

Sect. 30. Order XXXVI. r. 57. The court may refer the damages to an official referee for inquiry and report (*h*).

NOTE.

Account and Damages.

As to costs of inquiry as to damages or account of profits, see *ante*, p. 243, under s. 29 (6).

Certificate of validity questioned, and costs thereon.

31. In an action for infringement of a patent, the Court or a judge may certify that the validity of the patent 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 action certifies that he ought not to have the same.

These provisions are, in substance, a re-enactment of the Act of 1852, s. 43, which was in lieu of the Act of 1835, s. 3 (*i*), under which, upon a similar certificate being granted in the first trial, a plaintiff could, in a subsequent "suit or action touching such patent," recover treble costs.

Certificate not granted if verdict by consent.

"**Action for infringement of a patent.**"—Under the Act of 1835 it was held in *Stocker v. Rodgers* (*j*), that the certificate ought not to be granted if the verdict were for the plaintiff by consent, no evidence being offered. But where the validity of the patent had in part come in question, as for instance, where there was a plea that the invention was not new, and the defendant was prevented by the state of the pleadings from raising the further objection that the patent was illegal, it was held that, as the verdict on the plea of want of novelty was for the plaintiff, the certificate might be granted (*k*).

And under the present Act, where an action in which the validity of the patent was disputed was tried during some days and then a compromise was effected, and a consent order agreed to giving judgment for the plaintiff on the validity of the patent and for defendants on infringement, the certificate was given (*l*).

Where defendant does not appear at trial,

In *Peroni v. Hudson* (*m*) it was held that the section only applies when the patent is established in a case contested in court; and therefore, when the defendant put in a defence but did not appear at the trial, and the plaintiff proved his case, and obtained all the relief asked

(*h*) *Westinghouse v. L. & Y. Rail. Co.*, 1 R. P. C. 253; and see *American Braided Wire Co. v. Thompson* (4), 5 R. P. C. 696.

(*i*) Now repealed: 5 & 6 Vict. c. 97.

(*j*) 1 C. & K. 99.

(*k*) *Gillett v. Wilby*, 1 Webst. 270; S. C. 9 C. & P. 334.

(*l*) *Delta Metal Co. v. Maxim-Nordenfelt, etc., Co.*, 8 R. P. C. 247.

(*m*) 1 R. P. C. 261.

by him, the certificate was refused. In *Haydock v. Bradbury* (n), and *Edison Bell Phonograph Co. v. Edison Phonograph Co.* (o), and *Edison United Phonograph Co. v. Young* (p), however, under like circumstances, the certificate was given.

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Under the Act of 1852 it was held that the certificate could not be given to the defendants in an action for infringement of patent (q). Not given to defendant.

In *Haslam Co. v. Hall* (r), a case under the present Act, the certificate was given to the plaintiff, although the patent was declared invalid. In this case the patent was established except as regarded one claim in the specification, but the learned judge refused to certify anything further than that the validity of the patent came in question. Plaintiff failing in action.

The certificate has been given in actions in which the plaintiff succeeded as to the validity of the patent, but failed on the question of infringement (s). And this course was followed in *Tweedale v. Ashworth* (t), where after some evidence of the plaintiff had been given the defendant did not further dispute the validity of the patent.

In *Kurtz v. Spence* (u), it was held that an action under s. 32 of the present Act is not an "action for infringement of a patent," even though the questions of validity of the patent and infringement are raised, and that no certificate could be given under this section in such an action. In *Crampton v. Patents Investment Co.* (x), however, the certificate was given, but without prejudice to its validity if it should come into operation, the learned judge entertaining great doubt whether he had jurisdiction to grant it. Threats action not within this section,

The certificate may be given although the patent has expired (y).

It appears that the costs of a motion to commit for breach of an injunction are not within this section (z). nor motion to commit.

Where a certificate as to validity had been given in the first action, and in a second action, which resulted also in judgment for the plaintiff, the patent was attacked on grounds different from the grounds of attack in the first action, PEARSON, J., gave a second certificate certifying the extent to which the patent had been in controversy in the second action (a). But in *Edison, etc. Co. v. Holland* (b), where the certificate

(n) 4 R. P. C. 75.

(o) 11 R. P. C. 33.

(p) 11 R. P. C. 489, 492.

(q) *Badische Anilin, etc. Fabrik, v. Levinstein*, 29 Ch. D. 366.

(r) 5 R. P. C. 1.

(s) *Automatic Weighing Machine Co. v. Knight*, 6 R. P. C. 113, 120, 126; *Shoe Machinery Co. v. Cutlan*, 12 R. P. C. 342, 359; *Birch v. Harrap*, 13 R. P. C. 615, 627.

(t) 7 R. P. C. 426; 8 R. P. C. 49.

(u) 5 R. P. C. 161.

(x) 5 R. P. C. 382, 404.

(y) *Sunlight Incandescent, etc. Co. v. Incandescent Gaslight Co.*, 14 R. P. C. 757, 763, 776.(z) *Spencer v. The Ancoats Vale Rubber Co.*, 6 R. P. C. 46, 68.(a) *Otto v. Steel*, 3 R. P. C. 120.

(b) 6 R. P. C. 243, 287.

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had been given in the first action, the Court of Appeal under like circumstances refused to give any certificate in the second action on the ground that to give one might throw a doubt on the sufficiency of the former certificate.

“**Court or a judge.**”—The Act of 1852, s. 43, required that the certificate should be given by “the judge before whom any such action should be tried,” and therefore, where the court below had on the trial dismissed the action on the ground that the patent was invalid, and this decision was reversed on appeal, the Court of Appeal thought that the safer course was that application should be made for the certificate to the judge of the court below, and accordingly gave leave to apply to him for that purpose, and did not themselves grant the certificate (c). And in such a case the judge of the court below would, if necessary, apply to the Court of Appeal for information to enable him to determine what he would certify (d).

May now be given by Court of Appeal.

The present section removes this difficulty. The certificate may be given by “the court or a judge,” that is, may be given in chambers (e), and “court,” by the interpretation clause (s. 117 (1)), means the High Court of Justice; but by S. C. R. 1883, Order LVIII. r. 4, the Court of Appeal has all the powers and duties as to amendment and otherwise of the High Court, and may, therefore, certify under this present section (f). The Act of 1852 provided that the certificate might be given in evidence in any proceeding by *scire facias* to repeal the patent. There is no corresponding provision in the present Act in reference to proceedings for revocation.

The words “court or a judge” in this section were held not to include the Vice-Chancellor of the County Palatine of Lancaster, nor the Court of Appeal sitting on appeal from him (g). And, therefore, a certificate given by the Vice-Chancellor in an action where the plaintiff succeeded, and where the Vice-Chancellor’s judgment was upheld by the Court of Appeal, was held not to be a certificate entitling the plaintiff in a subsequent action in the High Court to solicitor and client costs (h).

A certificate under this section is not a judgment or order within s. 19 of the Judicature Act, 1873, and is, therefore, not appealable (i).

(c) *Otto v. Linford*, Appendix, *post*.

(d) *Cropper v. Smith*, 2 R. P. C. 61.

(e) Judicature Act, 1873, s. 39.

(f) See *Birch v. Harrap*, 13 R. P. C. 615. See also *Shoe Machinery Co. v. Cutlan*, [1896] 1 Ch. 108, a case under s. 29.

(g) *Proctor v. Sutton Lodge Chemical Co.*, 5 R. P. C. 184.

(h) *Proctor v. Sutton Lodge Chemical Co.*, *ubi supra*. But see now 53 & 54 Vict. c. 23, ss. 3, 4, cited *post*, under s. 112 A.

(i) *Haslam Foundry, etc. Co. v. Hall*, 20 Q. B. D. 491; 5 R. P. C. 144, and see observations of PEARSON, J., *Cropper v. Smith*, 2 R. P. C. 63.

“In any subsequent action for infringement.”—This section applies only to a second action for infringement, and therefore does not entitle a patentee to recover the full costs of a first trial (*k*).

An action which was commenced before the date of the certificate in the first action is not a “subsequent action” within this section even though the defendants after that date amended their defence (*l*).

And when the second action was in the paper for trial at the same time as the first action, it was held that a certificate given in the first action did not make the defendant in the second action, although he raised the question of validity of the patent, liable to solicitor and client costs (*m*).

And apparently the certificate will not entitle a patentee who has succeeded in establishing his patent against one defendant to his costs as between solicitor and client in an action against another, a licensee, for royalties (*n*).

Under the express words of the Act of 1852, s. 43, the certificate was required to be given in evidence at the subsequent trial. These words are not in the present section. But the certificate should be pleaded in the second action (*o*).

“Final order or judgment.”—The corresponding words of the Act of 1852, “decree, decretal order or final judgment,” were held not to apply to a motion for a new trial of the subsequent action, and the costs of an unsuccessful motion for a new trial were only given as between party and party (*p*).

“Full costs charges and expenses,” etc. — The result of the section appears to be that the *onus* is on the defendant in the subsequent action to show that the plaintiff ought not to have the full costs (*q*); and full costs will be given when the defendant on the motion for injunction consents to have the hearing of the motion treated as the trial of the action, and submits to an injunction notwithstanding previous negotiations for a settlement in which the question of costs was discussed (*r*).

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Section applies only to second action for infringement.

Onus on defendant in second action to show why plaintiff should not have full costs.

(*k*) *Penn v. Bibby*, L. R. 3 Eq. 308.

(*l*) *Automatic Weighing Machine Co. v. International Hygienic Society*, 6 R. P. C. 475.

(*m*) *Automatic Weighing Machine Co. v. Combined Weighing Machine Co.*, 6 R. P. C. 120.

(*n*) See *Bovill v. Hadley*, 17 C. B. (N.S.) 435. 5 & 6 Wm. 4, c. 83, s. 3, applied to every subsequent action touching the patent.

(*o*) *Pneumatic Tyre Co. v. Chisholm*, 13 R. P. C. 488.

(*p*) *Bovill v. Goodier*, Griffin, L. O. C. 49.

(*q*) *Davenport v. Rylands*, L. R. 1 Eq. 302, 309; *United Telephone Co. v. Patterson*, 6 R. P. C. 140. See also remarks of WILLES, J., in *Bovill v. Hadley*, 17 C. B. (N.S.) 439.

(*r*) *United Telephone Co. v. Townshend*, 3 R. P. C. 10.

Sect. 31. The section appears not to apply to the costs of an appeal (*s*).

NOTE.

Full costs refused if first action collusive, Or not conclusive.

The court has a discretion to refuse these costs, and they would be refused where the first action was collusive, or the judge considered the case an improper one (*t*).

And full costs will be refused where, although the certificate was given in the former action, that action has not been conclusive between the parties, as where a verdict having been found for the plaintiff a new trial was directed, but was never had owing to the action having been compromised (*u*).

But plaintiff entitled to full costs, though validity of patent not contested in second action.

The mere fact of the validity of the patent not being called in question in a subsequent action is no ground by itself for the judge exercising his discretion in favour of the defendant and giving the certificate which will deprive the plaintiff of solicitor and client costs (*x*). And solicitor and client costs have been given when in the subsequent action judgment was given in default of defence (*y*).

In the case of *Otto v. Steel* (*z*), PEARSON, J., refused costs as between solicitor and client on the ground that the patent was impeached in the first action on different grounds to those on which it was impeached in the second action.

“Unless the court or judge trying the action certifies,” etc.— Where the defendants did not dispute the validity of the patent, and all they had done was to try some years ago a process proved to be an infringement, which they had abandoned, and had never since used, and did not intend to use, and the damages were very trifling, the court considered the action vexatious, and certified under this section that the plaintiffs were not to have full costs (*a*). And full costs have been refused when the judge thought the litigation was owing to the lax manner in which the specification had been framed (*b*), and when the defendants were innocent infringers who took over the infringing machines when they bought a cotton mill, knowing little or nothing about them (*c*).

(*s*) *Incandescent, etc. Co. v. De Mare, etc. System*, 13 R. P. C. 559, 579. See also *Cole v. Saqui*, 40 Ch. D. 132.

(*t*) *Davenport v. Rylands*, L. R. 1 Eq. 309.

(*u*) *Betts v. De Vitre*, 11 Jur. (N.S.) 9.

(*x*) See per CHITTY, J., *United Telephone Co. v. Patterson*, 6 R. P. C. 140, 142; see also *Davenport v. Rylands*, L. R. 1. Eq. 302, 308; see, however, *Automatic Weighing*

Machine Co. v. International Hygienic Society, 6 R. P. C. 475.

(*y*) *Pneumatic Tyre Co. v. Chisholm*, 13 R. P. C. 488.

(*z*) 3 R. P. C. 120.

(*a*) *Proctor v. Sutton Lodge Chemical Co.*, 5 R. P. C. 184.

(*b*) *Automatic Weighing Machine Co. v. National Exhibitions Co.* 8 R. P. C. 345, 352.

(*c*) *Boyd v. Ttotal, etc. Co.*, 11 R. P. C. 175, 185.

But where the defendant, although not contesting the validity of the patent, denied infringement, and after a trial of several days the court decided against him, the court refused to give any certificate that the plaintiffs were not entitled to their full costs (*d*). Sect. 31.
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The practice of the Court of Chancery being to tax costs as between party and party, in the absence of special directions to the contrary, it was held in *Lister v. Leather* (*e*), that the decree or order under s. 43 of the Act of 1852 should contain an express direction for the taxing master to tax the plaintiff's costs as between solicitor and client. Decree in second action should direct the taxation as between solicitor and client.

For form of certificate under this section and s. 29 (6), see Seton, p. 567, and Pemberton, p. 482.

The certificate is now usually embodied in the judgment (*f*).

By s. 18 of the Act of 1888 (*g*), similar provisions to the provisions of this section are enacted with respect to actions for infringements of a registered trade mark.

32. Where any person claiming to be the patentee of an invention, by circulars advertisements or otherwise threatens any other person with any legal proceedings or liability in respect of any alleged manufacture use sale or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats: Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent. Remedy in case of groundless threats of legal proceedings.

“Where any person . . . threatens,” etc.—In *Halsey v. Brotherhood* (*h*) it was held by the Court of Appeal, on the authority of *Wren v. Weild* (*i*), that a patentee who issued notices against purchasing certain articles, alleging they were infringements of his patent, was not liable to an action by the vendor for damages, provided he issued the Old law as to threatening notices.

(*d*) *United Telephone Co. v. St. George*, 3 R. P. C. 321, 339.

(*f*) Seton, p. 567.

(*g*) *Post*, p. 512.

(*e*) 4 K. & J. 425. See *North Metropolitan Tramways Co. v. London County Council*, [1898] 2 Ch. 145.

(*h*) 19 Ch. D. 386, affirming decision of JESSEL, M.R., 15 Ch. D. 514.

(*i*) L. R. 4 Q. B. 730.

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notices *bonâ fide*, and in the belief that the articles complained of were infringements of his patent. And it was further held that such a patentee was not liable to be restrained by injunction from continuing to issue the notices unless they were proved to be untrue, so that the further issue of them would not be *bonâ fide*; and Lord COLERIDGE, C.J., said (*k*): "If the statement" (as to infringement) "is made in defence of the defendant's own property, although it injures and is untrue, it is still what the law calls a privileged statement; it is a statement that the defendant has a right to make unless, besides its untruth and besides its injury, express malice is proved, that is to say, want of *bona fides* or the presence of *mala fides*." The statements were not actionable if they were made with reasonable and probable cause (*l*). If, however, the statements were not mere allegations of piracy, which is matter of law, but went on to allege, and allege untruly, matters of fact, an action, it seems, would lie. "A man is not bound to be correct in his statement of the law, but he is bound to be correct in his statement of facts" (*m*).

In *Rollins v. Hinks* (*n*), and *Axmann v. Lund* (*o*), MALINS, V.-C., had held that a patentee issuing notices as above was liable to be restrained by injunction if he had no *bonâ fide* intention of bringing an action against the vendor of the articles to assert the validity of his patent. But in *Halsey v. Brotherhood*, JESSEL, M.R., dissented from this view, and held there was no law in this country to compel a man to assert such a right by action. The person might desist, and then there would be no occasion for the action, or he might not be worth suing.

It appears, then, that the above section makes a considerable alteration in the law as to threats of legal proceedings in patent cases. The section imposes an absolute prohibition against a person threatening unless the threatener can bring himself within either of the two saving clauses at the end of the section. The meaning of the section is that a man shall not threaten legal proceedings unless the manufacture to which the threat applies infringes the legal right of the threatener, or unless the threatener is about forthwith to commence an action to show the validity of his threats. And it is *nihil ad rem* to say what he did was *bonâ fide* (*p*).

The question whether the statements of the patentee were in fact true might be tried in the action in which damages or an injunction

(*k*) 19 Ch. D. 388.

(*l*) See judgment of BAGGALLAY, L.J., 19 Ch. D. 390.

(*m*) *Dicks v. Brooks*, 15 Ch. D. 22. See judgment of BRAMWELL, L.J., pp. 39, 40.

(*n*) L. R. 13 Eq. 355.

(*o*) L. R. 18 Eq. 335.

(*p*) See *per* A. L. SMITH, L.J.; see *Skinner v. Shew*, [1893] 1 Ch. 413, 426.

was sought by the party aggrieved (*q*), and if the statements were in fact not true, the plaintiff to obtain an injunction was bound to make out that the defendant intended to persevere in making the representations complained of, although his allegation of infringement by the plaintiff was untrue (*r*). In such a case the injunction would be granted, because after the statements had been, in the presence of the patentee, proved to be false, it would be malicious and fraudulent to continue them (*s*).

But the mere assertion at the trial of the action of a right to issue the notices originally is no evidence of a threat to issue them, in the event of its being decided that there was no infringement (*t*).

In such an action the burden of proof that the patentee's statements are false lay on the plaintiff (*u*). On the question whether the patentee's statements as to infringement could be justified, the patent, if it had not been repealed by *scire facias*, was assumed to be valid (*x*).

Where after an action for infringement had been commenced a threats action alleging express malice was brought, it was held that in the absence of sufficient evidence no interlocutory injunction could be granted (*y*).

Where, in an action brought before but tried after this Act, it was proved that plaintiff had not infringed, but that the defendant's statements were made *bond fide*, the action was dismissed, but, each party having been partially successful, without costs (*z*). But in actions since the Act it is *nihil ad rem* to say that what the defendant did was *bond fide*, or that what he did was on a privileged occasion (*a*).

Where an action for an injunction to restrain the issue of circulars, etc., alleging infringement of a patent, had been commenced before the Act, a summons taken out after the action had been set down for trial (which summons was not, however, heard till after the Act), that the statement of claim might be amended by adding a claim for a declaration that the plaintiffs had not infringed the defendant's patent or if they had that the patent was invalid, was dismissed (*b*).

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(*q*) *Halsey v. Brotherhood*, 15 Ch. D. 518, judgment of JESSEL, M.R. and *Burnett v. Tak*, 45 L. T. (N.S.) 743.

(*r*) Per JESSEL, M.R., *Halsey v. Brotherhood*, 15 Ch. D. 523.

(*s*) Per KAY, J., *Burnett v. Tak*, 45 L. T. (N.S.) 743. See also *Household v. Fairburn*, 1 R. P. C. 109; *Sugg v. Bray*, 2 R. P. C. 224, 246.

(*t*) *Sugg v. Bray*, *ubi supra*.

(*u*) *Burnett v. Tak*, cited above; and see *Anderson v. Liebig's Extract*

of Meat Co., 45 L. T. (N.S.) 757, 759.

(*x*) Per BAGGALLAY, L.J., in *Halsey v. Brotherhood*, 19 Ch. D. 390, overruling the *dicta* of MALINS, V.-C., on this point, in *Rollins v. Hinks*, cited above.

(*y*) *Dredge v. Parnell*, 13 R. P. C. 392.

(*z*) *Sugg v. Bray*, 2 R. P. C. 224.

(*a*) Per A. L. SMITH, L.J., *Skinner v. Shew*, [1893] 1 Ch. 413, 426.

(*b*) *Sugg v. Bray*, 1 R. P. C. 45.

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“Any person claiming to be the patentee.”—Only persons “claiming to be the patentees” can be sued under this section, and therefore where a threats action was brought against the agents of the owner of the patent, and it was proved that they had acted *bonâ fide*, the action was dismissed (c).

“By circulars advertisements or otherwise.”—The words “or otherwise” are words to which an enlarging effect should be given so as to increase the methods by which an actionable threat can be made (d). And a private letter from the patentee (e) or his solicitor (f) threatening proceedings for infringement, and whether addressed to the infringer himself or a third person (g), is within this section. So also threats may be made by a letter in answer to inquiries (h) or at a personal interview, and by correspondence, although the interview and correspondence were with a view to a settlement and “without prejudice” (i).

And a letter may be a threat within the section, though it does not in terms refer to any patent in particular or set forth that the letter is written on behalf of a person claiming as patentee (k).

If the patentee complains not of the actual use of plaintiff's apparatus but of the use of certain apparatus in such a way as to infringe, he must make this clear in any circular or threat which he issues (l).

If a letter threatening proceedings is not withdrawn, it is to be taken as being continued (m).

“Threatens any other person,” etc.—In *Challender v. Royle* (n) it was said by BOWEN, L.J., that: “The threat must not be merely a warning about something that is going to be done, but must be a threat about an act done, a threat of legal proceedings in respect of an alleged manufacture, use, sale, or purchase of the invention, not in respect of a proposed manufacture, use, sale, or purchase. . . . Everybody has still a right to issue a general warning to infringers not to infringe, and to warn the public that the patent to which the patentee is entitled, and under which he claims, is one which he

(c) *Temler v. Stevenson*, 15 R. P. C. 24.

(d) Per A. L. SMITH, L.J., *Skinner v. Shew*, [1893] 1 Ch. 427. See also *Crampton v. Patents Investment Co.*, 5 R. P. C. 382, 393.

(e) *Walker v. Clarke*, 4 R. P. C. 113.

(f) *Driffield, etc. Co. v. Waterloo, etc. Co.*, 31 Ch. D. 638; *Combined Weighing etc. Co. v. Automatic Weighing Machine Co.*, 42 Ch. D. 665.

(g) *Skinner v. Shew*, [1893] 1 Ch. 413.

(h) *Skinner v. Shew*, [1893] 1 Ch. 413.

(i) *Kurtz v. Spence*, 5 R. P. C. 161, 172, 173. As to letters “without prejudice,” see *Walker v. Wilsher*, 23 Q. B. D. 335.

(k) *Douglass v. Pintsch's Patent Lighting Co.*, [1897] 1 Ch. 176.

(l) *Burt v. Morgan*, 4 R. P. C. 279.

(m) *Driffield, etc. Co. v. Waterloo etc. Co.*, 31 Ch. D. 638, 643.

(n) 36 Ch. D. 425.

intends to enforce." But "it does not follow that because a threat is so worded as grammatically to apply only to the future, therefore it may not in any particular case be in substance and in fact applicable to what has been done."

And in *Ungar v. Sugg* (o) it was said by WRIGHT, J., that the "section does not subject a patentee to an action for publishing a general statement that he claims to be the owner of a valid patent which covers all articles of a particular description, or that he has an action pending against a third party for infringement unless that statement is in fact meant or calculated to operate as a threat."

But when a circular stated that information of extensive violation of the patent rights had been received, and that all parties were warned not to infringe those rights, it was held that the circular was a threat within the section (p).

Where a defendant had consented to an injunction restraining him from representing that D.'s Little Fire Queen Extinguishers were infringements of his patent, it was held, on a motion to commit for breach of injunction, that evidence that defendant had stated that all conical-shaped fire extinguishers were infringements, and that the manufacture by the plaintiff of extinguishers similar in shape to defendant's was an infringement, was not enough to justify a committal (q).

"Any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction," etc.—A person may be aggrieved within this section, though the threats are not addressed to himself (r).

In *Barney v. United Telephone Co.* (s), it was held that, to obtain an interlocutory injunction under this section, the applicant must show as a condition precedent that there is no infringement, and that if on the motion for injunction a case of alleged infringement is raised by the respondent's affidavits the motion will not be granted, although the respondent declines to take legal proceedings in respect of such infringement. This view of the section was dissented from in *Walker v. Clarke* (t), though the injunction was, under the circumstances, refused.

And in *Challender v. Royle* (u), it was held by the Court of Appeal that to obtain an interlocutory injunction under this section the plaintiff

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(o) 8 R. P. C. 385.

(p) *Johnson v. Edge*, [1892] 2 Ch. 1.(q) *Diok v. Haslam*, 8 R. P. C. 196.(r) *Burt v. Morgan*, 4 R. P. C. 278; *Walker v. Clarke*, 4 R. P. C.111, 114; *Challender v. Royle*, 36 Ch. D. 425; *Johnson v. Edge*, [1892] 2 Ch. 1.

(s) 28 Ch. D. 394.

(t) 4 R. P. C. 114.

(u) 36 Ch. D. 425.

