

16 Eq., 117; but *quære* if this is not expressed too broadly. See the cases under "Patent," p. 95.

The Master of the Rolls, in *Jewitt v. Eckhardt* (1878), 8 Ch. D., 404, expressed the opinion that it is necessary that all transfers of the whole or partial interest after registration be in writing, and that the proprietor be registered before he can grant partial interests. This would not apply to the transfer of the whole interest before registration. See "Register" (p. 191, etc.).

## CHAPTER IV

### THE APPLICATION

By s. 47, sub-ss.

“(1) The comptroller may, on application by or on behalf of any person claiming to be the proprietor of any new or original design not previously published in the United Kingdom, register the design under this part of this Act.

“(2) The application must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed, and must be left at, or sent by post to, the Patent Office in the prescribed manner (p. 187).

“(3) The application must contain a statement of the nature of the design, and the class or classes of goods in which the applicant desires that the design be registered.

“(4) The same design may be registered in more than one class.

“(5) In case of doubt as to the class in which a design ought to be registered, the comptroller may decide the question.

“(6) The comptroller may, if he thinks fit, refuse to register any design presented to him for registration, but any person aggrieved by any such refusal may appeal therefrom to the Board of Trade (p. 190).

“(7) The Board of Trade shall, if required, hear the

applicant and the comptroller, and may make an order determining whether and subject to what conditions, if any, registration is to be permitted."

By s. 48, sub-ss.

"(1) On application for registration of a design the applicant shall furnish to the comptroller the prescribed number of copies of drawings, photographs, or tracings of the design, sufficient, in the opinion of the comptroller, for enabling him to identify the design; or the applicant may, instead of such copies, furnish exact representations or specimens of the design.

"(2) The comptroller may, if he thinks fit, refuse any drawing, photograph, tracing, representation, or specimen which is not, in his opinion, suitable for the official records."

The application must be made by the proprietor (p. 183) or his duly authorised agent (p. 187), in the prescribed Form E (p. 203), which must be followed as closely as possible. Form O should be used when it is intended to apply the design to a set of articles (p. 208).

As to international and colonial arrangements, see s. 103 (p. 297).

The classes are given in the third schedule of the Rules of 1890 as follows:—

*"Classification of Articles of Manufacture and Substances*

"1. Articles composed wholly or chiefly of metal, not included in Class 2.

"2. Jewellery.

"3. Articles composed wholly or chiefly of wood, bone, ivory, papier-maché, or other solid substances not included in other classes.

"4. Articles composed wholly or chiefly of glass, earthenware or porcelain, bricks, tiles or cement.

“5. Articles composed wholly or chiefly of paper (except hangings).

“6. Articles composed wholly or chiefly of leather, including bookbinding, of all materials.

“7. Paper-hangings.

“8. Carpets and rugs in all materials, floorcloths, and oilcloths.

“9. Lace, hosiery.

“10. Millinery and wearing apparel, including boots and shoes.

“11. Ornamental needlework on muslin or other textile fabrics.

“12. Goods not included in other classes.

“13. Printed or woven designs on textile piece goods.

“14. Printed or woven designs on handkerchiefs and shawls.”

The following Rules regulate the procedure:—

“6. All communications between an applicant for the registration of a design and the comptroller or the Board of Trade, as the case may be, may be made by or through an agent duly authorised to the satisfaction of the comptroller.

“7. An application for the registration of a design shall, with the prescribed fee (p. 201), be left at the Patent Office (Designs Branch), or be sent prepaid by post, addressed to the Comptroller at the Patent Office (Designs Branch), 25 Southampton Buildings, Chancery Lane, London.

“8. An application for the registration of a design, and all drawings, sketches, photographs, or tracings of a design, and all other documents sent to or left at the Patent Office (Designs Branch), or otherwise furnished to the comptroller or to the Board of Trade, shall be written, printed, copied, or drawn upon strong, wide-ruled, foolscap paper



(on one side only), of the size of 13 inches by 8 inches, leaving a margin of not less than one inch and a-half on the left-hand part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand.

“The comptroller may, in any particular case, vary the requirements of this Rule as he may think fit.

“9. An application for the registration of a design shall be accompanied by a sketch or drawing, or by three exactly similar drawings, photographs, or tracings of the design, or by three specimens of the design, and shall, in describing the nature of the design, state whether it is applicable for the pattern or for the shape or configuration of the design, and the means by which it is applicable.

“When sketches, drawings, or tracings are furnished they must be fixed.

“When the articles to which designs are applied are not of a kind which can be pasted into books—drawings, photographs, or tracings of such designs shall be furnished.

“10. If the comptroller determines to register a design he shall, as soon as may be, send to the applicant a certificate of such registration in the prescribed form, sealed with the seal of the Patent Office.

“11. Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office or to the comptroller, or to any other person under these Rules, may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

“In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.”

As to the exercise of discretionary powers by the controller, see p. 289.

The following Instructions are issued by the Patent Office (Designs Branch):—

*“The Drawings or Photographs*

“7. The drawings, etc., accompanying an application, must be sent in triplicate, each representation of each design or set to be upon ordinary foolscap paper, and not on cardboard (on one side only), of the size of 13 inches by 8 inches.

“8. When sketches, drawings, or tracings are furnished, they should be in ink, or if in pencil they must be fixed. Drawings on tracing paper cannot be received, unless mounted on ordinary foolscap paper.

“9. Rough sketches cannot be accepted.

“10. When the design is to be applied to a set, each of the drawings accompanying the application, or the sketch, if a sketch is sent, should show all the various arrangements in which it is proposed to apply the design to the articles included in the set.

“11. When specimens of the design are furnished in lieu of drawings or photographs, they must be of such a nature as can be pasted into books; the dimensions of each specimen must not exceed 12 inches by 21 inches, and each must, when necessary, be mounted upon ordinary foolscap paper of the size above mentioned. Each representation of a design in Classes 13 and 14 should show the complete pattern and a portion of the repeat, and ought not to be of less size than 7 inches by 3 inches.

“12. Only two views of the same design can be accepted, unless in the case of a design for a set. Each view should be designated in writing, *i.e.* front view, side

view. Both views should be on one and the same half-sheet of foolscap paper."

#### APPEAL

The following Rules apply :—

"15. Where the comptroller refuses to register a design, and the applicant intends to appeal to the Board of Trade from such refusal, he shall, within one month from the date of the decision appealed against, leave at the Patent Office (Designs Branch) a notice of such his intention. See Form F (p. 203).

"16. Such notice shall be accompanied by a statement of the grounds of appeal, and of the applicant's case in support thereof.

"17. The applicant shall forthwith on leaving such notice send a copy thereof to the Secretary of the Board of Trade, No. 7 Whitehall Gardens, London.

"18. The Board of Trade may thereupon give such directions (if any) as they may think fit for the purpose of the hearing of the appeal for the Board of Trade.

"19. Seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing of the appeal shall be given to the comptroller and the applicant."

## CHAPTER V

### THE REGISTER

“S. 55 (1) There shall be kept at the Patent Office a book called the *Register of Designs*, wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs, and such other matters as may from time to time be prescribed.

“(2) The register of designs shall be *prima facie* evidence of any matters by this Act directed or authorised to be entered therein.

“S. 49 (1) The comptroller shall grant a certificate of registration to the proprietor of the design when registered. Form G (p. 204).

“(2) The comptroller may, in case of loss of the original certificate, or in any other case in which he deems it expedient, grant a copy or copies of the certificate.” Form H (p. 204).

The following Rules regulate the keeping of the register:—

“20. Upon the sealing of a certificate of registration the comptroller shall cause to be entered in the register of designs the name, address, and description of the registered proprietor, and the date upon which the application for registration was received by the comptroller, which day shall be deemed to be the date of the registration.



“ 21. Where a person becomes entitled to the copyright in a registered design, or to any share or interest therein, by assignment, transmission, or other operation of law, or where a person acquires any right to apply the design either exclusively or otherwise, a request (Form K, p. 206) for the entry of his name in the register as such proprietor of the design, or as having acquired such right, as the case may be (hereinafter called the claimant), shall be addressed to the comptroller, and left at the Patent Office (Designs Branch).

“ 22. Every such request shall, in the case of an individual, be made and signed by the person requiring to be registered as proprietor; and in the case of a firm or partnership, by some one or more members of such firm or partnership, or, in either case, by his or their agent respectively, duly authorised to the satisfaction of the comptroller; and in the case of a body corporate, by their agent authorised in like manner.

“ 23. Every such request shall state the name, address, and description of the claimant, and the particulars of the assignment, transmission, or other operation of law, by virtue of which the request is made, so as to show the manner in which, and the person or persons to whom, the design has been assigned or transmitted, or the person or persons who has or have acquired such right as aforesaid, as the case may be.

“ 24. Every such request shall be accompanied by a statutory declaration to be thereunder written, verifying the several statements therein, and declaring that the particulars above described comprise every material fact and document affecting the proprietorship of the design or the right to apply the same, as the case may be, as claimed by such request.

“ 25. The claimant shall furnish to the comptroller

such other proof of title as he may require for his satisfaction.

“ 26. A body corporate may be registered as proprietor by its corporate name.

“ 27. Four clear days' notice of every application to the Court under s. 90 of the Patents, Designs, and Trade Marks Acts 1883 to 1888, for rectification of the Register of Designs, shall be given to the comptroller.

“ 28. Where an order has been made by the Court, under s. 90 of the said Acts (p. 284), the person in whose favour such order has been made shall forthwith leave at the Patent Office an office copy of such order. The register shall thereupon be rectified, or the purport of such order shall otherwise be duly entered in the register, as the case may be.”

As to the assignment being in writing, see p. 184.

It is extremely important that an assignment should be promptly registered in view of future proceedings to protect the design, which must be taken by the “registered proprietor.”

The want of registration would not leave the design “within the order and disposition” of the assignor, so as to pass to his trustee in bankruptcy—*Colonial Bank v. Whinney* (1885), 11 App. Cas., 426.

As to “Inspection,” etc., see pp. 199, 200.

### EFFECT OF REGISTRATION

By s. 50, sub-ss.

“ (1) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during five years from the date of registration.

“ (2) Before delivery on sale of any articles to which a

registered design has been applied, the proprietor must (if exact representations or specimens were not furnished on the application for registration) furnish to the comptroller the prescribed number of exact representations or specimens of the design; and if he fails to do so, the comptroller may erase his name from the register, and thereupon his copyright in the design shall cease."

By s. 60, "'Copyright' means the exclusive right to apply a design to any article of manufacture or to any such substance as aforesaid in the class or classes in which the design is registered."

By s. 51, "Before delivery on sale of any articles to which a registered design has been applied, the proprietor of the design shall cause each such article to be marked with the prescribed mark, or with the prescribed word or words or figures, denoting that the design is registered; and if he fails to do so, the copyright in the design shall cease, unless the proprietor shows that he took all proper steps to ensure the marking of the article."

Under the last clause, a proprietor was held not to have lost his copyright in a case where he directed his manufacturer to apply the mark prescribed by the comptroller, but by inadvertence the manufacturer applied the mark of an expired design. The result would have been the same if no mark had been applied—*Wittman v. Oppenheim* (1884), 27 Ch. D., 260.

By r. 32, "Before the delivery on sale of any article to which a registered design has been applied, the proprietor of such design shall, if such article is included in any of the classes one to twelve in the third schedule hereto, cause each such article to be marked with the abbreviation 'R<sup>d</sup>' and the number appearing on the certificate of registration, and shall, if such article is included in the classes thirteen or fourteen in the third schedule hereto,

cause each such article to be marked with the abbreviation 'REGD.'".

It is sufficient if the labels or wrappers in which the goods are sold are marked ; but each parcel sold, however small, must be marked—*Blank v. Footman, etc.* (1888), 39 Ch. D., 678.

By s. 54, "If a registered design is used in manufacture in any foreign country, and is not used in this country within six months of its registration in this country, the copyright in the design shall cease."



## CHAPTER VI

### INFRINGEMENT

*Legal Proceedings.*—S. 58, as altered by the Act of 1888, gives to the registered proprietor, in addition to the equitable remedy of an injunction, a right of suing for penalty. The words of s. 58 are as follows:—

“During the existence of copyright in any design—

“(a) It shall not be lawful for any person, without the licence or written consent of the registered proprietor, to apply or cause to be applied such design or any fraudulent or obvious imitation thereof, in the class or classes of goods in which such design is registered, for purposes of sale to any article of manufacture or to any substance artificial or natural or partly artificial and partly natural ; and

“(b) It shall not be lawful for any person to publish or expose for sale any article of manufacture or any substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, knowing that the same has been so applied without the consent of the registered proprietor.

“Any person who acts in contravention of this section shall be liable for every offence to forfeit a sum not exceeding fifty pounds to the registered proprietor of the design, who may recover such sum as a simple contract

debt by action in any court of competent jurisdiction, provided that the total sum forfeited in respect of any one design shall not exceed one hundred pounds."

It will be noticed that these sections leave it open for any one to copy a design, provided the copy is not meant for sale. It may lawfully be made for private use or giving away, and this in spite of the more extensive definition of copyright in s. 60 (*supra*). An injunction would not be granted in such a case, as it would probably be held that the copyright is co-extensive only with the statutory remedy.

In *Sherwood v. Decorative Art Tile Co.* (1887), 4 R. P. C., 207, a design was held a "fraudulent," though not an "obvious," imitation.

The plaintiff in an action under this section must prove that the defendant knew of the registration of the design and afterwards applied such design, or at least intended to apply it—*Smith v. Lewis, Roberts, & Co.* (1888), 5 R. P. C., 611.

S. 59 gives as an alternative to the action for penalties an action for damages, subject to proof that the offender knew "that the proprietor had not given his consent to such application." So that both under s. 58 (*b*) and s. 59 it will be necessary to prove knowledge of infringement on the part of the defendant. Therefore it will generally be advisable to give written notice to the alleged infringer of the proprietor's rights, and take proceedings only upon continuance of the infringement.

A person whose design is registered in respect of one class cannot proceed against one who is infringing in other classes only—*Read & Cresswell's Design* (1889), 42 Ch. D., 260.

See further as to "Injunction," Part II, Chap. X, p. 139.

The evidence of infringement, as in the case of trade marks, is ocular. "The eye must be the judge in such a case as this, and the question must be determined by placing the designs side by side, and asking whether they are the same or whether the one is an obvious imitation of the other" — *Hecla Foundry Co. v. Walker, Hunter, & Co.* (1889), 14 App. Cas., 550; and see under "Novelty," *supra*, p. 181.

The defendant infringer has a right to call upon the proprietor to state the purpose for which the design is registered, whether pattern, shape, or ornament—*Hunter, Walker, & Co. v. Falkirk Iron Co.* (1887), Dec. Ct. Ses., 4th Ser., xiv., p. 1072. The purpose may be proved by evidence.

As to foreign and colonial arrangements, see pp. 297–303.

Copyright in designs is purely territorial, and it is no infringement for a British subject to make a design in this country and apply it to goods in a foreign State where only they are sold—*Potter & Co. v. Braco P., etc., Co.* (1891), 8 R. P. C., 218.

## CHAPTER VII

### MISCELLANEOUS

#### INSPECTION, ETC., OF THE DESIGN

By s. 52 it is enacted that "During the existence of copyright in a design, the design shall not be open to inspection except by the proprietor, or a person authorised in writing by the proprietor, or a person authorised by the comptroller or by the Court, and furnishing such information as may enable the comptroller to identify the design, nor except in the presence of the comptroller, or of an officer acting under him, nor except on payment of the prescribed fee; and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof, provided that where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered.

"(2) When the copyright in a design has ceased, the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee."

The days for inspection are posted up at the Patent Office; the hours are 10 A.M. to 4 P.M. The applicant must produce the number of the design. (R. 33.)

As to "inspection of the register," see p. 284, ss. 88, 89.



## INFORMATION AS TO EXISTENCE OF COPYRIGHT

By s. 53, "On the request of any person producing a particular design, together with its mark of registration, or producing only its mark of registration, or furnishing such information as may enable the comptroller to identify the design, and on payment of the prescribed fee, it shall be the duty of the comptroller to inform such person whether the registration still exists in respect of such design, and if so, in respect of what class or classes of goods, and stating also the date of registration, and the name and address of the registered proprietor."

Form N should be used. See p. 208.

By r. 35, "The comptroller may, on receipt of the prescribed fee, make searches among the designs registered at the Patent Office, and inform any person requesting him so to do whether a particular design produced by such person, and to be applied to goods in any particular class, is or is not identical with or an obvious imitation of any registered design applied to such goods of which the copyright is still existing."

The request must be accompanied by two representations of the design to be searched for.

This information is not evidence in an action, except for showing *bonâ fides*.

## CERTIFICATE

"Where a certificate is required for the purpose of any legal proceeding or other special purpose as to any entry, matter, or thing which the comptroller is authorised by the said Act or these Rules to make or do, the comptroller may, on a request in writing and on payment of the prescribed fee, give such certificate, which shall also specify

on the face of it the purpose for which it has been requested as aforesaid." (R. 34, and see pp. 204, 205 for Forms to be used.)

FEEES

1. On application to register one design to be applied to single articles in each class, except Classes 13 and 14 . . . . .	£0 10 0
2. On application to register one design to be applied to single articles in Classes 13 and 14 . . . . .	0 1 0
3. On application to register one design to be applied to a set of articles for each class of registration. . . . .	1 0 0
4. On notice of appeal to Board of Trade against refusal of comptroller to register . . . . .	1 0 0
5. Copy of certificate of registration, each copy . . . . .	0 1 0
6. On request for certificate of comptroller for legal proceedings or other special purpose . . . . .	0 5 0
7. On request to enter name of subsequent proprietor . . . . .	} Same as registration fee.
8. On notice to comptroller of intended exhibition of an unregistered design . . . . .	
9. Inspection of design in any case in which inspection is permitted by the Patents, Designs, and Trade Marks Acts 1883 to 1888, and the Designs Rules thereunder, for each quarter of an hour . . . . .	0 1 0
10. Copy of one such design . . . . .	} Cost according to agreement.
11. On request to correct clerical error . . . . .	
12. On request for search under s. 53 . . . . .	0 5 0
13. On request to enter new address . . . . .	0 5 0
14. For office copy, every hundred words . . . . .	0 0 4
	(but never less than 1s.)
15. For certifying office copies, MSS. or printed . . . . .	0 1 0

NOTE.—The term "set" to include any number of articles ordinarily on sale together, irrespective of the varieties of size and arrangement in which the particular design may be shown on each separate article.

## FORMS

- E.—Form of Application to register.  
F.— „ Appeal to Board of Trade.  
G.— „ Certificate of registration.  
H.— „ Application for copy of certificate of registration  
I.— „ Request for certificate for use in legal proceedings.  
J.— „ Certificate for use in legal proceedings.  
K.— „ Request to enter name of subsequent proprietor.  
L.— „ Notice of intending exhibition of unregistered  
design.  
M.— „ Request for correction of clerical error or for  
entry of new address.  
N.— „ Request for search under s. 53.  
O.— „ Application to register for a set of articles.

*N.B.*—As to where these Forms can be obtained, see p. 319.

*Patents, Designs, and Trade Marks Acts 1883 to 1888*

E (p. 186)

APPLICATION FOR REGISTRATION OF DESIGN IN CLASSES



You are hereby requested to register the accompanying design in Class \_\_\_\_\_, in the name of (a)

(a) Here insert legibly the name, address, and description of the individual or firm.

of \_\_\_\_\_ who claims to be the proprietor thereof, and to return the same to

Statement of nature of design (b)

(b) Such as whether it is applicable for the pattern or for the shape.

(Signed)

(c)

(c) To be signed by the applicant.

Dated the \_\_\_\_\_ day of \_\_\_\_\_ 189

To the Comptroller,  
Patent Office, Designs Branch,  
25 Southampton Buildings,  
Chancery Lane, London, W.C.

*Patents, Designs, and Trade Marks Acts 1883 to 1888*

F (p. 190)

APPEAL TO BOARD OF TRADE ON REFUSAL OF COMPTROLLER TO REGISTER A DESIGN



(To be accompanied by an unstamped copy)

SIR,

I hereby appeal against your decision upon my application to register and beg to submit my case (a) for the decision of the Board of Trade.

(a) The statement of the case to be written upon foolscap paper (on one side only), with a margin of two inches on the left-hand side thereof.

I am, Sir,  
Your obedient Servant,

To the Comptroller,  
Patent Office, Designs Branch,  
25 Southampton Buildings,  
Chancery Lane, London, W.C.



SEAL OF  
PATENT  
OFFICE.

*Patents, Designs, and Trade Marks Acts 1883 to 1888*

G (p. 190)

CERTIFICATE OF REGISTRATION OF DESIGN

(R<sup>D</sup>. No.           )

Patent Office, Designs Branch,  
25 Southampton Buildings,  
Chancery Lane, London, W.C.

This is to certify that the design of which this is a copy was registered this            day of            188    , in pursuance of the Patents, Designs, and Trade Marks Acts 1883 to 1888, in respect of the application of such Design to articles in Class            , for which a copyright of five years is granted.

DESIGNS.

*Patents, Designs, and Trade Marks Acts 1883 to 1888*

H (p. 190)

APPLICATION FOR COPY OF CERTIFICATE OF  
REGISTRATION OF DESIGN

SIR,

I hereby request you to furnish me with a Copy Certificate of Registration of Design No.            in Class            .

(Signed)

Dated the            day of            189

To the Comptroller,  
Patent Office, Designs Branch,  
25 Southampton Buildings,  
Chancery Lane, London, W.C.

*Patents, Designs, and Trade Marks Acts 1883 to 1888*

I (pp. 200, 290)

REQUEST FOR CERTIFICATE FOR USE IN LEGAL  
PROCEEDINGS

DESIGNS.

SIR,

I hereby request you to send me for the purpose of use in the suit of (a)

(a) Here state the title of the legal proceeding or the other purpose for which the Certificate is required.

a certificate that the design of which a copy is herein enclosed was (b)

(b) Here state the entry, matter or thing which the writer wishes certified.

(Signed)

day of 189 .

To the Comptroller,  
Patent Office, Designs Branch,  
25 Southampton Buildings,  
Chancery Lane, London, W.C.

*Patents, Designs, and Trade Marks Acts 1883 to 1888*

J (pp. 200, 290)

CERTIFICATE FOR USE IN LEGAL PROCEEDINGS

In the matter of

No. .

I, Comptroller-General of Patents,  
Designs, and Trade Marks, hereby certify that

SEAL.

Witness my hand and seal this day of  
189

Comptroller.

Patent Office, Designs Branch,  
25 Southampton Buildings,  
Chancery Lane, London, W.C.

DESIGNS.

*Patents, Designs, and Trade Marks Acts 1883 to 1888*

K (pp. 192 and 284)

REQUEST TO ENTER NAME OF SUBSEQUENT PROPRIETOR  
OF DESIGN, WITH DECLARATION IN SUPPORT THEREOF

(a) or We.  
Here insert  
name, full ad-  
dress, and de-  
scription.

I, (a)

(b) My or our.

hereby request that you will enter (b) name

(c) or Names.

(c) in the register of designs as proprietor  
of the Design No. in Class

(d) I am, or We  
are.

(d)

entitled as to the said design

(e) Here state  
whether design  
transmitted by  
death, marriage,  
bankruptcy, or  
other operation  
of law, and if  
entitled by as-  
signment state  
the particulars  
thereof as, e.g.,  
"by deed dated  
the \_\_\_ day of  
\_\_\_ 188\_\_\_ made  
between So-and-  
so of the one  
part."

(e)

(f) This para-  
graph is not re-  
quired when the  
declaration is  
made out of the  
United King-  
dom.

(f) And I do solemnly and sincerely declare that  
the above several statements are true, and the par-  
ticulars above set out comprise every material fact and  
document affecting the proprietorship of the said design  
as above claimed.

And I make this solemn declaration, conscientiously  
believing the same to be true, and by virtue of the  
provisions of the Statutory Declarations Act, 1835.

(g) To be signed  
here by the per-  
son making the  
declaration.

(g)

Declared at  
this day of 189  
Before me,

(h) Signature  
and title of the  
authority before  
whom the decla-  
ration is made.

(h)

To the Comptroller,  
Patent Office, Designs Branch,  
25 Southampton Buildings,  
Chancery Lane, London, W.C.

*Patents, Designs, and Trade Marks Acts 1883 to 1888*

L (p. 182)

NOTICE OF INTENDED EXHIBITION OF AN UNREGISTERED  
DESIGN

DESIGNS.

(a)

hereby give notice of my intention to exhibit a  
of at the  
Exhibition, which (b)

(a) Here state name and address of applicant.

(b) State "opened" or "is to open."

of 189 , under the provisions of the  
Patents, Designs, and Trade Marks Acts of 1883 to  
1888 (c)

(c) Insert brief description of design, with drawing.

herewith enclose a

(Signed)

Dated the day of 189

To the Comptroller,  
Patent Office, Designs Branch,  
25 Southampton Buildings,  
Chancery Lane, London, W.C.

*Patents, Designs, and Trade Marks Acts 1883 to 1888*

M (p. 287)

REQUEST FOR CORRECTION OF CLERICAL ERROR OR FOR  
ENTRY OF NEW ADDRESS

DESIGNS.

SIR,

I hereby request that

(Signed)

Dated the day of 189

To the Comptroller,  
Patent Office, Designs Branch,  
25 Southampton Buildings,  
Chancery Lane, London, W.C.





