteration or rectification of the register of trade marks, that being a special jurisdiction conferred on the High Court in England: *Bayer v. Connell*, (1897) 1 L.R. 544. And see note to § 111.

For Australian cases of removal from the register, see *In re Rowley & Pyne*, 9 V. L. R. (L.) 307, in which R. & P. had used a device of a horse and groom for twenty years, and D. and his predecessor in business had used a device of a horse alone for twelve years, and then R. & P. adopted and registered a device of a horse alone, and it was removed from the Victorian register on D.'s application; *Harris v. Ogg*, 5 N. S. W. Rep. (E.) 114, in which a mark which had been registered by a person who had not used it, was removed from the New South Wales register on the application of a person who had long done so. *In re Hicks*, 22 V. L. R. 636, in which a trade mark was removed from the Victorian register upon similar grounds; and *National Starch Manufacturing Co. v. Munn's Patent Maizena & Starch Co.*, 13 N. S. W. R. (E.) 101; (1894) A. C. 275, in which the name "Maizena" was removed from the New South Wales register on the ground that it had become *publici juris* at the date of registration.

Rectification
by varying.

- (g) The register has been rectified by varying an entry in the following ways:—
- (i.) By restricting the goods for which the mark is registered: *Edwards v. Dennis*, 30 Ch. D. 454; *In re Metcalf*, 31 Ch. D. 454; *In re Banks & James*, 12 P. R. 333; *In re Batt & Co.* (2), (1898) 2 Ch. 432.

- (ii.) By striking some part of the mark out of it: *In re Stock*, 52 L. T. N. S. 123 (word "Strathmore" struck out of a whiskey mark); *In re Vaughan-Jones*, North, J., June 21st, 1884 (word "Glenlivet" struck out of a whiskey mark); *In re Biegel*, 4 P. R. 525 (three-triangle device struck out of a beer mark). And see *Burland & Co. v. Broxburn Oil Co., Ltd.* (2), 42 Ch. D. 274.
- (iii.) By causing a partial disclaimer to be entered on the register, as in *In re Leonardt*, Dig. 610; *In re Mitchell* (2), Dig. 611; *In re Hubbuck*, Jessel, M. R., June 20th, 1879; *In re Kuhn & Co.*, 53 L. J. Ch. 238; *In re Johnson, Philpott & Co.*, North, J., Feb. 21st, 1888; *Humphries & Co. v. Taylor Drug Co.* (2), 59 L. T. N. S. 820; *Burland & Co. v. Broxburn Oil Co., Ltd.* (2), 42 Ch. D. 274; *Baker v. Rawson*, 45 Ch. D. 519, 534; *In re Edge*, 8 P. R. 207; *In re Steel*, Chitty, J., Jan. 12th, 1893; *In re Thompson*, 13 P. R. 35. See notes to §§ 72 and 74.
- (iv.) By directing an alteration in the name of the registered proprietor. It is however, very questionable whether this can be done, and when registration has been effected in accordance with the application, but the application was wrong in some respect, it seems that the Court will amend the register by expunging the entry, but not by varying it so as to make the registration stand in another name. Thus Hall, V.-C., said, in *In re Ward, Sturt & Sharp*, 50 L. J. Ch. 347: "I cannot rectify the register where no error has been committed. The term 'rectification' is only applicable to cases in which there has been some mistake or error in the registration. In other cases the applicant must follow the course laid down for cases of assignment or transmission." So in *Ex parte Lawrence Bros.*, 44 L. T. N. S. 98, Jessel, M. R., expunged the entry, and left the rightful owners of the mark to make a fresh application in their own names. So in *In re Farina* (4), 44 L. T. N. S. 99, he directed administration to be taken out to the estate of the deceased registered proprietor, and the administrator, when appointed, to assign to the rightful proprietor. In *In re Rust & Co.*, 44 L. T. N. S. 98, however, the same learned judge allowed a mark to be transferred from the name of an individual member of a firm, stated to be trading under the name of the firm, into the names of all the partners trading under the name of the firm. It appears to have been thought by Jessel, M. R., in *Ex parte Lawrence Bros.*, 44 L. T. N. S. 98, that it might not be impossible for the Court to transfer a registration from one name into another, if the registered proprietor has registered another's trade mark in his own name when he was actually employed by the true owner to register it for him, and was so the agent and trustee for the other. In that case there was no agency, and no such order was made; but in *In re Australian Wine Co., Ltd.*, 61 L. T. N. S. 427, where the sole consignee in England of the wine from certain Australian vineyards had registered the name of the vineyards as his own trade mark, but intending it to be for the benefit of the owner of the vineyards, an order transferring the mark into the name of the owner of the vineyards was made. In *In re Riviere*, 53 L. T. N. S. 237, however, the Court of Appeal seems to have been decidedly of opinion that such an order could not be made, and Cotton, L. J., said: "In my opinion, whatever might be the result of the application to strike the name of the French firm off the register, the other application ought not to be granted. Without saying that it is impossible to grant such an application as this in any case where one person is improperly on the register, and another person who is entitled to the trade mark wishes to be put on, yet, as a rule (and I do not know a case where there would be an exception), when any one applies in the first instance to be publicly registered as the proprietor of a trade mark, the requirements of the Act and Rules as to issuing advertisements and otherwise ought to be complied with. For there may be cases—and I can imagine them—where, although the person applying to strike a name off the register may be entitled to say, as against the person on the register, that he is improperly registered as owner of the trade mark, yet there may be persons, not present at the litigation, who have a right, as against the applicant, to rectify the register, and to say that such applicant is not himself entitled to be there

