

THE LAW
OF
TRADE MARK REGISTRATION.

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BY
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OF LINCOLN'S INN, BARRISTER-AT-LAW,
AUTHOR OF "THE LAW OF TRADE MARKS," ETC., ETC.

SECOND AND ENLARGED EDITION.

INCLUDING
AN INTRODUCTION TO THE LAW OF TRADE MARKS AND
PASSING OFF, THE TRADE MARKS ACTS, 1905—1919,
AND WAR AND PEACE LEGISLATION.

BY
THE AUTHOR
AND
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PREFACE

TO THE SECOND EDITION.

—◆—

THIS is a new and enlarged edition of the writer's work on "The Law of Trade Mark Registration under the Trade Marks Act, 1905," published in 1906. The Fifth Edition of the larger work on "The Law of Trade Marks" was published in 1911, bringing the subject up to that date. Pending the issue of a further edition of the larger work, which has been unavoidably delayed, and may not be possible for some time to come, it has been felt that the present work was required for the purpose of dealing with the Trade Marks Act, 1919, and also of bringing the elucidation of the Act of 1905 up to date.

The Act of 1919 introduces a new species of registration, granted under less exacting conditions and conferring less valuable rights than registration under the principal Act, and regard must now be had to this Act in considering questions relating to registration. Certain problems are also likely to arise, at any rate temporarily, out of the special War and Peace legislation. The present work is intended to deal with these matters, and includes, in addition

to the annotated Acts, an Introduction in which the main outlines of Trade Mark Law are reviewed, and a number of Appendices containing other matters of importance.

The cases reported up to February, 1922, are referred to, so that it is hoped that the book will be found to contain all that is essential at the present time. References are given to the last edition of the larger work, which can be consulted when necessary.

It is due to Mr. BRAY to state here that most of the spade work has been done by him, and that any merit which new features of the book may be thought to possess should be mainly attributed to him. Mr. HENRIQUES has also given much valuable assistance.

L. B. S.

LINCOLN'S INN,

April, 1922.

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Braided Fixed Stars	Palmer's T. M.
Brazilian Silver	Daniel <i>v.</i> Whitehouse.
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Camel Hair Belting	See Reddaway.
Capstan Closets	Freeman <i>v.</i> Sharpe.
Carlsbad Salts	Kutnow's T. M.
O.B. Corsets	See Bayer.
Century	Printing Machinery Co.'s Appn.
Chartreuse	Rey <i>v.</i> Lecouturier.
Chocaroons	Williams' Appn.
Classic	Sharp <i>v.</i> Solomon.
Club Soda	Cochrane <i>v.</i> MacNish.
Colonel) Colonial)	St. Mungo Manufacturing Co. <i>v.</i> Viper, &c. Co.

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Cowslip Brand	Mueder's T. M.
Crystal Palace Fireworks ...	Brock v. Pain.
Cyclostyle	Gestetner's T. M.
Dairy Maid Milk	Anglo-Swiss Condensed Milk Co. v. Metcalf.
Demos	Do Maid's Appn.
Diabolo	Philippart v. Whiteley.
Diamine	Cassella's Appn.
Dolly Blue	See Edge.
Dog's Head Beer	Read v. Richardson.
Dome Black Lead	James' Appn.
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Erect Form	Weingarten v. Bayer.
Elephant	Johnston v. Orr-Ewing.
Eton Cigarettes	Wood v. Lambert and Butler.
Eureka Shirts	Ford v. Foster.
Evening News	Outram v. London Evening Newspaper Co.
Evening Post	Borthwick v. Evening Post.
Everybody's Magazine	Ridgway v. Amalgamated Press, Ltd.
Excelsior White Soap	Braham v. Bustard.
Filtered Blue	Edge's T. M.
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Glenfield Starch	Wotherspoon v. Currie.
Gnidroc	Cording's Appn.
Golden Fan Brand	Dewhurst's Appn.
Golden Fleece	Australian Wine Importers' T. M.
Goupil Gallery	Boussod, Valadon & Co. v. Marchant.
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K. M. S.	Boake Roberts v. Wayland.
Kodak	See Eastman, Kodak.

MARK OR NAME.	TITLE OF CASE.
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Lacto-bacilline	Société le Ferment's Appn.
Lawson Tuit	Whitfield Bedsteads, Ltd.'s Appn.
Limit	Smith's Appn.
Los Alambardores	Van der Leeuw's Appn.
Maizena	National Starch Co. <i>v.</i> Munn's Patent Maizena Co.
Marcella Cigars	Imperial Tobacco Co. <i>v.</i> Purnell.
Muttamae	Pearson <i>v.</i> Valentine.
Muzawattoe	Densham's T. M.
Mendine	Coombe <i>v.</i> Mendit.
Milkmaid Brand	See Anglo-Swiss Milk Co.
Monopole	Richards <i>v.</i> Butcher.
Morning Post	Borthwick <i>v.</i> Evening Post.
Motorine	Cie. Industrielle des Petroles' Appn.
Mottate	Fox & Co.'s Appn.
Multigraph	Kenrick and Jefferson's T. M.
Ogee	Garrett's Appn.
Orb Footballs	Spalding <i>v.</i> Gamage.
Oswan Towels	Barlow <i>v.</i> Johnson.
Oswego	National Starch Co.'s Appn.
Paraffin Oil	Young <i>v.</i> Macrae.
Perfection	Crosfield's Appn.
Primus	Hjorth's Appn.
Prince of Wales' Feathers...	Imperial Tobacco Co.'s T. Ms.
Quaker Spirits	Ellis & Co.'s T. M.
Red Star Glass	Soc. des Verreries de l'Etoile's T. M.
Regimental Cigarettes	Imperial Tobacco Co. <i>v.</i> de Pasquali.
Ribbon Dentifrice	Colgate's Appn.
Savonol	Field <i>v.</i> Wagel.
Seecotine	McCaw <i>v.</i> Nickols.
Silverpan	Faulder <i>v.</i> Rushton.
Slip-on	Burberrys <i>v.</i> Cording.
Solio	Eastman & Co.'s Appn.
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Two Elephant Yarn	Johnston <i>v.</i> Orr-Ewing.

<u>MARK OR NAME.</u>	<u>TITLE OF CASE.</u>
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Vaseline	Chesbrough Co.'s T. M.
Victor	Massachusetts Saw Works' Appn.
W. & G.	Du Cros' Appn.
Wineacenis	Coleman <i>v.</i> Stephen Smith & Co.
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THE LAW OF TRADE MARK REGISTRATION.

GENERAL INTRODUCTION.

Section 1.—The Foundations of Trade Mark Law.

The jurisdiction of the Courts in respect of trade marks is derived from three sources, the Common Law, the Principles of Equity, and Statutory Enactments. This last source of authority dates from the passing of the Trade Marks Registration Act, 1875, and the scope and effect of the legislative provisions now in force can only be properly understood if the function of a trade mark and the rights to which the use of such a mark give rise independently of the statutes are clearly appreciated.

Sources of the
Courts'
authority.

The function of a trade mark is to give to a purchaser or possible purchaser an indication of the trade source from which the goods come, or the trade hands through which they pass on their way to the market (a). Where, therefore, a trader has been in the habit of marking the goods which he supplies with a particular mark, so that thereby persons purchasing goods of that description know them by the mark to be his goods, if any other trader were to adopt the same mark, he would substantially be representing his goods to be those of the trader who had previously adopted the mark. By so doing he would or might deceive the public, and also damage the other trader by depriving him of the profit on sales of his goods which the purchaser intended to buy, or by injuring his reputation if the goods passed off were of inferior quality, or, even if actual deception did not result, by reducing the value of the trade mark as a guide by which intending purchasers could recognise his goods.

Function of a
trade mark.

(a) *Per Bowen, L. J., in Powell's T. M. (1893), 10 R. P. C. 195, p. 200.*

Origin of the
Common Law
action.

The Courts of Common Law found a means for giving some redress to a trader injured in this manner by adapting to the case the form of action well known as an action upon the case for deceit. The early history has been described by Mellish, L. J. :—
“Originally, I apprehend, the right to bring an action in respect of the improper use of a trade mark arose out of the Common Law right to bring an action for a false representation, which, of course, must be a false representation made fraudulently *b*. It differed from an ordinary action for false representation in this respect, that an action for false representation is generally brought by the person to whom the false representation is made; but in the case of the improper use of a trade mark, the Common Law Courts noticed that the false representation which is made by putting another man’s trade mark, or the trade name of another manufacturer, on the goods which the wrongdoer sells, is calculated to do an injury not only to the person to whom the false or fraudulent representation is made, but to the manufacturer whose trade mark is imitated; and therefore the Common Law Courts held that such a manufacturer had a right of action for the improper use of the trade mark. Then the Common Law Courts extended the doctrine one step further, first, if I recollect rightly, in the case of *Sykes v. Sykes &c.* There it was held that although the representation was perfectly true as between the original vendor and the original purchaser, in this sense, that the original purchaser knew perfectly well who was the real manufacturer of the goods, and therefore was not deceived into believing that he had bought goods manufactured by another person, yet if the trade mark was put on the goods for the purpose of enabling the purchaser, when he came to resell the goods, to deceive any one of the public into thinking that he was purchasing the goods of the manufacturer to whom the trade mark properly belonged, then that was equally a deception, a selling of goods with a false representation which would give the original user of the trade mark a right of action *d*. That was the Common Law right” *c*.

(b) *E.g.*, *Croesby v. Thompson* (1812), 4 Man. & G. 357.

(c) (1833), 3 B. & C. 541; and see *per* Lord Blackburn in *Singer Manufacturing Co. v. Loog* (1882), 8 A. C. 15.

(d) This would be, in the words of Wood, V.-C., in *Faring v. Silverlock* (1855), 1 K. & J. 509, “scattering over the world the means of enabling parties to commit frauds upon the plaintiffs.”

(e) *Singer Manufacturing Co. v. Wilson* (1876), 2 Ch. D. 434, 453.

It is possible that this right was recognised as early as the reign of Queen Elizabeth (*f*) ; it was at any rate established in 1833, when a decision was given which indicates a marked departure from the rules governing the ordinary action for deceit. In *Bloufield v. Payne* (*g*), the jury found that the defendant's goods, which had been sold in the plaintiff's wrappers, were not inferior to the plaintiff's goods, and awarded only nominal damages of one farthing. It was argued that judgment should be entered for the defendant, since actual damage was of the essence of the action for deceit. This argument was rejected, Littledale, J., saying: "The act of the defendant was a fraud against the plaintiff; and if it occasioned him no specified damage, it was still to a certain extent an invasion of his right."

Progress in
the Common
Law Courts.

This decision provokes two questions:— 1. If the plaintiff's cause of action is the invasion of a right, is there any reason for limiting the action to those cases in which the invasion is proved to be fraudulent? 2. What is the real nature of this "right" which was held to have been invaded? These questions were already in process of solution by the Courts of Equity at the time when the decision was given.

In those Courts it had long been the practice to give protection to suitors by granting an injunction to restrain the commission or continuance of certain wrongful acts, and it was soon perceived that this remedy was particularly appropriate to cases of improper use of trade marks. At first such cases were treated on the same principles as they were at Common Law, and redress was refused where actual intentional fraud was not alleged and substantiated (*h*). But in 1838, in *Millington v. Fox* (*i*), the fact was recognised that when goods made by one man were put upon the market bearing the mark of another, the same evil effects were produced, whether the mark was so affixed for fraudulent purposes or with innocent intentions, and Lord Cottenham granted an injunction, although he stated in express terms that he saw no reason for thinking that there had been any fraudulent use.

Proceedings
in Equity.

(*f*) See *per* Dodderidge, J., in *Southern v. How*, as reported in Popham, 144; the report in Cro. Jac. 471 differs.

(*g*) (1833), 4 B. & Ad. 410.

(*h*) See *per* Lord Langdale, M. R., in *Perry v. Truett*, 6 Beav. p. 73.

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

Proof of fraud unnecessary.

The first of the questions suggested above as the result of the Common Law decisions was thus answered in the negative, and it has for long been settled that a trader who proves that a particular mark is distinctive of his goods can obtain an injunction to restrain another from using upon goods of the same description the same or a similar mark in a manner likely to deceive the public, whether fraudulent intention is proved or not (*k*).

Nature of the right invaded.

The second question—what is the nature of the right which is invaded?—has been the subject of some controversy among high authorities, those on the one side maintaining that there is a right of property, and that it is the need to protect such property which prompts the intervention of the Court (*l*), those on the other side denying or doubting the existence of property in a trade mark, and tracing the action of the Court to the need for suppressing conduct which, if not fraudulent in its inception, becomes fraudulent if persisted in after notice of the possibility of deception being caused thereby (*m*).

The controversy examined.

This controversy may seem academic, but it is of real importance on account of the light which it throws on the true nature of trade mark rights. The solution of the controversy would appear to lie in observing that each party has sought to isolate one of two aspects of the same wrongful act and, in doing so, has used language capable of misconstruction. Thus the probability that deception will result from the use of a mark by the defendant is unquestionably essential to the cause of action, but it is equally essential that the plaintiff in an action for infringement should prove that the deceptive mark is understood as indicating *his* goods, and not merely those of a third party (*n*). The first point shows that persistence

(*k*) *Singer Manufacturing Co. v. Wilson* (1877), 3 A. C. 376, at p. 391; *Edelsten v. Edelsten* (1863), 1 De G. J. & S. 185.

(*l*) *Leather Cloth Co. v. American Leather Cloth Co.* (1863), 4 De G. J. & S. 137, per Lord Westbury, at p. 142; *Ransome v. Graham* (1882), 51 L. J. Ch. p. 900, per Bacon, V.-C.

(*m*) *Perry v. Truefitt* (1843), 6 Beav. 66, per Lord Langdale; *Collins Co. v. Brown* (1857), 3 K. & J. 423; *McAndrew v. Bassett* (1864), 33 L. J. Ch. 561, per Page Wood, V.-C., at p. 563, 564; *Reddaway v. Banham*, (1896) A. C. 199, per Lord Herschell, at p. 209.

(*n*) *Richards v. Butcher* (1890), 7 R. P. C. 288; *Pinto v. Bulman* (1891), 8 R. P. C. 181; *Dental Manufacturing Co. v. de Trey* (1912), 29 R. P. C. 617; and see *Lery v. Walker* (1879), 10 Ch. D. at p. 448; and, as to the case of a mortgagee who does not intend to use the mark, *Beazley v. Soares* (1882), 22 Ch. D. 660.

in the conduct complained of after knowledge of the result will be fraudulent; but as the action for infringement will succeed without proof of such knowledge, it would seem illogical to treat fraud as the foundation of the action. The second point shows that no relief will be given unless the plaintiff proves association of the mark with a business which is *his*. The expression "his" involves the notion of some form of property, and the criticism which has been levelled against the view that the protection of property is the motive of the Court's intervention would seem to be due to a looseness of expression which appears to identify that property with the mark itself (*o*). A Common Law mark itself is in no sense property; that which is damaged by the misuse of a trade mark, and which is accurately described as being property, is the goodwill of the business with which the trade mark is associated (*p*).

What is goodwill? "It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation, and connection of a business. It is the attractive force which brings in custom It is very difficult to say that goodwill is not property. It is bought and sold every day. It may be acquired, I think, in any of the different ways in which property is usually acquired. When a man has got it he may keep it as his own. He may vindicate his exclusive right to it, if necessary, by process of law. He may dispose of it if he will—of course, under the conditions attaching to property of that nature" (*q*). "If goodwill is not property, it is difficult to say what is" (*r*).

Clearly the association between a business and a trade mark which enables a purchaser to recognise the goods emanating from that particular business is one of the "attractive forces which brings in custom." The existence of such a mark is, therefore, essentially an element which enhances the value of the goodwill

(*o*) Thus the Act of 1905 refers to a person as claiming to be the "proprietor" of a trade mark, an expression which may not be inapt to the case of a right conferred by statute in the nature of a monopoly, but is likely to lead to misconception in the case of Common Law trade marks.

(*p*) See *Spalding v. Gamage* (1915), 32 R. P. C. at p. 284; 35 R. P. C. at pp. 113, 117; *Burberry's v. Cording* (1909), 26 R. P. C. at p. 701.

(*q*) *Inland Revenue Commissioners v. Muller & Co.'s Margarine, Ltd.*, (1901) A. C. 217, per Lord Macnaghten, at p. 223.

(*r*) *Potter v. Inland Revenue Commissioners* (1854), 10 Exch. 147, at p. 154.

of a business. But the value derived from the trade mark is dependent upon the fact that its use conveys a representation that the goods emanate from a particular business. Hence it may be perceived that the two propositions, viz.: that the Court intervenes to protect the plaintiff's property, and that it only intervenes when the defendant's conduct involves misrepresentation, both follow from the inherent nature of trade mark rights (s).

Conclusion.

The conclusion which thus emerges is the inseparable connection between trade mark rights and the goodwill of a business. This conclusion might indeed have seemed to be obvious, but in spite of legal decisions of long standing (t), and in spite of express provisions in the Trade Marks Acts to prevent the separation of the statutory rights from the goodwill of the business which the marks are used to indicate (u), the misapprehension persists that a trade mark is something which may be bought and sold without regard to the representation which it conveys (x). It cannot, therefore, be too clearly emphasised that, although under the statute some rights can be obtained by registration, the mere adoption of a badge by a trader gives rise to no right to monopolise it (y). Its use by another trader, however morally objectionable, is only actionable when such use is proved to involve a representation as to trade origin (z), a condition which assumes the existence of the goodwill of a business which is the property of the plaintiff.

(s) See *per* Lord Westbury in *Leather Cloth Co. v. American Leather Cloth Co.* (1863), 4 De G. J. & S. at p. 111. Although, in general, the jurisdiction to protect property may be considered as concerned only with property in this country, and will undoubtedly be exercised according to the law of this country (*Rey v. Lecouturier* (1910), 27 R. P. C. p. 280; *Pinto v. Badman* (1891), 8 R. P. C. p. 192), it does not necessarily follow that when there is no goodwill here the Court cannot prevent conduct in this country intended to result in sales which will be deceptive abroad. See *Collins v. Brown* (1857), 3 K. & J. 423, though some of the expressions used in that case cannot be regarded as authoritative. As to what may amount to goodwill in this country, see *Panhard v. Panhard* (1901), 18 R. P. C. 405; *Magnolia Metal Co.'s T. M.* (1897), 14 R. P. C. p. 628; and contrast *Neuchatel Co.'s Appn.* (1913), 30 R. P. C. 349.

(t) *E.g.*, *Hull v. Barrows* (1863), 4 De G. J. & S. 150.

(u) Trade Marks Act, 1905, s. 22.

(x) As to the limits of assignability, see *Pinto v. Badman* (1891), 8 R. P. C. 181, and p. 72, *post*; and as to attempts to grant a licence, see p. 9.

(y) See *Singer Manufacturing Co. v. Looy* (1882), 18 Ch. D. at p. 412; and cf. cases of a mere intention to use: *Maxwell v. Hogg* (1867), L. R. 2 Ch. 307; *Civil Service Supply Assn. v. Deam* (1878), 13 Ch. D. 512.

(z) *Batty v. Hill* (1863), 1 H. & M. 264.

Such was the legal position before legislation was introduced. It involved some hardship upon traders in two respects. It was necessary, before protection could be obtained, to prove by evidence that the use of the mark conveyed a representation to the public, a process often of difficulty, and usually involving considerable expense, and one which had to be repeated whenever an action was brought. Further, there was no recognised source from which a trader selecting a mark to indicate his business could ascertain what marks had already been adopted. Hence he might involve himself in useless expense or litigation by adopting, in ignorance, the mark of another trader.

Unsatisfactory position before legislation.

The principal object of the legislation introduced was to remedy these two defects. A register was established, and registration of a mark conferred upon the person registered as "the proprietor" a certain limited monopoly in the use of the mark. The conditions of the monopoly were designed to assure to the proprietor, without the necessity of proving that the mark in fact distinguished his goods, approximately the rights which, on giving such proof, he could previously have established in the Courts. Registration was not compulsory but, in addition to the positive advantages afforded by the registration, it was provided that an action *for infringement* could not be instituted unless the mark was registered (*a*). The result of this prohibition was soon shown to be not entirely satisfactory. In order to prevent the indiscriminate monopolisation of marks, more especially words and names, the categories of registrable marks had been strictly limited, with the result that many marks which were in fact distinctive could not be registered. The hardship involved in the case of owners of such marks was partly met by an amending Act, which allowed an action for infringement to be brought in respect of marks used as trade marks before the passing of the Act of 1875, the registration of which had been refused (*b*). But the real protection of unregistered marks was secured by the exercise of the power of the Court to prevent the passing-off of spurious goods as genuine by the use of a mark which, though not registered, in fact distinguished the genuine goods of the trader who had adopted the mark as his trade mark. This power was expressly reserved by the Act of 1905 (*c*).

Main objects of legislation.

(*a*) Trade Marks Act, 1875, s. 1.

(*b*) Trade Marks Act, 1876, s. 1; and see now sect. 42 of the Act of 1905.

(*c*) Sect. 45. A limitation on the right has, however, been imposed by sect. 6 of the Act of 1919; see p. 111.

Infringement
and passing-
off.

In a passing-off action, if the plaintiff can prove that the defendant is using a mark which, by reason of its resemblance to the mark used by the plaintiff, is calculated to lead to the defendant's goods being passed off as the plaintiff's, he can obtain the same relief as in the case of an infringement of a registered mark. Consequently, the restriction imposed upon bringing an action for infringement, though it has led to the term "infringement" being usually confined to the action based upon the statutory title, is of less practical importance than might appear. The old rights in respect of unregistered marks still exist, but they must be enforced by an action for "passing-off" (see pp. 13 *et seq.*). As a matter of precaution, in view of possible attacks on the validity of the registration, a claim for passing-off is generally added in an action for infringement.]

Statutory and
non-statutory
rights.

Although liberal extensions in the categories of marks for which registration may be obtained have led to a much larger number of marks being registered, it is none the less a fact to be constantly borne in mind that the legislation does not cover the whole field of trade mark law, and that the statutory and non-statutory rights exist together. Nor must the two be confused. The latter are founded on first principles, and the sources from which they can be ascertained are the judicial decisions and the logical consequences to be deduced therefrom. The former are essentially artificial rights, to be ascertained from the Acts of Parliament as interpreted by the Courts. To determine the rights of the parties to any dispute, it is generally necessary to examine both. The present work is mainly devoted to an examination of the statutory provisions, but in this introductory section and in those which follow, an attempt is made briefly to summarise the main principles of the old law, so far as may be necessary for the understanding of the new, and to point out the distinctions between the two.

Section 2.- What is a Trade Mark?

Definition.

At Common Law no exhaustive definition of a trade mark was necessary; if a mark distinguished the goods of one trader so as to be calculated to deceive when used on similar goods by another trader, the Common Law rights attached to it without reference to what the character of the mark might be. But with the advent

of legislation establishing a register of trade marks to which statutory privileges attached, some definition of what might be registered became necessary. The earlier Acts did not actually define a trade mark, but contained an enumeration of "essential particulars," one of which a mark must possess in order to be registrable, and a special provision for certain marks in use before the Act of 1875. The Act of 1905, whilst including a similar, though wider and simplified enumeration (*d*), introduced a definition of a trade mark for the purposes of the Act in the following terms (*e*):—"A trade mark shall mean a mark (*e*) used or proposed to be used upon or in connection with goods for the purpose of indicating that they are the goods of the proprietor of such trade mark by virtue of manufacture, selection, certification, dealing with, or offering for sale."

Except in certain specified cases (*f*), no evidence is required in order to obtain registration. Consequently, the mere adoption of a mark as a trade mark, followed by registration, is sufficient to entitle the proprietor *prima facie* to the exclusive rights in respect of it which are granted by the statute (*g*). This fact constitutes a marked difference in principle between statutory and non-statutory trade marks. The express provisions of the statute which determine the validity or otherwise of the registration, and regulate the enjoyment of the rights granted, go far to assimilate the rights which in practice follow from registration to those which were previously recognised (*h*); but, apart from such express provisions, the terms of the definition itself may have an important bearing on the construction of the Act. Thus, provision is made for the removal of entries wrongly remaining on the register (*i*), and the question arises whether a mark can be said rightly to remain on the register, when the use made of it is such that it cannot any longer be considered to be a trade mark within the definition.

Importance of the definition.

Experience shows, for instance, that in the mistaken notion as to what a trade mark really is, the proprietor of a trade mark will sometimes grant to another a so-called licence to use the mark upon goods which are not the goods of the proprietor by virtue of any

A licence inconsistent with the definition.

(*d*) Sect. 9.

(*e*) Sect. 3, which also defines a "mark."

(*f*) See, as to word and name marks, sect. 9 and notes; and as to registration of marks used concurrently, sects. 19 to 21.

(*g*) See sects. 39, 40.

(*h*) See p. 12, *post*.

(*i*) Sect. 35, p. 79, *post*.

of the operations enumerated in the definition *k* . Such a course can give the licensee no enforceable right against others, but prevents the licensor from interfering with the use of the trade mark by the licensee, and is therefore inconsistent with the intention that the mark should indicate the licensor's goods alone. It consequently imperils his mark, and it has been held that a trade mark so dealt with is liable to be removed from the register (*l* . The reference by Lord Shaw in that case to the words of the definition suggests that the ground for removal is that the entry wrongly remains on the register of trade marks, when, by the action of the proprietor, it has ceased to be a trade mark within the definition.

Abandonment.

Equally it would seem that a mark ceases to be a trade mark if the business which it serves to indicate is finally abandoned; and the mark can then be removed without waiting for the lapse of the period of non-user, for which special provision is made (*m* .

Misuse of a trade mark.

The same reasoning would seem to justify the removal of a trade mark where the proprietor, without granting an express licence or abandoning the mark, so uses the mark, or fails to prevent others from using it, that it comes into general use as the name of the article, and not as indicative of the particular trader (*n* .

A trade mark does not cease to be such because it is used to distinguish not only manufacture, &c., but also differentiation in quality: see p. 36.

What marks may be trade marks.

The question "what is a trade mark?" is not completely answered without a discussion as to the character of marks which may properly be classified as trade marks. So far as registration is concerned, this is considered in the notes to the Act (see pp. 49 *et seq.* ; and so far as the matter arises in relation to cases independent of statutory rights, it is referred to elsewhere in the Introduction (see pp. 17, 22 .

(*k*) Consent by the proprietor to the mark being applied to genuine goods is of course a legitimate and common practice: see p. 12, *post*.

(*l*) *Borden Wire, Ltd. v. Borden Brake, Ltd.* (1914), 31 R. P. C. 385; and see notes to sect. 22, *post*.

(*m*) See sects. 22 and 37, and *Peck v. Sharrowood* (1913), 30 R. P. C. 725.

(*n*) See, however, as to the possibility of the position being affected by sect. 41, *Woodward v. Boulton Maero* (1915), 32 R. P. C. 173, and the comment on that case in *Imperial Tobacco Co. v. de Pasquale* (1918), 35 R. P. C. 185; and notes to sect. 41, p. 85.

Section 3. The Character and Conditions of the Statutory Rights.

The Register of Trade Marks is now ^(o) divided into two parts. Part A. comprises all trade marks entered in the register at the commencement of the Act of 1919, and all trade marks subsequently registered under the Act of 1905. Part B. comprises all trade marks registered under Part I. of the Act of 1919, or removed thereto under that Act. There is ~~a~~ material difference between the effects of registration in the two parts. Registration in Part B., though it may facilitate registration abroad, creates no new right which did not exist in this country at Common Law or in Equity: it only affords a means by which the burden of proving such right may be discharged in the first instance ^(p). Registration in Part A., on the other hand, does give rise to a qualified statutory monopoly.

Parts A. and B. of the Register.

Thus sect. 4 of the Act of 1919 provides that registration in Part B. shall be *prima facie* evidence that the registered proprietor has the exclusive right to the use of the trade mark, and throws upon the defendant in an action for infringement the onus of showing that the user complained of is not calculated to deceive. It will therefore be observed that no new exclusive right is given by registration: the right referred to is that which, independently of the statute, belongs to a trader whose trade mark is distinctive of his goods. Consequently, except in relation to the onus of proof, the action for infringement in respect of a mark registered in Part B. is substantially the same as the old action in Equity ^(q).

Registration in Part B.

Subject to certain qualifications, registration in Part A., if valid, gives to the registered proprietor the exclusive right to the use of the registered trade mark upon or in connection with the goods in respect of which it is registered ^(r). This is a definite right conferred by statute, and its character therefore requires a close examination. What is meant by the phrase "exclusive right to use"? It is clear that a mark is "used" by any trader who deals in, offers, or advertises goods under that mark ^(s): but

Registration in Part A.

(o) Sect. 1 of the Act of 1919.

(p) See notes to sect. 4 of the Act of 1919.

(q) *Pinto v. Budman* (1891), 8 R. P. C. 181; *Boor v. Hart* (1905), 22 R. P. C. 222, decided on similar words in the Act of 1883.

(r) Trade Marks Act, 1905, s. 39, and see notes, p. 85.

(s) Actions are commonly brought against retailers.

it is also clear that a trader who has applied his mark to goods and then sold them to a retailer, cannot thereupon claim to exclude the retailer from using the mark upon the goods so supplied to him. It has consequently been suggested that anyone may use the trade mark upon goods which are the genuine goods of the proprietor, and of the quality or description of the goods to which he himself applies the mark, as this cannot result in deception (*t*). In the case of a mark not registered under the Act of 1905, where the issue is as to the probability of deception, this would no doubt be the case; but there has been no decision that the same principle applies where the rights arise from valid registration, and do not depend primarily on the trade mark having actually acquired a distinctive meaning. It is possible that the question of infringement under the Act of 1905 may depend upon whether the mark has been used in connection with the goods with the consent of the proprietor, as it is sometimes the practice of a manufacturer to supply merchants of his goods with labels to be applied to them. Such consent will no doubt be implied when goods have been sold by the proprietor under the mark, or with knowledge that the goods are to be resold under the mark (*u*), and in some cases it may be implied if the proprietor has applied the mark, though he has not put the goods on to the market (*x*).

Statutory
rights are
artificial.

Whatever may be the correct view upon this point, it is clear that the exclusive rights conferred by sect. 39 are at best an artificial reproduction of the non-statutory rights which are founded upon first principles. The statutory rights, however, are dependent upon the registration being valid, and an action for infringement may be met by an application to rectify the register whenever the validity of the registration is open to attack. By means of the provisions which determine such validity, a closer approximation between the practical results of the statutory and non-statutory law has been achieved. Thus there are limitations upon the character of the marks admissible for registration under the Act of 1905 which effectually exclude marks inherently incapable of

(*t*) The cases cited in support of this proposition, viz.: *Farma v. Silverlock* (1855), 6 De G. M. & G. 214; 4 K. & J. 650; and *Siegest v. Finollater* (1878), 7 Ch. D. 801, are not authoritative as to the Act of 1905.

(*u*) *E.g.*, *Condy and Mitchell v. Taylor* (1887), 56 L. T. 891.

(*x*) *Burgoyne v. Godfree* (1905), 22 R. P. C. 168, illustrates the question of consent. In *Rey v. Lecouturier* (1910), 27 R. P. C. 268, there was no issue raised as to any liquors seized by the liquidator in a condition ready for sale.

becoming distinctive in fact (*g* : a limitation has been put on marks which are the name, or only practicable name, of patented articles or chemical substances (*z* : deceptive marks are excluded (*a* : non-user may destroy the validity of the registration (*b* : assignment of trade marks without the goodwill to which they are attached is prohibited (*c* : and there is a general power to remove marks wrongly remaining on the register (*d*). Further, notwithstanding registration by others, honest traders are protected in the use of their name, or that of their place of business, or a *bonâ fide* description of their goods (*e*), and may in certain cases establish concurrent rights in regard to marks registered by others *f*. Broadly, therefore, it may be said that while the statute confers rights in respect of marks which are trade marks in embryo only, the other provisions of the Act are designed to secure that the trade marks so protected shall develop into trade marks to which protection would have been afforded at Common Law, and that the character of the protection given shall ultimately approximate to that given independently of the statute, though without the same difficulties in securing it.

Section 4.—The Actions for Passing-Off and Infringement.

The exclusive right to the use of a trade mark validly registered is enforceable by the action for infringement. The right extends to enable the proprietor to prevent the use on goods for which the mark is registered, not only of an exact copy of the mark, but of any mark which so nearly reproduces the distinguishing feature or features of the registered mark as to be likely to be mistaken for it (*g*). Extent of statutory right.

If a plaintiff relies, for the purpose of proving the probability of deception, upon matters other than the resemblance between the defendant's mark and the distinguishing feature or features of his mark as registered, his claim must be based on passing off (*h*). It is, in any case, usually advisable to add such a claim in any action for infringement, not only in order to be able to rely on

(*g*) Trade Marks Act, 1905, s. 9.

(*z*) Trade Marks Act, 1919, s. 6.

(*a*) Trade Marks Act, 1905, ss. 11, 19.

(*b*) *Ibid.*, s. 37.

(*c*) *Ibid.*, s. 22.

(*d*) *Ibid.*, s. 35.

(*e*) *Ibid.*, s. 44.

(*f*) *Ibid.*, ss. 20, 21, 39, 41.

(*g*) *Tatam v. Giammont* (1917), 24 R. P. C. 181; and see p. 28.

(*h*) *Ibid.*; and see *Alcedice v. Burke* (1916), 33 R. P. C. 341.

such other matters, but also as an alternative ground for relief in case the validity of the registration is successfully attacked (*j*), or the registration held not to extend to the goods in question (*k*).

The issues in trade mark and passing-off cases.

The distinction between claims for infringement and passing-off, so far as it now rests on the statutory provisions, has already been referred to (pp. 7, 8). But, apart from the statutory right, the term infringement may be reasonably applied to the type of passing-off action in which the plaintiff founds his claim on the existence of an unregistered trade mark distinctive of his goods. In such an action two questions arise: Does the mark used by the plaintiff in fact distinguish his goods? If so, is the mark used by the defendant calculated to deceive by reason of its resemblance to the plaintiff's mark? Where these two questions can be separately answered in the plaintiff's favour, infringement in its original meaning is established. But passing-off in relation to the supply of goods may be established without deciding these questions separately, the issue being generally the single issue: Is the defendant's conduct likely to result in goods which are not those of the plaintiff being passed off as and for such goods? (*l*). Consequently, although assistance in solving the two questions mentioned above may often be obtained from passing-off cases, care must be exercised in seeing how far the principles there laid down are applicable, and equal care is necessary in referring to cases on infringement or registration for assistance as to the principles applicable to actions for passing-off (*m*). The present section is not intended to do more than indicate the principles applied in passing-off cases sufficiently to enable their relevancy to these questions to be tested (*n*).

Passing-off by direct

The simplest case of actual passing-off occurs when a purchaser

(*i*) The claim for passing-off must be clearly pleaded; an amendment at the trial will sometimes, but not always, be allowed. See *Native Cotton Co. v. Sewane Mauter Co.* (1887), 4 R. P. C. 473; 8 R. P. C. 125; *Jay v. Lutter* (1888), 6 R. P. C. 136; and for a case of amendment before trial, *Rossell v. Hodges* (1918), 35 R. P. C. 285. The two claims do not constitute separate causes of action where there is only one matter of complaint. *Vernon v. Buchanan's Flour Mills*, 23 R. P. C. 17.

(*k*) *Hart v. Colley* (1890), 7 R. P. C. 93.

(*l*) *Magnolia Metal Co. v. Tandem Smelting Syndicate* (1900), 17 R. P. C. 486.