PART IV

—0—

*TRADE MARKS*

## CHAPTER I

### INTRODUCTION

UP to the year 1862 the law relating to trade mark was the same as that relating to trade name, viz. a branch of the law of fraud. The plaintiff had a right to obtain an injunction against a man passing off his goods as the plaintiff's, or the plaintiff's goods as his own, whether he did this by adopting the plaintiff's trade name, mark, or by means of any other misrepresentation. He had, further, a right to obtain damages from a defendant who was wilfully fraudulent. Both these rights exist to the present day in respect to trade name and unregistered trade mark. See pp. 307-312.

In the year 1862 was passed the first Merchandise Marks Act (25 and 26 Vict., c. 88), a statute which contained a definition of trade mark, and made the forging of a mark, or falsely applying it with intent to defraud, a misdemeanour. This Act has now been superseded by the Merchandise Marks Act 1887 (*infra*, p. 320).

In 1875 the Trade Marks Registration Act (38 and 39 Vict., c. 91) established a register of marks under the control of the then commissioners of patents, and defined (s. 10) a trade mark as follows:—

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

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

“ A distinctive device, mark, heading, label, or ticket ;

“ And there may be added to any one or more of the said particulars—

“ Any letters, words or figures, or combination of letters, words or figures ; also

“ Any special and distinctive word or words or combination of figures or letters used as a trade mark before ” 13th August 1875 “ may be registered as such under this Act.”

This Act was amended in 1876 and 1877, and was repealed by the Patents Act 1883, particulars of which and of the general law on the subject now follow

## CHAPTER II

### DEFINITION

ONE main difference between trade marks and trade names is that the trader has a right of property in the former if registered, but not in the latter, except where used as trade mark.

Since the Act of 1883 (46 and 47 Vict., c. 57) trade marks have been divided into two classes: 1st, Those which have been registered under the Act; 2nd, Those in use before 13th August 1875, whose registration has been refused. Only in these two cases may proceedings be taken to prevent infringement. (S. 77, p. 251.)

By the same Act (s. 64), as amended by 51 and 52 Vict., c. 50, s. 10, certain trade marks only may be registered. The s. is as follows:—

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

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

“(b) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark; or

“(c) A distinctive device, mark, brand, heading, label, or ticket; or

“(d) An invented word or invented words; or



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

“(2) There may be added to any one or more of the essential particulars mentioned in this section any letters, words or figures, or combination of letters, words or figures, or of any of them, but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

“(3) Provided as follows :

“(i.) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof :

“(ii.) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures used as a trade mark before the 13th day of August 1875, may be registered as a trade mark under this part of this Act.”

By s. 74. (1) “Nothing in this Act shall be construed to prevent the comptroller entering on the register, in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade mark—

“(a) In the case of an application for registration of a trade mark used before the 13th day of August 1875—

“Any distinctive device, mark, brand, heading, label, ticket, letter, word or figure, or combination of letters, words or figures, though the same is common to the trade in the goods with respect to which the application is made ;

“(b) In the case of an application for registration of a trade mark not used before the 13th day of August 1875—

“Any distinctive word or combination of words, though the same is common to the trade in the goods with respect to which the application is made;

“(2) The applicant for entry of any such common particular or particulars must, however, disclaim in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the register;

“(3) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words or figures, which was or were, before the 13th day of August 1875, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods.”

For rules 28-31, restricting registration, see p. 235.

*Notes.*—Registration of a mark for long time in use will sometimes be granted, subject to conditions, *e.g.* that the mark shall only be applied as in the past, etc.; but, as a rule, conditions will not be imposed except where a similar mark is used by another trader for similar goods, and where the facts for the opposition are not strong enough to warrant the comptroller in refusing registration altogether.

No mark, whether old or new, can be registered which is calculated to deceive, or which is combined with deceptive words. So the words “patent,” “registered,” “royal,” etc., have been held deceptive, where not representing a fact, and *infra* (c) and 3 (ii.), s. 73 (p. 241), and r. 29 (p. 235).

The trade mark must be used in connection with the goods, either by being actually impressed on or affixed to the goods or at least printed on the wrappers and labels.

(d) This has taken the place of “fancy word or words, not in common use” of the Act of 1883, a phrase which occasioned great difficulty and many legal conflicts, and which still applies to applications made but not perfected before the Act of 1888—*Apollinaris Co.’s T. M.* (1891), 2 Ch. 186. It seems that many words will be capable of registration as “invented” that were excluded as “fancy” and *vice versa*. For definitions of “fancy” words, see *Van Duzer’s T. M.* (1887), 34 Ch. D., 623.

(c) “Letters” cannot be registered as essential particulars of a trade mark, unless used so as to come within this s.-s. As to “brand,” see *Pirie v. Goodall* (1891), 8 R. P. C., 261.

(c) and (e) Where the word used is descriptive, not merely of the goods of the applicant, but of all goods of the same pattern, it cannot be registered, as it is not distinctive and it does refer to the character of the goods—*Arbenz T. M.* (1887), 35 Ch. D., 248.

As to a geographical name, see *Apollinaris Co.’s T. M.* (1891), 2 Ch., 186.

(c) and 3 (ii.) No mark can be distinctive which by itself or by reason of added words is calculated to deceive; so “Eton,” as a trade mark for cigarettes, was refused registration, as words were added indicative of foreign manufacture, which was untrue—*Wood’s T. M.* (1886), 32 Ch. D., 247. The onus lies on the applicant to show that his mark is *not* calculated to deceive. See Chapter IV, at p. 241. *In re Fuente’s T. M.* (1891), 2 Ch., 166, decided that a trade mark which has been used in combination with fraudulent words may not be registered alone.

Red, white, and blue stripes, or stripes of any colour, are not distinctive. Colour will not be registered—*Hanson’s T. M.* (1887), 37 Ch. D., 112; see s. 67, p. 222.

The mark must be such as to distinguish the goods as those of the applicant—*Apollinaris Co.’s T. M.* (u.s., p. 160).



A firm has been held entitled to register the figure of a black dome, one of the shapes in which they sold their black-lead, the evidence showing that the black-lead of the plaintiffs, of whatever shape, was known in the trade as "dome black-lead," and from that the Court inferred that the mark was distinctive. The mark was always stamped on the goods in whatever shape sold—*James' T. M.* (1886), 33 Ch. D., 392. The words "Parchment Bank," as applied to notepaper, are descriptive—*Pirie v. Goodall* (1891), 8 R. P. C., 261. A label with the name of the firm and the article manufactured is not distinctive—*Price's, etc., Co.* (1884), 27 Ch. D., 681; nor when combined with the obverse and reverse of a medal—*Bryant & May's T. M.* (1891), 8 R. P. C., 69.

The question whether a new mark is calculated to deceive from its similarity to a mark already on the register will be decided by comparison of the new mark with the old mark, as registered and not as used, when, as in some cases, a difference exists; but the newer mark may be looked at *as used*, even if *as registered* it is not calculated to deceive. Other evidence besides ocular comparison is, of course, admissible.

A mark used for wines, being the same as that for spirits sold by another firm is calculated to deceive; so is "demotic" stamped on racquets, the plaintiff's mark being a demon's face and the words "The Demon" for the same goods; so is "Monobrut" as applied to champagne, the plaintiff's trade mark (registered abroad only) being "Monopole;" so is a buffalo, an existing mark for the same class of goods being a bull's head; so a winged cross within concentric circles is too like a lighthouse on a rock within concentric circles—*Baker v. Rawson* (1890), 45 Ch. D., 519.

3 (ii.) The device or words must have been used alone,

not in combination—*Meeus' Appn.* (1891), 1 Ch., 41 ; *Perry, Davis, & Son v. Harbord* (1890), 15 App. Cas., 316.

Even where the mark has been used in combination with the name of the firm only, *e.g.* on labels, it cannot be registered. The latest case is *Richards v. Butcher* (1891), 2 Ch., 522. But the label may be registered as a whole ; see next page. After registration the mark may be used in combination—*Melachrino & Co. v. Melachrino Cigarette Co.* (1887), 4 R. P. C., 215 ; and see under s. 77, p. 251.

Words used as an old mark must be “special and distinctive” ; and, if so, do not fail because they are also descriptive. They must be words which suggest that the article to which it is applied is manufactured or sold by a particular firm. See *Bodega Co. v. Owens* (1889), 6 R. P. C., 236 ; so that the name of an article cannot be registered alone, even where the name was originally coined for application to the article, for it is descriptive only and not “special and distinctive.”

“Pain Killer” has been held merely descriptive of the quality of a patent medicine, and not “special and distinctive”—*Perry, Davis, & Son v. Harbord* (*supra*). So “Granolithic” in *Stuart & Co. v. Scottish Val de Travers Co.* (1885), Dec. Ct. Ses., 4th Ser., xiii., p. 1. Nor can names be registered, which from being distinctive have by use become descriptive of the articles, no longer being used to indicate a particular maker or seller, *e.g.* “Harvey’s Sauce.” And a word which has remained on the register five years unchallenged will be expunged if used not as a trade mark, but to specify a pattern or design. So where a manufacturer used the word “Albion” to denote not his manufacture, but a particular design of machine, the name was expunged—*Harrison’s T. M.* (1889), 42 Ch. D., 691. The design should have been registered and not the name. See “Design,” chap. ii. p. 182.



“Emollio,” meaning “I soften,” is a descriptive word, when applied to substances which soften. “Washerine,” as applied to a washing preparation, is descriptive. So is “Electroid,” when denoting the presence of electric action. “Satinine,” as applied to a washing preparation, is descriptive of the effect, etc.

*Disclaimer*—even in the case of an “old” mark—must be made in the application. It is too late to disclaim in Court. And the disclaimer must be of something common to the trade. So that a mark which cannot be registered in consequence of having been used in combination with a firm name, cannot be made fit for registration by disclaimer of the firm name. See *Goodall's T. M.* (1889), 42 Ch. D., 566, and *Meeus' Appn.* (1891), 1 Ch., 41. Where it is sought to register a label containing “common” words, as a whole, and not as containing a trade mark and something else, it is not necessary to disclaim—*Apollinaris Co.'s T. M.* (1891), 2 Ch., 186; *Pinto v. Badman*, 8 R. P. C., 191.

“Common” to the trade means “open” to the trade—*Burland's T. M.* (1889), 6 R. P. C., 482.

As to what is “user” within s. 74—see *Jackson v. Napper* (1886), 4 R. P. C., 45. Exposure for sale of goods, essentially the same, though passing by a different name, is sufficient.

## SEARCHES

See s. 88. A person desiring to adopt a trade mark should make a search at the Trade Mark Branch of the Patent Office in order to discover if the mark is already registered, or whether, from its similarity to a registered mark, it would be calculated to deceive. The fee is one shilling for each quarter of an hour. The comptroller only undertakes to make searches in connection with applications for registration.

## CHAPTER III

### APPLICATION

THE mode of application is regulated by s. 62 of the Act of 1883, as amended by the Act of 1888. The s. is as follows:—

“(1) The comptroller may, on application by or on behalf of any person claiming to be the proprietor of a trade mark, register the trade mark.

“(2) The application must be made in the form (Form F, p. 265) set forth in the first schedule to this Act, or in such other form as may be from time to time prescribed, and must be left at, or sent by post to, such place and in such manner as may be prescribed (p. 222).

“(3) The application must be accompanied by the prescribed number of representations of the trade mark, and must state the particular goods or classes of goods in connection with which the applicant desires the trade mark to be registered (p. 225).

“(4) The comptroller may, if he thinks fit, refuse to register a trade mark, but any such refusal shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted (p. 231).

“(5) The Board of Trade may, however, if it appears

expedient, refer the appeal to the Court; and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid. Form T, p. 275.

“(6) Where an applicant for the registration of a trade mark, otherwise than under an international convention, is out of the United Kingdom at the time of making the application, he shall give the comptroller an address for service in the United Kingdom; and if he fails to do so, the application shall not be proceeded with until the address has been given.” See pp. 297–303.

It seems that importation by a foreigner, for the purpose of transshipment, gives him no title to register a trade mark here—*Meeus' Appn.* (1891), 1 Ch., 41; *Jackson v. Napper* (1887), 35 Ch. D., 162. And see “Disclaimer,” p. 219.

By s. 63, “Where registration of a trade mark has not been or shall not be completed within twelve months from the date of the application, by reason of default on the part of the applicant, the comptroller shall give notice of the non-completion to the agent employed on behalf of the applicant; and if, at the expiration of fourteen days from that notice, the registration is not completed, shall give the like notice to the applicant; and if, at the expiration of the latter fourteen days, or such further time as the comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned.”

But in special cases, where the applicant is not guilty of laches or conduct disentitling him, he may, after abandonment, make a fresh application for registration—*Jackson v. Napper* (1886), 35 Ch. D., 162.

By s. 65, “A trade mark must be registered for particular goods or classes of goods.

“66. When a person claiming to be the proprietor of

several trade marks which, while resembling each other in the material particulars thereof, yet differ in respect of (a) the statement of the goods for which they are respectively used or proposed to be used, or (b) statements of numbers, or (c) statements of price, or (d) statements of quality, or (e) statements of names of places, seeks to register such trade marks, they may be registered as a series in one registration. A series of trade marks shall be assignable and transmissible only as a whole; but for all other purposes each of the trade marks composing a series shall be deemed and treated as registered separately.

“67. A trade mark may be registered in any colour or colours, and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour or colours.” See pp. 216 and 235.

A mark applies only to goods, not *e.g.* to a place of business where the goods are sold—*Bogeda Co. v. Owens* (1889), 6 R. P. C., 236. A mark should only be registered for the particular goods in the class for which it is used—*Harrison's T. M.* (1890), 7 R. P. C., 25; and not for the whole class, unless actually used for the whole. Where registered for the whole, but used for particular goods only, it will be treated as confined to the latter—*Hargreaves v. Freeman* (1891), 8 R. P. C., 237.

The following Rules have been made regulating the procedure:—

“7. An application for registration of a trade mark, if made by any firm or partnership, may be signed by some one or more members of such firm or partnership, as the case may be.<sup>1</sup>

<sup>1</sup> After the signature of a member of a firm should be the words, “A member of the firm”; in the case of a company, “for the company” should be added.



“ If the application be made by a body corporate, it may be signed by the secretary or other principal officer of such body corporate.

“ 8. Where a trade mark, for registration of which application is made, is in Classes 23, 24, or 25 of the third schedule to these Rules, the applicant shall address and send his application to the Manchester Trade Marks Branch, 48 Royal Exchange, Manchester. Other applications (except applications which, under s. 81 of the said Acts, should be made to the Cutlers' Company) shall be addressed and sent to the Patent Office, Trade Marks Branch, 25 Southampton Buildings, Chancery Lane, London, W.C.

“ 9. An application for registration, and all other communications between the applicant and the comptroller, may be made by or through an agent duly authorised to the satisfaction of the comptroller.<sup>1</sup>

“ 10. On receipt of the application, the comptroller shall furnish the applicant with an acknowledgment thereof.

“ 11. Where application is made to register a trade mark which was used by the applicant or his predecessors in business before the 13th of August 1875, the application shall contain a statement of the time during which and of the person by whom it has been so used in respect of the goods mentioned in the application.

“ 12. Subject to any other directions that may be given by the comptroller, all applications, notices, counter-statements, representations of marks, papers having representations affixed, or other documents required by the said Acts or by these Rules to be left with or sent to the comptroller or to the Cutlers' Company, shall be upon foolscap paper of a size of 13 inches by 8 inches, and shall have on the left-hand part thereof a margin of not less than one inch and a half.

<sup>1</sup> After an agent's signature, " Agent " should appear.



“ 13. Subject to any other directions that may be given by the comptroller, three representations of each trade mark, except in the case of marks applied for in Classes 23 to 35 inclusive, must be supplied upon paper of the size aforesaid, and must be of a durable nature. One of such representations must be made upon or affixed to the form of application, the others upon separate half-sheets. In the case of trade marks exceeding the limits of the foolscap paper of the size aforesaid, such marks may be pasted and folded upon the sheets of foolscap. Form G, p. 267.

“ In the case of marks applied for in Classes 23 to 35 inclusive, the applicant shall supply four representations of each mark for each class.

“ Where a drawing or other representation or specimen cannot be given in manner aforesaid, a specimen or copy of the trade mark may be sent either of full size or on a reduced scale, and in such form as the comptroller may think most convenient.

“ The comptroller may, if dissatisfied with the representation of a trade mark, require a fresh representation, either before he proceeds with the application or before he registers the trade mark.

“ The comptroller may also, in exceptional cases, deposit in the Patent Office a specimen or copy of any trade mark which cannot conveniently be shown by a representation, and may refer thereto in the register in such manner as he may think fit.

“ 14. When an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in s. 66 of the said Acts, a representation of each trade mark of the series shall be made or affixed upon the form of application, and also upon each of the separate half-sheets of paper aforesaid.

“ 15. Wherever a mark consists of or includes words

printed in other than Roman character, there shall be given at the foot or on the back of each representation a translation of such words, signed by the applicant or his agent.

“16. Any application, statement, notice, or other document authorised or required to be left, made or given at the Patent Office, or to the comptroller, or to any other person under these Rules, may be sent by a prepaid letter through the post ; and if so sent shall be deemed to have been left, made or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

“In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.”

## CLASSIFICATION OF GOODS

(*Rules 1890. Schedule 3*)

---

(A guide to this classification can be obtained at the Patent Office, Trade Marks Branch, Cursitor Street, E.C.

If any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the comptroller (r. 6, and p. 289).

*General Note.*—Any wares made of mixed materials (for example, of both cotton and silk) shall be included in such one of the classes appropriated to those materials as the comptroller may desire.

Goods are mentioned by way of illustration, and not as an exhaustive list of the contents of a class.

---

### CLASS 1.

Chemical substances used in manufactures, photography, or philosophical research, and anti-corrosives—Such as acids (including vegetable acids), alkalies, artists' colours, pigments, mineral dyes.

### CLASS 2.

Chemical substances used for agricultural, horticultural, veterinary and sanitary purposes—Such as artificial manure, cattle medicines, deodorisers, vermin destroyers.

## CLASS 3.

Chemical substances prepared for use in medicine and pharmacy—Such as cod-liver oil, medicated articles, patent medicines, plasters, rhubarb.

## CLASS 4.

Raw or partly prepared vegetable, animal and mineral substances used in manufactures, not included in other classes—Such as resins, oils used in manufactures and not included in other classes, dyes (other than mineral), tanning substances, fibrous substances (*e.g.* cotton, hemp, flax, jute), wool, silk, bristles, hair, feathers, cork, seeds, coal, coke, bone, sponge.

## CLASS 5.

Unwrought and partly wrought metals used in manufacture—Such as iron and steel, pig or cast; Iron—rough; bar and rail, including rails for railways; bolt and rod; sheet, and boiler and armour plates; hoop. Lead—pig, rolled and sheet; wire; copper; zinc; and gold in ingots.

## CLASS 6.

Machinery of all kinds, and parts of machinery, except agricultural and horticultural machines included in Class 7—Such as steam engines, boilers, pneumatic machines, hydraulic machines, locomotives, sewing machines, weighing machines, machine tools, mining machinery, fire engines.

## CLASS 7.

Agricultural and horticultural machinery, and parts of such machinery—Such as ploughs, drilling machines, reaping machines, thrashing machines, churns, cider presses, chaff cutters.

## CLASS 8.

Philosophical instruments, scientific instruments, and apparatus for useful purposes. Instruments and apparatus for teaching—Such as mathematical instruments, gauges, logs, spectacles, educational appliances.

## CLASS 9.

Musical instruments.

## CLASS 10.

Horological instruments.

## CLASS 11.

Instruments, apparatus and contrivances, not medicated, for surgical or curative purposes, or in relation to the health of men or animals—Such as bandages, friction gloves, lancets, fleams, enemas.

## CLASS 12.

Cutlery and edge tools—Such as knives, forks, scissors, shears, files, saws.

## CLASS 13.

Metal goods not included in other classes—Such as anvils, keys, basins (metal), needles, hoes, shovels, corkscrews.

## CLASS 14.

Goods of precious metals (including aluminium, nickel, Britannia metal, etc.) and jewellery, and imitations of such goods and jewellery—Such as plate, clock cases and pencil cases of such metals, Sheffield and other plated goods, gilt and ormolu work.

## CLASS 15.

Glass—Such as window and plate glass, painted glass, glass mosaic, glass beads.

## CLASS 16.

Porcelain and earthenware—Such as china, stoneware, terracotta, statuary porcelain, tiles, bricks.

## CLASS 17.

Manufactures from mineral and other substances for building or decoration—Such as cement, plaster, imitation marble, asphalt.

## CLASS 18.

Engineering, architectural and building contrivances—Such as diving apparatus, warming apparatus, ventilating apparatus, filtering apparatus, lighting contrivances, drainage contrivances, electric and pneumatic bells.

## CLASS 19.

Arms, ammunition and stores, not included in Class 20—Such as cannon, small-arms, fowling-pieces, swords, shot and other projectiles, camp equipage, equipments.

## CLASS 20.

Explosive substances—Such as gunpowder, gun-cotton, dynamite, fog signals, percussion caps, fireworks, cartridges.



## CLASS 21.

Naval architectural contrivances and naval equipments not included in Classes 19 and 20—Such as boats, anchors, chain cables, rigging.

## CLASS 22.

Carriages—Such as railway carriages, waggon, railway trucks, bicycles, bath chairs.

## CLASS 23.

- (a) Cotton yarn and sewing cotton not on spools or reels.
- (b) Sewing cotton on spools or reels.

## CLASS 24.

Cotton piece goods of all kinds—Such as cotton shirtings, long cloth.

## CLASS 25.

Cotton goods not included in Classes 23, 24, or 38—Such as cotton lace, cotton braids, cotton tapes.

## CLASS 26.

Linen and hemp yarn and thread.

## CLASS 27.

Linen and hemp piece goods.

## CLASS 28.

Linen and hemp goods not included in Classes 26, 27, and 50.

## CLASS 29.

Jute yarns and tissues, and other articles made of jute not included in Class 50.

## CLASS 30.

Silk—spun, thrown or sewing.

## CLASS 31.

Silk piece goods.

## CLASS 32.

Other silk goods not included in Classes 30 and 31.



**CLASS 33.**

Yarns of wool, worsted, or hair.

**CLASS 34.**

Cloths and stuffs of wool, worsted, or hair.

**CLASS 35.**

Woollen and worsted and hair goods not included in Classes 33 and 34.

**CLASS 36.**

Carpets, floor-cloth, and oil-cloth—Such as drugget, mats and matting, rugs.

**CLASS 37.**

Leather, skins unwrought and wrought, and articles made of leather not included in other classes—Such as saddlery, harness, whips, portmanteaus, furs.

**CLASS 38.**

Articles of clothing—Such as hats of all kinds, caps and bonnets, hosiery, gloves, boots and shoes, other ready-made clothing.

**CLASS 39.**

Paper (except paper-hangings), stationery and book-binding—Such as envelopes, sealing wax, pens (except gold pens), ink, playing cards, blotting cases, copying presses.

**CLASS 40.**

Goods manufactured from india-rubber and gutta-percha not included in other classes.

**CLASS 41.**

Furniture and upholstery—Such as paper-hangings, papier-mâché, mirrors, mattresses.

**CLASS 42.**

Substances used as food, or as ingredients in food—Such as cereals, pulses, olive oil, hops, malt, dried fruits, tea, sago, salt, sugar, preserved meats, confectionery, oil cakes, pickles, vinegar, beer clarifiers.

**CLASS 43.**

Fermented liquors and spirits—Such as beer, cider, wine, whisky, liqueurs.

## CLASS 44.

Mineral and aerated waters, natural and artificial, including gingerbeer.

## CLASS 45.

Tobacco, whether manufactured or unmanufactured.

## CLASS 46.

Seeds for agricultural and horticultural purposes.

## CLASS 47.

Candles, common soap, detergents; illuminating, heating, or lubricating oils; matches and starch, blue and other preparations for laundry purposes—Such as washing powders, benzine collas.

## CLASS 48.

Perfumery (including toilet articles, preparations for the teeth and hair, and perfumed soap).

## CLASS 49.

Games of all kinds, and sporting articles not included in other classes—Such as billiard tables, roller skates, fishing nets and lines, toys.

## CLASS 50.

Miscellaneous (such as coopers' wares), including—

- (1) Goods manufactured from ivory, bone, or wood, not included in other classes.
- (2) Goods manufactured from straw or grass, not included in other classes.
- (3) Goods manufactured from animal and vegetable substances, not included in other classes.
- (4) Tobacco pipes.
- (5) Umbrellas, walking-sticks, brushes, and combs.
- (6) Furniture cream, plate powder.
- (7) Tarpaulins, tents, rick-cloths, rope, twine.
- (8) Buttons of all kinds, other than of precious metal or imitations thereof.
- (9) Packing and hose of all kinds.
- (10) Goods not included in the foregoing classes.

The following Rules regulate procedure on—

### APPEAL TO THE BOARD OF TRADE

“20. When any person intends to appeal to the Board of Trade from a decision of the comptroller in any case in which an appeal is given by the said Acts, he shall, within one month from the date of the decision appealed against, leave at the Patent Office (Trade Marks Branch), a notice of such his intention. Form H, p. 268.

“21. Such notice shall be accompanied by a statement in writing of the grounds of appeal, and of the appellant's case in support thereof.

“22. A copy of the notice of intention to appeal, accompanied by a statement of the case, shall also be forthwith sent to the Secretary of the Board of Trade, No. 7 Whitehall Gardens, London; and where there has been an opposition before the comptroller, to the opponent or applicant as the case may be.

“23. The Board of Trade may thereupon give such directions (if any) as they may think fit with respect to evidence, or otherwise, for the purpose of the hearing of the appeal by the Board of Trade, or for the purpose of their referring the appeal to the Court to hear and determine the same.

“24. Where the Board of Trade intend to hear the appeal, seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing, shall be given to the comptroller and to the appellant, and where there has been an opposition before the comptroller to the opponent or applicant as the case may be.