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must make out a *prima facie* case that the matter to which the threats related is not, in fact, an infringement, and that, unless this is done, the court will not interfere on the mere balance of convenience and inconvenience.

In *Société Anonyme des Manufactures de Glaces v. Tilghman's Patent Sand Blast Co. (v)*, a case before the Act, it was said that generally, where circulars of this kind are honestly issued, the court will not interfere at least till the hearing of the cause, unless there is some strong *prima facie* case on the evidence before the court of the violation of some contract entered into between the plaintiff and defendant.

But if on the balance of the evidence on the motion the court considers that the plaintiff has not infringed, and if, further, the defendant does not bring an action, the interlocutory injunction will be granted (*w*). And when there is a doubt as to the infringement, the fact that the defendant refrains from bringing an action will be taken into consideration by the court in forming an opinion whether he has any rights within this section (*x*).

Where an action was brought to restrain the issue, by a company who were only limited exclusive licensees, of circulars within this section, and the patentees subsequently commenced against the plaintiff an action for infringement in which the company had applied to be joined as co-plaintiffs, a motion for an injunction in the first action was ordered to stand over till the result of the infringement action should be known, with liberty to any person to apply, all question of costs being reserved (*y*).

Where the patentee, defendant to an action seeking to restrain the issue of circulars alleging infringement, brought an action against the plaintiff for infringement, the court, in the absence of *mala fides*, or breach of contract, refused to grant an injunction pending the trial of the infringement action, the patentee undertaking to prosecute this latter action with due diligence; and the injunction action was stayed meanwhile (*z*); and this undertaking not having been observed, the injunction was subsequently granted (*a*). And in *Mackie v. The Solvo Laundry Supply Co. (b)*, where the infringement action was commenced after the notice of motion for injunction, but before the hearing of the motion, on the defendant disclaiming any intention of issuing further

(*v*) 25 Ch. D. 9.

(*w*) *Colley v. Hart*, 6 R. P. C. 17.

(*x*) *Colley v. Hart, ubi supra*.

(*y*) *Barnett v. Barrett's Screw Stopper Bottling Co., Limited*, 1 R. P. C. 9.

(*z*) *Household v. Fairburn*, 1 R. P. C. 109. See also *Combined*

Weighing, etc. Co. v. Automatic Weighing Machine Co., 6 R. P. C. 502, 504, 42 Ch. D. 665, where, however, the threats action was not stayed.

(*a*) *Household v. Fairburn*, 2 R. P. C. 140.

(*b*) 9 R. P. C. 465.

threats and undertaking to prosecute the infringement action diligently, no order was made except that the costs should be costs in the action.

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But the threats action will not be stayed if the infringement action is only in respect of one of several patents mentioned in the threats action (c).

NOTE.

Where there was a question whether certain letters complained of were intended as threats, and the defendants disclaimed any intention to threaten, the motion for injunction was ordered to stand to the trial with liberty to the plaintiff to bring it on on two days' notice (d).

It appears that application under this section ought not to be made *ex parte* (e).

An objection that the acts alleged are not threats within the Act cannot be taken as a preliminary objection on the trial of the action (f).

The interlocutory injunction should in form restrain the defendant from issuing the particular circular and "from by circular letters or otherwise threatening any person with proceedings or liability in respect of the following articles manufactured by the plaintiff" (g). Form of injunction.

In an action against a patentee for falsely alleging infringement, the defendant may be ordered to deliver particulars showing in what respect plaintiff's machines are alleged to infringe defendant's patent, and pointing out, by reference to pages and lines of defendant's specification, which part of the invention therein described he alleges to have been infringed (h). Particulars in threats actions.

The plaintiff may be ordered to give particulars of the threats complained of (i) and of the names of the defendant's agents whom he alleged made the threats (k).

Where particulars of objections which had been delivered with the statement of claim in a threats action were insufficient, it was held that the defendants were entitled to further particulars before delivering their defence (l).

In an action under this section the plaintiffs, as a condition of being allowed to raise the question whether they could successfully impeach

(c) *Dowson v. Drosophore Co.*, 12 R. P. C. 95.

(d) *Douglass v. Pintsch's Lighting Co.*, 13 R. P. C. 60.

(e) *Wilson v. W. E. Church Engineering Co.*, 2 R. P. C. 175; *Commercial Development Corporation v. Castner-Kellner Alkali Co.*, 14 R. P. C. 939.

(f) *Kurtz v. Spence*, 5 R. P. C. 161, 170.

(g) *Colley v. Hart*, 6 R. P. C. 17, 22.

(h) *Wren v. Weild*, L. R. 4 Q. B. 213.

(i) *Law v. Ashworth*, 7 R. P. C. 86.

(k) *Dowson v. Drosophore Co.*, 11 R. P. C. 536.

(l) *Law v. Ashworth*, 7 R. P. C. 86.

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the validity of the patent, were ordered to give to the defendants the same rights as to objections, and to allow them the same right of beginning and replying as the defendants would have had if an action had been brought by them to restrain the violation of their patent (*m*).

But where the threats complained of were contained in an advertisement referring generally to the defendants' patents, the order that the plaintiffs should deliver particulars of objections was made conditional upon the defendants first giving a list of the patents on which they relied as justifying their threats. And the plaintiffs agreed to amend their statement of claim by confining their allegation of invalidity to these particular patents (*n*).

Where the plaintiffs alleged that they had suffered damages by the threats, and had been compelled to indemnify customers continuing to purchase from them, it was held that they were not bound to furnish the names of those customers (*o*).

"And may recover such damages," etc.—Where no special damage was proved, and the plaintiffs, who had a rival patent which was alleged to infringe the defendants' patent, had only worked their process to a small extent, and had not as yet erected machinery for carrying out their process, and the threats were made in the course of a correspondence as to the relative rights of the parties under the rival patents, it was held that the circumstances under which the threats were made precluded the notion that serious damage was sustained, and the court refused to direct a reference, and itself assessed the damages at 40s. (*p*).

The necessity of suspending building operations and of making inquiries into the alleged infringement are not of themselves grounds for damages in an action by the person threatened (*q*).

The defendants are liable for damages caused by their own threats, not for damages caused by threats made by their travellers without their authority and without their knowledge (*r*).

Where a contract, providing that S. should have the exclusive right to buy the plaintiffs' patented article and should take a minimum quantity yearly, fell through on account of the defendant's threats, it was held that the measure of damages was the lost profits of the contract and not the difference between that amount and what the

(*m*) *Kurtz v. Spence*, 36 Ch. D. 770.

(*n*) *The Union Electrical Power and Light Co. v. The Electrical Power Storage Co.*, 38 Ch. D. 325.

(*o*) *Law v. Ashworth*, 7 R. P. C. 86.

(*p*) *Kurtz v. Spence*, 5 R. P. C. 161, 177.

(*q*) *Driffield, etc. Co. v. Waterloo, etc. Co.*, 3 R. P. C. 48; 31 Ch. D. 638.

(*r*) *Ungar v. Sugg*, 9 R. P. C. 113.

plaintiffs might have made if they had gone on manufacturing the articles and sold them in the market (s).

When it was shown that all the falling off in the plaintiff's trade was due to the defendant's threats, but that some damage had been inflicted on the leading branch of his business, it was held to be reasonable to ascribe some damage to his general business also (t).

The difficulty of assessing the damages is no ground for giving only a nominal sum (u).

"Was not in fact an infringement of any legal rights," etc.— In *Kurtz v. Spence* (x) it was held that under this section only the question of infringement could be tried, and an allegation of the invalidity of the defendants' patent was ordered to be struck out of the statement of claim. In the subsequent case of *Challender v. Royle* (y), an opinion was expressed by COTTON and BOWEN, L.JJ., disapproving of the above decision. The plaintiffs in *Kurtz v. Spence* accordingly applied to the Court of Appeal for leave to appeal from the order striking the above-mentioned allegation from the statement of claim, notwithstanding the time for appealing had expired, and applied also to the judge before whom the action was set down for trial for leave to amend the pleadings by adding the allegation above mentioned. The judge refused this leave and both applications came on before the Court of Appeal. The leave to appeal was refused, but the majority of the court, FRY, L.J., *diss.*, gave leave to amend the statement of claim as desired, upon payment by the plaintiffs of the costs, as between solicitor and client, of the application, and of all costs thrown away in consequence of the amendment not having been made on the day following the order of the court below, and upon the plaintiffs undertaking to deliver particulars of objections and to give the defendants the right at the trial to begin and reply on the question of the validity of the patent (z).

When the action was ultimately tried, however, it was found inconvenient thus to limit the defendants' right, and they were allowed to open and reply on the whole case (a).

In *Herrburger v. Squire* (b), where the defendant by counterclaim alleged infringement of his patent and claimed the usual relief, this course was not followed and the action was tried in the usual way.

In *Challender v. Royle* there was no final judgment though there was an expression of opinion that the question of the validity of the

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NOTE.

(s) *Skinner v. Perry*, 11 R. P. C. 406, 420.

(t) *Ungar v. Sugg*, 8 R. P. C. 385; 9 R. P. C. 115.

(u) *Ungar v. Sugg*, *ubi supra*.

(x) 33 Ch. D. 579; 3 R. P. C. 368.

(y) 36 Ch. D. 425.

(z) *Kurtz v. Spence*, 36 Ch. D. 770.

(a) 5 R. P. C. 176.

(b) 5 R. P. C. 681.

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patent might be raised in an action under this section (c). But the question was raised on the trial of *Kurtz v. Spence*, and it was decided in that action that the words "legal rights" in the section meant rights enforceable in a court of law, and that the defendants could not protect themselves by the mere production of their letters patent, but were bound to support them as if plaintiff in an action for infringement (d). And, accordingly, in a threats action under this section when the defendant's patent is found invalid the injunction will be granted (e), and when the patent is found to be valid and infringed the action will fail (f).

A company having only an agreement with the registered proprietor for the assignment of the patent has no "legal rights" within the meaning of this section (g).

If the statement of claim does not allege the invalidity of the patent, the allegation may be made by reply subject to the defendant's right in that case to put in a special rejoinder (h).

"Provided that this section shall not apply," etc.—It is not necessary in order to be within the proviso that the action for infringement should be brought after the threats action, or that it should be an action in which the validity of the patent can be tried (i).

But an action for infringement pending at the time when the threats were made is not within the proviso when the infringement complained of is different from that which was the subject of the threats (k). So, also, where though the action for infringement was brought by the patentee, the threats were made not by him but by a company who had only an agreement with him for the assignment of the patent upon terms which were not disclosed to the court (l).

The defendant in a threats action is not bound to assert his right by defence or counterclaim, but may bring a separate action for infringement (m). But in such a case some arrangement should be made to avoid the unnecessary costs of trying the same action in different

(c) 36 Ch. D. 443.

(d) 5 R. P. C. 161, 177. See also *Crampton v. Patents Investment Co.*, 5 R. P. C. 382, 393; *Herrburger v. Squire*, 5 R. P. C. 581.

(e) *Kurtz v. Spence*, 5 R. P. C. 161. *Herrburger v. Squire*, *ubi supra*.

(f) *Crampton v. Patents Investment Co.*, 5 R. P. C. 382, 404. And see *Automatic Weighing Machine Co. v. Combined Weighing Machine Co.*, 6 R. P. C. 120, 125.

(g) *Kensington, etc. Electric Lighting Co. v. Lane Fox Electrical Co.*, [1891] 2 Ch. 573.

(h) *Dowson v. Drosophore Co.*, 12 R. P. C. 95.

(i) *Per NORTH, J., Barrett v. Day*, 43 Ch. D. 435, 447.

(k) *Combined Weighing Machine Co. v. Automatic Weighing Machine Co.*, 42 Ch. D. 665.

(l) *Kensington, etc. Electric Lighting Co. v. Lane Fox Electrical Co.*, [1891] 2 Ch. 573. But see *Incan- descent Gas Light Co. v. New In- candescent, etc. Co.*, 76 L. T. (N.S.) 47.

(m) *Combined Weighing Machine Co. v. Automatic Weighing Machine Co.*, 42 Ch. D. 665.

forms (*n*). And where this was not done, and the plaintiff in the threats action had offered to stay proceedings till the trial of the infringement action and the offer was refused by the defendants, and the actions came on for trial together, the threats action was dismissed without costs, although the plaintiffs were held not to have infringed the patent (*o*).

Where by reason of the proviso being complied with the section does not apply, the case stands upon the old law, and in the absence of malice, an interlocutory injunction will not be granted (*p*). On the trial the threats action will in such a case be dismissed, although there has been no infringement (*q*). So, also, where the patent was shown in the infringement action to be invalid (*r*).

Where there was an action for threats and a cross-action for infringement, and at the trial the court, being of opinion that there was an infringement, dismissed the threats action with costs, and on appeal the judgment in the infringement action was reversed, the Court of Appeal referred the threats action back to the judge (*s*).

The section does not apply to threats relating to trade marks (*t*).

"With due diligence commences and prosecutes," etc.—If the action for infringement is commenced and prosecuted with due diligence the section does not apply (*u*). And therefore, where, after the commencement of the threats action, the patentee commenced and prosecuted with due diligence an action for infringement in which he failed, the threats action was dismissed (*x*).

So, also, where the infringement action was commenced and prosecuted with due diligence after the threat, a subsequent threats action was stayed as being vexatious within S. C. R. Order XXV., r. 4 (*y*).

The words "with due diligence" do not mean that the action must be commenced with due diligence from the time when the defendant first knew that the plaintiff was doing what the defendant alleges to be an infringement, but within a reasonable time after the threats have

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NOTE.

(*n*) *Automatic Weighing Machine Co. v. Combined Weighing Machine Co.*, 6 R. P. C. 367; *Combined Weighing Machine Co. v. Automatic Weighing Machine Co.*, 42 Ch. D. 665.

(*o*) *Combined Weighing Machine Co. v. Automatic Weighing Machine Co.*, 42 Ch. D. 665.

(*p*) *Incandescent Gas Light Co. v. Sunlight Incandescent, etc. Co.*, 14 R. P. C. 180; *Temler v. Stevenson*, 15 R. P. C. 24.

(*q*) *Colley v. Hart*, 44 Ch. D. 179; 7 R. P. C. 101, 114; *Combined*

Weighing Machine Co. v. Automatic Weighing Machine Co., 42 Ch. D. 665

(*r*) *Sharp v. Brauer*, 3 R. P. C. 193.

(*s*) *Automatic Weighing Machine Co. v. Combined Weighing Machine Co.*, 6 R. P. C. 367, 371.

(*t*) *Colley v. Hart*, 6 R. P. C. 17.

(*u*) *Per KEKEWICH, J., Combined Weighing Machine Co. v. Automatic, etc. Co.* 42 Ch. D. 665.

(*x*) *Combined Weighing Machine Co. v. Automatic, etc. Co., ubi supra.*

(*y*) *Barrett v. Day*, 43 Ch. D. 435.

Sect. 32. been made (s). And an interval of three months is not an unreasonable time for a man to consider whether he should bring an action in respect of a supposed infringement of his patent (a).

NOTE.

But there is no hard and fast rule (b). And a patentee is not guilty of unreasonable delay if, after the commencement of the threats action, he waits to see if he cannot combine the two causes of action in one action and proceed by counterclaim (c).

And where the threats had been going on for a long time, during which the parties had been negotiating as to the use of the patent, and the plaintiff at last brought an action for threats and moved for injunction, and the defendants, after inspecting the plaintiff's machine, brought their action for infringement, it was held that there was no want of due diligence (d).

But when threats were made in October, 1886, and no proceeding to restrain infringement was taken by the patentee till after the commencement, in October, 1887, of an action under this section, in which the patentee by counterclaim alleged infringement, and claimed the usual relief, it was held that the patentee had not shown "due diligence" within the proviso (e).

And where after the commencement of a threats action the patentees brought their action for infringement, and undertook to prosecute it with diligence, and did not comply with their undertaking, the injunction was granted (f).

And when the infringement action is set down by the defendant, that is *prima facie* evidence of want of due diligence in the prosecution of the action (g).

Where the patentee has brought his action for infringement, it would seem that, if it is prosecuted with due diligence, there is no ground for the court to interfere against him merely because he has not applied for an interlocutory injunction in his action (h).

Action need not be prosecuted to judgment.

It is not necessary in order to be within the proviso that the infringement action should be prosecuted to recovery of judgment if the action has been brought and prosecuted with due diligence. The

(z) *Per* COTTON, L.J., *Challender v. Royle*, 36 Ch. D. 437.

(a) *Challender v. Royle*, *ubi supra*; *Colley v. Hart*, 44 Ch. D. 179.

(b) See *Colley v. Hart*, 44 Ch. D. 179, 187.

(c) *Colley v. Hart*, *ubi supra*.

(d) *Edlin v. Pneumatic Tyre, etc. Agency*, 10 R. P. C. 311.

(e) *Herrburger v. Squire*, 5 R. P. C. 581.

(f) *Household v. Fairburn*, 2 R. P. C. 140.

(g) *Combined Weighing Machine Co. v. Automatic Weighing Machine Co.*, 42 Ch. D. 665, 673.

(h) *Anderson v. Liebig's Extract of Meat Co.*, 45 L. T. (N.S.) 757.

threats action in such a case will be dismissed, although the infringement action is discontinued (*i*).

And this rule was applied where the threats had been *bond fide* made in respect of three patents, and one of them was dropped out of the action for infringement (*j*).

But, where, in an action under this section, it was shown that a previous action for infringement brought by the defendant (the patentee) against the plaintiff had been discontinued, each party bearing certain costs, it was held that the defendant in the threats action was not protected by the proviso, even though the plaintiff in that action had failed to pay the agreed costs of the infringement action (*k*).

The proviso will be satisfied if the patentee with due diligence commences and prosecutes an action for infringement, even though it be against a different person from the person aggrieved by the patentee's threats; it is sufficient if it be brought against any person to whom the threat has been made (*l*).

Where the owner of the patent had brought an action for infringement, exclusive licensees from him with an option of purchase were held to be within the proviso (*m*).

The action for infringement must be an honest action, honestly brought in order to test the validity of the patent or the fact of infringement, whichever may be in question (*n*). And where the proceedings for infringement were only commenced by amendment of an existing action instituted for another purpose, and were abandoned almost as soon as put forward, it was held that the action was not within the proviso (*o*).

Where, by consent in a threats action, the motion for injunction was treated as the trial, and it was admitted that the defendants had not brought, and did not intend to bring, an action for infringement, and that as proceedings for amendment of their specification were pending, they were not in a position to bring such an action, the injunction was granted with an inquiry as to damages (*p*).

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NOTE.

Against and by whom action may be brought.

Infringement action must be *bond fide*.

(*i*) *Colley v. Hart*, 44 Ch. D. 179; 7 R. P. C. 101; *English and American Machinery Co. v. Gare*, 11 R. P. C. 627; *Temler v. Stevenson*, 15 R. P. C. 24.

(*j*) *Temler v. Stevenson*, *ubi supra*.

(*k*) *Crampton v. Patents Investment Co.*, 5 R. P. C. 382, 393.

(*l*) *Challender v. Royle*, 36 Ch. D. 425.

(*m*) *Incandescent Gas Light Co. v. New Incandescent Gas, etc. Co.*, 76 L. T. (N.S.) 47. But see *Kensington, etc. Co. v. Lane Fox, etc. Co.*, [1891] 2 Ch. 573.

(*n*) *Challender v. Royle*, *ubi supra*.

(*o*) *Johnson v. Edge*, [1892] 2 Ch. 1.

(*p*) *Skinner v. Shew*, [1893] 1 Ch. 413.

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NOTE.

To be within the proviso, the action must be an action for infringement in respect of the same manufacture, sale, or use as that to which the threats relate (*q*).

Advertisements by patentee licensor.

A patentee who has agreed to grant a licence will not be allowed, pending the settlement of disputes as to the validity of the agreement and the form of the licence, to publish advertisements and circulars, which will have the effect of deterring usual customers or the public from dealing with the licensee (*r*).

But the owners of English and foreign patents for the same invention, who have granted to a foreign firm a licence for the use of it in the foreign country and not elsewhere, will not be restrained at the suit of the foreign licensees from issuing circulars warning the trade that the importation into and sale in England of articles made abroad according to the invention is an infringement of the English patent (*s*).

Pending an action for infringement, a plaintiff is not at liberty to advertise a positive statement that the defendants have infringed (*t*), or simply that users of particular articles are liable to damages and injunction (*u*), but there is no objection to an advertisement stating the fact of the action having been brought and warning others from infringing (*x*).

An advertisement stating that in an action complaining of a certain alleged representation by the defendant, the defendant was ordered to give an undertaking not to make the representation when in fact he had volunteered the undertaking, and upon that the court had dismissed the action, was restrained as untrue and injurious to the plaintiff's trade (*y*). So, also, an advertisement by the plaintiff containing a report of the proceedings on a motion, and placing in heavily leaded type the statement of the plaintiff's counsel only, was held to be a contempt of court (*z*).

Plaintiffs who have brought an action for infringement, and in that action have obtained from the court liberty to apply to the Patent Office for leave to amend, are not entitled, pending the proceedings in

(*q*) *Combined Weighing Machine Co. v. Automatic Weighing Machine Co.*, 42 Ch. D. 665, 670.

(*r*) *Clark v. Adie*, 21 W. R. 456; affirmed on appeal, *ibid*, 764. See also *Guyot v. Thomson*, [1894] 3 Ch. 388.

(*s*) *Société Anonyme des Manufactures de Glaces v. Tilghman's Patent Sand Blast Co.*, 25 Ch. D. 1.

(*t*) *Gaulard v. Lindsay*, 4 R. P. C. 189.

(*u*) *Fenner v. Wilson*, 10 R. P. C. 283.

(*x*) *Gaulard v. Lindsay*, 4 R. P. C. 189; *Incandescent Gas Light Co. v. Sunlight, etc. Co.* 14 R. P. C. 180. See also *Nähmaschinen Fabrik v. Singer Manufacturing Co.*, 10 R. P. C. 310.

(*y*) *Hayward v. Hayward* 34 Ch. D. 198.

(*z*) *Edlin v. Pneumatic Tyre, etc. Agency* (2), 10 R. P. C. 317.

the Patent Office, to issue notices threatening customers of the defendants (a). Sect. 32.

In such a case, it seems that the defendants seeking an injunction ought to undertake at the proper time to put in a counterclaim (b).

NOTE.

Miscellaneous.

33. Every patent may be in the form in the First Schedule to this Act, and shall be granted for one invention only, but may contain more than one claim; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention. Patent for one invention only.

“Every patent may be in the form,” etc.—The form in the first schedule does not contain any condition avoiding the patent if the specification is insufficient which has hitherto been contained in all letters patent. But the use of this form is not obligatory, and under s. 116 the Crown may, if it is found necessary, insert such a condition in the patent.

“One invention only.”—The general object of the invention is the test by which the question of one invention is to be decided. If there is a particular general object and two or three devices of an analogous nature, cognate devices, for carrying it into effect, then they are all one invention. If, however, there is no common purpose, so that it might be said, “I use this as a substitute for that,” both serving the same purpose though there is some difference between them, but they are to serve some different purpose, then the devices are different inventions (c).

Alternative devices for producing a particular object would be one invention (d).

A combination and all the subordinate parts of that combination, so far as claimed to be used for the one main purpose, may be included in one patent; but if a subordinate part, or one of the elements of the combination, is claimed for a purpose independent of the purpose of the combination, then there is an extra invention and it is not all one (d).

Thus where the law officer held that the applicant had invented, first an improved cock or arrangement of cocks, which he described as

(a) *Fusce Vesta Co. v. Bryant & May* (2), 4 R. P. C. 191.
(b) *Ibid.*

(c) See *per* HERSHELL, S.-G., *Jones' Patent*, Griffin, P. C. 265.
(d) *Jones' Patent, ubi supra.*

Sect. 33. applicable not only to geysers and the particular apparatus described by him, but also to other apparatus, and *second* an apparatus for an improved geyser consisting of a combination of several parts of which one was his new and improved arrangement of cocks, the applicant was not allowed to include both the inventions in one patent (*e*).

NOTE.

Use of the words "other purposes."

Under this section the applicant has been directed to omit from his title the words "a part of which improvement is applicable to other purposes," and also to omit corresponding words from his provisional specification (*f*).

When the application was for "improvements in the art of producing and utilising induced electrical currents *for telegraphy and other purposes*," the invention, consisting in the employment in telegraphic transmitting and receiving instruments of a certain appliance, **HERSOEELL, S.-G.**, gave the applicant the option of protecting the appliance for all purposes, or of protecting improved telegraphic apparatus which consisted in the employment of the appliance therein, and the applicant electing to take the former alternative the title was altered by the omission of the words in italics, and the description of the telegraphic apparatus was struck out of the provisional specification (*g*).

Where the provisional specification did not sufficiently point out the common purpose which bound together the respective parts as one invention, the law officer required words to be inserted showing to his satisfaction that they had one common object (*h*).