(*m*) The *Magnolia* case, *supra*, perhaps marks the end of a certain confusion, traceable in some stages of the *Singer* and *Camel Hair Belling* litigation, whereby a plain issue on passing-off may be lost sight of in an abstract discussion on trade-mark rights. For references, see Index of Cases, under *Singer* and *Reddaway* respectively.

(*n*) For a more exhaustive examination of the subject, reference should be

is induced to accept the goods of A. on the faith of a direct and untrue representation that they are the goods of B. Equally, where there is a known and ascertainable class or quality of A.'s goods, it is possible that goods which are not of that class or quality may be passed off by a representation that they are (o). Passing-off also occurs when a customer asks for A.'s goods and is led to accept the goods of B. by a substitution effected in such a way as to conceal the fact; but in such a case the shopkeeper is alone responsible, unless the get-up of the goods has contributed to the deception. There is no culpable substitution if the dealer makes it clear to the customer that the goods supplied are not those ordered (p).

Though no actual sale or deception takes place, an offer of goods accompanied by a similar false representation or concealment may be proof of conduct which the Court will restrain as likely to lead to passing-off. To give rise to a civil action, as distinguished from being a matter for criminal prosecution only, it must be shown that the representation would be understood to relate to the plaintiff's goods. The offer may be made by a tender of the actual goods, or by advertisement, but in the latter case it must be shown that the advertiser does intend to supply goods with reference to which the advertised description as to origin, or as to the goods being of a particular quality, is untrue. Generally, mere evidence that he has not got the genuine goods in stock, or may have difficulty in obtaining them, will not alone be sufficient (q).

misrepresentation.

Offers or advertisement.

made to the author's larger work on Trade Marks, or that of Sir Duncan Kerly, K.C.

(o) *Jameson v. Clarke* (1902), 19 R. P. C. 255; *Teucher v. Levy* (1906), 23 R. P. C. 117; *Spalding v. Gamage* (1915), 32 R. P. C. 273. Contrast *Burgoyne v. Godfree* (1905), 22 R. P. C. 168, 173; *Hunt, Ross, Tongue & Co. v. Ebrmana* (1910), 27 R. P. C. 512; *Harris v. Warren* (1918), 35 R. P. C. 217, where a recognised distinction of class or quality was not established; and *Mosley v. Nathan* (1906), 23 R. P. C. 345, where an interlocutory injunction was refused. As to passing off a diluted article, see *Palestine Wine Co. v. Cohen* (1906), 23 R. P. C. 568. It should be observed that in *Spalding v. Gamage* the reference to a particular patent was in fact an unambiguous misrepresentation. As to cases where the meaning of the words or mark is ambiguous, see the judgment of Buckley, L. J., in C. A., 31 R. P. C. p. 137.

(p) *Borril v. Bodega* (1916), 33 R. P. C. 153; *Pearson v. Valentine* (1917), 34 R. P. C. 267. Contrast *Silicate Paint Co. v. Smith* (1906), 23 R. P. C. 143. As to the circumstances which justify granting an injunction in such cases, see p. 37, *post*.

(q) Contrast *Ajello v. Worsley*, (1898) 1 Ch. 271, and *Mosley v. Nathan* (1906), 23 R. P. C. 345, with *Spalding v. Gamage* (1915), 32 R. P. C. 273. See also *Yeatman v. Hamburger* (1912), 29 R. P. C. 645; *Jay v. Lodge* (1888), 6 R. P. C. 136; *Singer v. Wilson* (1877), 3 A. C. p. 389; *Singer v. British Empire Co.* (1903), 20 R. P. C. 313.

A printer of labels intended for use upon goods other than those for which the proprietor uses the mark may also be restrained (r).

Passing-off
by other
means.

More generally, passing-off is effected not by a direct misrepresentation capable of only one obvious meaning, but by the use of names, words, symbols, general get-up of goods, or any other such indication likely to produce the same effect as the direct misrepresentation (s). In such cases the probability of passing-off resulting will depend upon how such indications will be understood, and it becomes necessary to consider two questions: What is the material point of the representation which must be understood, so that if it is false on that point, passing-off may result? Who are the persons whose understanding it is material to consider in deciding whether any such indication involves a false representation on that point? (t).

How much
must be
understood.

It is mainly in regard to the first of these questions that the difference between cases of passing-off generally and the specialised type of trade mark case is most apparent. Thus the fundamental and original idea of a trade mark was that it should enable purchasers to distinguish certain goods from other goods of a like description, the goods so distinguished differing from the others *in this respect*, that, in relation to them, the proprietor of the mark had performed some particular function—manufacture, selection, or whatever it might be. Now it is clear that a person who understands that such a trade mark does differentiate goods in that way, and buys accordingly “by the mark,” is likely to be deceived by the sale of the goods of another trader under that mark, and that he will be none the less deceived because he may happen to be ignorant of the actual identity of the trader whose goods the mark indicates (u). In fact the object of adopting a trade mark is often to provide a substitute for a name which will be more easily remembered and recognised. It is also clear that a person who understands that the mark does indicate the trade hands through which the article has passed, but does not know whether it indicates manufacture, selection, or the performance of some other function,

(r) *Farina v. Sidrecluck* (1855), 4 K. & J. 650; *Jameson v. Johnston* (1901), 18 R. P. C. 259; *De Kuiper v. Baird* (1903), 20 R. P. C. 581.

(s) A statement literally true may convey an untruth. *Musson v. Thorley* (1880), 14 Ch. D. p. 753. Cf. *Iron Ore Remedial Co. v. Co-operative Wholesale Soc.* (1907), 24 R. P. C. 125.

(t) As to this latter question, see p. 27, *post*.

(u) *Powell v. Birmingham Vinegar Co.* (1897), 14 R. P. C. 720; *Warwick Tyre Co. v. New Motor Co.* (1910), 27 R. P. C. p. 171.

is still liable to be misled by the use of the mark on the goods of another trader, *x*. The cases considered do not, however, exhaust the possible representations which an indication may convey to a purchaser. It often happens that a word is coined or adopted by a trader, and is then used by the public merely as the name which describes the article without in any way identifying it with any representation as to origin or class. To such a case Common Law trade mark rights, strictly speaking, can have no application, since a mark which conveys no representation as to origin cannot be an inducement to purchase goods on account of their origin.

Where, therefore, a word is used by the public as a name for an article, such as Yorkshire Relish, Apollinaris, or Gramophone, the question whether these words are good Common Law trade marks will depend upon whether the names are understood merely as names for the article, by whomsoever made, or as something more, viz.: the articles which emanate from a particular trader. Knowledge of the actual identity of the trader, or of the function which he performs, may not be material, but some representation as to trade origin is essential to constitute a trade mark independently of the statute.

Passing-off may, nevertheless, be effected by the use of a name without any such understanding of its meaning, if in fact it is impossible for the article known by the name to be produced from any source except one. Thus, even if "Yorkshire Relish" was understood to mean no more than sauce prepared according to a certain recipe, as long as that recipe was a secret known only to one manufacturer, that manufacturer would lose his profit if a purchaser desirous of obtaining the article were induced by the use of the name to accept the sauce of another manufacturer as being the identical article which he required. A similar result would follow if "Apollinaris" meant no more than water bottled from a particular spring, so long as only one trader had the means of obtaining water from that spring, or again, if "Gramophone" meant an article made according to an existing patent, and a purchaser were deceived into thinking that he was getting the patented article by the use of the name, the patentee, if he alone made the article, would lose the profit he would have made on the sale of the article required by the purchaser (*y*).

Passing-off
where a
monopoly
exists

(*x*) *European Bisc Co.'s T. M.* (1896), 13 R. P. C. 600.

(*y*) See *Palmer's T. M.* (1883), 24 Ch. D. p. 520.

But if these names were understood only as names for the articles in question, when the secret became known, or access to the spring became open to others, or the patent expired, the names would become open to all who could supply the article (z). The distinction between the cases in which the possibility of passing-off depends only on the existence of a monopoly and true trade mark cases, is made clear by the consideration that in the former case the name is associated with the monopoly, and it is possible that there might be an assignment of the monopoly, without the assignment of the goodwill of any business, as in the case of a patent, which would in practice operate to transfer the sole power to apply the name during the currency of the patent.

So long as such a monopoly exists, a name applied to the article will not generally become distinctive of the manufacturer, because in the absence of competitors, the occasion to draw a distinction is unlikely to arise (a). The conditions when the monopoly will no longer exist may, however, be thought of before the time arrives, and so long as a description of the article, other than the trade name, exists, and is recognised by the public, the trade name may be distinctive in the true sense (b), although it is at the same time descriptive (c).

Proof of distinctiveness will no doubt be more difficult, as the existence of the monopoly may explain the fact that the name has been exclusively used by one trader, a circumstance which in other cases will usually be attributed to a general recognition that

(z) See *Porrett v. Birmingham Vinegar Co.* (1896), *per* Lindley, L. J., 13 R. P. C. p. 252, and observations in H. L., 14 R. P. C. pp. 730, 732. The reservation there made as to the possibility of using the name without passing off is wide enough to exclude from the cases in which the names would become open, the case where the name is also understood to denote association with a particular trader. The names mentioned are only chosen as illustrations; actually, *Apollinaris* is registered (24 R. P. C. 436), *Gramophone* was refused (27 R. P. C. 689), and *Yorkshire Relish* was removed under the Act then in force (11 R. P. C. 4) as not being within the categories of registrable marks, but has since been registered under sect. 9 (5) of the Act of 1915 after an order by the Board of Trade.

(a) See *S. v. P. v. Foulton* (1878), 7 Ch. D. p. 813; *Leonard and Ellis's T. M.* (1884), 26 Ch. D. 288; *Linoleum Co. v. Vaino* (1878), 7 Ch. D. 834; *Pollock's T. M.*, 21 Ch. D. 504.

(b) The importance of the existence of an alternative name is recognised in the Act of 1919; see p. 111.

(c) *Burbery's v. Cording* (1909), 26 R. P. C. 693. See also cases on registration, p. 57.

the name is a trade mark (*d*). But where the article is one which requires particular skill or care in its production, it may be readily believed that the public will identify the article of the original manufacturer by the original name (*e*).

It should be observed that where a trade name is also descriptive, that name, in an appropriate context, may sometimes be used by another trader without risk of passing-off. Thus it was held that no action would lie for describing metal as "similar to magnolia" (*f*). So also the use of a trade name associated with such words as "type," "system," "model," or "quality" may be legitimate as a *bonâ fide* description, or may be a mere attempt to effect a fraud (*g*). A trade name may also be distinctive for one class of goods, but descriptive where applied to accessories (*h*). In other cases a name, not in itself distinctive, may be used with a deceptive addition, so as to lead to passing-off (*i*).

"System,"
"model,"
"quality,"
&c.

On the question whether a name for goods is merely descriptive, or is also understood as distinguishing the goods of a particular trader, the following further considerations will usually be material:—The character of the name in question, the use made of it by the party claiming that it distinguishes his goods, and the function performed by that party in virtue of which he claims that goods so named are his.

Name of
goods—
distinctive or
descriptive.

The character of the name is important, as a fanciful word is

Character of
the name.

(*d*) *Young v. Macrae* (1863), 9 Jur. N. S. 322.

(*e*) See *Masson v. Thorley* (1880), 14 Ch. D. p. 754, and *Rey v. Lecouturier* (1910), 27 R. P. C. 268, where stress is laid on two things which the liquidator could not acquire, the secret and the reputation of the monastery.

(*f*) *Magnolia Metal Co. v. Tandem Smelting Syndicate* (1900), 17 R. P. C. 477.

(*g*) Contrast *Singer v. Looy* (1882), 8 A. C. 15; *Singer v. Spear* (1893), 10 R. P. C. 297; *Singer v. British Empire Co.* (1903), 20 R. P. C. 313 (Singer system); *Gamage v. Randall* (1899), 16 R. P. C. p. 192 (Shorland type); *Barbery's v. Raper* (1906), 23 R. P. C. 170 ("identical with" in smaller type); *Bechstein v. Barker* (1910), 27 R. P. C. 464 (Bechstein model); *Vacuum Oil Co. v. Gooch* (1910), 27 R. P. C. 76 (Vacuum quality); *Armstrong Oil Co. v. Patent Axle Box Co.* (1910), 27 R. P. C. 362 (Armstrong type); *J. V. Roe, Ltd. v. Aircraft Disposals Co.* (1920), 37 R. P. C. 249 (Avro type).

(*h*) Contrast *Gledhill v. British &c. Paper Co.* (1911), 28 R. P. C. 714 (Gledhill rolls for a Gledhill cash till), with *Kodak v. Loubon Stereoscopic Co.* (1903), 20 R. P. C. 337 (Kodak films); and see *Yost Typewriter Co. v. Typewriter Exchange Co.* (1902), 19 R. P. C. 422 (Yost pads for a Yost typewriter); *Neostyle Manufacturing Co. v. Ellens* (1904), 21 R. P. C. 185, 569 (Neostyle ink, &c. for a Neostyle machine).

(*i*) *E.g.*, by adding "the original": see *Corks v. Chandler* (1871), L. R. 11 Eq. 446.

more likely to become distinctive than one which has a natural meaning apt to describe the goods (*k*). In the case of a name consisting of a combination of words, of which only a part is taken, the character of the different elements must be considered, and the use of parts which are naturally descriptive will not usually lead to deception (*l*).

Use made of
the name.

If the party who claims that the name is distinctive has so used it as to encourage the public to adopt it as a descriptive term for an article characterised by features which are not dependent on manufacture, care, or quality, or anything else particularly associated with himself, then he will have great difficulty in proving that the name is distinctive of his goods, though registration of the name prior to his so using it may, except in the cases especially provided for by statute (*m*), enable him to maintain an exclusive right to it (*n*). Care should therefore be taken as to the form in which an article is advertised under a trade name, and any use of it by trade papers or otherwise in a context likely to lead the public to treat the trade name as purely descriptive should be checked.

Function
performed by
the trader.

A mere selector or retailer will usually have more difficulty than a producer in showing that a name used to describe an article which he sells is associated with the function which he performs, so as to become his trade mark, or a means by which goods may be passed off as his (*o*).

Descriptive
terms.

Closely akin to the cases of the name of the goods are those in which passing-off is alleged to be the probable result of the use of a term which is naturally descriptive. Such terms may become distinctive if long user has acquired for them a secondary meaning, so that the primary meaning, if not lost, is, in the particular

(*k*) *Burberry's v. Cording* (1909), 26 R. P. C. 693; *Young v. Macrae* (1863), 9 Jur. N. S. 322; *Braham v. Bustard* (1863), 1 H. & M. 447. As to descriptive terms generally, see cases cited in note (*p*), p. 21.

(*l*) Thus a surname may be the distinguishing factor: *Horlick's Malted Milk v. Summerskill* (1917), 34 R. P. C. 63; or both elements may be distinctive, e.g., *Eno v. Dunn* (1890), 7 R. P. C. 311; *Eno's Appn.* (1920), 37 R. P. C. 1; or the name may only be that of an originator: see Index of Cases, under *Anderson, Liebig, Hommel*. As to combinations including geographical names, see p. 24, *post*.

(*m*) Trade Marks Act, 1919, s. 6. See p. 111.

(*n*) *Gramophone Co.'s Appn.* (1910), 27 R. P. C. 689; *Chesebrough Co.'s T. M.* (1902), 19 R. P. C. 342.

(*o*) See *Arbenz' Appn.* (1887), 4 R. P. C. 143; and cf. *Dental Manufacturing Co. v. de Trey* (1912), 29 R. P. C. 617.

circumstances in which it is used, superseded. The more appropriate and the commoner the epithet, the greater the difficulty in establishing a secondary meaning (*p*). If other traders have honestly applied the word to articles of the same description during the time in which it is alleged that distinctiveness was being acquired, the difficulties of proving a case in the absence of circumstances pointing to fraud on the part of the defendant will be very great (*q*).

Passing-off may take place not only in relation to the supply of goods, but in relation to services of any kind, one business being in effect passed off for another (*r*). This may be effected in many ways, a recent curious example being a case in which initials, which formed part of the plaintiff company's name, though not in themselves distinctive of that company, were described by the defendant company in advertisements as a means of identifying the goods of the defendant company (*s*). In some cases the representation is alleged to be false as suggesting connection with, or succession to, an existing business (*t*). There is, of course, no harm in a person advertising his former association with another trader, as long as this is honestly and truthfully done (*u*); nor will the mere copying of a novel form of advertising constitute a cause of action (*x*).

Passing-off
one business
for another.

(*p*) *Reddaway v. Busham* (1896), 13 R. P. C. 218; *Cellular Clothing Co. v. Marton* (1899), 16 R. P. C. 397; *Kinnell v. Ballantyne* (1910), 27 R. P. C. 185. Cf. *Crosfield's Appn.* (1909), 26 R. P. C. 837, and other cases cited in note (*k*), p. 20. It should, however, be noted that refusal of registration does not mean that a passing off case may not succeed. See *Crosfield v. Caton* (1912), 29 R. P. C. 47.

(*q*) *E.g.*, *Sharp v. Solomon* (1915), 32 R. P. C. 15.

(*r*) *E.g.*, *Hendriks v. Montagu* (1881), 17 Ch. D. 638, and many of the cases cited in succeeding notes. As to cases where the business is not an ordinary trading concern, see p. 25, *post*.

(*s*) *A. G. S. Manufacturing Co. v. Aeroplane General Sundries Co.* (1918), 35 R. P. C. 127. Cf. on infringement, *Paine v. Danells* (1893), 10 R. P. C. 217.

(*t*) *E.g.*, *Eastman Photographic Co. v. Kodak Cycle Co.* (1898), 15 R. P. C. 105; *Manchester Brewery Co. v. North Cheshire and Manchester Brewery Co.*, (1899) A. C. 83; *Walter v. Ashton*, (1902) 2 Ch. 282; *Harper v. Pearson* (1861), 3 L. T. N. S. 547.

(*u*) *E.g.*, *Foot v. Lea* (1850), 13 Ir. Eq. 484; contrast *Hookham v. Pattage* (1872), L. R. 8 Ch. 91; *Glenny v. Smith* (1865), 13 W. R. 1032. The right to a description of this sort may in some cases devolve with the business: *Rickett v. Neville* (1904), 21 R. P. C. 395.

(*x*) *Wertheimer v. Stuart, Cooper & Co.* (1906), 23 R. P. C. 481; *Plotzker v. Lucas* (1907), 24 R. P. C. 551.

Passing off
by similarity
of traders'
names.

The way in which confusion between businesses is most commonly caused is by the use of similar names. In general, the principles already discussed in relation to the passing-off of goods are applicable (y) ; but the cases relating to surnames and trading names which include a geographical reference require some special consideration, particularly in view of their relevance to questions as to the registrability of such names.

Surnames.

A surname is, within limits, a most effective trade mark, its very purpose being to distinguish, but it is subject to this disadvantage, that for distinguishing between two persons having the same surname it is worse than useless (z). When, therefore, a trader claims protection for the goodwill of a business associated with a surname, he is faced with the difficulty that so far as he relies on a surname as the means of guiding customers to his business that goodwill is, and must always be, subject to the risk that an individual with the same surname may set up business in competition, or, having acquired a reputation, may transfer the benefit of it to a firm or company so that connection with the name properly becomes a part of the goodwill of such firm or company (a). But that is the limit of the risk to which his good-

(y) Thus artificial names for firms or companies often include a description of the goods sold; the character of the name, the description and locality of the business, and the class of customer are all factors relevant to the probability of deception. *Randall v. Bradley* (1907), 24 R. P. C. 773; *British Vacuum Cleaner Co. v. New Vacuum Cleaner Co.* *ibid.* 641; *Ewing v. Buttercup Margarine Co.* (1917), 34 R. P. C. 232; *Buttons, Ltd. v. Buttons Covered, Ltd.* (1920), 37 R. P. C. 45; *Aerators, Ltd. v. Tollit* (1902), 19 R. P. C. 419; *Merchants' Banking Co. of London v. Merchants' Joint Stock Bank* (1878), 9 Ch. D. 560. The first and leading word in a name may be of special importance: *Accident Insurance Co. v. Accident, Disease and General Insurance Co.* (1884), 51 L. J. Ch. 104; *Facsimile Letter Printing Co. v. Facsimile Typewriting Co.* (1912), 29 R. P. C. 557; though the mere addition of words at the beginning will not assist in distinguishing if they only suggest an amalgamation: *North Cheshire and Manchester Brewery Co. v. Manchester Brewery Co.*, (1899) A. C. 83. Sect. 8 of the Companies (Consolidation) Act expresses the principles on which the Court acts: *Daimler Motor Co. v. London Daimler Motor Co.* (1907), 24 R. P. C. p. 385; though the section does not actually apply to a company already registered: *Orub Ceylon Estates, Ltd. v. Uva Ceylon Rubber Estates, Ltd.* (1910), 27 R. P. C. p. 756.

(z) See *Ainsworth v. Womblesley* (1866), L. R. 1 Eq. p. 525; *Cadbury's App.* (1915), 32 R. P. C. 9.

(a) As to the extent to which association with an individual can or cannot justify the inclusion of his name in an artificial name of a firm or company, see *Tussaud v. Tussaud* (1890), 44 Ch. D. 678; *Fine Cotton Spinners' Association v. Harwood, Cosh & Co., Ltd.* (1907), 24 R. P. C. 533; *Kingston, Miller & Co.*

will is subject; and if the possibility of confusion which is inevitably caused by such competition is increased by anything which such competitor does, either by adding to the name, or omitting distinguishing features, or in the manner of conducting his business, relief will be given. *b* It is indeed the duty of a competitor coming into the field under the same name as a trader with an established reputation, to take care to avoid confusion. *c* An expression sometimes used is that "any man has a right to trade honestly under his own name," and there is no doubt that successful actions based on the use of surnames are usually cases in which fraudulent intention is proved. But as the standard of what is not "honest" is determined by the decision of the Court, having regard to the circumstances of the plaintiff's trade and reputation, the above expression, which might be understood as meaning that the action will necessarily fail unless the defendant's conduct is proved to have been dishonest, is not a satisfactory summary of the law. *d* Apart from its association with a trade or business, there is no exclusive right to a surname. *e* []

v. Thomas Kingston & Co., Ltd. (1912), 29 R. P. C. 289; *Waring and Gillow, Ltd. v. Gillow and Gillow, Ltd.* (1916), 33 R. P. C. 173; *Baird and Tatlock (London), Ltd. v. Baird and Tatlock, Ltd.* (1917), 34 R. P. C. 85; *Dunlop Pneumatic Tyre Co. v. Dunlop Motors Co.* (1907), 24 R. P. C. 572; *Chivers v. Chivers* (1900), 17 R. P. C. at p. 426; *Allen v. Original Sausage' Allen & Sons, Ltd.* (1905), 32 R. P. C. 33; and for a case of a right acquired to the name of a predecessor, see *Gaimourcas v. Fosseca and Vasconcellos, Ltd.* (1921), 38 R. P. C. 388. Of the older cases, the grounds for the decision in *Burgess v. Burgess* (1853), 3 De G. M. & G. 896, require critical examination, and *Turton v. Turton* (1889), 42 Ch. D. 128, cannot be regarded as an authoritative statement of the law in view of the observations in *Reddaway v. Banham* (1895), 13 R. P. C. 218; and *Brinsmead v. Brinsmead* (1913), 30 R. P. C. 493.

(*b*) *J. & J. Cash, Ltd. v. Cash* (1902), 19 R. P. C. 181; *Goddard v. Goddard* (1918), 35 R. P. C. 21; and see Seb. p. 293.

(*c*) The observations on this question in *Jamieson v. Jamieson* (1897), 15 R. P. C. 169, must be reviewed in the light of subsequent expressions in *Brooks v. Norfolk Cycle Co.* (1899), 16 R. P. C. 523; *Williams v. Bromley* (1909), 26 R. P. C. at p. 773; *Teofani v. Teofani* (1913), 30 R. P. C. at p. 457; and the reasoning in *Brinsmead v. Brinsmead, supra.* See also *Massam v. Thorley* (1880), 14 Ch. D. p. 760, and observations in *Cording's Appn.* (1916), 33 R. P. C. pp. 335, 336.

(*d*) *Valentine v. Valentine* (1900), 17 R. P. C. 673; and see *per* Lord Halsbury in *Electromobile Co. v. British Electromobile Co.* (1908), 25 R. P. C. p. 154, and cases cited in note (*c*). Where the deceptive results are clear, persistence in the use of a name may be treated as fraudulent; *Shorts, Ltd. v. Short* (1914), 31 R. P. C. p. 298; but persistence may be due to a contest as to the facts.

(*e*) *Du Boulay v. Du Boulay* (1869), L. R. 2 P. C. 430.

Geographical terms.

Geographical terms, whether as part of a trader's name, or of the name of his goods, or place of business, sometimes afford a means by which passing-off is effected. Substantially the questions raised by such cases are similar to those applicable to surnames and descriptive terms generally. Where a monopoly exists in relation to the products of a particular locality, passing-off may occur even where the name is understood in its primary descriptive sense, because the description *must* indicate the goods of the single producer (*f*). Where this is not the case, it may be necessary to show that a secondary meaning has been acquired, at any rate, in the particular context (*g*). If there is no particular connection between the locality and the class of business in question, proof of this may be comparatively easy (*h*), but where the geographical term is naturally apt to describe the article or class of business the proof will be difficult (*i*), and may be practically impossible (*k*). The address of an established business is not infrequently imitated in order to assist in passing-off (*l*), and where the goodwill of a business is sold with the premises, or premises sold without the goodwill, difficult questions may sometimes arise as to the right to use the name (*m*).

(*f*) See p. 17, *ante*.

(*g*) *Thompson v. Montgomery* (1891), 8 R. P. C. 361; *De Liden v. Bisset* (1864), 33 L. J. Ch. 561; *Seixo v. Procezo* (1865), L. R. 1 Ch. 192. Contrast *Weikle v. Williams* (1909), 26 R. P. C. 775.

(*h*) *E.g.*, *Wotherspoon v. Currie* (1872), L. R. 5 H. L. 508; *Worcester Royal Porcelain Co. v. Locke* (1902), 19 R. P. C. 479; *Price v. Ogston* (1909), 26 R. P. C. 797; contrast *Cooper v. MacLachlan* (1902), 19 R. P. C. 27.

(*i*) Compare *Whitstable Oyster Fisheries v. Hayling* (1901), 18 R. P. C. 434; *Brack v. Pann* (1911), 28 R. P. C. 697; *Grand Hotel of Caledonia v. Wilson* (1904), 21 R. P. C. 117; *Apollinaris Co. v. Duckworth* (1906), 23 R. P. C. 540; *Spicer v. Spalding and Hodge* (1915), 32 R. P. C. 52; and contrast *Hopton Wood Stone Firms, Ltd. v. Gething* (1910), 27 R. P. C. 605, with *Dunpachie v. Young* (1883), 10 Ct. Sess. Cas. (4th Ser.) 874.

(*k*) *Plotzker v. Lucas* (1905), 24 R. P. C. 551; *Australian Land, &c. Co. v. Australian and New Zealand Mortgage Co.* (1880), W. N. 6; *Wolff v. Nopitsch* (1900), 17 R. P. C. 321; 18 R. P. C. 27.

(*l*) *Pullman v. Pullman* (1919), 36 R. P. C. 240; *Hudson v. Osborne* (1869), 39 L. J. Ch. 79; and as to the importance of an address, see *Lee v. Haley* (1869), L. R. 5 Ch. 155. But an address may be of a descriptive character which has not acquired any secondary meaning. *Charleson v. Campbell* (1876), 4 Ct. Sess. Cas. (4th Ser.) 149.

(*m*) See, for example, *Rickerby v. Reay* (1903), 20 R. P. C. 381; *Boussod, Valadon & Co. v. Marchant* (1908), 25 R. P. C. 42; *Nicholson v. Buchanan* (1902), 19 R. P. C. 321; *Motley v. Dunham* (1837), 3 My. & Cr. 1; *Mason v. Queen* (1886), 23 Sc. L. R. 641; *Townsend v. Jarman* (1900), 17 R. P. C. 649.

In all cases of alleged passing-off, mere inconvenience, not resulting in damage due to deception, is not a ground for granting an injunction, but as between two traders, confusion will generally result in damage, and this result will be readily assumed (n) ; and a society, though not an ordinary trading concern, may have a pecuniary interest in maintaining the distinctive character of a title which indicates its members (o) . -

Probability of damage must be shown.

A number of cases have arisen in relation to the passing-off of literary or musical works, magazines, or periodicals. Originally, as in the earlier trade mark cases, the decisions turned upon the question of fraudulent intention (p) , but it is now well settled that although there is no copyright in the title to a work, the ordinary principles of passing-off cases are applicable, and if there is a serious risk of deception and damage, an injunction will be granted (q) . In order that rights may be acquired in respect of the title to a work, there must have been actual use of the title. Mere advertisement will not in general be sufficient, though it may perhaps be doubted whether at the present time advertisement might not be made upon a sufficient scale to enable a plaintiff to prove both deception and damage, and establish a claim to relief (r) . Each case will depend upon the particular facts, but it must be borne in mind in connection with literary works that the persons likely to be affected are *ex hypothesi* persons of some degree of intelligence, though perhaps, in the case of certain classes

Literary productions.

(n) Contrast *Day v. Brownrigg* (1878), 10 Ch. D. 294, and *Street v. Union Bank of Spain* (1885), 30 Ch. D. 156, with *Ouvah Ceylon Estates, Ltd. v. Uru Ceylon Rubber Estates, Ltd.* (1910), 27 R. P. C. p. 648 (affirmed on appeal), and *Ewing v. Buttercup Margarine Co., Ltd.* (1917), 34 R. P. C. p. 237.

(o) *Society of Accountants and Auditors v. Goodway* (1907), 24 R. P. C. 159; *Society of Accountants in Edinburgh v. Corporation of Accountants, Ltd.* (1893), 20 Ct. Sess. Cas. (4th Ser.) 750. Cf. *Toms and Moore v. Imperial Merchant Service Guild, Ltd.* (1908), 25 R. P. C. 474; but contrast *Society of Architects v. Kendrick*, (1910) W. N. 113.

(p) *Hogg v. Kirby* (1803), 8 Vesey, 215; *Spottiswoode v. Clarke* (1846), 2 Ph. 154, and other cases cited in Seb. pp. 325, 326.

(q) *Kelly v. Hutton* (1868), L. R. 3 Ch. 703; *Clements v. Maddick* (1859), 1 Giff. 98; *Walter v. Emmott* (1885), 54 L. J. Ch. 1059, where it will be observed that the question whether the term "property" is rightly used in this connection again appears: see pp. 4, 5, *ante*. For a long list of examples of such cases, see Seb. pp. 328 *et seq.*

(r) See *Maxwell v. Hogg* (1867), L. R. 2 Ch. 307; *Licensed Victuallers' Newspaper Co. v. Bingham* (1888), 38 Ch. D. 139; but see *Primrose Press Agency v. Knowles* (1886), L. J. Notes of Cases, p. 43.

of literature, the intelligence to which they appeal may not reach a very high standard. The probability of deception is not, therefore, the same as with some other classes of goods (s), and there may be no likelihood of deception or damage unless the two publications will compete against each other (t).

Injunctions will similarly be granted to restrain the publication of a book which is not the work of a particular author in such a manner as to suggest that it is (u); but an attempt to prove that an older musical work of an authoress was being passed off as a recent work was unsuccessful where no distinct and recognised difference between the alleged classes was proved (v).

The name of a play or film production can be protected in the same way as the title of a book or periodical (y).

Probability of
deception.

The examination of passing-off cases in the preceding pages has been made principally with a view to illustrating the circumstances in which names and words can, or cannot, be considered as distinctive of particular traders. It has been pointed out that the relevance of such cases on the single question as to whether a mark is distinctive or not is limited by the consideration that in passing-off cases this question may not have to be answered by itself (z). It is equally necessary to emphasise the fact that the issue as to deceptive resemblance between two marks, which arises in an action for infringement, or on a question of objection to registration under sect. 19, is more limited than the issue in a passing-off case where the defendant's conduct as a whole must be considered. On the other hand, in considering an opposition to registration based on sect. 11, all the circumstances attending the use which the applicant has made or is likely to make of the proposed mark can be considered, so that registration may be refused, although proof of the probability of deception is less than would justify the granting of an injunction in an action for infringement or passing-off (a). Subject to these qualifications,

(s) *Barthwick v. Evening Post* (1888), 37 Ch. D. p. 461.

(t) *Ibid.*, and *Outram v. London Evening Newspaper Co.* (1911), 28 R. P. C. 308; *Ridgway v. Amalgamated Press, Ltd.* (1912), 29 R. P. C. 130; *Lee v. Cassell* (1913), 30 R. P. C. 199.

(u) *Byron v. Johnson* (1816), 2 Mer. 29; *Archbold v. Sweet* (1832), 1 M. & R. 162. See, however, *Lee v. Gibbins* (1892), 67 L. T. 263.

(v) *Harris v. Warren* (1918), 35 R. P. C. 217.

(y) *Rutleigh v. Kinematograph Trading Co.* (1914), 31 R. P. C. 143.

(z) P. 14, *ante*.

(a) *Whalley, Akroyd & Co.'s Appn.* (1920), 37 R. P. C. 137; and see p. 60.

the general principles which guide the Courts in passing-off cases are applicable to questions of deceptive resemblance arising in relation to the statutory provisions.

One of the most important of these principles is that in considering the probability of deception, weight must be given to the characteristics of the persons liable to be deceived, and the nature of the transaction in respect of which deception may occur. Thus the persons to be considered are those who are likely to be influenced by the representation in question, that is, the probable customers, including ultimate as well as immediate purchasers (*b*), who are likely to rely on the mark (*c*). Further, amongst such, it is neither the unusually acute or well informed, nor the inordinately stupid, who are particularly to be considered, but those of the intelligence ordinarily found amongst customers of the class in question, who exercise that degree of caution or lack of caution which is usual in dealings of the character to which the particular action relates (*d*). Where special markets are concerned, the characteristics of purchasers in such markets must be considered (*e*).

Class of persons and transactions to be considered.

In cases of passing-off by mark or get-up it is necessary to show that the plaintiff's mark or get-up is understood to be distinctive in the area in which the defendant trades. It is not necessary that everybody in that area should so understand it, but actual trade in the district must be established, and where proof of distinctiveness

Locality of reputation.

(*b*) *Syles v. Syles* (1833), 3 B. & C. 541; *Lever v. Goodwin* (1887), 4 R. P. C. 492.

(*c*) *Schuerdtfeger v. Hart Publishing Co.* (1912), 29 R. P. C. 236, p. 243.

(*d*) *Ford v. Foster* (1872), L. R. 7 Ch. 611 (*Eureka* used with one meaning in the trade and another to the public; contrast *Gismophone Co.'s Appn.* (1910), 27 R. P. C. 689); *Payton v. Snelling* (1890), 17 R. P. C. p. 57 (coffee tins); *Edge v. Nicolls* (1911), 28 R. P. C. 582 (*Id.* jackets of blue); *Montgomery v. Thompson* (1891), 8 R. P. C. 361 (thirsty folk want beer, not explanations); *Barthwick v. Evening Post* (1888), 37 Ch. D. p. 461 (newspapers); *Armstrong Oilier Co. v. Patent Axle-box Co.* (1910), 27 R. P. C. p. 376, and *Universal Winding Co. v. Hattersley* (1915), 32 R. P. C. p. 490 (machinery); *Aquascutum v. Cohen and Walks* (1909), 26 R. P. C. p. 653 (waterproofs); *Buttons, Ltd. v. Buttons Covered, Ltd.* (1920), 37 R. P. C. 45; *Waring and Gillow, Ltd. v. Gillow and Gillow, Ltd.* (1916), 33 R. P. C. p. 188 (business transactions). See also notes to sects. 11 and 19.