so as to prevent such third person from using the mark. I have thought it right to express my opinion on that part of the case at once." And Lindley, L. J., added: "If the applicants had succeeded in making out a case to remove the name of Riviere & Co., I do not think they would have been entitled to have themselves registered in respect of this mark. I think Mr. Stirling's observation is conclusive—that they could not have registered anew in respect of the old mark without advertising and taking the other steps required by the Act and Rules. I say that on behalf of the public." The same view was taken independently by Kay, J., in *In re Kingsford & Son*, 6 P. R. 413. The most expedient course to adopt in such cases, where the parties are friendly, is indicated by the case of *In re Wellcome*, 32 Ch. D. 213, where an agent had registered his foreign principal's mark in his own name, but for the benefit of the principal, and subsequently assigned the trade mark to the principal, and it was held that the assignment was an assignment in connection with the goodwill, within § 70, and ought to be registered. A similar course was directed by Stirling, J., following *In re Farina* (4), 44 L. T. N. S. 99, and distinguishing *In re Rust & Co.*, 44 L. T. N. S. 98, in *In re Greenlees*, 9 P. R. 93, where a member of a firm had erroneously registered the mark of the firm in his own name, the Court expressing its opinion that the comptroller ought to register the assignment. A very special order was made in *In re Avril*, Stirling, J., April 20th, 1888, in which persons to whom the registered proprietor of a trade mark had assigned her business and goodwill, with the right to use the trade mark, all for a limited period of six-and-a-quarter years, at the end of which period those rights were to revert to her, procured themselves to be registered as the proprietors of the trade mark in succession to their assignor; but, on her making complaint, they applied to the Court to restore the register to its previous condition, and it was accordingly ordered that the register should be rectified by removing their names as subsequent proprietors of the mark and re-entering the name of the original proprietor. In *In re Patent Plumbago Crucible Co.* (2), 7 P. R. 282, two trade marks were registered in 1879 as the property of the Patent Plumbago Crucible Co., an unregistered company. In 1882 the Company assumed the name of "The Morgan Crucible Co.," and in 1890 the marks were allowed to be transferred into the name of "The Morgan Crucible Co., formerly trading as the Patent Plumbago Crucible Co." And this case has been followed by Kekewich, J., in *In re Burgon & Wilkinson*, 40 Sol. J. 336; but the proprietor being in that case a registered company, the learned judge held that the words "originally called" should be substituted for the words "formerly trading as." The decision of Stirling, J., has, however, been questioned by North, J., in *In re New Ormonde Cycle Co.*, 13 P. R. 475, from which it seems that where a registered proprietor changes his name the application should be made under § 87, which see. In America a partner who registered in his own name a trade mark of the firm was ordered to assign to his partner an equal interest in it: *Taylor v. Bothin*, 5 Sawy. 584.

When a trade mark has been improperly registered, the register will be rectified on an application by a person aggrieved, even though, by reason of a change in the circumstances, or by the coming into operation of a new Act of Parliament, the registration might be immediately renewed, seeing that the public must have an opportunity of opposing the new application: *In re Apollinaris Co.*, (1891) 2 Ch. 186, 231. Compare *In re Riviere*, 53 L. T. N. S. 237.

(h) It has been held that opposed applications for the registration of trade marks are not within this section, and that the Court has no jurisdiction to give a successful opponent his costs of the proceedings in the Registry Office: *In re Australian Wine Importers, Ltd.*, 41 Ch. D. 278; following *In re Brandreth*, 9 Ch. D. 618. As to the costs of applications to remove marks, see Chap. VII. *sub fine*. Where the comptroller is served with notice of the application, as he now must be (Rule 49), and appears, his costs are usually ordered to be paid by the unsuccessful party.

(i) See Rule 46 and Form N. in the Second Schedule. The order is to be carried into effect by the comptroller (Rule 46), and to be made public, if he thinks fit (Rule 50).

91. The comptroller may (a), on request in writing, accompanied by the prescribed fee (b),—
- (a.) Correct any clerical error (c) in or in connection with an application for a patent, or for registration of a design or trade mark; or
- (b.) Correct any clerical error (c) in the name, style or address of the registered proprietor of a patent, design, or trade mark.
- (c.) Cancel the entry or part of the entry of a trade mark on the register (d): Provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on the register as the proprietor of the said trade mark (e).
- [(d.) Permit an applicant for registration of a design or trade mark to amend his application by omitting any particular goods or classes of goods in connection with which he has desired the design or trade mark to be registered.]

Power for
comptroller
to correct
clerical errors.

The amendment in this section was made by § 24 of the Act of 1888.

(a) In addition to the powers given by this section, the comptroller has authority, under Rule 48, to alter in the register the address of the proprietor of a trade mark (see Form M), and, under Rule 54, to allow amendments of documents.

(b) By the First Schedule the fee for altering address, or allowing correction of a clerical error, or cancelling the whole or part of an entry, or permitting amendment, is 5s.

(c) For form of request, see Form Q.

(d) This comes from the old rules. For form of application for cancellation, see Form O. In *In re Lysaght*, Dig. 623, a registration for all the goods in Class 5 was, on application by the proprietor, corrected by limitation to galvanized sheet iron only. In *Ex parte Sales, Pollard & Co.*, Dig. 620, the registered proprietors of a trade mark for snuff, consisting of the letters "S. P.," the initials of their firm, discovered that that mark had been for many years in common use in the snuff trade, though used originally by themselves, and procured the cancellation of the registration.

(e) See Rule 61, and for form of declaration see Form P.

92.—(1.) The registered proprietor of any registered trade mark may apply to the Court for leave to add to or alter (a) such mark in any particular, not being an essential particular (b) within the meaning of this Act, and the Court may refuse or grant leave on such terms as it may think fit.

Alteration
of registered
mark.

(2.) Notice of any intended application to the Court under this section shall be given to the comptroller by the applicant (c); and the comptroller shall be entitled to be heard on the application.

(3.) If the Court grants leave, the comptroller shall, on proof thereof (d) and on payment of the prescribed fee (e), cause the register to be altered in conformity with the order of leave.

(a) This section is taken from the old rules.

(b) For what is an "essential particular," see § 64, *supra*. The alteration of a mark in non-essential respects does not deprive a mark of the benefit of the period of user before the alteration: *In re Bryant & May, Ltd.*, 4 Times L. R. 675.

Alteration of
trade marks.