If by inadvertence more than one invention is included, the application may, after the comptroller's refusal to accept it, be amended and separate patents may be applied for, but such application shall, if the applicant so desires, bear the date of the first application, and is together therewith to proceed as if such application had been originally made on that date (*i*).

If an invention omitted from the original application is claimed separately in a contemporary application, and is also part of the combination claimed by the original application, the latter should be amended so as to refer to the contemporary application (*k*).

Patent on application of representative of deceased inventor.

34.—(1.) If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.

(*e*) *Hearson's Patent*, Griffin, P. C. 266.

(*f*) *Hearson's Patent*, *ubi supra*.

(*g*) *Robinson's Patent*, Griffin, P. C. 267.

(*h*) *Jones' Patent*, Griffin, P. C. 265.

(*i*) P. R. r. 19, *post*.

(*k*) *Hearson's Patent*, Griffin, P. C. 266.

(2.) Every such application (*l*) must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention. Sect. 34 (2).

This section alters the law as it was before the Act. In *Marsden v. The Saville Street Foundry and Engineering Co.* (*m*) it had been held that the legal personal representative of a person who had made an invention, but who had not taken out letters patent, could not take out such letters patent.

35. A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection. Patent to first inventor not invalidated by application in fraud of him.

This section substantially re-enacts s. 10 of the Act of 1852. Under that Act it was held that where, on an opposition to the sealing of a patent on the ground of previous public user of the invention, the applicant alleged that such user took place in consequence of a fraud which, under the Act, would destroy its effect, such a question ought to be tried by a jury, and that the patent ought to be sealed, so that an opportunity for such trial might be given (*n*).

36. A patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only. Assignment for particular places.

The corresponding section (s. 35) of the Act of 1852 was that a patentee might "assign the letters patent for England, Scotland, and Ireland respectively as effectually as if the letters patent had been originally granted to extend to England or Scotland or Ireland only."

On this section it was said by the Court of Common Pleas that the Legislature appeared "to consider and treat the grants for England, Ireland, and Scotland, although in future they might be technically contained in one instrument under the Great Seal, as separate and separable grants in substance and operation" (*o*).

(*l*) P. R. r. 20.

(*m*) 3 Ex. D. 203.

(*n*) *Re Vincent's Patent*, L. R.

2 Ch. 341. See as to this *Stuart's Patent*, 9 R. P. C. 452.

(*o*) *Borill v. Finch*, L. R. 5 C. P. 533. See *post*, s. 110.

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NOTE.

Where a patentee had granted an exclusive licence for the use of an invention within a limited district, and afterwards sold outside the district certain of the patented machines to persons who sold them, also outside the district, to the defendants, and the defendants without notice of the exclusive licence used the machines within the district, an injunction at the suit of the exclusive licensee seeking to restrain the defendants from such user was refused (*p*).

So, also, where the defendants had purchased from a licensee for a limited district, certain of the patented articles and afterwards sold them outside the district, it was held that patentee could not interfere with such sales (*q*).

Loss or
destruction of
patent.

37. If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the comptroller, the comptroller may at any time cause a duplicate thereof to be sealed (*r*).

This section is a re-enactment in effect of s. 22 of the Act of 1852.

Proceedings
and costs
before law
officer.

38. The law officers may examine witnesses on oath and administer oaths for that purpose under this part of this Act, and may from time to time make, alter, and rescind rules regulating references and appeals to the law officers and the practice and procedure before them under this part of this Act; and in any proceeding before either of the law officers under this part of this Act, the law officer may order costs to be paid by either party, and any such order may be made a rule of the court.

The power to the law officers to examine witnesses on oath was introduced by the present Act. Under the old practice the Lord Chancellor had, in case of opposition, power to examine witnesses *virá voce* (*s*).

“**May make rules.**”—See Law Officers’ Rules, *post*.

“**The law officer may order costs,**” etc.—The comptroller has no power as to costs.

It was held by Lord ELDON, in *Ex parte Fox* (*t*), that where the opposition failed but was not unreasonable no costs would be given.

(*p*) *Heap v. Hartley*, 5 R. P. C. 603. See *S.C.* on appeal, 42 Ch. D. 461.

(*q*) *Smith v. Buchanan*, 26 S. J. 347.

(*r*) See P. R., *post*, Second Schedule, Form N.

(*s*) *In re Gething*, L. R. 9 Ch. 633.

(*t*) 1 Webst. P. C. 431; *S.C.* 1 V. & B. 67.

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NOTE.

But in the later case of *Re Cutler's Patent* (u), Lord COTTENHAM, C., ordered the party who had lodged an unsuccessful *caveat* against the grant of letters patent to pay to the patentee the taxed costs occasioned by the *caveat*, and this notwithstanding the opposition was alleged to be reasonable. And this was the rule under the old practice (x), and *à fortiori* when the conduct of the opponents was open to suspicion (y).

And where objections were filed to the sealing of a patent, but were afterwards withdrawn, the opponent was ordered to pay the costs (z). But where the opponent's affidavits were only filed on the morning of hearing, and he was not allowed to use them, and the opposition failed, Lord CAMPBELL, C., said it was not a case for costs (a).

Where a patent was refused on the ground of previous dedication of the invention by the inventor to the public (b), the petition for patent was dismissed with costs (c).

So, also, where the application was refused on the ground that the invention was the same as in an existing patent (d).

Where, however, the opposition succeeded, but the case was one of first impression, no costs were given (e).

As between rival applicants for patents, the applicant who failed was ordered to pay costs (f). In a case between master and servant, the servant's patent was sealed, but as there appeared to have been some unfairness on the part of the latter, the master's patent was refused without costs (g).

Where the law officer reported in favour of the patent, but terms were imposed on the patentee, no costs were given (h).

Under the new practice the costs as a rule follow the event (i).

But where the opponents appealed from the decision of the comptroller on the ground that the excision of a claim which had been ordered necessitated an alteration in the description contained in the specification, and the applicants assented to this, but had not been asked before the appeal to agree to the modification, and it did not appear to be the fault of the opponents that the matter had arisen, an application

(u) 4 My. & Cr. 510.

(x) *Re Harrison*, L. R. 9 Ch. 632 ;
Re Gething, L. R. 9 Ch. 634.

(y) *Ex parte Scott and Young*,
L. R. 6 Ch. 277.

(z) *Re Copley's Patent*, 8 Jur.
(N.S.) 106 ; *Re Ashenhurst's Patent*,
2 W. R. 3.

(a) *Re McKean's Patent*, 1 D. F. J.
2, 4.

(b) Not now a ground of opposi-
tion. See s. 11 (1), *ante*.

(c) *Re Adamson's Patent*, 6 De G.
M. & G. 420 ; S. C. 25 L. J. Ch. 456.

(d) *Ex parte Yates*, L. R. 5 Ch. 1.

(e) *Ex parte Bates and Redgate*,
L. R. 4 Ch. 577, 580.

(f) *Ex parte Henry*, L. R. 8 Ch.
171.

(g) *Re Lowe's Patent*, 25 L. J. Ch.
456.

(h) *Re Daine's Patent*, 26 L. J. Ch.
298.

(i) *Anderton's Application*, Griffith
L. O. C. 25.

Sect. 38.**NOTE.**

of the applicants for costs was refused, and no costs were allowed (*k*). And where the law officer considered that a statement in one of the applicant's declarations was not quite candid, the applicant, though succeeding in the appeal, was not allowed costs (*l*).

Where an adjournment of the hearing was asked for the purpose of amending a notice of opposition, the adjournment was allowed on payment of costs (*m*).

Where an appeal was withdrawn after the notice of hearing had been given, the appellant was ordered to pay the costs (*n*). And when the appellant did not appear at the hearing, the appeal was dismissed with costs (*o*).

In the absence of any special circumstances, the comptroller, on an appeal to the law officer, neither gives nor receives costs (*p*).

Under the old practice, the taxation of costs in cases of opposition to patents was conducted on the principle on which taxation of costs between party and party in Chancery suits was conducted, and a petition that the applicants might be allowed all costs, charges, and expenses reasonably incurred in consequence of the opposition to the patent was dismissed with costs (*q*). The law officer may now fix the amount of the costs or direct how it is to be ascertained (L. O. R. r. 11, *post*); and this power of naming a specific sum for costs has been exercised in many cases (*r*). And where there were several opponents one sum has been allowed for costs, to be divided among the opponents (*s*).

When the appellant succeeds, the law officer, in fixing the costs, will have regard to the stamp which has been paid on the notice of appeal (*t*). And for this purpose it is desirable that on appeal each party should hand in a statement of what fees have been paid before the law officer (*u*).

The section does not empower the Attorney-General to order payment of costs in case of an abandoned application under s. 26 (4)(b), for his authority to present a petition for revocation of a patent (*x*).

(*k*) *Woodhead's Application*, Griffin, L. O. C. 44.

(*l*) *Anderton's Application*, *ubi supra*.

(*m*) *Lake's Application*, Griffin, L. O. C. 35.

(*n*) *Knight's Application*, Griffin, L. O. C. 35.

(*o*) *Dietz's Patent*, 6 R. P. C. 297.

(*p*) *Lake's Application*, Griffin, L. O. C. 16.

(*q*) *Re Cutler's Patent*, 4 My. & Cr. 511.

(*r*) See *Hall and Hall's Patent*, 5 R. P. C. 285; *Macevoy's Patent*,

ibid; *Sielaff's Application*, 5 R. P. C. 485; *Lake's Patent*, 6 R. P. C. 548, 550; *Stuart's Patent*, 9 R. P. C. 452.

(*s*) *Johnson's Patent*, 13 R. P. C. 659, 664.

(*t*) *Aire and Calder, etc. Works Co. and Walker's Application*, 5 R. P. C. 345; *Wallis and Ratcliff's Application*, *ibid*. 347.

(*u*) *Sielaff's Application*, 5 R. P. C. 484, 486.

(*x*) *Martin's Patent*, Griffin, P. C. 320.

For form of order of law officer for taxation of costs, see Seton, **Sect. 38.**
p. 1980.

As to costs in amendment cases, see *ante*, p. 76.

NOTE.

39. The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely,—

Exhibition at industrial or international exhibition not to prejudice patent rights.

(a.) The exhibitor must, before exhibiting the invention, give the comptroller the prescribed notice of his intention to do so ; and

(b.) The application for a patent must be made before or within six months from the date of the opening of the exhibition.

A re-enactment, with modifications, of the provisions of 28 Vict. c. 3, and 33 & 34 Vict. c. 27. As to proceedings by intending exhibitor of unpatented invention, see P. R. r. 15.

This section is now, by the Act of 1886 (s. 3), *post*, extended to industrial and international exhibitions held out of the United Kingdom.

40.—(1.) The comptroller shall cause to be issued periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that the comptroller may deem generally useful or important.

Publication of illustrated journal, indexes, etc.

(2.) Provision shall be made by the comptroller for keeping on sale copies of such journal, and also of all complete

Sect. 40 (2). specifications of patents for the time being in force, with their accompanying drawings, if any.

(3.) The comptroller shall continue, in such form as he may deem expedient, the indexes and abridgments of specifications hitherto published, and shall from time to time prepare and publish such other indexes, abridgments of specifications, catalogues, and other works relating to inventions, as he may see fit.

Patent
museum.

41. The control and management of the existing Patent Museum, and its contents shall from and after the commencement of this Act, be transferred to and vested in the Department of Science and Art, subject to such directions as Her Majesty in Council may see fit to give.

Power to
require
models on
payment.

42. The Department of Science and Art may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model ; the amount to be settled, in case of dispute, by the Board of Trade.

Foreign
vessels in
British
waters.

43.—(1.) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of Her Majesty's Courts in the United Kingdom, or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connexion with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man.

(2.) But this section shall not extend to vessels of any foreign state of which the laws authorise subjects of such foreign state, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British vessels while in the ports of such foreign state, or in the waters within the jurisdiction of its courts, where such inventions are not so used for the manufacture or preparation of anything

intended to be sold in or exported from the territories of such Sect. 43 (2).
foreign state.

Substantially a re-enactment of s. 26 of the Act of 1852, which altered the law as laid down in *Caldwell v. Vanvlissengen (y)*, where an injunction was granted restraining subjects of the kingdom of Holland from using on board their ships, within the dominions of England, without licence of the plaintiffs, certain propellers made according to the plaintiff's patent.

44.—(1.) The inventor of any improvement in instruments or munitions of war, his executors, administrators, or assigns (who are in this section comprised in the expression the inventor) may (either for or without valuable consideration) assign to Her Majesty's Principal Secretary of State for the War Department (herein-after referred to as the Secretary of State), on behalf of Her Majesty, all the benefit of the invention and of any patent obtained or to be obtained for the same; and the Secretary of State may be a party to the assignment.

Assignment
to Secretary
for War of
certain
inventions.

(2.) The assignment shall effectually vest the benefit of the invention and patent in the Secretary of State for the time being on behalf of Her Majesty, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by the Secretary of State for the time being.

(3.) Where any such assignment has been made to the Secretary of State, he may at any time before the application for a patent for the invention, or before publication of the specification or specifications, certify to the comptroller his opinion that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

(4.) If the Secretary of State so certifies, the application and specification or specifications with the drawings (if any), and any amendment of the specification or specifications, and

Sect. 44 (4). any copies of such documents and drawings, shall, instead, of being left in the ordinary manner at the Patent Office, be delivered to the comptroller in a packet sealed by authority of the Secretary of State.

(5.) Such packet shall until the expiration of the term or extended term during which a patent for the invention may be in force, be kept sealed by the comptroller, and shall not be opened save under the authority of an order of the Secretary of State, or of the law officers.

(6.) Such sealed packet shall be delivered at any time during the continuance of the patent to any person authorised by writing under the hand of the Secretary of State to receive the same, and shall if returned to the comptroller be again kept sealed by him.

(7.) On the expiration of the term or extended term of the patent, such sealed packet shall be delivered to any person authorised by writing under the hand of the Secretary of State to receive it.

(8.) Where the Secretary of State certifies as aforesaid, after an application for a patent has been left at the Patent Office, but before the publication of the specification or specifications, the application, specification or specifications, with the drawings (if any), shall be forthwith placed in a packet sealed by authority of the comptroller, and such packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the Secretary of State.

(9.) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which the Secretary of State has certified as aforesaid.

(10.) No copy of any specification or other document or drawing, by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but save as in this section otherwise directed, the provisions of this part of this Act shall apply in respect of any such invention and patent as aforesaid.

(11.) The Secretary of State may, at any time by writing Sect. 44 (11).
under his hand, waive the benefit of this section with respect
to any particular invention, and the specifications documents
and drawings shall be thenceforth kept and dealt with in the
ordinary way.

(12.) The communication of any invention for any
improvement in instruments or munitions of war to the
Secretary of State, or to any person or persons authorised
by him to investigate the same or the merits thereof, shall
not, nor shall anything done for the purposes of the investi-
gation, be deemed use or publication of such invention so
as to prejudice the grant or validity of any patent for the
same.

Substantially a re-enactment of 22 Vict. c. 13.

Existing Patents.

45.—(1.) The provisions of this Act relating to applications Provisions
for patents and proceedings thereon shall have effect in respecting
respect only of applications made after the commencement of existing
this Act. patents.

(2.) Every patent granted before the commencement of
this Act, or on an application then pending, shall remain
unaffected by the provisions of this Act relating to patents
binding the Crown, and to compulsory licenses.

(3.) In all other respects (including the amount and time
of payment of fees) this Act shall extend to all patents granted
before the commencement of this Act, or on applications then
pending, in substitution for such enactments as would have
applied thereto if this Act had not been passed.

(4.) All instruments relating to patents granted before the
commencement of this Act required to be left or filed in the
Great Seal Patent Office shall be deemed to be so left or filed
if left or filed before or after the commencement of this Act
in the Patent Office.

The provisions of this section have now, or shortly will, become
inoperative by lapse of time; but it has been thought desirable to retain
the following note, somewhat abridged from the earlier editions.

Sect. 45 (4). The effect of sub-s. (3) was that the provisions of this Act as to amendment (z) (ss. 18 and 19) and extension (s. 25) applied to all patents whether existing at the commencement of the Act, or granted on applications then pending, or granted on applications after the commencement of the Act, subject, however, to the provisions of s. 113 (*post*) safeguarding vested rights and interests to the extent to which that section applies (a).

NOTE.

25th section
of Act of
1852.

An important question may arise as to how far existing patents and patents granted on pending applications are affected in regard to s. 25 of the Act of 1852, which is repealed by the present Act and not re-enacted. By that section it was provided that where letters patent "are granted in the United Kingdom for or in respect of any invention first invented in any foreign country, or by the subject of any foreign power or State, and a patent or like privilege for the monopoly or exclusive use or exercise of such invention in any foreign country is there obtained before the grant of such letters patent in the United Kingdom, all rights and privileges under such letters patent shall (notwithstanding any term in such letters patent limited) cease and be void immediately upon the expiration or other determination of the term during which the patent or like privilege obtained in such foreign country shall continue in force; or when more than one such patent or like privilege is obtained abroad, immediately upon the expiration or determination of the term which shall first expire or be determined of the several patents or like privileges. Provided always, that no letters patent for or in respect of any invention for which any such patent or like privilege as aforesaid shall have been obtained in any foreign country, and which shall be granted in the said United Kingdom after the expiration of the term for which such patent or privilege was granted, or was in force, shall be of any validity."

Section 113, *post*, provides that the repeal effected by the present Act shall not affect the past operation of any of the enactments repealed.

It may well happen that there were, at the commencement of this Act, English patents posterior in date to foreign patents for the same invention, but which foreign patents have expired or otherwise determined. In such cases it would seem that under the above provision of s. 113 those English patents are void, and that advantage may after the Act be taken of that fact in any proceeding respecting the patent.

So also if the foreign patent was in force at the commencement of this Act, the subsequent English patent by virtue of s. 113, is subject to

(z) See *Singer v. Stassen*, 1 R. P. C. 121, 125, 126.

(a) *Singer v. Stassen*, *ubi supra* judgment of BOWEN, L.J.; *Brandon's Patent*, 9 App. Cas. 589.

the liability to fail if the foreign patent subsequently expire or be determined (b). Sect. 45 (4).

In view of the possible application above suggested of the provisions of s. 25 of the Act of 1852 to certain existing patents, the following short statement of the effect of the decided cases may be useful.

NOTE.

Under that section it was held :—

That it did not apply at all to the case of an English patent obtained before any foreign patent was taken out, whether the patent were granted to an Englishman (c) or to a foreigner (d).

That where the English patent was subsequent to the foreign patent, and the latter ceased or became void, the English patent became void also (e), and this whether the English and foreign patentees were or were not independent inventors (f).

That, even if the foreign patent were void *ab initio*, s. 25 would apply, and that the existence of a void foreign patent was not equivalent to there being no foreign patent (g).

That if the foreign law required a formal declaration of *déchéance* in order to determine a patent, the English court would consider the English patent in force until that declaration were actually obtained (h).

That, for the purposes of the section, the date when the foreign patent was perfected, and not the day on which it is dated, is to be considered as the day when the patent was “obtained” within the meaning of the section (i).

That, when certain parts of the English patent were identical with the foreign patent, it did not follow as a necessary result that when the foreign patent was determined the rest of the English patent which was not identical was void also (k).

That, for the purposes of s. 25 of the Act of 1852, the date of the patent, and not the date of the sealing, was to be regarded (l).

That the defence of invalidity of the patent on the ground of the expiry of a previous foreign patent must be raised by the pleadings (m).

Upon applications for prolongation of the term of a patent, the Judicial Committee of the Privy Council were in the habit of acting

(b) *Jablookhoff's Patent*, [1891] A. C. 293.

(c) *Re Betts' Patent*, 1 Moo. P. C. C. (N.S.) 49; *Re Poole's Patent*, L. R. 1 P. C. C. 515.

(d) *Winan's Patent*, L. R. 4 P. C. C. 93; *Blake's Patent*, *ibid.* 535.

(e) *Daw v. Eley*, L. R. 3 Eq. 497.

(f) *Hills' Patent*, 1 Moo. P. C. C. (N.S.) 258; 9 Jur. (N.S.) 1210.

(g) *Daw v. Eley*, L. R. 3 Eq. 511.

(h) *Ibid.* 496, 510.

(i) *Nordenfelt v. Gardner*, 1 R. P. C. 10.

(k) *Daw v. Eley*, L. R. 3 Eq. 512.

(l) *Holste v. Robertson*, 4 Ch. D. 9.

(m) *Bovill v. Goodier* (No. 2), L. R. 2 Eq. 195.

Sect. 45 (4). on the spirit of s. 25 of the Act of 1852, and would refuse a prolongation even if the English patent were prior to the foreign patent in cases where one of two or more foreign patents had, by the patentees under the English patents (being themselves foreigners), been allowed to expire (*n*).

NOTE.

For the present practice of the Judicial Committee, see under s. 25 (4).

Definitions.

Definitions of patent, patentee, and invention.

46. In and for the purposes of this Act—

“Patent” means letters patent for an invention :

“Patentee” means the person for the time being entitled to the benefit of a patent :

“Invention” means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, intituled “An Act concerning Monopolies and Dispensations with Penal Laws and the Forfeiture thereof”), and includes an alleged invention.

In Scotland “injunction” means “interdict.”

“Patentee.”—This definition allows an assignee (as under the old law) to apply for leave to amend a specification (s. 18) or for extension (s. 25). And see *ante*, pp. 69, 99.

“Person” includes “persons” (*o*), and “a body corporate” (*p*).

“Invention.”—See “Subject-matter,” *ante*, p. 96.

PART III.

DESIGNS.

Registration of Designs.

Application for registration of designs.

47. (1.) The comptroller may, on application by or on behalf of any person claiming to be the proprietor of any

(*n*) *Winan's Patent*, L. R. 4 P. C. C. 93; *Blake's Patent*, *ibid.* 535; *Newton's Patent*, 15 Moo. P. C. 176; *Normand's Patent*, L. R. 3 P. C. C. 193.

(*o*) 52 & 53 Vict. c. 63, s. 1. And see *Powell v. Mead*, 12 Ch. D. 686, 690.

(*p*) Section 117, *post*.

new or original design not previously published in the United Kingdom, register the design under this part of this Act. Sect. 47 (1).

(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 (*q*), and must be left at, or sent by post to, the Patent Office in the prescribed manner (*r*).

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

(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 (*u*).

(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.

SUB-SECTION 1.

“Proprietor.”—In the Act of 1861 (*x*) there was an express enactment that the Designs Act should extend to any proprietor, whether or not a subject of her Majesty. That Act is now repealed, and there is no corresponding provision in the present Act; but since the word “proprietor” is there used without any limitation, it is presumed that a foreigner may, subject to the provisions of s. 54, register a design equally with a British subject (*y*); and see *post*, s. 61.

(*q*) D. R., r. 4, *post*.

(*u*) D. R., rr. 15—19.

(*r*) *Ibid.* r. 11; all communications may be signed by agents, r. 6.

(*x*) 24 & 25 Vict. c. 73, s. 1.

(*s*) *Ibid.* r. 9, and Form E, Second Schedule to D. R.

(*y*) *Guterman's Design*, 55 L.J. (N.S.) Ch. 309, reported as *Ex parte Wild*, 2 Times R. 174.

(*t*) *Ibid.* r. 5 (for the classes, see Third Schedule to D. R., *post*).

Sect. 47 (1). "New or original."—That is, the design must either be substantially novel or substantially original, having regard to the nature and character of the subject-matter to which it is to be applied (z). "It must be new or original with reference to the class of article for which it is registered, meaning by kind of article the class of article mentioned in the schedule to the rules, but the kind of article having regard to its general character and use. A design may be new for a coal-scuttle but not for a bonnet. On the other hand, a design for a shade of a gas-lamp can hardly be new if it was old for an oil-lamp" (a).

NOTE.

And therefore where a design has been registered in one class for a particular article of a certain material, it cannot be registered by another person in another class for a similar article of a different material, as such a design would not be new or original (b).

But a design already on the register may be registered in another class for an article applied to a different purpose (c).

Under the Act of 1842 the design was required to be "new and original," and the same words are used in s. 61 of the present Act.

There is a distinction between the words "new" and "original." Every design which is original is new, but every design which is new is not necessarily original (d).

Thus, a design applicable to ornamental tiles, consisting of a new arrangement of well-known parts, was held to be new, but not original. If there had never been any ornamental tiles, and a designer had designed the design in question, that would have been original (e).

And a design may be new though it is founded upon one which the designer has previously registered (f).

On the question of the novelty of a design applicable to articles of utility, effect has been given to the fact that directly the design was put on the market it at once commanded a large sale, and that the so-called anticipations were never practically sold at all (g).

In considering whether a design is new or original, no part of the description under which it was registered can be rejected (h).

Meaning of "design."