(*e*) *Jabaston v. Orr-Ewing* (1882), 7 A. C. 219. On a claim appropriately framed, leave will be given to take evidence abroad: *Rose v. Riddle* (1914), 31 R. P. C. 48; contrast *White v. United Confectionery Co.*, *ibid.* 286. Cf. *Ogston and Tennant's Appn.* (1909), 26 R. P. C. 816. The idiosyncrasies of foreign customers must not be exaggerated: *Cowie v. Herbert* (1897), 14 R. P. C. 436. As to cases on registration, see p. 61.

involves establishing the fact that a secondary meaning has been acquired in respect of a name or common word, a stricter standard will be set (*f*), but sporadic and intermittent user of the name or word by persons other than the plaintiff will not necessarily prevent such name or word from becoming distinctive (*g*).

Degree of
resemblances.

In considering whether the resemblance between two contrasted marks is such that one is an infringement of the other, or is calculated to lead to passing-off, every case raises a question which can only be decided on its own particular facts; other cases on other facts are only useful as showing the considerations which weigh with the Court (*h*). Some of these considerations may be noted. Thus, the ear, the eye, and the understanding may each contribute to the final result; consequently similarity in the appearance of words may justify an injunction, although the difference between them is more marked where they are vocalised (*i*). On the other hand, the sound of a word as pronounced by the class of customer in question is a material consideration (*k*), and where the word conveys an intelligible idea, that idea may be a relevant factor. If the same idea is suggested by both marks, deception may be probable though the words differ in appearance, whereas a difference in meaning, though the lettering is similar, may result in making the marks readily distinguishable (*l*). So where a mark, label, or get-up has resulted in a word becoming distinctive of the goods of a particular trader, though the word is not itself used

(*f*) *Faulder v. Ashton* (1903), 20 R. P. C. 477; *Thorne v. Sandow* (1912), 29 R. P. C. 116. Some of the observations in *Chiracs v. Chiracs* (1900), 17 R. P. C. 120, must be considered in the light of subsequent name cases; see p. 22, *ante*; and *Shorts, Ltd. v. Short* (1914), 31 R. P. C. at p. 298. Cf. *Warm v. Webster* (1904), 21 R. P. C. 373.

(*g*) *Goddard v. Gouldard* (1918), 35 R. P. C. 21.

(*h*) *Seico v. Procezoide* (1866), L. R. 1 Ch. p. 196; *Edwards v. Innes* (1885), 30 Ch. D. p. 471. For an exhaustive discussion of the subject, and examples of contrasted words and devices, reference should be made to Sebastian or Kerly on Trade Marks.

(*i*) *Oxo, Ltd. v. King* (1917), 34 R. P. C. 165. Cf. *Schacht's Appn.* (1912), 29 R. P. C. 483; *Egg Products, Ltd.'s Appn.* (1922), 39 R. P. C. 155.

(*k*) *E.g.*, on an application to register, *Wheatley, Akroyd's Appn.* (1920), 37 R. P. C. 137.

(*l*) *Fitchetts v. Loubet* (1919), 36 R. P. C. 296; *McCaw v. Nickols* (1904), 21 R. P. C. 15; *St. Mungo Manufacturing Co. v. Piper Co.* (1910), 27 R. P. C. 420. Cf. *Fox & Co.'s Appn.* (1920), 37 R. P. C. 37; *Smith's Appn.* (1913), 30 R. P. C. 363. As to infringement of ordinary English words, see *Imperial Tobacco Co. v. de Pasquali* (1918), 35 R. P. C. p. 195.

on the goods, the use of that word by another may lead to confusion, and, conversely, where a word is used as a trade mark by one trader, the use by another of a device suggesting that word may be restrained, or registration may be refused under sect. 11 (*m*).

Generally speaking, in cases either of passing-off or of infringement, a comparison of elements which are common to the trade, or otherwise of a non-distinctive character, is of little assistance (*n*), and similar considerations apply in relation to comparisons of parts of words or devices on applications to register (*o*). Such comparisons must, however, be made by considering the marks as a whole, and, particularly where the question of fraudulent intention is in issue, the fact that certain elements are common to the trade will not prevent their playing a part in producing a deceptive whole (*p*). On the other hand, the fact that there has been no attempt to copy the general get-up may be material as negating any fraud (*q*). If a mark consists of a special arrangement of words, the mere use of those words will not generally be an infringement, or lead to passing-off, unless they are in themselves distinctive (*r*); but if the trade mark is substantially a word mark, the mere omission of some conventional border or ornamentation will not be a sufficient distinction to avoid infringement (*s*).

The proper test in making the comparison is not to look at the two marks side by side, when differences may become apparent, How the test should be applied.

(*m*) *E.g.*, *Briggs v. Dunn* (1911), 28 R. P. C. 705; *Johuston v. Orr-Ewing* (1882), 7 A. C. 219; *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 3 R. P. C. 28. Cf. *Dechurst's Appn.* (1896), 13 R. P. C. 288; *Société des Verreries' T. M.* (1894), 11 R. P. C. 112; *Pomrid's Appn.* (1901), 18 R. P. C. 181. As an example of this principle and its limits, see *Boord v. Thom and Cameron* (1907), 21 R. P. C. 697; *Boord v. Huddart* (1904), 21 R. P. C. 149; *Société Dubonnet's Appn.* (1915), 32 R. P. C. 241; *Bagots Hatton's Appn.* (1916), 33 R. P. C. 357.

(*n*) *E.g.*, *Payton v. Snelling* (1900), 17 R. P. C. 48, 628; *Williams v. Bronnley* (1909), 26 R. P. C. 765; *Coleman v. Stephen Smith, Ltd.* (1912), 29 R. P. C. 81; *Tatem v. Gaumont* (1917), 34 R. P. C. 181; *Hennessy v. Keating* (1908), 25 R. P. C. 361.

(*o*) *Texas Co.'s Appn.* (1914), 31 R. P. C. 53; *For & Co.'s Appn.* (1920), 37 R. P. C. 37; *Pianotist Co.'s Appn.* (1906), 23 R. P. C. 774.

(*p*) *Christiansen's T. M.* (1886), 3 R. P. C. 54; *Farrow's T. M.* (1890), 7 R. P. C. 260; *De Cros v. Gold* (1913), 30 R. P. C. 117.

(*q*) *California Fig Syrup Co. v. Taylor's Drug Stores* (1897), 14 R. P. C. at p. 569; *Fitchetts v. Loubet* (1919), 56 R. P. C. 296.

(*r*) *Rugby Portland Cement Co. v. Rugby and Newbold Portland Cement Co.* (1892), 9 R. P. C. 46.

(*s*) *Woodward v. Boulton Macro, Ltd.* (1915), 32 R. P. C. p. 196.

but to consider the effect which will be produced by the defendant's mark on a purchaser who has the plaintiff's mark in his mind, but not actually before him (*l*). Colour may be a very material consideration (*n*).

Effect of
features dis-
tinguishing
the goods.

As has already been pointed out, where the issue is only that of infringement of the statutory right conferred by registration, the question is whether the defendant has used the plaintiff's mark, or a mark so closely resembling it as to be calculated to deceive (*r*). If he has done this it is no defence to prove that he has in practice added other matter which would prevent the likelihood of passing off (*y*), and even where the name forms part of a label registered as a trade mark, the substitution of the defendant's name for the plaintiff's may not be a sufficient distinction (*z*).

Where, however, the issue is passing-off, the question is the single question as to whether, taking all the circumstances into account, deception is probable, and added matter may prevent the probability of deception which would otherwise result from similarity in certain features (*a*). But the mere addition of the defendant's name, though a matter to be considered, is often quite insufficient as a distinction (*b*), and in any case reliance cannot be placed on such distinguishing features unless they will remain on the goods when they reach the public (*c*). The affixing of a dealer's adhesive label upon bottles having a manufacturer's trade mark moulded upon them will not in general justify the filling of such bottles with anything other than the product of the owner of

(*l*) *Seizo v. Provezende* (1866), L. R. 1 Ch. p. 196.

(*n*) Colouring may affect the impression created by the design by giving prominence to or obscuring features; e.g., *Biezel's T. M.* (1887), 4 R. P. C. 525; 57 L. T. 247. As to statutory provisions with regard to colour, see p. 59 and notes.

(*r*) *Tatem v. Gannont* (1917), 34 R. P. C. 181.

(*y*) Thus in *Brighton v. Cavendish* (1915), 32 R. P. C. 230, it appeared that so far as the get up was concerned passing-off was not probable.

(*z*) E.g., *Boord v. Thom* (1907), 24 R. P. C. 697.

(*a*) E.g., *Pryton v. Saelling* (1900), 17 R. P. C. 628; *Schweppes v. Gibbes* (1905), 22 R. P. C. 601; *Star Cycle Co. v. Frankenburgs* (1907), 24 R. P. C. 105; *Alaska Packers v. Crooks* (1901), 18 R. P. C. 129.

(*b*) E.g., *Kinahan v. Bolton* (1863), 15 Ir. Ch. 75; *Wotherspoon v. Currie* (1872), L. R. 5 H. L. 508; *Johnston v. Orr-Ewing* (1882), 7 A. C. p. 230; *Daniel v. Whitehouse* (1899), 16 R. P. C. 71. Cf. *Price v. Jeyes* (1902), 19 R. P. C. 22, per Vaughan Williams, L. J. See also p. 16, ante.

(*c*) *Elliott v. Hodgson* (1902), 19 R. P. C. 518; and cf. *Cochrane v. McNish* (1896), 13 R. P. C. 100; *Barlow v. Johnson* (1890), 7 R. P. C. 395.

the trade mark *d*, but if there is no likelihood of deception it would seem that the ordinary action for passing-off cannot be maintained in such cases (*e*).

Except in cases of infringement in which the resemblance Evidence. between the two marks is obvious to the eye, it is usual to call witnesses familiar with the trade in question. Such witnesses may state the effect produced by the mark in question upon their own mind *f*, and may give valuable evidence as to the practice in the trade, the habits of customers, the circumstances under which transactions are carried on; but statements as to the witnesses' opinion on the question whether the public would or would not be likely to be deceived are not admissible in evidence (*g*). Evidence of the last-mentioned character is frequently included in statutory declarations on oppositions to applications to register, and is frequently read without objection, but evidence obtained in such a way, or in answer to leading questions, does not carry much weight (*h*).

Fraudulent intention does not necessarily prove that the result will be deceptive, though the deduction will readily be made that a scheme planned to deceive will succeed in its object (*i*).

Evidence of great value may often be obtained by what are Trap orders. known as "trap orders," that is, orders given for the plaintiff's goods to persons suspected of supplying, or likely to supply, the defendant's goods in substitution for them. Where such substitution is effected by the defendant or his servants, cogent evidence is afforded either of systematic fraud, or of a deceptive

(*d*) See Merchandise Marks Act, 1887, ss. 2, 3, 5; *Wood v. Burgess* (1883), 24 Q. B. D. 162; *Thwaites v. McErilly* (1904), 21 R. P. C. 397; *Baro v. Man-ibid.* 665; *Stowe v. Burn* (1910), 103 L. T. 540.

(*e*) *Welsh v. Knott* (1857), 4 K. & J. 747; *Burrett v. Goum* (1883), 71 L. T. Jo. 388; *Wadden v. Morrison* (1904), 21 R. P. C. 463, 349; *Donohoe v. Cherry* (1909), 26 R. P. C. 545. Contrast *Rose v. Luttas* (1878), 47 L. J. Ch. 576.

(*f*) *Ash v. Larieta Co.* (1912), 29 R. P. C. 465; *Bourne v. Swan and Edge* (1903), 20 R. P. C. 105.

(*g*) *Royal Warrant Holders' Assn. v. Dean* (1911), 28 R. P. C. 721, reviewing earlier authorities and following *North Cheshire and Manchester Brewery Co. v. Manchester Brewery Co.*, (1899) A. C. 83; *Panton v. Snelling* (1900), 17 R. P. C. p. 635. As an example of admissible expert evidence, see *Iron-Or Remedy Co. v. Co-op. Wholesale Soc.* (1907), 24 R. P. C. 425.

(*h*) See observations in *Smith's Appn.* (1913), 30 R. P. C. p. 366; *Bransmead v. Bransmead, ibid.* p. 513; *Far & Co's Appn.* (1929), 37 R. P. C. 37.

(*i*) *Ash v. Larieta Co.* (1912), 29 R. P. C. p. 475; *Perry v. Hessia, ibid.* p. 528; *Iron-Or Remedy Co. v. Co-op. Wholesale Soc.*, *supra*.

resemblance resulting in the person who served the goods being himself misled (*k*). Where the substitution is effected by a retailer, the circumstance is open to the comment that the case may only prove an attempt at fraud by a third party, and does not afford any certain indication that such frauds could be successfully carried out, but this objection will have little force if the same result is obtained from several retail shops. The Courts, however, will always bear in mind the fact that when trap orders are given they are intended to be successful, and will carefully scrutinise the evidence to make sure that the order was fairly given (*l*), and will hesitate to accept such evidence if there is no corroboration, and attach little weight to a single case, which may well have been accidental (*m*). Written orders are, therefore, much more valuable than verbal orders, and it has been thought to be desirable that the circumstances should be brought to the notice of the defendant soon after the event, so that investigation is still possible. Cases relied upon should, therefore, be brought forward at once if a motion is made for interlocutory relief, and should in any case be pleaded (*n*).

Defences.

It has already been pointed out that in a passing-off case there is normally only one issue, viz.: whether the plaintiff has proved his allegation that the defendant's conduct is such that goods which are not the plaintiff's are likely to be taken as and for the plaintiff's (*o*). The usual defence will, therefore, be a traverse of this allegation. Where, however, the plaintiff's case involves two steps, viz.: firstly, that a particular mark, name, or feature is distinctive of his goods, and secondly, that the defendant's imitation is so near as to be calculated to deceive, the defence may take the form of a denial of either or both of these allegations. So, in an action upon a registered trade mark, it is open to the defendant either to challenge the validity of the registration by a

(*k*) See, for example, *Harman Cigars Co. v. Tiffin* (1909), 26 R. P. C. 473; *O. T., Ltd. v. Cummings* (1915), 32 R. P. C. 69; *Borrit v. Bodega* (1916), 33 R. P. C. 153.

(*l*) See, for example, *Carr v. Crisp* (1902), 19 R. P. C. 497; *Peters v. Domestic Inventions, Ltd.* (1908), 25 R. P. C. 387; *Coombe v. Mendit* (1913), 30 R. P. C. p. 719.

(*m*) See, for example, *Donohoe v. Cherry* (1909), 26 R. P. C. 545; *Rutter v. Smith* (1901), 18 R. P. C. 49; *Lover v. Mashra, &c. Society* (1912), 29 R. P. C. 33, 225; *Leahy v. Glover* (1893), 10 R. P. C. 141.

(*n*) *Ripley v. Griffiths* (1902), 19 R. P. C. 590.

(*o*) See p. 14, *ante*.

motion to rectify the register upon any of the grounds available (*p*), and also to deny infringement. The latter defence may be based on the ground either that there is no deceptive resemblance between the marks (*q*), or that the registration does not cover the goods in question (*r*), or on the defendant's right to use the mark in spite of the plaintiff's registration (*s*). In addition to such defences it may sometimes be possible for the defendant to prove that the plaintiff is disentitled to any of the relief claimed, or to some part of it, on some special ground such as fraud or acquiescence.

A defence based on the allegation that the plaintiff's own trade is fraudulent is founded on the principle that the plaintiff must come into Court with clean hands (*t*). Under the old practice this principle was in many cases made a ground for refusing equitable relief until the plaintiff had brought an action in the Common Law Courts (*u*). That procedure is obsolete, and the legal and equitable rights of the plaintiff have to be determined in the same proceeding (*x*). Doubts have been expressed as to whether such a defence is available where the action is an action for damages, such as could have been brought in the Common Law Courts based upon fraud (*y*), and in regard to a registered mark the terms of sect. 39 must be considered. It has, however, been treated as sufficient in a number of actions (*z*). But it is now clear that to afford an answer to the plaintiff's claim it is necessary to

Fraudulent trade or misrepresentation by the plaintiff.

(*p*) See sects. 35 and 41, and notes thereto.

(*q*) See pp. 26 *et seq.*

(*r*) See sect. 8.

(*s*) See sect. 39, which is subject to the proviso to sect. 41 as to marks continuously used from a date anterior to the first user or registration of the plaintiff's mark, and also to the provisions of sect. 44 and any conditions or limitations upon the register.

(*t*) *Leather Cloth Co. v. American Leather Cloth Co.* (1863), 4 De G. J. & S. 127; 11 H. L. C. 523.

(*u*) *E.g.*, *Pidding v. How* (1837), 8 Sim. 477; *Percy v. Truettitt* (1842), 6 Beav. 66; *Flavel v. Harrison* (1853), 10 Hare, 467.

(*v*) *Ford v. Foster* (1872), L. R. 7 Ch. 611.

(*y*) *Jamieson v. Jamieson* (1898), 15 R. P. C. p. 191; *Wolff v. Napitsch* (1901), 18 R. P. C. p. 32.

(*z*) *E.g.*, *Newman v. Pinto* (1887), 4 R. P. C. 508; *Morgan v. McAdam* (1867), 36 L. J. Ch. 228; *Leather Cloth Co. v. Lorscheut* (1869), L. R. 9 Eq. p. 252; and see *Rile Bean Co. v. Davidson* (1905), 22 R. P. C. 553; 23 R. P. C. 725; *Cropper v. Cropper* (1906), 23 R. P. C. at p. 394. Misrepresentations as to the identity of the manufacturer may prevent the acquisition of any right to a trade mark; *Wool v. Lambert* (1886), 3 R. P. C. 81; *Thurndloe v. Hill* (1894), 11 R. P. C. 61.

prove a misrepresentation which is not merely collateral, but one which, though it may not form part of the actual trade mark, is a part of, or associated with, the style under which the goods are offered to the public (*a*). A misrepresentation may be disregarded if it is both trivial and unlikely to deceive (*b*), or has been abandoned for some time before the action is brought (*c*). Where the defendant succeeds in establishing such a defence, but his own trade is tainted with fraud, the action is commonly dismissed without costs (*d*).

The presence in a mark of matter which would render it disentitled to protection in a Court of Justice is a bar to registration, and if registration has been obtained, a ground for rectification of the register (*e*).

Failure to comply with some independent statutory requirement is not of itself sufficient to bar the plaintiff's right to relief (*f*).

Improper use
of the word
"patent."

An example of misrepresentation, which has in many cases been relied upon as a defence, is the use of words suggesting untruly that the goods are protected by a patent. In particular cases the word "patent" may not convey any such suggestion, as when it has become generally recognised as a part of the description of the goods (*g*), or the reference is such as to show that the patent has expired (*h*), and in some cases the use of such words may not affect the plaintiff's right to relief on the ground above mentioned, that such misrepresentation is merely collateral (*i*). Subject to these considerations, the rule in regard to misrepresentations will be applied whether there has never been a patent, or whether there has been a patent which has been declared invalid

(*a*) Contrast *Ford v. Foster, supra*, with *Bile Bean Co. v. Davidson, supra*.

(*b*) *Siegey v. Lindlater* (1878), 7 Ch. D. 801; and cf. *Cochrane v. McNish* (1896), 13 R. P. C. 100. The mere unlikelihood of deception will not exonerate the plaintiff: *Leather Cloth Co. v. American Leather Cloth Co.*, 4 De G. J. & S. at p. 148.

(*c*) *Burdick v. Sullivan* (1895), 12 R. P. C. 25, 32. Cf. *Hills' T. M.* (No. 2) (1893), 10 R. P. C. 269.

(*d*) E.g., *Newman v. Pinto, supra*.

(*e*) See notes to sects. 11, 35 and 41.

(*f*) *Randall v. British-American Shoe Co.* (1902), 19 R. P. C. 393; *Pearks v. Talmey* (1901), 18 R. P. C. 185. Cf. *Albert Baker & Co.'s Appn.* (1908), 25 R. P. C. p. 513.

(*g*) *Marshall v. Ross* (1869), L. R. 8 Eq. 651; and cf. *Cochrane v. McNish, supra*.

(*h*) See *Chevin v. Walker* (1877), 5 Ch. D. 850.

(*i*) *Ford v. Foster* (1872), L. R. 7 Ch. 611; and cf. *Perry v. Hessin* (1912), 29 R. P. C. at p. 128.

or has expired (*k*). Trade marks containing words such as "patent," "registered," &c., will not usually be accepted for registration (*l*).

On the same principle, a misrepresentation as to a trade mark being registered, which is not so, or a misrepresentation as to what it is that is registered, may similarly affect the plaintiff's right to relief. But a claim to registration before the mark is in fact registered, if registration is subsequently obtained, may be no bar to the plaintiff's right (*m*). Where a general claim is made to registration of a label in which the word "trade mark" is so placed as to appear to refer only to one particular feature of the label, the question may arise as to whether there is likely to be confusion as to what is, and what is not, registered (*n*); but apart from such cases, the mere use of the word "trade mark" will not be held to imply registration (*o*). A false claim to registration is also punishable as an offence (*p*).

Untrue claim
to registra-
tion.

In all cases where misrepresentation by the plaintiff is relied upon by way of defence, it must be pleaded (*q*).

Misrepresenta-
tions by
plaintiff must
be pleaded.

Mere delay by the plaintiff, though it may affect his claim for interlocutory relief (*r*) or damages (*s*), will not deprive him of the right to an injunction if he could still obtain at least nominal damages at law (*t*). Such delay may be excused for a variety of

Delay or
acquiescence.

(*k*) *Cheurin v. Walker, supra*; cf. *Hubbuck v. Brown* (1900), 17 R. P. C. p. 647; *Boake Roberts v. Wayland* (1909), 26 R. P. C. p. 257.

(*l*) See Rule 11. As to offences in connection with misleading use of the words "patent," &c., see Patents and Designs Act, 1907, s. 89, and Merchandise Marks Act, 1887, s. 3 (1).

(*m*) *Reed v. Richardson* (1881), 45 L. T. N. S. 54. Cf. on an application to register, *Altman's Appn.* (1901), 21 R. P. C. 753.

(*n*) See *Apollinaris Co.'s T. M.* (1891), 8 R. P. C. 137; *Wills' T. M.* (No. 2) (1893), 10 R. P. C. 269; but see *Bass' T. M.* (1902), 19 R. P. C. 529; *Hammond v. Brunner* (1892), 9 R. P. C. 301.

(*o*) *Sen Sen Co. v. Britten* (1899), 16 R. P. C. 137; and see *Hubbuck v. Brown* (1900), 17 R. P. C. 148. p. 156.

(*p*) See sect. 67 and notes.

(*q*) *Lever v. Goodwin* (1887), W. N. 107; *Boake Roberts v. Wayland* (1909), 26 R. P. C. 251.

(*r*) See p. 38.

(*s*) See p. 40.

(*t*) *Fullwood v. Fullwood* (1878), 9 Ch. D. 176; and see cases cited below. In *Ripley v. Baudley* (1897), 14 R. P. C. 591, 944, an injunction was refused; the case was compromised on appeal, and its authority has been doubted: *Reddaway v. Sterenson* (1903), 20 R. P. C. p. 282. Delay may be a reason for staying the operation of the injunction: *Grant v. Levitt* (1901), 18 R. P. C. 361.

reasons, such as the need to collect evidence (*u*), or the trifling character of the infringement (*x*), and ignorance of the infringement is a sufficient answer (*y*).

Delay, however, may be evidence of actual acquiescence, amounting in effect to a licence which will deprive the plaintiff of his right (*z*), and in some circumstances may result in the mark becoming *publici juris* (*a*), and conduct which might once have led to the probability of deception may cease to be likely to produce that effect if it has been long continued (*b*). But in the latter case, the Court will be disposed to disregard user which was fraudulent in its inception (*c*).

Inoperative defences.

Many defences have been set up from time to time which are inoperative. A few of these may be mentioned (*d* : *e.g.*, ignorance of the plaintiff's rights (*e*); absence of proof of actual deception or fraudulent intention (*f*); that immediate purchasers will not be deceived (*g*); that the mark is descriptive or indicates quality as well as trade origin (*h*); that the entire mark has not been copied (*i*); that the name complained of is the defendant's own name, if he has used it so as to deceive (*k*); that the goods are in fact of the plaintiff's manufacture, if they are of a different quality from that which the mark is known to indicate (*l*); that the goods

(*u*) *Lee v. Haley* (1869), 1 L. R. 5 Ch. 155.

(*x*) *Goddard v. Goddard* (1918), 35 R. P. C. 21; *Rowland v. Mitchell* (1897), 14 R. P. C. 37.

(*y*) *Apollinaris Co. v. Herrfeldt* (1887), 4 R. P. C. 478; *Barlow v. Johnson* (1890), 7 R. P. C. 395, 419.

(*z*) As to effect of a licence, see p. 9.

(*a*) *National Starch Co. v. Munn's, & Co.* (1894), 11 R. P. C. 281; *Woodward v. Boulton Macro, Ltd.* (1915), 32 R. P. C. 173 (so far as the action for passing off was concerned; as to the effect of registration and sect. 41, see pp. 10, 85); *Gledhill v. British Perforated Toilet Paper Co.* (1911), 28 R. P. C. 429, 714.

(*b*) *E.g.*, *Londonderry v. Russell* (1887), 3 T. L. R. 360.

(*c*) *Rodgers v. Rodgers* (1874), 31 L. T. N. S. 285. But see *National Starch Co. v. Munn's, & Co.*, *supra*.

(*d*) For a fuller list, see Seb. pp. 239 *et seq.*

(*e*) *Edelsten v. Edelsten* (1863), 1 De G. J. & S. 185; as to damages, see p. 39.

(*f*) *Ibid.*; and see p. 4, *ante*.

(*g*) *Sykes v. Sykes* (1821), 3 B. & C. 541.

(*h*) *Ransome v. Graham* (1882), 51 L. J. Ch. 897; and see p. 18.

(*i*) *Ford v. Foster* (1872), 1 L. R. 7 Ch. 611.

(*k*) See p. 23.

(*l*) See p. 15.

are of equal quality to the plaintiff's (*m*), or better (*n*): that the defendant has used his own name as well (*o*); that the mark has been used by others, unless it is proved to be common to the trade (*p*); that the plaintiff uses more than one trade mark on the same goods (*q*); that the plaintiff in fact uses his trade mark with devices not registered as part of it, *e.g.*, by filling in blank spaces (*r*): that the acts complained of were only the acts of a servant or agent (*s*): that the defendants acted only as commission agents (*t*).

The fact of infringement of a trade mark validly registered, or of conduct likely to lead to passing-off, coupled with a reasonable apprehension of repetition of the acts complained of, is sufficient, in the absence of other circumstances disentitling the plaintiff to relief (*u*), to justify a trader in seeking relief from the Court. Since the very life of a trade mark may depend on the prompt suppression and exposure of infringements (*x*), proof that deceptive conduct is threatened is sufficient (*y*), and it is unnecessary to complain before action (*z*), although in exceptional cases, particularly where retailers only are attacked (*a*), a plaintiff who does not make

Plaintiff's
right to
relief.

(*m*) *Blotfeld v. Payne* (1833), 4 B. & Ad. 410.

(*u*) *Spicer v. Spalding and Hodge* (1915), 32 R. P. C. 52.

(*o*) See p. 30.

(*p*) *Dent v. Turpin* (1861), 2 J. & H. 139; *Worcester Porcelain Co. v. Locke* (1902), 19 R. P. C. 479; *Dunnachie v. Young* (1883), 10 Ct. Sess. Cas. (4th Ser.) 874; *Paine v. Daniells* (1893), 10 R. P. C. 217.

(*q*) *Braham v. Bustard* (1863), 1 H. & M. 447; and see *Andrew v. Kuehnrich* (1913), 30 R. P. C. 677.

(*r*) *Melachrino v. Melachrino* (1887), 4 R. P. C. 215; *Hammond v. Malcolm Brunner & Co.* (1890), 9 R. P. C. 301.

(*s*) *Bovril v. Bodega* (1916), 33 R. P. C. 153; *Grierson v. Birmingham Hotel Co.* (1901), 18 R. P. C. 158; *Havana Cigar Co. v. Tiffin* (1909), 26 R. P. C. 473; *Cusciner v. Gaiety Bars* (1902), 19 R. P. C. 357. As to exceptional cases, see *Coumbe v. Mendil* (1913), 30 R. P. C. 709; *Magnolia Metal Co. v. Atlas Metal Co.* (1897), 14 R. P. C. 389, as to the defendant Pound.

(*t*) *Cutterson v. Anglo-Foreign Manufacturing Co.* (1911), 28 R. P. C. 74. As to the position of a wharfinger, see *Hunt v. Monière* (1864), 34 Beavan, 157.

(*u*) See p. 33.

(*x*) *Johnston v. Orr-Ewing* (1882), 13 Ch. D. p. 464; 7 A. C. p. 229; *Perry v. Hessin* (1912), 29 R. P. C. p. 528.

(*y*) See *Hendriks v. Montagu* (1881), 17 Ch. D. p. 646.

(*z*) *Upmann v. Forester* (1883), 24 Ch. D. 231; and see *Weingarten v. Bayer* (1905), 22 R. P. C. p. 350. Cf. *Wittman v. Oppenheim* (1884), 27 Ch. D. p. 268.

(*a*) Actions against innocent retailers are not regarded with favour by the Court if proceedings could be taken against the real offender: *e.g.*, *American Tobacco Co. v. Guest* (1892), 9 R. P. C. 218.

such a complaint may run some risk of being unable to prove apprehension of repetition (*b*). If a defendant desires to submit, he must offer all that the plaintiff is entitled to (*c*), including the costs of obtaining judgment (*d*), which judgment should be given in open Court (*e*), and without attaching any condition (*f*). If such an offer is made, and the plaintiff does not adopt the speediest manner of obtaining judgment in Court, but goes on with the action, either claiming relief which he could have obtained on motion for judgment (*g*), or further relief to which he is not entitled (*h*), a special order as to costs will usually be made to meet the justice of the case (*i*), and the discretion of the judge as to costs will not be interfered with unless exercised on a wrong principle (*k*).

In cases of fraud the plaintiff is not bound to be satisfied with an undertaking (*l*), but if he fails to make out the charge of fraud, this may be taken into account in the order as to costs (*m*). A defendant cannot at the same time contest the plaintiff's right and seek to rely on the plea that the action was unnecessary because he did not intend to repeat the acts complained of (*n*).

(*b*) *E.g.*, *Leahy v. Glover* (1893), 10 R. P. C. 141; *Bass v. Taidlaw* (1909), 26 R. P. C. 211; *Burberrys v. Watkinson* (1906), 23 R. P. C. 141. Contrast *Bovril v. Bodegn* (1915), 33 R. P. C. p. 155.

(*c*) *Tonge v. Hard* (1869), 21 L. T. 480; *Hat Manufacturers Supply Co. v. Tomlin* (1906), 23 R. P. C. 413; *Featman v. Homberger* (1912), 29 R. P. C. 645.

(*d*) *Burgess v. Hills* (1858), 26 Beav. 244; *Upmann v. Forester*, *supra*; *Wittman v. Oppenheims*, *supra*.

(*e*) *Gandy v. Fleming* (1901), 18 R. P. C. 276; *Smith v. Service, Reeve & Co.* (1914), 31 R. P. C. 319; and cf. *Royal Warrant Holders v. Kitson* (1909), 26 R. P. C. 157.

(*f*) *Clay v. Godfrey Phillips, Ltd.* (1910), 27 R. P. C. 508.

(*g*) *E.g.*, *Rippingilles Co. v. Clarke's Syphon Store Co.* (1917), 34 R. P. C. 365.

(*h*) *E.g.*, damages or an account of profits where not recoverable, *Muet v. Couston* (1864), 33 Beav. 578; *Millington v. Fox* (1838), 3 Myl. & Cr. 338; *Slazenger v. Spalding* (1910), 27 R. P. C. 20; but as to damages, see p. 39, *post*.

(*i*) See cases cited in last two notes; *Clarke v. Hudson* (1901), 18 R. P. C. 310; and other cases cited in Sebastian, pp. 262, 263.

(*k*) *Lever Bros. v. Masbro, &c. Society* (1912), 29 R. P. C. 225. As to the limits to the discretion to deprive a successful defendant of costs, see *King v. Gillard* (1905), 22 R. P. C. 327.

(*l*) *Smith v. Carron Co.* (1896), 13 R. P. C. 108; *Jameson v. Johnston* (1901), 18 R. P. C. 259.

(*m*) *E.g.*, *O. T., Ltd. v. Cummings* (1915), 32 R. P. C. 69.

(*n*) *McAndrew v. Bassett* (1864), 4 De G. J. & S. 380. Cf. *Finlater v. Newman* (1902), 19 R. P. C. p. 241.

If the plaintiff can show a *prima facie* right (o), and applies without any unexplained delay (p), an interlocutory injunction will be granted if the damage likely to result in case of the acts being continued, outweighs the possibility of damage being caused by granting the injunction (q). It is consequently a usual practice to apply for interlocutory relief, and this is a convenient course, as it frequently results in the motion being treated as the trial of the action and further costs being saved. Interlocutory injunction.

The Court will further, where necessary, order the delivery up or destruction upon oath of all offending labels, cards, tickets, advertising matter, &c. (r), or the production of the goods wrongfully marked for the purpose of erasure of the spurious mark (s). Destruction of the goods will not generally be ordered if it is possible without destruction satisfactorily to erase the spurious marks (t), and if the plaintiff has delayed taking action after knowledge of the infringement, the Court may be influenced by that fact in considering whether destruction should be ordered (u). Delivery up.

It has been pointed out that the action for infringement or passing-off developed originally from the Common Law action for deceit, in which damages were only recoverable on proof of fraud (v). The Courts of Equity did not at that time award damages, and the power to grant compensation in cases of infringement, by ordering an account of profits, was treated as only applicable to cases where the defendant was aware of the plaintiff's mark (w). It consequently came to be thought that neither damages nor an account of profits could be obtained in the case of infringement without knowledge, and this rule was held to be Damages or account of profits.

(o) The right need not be established beyond all doubt: *Read v. Richardson* (1881), 45 L. T. R. 51; particularly if there is reason to suspect fraud: *Radde v. Norman* (1872), L. R. 14 Eq. 348.

(p) As to delay, contrast *Hagyard v. Penkall* (1909), 26 R. P. C. 89, and *Army and Navy Co-op. Soc., Ltd. v. Army, Navy and Civil Service Co-op. Soc. of S. Africa, Ltd.* (1902), 19 R. P. C. 574, with *Post Typewriter Co., Ltd. v. Typewriter Exchange Co.*, *ibid.* p. 422. As to the effect of delay on the right to an injunction at the trial, see p. 35, *ante*.

(q) *Read v. Richardson*, *supra*; *Alaska Packers Assn. v. Crooks* (1899), 16 R. P. C. 503, where the plaintiffs eventually failed at the trial: 18 R. P. C. 129.

(r) *E.g.*, *Farina v. Silverlock* (1858), 4 K. & J. 650.

(s) *E.g.*, *Dent v. Turpin* (1861), 2 J. & H. 139.

(t) *Stazenger v. Feltham* (1889), 6 R. P. C. 531.

(u) See *County Chemical Co. v. Frankenburg* (1904), 21 R. P. C. 722.

(v) See p. 2, *ante*.