An important question which was raised for the first time in 1891, after the registration system had been in operation for sixteen years or thereabouts, and after many orders had been made by the Court by which alterations of various kinds in old marks, i.e., marks originally used before the date of the Act of 1875, were

Old Marks.

allowed, is how far, if at all, the provisions of this section authorize the alteration of old marks. In *In re Phillips*, (1891) 3 Ch. 139, it seems to have been suggested by Chitty, J., that old marks ought to remain on the register in the precise form in which they had been originally used; and in *In re Adams*, 9 P. R. 174, and *In re Henry Clay & Bock & Co.*, (1892) 3 Ch. 540, the same view has been taken by Kekewich, J. It is, however, to be noticed that the nature of the alteration desired in these cases, or, at all events, in the first two of them, was very serious, and might have had the effect of making a good mark out of a bad one, while, in the first case, it certainly would have resulted in depriving the public of the indication of a restricted claim which previously existed, and this was pointed out by Chitty, J., in the case referred to. From the list of orders given below it will be seen that Chitty, J., has allowed alterations of old marks in many cases, and Kekewich, J., in a few, so that it may perhaps be considered that the observations made in the cases above cited were intended to have special reference to the cases then before the Court, in which the alteration would have materially altered the marks there in question. This much is clear, that neither in § 92 itself, nor in Rule 35 of the Rules under the Act of 1875, from which this section is taken, is the power of the Court to permit alterations restricted in any way to new marks, that the great bulk of the marks to which the rule was applicable when it was made in 1875 were old marks, and that, as a matter of fact, the majority of the instances in which alterations were allowed, at all events, down to a comparatively recent date, occurred with reference to old marks. The old mark must, no doubt, be registered precisely as used, but when the mark has once been properly registered the Court has full power to permit it to be altered in non-essential particulars if the case appears to be a proper one for such an indulgence. It is suggested that the true principle is that no mark, whether old or new, should be allowed to be altered where the alteration, whether in a technically "essential particular" or not, would materially alter the nature or appearance of the mark, or make a good mark out of a bad, or possibly bad, one; but that when the proposed alteration is not open to such an objection there is no reason why the Court should not allow the alteration if it thinks fit, whether the mark be old or new.

Classes of alterations.

The Trade Marks Journal contains numerous instances of announcements of alterations in registered trade marks authorized by the Court, and a list of them is given at p. 380, distinguishing them as they refer to old and new marks respectively. In two or three cases the orders referred to do not appear to have been advertised in the Trade Marks Journal, the reason being that the applicants remained content with obtaining their orders and omitted to notify them to the office, so that the register has *de facto* continued unaltered. In the earlier years the registrar or comptroller was not represented on these applications, but it ought hardly to be assumed that the orders were made without proper consideration on that account.

It seems convenient to classify the orders made under the headings: (1) Alterations in the name or initials appearing on the mark; (2) alterations in respect of the word "limited" or abbreviations of it; (3) alterations in respect of the words "patent" or "trade mark" on the mark; (4) other alterations in respect of wording, type, &c., appearing on the mark; to which may be added (5) alterations made, not in the mark itself, but in the name of the registered proprietor of the mark.

Alterations in name on mark.

In several cases it has happened that a registered mark has contained the name of the proprietor of the mark, but that, on account of a subsequent change of ownership, it has become desirable that the name in the mark should be changed so as to correspond with the altered circumstances, and in such cases the Court has usually allowed the change to be made. Thus, in *In re Dewhurst*, February 23rd, 1878, March 19th, 1880, and July 9th, 1880, Jessel, M. R., allowed a number of marks in the cotton classes to be altered by substituting the names of the new proprietors for the names of the former proprietors, "Alexander Collie & Co." and "Balfour, Heugh & Co." But in one of these cases, in which the name of the former proprietor was printed in the form of a signature, so as to constitute an essential particular, the Master of the Rolls refused to allow the alteration. See also *In re Murphy & Co.*, 7 P. R. 163. In *In re Boord*, Mar. 25th, 1881, Jessel, M. R., allowed the registered proprietors of a mark for beer which contained a former name of their firm, "Swaine, Boord & Co.," in ordinary type, to remove the name from the mark, leaving the space vacant, and to add a note to the registration stating that the name of the person or firm for the time being entitled to the mark might, in practice, be inserted in the blank space. See, however, *In re Brown*, 11

P. R. 365. Again, in *In re Bass, Ratcliff & Gretton, Ltd.*, July 21st, 1882, Chitty, J., allowed the name of the above company to be substituted for "Bass & Co.," and in *In re Moeller & Schreiber*, Mar. 7th, 1888, Kay, J., allowed the initials of the existing firm, "M. & S.," to be substituted for other initials. The above were all old marks, and the same was the case in *In re Kirkpatrick*, Chitty, J., Feb. 21st, 1890, and *In re Brown*, Stirling, J., 11 P. R. 365. In *In re Henry Clay & Bock & Co.*, (1892) 3 Ch. 540, however, an old mark was not allowed to be altered by substituting the name of the new proprietors for the initials of the former owners. In the case of new marks alterations have also, in various instances, been authorized to be made in the name or initials on the mark. Thus, by substituting "N. W. T. S. A., Ltd." for "A. J. S. & Co., Ltd.": *In re National Wholesale Tea Supply Association, Ltd.*, 10 P. R. 164; "Stockowners' Meat Company," for "Graziers' Meat Export Company": *In re Stockowners' Meat Company of New South Wales*, 14 P. R. 733. And see list below.