The interpretation clause (s. 60) does not throw much light on the meaning of the word "design" *per se*, since it merely says that "design" in the Act means a "design applicable," etc.

(z) *Per* FRY, L.J., *Le May v. Welch*, 28 Ch. D. 35.

(a) *Per* LINDLEY, L.J., *Clarke's Design*, [1896] 2 Ch. 38, 45.

(b) *Read and Greenwell's Design*, 42 Ch. D. 260; *Bach's Design*, 42 Ch. D. 661.

(c) *Bach's Design*, *ubi supra*.

(d) See *per* CHITTY, L.J., *Roll-*

ison's Design, [1898] 1 Ch. 248; 14 R. P. C. 909, 914.

(e) *Per* MANISTY, J., *Sherwood v. Decorative Art Tile Co.*, 4 R. P. C. 207, 209.

(f) *Harper v. Wright*, [1896] 1 Ch. 142, 151.

(g) *Tyler v. Sharpe*, 11 R. P. C. 35.

(h) *Smout v. Slaymaker*, 7 R. P. C. 90.

In *Harrison v. Taylor* (i), a case under the old Acts, BYLES, J., thus defined a "design": "I think 'design' imports, among other things, variations on old forms in respect of size, configuration, colour, and other qualities; but where size may introduce novelty into some parts of a design it may not do so in other parts. Configuration may constitute a new design, for where there is alteration of proportions that may be a new design"; and in the same case, WIGHTMAN, J., said: "I apprehend a design to be not a project or invention, but a picture or drawing—something which the inventor has for the first time produced."

NOTE.

A "design" within this section must be something which appeals to the eye (k), it must be capable of existence outside the article itself (l). The question whether it adds to the utility of the articles to which it is applied or not is immaterial (m). Therefore an arrangement for fastening the busk in a corset which did not show any novelty in appearance, or shape, or configuration, was held not proper subject for a design (n).

And a design for a basket, the claim being for the pattern of the basket consisting in the osiers being worked in singly with all the butt ends outside, was held incapable of registration, the claim being in fact for a process or mode of manufacture (o).

A new and original combination may be a design within the Act, as the result of simultaneously applying two old and known designs to the ornamenting of a button (p).

So, also, a honeycomb pattern consisting of a combination of a large honeycomb and a small honeycomb arranged to form a large honeycomb stripe on a small honeycomb ground, both the large and small honeycomb pattern being previously well known, but the combination being new, was protected (q).

And a figure of six-pointed stars on an Albert chain arranged in a particular manner, and shaded, was a good design as applied to a woven fabric (r).

(i) 4 H. & N. 815; S.C. 5 Jur. (N.S.) 1219.

(k) *Cooper v. Symington*, 10 R. P. C. 264.

(l) See per VAUGHAN WILLIAMS, J., *Moody v. Tree*, 9 R. P. C. 333.

(m) See per LINDLEY, L.J., *Clarke's Design*, [1896] 2 Ch. 43.

(n) *Cooper v. Symington*, *ubi supra*.

(o) *Moody v. Tree*, *ubi supra*.

(p) *R. v. Firmin*, cited *Harrison v. Taylor*, 3 H. & N. 304; *Norton v. Nicholls*, 1 E. & E. 765; S.C. 5 Jur. (N.S.) 1203; *Sherwood v. Decorative Tile Co.*, 4 R. P. C. 207.

(q) *Harrison v. Taylor*, 4 H. & N. 815; S.C. 5 Jur. (N.S.) 1219. See also *Rollason's Design*, [1898] 1 Ch. 237; 14 R. P. C. 909.

(r) *Holdsworth v. McCrea*, L. R. 2 H. L. 380.

Sect. 47 (1). And when the general idea of a design for lace, viz., a scalloped border and a flowing backing, was old, and the class of border and class of backing was old, and a coral backing with a scalloped border was old, it was held that a new and pretty example of the general idea was a good design (s).

NOTE.

And a writing table of which no part was new in itself, but which was novel in its arrangements, novel in its details as a combination, and novel also in its general design and appearance, was held to be within the Act (t).

If a combination design be registered, it is the combination which is protected, and not the separate parts (u).

Must be one design, and not a multiplicity of designs.

But in order that a combination design may be good, the result must be one design, and not a multiplicity of designs. And therefore a design for a shawl which had five peculiarities, each of which was in itself old, was not a design which could be registered under the old Acts. What is protected is not the article of manufacture, but the design applicable to the article of manufacture, and this was not a case of several designs going to make up one design, but of several designs applicable to one article of manufacture (x).

And where there were four old designs applied respectively to three ribbons and a button, and the three ribbons were then united so as to form a badge, this was held by Lord HATHERLEY, then V.-C., not to be a design within the Act (y).

And something novel must be introduced into the combination.

In *Lazarus v. Charles* (z), MALINS, V.-C., observed that the cases of *Harrison v. Taylor* and *R. v. Firmin* had given an exceedingly liberal interpretation to the Act, and said that he would follow them with great reluctance unless something novel were introduced into the combination; and he held that a mere combination of two old card-baskets into one basket, making a double basket, could not be registered.

So, also, a design for a shirt collar which showed no marked novelty, but differed from previous collars only in small particulars (a).

And a design for the shape of a lamp reflector which differed from known reflectors only by the addition or omission of details which were immaterial, and did not substantially alter the shape, was held incapable of registration (b).

(s) *Birkin v. Pratt*, 12 R. P. C. 371.

(t) *Heinrichs v. Bastendorff*, 10 R. P. C. 160

(u) *Holdsworth v. McCrea*, *ubi supra*.

(x) *Norton v. Nicholls*, 1 E. & E. 765; S.C. 5 Jur. (N.S.) 1203.

(y) *Mulloney v. Stevens*, 10 L. T. (N.S.) 190.

(z) L. R. 16 Eq. 117.

(a) *Le May v. Welch*, 28 Ch. D. 24; *Smith v. Hope*, 6 R. P. C. 201.

(b) *Clarke's Design*, [1896] 2 Ch. 38; see also *Sherwood's Design*, 9 R. P. C. 268.

And an old border taken from a well-known duster and applied to a previously existing fabric was held not to constitute a new design within the Act (c). Sect. 47 (1).
NOTE.

A copy of a photograph of a public character is not a new or original design which can be registered (d); nor was the use of an arch under the body of a carriage for the purpose of enabling the wheels to pass under the carriage during the turning of the carriage, when the novelty was that the arch proposed was only larger than that formerly used for the same purpose (e).

When during the existence of the copyright in a design, the same design is registered with a slight variation as an improvement, it is open to any one as soon as the term of the original registration has expired to copy the original design, omitting the variation (f).

But an article in two parts, such as a butter-dish consisting of a dish and a cover, is one article of manufacture, and the design may be registered (g). Article in two parts may be registered.

The question whether a design is new and original is for the jury, and is to be decided from the evidence of experts, and principally from eyesight (h). Question for originality is for jury, and is matter of eyesight.

A design may be registered in respect of an article not complete in itself, but which is to be used in combination with another article (i).

There is little or no analogy between patents and designs (k); and, therefore, where the design was for a combination of large and small honeycomb patterns, and it was shown that a pattern called "hopsack" pattern had been used in the same way, the Court of Exchequer Chamber, reversing the decision of the Court below, refused to follow the analogy of the case of *Brook v. Aston* (l), where it was held that there could be no patent for a mere application of old means to a new purpose, and held the honeycomb combination to be a good design (m). So also where doors having mouldings along the top had been in use in articles of furniture, such as sideboard covers, and the like, a kitchen No analogy between patents and designs.

(c) *Hothersall v. Moore*, 9 R. P. C. 27.

(d) *Adams v. Clementson*, 12 Ch. D. 714; see, however, observations on this case in *Saunders v. Wiel*, 9 R. P. C. 467, [1893] 1 Q. B. 470.

(e) *Windover v. Smith*, 32 Beav. 200; 9 Jur. (N.S.) 397.

(f) *Harper v. Wright*, [1896] 1 Ch. 142, 153.

(g) *Fielding, app. v. Hawley, resp.*, 48 L. T. (N.S.) 639.

(h) *Harrison v. Taylor*, 4 H. & N. 815; 5 Jur. (N.S.) 1219. See also *per* FRY, L.J., *Le May v. Welch*, 28 Ch. D. 37, and *per* CHITTY, L.J., *Hollason's Design*, [1898] 1 Ch. 249; 14 R. P. C. 909, 914.

(i) *Walker v. Falkirk Iron Foundry Co.*, 4 R. P. C. 392.

(k) *Harrison v. Taylor*, 4 H. & N. 815; 5 Jur. (N.S.) 1219.

(l) 8 E. & B. 478.

(m) *Harrison v. Taylor*, cited above.

Sect. 47 (1). range door with a moulding along the top edge, which would make a continuous moulding with the other part of the range, was held to possess sufficient novelty to sustain the design (*n*). Nor is the proprietor of the design bound to distinguish what is new from what is old (*o*), nor to describe it with the same nicety and accuracy as is required in the specification of a patent (*p*). The fact that a patent might have been obtained for the article does not prevent its registration as a design (*q*).

NOTE.

And on the question of novelty or originality it is wholly immaterial how or by what movements of machinery the design is produced (*r*).

A design may be registered as an improvement upon one previously registered, and the registration may be good even though the new design contains all the essential features of the original design (*s*).

Idea of the design.

The Act does not require novelty in the idea of the design, but novelty in the design itself, that is, novelty in the way in which the idea is to be made applicable to some special subject matter. And, therefore, a design may be a good design, although it is taken from a source common to all mankind (*t*).

And a design in metal for a spoon handle consisting of a representation of Westminster Abbey taken from a photograph, was held a proper subject for registration (*u*).

Novelty distinct from publication.

“Not previously published in the United Kingdom.” etc. —The question of novelty of a design is not necessarily the same as the question of publication in the United Kingdom (*x*). If the design has been previously so published, of course the design cannot be registered, although it may have been independently invented (*y*); but even if the particular design may not have been so published, the case of *Lazarus v. Charles*, and the other cases cited above, show that the Court will sometimes take upon itself to say that a particular design does not contain a sufficient element of novelty to entitle it to registration.

What is publication.

Under the 4th section of the Act of 1842, which required the design to be registered “before publication thereof,” a doubt was expressed

(*n*) *Walker v. Falkirk Iron Foundry Co.*, *ubi supra*.

(*o*) *McCrea v. Holdsworth*, L. R. 6 Ch. 420, *per* Lord HATHERLEY, C.

(*p*) *Holdsworth v. McCrea*, L. R. 2 H. L. 385, *per* Lord CRANWORTH. See also judgment of Lord WESTBURY.

(*q*) *Walker v. Falkirk Iron Co.*, *ubi supra*.

(*r*) *Plackett's Design*, 9 R. P. C. 436.

(*s*) *Harper v. Wright*, [1896] 1 Ch. 142, 151.

(*t*) *Saunders v. Wiel*, [1893] 1 Q. B. 470, 474. See also *Hollinrake v. Truswell*, [1894] 3 Ch. 420, 427, a copyright case.

(*u*) *Saunders v. Wiel*, *ubi supra*. S. C., before CAVE, J., 9 R. P. C. 467.

(*x*) *Rivett v. Grimshaw*, 11 R. P. C. 352.

(*y*) *Smout v. Slaymaker*, 7 R. P. C. 49.

whether the term "publication" was limited to publication of the design itself or to publication after the design had been embodied and introduced into some fabric (z). **Sect. 47 (1).**

NOTE.

Where the inventor before registration showed the design to a commission agent to ascertain whether the latter thought it was likely to succeed, and the commission agent showed it to customers and obtained orders for the article: it was held under the present Act that there had been a publication of the design (a).

It is evidence against the defendant of the novelty and originality of the design that he has copied into his own catalogue a pictorial representation of the design in the plaintiff's catalogue (b).

If a design, not new or original, has been registered, it may be removed from the register. See *post*, under s. 90.

In the Act of 1842, s. 3, after the words United Kingdom were the words "or elsewhere."

SUB-SECTION (2).

As to correction of clerical errors in, or in connection with, an application for registration of a design, see s. 91 (a), *post*, and as to amendments, see D. R., r. 30, *post*. In certain cases the comptroller has a discretion as to evidence, *ibid.* r. 29.

SUB-SECTION (3).

"Statement of the nature of the design."—The Designs Rules, 1890, r. 9, require that the applicant 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.

The forms of application (forms E and O) do not require any statement of the means by which the design is applicable, and against the words "statement of nature of design" is a marginal note "such as whether it is applicable for the pattern or for the shape."

The rule makes it essential for the person claiming the design to distinguish between the several things named in the rule, and to show for which of them he makes his claim (c). And if the applicant chooses in his application to draw such distinction, this must be borne in mind in the consideration of every question of novelty and originality (d).

(z) *Dalglish v. Jarvie*, 2 Mac. & G. 231.

(a) *Blank v. Footman*, 39 Ch. D. 678; *Winfield v. Snow*, 8 R. P. C. 15. See also *Hunt v. Sterens*, W.N. 1878, 79, under the old Act.

(b) *Heinrichs v. Bastendorff*, 10 R. P. C. 160.

(c) *Per Lord HERSCHELL, Harper v. Wright*, [1896] 1 Ch. 142, 149.

(d) See *per VAUGHAN WILLIAMS, L. J., Rollason's Design*, [1898] 1 Ch. 252; 14 R. P. C. 909, 916.

Sect. 47 (3). When the design is registered as “applicable to pattern, shape, and configuration,” the registration applies to the design as a whole (*e*).

NOTE.

“**Class or classes of goods.**”—For the purposes of registration of designs, goods are classified in the manner appearing in the third schedule to the Designs Rules, 1890.

“Set” of articles.

A design may be registered as applied to single articles in a class, or as applied to a “set” of articles for a class; and the term “set” includes 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 “set” of articles. See D. R., First Schedule, *post*.

SUB-SECTION (4).

A design already on the register may be registered in another class for an article applied to a different purpose (*f*), but not for an article merely of a different material (*g*).

SUB-SECTION (5).

“Piece goods” (class 13) denotes goods measured by the piece and sold by the piece; goods which, though woven in the piece, are subdivided in pattern by cross lines or other demarcations, showing that they would be sold not by measurement but by number, fall within the class of handkerchiefs and shawls (class 14); but to avoid any difficulty a person may register under both classes (*h*).

SUB-SECTION 7.

Under the corresponding provision in the case of refusal by the comptroller to register a trade mark (*i*), it was held that the applicant could not appeal direct to the Court from such refusal as a person aggrieved within s. 90 of this Act, but must appeal to the Board of Trade (*k*).

The sub-section differs from the corresponding provisions as to trade marks in not giving authority to the Board of Trade to refer the appeal to the Court; see s. 62 (5), *post*, and notes thereto. Proceedings under this Act by or before the Board of Trade are now regulated by s. 102A added by the Act of 1888, s. 25, *post*.

(*c*) *Harper v. Wright, ubi supra.*
 (*f*) *Bach's design*, 42 Ch. D. 661.
 (*g*) *Bach's design, ubi supra.*
Read and Greswell's design, 42 Ch.
 D. 260, 262.

(*h*) *Hothersall v. Moore*, 9 R. P. C.
 27, 38.
 (*i*) Sect. 62 (4), *post*.
 (*k*) *Re Trade Mark "Normal,"*
 35 Ch. D. 231.

The provisions of the repealed Act of 1850 (*l*) as to provisional **Sect. 47 (7)** registration are not re-enacted in this Act.

See further as to affect of registration, s. 58, *post*.

NOTE.

48. (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 (*m*).

Drawings,
etc., to be
furnished on
application.

(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.

SUB-SECTION (1).

“**Exact representations or specimens.**”—The privilege of registering a pattern was expressly conferred by the Act of 1858 (*n*), under which it was held that if the pattern consisted of different parts, each of which separately might have been registered as a design, the registering the pattern was a claim only to the combination shown in the pattern, and not to the separate parts (*o*).

Under the special words of the Act of 1858 it was held that if a pattern were registered, there was no need of a written description, which was in certain cases required by the other Acts (*p*). In the present Act, however, the “specimen” is only to be instead of a copy of the design. It is presumed, therefore, that a description sufficient to satisfy s. 47, sub-s. (3), will be necessary, whether a specimen is or is not furnished to the comptroller.

Exact representations or specimens, if not furnished on the application to register, must be furnished to the comptroller before the articles to which the design is to be applied are offered for sale. See s. 50 (2), *post*.

(*l*) 13 & 14 Vict. c. 104.

(*m*) D. R., *post*, rr. 8, 9.

(*n*) 21 & 22 Vict. c. 70, s. 5. In *Norton v. Nicholls*, 4 K. & J. 475. Wood, V.-C., held that the registration of a specimen was registration of a copy within the 5 & 6 Vict. c. 100, s. 15, contrary to the opinion of the

Court of Queen's Bench in the same case, 5 Jur (N.S.) 1203.

(*o*) *Holdsworth v. McCrea*, L. R. 2 H. L. 380; *Grafton v. Watson*, 50 L. T. (N.S.) 420, affirmed 51 L. T. (N.S.) 143.

(*p*) *Holdsworth v. McCrea*, *ubi supra*.

Sect. 48 (1). As to the extent of protection when the design is registered by sample, see *post*, under s. 58.

NOTE.

SUB-SECTION (2).

“**The comptroller may . . . refuse,**” etc.—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 (*q*).

Certificate of registration.

49. (1.) The comptroller shall grant a certificate of registration to the proprietor of the design when registered.

(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.

See *post*, s. 96.

Copyright in Registered Designs.

Copyright on registration.

50. (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.

SUB-SECTION (1).

“**Copyright**” is defined *post*, s. 60.

SUB-SECTION (2).

“**Before delivery on sale.**”—These words remove the doubt as to the meaning of “publication” expressed in *Dalglish v. Jarrie*, cited *ante*, p. 355. And see *post*, s. 51.

“**Shall cease.**”—See *post*, s. 51.

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 (*r*); 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. Sect. 51.
Marking registered designs

“Delivery on sale.”—Where lace according to a registered design was made in a “brown” state (in which state it was really unfinished and not saleable to the public) and was sold to a “finishing” firm by whom it was “finished” and sold to the public, it was held that the sale to the “finishing” firm was a sale within this section and, the lace not having been marked with the prescribed mark, that the copyright had ceased (*s*).

The section was held to apply to the delivery on sale after the Act of an article made according to a design registered under the old Act (*t*).

“Shall cause each article to be marked,” etc.—Under the corresponding provisions in the Acts of 1842 and 1843 (*u*), where the words were that no person should be “entitled to the benefit” of the Act unless the register mark was placed on “every” article of manufacture on which the design was used, it was held that the provisions of the Act were imperative, and that there was no equity in the Court to relieve against the statute (*x*); and where it was shown in one case (*y*) that two articles, and in another (*z*) that one article, had not been stamped with these marks, the plaintiffs could not establish their copyright, and an injunction was refused. And it was necessary that this mark should be placed on all the articles, whether sold abroad or in this country (*a*).

A book of copies of registered designs was under the old Acts held not to require the registration mark (*b*).

It was also held under the old Acts that every portion of the article containing the design which is published and put forth by the Patterns.

(*r*) D. R. r. 32.

(*s*) *Woolley v. Broad*, 9 R. P. C. 429.

(*t*) *Wittman v. Oppenheim*, 27 Ch. D. 260.

(*u*) 5 & 6 Vict. c. 100, s. 4; 6 & 7 Vict. c. 65, s. 3.

(*x*) *Peirce v. Worth*, 18 L. T. (N.S.) 710; W. N. (1868), 217.

(*y*) *Peirce v. Worth*, cited above.

(*z*) *Hunt v. Stevens*, W.N. [1878], 79.

(*a*) *Sarazin v. Hamel* (No. 1), 32 Bea. 145; S.C. (No. 2), *ibid.* 151; 9 Jur. (N.S.) 192.

(*b*) *Branchardière v. Elvery*, 4 Ex. 380; 18 L. J. (N.S.) Ex. 381.

Sect. 51.**NOTE.**

manufacturer as such must contain the prescribed mark ; and therefore, where a manufacturer of wall papers sold as patterns small pieces containing the whole design, but not marked as required by the Act, it was held that he was not protected, and could not maintain an action for infringement (*c*). But now, since articles need only be marked before "delivery on sale," it would seem that mere patterns if not sold need not be marked.

If the article itself were in two parts it was, under the old Acts, held sufficient if one part was marked with the prescribed marks (*d*).

And where a trimming could not itself be conveniently marked, and was sold in parcels, each containing a certain number of yards, each parcel having round it a paper band properly marked, it was held, under the present Act, that the provisions of this section had been sufficiently complied with (*e*).

But where a design, registered in class 13 for textile piece goods was applied to a set of dusters woven in sets of twelve, it was held not sufficient to mark the piece only and that each duster must be marked (*f*).

If during the progress of manufacture part of the registered mark on the article becomes illegible, it seems that this will not deprive the proprietor of the protection of the statute (*g*).

The putting Regd. on an article instead of the letters Rd. which were prescribed by the Design Rules was held not to vitiate the registration (*h*). Nor if the proper registered number is on the articles sold is the protection lost because the proprietor has mistakenly placed on them other registered numbers which ought not to be there (*i*).

"Unless the proprietor," etc. -- This provision was introduced by the present Act.

Where the proprietors of the design had directed the manufacturer to affix the proper mark, but the manufacturer had inadvertently affixed another mark belonging to the same proprietors, but both marks contained the word Rd. (meaning registered), it was held that the proprietors were protected by this proviso (*k*). But it is doubtful whether the proviso would apply to a case where there had been an omission on the part of the manufacturer to affix any mark to the article (*l*).

(*c*) *Heywood v. Potter*, 1 E. & B. 439.

(*d*) *Fielding, app., Hawley, resp.*, 48 L. T. (N.S.) 639.

(*e*) *Blank v. Footman*, 39 Ch. D. 678.

(*f*) *Hothersall v. Moore*, 9 R. P. C. 27.

(*g*) *Fielding, app., Hawley, resp.*,

ubi supra. But see *Johnson v. Bailey*, 11 R. P. C. 21.

(*h*) *Heinrichs v. Bastendorff*, 10 R. P. C. 160.

(*i*) *Harper v. Wright*, [1896]. 1 Ch. 142.

(*k*) *Whitman v. Oppenheim*, 27 Ch. D. 260.

(*l*) *Ibid.*

Where the proprietor had given proper instructions to a die sinker to prepare a series of eight dies for stamping the articles with the registered number and by error of the die sinker 5 was substituted for 3 in one of the dies, and the error was not found out till several articles wrongly stamped had been sold, and it was shown that the proprietor had himself examined the first impressions of the dies and had overlooked the error, it was held that the proviso applied and that the copyright had not ceased (*m*).

Sect. 51.

NOTE.

But the mere giving instructions that the articles are to be marked without taking adequate means to see that the instructions are carried out is not sufficient (*n*).

52.—(1.) 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.

Inspection of registered designs.

(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 (*o*).

This and the next section re-enact, with modifications (the most important of which is the power given to the Court to authorise an inspection), s. 17 of the Act of 1842.

By s. 6 of the Act of 1888 the following words are added after sub-s. (1) of this section :—

“ 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.”

53. On the request of any person producing a particular design, together with its mark of registration, or producing

Information as to existence of copyright.

(*m*) *Rollason's design*, 14 R. P. C. 893, 909.

(*n*) *Johnson v. Bailey*, 11 R. P. C. 21.

(*o*) D. R. r. 33.

Sect. 53. 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 (*p*), 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.

Cesser of
copyright in
certain
events.

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.

Register of Designs.

Register of
designs.

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 (*q*).

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

See *post*, ss. 87, 88, 89, 90, 91, 93.

“**Assignment.**”—Under the Act of 1842 it was held that no assignment or licence could be made or granted by the proprietor before he himself had registered (*r*). There is no express enactment to this effect in the present Act, but looking to s. 87, and to the fact that the provisions of the Designs Rules apply only to a “registered design” (see r. 21 also Forms K and K1 in D. R., Second Schedule), it would appear that the law remains the same in this respect also.

Under the Act of 1842, s. 6, which contained forms of assignment, and required the “writing” to be produced to the registrar, it was held

(*p*) Or whether a particular design produced is identical with or an obvious imitation of a registered design, D. R. r. 35, *post*.

(*q*) D. R. rr. 20—28.
(*r*) *Jewitt v. Eckhardt*, 8 Ch. D. 404, 409.

that an assignment or licence must be in writing (s). There is no such provision in terms in the present Act or Rules, nor is there any requirement as to the mode of assignment or licence. But s. 58 (a) prohibits the application of the design by any person without the "licence or written consent" of the registered proprietor.

Sect. 55.

NOTE.

"**Transmission.**"—Copyright in a design will devolve on the executor of the proprietor (t).

"**Such other matters,**" etc.—D. R., r. 21, *post*, extends the operation of this section to "any share or interest" in the copyright of a registered design, and to the case of a person acquiring "any right to apply the design either exclusively or otherwise." Where the name of a company registered as proprietors of a design has been changed the court may order the name on the register to be changed to the new name (u).