(w) *Edelsten v. Edelsten* (1863), 1 De G. J. & S. 185.

equally applicable to the case of infringement of the statutory rights under the Act of 1905 (z). Orders for inquiries or accounts have, therefore, sometimes been limited, so that the assessment should commence from the date when the defendants first became aware of the plaintiff's mark (a). Having regard to the speeches, particularly that of Lord Parker, in *Spalding v. Gamage* (b), and to the observations in the Court of Appeal during the argument on the inquiry as to damages (c), although in that case there was no doubt as to the defendant's knowledge, it would seem that the rule in favour of innocent infringers is rather a matter of indulgence than of strict legal right. The injury to the plaintiff is the same whether the defendant knew that he was inflicting it or not. The plaintiff may elect between an inquiry as to damages and an account of profits, but cannot obtain both (d); and even if the plaintiff has established a right to nominal damages (e), an inquiry or an account may still be refused if it is clear that nothing substantial will be recovered (f). So also, where there are special circumstances, such as delay or acquiescence, the inquiry or account may be limited to a particular period (g), or refused altogether (h). The account, if ordered, will be an account of the profits made by the sales under the mark as to which the injunction is granted (i). In the case of damages, it will not be assumed that the plaintiff has necessarily been deprived of a profit on every sale effected by the defendant (k), but the facts proved may in certain cases justify

(z) *Slazenger v. Spalding* (1910), 27 R. P. C. 20, following *Ellen v. Stock* (1880), 24 Sol. J. 290, a case under the Act of 1875.

(a) E.g., *Horsfield v. Walkden* (1911), 28 R. P. C. 175.

(b) (1915), 32 R. P. C. 273.

(c) (1918), 35 R. P. C. 101, at p. 113.

(d) *Lever v. Goodwin* (1887), 4 R. P. C. p. 507; *Weingarten v. Bayer* (1905), 22 R. P. C. p. 351; *Neilson v. Betts* (1871), L. R. 5 H. L. 1. See, as to discovery, p. 42, *post*.

(e) *Blufeld v. Payne* (1833), 4 B. & Ad. 410.

(f) E.g., *Sunitas Co. v. Condy* (1887), 4 R. P. C. 530; *Boord v. Huddart* (1904), 21 R. P. C. 149.

(g) *Ford v. Foster* (1872), L. R. 7 Ch. p. 627. Mellish, L. J., assumes that in any case the account would be limited to the six years preceding the writ: *ibid.* p. 633.

(h) *Reddaway v. Stevenson* (1903), 20 R. P. C. 276; and see *Magnolia Metal Co. v. Atlas Metal Co.* (1897), 14 R. P. C. 389.

(i) *Lever v. Goodwin*, *supra*; *Saclehner v. Apollinaris Co.* (1897), 14 R. P. C. 645; *Weingarten v. Bayer*, *supra*.

(k) *Leather Cloth Co. v. Hirschfeld* (1865), L. R. 1 Eq. 299.

such an inference (*l*). But the damages are not limited merely to the loss of profits on articles which the defendant has sold. A trade may have been destroyed (*m*), or there may be injury to reputation if the goods sold are inferior (*n*), and the value of the trade mark as being an indication of the plaintiff's goods exclusively may be injured (*o*). The proper form, therefore, for an order is for an inquiry as to what damages (if any) the plaintiffs have sustained by reason of the acts the repetition of which is restrained (*p*). It has been held that where a defendant has a claim against a third party for damages for breach of warranty under sect. 17 of the Merchandise Marks Act, 1887, third party procedure is applicable (*q*).

The practice and procedure in relation to actions for infringement and passing-off are governed by the ordinary provisions applicable to other actions of the same class. The distinction between the old Common Law action founded on deceit, the equitable proceedings, and actions based on the statutory right, must be observed. Thus the first could, no doubt, still be brought in the County Court, but not either of the last two (*r*). Further, the old Common Law action is subject to the rule *actio personalis moritur cum personâ* (*s*), whereas if the plaintiff's claim is based on injury to a right of property, or the defendant is in possession of profits for which he is liable to account, the death of either party will not put an end to the action (*t*).

Practice and procedure.

(*l*) *Alexander v. Henry* (1895), 12 R. P. C. 360. Contrast *Kinnell v. Ballantine* (1910), 27 R. P. C. 185.

(*m*) *Alexander v. Henry* (1895), 12 R. P. C. 360.

(*n*) *Ainsworth v. Walsley* (1866), L. R. 1 Eq. p. 524; *Spalding v. Gamage* (1918), 35 R. P. C. 101.

(*o*) *E.g.*, in *Spalding v. Gamage, supra*, a part of the damages awarded was in respect of the cost of counter-advertisement by the plaintiffs to correct the impression created by the defendants' advertisements. Damages for wrongfully registering a trade mark were refused in *Reid v. Thomson* (1905), 22 R. P. C. 376; 23 R. P. C. 153.

(*p*) *Davenport v. Rylands* (1865), L. R. 1 Eq. p. 308; *Spalding v. Gamage, supra*.

(*q*) *Pidoux v. Beneckendorff* (1914), 31 R. P. C. 65.

(*r*) *Bow v. Hart* (1905), 22 R. P. C. 222, decided on the Act of 1883. It may further be argued that the right conferred by sect. 39 of the Act of 1905 is a franchise.

(*s*) *Goddard v. Goddard* (1918), 35 R. P. C. 21.

(*t*) *Oakey v. Dalton* (1887), 4 R. P. C. 313.

Jurisdiction. If a wrong is committed or threatened within the jurisdiction, leave may be obtained to issue a writ on a defendant domiciled outside the jurisdiction of the Court (*a*), but the order may be discharged on the defendant's application if the balance of convenience is against trial in this country (*x*).

Pleading and particulars. The plaintiff must show by his statement of claim whether he intends to rely on his statutory rights, or his rights independently of the statute, or both (*y*). If he alleges fraudulent intention on the part of the defendant, this must be pleaded (*z*), and particulars must be given of any cases of deception or attempted deception intended to be relied upon at the trial (*a*); but apart from such particular cases, evidence of sales which are only relevant to the quantum of damages may be reserved for the inquiry which will be ordered in appropriate cases (*b*). So also where a defendant alleges user by other traders of the mark which the plaintiff claims to be distinctive of his goods, he will be ordered to give particulars of any specific cases relied upon (*c*).

Discovery and inspection. If misrepresentation by the plaintiff is set up as a defence, this must be pleaded (*d*). Discovery and inspection will be ordered upon the usual principles, notwithstanding that the person required to make discovery might be liable to prosecution under the Merchandise Marks Act (*e*). The discovery ordered before trial must be material to the issues to be determined at the hearing (*f*).

(*a*) See R. S. C., O. XI. and notes thereto in the Annual Practice. As to deception abroad, see pp. 6, 27, *ante*.

(*x*) *E.g.*, *Kinahan v. Lyle* (1891), 8 R. P. C. 18, and see notes in the Annual Practice; and as to convenience, *Marshall v. Marshall* (1888), 38 Ch. D. 330.

(*y*) See p. 13, and *Andrew v. Kuchurich* (1913), 30 R. P. C. 93, 677.

(*z*) *Ash v. Luricta Manufacturing Co.* (1912), 28 R. P. C. 252, 597; 29 R. P. C. 465.

(*a*) *Humphries v. Taylor Drug Co.* (1888), 5 R. P. C. 687; *Whitstable, &c. Co. v. Hayling, &c. Co.* (1900), 17 R. P. C. p. 470; *Imperial Tobacco Co. v. Purnell*, 20 R. P. C. 718; but the names of the persons to whom the sales were made need not be given: *Duke v. Wisden* (1897), 77 L. T. N. S. 67; *Blackburn v. Lodge*, Ann. Practice, 1922, p. 497; and see Seb. p. 247.

(*b*) As to inquiry and account of profits, see p. 39.

(*c*) *Roake Roberts v. Wayland* (1909), 26 R. P. C. 249; *Anglo-Swiss, &c. Co. v. Pearks* (1903), 20 R. P. C. 509; *Aquascutum, Ltd. v. Moore*, *ibid.*, 640; *Schweppes v. Gibbens* (1905), 22 R. P. C. 116. See also *Star Cycle Co. v. Frankenburys* (1907), 24 R. P. C. 46, 405.

(*d*) See p. 35, *ante*.

(*e*) Merchandise Marks Act, 1887, s. 19.

(*f*) *E.g.*, *Howe v. McKernan* (1862), 30 Beav. 517; *Andrew v. Kuchurich* (1912), 29 R. P. C. 605.

and not merely to the issues which may become relevant on an inquiry as to damages or in taking an account of profits (*g*). When the latter stage is reached further discovery may be ordered (*h*). Discovery may also be ordered on a motion to rectify the register (*i*). Any order for discovery is also subject to the ordinary rule that it must not be oppressive or sought only for an ulterior purpose (*k*).

(*g*) *Fennessy v. Clark* (1887), 37 Ch. D. 184.

(*h*) *Leather Cloth Co. v. Hirschfeld* (1863), 1 H. & M. 295; *Powell v. Birmingham Vinegar Co.* (1897), 14 R. P. C. 1. It is a consideration to be borne in mind by a plaintiff in choosing between an account of profits and an inquiry as to damages that in the latter case, in order to ascertain the measure of his damages, some disclosure may have to be made as to how he arrives at the profits which he claims that he would have made.

(*i*) *Wills' T. M.* (No. 1), 9 R. P. C. 346.

(*k*) *Carver v. Pinto Leite* (1871), L. R. 7 Ch. 90; *Benbow v. Low* (1880), 16 Ch. D. 93.

TRADE MARKS ACT, 1905.

[5 EDW. 7, c. 15.]

Printed with Amendments made by the Act of 1919 *(a)*.*An Act to consolidate and amend the Law relating to Trade Marks.* [11th August, 1905.]

BE it enacted by the King's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Short title.

*1. This Act may be cited as the Trade Marks Act, 1905 *(a)*.

Commencement of Act.

*2. This Act shall, save as otherwise expressly provided, come into operation on the first day of April one thousand nine hundred and six *(b)*.

(a) The Trade Marks Act, 1905, has been amended by the Trade Marks Act, 1914 (see App. C.), and the Trade Marks Act, 1919. Parts I. and II. of the latter Act effect substantial changes in the law, and are noted separately. Part III. effects certain less material changes and also some amendments of a quite minor character. In this edition these are incorporated in the text of the Act of 1905, new words being included in brackets, the original wording of the Act of 1905 being shown in italics.

The Trade Marks Acts, 1905, 1914, and 1919, and so much of the Patents and Designs Acts, 1907-1919, as relates to trade marks (see App. A.), may be cited together as the Trade Marks Acts, 1905-1919.

*Sections, the whole or part of which is not applied to marks registered in Part B., are marked with an asterisk. See sect. 3 of the Trade Marks Act, 1919.

(b) The legislation in force immediately before that date was contained in the Patents, Designs and Trade Marks Acts, 1883-1902, and in considering decisions prior to April, 1906, the language of those Acts or of the earlier legislation must, of course, be considered.

As to the effect of the Act of 1905 on marks registered under previous Acts, see sect. 6 and notes thereto.

PART I.

Definitions (c).

Definitions.

3. In and for the purposes of this Act (unless the context otherwise requires):—

A "mark" shall include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof *(d)*:

- A "trade mark" shall mean a mark used or proposed to be used upon or in connexion with goods for the purpose of indicating that they are the goods of the proprietor of such trade mark by virtue of manufacture, selection, certification, dealing with, or offering for sale (*e*):
- A "registrable trade mark" shall mean a trade mark which is capable of registration under the provisions of this Act:
- "The register" shall mean the register of trade marks kept under the provisions of this Act (*f*):
- A "registered trade mark" shall mean a trade mark which is actually upon the register (*g*):
- "Prescribed" shall mean, in relation to proceedings before the Court, prescribed by rules of court, and in other cases, prescribed by this Act or the Rules thereunder (*h*):
- "The Court" shall mean (subject to the provisions for Scotland, Ireland, and the Isle of Man) His Majesty's High Court of Justice in England (*k*).

(*e*) The definitions of "mark," "trade mark" and "registrable trade mark" were introduced by this Act. In the earlier Acts, the only definition was one which took the form of an enumeration of the particulars which a trade mark, other than an "old mark," had to contain in order to be registrable, analogous to the provisions of sect. 9 of the present Act. The expression "mark" was used in such earlier Acts in a context with "device," "heading," and subsequently "brand," which made it necessary to construe those words as excluding marks consisting only of a name or word not otherwise registrable: *Leonard & Ellis' T. M.* (1884), 26 Ch. D. 288, 295; *Pirie v. Goodall* (1892), 9 R. P. C. 17.

There is now a logical sequence: to be registrable under the Act of 1905, a symbol must be, firstly, a mark, a requisite which relates to its inherent character; secondly, it must be a "trade mark," a condition which involves a connection between the mark and a trader; thirdly, it must be shown, subject to a proviso in favour of "old marks," to contain at least one of certain enumerated particulars, a fact which may be established either by reference to the inherent character of the mark or by evidence.

(*d*) Inasmuch as the enumeration does not purport to be exhaustive, the cases on the older Acts in which the meaning of "brand," "heading," &c. were discussed are no longer of importance, but the word "mark" itself implies the notion of something applicable to the goods or their covering: see *Singer Manufacturing Co. v. Wilson* (1876), 2 Ch. D. 434, 441. Such application may be effected by attaching a label or ticket to the goods, or by branding or stamping the mark on the actual article sold, as in the case of iron or soap, or by weaving the mark into the actual goods: *Harter v. Souvasoglu* (1875), W. N. 11, 101; and stripes of colour running throughout the

length of the article may constitute a "mark": *Reddaway & Co.'s Appn.* (1914), 31 R. P. C. 147, 153.

In respect of cotton goods, no mark consisting of a line heading alone has been registered for many years: see now sect. 61 (10) (b).

(e) As to the general effect of this definition, see p. 9. "Proposed to be used" means "proposed to be used in this country forthwith": *Neuchatel Co.'s Appn.* (1913), 30 R. P. C. 319.

"Manufacture, selection, &c.": where goods pass through different hands before reaching the public, difficult questions may arise as to who are the real proprietors of the mark. In each case, subject to the possible effect of sect. 41, the question is one of fact as to whether the mark indicates association with a particular manufacturer or a particular selector, &c., or a combination of two or more. Thus, a retailer or importer will not be entitled to registration as proprietor of a mark which in fact indicates the manufacturer: *Thorn & Sons v. Pimms* (1909), 26 R. P. C. 221; *Neostyle Manufacturing Co.'s T. M.* (1903), 20 R. P. C. 329, 803; *Apollinaris Co.'s T. Ms.* (1891), 8 R. P. C. 137; *European Blair Co.'s T. M.* (1896), 13 R. P. C. 600; nor can he successfully oppose the manufacturer's application to register: *Hala Fabrica's Appn.* (1910), 27 R. P. C. 493; contrast *Neuchatel Co.'s Appn.*, *supra*. Cf. cases in which an agent or retailer has failed in an action for infringement or passing off: *Richards v. Butcher* (1890), 7 R. P. C. 288; *Dental Manufacturing Co. v. De Trey* (1912), 29 R. P. C. 617; *Goodfellow v. Prince* (1887), 35 Ch. D. 9; *Hirsch v. Jonas* (1876), 3 Ch. D. 584 (interlocutory decision only). Contests between producer and retailer are illustrated by *Saxlehner v. Apollinaris Co.* (1897), 14 R. P. C. 615, and *Van Zeller v. Mason, Cattley & Co.* (1908), 25 R. P. C. 37. If a defendant in an action for infringement disputes the plaintiff's proprietorship of the mark, he should move to expunge the entry: *Apollinaris Co. v. Snook* (1890), 7 R. P. C. 174.

A mark may indicate the manufacturer of a metal, though it is only known to the public on goods finished by another hand: *Magnolia Metal Co.'s T. Ms.* (1897), 14 R. P. C. pp. 628 *et seq.* On the other hand, a mark may indicate a retailer, though actually applied by a manufacturer: *Defries v. Electric Ordnance Co.* (1906), 23 R. P. C. 341, or though used only on the goods of a particular manufacturer: *Ullman v. Leuba* (1908), 25 R. P. C. 673; and see *Knott v. Marshall* (1894), W. N. 214.

As to a selector's mark, see *Major v. Franklin* (1908), 25 R. P. C. 407.

Again, a mark may indicate the goods of a consignee abroad: *New Atlas Co.'s T. M.* (1918), 35 R. P. C. 269, or possibly those of a consignee abroad and a producer in Great Britain: *Rivière's T. M.* (1885), 53 L. T. 237. Similarly, where two or more parties are concerned in what is really a joint adventure, the meaning of the mark will in each case be a question of fact: *Robinson v. Finlay* (1877), 9 Ch. D. 487; *Re Tarantella* (1910), 27 R. P. C. 573, 762. With reference to the latter case, it must be observed that the right of either party to such an adventure to use the mark after the adventure has come to an end must be subject to the condition that the public should not be deceived: *Jones' T. M.* (1885), 53 L. T. N. S. 1; but

the joint adventure may be resumed, in which case there is no difficulty. Mere origination of the article or its get up will not give the originator any rights in respect of such get up or of a mark which indicates manufacture: *Franklin v. Pflenger* (1909), 28 R. P. C. 130; *Freeman v. Sharpe* (1899), 16 R. P. C. 205; and cf. *Coudy v. Mitchell* (1878), 37 L. T. N. S. 268, 766.

If a mark has gained a reputation as a manufacturer's mark, it may be deceptive for the proprietor to continue to use it if he ceases to manufacture, but this will depend on the particular circumstances: *Holpoint Co.'s Appn.* (1921), 38 R. P. C. p. 71.

"Certification": this word was probably included to meet the case of special trade marks introduced by sect. 62.

(f) As to the register, see sects. 4-7 and notes.

(g) As this section is applied to marks registered in Part B. under the Act of 1919, the expression "registered mark" will generally include marks registered in Part B., but as certain sections, e.g., sect. 11, are not applied, the phrase in such sections must be read as limited to marks registered in Part A.

(h) For Rules under the Act, see App. D. No special rules of Court relating to trade marks have as yet been made.

(k) See sects. 69--72.

Register of Trade Marks.

4. There shall be kept at the Patent Office for the purposes of this Act a book called the Register of Trade Marks, wherein shall be entered all registered trade marks with the names and addresses of their proprietors, notifications of assignments and transmissions, disclaimers, conditions, limitations, and such other matters relating to such trade marks as may from time to time be prescribed. The register shall be kept under the control and management of the Comptroller-General of Patents, Designs, and Trade Marks, who is in this Act referred to as the Registrar.

Register of
trade marks.

This section comes from sect. 78 of the Act of 1883. The Register is now divided into two parts, Part A. for marks registered under the Act of 1905 or prior Acts, Part B. for marks registered in, or removed to, Part B. under the Act of 1919; see p. 106.

As to the register of the Cutlers' Company for Sheffield Marks, see sect. 63, and as to the Manchester Branch of the Trade Marks Registry of the Patent Office, see sect. 64.

The Comptroller is appointed by the Board of Trade subject to the sanction of the Treasury: see sect. 63 of the Patents and Designs Act, 1907.

5. There shall not be entered in the register any notice of any trust expressed, implied, or constructive, nor shall any such notice be receivable by the Registrar.

Trust not to
be entered
on register.

This section comes from sect. 85 of the Act of 1883. Though not capable of entry on the register, trusts may be enforced: see sect. 38.

Under prior Acts, in order to correct an entry, where the person registered as proprietor was registered in circumstances which made him in law a trustee for the true owner, there was sometimes a difficulty raised which made it necessary first to expunge the existing entry, or to have a formal assignment: see notes to *Ward, Start & Sharp's T. M.* (1881), 44 L. T. 97; *Biviere's T. M.* (1885), 53 L. T. 237; *Kingsford & Son's Appn.* (1888), 6 R. P. C. 413; *Australian Wine Co.'s T. M.* (1885), 61 L. T. 427; *Greenlees' T. M.* (1892) 9 R. P. C. 93. Under the present Act this may be unnecessary if the registered proprietor makes the application himself, as sect. 32 of the Act of 1905 is not limited to clerical errors as was sect. 91 (b) of the Act of 1883.

In proper cases the defective title may also be made good by an assignment by the trustee: *Wellcome's T. M.* (1886), 3 R. P. C. 76.

If the existence of such a trust is disputed proceedings should be taken under sect. 35.

Incorporation
of existing
register.

*6. The register of trade marks existing at the date of the commencement of this Act, and all registers of trade marks kept under previous Acts, which are deemed part of the same book as such register, shall be incorporated with and form part of the register. Subject to the provisions of sections thirty-six and forty-one of this Act the validity of the original entry of a trade mark upon the registers so incorporated shall be determined in accordance with the statutes in force at the date of such entry, and such trade mark shall retain its original date, but for all other purposes it shall be deemed to be a trade mark registered under this Act.

The first sentence of this section corresponds to sect. 14 (2) of the Act of 1883. As regards the remainder of the section, it was previously the law that a mark was liable to be removed on the ground that it was not registrable on the facts and law as they stood at the date of registration: *Apollinaris Co.'s T. Ms.* (1891), 8 R. P. C. 137, 163. Sect. 36 of the Act of 1905 alters the law on this point, and leaves little on which sect. 6 can operate in this respect. Now that the Act of 1905 has been in force for more than seven years, the earlier statutes are no longer material as determining the validity of the original registration: see notes to sects. 36 and 41.

The words "trade mark registered under this Act" do not occur elsewhere in the Act; the meaning of the final sentence would seem to be that the rights conferred by registration should be the same for all trade marks, whether registered under previous Acts or under this Act; but see *Woodward v. Boulton Macro.* (1915), 32 R. P. C. 173, 196.

Inspection of
and extract
from register.

7. The register kept under this Act shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed; and certified copies, sealed with the seal of

the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

As to certificates, see Rules 99—101.

Registrable Trade Marks.

8. A trade mark must be registered in respect of particular goods or classes of goods. Trade mark must be for particular goods.

See Rule 5. A guide to the classification of goods is obtainable *gratis* from the Patent Office.

Registration ought only to be applied for in respect of the goods for which the mark is used or proposed to be used, and if registration for other goods is obtained the entry may be struck out or limited to some particular goods either upon the application of the proprietor (sect. 32 (4)) or of any person aggrieved (sect. 35 (1) and Trade Marks Act, 1919, s. 9). See notes to sect. 35. The classification contained in the third schedule to the Rules (App. D.) must not be taken as any guide upon the question whether different goods are of the same description for the purpose of sect. 19 or sect. 24; *Australian Wine Importers' T. M.* (1889), 6 R. P. C. 311; and see notes to sect. 19.

***9.** A registrable trade mark must contain or consist of at least one of the following essential particulars (a):— Registrable trade marks.

- (1) The name of a company, individual, or firm represented in a special or particular manner (b);
- (2) The signature of the applicant for registration or some predecessor in his business (c);
- (3) An invented word or invented words (d);
- (4) A word or words having no direct reference to the character or quality of the goods (e), and not being according to its ordinary signification a geographical name or a surname (f);
- (5) Any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the above paragraphs (1), (2), (3), and (4), shall not [be registrable under the provisions of this paragraph except upon evidence of its distinctiveness], *except by order of the Board of Trade or the Court, be deemed a distinctive mark: (See note (a).)*

Provided always that any special or distinctive word or words, letter, numeral, or combination of letters or numerals used as a trade mark by the applicant or his predecessors in business before

the thirteenth day of August one thousand eight hundred and seventy-five, which has continued to be used (either in its original form or with additions or alterations not substantially affecting the identity of the same) down to the date of the application for registration shall be registrable as a trade mark under this Act (*g*).

For the purposes of this section "distinctive" shall mean adapted to distinguish the goods of the proprietor of the trade mark from those of other persons. (*See note (a).*)

In determining whether a trade mark is so adapted, the tribunal may, in the case of a trade mark in actual use, take into consideration the extent to which such user has rendered such trade mark in fact distinctive for the goods with respect to which it is registered or proposed to be registered. (*See note (a).*)

(a) This section differs in material respects from the corresponding provisions in sect. 10 of the Act of 1875, sect. 64 of the Act of 1883, and sect. 10 of the Act of 1888.

The words in square brackets were substituted for the words in italics by sect. 7 of the Act of 1919. Before this change a special application under this sub-section was necessary in the case of a name, signature, word or words, other than such as fell within the preceding sub-sections, and the applicant was called upon to elect whether he would apply for the necessary order to the Board of Trade or to the Court. This preliminary application, which did not result in any final decision as to whether the mark was or was not distinctive (see *Crosfield's Appn.* (1909), 26 R. P. C. 837), is now unnecessary, and there is no longer any difference in *procedure* between applications for such trade marks and applications for other marks, but in the case of the former, evidence is essential, whilst in the case of the latter it is optional. Under the new procedure, when an application for a name or word is made, if the Registrar is of opinion that the mark does not fall within any of the sub-sects. (1) to (4), he can himself consider the question whether it falls within sub-sect. (5) without requiring a special application to be made.

It is conceived that the change was primarily intended to affect only the procedure, and not the principles upon which the tribunal should act in considering applications for words and names; but the absence of any limitation in regard to the character of the evidence required should meet an objection which has sometimes been raised, viz., that evidence is of little value unless it relates to user of the mark in the exact form for which registration is sought. This objection was based on the concluding words of the section interpreted in the light of old decisions on the Acts of 1875 and 1883 as to what constituted "user as a trade mark." It was suggested in *Lea's Appn.* (1913), 30 R. P. C. at p. 226, and relied upon in *Crawford's Appn.* (1917), 34 R. P. C. 94, but did not prevail in *Cadbury's Appn.* (1915), 32 R. P. C. 9. It is clear that evidence proving that "Cadbury's" had become distinctive must be relevant upon the issue as to whether "Cadbury" alone is adapted to distinguish.

Sub-sect. (d) was a new departure introduced by the Act of 1905, which makes it possible to obtain registration for a mark irrespective of its features, provided that it possesses the one essential quality of being adapted to distinguish the goods of the proprietor from those of other persons. The ambit of this sub-section is such as to reduce materially the importance of the other sub-sections; and as it introduces the word "distinctive," it is convenient to examine it first.

"Mark" is defined by sect. 3; see notes thereto. "Distinctive" is defined in the section itself. This definition, when read with the concluding paragraph, shows that the Act contemplates two factors which may contribute in giving to a mark the quality of being adapted to distinguish. There are, firstly, the features of the mark itself in relation to its proposed use as a trade mark, and, secondly, the effect which actual use of a trade mark may have produced. The first factor has sometimes been referred to as a quality inherent in the mark, and it has been said that it is not legitimate to speculate upon the effect which the grant of a monopoly by registration may produce: *Du Cros' Appn.* (1913), 30 R. P. C. 660, 671. It must, however, be observed that it is impossible to consider the mark entirely without regard to the use to which it is proposed to be put: *Diamond T. Motor Co.'s Appn.* (1921), 38 R. P. C. 373. Thus "match," though, no doubt, incapable of becoming distinctive as a trade mark for matches, is not inherently incapable of distinguishing other goods. The second factor is one by which distinctiveness may be acquired where a mark has already been used for the purpose of distinguishing the proprietor's goods: see observations in *Gramophone Co.'s Appn.* (1910), 27 R. P. C. 689, 697.

When such a mark comes up for consideration, the tribunal is not limited to an examination of the features of the mark considered in the abstract. It may then be possible to say that the question whether the mark is adapted to distinguish is solved by observing the extent to which the mark, or a mark substantially identical with it, does in fact distinguish: *Crosfield's Appn.* (1909), 26 R. P. C. 837, p. 857, 858. There may be marks, especially names and words, as to which it is possible to say that no amount of user can render them adapted to distinguish, e.g., a word which is a mere laudatory epithet and nothing else, such as "best," or the word "matches" as a trade mark for matches: see *Crosfield's Appn.*, *supra*, p. 858; *Gramophone Co.'s Appn.*, *supra*, p. 697. In the case of words, signatures and names, not within other sub-sections, the statute provides that the test of evidence *must* be applied; in other cases it is open to the applicant to satisfy the tribunal by evidence that a mark which at first sight might not appear adapted to distinguish, has proved to be so in fact. In any doubtful case an applicant will be well advised to file any evidence which may be available, and on this issue adoption and user abroad may be of assistance: *Diamond T. Motor Co.'s Appn.* (1921), 38 R. P. C. 373.

In so far as "adapted to distinguish" involves the notion of suitability, the restrictions or inconvenience which may be caused to other traders are material considerations, in reference to which the tribunal must exercise a judicial discretion: *Crosfield's Appn.* and *Du Cros' Appn.*, *supra*. Every decision must therefore be regarded

as given upon the particular facts of each case (see *Thorne v. Sandow* (1912), 29 R. P. C. 440, 451), and the observations and examples given below are only intended to indicate the trend of judicial decisions as a guide to persons selecting a trade mark: they must not be regarded as laying down principles applicable to all cases.

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Marks other than names, signatures or words.—In deciding whether a mark is distinctive, it must be looked at as a whole: *British Thomson-Houston Co.'s Appn.* (1917), 34 R. P. C. 169, 177; but if, when so viewed, the mark is seen to consist substantially only of a word or name which is not registrable without evidence, immaterial additions will not take it out of that category: see *Massachusetts Saw Works' Appn.* (1918), 35 R. P. C. p. 145. Under the former Acts an analogous principle was applied: e.g., *Bradley's T. M.* (1880), 9 R. P. C. 205, and cases cited in Sebastian, p. 596. But in reference to such cases it must be observed that the decisions turned on a construction of "mark" in sect. 64 of the Act of 1883, which is inapplicable to the Act of 1905 in view of the definition in sect. 3, and also that those cases are relevant now only on the question whether evidence is necessary, and not on the final question of registrability, when evidence is available: see observations on *Benz et Cie.'s Appn.* (1913), 30 R. P. C. 177, in *British Thomson-Houston Co.'s Appn.*, *supra*; *Diamond T. Motor Co.'s Appn.*, *supra*.

A picture of the article sold may be a distinctive device: *James' T. M.* (1885), 33 Ch. D. 392; though such a mark would no doubt be refused if it did not contain some feature adapted to distinguish it from any other picture of similar goods produced by other traders: see *Splinter Grip Co.'s T. M.* (1893), 10 R. P. C. 84, and *Moore's Modern Methods' Appn.* (1919), 36 R. P. C. 6. The protection afforded by such marks would in any case be narrow.

The portrait of an individual may similarly be a good mark, though not necessarily so in the case of an individual who is associated with the character of the goods in question: see *Anderson's Appn.* (1884), 26 Ch. D. 409 (portrait of Baron Liebig); cf. *Rowland v. Michell* (1897), 14 R. P. C. 37; *Louise v. Gainsborough* (1903), 20 R. P. C. 61.

Initials or letters are subject to the *prima facie* disadvantage that other traders may have the same initials, but user may establish distinctiveness, and initials may assist in making up a distinctive combination: *British Thomson-Houston Co.'s Appn.*, *supra* (B. T.-H. in a border, allowed); *Du Cros' Appn.* (1913), 30 R. P. C. 660 (W. & G. refused, the evidence of distinctiveness being too local); *Verschure & Zoon's Appn.* (1905), 22 R. P. C. 568 (Vezet allowed, with a disclaimer); *Garrett's Appn.* (1916), 33 R. P. C. 117 (Ogee refused). The extent to which combinations of letters may become distinctive trade marks is shown by the number of cases of successful actions in respect of such marks. See cases collected in Sebastian, pp. 90 *et seq.*, and *Liquid Veneer Co. v. Scott* (1912), 29 R. P. C. 639; *Andrew v. Kuehnrich* (1913), 30 R. P. C. 93, 677; *A. G. S. Manufacturing Co. v. Aeroplane General Sundries Co.* (1918), 35 R. P. C. 127; *O-T, Ltd. v. Cumming* (1915), 32 R. P. C. 69.

Registration in Part A. is refused for letter marks for classes 23 to 25 in pursuance of sect. 64 (10) (c).

In some cases distinctiveness has been claimed for a feature which has some purpose other than that of merely indicating trade origin, *e.g.*, a mechanical purpose, as in *Edge v. Nicolls* (1910), 27 R. P. C. 671, a passing oil case, and *Moore's Modern Methods' Appn.*, *supra*, where a claim was made to register an illustration of part of a patented device. In the latter case the application was refused on the ground that the grant of registration might in effect extend a patent monopoly, and it may be argued that a mark is not adapted to distinguish the goods of a trader if the production of the same goods by another trader would necessarily or naturally involve the reproduction of the mark. Sect. 9 (5).

Names. In connection with names it should be noted that names represented in a special or particular manner, and signatures of applicants or their predecessors are included in sub-sects. (1) and (2).

As regards names generally, the number of cases in which the use of a name has been proved to be calculated to deceive indicates the importance of names as distinguishing the goods or business of a trader (see p. 22); but before granting registration, the tribunal will always consider the possible interests of persons having the same name. This consideration must not, however, be exaggerated, and in the *Burford case* (1919), 36 R. P. C. 139, the principle was clearly recognised that the rights given by the registration of a name do not, in view of sect. 44, really alter for the worse the position of any honest person having the same name. Many surnames have been registered by order of the Board of Trade; the following cases have been considered by the Courts: *Pope's Electric Lamp Co's Appn.* (1911), 28 R. P. C. 629 (Pope, refused; the judgment has been criticised in the next case); *R. J. Lea, Ltd.'s Appn.* (1912), 30 R. P. C. 216 (Boardman's, refused); *McEwan's Appn.* (1912), 29 R. P. C. 165 (McEwan's, refused); "*Teofani*" *T. M.* (1913), 30 R. P. C. 446 (Teofani, upheld); *Slazengers, Ltd.'s Appn.* (1914), 31 R. P. C. 501 (Slazenger, refused); *Cadbury, Ltd.'s Appn.* (1915), 32 R. P. C. 9 (Cadbury, allowed); *Muratti, Sons & Co., Ltd.'s Appn.*, *ibid.* 77 (Muratti, allowed); *Daimler Co., Ltd.'s Appn.* (1916), 33 R. P. C. 337 (Daimler, allowed); *William Crawford & Sons, Ltd.'s Appn.* (1917), 34 R. P. C. 94 (Crawford, refused); *Moore's Appn.*, *ibid.* 154 (Moore & Moore, allowed); *Lodge Sparking Plug Co., Ltd.'s Appn.* (1918), 35 R. P. C. 222 (Lodge, allowed); *Burford & Co., Ltd.'s Appn.* (1919), 36 R. P. C. 139 (Burford, allowed on appeal); *Winget, Ltd.'s Appn.*, *ibid.* 75 (Winget, allowed); *Avery, Ltd.'s Appn.*, *ibid.* 89 (Avery, allowed); *Eno, Ltd.'s Appn.* (1920), 37 R. P. C. 1 (Eno, allowed); *Thornycroft, Ltd.'s Appn.*, *ibid.* 25 (Thornycroft, allowed). In addition to the above, a number of applications were allowed in 1921 without any opposition. They are reported in 38 R. P. C., and call for no special comment. The higher proportion of successful cases in recent years may be attributed perhaps in part to a fuller appreciation of the principles clearly enunciated in the *Burford case*, and partly to greater care on the part of the applicant in presenting his case to the Court. The most material considerations are that the area in which the name does in fact distinguish the applicant's goods should extend practically throughout the United Kingdom, that the name should not be too common, that the character of the trade should be such that names

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generally are adapted to distinguish the goods of different makers, and that the circumstances which have contributed towards making the name distinctive should be likely to continue. Other factors, as mentioned in the *Burford case*, may apply to particular applications. As to the possible effect of the amendment to sect. 9 (5) in regard to evidence of user of a name in a slightly different form to that applied for, see p. 50. *ante*; and as to use of the mark applied for in conjunction with another mark, see *Eno's Appn.*, *supra*.

The surname *Lawson Tail* has been registered for bedsteads in circumstances in which the name indicated a particular class of bed manufactured by the applicants: *Whitfield's Bedsteads, Ltd.'s Appn.* (1909), 26 R. P. C. 657.