In *In re Guinness, Son & Co., Ltd.*, 5 P. R. 316, the firm of Arthur Guinness, Son & Co. had registered an oval label bearing, with other words and a device of an Irish harp, the printed signature "Arthur Guinness, Son & Co.," and the goodwill having been subsequently assigned to a limited company called "Arthur Guinness, Son & Co., Ltd.," leave was given to alter the registered trade mark, which was an old one, by adding the word "Limited" in ordinary type, beneath the signature. The addition of the word "Limited" has in many similar cases been since permitted, the addition being sometimes made to a printed signature, as in *In re Burke*, W. N. 1891, p. 2, but more frequently to a name in ordinary print; and in *In re Bryant & May, Ltd.*, 4 Times L. R. 675, Stirling, J., said that such leave would be given as a matter of course. In *In re Adshedd*, Kekewich, J., Nov. 25th, 1892, the addition permitted was "& Co., Ltd.," and in several cases the abbreviation "Ltd." or "Ld." has been sanctioned, e.g., *In re Ind, Coope & Co., Ltd.*, Stirling, J., June 22nd, 1888; *In re Younger*, Stirling, J., June 22nd, 1888; *In re Macintosh*, Stirling, J., Nov. 29th, 1889; *In re Foster*, Chitty, J., July 25th, 1890, but more recently Stirling, J., has expressed himself unwilling to allow the addition of the word "Limited" in the form of any abbreviation, preferring that it should be printed at full length: *In re Robert Porter & Co.*, W. N. 1895, p. 102; *In re Hayward*, 13 P. R. 729. The objection seems to have been founded on the supposition that the wish for the addition proceeded from a desire to comply with the provisions of § 42 of the Companies Act, 1862, which does not provide for the use of any abbreviation of the word. It seems, however, reasonably clear that this section of the Companies Act has no application to the case of a trade mark, and if a company is desirous of using a trade mark which had been used by the firm which preceded it in business, but with the addition of "Ld.," there seems to be no reason in law why it should not do so. Then, if it wishes to have the registration altered so as to correspond with the actual form in which the mark is lawfully used, it is not very easy to see what substantial objection there can be to it. On the occasions of the alteration of the marks in *In re Ind, Coope & Co., Ltd.*, Stirling, J., June 22nd, 1888; *In re Younger*, Stirling, J., June 22nd, 1888; and *In re Orlando Jones & Co.*, 12 P. R. 278, the further addition was permitted of the words "This label is issued only by 'Ind, Coope & Company, Limited,' or 'Wm. Younger & Co., Limited, Brewers, Edinburgh,' or 'Orlando Jones & Co., Lim.' " In *In re Jones & Co.*, Chitty, J., July 20th, 1883, on the other hand, the word "Limited," which had been inserted by mistake, was allowed to be expunged.

Alterations in respect of word "Limited."

After the decision of the Court of Appeal in *In re Apollinaris Co.*, (1891) 2 Ch. 186, 233—235, that the presence in a trade mark of the words "trade mark," so placed as to be likely to mislead the public into the belief that a part only of the trade mark, and not the whole, was registered and claimed, was sufficient to vitiate the registration, an application was made by Messrs. Colman (*In re Colman*, (1891) 2 Ch. 403) for leave to alter, under § 92, a considerable number of trade marks registered by them, by striking out of each mark the words "trade mark," except in one case in which the mark was intended for use in France, and the words sought to be removed were "marque de fabrique." Kekewich, J., acceded to the application, making it a condition that the applicants should undertake to endorse on their original applications for registration, and enter on the register, a statement of the essential particulars of each mark, and a disclaimer of the exclusive right to the added matter, if any, to the satisfaction of the comptroller, with liberty to apply to the Court in case of difference. All the marks had been registered under the Act of 1883, so that the effect of the order was to place them on the same footing as if they

Alterations in respect of "Trade Mark," "Patent."

had been registered under the Act of 1888, in which case the conditions now imposed by the Court would have been enforceable by virtue of the amended § 64. No further application was made to the Court in the matter, the terms of the claims and disclaimers being arranged between the applicants and the comptroller. The terms so arranged were advertised in Vol. 16 of the Trade Marks Journal, at p. 813 (August 16th, 1891). In this case all the marks sought to be altered were, with two exceptions only, registered as new marks, *i.e.*, as not having been in use prior to the Act of 1875. In the case of the two old marks no conditions were imposed. The words "trade mark" were again allowed to be removed from new trade marks in which they appeared, by Stirling, J., in *In re Badische Anilin & Soda Fabrik*, July 3rd, 1891, and by Romer, J., in *In re Franklyn, Morgan & Davey*, July 17th, 1891. When the same application, however, was made in *In re Phillips*, (1891) 3 Ch. 139, Chitty, J., refused leave to remove the words "trade mark" on various grounds, one of which was that the trade and the public were entitled to have on the register the same indication of a restricted claim as previously. He also expressed the view that the mark, being an old mark, ought not to be altered; but, for the reasons stated in an earlier part of this note, it seems reasonable to suppose that this was only intended to apply to alterations of so serious a character as that here sought.

In two comparatively early cases—*In re Muntz*, Kay, J., Dec. 13th, 1883, and *In re Beanes*, Chitty, J., May 16th, 1884—the word "Patent" was allowed to be removed from trade marks, the vacant space being filled up in the first instance by the introduction of the words "Yellow Metal." The presence in a trade mark of the word "Patent" seems, however, to be even more material than that of the words "Trade Mark," and the decision of Kekewich, J., in *In re Adams*, 9 P. R. 174, in which he refused to allow the alteration of an old mark by striking out the word "Patent," which had been improperly used, does not seem to be open to question. In fact, it would seem that the application should have met the same fate even if the mark had been a new one.

Alterations in addresses.

In numerous other cases, some of old marks, some of new marks, as may be seen by the list below, alterations of various kinds have been allowed to be introduced into registered trade marks. Frequently such alterations have consisted in varying the address given on the mark, *e.g.*, *In re Walker*, Dig. 624, where a trade mark consisting of the letter "W," a crown, and the word "Netherton," was allowed to be altered by substituting "Dudley" for "Netherton." So, in *In re Dunn*, Hall, V.-C., Dec. 20th, 1880, "Middlesboro'" was substituted for "Wolsingham." In *In re Hargreaves*, Stirling, J., Jan. 11th, 1890, the address, "Heywood, Manchester," was struck out, and in *In re Kinahan*, North, J., Dec. 16th, 1891, "Guildford Street, York Road, Lambeth, London, S.E.," was substituted for "20, Great Titchfield Street, Oxford Street, W.," and other cases will be found in the list.