Under the Act of 1842, ss. 3 and 5 (substantially re-enacted in ss. 60 and 61 of the present Act, pp. 372, 374, *post*), the exclusive right to apply the design might be the subject of licence, or might be assigned wholly or partially (x).

Moreover, the right might be divided so that a right might be given to apply the design to certain articles but not to others (y). This would appear, reading the above Rule in connection with ss. 60, 61, and 87, of this Act, to be still the law.

See also notes under s. 61, *post*.

Fees.

56. There shall be paid in respect of applications and registration and other matters under this part of this Act such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of Her Majesty's Exchequer in such manner as the Treasury shall from time to time direct (z).

Fees on registration, etc.

Industrial and International Exhibitions (a).

57. The exhibition at an industrial or international exhibition, certified as such by the Board of Trade, or the exhibition

Exhibition at industrial or international

(s) *Jewitt v Eckhardt*, 8 Ch. D. 404, 409.

(t) *Ibid.* p. 409.

(u) *Pneumatic Tyre Co.'s Registered Design*, 11 R. P. C. 636.

(x) *Jewitt v. Eckhardt*, 8 Ch. D. 404, 409.

(y) *Ibid.*

(z) D. R. First Schedule, *post*.

(a) D. R. r. 36, Form L.

Sect. 57. exhibition not to prevent or invalidate registration. elsewhere during the period of the holding of the exhibition, without the privity or consent of the proprietor, of a design, or of any article to which a design is applied, or the publication, during the holding of any such exhibition, of a description of a design, shall not prevent the design from being registered, or invalidate the registration thereof, provided that both the following conditions are complied with; namely,—

- (a) The exhibitor must, before exhibiting the design or article, or publishing a description of the design, give the comptroller the prescribed notice of his intention to do so; and
- (b) The application for registration must be made before or within six months from the date of the opening of the exhibition.

A re-enactment, with modifications, of the provisions of 28 Viet. c. 3, and 33 & 34 Viet. c. 27, applying to designs.

This section is now, by s. 3 of the Act of 1886, extended to industrial and international exhibitions held out of the United Kingdom. See *post*, p. 511.

Legal Proceedings.

Penalty on piracy of registered design.

- 58.** 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 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.

Sect. 58.

This section is, by the Act of 1888, s. 7, amended as follows :—

(1.) In section fifty-eight of the principal Act the words “or cause to be applied” shall be added after the word “apply.”

(2.) To the same section the following words shall be added: “Provided that the total sum forfeited in respect of any one design shall not exceed one hundred pounds.”

The section is a re-enactment, with modifications, of s. 7 of the Act of 1842. An important modification is that in clause (b) the word “knowing” is substituted for the more complicated provisions of the old Act.

Clause (a), it will be noted, deals with the manufacturer, and clause (b) with the retailer; and the latter is only liable if he sells the article knowing that the design has been applied without the proprietor's consent. Distinction between the manufacturer and retailer.

See also s. 59.

Where a defendant, a lace merchant, and not a manufacturer, had bought undressed lace and sent a pattern of plaintiff's registered design (which had been sent him) to another manufacturer, who applied the design to the lace, the lace merchant was held to have “caused to be done” the acts forbidden by s. 7 of the Act of 1842, and to be liable to the plaintiff (b).

The manufacturer of an article within the provisions of the Act is bound to inquire whether the design is already registered (c).

“It shall not be lawful . . . to apply such design,” etc.—Infringement of a design consists in the production of the goods in this country, and therefore the application in Lisbon by British subjects having works there of a design registered in England to articles for which the design was registered, and which were sold in Lisbon, was held to be no infringement (d). Infringement

(b) *Mallet v. Howitt*, W.N. [1879], p. 107. See also *Sykes v. Howarth*, 12 Ch. D. 826.

(c) *Per* JESSEL, M.R., *Mallet v. Howitt*, W. N. [1879], p. 107.

(d) *Potter v. Braca de Prata Printing Co.*, 8 R. P. C. 218.

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NOTE.

“Such design or a fraudulent or obvious imitation.”—The words “such design,” without the words “fraudulent imitation,” will prohibit anything which is substantially the same design. “Fraudulent imitation” is “imitation with knowledge, . . . conscious imitation, the man having the design before him” (e).

In this Act the words “or obvious” have been added after the word “fraudulent” in the corresponding sentence of the Act of 1843.

“Obvious” does not mean that which is obvious at a glance to the uneducated or unskilled eye; it means obvious to the judge or to the jury with the assistance of experts—persons conversant with the particular trade (f). An imitation may be fraudulent without being obvious (g). And where the registered design is known and there is imitation, the burden of proving that the registered design was not copied is thrown on the person who produces the pattern like that which is imitated (h).

The Court may take into account the state of knowledge at the time of registration, and in what respects the design was new or original, when considering whether any variations from the registered design which appear in the alleged infringement are substantial or immaterial (i).

On question of infringement of design, the appeal is to the eye.

On the question whether a design has been infringed, “the appeal is to the eye, and the eye alone is the judge of the identity of the two things” (k), and this is a question for the jury (l).

It is not necessary, in order to establish a case of infringement, that every detail should be actually copied. It is sufficient if the thing complained of is, to all appearance, the same as the registered design (m).

Thus the plaintiff had a design of a metal stove supported on feet, above which was a base sloping upwards with open tracery, and above that a gothic window, and above that again other tracery, and a projecting cornice and a cover sloping up to an apex surmounted by a

(e) Per JESSEL, M.R., *Barran v. Lomas* 28 W. R. 973, 974, 975. See also judgment of COTTON, L.J., *Grafton v. Watson*, 51 L. T. (N.S.) 143.

(f) Per CHITTY, J., *Grafton v. Watson*, 50 L. T. (N.S.) 420, affirmed 51 L. T. (N.S.) 143.

(g) *Sherwood v. Decorative Tile Co.*, 4 R. P. C. 207, 210.

(h) *Grafton v. Watson*, *ubi supra*.

(i) *Hecla Foundry Co. v. Walker*, 14 App. Cas. 550, 555; *Harper v. Wright*, [1896] 1 Ch. 142, 146.

(k) Per Lord WESTBURY, *Holdsworth v. McCrea*, L. R. 2. H. L. 388. See also *Hecla Foundry Co. v. Walker*, 14 App. Cas. 550, 557. See also *Barran v. Lomas*, 28 W. R. 975; and compare *Mitchell v. Henry*, 15 Ch. D. 181, and observations of CHITTY, J., in *Grafton v. Watson*, 50 L. T. (N.S.) 420.

(l) *McCrea v. Holdsworth*, L. R. 1 Q. B. 264.

(m) *McCrea v. Holdsworth*, L. R. 6. Ch. 419; *Harper v. Wright*, [1896] 1 Ch. 142; *Oliver v. Thornley*, 13 R. P. C. 490.

knob. The defendants sold a stove which could be described by the above general description, but in which the tracery, the style of architecture of the window, and other details were different from the corresponding details in the plaintiff's stove. It was held by the Court of Appeal that the stoves being alike in all their essential features, the defendant's stove was an "obvious imitation" of the plaintiff's, and an infringement of the registered design (*n*).

"But a fair imitation, that is to say something to which the idea of the original design has been applied, is not prohibited. I take an illustration from architecture, though a man could not take either Teutonic capitals or the Greek capitals, the Act would not prevent his using the composite capitals" (*o*). And if one man takes a particular view of Westminster Abbey and puts it on the top of a spoon by way of ornamentation, anyone may take a different view (*p*). And if the whole point of the design consists merely of a cathedral window of a particular kind, a design consisting of a cathedral window of another kind would not infringe (*q*). So, also, when the resemblance between the plaintiff's and defendant's designs for lace were only in the general ideas of the plaintiff's design which were common and old (*r*). Or where the only novelty in a design for an oil-can for cyclists was a rounded edge, which the defendants did not take (*s*), it was held that there was no infringement.

And in *Demartial v. Booth* (*t*), where a design for a china dinner-service was registered as for a "richly embossed shape," and it appeared that the shape itself was old, and the defendant's article differed entirely in ornamentation from the design of the plaintiff's, it was held that the plaintiff's design had not been infringed.

One test of infringement is whether the defendants would obtain any right by registering their design consistently with the plaintiff's registration (*u*).

Where a design was registered by sample, it was said under the old law, by Lord WESTBURY, that in such a case all that was protected was the thing in the exact form and relation, position and proportions, as they appeared on the pattern (*c*), and that anything

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NOTE.

(*n*) *Harper v. Wright*, [1896] 1 Ch. 142.

(*o*) Per JESSEL, M.R., *Barran v. Lomas*, 28 W. R. 974; and see also *Hollingrake v. Truswell*, [1894] 3 Ch. 420, 427, a copyright case.

(*p*) Per CAVE, J., *Saunders v. Wiel*, 9 R. P. C. 469.

(*q*) See per Lord HERSCHELL *Harper v. Wright*, [1896] 1 Ch.

142, 148, and see *S.C.* [1895] 2 Ch. 593.

(*r*) *Birkin v. Pratt*, 12 R. P. C. 371.

(*s*) *Walker v. Scott*, 9 R. P. C. 482.
(*t*) 9 R. P. C. 499.

(*u*) *Walker v. Hecla Foundry Co.*, 5 R. P. C. 73.

(*r*) *Holdsworth v. McCrea*, L.R. 2 H. L. 388.

Registration
by sample.

Sect. 58.**NOTE.**

which was a *fac simile* of that drawing—any other pattern which was a reproduction of that in its integrity—became an infringement. But that which was different in shape and form, or in the relative position of the several parts, which was not a production of it, as a *replica* or copy of a picture, would not be an infringement of the thing so specified.

But in the subsequent case of *McCrea v. Holdsworth* (y), these words were explained by Lord HATHERLEY, L.C., to mean merely that the design could be only as it was represented, and that the learned lords considered that the question whether there was any difference in the effect would be left to the jury, and he added: "Their lordships seem to have meant that the designer is not bound, as in a patent case, to distinguish the new from the old, and is allowed to register his pattern without distinguishing what is new from what is old; but if he chooses to put it in that way, it will not be protected as against the public in case they choose to use any portion in any manner substantially differing from the registered design. If the designs are used in exactly the same manner, as I hold they are in this case, and have the same effect, or nearly the same effect, then of course the shifting or turning round of a star, as in this particular place, cannot be allowed to protect the defendant from the consequences of the piracy." And the defendant's design being for all practical purposes identical with the plaintiff's design, a decree was made in favour of the plaintiff.

When the design is for shape or configuration, this alone is to be looked to on a question of infringement, and the court ought not to consider whether the defendant's design accomplishes the same useful end as the plaintiff's (z).

Working on plaintiff's design.

Under the old Act it was held that the mere fact of working on the plaintiff's design did not constitute the patterns so produced an infringement of designs which had been registered by sample only (a) And this is the same under the present Act (b).

But where plaintiff's designs had been registered by sample, and it was admitted that defendants had worked on them and had instructed their artists to produce the same effect, but to avoid the *minutiae* of plaintiff's design, it was held, under the present Act, that a combination of drawings similar to plaintiff's, and so arranged and coloured as to produce a similar effect, was legally a fraudulent and obvious imitation

(y) L. R. 6 Ch. 418.

(z) *Hecla Foundry Co. v. Walker*,
14 App. Cas. 550.

(a) *Thom v. Syddall*, 26 L. T.
(S.S.) 15; 20 W. R. 291.

(b) *Demartial v. Booth*, 9 R. P. C.
499, 502.

within this section, though it imitated neither the dominant nor subservient parts of plaintiff's design (c).

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A design may, however, be an infringement, though it be devised independently of the plaintiff's design (d).

NOTE.

A design may be registered in respect of an article to be used in combination with another article (e). But if a design be registered as applied to any particular thing, it seems that it cannot be claimed apart from that thing (f).

Design may be registered as applied to a particular thing, but it cannot be claimed apart from that thing.

"For purposes of sale."—Under corresponding words in the Act of 1842, s. 7, an injunction was granted by KNIGHT BRUCE, V.-C., to restrain not merely the sale but the manufacture of articles to which the design was applied during the continuance of the registration, and this although it was not intended that they should be sold till the term of protection had expired. And the articles complained of were ordered to be given up to the plaintiff for the purpose of being destroyed (g).

"Knowing that the same has been so applied without the consent," etc.—These words differ somewhat from the corresponding part of s. 7 of the Act of 1842, under which the retailer was not liable to be sued till he had received "knowledge" that the proprietor's consent had not been given, or had been served with written notice to that effect by the proprietor (h); but the effect of the present words appears to be substantially the same. If written notice is relied on it should show the defendant distinctly and intelligibly that the design was applied without the plaintiff's consent (i).

A mere notice by the proprietor that the retailer is selling goods (the sale of which was open) with registered patterns, the notice not containing any pattern of the design, or giving any detail of what is claimed, is not of itself sufficient to fix the retailer with knowledge within the sub-section (k).

Where the defendants, on complaint made by a notice which the court held insufficient to fix them with knowledge within this

(c) *Grafton v. Watson*, 50 L. T. (N.S.) 420, affirmed 51 L. T. (N.S.) 143. See also *Harper v. Wright*, [1896] 1 Ch. 142.

(d) *Walker v. Hecla Foundry Co.*, 5 R. P. C. 73, 368.

(e) *Walker v. Falkirk Iron Co.*, 4 R. P. C. 392.

(f) *Barran v. Lomas*, 28 W. R. 973.

(g) *McCrea v. Holdsworth*, 2 De G. & Sm. 499; S. C. 12 Jur. 820.

See the form of the decree also in *Pemberton*, p. 484. See also *Crossley v. Beverley*, 1 Webst. 119, a patent case.

(h) *Norton v. Nicholls*, 1 E. & E. 765; 5 Jur. (N.S.) 1203; see remarks of JESSEL, M.R., *Halsey v. Brotherhood*, 15 Ch. D. 517.

(i) *Norton v. Nicholls*, *ubi supra*; *Smith v. Roberts*, 5 R. P. C. 611.

(k) *Smith v. Roberts*, 5 R. P. C. 611.

Sect. 58.**NOTE.**

section, at once stopped their sale of goods of the class complained of, and did not know, till after an inspection subsequent to the commencement of the action, of the plaintiff's designs, that they had infringed the plaintiff's copyright, and had then at once returned the goods bearing infringing designs to the manufacturers, it was held that they had done no wrong within this section, and the action was dismissed with costs (*l*)

"Any person who acts in contravention," etc.—This section imposes a penalty, and the plaintiff in an action to recover such penalty for infringement of his copyright in a design cannot interrogate the defendant as to the infringement charged (*m*).

"Who may recover," etc.—Under the old law (Act of 1842, s. 8) the penalty could be recovered by action or by summary proceedings before justices of the peace. On similar words in the corresponding section of the Copyright (Works of Art) Act (*n*), it was held that process before a magistrate to enforce the penalty was of a criminal nature, and not for a debt (*o*). It will be observed that in this subsection the penalty is recoverable only by action, and is made a simple contract debt.

The plaintiff is not confined to the recovery of the penalty. He may have also the ancillary remedy by injunction (*p*).

"For every offence."—Where, in an action for an infringement of a design for ornamental tiles, the only sale proved against the defendants was one sale of 100 tiles, this sale was treated as one offence only, and judgment was given for one penalty of 50*l.* (*q*). The court or jury may assess the penalty at less than 50*l.* (*r*).

The total sum to be forfeited in respect of any one design is now limited to 100*l.* (*s*).

Action for damages.

59. Notwithstanding the remedy given by this Act for the recovery of such penalty as aforesaid, the registered proprietor of any design may (if he elects to do so) bring an action for the recovery of any damages arising from the application of any such design, or of any fraudulent or obvious imitation thereof for the purpose of sale, to any article of manufacture

(*l*) *Smith v. Roberts*, 5 R. P. C. 611. See also *Jan v. Grossman*, 12 R. P. C. 539.

(*m*) *Saunders v. Wiel*, [1892] 2 Q. B. 18, 321; 9 R. P. C. 459.

(*n*) 25 & 26 Vict. c. 68, s. 6.

(*o*) *Ex parte Graves*, L. R. 3 Ch. 642.

(*p*) *Cooper v. Whittingham*, 15 Ch. D. 501, 506; see also *Sheriff v. Coates*, 1 R. & M. 159.

(*q*) *Sherwood v. Decorative Tile Co.*, 4 R. P. C. 207, 212.

(*r*) *Saunders v. Wiel*, [1892] 2 Q. B. 321, 323; 9 R. P. C. 464, 470.

(*s*) *Ante*, p. 365.

or substance, or from the publication sale or exposure for sale by any person of any article or substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, such person knowing that the proprietor had not given his consent to such application.

Sect. 59

See s. 58.

A substantial re-enactment of s. 9 of the Act of 1842, adding, however, the words "or obvious" after "fraudulent."

"The registered proprietor . . . may, if he elects," etc., "bring an action."—The registered proprietor alone is entitled to sue, and therefore where certain persons had verbally agreed with the registered proprietor for the exclusive sale of goods to which the design was applied, it was held that they had no right of action against infringement of the design (*t*). The action is only given to the registered proprietor if he elects not to proceed for penalties (*u*).

It is no answer to an action to recover penalties for an infringement that a design has been registered under a wrong class (*x*).

The publication and sale of a book of registered designs is not a licence to the purchaser to sell articles to which the designs had been applied (*y*).

It is sufficient in the pleadings to allege that the design and the proprietorship have been duly registered, and it is not necessary expressly to allege that all the provisions of the Act have been complied with (*z*).

"Knowing that the proprietor," etc.—See notes under s. 58 (*b*), *ante*, p. 369.

In *Wittman v. Oppenheim* (*a*), it was held by PEARSON, J., that an innocent infringer of a registered design must pay the costs of a motion for an injunction to restrain him from infringing, even though the plaintiff had given him no notice before commencing the action.

But in *Smith v. Roberts* (*b*), BRISTOWE, V.-C., refused to apply this rule to the trial of an action; and where the action had been continued after the plaintiff had by interrogatories discovered certain facts, which

(*t*) *Woolley v. Broad*, [1892] 1 Q. B. 806.

(*u*) *Woolley v. Broad*, *ubi supra*; *Saunders v. Wiel*, 9 R. P. C. 459, 465.

(*x*) *Lowndes v. Browne*, 12 Ir. L. R. 293.

(*y*) *Branchardière v. Elvery*, 4 Ex. 380; N. C. 18 L. J. (N.S.) Ex. 381.

(*z*) *Sarazin v. Hamel* (No. 1), 32 Bea. 145.

(*a*) 27 Ch. D. 260.

(*b*) 5 R. P. C. 611.

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in the opinion of the court showed that the defendant had no knowledge within s. 58 (b) of the present Act, the action was dismissed with costs.

In an action for infringement the plaintiff may go into evidence as to the purpose for which the design was registered, and, if necessary, the court will call for the statement as to the nature of the design which was lodged, under s. 17 (3), when the application to register was made (c).

The practice in patent actions whereby a defendant desiring to amend particulars of objections, may be compelled to allow the plaintiff a time in which to elect to discontinue (*ante*, p. 175), has been followed in an action for infringement of design (d). But there is nothing in such a practice to fetter the absolute discretion of the judge as to the terms on which such an amendment will be allowed (e).

An action for infringement of design is not, on the question of costs, analogous to a patent case (f); and where the defendants raised several defences, and succeeded on one only, viz., that of previous publication of the design, and failed on one other issue, and the other defences were not fought out, it was held that the defendants were entitled to all the costs of the action except those of the issue on which they failed (g).

And see under s. 29 (6), *ante*, p. 231.

Definitions.

Definition of
“design,”
“copyright.”

60. In and for the purposes of this Act—

“Design” means any design applicable to any article of manufacture, or to any substance artificial or natural, or partly artificial and partly natural, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined, not being a design for a sculpture, or other thing within the

(c) *Walker v. Falkirk Iron Co.*,
4 R. P. C. 390, 394, 395.

(d) *Morris Wilson & Co. v. Coventry Machinists Co.*, [1891]
3 Ch. 418.

(e) *Woolley v. Broad*, [1892] 2
Q. B. 317; 9 R. P. C. 429.

(f) *Per KEKEWICH, J., Blank v. Footman*, 39 Ch. D. 678, 685.

(g) *Blank v. Footman, ubi supra.*

protection of the Sculpture Copyright Act of the year 1814 (fifty-fourth George the Third, chapter fifty-six).

“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.

“‘Design’ means any design,” etc.—See *ante*, under s. 47, p. 350.

The above definition of “design” is taken nearly *verbatim* from s. 3 of the Act of 1842, omitting in the present Act, after the words “applicable to,” the words “the ornamenting of.” The Act of 1842 dealt only with ornamental designs. “Useful” designs were dealt with by the 6 & 7 Vict. c. 65, which, by s. 2, gave protection to a new and original design for any article of manufacture having reference to some purpose of utility, so far as such design should be for the shape or configuration of such article, and that whether it should be for the whole of such shape or configuration, or only for a part thereof.

Questions arose under the old Act as to whether a particular arrangement was or was not a “useful design” within the latter Act, or whether it was not properly an article of manufacture the subject of a patent (*h*). These questions cannot now arise, there being no distinction in the present Act between ornamental and useful designs.

But it was said under the old Act, and there appears to be nothing in the present Act to the contrary, that if the invention was not merely a good “useful” design, but was also a proper subject of a patent, there was nothing to prevent an inventor from having a concurrent right to take out a patent, or to take the smaller protection given by the Designs Act (*i*).

“For the pattern or for the shape or configuration.”—There is a distinction drawn in the Act and the rules in respect of pattern, and shape or configuration, but the distinction between pattern and shape is not necessarily scientific and precise (*k*).

Where the design is registered as “applicable to pattern, shape and configuration,” the registration applies to the design as a whole (*l*).

As to the words “richly embossed shape,” see *Demartial v. Booth*, *ante*, p. 367.

(*h*) *Millingen v. Picken*, 1 C. B. 799; *Rogers v. Driver*, 1 Q. B. 103; *R. v. Bessell*, 16 Q. B. 810; *Margeson v. Wright*, 2 De G. & Sm. 420; *White v. Toms*, 37 L.J. (N.S.) 204.

(*i*) *Per* ERLE, J., and COLERIDGE, J., *Rogers v. Driver*, 16 Q. B. 108.

(*k*) *Rollason's Design*, [1898] 1 Ch. 248; 14 R. P. C. 909, 914, 916.

(*l*) *Harper v. Wright*, [1896] 1 Ch. 142, 150, 152.

Sect. 60.

NOTE.

“Shape or configuration.”—It has been considered doubtful whether a mechanical contrivance in the stem of a parasol (*m*), or a design for a protector label, which consisted in making in the label an eyelet-hole and lining it with a metallic substance (*n*), could be considered designs for “shape or configuration.”

On the other hand, a design of a new form of brick with corresponding apertures in the sides, so that passages were formed when the bricks were laid together through which ventilation could take place, was held under the old Act a good design for “shape or configuration having reference to some purpose of utility” (*o*).

Utility
immaterial.

It was also held that a mere combination of parts for a useful purpose, independently of shape or configuration, was not within the Act (*p*).

The rule is the same under the present Act. The statute applies to all such designs as are within it whether they add to the utility of the articles to which they are applied or whether they do not. The question of utility is wholly immaterial (*q*).

“Ornament.”—Under a registration “ornamental design,” not only the ornament but the combination with the shape is protected (*r*).

“Copyright.”—Under the Act of 1842, s. 3, the proprietor had the sole right to apply the registered design, “provided the same were done within the United Kingdom of Great Britain and Ireland.” This limitation was repealed by the Act of 1861, and is not contained in the present Act.

See also s. 58, *ante*

Definition of
proprietor.

61. The author of any new and original design shall be considered the proprietor thereof, unless he executed the work on behalf of another person for a good or valuable consideration, in which case such person shall be considered the proprietor, and every person acquiring for a good or valuable consideration a new and original design, or the right to apply the same to any such article or substance as aforesaid, either exclusively of any other person or otherwise, and also every person on whom the property in such design

(*m*) *Millingen v. Picken*, 1 C. B. 799.

(*n*) *Margetson v. Wright*, 2 De G. & Sm. 421.

(*o*) *Rogers v. Driver*, 16 Q. B. 103.

(*p*) *R. v. Bessell*, 16 Q. B. 810.

(*q*) *Per LINDLEY, L.J., Clarke's Design*, [1896] 2 Ch. 38, 43; see also *Cooper v. Symington*, 10 R. P. C. 264.

(*r*) *Gordon v. Patrick*, 12 R. P. C. 22.

or such right to the application thereof shall devolve, shall be considered the proprietor of the design in the respect in which the same may have been so acquired, and to that extent, but not otherwise.