Geographical names.—As to words which are not geographical in their ordinary signification, see sub-sect. (4) and notes thereto. Under sub-sect. (5), the principal consideration is whether registration would be likely to embarrass other traders, and conditions may be imposed to prevent any possibility of the name being used upon goods as to which, in its primary meaning as a geographical description, the word would be deceptive: *Apollinaris Co.'s Appn.* (1907), 27 R. P. C. 436 (Apollinaris, allowed subject to the applicants undertaking only to use the mark on water from the Apollinaris springs); *National Starch Co.'s Appn.* (1908), 25 R. P. C. 802 (Oswego, allowed); *California Fig Syrup Co.'s Appn.* (1909), 26 R. P. C. 846 (California Syrup of Figs, allowed); *Royal Worcester Corset Co.'s Appn.*, *ibid.* p. 185 (Royal Worcester, refused); *Itala Fabbrica, &c.'s Appn.* (1910), 27 R. P. C. 493 (Itala, allowed); *Karlsbad's Appn.* (1912), 29 R. P. C. 162 (Karlsbader Wasser, allowed); *Sheffield-Simplex, &c.'s Appn.* (1915), 32 R. P. C. 145 (Sheffield-Simplex, allowed); *Berna Motors, Ltd.'s Appn.*, *ibid.* p. 113 (Berna, allowed); and see *Burford's Appn.*, *supra*. In connection with geographical names, reference may be made to passing off cases: see p. 24.

Signatures.—The signature of the applicant or a predecessor in business may be registered without evidence under sub-sect. 2: see notes thereto. It is possible that a signature may be distinctive, where the mere name in ordinary script would not.

Words.—The express inclusion in sub-sect. 5 of words, other than such as fall within the previous sub-sections, shows that words may be registered although they have a direct reference to the character and quality of the goods. But in such cases, unless the word is uncommon, very cogent evidence will be required that throughout the United Kingdom the word, when applied to the goods in question, is so well known as indicative of a particular trader as almost to have lost its primary meaning. A mere laudatory epithet which ought to be open to the whole trade will not be allowed, nor words which are the obvious description of the goods in question, nor any mere mis-spelt version of such words: *Crosfield's Appn.* (1909), 26 R. P. C. 837 (Perfection, refused for soap); *Orlwoola T. M.*, *ibid.* 850 (Orlwoola, refused for woollen goods); see also *Sharpe v. Solomon* (1915), 32 R. P. C. 15 (Classic, for Christmas cards, removed, the evidence of distinctiveness being insufficient to support a case of passing off); *Thorne & Co. v. Sandow* (1912), 29 R. P. C. 440 (Health, for cocoa, removed); and cf. *Standard Ideal Co. v. Standard Manufacturing*

Co. (1910), 27 R. P. C. 789 (Standard, considered a mere descriptive epithet) **Sect. 9 (5).**

In the case of words which are popularly used as the name of an article, the question arises whether it is a "trade name" in the sense that it indicates not merely the article, but the article produced by one trader and no one else, some other name being available for the article produced by another trader. Well-known examples of such trade names are Vaseline and Bovril, registered under earlier Acts (see p. 57). Such words are generally invented words and registrable as such, but where the word, even though it is recognised in the trade as in fact used by only one manufacturer, has been adopted by the public as the name of the article by whomsoever made, it will not be registrable either as an invented word (see p. 56) or as a distinctive word under sub-sect. 5: *Cassella's Appn.* (1910), 27 R. P. C. 453 (Diamine refused for chemical substances); *Gramophone Co.'s Appn.*, *ibid.* 689 (Gramophone refused for talking machines); *Bowden Patents, Ltd.'s Appn.* (1909), 26 R. P. C. 205 (Bowden wire refused as the name of mechanism); *De Maid's Appn.* (1914), 31 R. P. C. 305 (Demos refused as the name for a particular description of fishing gut); *Williams's Appn.* (1917), 34 R. P. C. 1, 197 (Chocaroons refused as the name of a sweet).

Special provision is now made to meet the case of a word which is the name or the only practicable name of a patented article by sect. 6 of the Act of 1919. This question is further referred to in its bearing on cases of passing off (See p. 17.)

Examples of words within the sub-section are: "Primus" for stoves: *Hjorth's Appn.* (1910), 27 R. P. C. 461; "Overland" for motor cars, which was a word as well as a surname: *Willlys-Overland Co.'s Appn.* (1920), 37 R. P. C. 243; and as combinations of words. Sheffield-Simplex and California Syrup of Figs, referred to in relation to geographical names on p. 54.

In *Hotpoint Co.'s Appn.* (1921), 38 R. P. C. 63. "Hotpoint" was allowed for certain goods, though refused for others in respect of which it had already been used descriptively by another trader.

The limitation contained in sect. 64 upon the effect of registration of cotton marks, so far as it affected words, has been removed by sect. 12 of the Act of 1919.

(b) The word "company" in sub-sect. (1) was first introduced **Sect. 9 (1).** by the Act of 1905. A surname alone is not the name of an individual, nor is a part of a company's name the name of the company: *Ben: et Cie.'s Appn.* (1913), 29 R. P. C. 357; 30 R. P. C. 177; but such a name may be delineated or expressed, so as to constitute a distinctive device and therefore a distinctive mark registrable under sub-sect. (5) with or without evidence: *ibid.* In the last cited case evidence might have led the Court to a different conclusion: see *British Thomson-Houston's Appn.* (1917), 34 R. P. C. 169. The name of a merely fictitious character is not within sub-sect. (1), but within sub-sect. (4): *Holt's T. M.* (1896), 13 R. P. C. 16, 118. It was held, under the Act of 1883, that "Pirie's" in the genitive was not the name of an individual or firm: *Pirie v. Goodall* (1892), 8 R. P. C. 261; 9 R. P. C. 77. The name of a company in ordinary script is not within the sub-section: *British Milk Product Co.'s*

Appn. (1915), 32 R. P. C. 453. The different wording of the former Acts must be borne in mind in considering such cases as *Carroll's Appn.* (1899), 16 R. P. C. 82; *Gianacchi's T. M.* (1889), 6 R. P. C. 468; *Price's Patent Candle Co.'s Appn.* (1884), 27 Ch. D. 681; *Bradley's T. M.* (1892), 9 R. P. C. 205.

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(c) In sub-sect. (2) the words "applicant for registration or some predecessor in his business" replace the words "individual or firm applying for registration" in sect. 10 of the Act of 1888. It may be doubted whether a company can have a signature: see *British Milk Product Co.'s Appn.*, *supra*; and it would seem clear that an assumed name in the form of a signature cannot come under this sub-section, as was admitted in *Macmillan v. Ehrmann Bros., Ltd.* (1904), 21 R. P. C. 357, p. 367.

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(d) *Invented words.*— The leading case on this subject is the "*Solio*" case, decided on similar words in sect. 10 of the Act of 1888: *Eastman Photographic Materials Co.'s Appn.* (1898), 15 R. P. C. 476, from which it follows that a word is not necessarily excluded from sub-sect. (3) because it has a reference to the character or quality of the goods. All previous decisions must be reviewed in the light of that case.

The sub-section suggests four points for discussion, viz.: the materiality of (1) the person who invented the word; (2) the date of the invention; (3) the purpose for which the word was invented; (4) the quantum of the invention. The context in which the sub-section appears suggests that the reason for distinguishing invented from non-invented words is that restrictions should be placed upon the power to register the latter in order to limit the monopolising of words which, as applied to the goods in question, may be useful to traders in their ordinary meaning. The material point would therefore seem to be the use which has been made of the word prior to the date of the application; if, before that date, the word has never been used except as the trade mark of a particular business, the identity of the actual inventor, the purpose which he had in mind, and the date of the invention would none of them be directly material, although each of these questions might be relevant in deciding whether the word has been so used as to have become by the date of the application a part of the ordinary English language. It is clear that invention by a predecessor in business is sufficient: *Linotype Co.'s Appn.* (No. 2) (1900), 17 R. P. C. 380 (*Tachytype*), and an interval between the dates of the invention and the application to register is not necessarily fatal: *ibid.*; *Kodak, Ltd. v. London Stereoscopic Co., Ltd.* (1903), 20 R. P. C. 337 (*Kodak*); *Société le Ferment's Appn.* (1912), 29 R. P. C. 497 (*Lactobacilline*), disapproving of conclusions to the contrary which might be drawn from the words used in *Hommel v. Bauer* (1904), 21 R. P. C. 576; *Norton Co.'s Appn.* (1919), 36 R. P. C. 153 (*Alundum*). The expressions of Lindley, L. J., in *Holl's T. M.* (1896), 13 R. P. C. 118, p. 121, with reference to *Tailby*: "it may have been once an invented word; but it long ago became too well known to fall under that head," support the view suggested above that, if the word was at some time an invented word, the real test of registrability is whether, before the date of the application, the word has acquired a

known meaning other than an indication of the goods of a particular business. See also cases where a word, though perhaps originally invented, was invented as, or has become, the name of the goods: *Gestetner's T. M.* (1907), 25 R. P. C. 156 (Cyclostyle); *Philippart v. Whiteley* (1908), 25 R. P. C. 565 (Diabolo); *Formalin Co.'s Appn.* (1900), 17 R. P. C. 486 (Formalin); *Williams's, Ltd.'s Appn.* (1917), 34 R. P. C. 197 (Chocaroons); and p. 55. Sect. 9 (3).

As regards the quantum of invention, nothing analogous to merit is necessary, but there must be invention and not the mere semblance of invention: *Eastman Photographic Materials Co.'s Appn.*, *supra*. The mere introduction of a foreign word is not enough, but the fact that a word which would otherwise be regarded as invented does in fact occur in a foreign language is not necessarily fatal: *Ibid.* The mere mis-spelling or collocation of known words or initials is not invention: *National Biscuit Co.'s Appn.* (1901), 18 R. P. C. 170; 19 R. P. C. 281 (Unceda); *Re "Orlwoaba" T. M.* (1910), 26 R. P. C. 681, 850; *Garrett's Appn.* (1916), 33 R. P. C. 117 (Ogee); *Eisman & Co.'s Appn.* (1920), 37 R. P. C. 134 (Eanco); nor possibly the mere reversal of the letters of a known name: *Cordling's Appn.* (1916), 33 R. P. C. 70, 83, 325 (Gnidroe). In addition to the cases cited, the following cases, which do not include any of those in which registration was refused before the "*Solio*" case, may also be referred to: *Kynoch & Co.'s Appn.* (1897), 14 R. P. C. 995 (Kynite, registration allowed); *Densham's T. M.* (1895), 12 R. P. C. 75, 271 (Mazawattee, registration upheld); *Field v. Wegel* (1900), 17 R. P. C. 266 (Savonol, registration upheld); *Neostyle Manufacturing Co.'s T. M.* (1903), 20 R. P. C. 329, 333, 803 (Neostyle, registration upheld); *Kodak, Ltd. v. London Stereoscopic Co.* (1903), 20 R. P. C. 337 (Panoram, removed; Kodak, upheld); *Warwick Trading Co. v. Urban* (1904), 21 R. P. C. 240 (Bioscope, removed); *Christy v. Tipper* (1904), 21 R. P. C. 97, 755 (Absorbine, removed); *Verschure & Zoon's Appn.* (1905), 22 R. P. C. 568 (Vezet, registration allowed); *Lindstroem's Appn.* (1914), 31 R. P. C. 231 (Parlograph, registration allowed); *Yalding Co.'s Appn.* (1916), 33 R. P. C. 285 (Arsenoid, refused); *Standard Woven Fabric Co.'s Appn.* (1918), 35 R. P. C. 53 (Stanwal, registration allowed).

The Act of 1883 did not include invented words in the categories of essential features, but included "fancy words not in common use." Cases decided on that Act are not properly applicable in determining whether a word is invented, and those in which registration was refused are of little assistance: see the *Solio case*, *supra*. But cases where the objection that the word was descriptive were overruled are frequently cited. See cases collected in Sebastian, p. 54, and especially *Bovril Co.'s T. M.* (1896), 13 R. P. C. 382 (Bovril), and *Burroughs, Wellcome & Co.'s T. M.* (1904), 22 R. P. C. 164 (Tabloid). See also *Chesebrough Co.'s T. M.* (1902), 19 R. P. C. 342 (Vaseline).

(e) "A word or words having no direct reference to the character or quality of the goods." The word "direct" did not appear in the corresponding sect. 10 of the Act of 1883, and consequently decisions refusing registration under that Act must be reconsidered: *e.g.*, *Printing Machinery Co.'s Appn.* (1905), 23 R. P. C. 38. On the other hand, cases in which it was held that there was no reference are a Sect. 9 (4).

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fortiori authorities that there was no direct reference: e.g., *Pinto v. Badman* (1891), 8 R. P. C. 181 (El Destino, for cigars, does not suggest that the goods are foreign); *Densham's T. M.* (1895), 12 R. P. C. 271 (Mazawattee, for tea); *Holt's T. M.* (1896), 13 R. P. C. 118 (Trilby, for millinery); *Kynoch's T. M.* (1897), 14 R. P. C. 905 (Kynite, for explosives); *Eastman & Co.'s T. M.* (1898), 15 R. P. C. 476 (Solio, for printing paper); *Kodak v. London Stereoscopic Co.* (1903), 20 R. P. C. 337 (Brownie, Bullseye, Kodak, for films); *Ellis & Co.'s Appn.* (1904), 21 R. P. C. 617 (Quaker, for fermented liquors). For a list of cases in which the descriptive character of a word has been discussed, see Sebastian, pp. 76 and 77.

The question whether a word has a direct reference to the character or quality of the goods may depend upon all the circumstances of its user, since these may affect its meaning. Thus the word "National" was allowed in the case of a cash register company whose machines had been known under that name for years, and has been allowed by the Registrar in other cases, but was refused by him for seeds and for hollow ware, his decision in the latter case being upheld by the Court as a proper exercise of his discretion, Astbury, J., pointing out that as applied, for example, to flags, the word would be clearly descriptive: *National Cash Register Co.'s Appn.* (1917), 34 R. P. C. 273, 354; *National Galvanizers, Ltd.'s Appn.* (1920), 37 R. P. C. 202, p. 216. Cf. *Colgate's Appn.* (1913), 30 R. P. C. 262 (Ribbon, refused for a dentifrice sold in tubes from which it was squeezed as a ribbon). "Standard" was considered merely descriptive in *Standard Ideal Co. v. Standard Manufacturing Co.* (1912), 27 R. P. C. 789. The name used to describe an article without reference to origin cannot be registered under this subsection: see cases cited in the last note, and *De Maid's Appn.* (1914), 31 R. P. C. 305; nor a mere laudatory epithet: *Massachusetts Saw Works' Appn.* (1918), 35 R. P. C. 137, p. 146; and see cases cited on p. 54. The following further cases, decided under the Act of 1905, may be referred to: *Compagnie Industrielle des Petroles' Appn.* (1907), 24 R. P. C. 585 (Motorine, registration upheld for lubricants); *Société le Ferment's Appn.* (1912), 29 R. P. C. 497, p. 504 (Lactobacilline, considered to have no reference to alimentary goods, &c.); *Lindstroem's Appn.* (1914), 31 R. P. C. 261 (Parlograph, allowed for talking machines).

As to cases on "fancy words" relevant to the question of descriptiveness of the goods, see end of note (d).

(f) "Not being in its ordinary signification a geographical name or a surname." The words "according to its ordinary signification" and "or a surname" were introduced by the Act of 1905. Decisions refusing names as geographical under the former Act may therefore require reconsideration: e.g., *Salt & Co.'s Appn.* (1894), 11 R. P. C. 517 (Eboline); but even under the old Act, where the geographical signification was in the nature of an accidental coincidence, registration was allowed: *Magnolia Metal Co.'s T. Ms.* (1897), 14 R. P. C. 265, 621; *Densham's T. M.* (1895), 12 R. P. C. 75, 271 (Mazawattee). For decisions under the Act of 1905, see *Brock v. Pain* (1912), 28 R. P. C. 461, 697 (Crystal Palace, for fireworks, upheld); *Standard Woven Fabric's Co.'s Appn.* (1918), 35 R. P. C. 53 (Stan-

wal, allowed). It should be noted that geographical names and surnames may be registered in proper cases under sub-sect. 5: see pp. 53, 54. Sect. 9 (4).

As to geographical names appearing on a label registrable now under sub-sect. (5), see *Clement et Cie.'s T. M.* (1900), 16 R. P. C. 173, 611 (St. Raphael).

(g) *Old marks.*—This proviso is a more liberal form of similar savings in earlier Acts for trade marks used as such before registration was introduced. The extension which permits registration "either in its original form or with additions or alterations not substantially affecting the identity of the same" removes difficulties which previously led to the refusal of many applications. The period which has elapsed since 1875, and the more liberal provisions of the Act of 1905 as to the registrability of new marks, reduces the importance of this proviso. Some of the cases decided under the old Acts, though the corresponding provision is different, may be referred to as interpreting the phrase "user as a trade mark" and "user" where that word has the same meaning. The material point in considering whether a mark has been used as a trade mark is not so much the intention of the trader as the effect upon the public: *Richards v. Butcher* (No. 2) (1891), 8 R. P. C. 249; *Powell's T. M.*, 10 R. P. C. 195; 11 R. P. C. 4. User as a merely descriptive term is not user as a trade mark: see *Leonard & Ellis' T. M.* (1884), 26 Ch. D. 288, and pp. 20 and 54. *supra.* The fact that another trade mark is used in association with the mark claimed to be used as a trade mark may be of importance in considering whether the latter is really a trade mark or a description: *Williams' Appn.* (1917), 34 R. P. C. p. 203; but it is by no means conclusive, as the association of a general "house" mark with other marks for special classes of goods is a common practice: *Andrew v. Kuehnrich* (1913), 30 R. P. C. pp. 695, 697. Nor does the addition of a trader's name to a word mark negative the conclusion that the latter is a true trade mark: *Imperial Tobacco Co. v. De Pasquati* (1918), 35 R. P. C. p. 208, though such use may be a material consideration: *Horlick's Malted Milk Co. v. Summerskill* (1917), 34 R. P. C. 63; *Perry Davis v. Harbord* (1890), 7 R. P. C. 336. Sect. 9,
Proviso.

Where old user is necessary, the user must have been user in the United Kingdom: *Mecus' Appn.* (1891), 8 R. P. C. 25; and cf. *Neuchatel Co.'s Appn.* (1913), 30 R. P. C. 349; and although it may be sufficient if the user has been for the purpose of sales abroad, the mark must have been applied for the purpose of distinguishing the applicant's goods and not those of the consignee abroad. See *New Atlas Co.'s T. M.* (1918), 35 R. P. C. at p. 275, and note (e), p. 46. Sales in the United Kingdom by third parties may be sufficient to establish the reputation of a foreign manufacturer: *Panhard v. Panhard* (1901), 18 R. P. C. 405; *Poiret v. Poiret* (1920), 37 R. P. C. p. 187. As to the importance of user abroad on the question whether a mark is "adapted to distinguish," see p. 51.

10. A trade mark may be limited in whole or in part to one or more specified colours, and in such case the fact that it is so limited shall be taken into consideration by any tribunal having Coloured
trade marks.

to decide on the distinctive character of such trade mark. If and so far as a trade mark is registered without limitation of colour it shall be deemed to be registered for all colours.

This provision was new in 1905, the previously existing provision as to colour being found in sect. 67 of the Act of 1883, as amended by sect. 11 of the Act of 1888. Colour may now be an element sufficient to render distinctive a mark which would previously have been refused, as in *Hanson's Appn.* (1887), 37 Ch. D. 142; see *Reddaway's Appn.* (1914), 31 R. P. C. 147. When a trade mark contains matter which, irrespective of colour, is distinctive, it is obviously inadvisable to limit the registration to a particular colour, as this might leave it open to a rival to imitate the mark in a different colour. Limitation to particular colours or exclusion of one colour may also be imposed under sect. 12 as amended (q.v.) as a condition of allowing registration: *Reddaway's Appn.*, *supra*; *Re Jeffrey & Co.* and *Re Johnson Philpott & Co.*, *Supra*, p. 602.

It is evident that colour may be a material element in considering the degree of resemblance between two marks. See *Worthington's Appn.* (1880), 14 Ch. D. 8; *Re Robinson*, 29 W. R. 31; *Mitchell v. Henry* (1880), 15 Ch. D. 181; *Texas Co.'s Appn.* (1914), 31 R. P. C. 53. It is, therefore, necessary to consider the possible effect of colour upon a question of resemblance under sects. 11 or 19: *Société des Verrières' T. M.* (1894), 10 R. P. C. 436; 11 R. P. C. 142.

Restriction
on registra-
tion.

11. It shall not be lawful to register as a trade mark or part of a trade mark any matter, the use of which would by reason of its being calculated to deceive or otherwise be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

This section is derived from sects. 73 and 86 of the Act of 1883.

It has been held that this section is in the nature of a proviso to sect. 9, so that the words "disentitled to protection" involve some positive objection to the mark other than the mere fact that it did not include any of the essential particulars required by sect. 9: *Imperial Tobacco Co. v. De Pasquali* (1918), 35 R. P. C. 185, overruling *Wipfall v. Jackson* (1916), 33 R. P. C. 97. In considering the section as a ground for removing a mark already registered, as distinguished from a ground for objection prior to registration, it may become material to consider the time at which its effect is to be taken into account, particularly having regard to the reference to this section contained in sect. 41. See the last cited case and observations therein on *Woodward v. Boulton Macro* (1915), 32 R. P. C. 173, and notes, p. 85, *post*.

On applications for registration the onus of proving that a trade mark is not calculated to deceive is on the applicant: *Euo v. Dunn* (1890), 15 A. C. 252; 7 R. P. C. 311; and in doubtful cases the discretion of the Registrar and of the Court is exercised against the applicant, especially in the case of new marks: see, for example, *Sandow's Appn.* (1914), 31 R. P. C.

196: *United Kingdom Tobacco Co.'s Appn.* (1915), 29 R. P. C. 489. The existence of similar marks used by other traders, whether registered or not, is a common ground for refusal under this section or sect. 19 (*q.v.*): see *Albert Baker & Co.'s Appn.* (1908), 25 R. P. C. 513; as to the length of user relied upon by other traders, see *Kerrick & Jefferson's Appn.* (1909), 26 R. P. C. 641, and *Southall & Barclay's Appn.* (1911), 28 R. P. C. 481. Subject to what has been said above as to the onus of proof, the degree of similarity which will lead to the refusal of a mark is a question of fact to be decided in each case by reference to considerations similar to those relevant to an action for infringement or passing off by the use of a mark (see p. 28), the description of goods, the class of customer, the practice of the trade, the appearance of the mark in actual use, all being material: see, for example, *Crook's T. M.* (1914), 31 R. P. C. 79; *Brown Co.'s Appn.* (1921), 38 R. P. C. 15; *Currie's Appn.* (1896), 13 R. P. C. 681; *Farrow's Appn.* (1890), 7 R. P. C. 260; *Rosing's Appn.* (1878), 54 L. J. Ch. 975; and notes to sects. 10 and 19.

If the applicant's mark has been in use for some time, even if only in a foreign country, it will receive more favourable consideration, as no suspicion will attach to the application: *Soc. Dubouche's Appn.* (1915), 32 R. P. C. 241. On the other hand, the probability of deception in a foreign country may be material if there is reason to suspect fraudulent intention on the part of the applicant, but a mark ought not to be refused where the only objection is that the mark, if used abroad, might possibly deceive some foreigners: contrast *Dewhurst's Appn.* (1896), 13 R. P. C. 288, and *Soc. des Ferreries' Appn.* (1894), 11 R. P. C. 142, with *Bagots, Hutton & Co.'s Appn.* (1916), 33 R. P. C. 357, and *Soc. Dubouche's Appn.*, *supra*. Such possibility may now be avoided by imposing a geographical limitation under sect. 12.

The probability of deception must be serious and not merely fanciful: *Bass' T. M.* (1902), 19 R. P. C. 529, at p. 544; *Angus Watson's Appn.* (1911), 28 R. P. C. 313; *Sunbeam Co.'s Appn.* (1916), 33 R. P. C. p. 398. On the other hand, the Registrar is not bound to surrender his opinion that deception is probable because the owner of a similar mark consents to the application: *Dewhurst's Appn.*, *supra*. The public, as well as any individual opponent, must be considered: *Havana Commercial Co.'s Appn.* (1916), 33 R. P. C. 399.

Apart from similarity to an existing mark, there are many other grounds upon which a question as to whether a mark is calculated to deceive may arise:—statements or suggestions as to origin: *Kutnow's Appn.* (1893), 10 R. P. C. 401; *McGlenon's Appn.* (1912), 25 R. P. C. 797; *Royal Worcester Corset Co.'s Appn.* (1909), 26 R. P. C. 385; *Van de Leeuw's Appn.* (1912), 28 R. P. C. 708; or as to Royal patronage: *Royal Worcester Corset Co.'s Appn.*, *supra*; *Royal Baking Powder Co.'s Appn.* (1902), 19 R. P. C. 261; *Imperial Tobacco Co.'s T. M.* (1915), 32 R. P. C. 361 (and see App. D., rule 12); a suggested claim to monopoly: *Hayward's T. Ms.* (1885), 54 L. J. Ch. 1003; *Smokeless Powder Co.'s Appn.* (1892), 9 R. P. C. 109; *Apollinaris Co.'s T. M.* (1891), 8 R. P. C. p. 163; registration by a servant or other party not the true

proprietor: *Ex parte Lawrence Bros.* (1878), 44 L. T. 98; *Jones' T. M.* (1885), 53 L. T. 1; *Thorne v. Pinns* (1909), 26 R. P. C. 221; *Casson's T. M.* (1910), 27 R. P. C. 65; *New Atlas Co.'s T. M.* (1918), 35 R. P. C. 269; *Walker & Sons, Ltd. v. Kego* (No. 1) (1921), 38 R. P. C. 25; false name and address: *Hill's T. M.* (1893), 10 R. P. C. 113; previous association of the mark with false statements: *Wood v. Butler* (1883), 3 R. P. C. p. 88; *Fuente's Appn.* (1891), 8 R. P. C. 214; but see *Cohen's T. M.* (1922), 39 R. P. C. 33; *Paterson v. Kit Coffee Co.* (1910), 27 R. P. C. 594; use of words suggesting a false claim as to what is the trade mark or to registration: *Apollinaris Co.'s T. M.* (1891), 8 R. P. C. p. 164; *Wills' T. M.* (1893), 10 R. P. C. 269; *Hammond v. Malcolm, Bruncker & Co.* (1892), 9 R. P. C. 301; *Lyle & Kinahan's Appn.* (1907), 24 R. P. C. p. 260; *Bass, &c.'s T. M., supra*; *Massachusetts Saw Works' Appn.* (1918), 35 R. P. C. p. 145; and see sect. 67. As to the use of the word "patent," see Rule 11 and p. 34, *ante*.

The registration as a trade mark of a word which is in truth only the name of the article may perhaps be deceptive within the section: see *Palmer's T. M.*, 21 Ch. D. p. 58; *Philippart v. Whiteley, Ltd.* (1908), 25 R. P. C. 565; and there would no doubt be deception if the mark had a descriptive meaning and the article did not answer the description: *Edge's T. M.* (1891), 8 R. P. C. 207; *Walker & Sons, Ltd. v. Kego* (No. 2) (1921), 38 R. P. C. 31; and cf. *Crosfield's Appn.*, (1910) 1 Ch. 130, at pp. 142, 150; 26 R. P. C. 837. The possibility that registration of a mark containing elements which are common to the trade might be deceptive by leading to the belief that one or more of such elements alone was protected by the registration may be avoided by requiring a disclaimer: e.g., *Diamond T. Motor Co.'s Appn.* (1921), 38 R. P. C. 373.

Registration of Trade Marks.

Application
for registra-
tion.

*12. -(1 Any person claiming to be the proprietor of a trade mark who is desirous of registering the same must apply in writing to the Registrar in the prescribed manner (a).

(2 Subject to the provisions of this Act the Registrar may (b) refuse such application, or may accept it absolutely or subject to conditions, amendments, or modifications, [or to such limitations, if any, as to mode or place of user or otherwise, as he may think right to impose] (c).

(3 In case of any such refusal or conditional acceptance the Registrar shall, if required by the applicant, state in writing the grounds of his decision and the materials used by him in arriving at the same, and such decision shall be subject to appeal to the Board of Trade or to the Court at the option of the applicant.

(4 An appeal under this section shall be made in the prescribed manner (d), and on such appeal the Board of Trade or the Court, as the case may be, shall, if required, hear the applicant and the Registrar, and shall make an order determining whether, and

subject to what conditions, amendments, or modifications, if any [or to what limitations, if any, as to mode or place of user or otherwise,] the application is to be accepted.

(5) Appeals under this section shall be heard on the materials so stated by the Registrar to have been used by him in arriving at his decision, and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Registrar, other than those stated by him, except by leave of the tribunal hearing the appeal (e). Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of costs on giving notice as prescribed.

(6) The Registrar or the Board of Trade or the Court, as the case may be, may at any time, whether before or after acceptance, correct any error in or in connexion with the application, or may permit the applicant to amend his application upon such terms as they may think fit.

This section is derived from sect. 62 of the Act of 1883, as amended by sect. 8 of the Act of 1888. The words in brackets were introduced by sect. 12 of the Act of 1919.

(a) See Rules 16 *et seq.*; and as to special trade marks under sect. 62, Rules 36 *et seq.*; applications to the Cutlers' Co., Rules 104 *et seq.*; applications for cotton marks, Rules 110 *et seq.* Printed instructions to applicants may be obtained from the Patent Office.

As to what is a trade mark, see p. 45; and as to who may claim to be the proprietor, see p. 46.

(b) A further alternative, viz., that of registering the mark in Part B., has been added by sect. 5 of the Act of 1919.

As to rules in relation to the Registrar's discretion, see Rules 78-81, and Rules 11-15 as to cases there specified.

The question as to how far the word "may" imports a discretion on the part of the Registrar has been much discussed. In any case, it is now expressly provided that the Court, on appeal, has and must exercise the same discretion: Trade Marks Act, 1919, s. 8 (2); *National Galvanizers' Appn.* (1920), 37 R. P. C. 202; *Diamond T. Motor Co.'s Appn.* (1921), 38 R. P. C. 373. Such discretion as exists can only be exercised in accordance with principles to be deduced from the Act itself: *Euo v. Dunn* (1890), 7 R. P. C. 311; *De Cros' Appn.* (1913), 30 R. P. C. 660, and cannot be made a ground for refusing a mark where the applicants will not accept a condition which the Act does not authorise the Registrar to impose: *B. S. A. Co.'s Appn.* (1907), 24 R. P. C. 563. A formula, at one time adopted by the Registrar, "for these reasons, and also in the exercise of my discretion, the application is refused," has been disapproved: see *National Cash Register Co.'s Appn.* (1917), 34 R. P. C. p. 281, affirmed p. 354. Cf. *Standard Woven Fabric Co.'s Appn.* (1918), 35 R. P. C. 55, 58, which clearly states that the object of the register

is to enable trade marks to be put upon it; and see the references to official practice in *Cadbury's Appn.* (1915), 32 R. P. C. p. 462. *Garrett's Appn.* (1916), 33 R. P. C. 117, in which the mark "Ogee," though within the literal words of sect. 9 (4), was refused as being in substance only the letters O. G., which would in the circumstances have been refused under sect. 9 (5), must be regarded as an exceptional case.

Failure by the applicant to comply with the provisions of another statute, unless amounting to a deliberate defiance of the law, is not a ground for refusing registration: *Mann's Appn.* (1919), 36 R. P. C. 189; *Albert Baker & Co.'s Appn.* (1908), 25 R. P. C. 513.

(c) Under this sub-section, a condition as to mode of user may be imposed which is necessary to ensure that the mark as used in practice will be distinctive: *Reddaway's Appn.* (1914), 31 R. P. C. 147. The decisions in *Dewhurst's Appn.* (1896), 13 R. P. C. 288, and *Crispin's Appn.* (1917), 34 R. P. C. 249, 349, are no longer authoritative in view of the words added to the section by the Act of 1919. In *Apollinaris Co.'s Appn.* (1907), 24 R. P. C. 436, an undertaking as to the goods to which the mark should be applied was required to prevent the mark from becoming deceptive. See also Rule 15.

(d) As to appeals to the Court, see Rule 122; and appeals to the Board of Trade, Rules 123 *et seq.*; and as to withdrawal of an appeal, Rule 129. As to practice on appeals generally, see p. 67, *post*. The Board of Trade has power to refer an appeal to the Court: sect. 59.

A refusal by the Board of Trade on appeal is final; an appeal to the Court is subject to further appeal in the usual way. A decision at this preliminary stage, before advertisement, is open to reconsideration in subsequent proceedings upon an opposition: *Neuchatel Co.'s Appn.* (1913), 30 R. P. C. p. 355.

(e) As the Registrar cannot be ordered to pay costs in the case of an appeal being successful, leave to file further evidence is readily given and may materially affect the case: *e.g.*, *British Thomson-Houston Co.'s Appn.* (1917), 34 R. P. C. 169.

Where the application has been refused by the Registrar, before advertisement, on account of similarity to another registered mark, it is convenient that the owner of such mark should be served, so that he may appear to oppose if he wishes: *Royal Worcester Corset Co.'s Appn.* (1909), 26 R. P. C. 185. See also *Shamrock & Co.'s Appn.* (1907), 24 R. P. C. 569; *Carborundum Co.'s Appn.* (1909), 26 R. P. C. 504; *Itala Fabbrica's Appn.* (1910), 27 R. P. C. 493; *Neuchatel Co.'s Appn.* (1913), 30 R. P. C. 349; and cases under the previous Acts cited *Seb.* p. 374. In the *Royal Worcester case*, a party served with notice of a special application under sect. 9 (5) obtained an order for security for costs against the applicants, a foreign corporation: *Seb.* p. 376.

Advertisement of application.

13. When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions [and limitations], the Registrar shall, as soon as may be after such acceptance, cause the application as accepted to be advertised in the prescribed manner. Such advertisement shall set forth all

conditions [and limitations] subject to which the application has been accepted. [Provided that an application under the provisions of subsection (5) of section 9 of this Act may be advertised by the Registrar on receipt of such application and before acceptance.]

This section is derived, with modifications, from sect. 68 of the Act of 1883, as amended by sect. 12 of the Act of 1888. The words in brackets were introduced by sect. 12 of the Act of 1919.

As to advertisement, see Rules 41—44.

The proviso, taken in conjunction with the amendment to sect. 9 (5), enables the Registrar to defer any decision as to whether a mark tendered for registration under sect. 9 (5) is distinctive or is open to objection under sects. 11 or 19 until any opposition raised by third parties after advertisement is heard. A preliminary decision upon evidence which may be incomplete can thus be avoided.

14. (1) Any person may, within the prescribed time from the date of the advertisement of an application for the registration of a trade mark, give notice to the Registrar of opposition to such registration (a). Opposition to registration.

(2) Such notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition (b).

(3) The Registrar shall send a copy of such notice to the applicant, and within the prescribed time after the receipt of such notice, the applicant shall send to the Registrar, in the prescribed manner, a counter-statement of the grounds on which he relies for his application, and, if he does not do so, he shall be deemed to have abandoned his application.

(4) If the applicant sends such counter-statement, the Registrar shall furnish a copy thereof to the persons giving notice of opposition, and shall, after hearing the parties, if so required, and considering the evidence, decide whether, and subject to what conditions [or what limitations as to mode or place of user or otherwise], registration is to be permitted.