“25. No appeal shall be entertained of which notice has not been given within one month from the date of the

decision appealed against, or such further time as the comptroller may allow, except by special leave of the Board of Trade.

“26. Subject to the directions and leave of the Board of Trade, the evidence to be used on an appeal to the Board of Trade in the matter of an opposition shall be the same as that used at the hearing before the comptroller.”

#### ADVERTISEMENT OF APPLICATION

By s. 68, “Every application for registration of a trade mark under this part of this Act shall, as soon as may be after its receipt, be advertised by the comptroller, unless the comptroller refuse to entertain the application.”

The following Rules apply:—

“27. Every application shall be advertised by the comptroller in the official paper, during such times and in such manner as the comptroller may direct, unless he refuse to entertain the application.

“If no representation of the trade mark be inserted in the official paper, in connection with the advertisement of an application, the comptroller shall refer in such advertisement to the place or places where a specimen or representation of the trademark is deposited for exhibition.

“28. The official paper for the purposes of these Rules shall be some paper published under the direction of the Board of Trade, or such other paper as such Board may from time to time direct.<sup>1</sup>

#### <sup>1</sup> “SALE OF OFFICIAL PUBLICATIONS

“The Patents, Designs, and Trade Marks Acts 1883–1888, and the Trade Marks Rules 1890, should be carefully studied. Copies of the Acts and of the Rules can be purchased at the Sale Branch of the Patent Office, 38 Cursitor Street, Chancery Lane, London, E.C. The price of the Acts and Rules together is 2s. 6d., postage 2d.; of the Acts alone 2s., postage 1½d.; and of the Rules alone 6d., postage 1d.



“29. For the purposes of such advertisement the applicant may be required to furnish a wood-block or electrotype (or more than one, if necessary) of the trade mark, of such dimensions as may from time to time be directed by the comptroller, or with such other information or means of advertising the trade mark as may be required by the comptroller; and the comptroller, if dissatisfied with the block or electrotype furnished by the applicant or his agent, may require a fresh block or electrotype before proceeding with the advertisement.

“30. When an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in s. 66 of the said Acts, the applicant may be required to furnish a wood-block or electrotype (or more than one, if necessary) of any or of each of the trade marks constituting the series; and the comptroller may, if he thinks fit, insert with the advertisement of the application a statement of the manner in respect of which the several trade marks differ from one another.”

It appears from the instructions issued by the Patent Office that:—

“20. A trade mark cannot in any case be entered upon the register until one month after its advertisement in the official paper.

“21. A wood-block or electrotype must be furnished for each mark in each class claimed, except in the case of Class 23A (cotton yarn and sewing cotton, not on spools or  
Sums exceeding 1s. should be remitted by postal order or post-office order.

“Copies of the *Trade Marks Journal* may also be obtained from the Sale Branch of the Patent Office, 38 Cursitor Street, Chancery Lane, London, E.C.

“The price of the *Trade Marks Journal* is:—

Nos. 1 to 509 (years 1876 to 1887)	. . .	1s. per number.
Nos. 510 to 561 (year 1888)	. . .	1s. 6d. „
No. 562 and following Nos. from 1st January 1889,		6d. „



reels), and Classes 24 and 25, for which no blocks or electrotypes are required.

“A wood-block or electrotype will be required for an application in Class 23 whenever it is in respect of, or covers, sewing cotton on spools or reels.

“No block or electrotype should be forwarded until a formal demand for it is sent by the comptroller.

“22. In the case of a series of trade marks differing only in respect of the particulars mentioned in s. 66 of the Acts, a wood-block or electrotype must be furnished for each mark in the series, for each class claimed.

“23. The wood-blocks or electrotypes furnished must correspond *exactly* with the representations, must afford *perfectly distinct* impressions of the marks, and must be upon a scale sufficiently large to reproduce the marks faithfully. Worn or mutilated blocks or electrotypes cannot be accepted.

“24. The largest space available for the insertion of any single block or electrotype is five and a half inches broad by seven and a half inches deep.

“When a block or electrotype *exceeds two inches in depth or breadth*, a charge for additional space is made, at the rate of two shillings for every inch or part of an inch in depth or breadth beyond the two inches.

“25. The number given by the comptroller should *not* be cut on the face of the block or electrotype, but should be *marked upon the side* in such a manner as to secure its identification.

“26. All blocks or electrotypes should be sent to the Patent Office (Trade Marks Branch), together with the paper marked ‘Form 2,’ and with the representation of the mark sent for the guidance of the applicant in preparing the block or electrotype.

“27. The blocks or electrotypes supplied for the

advertisement of trade marks cannot in any case be returned to applicants.

*“Restrictions on Registration*

“28. Ornamental or coloured groundwork, such as tartans or checks, cannot be claimed as part of a mark unless such groundwork be included within the mark by some border or lines.

“29. The words ‘Registered,’ ‘Registered Design,’ ‘Copyright,’ ‘Entered at Stationers’ Hall,’ ‘To counterfeit this is forgery,’ will not be registered under the Acts, and should not, therefore, appear upon the representations of trade marks forming part of an application. See p. 215.

“30. The following will not be registered as trade marks, or as prominent parts of trade marks, unless the marks have been used before 1st August 1875:—The Royal Arms, or arms so nearly resembling them as to be calculated to deceive; representations of Her Majesty the Queen, or of any member of the Royal Family; representations of the Royal Crown; the national arms or flags of Great Britain.

“31. When there appears on the face of a trade mark an indication of the goods to which the mark is applied, the claim for its registration must be in respect of *those goods only.*”

User for part only of a class does not support a claim for entire class, although the registration extends to the whole. It should be confined to the articles with which the mark is used—*Hargreaves v. Freeman* (1891), 8 R. P. C. 237.

As to procedure subsequent to the advertisement of the application, see *infra*, p. 242.

## CHAPTER IV

### OPPOSITION

[See "Rectification," p. 285.]

By s. 69, as amended, sub-ss.

"(1) Any person may, within one month or such further time, not exceeding three months, as the comptroller may allow of the advertisement of the application, give notice in duplicate at the Patent Office of opposition to registration of the trade mark, and the comptroller shall send one copy of such notice to the applicant.

"(2) Within one month after receipt of such notice, or such further time as the comptroller may allow, the applicant may send to the comptroller a counter-statement in duplicate of the grounds on which he relies for his application, and if he does not do so shall be deemed to have abandoned his application.

"(3) If the applicant sends such counter-statement, the comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall, after hearing the applicant and the opponent, if so required, decide whether the trade mark is to be registered, but his decision shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the opponent and the comptroller, and may make an order determining whether, and subject to what conditions (if any), registration is to be permitted (p. 231).

“(4) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court, and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid.

“(5) If the applicant abandons his application, after notice of opposition in pursuance of this section, he shall be liable to pay to the opponent such costs in respect of the opposition as the comptroller may determine to be reasonable.

“(6) Where the opponent is out of the United Kingdom, he shall give the comptroller an address for service in the United Kingdom.”

The following Rules apply :—

“31 (1) A notice of opposition to the registration of a trade mark shall state the ground or grounds on which the opponent intends to oppose the registration, and be signed by him or by his solicitor, and shall also contain an address for service in the United Kingdom, and shall be in the Form J in the second schedule to these Rules, with such variations as circumstances may require (p. 269).

“(2) Where the ground, or one of the grounds, of opposition is that the applicant is applying for the registration of a trade mark identical with one already on the register with respect to the same goods or description of goods, or having such resemblance to a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive, the notice shall state the date of registration, and the number on the register of such trade mark already on the register.

“(3) Within two months after the expiration of one month, or such further time, not exceeding three months, as the comptroller may allow from the date of the advertisement of the application, the opponent shall leave at the Patent Office (Trade Marks Branch), such evidence



by way of statutory declaration as he may desire to adduce in support of his opposition, and deliver to the applicant copies thereof.

“(4) Within one month from the delivery of the opponent’s copies of his statutory declarations, the applicant shall leave at the Patent Office (Trade Marks Branch) his evidence by way of statutory declaration in answer, and deliver to the opponent copies thereof; and, within seven days from such delivery, the opponent shall leave at the Patent Office (Trade Marks Branch) his evidence by way of statutory declaration in reply, and deliver to the applicant copies thereof. Such last-mentioned evidence shall be confined to matters strictly in reply.

“(5) No further evidence shall be left on either side, except by leave of the comptroller upon the written consent of the parties duly notified to him, or by special leave of the comptroller given on an application made to him.

“(6) Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application.

“(7) On the completion of the evidence the comptroller shall, upon application by either party, upon Form E (p. 265) in the second schedule to these Rules and upon payment of the prescribed fee, appoint a time for the hearing of the case, and shall give the parties at least seven days’ notice of such appointment.

“(8) On the hearing of the case, no opposition shall be allowed in respect of any ground not stated in the notice of opposition, and where the ground or one of the grounds of opposition is that registration is being applied for in respect of a trade mark identical with one already on the register with respect to the same goods or description of goods, or having such resemblance to a trade mark already



on the register with respect to such goods or description of goods as to be calculated to deceive, the opposition shall not be allowed upon such ground, unless the date of registration and the number on the register of the said trade mark already on the register have been duly specified in the notice of opposition.

“(9) The decision of the comptroller in the case shall be notified to the parties.”

The counter-statement must be delivered by the applicant within one month from the receipt of the opponent's notice of opposition, and may be in the following Form:—

*“Patents, Designs, and Trade Marks Acts 1883 to 1888*

“TRADE MARKS

“In the Matter of an Application No. . . .  
and of the Opposition thereto No. . . .

“In reply to the Notice of Opposition in this matter by  
of . . . , I give notice by way of  
Counter-statement that I rely for my Application on the  
following grounds:—

“(To be dated and signed by the Applicant or his Solicitor)

“To the Comptroller,  
Patent Office, Trade Marks Branch,  
25 Southampton Buildings, London.”

By s. 71, “Where each of several persons claims to be registered as proprietor of the same trade mark, the comptroller may refuse to register any of them until their rights have been determined according to law, and the comptroller may himself submit or require the claimants to submit their rights to the Court.”

There are two cases in which it is not uncommon that there should be conflicting claims under s. 71:—1st, Where more than one person succeed to the goodwill of a business, and 2nd, Where there is a dissolution of partnership.

In the absence of special terms, in the documents or agreements forming the base of the claims, both claimants would be entitled to be registered in respect of the same trade mark.

Where a trader innocently uses the mark of another and has it registered, and in using it has done a large business, his mark will not be removed, at any rate at the suit of a rival who has for a long time ceased to use the mark, although he may not have abandoned it. See s. 72—*Mouson v. Boehm* (1884), 26 Ch. D., 398. In this case both marks were retained on the register. Where two persons have *bonâ fide* used the same trade mark before 13th August 1875, both will be registered—*Re Powell* (1878), Johnson's Trade Marks, 237.

A trader who had used a mark before 13th August 1875, by which time it had become well known in the trade, was allowed to register it, although a similar mark was registered in 1877 in connection with similar goods—*White Rose T. M.* (1885), 30 Ch. D., 505.

The application to the Court should be by special case, if it is a simple point of law, but there is jurisdiction to hear the case, on motion, if facts are in dispute.

The opposition may be based on any of the grounds mentioned in ss. 71, 72, 73, or on the ground of the existence of a previous and similar mark, or on the ground of fraud. The Court may entertain other objections besides those stated in the notice—*Sanitas Co.'s T. M.* (1887), 4 R. P. C., 533; *Arbenz' Appln.* (1887), 35 Ch. D., 248.

The Court has no jurisdiction to give to a successful opponent the costs of proceedings before the comptroller—*Australian Wine, etc.* (1889), 41 Ch. D., 278.

The comptroller has an absolute discretion to refuse registration, and has also power to amend a notice of opposition—*Moët's T. M.* (1890), 7 R. P. C., 226.

By s. 72, sub-ss.

“(1) Except where the Court has decided that two or more persons are entitled to be registered as proprietors of the same trade mark, the comptroller shall not register in respect of the same goods or description of goods a trade mark identical with one already on the register, with respect to such goods or description of goods.

“(2) Except as aforesaid, the comptroller shall not register with respect to the same goods or description of goods a trade mark having such resemblance to a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive.”

This s. is for the protection of traders.

“73. It shall not be lawful to register as part of or in combination with a trade mark any words the exclusive use of which would, by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a court of justice, or any scandalous design.”

And see s. 86, p. 283.

This s. is for the protection of the public.

The comptroller has jurisdiction to refuse to register until the opinion of the Court has been obtained—*Price's Patent Candle Co.* (1884), 27 Ch. D., 681.

*Calculated to deceive* (see Chap. II, at p. 217, and Chap. VI, at p. 253).—Even where the goods differ, as wines from spirits, registration may be refused—as, though the goods may not be of “the same description,” they are



similar, and the mark may be calculated to induce the public to believe that both sorts of goods are sold by the same person. *In re The Australian Wine Importers, Limited* (1889), 41 Ch. D., 278—a decision based on analogy, but not strictly within the wording of s. 72, sub-s. 2, or s. 73, and the principle of which was carried further by *Eno v. Dunn* (1890), 15 App. Cas., 252, where Eno, who had for many years used as his trade mark the words “Fruit Salt,” which were descriptive of a powder used for making an effervescing drink, succeeded in preventing Dunn from registering the same words as additional matter and as applied to baking-powder, Lord Herschell saying, “I think it is enough to say that I am not satisfied that there would be no reasonable danger of the public being so deceived.” It was considered also that the public might believe that the baking-powder had among its ingredients some proportion of the drink-powder. Dunn might well have used “Fruit Salt,” words in which there is no property, if he had so used them as to exclude the suggestion of any connection with Eno’s Fruit Salt.

As to registering common marks, etc., as additions to trade marks and as to “old marks,” see s. 74, p. 214.

#### PROCEDURE FOR REGISTRATION

The following Rules regulate the procedure subsequent to the advertisement of the application:—

“32. As soon as may be after the expiration of one month from the date of the advertisement of the application, the comptroller shall, subject to opposition to the application and the determination thereof, if he is satisfied that the applicant is entitled to registration, and on payment of the prescribed fee (Form I, p. 268), enter the name, address, and description of the applicant in the



Register of Trade Marks as the registered proprietor of the trade mark in respect of the particular goods or classes of goods described in his application.

“33. In case of the death of any applicant for a trade mark after the date of his application, and before the trade mark applied for has been entered on the register, the comptroller, after the expiration of the prescribed period of advertisement, may, on being satisfied of the applicant's death, enter on the register, in place of the name of such deceased applicant, the name, address, and description of the person owning the goodwill of the business, if such ownership be proved to the satisfaction of the comptroller.

“34. Upon registering any trade mark the comptroller shall enter in the register the date on which the application for registration was received by the comptroller, and such other particulars as he may think necessary.

“35. The comptroller shall send notice to the applicant of the registration of his trade mark, together with a reference to the advertisement of such trade mark in the official paper.

“36. Where a person becomes entitled to a registered trade mark by assignment, transmission, or other operation of law, a request for the entry of his name in the register, as proprietor of the trade mark, shall be addressed to the comptroller, and left at the Patent Office (Trade Marks Branch).<sup>1</sup>

“37. Such request shall, in the case of an individual, be made and signed by the person requiring to be registered as proprietor, and in the case of a firm or partnership by some one or more members of such firm or partnership, or in either case by his or their agent respectively duly authorised to the satisfaction of the comptroller, and in

<sup>1</sup> Form K, p. 270.

the case of a body corporate by their agent, authorised in like manner.

“38. Every such request shall state the name, address, and description of the person claiming to be entitled to the trade mark (hereinafter called the claimant), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the register as proprietor, so as to show the manner in which, and the person or persons to whom, the trade mark has been assigned or transmitted, and so as to show further that it has been so assigned or transmitted in connection with the goodwill of the business concerned in the particular goods or classes of goods for which the trade mark has been registered.

“39. Every such request shall be accompanied by a statutory declaration to be thereunder written, verifying the several statements therein, and declaring that the particulars above described comprise every material fact and document affecting the proprietorship of the trade mark as claimed by such request.

“40. The claimant shall furnish to the comptroller such other proof of title, and of the existence and ownership of such goodwill as aforesaid, as he may require for his satisfaction.

“41. A body corporate may be registered as proprietor by its corporate name.

“42. The term ‘applicant’ in Rules 17, 18, and 19 shall include each of several persons claiming to be registered as proprietor of the same trade mark.

“43. Whether all such persons so claiming require to be heard before the comptroller or not, he may, before exercising the discretion vested in him by s. 71 of the said Acts, require such persons, or any or either of them, to submit a statement in writing within a time to be notified by him,

or to attend before him and make oral explanations with respect to such matters as the comptroller may require.

“44. Where each of several persons claims to be registered as proprietor of the same trade mark, and the comptroller refuses to register any of them until their rights have been determined according to law, the manner in which the rights of such claimants may be submitted to the Court by the comptroller, or, if the comptroller so require, by the claimants, shall, unless the Court otherwise order, be by a special case; and such special case shall be filed and proceeded with in like manner as any other special case submitted to the Court, or in such other manner as the Court may direct.

“45. Where the special case is to be submitted by the parties it may be agreed to by them, or, if they differ, may be settled by the comptroller on payment of the prescribed fees. Form T, p. 275.

“46. Where an order has been made by the Court in either of the following cases, viz. :—

“(a) Allowing an appeal under s. 62 of the said Acts ;

“(b) Disallowing an opposition to registration under s. 69 ; or,

“(c) Under the provisions of ss. 72, 90, or 92 of the said Acts,—

“the person in whose favour such order has been made, or such one of them if more than one, as the comptroller may direct, shall forthwith leave at the Patent Office (Trade Marks Branch), an office copy of such order. The register shall thereupon be rectified or altered, or the purport of such order shall otherwise be duly entered in the register, as the case may be.<sup>1</sup>

“47. Where a trade mark has been removed from the register for non-payment of the prescribed fee or other-

<sup>1</sup> See Form N, p. 272.

wise, under the provisions of s. 79 of the said Acts, the comptroller shall cause to be entered in the register a record of such removal and the cause thereof (p. 249).

“48. If the registered proprietor of a trade mark send to the comptroller, together with the prescribed fee, notice of an alteration in his address, the comptroller shall alter the register accordingly.<sup>1</sup>

“49. Four clear days' notice of every application to the Court under s. 90 of the said Acts, for rectification of the register, shall be given to the comptroller<sup>2</sup> (p. 284).

“50. Whenever an order is made by the Court for making, expunging, or varying an entry from or in the register, the comptroller shall, if he thinks that such rectification or variation should be made public, and at the expense of the person applying for the same, publish, by advertisement or otherwise, and in such manner as he thinks just, the circumstances attending the rectification or variation in the register.

“51. Whenever the registered proprietor of any trade mark intends to apply for the leave of the Court to add to or to alter such trade mark, under s. 92 of the said Acts, the notice to be given to the comptroller shall be given fourteen days at least before such application. If leave be granted on such application the applicant shall forthwith supply to the comptroller such a number of representations of the trade mark, as altered, as he may deem sufficient” (p. 288).

<sup>1</sup> Form M, p. 271.

<sup>2</sup> Form O, p. 272.



## CHAPTER V

### THE REGISTER

By s. 78, "There shall be kept at the Patent Office a book called the *Register of Trade Marks*, wherein shall be entered the names and addresses of proprietors of registered trade marks, notifications of assignments and of transmissions of trade marks, and such other matters as may be from time to time prescribed."

By s. 75, "Application for registration of a trade mark shall be deemed to be equivalent to public use of the trade mark, and the date of the application shall, for the purposes of this Act, be deemed to be, and as from the 1st day of January 1876 to have been, the date of the registration."

There is no jurisdiction to order an unsuccessful applicant to pay an opponent's costs before the comptroller, unless by this s. it can be obtained in an action for damages for "public use" of the trade mark by applying for registration—*Australian Wine Co.* (1889), 41 Ch. D., 278.

By s. 76, "The registration of a person as proprietor of a trade mark shall be *primâ facie* evidence of his right to the exclusive use of the trade mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade mark, subject to the provisions of this Act."

The last few words of this s. are very important, for under them it has been decided that a mark which never ought to have been registered does not become valid by the expiration of five years. It may even then be removed from the register on proper application—*Wragg's T. M.* (1885), 29 Ch. D., 551, and *Baker v. Rawson* (1890), 45 Ch. D., 519; but it seems that a mark is good so long as it is on the register. A proper application should be made to remove it, if a defendant intends to defend infringement on this ground. And see *Compania, etc., v. Rehder* (1888), 5 R. P. C., 61; and s. 77 (p. 251).

Damages may be given for the use of a mark before it is registered, in an action brought subsequently—*Barlow and Jones v. Johnson* (1890), 7 R. P. C., 395.

“70. A trade mark, when registered, shall be assigned and transmitted only in connection with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that goodwill.” See s. 87, p. 283.

This s. crystallises the former law, that trade marks cannot exist by themselves, but only in connection with the goodwill of a business. A trade mark, even before registration, cannot be assigned apart from the particular business to which it is attached, not even to the proprietor of a similar business. This is so although the assignment be made by a foreign owner and be good by foreign law—*Pinto v. Badman* (1891), 8 R. P. C., 181. When goodwill is assigned or transmitted, the marks will pass therewith although not mentioned—*Wellcome's T. M.* (1886), 32 Ch. D., 213. When the business is discontinued, the trade mark is abandoned with it, but the mere disuse of a mark, the business continuing, is not of itself sufficient evidence of an intention to abandon the

mark—*Mouson v. Boehm* (1884), 26 Ch. D., 398. A trade mark is a partnership asset, and so, on dissolution of partnership, each partner may continue to use the mark, if there is no agreement to the contrary. See s. 71, p. 239.

As to rectification of register, correction of errors and alteration generally, see ss. 90-92, pp. 284, 288.

As to inspection of the register, see p. 284, ss. 88, 89.

### REMOVAL FROM REGISTER

By s. 79, sub-ss.

“(1) At a time not being less than two months nor more than three months before the expiration of fourteen years from the date of the registration of a trade mark, the comptroller shall send notice to the registered proprietor that the trade mark will be removed from the register unless the proprietor pays to the comptroller before the expiration of such fourteen years (naming the date at which the same will expire) the prescribed fee; and if such fee be not previously paid, he shall at the expiration of one month from the date of the giving of the first notice, send a second notice to the same effect.

“(2) If such fee be not paid before the expiration of such fourteen years the comptroller may, after the end of three months from the expiration of such fourteen years, remove the mark from the register, and so from time to time at the expiration of every period of fourteen years.<sup>1</sup>

“(3) If before the expiration of the said three months the registered proprietor pays the said fee together with the additional prescribed fee, the comptroller may, without removing such trade mark from the register, accept the said fee as if it had been paid before the expiration of the said fourteen years.<sup>2</sup>

<sup>1</sup> Form X, p. 278.

<sup>2</sup> Form Y, p. 279.

“(4) Where after the said three months a trade mark has been removed from the register for non-payment of the prescribed fee, the comptroller may, if satisfied that it is just so to do, restore such trade mark to the register, on payment of the prescribed additional fee.

“(5) Where a trade mark has been removed from the register for non-payment of the fee or otherwise, such trade mark shall nevertheless, for the purpose of any application for registration during one year next after the date of such removal, be deemed to be a trade mark which is already registered, unless it is shown to the satisfaction of the comptroller that the non-payment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade mark.”

See r. 47, p. 245.

As to “rectification,” see ss. 90–92, pp. 284, 288.

<sup>1</sup> Form Z, p. 279.



## CHAPTER VI

### LEGAL PROCEEDINGS

#### INFRINGEMENT

By s. 77, "A person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of a trade mark unless, in the case of a trade mark capable of being registered under this Act, it has been registered in pursuance of this Act, or of an enactment repealed by this Act, or, in the case of any other trade mark in use before the 13th of August 1875, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused. The comptroller may, on request and on payment of the prescribed fee, grant a certificate that such registration has been refused."<sup>1</sup>

And by 77 A, added in 1888, "In an action for infringement of a registered trade mark the Court or a judge may certify that the right to the exclusive use of the trade mark came in question, and, if the Court or a judge so certifies, then, in any subsequent action for infringement, the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or judge trying the subsequent action certifies that he ought not to have the same."

<sup>1</sup> Form L, p. 271.

As to the necessity of registration prior to action, see *Goodfellow v. Prince* (1887), 35 Ch. D., 9.

If a mark has once been registered it is not necessary, although it is proper, to register subsequent assignments in order to enable the assignee to sue—*Ihlee v. Henshaw* (1885), 31 Ch. D., 323. No one who is not the proprietor can bring an action for infringement—*Richards v. Butcher* (1890), 7 R. P. C., 288.

The sections relating to “registration” are designed to protect the proprietor of a mark by preventing the registration by another person of the same mark, or of another so closely resembling as to be calculated to deceive. S. 77 goes further, and gives the proprietor of a registered mark power to prevent future infringement by an order of the Court, and to obtain compensation for past infringement on the part of another, whether claiming to own a registered trade mark or not. It is often necessary to claim rectification of the register, under O 90 (p. 284), at the same time as damages or an injunction. The right to sue survives to the legal personal representatives of the proprietor.

In order to support a plaintiff’s claim to injunction and costs it is necessary to prove infringement, it being immaterial whether or not the defendant knew he was doing wrong; as Lord-Chancellor Cairns said in “*Singer*” *Machine Manufacturers v. Wilson* (1877), 3 App. Cas., at p. 391: “A man may take the trade mark of another ignorantly, not knowing it was the trade mark of the other; or he may take it in the belief, mistaken but sincerely entertained, that in the manner in which he is taking it he is within the law, and doing nothing which the law forbids; or he may take it knowing it is the trade mark of his neighbour, and intending and desiring to injure his neighbour by so doing. But in all these

cases it is the same act that is done, and in all these cases the injury to the plaintiff is just the same. The action of the Court must depend upon the right of the plaintiff, and the injury done to that right. What the motive of the defendant may be, the Court has very imperfect means of knowing."