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This section is substantially the same as s. 5 of the Act of 1842, under which it was held that where a person has a workman in his employ under him, and the workman makes a design which is new and original, that design becomes the property of the master; but that persons who were not the original designers, nor the employers of the actual designer, but who had merely contracted with the foreign designer to purchase articles made by him according to the design abroad, were not proprietors within the Act (*s*). So, also, where an American manufacturer purported to sell to the plaintiff the sole right to sell an article newly designed and about to be manufactured, it being stipulated that the plaintiff should obtain the articles exclusively from the manufacturer, it was held that the plaintiff, not having under the contract the right to manufacture, had not acquired the right to apply the design, and could not be registered as proprietor (*t*). And a mere agent in this country of a foreign firm for the sale of certain goods of a particular design, not being the author of the design, nor otherwise fulfilling the requirements of the section, is not "proprietor of" the design, and cannot register it (*u*).

See also notes under s. 55.

PART IV.

TRADE MARKS.

Registration of Trade Marks.

62. (1.) The comptroller may, on application (*x*) by or on behalf of any person claiming to be the proprietor of a trade mark, register the trade mark. Application for registration.

(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

(*s*) *Lazarus v. Charles*, L. R. 16 Eq. 117, 122.

(*t*) *Jewitt v. Eckhardt*, 8 Ch. D. 404.

(*u*) *Re Guiterman's Design*, 55 L. J. (N.S.) Ch. 309, reported as *Ex parte Wild*, 2 Times R. 174.

(*x*) T. M. R. rr. 7—16.

Sect. 62 (2). from time to time prescribed, and must be left at, or sent by post to, *the Patent Office in the prescribed manner (y)*.

(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 connexion with which the applicant desires the trade mark to be registered (z).

(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 (a), 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.

(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 (b).

This section is, by the Act of 1888, s. 8, amended as follows:—

(1.) In sub-section two of section sixty-two of the principal Act for the words “the patent office in the prescribed manner” shall be substituted the words “such place and in such manner as may be prescribed.”

(2.) To the same section of the principal Act the following sub-section shall be added:—

“(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.”

This section does not, in terms, refer to cases of opposition, which are dealt with in s. 69. But it may be doubtful whether this present section does not also extend to opposition cases (c).

(y) T. M. R. r. 8. In exceptional cases a specimen may be deposited, r. 13.

(z) *Ibid.* rr. 13, 14.

(a) *Ibid.* rr. 20—26.

(b) T. M. R. r. 23.

(c) See *Re Australian Wine Importers and Mason*, 41 Ch. D. 285, COTTON, L.J.

SUB-SECTION (1).

Sect. 62 (1).

“Any person.”—Under the Rules of 1875, r. 5, express permission was given to a foreigner to register. There is no such provision in the present Act or rules, but the word “person,” sub-s. (1), is used without any limitation.

NOTE.

And see s. 103, *post*, and the International Convention, *post*.

An importer of foreign goods cannot, even with the consent of the foreign producer, register the trade mark of the latter as his own. And for this purpose the foreign owner of a natural source of the article is in the same position as a manufacturer. And the rule is the same whether the importer has or has not an exclusive contract for this country (*d*).

In *Re Rivière's Trade Mark* (*e*), it was held by PEARSON, J., under the Act of 1875, that foreigners who neither used nor intended to use the trade mark in England were not entitled to register. The decision in this case was reversed in the Court of Appeal on grounds not affecting this point, which the Court of Appeal expressly refrained from deciding. In the same case the question whether it was necessary that a person desiring to register should be carrying on, or intending to carry on, business in this country, was also left open.

In *Edwards v. Dennis* (*f*) it was said in the Court of Appeal that the Act of 1875 appeared to contemplate a user of the particular mark contemporaneously with, if not before, registration. But in *Re Hudson's Trade Marks* (*g*) it was expressly decided that the true meaning of the Act was to enable a person who had invented a trade mark which had not been previously used by some other person to obtain registration of that trade mark, and to treat its being on the register as evidence of public user, or equivalent to public user. And that in this respect there is no difference between the Act of 1875 and the present Act (*g*).

A person who has once acquired a trade mark by user may register it, though he has discontinued it for a time, if he has not abandoned it (*h*).

Abandonment of a trade mark is a question of intention (*i*); and where the applicant had, before 1875, ceased to sell the article in respect of which the trade mark was used, and had destroyed the labels to which it was attached, it was held that he had abandoned it, and could not now register it as an old mark (*k*).

(*d*) *Apollinaris Co.'s Trade Marks*, [1891] 2 Ch. 226, 234, 235.

(*e*) 26 Ch. D. 48.

(*f*) 30 Ch. D. 455, 473. See also *Lyndon's Trade Mark*, 32 Ch. D. 109; 3 R. P. C. 102; *Anderson's Trade Mark*, 54 L. J. Ch. 1084.

(*g*) 32 Ch. D. 311, 326. See judgment of FRY, L.J.

(*h*) *Mouson v. Boehm*, 26 Ch. D. 398.

(*i*) *Mouson v. Boehm*, *ubi supra*.

(*k*) *Grossmith's Trade Mark*, W. N. (1889), 2; 6 R. P. C. 180.

Sect. 62 (1).**NOTE.**

When an application under the Act of 1875 for registration had not been completed within the twelve months, it was held not to be a pending application saved under s. 113, *post*, of this Act (*l*).

Applications under this Act may be made by or through agents (*m*), and the comptroller may require particulars. See T. M. R. 1897, r. 13, *post*.

Applications for registration of marks for cutlery, if made by a person carrying on business in Hallamshire, or within six miles thereof, are to be made to the Cutlers' Company (see s. 81 (3), *post*), who may enter the mark in the "Sheffield Registry" established by that section, and thereupon notice is to be given to the comptroller, who is to enter the mark in the Register of Trade Marks (see s. 81 (6), *post*).

SUB-SECTION 2.

As to correction of clerical errors in or in connection with an application for registration of a trade mark, see s. 91 (a), *post*, and T. M. R., Form Q.

SUB-SECTION 3.

"Particular goods or classes of goods."—For the purposes of registration goods are classified in the manner appearing in the Third Schedule to the Trade Marks Rules, 1890, *post*, which is practically the same as the classification under the repealed Trade Mark Rules, 1883. Applications for the registration of the same mark in different classes are to be treated as separate and distinct applications. See T. M. R., 1897, r. 13, *post*.

Mark not used for all goods in the class for which registered.

Under the Act of 1875, it was held that it is not the intention of the Act that a man registering a trade mark for the entire class, and yet only using it for one article in the class, can claim for himself the exclusive right to use it for every article in the class; and where this was shown to have been done, the register was, on the application of persons aggrieved, rectified by confining the registration to those articles in the class in connection with which the mark was actually used (*n*). If the person on the register desires to extend his business to other articles in the class, and to apply his trade mark to them, he should register it in respect of those goods (*o*).

The right to sue for infringement is limited to the class of goods in respect of which the mark has been registered (*p*).

(*l*) *Hayward & Son's Trade Mark*, 54 L. J. Ch. 1003.

(*m*) T. M. R. r. 9, *post*; and see remarks of STIRLING, J., *Jackson v. Napper*, 35 Ch. D. 172.

(*n*) *Edwards v. Dennis*, 30 Ch. D. 471. See also *Batt & Co.'s Trade Mark*, [1898] W. N. 44 (15) under present Act.

(*o*) *Edwards v. Dennis*, *ubi supra*.

(*p*) *Hart v. Colley*, 44 Ch. D. 193.

And when a trade mark was registered for the whole of class 45, viz., "tobacco, whether manufactured or unmanufactured," and the plaintiffs had only used it for cut tobacco, and it contained a word which was inapplicable to cigars and which was omitted from the mark as used by the plaintiffs for cigars, it was held that the plaintiffs were not entitled to an injunction to restrain the defendants from using the mark in reference to cigars without the word in question (*q*).

Sect. 62 (3).

NOTE.

But where, although the mark was registered for only some goods in a class, the plaintiff had used it for other goods, and it had acquired by user a public reputation as designating the plaintiff's goods in the market, the plaintiff was held to be protected by the general law, and an injunction was granted (*r*).

Each of the classes of goods is to be treated as separate and distinct, and the registration of a mark in each class is to be taken as a separate registration. And a person who has registered a mark in one class may be prevented from registering the same mark for another class, if any other person has used the same or a sufficiently similar mark for the latter class (*s*).

SUB-SECTION 4.

"The comptroller may refuse," etc.—Under the Act of 1875 it was held that if the applicant is a person who is for the time being entitled to the exclusive use of a trade mark in accordance with law, and the trade mark is one within the definition of the Act (*post*, s. 64), he was entitled to registration *ex debito justitiæ*. The burden of proof lay on the applicant, but if he produced such proof as would, in the opinion of the court, entitle him to an injunction, the words in s. 5 of that Act, "if satisfied of the justice of the case" (*t*), were not to be construed as meaning to give the court a discretion whether the nature of the trade mark was such as to make it inconvenient that the applicant should exercise the right of property which he was proved to have (*u*).

But the present section gives the comptroller a discretion, and while the Act prohibits the registration of a trade mark in certain specified cases there is no duty cast upon the comptroller of registering every

Comptroller's discretion as to registration.

(*q*) *Hargreave v. Freeman*, [1891] 3 Ch. 39. See also *Wills' Trade Mark*, [1893] 2 Ch. 262.

(*r*) *Jay v. Ladler*, 40 Ch. D. 649; 60 L. T. (N.S.) 27. See also *Hart v. Colley*, 44 Ch. D. 193; *Bodega Co. v. Owens*, 7 R. P. C. 31.

(*s*) See *per* PEARSON, J., *Lyn-don's Trade Mark*, 32 Ch. D. 109, 113.

(*t*) These words are not in the present Act.

(*u*) *Orr Ewing v. Registrar of Trade Marks*, 4 App. Cas. 497, judgment of Lord BLACKBURN.

Sect. 62 (4). other mark that may be applied for. On the contrary, a discretion whether to register or not is in all cases plainly conferred (*x*).

NOTE.

And the comptroller is bound to look into all the facts of the case, and to see whether it is proper under all the circumstances to register the mark (*y*).

It is a reasonable exercise of the comptroller's discretion to refuse to register the mark when it is not clear that deception would not result (*z*).

In an application to register a trade mark the applicant is *in petitorio*, and must justify the registration by showing affirmatively that it is not calculated to deceive. And if *in dubio* the application ought to be refused (*a*).

On these grounds words involving a misleading allusion or a suggestion of what is not strictly true (*b*), a mark for goods practically though not actually of the same description as those for which a similar mark has been registered (*c*), and a description in words of a registered device (*d*), whether the description be or be not in a foreign language (*e*), have been refused registration, or expunged from the register, though not strictly within the prohibitory clauses of the Act. (And see under ss. 72, 73, *post*.)

Where the comptroller objects to register on the ground of similarity of the proposed mark to marks already on the register, the consent of the owners of those marks is immaterial except so far as it may be evidence of there not being a probability of persons being deceived (*f*).

The comptroller, before refusing, must give the applicant an opportunity of being heard. T. M. R., r. 17.

The books of the office showing that registration of a trade mark has been refused are no evidence that it has become *publici juris* (*g*).

"Appeal to the Board of Trade."—If the comptroller refuses to register, the only course open to the applicant is to appeal to the Board of Trade, and the court has no jurisdiction in such a case to rectify the register under s. 90 (*h*).

(*x*) *Australian Wine Importers, Ltd.*, 41 Ch. D. 278, 285; and *per* Lord HERSCHELL, *Eno v. Dunn*, 15 App. Cas. 261.

(*y*) See *per* KAY, J., *Grossmith's Trade Mark*, 6 R. P. C. 180, 182.

(*z*) *Per* Lord HERSCHELL, *Eno v. Dunn*, *ubi supra*.

(*a*) *Per* Lord WATSON, *Eno v. Dunn*, *ubi supra*.

(*b*) *Eno v. Dunn*, 15 App. Cas. 252, 263.

(*c*) *Australia Wine Importers, Ltd.*, 41 Ch. D. 278, 286.

(*d*) *Re La Société Anonyme des Verrieres de l'Etoile*, [1894] 1 Ch. 61, 64, [1894] 2 Ch. 26.

(*e*) *John Dewhurst and Son's Trade Mark*, [1896] 2 Ch. 137.

(*f*) *John Dewhurst and Son's Trade Mark*, [1896] 2 Ch. 137.

(*g*) *Orr Ewing v. Johnston*, 13 Ch. D. 434.

(*h*) *Re "Normal" Trade Mark*, 35 Ch. D. 231.

Proceedings before the Board of Trade are now regulated by s. 102A, Sect. 62 (4), added by the Act of 1888, s. 25, *post*.

“**Conditions.**”—Registration has been granted subject to an undertaking to use or not to use a mark in a particular way (*i*), or in a particular place (*k*), or on particular goods (*l*), and a notice of the undertaking has been placed on the register (*m*). And such an undertaking may be added to the register on the *ex parte* application of the applicant, the consent in writing of the comptroller being produced (*n*). But in *Re John Dewhurst Co.’s Trade Mark* (*o*), it was held that the court ought not to direct registration subject to a condition that the mark shall only be used in a particular country, there being no authority in the Act enabling the court to impose such a condition, and no means of enforcing it if imposed.

In cases of applications under the Act of 1875, a disclaimer of words common to the trade cannot be enforced, that Act having no provision analogous to s. 74 of the present Act (*p*).

SUB-SECTION 5.

By s. 117, *post*, p. 502, “the court” means, subject to the provisions for Scotland, Ireland, and the Isle of Man, Her Majesty’s High Court of Justice in England. By r. 42 of the Rules of 1875, applications as to registration of trade marks were assigned to the Chancery Division, and this is still the practice (*q*).

If the appeal is referred to the court by the Board of Trade, the court may entertain any objections to the registration, whether they were or were not taken by the comptroller (*r*).

The order of reference directs the appellants to apply to the court to hear and determine the appeal. See *H. J. Neill’s Trade Mark* (No. 1), Appendix, *post*.

No provisions are made by this Act, or the Act of 1888, as to the costs of these proceedings before the comptroller or the Board of Trade.

Under the Trade Marks Act, 1875, it was held that an applicant who, on the registrar objecting to register a particular mark, succeeded

NOTE.

(*i*) *Re Whitelzy’s Trade Mark*, 29 W. R. 235; *Re Farina*, Seb. Dig. p. 405; *Re Sykes & Co.’s Trade Mark*, 29 W. R. 235; *Re Mitchell & Co.*, and *Houghton and Hullmark’s Trade Marks*, 32 W. R. 90; varied 28 Ch. D. 666; *Ex parte Humming and Son*, 25 S. J. 570.

(*k*) *Re Rabone, Brothers & Co.*, Seb. Dig. p. 395; *Re Keep’s Trade Mark*, 26 Ch. D. 187.

(*l*) *Re Otaduy’s Trade Mark*, W. N. (1885), p. 177.

(*m*) See cases cited in the three previous notes.

(*n*) *Keep’s Trade Mark*, 26 Ch. D. 187.

(*o*) [1896] 2 Ch. 137.

(*p*) *Hudson’s Trade Marks*, 32 Ch. D. 311.

(*q*) *King & Co.’s Trade Marks*, [1892] 2 Ch. 462, 480.

(*r*) *Sanitas Co.’s Trade Mark*, 58 L. T. (N.S.) 166; 4 R. P. C. 533.

Costs of
comptroller

Sect. 62 (5). against the registrar on the matter being referred to the court, must nevertheless pay the registrar's costs, there being no fund out of which the registrar could be paid (s). And this is the general rule under the present Act (t). But the practice is not invariable (u).

NOTE.

Under the Trade Marks Act, 1875, it was held that there was no jurisdiction to order the registrar to pay costs (x); but in *Leaf's Trade Mark* (y), where the applicant succeeded, BACON, V.-C., refused to give the comptroller his costs. The case was, however, reversed on appeal on the question whether the mark was one capable of registration, and the court, considering the case as a test case brought forward by the Patent Office, gave no costs on either side (z).

The rule as to the payment of the costs of the registrar was the same where the registrar appeared and did not oppose (a). But the costs thus to be paid were confined to the costs of proceedings in court, and the applicant could not be ordered to pay the costs in the registrar's office (b). This distinction proceeded on the words of the Judicature Rules, 1875, Order LV., which provided that the costs of proceedings in the High Court should be in the discretion of the court.

Limit of time for proceeding with application.

63. Where registration of a trade mark has not been or shall not be completed within twelve months from the date of the application, by reason of default on the part of the applicant, *the application shall be deemed to be abandoned.*

By the Act of 1888 (c), this section is amended by substituting for the words "the application shall be deemed to be abandoned," the words—

"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

(s) *Re Maignen*, 28 W. R. 759; *Rotherham's Trade Mark*, 14 Ch. D. 655.

(t) *Re White Rose Trade Mark*, 30 Ch. D. 507; *Re Trade Mark Alpine*, 29 Ch. D. 877; and see *Van Duzer's Trade Mark*, 34 Ch. D. 645; and *Colman's Trade Marks*, [1891] 2 Ch. 402, 408.

(u) *Colman's Trade Mark Application*, [1894] 2 Ch. 115, 132.

(x) *Re Rotherham's Trade Marks* 14 Ch. D. 587.

(y) 33 Ch. D. 481.

(z) 34 Ch. D. 645.

(a) *Re Orr Ewing*, W. N. (1880), 24.

(b) *Brandreth's Trade Mark*, 9 Ch. D. 619; *Re Hargreaves*, 11 Ch. D. 675.

(c) Section 9, *post*, p. 515.

further time as the comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned.”

Sect. 63.

The original section was held to be retrospective, and applied to applications pending at the commencement of the Act (*d*).

But where the mark had been registered, it was held that, instead of directing the mark to be expunged, the court, in its discretion, given under s. 90, might rectify the register by making an entry that the five years mentioned in s. 76 should run from the date of the entry, and not from the date of the original registration (*e*).

Where an application by a foreigner was deemed to be abandoned under this section, by reason of the default of the applicant's agents, and without the applicant's knowledge, he believing that his mark had been registered, it was held that there was nothing to prevent his making a fresh application (*f*).

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

Conditions of registration of trade mark.

- (a.) *A name of an individual or firm printed, impressed, or worn in some particular and distinctive manner ; or*
- (b.) *A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark ; or*
- (c.) *A distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use.*

(2.) *There may be added to any one or more of these particulars any letters words or figures, or combination of letters words or figures, or of any of them.*

(3.) *Provided that any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures used as a trade mark before the thirteenth day of August one thousand eight hundred and seventy-five (g), may be registered as a trade mark under this part of this Act.*

(d) *Jackson v. Napper*, 35 Ch. D. 162; *Re Hayward & Son's Trade Mark*, 54 L. J. Ch. 1003.

(e) *Re Hayward & Son's Trade Mark*, 54 L. J. Ch. 1003.

(f) *Jackson v. Napper, ubi supra ; Loftus' Trade Mark*, [1894] 1 Ch. 193.

(g) The day of the passing of the Act of 1875.

Sect. 64 (1). By the Act of 1888, s. 10, the following is substituted for this section :—

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 thirteenth day of August one thousand eight

hundred and seventy-five (*h*), may be registered Sect. 64 (3) as a trade mark under this part of this Act.

The original section was a re-enactment, with considerable alterations, of s. 10 of the Act of 1875. The new section is not retrospective with reference to marks applied before January 1st, 1889, the date of the commencement of the Act of 1888 (*i*).

The section must be read in connection with s. 73, *post*.

Old marks.—In reference to s. 10 of the Act of 1875, it was said by MALINS, V.-C., that “wherever there is a trade mark which has been lawfully used, whether it consists of a single device, as the crown with the initials, or of a foreign word, such as ‘Anatolia,’ or the Turkish word for ‘warranted’ simply, or of a name with a device, or also of a description of quality, if the whole combination is such as would, before the passing of the Act, have been the proper subject of a trade mark, and could have been protected as a trade mark, that should be registered, and could properly be registered” (*j*). But a trade mark in use before the Act cannot be registered unless it is within one of the definitions comprised in the above sub-sections (*k*). And it must be shown that the whole combination as proposed to be registered has been used as a trade mark before the statutory date (*l*).

Thus, where an application was made to register as an old mark a winged cross within two circles, the circles being disclaimed as common to the trade, and it appeared that the mark had only been used in this form in connection with the names of the owners of the mark, the application was refused (*m*).

Where, under the Act of 1875, a mark consisting of a lighthouse surrounded by two circles had been registered, and it appeared that the circles were common to the trade, the mark was not expunged, but a note was added that so much of the device as consisted of the two circles was common to the trade (*n*). Such a mark would now be registered under s. 74, *post*, with the disclaimer then required.

A mark used before August 13th, 1875, is an old mark only in respect of the goods on which it has been used, and as regards other goods it is to be treated as a new mark (*o*).

As to registration of identical, or nearly identical, old marks, see *post*, under s. 72, *post*, p. 426.

(*h*) The day of the passing of the Act of 1875.

(*i*) *Re Burgoyne's Trade Mark*, 6 R. P. C. 227, 231.

(*j*) *Re Barrow's Trade Marks*, 5 Ch. D. 364.

(*k*) *Re Mitchell's Trade Mark*, 7 Ch. D. 36.

(*l*) *Mecus' Application*, [1891] 1 Ch. 41.

(*m*) *Baker v. Rawson*, 45 Ch. D. 519.

(*n*) *Baker v. Rawson*, 45 Ch. D. 519.

(*o*) *Re Jelley, Son & Jones*, 51 L. J. Ch. (N.S.) 639, n.; *Re Lyndon's Trade Mark*, 32 Ch. D. 109.

Sect. 64(1).

NOTE.
Comptroller
may require
proof of time
of user of
old mark.

On applications to register an old mark as having been in use before August 13th, 1875, the comptroller, in cases where from any cause he thinks it desirable, will require the applicant, before the application is advertised, to furnish a statutory declaration, made by some person acquainted with the facts, stating that the mark has been used as an old mark. To this declaration it is convenient to append an exhibit showing the mark as used. The comptroller, as a rule, requires that the declaration shall state continuous user of the mark as a trade mark in the United Kingdom from the date before 1875 as to which the declarant can speak, and, further, that on the goods (save the mark shown on the exhibit) there did not appear any device, words, numerals, letters, or any other particulars whatsoever.

A specimen of such a declaration will be found in the Appendix, *post*.

“**Essential particulars.**”—In *Orr Ewing v. Registrar of Trade Marks* (*p*), a case under the Act of 1875, HALL, V.-C., said that the device or label, the registration of which is applied for, must be looked at as a whole, and that if it appears to be such as in the ordinary course of business would be distinguished from other devices or labels, it should be registered. Commenting on these words when the case was under appeal to the House of Lords (*q*), Earl CAIRNS, C., said: “To some extent, no doubt, this is true, but I apprehend the first duty cast upon the court is to ascertain whether some one or more than one of the essential particulars of a trade mark as defined by the Act is found to exist, so that the mark may be described with one or more than one essential particular or particulars which distinguish it.”

1 (a.) The words “individual or firm” in this and the next sub-section indicate the same thing, viz., the name or written signature of a real human being or a real firm (*r*). Such names as “Hamlet,” “Sam Weller,” “Jupiter,” “Venus,” etc., are not names of “individuals” within the sub-section (*s*).

The word “Pirie’s” (part of the expression Pirie’s Parchment Bank, a name for paper) is not the name of an individual or firm within this sub-section (*t*).

The words “Gianaclis cigarettes,” Gianaclis being the name of the maker, and there being nothing particular or distinctive in the manner of printing, were held not to constitute a good trade mark, and was removed from the register (*u*).

The name under this sub-section need not be the name of a living person, nor the name of the applicant for registration (*x*).

(*p*) 8 Ch. D. 799.

(*q*) 4 App. Cas. 484.

(*r*) *Per* A. L. SMITH, L.J., *Holt's Trade Mark*, [1896] 1 Ch. 711, 724.

(*s*) *Holt's Trade Mark, ubi supra*, p. 720, LINDLEY, L.J.

(*t*) *Pirie v. Goodall*, [1892] 1 Ch. 35, 43.

(*u*) *Gianaclis' Trade Marks*, 6 R. P. C. 467.

(*x*) *Per* LINDLEY, L.J., *Holt's Trade Mark*, [1896] 1 Ch. 719.

1 (b.) The words "applying for registration thereof as a trade-mark" Sect. 64 (1). were introduced by the Act of 1883. It would appear that the written signature of the predecessors of the firm applying for registration would not be within the Act (y). See also under sub-s. 1 (a).
NOTE.

1 (c.) "Distinctive."—This word must be construed as running through the whole of the sub-section (z).

The word "distinctive" imports a distinction in the product of one particular maker from that of others (a). And therefore, where a name was originally, or has come to be, descriptive of the article to which it is applied, so that while indicating what the article is, it does not connect it with any particular manufacturer, it cannot be registered as a trade mark (b). And see under s. 73, *post*.