(5) The decision of the Registrar shall be subject to appeal to the Court *or, with the consent of the parties, to the Board of Trade.*

(6) An appeal under this section shall be made in the prescribed manner (c), and on such appeal *the Board of Trade or the Court, as the case may be,* shall, if required, hear the parties and the Registrar, and shall make an order determining whether, and subject to what conditions, if any [or what limitations, if any,

as to mode or place of user or otherwise, registration is to be permitted (d).

(7) On the hearing of any such appeal any party may either in the manner prescribed or by special leave of the tribunal bring forward further material for the consideration of the tribunal (e).

(8) In proceedings under this section no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Registrar other than those stated by the opponent as herein-above provided except by leave of the tribunal hearing the appeal. Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed (f).

*9 In any appeal under this section, the tribunal may, after hearing the Registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity of such trade mark, but in such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.

10 *The Registrar, or in the case of an appeal to the Board of Trade the Board of Trade, shall have power in proceedings under this section to award to any party such costs as they may consider reasonable, and to direct how and by what parties they are to be paid.*

(11) If a party giving notice of opposition or of appeal neither resides nor carries on business in the United Kingdom, the tribunal may require such party to give security for costs of the proceedings before it relative to such opposition or appeal, and in default of such security being duly given may treat the opposition or appeal as abandoned.

This section is founded on sect. 69 of the Act of 1883, as amended by sect. 13 of the Act of 1888. The words in brackets were introduced, and the words in italics repealed, by sect. 12 of the Act of 1919, the repeal being consequential upon sect. 8 of the latter Act. Sub-sect. 10, relating to costs, was repealed by the same section, and the existing provision as to costs is contained in sect. 10 of the Act of 1919.

Sub-sect. 9 does not apply to marks registered in Part B.

It will be observed that the appeal which used to lie to the Board of Trade against a decision given on an opposition is now abolished, though an appeal against a preliminary refusal by the Registrar under sect. 12 may still be made to the Board of Trade.

(a) As to procedure in case of opposition, see Rules 45—56. As to evidence, see sect. 49.

(b) There is no express limitation requiring opponents to be "persons aggrieved," or as to the grounds upon which an application may be opposed, but oppositions are usually based upon some objection to the registrability of the mark contained in the provisions of the statute itself. Objections based on the failure to comply with some other Act will not prevail, except perhaps in the case of a trade carried on in deliberate defiance of such Act: see *Albert Baker & Co.'s Appn.* (1908), 25 R. P. C. 513; *Mann's Appn.* (1919), 36 R. P. C. 189.

(c) See Rules 122 and 129. The appeal is by motion; on the day named in the notice of motion directions are generally given for the motion to be placed in the witness or non-witness list, as may be appropriate, and leave should then be applied for, if desired, to file further evidence: *e.g.*, *Ogston & Tennant's Appn.* (1909), 26 R. P. C. 816. In *Waide's Appn.* (1916), 33 R. P. C. 329, discovery and cross-examination was applied for, but, in the circumstances, refused.

(d) In *Crispin's Appn.* (1917), 34 R. P. C. 249, 349, where the Registrar had imposed a limitation which, under the then existing law, was held by the Court to be beyond his jurisdiction, the opponents were given leave to appeal against registration without the limitation.

(e) See *Ogston & Tennant's Appn.*, *supra*.

(f) Where a particular ground of objection not mentioned in the notice of opposition was known to the opponents at the hearing before the Registrar, but no application was made to him to amend the notice, leave to amend on appeal was refused: *Kenrick & Jefferson's Appn.* (1909), 26 R. P. C. 641. In *Albert Baker & Co.'s Appn.* (1908), 25 R. P. C. 513, at 516, further grounds of objection were allowed. Before the hearing by the Registrar, he may give leave to amend (Rule 96), and in *Moll's T. M.* (1890), 7 R. P. C. 226, he was ordered by mandamus to give such leave.

As to how far a decision of the Registrar, against which there has been no appeal, amounts to a case of *res judicata*, see *Hunt's Appn.* (1911), 28 R. P. C. 303; *Massachusetts Saw Works' Appn.* (1918), 35 R. P. C. 137; and sect. 54, *post*.

*15. If a trade mark contains parts not separately registered by the proprietor as trade marks, or if it contains matter common to the trade or otherwise of a non-distinctive character, the Registrar or the Board of Trade or the Court, in deciding whether such trade mark shall be entered or shall remain upon the register, may require, as a condition of its being upon the register, that the proprietor shall disclaim any right to the exclusive use of any part or parts of such trade mark, or of all or any portion of such matter, to the exclusive use of which they hold him not to be entitled, or that he shall make such other disclaimer as

they may consider needful for the purpose of defining his rights under such registration: Provided always that no disclaimer upon the register shall affect any rights of the proprietor of a trade-mark except such as arise out of the registration of the trade-mark in respect of which the disclaimer is made.

This section effects important modifications in the previous law as to disclaimers contained in sects. 64 and 74 of the Act of 1883, as altered by sects. 10 and 16 of the Act of 1888.

A disclaimer in no way affects any common law remedy available in an action for passing off: see *Bayer v. Baird* (1898), 15 R. P. C. 615, and sect. 45: nor will it prevent any subsequent acquisition of the right to registration without a disclaimer: see *Willys-Overland Co.'s Appn.* (1920), 37 R. P. C. 244, p. 246. The effect of a disclaimer on the statutory rights is not very clear. On an application to register, Parker, J., held that an opponent, the registered proprietor of "Repellus," with a disclaimer of "Repel," was not prejudiced by the disclaimer in his opposition to a fancy variation, "Aquarepela": *Wilks' Appn.* (1912), 29 R. P. C. 21: but in *Coombe v. Mendit* (1913), 30 R. P. C. 709, Eve, J., appears to have considered that a disclaimer of "Mend" by the registered proprietor of "Mendine" materially affected the issue on alleged infringement by "Mendit."

The real reason for requiring a disclaimer is to prevent a misconception which might lead people to suppose that a part of a mark, which was in fact common to the trade, was the monopoly of one trader. Disclaimers are, however, generally unsatisfactory, as they may operate as an encouragement to unscrupulous traders to imitate an existing mark, and they should not be insisted upon unless really necessary for the protection of innocent traders: *Albert Baker & Co.'s Appn.* (1908), 25 R. P. C. 513; *Cadbury's Appn.* (No. 2), 32 R. P. C. 456.

Cases decided before the Act of 1905 are not of much assistance in construing the present section, but as to what ought to be considered as a part of a mark, reference may be made to *Clement et Cie's T. M.* (1900), 16 R. P. C. 173, 611: and it may reasonably be supposed that the old rule in regard to names which form part of a distinctive label will be adhered to: see *Colman's Appn.* (1894), 11 R. P. C. 129. Cases in which applicants anxious to secure registration have consented to a disclaimer without argument should not be regarded as precedents for requiring disclaimers in other cases.

In some cases it may be possible to avoid the necessity for a disclaimer of a distinctive part by obtaining registration of that part as an associated mark under sect. 25.

As to the principles on which the Registrar's discretion should be exercised, see, generally, note (b), p. 63. The discretion vested in the Registrar by sect. 12 (2) must be regarded, so far as disclaimers are concerned, as restricted by the terms of sect. 15. Cf. *B. S. A. Co.'s Appn.* (1907), 24 R. P. C. 563, as to association.

Date of
registration.

16. When an application for registration of a trade mark has been accepted and has not been opposed, and the time for notice

of opposition has expired, or having been opposed the opposition has been decided in favour of the applicant, the Registrar shall, [unless the mark has been accepted in error or] unless the Board of Trade otherwise direct, register the said trade mark, and the trade mark, when registered, shall be registered as of the date of the application for registration, and such date shall be deemed for the purposes of this Act to be the date of registration.

The latter part of this section comes from sect. 17 of the Act of 1888. The words in brackets were inserted by sect. 12 of the Act of 1919. See Rules 58—61.

17. On the registration of a trade mark the Registrar shall issue to the applicant a certificate in the prescribed form of the registration of such trade mark under the hand of the Registrar, and sealed with the seal of the Patent Office. Certificate of registration.

This section was new in 1905. As to the form, see Rule 61.

A certificate required under sect. 51 to prove that a party is at the time the registered proprietor, for use in legal proceedings or for other purposes, is issued on payment of a fee. See Rules 99 to 101.

18. Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in such notice. Non-completion of registration.

This section comes from sect. 63 of the Act of 1883, as amended by the Act of 1888. The mere abandonment of an application does not prevent a fresh application to register: *Loftus' Appn.* (1894), 11 R. P. C. 29; but as to cases where there is an opponent, see note (f), p. 67. As to the prescribed notices, see Rule 57.

Identical Trade Marks.

19. Except by order of the Court (a) or in the case of trade marks in use (b) before the thirteenth day of August one thousand eight hundred and seventy-five, no trade mark shall be registered in respect of any goods or description of goods which is identical with one belonging to a different proprietor which is already on the register with respect to such goods or description of goods, or so nearly resembling such a trade mark as to be calculated to deceive (c). Identical marks.

This section is a modified form of sect. 72 of the Act of 1883, as amended by sect. 12 of the Act of 1888.

The introduction of the words "belonging to a different proprietor" makes the decision in *Player's Appn.* (1901), 18 R. P. C. 65, obsolete, provision for similar marks belonging to a single proprietor being contained in sect. 24.

This section applies also to marks registered in Part B., and the register includes both parts.

(a) See sect. 21: it should be observed that in this section no amendment has been made corresponding to that made in sect. 21 by the Act of 1919.

(b) "In use" in this context will no doubt be construed as meaning "in use as a trade mark in this country": see p. 59.

(c) "Calculated to deceive" does not necessarily import any design to deceive: *Lyndon's T. M.* (1886), 3 R. P. C. 102. As to the comparison between this section and sect. 11, see per Sargant, J., in *Macder's T. M.* (1916), 33 R. P. C. 77. It should also be noted that this section, unlike sect. 11, is limited to the particular case of another mark registered for the same description of goods.

In considering whether a mark is calculated to deceive by reason of its similarity to a registered mark, the onus of proving that it is not so calculated is on the applicant: see pp. 60, 61. Subject to this, the tests to be applied are similar to those applicable to cases of infringement: see pp. 28, 29.

Goods of the same description.—This expression must not be confused with the classes for which marks must be registered: *Gutta Percha Co.'s Appn.* (1909), 26 R. P. C. 428. In considering whether different goods are, nevertheless, of the same description, all the circumstances of the trade must be considered, the use to which the goods are put and the probability of their being sold in the same shop or department. See, for example, *Australian Wine Importers' T. M.* (1889), 6 R. P. C. 311; *Turney's Appn.* (1894), 11 R. P. C. 37; *Pianotist Co.'s Appn.* (1906), 23 R. P. C. 774; *Lake & Elliott's Appn.* (1903), 20 R. P. C. 605; *Leiner's Appn.*, *ibid.* p. 253; *B. S. A. Co.'s Appn.* (1907), 24 R. P. C. 563; *Cie. Industrielle des Petroles' Appn.*, *ibid.* p. 585; *Gutta Percha Co.'s Appn.*, *supra*; *British Drug Houses' T. M.* (1913), 30 R. P. C. 73; *Shreeve's T. M.* (1910), 31 R. P. C. 24; *Sunbeam Co.'s Appn.* (1916), 33 R. P. C. 389; *Egg Products Ltd.'s Appn.* (1922), 39 R. P. C. 155.

**Rival claims
to identical
marks.**

20. Where each of several persons claims to be proprietor of the same trade mark, or of nearly identical trade marks in respect of the same goods or description of goods, and to be registered as such proprietor, the Registrar may refuse to register any of them until their rights have been determined by the Court (a) or have been settled by agreement (b) in a manner approved by him or (on appeal) by the Board of Trade.

This section is derived from sect. 71 of the Act of 1883.

(a) One form of procedure for determining the rights is for one applicant to apply to the Court by notice of motion, serving the

Registrar and the rival applicant: see *De Maid's Appn.* (1914), 31 R. P. C. 305; or the rights may be determined on appeals by both applicants from the Registrar's refusal to proceed: *Javal & Parquet's Appn.* (1912), 29 R. P. C. 627.

The section applies only where there are simultaneous applications to register and not where one mark is already on the register: *Roskill's T. M.* (1915), 32 R. P. C. 577.

Other cases in which the rights have been determined by the Court are: *Hudson's Appn.* (1907), 24 R. P. C. 582; *Albert Baker & Co.'s Appn.* (1908), 25 R. P. C. 513. Cases decided under sect. 21 also illustrate circumstances under which two parties may be registered as proprietors of resembling marks. Cf. also *Re Tarantello* (1910), 27 R. P. C. 573, 762.

(b) Provision for agreement was introduced by the Act of 1905, and may meet cases of dissolution of partnership, such as *Ehrmann's T. Ms.* (1897), 14 R. P. C. 665, but such agreements will no doubt only be sanctioned where there is no risk of serious deception of the public. *Jones' T. M.* (1885), 53 L. T. N. S. 1.

21. In case of honest concurrent user *a* or of other special circumstances which, in the opinion of the Court [or Registrar], make it proper so to do, the Court [or Registrar] may *b* permit the registration of the same trade mark, or of nearly identical trade marks, for the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any, as to mode or place of user or otherwise, as *it* [the Court or the Registrar, as the case may be,] may think it right to impose *c*.

Concurrent user.

This was a new section in 1905. Sect. 74 of the Act of 1883 contained a provision permitting the registration of similar *old* marks by three, but not more, different proprietors.

The words in brackets were introduced by sect. 12 of the Act of 1919. As no corresponding amendment is made in sect. 19 of the Act of 1905, it is questionable whether the amendment does more than remove any doubts as to the power of the Registrar to deal with simultaneous applications to register: see *Roskill's T. M.* (1915), 32 R. P. C. 577, on the position before the amendment.

(a) The concurrent user must be user in this country as a trade mark: *Massachusetts Saw Works' Appn.* (1918), 35 R. P. C. 137; *Hoemoulier's T. M.* (1911), 28 R. P. C. 249. As to what is user as a trade mark, see p. 59.

Recent user by the applicant with the knowledge of the existence of a similar registered mark, though without any dishonest intention, will not be sufficient to induce the Court to exercise its discretion in favour of the applicant: *Massachusetts Saw Works' Appn.*, *supra*; cf. *Cohen v. Fidler* (1916), 33 R. P. C. 129, where the user was held not to be honest.

(b) Under this section the Court may permit registration of a mark even if there is some possibility of confusion: *Maeder's T. M.* (1916), 33 R. P. C. 77; *Lehmann's Appn.* (1918), 35 R. P. C. 92.

As to the form of order and as to costs, see last cited cases.

As examples of the exercise of the discretion, see also *Lyle & Kinahan's Appn.* (1907), 24 R. P. C. 249; *Gutta Percha Co.'s Appn.* (1909), 26 R. P. C. 428; *Roskill's T. M.*, *supra*.

(c) A limitation, the effect of which is to enable the earlier registered proprietor to control the use of the applicant's mark, will not in general be allowed: see *Roskill's T. M.*, *supra*.

The power to impose limitations as to place of user has been extended by amendments to sects. 12 and 14, introduced by sect. 12 of the Act of 1919. In some earlier decisions reasons have been given for considering such limitations as unsatisfactory: see *Soc. de Verreries' T. M.* (1894), 11 R. P. C. 142; *Dewhurst's Appn.* (1896), 13 R. P. C. 288; *Crispin's Appn.* (1917), 34 R. P. C. 249, 349; but local limitations may meet the case of a division of the goodwill in distinct areas and separate assignments as contemplated by the amended form of sect. 22.

Assignment.

Assignment
and trans-
mission of
trade marks.

22. A trade mark when registered shall be assigned and transmitted only in connexion with the goodwill of the business concerned in the goods for which it has been registered (a) and shall be determinable with that goodwill (b). But nothing in this section contained shall be deemed to affect the right of the proprietor of a registered trade mark to assign the right to use the same in any British possession or protectorate or foreign country in connexion with any goods for which it is registered together with the goodwill of the business therein in such goods. [and the assignment of such right to use the same shall constitute the assignee a proprietor of a separate trade mark for the purpose of section 21 of this Act, subject to such conditions and limitations as may be imposed under that section] (c).

This section is derived from sect. 70 of the Act of 1883.

Other provisions in the Act of 1905 dealing with assignment are sects. 23, 27, 33 (now replaced by sect. 11 of the Act of 1919), and sect. 38.

The words in brackets were added by sect. 12 of the Act of 1919.

As to procedure, see Rules 70—76.

(a) The inseparable connection between trade marks and goodwill has long been recognised as fundamental, though it is sometimes lost sight of by traders: see pp. 5, 6, *ante*.

The effect of a separation of the trade mark from the goodwill is to render the registration invalid, and the trade mark is liable to removal under sect. 35: *Bowden Wire, Ltd. v. Bowden Brake Co., Ltd.* (1914), 31 R. P. C. 385. Cf. *Cotton v. Gillard* (1874), 44 L. J. Ch. 90; *Thorneloe v. Hill* (1894), 11 R. P. C. 61; *Oldham v. James* (1862), 14 Ir. Ch. 81; *Walker v. Kego* (No. 1) (1921), 38 R. P. C. 25; *Harness' T. M.* (1900), 17 R. P. C. 49. But where a mark has been registered in the name of a person who is really a trustee for another, the defective title can be made good by an

assignment by the trustee to the true owner, as the effect of this is to reunite the trade mark with the goodwill to which it is attached: *Wellcome's T. M.* (1886), 3 R. P. C. 76.

Where a party who is not the successor in title to the goodwill has become registered as assignee, the entry will be rectified: *Johnson's T. M.* (1909), 26 R. P. C. 195; *Rey v. Lecouturier* (1908), 25 R. P. C. 265; 27 R. P. C. 268.

An assignment of the goodwill of a business will pass the right to any trade marks or trade names without special mention, since their association with the business is part of the goodwill: see *Hall v. Barrows* (1863), 33 L. J. Ch. at p. 207; *Ley v. Walker* (1879), 10 Ch. D. 436; *Currie v. Currie* (1898), 15 R. P. C. 339; *Townsend v. Jarman* (1900), 17 R. P. C. 649; and cf. *Rickerby v. Reay* (1903), 20 R. P. C. 380. But in the absence of a special covenant an assignor may, if he can do so honestly, set up again in the same business in his own name after the assignment: *Churton v. Douglas* (1859), Johnson, 174; and see *Trego v. Hunt*, (1896) A. C. 7; but not under the old name, unless it is his personal name: *Pomeroy v. Sealé* (1907), 24 R. P. C. 177; and as to names generally, see p. 22, *ante*.

The right to a trade name may also pass to, and be assigned by, a trustee in bankruptcy: *Melrose, Ltd. v. Heddle & Co.* (1902), 1 Fraser, 1120; *Wood v. Hall* (1916), 33 R. P. C. 16, or a receiver for debenture holders who carries on the business: *Hart v. Thurber Wyland, Ltd.* (1915), 32 R. P. C. 217; but a name should not be used so as to suggest that a successor is the original trader: *Cropper v. Cropper* (1906), 23 R. P. C. p. 394.

(b) *Pink v. Sharwood* (1913), 30 R. P. C. 725, is an example of the determination of the goodwill of a business. There may be cases in which a trader who ceases to *manufacture* can no longer claim as his trade mark, for goods which he only *sells*, a mark which has become known as a manufacturer's mark: see *Hotpoint Co.'s Appn.* (1921), 38 R. P. C. p. 71.

(c) The latter part of the section provides for the increasing number of cases in which separate companies are formed to deal with the trade in different territories; but in the case of an assignee whose trade is conducted entirely abroad, the provisions of sect. 37 would have to be considered.

Berna, Ltd.'s Appn. (1915), 32 R. P. C. 113, is an example of the division of goodwill in different localities. It is also possible that where there are two distinct departments in one business, the goodwill of each department may be separable from the rest: see *Sunbeam Co.'s Appn.* (1916), 33 R. P. C. 389.

There would appear to be no reason against an assignment of the goodwill of a business with its trade marks for a limited period, provided that the provisions as to reassignment at the end of the period are such that the goodwill will be genuinely re-transferred: see *Re Avril*, cited Seb. p. 640. Special arrangements affecting goodwill were considered in *Magnolia Metal Co.'s T. Ms.* (1897), 14 R. P. C. 265, 621, and *Warwick Tyre Co. v. New Motor, &c. Co.* (1910), 27 R. P. C. p. 170.

For an exhaustive discussion of the subject of goodwill, see Seb. pp. 333 *et seq.*

Apportionment of marks on dissolution of partnership.

23. In any case where from any cause, whether by reason of dissolution of partnership or otherwise, a person ceases to carry on business, and the goodwill of such person does not pass to one successor but is divided, the Registrar may (a) (subject to the provisions of this Act as to associated trade marks, (b), on the application of the parties interested, permit an apportionment of the registered trade marks of the person among the persons in fact continuing the business, subject to such conditions and modifications, if any [and to such limitations, if any, as to mode or place of user], as he may think necessary in the public interest. Any decision of the Registrar under this section shall be subject to appeal to the Board of Trade.

This section was new in 1905. The words in square brackets were added by sect. 12 of the Act of 1919. Coupled with the provision as to agreements contained in sect. 20, this section removes the hardship exemplified in *Ehrmann's T. Ms.* (1897), 14 R. P. C. 665. As to the position of partners, see *Hall v. Barrows* (1864), 33 L. J. Ch. 204; *Churton v. Douglas* (1859), 28 L. J. Ch. 841; *Scott v. Scott* (1867), 16 L. T. N. S. 143; *Townsend v. Jarman* (1900), 17 R. P. C. p. 661; and see cases in reference to a joint adventure, p. 46.

As to the procedure on applications under this section, see Rules 82—84; and as to appeals, Rules 123—128.

(a) As to the Registrar's discretion, see note (b), p. 63.

(b) See sects. 24—27.

Associated Trade Marks.

Associated trade marks.

***24.** If application be made for the registration of a trade mark [identical with or] so closely resembling a trade mark of the applicant already on the register for the same goods or description of goods as to be calculated to deceive or cause confusion if used by a person other than the applicant, the tribunal hearing the application may require as a condition of registration that such trade marks shall be entered on the register as associated trade marks.

The provisions in regard to association were introduced by the Act of 1905, though registration of a series as contemplated by sect. 26 was previously allowed by sect. 66 of the Act of 1883. They were rendered desirable in view of the amendment introduced by sect. 19 to meet such cases as *Player's Appn.* (1901), 18 R. P. C. 65, slight variations in a registered mark, followed by separate registration, being often required in practice either for commercial reasons or to obtain registration abroad. See Rule 59.

The words in brackets were introduced by sect. 12 of the Act of 1919, and displace the view expressed in *B. S. A. Co.'s Appn.*

(1907), 24 R. P. C. p. 567, as to marks actually identical. An identical mark might be required for registration for goods not the same as those covered by an existing limited registration, though of the same description, or even for the same goods differently regarded.

The discretion to require association can only be exercised in the case of applications for goods of the same description, and to that extent the Registrar's general discretion as to imposing conditions is restricted: *B. S. A. Co.'s Appn., supra.* For rules in connection with such discretion, see Rules 78—81.

As to what degree of similarity is calculated to deceive, see notes to sect. 11 and sect. 19, and cases on infringement, p. 28. As to the meaning of goods of the same description, see notes, p. 70.

***25.** If the proprietor of a trade mark claims to be entitled to the exclusive use of any portion of such trade mark separately, he may apply to register the same as separate trade marks (*a*). Each such separate trade mark must satisfy all the conditions and shall have all the incidents of an independent trade mark, except that when registered it and the trade mark of which it forms a part shall be deemed to be associated trade marks and shall be entered on the register as such, but the user of the whole trade mark shall for the purposes of this Act be deemed to be also a user of such registered trade marks belonging to the same proprietor as it contains (*b*). Combined trade marks.

(*a*) The ordinary case would probably be that of registration of a distinctive label containing within itself some distinctive device or word. A valid registration of such part will have the advantage of removing any doubt as to whether the copying of that part was an infringement of the rights of the proprietor of the label, and may be desirable having regard to the provisions as to disclaimers in sect. 15.

(*b*) The last paragraph of the section, coupled with the proviso to sect. 27, is useful as giving to the proprietor of a number of associated marks a reasonable freedom in selecting the mark actually to be put upon the goods without rendering other marks liable to removal under sect. 37.

Though not expressly so stated, as is the case in sect. 24, it is conceived that this section cannot operate so as to require association of a trade mark registered for one description of goods with a part of the same mark registered for a different description of goods.

26. When a person claiming to be the proprietor of several trade marks for the same description of goods which, while resembling each other in the material particulars thereof, yet differ in respect of— Series of trade marks.

(*a*) Statements of the goods for which they are respectively used or proposed to be used; or

- (b) statements of number, price, quality, or names of places: or
- (c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark: or
- (d) colour:

seeks to register such trade marks, they may be registered as a series in one registration. All the trade marks in a series of trade marks so registered shall be deemed to be, and shall be registered as, associated trade marks.

This section is founded on sect. 66 of the Act of 1883.

As to procedure on an application for registration of a series, see Rule 27. A reduced fee is charged for the registration of marks other than the first: see item 4a in the scale of fees.

As to colour, see sect. 10 and notes.

With reference to the final provision of this section, it is to be observed that by sect. 3 of the Trade Marks Act, 1919, the section is made applicable to registrations in Part B., but on the other hand, sect. 27, which contains the essential provision which distinguishes associated marks from other marks, is not applied to registrations in Part B. This being so, the effect of association in relation to marks registered in Part B. may require consideration if the question arises.

Assignment
and user of
associated
trade marks.

***27.** Associated trade marks shall be assignable or transmissible only as a whole and not separately, but they shall for all other purposes be deemed to have been registered as separate trade marks. Provided that where under the provisions of this Act user of a registered trade mark is required to be proved for any purpose, the tribunal may if and so far as it shall think right accept user of an associated registered trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for such user.

This section does not apply to marks registered in Part B.: see notes to sect. 26. As to assignments generally, see sects. 22, 23, 33.

It is to be observed that the proviso is not limited to the case of associated marks, and may have a material bearing on sect. 37, as user with immaterial variations will have to be taken into consideration.

Renewal of Registration.

Duration of
registration.

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

Renewal of
registration.

29. The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within

the prescribed period, renew the registration of such trade mark for a period of fourteen years from the expiration of the original registration or of the last renewal of registration, as the case may be, which date is herein termed "the expiration of the last registration."

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

Procedure on expiry of period of registration.

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

Status of un-renewed trade mark.

Sects. 28--31 are derived from sect. 79 of the Act of 1883, as amended by sect. 19 of the Act of 1888.

For procedure, see Rules 62--69.

As to user of a trade mark, see note (g), p. 59. User of a registered trade mark with alterations or additions not substantially affecting its identity may be accepted as user of the registered mark: sect. 27.

Correction and Rectification of the Register.

32. The Registrar may, on request made in the prescribed manner by the registered proprietor or by some person entitled by law to act in his name.—

Correction of register.

- (1) Correct any error in the name or address of the registered proprietor of a trade mark (a) : or
- (2) Enter any change in the name or address of the person who is registered as proprietor of a trade mark (b) : or
- (3) Cancel the entry of a trade mark on the register: or
- (4) Strike out any goods or classes of goods from those for which a trade mark is registered (c) : or

(5) Enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of such trade mark (*d*).

Any decision of the Registrar under this section shall be subject to appeal to the Board of Trade.

This section comes from sect. 91 of the Act of 1883, but contains some material modifications, and it should be noted that sub-sect. (a) of that section is included in the wider provision of sect. 12 (6) of the Act of 1905.

For procedure, see Rules 85-87 and Forms 20-24; and as to appeals, Rules 123-128.

(a) This is not confined to clerical errors as was the old sect. 91 (b).

(b) This sub-section is new and meets the difficulty of such cases as *New Ormonde Cycle Co.'s T. M.* (1896), 13 R. P. C. 475. Rule 77 makes it obligatory on a proprietor to apply for entry of a new address.

(c) This provision is frequently made use of in order to anticipate an application to rectify the register in cases where registration has been obtained for a wider description of goods than those for which it can validly be registered: see notes to sect. 35.

(d) This enables a proprietor to put his registration in order where without a disclaimer or limitation it might be liable to removal under sect. 35.

Registration
of assign-
ments.

33.—(1) [Where a person becomes entitled by assignment, transmission, or other operation of law to a registered trade mark, he shall make application to the registrar to register his title, and the registrar shall, on receipt of such application and on proof of title to his satisfaction, register him as the proprietor of the trade mark, and shall cause an entry to be made in the prescribed manner on the register of the assignment, transmission, or other instrument affecting the title. Any decision of the registrar under this section shall be subject to appeal to the Court.

(2) Except in cases of appeals under this section and applications made under section thirty-five of this Act, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of subsection (1) aforesaid shall not be admitted in evidence in any Court in proof of the title to a trade mark unless the Court otherwise directs.]

This section in its present form was introduced by the Act of 1913 (s. 11), in place of the original section in the Act of 1905, which was in the following terms:—

Subject to the provisions of this Act where a person becomes entitled to a registered trade mark by assignment, transmission, or other operation of law, the Registrar shall, on request made in the

prescribed manner, and on proof of title to his satisfaction, cause the name and address of such person to be entered on the register as proprietor of the trade mark. Any decision of the Registrar under this section shall be subject to appeal to the Court or, with the consent of the parties, to the Board of Trade.

The provisions on this subject in the earlier legislation were contained in sect. 87 of the Act of 1883.

For procedure, see Rules 70—76; and as to appeals to the Court, Rule 122.

The substantive provisions in regard to assignment and transmission of trade marks are contained in sects. 22, 23, 27 and 38. Registration constitutes *prima facie* evidence of validity: sect. 40; and provisions in case of rival claims are contained in sect. 20.

The provision as to making an entry on the register of the instrument, and sub-sect. (2) are both new, and may afford a check to attempts to obtain an entry of an assignment or transmission without a full disclosure of the circumstances: see, for example, *Johnson's T. M.* (1909), 26 R. P. C. 195; and cf. *Pinto v. Badman* (1891), 8 R. P. C. 181, where the documents eventually disclosed disproved the plaintiffs' title.

34. The registered proprietor of any trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter such trade mark in any manner not substantially affecting the identity of the same, and the Registrar may refuse such leave or may grant the same on such terms [and subject to such limitations as to mode or place of user] as he may think fit, but any such refusal or conditional permission shall be subject to appeal to the Board of Trade. If leave be granted, the trade mark as altered shall be advertised in the prescribed manner.

Alteration of registered trade mark.

This section is derived from sect. 92 of the Act of 1883.

The words in brackets were introduced by sect. 12 of the Act of 1919.

For procedure, see Rules 88, 89; and as to appeals, Rules 123—128. The Board of Trade may refer the appeal to the Court (sect. 59), as was done in *Carron Co.'s T. M.* (1910), 27 R. P. C. 412.

The power to allow alterations is vested by this section in the Registrar instead of the Court as under the repealed Act; it is also much wider, as the power was formerly limited to alterations in any particular not being an essential particular as defined by sect. 64. The authorities on sect. 92 of the Act of 1883 may be found in *Seb.* p. 641.

35. Subject to the provisions of this Act (a) —

(1) The Court may on the application (b) in the prescribed manner of any person aggrieved (c) by the non-insertion in or omission from the register of any entry, or by

Rectification of register.

any entry made in the register without sufficient cause (*d*), or by any entry wrongly remaining on the register (*e*), or by any error or defect in any entry in the register, make such order for making, expunging, or varying such entry as it may think fit (*f*):

- (2) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connexion with the rectification of the register (*g*):
- (3) In case of fraud in the registration or transmission of a registered trade mark, the Registrar may himself apply to the Court under the provisions of this section:
- (4) Any order of the Court rectifying the register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner who shall upon receipt of such notice rectify the register accordingly.

This section is a modification of sect. 90 of the Act of 1883. Its application is limited by sect. 41: see notes, pp. 85, 86.

(*a*) See, in particular, sect. 36, relating to marks registrable under the Act of 1905, but not under the legislation in force at the date of registration, and sect. 41 as to the conclusiveness of the original registration in certain circumstances.

(*b*) Applications under this section may now also be made to the Registrar unless an action is pending: see sect. 9 of the Act of 1919, below.

In England the application, when made to the Court direct, is in practice made by notice of motion in the Chancery Division, though no rules have been made defining the prescribed manner. It cannot be made by counterclaim: see *Pinto v. Badman* (1891), 8 R. P. C. 181. As to jurisdiction of other Courts, see p. 104. The notice should be served on the Registrar (see Rule 130) and on the registered proprietor, though service on the latter may be dispensed with: *Cie. Générale, &c.'s T. M.* (1891), 8 R. P. C. 446; *King & Co.'s T. M.* (1892), 9 R. P. C. 350; *Royal Baking Powder Co.'s T. Ms.* (1897), 14 R. P. C. 425; *Ashton's T. M.* (1900), 48 W. R. 389; cf. *Smollens' T. M.* (1912), 29 R. P. C. 158 (decided on sect. 37). As to foreign proprietors, see also Trade Mark Rules, r. 9, and *Rollins' T. M.* (1915), 32 R. P. C. 472. As to security for costs, see *Cie. Générale, &c.'s T. M.*, *supra.* and *Soc. des Verreries' T. M.* (1893), 10 R. P. C. 290.

Particulars of the objections relied upon will be ordered: *Kenrick & Jefferson's T. M.*, reported on another point at 28 R. P. C. 45; and discovery may be ordered in an appropriate case: *Wills' T. M.* (1892), 9 R. P. C. 346.

The question whether any issue decided between the parties on an opposition becomes *res judicata* as regards an application to rectify was raised in *Kenrick & Jefferson's T. M.* (1911), 28 R. P. C. 45.

but only one preliminary point was decided. See also observations in *Coleman v. Stephen Smith & Co.* (1912), 29 R. P. C. at p. 90. The correct view would seem to be that, inasmuch as an application to rectify is not a matter which concerns the applicant alone, but is for the public benefit, it should not be affected by anything which has taken place *inter partes*.

(c) *Person aggrieved.*—To prove that he is aggrieved, a person must show that the effect of the continuance of the entry on the register unaltered would or might limit his legal rights so that, by reason of the entry, he could not lawfully do that which otherwise he might do, or that damage or injury to himself is possible in a practical and not merely fantastic sense: see *Powell's T. M.* (1894), 11 R. P. C. 4; *Wright, Crossley & Co.'s T. M.* (1898), 15 R. P. C. 379; *Rivière's T. M.* (1884), 26 Ch. D. 48; 55 L. J. Ch. 545; *Apollinaris Co.'s T. M.* (1894), 8 R. P. C. 137. Where the grievance is, not the particular entry, but only the fact that the proprietor has a registered trade mark at all, that is not sufficient: *Wright, Crossley & Co.'s T. M.*, *supra*, per Lindley, M. R.; nor where the grievance is purely sentimental: *Ellis & Co.'s T. M.* (1904), 21 R. P. C. 617; nor where the registration is merely superfluous and adds nothing to the existing rights of the proprietor: *Crompton & Co.'s T. M.* (1902), 19 R. P. C. 265.

A foreigner may be a person aggrieved: *Rivière's T. M.*, *supra*, and *European Blair Co.'s T. M.* (1896), 13 R. P. C. 600.

Whether the Royal Warrant Holders' Association or any member not holding a warrant from the Prince of Wales is a person aggrieved by a mark suggesting the Prince's patronage may be doubtful: *Imperial Tobacco Co.'s T. M.* (1915), 32 R. P. C. 10, 361.

Other cases on this point which may be referred to are: *Talbot's T. M.* (1894), 11 R. P. C. 77; *Zonophone T. M.* (1903), 20 R. P. C. 450; *Neostyle Co.'s T. M.*, *ibid.* p. 803.