Alterations in wording.

In some cases descriptive words have been struck out of a composite mark, *e.g.*, *In re Skinner*, Jessel, M. R., Aug. 3rd, 1881; *In re Burke*, North, J., Jan. 13th, 1891; but in *In re Orlando Jones & Co.*, 12 P. R. 278, Stirling, J., while allowing the words "superior quality" to be added to a new mark, in which they had always in practice been used, only did so upon condition that the applicants should disclaim, not merely the added words, but all the common words in the mark, as in *In re Colman*, (1891) 2 Ch. 403. So, prices of goods have been removed: *In re Clarkson & Finlay*, Kay, J., April 5th, 1889; *In re Scott & Bowne*, Stirling, J., May 4th, 1896. In *In re British Tea & Trading Association, Ltd.*, North, J., Oct. 26th, 1886, the registered trade mark, which was an old mark, consisted of three sides of a wrapper for packets of tea, of which those on the right and left consisted of arrangements of Chinese words, and that in the centre of the head of a mandarin, with the words "The British Tea Association" above it, and below it the words "Imperial Mandarin Tea, imported direct from the Imperial district in China," and leave was given to alter it by substituting for the words "imported direct from the Imperial district in China" (which had never been used by the applicants themselves, and not by their predecessors in business since 1877) the words "This label is protected by registration as a trade mark." In *In re Reiss Brothers*, 5 P. R. 291, the registered mark consisted of a combination mark for cotton piece goods, which comprised various words and devices, including the applicants' name and address, "Reiss Brothers, Manchester," and the words "Grass Bleach, Best Quality." "Grass Bleach" was the name of a description of bleaching which had gone out of use, and leave was given to alter the word "Grass" to "Reiss," notwithstanding that another firm's combination mark, registered for similar goods, bore the name "Reiss & Co., Batavia," the remainder of the latter mark being quite dissimilar from the

applicants' mark. In one case—*In re Read*, Hall, V.-C., July 7th, 1881—the words "Dog's Head Bottling" were allowed to be substituted for "Bull Dog Bottling"; and in another case—*In re Smith*, Kay, J., Aug. 3rd, 1882—the whole of the mark, except the word "Glenlivet," was struck out, leaving that word to stand alone as the trade mark. But these two cases would hardly be followed now; e.g., in *In re Orlando Jones & Co., Ltd.*, 12 P. R. 278, Stirling, J., refused to alter a pictorial label by removing two curved lines common to the trade, but this was without prejudice to an application for the separate registration of the remaining portion of the label. However, in *In re Scott & Bowne*, May 4th, 1896, Stirling, J., allowed two side panels, in French and German, of a tripartite label to be struck out. In some cases, the size and arrangement of the printed matter on the label, or of some of it, have been altered, e.g., *In re Lazenby*, Malins, V.-C., Feb. 26th, 1880; *In re Durham Brick, Lime & Cement Co.*, 9 P. R. 422.

In *In re Ermen & Roby*, 4 P. R. 70, leave was given to alter a new mark on which were words in Russian, by changing a capital E from the English into the Russian character, and inserting the Russian word meaning "of" between "Roby" and "Manchester." Again, in *In re Le Coq* (Stirling, J., Dec. 19th, 1890), Russian words meaning "Deposited at the Department of Commerce and Manufactures," were allowed to be added between two circles which formed part of the mark, and a rim of two circular lines to be added to the outer circle. (But in *In re Orlando Jones & Co., Ltd.*, 12 P. R. 278, as stated above, two oval lines were not allowed to be removed from a new mark.) On the other hand, where an old trade mark contained words partly in Russian and partly in English characters, North, J., refused to allow the mark to be altered by turning the bulk of the words into Russian characters, and making certain additions to and omissions from the name and place of business of the proprietor, on the ground that the alterations, whether in essential particulars or not, were in very material respects as regarded the appearance of the marks: *In re Savin*, 13 P. R. 21.

In various instances the name entered in the register as that of the registered proprietor has been allowed to be altered under this section, usually on account of the name of the proprietor having been altered. Thus, in *In re Moet & Chandon*, Bacon, V.-C., Aug. 19th, 1882, "Chandon et Cie, successors to Moet & Chandon," was substituted for "Moet & Chandon"; in *In re Boott*, Kay, J., Dec. 21st, 1882, "Boott Cotton Mills" was substituted for "Boott Manufacturing Company"; in *In re Porous Plaster Co.*, Pearson, J., Feb. 6th, 1885, the words "trading as the Porous Plaster Co." were struck out; in *In re Patent Plumbago Crucible Co.*, 7 P. R. 282, "The Morgan Crucible Co., formerly trading as the Patent Plumbago Crucible Co.," was substituted for "The Patent Plumbago Crucible Co."; in *In re Milne & Co.*, Kekewich, J., April 15th, 1890, "James Virtue McEntire" was substituted for "Milne & Co."; in *In re Birmingham Wagon Co., Ltd.*, Chitty, J., Nov. 22nd, 1890, "The Birmingham Railway Carriage and Wagon Company, Limited," for "The Birmingham Wagon Co., Ltd."; in *In re National Wholesale Tea Supply Association, Ltd.*, 10 P. R. 164, the new name of the company for "Albert John Slaney, Ltd."; in *In re W. Wilkinson & Sons, Ltd.*, Kekewich, J., March 6th, 1896; 40 Sol. J. 336, "Burgess & Wilkinson, Limited," originally called "W. Wilkinsons & Sons, Ltd.," for "W. Wilkinson & Sons, Ltd."; in *In re Findlater, Mackie & Co.*, North, J., April 24th, 1896, "Findlater, Gamble & Co." for "Findlater, Mackie & Co." But in *In re New Ormonde Cycle Co.*, (1896) 2 Ch. 520, North, J., pointed out that the language of § 92 only refers to leave being given to add to or alter a mark, and the alteration of the name of the proprietor not being an alteration in the mark, he did not consider that he would be justified in treating the section as enabling him to sanction the alteration proposed, but he suggested that the comptroller might make the alteration under § 87.