If the mark is by the owner placed on boxes not containing his own goods, but marked with and containing the name of another manufacturer, it is not distinctive of the owner's manufacture and ought not to be registered (c).

But where a mark used generally for tobacco in packets was used by the proprietors on a few boxes of foreign cigars in such a way as merely to denote that they sold the cigars, and not to imply that they manufactured them, it was held that the mark had not lost its distinctive character (d).

The words "Old Innishowen" as applied to whisky, were held descriptive, and as such incapable of being registered as a trade mark (e).

And the mark of a manufacturer pure and simple cannot rightly be assumed by an importer from that manufacturer, or by a person who buys from that manufacturer, unless indeed when all the goods of the manufacturer go to that importer or that dealer (f).

Thus where the foreign owner of a mineral spring placed on the bottles containing water from the spring a label in which his own name appeared, it was held that purchasers from him who had not previously used the mark in this country, and had not the right to the whole produce of the spring, could not register the mark in this country even with the consent of the foreign owner (g).

(y) *Birmingham Vinegar Brewery Co.'s Application*, 11 R. P. C. 195, 197.

(z) *Burland v. Broxbourne Oil Co.*, 42 Ch. D. 274.

(a) *Apollinaris Co.'s Marks*, [1891] 2 Ch. 186, 226; see also *Re Anderson's Trade Mark*, 54 L. J. Ch. 1084.

(b) *Re Arbenz's Application*, 35 Ch. D. 248; *Magnolia Metal Co.'s*

Trade Mark, [1897] 2 Ch. 371; 14 R. P. C. 621.

(c) *Wood v. Lambert*, 32 Ch. D. 247.

(d) *Wills's Trade Marks*, [1893] 2 Ch. 262.

(e) *Watt v. O'Hanlon*, 4 R. P. C. 1.

(f) *Apollinaris Co.'s Trade Marks*, [1891] 2 Ch. 186, 226, 230.

(g) *Apollinaris Co.'s Trade Marks*, *ubi supra*. See also pp. 229, 230.

Sect. 64 (1).

NOTE.

And where a foreign maker of photographic cameras had been in the practice of sending his cameras to a firm in this country marked with his trade mark, and under circumstances which amounted to a user of the mark in this country by the foreigner, and the consignees had registered the mark in their own names, the entry was, in the absence of satisfactory evidence of the foreigner's consent to the registration, expunged on the application of subsequent purchasers of the foreigner's business and trade mark (*h*).

"Device."—In the case of *Orr Ewing v. Registrar of Trade Marks*, cited above, it was held that certain devices of lions, demi-lions, and elephants, with the name and address of the firm added, which had been put into the second class by the Manchester Committee of Experts as not being trade marks as defined by the Act (*i*), were "distinctive devices" within the Act of 1875, and that the registrar ought to proceed with the application to register them as cotton marks, although elephants, lions, and demi-lions had been, in fact, in common use in the trade as marks for cotton goods (*k*).

A name in foreign characters may be a distinctive device and entitled to registration (*l*). In such case, however, a transliteration and translation must be furnished to the comptroller, who may also require a translation if the trade mark contains a word or words in a language other than English (*m*).

A portrait of the inventor of the article, taken from a photograph, is not a sufficiently distinctive device to be entitled to registration *per se*, where the name of the inventor has become common to the trade as descriptive of the article (*n*). But where this is not the case there is no reason why the photograph of the person who invented a trade mark should not be in itself distinctive and capable of registration (*o*).

A pictorial representation of the article may be distinctive, and if the evidence shows that it is so in fact, it may be registered (*p*).

A device is not for the purposes of the Act the same as a word, and therefore it was held that there was no objection to the registration as a trade mark of a drawing of a magnolia, though it had been held that the word "Magnolia" was not under the circumstances a word which could be registered (*q*).

(*h*) *European Blair Camera Co.'s Trade Mark*, 13 R. P. C. 600.

(*i*) T. M. R. Aug. 1876, r. 59.

(*k*) See also *Re Dugdale's Application*, 49 L. J. (N.S.) Ch. 303.

(*l*) *Rotherham's Trade Mark*, 14 Ch. D. 585.

(*m*) T. M. R., [1897] r. 15.

(*n*) *Re Anderson's Trade Mark*, 26 Ch. D. 409, affirmed 54 L. J. Ch. 1081.

(*o*) *Rowland v. Micholl*, [1897] 1 Ch. 71.

(*p*) *Re James's Trade Mark*, 33 Ch. D. 392.

(*q*) *Magnolia Metal Co.'s Trade Marks*, [1897] 2 Ch. 371.

“Brand.”—A brand appears to be only a particular kind of mark, Sect. 64 (1). and a mark consisting only of words not capable of registration as fancy words cannot be registered as a brand (r). Further, it would seem to be necessary to the registration of a “brand,” that it should be used as a brand only by being impressed on the goods, and should not be used in the way a trade mark is ordinarily used, and that it may include a water mark (s).

NOTE.

“Heading.”—A single word used alone is not a “heading” within the clause (t).

“Label.”—When there was nothing distinctive in the form of a label, and it contained only the name of a firm in common letters and words which were not “fancy words not in common use,” it was held that the label as a whole did not contain any of the essential particulars required by the Act, and it was refused registration (u).

An oblong label in three parallel stripes of equal width, the two outer stripes shaded and the middle stripe being plain, and having on it the words “French Coffee,” and under them the words “red, white, and blue,” and below this letter-press in French and English, is not distinctive, and cannot be registered in colours under s. 67 (v).

And when a label consisted only of the name of the proprietor in ordinary type, and certain common flourishes and representations of certain gold medals, and it was shown that representations of such gold medals were in common use, it was held that the label did not contain any of the essential particulars required by the Act, and registration was refused (w).

The label does not consist of each particular part of it, but consists of the combination of them all (x). And the whole label may be an essential particular within the Act (y).

But when the label consisted of certain letters and words, with the name of the article, all in block type, with a device of St. George and the Dragon, and the comptroller refused to register unless the device was claimed as the essential particular, and the added matter disclaimed, which condition was declined by the applicant, it was held that the comptroller’s decision was right, and that the label did

(r) *Pirie v. Goodall*, [1892] 1 Ch. 35.

(s) See per VAUGHAN WILLIAMS, J., *Pirie v. Goodall*, [1892] 1 Ch. 41.

(t) *Leonard v. Wells*, 26 Ch. D. 289.

(u) *Re Price’s Patent Candle Co.*, 27 Ch. D. 681; *Bradley’s Trade Mark*, 9 R. P. C. 205.

(v) *Hanson’s Trade Mark*, 37 Ch. D. 112.

(w) *Bryant and May’s Trade Mark*, 8 R. P. C. 69.

(x) Per Lord ESHER, M.R., *Pinto v. Badman*, 8 R. P. C. 191.

(y) Per KEREWICH, J., *Birmingham Vinegar Brewery Co.’s Application*, 11 R. P. C. 195.

Sect. 64 (1). not contain any "essential particulars," and was incapable of registration (z).

NOTE.

Where the whole label is registered as a trade mark the words "trade mark" ought not to appear on it in such a way as to point to a particular device on the label as being the trade mark (a). And the registration of a label liable to this objection will be expunged except as to so much as is the real trade mark (b).

But the mere use of the words "trade mark" on the registered label will not disentitle the proprietor to sue. It is a question of fact in every case whether the words are so placed as to indicate that a claim is made to a particular part of the label only (c).

1 (d.) "An invented word or invented words."—This and the following essential particulars are by the Act of 1888 (d) substituted for the words "fancy word or words not in common use," which were an addition to the corresponding section of the Act of 1875. Under that Act it was held that the word "AEILYTON" could not be registered as a new mark (e).

As to invented words, the law before the Acts for the registration of trade marks, which law, it will be remembered, has not been altered by those Acts (f), was thus stated by Lord HATHERLEY, then Sir W. P. WOOD, V.-C. :—

"I have not the least doubt that if the plaintiff (if I doubted I should be going quite contrary to the *Mexican Balm case* (g), and other cases in which ridiculous names have been used) has invented a fanciful and ridiculous name—and the more ridiculous the better it is for his purpose—and has used it for eight or ten years in his trade, that then the court would take care that nobody else should use that absurd name; for such user could only be a user for the express purpose of imitating the plaintiff's, and so defrauding the plaintiff, by representing the goods manufactured by one person to be the goods manufactured by another" (h).

An "invented word" to be within the sub-section must be a word invented in fact and not merely in the belief of the person claiming to register it (i); it must be a word "coined for the first time" (j), and

(z) *Birmingham Vinegar Brewery Co.'s Application*, 11 R. P. C. 195.

(a) *Apollinaris Co.'s Trade Marks*, [1891] 2 Ch. 186, 233.

(b) *Wills' Trade Marks*, [1893] 2 Ch. 262.

(c) *Hammond v. Brunner*, 9 R. P. C. 301.

(d) See *post*, p. 516.

(e) *Ex parte Stephens*, 3 Ch. D. 659.

(f) See *post*, p. 442.

(g) *Perry v. Truefitt*, 6 Bea. 66.

(h) *Young v. Macrae*, 9 Jur. (N.S.) 323.

(i) *Sir Titus Salt's Application*, [1894] 3 Ch. 166, 168.

(j) *Per A. L. SMITH, L.J., Farbenfabriken Application*, [1894] 1 Ch. 658.

apparently it must have been invented or first used by the person seeking to register it (*k*). Sect. 64 (1).

The *quantum* of invention is not material, but a mere variation of the orthography or termination of a word is not sufficient if to the eye or ear the same idea would be conveyed as by the word in its ordinary form (*l*).

NOTE.

It was also held that an "invented word" must have no reference to the character or quality of the goods, and must have no meaning (*m*); and the Court refused to register the word "Satinine" for preparations for laundry purposes and perfumery (*n*); and "Somatose" for a pharmaceutical product applicable to the human body (*o*).

But in *Re Denham's Trade Mark* (*p*), where a tea dealer had registered the word "Mazawattee" as a trade mark for tea, and it was shown that it was compounded by joining the first syllables of a Hindustani word to the last syllables of a Cingalese word, and that the word thus made up did not exist in any language, it was held to have been invented within the Act, and a motion to expunge it was refused. And in this case the court intimated an opinion that the cases had gone quite far enough, and that if they went further the effect would be to nullify the Act.

And the word "Kynite" which was formed by taking the first syllable of the name of the applicants and adding the termination "ite" which is a common termination for explosives, was held to be an invented word, and to have no reference to the character or quality of the goods, and was admitted to registration (*q*).

And now in *Eastman Photographic, etc. Co.'s Trade Mark* (*r*), it has been held by the House of Lords that sub-ss. (d) and (e) of this section are separate and distinct, and that if the word be really an "invented word" it may be registered, whether meaningless or not, and whether it has or has not reference to the character or quality of the goods.

The court will have regard to the sound of the word proposed to be registered as an invented word, and where the word "Pearl" had been refused registration it was held that the word "Pirle," being a

(*k*) See *per* KAY, L.J., *Holt & Co.'s Trade Mark*, [1896] 1 Ch. 711, 722.

Application, [1894] 1 Ch. 645, 647, 656.

(*l*) See *per* Lord HERSCHELL, *Eastman Photographic, etc. Co.'s Trade Mark*, 15 R. P. C. 485; and see *Sir Titus Salt's Application*, [1894] 3 Ch. 166; *British Electrozone Co.'s Trade Mark*, 13 R. P. C. 447.

(*n*) *Meyerstein's Trade Mark*, 43 Ch. D. 604.

(*o*) *Farbenfabriken Application*, [1894] 1 Ch. 645, LINDLEY, L.J., *diss.*

(*p*) [1895] 2 Ch. 176.

(*m*) *Meyerstein's Trade Mark*, 43 Ch. D. 604; *Farbenfabriken*

(*q*) *Kynoch & Co.'s Trade Mark*, 14 R. P. C. 905.

(*r*) 15 R. P. C. 476.

Sect. 64 (1). mere misspelling of the word "Pearl," and the same in sound, could not be registered (s).

NOTE.

1 (e.) "A word or words having no reference to the character or quality of the goods."—The limitation here mentioned was always enforced when it was sought to register words as "fancy words" under the repealed sub-section. See *post*, p. 394, and see also under s. 73, *post*, p. 432.

A fictitious name such as the name of a character in a novel is a "word" within this sub-section, and can be registered alone (t). And where the word "Osman" was proved to denote a particular towel of the plaintiff's manufacture, and not the name of the towel by whomsoever made, a motion to expunge the word from the register was refused (u).

And if a word applied to a particular article had originally no reference to "the character and quality of the goods" it does not by subsequently becoming the name of the article come within the sub-section (a).

In considering whether the particular word has reference to the character or quality of the goods, the word must be regarded not from an etymological point of view, but from the ordinary point of view which would be taken by the ordinary British subject dealing with the particular goods (b). And on this ground the word "Typograph" was refused registration as a trade mark for the metal used in the business of the applicants, who were manufacturers of machines and articles adapted for and capable of being used by printers and type founders (c).

And the word "Compactum," which was the name given by a patentee to certain umbrellas made under his patent, and which had been registered by him as a trade mark, was after the expiry of the patent removed from the register (d).

"Not being a geographical name."—In *Re Van Duzer's Trade Mark* (e) it was held that "Melrose" could not be used as a trade mark for a hair restorer (f); but the court expressly refrained from deciding that no geographical term could be a "fancy word." This question cannot now arise.

(s) *Ripley's Trade Mark*, 15 R. P. C. 151; 77 L. T. (N.S.) 495.

(t) *Holt's Trade Mark*, [1896] 1 Ch. 711.

(u) *Barlow v. Johnson*, 7 R. P. C. 395.

(a) *Magnolia Metal Co.'s Trade Marks*, [1897] 2 Ch. 371, 392.

(b) *Per KEKEWICH, J., Linotype Co.'s Application*, 14 R. P. C. 900;

see also *Kynoch & Co.'s Trade Mark*, 14 R. P. C. 905.

(c) *Linotype Co.'s Application*, *ubi supra*.

(d) *Davis's Trade Marks*, 14 R. P. C. 903.

(e) 34 Ch. D. 623.

(f) See also *Re Ainslie's Trade Mark*, 4 R. P. C. 212; *Batt's Trade Mark*, 6 R. P. C. 493.

The phrase "geographical name" is not to be so widely interpreted as Sect. 64 (1). to be simply equivalent to the name of any place. "It must, in the absence of special circumstances, be interpreted so as to be in accordance in some degree with the general and popular meaning of the words, and a word does not become a geographical name simply because some place upon the earth's surface has been called by it. For example, the word 'Monkey' is not proved to be a geographical name by showing merely that a small and by no means generally known island has been called by that name. If, indeed, in its primary and obvious meaning the word has reference to a locality, as the word 'Melrose' in *Van Duzer's Case*, or the word 'Eboli' in *Sir Titus Salt & Co.'s Case*, it may well be a geographical name within the meaning of the sub-section. Even when the primary signification is not geographical, if the name is really a local name (however little known the locality may be), and the name is given because of the connection of the article with the locality, whether that be real, or imputed only by those who give the name, it may well be a geographical name within the meaning of the sub-section" (g).

NOTE.

And therefore where the word "Magnolia," the name of a flower, had been registered as a trade mark for anti-friction metal, it was held that the fact that there were places in America of that name was no objection to the registration, though it might have been a good objection if the metal had been manufactured there (h).

But the names of certain water springs known as "Apollinaris," "Friedrichshall," and "Hunyadi Janos" were held to be geographical names, and incapable of registration in respect of the waters of the springs, or of the products of these waters (i).

And the prohibition is not confined to the use of the noun substantive; it extends to the adjective, and to the name of a place to which an ordinary English suffix has been added, so as to impart to it an adjectival form: and therefore the word "Eboline" derived from "Eboli" was refused registration (k).

But though geographical names cannot be registered as trade marks, they must, if they have come to designate a particular manufacturer's goods in the market, only be used by a rival trader in such a way as not to mislead the public into buying goods of the latter as those of the original maker (l). And see *post*, p. 442.

(g) *Magnolia Metal Co.'s Trade Marks*, [1897] 2 Ch. 371, 393.

(k) *Sir Titus Salt's Application*, [1894] 3 Ch. 166.

(h) *Magnolia Metal Co.'s Trade Marks*, *ubi supra*. See *Batt's Trade Mark*, *ubi supra*.

(l) *Thompson v. Montgomery*, 41 Ch. D. 35; affirmed, [1891] A. C. 217; *Compania General de Tabacos v. Rehder*, 5 R. P. C. 61; *Wotherpoon v. Currie*, L. R. 5 H. L. 508.

(i) *Apollinaris Co.'s Trade Marks*, [1891] 2 Ch. 187.

Sect. 64 (1). The words "El Destino," the name of a cigar factory in Mexico, were held not open to objection under either branch of this sub-section (*m*).
NOTE. Nor was the word "Mazawattee" as a name for tea, though the last two syllables of the word, which are Cingalese, meant a garden and might be understood to refer more or less to Ceylon, and the first two syllables were a Hindustani word meaning "taste" (*n*).

Fancy words. There was considerable difference of opinion as to the meaning of the words "fancy words not in common use" in the repealed sub-sections.

It was at first held that it would allow the registration as trade marks of words which, though not strictly "fancy words," were fanciful words when applied to the goods in respect of which they were registered, as "Alpine" as a trade mark for cotton embroidery (*o*), and this view was also taken in other cases (*p*). But in *Van Duzer's Trade Mark* (*q*) it was held by the Court of Appeal that a word may not be registered as a trade mark if it is fancifully used, but only if it is a fancy word; that a "fancy word" must be a word "which obviously could not have reference to any description or designation of where the article is made or of what its description is." "It must be obviously non-descriptive when used as a trade mark." "It must be a word fanciful in its application to the article to which it is applied, in the sense of being so obviously and notoriously inappropriate as neither to be deceptive, nor descriptive, nor calculated to suggest deception or description"; and further, it "must have an innate and inherent character of fancifulness, which must not depend on evidence . . . it must be a fancy word of its own inherent strength."

On the above grounds the words "Melrose" as a trade mark for a hair restorer (*r*), "Glengowrie" as a name for whiskey (*s*), "Electric" as a trade mark for velveteen (*t*), were refused registration; since, in the one case, it was not obvious that the names were not intended to designate the places where the articles were produced, and in the other the word suggested a meaning, and might, rightly or wrongly, be associated with electricity. So also, the word "Reversi," which was the name of a game where the player reversed his adversary's counters, was expunged from the register (*u*).

(*m*) *Pinto v. Badman*, 8 R. P. C. 181; *Pinto v. Trott*, 8 R. P. C. 173.

(*n*) *Densham's Trade Mark*, [1895] 2 Ch. 176.

(*o*) *Re Trade Mark Alpine*, 29 Ch. D. 877.

(*p*) *Re Leaf, Son & Co.'s Trade Mark*, 33 Ch. D. 477; *Arbenz's Application*, 35 Ch. D. 248.

(*q*) 34 Ch. D. 623, 640, 642, 645.

(*r*) *Van Duzer's Trade Mark*, *ubi supra*.

(*s*) *Re Laing's Trade Mark*, 3 Times R. 728.

(*t*) *Leaf, Son & Co.'s Trade Mark*, 34 Ch. D. 623. See also *Great Tower Street Tea Co. v. Smith*, 5 Times R. 232; 6 R. P. C. 165.

(*u*) *Waterman v. Ayres*, 39 Ch. D. 20.

And where the word "Gem," as applied to air-guns, had become descriptive or indicative of the quality of a particular make of gun, it was held not to be a fancy word, and was not admitted to registration (x).

Sect. 64 (1).

NOTE.

But it did not follow that geographical names were necessarily to be excluded from registration, nor that any word found in a dictionary was *ipso facto* to be disqualified (y). Geographical names are now excluded by the modifications in the section introduced by the Act of 1888, see *ante*, p. 384.

The words "Zephyr Asiatic Walnut Pipe" (z), "Hand Grenade Fire Extinguisher" (a), "Jubilee" as a name for paper (b), "Self-Washer" as a name for soap (c), "Sanitas" as a name for medicine (d), "Washerine" as a name for a preparation for laundry purposes (e), have also been held incapable of registration as fancy words. So, also, the word "Bokol," the Norwegian name for a particular kind of ale, which had been registered as a trade mark of importers of the ale, was expunged from the register on the application of rival importers of Norwegian beer (f). And the word "Kokoko," the name for an owl in the language of the Chippeway Indians, was refused registration, the device of an owl being common to the trade (g). And, speaking generally, that which is the only name of a thing cannot be a fancy word with regard to it (h).

Other words which have been held incapable of registration as fancy words are "Manor" (i), "Britannia" (k), "Parchment Bank," as a name for paper (l), "Carnival" for cigarettes (m).

The following words have been refused registration or expunged as not being obviously non-descriptive: "John Bull Brand" for fermented liquors (n), "Emolliolorum" for a preparation for softening harness (o),

(x) *Re Arbenz's Application*, 35 Ch. D. 248.

(y) *Per LOPES, L.J., Van Duzer's Trade Mark*, 34 Ch. D. 645. See also p. 632.

(z) *Re Friedlander's Trade Mark*, W. N. (1885), 85.

(a) *Re Harden Star Hand Grenade Co.*, 3 R. P. C. 133.

(b) *Towgood v. Pirie*, 4 R. P. C. 67.

(c) *Lerer v. Goodwin*, 4 R. P. C. 492.

(d) *Sanitas Co.'s Trade Mark*, 4 R. P. C. 534.

(e) *Burland v. Broxbourne Oil Co.*, 6 R. P. C. 482.

(f) *Re Davis, Bergendael & Co.'s, Trade Mark*, 59 L. T. (N.S.) 854;

6 R. P. C. 207 (reported as *Davis v. Stribolt*).

(g) *Jackson Co.'s Trade Mark*, 60 L. T. (N.S.) 93; 6 R. P. C. 80.

(h) *Waterman v. Ayres*, 39 Ch. D. 30. See judgment of Fry, L.J.

(i) *Thompson's Trade Mark*, 6 R. P. C. 213.

(k) *Hodgson v. Sinclair*, 9 R. P. C. 22.

(l) *Pirie v. Goodall*, 9 R. P. C. 17.

(m) *Lloyd & Sons Trade Mark*, 10 R. P. C. 281.

(n) *Paine's Trade Mark*, 9 R. P. C. 130.

(o) *Talbot's Trade Mark*, 11 R. P. C. 77.

Sect. 64 (1). "The Beatrice" for ladies' shoes (*p*), "Hannay's electroid anti-fouling composition" (*q*), "Apollinaris" and other names of mineral-water springs for mineral waters (*r*), "Triticumina" as a name for preparations from wheat (*s*).

NOTE.

Names of
living
persons.

In *Slazenger v. Malings* (*t*), the words "The Lawford" were allowed registration in connection with tennis bats, Lawford being the name of a celebrated tennis player. But in *Banks and James' Trade Marks* (*u*), it was held that a name in use at the present day cannot be taken as a fancy word within the Act, although it has been borne by a celebrated man in past times, and on this ground the word "Shakespeare" was expunged from the register.

The addition of the definite article to a word not of itself a fancy word, was held not to make it a fancy word within the Act (*v*).

The word "Oomoo," a word in the aboriginal language of Australia signifying choice, was held to be a "fancy word," and was registered in respect of Australian wines and spirits (*x*). So also the word "Bovril" has been held a good fancy word (*y*). And the word "Mazawattee" as a word for tea (*z*).

The question is whether the fancy word is non-descriptive at the time it is placed on the register; and if it is, the fact that it has since become descriptive is no ground for removal from the register (*a*).

SUB-SECTION (2).

"There may be added to any one or more of the essential particulars," etc.—Descriptive words, though incapable of registration alone, might, under the Act of 1875, and may, under the present Act, be registered as "added" to one of the "essential particulars" of a trade mark capable of registration. Thus the words "Filtre Rapide" were allowed to be registered in combination with a written signature, and this although the words "Rapid Water Filter" were already on the register (*b*).

(*p*) *Harris's Trade Marks*, 9 R. P. C. 492.

(*q*) *Hannay's Trade Mark*, 7 R. P. C. 46.

(*r*) *Apollinaris Co.'s Trade Mark*, [1891] 2 Ch. 186.

(*s*) *Meaby v. Triticine, Ltd.*, 15 R. P. C. 1.

(*t*) W. N. (1885), 124.

(*u*) 12 R. P. C. 333.

(*v*) *Re The Trade Mark Alpine*, 29 Ch. D. 877, 879.

(*x*) *Re Burgoyne's Trade Mark*, W. N. (1889), 53; 6 R. P. C. 227.

(*y*) *Re Bovril Trade Mark*, [1896] 2 Ch. 600.

(*z*) *Densham's Trade Mark*, [1895] 2 Ch. 176, cited *ante*, p. 391.