A person whose application to register has been refused must appeal in accordance with the procedure laid down (see sects. 12 and 14), and cannot apply under this section as a person aggrieved by the non-insertion of an entry without sufficient cause: *Normal & Co.'s Appn.* (1887), 4 R. P. C. 123.

Once it is shown that the applicant has a *locus standi* as a person aggrieved, the application may be supported upon any ground on which the validity can be attacked, the purity of the register being a matter of concern to the Court: *Paine v. Daniell* (1893), 10 R. P. C. 217; and, subject now to sect. 41, delay by the applicant in seeking rectification is no bar: *Addley Bourne v. Swan & Edgar* (1903), 20 R. P. C. 105; nor, presumably, would the absence of merits on the part of the applicants affect the case: cf. *Havana Commercial Co.'s Appn.* (1916), 33 R. P. C. 399, though in that case it should be observed that *locus standi* was unnecessary. Compare, on the repealed Act, *Batt's T. M.* (1898), 15 R. P. C. 534; 16 R. P. C. 411.

(d) *Entry made without sufficient cause.*—In *Batt's T. M.* (1898), 15 R. P. C. 534, the C. A. held that these words in sect. 90 of the Act of 1883 covered the case of any entry wrongly on the register, however it got there, but that case is specially provided for in the present Act by the words next following. Hence, in this Act, the

words appear to relate to the time when the entry was first made. The fact that this distinction is here clearly drawn is material in considering the meaning of "original registration" in sect. 41.

(e) These words did not occur in sect. 90 of the Act of 1883. It is evident that, by contrast with the preceding words, they include cases where the entry was made with sufficient cause, but owing to some circumstances arising since the date of registration, wrongly remains on the register. See this question discussed at p. 9, *ante*, and as to the effect of sect. 41, p. 85, *post*.

(f) The onus of establishing the case for rectification is on the applicant (sect. 40), and in doubtful cases, particularly in regard to marks of long standing, every presumption will be made in favour of the registered proprietor: *Chesebrough Co.'s T. M.* (1902), 19 R. P. C. 342; *Bass' T. M.*, *ibid.* p. 539; *Burroughs & Wellcome's T. M.* (1904), 22 R. P. C. 164.

A classified list of examples of occasions for rectification of the register may be found in Seb. pp. 635 *et seq.*

(g) On an application under sect. 35, where an order is sought to expunge an entry, the Court may, as an alternative, modify the entry, but will not do so unless all the materials necessary for the decision are before it: *Gestetner's T. M.* (1908), 25 R. P. C. 156. Whether, on an application to expunge a mark which could only have been registered under sect. 21, the Court could consider that section and allow the registration to stand, is doubtful: see *Roshill's T. M.* (1915), 32 R. P. C. 577.

There is power on an application under this section to remove a mark from Part A. to Part B.: see sect. 9 of the Act of 1919.

Trade marks
registered
under pre-
vious Acts.

***36.** No trade mark which is upon the register at the commencement of this Act and which under this Act is a registrable trade mark shall be removed from the register on the ground that it was not registrable under the Acts in force at the date of its registration. But nothing in this section contained shall subject any person to any liability in respect of any act or thing done before the commencement of this Act to which he would not have been subject under the Acts then in force.

This section was introduced by the Act of 1905, and reversed the legal position which existed prior to that Act. As all marks registered under earlier Acts which are still on the register have now been on for more than seven years, so that sect. 41 is necessarily operative, the importance of this section has been reduced.

The effect of the section has been expressed as being:—"Take the facts of to-day and the law of to-day and enquire whether, if the mark were taken off it would, on the facts of to-day and the law of to-day, be entitled to go on again. If so, leave it alone." See per Buckley, L. J., in *Gestetner's T. M.* (1908), 25 R. P. C. p. 160. A doubt was subsequently expressed by Parker, J., as to whether the material date at which the facts and law were to be considered was not the date of the passing of the Act of 1905: *Philippart v. Whiteley* (1908), 25 R. P. C. p. 571.

37. A registered trade mark may, on the application (*a*) to the Court of any person aggrieved (*b*), be taken off the register in respect of any of the goods for which it is registered, on the ground that it was registered by the proprietor or a predecessor in title without any *bonâ fide* intention to use (*c*) the same in connexion with such goods, and there has in fact been no *bonâ fide* user of the same in connexion therewith, or on the ground that there has been no *bonâ fide* user of such trade mark in connexion with such goods during the five years immediately preceding the application, unless in either case such non-user is shown to be due to special circumstances in the trade, and not to any intention not to use or to abandon such trade mark in respect of such goods (*d*).

Non-user of
trade mark.

This section was introduced by the Act of 1905, but it had been held previously that if a mark had been registered by a person with no *bonâ fide* intention of using it, it had been registered without sufficient cause, and could be removed under sect. 90 of the Act of 1883: *Batt's T. M.* (1899), 16 R. P. C. 411.

(*a*) The procedure is the same as on an application under sect. 35, and may now be made to the Registrar: see note (*b*), p. 80.

(*b*) As to the meaning of "person aggrieved," see note (*c*), p. 81.

(*c*) In *Philippart v. Whiteley* (1908), 25 R. P. C. 565, Parker, J., suggested that the use referred to must be use as a trade mark, *i.e.*, for the purpose of distinguishing the proprietor's goods: see p. 45. In *Andrew v. Kuehnrich* (1913), 30 R. P. C. 93, 677, some of the judges expressed a contrary opinion. The same question was raised in argument in *Woodward v. Boulton Macro* (1915), 32 R. P. C. 173. It is submitted that the word *bonâ fide* implies some reference to the motive with which the mark is used, and that, although the Courts will not be hypercritical in examining the form in which the mark has been used, mere use, for example, as a descriptive term will not be *bonâ fide* user within the section. As to user of a trade mark generally, see p. 59, *ante*.

(*d*) *Bonâ fide* intention to use means a present intention, and not a mere expectation, of possible future user: *Batt's T. M.*, *supra*; *Muratti v. Murad* (1911), 28 R. P. C. 497; *Hart's T. M.* (1902), 19 R. P. C. 569. Cf. *Neuchatel Co.'s Appn.* (1913), 30 R. P. C. 349, on the construction of "proposed to be used."

To secure the benefit of the saving clause, the proprietor must show, not merely that special circumstances would in any event have prevented user of the mark, but that he would have used the mark if those circumstances had not occurred: *Cream's T. M.* (1921), 38 R. P. C. 155. Reference may be necessary in some cases to art. 307 of the Treaty of Peace: see p. 204.

Effect of Registration.

**Powers of
registered
proprietor.**

38. Subject to the provisions of this Act (*a* —

- (1) The person for the time being entered in the register as proprietor of a trade mark shall, subject to any rights appearing from such register to be vested in any other person, have power to assign the same, and to give effectual receipts for any consideration for such assignment:
- (2) Any equities in respect of a trade mark may be enforced in like manner as in respect of any other personal property (*b*).

This section is derived from sect. 87 of the Act of 1883.

(*a*) See sects. 22, 23 and 27, and notes thereto, in relation to assignment and transmission of trade marks; and as to procedure by which the assignee can obtain registration, see sect. 33.

(*b*) No notice of trust can be entered on the register: see sect. 5.

**Rights of
proprietor of
trade mark.**

†**39.** Subject to the provisions of section forty-one (*a*) of this Act and to any limitations and conditions entered upon the register (*b*), the registration (*c*), of a person as proprietor of a trade mark shall, if valid, give to such person the exclusive right to the use of such trade mark upon or in connexion with the goods in respect of which it is registered (*d*): Provided always that where two or more persons are registered proprietors of the same or substantially the same trade mark in respect of the same goods no rights of exclusive user of such trade mark shall (except so far as their respective rights shall have been defined by the Court) be acquired by any one of such persons as against any other by the registration thereof, but each of such persons shall otherwise have the same rights as if he were the sole registered proprietor thereof (*e*).

(*a*) See proviso to that section.

(*b*) As to limitations and conditions see sects. 12 (2), 12 (4), 14 (4), 14 (6), 21 and 23.

(*c*) *I.e.*, registration in Part A.

(*d*) As to the general nature of the exclusive right conferred, see Introduction, p. 11; and as to the change of law effected by this section, the general note below, after sect. 41.

(*e*) This proviso was new in 1905. Provision for concurrent registration is made by sect. 21. The proprietor of an unregistered mark is protected by the proviso to sect. 41 in the cases there specified.

† Only the proviso to this section applies to registrations in Part B. of the register.

40. In all legal proceedings relating to a registered trade mark (including applications under section thirty-five of this Act) the fact that a person is registered as proprietor of such trade mark shall be *prima facie* evidence of the validity of the original registration of such trade mark and of all subsequent assignments and transmissions of the same (a).

Registration to be *prima facie* evidence of validity.

(a) It should be observed that this section applies to registrations in Part B., while sect. 41 does not. As to assignments, see sects. 22, 23, 27, 33 and 38. As to this section generally, see note after sect. 41.

†**41.** In all legal proceedings relating to a registered trade mark (including applications under section thirty-five of this Act) the original registration of such trade mark shall after the expiration of seven years from the date of such original registration (or seven years from the passing of this Act, whichever shall last happen) be taken to be valid in all respects unless such original registration was obtained by fraud, or unless the trade mark offends against the provisions of section eleven of this Act:

Registration to be conclusive after seven years.

Provided that nothing in this Act shall entitle the proprietor of a registered trade mark to interfere with or restrain the user by any person of a similar trade mark upon or in connexion with goods upon or in connexion with which such person has, by himself or his predecessors in business, continuously used (a) such trade mark from a date anterior to the user [or registration, whichever is the earlier.] of the first-mentioned trade mark by the proprietor thereof or his predecessors in business, or to object (on such user being proved) to such person being put upon the register for such similar trade mark in respect of such goods under the provisions of section twenty-one of this Act.

The words in square brackets were introduced by sect. 12 of the Act of 1919, and remove a doubt raised in *Williams v. Massey* (1911), 28 R. P. C. 512. Sect. 6 of the Act of 1919 affects the operation of the section in regard to certain classes of marks.

(a) Such user must probably be a substantial user: *Williams v. Massey, supra*. The case of a second registered mark is provided for by sect. 39.

General Note to sects. 39—41.

Sects. 39, 40 and 41 were new sections in the Act of 1905; they deal, though in a substantially different manner, with the subject-matter covered by sect. 76 of the Act of 1883, which was as follows:—

“The registration of a person as proprietor of a trade mark shall

† Only the proviso to this section applies to registrations in Part B. of the register.

be *prima facie* evidence of his right to the exclusive use of the trade-mark, and shall, after the expiration of five years from the date of registration, be conclusive evidence of his right to the exclusive use of the trade mark subject to the provisions of this Act."

It will be observed that the earlier part of that section did not in terms confer any new exclusive right: it only dealt with the evidence and onus of proof in regard to a right, which, apart from the statute, might have been capable of proof, and which, notwithstanding the statute, could be shown by rebutting evidence not to exist. *Pinto v. Badman* (1891), 8 R. P. C. 181. The latter part of sect. 76, though also purporting to deal only with evidence, might in practice have operated to enable a trader to establish a right which, but for the statute, could have been proved not to exist. This result might, however, be avoided by rectification of the register under sect. 90 of the Act of 1883, as construed by legal decisions: see *Bull's T. M. in C. A.* (1898), 15 R. P. C. 534. The practical position, therefore, was that, after the lapse of five years, the existence of the exclusive right still depended upon the validity of the registration, and the lapse of five years in no way affected the grounds upon which such validity could be attacked.

The Act of 1905 adopted a more logical system. Instead of making registration effective only as evidence of a right or as shifting the onus of proof, it provides that registration, if valid, shall confer a certain qualified monopoly: sect. 39; and see pp. 11, 12. *ante*. Validity of the registration is, therefore, the test. Sect. 40 establishes certain presumptions as to validity, which can be rebutted: and sect. 41 further provides that, after the lapse of seven years, there is to be an absolute presumption as to the validity of the original registration, except in certain specified cases.

The terms of sect. 41 are therefore of great importance, as they may make it in certain circumstances impossible to contest the exclusive right conferred by sect. 39. The section is, however, not entirely free from ambiguity, and its construction cannot be said to be finally settled. "Registration" may mean the act of making an entry on the register, a single act done at a definite time, or it may refer to the fact of the entry being on the register, a condition which is continuous. The word is used with the former significance in sects. 17 and 18, and with the latter significance in sects. 28—30. In sect. 41, the words "original registration" would appear to point to the original act. On that view, it would seem that the continuance of the mark on the register could be attacked, even after the lapse of the seven years, if subsequent events affecting the trade mark could be used to show that, notwithstanding the validity of the original registration, the mark was wrongly remaining on the register: see pp. 9, 80, *ante*. This construction gives rise to little difficulty in sect. 41, but sects. 39 and 40 must also be considered. The matter was not fully dealt with in *Woodward v. Boulton Macro* (1915), 32 R. P. C. 173, and the point was left open in *Imperial Tobacco Co. v. De Pasquali* (1918), 35 R. P. C. 185.

The words in sect. 41 which refer to sect. 11 are also somewhat obscure. They cannot be taken quite literally (since the mark itself cannot "offend" against sect. 11), and might be paraphrased so as to read: "unless the mark is one the use of which would by reason

of its being calculated to deceive or otherwise be disentitled to protection." &c., or "unless the act of registration was forbidden by sect. 11."

No construction has yet been put upon the word "fraud" as used in sect. 41. In *Palmer's T. M.* (1882), 21 Ch. D. p. 57. Jessel, M. R., characterises an application to register as a trade mark words which the applicant knows to be a mere description of the article as an attempt to deceive the Registrar, but he was then dealing with a different Act of Parliament. *Hyde's T. M.* (1878), 7 Ch. D. 724. illustrates the case of an applicant who knew the facts, which were sufficient to invalidate his registration, but was ignorant of the law. It is perhaps material to note that in the form of application the applicant is described as a person "who claims to be the proprietor" of the trade mark: see Form No. 2; but a claim does not necessarily imply a representation that the claim is well founded.

If the date of the application to rectify is after the expiration of the seven years, the section applies, although an action for infringement was pending before the expiration: *Andrew v. Kuehnrich* (1913) 30 R. P. C. 93, 677.

*42. No person shall be entitled to institute any proceeding to prevent or to recover damages for the infringement of an unregistered trade mark unless such trade mark was in use before the thirteenth of August one thousand eight hundred and seventy-five, and has been refused registration under this Act. The Registrar may, on request, grant a certificate that such registration has been refused *a*.

Unregistered
trade mark.

This section comes from sect. 77 of the Act of 1883, with material alterations. Formerly, refusal of registration under any Act was sufficient. The present section requires refusal of an application under the Act of 1905, so that, when it is desired to protect an old unregistered trade mark *qua* trade mark, even if it has been already refused registration under an earlier Act, it should be tendered for registration again. As the action for passing off is not affected by the restriction (sect. 45), the proprietor of an unregistered mark which has not been refused is not deprived of all remedy. A mark which has been refused registration in Part A. may be registrable in Part B. under the Act of 1919.

The section does not specifically provide that an assignee of a registered mark must obtain registration before commencing an action, and, if the object of the section is to ensure that the register should serve as notice to other traders of marks already appropriated, the fact that the mark is registered would be sufficient. No decision on this point has been given under the Act of 1905. As to the Act of 1883, see *Ihlee v. Henshaw* (1886), 3 R. P. C. 15; *Revelière v. Gateley* (1890), 89 L. T. Journal, 314. In *Magnolia Metal Co. v. Atlas Metal Co.* (1897), 14 R. P. C. 389, the plaintiffs were not registered at the date of the judgment. If registration of the assignment has not been obtained and it is necessary to avoid

any delay, the registered proprietor should be joined. Cf. *Richards v. Butler* (1890), 7 R. P. C. 288, where a plaintiff who had no title to the mark at all was allowed to join the registered proprietor.

(a) As to procedure, see Rule 99 and Form T. M. 32.

43. In any action or proceeding relating to a trade mark or trade name the tribunal shall admit evidence of the usages of the trade concerned and of any relevant trade mark or trade name or get-up legitimately used by other persons.

This section in its present form is substituted by the Act of 1919 (see sect. 12 and the second schedule) for the original section of the Act of 1905, which was in the following terms:

In an action for the infringement of a trade mark the Court trying the question of infringement shall admit evidence of the usages of the trade in respect to the get-up of the goods for which the trade mark is registered, and of any trade marks or get-up legitimately used in connexion with such goods by other persons.

As to the character of evidence which is admissible generally, see p. 31.

User of name,
address, or
description
of goods.

44. No registration under this Act *a* shall interfere with any bona fide use by a person of his own name or place of business or that of any of his predecessors in business, or the use by any person of any bona fide description of the character or quality of his goods.

This section was new in the Act of 1905. In the case of applications to register names or words, it affords an argument against attaching too much weight to the apprehension lest registration should at some future time embarrass honest traders, but is only one of the factors to be considered, and cannot be urged as a reason for allowing registration indiscriminately.

Numerous illustrations of what may and what may not be considered the *bona fide* use of a name or descriptive word can be found in passing off cases: see examples cited at pp. 22, 23. An unsuccessful attempt to rely on this section was made in *Farrow v. Seyfried* (1921), 38 R. P. C. 114, and it is difficult to suppose that the Courts will lend any encouragement to the use by one trader of the registered mark of another unless such mark is substantially a part of the ordinary English language without the use of which certain qualities cannot practically be described.

(a) An important question arose in *Woodward v. Boulton Macro* (1915), 32 R. P. C. 173, where it was held that this section did not apply to the case of a word registered prior to the Act of 1905. The possible relevance of sect. 6 was considered, but no reference appears to have been made to the meaning which must be attached to the word "registration" in sects. 28–30: see note, p. 86.

45. Nothing in this Act contained shall be deemed to affect rights of action against any person for passing off goods as those of another person or the remedies in respect thereof. "Passing-off" action.

This section was new in 1905, and sets at rest any doubt on the point under the previous legislation. Cf. *Sea-Sea v. Britten* (1899), 16 R. P. C. 137. See, however, sect. 6 (1) of the Act of 1919. As to the action for passing off, see pp. 7, 11.

Legal Proceedings.

46. In any legal proceeding in which the validity of the registration of a registered trade mark comes into question and is decided in favour of the proprietor of such trade mark, the Court may certify the same, and if it so certifies then in any subsequent legal proceeding in which such validity comes into question the proprietor of the said trade mark on obtaining a final order or judgment in his favour shall have his full costs, charges, and expenses as between solicitor and client, unless in such subsequent proceeding the Court certifies that he ought not to have the same. Certificate of validity.

This section comes from sect. 18 of the Act of 1888, which introduced a corresponding provision as 77 (a) of the Act of 1883, but it must be noted that the present section deals directly with the question of validity of the registration, whereas sect. 77 (a) referred to the "right to the exclusive use of a trade mark." That right might have come into question without a dispute as to the validity of the registration, unless the mark had been registered for five years: see p. 85. Further, sect. 77 (a) only related to actions for infringement, and not to *any* legal proceeding.

There is apparently no right of appeal against the granting of a certificate: *Huslam v. Hall* (1888), 5 R. P. C. 144; *Pinto v. Badman* (1891), 8 R. P. C. p. 198; but in a subsequent action where a plaintiff seeks to have the section applied in his favour, it may be competent for the defendant to argue that there was no jurisdiction to grant the certificate: see *Field v. Wagel* (1900), 17 R. P. C. 266.

In *Addley Bourne v. Swan & Edgar* (1903), 20 R. P. C. 105, a certificate was refused as a matter of discretion where a motion to rectify had been abandoned. Under sect. 33 of the Patents Act, 1907, certificates of validity are sometimes granted, although the issue is abandoned at the trial upon some evidence of validity being given: *Broune v. Cyko Manufacturing Co.* (1920), 37 R. P. C. 270.

For examples of certificates granted under the present Act, see *Cie. Industrielle des Petroles' T. M.* (1907), 24 R. P. C. 585; *Boord v. Thom.* *ibid.* p. 722. In *Major Bros. v. Franklin* (1908), 25 R. P. C. 406, a certificate was granted where the question of validity was argued, though there was no application to rectify the register.

47. In any legal proceeding in which the relief sought includes alteration or rectification of the register, the Registrar Registrar to have notice

of proceeding
for recti-
fication.

shall have the right to appear and be heard, and shall appear if so directed by the Court. Unless otherwise directed by the Court, the Registrar in lieu of appearing and being heard may submit to the Court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting the same or of the practice of the office in like cases, or of such other matters relevant to the issues, and within his knowledge as such Registrar, as he shall think fit, and such statement shall be deemed to form part of the evidence in the proceeding.

This section was new in 1905.

Where the question is one which concerns only the applicant to rectify and the proprietor, the Registrar does not usually appear, but where questions of general importance are raised, he is not infrequently represented: *e.g.*, *Bowden v. Bowden* (1914), 31 R. P. C. p. 391; *Imperial Tobacco Co.'s T. Ms.* (1915), 32 R. P. C. p. 368.

Costs.

Costs of
proceedings
before the
Court.

48. In all proceedings before the Court under this Act the costs of the Registrar shall be in the discretion of the Court, but the Registrar shall not be ordered to pay the costs of any other of the parties.

This section was new in 1905. See Rules 55 and 56.

Sect. 48 deals only with the costs of the Registrar, but it is convenient to deal here with other questions as to the costs of proceedings for registration or rectification. The costs of proceedings before the Registrar are provided for by the Act of 1919 as follows:—

Sect. 10. In all proceedings before the Registrar under the principal Act or this Act the Registrar shall have power to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of court.

That section replaced sect. 14 (10) of the Act of 1905, now repealed, which was as follows:—

The Registrar, or in the case of an appeal to the Board of Trade, the Board of Trade shall have power in proceedings under this section to award to any party such costs as they may consider reasonable, and to direct how and by what parties they are to be paid.

Under that sub-section, in case of an appeal from his decision, the Registrar did not usually deal with the question of costs until the appeal had been determined, and that is still the practice. Prior to the Act of 1905, the Court could not deal with the costs of proceedings before the Registrar: *Brandreth's T. M.* (1878), 9 Ch. D. 618; *Australian Wine Importers' Appn.* (1889), 41 Ch. D. 278. The question under the Act of 1905 was raised, but not decided, in *Cording's Appn.* (1916), 33 R. P. C. pp. 96, 386. It is possible, but not likely, that sect. 8 (2) of the Act of 1919 may be construed as

giving the Court jurisdiction to deal with such costs, though it was no doubt, inserted for a different purpose.

Under sect. 53, the parties can claim a hearing before the Registrar as to costs.

As regards costs on appeal to the Court, in cases under sect. 12, if service is not directed upon any third party, the usual rule is that, whatever the result, the applicant is ordered to pay the costs of the Registrar, such costs being regarded as part of the expenses of the application. In special cases, where some new question of principle is raised, especially if the Court decides against the Registrar, the Registrar does not press for costs: see *British Thomson-Houston Co.'s Appn.* (1917), 34 R. P. C. 169; *Cadbury's Appn.* (1915), 32 R. P. C. 456. No order was made as to costs in *Bagots, Hutton & Co.'s Appn.* (1912), 29 R. P. C. 702. Where the applicant succeeds in the Court of Appeal, it is usual that the order of the Court below as to costs should not be disturbed, but that the Registrar should not get costs in the Court of Appeal: see *California Fig Syrup Co.'s Appn.* (1909), 26 R. P. C. 846; *National Cash Register Co.'s Appn.* (1917), 34 R. P. C. 354; *Du Cros' Appn.* (1912), 29 R. P. C. p. 78, and see *Eastman, &c. Co.'s Appn.* (1898), 15 R. P. C. 476.

Where parties appear on an appeal under sect. 12, in pursuance of a direction to serve them, they may, if successful, get their costs, e.g., *Acson & Jefferson's Appn.* (No. 1) (1890), 7 R. P. C. 321; *Neuchatel Co.'s Appn.* (1913), 30 R. P. C. 349; but leave to appear may be given on special terms: e.g., *Schicht's Appn.* (1912), 29 R. P. C. 483.

In the case of appeals under sect. 14, the ordinary rule is that the unsuccessful party pays the costs, including the costs of the Registrar: *Havana Commercial Co.'s Appn.* (1916), 33 R. P. C. p. 405; but where the opposition is part of other proceedings and each party is partially successful, the result may be that no costs are given: e.g., *Jelley's Appn.* (1878), 51 L. J. Ch. 639; *Mouson v. Boehm* (1884), 26 Ch. D. 398.

Prior to the Act of 1919, applications under sect. 35 to rectify the register had to be made to the Court, and, normally, if the application was successful the registered proprietor was ordered to pay the costs of the application, including those of the Registrar, unless costs were unnecessarily incurred or there were other special circumstances, e.g., *Paine's T. M.* (1908), 25 R. P. C. 329; *Bradley's T. M.* (1892), 9 R. P. C. 205; *Burke's T. M.* (1917), 34 R. P. C. 213; *Fitchett's T. M.* (1919), 36 R. P. C. 296.

Costs on the higher scale were allowed in *Crosfield's Appn.* (1910), 27 R. P. C. 433, and allowance for three counsel, the latter being also allowed in *Burroughs & Wellcome's T. M.* (1905), 22 R. P. C. 164. Such costs were refused in *Apollinaris Co.'s T. M.* (1891), 8 R. P. C. 137.

Evidence.

49. In any proceeding under this Act before the Board of Trade or the Registrar, the evidence shall be given by statutory declaration in the absence of directions to the contrary, but, in any case in which it shall think it right so to do, the tribunal may

Mode of giving evidence.

(with the consent of the parties) take evidence *vivâ voce* in lieu of or in addition to evidence by declaration. Any such statutory declaration may in the case of appeal be used before the Court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

In case any part of the evidence is taken *vivâ voce* the Board of Trade or the Registrar shall in respect of requiring the attendance of witnesses and taking evidence on oath be in the same position in all respects as an Official Referee of the Supreme Court.

This section was new in 1905. Previously it had been necessary in proceedings before the Court to confirm by affidavit the contents of any declarations which it was desired to use.

In practice, *vivâ voce* evidence is very seldom used
As to declarations, see Rules 102 and 103.

Sealed copies
to be evi-
dence.

50. Printed or written copies or extracts of or from the register, purporting to be certified by the Registrar and sealed with the seal of the Patent Office, shall be admitted in evidence in all Courts in His Majesty's dominions, and in all proceedings, without further proof or production of the originals.

This section comes from sect. 89 of the Act of 1883.

Certificate of
Registrar to
be evidence.

51. A certificate purporting to be under the hand of the Registrar as to any entry, matter, or thing which he is authorised by this Act, or rules made thereunder, to make or do, shall be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or not done.

This comes from sect. 96 of the Act of 1883: see Rules 99--101.

Certificate
of Board of
Trade to be
evidence.

52.—(1) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

(2) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.

This comes from sect. 25 of the Act of 1888, inserted as sect. 102 (A) in the Act of 1883.

PART II.

Powers and Duties of Registrar of Trade Marks.

53. Where any discretionary or other power is given to the Registrar by this Act or rules made thereunder he shall not exercise that power adversely to the applicant for registration or the registered proprietor of the trade mark in question without (if duly required so to do within the prescribed time) giving such applicant or registered proprietor an opportunity of being heard.

Exercise of discretionary power by Registrar.

This comes from sect. 94 of the Act of 1883. As to procedure for a hearing, see Rules 78—81.

54. Except where expressly given by the provisions of this Act or rules made thereunder there shall be no appeal from a decision of the Registrar otherwise than to the Board of Trade, but the Court, in dealing with any question of the rectification of the register (including all applications under the provisions of section thirty-five of this Act), shall have power to review any decision of the Registrar relating to the entry in question or the correction sought to be made.

Appeal from Registrar.

This was a new section in 1905. Against refusals to register under sect. 12, appeals may be made either to the Court or the Board of Trade. Under sect. 14, as amended by the Act of 1919, appeals in opposition cases must now be made to the Court. Other cases of appeals are referred to in the notes to the section relevant to the subject-matter in question.

In *Coleman v. Stephen Smith & Co.* (1912), 29 R. P. C. 81, where there was a motion by the plaintiffs to remove the defendants' mark on the ground that it was deceptive, it was suggested that a decision by the Registrar on a previous opposition to the registration, against which no appeal had been made, amounted to a case of *res judicata*, but attention was not called to this section, and no decision on the point was given. It does not appear that attention was called to the importance of rectification from the public point of view.

It should be observed that the reference to the Court in this section only relates to its dealing with any question of rectification, and not to appeals on applications to register. As to whether the Registrar's decision could possibly result in a question being *res judicata* in the latter case, see note (f), p. 67.

55. Where by this Act any act has to be done by or to any person in connexion with a trade mark or proposed trade mark or any procedure relating thereto, such act may under and in accordance with rules made under this Act or in particular cases by special leave of the Board of Trade be done by or to an agent of such party duly authorised in the prescribed manner.

Recognition of agents.

This was a new section in 1905. See Rule 10.

Registrar
may take
directions of
law officers.

56. The Registrar may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to His Majesty's Attorney-General or Solicitor-General for England for directions in the matter.

This section is derived from sect. 95 of the Act of 1883.

Annual
reports of
Comptroller.
46 & 47 Vict.
c. 57.

57. The Comptroller General of Patents, Designs, and Trade Marks shall in his yearly report on the execution by or under him of the Patents, Designs, and Trade Marks Act, 1883, and Acts amending the same, include a report respecting the execution by or under him of this Act as though it formed a part of or was included in such Acts.

As to the annual report, see now sect. 76 of the Patents and Designs Act, 1907.

Powers and Duties of the Board of Trade.

Proceedings
before Board
of Trade.

58. All things required or authorised under this Act to be done by or before the Board of Trade may be done by or before the President or a secretary or an assistant secretary of the Board or any person authorised in that behalf by the President of the Board.

This section comes from sect. 25 of the Act of 1888, numbered 102 (A) in the Act of 1883.

Appeals to
Board of
Trade.

59. Where under this Act an appeal is made to the Board of Trade, the Board of Trade may, if they think fit, refer any such appeal to the Court in lieu of hearing and deciding it themselves, but, unless the Board so refer the appeal, it shall be heard and decided by the Board, and the decision of the Board shall be final.

This section was an extension of the powers to refer contained in sects. 62 and 69 of the Act of 1883. The express provision that the decision of the Board is to be final was new, but in accordance with the view previously held: see *Normal Co.'s Appn.* (1887), 4 R. P. C. 123. For procedure, see Rules 123—129.

Power of
Board of
Trade to
make rules.

60.—(1) Subject to the provisions of this Act the Board of Trade may from time to time make such rules, prescribe such forms, and generally do such things as they think expedient—

a. For regulating the practice under this Act;

b. For classifying goods for the purposes of registration of trade marks:

- (c) For making or requiring duplicates of trade marks and other documents:
- (d) For securing and regulating the publishing and selling or distributing in such manner as the Board of Trade think fit, of copies of trade marks and other documents:
- (e) Generally, for regulating the business of the office in relation to trade marks and all things by this Act placed under the direction or control of the Registrar, or of the Board of Trade.

(2) Rules made under this section shall, whilst in force, be of the same effect as if they were contained in this Act.

(3) Before making any rules under this section the Board of Trade shall publish notice of their intention to make the rules and of the place where copies of the draft rules may be obtained in such manner as the Board consider most expedient, so as to enable persons affected to make representations to the Board before the rules are finally settled.

(4) Any rules made in pursuance of this section shall be forthwith advertised twice in the Trade Marks Journal, and shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament.

(5) If either House of Parliament within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.

This section is derived from sect. 101 of the Act of 1883.

For rules and forms, see Appendix, p. 127.

As to the power of the Board of Trade to direct service of a notice on other parties, see Rule 126: *Extract of Meat, &c. Ltd.'s Appn.* (1900), 17 R. P. C. 161; *Royal Worcester Corset Co.'s Appn.* (1909), 26 R. P. C. 185.

Fees.

61. There shall be paid in respect of applications and registration and other matters under this Act, such fees as may be, with the sanction of the Treasury, prescribed by the Board of Trade.

This section comes from sect. 80 of the Act of 1883.

See Rule 3 and Schedule I.

Special Trade Marks.

Standardiza-
tion, &c.,
trade marks.

62. Where any association or person undertakes to certify the origin, material, mode of manufacture, quality, accuracy or other characteristic of any goods by mark used upon or in connection with such goods, the Board of Trade, if and so long as they are satisfied that such association or person is competent to certify as aforesaid, may, if they shall judge it to be to the public advantage, permit such association or person to register such mark as a trade mark in respect of such goods, whether or not such association or person be a trading association or trader or possessed of a goodwill in connection with such certifying.¹ When so registered such trade mark shall be deemed in all respects to be a registered trade mark, and such association or person to be the proprietor thereof, save that such trade mark shall be transmissible or assignable only by permission of the Board of Trade.

The part of the section printed in brackets was introduced by the Act of 1919 in substitution for the earlier part of the original section of the Act of 1905, which was as follows:—

Where any association or person undertakes the examination of any goods in respect of origin, material, mode of manufacture, quality, accuracy, or other characteristic, and certifies the result of such examination by mark used upon or in connection with such goods, the Board of Trade may, if they shall judge it to be to the public advantage, permit such association or person to register such mark as a trade mark in respect of such goods, whether or not such association or person be a trading association or trader or possessed of a goodwill in connection with such examination and certifying.

For rules in connection with such applications, see Rules 36—40.

It is to be observed that the new form of the section does not require that the applicants should undertake the *examination* of the goods. Several marks were registered before the Act of 1919, although the association in question did not *inspect* the goods. In the application of *Union Nationale Intersyndicale des Marques Collectives* (1922), 39 R. P. C. 97, it was held that the rules, by which the ordinary procedure in opposition cases is made applicable to these special applications, do not enable an opponent to raise any objections which would not be relevant to the case of an ordinary trade mark, such as that the association did not undertake to certify or was not competent to certify. Such objections might be made to the Board of Trade or in proceedings against the Board of Trade. It was also decided that where an application was made and notice of opposition given before the Act of 1919 was passed, and that Act came into operation before the opposition was heard, the substituted provisions must be applied, but that amendment of the notice of opposition should be allowed so as to raise points under the new Act

Sheffield Marks.

63. With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called the Cutlers' Company), and the marks or devices (in this Act called Sheffield marks) assigned or registered by the master, wardens, searchers, and assistants of that company, the following provisions shall have effect:—

Sheffield
marks.

- (1) The Cutlers' Company shall continue to keep at Sheffield the register of trade marks (in this Act called the Sheffield register) kept by them at the date of the commencement of this Act, and, save as otherwise provided by this Act, such register shall for all purposes form part of the register:
- (2) The Cutlers' Company shall, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal goods as defined in this section, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January one thousand eight hundred and eighty-four, but which have not been entered in such register before the passing of this Act:
- (3) An application for registration of a trade mark used on metal goods shall, if made after the commencement of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company:
- (4) Every application so made to the Cutlers' Company shall be notified to the Registrar in the prescribed manner, and, unless the Registrar within the prescribed time gives notice to the Cutlers' Company of any objection to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner:
- (5) If the Registrar gives notice of an objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may in the prescribed manner appeal to the Court:
- (6) Upon the registration of a trade mark in the Sheffield register the Cutlers' Company shall give notice thereof to the Registrar, who shall thereupon enter the mark

- in the register of trade marks; and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the Registrar on that day:
- (7) The provisions of this Act, and of any rules made under this Act with respect to the registration of trade marks and all matters relating thereto, shall, subject to the provisions of this section (and notwithstanding anything in any Act relating to the Cutlers' Company), apply to the registration of trade marks on metal goods by the Cutlers' Company, and to all matters relating thereto; and this Act and any such rules shall, so far as applicable, be construed accordingly with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield register, for the Registrar, the Patent Office, and the Register of Trade Marks respectively; and notice of every entry, cancellation, or correction made in the Sheffield register shall be given to the Registrar by the Cutlers' Company:
- (8) When the Registrar receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade mark used on metal goods, he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company:
- (9) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the Court:
- (10) For the purposes of this section the expression "metal goods" means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal:
- (11) For the purpose of legal proceedings in relation to trade marks entered in the Sheffield register a certificate under the hand of the Master of the Cutlers' Company shall have the same effect as the certificate of the Registrar.