For List of Cases, see next page.

(c) Notice must be given to the comptroller fourteen days before the application. See Rule 51.

(d) As to mode of notifying the order to the comptroller, see Rule 46 and Form N.

(e) *I. e.*, 10a. See First Schedule. Representations of the mark as altered are also to be supplied. See Rule 51.

List of Alterations of the Register sanctioned by the Court under Sect. 92.

I.—MARKS IN USE BEFORE THE 13TH AUGUST, 1875 (OLD MARKS).

(1) *Alterations in the Name or Initials appearing on the Mark.*

Name.	Date.	Judge.	Length of user before August, 1875.	Nature of order.
Re Dewhurst	Feb. 23, '78.	Jessel, M.R.	{ 9½ yrs. }	"G. & R. Dewhurst" substituted for "Alex ^r Collie & Co."
Re Dewhurst	Mar. 19, '80.	Jessel, M.R.	{ 5½ yrs. }	
Re Dewhurst	July 9, '80.	Jessel, M.R.	{ 9½ yrs. }	"G. & R. Dewhurst" substituted for "Alex ^r Collie & Co."
Re Dewhurst	July 9, '80.	Jessel, M.R.	{ 17 yrs. }	
Re Dewhurst	July 9, '80.	Jessel, M.R.	26 yrs.	"G. & R. Dewhurst" substituted for "Balfour, Hough & Co."
Re Boord	Mar. 25, '81.	Jessel, M.R.	21 yrs.	"Swaine, Boord & Co." removed from mark, and note added to the registration that the mark may be used with the name of the person or firm entitled inserted in the place left vacant.
Re Bass, Ratcliff & Gretton, Ld.	July 21, '82.	Chitty, J. ...	{ 20 yrs. }	"Bass, Ratcliff & Gretton, Ld." substituted for "Bass & Co."
Re Moeller & Schreiber	Mar. 7, '88.	Kay, J.	{ 18 yrs. }	
Re Moeller & Schreiber	Mar. 7, '88.	Kay, J.	1½ yrs.	"M. & S." substituted for "D. G. F. H."
Re Kirkpatrick	Feb. 21, '90.	Chitty, J. ...	3 yrs.	"& Sons" added after "Thomas Kirkpatrick."
Re Brown	May 25, '94.	Stirling, J. .	{ 30 yrs. }	"and Son" added after "E. Brown."
(11 P. R. 365.)			{ 5 yrs. }	

(2) *Alterations in respect of the Word "Limited," or Abbreviations of it.*

Re Jones	July 20, '83.	Chitty, J. ...	1 yr.	"Limited" struck out.
Re Guinness	May 11, '88.	Chitty, J. ...	13 yrs.	"Limited" added to signature.
(5 P. R. 316.)				
Re Ind, Coope & Co., Ld.	June 22, '88.	Stirling, J. .	{ 6 yrs. }	"Limited" added in some cases, "Ltd." in others. "This label is issued only by Ind, Coope and Company, Limited," in others.
			{ 9 yrs. }	
			{ 12 yrs. }	
Re Younger	June 22, '88.	Stirling, J. .	20 yrs.	Same as in <i>Re Ind, Coope & Co. Ld.</i>
Re Allsopp	July 6, '88.	Chitty, J. ...	13 yrs.	"Limited" added after name.
Re Schweitzer	Mar. 25, '89.	North, J. ...	7 yrs.	"Limited" added after name.
Re Macintosh	Nov. 29, '89.	Stirling, J. .	10 yrs.	"Ld." added after name.
Re Foster	July 25, '90.	Chitty, J. ...	{ 13 yrs. }	"Limited" added in some cases, "Ltd." in others.
			{ 1 yr. }	
Re Burke	Jan. 13, '91.	North, J. ...	{ 11 yrs. }	"Limited" added after signature.
(W. N. 1891, p. 2.)			{ 7 yrs. }	
Re Adshead	Nov. 25, '92.	Kekewich, J.	17 yrs.	"& Co., Ltd.," added after name.
Re Oakey	Aug. 26, '93.	North, J. ...	{ 20 yrs. }	"Limited" added after name.
			{ 15 yrs. }	
			{ 12 yrs. }	
			{ 10 yrs. }	
			{ 4 yrs. }	

LIST OF ALTERATIONS OF THE REGISTER—continued.

Name.	Date.	Judge.	Length of user before August, 1875.	Nature of order.
Re Day & Martin, Ld.	Aug. 2, '94.	Stirling, J. .	{ 75 yrs. } { 20 yrs. } { 5 yrs. }	"Limited" added in some cases, "Ltd." in others.
Re Jones (12 P. R. 278.)	Apr. 23, '95.	Stirling, J. .	{ 20 yrs. } { 10 yrs. }	"This label is issued only by Orlando, Jones & Co., Ld." added on marks.
Re Hayward..... (13 P. R. 729.)	July 24, '96.	Stirling, J. .	{ 86 yrs. } { 43 yrs. }	"Limited" added after name.

(3) Alterations in respect of Words "Patent" or "Trade Mark" on Mark.

Re Muntz	Dec. 13, '83.	Kay, J.	10 yrs.	"Yellow metal" substituted for word "Patent."
Re Beanes.....	May 16, '84.	Chitty, J. . .	{ 6 yrs. } { 5 yrs. }	"Patent" struck out.
Re Colman	Apr. 11, '91.	Kekewich, J.	13 yrs.	"Trade mark" struck out.

(4) Other Alterations in respect of Wording, Type, &c. appearing on Mark.