But in order to support an action for damages for past infringement it would, it is submitted, be necessary to prove that the defendant *knew* he was doing wrong; and in some cases it would be wise to draw his attention to the fact by a written notice, and only proceed to an action in case he persist in his wrong-doing. Where the plaintiff proves that the defendant has sold much of the goods wrongly marked, he will be entitled at his option to an account of profits in lieu of damages.

An action for infringement is based upon fraud and deceit; but in order to obtain an injunction it is not necessary, if an application is made promptly, to prove that any one has been actually misled, provided the defendant's dealings are calculated to mislead. If the defendant has been for a long period using the trade mark complained of, it might then be necessary to prove that it had misled some of the public—as, if there had been no misleading, there would be no infringement, and the Court would not, except in a strong case, act upon its own view as to whether the mark was calculated to mislead. As to "Injunction," see Part II, Chap. X, p. 139. Printed notice used by defendants when selling tea, stating that their mark is only for coffee, will not exempt them from the consequences of infringing the plaintiff's mark for tea—*Upper Assam Tea Co. v. Herbert & Co.* (1890), 7 R. P. C., 183.

*Calculated to deceive* (see Chap. IV, at p. 241).—Regard should be had not only to English buyers, but to



those who may become ultimate purchasers of the goods, *e.g.* natives of India, where the goods are intended for the Indian market—*Orr-Ewing v. Johnston* (1882), 7 App. Cas., 219 ; a case which decided also that a rival trader is not entitled to use a trade mark which is likely to attract to his goods the name by which the plaintiff's goods are known in the trade.

In the *Singer Manufacturing Co. v. Loog* (1882), 8 App. Cas., 15, there occur some important passages. "The imitation of a man's trade mark, in a manner liable to mislead the unwary, cannot be justified by showing, either that the device or inscription upon the imitated mark is ambiguous, and capable of being understood by different persons in different ways, or that a person who carefully and intelligently examined and studied it might not be misled" (p. 18). Then, at p. 26, Lord Selborne intimated that representations made to wholesale customers had no natural or necessary connection, in intention or fact, with any deception of retail customers ; though in other cases this might be different. This case and some cited in the judgments are useful in illustrating the fact that a name which once designates a particular manufacturing firm of special goods may, in time, come to designate the special class of goods by whomsoever manufactured. Another manufacturer is at liberty to refer in his advertisements, etc., to the plaintiff's goods, to make others like them, where not protected by patent, and to state that his goods are made upon the plaintiff's system.

In *Dunnachie v. Young* (1883), Dec. Ct. Sess., 4th Ser., x., p. 874, the Court granted an interdict restraining the defender from stamping bricks with the name of a locality, which name formed part of the plaintiff's trade marks ; as the defender's bricks, though of exactly the same clay, were actually made two miles from the place named.



In *Anglo-Swiss Co. v. Metcalf* (1886), 3 R. P. C., 28, it was held that the proprietor of a figured trade mark, known as "the dairymaid," was entitled to an injunction to restrain the defendant from selling similar goods under a label comprising the word "dairymaid," and to rectification of the register.

It seems that it is no infringement to use another's trade mark on a price list or otherwise, so that it is not used on the goods—*Talbot v. Webley* (1886), 3 R. P. C., 276: *sed quære*. At any rate, use by a customer, in ordering goods from defendant, of words which form part of plaintiff's mark, is not infringement by the defendant—*Rugby, etc., Co. v. Rugby, etc., Co.* (1891), 8 R. P. C., 241.

See also *Eno v. Dunn* (1890), 15 App. Cas., 252, where Lord Herschell said: "If it were proposed so to employ the words 'Fruit Salt' that no reasonable person could suppose that they had reference to the appellant's preparation, such a use would be perfectly unobjectionable. I think it is enough to say that I am not satisfied that there would be no reasonable danger of the public being so deceived."

When plaintiff uses his trade mark in combination with other marks, capable of registration but not registered, he may succeed in an action to prevent fraudulent imitation of goods—*Great Tower Street Tea Co. v. Langford & Co.* (1888), 5 R. P. C., 66.

A pipe is not likely to be confounded with a pipe and a dart—*Lambert's T. M.* (1889), 6 R. P. C., 344.

And see the notes under s. 73, p. 241.

It is no infringement to use the plaintiff's trade mark for goods of a totally different character, provided a representation be not thereby made that the goods are the plaintiff's goods—*Hart v. Colley* (1890), 7 R. P. C., 93; but trade marks in use before 13th August 1875, the

registration whereof has been refused (see *supra*, p. 213), are dependent, like trade names, on the general principles of the commercial law, and are protected from fraud and deceit on the part of rivals. There is strictly no right of property in trade names or these trade marks, but no rival may pass his goods off as the goods of another or another's goods as his own. Whether this is done directly or indirectly is a matter of no consequence. See *Somerville v. Schembri* (1887), 12 App. Cas., 453, and the cases and notes under s. 77 which apply. Plaintiff must be prepared to prove that his goods have obtained a reputation in connection with the trade mark or name—*Jay v. Ladler* (1888), 40 Ch. D., 649, and see p. 307.

## CHAPTER VII

### SHEFFIELD MARKS

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

“ (1) The Cutlers’ Company shall establish and keep at Sheffield a new register of trade marks (in this Act called the Sheffield register).

“ (2) The Cutlers’ Company shall enter in the Sheffield register, in respect of metal goods as defined in this section, all the trade marks entered before the 1st day of January 1889, in respect of metal goods either in the register established under the Trade Marks Registration Act 1875, or in the register of trade marks under this Act, belonging to persons carrying on business in Hallamshire, or within six miles thereof. The Cutlers’ Company shall also, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal goods, all the trade marks which shall have been assigned by the Cutlers’ Company and actually used before the 1st day of January 1884, but which have not been entered in either

of the said other registers. [There can be no opposition to an application to register under this section—*Lambert's T. M.* (1889), 6 R. P. C., 344.] And see Form, p. 280.

“(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 comptroller in the prescribed manner, and unless the comptroller within the prescribed time gives notice to the Cutlers' Company that he objects to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner.

“(5) If the comptroller gives notice of objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the Court.

“(6) Upon the registration of a trade mark in the Sheffield register the Cutlers' Company shall give notice thereof to the comptroller, who shall thereupon enter the mark in the register of trade marks; and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the comptroller on that day.

“(7) The provisions of this Act and of any general Rules made under this Act with respect to the registration of trade marks, and all matters relating thereto, shall, subject to the provisions of this section, apply to the registration of trade marks on metal goods by the Cutlers' Company, and to all matters relating thereto; and this Act and any such general Rules shall, so far as applicable, be construed accordingly, with the substitution of the



Cutlers' Company, the office of the Cutlers' Company, and the Sheffield register, for the comptroller, the Patent Office, and the Register of Trade Marks, respectively; and notice of every entry, cancellation, or correction made in the Sheffield register shall be given to the comptroller by the Cutlers' Company: Provided that this section shall not affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register.

“(8) Where the comptroller receives from any person not carrying on business in Hallamshire, or within six miles thereof, an application for registration of a trade mark used on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge, he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company.

“(9) At the expiration of five years from the commencement of this Act, the Cutlers' Company shall close the Cutlers' register of corporate trade marks, and thereupon all marks entered therein shall, unless entered in the Sheffield register, be deemed to have been abandoned.

“(10) A person may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of two or more trade marks.

“(11) A body of persons, corporate or not corporate, may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of a trade mark or trade marks.

“(12) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the comptroller, who shall have power to confirm, reverse,

or modify the decision, but the decision of the comptroller shall be subject to a further appeal to the Court.<sup>1</sup>

“(13) So much of the Cutlers’ Company’s Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate marks—that is to say, the fifth section of the Cutlers’ Company’s Act of 1814, and the provisions in relation to the recovery and application of the penalty imposed by such last-mentioned section contained in the Cutlers’ Company’s Act of 1791—shall apply to any mark entered in the Sheffield register.

“(14) For the purposes of this section the expression ‘metal goods’ means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal.

“(15) For the purpose of legal proceedings, in relation to trade marks entered in the Sheffield register, a certificate under the hand of the master of the Cutlers’ Company shall have the same effect as the certificate of the comptroller.”

The following are the Rules applying to Sheffield marks :

“56. All applications to the Cutlers’ Company for registration of a trade mark, under s. 81 of the said Acts, shall be in duplicate, accompanied by the prescribed fees and representations.

“57. The Cutlers’ Company shall, within seven days of the receipt by them of an application to register a trade mark, send the comptroller one copy of such application, by way of notice thereof, together with two representations of the mark for each class for which the applicant seeks registration.

“58. (1) The time within which the comptroller shall give notice to the Cutlers’ Company of any objection he may have to the acceptance of an application for registra-

<sup>1</sup> Form W, p. 278.

tion made to the said Company, shall be one month from the date of the receipt by the comptroller of the notice from the said Company of the making of the application.

“(2) If no such objection is made by the comptroller, the Cutlers' Company shall require the applicant to send the comptroller a wood-block or electrotype as the comptroller may direct, and the comptroller shall, if satisfied with such wood-block or electrotype, advertise the application in the same manner as an application made to him at the Patent Office.

“(3) The manner in which the comptroller shall notify to the Cutlers' Company an application and proceedings thereon made as mentioned in sub-s. 8 of s. 81 of the said Acts, shall be by sending to the Cutlers' Company a copy of the official paper containing the application of which notice is required to be given, with a note distinguishing such application.

“59. The provisions of these Rules as to forms, representations, the proceedings on opposition to registration, registration, and all subsequent proceedings shall, as far as the circumstances allow, apply to all applications to register made to the Cutlers' Company, and to all proceedings consequent thereon.”

According to the instructions issued by the Patent Office, “applications made to the Cutlers' Company, in pursuance of s. 81 of the Acts, should be made on Form F, the address in the left hand corner to be, ‘To the Cutlers' Company, Sheffield,’ instead of ‘To the Comptroller,’ and should be left at, or sent by post to, the Cutlers' Hall, Sheffield.

“Each application should be accompanied by an unstamped copy on foolscap paper. See Rule 56.

“Applications sent by post should be addressed—

“The Law Clerk to the Cutlers' Company,  
“The Cutlers' Hall, Sheffield.”



## FEES

THE following fees are payable by virtue of s. 80, and the orders of the Board of Trade made thereunder:—

1. On application to register a trade mark for one or more articles included in one class . . . . .	£0	5	0
2. For registration of a trade mark for one or more articles included in one class . . . . .	1	0	0
3. For registering a series of trade marks, for every additional representation after the first in each class . . . . .	0	5	0
4. On appeal from comptroller to Board of Trade—by appellant . . . . .	1	0	0
5. On notice of opposition for each application opposed—by opponent . . . . .	1	0	0
6. On hearing by comptroller—by applicant and by opponent respectively . . . . .	1	0	0
7. On application to register a subsequent proprietor in cases of assignment or transmission, the first mark . . . . .	1	0	0
8. For every additional mark assigned or transmitted at the same time . . . . .	0	2	0
9. For continuance of mark at expiration of fourteen years . . . . .	1	0	0
10. Additional fee, where fee is paid within three months after expiration of fourteen years . . . . .	0	10	0
11. Additional fee for restoration of trade mark where removed for non-payment of fee . . . . .	1	0	0
12. For altering address on the register for every mark . . . . .	0	5	0
13. For every entry in the register of a rectification thereof or an alteration therein, not otherwise charged . . . . .	0	10	0
14. For cancelling the entry or part of the entry of a trade mark upon the register, on the application of the owner of such trade mark . . . . .	0	5	0
15. On request to comptroller to correct a clerical error, or permit amendment of application under s. 91 . . . . .	0	5	0
16. For certificate of refusal to register a trade mark under s. 77 . . . . .	1	0	0
17. For certificate of refusal at the same time for more than one trade mark, for each additional trade mark after the first . . . . .	0	10	



18. For certificate of registration to be used in legal proceedings . . . . .	£1	0	0
19. For certificate of registration to be used for the purpose of obtaining registration in foreign countries . . . . .	0	5	0
20. For certificate of comptroller under s. 96, other than certificate of registration to be used in legal proceedings, or for the purpose of obtaining registration in a foreign country . . . . .	0	5	0
21. For copy of notification of registration . . . . .	0	2	0
22. Settling a special case by comptroller . . . . .	2	0	0
23. For inspecting register, for every quarter of an hour . . . . .	0	1	0
24. For making a search amongst the classified representations of trade marks, for every quarter of an hour . . . . .	0	1	0
25. For office copy of documents for every hundred words (but never less than one shilling) . . . . .	0	0	4
26. For certifying office copies, MS. or printed . . . . .	0	1	0
27. In cases where the wood-block or electrotype of the trade mark exceeds 2 inches in breadth or depth, or in breadth and depth—For every inch or part of an inch over 2 inches in breadth . . . . .	0	2	0
For every inch or part of an inch over 2 inches in depth . . . . .	0	2	0
28. Manchester Trade Marks Office . . . . .	Same as above		
29. Sheffield Marks . . . . .	Same as above		
30. On appeal from Cutlers' Company, Sheffield, to comptroller . . . . .	1	0	0

*N.B.*—The fees in relation to *registration* will not be received at the Patent Office. They should be paid in exchange for the stamped forms required, which may be obtained as stated on p. 319.

## FORMS

- E.—Form of application for hearing by comptroller.  
 F.— „ application for registration.  
 G.— „ additional representation of trade mark.  
 H.— „ appeal to Board of Trade.  
 I.— „ transmission of registration fee.  
 J.— „ notice of opposition.  
 K.— „ request to enter name of subsequent proprietor  
 of trade mark.  
 L.— „ request for certificate of refusal.  
 M.— „ notice of application for alteration of address.  
 N.— „ notice of order of Court for rectification of  
 register.  
 O.— „ application to cancel entry on register.  
 P.— „ declaration in support of application to cancel  
 entry.  
 Q.— „ request to comptroller for correction of clerical  
 error, or for permission to amend application  
 under s. 91.  
 R.— „ request for certificate of registration for use in  
 obtaining registration abroad.  
 S.— „ request for certificate of registration for use in  
 legal proceedings.  
 T.— „ application for settlement of a special case.  
 T 1.— „ request for general certificate of comptroller.  
 U.— „ general certificate of comptroller.  
 V.— „ request for copy of notification of registration.  
 W.— „ appeal from Cutlers' Company.  
 X.— „ application for continuance on register.  
 Y.— „ transmission of additional fee.  
 Z.— „ application for restoration to register.  
 „ application for registration of old corporate trade  
 mark.

*N.B.*—As to where these Forms may be obtained, see p. 319.

*Patents, Designs, and Trade Marks Acts 1883 to 1888*

FORM E (p. 238)

FORM OF APPLICATION FOR HEARING BY THE  
COMPTROLLER

*In cases of Opposition, etc.*

SIR,

of (a)

(a) Here insert  
full address.

hereby apply to be heard in reference to

and request that I may receive due notice of the day  
fixed for the hearing.

Your obedient Servant,

To the Comptroller,  
Patent Office, Trade Marks Branch,  
25 Southampton Buildings, London, W.C.

*Patents, Designs, and Trade Marks Acts 1883 to 1888*

FORM F (p. 220)

APPLICATION FOR REGISTRATION OF TRADE MARK

TRADE  
MARKS,

One representation to be fixed within this square, and two others to be sent on separate half sheets of foolscap.

Representations of a larger size may be folded, but must be mounted upon linen and affixed hereto.

You are hereby requested to register the accom-

panying trade mark in Class \_\_\_\_\_, in respect  
of (a)

(a) Only goods contained in one and the same class should be set out here. A separate application form is required for each separate class.

(b) Here insert in the name of (b) legibly the full name, address, and description of the individual firm or company. Add trading style (if any).

(c) Alter to who claims to be the proprietor thereof (c).  
"claim to be the proprietors thereof" in the case of a firm or company.

(d) See sub-ss. 2 and 3 of s. 64 of the Acts. The essential particulars of the trade mark are the following (d)

and disclaim any right to the exclusive use of the added matter.

(e) To be signed by the applicant or by an agent duly authorised.

(Signed)

(e)

Dated the \_\_\_\_\_ day of \_\_\_\_\_ 18

To the Comptroller,  
Patent Office, Trade Marks Branch,  
25 Southampton Buildings, London, W.C.

(Or where the application is for a mark in  
Classes 23, 24, or 25.)

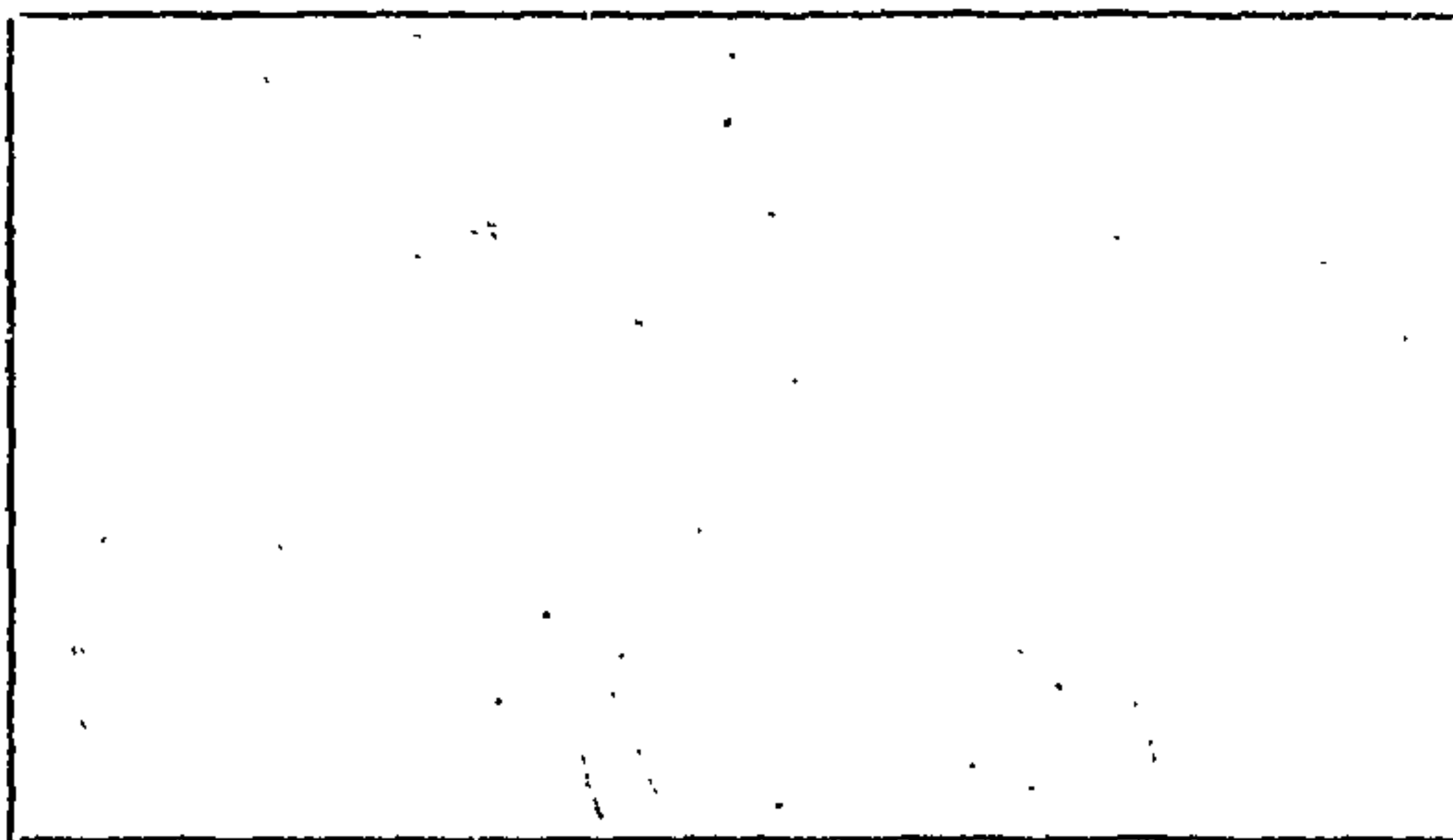
To the Comptroller,  
Manchester Trade Marks Branch,  
48 Royal Exchange, Manchester.

NOTE.--If the trade mark has been in use in respect of the goods since before August 13th, 1875, state length of such user.



*Patents, Designs, and Trade Marks Acts 1883 to 1888*

## FORM G (p. 224)

**ADDITIONAL REPRESENTATION OF TRADE MARK, TO  
ACCOMPANY APPLICATION FOR REGISTRATION**

One representation of the trade mark to be affixed within this square.

It must correspond *exactly*, in all respects, with the representation affixed to the Application Form.

Any representation of a larger size than foolscap may be folded, but must then be mounted upon linen and affixed hereto.

Two of these ADDITIONAL REPRESENTATIONS of the trade mark must accompany *each* form of application.

In the case of a trade mark claimed in one of the Classes 23 to 35, THREE of these ADDITIONAL REPRESENTATIONS of the mark must accompany the form of application.

---

TRADE  
MARKS.

*Patents, Designs, and Trade Marks Acts 1883 to 1888*

FORM H (p. 231)

FORM OF APPEAL FROM THE COMPTROLLER TO THE  
BOARD OF TRADE

(a) Here insert full name and address of appellant.

(b) Here insert "the decision" or that part of the decision as the case may be.

(c) Here insert the decision complained of.

I, (a)

of (a)

hereby give notice of my intention to appeal to the Board of Trade from (b)

of the comptroller of the                      day of                      18 ,  
whereby he (c)

Accompanying this notice is a statement of my case for the decision of the Board of Trade.

(Signed)

Dated                      day of                      18

To the Comptroller,  
Patent Office, Trade Marks Branch,  
25 Southampton Buildings, London, W.C.  
And to  
(Name of Respondent to Appeal.)

TRADE  
MARKS.

*Patents, Designs, and Trade Marks Acts 1883 to 1888*

FORM I (p. 242)

FEE FOR REGISTRATION OF A TRADE MARK

SIR,

In reply to your request, I hereby transmit the prescribed fee for the registration of the trade mark No.                      in Class                      .

I am, Sir,

Your obedient Servant,

To the Comptroller,  
Patent Office, Trade Marks Branch,  
25 Southampton Buildings, London, W.C.

*Patents, Designs, and Trade Marks Acts 1883 to 1888*

FORM J (p. 237)

TRADE MARKS.
-----------------

NOTICE OF OPPOSITION TO APPLICATION FOR  
REGISTRATION

(To be accompanied by an unstamped duplicate)

In the matter of an application,  
No.                      by  
of

\* I,

\* Here state  
full name and  
full address.

hereby give notice of my intention to oppose the registration of the trade mark advertised under the above number for Class            in the *Trade Marks Journal* of the            day of            , 18    , No.    , page    .

The grounds of opposition are as follows:—

(Signed)

Dated the            day of            , 18

Address for service:—

To the Comptroller,  
Patent Office, Trade Marks Branch,  
25 Southampton Buildings, London, W.C.

TRADE  
MARKS.

*Patents, Designs, and Trade Marks Acts 1883 to 1888*

FORM K (p. 243)

REQUEST TO ENTER NAME OF SUBSEQUENT PROPRIETOR  
OF TRADE MARK UPON THE REGISTER, WITH DECLARATION  
IN SUPPORT THEREOF

(a) Or We. Here insert name, full address and description.

I, (a)

(b) My, or our. (c) Or names.

hereby request that you will enter (b) name (c) in the Register of Trade Marks as proprietor of the trade mark No. in Class .

(d) I am, or We are.

(d) entitled to the said trade mark, and to the goodwill of the business concerned in the goods with respect to which the said trade mark is registered.

(e) Here state whether trade mark transmitted by death, marriage, bankruptcy, or other operation of law, and if entitled by assignment state the particulars thereof, as e.g., "by deed dated the day of 18, made between So-and-so of the one part."

(e)

And I do solemnly and sincerely declare that the above several statements are true, and the particulars above set out comprise every material fact and document affecting the proprietorship of the said trade mark as above claimed.

(f) This paragraph is not required when the declaration is made out of the United Kingdom.

(f) And I make this solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

(g) To be signed here by the person making the declaration.

(g) Declared at this day of 18 }  
Before me, (h)

(h) Signature and title of the authority before whom the declaration is made

To the Comptroller,  
Patent Office, Trade Marks Branch,  
25 Southampton Buildings, London, W.C.



*Patents, Designs, and Trade Marks Acts 1883 to 1888*

FORM L (pp. 251 and 284)

TRADE  
MARKS.

REQUEST FOR CERTIFICATE OF REFUSAL TO REGISTER A  
TRADE MARK IN USE BEFORE AUGUST 13, 1875

In the matter of an application for  
registration of an old Trade Mark,  
No. \_\_\_\_\_ in Class \_\_\_\_\_

SIR,

I,

of

the applicant in the above matter, hereby request you  
to furnish me with your Certificate of Refusal to register  
the said trade mark.

\*

Dated this \_\_\_\_\_ day of \_\_\_\_\_ 18

\* Signature of  
applicant.

To the Comptroller,  
Patent Office, Trade Marks Branch,  
25 Southampton Buildings, London, W.C.

*Patents, Designs, and Trade Marks Acts 1883 to 1888*

FORM M (p. 246)

TRADE  
MARKS.