This section comes from sect. 81 of the Act of 1883, as amended by sect. 20 of the Act of 1888.

For rules, see Rules 104—109.

TRADE MARKS ACT, 1905.

100

Cotton Marks.

64.—(1) The Manchester Branch of the Trade Marks Registry of the Patent Office (herein-after called "the Manchester Branch") shall be continued according to its present constitution. A chief officer of the Manchester Branch shall be appointed who shall be styled "the Keeper of Cotton Marks," and shall act under the direction of the Registrar. The present keeper of the Manchester Branch shall be the first Keeper of Cotton Marks. Cotton marks.

(2) As regards cotton goods which have hitherto constituted classes 23, 24, and 25, under the classification of goods under the Patents, Designs, and Trade Marks Acts, 1883 to 1902, the Register of Trade Marks for all such goods, except such as may be prescribed, shall be called "the Manchester Register," and a duplicate thereof shall be kept at the Manchester Branch.

(3) All applications for registration of trade marks for such cotton goods in the said classes (herein-after referred to as "cotton marks") shall be made to the Manchester Branch.

(4) Every application so made to the Manchester Branch shall be notified to the Registrar in the prescribed manner together with the report of the Keeper of Cotton Marks thereon, and unless the Registrar, after considering the report and hearing, if so required, the applicant, within the prescribed time gives notice to the Keeper of Cotton Marks of objection to the acceptance of the application, it shall be advertised by the Manchester Branch and shall be proceeded with in the prescribed manner.

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

(6) Upon the registration of a trade mark in the Manchester Register the Keeper of Cotton Marks shall upon notice thereof from the Registrar thereupon enter the mark in the duplicate of the Manchester Register, and such registration shall bear date as of the day of application to the Manchester Branch, and shall have the same effect as if the application had been made to the Registrar on that day.

(7) When any mark is removed from or any cancellation or correction made in the Manchester Register notice thereof shall

be given by the Registrar to the Keeper of Cotton Marks, who shall alter the duplicate register accordingly.

(8) For the purpose of all proceedings in relation to trade marks entered in the Manchester Register a certificate under the hand of the Keeper of Cotton Marks shall have the same effect as a certificate of the Registrar.

(9) In every application for registration of a cotton mark, if such mark has been used by the applicant or his predecessors in business prior to the date of application, the length of time of such user shall be stated on the application.

(10) As from the passing of this Act—

(a) *In respect of cotton piece goods and cotton yarn no mark consisting of a word or words alone (whether invented or otherwise) shall be registered, and no word or words shall be deemed to be distinctive in respect of such goods (a):*

(b) In respect of cotton piece goods no mark consisting of a line heading alone shall be registered and no line heading shall be deemed to be distinctive in respect of such goods:

(c) No registration of a cotton mark [in respect of cotton piece goods or cotton yarns] (b) shall give any exclusive right to the use of any *word* (a), letter, numeral, line heading, or any combination thereof.

(11) The right of inspection of the Manchester Register shall extend to and include the right to inspect all applications whatsoever that have been since the passing of the Trade Marks Registration Act, 1875, and hereafter shall have been made to the Manchester Branch in respect of cotton goods in classes 23, 24, and 25, whether registered, refused, lapsed, expired, withdrawn, abandoned, cancelled, or pending.

(12) The Keeper of Cotton Marks shall, on request, and on production of a facsimile of the mark, and on payment of the prescribed fee, issue a certified copy of the application for registration of any cotton mark, setting forth in such certificate the length of time of user (if any) of such mark as stated on the application, and any other particulars he may deem necessary.

(13) As regards any rules or forms affecting cotton marks which are proposed by the Board of Trade to be made, the draft of the same shall be sent to the Keeper of Cotton Marks and also to

the Manchester Chamber of Commerce. And the said Keeper, and also the said Chamber, shall, if they or either of them so request, be entitled to be heard by the Board of Trade upon such proposed rules before the same are carried into effect.

(14) The existing practice whereby the keeper of the Manchester Branch consults the Trade and Merchandise Marks Committee appointed by the Manchester Chamber of Commerce upon questions of novelty or difficulty arising on applications to register cotton marks shall be continued by the Keeper of Cotton Marks.

This was a new section in 1905. For procedure, see Rules 110—121.

(a) The words in italics were repealed by sect. 12 of the Act of 1919: see p. 115.

(b) The words in square brackets were inserted by the Trade Marks Act, 1914: see p. 126.

In consequence of sub-sect. 10 (c), marks which consist substantially only of the particulars therein enumerated are refused registration in Part A. for the cotton goods mentioned. It would appear that the sub-section need not affect applications in Part B.

International and Colonial Arrangements.

65. The provisions of sections one hundred and three and one hundred and four of the Patents, Designs, and Trade Marks Act, 1883 (as amended by the Patents, Designs, and Trade Marks (Amendment) Act, 1885), (a), relating to the registration of trade marks both as enacted in such Acts and as applied by any Order in Council made thereunder, shall be construed as applying to trade marks registrable under this Act.

International
and Colonial
arrange-
ments.
48 & 49 Vict.
c. 63.

(a) Sect. 91 of the Patents and Designs Act, 1907, as amended by sect. 20 of the Patents and Designs Act, 1919, has now been substituted for sects. 103—4 of the Act of 1883—5.

As to International and Colonial arrangements, see p. 175.

Offences.

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

Falsification
of entries in
register.

This section comes from sect. 93 of the Act of 1883.

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

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

(2) A person shall be deemed, for the purposes of this enactment, to represent that a trade mark is registered, if he uses in connection with the trade mark the word "registered," or any words expressing or implying that registration has been obtained for the trade mark.

This section comes from sect. 105 of the Act of 1883.

The words "trade mark" alone do not import that the mark is registered, and their use would not therefore constitute an offence: see *Sen Sen Co. v. Britten* (1899), 16 R. P. C. 137; *Royal Baking Powder Co. v. Wright, Crossley & Co.* (1901), 18 R. P. C. 95.

As to criminal offences in connection with trade marks and other indications of origin, &c., see Merchandise Marks Act, 1887.

As to false statements with respect to patents and designs, see sect. 89 of the Patents and Designs Act, 1907.

Royal Arms.

Unauthorised
assumption of
Royal Arms.

68. If any person, without the authority of His Majesty, uses in connexion with any trade, business, calling, or profession, the Royal Arms (or arms so closely resembling the same as to be calculated to deceive, in such manner as to be calculated to lead to the belief that he is duly authorised so to use the Royal Arms, or if any person without the authority of His Majesty or of a member of the Royal Family, uses in connexion with any trade, business, calling, or profession any device, emblem, or title in such manner as to be calculated to lead to the belief that he is employed by or supplies goods to His Majesty or such member of the Royal Family, he may, at the suit of any person who is authorised to use such arms or such device, emblem, or title, or is authorised by the Lord Chamberlain to take proceedings in that behalf, be restrained by injunction or interdict from continuing so to use the same: Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing any such arms, device, emblem, or title to continue to use such trade mark.

This was a new section in the Act of 1905, extending the provisions of sect. 106 of the Act of 1883. Similar, but extended, provisions are now contained in sect. 90 of the Patents and Designs Act, 1907: see p. 121.

Injunctions have been obtained by the Royal Warrant Holders'

Association in a number of cases: *Royal Warrant Holders' Association v. Slade* (1908), 25 R. P. C. 245; *Royal, &c. v. Kitson* (1909), 26 R. P. C. 157; *Royal, &c. v. Deane & Beal* (1911), 28 R. P. C. 721; *Royal, &c. v. Matthews* (1915), 32 R. P. C. 81; *Royal, &c. v. Boguslavsky, ibid.* 83; *Royal, &c. v. Sullivan*, (1911) 1 Ir. 236. The question whether the association or any of its members were persons aggrieved so as to have a *locus standi* to apply for rectification under sect. 35, was discussed in *Imperial Tobacco Co.'s T. Ms.* (1915), 32 R. P. C. 361, but the decision was given on the ground that the marks in question were not calculated to deceive.

Prior to the Act of 1905, it had been the practice to refuse marks of this character, and as to cases not covered by the section, see Rules 11-13. In *Koenig v. Ebbard's T. M.* (1896), 13 R. P. C. 451, the validity of any office rule, apart from an exercise of discretion in each particular case, was questioned; the mark in that case was held not to resemble a royal crown. As to the word "royal," see *Royal Worcester Corset Co.'s Appn.* (1909), 26 R. P. C. 185, and *Carron Co.'s Appn.* (1910), 27 R. P. C. 112; *Royal Baking Powder Co.'s Appn.* (1902), 19 R. P. C. 261.

Courts.

69. The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in any proceedings relating to trade marks; and with reference to any such proceedings in Scotland the term "the Court" shall mean the Court of Session; and with reference to any such proceedings in Ireland the term "the Court" shall mean the High Court of Justice in Ireland.

General
saving for
jurisdiction
of Courts.

70. This Act shall extend to the Isle of Man, and —

Isle of Man.

- (1) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man in proceedings for infringement or in any action or proceeding respecting a trade mark competent to those Courts;
- (2) The punishment for a misdemeanor under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour and with or without a fine not exceeding one hundred pounds, at the discretion of the Court;
- (3) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Jurisdiction
of Lancashire
Palatine
Court.

71. The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade marks, the registration whereof is applied for in the Manchester Branch, have the like jurisdiction under this Act as His Majesty's High Court of Justice in England, and the expression "the Court" in this Act shall be construed and have effect accordingly:

Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that Court in other cases.

72. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the Sheriff Court.

Sects. 69-72 relate to the jurisdiction of Courts other than the High Court in England, and are derived, with modifications, from sects. 108, 111, 112, 112A of the Act of 1883.

The expression "the Court" is defined in sect. 3 of the Act of 1905 as meaning "(subject to the provisions for Scotland, Ireland and the Isle of Man) His Majesty's High Court of Justice in England." The effect of this definition, when read with sect. 69, is not easily determined. Under the corresponding, though not identical, provisions of the Act of 1883, it was held: (1) by the English High Court, in *King's T. M.* (1892), 9 R. P. C. 350, that that Court had jurisdiction to remove a mark of which the registered proprietor was domiciled in Ireland, no opinion being expressed as to whether the Irish Courts had concurrent jurisdiction; (2) by the Irish Court, in *Boyer v. Connell* (1893), 16 R. P. C. 157, that there was no jurisdiction in that Court to rectify the register; (3) by the Scotch Court of Session, in *Dewar v. Dewar* (1900), 17 R. P. C. 341, that the Scotch Court had jurisdiction to decide between parties domiciled in Scotland the question whether a trade mark was rightly registered, and that under sect. 111 (2) of the Act of 1883, the effect of a decision that the mark was not rightly registered was that the Comptroller was required to expunge the entry. In the latter case the question whether the Court could entertain a petition to expunge under sect. 90 was left open, though in *Cowie v. Herbert* (1897), 14 R. P. C. 436, the Lord Ordinary had entertained such a proceeding. *Dewar v. Dewar* was followed in *Darson v. Stewart* (1905), 22 R. P. C. p. 253, and *Reid v. Thomson, ibid.* p. 379.

In the Act of 1905, sect. 111 (2) of the Act of 1883 is not reproduced, except partially in sect. 35 (4), and consequently the *ratio decidendi* in *Dewar v. Dewar*, so far as it decides that rectification is the necessary consequence of the decision of a Scotch Court that a registration is not valid, is no longer applicable. But in *Board v. Thom & Cameron* (1907), 24 R. P. C. 697, where proceedings were begun before, and decided after, the passing of the Act of 1905,

Dewar v. Dewar was assumed, without argument, to be still authoritative, and the former case was treated as settling the law under the Act of 1905 in *Walter v. Kejo* (No. 1) (1921), 38 R. P. C. 25, but no attention was drawn to the altered language of the Act of 1905. The question whether the Scotch or Irish Courts have jurisdiction to entertain applications under sect. 35 cannot therefore be regarded as finally determined.

Repeal: Savings.

*73. The enactments described in the schedule to this Act are repealed to the extent mentioned in the third column, but this repeal shall not affect any rule, table of fees, or classification of goods made under any enactment so repealed, but every such rule, table of fees, or classification of goods shall continue in force as if made under this Act until superseded by rules, tables of fees, or classification under this Act. Repeal and saving for rules, &c.

74. The provisions of sections eighty-two to eighty-four of the Patents, Designs, and Trade Marks Act, 1883, as amended by any subsequent enactment, shall continue to apply with respect to the administration at the Patent Office of the Law relating to the registration of trade marks, and shall accordingly be construed as if this Act formed part of that Act. Application of 46 & 47 Vict. c. 57, ss. 82-84.

SCHEDULE.

Sect. 73.

ENACTMENTS REPEALED.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Sections sixty-two to eighty-one, and, so far as they respectively relate to trade marks, sections eighty-five to ninety-nine, one hundred and one, one hundred and two, one hundred and five, one hundred and eight, and one hundred and eleven to one hundred and seventeen.
51 & 52 Vict. c. 50.	The Patents, Designs, and Trade Marks Act, 1888.	Sections eight to twenty, and, so far as they respectively relate to trade marks, sections twenty-one to twenty-six.

The effect of this repeal is that the whole of the part of the Act of 1883 devoted exclusively to trade marks is repealed, and that, of the general part of the Act, the only sections left unrepealed which

affected trade marks were sects. 82 to 84 (relating to administration of the Patent Office), sects. 103 and 104 (relating to International and Colonial arrangements), and sect. 106 (relating to the Royal Arms, &c.).

Sects. 82 to 84 of the Act of 1883 have since been replaced by sects. 62 to 64 of the Patents and Designs Act, 1907, sects. 103 and 104 by sects. 91 and 88 of that Act, and sect. 106 by sect. 90 of that Act.

Sect. 91 of the Patents and Designs Act, 1907, has been amended by sect. 20 of the Patents and Designs Act, 1919. See p. 123.

TRADE MARKS ACT, 1919.

[9 & 10 GEO. 5, c. 79.]

An Act to amend the Trade Marks Act, 1905.

[23rd December, 1919.]

BE it enacted by the King's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:—

PART I.

REGISTRATION OF CERTAIN TRADE MARKS NOT REGISTRABLE UNDER PRINCIPAL ACT.

1.—(1) The register of trade marks (including the Manchester Register) kept under the Trade Marks Act, 1905 (hereinafter referred to as the principal Act), shall be divided into two parts to be called respectively Part A. and Part B. (*a*).

(2) Part A. of the register shall comprise all trade marks entered in the register of trade marks at the commencement of this Act and all trade marks which after the commencement of this Act may be registered under the provisions of the principal Act (*b*).

(3) Part B. shall comprise all trade marks registered under this Part of this Act, and all trade marks entered on or removed thereto under this Act (*c*).

(*a*) Register of trade marks: see sects. 4—7 of the principal Act; Manchester Branch Register, *ibid.* s. 64. The Sheffield Register forms part of the register: *ibid.* s. 63.

(*b*) Part III. of the Act of 1919 makes certain amendments to the Act of 1905, some of which, *e.g.*, sect. 7, affect the question of

Division of register of trade marks into two parts.

5 Edw. 7, c. 15.

registrability; consequently the expression "provisions of the principal Act" in this sub-section must include the provisions of the Act of 1905, as amended by the Act of 1919.

(c) Provision for removal from Part A. to Part B. is made by sect. 9 (3).

2. - (1) Where any mark has for not less than two years been bona fide used in the United Kingdom upon or in connection with any goods (whether for sale in the United Kingdom or exportation abroad) for the purpose of indicating that they are the goods of the proprietor of the mark by virtue of manufacture, selection, certification, dealing with or offering for sale (a), the person claiming to be the proprietor of the mark may apply in writing to the registrar in the prescribed manner (b) to have the mark entered as his registered trade mark in Part B. of the register in respect of such goods.

Registration
of trade
marks in
Part B.

(a) Compare the words of the definition contained in sect. 3 of the Act of 1905, and see notes to that section. A mark may be used in the United Kingdom, although the proprietor has no actual place of business there, if the goods are sold by a third party under the mark for the purpose mentioned: cf. *Magnolia Metal Co.'s T. M.* (1897), 14 R. P. C. p. 628; and in relation to the reputation attaching to trade names, *Panhard v. Panhard* (1901), 18 R. P. C. 405; *Poirot v. Poirot* (1920), 37 R. P. C. p. 187.

The two years' user is a condition precedent to application. It does not necessarily give rise to a right to registration: see sub-sec. 2.

(b) As to procedure, see Rules 16 *et seq.* and 35.

(2) The registrar shall consider every such application for registration of a trade mark in Part B. of the register, and if it appears to him, after such search, if any, as he may deem necessary, that the application is inconsistent with the provisions of section eleven or section nineteen of the principal Act, or if he is not satisfied that the mark has been so used as aforesaid, or that it is capable of distinguishing (a) the goods of the applicant, he may (b) refuse the application, or may accept it subject to conditions (c), amendments or modifications as to the goods or classes of goods in respect of which the mark is to be registered, or to such limitations, if any, as to mode or place of user or otherwise as he may think right to impose, and in any other case he shall accept the application (d).

(a) In considering the expression "adapted to distinguish" in sect. 9 of the Act of 1905, the Courts have taken the view that there are some words, such as "best," which are incapable of dis-

tinguishing the goods of one trader from those of another: see *Crosfield's Appn.* (1909), 26 R. P. C. 827, and other cases cited at p. 51.

(b) Sects. 11 and 19 of the Act of 1905 are applicable to registration under this part of the Act: see sect. 3. Consequently, in the case of applications inconsistent with either of those sections, the Registrar not only *may*, but *must*, refuse the application unless the conditions, amendments, &c. next mentioned enable the registration to be made consistently with both sections.

(c) The provision as to conditions and limitations, &c. is similar to those contained in sect. 12 and elsewhere in the Act of 1905. Sect. 15 of that Act as to disclaimers does not apply.

(d) Contrast this with sect. 12 (2) of the Act of 1905, where there is no express obligation to accept a mark: see *Egg Products Ltd's Appn.* (1922), 39 R. P. C. 155.

(3) Every such application shall be accompanied by a statutory declaration (a) verifying the user, including the date of first user, and such date shall be entered on the register.

(4) Any such refusal or conditional acceptance shall be subject to appeal to the Court, and, if the ground for refusal is insufficiency of evidence as to user, such refusal shall be without prejudice to any application for registration of the trade mark under the provisions of the principal Act (b).

(5) Every such application shall, if accepted, be advertised in accordance with the provisions of the principal Act (c).

(6) A mark may be registered in Part B, notwithstanding any registration in Part A, by the same proprietor of the same mark or any part or parts thereof (d).

(a) See sect. 49 and Rules 102, 103.

(b) Applications under the Act of 1905, except in the case of certain marks mentioned in sect. 9 (5), may be granted without evidence of user, and even in the latter case no length of user is specified. There could not therefore be any suggestion as to *res judicata* in the case covered by this sub-section. Where the question was one of similarity to existing marks, there might be a case of *res judicata*: see *Massachusetts Co.'s Appn.* (1918), 35 R. P. C. 137.

(c) This follows from sect. 13 of the Act of 1905, which applies to Part B.: see sect. 3 of the Act of 1919. As to procedure, see Rules 41-44. After advertisement there is an opportunity for opposition: see sect. 14 of the Act of 1905.

(d) In this case association cannot be required as under the Act of 1905, sects. 24, 25 and 27 of that Act not being applicable.

Application of certain provisions of principal Act to Part B. trade marks.

3. The provisions of the principal Act, as amended by this Act, with the exception of those set out in the First Schedule (a) to this Act, shall, subject to the provisions of this Part of this Act, apply in respect of trade marks to which this Part of this Act

applies as if they were herein re-enacted and in terms made applicable to this Part of this Act.

(a) The first schedule is as follows:—

PROVISIONS OF PRINCIPAL ACT NOT APPLIED.

No. of Section.	Subject-matter.
1	Short title
2	Commencement of Act.
6	Incorporation of existing register.
9	Registrable trade marks.
12	Application for registration.
14 & 9	Modification of trade mark on appeals.
15	Disclaimers.
24	Associated trade marks.
25	Combined trade marks.
27	Assignment and user of associated trade marks.
31	Status of unrenewed trade marks.
36	Trade marks registered under previous Acts.
39 (except proviso)	Rights of proprietor of trade mark.
41 down to the words " against the provisions " of section eleven of " this Act."	Registration to be conclusive after seven years.
42	Unregistered trade mark.
62	Standardization, &c., trade marks.
73	Repeal and saving for rules, &c.

Of the sections not applied, those which are most material are sects. 9, 39 and 41.

One of the objects of the introduction of registrations under Part B. was to obviate a difficulty experienced by British traders in certain foreign countries where registration of a trade mark could not be obtained unless the mark was already registered in the country of origin. The result of this was that a British trader might have a trade mark well known in a foreign country, but be unable to register it owing to the mark not being registrable in the United Kingdom, while an unscrupulous competitor in a foreign country, not being under a similar disability under the law of his country, might step in and oust the British trader by obtaining registration.

It appears, however, to have been considered desirable not to eliminate the safeguards contained in the Act of 1905 against the risk of indiscriminate monopolisation of marks. Consequently, the most important rights secured by the provisions of sects. 39 and 41 were materially modified in regard to the effect of registration in Part B. For the rights conferred by sect. 39 there are substituted the less valuable rights conferred by sect. 4 of the Act of 1919, and the provisions of sect. 41, restricting the grounds upon which the validity of the original registration can be attacked after the lapse of seven years, are not applied to registrations in Part B.

The other excepted sections are either inapplicable or of minor importance.

Effect of registration in Part B.

4. The registration of a person as the proprietor of a trade mark in Part B. of the register shall be *prima facie* evidence that that person has the exclusive right to the use of that trade mark (a) but, in any action for infringement of a trade mark entered in Part B. of the register, no injunction, interdict or other relief shall be granted to the owner of the trade mark in respect of such registration, if the defendant establishes to the satisfaction of the Court that the user of which the plaintiff complains is not calculated to deceive (b) or to lead to the belief that the goods the subject of such user were goods manufactured, selected, certified, dealt with or offered for sale by the proprietor of the trade mark.

(a) This section does not, as does sect. 39 of the Act of 1905, bring into existence a statutory right materially different from that recognised by the Common Law or Equity. It shifts the onus of proof in favour of the proprietor of a mark registered in Part B., in regard to a claim to the exclusive right which, before the Registration Acts, a trader could have established by proving that the trade mark was in fact distinctive of his goods. Its effect is to facilitate an action for infringement in this country in cases where previously an application and refusal of registration under the Act of 1905 would have been necessary (see sect. 42), and it may also facilitate registration abroad of marks not registrable in Part A.

The words down to note (a) correspond with the first part of sect. 76 of the Act of 1883 and sect. 3 of the Act of 1875. As to the construction of such words, reference may be made to cases decided under those Acts: *e.g.*, *Palmer's T. M.* (1882), 21 Ch. D. at p. 57; *Pinto v. Badman* (1891), 8 R. P. C. 181; *Bow v. Hart* (1905), 22 R. P. C. 222. Under this section a defendant, even if he has used a mark identical with the plaintiff's, may succeed without an application to expunge the entry, but where validity is in effect challenged, it will probably be advisable to apply for rectification.

(b) The effect of requiring a defendant to prove that his user is not calculated to deceive, as well as not calculated to lead to the belief, &c., is not very clear. Normally, proof of the latter alone would negative the plaintiff's right to relief.

As to the meaning of "calculated to deceive," see notes to sect. 11.

Power to treat applications for registration in Part A. as applications for registration in Part B.

5. If any person applies for the registration of a trade mark under the principal Act in Part A. of the register, the registrar may, if the applicant is willing, instead of refusing the application, treat it as an application for registration in Part B. of the register under this Part of this Act and deal with the application accordingly.

This section does not in terms give a similar power to the Court, but the power here conferred is discretionary, and sect. 8 (2) may be

construed as conferring the same power upon the Court. If, however, the Registrar objected, it might be held that an application to register in Part B., not being the subject-matter of the appeal before the Court, could not be dealt with.

PART II.

PROVISIONS FOR THE PREVENTION OF ABUSES OF TRADE MARKS.

6.—(1) Where in the case of an article or substance manufactured under any patent in force at or granted after the passing of this Act, a word trade mark registered under the principal Act or Part I. of this Act is the name (*a*) or only practicable name (*b*) of the article or substance so manufactured, all rights to the exclusive use of such trade mark, whether under the common law (*c*) or by registration (and notwithstanding the provisions of section forty-one of the principal Act), shall cease upon the expiration or determination of the patent, and thereafter such word shall not be deemed a distinctive mark, and may be removed by the Court from the register on the application of any person aggrieved (*d*).

Removal from register of word trade marks used as names of articles.

(2) (*e*) No word which is the only practicable (*f*) name or description of any single chemical element or single chemical compound, as distinguished from a mixture, shall be registered as a trade mark, and any such word now or hereafter on the register may, notwithstanding section forty-one of the principal Act, be removed by the Court from the register on the application of any person aggrieved:

Provided that—

- (a) the provisions of this subsection shall not apply where the mark is used to denote only the proprietor's brand or make of such substance, as distinguished from the substance as made by others, and in association with a suitable and practicable name open to the public use (*g*); and
- (b) in the case of marks registered before the passing of this Act, no application under this section for the removal of the mark from the register shall be entertained until after the expiration of four years from the passing of this Act (*h*).

(3) The power to remove a trade mark from the register conferred by this section shall be in addition to and not in derogation of any other powers of the Court in respect of the removal of trade marks from the register.

(4) The provisions contained in Part III. of this Act authorising applications for the rectification of the register to be made in the first instance to the registrar instead of to the Court shall apply to applications under this section (*i*).

If application is made to register a word which is understood by the public as the mere name for an article, whether patented or not, registration will be refused: see *Gramophone Co.'s Appn.* (1910), 27 R. P. C. 689; *Williams' Appn.* (1917), 34 R. P. C. 197, and notes, pp. 17, 55, *ante*. If such registration were allowed, the trade might be hampered by being unable to sell the same article made by other manufacturers under the name habitually used by purchasers intending to use it only as a mere description of the article; and so long as the name was registered, the proprietor might in effect acquire something approaching a monopoly in the manufacture of the article.

Sect. 6 of the Act of 1919 points to the possibility of a word mark getting on to the register, either because at the time it was not yet recognised by the public as the mere name for the article, or because the facts were not fully known. Difficulty might then be experienced in removing such a mark after the lapse of seven years from the date of registration, having regard to the terms of sect. 41 of the Act of 1905. The new section provides a remedy in certain specific cases, but it should not therefore be assumed that, but for this section, there was no remedy either in these or other similar cases. That question may still have to be determined: see notes to sect. 41, p. 85, *ante*.

The particular cases dealt with by the section are probably the most important instances of what the heading to the section characterises as "abuses of trade marks." Thus, during the currency of a patent it might be difficult to question the validity of the registration while the article in question was made by only one manufacturer, and, in the absence of competitors, no one might have a sufficient incentive to do so. Similarly, the production of a chemical element or compound is often the subject of a secret process which effectually keeps competitors out of the field. In either case, when the manufacture became open to others, registration might have the effect of interfering with the trade as mentioned above.

(a) The name must here mean the *only* name.

(b) "Practicable" in this context should probably be understood with reference to the requirements of the public at the time. A difficult scientific description would probably not be regarded as a "practicable" name.

(c) This is in appearance a marked departure from the policy of sect. 45 of the Act of 1905, but as it would have been practically impossible at common law to establish any exclusive right to the only practicable name of an article formerly patented, it does not effect any serious change in the law: see, for example, *Linoleum Co. v. Nairn* (1878), 7 Ch. D. 834; and pp. 17, 18, *ante*.

The section would not interfere with a common law action in which the plaintiff's case rested, not on a claim to an exclusive right to the name, but on the use by the defendant of the name coupled with some additional circumstance calculated to deceive. In such a case the cause of action would arise, not from the use of the name, but from the combination of circumstances.

(d) As to "person aggrieved," see note (c), p. 81.

As to the procedure on such an application to the Court, see notes to sect. 35 of the Act of 1905, p. 80; and on applications to the Registrar as provided for by sub-sect. (4), see sect. 9 of the Act of 1919.

(e) Sub-sect. (2) is not confined to the case of patented articles.

(f) "Practicable" qualifies both "name" and "description"; and see note (b), above.

(g) As proviso (a) presupposes the existence of a practicable name other than the word trade mark, the proviso may be redundant. Possibly it is intended to make it clear that, in the case referred to, the registration is not to be expunged under the section on the argument that the word trade mark is still "the name" for the article because the public has not chosen to adopt the alternative suggested by the proprietor.

(h) The Act was passed on 23rd December, 1919.

(i) See sect. 9 of this Act and sect. 35 of the Act of 1905.

PART III.

GENERAL AMENDMENTS OF PRINCIPAL ACT.

7. In paragraph (5) of section nine of the principal Act (which defines the particulars which registrable trade marks must contain or consist of) for the words "except by order of the Board of Trade or the Court be deemed a distinctive mark," there shall be substituted the words "be registrable under the provisions of this paragraph, except upon evidence of its distinctiveness." Amendment of the law as to registrable trade marks.

See notes to sect. 9 of the Act of 1905.

8.—(1) All appeals from the decisions of the registrar under section fourteen of the principal Act shall be made to the Court, and an appeal shall not lie from any such decision to the Board of Trade, and accordingly that section shall have effect, subject to the modifications set forth in the Second Schedule to this Act: Appeals.

Provided that nothing in this subsection shall affect any appeal which may be pending at the commencement of this Act.

(2) In any appeal from the decision of the registrar to the Court under the principal Act or this Act the Court shall have

and exercise the same discretionary powers as under the principal Act or this Act are conferred upon the registrar.

Sect. 14 of the Act of 1905 relates to proceedings on opposition to an application to register.

It should be observed that sect. 8 (2) is not confined to decisions on applications to register, though it was probably passed mainly to remove any doubts as to the freedom of the Court in this respect: see notes, p. 63. and *Diamond T. Motor Co.'s Appn.* (1921), 38 R. P. C. 373.

Rectification
of register.

9.—(1) Any application for the rectification of the register or the removal of any trade mark from the register in respect of any goods which, under section thirty-five or section thirty-seven of the principal Act or under Part II. of this Act, is to be made to the Court, may, at the option of the applicant, be made in the first instance to the registrar (*a*):

Provided that no such application shall be made otherwise than to the Court where an action concerning the trade mark in question is pending.

(2) The registrar may, at any stage of the proceedings, refer any such application to the Court or he may, after hearing the parties, determine the question between them, subject to appeal to the Court.

(3) In any proceedings for the rectification of the register under this Act or under section thirty-five of the principal Act as amended by this section the Court or the registrar shall, in addition to the powers conferred by that section as so amended, have power to direct a trade mark entered in Part A. of the register to be removed to Part B. of the register (*b*).

(*a*) As to procedure on applications under this section, see Rules 90—92. Rules 47—56, which are applied *mutatis mutandis*, relate to opposition to registration. In applying these rules, the word “applicant” must be understood as referring to the registered proprietor, and the word “opponent” as referring to the applicant to rectify.

As to procedure on appeals, see Rule 122.

In simple cases the procedure allowed by this section will probably be convenient and less expensive, but where there is a serious contest of fact, so that discovery or cross-examination may be required, it will be more satisfactory to apply to the Court at once under sect. 35.

(*b*) Such an order would be appropriate, when the only objection to the mark is that it is not a registrable trade mark within the categories enumerated in sect. 9 of the Act of 1905.

Costs.

10. In all proceedings before the registrar under the principal Act or this Act the registrar shall have power to award to any

party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of Court.

As to costs generally, see p. 90, *ante*.

11. For section thirty-three of the principal Act, the following section shall be substituted:—

“33.—(1) Where a person becomes entitled by assignment, transmission, or other operation of law to a registered trade mark, he shall make application to the registrar to register his title, and the registrar shall, on receipt of such application and on proof of title to his satisfaction, register him as the proprietor of the trade mark, and shall cause an entry to be made in the prescribed manner on the register of the assignment, transmission, or other instrument affecting the title. Any decision of the registrar under this section shall be subject to appeal to the Court.

Registration
of assign-
ments.

“(2) Except in cases of appeals under this section and applications made under section thirty-five of this Act, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of subsection (1) *aforsaid* shall not be admitted in evidence in any Court in proof of the title to a trade mark unless the Court otherwise directs.”

For notes to this section, see sect. 33 of the Act of 1905, p. 78.

12. The amendments specified in the second column of the Second Schedule to this Act, which relate to minor details, shall be made in the provisions of the principal Act specified in the first column of that schedule.

Minor
amendments
of principal
Act.

The amendments effected by this section are incorporated in the text of the Act of 1905, new words being printed in square brackets, the repealed words being shown in italics.

13.—(1) This Act may be cited as the Trade Marks Act, 1919, and the Trade Marks Acts, 1905 and 1914, and so much of the Patents and Designs Acts, 1907 to 1919, as relates to trade marks (*a*), and this Act may be cited together as the Trade Marks Acts, 1905 to 1919.

Short title,
construction
and com-
mencement.

(2) This Act shall be construed as one with the principal Act and shall come into operation on the first day of April nineteen hundred and twenty.

(*a*) As to the sections of the Patents and Designs Act, 1907, which are applicable, see notes to sect. 74 of the Act of 1905. The relevant sections are printed in Appendix A.

TRADE MARKS ACT, 1919.

SCHEDULES.

Sect. 3

FIRST SCHEDULE.

PROVISIONS OF PRINCIPAL ACT NOT APPLIED.

No. of Section.	Subject-matter.
1	Short title.
2	Commencement of Act.
6	Incorporation of existing register.
9	Registrable trade marks.
12	Application for registration.
14 (9)	Modification of trade mark on appeals.
15	Disclaimers
24	Associated trade marks.
25	Combined trade marks.
27	Assignment and user of associated trade marks.
31	Status of unrenewed trade marks.
36	Trade marks registered under previous Acts.
39 (except proviso)	Rights of proprietor of trade mark.
41 down to the words " against the provisions " of section eleven of " this Act."	Registration to be conclusive after seven years.
42	Unregistered trade mark.
62	Standardization, &c., trade marks
73	Repeal and saving for rules, &c.

Sects. 8
and 12.

SECOND SCHEDULE

MINOR AMENDMENTS OF PRINCIPAL ACT.

Section Amended.	Nature of Amendment.
Section 12	At the end of subsection (2) there shall be inserted the following words " or to such limitations, if any, as to mode or place of user or otherwise as he may think right to impose." In subsection (4), after the words " modifications, if any," shall be inserted the words " or to what limitations, if any, as to mode or place of user or otherwise."
Section 13	After the word " conditions " in both places where it occurs, there shall be inserted the words " and limitations." At the end of the section there shall be inserted the words " Provided that an application under the provisions of subsection (5) of section nine of this Act may be advertised by the registrar on receipt of such application and before acceptance."
Section 14	In subsection (4), after the word " conditions " there shall be inserted the following words " or what limitations as to mode or place of user or otherwise." In subsection (5) the words " or with the consent of the parties to the Board of Trade " shall be repealed. In subsection (6) the words " the Board of Trade or " and " as the case may be " shall be repealed; and after the