Re Walker	Aug. 6, '79.	Malins, V.-C.	3 mos.	"Dudley" substituted for "Nether-ton."
Re Lazenby	Feb. 26, '80.	Malins, V.-C.	15 yrs.	"Manufactory" and "Prepared by" struck out, and alterations made in type.
Re Smith	Aug. 3, '82.	Kay, J.	50 yrs.	The two circles and the plaid pattern on the inner circle struck out, leaving the word "Glenlivet" alone.
Re Hanson	June 2, '85.	Bacon, V.-C.	3 yrs.	Words "and Parisian relevé," also "et de relevé Parisien" and "agents" struck out.
Re British Tea & Trading Association.	Oct. 26, '86.	North, J. . .	4 yrs.	Words "This label is protected by registration as a trade mark" substituted for words "Imported direct from the Imperial District in China"
Re Bloxwich Iron & Steel Co., Ld.	Nov. 24, '87.	Chitty, J. . .	2 yrs.	"Bloxwich" substituted for "Birchills Hall."
Re Reiss	Apr. 11, '88.	North, J. . .	5 yrs.	"Reiss" substituted for "Grass."
Re Harris	Jan. 11, '89.	Stirling, J. .	3 yrs.	"Charles" and "& Co." struck out, and position of word "Calne" altered.
Re Schweitzer	Mar. 25, '89.	North, J. . .	7 yrs.	"10, Adam St., A&Zelphi," struck out.
Re Clarkson & Finlay.	Apr. 5, '89.	Kay, J.	24 yrs.	Prices of goods struck out of marks.
Re Kirkpatrick	Feb. 21, '90.	Chitty, J. . .	3 yrs.	"& Hindley Green n ^r Wigan" added after "Tyldesley, Manchester."
Re Lincoln, Bennett & Co.	Apr. 18, '90.	Chitty, J. . .	12 yrs.	"London" added.

LIST OF ALTERATIONS OF THE REGISTER—*continued.*

Name.	Date.	Judge.	Length of user before August, 1875.	Nature of order.
Re Melton & Co.	May 23, '90.	North, J. ..	8 yrs.	"& Co." added after name, "to the Queen" struck out, "the late" inserted before "Napoleon," "London" substituted for "194, Regent St.," and "Trade mark" substituted for "London."
Re Le Coq	Dec. 19, '90.	Stirling, J. .	40 yrs.	Russian words meaning "Deposited at the Department of Commerce and Manufactures" added between the two circles, and a rim of two circular lines added to the outer circle.
Re Burham Brick, Lime & Cement Co. (9 P. R. 422.)	July 22, '92.	Stirling, J. .	{ 9 yrs. } { 3 yrs. }	"Works" omitted after "Burham," also "Murston," and type of remaining words expanded.
Re Brown..... (11 P. R. 365.)	May 25, '94.	Stirling, J. .	{ 30 yrs. } { 5 yrs. }	Numerous alterations in addresses.
Re Day & Martin, Ld.	Aug. 2, '94.	Stirling, J. .	{ 75 yrs. } { 20 yrs. }	"Late" inserted before the address "High Holborn."
Re Foster	Mar. 22, '95.	North, J. ..	{ 13 yrs. } { 4 mos. }	"London" substituted for "27, Brook St., Bond St., London."

(5) *Alterations in Name of Proprietor of Mark.*

Re Moet & Chandon.	Aug. 19, '82.	Bacon, V.-C.	{ 40 yrs. } { 9 yrs. } { 4 yrs. }	"Chandon et C ^{ie} , successors to Moet & Chandon" substituted for "Moet & Chandon."
Re Boott	Dec. 21, '82.	Kay, J.	30 yrs.	"Boott Cotton Mills" substituted for "Boott Manuf ^g Co."
Re Australian Wine Co. (61 L. T. N. S. 427.)	Jan. 23, '85.	Chitty, J. ..	3 yrs.	"J. H. Symon and E. V. Joyner" substituted for "The Australian Wine Co."
Re Avril	Apr. 20, '88.	Stirling, J. .	3 yrs.	Names of Thomas Monckton and others, subsequent proprietors, removed, and name of "Louise Avril, widow," proprietor, restored.
Re Birmingham Wagon Co., Ld.	Nov. 22, '90.	Chitty, J. ..	19 yrs.	"Birmingham Railway Carriage and Wagon Company, Limited," substituted for "Birmingham Wagon Company, Limited."
Re Wilkinson	Mar. 6, '96.	Kekewich, J.	100 yrs.	"Burgon and Wilkinson, Limited," substituted for "William Wilkinson and Sons, Limited."
Re Findlater	Apr. 24, '96.	North, J. ..	2 yrs.	"Findlater, Gamble & Co." substituted for "Findlater, Mackie & Co."

LIST OF ALTERATIONS OF THE REGISTER—*continued.*

II.—MARKS NOT IN USE BEFORE THE 15TH AUGUST, 1875 (NEW MARKS).

(1) *Alterations in the Name or Initials appearing on the Mark.*

Name.	Date.	Judge.	Nature of order.
Re Bass, Ratcliff & Gretton, Ld.	July 21, '82.	Chitty, J. . .	"Bass, Ratcliff & Gretton, Ld." substituted for "Bass & Co."
Re May & Baker, Ld.	May 1, '91.	North, J. . .	"W. G. Baker," "R. C. Heath," "T. Tyrer," and "W. E. B. Blenkinsop" struck out.
Re National Wholesale Tea Supply Association, Ld. (10 P. R. 164.)	Apr. 11, '93.	Chitty, J. . .	"N. W. T. S. A. Ld." substituted for "A. J. S. & Co."
Re Explosives Co., Ld.	July 31, '96.	North, J. . .	"Explosives" substituted for "E. C. Powder."
Re Stock Owners' Meat Co. of N. S. W. (14 P. R. 733.)	July 9, '97.	Romer, J. . .	"Stock Owners' Meat" substituted for "Graziers' Meat Export."