NOTICE OF APPLICATION FOR ALTERATION OF ADDRESS  
ON REGISTER OF TRADE MARKS

In the matter of the trade mark,  
No. \_\_\_\_\_ registered  
in Class \_\_\_\_\_

SIR,

NOTICE is hereby given that I  
of

the registered proprietor of the trade mark numbered  
as above, desire that my address on the Register of  
Trade Marks be altered to

Dated this \_\_\_\_\_ day of \_\_\_\_\_ 18

\*

\* Signature of  
proprietor.

To the Comptroller,  
Patent Office, Trade Marks Branch,  
25 Southampton Buildings, London, W.C.



*Patents, Designs, and Trade Marks Acts 1883 to 1888*

FORM N (p. 245)

NOTICE OF ORDER OF COURT FOR ALTERATION OR  
RECTIFICATION OF REGISTER OF TRADE MARKS

In the matter of the trade mark,  
No. \_\_\_\_\_, registered  
in Class \_\_\_\_\_ in the name of

SIR,

NOTICE is hereby given that by an Order of the  
Court made on the \_\_\_\_\_ day of \_\_\_\_\_ 18\_\_\_\_,  
it was directed that the entry on the Register of Trade  
Marks in respect of the trade mark numbered as above  
should be rectified in the manner therein specified.

An Office Copy of the Order of Court is enclosed  
herewith.

Dated this \_\_\_\_\_ day of \_\_\_\_\_ 18\_\_\_\_

\*

\* To be signed  
by the person  
interested or his  
agent.

To the Comptroller,  
Patent Office, Trade Marks Branch,  
25 Southampton Buildings, London, W.C.



*Patents, Designs, and Trade Marks Acts 1883 to 1888*

FORM O (p. 246)

FORM OF APPLICATION BY PROPRIETOR OF REGISTERED  
TRADE MARK TO CANCEL ENTRY ON REGISTER

Trade Mark No. \_\_\_\_\_ Class \_\_\_\_\_ advertised in  
*Trade Marks Journal*, No. \_\_\_\_\_, page \_\_\_\_\_.

Name of Registered Proprietor or Firm  
Place of Business

I, the undersigned,  
of \_\_\_\_\_

(or I, the undersigned,  
a member of the firm of  
of \_\_\_\_\_

on behalf of my said firm)

apply that the entry upon the Registry of the Trade

Marks in Class of the trade mark No.  
may be cancelled.

The day of 18  
(Signed)

This is the statement marked "O" referred to in  
the Declaration of made  
before me the of 18

*Patents, Designs, and Trade Marks Acts 1883 to 1888*

FORM P (p. 246)

FORM OF DECLARATION IN SUPPORT OF APPLICATION  
FOR CANCELLATION OF TRADE MARK BY OWNER

I, of ;  
(or I, a member of the firm of  
of

) do hereby solemnly and sincerely declare,  
to the best of my knowledge and belief, as follows:—

(1) The application signed by me, and dated the day  
of 18, and marked with the letter "O," and shown  
to me at the time of making this declaration, is true.

(2) I am the person whose name appears on the  
Register of Trade Marks as the proprietor of the  
trade mark referred to in the said application marked  
with the letter "O."

(or my said firm is the firm whose name appears on  
the Register of Trade Marks as the proprietor of the  
trade mark referred to in the said application marked  
with the letter "O.")

And I make this solemn declaration conscientiously  
believing the same to be true, and by virtue of the  
provisions of the Statutory Declarations Act 1835.

(Signed)

Declared at  
this day of 18 }  
Before me, }

If the declaration be made before a Commissioner  
to administer oaths it will require to be stamped with  
a 2s. 6d. impressed Inland Revenue stamp.

TRADE  
MARKS.

*Patents, Designs, and Trade Marks Acts 1883 to 1888*

FORM Q (p. 287)

FORM OF REQUEST FOR CORRECTION OF CLERICAL  
ERROR OR FOR PERMISSION TO AMEND APPLI-  
CATION UNDER S. 91

SIR,

I HEREBY request that

To the Comptroller,  
Patent Office, Trade Marks Branch,  
25 Southampton Buildings, London, W.C.

TRADE  
MARKS.

*Patents, Designs, and Trade Marks Acts 1883 to 1888*

FORM R (p. 290)

REQUEST FOR CERTIFICATE OF REGISTRATION OF  
TRADE MARK FOR USE IN OBTAINING REGIS-  
TRATION ABROAD

In the matter of the trade mark,  
No. \_\_\_\_\_, registered in  
Class \_\_\_\_\_, in the name of

SIR,

I,

of

the registered proprietor of the above trade mark,  
hereby request you to furnish me with your Certificate  
of Registration for use in obtaining registration of the  
same in \*

\* Here state  
name of country  
in which regis-  
tration is to be  
sought.

† Signature.

†

Dated this \_\_\_\_\_ day of \_\_\_\_\_ 18

To the Comptroller,  
Patent Office, Trade Marks Branch,  
25 Southampton Buildings, London, W.C.



*Patents, Designs, and Trade Marks Acts 1883 to 1888*

FORM S (p. 290)

TRADE  
MARKS.

REQUEST FOR CERTIFICATE OF REGISTRATION OF TRADE  
MARK TO BE USED IN LEGAL PROCEEDINGS

In the matter of the trade mark,  
No. \_\_\_\_\_, registered in  
Class \_\_\_\_\_, in the name of

SIR,

I,

of

the registered proprietor of the above trade mark,  
hereby request you to furnish me with your Certificate  
of Registration to be used in legal proceedings

\*

Dated this \_\_\_\_\_ day of \_\_\_\_\_ 18

\* Signature.

To the Comptroller,  
Patent Office, Trade Marks Branch,  
25 Southampton Buildings, London, W.C.

*Patents, Designs, and Trade Marks Acts 1883 to 1888*

FORM T (p. 275)

TRADE  
MARKS.

APPLICATION FOR SETTLEMENT OF A SPECIAL CASE ON  
APPLICATION TO REGISTER A TRADE MARK

In the matter of the application  
of \_\_\_\_\_ and  
of the application of

SIR,

NOTICE is hereby given that I,

, of \_\_\_\_\_,

and I,

of \_\_\_\_\_,

are unable  
to agree upon the facts on which the opinion of the



*Patents, Designs, and Trade Marks Acts 1883 to 1888*

FORM U (p. 290)

TRADE  
MARKS.

GENERAL CERTIFICATE OF COMPTROLLER (OTHER THAN  
CERTIFICATE FOR USE IN LEGAL PROCEEDINGS OR  
FOR USE IN OBTAINING REGISTRATION ABROAD)

Patent Office, Trade Marks Branch,  
London,

18

I,  
Comptroller-General of Patents, Designs, and Trade  
Marks, hereby certify

*Patents, Designs, and Trade Marks Acts 1883 to 1888*

FORM V

TRADE  
MARKS.

REQUEST FOR COPY OF OFFICIAL NOTIFICATION  
OF REGISTRATION OF TRADE MARK

In the matter of the trade mark,  
No. \_\_\_\_\_, registered  
in Class \_\_\_\_\_

SIR,

I,  
of \_\_\_\_\_ the  
registered proprietor of the trade mark above named,  
hereby request that you will furnish me with a copy  
of the official notification of the registration of the  
same

\*

\* Signature.

Dated this \_\_\_\_\_ day of \_\_\_\_\_ 18

To the Comptroller,  
Patent Office, Trade Marks Branch,  
25 Southampton Buildings, London, W.C.



*Patents, Designs, and Trade Marks Acts 1883 to 1888*

FORM W (p. 260)

FORM OF APPEAL FROM CUTLERS' COMPANY AT  
SHEFFIELD TO COMPTROLLER

(To be accompanied by an unstamped duplicate)

SIR,

I HEREBY give notice of appeal against the  
decision of the Cutlers' Company of Sheffield in regard  
to my application for registration of a trade mark, No.

in Class                      for

and I beg to submit my case\* for your decision  
accordingly.

\* The state-  
ment of the case  
to be written  
upon foolscap  
paper (on one  
side only), with  
a margin of two  
inches on the  
left-hand side  
thereof.

† Signature.

†

Dated this                      day of                      18

To the Comptroller,  
Patent Office, Trade Marks Branch,  
25 Southampton Buildings, London, W.C.



*Patents, Designs, and Trade Marks Acts 1883 to 1888*

FORM X (p. 249)

CONTINUANCE OF MARK AT EXPIRATION OF FOURTEEN  
YEARS FROM THE DATE OF REGISTRATION

SIR,

In pursuance of the notice received from you, I  
hereby transmit the prescribed fee of £1 for continu-  
ance on the Trade Marks Register of the trade mark  
No.                      , in Class                      .

Dated the                      day of                      18

\*

\* Signature of  
proprietor.

To the Comptroller,  
Patent Office, Trade Marks Branch,  
25 Southampton Buildings, London, W.C.



*Patents, Designs, and Trade Marks Acts 1883 to 1888*

## FORM Y (p. 249)

TRADE  
MARKS.

ADDITIONAL FEE OF 10s. TO ACCOMPANY "CONTINU-  
ANCE FEE" (FORM X), WITHIN THREE MONTHS  
AFTER EXPIRATION OF FOURTEEN YEARS

SIR,

IN pursuance of the notices issued by you, and  
of the provisions of s. 79 (3) of the above Acts, I  
hereby transmit the additional fee of 10s. (along with  
Form X) for the continuance on the Trade Marks  
Register of the trade mark No. , in Class .

Dated the                      day of                      18

\*

\* Signature of  
proprietor.

To the Comptroller,  
Patent Office, Trade Marks Branch,  
25 Southampton Buildings, London, W.C.

*Patents, Designs, and Trade Marks Acts 1883 to 1888*

## FORM Z (p. 250)

TRADE  
MARKS.

RESTORATION OF TRADE MARK WHERE REMOVED FOR  
NON-PAYMENT OF FEE

(To accompany Form X)

SIR,

IN pursuance of the notices issued by you, and  
of the provisions of s. 79 (4) of the above Acts, I  
hereby transmit the additional fee of £1 (along with  
Form X) for restoration to the Trade Marks Register  
of the trade mark No. , in Class .

Dated the                      day of                      18

\*

\* Signature of  
proprietor.

To the Comptroller,  
Patent Office, Trade Marks Branch,  
25 Southampton Buildings, London, W.C.

*Patents, Designs, and Trade Marks Acts 1883 to 1888*

CORPORATE  
TRADE  
MARK.

APPLICATION FOR REGISTRATION OF OLD CORPORATE  
TRADE MARK (p. 258)



You are hereby requested to register the accompanying old corporate trade mark in Class  
in respect of  
in the name of  
who claims to be the proprietor thereof.

(Signed)

Dated the                      day of                      18

To the Cutlers' Company,  
Cutlers' Hall, Sheffield.

PART V



*GENERAL*

## CHAPTER I

### GENERAL

Ss. 82 and 83 of the 1883 Act provide for the establishment and maintenance of the Patent Office and the staff, and by s. 101 the Board of Trade have power to make general Rules for regulating the business of the office, etc.

“S. 84. There shall be a seal for the Patent Office, and impressions thereof shall be judicially noticed and admitted in evidence (*infra*, ss. 88, 89).

“S. 85. There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust expressed, implied, or constructive.” [But the Court may order an undertaking limiting the use of the registered property, as in *Mitchell & Co.'s T. M.* (1885), 28 Ch. D., 666.]

“S. 86. The comptroller may refuse to grant a patent for an invention, or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality.

“S. 87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade mark, the comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright



in the design, or trade mark, in the register of patents, designs, or trade marks, as the case may be. The person for the time being entered in the register of patents, designs, or trade marks, as proprietor of a patent, copyright in a design or trade mark, as the case may be, shall, subject to the provisions of this Act and to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the same, and to give effectual receipts for any consideration for such assignment, licence, or dealing. Provided that any equities in respect of such patent, design, or trade mark may be enforced in like manner as in respect of any other personal property."

*N.B.*—The sections are printed as amended by Act of 1888.

*Request.*—For a patent, Form L (p. 164), for a design, Form K (p. 206), for a trade mark, Form L (p. 271) should be used.

*Assignment.*—See s. 16, p. 122, and ss. 23 and 36, p. 145, s. 70, p. 248.

This section does not take away a mortgagor's right of suing for infringement without making his mortgagee party—*Van Gelder & Co. v. Sowerby, Bridge, etc.* (1890), 44 Ch. D., 374. A mortgagee is not a "proprietor."

An assignee of a registered trade mark may bring an action without registering the assignment—*Ihlee v. Henshaw* (1886), 31 Ch. D., 323.

By ss. 88, 89 any person may inspect any register kept, and may obtain certified and sealed copies or extracts, which are evidence in all Courts in Her Majesty's dominions. For rules, see p. 293.

*Rectification.*—By s. 90, sub-ss.

"(1) The Court may, on the application of any person aggrieved by the omission without sufficient

cause of the name of any person or of any other particulars from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging, or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.

“(2) The Court may, in any proceeding under this section, decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

“(3) Any order of the Court rectifying a register shall direct that due notice of the rectification be given to the comptroller.”

No Rules have been made under this and the following sections, except as regards trade marks (p. 246). By these Rules (r. 49) four clear days' notice must be given to the comptroller of every application under s. 90. This application, in the case of refusal to register a trade mark, can only be made after the hearing of the appeal by the Board of Trade, or when referred to the Court by the Board—“*Normal*” (1887), 35 Ch. D., 231. In other cases the appeal is direct from the comptroller.

By s. 111 (2), A copy of the order or decree for rectification, made in a Scotch or Irish Court, must be served on the comptroller.

There is no jurisdiction under this section to insert in the register the name of the real owner, the wrong name having been registered by mistake, although the wrong entry may be expunged. The real owner should proceed by a fresh application for registration—*Kingsford & Son's Appln.* (1889), 6 R P C., 413.

“*Person aggrieved.*” — In *Apollinaris Co.’s T. M.* (1891), 2 Ch. 186, the Court of Appeal said:—“The words ‘person aggrieved’ appear to us to have been introduced into the statute to prevent the action of common informers or of persons interfering from merely sentimental notions, but that they must not be so read as to make evidence of great and serious damage a condition precedent to the right to apply. Whenever one trader, by means of his wrongly registered trade mark, narrows the area of business open to his rivals, and thereby either immediately excludes, or with reasonable probability will in the future exclude, a rival from a portion of that trade into which he desires to enter, that rival is an ‘aggrieved person.’ Again, if the effect produced or likely to be produced by the wrongful trade mark is not the exclusion but the hampering of a rival trader, that rival trader is a ‘person aggrieved.’ A man in the same trade as the one who has wrongfully registered a trade mark, and who desires to deal in the article in question, is *primâ facie* an ‘aggrieved person.’ This may be rebutted by showing that, by reason of some circumstances entirely independent of the trade mark, the person complaining could never carry on any trade in the article; but the burden of tendering such proof is on the man who claims the mark. . . . When one trader uses the fact of registration as any part of his case against another trader in any legal proceedings, that second trader is aggrieved, and this is not the less so because that trader has other means of defending himself.”

It seems that a person who applied for and obtained the entry can hardly complain of its inaccuracy under this section, but a trade agent of the other party to the action may—*Ainslie & Co.’s T. M.* (1887), 4 R. P. C., 212.

Material misrepresentation, even when innocent, will



cause registration to be expunged — *Baker v. Rawson* (1890), 45 Ch. D. 519.

Where a change of ownership has taken place, or new interests have been acquired by persons not on the register, the application should be made under s. 87 (*supra*), and not under s. 90.

*Amendment Generally.*—By s. 91, “The comptroller may, on request in writing, accompanied by the prescribed fee :—

“(a) Correct any clerical error in or in connection with an application for a patent, or for registration of a design or trade mark ; or

“(b) Correct any clerical error in the name, style, or address of the registered proprietor of a patent, design or trade mark ;

“(c) Cancel the entry or part of the entry of a trade mark on the register : provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address and calling, and that he is the person whose name appears on the register as the proprietor of the said trade mark ;

“(d) Permit an applicant for registration of a design or trade mark to amend his application by omitting any particular goods or classes of goods in connection with which he has desired the design or trade mark to be registered.”

*Request.*—For a patent, Form P (p. 167) should be used ; for a design, Form M (p. 207) ; for a trade mark, Form Q (p. 274).

By No. 16 of the Patent Rules, No. 30 of the Designs, and No. 54 of the Trade Marks, any document, drawing, sketch, etc., “for the amending of which no special provision is made by the said Act may be amended, and any irregularity in procedure which, in the opinion of



the comptroller, may be obviated without detriment to the interests of any person may be corrected, if the comptroller think fit, and upon such terms as he may direct."

As to the jurisdiction of the Master of the Rolls to amend clerical errors in documents that have become records, see p. 120.

As to amendment of clerical errors in a specification after a patent has been granted, see p. 117.

As to amendment after litigation commenced, see p. 143.

*Trade Mark only.*—By s. 92, sub-ss.

"(1) The registered proprietor of any registered trade mark may apply to the Court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act, and the Court may refuse or grant leave on such terms as it may think fit.

"(2) Notice of any intended application to the Court under this section shall be given to the comptroller by the applicant; and the comptroller shall be entitled to be heard on the application.

"(3) If the Court grants leave, the comptroller shall, on proof thereof, and on payment of the prescribed fee, cause the register to be altered in conformity with the order of leave."

By trade mark Rule No. 51, the proprietor must give the comptroller fourteen days' notice at least. See p. 246.

Whenever the Court makes an order for making, expunging, or varying an entry of a trade mark, the comptroller may advertise the order at the expense of the person applying for it. (R. 50.)

*Colman's T. M.* (1891), 2 Ch. 402, the words "trade mark" were omitted from a label on terms as to the entry in the register. They had apparently applied to a portion only of a label, thereby designating that portion as essential, and the rest unessential.

As to using the mark with additions, leave of the Court not having been obtained, see p. 218.

The addition of the word "limited" is not an essential particular—*Burke's T. M.*, W. N., 1891, p. 2. Nor is the name of the firm (generally), *Murphy's T. M.* (1890), 7 R. P. C., 163.

*Discretionary Power.*—By s. 94, "Where any discretionary power is by this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent."

See Patent Rules, 11–13; Designs, 12–14; Trade Marks, 17–19.

The effect of these Rules is that applicant must "require" the opportunity within one month from the date of the comptroller's objection. The comptroller must then give applicant ten days' notice of the hearing. Within five days from the date when such notice would be delivered in the ordinary course of post the applicant must notify the comptroller in writing whether or not he intends to be heard.

In the case of a patent the comptroller may require a statement in writing, or personal attendance, or oral explanations.

His decision must be notified to the applicant.

By s. 95, the comptroller may, in any case of doubt or difficulty, apply to the law officers for directions.

*Certificate.*—By s. 96, "A certificate purporting to be under the hand of the comptroller as to any entry, matter or thing which he is authorised by this Act, or any

general Rules made thereunder, to make or do, shall be *primâ facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone."

Patents Certificate, Form Q (p. 168); Designs Form of Request, I (p. 205); Certificate, Form J (both for use in legal proceedings). Trade Marks Form of Request and Certificate for Use in Legal Proceedings, R and S respectively (pp. 274, 275); for General Certificate, T 1 and U respectively (see pp. 276, 277). Trade Mark Rule 60 is as follows:—"The comptroller, when required to give a certificate as to any entry, matter or thing which he is authorised by the said Acts or any of these Rules to make or do, may, on receipt of a request in writing, and on payment of the prescribed fee, give such certificate; but every certificate of registration shall have specified on the face thereof, whether the same is to be used in legal proceedings, or for the purpose of obtaining registration in a foreign country, or for purposes other than use in legal proceedings or obtaining registration in a foreign country."

According to the instructions issued by the Patent Office, "In every case where a certificate is required in respect of a cotton mark, or in respect of any trade mark of which the representations or specimens forming part of the application for registration are *coloured*, or in respect of an application made, or in respect of an application refused, two unmounted copies of the mark must be supplied, agreeing *in every respect* with the representations forming part of the application for registration. Special attention should be paid to this requirement, as the certificate cannot in any such case be prepared until these unmounted copies are received by the comptroller."



*Service.*—By s. 97, sub-ss.

“(1) Any application, notice, or other document authorised or required to be left, made or given at the Patent Office or to the comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made, or given respectively, at the time when the letter containing the same would be delivered in the ordinary course of post.

“(2) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.”

Patents Rule 16A, Designs 11 (p. 188), Trade Marks 16 (p. 225), are made under this section, and are in the same words. Letters, etc., for the comptroller should be addressed, “The Patent Office, 25 Southampton Buildings, Chancery Lane, W.C.” See “Enlargement of Time,” p. 293.

*Excluded Days.*—By s. 98, “Whenever the last day fixed by this Act, or by any Rule for the time being in force, for leaving any document or paying any fee at the Patent Office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days if two or more of them occur consecutively.”

*Incapacity.*—By s. 99, “If any person is, by reason of infancy, lunacy, or other inability, incapable of making any declaration, or doing anything required or permitted by this Act, or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed



by any court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted."

By s. 100, the Patent Office are to supply copies of accepted specifications, etc., to the Edinburgh Museum of Science and Art, the Enrolments Office of the Chancery Division in Ireland, and the Rolls Office in the Isle of Man within twenty-one days of the acceptance.

Under s. 102, the comptroller publishes an annual report including all general rules made in the year, a classification of the applications, an account of fees, etc.

*Board of Trade.*—By s. 102A, sub-ss.

"(1) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the president or a secretary or an assistant-secretary of the Board.

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

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

*Dispensing with Evidence.*—By Patents Rules 80, Designs 29, Trade Marks 53, “Where, under these Rules, any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the comptroller, or at the Patent Office, and it is shown to the satisfaction of the comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the comptroller, with the sanction of the Board of Trade, and upon the production of such other evidence, and subject to such terms as they may think fit, to dispense with any such act or thing, document, declaration or evidence.”

*Enlargement of Time.*—By Patents Rules 51 and Trade Marks 55, “The time prescribed by these Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the comptroller, if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.”

Designs Rule 31 is similar.

*Inspection of Registers.*—By Patents Rules 78, Trade Marks 52, “The Register of Trade Marks shall be open to the inspection of the public, on payment of the prescribed fee, on every week-day, between the hours of ten and four, except on the days and at the times following:—

“(a) Christmas Day, Good Friday, the day observed as Her Majesty’s birthday, days observed as days of public fast or thanksgiving, and days observed as holidays at the Bank of England; or

“(b) Days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office;

“(c) Times when the register is required for any purpose of official use.”

*Declarations.*—By Patents Rules 11, Trade Marks 61, “The statutory declarations required by the Acts and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows:—

“(a) In the United Kingdom, before any justice of the peace, or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding;

“(b) In any other part of Her Majesty’s dominions, before any court, judge, justice of the peace, or any officer authorised by law to administer an oath there for the purpose of a legal proceeding; and

“(c) If made out of Her Majesty’s dominions, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice-Consul, or other person exercising the functions of a British Consul, or a notary-public, or before a judge or magistrate.”

By Patents Rule 17 (A), “Statutory declarations and affidavits shall be headed in the matter or matters to which they relate. They shall be divided into paragraphs consecutively numbered, and each paragraph shall, so far as possible, be confined to one subject.”

By Trade Marks Rule 62, “Any document purporting to have affixed, impressed or subscribed thereto or thereon the seal or signature of any person hereby authorised to take such declaration in testimony of such declaration having been made or subscribed before him, may be admitted by the comptroller without proof of the genuineness of any such seal or signature, or of the official character of such person or his authority to take such declaration.”

By s. 107, the provisions with respect to the aid of



an assessor and trial without a jury are applied to Scotland.

By s. 108, summary proceedings in Scotland may be prosecuted in the Sheriff's Court.

S. 112 preserves the jurisdiction of the Manx Courts, and makes the maximum punishment for a misdemeanour in the Isle of Man imprisonment with hard labour for two years, with a fine of £100.

By s. 112*a*, the Court of Chancery of the County Palatine of Lancaster is given jurisdiction "with respect to any action or other proceeding in relation to *trade marks*, the registration whereof is applied for in the Manchester office." Except in this case there is no jurisdiction to try an action in the Court of the County Palatine—*Proctor v. Sutton Lodge, etc., Co.* (1888), 5 R. P. C., 184, nor in a County Court—*Reg. v. Judge of Halifax, etc.* (1891), 2 Q. B., 263.

*Offences.*—By s. 93, "If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanour."

S. 105, sub-ss.

"(1) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding £5.

"(2) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade mark is registered, if he sells the article



with the word 'patent,' 'patented,' 'registered,' or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved or impressed on, or otherwise applied to, the article.

"S. 106. Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any Government Department, assumes or uses in connection with any trade, business, calling, or profession, the Royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding £20."

And see the Merchandise Marks Act 1887, in Appendix.

A person who has applied for a patent is liable to be fined if he sells an article as patented before the patent is granted—*Reg. v. Wallis* (1886), 3 R. P. C., 1; *Reg. v. Crampton* (1886), 3 R. P. C., 367.

## CHAPTER II

### INTERNATIONAL AND COLONIAL ARRANGEMENTS

THE Act of 1883, as amended by that of 1885, enacts as follows :—

“S. 103 (1) If Her Majesty is pleased to make any arrangement with the Government or Governments of any foreign State or States for mutual protection of inventions designs, and trade marks, or any of them, then any person who has applied for protection for any invention, design, or trade mark in any such State, shall be entitled to a patent for his invention or to registration of his design or trade mark (as the case may be) under this Act, in priority to other applicants ; and such patent or registration shall have the same date as the date of the application in such foreign State.

“Provided that his application is made, in the case of a patent within seven months, and in the case of a design or trade mark within four months, from his applying for protection in the foreign State with which the arrangement is in force.

“Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade mark in this country, as the case may be.

“(2) The publication in the United Kingdom or the Isle of Man during the respective periods aforesaid of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade mark.

“(3) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act: Provided that, in the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under this Act.

“(4) The provisions of this section shall apply only in the case of those foreign States with respect to which Her Majesty shall, from time to time by Order in Council, declare them to be applicable, and so long only in the case of each State as the Order in Council shall continue in force with respect to that State.”

“S. 104 (1) Where it is made to appear to Her Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for Her Majesty from time to time, by Order in Council, to apply the provisions of the last preceding section, with such variations or additions, if any, as to Her Majesty in Council may seem fit, to such British possession.

“(2) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the order, take

effect as if its provisions had been contained in this Act; but it shall be lawful for Her Majesty in Council to revoke any Order in Council made under this Act."

The International Convention for the Protection of Industrial Property was signed in Paris on the 20th of March 1883, and was assented to by the Government of Great Britain on the 17th of March 1884.

The above s. 103, by limiting the time within which the foreign monopolies may be registered in England, excluded a large number from protection (see *In re Californian Fig Syrup Co.'s Trade Mark* (1888), 40 Ch. D., 620) in consequence of the delay which took place before the accession of Great Britain. In other respects the Act carries out the terms of the Convention.

A foreign patentee has two rights: either that under s. 103, in which case his patent will be dated as on the day of the foreign application; or as an importer under the general law. In the latter case he risks prior publication in this country, and s. 103, sub-s. 2, does not protect him. The date of his English patent will be conclusive as to which right he has adopted—*British Tanning Co. v. Groth* (1891), 8 R. P. C., 113.

*Date.*—The date of the renewed application abroad (if any), and not of the original, is the proper date for the English patent—*Van de Poele's P.* (1890), 7 R. P. C., 69.

Applicant is entitled to have his patent dated as on the day of the foreign application, although his country had not then acceded to the Convention—*Main's P.* (1890), 7 R. P. C., 13.

It should be noticed that the foreign patentee is the only person who can apply under s. 103 for a patent in Great Britain. He cannot part with the right to another. A corporation may apply, see *Carez' Appln.* (1889), 6 R. P. C., 552. See "Importation," pp. 96, 221.



The following are the Rules referring to applications under ss. 103, 104.

“ 24. The term ‘foreign application’ shall mean an application by any person for protection of his invention in a foreign State or British possession to which, by any Order of Her Majesty in Council for the time being in force, the provisions of s. 103 of the Patents, Designs, and Trade Marks Act 1883 have been declared applicable.

“ 25. An application in the United Kingdom for a patent for any invention in respect of which a foreign application has been made shall contain a declaration that such foreign application has been made and shall specify all the foreign States or British possessions in which foreign applications have been made and the official date or dates thereof respectively. The application must be made within seven months from the date of the first foreign application, and must be signed by the person or persons by whom such first foreign application was made. If such person, or any of such persons, be dead, the application must be signed by the legal personal representative of such dead person, as well as by the other applicants, if any.

“ 26. The application in the United Kingdom shall be made in the Form A<sup>2</sup> in the second schedule to these Rules,<sup>1</sup> and in addition to the specification, provisional or complete, left with such application must be accompanied by :—

“ (1) A copy or copies of the specification, and drawings or documents corresponding thereto, filed or deposited by the applicant in the Patent Office of the foreign State or British possession in respect of the first foreign application duly certified by the official chief or head of the Patent Office of such foreign State or British Possessions

<sup>1</sup> See p. 157.

as aforesaid, or otherwise verified to the satisfaction of the comptroller.

“(2) A statutory declaration as to the identity of the invention in respect of which the application is made with the invention in respect of which the said first foreign application was made; and if the specification or document corresponding thereto be in a foreign language, a translation thereof shall be annexed to and verified by such statutory declaration.

“27. On receipt of such application, together with the prescribed specification and the other document or documents accompanying the same, required by the last preceding Rule, and with such other proof (if any) as the comptroller may require of or relating to such foreign application, or of the official date thereof, the comptroller shall make an entry of the applications in both countries and of the official dates of such applications respectively.

“28. All further proceedings in connection with such application shall be taken within the times, and in the manner prescribed by the Acts or Rules for ordinary applications.

“29. The patent shall be entered in the Register of Patents as dated of the date on which the first foreign application was made, and the payment of renewal fees, and the expiration of the patent, shall be reckoned as from the date of the first foreign application.

“S. 117 contains *inter alia* the following definitions:—

“‘British possession’ means any territory or place situate within Her Majesty’s dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man; and all territories and places under one legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act.

“‘Legislature’ includes any person or persons who

exercise legislative authority in the British possession ; and where there are local legislatures as well as a central legislature, means the central legislature only."

The author is indebted to Mr. Alexander Pulling of the Inner Temple for the following list of arrangements and Orders in Council made under s. 103 :—

(a) COLONIAL ARRANGEMENTS

- 1885, Sept. 17.—O. in C. applying the provisions of 46 and 47 Vict., c. 57, s. 103, to Queensland *Lond. Gaz.* Sept. 22, 1885, p. 4429.  
1890, Feb. 8.—O. in C. applying the provisions of 46 and 47 Vict., c. 57, s. 103, to New Zealand *Lond. Gaz.* Feb. 11, 1890, p. 727.

(b) INTERNATIONAL ARRANGEMENTS

The following is a List of the O. in C. issued under these powers and now (Nov. 1, 1890) in force applying the provisions of 46 and 47 Vict., c. 57, s. 103, to foreign States :—

Foreign State	Date of O. in C.	Reference to <i>Lond. Gaz.</i> in which O. in C. is published				Reference to Herts. Treaties where O. in C. is published	
		Month	Day of the Month	Year	Page	Vol.	Page
Belgium . . . . .	June 26, 1884	July	1	1884	2993	17	504
Brazil . . . . .	June 26, 1884	July	1	1884	2993	17	504
Dominican Republic .	Oct. 21, 1890	Oct.	28	1890	5661	—	—
France . . . . .	June 26, 1884	July	1	1884	2993	17	504
Guatemala . . . . .	June 26, 1884	July	1	1884	2993	17	504
Italy . . . . .	June 26, 1884	July	1	1884	2993	17	504
Mexico . . . . .	May 28, 1889	May	31	1889	2954	—	—
Netherlands . . . . .	June 26, 1884	July	1	1884	2993	17	504
Netherlands, East Indian Colonies . . .	Nov. 17, 1888	Nov.	23	1888	6412	—	—
Netherlands (Curacoa, Surinam, etc.) . . . .	May 17, 1890	May	20	1890	2891	—	—
Paraguay . . . . .	Sept. 24, 1886	Sept.	28	1886	4725	17	859
Portugal . . . . .	June 26, 1884	July	1	1884	2993	17	504
Servia . . . . .	June 26, 1884	July	1	1884	2993	17	504
Spain . . . . .	June 26, 1884	July	1	1884	2993	17	504
Sweden and Norway . .	July 9, 1885	July	—	1885	3173	17	108
Switzerland . . . . .	June 26, 1884	July	1	1884	2993	17	504
Tunis . . . . .	June 26, 1884	July	1	1884	2993	17	504
United States . . . . .	July 12, 1887	July	15	1887	3827	17	1071
Uruguay . . . . .	Sept. 24, 1886	Sept.	28	1886	4725	17	859



## (c) PLACES UNDER BRITISH JURISDICTION

- (i.) *Africa*. 1889, Oct. 15.—O. in C. (Art. 55) imposing penalties on British subjects committing offences in Madagascar and certain parts of Africa against the Patents, etc., Acts, 1883-1888, and the O. in C. issued thereunder *Lond. Gaz.* Oct. 22, 1889, p. 5557.
- (ii.) *Morocco*. 1889, Nov. 28.—O. in C. (Art. 112), imposing penalties on British subjects committing offences in Morocco against the Patents, etc., Acts, 1883-1888, and the O. in C. issued thereunder *Lond. Gaz.* Dec. 13, 1889, p. 7163.
- (iii.) *Persia*. 1889, Dec. 13.—O. in C. (Art. 292) imposing penalties on British subjects committing offences in Persia against the Patents, etc., Acts, 1883-1888, and the O. in C. issued thereunder *Lond. Gaz.* Dec. 24, 1889, p. 7417.
- (iv.) *Persian Coast*. 1889, Dec. 13.—O. in C. (Art. 50) imposing penalties on British subjects committing offences within the Persian Coast and islands against the Patents, etc., Acts, 1883-1888, and the O. in C. issued thereunder *Lond. Gaz.* Dec. 24, 1889, p. 7459.
- (v.) *Somali Coast*. 1889, Dec. 13.—O. in C. (Art. 4) imposing penalties on British subjects committing offences on the Somali Coast against the Patents Acts, 1883-1888, and the O. in C. issued thereunder *Lond. Gaz.* Dec. 24, 1889, p. 7467.

*N.B.*—It is doubtful whether the Orders in Council, which apply to “places under British Jurisdiction,” are valid, as there seems no power to make them either under this Act or the Foreign Jurisdiction Acts. The power seems to have been assumed under s. 2 of the Act of last session, 53 and 54 Vict., c. 37.

The eighth report of the Comptroller-General (c. 6359) states that—

“A Conference of Delegates from States forming the Union was held in Madrid in the month of April, upon which occasion draft projects were agreed to relating— (1) to the repression of false indications of origin; (2) to the establishment of an international register of trade marks; and (3) to the interpretation to be placed upon certain Articles of the International Convention of 1883.

“These projects were subsequently submitted for the consideration of the Governments of the respective States.”



PART VI

—G—

*TRADE NAME*

*TRADE SECRETS*

## CHAPTER I

### TRADE NAME

No man may sell his goods as the goods of another, or another's goods as his own; but, subject to qualifications mentioned below, there is no law to prevent a man trading in his own or an assumed name next door to the establishment of another trader who deals in the same class of goods. See the Merchandise Marks Act 1887, Appendix.

But where a trader has acquired a reputation—see *Goodfellow v. Prince* (1887), 35 Ch. D., 9—for his goods, in connection with his name or firm name, other considerations apply—*Jay v. Ladler* (1888), 40 Ch. D., 649. Then, if a man without leave sells similar goods in such a way as to induce reasonable people to believe that his goods are manufactured by the established trader, or that he is his successor in business, or that his is the only genuine article, or that the articles made by the other firm are spurious, he is liable to an injunction. Such a sale is fraudulent.

A wholesale vendor cannot escape from an injunction by showing that he cautioned his shop assistants and agents to say that the goods sold by him are not those of the plaintiff, for the retail dealers would sell to the public without any such qualification.—*Chappell v. Davidson*

(1855), 2 K. and J., 123. In each case evidence must be produced from which the fraudulent intent may be inferred, *e.g.* the assumption of a name the same as or similar to that of the established trader, the trading in the same neighbourhood, the advertising of the goods, the colour, design, and shape of packages.

In *Thomas Turton & Sons v. Turton* (1889), 42 Ch. D., 128, Thomas Turton & Sons sought to prevent the defendants from trading as John Turton & Sons. It was proved that the defendant's firm did in fact consist of John Turton and his two sons, and no allegation of fraudulent use of the name was made. Lord Esher, M.R., said: "It is perfectly clear that if all that a man does is to carry on the same business, and to state how he is carrying it on, that statement being the simple truth, and he does nothing more with regard to the respective names, he is doing no wrong."

In the case of an assumed name, the very assumption of a name likely to be confused with the plaintiff's is good evidence of fraud; and it is not in a strong case necessary to wait and see if the assumption of the name does in fact injure the plaintiff's; for, if the Court can see from the nature of the case that injury is probable, an injunction will be granted, but not damages, unless injury is proved to have actually occurred. If the defendant continues the offending name or mark after being warned of the similarity, this would be strong evidence of fraud.

It often happens that goods have a distinctive name attached to them other than the name of the manufacturing firm, by which the public know by whom they are manufactured or sold. In this case the man whose goods have so acquired a reputation, in connection with the distinctive trade name attached to them, has a right to protect himself from the fraudulent appropriation of that trade name by

another trader in the same or similar class of goods. See *Goodfellow v. Prince* (1887), 35 Ch. D., 9. But mere similarity of name is not sufficient ground for an injunction, unless damage to the plaintiff be clearly proved, or the name is so closely similar as to be a colourable imitation of the plaintiff's—*Borthwick v. The Evening Post*, 37 Ch. D., 449.

The trade name must be proved to have been used in connection with the business and with the goods. Where the name to be protected is used in connection with special goods, proof should be adduced that it was affixed to the goods, or at least impressed on the wrappers or labels of the goods. Even a geographical name, e.g. "Stone" ale, used for ale manufactured by the plaintiff at Stone, will be protected from a similar name, adopted by the defendant, a new brewer at the same place—*Joule's T. M., Thompson v. Montgomery* (1891), A. C., 217.

But where this trade name is merely descriptive of the article, whether originally a descriptive name or not, and does not designate manufacture by any particular firm, it cannot longer be exclusively retained by the original maker, but may be adopted by any other trader. See, *inter alia*, *Native Guano Co. v. Sewage Manure Co.* (1887), 4 R. P. C., 473.

*Lever v. Goodwin* (1887), 4 R. P. C., 492, is instructive in showing that a defendant adopting the trade name and imitating the "get up" of the plaintiff's goods, may be liable on the ground of fraud, though the plaintiff has no exclusive right to the name. See, too, *Great Tower, etc., Co. v. Langford* (1888), 5 R. P. C., 66; and *Hart v. Colley* (1890), 7 R. P. C., 93.

The name of a place of business may denote that it belongs to the plaintiff, and, if so, will be protected. Of



course, evidence of reputation must be given to show the connection in the mind of the public between the name and the plaintiff—*Bodega Co. v. Owens* (1890), 7 R. P. C., 31.

A manufacturer living outside the jurisdiction of English municipal law may protect his trade name from fraud committed in England—*Somerville v. Schembri* (1887), 12 App. Cas., 453.

On the sale of the goodwill of a business, the right to use the trade name attached to the class of goods sold passes to the purchaser in the absence of special agreement; and it seems that the right to use the firm name passes also, subject to this reservation, that the purchaser must not lead the public to believe that the vendor is still carrying on the business. It must be remembered that goodwill can only be assigned in connection with a place of business—*Levy v. Walker* (1879), 10 Ch. D., 436.

In *Thynne v. Shore* (1890), 45 Ch. D., 577, Stirling (J.) decided that the purchaser can use the seller's name only "so long and so far as he does not, by so doing, expose him to any liability, but no further."

On the other hand, the vendor, in the absence of special agreement, has the right of setting up a similar business in the same neighbourhood, and may solicit old customers, but may not hold himself out as continuing the business which he has sold. Of course, he may not use the trade names with which he has parted—*Vernon v. Hallam* (1886), 34 Ch. D., 748.

A man may advertise the fact that he has been in the employ of a certain firm, but he has no right to induce the public to believe that he is carrying on the business of that firm, or is conducting a branch of it, if such is not the fact. Nor, it seems, may he advertise that he has been a manager when he has held only a subordinate

position. See *Boswell v. Mathie* (1884), Dec. Ct. Ses., 4th Ser., xi. p. 1072.

The Court will not protect from mere inconvenience, where there is no attempt to interfere with trade, and no legal injury done. Messrs. Street & Co. were unable to get an injunction against the Union Bank of Spain and England for using as a telegraphic address, "Street, London," they not representing themselves to be Street and Co., or carrying on the same or any business that could interfere with the plaintiff's trade. It is like the case of several people being called by the same name—*Street v. Union Bank* (1885), 30 Ch. D., 156.

It was apparently held in *Bass v. Laidlaw* (1886), Dec. Ct. Ses., 4th Ser., xiii. p. 898, that "Bass" was so much a synonym for ale, that the keeper of railway refreshment rooms, doing a quick trade, would not be liable to an interdict for supplying other ale when "Bass" was demanded. And in another public-house case—*Thomson & Co. v. Robertson* (1888), Dec. Ct. Ses., 4th Ser., p. 880—where other Irish whisky had been served when the plaintiff's was asked for, Lord Young said: "A case of this kind is not to be established by evidence of a few petty instances of the wrong use of a dealer's name, but upon proof of a continued and systematic course of fraudulent representation and dealing."

*N.B.*—Trade marks, which cannot be registered as not fulfilling the conditions of s. 64, may be protected on the same ground as trade name.

By the Companies' Act 1862 (25 and 26 Vict., c. 89), s. 20, it is enacted that "No company shall be registered under a name identical with that by which a subsisting company is already registered, or so nearly resembling the same as to be calculated to deceive, except in a case where such subsisting company is in the course of being

dissolved, and testifies its consent in such manner as the registrar requires." Power is given to a company to change its name, if inadvertently registered.

The most recent case under this section was one in which the proprietors of Madame Tussaud's Waxwork Exhibition were plaintiffs, they trading as a company under the name of "Madame Tussaud & Sons, Limited." Louis Tussaud and his friends promoted a company which they proposed to register as "Louis Tussaud, Limited," for the purpose of starting and carrying on a business similar to that of the plaintiff company. An injunction was granted. It seems, however, that if Louis Tussaud had actually traded under his own name, and transferred his business to the company, the Court would not have interfered—*Tussaud v. Tussaud* (1890), 44 Ch. D., 678. A name, apart from a business, is not saleable. See *Melachrino & Co. v. Melachrino Cigarette Co.* (1887), 4 R. P. C., 215.

## CHAPTER II

### TRADE SECRETS

THERE are some manufactures that are better protected by their processes being kept secret than by being the subject of a patent. Thus quack medicines, cordials, special concocted beverages, etc., usually bring profit to their owner by secrecy of their composition. It is probable that in most cases no patent could be obtained for them.

A trade secret is protected by the injunction of the Court of Chancery whenever a person, in breach of contract or of confidence, threatens to disclose the secret, or to utilise the knowledge of it for his own advantage, by manufacturing the article. Thus an employé who surreptitiously obtained a recipe, as in *Yovatt v. Winyard* (1820), 1 J. & W., 394; a partner and his innocent assignee for value, as in *Morison v. Moat* (1851), 9 Hare, 241, have been restrained. And in *Green v. Foljam* (1823), 1 S. & S., 398, one of several beneficiaries under a will was ordered to account for profits made through breach of confidence towards the other beneficiaries. It should be remembered that anyone may discover a trade secret, and use it to his own advantage, so that it be done honestly, *i.e.* not in breach of confidence or contract, expressed or implied. Not even a partner or ex-partner can be



restrained in the absence of these essentials; and the existence of the partnership is no ground for implying a contract of secrecy, at any rate after its dissolution—*Morison v. Moat (supra)*.

But a person becoming innocently possessed of a trade secret must not use means to induce the public to believe that his production is made by the inventor, or that it is the only genuine article, or that he is the successor in business of the inventor. Similarity in name, in advertisements, in packages, etc., are all to be taken into consideration in determining whether the law has been broken by the newer trader. See *Massam v. Thorley's Cattle Food Co.* (1880), 14 Ch. D., 748.

As to "patent medicines," see p. 84.

PART VII

—o—

*APPENDIX*

## PATENT FORMS

THE following information is circulated by the Patent Office :—

Forms A, A1, A2, B, and C are not supplied by the Patent Office, but may be obtained at a few days' notice, through any Money Order Office in the United Kingdom, upon prepayment of the value of the stamp. Forms A, B, and C are kept on sale at the under-mentioned places :—

The Inland Revenue Office, Royal Courts of Justice (Room No. 6).

The following Post Offices.

London General Post Office, E.C.

District Post Office, 226 Commercial Road, E.

” ” 9 Blackman Street, Borough, S.E.

” ” Charing Cross, W.C.

” ” Lombard Street, E.C.

” ” 28 Eversholt St., Camden Town, N.W.

Post Office, 12 Parliament Street, S.W.

ENGLAND AND WALES	Bolton. Bradford. Brighton. Bristol. Bromsgrove. Burnley. Burslem. Burton-on-Trent. Bury. Cambridge. Cardiff. Carlisle. Chatham. Chester.	Clitheroe. Congleton. Coventry. Crewe. Croydon. Darlaston. Derby. Dewsbury. Doncaster. Dorchester. Driffield. Droitwich. Dudley. Durham.
Accrington.		
Altrincham.		
Ashton-under-Lyne.		
Barnsley.		
Barrow-in-Furness.		
Bath.		
Bedford.		
Beverley.		
Birkenhead.		
Birmingham.		
Blackburn.		

Exeter.  
 Gateshead.  
 Goole.  
 Greenwich.  
 Guildford.  
 Halifax.  
 Hartlepool.  
 Huddersfield.  
 Hull.  
 Ipswich.  
 Keighley.  
 Kendal.  
 Kidderminster.  
 Knaresbro'.  
 Knutsford.  
 Lancaster.  
 Leamington.  
 Leeds.  
 Leicester.  
 Lichfield.  
 Lincoln.  
 Liverpool.  
 Macclesfield.  
 Manchester.  
 Middlesborough.  
 Nantwich.  
 Newcastle.  
 Newport (Mon.).  
 Northallerton.  
 Northampton.  
 Nottingham.  
 Nuneaton.  
 Oldbury.  
 Oldham.  
 Patrington.

Plymouth.  
 Pontefract.  
 Portsmouth.  
 Prescot.  
 Preston.  
 Reading.  
 Redditch.  
 Richmond (Yorks).  
 Ripon.  
 Rochdale.  
 Rotherham.  
 Rugby.  
 Salford.  
 St. Helens.  
 Scarborough.  
 Sedgeley.  
 Sheffield.  
 Southampton.  
 Stafford.  
 Stalybridge.  
 Stockport.  
 Stoke-on-Trent.  
 Stourbridge.  
 Stourport.  
 Sunderland.  
 Swansea.  
 Tamworth.  
 Truro.  
 Tunstall.  
 Wakefield.  
 Walsall.  
 Warrington.  
 Wednesbury.  
 West Bromwich.  
 Whitby.

Widnes.  
 Wigan.  
 Wolverhampton.  
 Wolverton.  
 Woolwich.  
 Worcester.  
 York.

## SCOTLAND

Aberdeen.  
 Dumbarton.  
 Dundee.  
 Edinburgh.  
 Glasgow.  
 Greenock.  
 Inverness.  
 Lanark.  
 Leith.  
 Paisley.  
 Perth.  
 Renfrew.

## IRELAND

Belfast.  
 Cork.  
 Dublin.  
 Dundalk.  
 Galway.  
 Limerick.  
 Londonderry.  
 Waterford.  
 Wexford.



In addition to Forms A, A1, B and C, the following Patent Forms can be purchased at the Inland Revenue Office, Royal Courts of Justice (Room No. 6), or they can be obtained at a few days' notice through any Money Order Office in the United Kingdom upon prepayment of the value of the stamp (pp. 151-152):—

D, E, F, G, H, I, J, K, L, M, N, O, P, Q, R, S, T, U, V.

These Forms are set out on pp. 153-170.

### TRADE MARK AND DESIGNS FORMS,

ready stamped, can be obtained at the same offices as patent forms, with the exception of Worcester.

*NOTE.—Arrangements have also been made by which any of the Forms required may be ordered at any Money Order Office in the United Kingdom not included in the above list.*

The following is a list of the stamped Forms under the Patents, Designs, and Trade Marks Acts, 1883-1888, which relate to trade marks and designs:—

**TRADE MARKS:** Forms E, F, G, H, I, J, K, L, M, N, O, Q, R, S, T, T<sup>1</sup>, V, W, X, Y, Z.

Of the above Forms, those bearing the letters F, G, I, X, Y, and Z are kept in stock at the various offices named above. Any of the others when required must be bespoke. These Forms are set out on pp. 264-280; the Fees on p. 262.

**DESIGNS:** Forms E, E, F, H, I, K, K, L, M, N, O.

*N.B.—*Forms E and O are kept on sale at the places above. The other Forms must be bespoke of the postmasters at those places. These Forms are set out on pp. 202-208; the Fees on p. 201.

## MERCHANDISE MARKS ACT 1887

## CHAPTER 28

*An Act to consolidate and amend the Law relating to Fraudulent Marks on Merchandise [23rd August 1887]*

(N.B.—Immaterial sections are omitted)

Short title. 1. This Act may be cited as the Merchandise Marks Act, 1887.

Offences as to trade marks and trade descriptions.

2.<sup>1</sup> (2) Every person who—  
 (a) forges any trade mark ; or  
 (b) falsely applies to goods any trade mark or any mark so nearly resembling a trade mark as to be calculated to deceive ; or  
 (c) makes any die, block, machine, or other instrument for the purpose of forging, or of being used for forging, a trade mark ; or  
 (d) applies any false trade description to goods ; or  
 (e) disposes of or has in his possession any die, block, machine, or other instrument for the purpose of forging a trade mark ; or  
 (f) causes any of the things above in this section mentioned to be done ;—  
 shall, subject to the provisions of this Act, and unless he proves that he acted without intent to defraud, be guilty of an offence against this Act.

(3) Every person who sells, or exposes for, or has in

<sup>1</sup> Under this section it was held, in *Starey v. Chilworth Gunpowder Co.* (1889), 24 Q. B. D., 90, that the defendants were liable to conviction for having supplied the Government with German powder instead of powder of their own manufacture, and in spite of the substituted powder being of as good quality. The offence consists in supplying an article of different description (d) from that ordered. In *Wood v. Burgess* (1889), 24 Q. B. D., 162, the same point was raised, and it was decided that the defendant could not be held to have "acted innocently" in sending out for sale his own mineral waters in bottles which were the property of and moulded with the name of Wood, although he did not in fact intend to defraud.

his possession for, sale, or any purpose of trade or manufacture, any goods or things to which any forged trade mark or false trade description is applied, or to which any trade mark or mark so nearly resembling a trade mark as to be calculated to deceive is falsely applied, as the case may be, shall, unless he proves—

(a) That having taken all reasonable precautions against committing an offence against this Act, he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the trade mark, mark, or trade description; and

(b) That on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons from whom he obtained such goods or things; or

(c) That otherwise he had acted innocently;—  
be guilty of an offence against this Act.

(3) Every person guilty of an offence against this Act shall be liable—

(i) on conviction on indictment, to imprisonment, with or without hard labour, for a term not exceeding two years, or to fine, or to both imprisonment and fine; and

(ii) on summary conviction to imprisonment, with or without hard labour, for a term not exceeding four months, or to a fine not exceeding £20; and in the case of a second or subsequent conviction to imprisonment, with or without hard labour, for a term not exceeding six months, or to a fine not exceeding £50; and

(iii) in any case, to forfeit to Her Majesty every chattel, article, instrument, or thing by means of or in relation to which the offence has been committed.

(4) The Court before whom any person is convicted under this section may order any forfeited articles to be destroyed or otherwise disposed of as the Court thinks fit.

(5) If any person feels aggrieved by any conviction made by a Court of summary jurisdiction, he may appeal therefrom to a Court of quarter sessions.

(6) Any offence for which a person is under this Act liable to punishment on summary conviction may be prosecuted, and any articles liable to be forfeited under this Act by a Court of summary jurisdiction may be forfeited,



42 and 43  
Vict., c. 40.

in manner provided by the Summary Jurisdiction Acts :  
Provided that a person charged with an offence under this section before a Court of summary jurisdiction shall, on appearing before the Court, and before the charge is gone into, be informed of his right to be tried on indictment, and if he requires be so tried accordingly.

Definitions.  
46 and 47  
Vict., c. 57.

3. (1) For the purposes of this Act—

The expression “trade mark” means a trade mark registered in the Register of Trade Marks kept under the Patents, Designs, and Trade Marks Act 1883, and includes any trade mark which, either with or without registration, is protected by law in any British possession or foreign State to which the provisions of the 103rd section of the Patents, Designs, and Trade Marks Act 1883 are, under Order in Council, for the time being applicable :

The expression “trade description” means any description, statement, or other indication, direct or indirect,—

(a) as to the number, quantity, measure, gauge, or weight of any goods ; or

(b) as to the place or country in which any goods were made or produced ; or

(c) as to the mode of manufacturing or producing any goods ; or

(d) as to the material of which any goods are composed ; or

(e) as to any goods being the subject of an existing patent, privilege, or copyright ;—

and the use of any figure, word, or mark which, according to the custom of the trade, is commonly taken to be an indication of any of the above matters, shall be deemed to be a trade description within the meaning of this Act :

The expression “false trade description” means a trade description which is false in a material respect as regards the goods to which it is applied, and includes every alteration of a trade description, whether by way of addition, effacement, or otherwise, where that alteration makes the description false in a material respect ; and the fact that a trade description is a trade mark, or part of a trade mark, shall not prevent such trade description being a false trade description within the meaning of this Act :



The expression "goods" means anything which is the subject of trade, manufacture, or merchandise :

The expressions "person," "manufacturer, dealer, or trader," and "proprietor," include any body of persons, corporate or unincorporate :

The expression "name" includes any abbreviation of a name.

(2) The provisions of this Act respecting the application of a false trade description to goods shall extend to the application to goods of any such figures, words, or marks, or arrangement or combination thereof, whether including a trade mark or not, as are reasonably calculated to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are.

(3) The provisions of this Act respecting the application of a false trade description to goods, or respecting goods to which a false trade description is applied, shall extend to the application to goods of any false name or initials of a person, and to goods with the false name or initials of a person applied, in like manner as if such name or initials were a trade description ; and, for the purpose of this enactment, the expression false name or initials means, as applied to any goods, any name or initials of a person which,—

(a) are not a trade mark, or part of a trade mark ; and

(b) are identical with, or a colourable imitation of the name or initials of a person carrying on business in connection with goods of the same description, and not having authorised the use of such name or initials ; and

(c) are either those of a fictitious person or of some person not *bonâ fide* carrying on business in connection with such goods.

4. A person shall be deemed to forge a trade mark who either—

Forging  
trade mark.

(a) without the assent of the proprietor of the trade mark, makes that trade mark, or a mark so nearly resembling that trade mark as to be calculated to deceive ; or

(b) falsifies any genuine trade mark, whether by alteration, addition, effacement, or otherwise ;—  
and any trade mark or mark so made or falsified is in this Act referred to as a forged trade mark.

Provided that in any prosecution for forging a trade mark the burden of proving the assent of the proprietor shall lie on the defendant.

Applying  
marks and  
descriptions.

5. (1) A person shall be deemed to apply a trade mark or mark or trade description to goods who—

(a) applies it to the goods themselves ; or

(b) applies it to any covering, label, reel, or other thing in or with which the goods are sold or exposed or had in possession for any purpose of sale, trade, or manufacture ; or

(c) places, encloses, or annexes any goods which are sold or exposed or had in possession for any purpose of sale, trade, or manufacture, in, with, or to any covering, label, reel, or other thing to which a trade mark or trade description has been applied ; or

(d) uses a trade mark or mark or trade description in any manner calculated to lead to the belief that the goods in connection with which it is used are designated or described by that trade mark or mark or trade description.

(2) The expression “covering” includes any stopper, cask, bottle, vessel, box, cover, capsule, case, frame, or wrapper ; and the expression “label” includes any band or ticket.

A trade mark, or mark, or trade description, shall be deemed to be applied whether it is woven, impressed, or otherwise worked into, or annexed, or fixed to the goods, or to any covering, label, reel, or other thing.

(3) A person shall be deemed to falsely apply to goods a trade mark or mark, who, without the assent of the proprietor of a trade mark, applies such trade mark, or a mark so nearly resembling it as to be calculated to deceive ; but in any prosecution for falsely applying a trade mark or mark to goods, the burden of proving the assent of the proprietor shall lie on the defendant.

6. Where a defendant is charged with making any die, block, machine, or other instrument for the purpose of forging, or being used for forging, a trade mark, or with falsely applying to goods any trade mark, or any mark so nearly resembling a trade mark as to be calculated to deceive, or with applying to goods any false trade description, or causing any of the things in this section mentioned to be done, and proves,—

Exemption of certain persons employed in ordinary course of business.

(a) That in the ordinary course of his business he is employed, on behalf of other persons, to make dies, blocks, machines, or other instruments for making, or being used in making, trade marks, or as the case may be to apply marks or descriptions to goods, and that in the case which is the subject of the charge he was so employed by some person resident in the United Kingdom, and was not interested in the goods by way of profit or commission dependent on the sale of such goods; and

(b) That he took reasonable precautions against committing the offence charged; and

(c) That he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the trade mark, mark, or trade description; and

(d) That he gave to the prosecutor all the information in his power with respect to the persons on whose behalf the trade mark, mark, or description was applied;—  
he shall be discharged from the prosecution, but shall be liable to pay the costs incurred by the prosecutor, unless he has given due notice to him that he will rely on the above defence.

7. Where a watch case has thereon any words or marks which constitute, or are by common repute considered as constituting, a description of the country in which the watch was made, and the watch bears no description of the country where it was made, those words or marks shall *primâ facie* be deemed to be a description of that country within the meaning of this Act, and the provisions of this Act with respect to goods to which a false trade description has been applied, and with respect to selling or exposing for, or having in possession for sale, or any purpose of trade or manufacture, goods with a

Application of Act to watches.



false trade description, shall apply accordingly, and for the purposes of this section the expression "watch" means all that portion of a watch which is not the watch case.

Mark on  
watch case.

8. (1) Every person who after the date fixed by Order in Council sends or brings a watch case, whether imported or not, to any assay office in the United Kingdom for the purpose of being assayed, stamped, or marked, shall make a declaration declaring in what country or place the case was made. If it appears by such declaration that the watch case was made in some country or place out of the United Kingdom, the assay office shall place on the case such a mark (differing from the mark placed by the office on a watch case made in the United Kingdom), and in such a mode as may be from time to time directed by Order in Council.

(2) The declaration may be made before an officer of an assay office, appointed in that behalf by the office (which officer is hereby authorised to administer such a declaration), or before a justice of the peace, or a commissioner having power to administer oaths in the Supreme Court of Judicature in England or Ireland, or in the Court of Session in Scotland, and shall be in such form as may be from time to time directed by Order in Council.

(3) Every person who makes a false declaration for the purposes of this section shall be liable, on conviction on indictment, to the penalties of perjury, and on summary conviction to a fine not exceeding twenty pounds for each offence.

Trade mark,  
how de-  
scribed in  
pleading.

9. In any indictment, pleading, proceeding, or document, in which any trade mark, or forged trade mark, is intended to be mentioned, it shall be sufficient, without further description and without any copy or facsimile, to state that trade mark, or forged trade mark, to be a trade mark or forged trade mark.

Rules as to  
evidence.

10. In any prosecution for an offence against this Act—  
(1) A defendant, and his wife or her husband, as the case may be, may, if the defendant thinks fit, be called



as a witness, and, if called, shall be sworn and examined, and may be cross-examined and re-examined in like manner as any other witness.

(2) In the case of imported goods, evidence of the port of shipment shall be *prima facie* evidence of the place or country in which the goods were made or produced.

11. Any person who, being within the United Kingdom, procures, counsels, aids, abets, or is accessory to the commission, without the United Kingdom, of any act, which, if committed in the United Kingdom, would under this Act be a misdemeanour, shall be guilty of that misdemeanour as a principal, and be liable to be indicted, proceeded against, tried, and convicted in any country or place in the United Kingdom in which he may be, as if the misdemeanour had been there committed.

Punishment  
of acces-  
sories.

12. (1) Where, upon information of an offence against this Act, a justice has issued either a summons requiring the defendant charged by such information to appear to answer to the same, or a warrant for the arrest of such defendant, and either the said justice, on or after issuing the summons or warrant, or any other justice, is satisfied by information on oath that there is reasonable cause to suspect that any goods or things by means of, or in relation to which such offence has been committed are in any house or premises of the defendant, or otherwise in his possession or under his control in any place, such justice may issue a warrant under his hand, by virtue of which it shall be lawful for any constable named or referred to in the warrant, to enter such house, premises, or place at any reasonable time by day, and to search there for and seize and take away those goods or things; and any goods or things seized under any such warrant shall be brought before a Court of summary jurisdiction for the purpose of its being determined whether the same are or are not liable to forfeiture under this Act.

Search  
warrant.

(2) If the owner of any goods or things which, if the owner thereof had been convicted, would be liable to forfeiture under this Act, is unknown or cannot be found, an information or complaint may be laid for the purpose

only of enforcing such forfeiture, and a Court of summary jurisdiction may cause notice to be advertised stating that, unless cause is shown to the contrary at the time and place named in the notice, such goods or things will be forfeited; and at such time and place the Court, unless the owner or any person on his behalf, or other person interested in the goods or things, shows cause to the contrary, may order such goods or things or any of them to be forfeited.

(3) Any goods or things forfeited under this section, or under any other provision of this Act, may be destroyed or otherwise disposed of, in such manner as the Court by which the same are forfeited may direct; and the Court may, out of any proceeds which may be realised by the disposition of such goods (all trade marks and trade descriptions being first obliterated), award to any innocent party any loss he may have innocently sustained in dealing with such goods.

Extension of  
22 and 23  
Vict., c. 17,  
to offences  
under this  
Act.

13. The Act of the session of the twenty-second and twenty-third years of the reign of Her present Majesty, chapter seventeen, intituled "An Act to prevent vexatious indictments for certain misdemeanours," shall apply to any offence punishable on indictment under this Act, in like manner as if such offence were one of the offences specified in section one of that Act, but this section shall not apply to Scotland.

Costs of de-  
fence or  
prosecution.

14. On any prosecution under this Act the Court may order costs to be paid to the defendant by the prosecutor, or to the prosecutor by the defendant, having regard to the information given by and the conduct of the defendant and prosecutor respectively.

Limitation  
of prosecu-  
tion.

15. No prosecution for an offence against this Act shall be commenced after the expiration of three years next after the commission of the offence, or one year next after the first discovery thereof by the prosecutor, whichever expiration first happens.

Prohibition  
on importa-  
tion.

16. Whereas it is expedient to make further provision for prohibiting the importation of goods which, if sold,

would be liable to forfeiture under this Act; be it therefore enacted as follows:—

(1) All such goods, and also all goods of foreign manufacture bearing any name or trade mark being or purporting to be the name or trade mark of any manufacturer, dealer or trader in the United Kingdom, unless such name or trade mark is accompanied by a definite indication of the country in which the goods were made or produced, are hereby prohibited to be imported into the United Kingdom, and, subject to the provisions of this section, shall be included among goods prohibited to be imported as if they were specified in s. 42<sup>1</sup> of the Customs Consolidation Act 1876.

39 and 40  
Vict., c. 36.

17. On the sale or in the contract for the sale of any goods to which a trade mark or mark, or trade description has been applied, the vendor shall be deemed to warrant that the mark is a genuine trade mark and not forged or falsely applied, or that the trade description is not a false trade description within the meaning of this Act, unless the contrary is expressed in some writing signed by or on behalf of the vendor and delivered at the time of the sale or contract to and accepted by the vendee.

Implied  
warranty  
on sale of  
marked  
goods.

18. Where, at the passing of this Act, a trade description is lawfully and generally applied to goods of a particular class, or manufactured by a particular method, to indicate the particular class or method of manufacture of such goods, the provisions of this Act with respect to false trade descriptions shall not apply to such trade description when so applied: Provided that where such trade descrip-

Provisions  
of Act as  
to false  
description  
not to apply  
in certain  
cases

<sup>1</sup> By this section importation of the following goods is forbidden:—  
“Articles of foreign manufacture, and any packages of such articles bearing any names, brand, or mark, being or purporting to be the name, brand, or mark of manufacturers resident in the United Kingdom, or any name, brand, or mark which states or implies that such articles were manufactured at any place in the United Kingdom.

“Any name, brand, or mark which states or implies that any such articles were manufactured at a town or place having the same name as a place in the United Kingdom, shall, unless accompanied by the name of the country in which such place is situate, be deemed for the purposes of this section to state or imply that such articles were manufactured at a place in the United Kingdom.”



tion includes the name of a place or country, and is calculated to mislead as to the place or country where the goods to which it is applied were actually made or produced, and the goods are not actually made or produced in that place or country, this section shall not apply unless there is added to the trade description, immediately before or after the name of that place or country, in an equally conspicuous manner, with that name, the name of the place or country in which the goods were actually made or produced, with a statement that they were made or produced there.

Savings.

19. (1) This Act shall not exempt any person from any action, suit, or other proceeding which might, but for the provisions of this Act, be brought against him.

(2) Nothing in this Act shall entitle any person to refuse to make a complete discovery, or to answer any question or interrogatory in any action, but such discovery or answer shall not be admissible in evidence against such person in any prosecution for an offence against this Act.

(3) Nothing in this Act shall be construed so as to render liable to any prosecution or punishment any servant of a master resident in the United Kingdom who *bonâ fide* acts in obedience to the instructions of such master, and, on demand made by or on behalf of the prosecutor, has given full information as to his master.

False representation as to Royal Warrant.

20. Any person who falsely represents that any goods are made by a person holding a Royal Warrant, or for the service of Her Majesty, or any of the Royal Family, or any Government Department, shall be liable, on summary conviction, to a penalty not exceeding £20.

Application of Act to Scotland.

21. In the application of this Act to Scotland the following modifications shall be made:—

The expression "Summary Jurisdiction Acts" means the Summary Procedure Act 1864, and any Acts amending the same.

The expression "justice" means sheriff.

The expression "court of summary jurisdiction" means the Sheriff Court, and all jurisdiction necessary for the purpose of this Act is hereby conferred on sheriffs.



22. In the application of this Act to Ireland, the following modifications shall be made:—

The expression “Summary Jurisdiction Acts” means, so far as respects the police district of Dublin metropolis, the Acts regulating the powers and duties of justices of the peace of such district, and as regards the rest of Ireland means the Petty Sessions (Ireland) Act 1851, and any Act amending the same.

Application of Act to Ireland.

The expression “court of summary jurisdiction” means justices acting under those Acts.

14 and 15 Vict., c. 93,

## MERCHANDISE MARKS ACT 1891

### CHAPTER 15

#### *An Act to amend the Merchandise Marks Act 1887*

[11th May 1891]

A.D. 1891.

1. The customs entry relating to imported goods shall, for the purposes of the Merchandise Marks Act 1887, be deemed to be a trade description applied to the goods.

Customs entry to be trade description. 50 and 51 Vict., c. 28.

2. (1.) The Board of Trade may, with the concurrence of the Lord Chancellor, make regulations providing that in cases appearing to the Board to affect the general interests of the country, or of a section of the community, or of a trade, the prosecution of offences under the Merchandise Marks Act 1887 shall be undertaken by the Board of Trade, and prescribing the conditions on which such prosecutions are to be so undertaken. The expenses of prosecutions so undertaken shall be paid out of moneys provided by Parliament.

Official prosecutions.

(2.) All regulations made under this section shall be laid before Parliament within three weeks after they are made if Parliament is then sitting, and if Parliament is not then sitting, within three weeks after the beginning of the next session of Parliament, and shall be judicially noticed, and shall have effect as if enacted by this Act, and shall be published under the authority of Her Majesty's Stationery Office.

(3.) Nothing in this Act shall affect the power of any person or authority to undertake prosecutions otherwise than under the said regulations.

## COPYRIGHT ACT (UNITED STATES)

[The following are the material sections of the Code, as amended by Statute No. 166 of this year 1891. The numbers of the Code are given, except the last three, 11-13.]

“SEC. 4952. The author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print, or photograph or negative thereof, or of a painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts, and the executors, administrators, or assigns of any such person shall, upon complying with the provisions of this chapter, have the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing, and vending the same; and, in case of dramatic composition, of publicly performing or representing it or causing it to be performed or represented by others; and authors or their assigns shall have exclusive right to dramatise and translate any of their works for which copyright shall have been obtained under the laws of the United States.”

[By the statute of 18th June 1874 “the words ‘engraving,’ ‘cut,’ and ‘print’ shall be applied only to pictorial illustrations or works connected with the fine arts; and no prints or labels designed to be used for any other articles of manufacture shall be entered under the copyright law, but may be registered in the Patent Office.”]

“S. 4953. Copyrights shall be granted for the term of twenty-eight years from the time of recording the title thereof in the manner hereinafter directed.

“S. 4954. The author, inventor, or designer, if he be still living, or his widow or children, if he be dead, shall have the same exclusive right continued for the further term of fourteen years, upon recording the title of the work or description of the article so secured a second time, and complying with all other regulations in regard to original copyrights, within six months before

the expiration of the first term ; and such persons shall, within two months from the date of said renewal, cause a copy of the record thereof to be published in one or more newspapers printed in the United States for the space of four weeks.

“S. 4955. Copyrights shall be assignable in law by any instrument of writing, and such assignment shall be recorded in the office of the Librarian of Congress within sixty days after its execution ; in default of which it shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice.

“S. 4956. No person shall be entitled to a copyright unless he shall, on or before the day of publication in this or any foreign country, deliver at the office of the Librarian of Congress, or deposit in the mail within the United States, addressed to the Librarian of Congress, at Washington, District of Columbia, a printed copy of the title of the book, map, chart, dramatic or musical composition, engraving, cut, print, photograph, or chromo, or a description of the painting, drawing, statue, statuary, or a model or design for a work of the fine arts for which he desires a copyright, nor unless he shall also, not later than the day of the publication thereof in this or any foreign country, deliver at the office of the Librarian of Congress, at Washington, District of Columbia, or deposit in the mail within the United States, addressed to the Librarian of Congress, at Washington, District of Columbia, two copies of such copyright book, map, chart, dramatic or musical composition, engraving, chromo, cut, print, or photograph, or in case of a painting, drawing, statue, statuary, model, or design for a work of the fine arts, a photograph of same : *Provided*, That in the case of a book, photograph, chromo, or lithograph, the two copies of the same required to be delivered or deposited as above shall be printed from type set within the limits of the United States, or from plates made therefrom, or from negatives, or drawings on stone made within the limits of the United States, or from transfers made therefrom. During the existence of such copyright the importation



into the United States of any book, chromo, or lithograph, or photograph, so copyrighted, or any edition or editions thereof, or any plates of the same not made from type set, negatives, or drawings on stone made within the limits of the United States, shall be, and it is hereby, prohibited, except in the cases specified in paragraphs five hundred and twelve to five hundred and sixteen, inclusive, in section two of the Act entitled 'An Act to reduce the Revenue and equalise the Duties on Imports, and for other purposes,' approved October first, eighteen hundred and ninety; and except in the case of persons purchasing for use and not for sale, who import subject to the duty thereon, not more than two copies of such book at any one time; and except in the case of newspapers and magazines, not containing in whole or in part matter copyrighted under the provisions of this Act, unauthorised by the author, which are hereby exempted from prohibition of importation: *Provided, nevertheless,* That in the case of books in foreign languages, of which only translations in English are copyrighted, the prohibition of importation shall apply only to the translation of the same, and the importation of the books in the original language shall be permitted."

[S. 4957 provides that the Librarian of Congress shall record the name, etc., of the copyright book or other article, and give a copy of the title or description, under his seal, to the proprietor whenever he shall require it.]

"S. 4958. The Librarian of Congress shall receive from the persons to whom the services designated are rendered the following fees:—

"First. For recording the title or description of any copyright book or other article, fifty cents.

"Second. For every copy under seal of such record actually given to the person claiming the copyright, or his assigns, fifty cents.

"Third. For recording and certifying any instrument of writing for the assignment of a copyright, one dollar.

"Fourth. For every copy of an assignment, one dollar.



“All fees so received shall be paid into the Treasury of the United States: *Provided*, That the charge for recording the title or description of any article entered for copyright, the production of a person not a citizen or resident of the United States, shall be one dollar, to be paid as above into the Treasury of the United States, to defray the expenses of lists of copyrighted articles as hereinafter provided for.

“And it is hereby made the duty of the Librarian of Congress to furnish to the Secretary of the Treasury copies of the entries of titles of all books and other articles wherein the copyright has been completed by the deposit of two copies of such book printed from type set within the limits of the United States, in accordance with the provisions of this Act and by the deposit of two copies of such other article made or produced in the United States; and the Secretary of the Treasury is hereby directed to prepare and print, at intervals of not more than a week, catalogues of such title-entries for distribution to the collectors of customs of the United States and to the postmasters of all post-offices receiving foreign mails, and such weekly lists, as they are issued, shall be furnished to all parties desiring them, at a sum not exceeding five dollars per annum; and the Secretary and the Postmaster-General are hereby empowered and required to make and enforce such rules and regulations as shall prevent the importation into the United States, except upon the conditions above specified, of all articles prohibited by this Act.

“S. 4959. The proprietor of every copyright book or other article shall deliver at the office of the Librarian of Congress, or deposit in the mail, addressed to the Librarian of Congress, at Washington, District of Columbia, a copy of every subsequent edition wherein any substantial changes shall be made: *Provided, however*, That the alterations, revisions, and additions made to books by foreign authors, heretofore published, of which new additions shall appear subsequently to the taking effect of this Act, shall be held and deemed capable of being copyrighted as above provided for in this Act, unless they form a part of the series

in course of publication at the time this Act shall take effect.

“S. 4960. For every failure on the part of the proprietor of any copyright to deliver or deposit in the mail either of the published copies, or description or photograph, required by ss. 4956 and 4959, the proprietor of the copyright shall be liable to a penalty of twenty-five dollars, to be recovered by the Librarian of Congress, in the name of the United States, in an action in the nature of an action of debt, in any district Court of the United States within the jurisdiction of which the delinquent may reside or be found.

“S. 4961. The postmaster to whom such copyright book, title, or other article is delivered, shall, if requested, give a receipt therefor; and when so delivered he shall mail it to its destination.

“S. 4962 [as altered by the Act of 18th June 1874]. No person shall maintain an action for the infringement of his copyright unless he shall give notice thereof by inserting in the several copies of every edition published, on the title-page or the page immediately following, if it be a book; or if a map, chart, musical composition, print, cut, engraving, photograph, painting, drawing, chromo, statue, statuary, or model or design intended to be perfected and completed as a work of the fine arts, by inscribing upon some visible portion thereof, or of the substance on which the same shall be mounted, the following words: ‘Entered according to Act of Congress, in the year                   , by A. B., in the office of the Librarian of Congress, at Washington’; or at his option the word ‘Copyright,’ together with the year the copyright was entered, and the name of the party by whom it was taken out, thus, ‘Copyright, 18   , by A. B.’

“S. 4963. Every person who shall insert or impress such notice, or words of the same purport, in or upon any book, map, chart, dramatic, or musical composition, print, cut, engraving, or photograph, or other article, for which

he has not obtained a copyright, shall be liable to a penalty of one hundred dollars, recoverable one-half for the person who shall sue for such penalty, and one-half to the use of the United States.

“S. 4964. Every person, who after the recording of the title of any book and the depositing of two copies of such book, as provided by this Act, shall, contrary to the provisions of this Act, within the term limited, and without the consent of the proprietor of the copyright first obtained in writing, signed in presence of two or more witnesses, print, publish, dramatise, translate, or import, or knowing the same to be so printed, published, dramatised, translated, or imported, shall sell or expose to sale any copy of such book, shall forfeit every copy thereof to such proprietor, and shall also forfeit and pay such damages as may be recovered in a civil action by such proprietor in any Court of competent jurisdiction.