(2) *Alterations in respect of the Word "Limited," or Abbreviations of it.*

Re Allsopp	July 6, '88.	Chitty, J. . .	"Limited" added after name.
Re Foster	July 25, '90.	Chitty, J. . .	"Limited" added in some cases, "Ltd." in others.
Re Burke (W. N. 1891, p. 2.)	Jan. 13, '91.	North, J. . .	"Limited" added after signature.
Re May & Baker	May 1, '91.	North, J. . .	"Limited" added after name.
Re Day & Martin, Ld.	Aug. 2, '94.	Stirling, J. . .	Do.
Re Salt	Nov. 23, '94.	North, J. . .	Do.
Re London Chemical Co., Ld.	Mar. 22, '95.	North, J. . .	Do.
Re Porter (W. N. 1895, p. 102.)	June 12, '95.	Stirling, J. . .	Do.
Re Scott & Bowne . . .	May 4, '96.	Stirling, J. . .	Do.
Re Hayward (13 P. R. 729.)	July 24, '96.	Stirling, J. . .	Do.
Re Thwaites	Dec. 10, '97.	Kekewich, J.	Do.

(3) *Alterations in respect of Words "Trade Mark" on Mark.*

Re Colman (1891) 2 Ch. 403.)	Apr. 11, '91.	Kekewich, J.	"Trade mark" and "Marque de Fabrique" struck out.
Re Badische Anilin & Soda Fabrik.	July 3, '91.	Stirling, J. . .	"Trade mark" struck out.
Re Franklyn, Morgan, & Davey.	July 17, '91.	Romer, J. . .	Do.

(4) *Other Alterations in respect of Wording, Type, &c., appearing on Mark.*

Re Dunn	Dec. 20, '80.	Hall, V.-C.	"Middlesboro'" substituted for "Wolsingham."
Re Read	July 7, '81.	Hall, V.-C.	"Dog's Head Bottling" substituted for "Bull Dog Bottling."
Re Skinner	Aug. 3, '81.	Jessel, M.R.	Words "containing phosphates of iron, lime, soda, &c., for nourishing and invigorating the brain and nerves" struck out.

LIST OF ALTERATIONS OF THE REGISTER—*continued.*

Name.	Date.	Judge.	Nature of order.
Re Ermen & Roby.... (4 P. R. 70.)	Dec. 21, '86.	Chitty, J. . .	A capital E altered from the English into the Russian character, and the word "of" in Russian inserted between "Roby" and "Manchester."
Re Hargreaves	Jan. 11, '90.	Stirling, J. . .	Address "Heywood, Manchester," struck out.
Re Burke (W. N. 1391, p. 2.)	Jan. 13, '91.	North, J. . .	Words "Refreshing, invigorating, and constituting an appetising tonic, while slightly stimulating. Easy of digestion. Specially selected and shipped only by" struck out.
Re Badische Anilin & Soda Fabrik.	July 3, '91.	Stirling, J. . .	"Fabrik Zeichen" struck out.
Re Kinahan	Dec. 16, '91.	North, J. . .	"Guildford Street, York Road, Lambeth, London, S.E.," substituted for "20, Great Titchfield Street, Oxford Street, W."
Re Day & Martin, Ld.	Aug. 2, '94.	Stirling, J. . .	"Late" inserted before "High Holborn, London," and "Commercial Road, Liverpool."
Re Foster	Mar. 22, '95.	North, J. . .	"London" substituted for "27, Brook Street, Bond Street, London."
Re Scott & Bowne....	May 4, '96.	Stirling, J. . .	Words "A reliable remedy for pulmonary diseases, coughs, colds, and general debility; contains the tonic and nutritive properties of these popular remedies in their fullest form, very pleasing to the taste, and easily digested, and is highly recommended by the medical faculty," substituted for words "A nutritive chemical food, contains all the tonic and nutritive properties of these valuable reconstructive agents, pleasing to the taste, easily digested, and is recommended and prescribed by physicians generally." "Price 2/6" struck out. Also two side panels in French and German struck out.

(5) *Alterations in Name of Proprietor of Mark.*

Re Porous Plaster Co.	Feb. 6, '85.	Pearson, J. . .	Words "trading as the Porous Plaster Co." struck out.
Re Patent Plumbago Crucible Co. (7 P. R. 282.)	Mar. 21, '90.	Stirling, J. . .	"The Morgan Crucible Company lately trading as" inserted before "The Patent Plumbago Crucible Co."
Re Milne.....	Apr. 15, '90.	Kekewich, J. . .	"James Virtue McEntire" substituted for "Milne & Co."
Re National Whole- sale Tea Supply Association. (10 P. R. 164.)	Apr. 11, '93.	Chitty, J. . .	"National Wholesale Tea Supply Association, Ld.," substituted for "Albert John Slaney and Co., Ld."

93. If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders, or causes to be produced or tendered, in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanour.

Falsification of entries in registers.

94. Where any discretionary power is by this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent (a).

Exercise of discretionary power by comptroller.

(a) See Rules 17--19 as to the exercise by the comptroller of his discretionary powers.

95. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers (a) for directions in the matter.

Power of comptroller to take directions of law officers.

(a) The Attorney-General or Solicitor-General for England. See § 117.

96. A certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be *prima-facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone (a).

Certificate of comptroller to be evidence.

(a) This section is somewhat modified from § 8 of the Act of 1875, by which the certificate of the registrar was made evidence. Now the certificate is to be *prima facie* evidence only.

By § 77, *supra*, the comptroller is authorised to grant a certificate of refusal to register an old mark (see Forms L and T¹), and by Rule 60 he *may* give a certificate, when required so to do, for the purpose of any legal proceeding or other special purpose, and on so doing *shall* specify on the face of it the purpose for which it is granted. See Forms R, S, and T¹.

See Instructions, *infra*, paragraphs 35—37, in which it is stated that the comptroller's certificate in relation to a trade mark is of four kinds, viz. :—

- (i.) For use in legal proceedings.
- (ii.) For use in applying for registration in foreign countries.
- (iii.) Of any application made and of proceedings thereon.
- (iv.) A certificate of refusal of a mark in use before the 13th August, 1875, and not registrable.

97.—(1.) Any application, notice or other document authorised or required to be left, made, or given at the Patent Office or to the comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

Applications and notices by post.

(2.) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post (a).

(a) See Rule 16.

98. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the Patent Office, shall fall on Christmas Day, Good Friday, or on a

Provision as to days for leaving documents at office.