“S. 4965. If any person, after the recording of the title of any map, chart, dramatic or musical composition, print, cut, engraving, or photograph, or chromo, or of the description of any painting, drawing, statue, statuary, or model or design intended to be perfected and executed as a work of the fine arts, as provided by this Act, shall within the term limited, contrary to the provisions of this Act, and without the consent of the proprietor of the copyright first obtained in writing, signed in presence of two or more witnesses, engrave, etch, work, copy, print, publish, dramatise, translate, or import, either in whole or in part, or by varying the main design with intent to evade the law, or, knowing the same to be so printed, published, dramatised, translated, or imported, shall sell or expose to sale any copy of such map or other article as aforesaid, he shall forfeit to the proprietor all the plates on which the same shall be copied and every sheet thereof, either copied or printed, and shall further forfeit one dollar for every sheet of the same found in his possession, either printing, printed, copied, published, imported, or exposed for sale, and in case of painting, statue, or statuary, he shall forfeit ten dollars for every copy of the same in his posses-



sion, or by him sold or exposed for sale ; one-half thereof to the proprietor, and the other half to the use of the United States.

“S. 4966. Any person publicly performing or representing any dramatic composition for which a copyright has been obtained, without the consent of the proprietor thereof, or his heirs or assigns, shall be liable for damages therefor, such damages in all cases to be assessed at such sum, not less than one hundred dollars for the first, and fifty dollars for every subsequent performance, as to the Court shall appear to be just.

“S. 4967. Every person who shall print or publish any manuscript whatever without the consent of the author or proprietor first obtained, shall be liable to the author or proprietor for all damages occasioned by such injury.

“S. 4968. No action shall be maintained in any case of forfeiture on penalty under the copyright laws, unless the same is commenced within two years after the cause of action has arisen.

“S. 11. That for the purpose of this Act each volume of a book in two or more volumes, when such volumes are published separately, and the first one shall not have been issued before this Act shall take effect, and each number of a periodical shall be considered an independent publication, subject to the form of copyrighting as above.

“S. 12. That this Act shall go into effect on the first day of July, Anno Domini eighteen hundred and ninety-one.

“S. 13. That this Act shall only apply to a citizen or subject of a foreign state or nation when such foreign state or nation permits to citizens of the United States of America the benefit of copyright on substantially the same basis as its own citizens ; or when such foreign state or nation is a party to an international agreement which provides for reciprocity in the granting of copy-



right, by the terms of which agreement the United States of America may, at its pleasure, become a party to such agreement. The existence of either of the conditions aforesaid shall be determined by the President of the United States by proclamation made from time to time as the purposes of this Act may require."

*Note.*—Several points must be observed :—

1. Delivery of a printed copy of the title of the book, etc., or a description of the work of art, "on or before the day of publication in this or any foreign country." (S. 4956.)

2. Delivery of two copies of the book, etc., or of the photograph of the work of the fine arts, "not later than the day of the publication thereof in this or any foreign country." (S. 4956.)

3. The publication in the United Kingdom must not precede, though it may be contemporaneous with, that in the United States.

4. In the case of a book, photograph, chromo, or lithograph, the two copies must be from type set, plate, negative, or drawing made, within the United States. (S. 4956.)

5. During the copyright, importation is forbidden, except of not more than two copies of a book at any one time, for use and not for sale, and except newspapers and magazines not containing unauthorised reprints, and except books in a foreign language, whereof the English translation only is protected. (S. 4956.)

6. The fees must be paid according to s. 4958.

7. Alterations, revisions, and additions made to books already published, by foreign authors may be copyrighted. (S. 4959.)

8. The words set out in s. 4962 must be inserted in every copy published.

9. Penalties are imposed on any one wrongfully inserting those words (s. 4963), and on persons infringing ss. 4964-4966.

10. An unpublished MS. is protected by s. 4967.

11. The United States Government has acted on the assumption that temporary allegiance even is superfluous

for the acquirement of British copyright, and by proclamation of President Harrison, dated 1st July, has extended the benefit of the above Act to citizens or subjects of Great Britain, France, Belgium, and Switzerland.

The following regulations have been made by the United States Treasury :—

“1. Copyrighted books and articles of importation which are prohibited by s. 4965 of the Revised Statutes, as amended by s. 8 of the said Act, shall not be admitted to entry. Such books and articles, if imported with the previous consent of the proprietor of the copyright, shall be seized by the Collector of Customs, who shall take proper steps for the forfeiture of the goods to the United States under s. 3082 of the Revised Statutes.

“2. Copyrighted books and articles imported contrary to the said prohibition without the previous consent of the proprietor of the copyright, being primarily subject to forfeiture to the proprietor of the copyright, shall be detained by the collector, who shall forthwith notify such proprietor in order to ascertain whether or not he wishes to institute proceedings for the enforcement of the right to forfeiture. If the proprietor institutes such proceedings, and obtains a decree of forfeiture, the goods shall be delivered to him on payment of the expenses incurred in the detention, storage, and duties accruing thereon. If such proprietor fails to institute proceedings within sixty days from the date of notice or declaration in writing, he abandons his right to forfeiture, and the collector shall proceed as in the case of articles imported with the previous consent of the proprietor.

“3. Copyrighted articles of importation which are not prohibited, but which, by virtue of s. 4965 of the Revised Statutes, as amended by s. 8 of the said Act, are forfeited to the proprietor of the said copyright when imported without his previous consent, and, moreover, subject to the forfeiture of one dollar or ten dollars per copy, as the case may be, one half thereof to the said proprietor, and the other half to the United States, shall be taken possession of by the collector, who shall take the necessary steps for securing to the United States half the sum forfeited, and shall keep the goods in his possession until

the decree of forfeiture has been obtained and half of the sum so forfeited, as well as the duties and charges accruing, are paid, whereupon he shall deliver the goods to the proprietor of the copyright. In case of a failure to obtain a decree of forfeiture the goods shall be admitted to entry."

These regulations, unless altered, will very materially prejudice the importation of serial publications into the United States if not altogether prevent them, for the seizure is to take place of books and articles "if imported with the previous consent of the proprietor of the copyright." The seizure may be justified under the Customs Act, but it is a distinct derogation from the rights apparently conferred by s. 8 of the Copyright Act.

## GENERAL INDEX

NOTE.—C. stands for 'Copyright,' P. for 'Patent,' D. for 'Design,'  
T.M. for 'Trade-mark.'

- ABRIDGMENTS, 13. *See* "Infringe-  
ment," C
- Abandonment of application, T.M.,  
221
- Acceptance of application, P., 106,  
107
- Accounts, P. *See* "Term, exten-  
sion of," 129, and "Infringe-  
ment," P
- Advertisement, T.M. *See* "Appli-  
cation," 232
- Amendment, P. D. T.M., 287. *See*  
"Rectification"  
of clerical error, 120  
P. of specification, 117-120  
rules as to, 118-120  
by disclaimer, 114-120  
pending proceedings, 143  
T.M., 288
- Appeal to Law Officers, P., 105,  
109-111  
D. to Board of Trade, 190  
T.M. to Board of Trade, 231
- Applicant, P. *See* "Inventor"
- Application for grant, P., 97-111  
form of, 97, 98  
joint, 94  
provisional specification, 97, 99  
complete specification, 97-100  
rules as to, 98-102, 108
- Application for grant, P., draw-  
ings, 102  
procedure subsequent to, 105  
second, 106  
acceptance of, 106, 107  
appeal, 105, 108  
by legal personal representa-  
tives, 94, 108, 121
- Application for registration, D.,  
185-190  
form of, 185, 186, 203  
by whom, 185, 186, 187  
rules as to, 187  
drawings, etc., 188, 189
- Application for registration, T.M.,  
220-235  
form of, 220, 265  
class of goods, 220, 221, 225  
abandonment of, 221  
rules as to, 222-225  
advertisement of, 232-235
- Artistic, C., 35-45. *See* "Engrav-  
ings," "Paintings," "Pho-  
tographs"  
attaches on completion, 35  
ownership of, 55  
subject-matter of, 41
- Assignment, C., 32-34  
Registration of, 29  
in writing or by registration, 33



- Assignment, C., of licence, 33  
 of performing-right, 33  
 of artistic, C., 39  
 of unpublished work, 33, 73  
 as to unsold copies, 33  
 Statute of Frauds, 32
- Assignment, P., 145, 146, 283  
 registration, 145  
 who may assign, 284
- Assignment, D., 283  
 in writing, 184  
 who may assign, 284
- Assignment, T.M., with goodwill  
 only, 248  
 registration, 283  
 who may assign, 284
- Author, C. See "Contract,"  
 "Periodical," etc.  
 rights of, before publication, 5  
 correspondence, 7  
 lectures, 7  
 right to use his name, etc., 73  
 right to a subject, 73  
 contract to write and publish,  
 74, 75  
 of picture, 41  
 of photograph, 41  
 of opera, etc., 47
- Author, D., 183
- BLASPHEMOUS** publication, not  
 protected, 9  
 may be erased by purchaser of  
 MS., 77
- Book, Definition of, Act of 1842,  
 8  
 publication of, 19  
 term of, C., 23  
 registration, 23  
 engravings and photographs in  
 book-form, 36  
 edition of, what is, 75
- Board of Trade, 292. See "Ap-  
 peal"  
 certificate, etc. by, *ib.*
- Brand, as T.M., 216
- British possessions, defined, 301
- "CALCULATED to deceive," 241,  
 253
- Canadian, C., 51, 53
- Certificate of Comptroller, 289  
 of Board of Trade, 292
- Certificate, D., 200
- Certificate, T.M., application for,  
 290  
 of refusal to register, 251  
 of litigation, 251
- Claim the, in specification, 192
- Classification, D., of articles and  
 substances, 186
- Classification, T.M., of goods, 225-  
 230
- Colonial, C., 51-53  
 Ordinances, 52  
 Canadian, 51-53
- Colonial, P. D. T.M., 297-303  
 list of arrangements, 302
- Colour, not registered as essential  
 T.M., 216, 222, 235
- Combination, P., 88, 92  
 infringement of, 138
- "Common to the Trade," 219
- Comptroller, discretionary power  
 of, 289  
 certificate of, *ib.*
- Compulsory licence, C., 34; P.,  
 131-133
- Contracts for composing and  
 publishing, 74-77
- Co-owner of P., 95, 96
- Copies, C., deposit of, in British  
 Museum, etc., 30  
 unsold, see "Assignment, C.,"  
 33
- Copies of register, P. D. T.M.,  
 284
- Copyright. See "Book," etc.  
 definition of, 3  
 subject-matter of literary, 8

- Copyright, essentials of, 9  
 history of, 3  
 is personal property, 23  
 extent of, 22, 51  
 is indivisible, 54  
 Copyright, D., definition of, 194  
 limited to British territory, 198  
 information as to existence of, 200  
 Correspondence. *See* "Letters"  
 Crown. *See* "Secretary for War"  
 bound by, P., 122  
 use of, P., by officers of, 122  
 Customs, C., 17
- DATE of, P., 121  
 Days, excluded, 291  
 Deceptive, T.M. must not be, 215-217  
 evidence, 217  
 Declarations, statutory, 294  
 Definition of P., 86  
 of D., 180  
 of T.M., 213  
 Descriptive, T.M. must not be, 216-219  
 Design, name of, not registered as T.M., 218  
 Disclaimer, in specification, 114, 120  
 Disclaimer, pending proceedings, P., 144  
 Disclaimer, T.M., when unnecessary, 214  
 how made, 219  
 of something "common to the trade," 219  
 Discretionary power of Comptroller, 289  
 Distinctive, T.M. must be, 213  
 Drama, publication of, 19, 21, 47  
 registration, 27  
 performing-right, 46  
 Drama, author of, 47  
 place of dramatic entertainment, 47  
 infringement, 46, 48  
 term of C., 46  
 Dramatisation of tale, 14  
 Drawing, C. *See* "Paintings," "Artistic"  
 P., 102-105  
 D., 189  
 T.M., 224
- EDITION, what is, 75  
 registration of new, 28  
 purchase of, 75  
 Encyclopædia. *See* "Periodical"  
 Engravings, C., 36-39  
 reduced, may be original, 9  
 property in plate, 35  
 may be protected as "book," 36  
 requirements of statutes, 36  
 term of C., 36  
 how far protected, 38  
 Enlargement of time, P. D. T.M., 293  
 Equities, enforcement of, 284  
 Essentials of, P., 85  
 Essentials of D., Novelty, 181  
 Utility is not, 182  
 Essentials of T.M. used in connection with goods, 215  
 distinctive, 213, 216, 217  
 used alone, not in combination, 217, 218  
 until registered, 218  
 Eton, rights of, saved, 18  
 Evidence, dispensing with, 293  
 Examiner, P., 105, 106  
 Exhibitions, P., 91  
 protection of, P., 91; D., 181  
 Existing P., at date of Act, 151  
 Existence of C. of D., how ascertained, 200  
 Extension of term, P. *See* "Term," 124-130

- FAIR use of work. *See* "Infringement," C.
- False trade description. *See* "Merchandise Marks Act," 320
- "Fancy" words, 216
- Fees, C., 24; P., 151  
 payment of, 123; D., 201; T.M., 262  
 removal from register unless paid, 249
- Foreign vessel, use of invention in, 137
- Forging a T.M., 323
- Forms, C., 25, 26; P. D. T.M., where obtained, 317-319; P., 153-173; D., 202-208; T.M., 264-280
- Fraud, 14. *See* "Trade-name"  
 False marking of pictures, 40  
 fraudulent use of name of author, etc., 73, 76, 77
- GEOGRAPHIC name as T.M., 214, 216
- Goodwill, T.M. exists only with, 248
- HISTORY of C., 3, 4; P., 83; D., 177; T.M., 211
- ILLEGAL, Comptroller may refuse to register, P. D. T.M., 283
- Immoral, Comptroller may refuse to register, P. D. T.M., 283
- Importation, C., 16-72  
 of pirate books, 17  
 P., 96, 299; T.M. of goods, 221
- Improvements, P., 92
- Incapacity, personal, P. D. T.M., 291
- Infancy, P. D. T.M., 291
- Infringement, C., 10-18  
 what constitutes, 11
- Infringement, C., materiality, 12  
 fair use, 12  
 abridgments, 13  
 reviews, 13  
 dramatisation of tale, 14  
 music, 15, 48  
 practice, 15, 16  
 importation, 16  
 fraud, 14  
 by employé, 11, 35  
 by photographer or printer, 35, 43  
 of engraving by photography, 38, 43  
 of picture, 35, 43  
 of sculpture, 44  
 of drama, etc., 48
- Infringement of P., 136-144  
 particulars must be delivered, 136, 137  
 defence, 137, 138  
 of combination, P., 138  
 mechanical equivalent, 138  
 injunction, damages, profits, 139  
 accounts, 140  
 inspection, *ib.*  
 certificates, 137, 140  
 threats, 141-143  
 amendment, 143, *q.v.*
- Infringement of D., 196-198  
 injunction, 196  
 penalties, *ib.*  
 damages, 197  
 evidence, 198  
 inspection, 199
- Infringement of T.M., 251-256  
 damages, 248  
 certificate of litigation, 251  
 costs, 251  
 who can sue, 252  
 knowledge of defendant, 252  
 evidence, 253  
 what constitutes, 253-256  
 "calculated to deceive," 241, 253.
- Injunction, C., 15; P., 139; D., 196

- Inspection, P. D. T.M., 284, 293;  
     P., 140; D., 199  
 International C., 54, 55  
     Statutory, 54-72  
     Bern Convention, 60, etc.  
     registration necessary, 56  
     reservation of C. in newspaper,  
     etc., 56  
     rights saved in Act of 1886, 71  
     translations, 71  
     performing-right, 72  
     United States Act, 332  
     terms of, abroad, 72  
 International P. D. T.M., 297-303  
     rights of foreigners, 297, 299  
     rules applicable, 300  
     list of arrangements, 302  
 Invented words, 216  
 Invention defined, 86  
     process or product, how claimed,  
     88  
 Inventor, P., first and true, 94-96  
     joint, 94, 95  
     master and servant, 95  
     second applicant, 96, 106  
     death of, 94  
     legal personal representative,  
     94, 108, 121
- JOINT-OWNER, P. 95**
- LABEL as T.M., 218, 219**  
 Lancaster, Courts of County Pala-  
     tine, 295  
 Lectures, C., 7  
     how published, 19, 20  
     how protected, 19  
 Letters, rights of vendor and re-  
     ceiver, 6, 7  
     as T.M., 216  
 Libellous publications not pro-  
     tected, 9  
     may be erased by purchaser of  
     MS., 77
- Licence, C., to publish, 23  
     compulsory, 34  
     is not assignment, 33  
     registration unnecessary, 33  
     to perform, 47  
     to copy picture, 39, 44  
 Licence of P. is not assignment,  
     146  
     registration of, 148  
     who may license, 284  
     compulsory, 131-133  
 Licence of D., who may license,  
     284  
 Licensing Act, 1662, 3  
 Limitation of action, C., 18  
 Literary C. *See* "Book"  
 Loss of P., 122  
 Lunacy, 291
- MANX Courts, 295**  
 Map, 9. *See* "Engraving"  
     registration, 26  
 Master or servant, invention by,  
     95  
 Mechanical equivalents, 138  
 Merchandise Marks Act of 1887,  
     320  
 Monopolies, Statute of, 83-85  
 Monopoly, defined, 84  
 Music. *See* "drama"  
     infringement, 15, 46  
     publication, 19, 21  
     registration, 23, 27  
     performing-right, 49, 50
- NOTICES, etc., how left, 291**  
     D. 188  
 Novel, dramatisation of, 14  
 Novelty, P., 89-92. *See* "Essen-  
     tials"  
     D., 181
- OFFENCES, against Act of 1883, 259**



- Offences against Act of 1883, false representations, *ib.*  
 false entry in register, *ib.*  
 against Merchandise Marks Act, 320
- Official secrets, 7
- "Old" T.M. in use before 13th Aug. 1875, 213, 214, 215, 240  
 certificate of refusal of registration, 251
- Opera, publication of, 19, 21. *See* "Music Drama"
- Opposition to grant, P., 112-116  
 grounds of, 113  
 who may oppose, 113  
 rules as to, 114-116  
 disclaimer, 114
- Opposition to registration, T.M., 236-242. *See* "Registration"  
 rules as to, 237-239  
 conflicting claims, 239  
 grounds of, 240  
 costs before comptroller, 241, 247
- Originality C., essential, 9. *See* "Infringement"
- PAINTING, C.** *See* "Artistic, C.," 39-44  
 publication of, 19  
 assignment, 39, 42, 44  
 registration, 39, 42  
 infringement, 40, 43  
 subject-matter, 41  
 author, 41  
 fees, 40  
 false marking, 40  
 description of, 42  
 licence, 43, 44
- Partnership, C., whether it is created, 74  
 rights on dissolution, 76  
 between printer and publisher, 74
- Patent, definition, 86, 87  
 historical sketch, 83-86  
 essentials, 85  
 novelty, 89-91  
 utility, 93  
 for combinations, 88, 92  
 for improvements, 92  
 sealing, 121  
 date, *ib.*  
 form, 122, 171  
 extent, 122  
 as to crown, 122  
 when lost, 122
- Patent medicines, 84
- Patent museum, 150
- Performing-right, 46  
 assignment of, 33  
 international, 72
- Periodicals, 78-80  
 rights of authors and publishers, 78  
 separate publication prevented, 29, 79
- "Person aggrieved," C., 29  
 P. D. T.M., 284, 286
- Photograph. *See* "Painting Infringement"  
 exposing copies, 35
- Place of dramatic entertainment, 47
- Practice, C., action for infringement, 15, 16  
 proprietor may bring detinue or conversion, 17  
 expunging entry, 29  
 limitation of action, 18
- Prior user, P., 92. *See* "Novelty"
- Proprietor, C. *See* "Author"  
 who is, 18, 27  
 registration of, 27  
 of engraving, 37  
 of MS., 77  
 of picture, 41
- Proprietor of P. D. T.M., registered, may assign, 284  
 mortgagee is not, 284

- Proprietor of D. author is, 183  
 assignee, *ib.*  
 master or servant, *ib.*  
 registration of, 184, 191
- Proprietor of T.M. only can sue  
 for infringement, 252
- Provisional protection, P., 106, 107
- Provisional specification, P., 97,  
 99  
 how drawn, 88, 99. See "Application"
- Publication, C., 19  
 rights arising from, 19-22  
 place of first, 21  
 unauthorised may be prevented,  
 5-7  
 by proprietor of periodical, etc.,  
 29  
 exhibition of picture is not, 35  
 simultaneous, 55
- Publication, P. See "Novelty"  
 of Patent Office, 150  
 where obtained, *ib.*, 232  
 of T.M. Journal, 232
- Publisher, registration of, 27  
 licence to publish, 73  
 contract to publish, 74, 75  
 is personal, 74  
 whether it amounts to partner-  
 ship, *ib.*  
 damages, *ib.*
- RECTIFICATION of register, P. D.  
 T.M., 284. See "Amend-  
 ment," 287, etc.  
 T.M. only, 245, 246
- Register of C., 24
- Register of P. D. T.M., no notice  
 of trust entered, 283  
 but order of Court, 283  
 copies and extracts obtained,  
 284  
 evidence, *ib.*  
 rectification, *q.v.*  
 inspection, 293
- Rectification of T.M., 247  
 evidence of right, 247  
 removal from, where fees un-  
 paid, 249
- Registration, C., of book, 23-28  
 fees, 24  
 forms, 25, 26  
 of proprietor, 27, 28  
 time of publication, 28  
 periodical, etc., 29, 79  
 map, 29  
 assignment, *ib.*  
 first number, *ib.*  
 expunging entry, *ib.*  
 of drama and music, 27  
 of painting, etc., 39, 42  
 licence to publish, 33  
 of engravings when necessary, 36
- Registration, P. D. T.M., of as-  
 signee, etc., 283
- Registration of P., 145-149  
 what should be entered, 145  
 rules as to, 146-149  
 extension of term, 148  
 licence, 145, 148
- Registration of D., 180, 191-195  
 when D. should be registered,  
 180  
 scandalous, contrary to law or  
 religion, 182  
 of proprietor, 184  
 refusal, 185  
 appeal from, 185, 190  
 rules as to, 191-193  
 articles to be marked Rd., etc.,  
 194  
 searching register, 200
- Register of T.M. See "Opposi-  
 tion"  
 application for *q.v.*, 220, etc.  
 refusal, 220, 239, 241  
 appeal from, 220  
 class of goods, 221, 222  
 colour, 216, 222, 235  
 series of T.M., 221, 222  
 restrictions on, 235

- Register of T.M., identical marks  
 when allowed, 239, 241  
 "calculated to deceive," 241,  
 242, 253  
 advertisement of application,  
 232-235  
 subsequent procedure, 242-246  
 rectification, 245, 246  
 evidence of right, 247  
 prior to action, 252  
 subsequent assignment, *ib.*
- Restraint of trade, 75
- Reviews, 13. *See* "Infringement,"  
 C.
- Revocation of grant, P., 134-136
- SCANDALOUS design, not regis-  
 tered, 182
- Scotch Courts, 295
- Sculpture, 44, 45  
 publication, 19, 45  
 term of C., 45
- Seal of P. Office, 283
- Sealing P., 121
- Search in register, D., 200  
 T.M., 219
- Secrets, protection of trade, 313
- Secretary of State for War. *See*  
 "Crown"  
 assignment to, 122, 150  
 communication to, not to pre-  
 judice novelty, 90
- Serials. *See* "Periodicals"
- Series of T.M., 221, 222
- Sermons, 20. *See* "Lectures"
- Service on comptroller and gener-  
 ally, 291
- Sheffield marks, 257-261  
 rules, 260
- Specification, provisional, P., 97,  
 99  
 how drawn, 88, 99  
 complete, 97, 100-102  
 how to be drawn, 88, 101  
 title, 99
- Specification, provisional, P., time  
 for leaving, 100  
 enlargement of, 100  
 the language, 100-102  
 claim, 102  
 drawings, 102-105  
 amendment, 117-120
- Statutory declarations, 294
- Subject-matter of literary C., 8,  
 etc.
- TERM of C., literary, 23  
 engravings, 36  
 paintings, etc., 39  
 sculpture, 45  
 drama, music, 46  
 in foreign countries, 73
- Term of P., 23  
 payment of fees, 123  
 extension of, 124-130  
 rules as to, 124, etc.  
 accounts, 129  
 grounds of extension, 127, 128  
 conditions of grant, 130  
 registration of, 148
- Term of D., 193; T.M., 249
- Threats, action for, generally,  
 142  
 P., 141-143  
 what action stops, 142
- Time of publication must be regis-  
 tered, C. 28
- Time, enlargement of, generally,  
 293  
 for complete specification, 100  
 for sealing, 121  
 for making payments, 123
- Title of work, 9, 15  
 of P., 99
- Trade-name, 14, 307-312  
 reputation essential, 307  
 fraud, actual or apparent, 14,  
 308  
 no protection against inconveni-  
 ence, 311

<p>Trade-name, in connection with              business and goods, 309, 312              of place of business, 309              "get-up" of goods, <i>ib.</i>              passes on sale of goodwill, 310              right of vendor, <i>ib.</i>              T.M. protected as, 311              under Companies' Act 1862, 311              Trade secrets, protected, 313              Translations, 9, 12, 62, 71</p> <p>UNITED STATES C. ACT, 332-341              notes on, 339</p>	<p>United States C. Act, Treasury              regulations, 310              Universities, rights of, saved, 18              Unpublished works, rights as to,              5-7.              assignment of, 73              right of purchaser, 77              User of T.M., 219, 247              of P. See "Novelty"              Utility, P., 93              in D. not essential, 182</p> <p>WAR. See "Secretary of State"</p>
---	---

*add*