(*a*) *Re Bovril Trade Mark*, [1896] 2 Ch. 600.

(*b*) *Re Maignen*, 28 W. R. 759.

So, also, a figure of Neptune with a trident, and with the word "Neptune," that being the name by which the goods were known in the market, was held to have been properly registered (c). And the words "Carbolic Acid Soap Powder" (d), "Sanitary Filter, easily cleaned" (e), each in combination with a distinctive device, were allowed registration.

Sect. 64 (2).

NOTE.

But in such cases it is only the label as a whole which is protected. No right to the exclusive use of these common words is gained by the registration (f). In one case the order allowing registration was prefaced by a declaration of the opinion of the court to this effect (g). Now, however, under the amended sub-section, the applicant must state the essential particulars of his trade mark, and disclaim the exclusive use of the added matter.

Where Baron Liebig was the inventor of an extract of meat, and the name Liebig had become common to the trade as designating the particular extract, a proposed trade mark, consisting of the words "Brand Baron Liebig," with a portrait copied from a photograph of the Baron, was refused registration, the latter not being a "distinctive device" capable of registration *per se* (h).

And the words "John Bull Brand" were held, in the Court of Appeal, to have been rightly registered as addition to a trade mark consisting of a figure of John Bull (i).

Marks for cotton goods, consisting of a shield or frame in the shape of a shield, with (1) letters indicative of the firm itself, (2) representation of a swan, and also letters indicative of the firm, varying letters being used on each mark, indicating the date and packer of each parcel of calico, were considered sufficiently distinctive to be registered as old marks, on an undertaking not to use them except in the manner in which they had been previously used (j).

"The . . . applicant must state . . . the essential particulars . . . and must disclaim," etc.—This requirement was introduced by the Act of 1888, and extends the provisions of s. 74 (2) to added matter not common to the trade. Under the Act of 1875 there was no power

(c) *Edwards v. Dennis*, 30 Ch. D. 457.

(d) *Hudson's Trade Marks*, 32 Ch. D. 311.

(e) *Re Atkins' Trade Mark*, 3 R. P. C. 164.

(f) *Re Hudson's Trade Marks*, *ubi supra*; *Atkins' Trade Mark*, *ubi supra*. See also *Smokeless Powder Co.'s Trade Mark*, [1892] 1 Ch. 590.

(g) *Re Hudson's Trade Marks*, 3 R. P. C. 155, 164. This Order is printed W. N. (1886), p. 71.

(h) *Anderson's Trade Mark*, 26 Ch. D. 409, affirmed 54 L. J. Ch. (N.S.) 1084.

(i) *Paine v. Daniell*, [1893] 2 Ch. 567.

(j) *Re Sykes & Co.'s Trade Mark*, 29 W. R. 235.

Sect. 64 (2). to require the applicant to disclaim the right to the exclusive use of any of the words in the trade mark presented for registration (*k*).

NOTE.

For the proper mode of complying with this provision, see T. M. R., Form F.

Where the application is to register a label, the label itself may be an essential particular. But a red label, containing the name of the goods with a device in a shield, and certain capital letters nearly as large as the label, and printed in white upon it, and with a *facsimile* signature and flourishes, is not such a label (*l*).

SUB-SECTION (3).

“(i) A person need not . . . disclaim his own name.”—This applies to a firm as well as to an individual, and whether the name is the name of a firm or an individual, it need not be disclaimed, nor need the whole name appear on the trade mark if it is used fairly and *bonâ fide* on the face of the trade mark, so that it cannot be mistaken for anything else than the name of the owner of the mark and the manufacturer of the goods. And therefore, when the name of a firm was J. Colman (*m*), and all the partners bore that name, it was held that a label containing the words “Colman’s mustard” might be registered without disclaiming the word “Colman.”

And it would seem that the above rule applies whether the name is the actual name of the applicant or a name assumed for trading purposes (*n*).

General rule as to rival traders of same name.

“But no entry of any such name shall affect the right of any owner of the same name,” etc.—The law as affecting rival traders of the same name dealing in the same article was thus stated by BRANWELL, L.J., in *Massam v. Thorley’s Cattle Food Co.* (*o*): “It is said that it is hard if a man has the name of Thorley that he cannot make food and sell it as Thorley’s food. So he may, but if, unfortunately for him, some preceding Thorley has carried on the business of making cattle food in such a way that by the name ‘Thorley’s cattle food’ is understood the manufacture of that man, then the second Thorley, or the man who assumes his name, must take care so to

(*k*) *Hudson’s Trade Marks*, 32 Ch. D. 311; *Thompson v. Montgomery*, 58 L. J. Ch. 94; 41 Ch. D. 35, [1891] A. C. 217.

(*l*) Per KEKEWICH, J., *Birmingham Vinegar Brewery Co.’s Application*, 11 R. P. C. 195, 196.

(*m*) *Colman’s Trade Mark Application*, [1894] 2 Ch. 115.

(*n*) *Colman’s Trade Mark Application*, *ubi supra*.

(*o*) 14 Ch. D. 760.

conduct his business as not to be mistaken for the original Thorley, and Sect. 64 (3). if he carries on his business so as to be mistaken, he must be restrained from doing it.”

NOTE.

And again, in *Melachrino v. The Melachrino Egyptian Cigarette Co.* (p), CHITTY, J., said: “It is said that a man has a right to carry on business under his own name, and that is unquestionably so; but where there is already an established business carried on under the same name, it is important to see that the man who happens to have the same name and starts in the same business, carries on that business fairly and honestly, and not in such a manner as to deceive the public into the belief that the two businesses are one and the same. Honestly he may trade under his own name, but he must be careful not to trade under his own name in such a manner as to take away that which lawfully belongs to another man.”

Thus, where the plaintiff and defendant were brothers, each entitled to make a particular article from a receipt which had descended to them from their father, and the defendant, who had a partner, traded in his own name with the addition “& Co.,” whereby his firm name became the same as that of the plaintiff firm except the initials, and the defendants were proved to have attempted to represent that the business which they carried on was the business of which the plaintiff was the proprietor, an injunction was granted (q).

So, also, where one Thomas Holloway had for some time sold a medicine as “Holloway’s Pills,” an injunction was granted to prevent the sale by a person whose name was Henry Holloway of pills under the name of “H. Holloway’s Pills” in such a way as to induce the public to believe they were buying the medicine of the original maker (r).

And where the plaintiff had for many years sold certain medical preparations under his own name as “A——’s Safe Cures,” and they had become known in the market as “A——’s Cures,” the defendant, whose name was the same as that of the plaintiff, and who sold a preparation which he called “A——’s Gout and Rheumatic Cure,” was restrained from selling any preparation not of the plaintiff’s manufacture so as to lead to the belief that such preparations were the goods of the plaintiff (s).

In cases between persons of the same name the proper form of injunction now is to restrain the defendant from carrying on his business under any name of which the name complained of forms

(p) 4 R. P. C. 220.

(q) *Fullwood v. Fullwood*, 9 Ch.D. 176.

(r) *Holloway v. Holloway*, 13 Bea.

209.

(s) *Warner v. Warner*, 5 Times R. 327, 359.

Sect. 64 (3). part without clearly distinguishing his goods from those made or sold by the plaintiff (*t*).

NOTE.

So also an injunction has been granted restraining the omission by the defendant of his second Christian name, whereby his name appeared to be the same as that of the plaintiff (*u*).

And a man cannot sell his own name to another for the purpose of enabling him to carry on a rival trade, particularly when it is for the purpose of carrying on a rival trade fraudulently (*v*).

Thus, in the well-known case of *Croft v. Day* (*x*), where the defendant, whose name was Day, obtained the authority of a man named Martin to use his name, and began to sell goods under the firm of Day and Martin, he was restrained, at the suit of the executors of the survivor of the original firm of that name, from selling his manufactures as being that of the plaintiffs.

And where a servant who had been in plaintiff's employment entered into partnership with another person of the same surname as plaintiff, and the two began to sell an article the same as that sold by plaintiff, under a name only colourably different from that used by him and with their firm name attached, the new partner's name being placed first, an injunction was granted (*y*).

So, also, where the plaintiffs were executors of a needle manufacturer with a large business, and the defendants, who were rival manufacturers, purchased a patent for making needles belonging to a nephew bearing the same name as the plaintiff's testator, and also the goodwill of a small trade in needles, carried on by the nephew, and the defendants conducted their business so as to deceive the public, an injunction was granted (*z*).

And where the defendants traded as a company, with a name in which the name of the original maker of the article sold by the company appeared, and the only connection of the company with that name was that a member of the family of the original makers, who was employed by the company to make the article, took a 1s. share in the company, it was held that the company were not at liberty to use the name for their article unless they took such precautions as would prevent purchasers from supposing that the article sold by them was manufactured at the establishment of the original maker (*a*) So, also, waere

(*t*) *Pinet v. Maison Pinet*, 14 R. P. C. 933.

(*u*) *James v. James*, L. R. 13 Eq. 421.

(*v*) See *per* CHITTY, J., *Melachrino v. The Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215; *Tussaud v. Tussaud*, 44 Ch. D. 678.

(*x*) 7 Bea. 84.

(*y*) *Schweizer v. Atkins*, 37 L. J. Ch. 847.

(*z*) *Perks v. Hall*, W. N. (1881), 111.

(*a*) *Massam v. Thorley's Cattle Food Co.*, 14 Ch. D. 748.

the plaintiff was the proprietor of an old established library business known as the "Grosvenor Library" he was held entitled to restrain a newly established company from carrying on a like business under the same name (b). Sect. 64 (8).

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NOTE.

And where the brother of the plaintiff had entered into an agreement with the defendant to act as his manager of a business, to be carried on under the brother's name, it was held, under the circumstances, that the business was really the defendant's, and that there was an obvious intention to take away the plaintiff's trade, and an injunction was granted (c).

So, also, a firm of needle makers, named Shrimpton and Hooper, who were in the habit of selling their goods in packets stamped with their name, were held entitled to prevent the defendant from selling needles in packets marked "Shrimpton Turvey," the latter not being the defendant's name, but the name of a person not a needle maker, and who had authorised the defendant to use his name (d).

If, however, the defendant uses his own name in his business in such a way as not to represent his goods as the goods of the plaintiff, the injunction will be refused. "In applications of this kind it must be made out that the defendant is selling his own goods as the goods of another. Where a person is selling goods under a particular name, and another person, not having that name, is using it, it may be presumed that he so uses it to represent the goods sold by himself as the goods of the person whose name he uses; but where the defendant sells goods under his own name, and it happens that the plaintiff has the same name, it does not follow that the defendant is selling his goods as the goods of the plaintiff. It is a question of evidence in each case whether there is false representation or not" (e). Where use of own name not restrained.

And therefore, where the father of the plaintiff and the plaintiff had carried on business in partnership at 107, Strand, which business the plaintiff continued after the father's death as executor and sole residuary legatee of the father, and another son commenced a similar business, describing himself by his own name and adding "late of 107, Strand," an injunction was granted restraining the use of the latter words; but an injunction against the use of the defendant's name in connection with the articles sold by him was refused, there being no

(b) *Hoby v. Grosvenor Library Co.*, 28 W. R. 386. See also *Hendriks v. Montagu*, 17 Ch. D. 638; *Manchester Brewery Co. v. North Cheshire and Manchester Brewery Co.*, 14 Times R. 350.

(c) *Melachrino v. The Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215.

(d) *Shrimpton v. Laight*, 18 Bea. 164; *Southorn v. Reynolds*, 12 L. T. (N.S.) 75; *Barber v. Manico*, 10 R. P. C. 93.

(e) *Per TURNER, L.J., Burgess v. Burgess*, 3 D. M. & G. 896. See also *Jamieson v. Jamieson*, 14 Times R. 160; 15 R. P. C. 169.

Sect. 64 (3). representation made by the defendant that his goods were the goods manufactured by the plaintiff (*f*).

NOTE.

And two persons or firms may each be entitled to use a name which both have derived from a common predecessor (*g*).

And when plaintiff had for many years carried on business as 'T. T. and Sons, and the defendant J. T. had carried on business in the same town as J. T., and then as J. T. & Co., and on taking his sons into partnership changed the name of his firm to J. T. and Sons, an injunction was refused, there being no evidence of imitation of trade marks or labels or of any attempt to deceive (*h*).

So, also, where a Canadian Insurance Company had for several years carried on business as the "Sun Life Assurance Company of Canada," it was held that an old established English Company called the Sun Life Assurance Company could not restrain the use of the name "Sun" or the "Sun Life" by the Canadian Company, provided it was always used in connection with the words "of Canada." (*i*)

But where a company was trading under a name derived from one of its directors who had only recently adopted the name, having changed his original name, it was held that the company had no rights against a plaintiff who had long previously traded under the same name, and an injunction was granted (*k*).

(ii.) "Special and distinctive word or words . . . used as a trade mark before the 13th day of August, 1875," etc.—Two things are here made requisite in order to registration—

1. The word or words must be "special and distinctive";
2. They must have been "used as a trade mark" before August 13th, 1875, the date of the passing of the Act of 1875 (*l*).

We will consider these in order.

"Special and distinctive."—"The word or words must be distinctive in this sense, that they distinguish the manufacture of the person who registers the trade mark from the manufacture of all others. . . . There may be cases in which they distinguish not the manufacture but the selection or some other operation upon the goods, but in all cases the word or words must distinguish the product of the person claiming the trade mark from the product of all other persons" (*m*).

(*f*) *Burgess v. Burgess*, *ubi supra*.

(*g*) *Dent v. Turpin*, 2 J. & H. 139, 147. But see *Daniel v. Whitehouse*, 67 L. J. Ch. 262.

(*h*) *Turton v. Turton*, 42 Ch. D. 128.

(*i*) *Sunders v. Sun Life Assurance Co. of Canada*, [1894] 1 Ch. 537.

(*k*) *Pinet v. Maison Louis Pinet*, [1898] 1 Ch. 179.

(*l*) *Wood v. Lambert*, 32 Ch. D. 247, 259, 262.

(*m*) *Per* FREY, L.J., *Wood v. Lambert*, 32 Ch. D. 262; *Leonard v. Wells*, 26 Ch. D. 304; *Re Perry Davis' Trade Mark*, 5 R. P. C. 333,

The name of an individual or firm printed in ordinary type may, if Sect. 64 (3). it has been used as a trade mark before the Act of 1875, be registered as an old mark under this sub-section (n).

NOTE.

The question whether words merely descriptive of a new article, and applied to it by the person who first invents the article or introduces it into the market, can in any case be registered as old marks has not been expressly decided. In the decided cases, where such words have been removed from the register, the ground of removal has been either that the words had not been "used as a trade mark" within the Act (o), or had been specially so used as not to be "distinctive" of the plaintiff's goods (p).

Descriptive words as old marks.

But in *Re Palmer's Trade Mark*, where the words in question had been used to designate a particular description of cigar lights, the subject of a patent since expired, BAGGALLAY, L.J., said, that if, by reason of the patentee using a word descriptive of the nature of his patent for the purpose of describing his article, he could acquire a title to the exclusive use of that name afterwards, it would simply be enabling him by a perversion of the Registration of Trade Marks Act to give an indefinite extension to the monopoly acquired by him under the patent; and that the alleged trade mark was not a trade mark such that an exclusive right to its use could have been enforced before the Act came into operation, and was not, therefore, a trade mark entitled to registration under the Act (q). And see also, *post*, p. 405.

And in *Leonard v. Wells*, FRY, L.J., said: "When a new material is invented and at the same time a new single word is invented which is applied to that material alone, I am by no means satisfied at present that that single word can be treated as a special and distinctive word within the meaning of the section" (r).

And in *Re Ralph's Trade Mark* (s), where a washing machine, which had been exclusively manufactured by a licensee under a patent, had been sold under the name "The Home Washer," PEARSON, J., while directing the mark to be expunged from the register on a special

341, reported as *Re Harbord*, 58 L. T. (N.S.) 695. And see judgment of Lord HALSBURY, C., in the case when in the House of Lords, 15 App. Cas. 320.

remarks of FRY, J., in *Linoleum Manufacturing Co. v. Nairn*, 7 Ch. D. 837.

(r) 26 Ch. D. 304. See also remarks of the same learned judge in *Wood v. Lambert*, 32 Ch. D. 262; *Linoleum Co. v. Nairn*, 7 Ch. D. 837; and see *per* COTTON, L.J., 26 Ch. D. 301; *per* KAY, J., *Re Grossmith's Trade Mark*, 6 R. P. C. 183; and *per* LINDLEY, L.J., *Palmer's Trade Mark*, 24 Ch. D. 521.

(s) 25 Ch. D. 194.

(n) *Hankinson's Trade Marks*, [1892] 2 Ch. 116.

(o) *Re Palmer's Trade Mark*, 24 Ch. D. 504; *Leonard v. Wells*, 26 Ch. D. 288.

(p) *Wood v. Lambert*, 32 Ch. D. 259.

(q) 24 Ch. D. 517; and see

Sect. 64 (3). ground peculiar to the Act of 1875, said, that he was very much disposed to think that if he had to decide the case on a point which had been raised that the name ought not, under the circumstances, to have been registered as a trade mark at all, he should decide that the case came within *The Linoleum Co. v. Nairn* (t), and that the trade mark ought to be removed on that ground also.

NOTE.

But in *Leonard v. Wells*, Lord SELBORNE, C., said, in reference to the word "Valvoline," which was a name given by the plaintiffs to a lubricating oil invented by them, that he was not disposed to doubt that if that word had been used in the United Kingdom as a trade mark before the passing of the Act of 1875, it might have been registered under that Act (u).

And in *Edgington v. Edgington* (v), it was held that the mere use of a word as the name of the article on letters, testimonials, and the like, dated before 1875, was not a fatal objection to its registration as an "old mark."

Where the word "Bodega," which is a Spanish word descriptive of a wine shop, had been used as a trade mark before 1875, it was held capable of registration as a trade mark for "wines, etc. and tobacco" (w).

It is doubtful whether the scientific name of a tree is a "distinctive word" capable of being registered as an old trade mark for a product of the tree (x).

The word "royal" in connection with the name of a company was held not sufficiently "special and distinctive," and was refused registration (y). So, also, the word "registered" will not be put on the register, either alone or as part of a mark (z). See also p. 458, *post*.

On a motion to expunge an old mark on the ground that it has not been used as a trade mark within this sub-section the burden of proof is on the applicants, and the court will, as against them, take into consideration the lapse of time since the registration and the circumstances under which the application is made (a).

The words "Family Salve" (b), "Kitchen Crystal Soap" (c), "Baffle," (as a mark for safes) (d), have been held entitled to registration as old marks.

(t) *Ubi supra*.

(u) 26 Ch. D. 295.

(v) 6 R. P. C. 513.

(w) *Bodega Co. v. Owens*, 6 R.P.C. 236; 7 R. P. C. 31.

(x) *Rose v. Evans*, 48 L. J. Ch. 618.

(y) *Re Royal Baking Powder Co.*, W. N. (1879), 108; affirmed on appeal, W. N. (1880), 49.

(z) *Re Meikle's Trade Mark*, W.N. (1876), 248.

(a) *Edgington v. Edgington*, 6 R. P. C. 513, 518.

(b) *Reinhardt v. Spalding*, 49 L.J. Ch. 57.

(c) *Eastman's Trade Mark*, W. N. (1880), 128.

(d) *Talbot v. Webley*, 3 R. P. C. 276.

And words such as "Melrose," "Electric," though not "fancy words Sect. 64 (3). not in common use," and therefore incapable of registration as new marks, might, if they had been used for a considerable time, and the trade had recognized goods to which these words were affixed as being the goods of the applicants for registration, be registered as old marks (e).

NOTE.

And it is not impossible that a word which is used to describe an article may also, if the proper means are taken at the proper time, be used as a trade mark (f).

And where the first producer of an article of manufacture has identified it with a particular name or word, such name or word may become a trade mark (g); as, for instance, "Singer" (the name of the original maker), as applied to sewing-machines (h); "Harvey," as a name for a sauce (i); "Turin," "Sefton," "Leopold," or "Liverpool," as names for cloth (k); "Eureka" for shirts (l); "United Service" for soap (m); "Eton" for cigarettes (n); "La Flor de Margarett" for cigars (o); and "Chartreuse" for a liqueur (p).

Name given by first producer.

But it is established as a general rule, that where an article is made under a secret process, or where the manufacture of it is protected by a patent, the manufacturer or patentee cannot by any means entitle himself to a monopoly in the use, after the secret process has been discovered or the term of the patent has expired, of the name by which the manufactured article is exclusively known whilst the secret is undiscovered, or the term of the patent is unexpired (q).

Name of article made under secret process or patent.

The name of a place may become a trade mark, thus: "Anatolia" (r), as applied to liquorice; "Glenfield," as applied to starch (s); "Cormac" (s), as applied to starch.

Name of a place.

(e) See per COTTON, L.J., *Van Duzer's Trade Mark*, 34 Ch. D. 623, 635. See also remarks of KAY, J., *Compania General de Tabacos v. Rehder*, 5 R. P. C. 61, 65.

(f) Per Lord SELBORNE, C., *Leonard v. Wells*, 28 Ch. D. 296. See also per FRY, L.J., *Wood v. Lambert*, 32 Ch. D. 262; but see remarks of KAY, J., *Re Grossmith's Trade Mark*, 6 R. P. C. 183.

(g) *Singer Co. v. Wilson*, 3 App. Cas. 376; *Singer Co. v. Loog*, 8 App. Cas. 15, 17, 35.

(h) *Singer Co. v. Wilson*, *ubi supra*.

(i) *Lazenby v. White*, 41 L. J. Ch. 354.

(k) *Hirst v. Denham*, L. R. 14 Eq. 543.

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

(m) *Field v. Lewis*, Seton, p. 537.

(n) *Wood v. Lambert*, 32 Ch. D. 247, PEARSON, J.

(o) *Benedictus v. Sullivan*, 12 R. P. C. 25.

(p) *Grezier v. Autran*, 13 R. P. C. 1; *Grezier v. Ziemer*, Seton, 536.

(q) *Magnolia Metal Co.'s Trade Mark*, [1897] 2 Ch. 371, 391; *Meaby v. Triticine, Ltd.*, 15 R. P. C. 1. See also per FRY, J., *Linoleum Manufacturing Co. v. Nairn*, 7 Ch. D. 837. And see CHITTY, J., *Palmer's Trade Mark*, 24 Ch. D. 509, and *Native Guano Co. v. Sewage, etc., Co.*, 8 R. P. C. 125, 132, 134 (a case of an old mark).

(r) *McAndrew v. Bassett*, 4 D. J. & S. 380.

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

Sect. 64 (3). Springs" (*t*); "Radstock," as applied to collieries within the parish of that name (*u*); "Apollinaris," as applied to mineral waters (*x*).

NOTE. Geographical words cannot now, however, be registered as essential particulars of a trade mark (*y*).

Words must be distinctive at date of registration.

In order to be capable of registration the words must be "special and distinctive" at the time of registration (*z*). And therefore, where the word "Eton" was registered by a manufacturer as an old mark for cigarettes, and it was proved that he had before registration been in the habit of selling and supplying for the purposes of sale "Eton" cigarettes in boxes so labelled (in conformity with an alleged trade custom) as to imply that the cigarettes were made by a Russian firm at St. Petersburg, the mark was removed from the register (*a*).

Must not have been used as descriptive.

(iii.) "Used as a trade mark."—Some use of the term, not as a descriptive term, but as a trade mark, must be shown in order to bring the case within this provision (*b*). And where the words "braided fixed stars" had been used merely to describe an article made under a patent which had expired, they were held not to have been "used as a trade mark" (*c*). So, also, where the word "Valvoline" had been used to describe a particular lubricating oil invented by the plaintiffs (*d*), and where the word "Albion" had been used simply to indicate the design and pattern of the goods (*e*).

Must have been used alone.

And the words must have been used by themselves as a trade mark, not in combination with any device or any other words (*f*). And where the words had only been used as part of a label (*g*), or in combination with a device and a name (*h*), or with a name only (*i*), it was held that they had not been "used as a trade mark" within the Act.

And where brewers at Stone had used, before 1875, the words "Stone ale" in combination with some device or the name of the firm, and had not used the words "Stone ale" alone, the registration of these words as

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

(*u*) *Braham v. Beacham*, 7 Ch. D. 848.

(*x*) *Apollinaris Co. v. Edwards*, Seton, p. 537; *Apollinaris Co. v. Norrish*, 33 L. T. (N.S.) 242.

(*y*) *Ante*, pp. 384, 392.

(*z*) *Wood v. Lambert*, 32 Ch. D. 258. See *Edwards v. Dennis*, 30 Ch. D. 454, 479.

(*a*) *Wood v. Lambert*, *ubi supra*.

(*b*) *Per Lord SELBORNE*, C., *Leonard v. Wells*, 26 Ch. D. 298.

(*c*) *Re Palmer's Trade Mark*, 24 Ch. D. 504, 519.

(*d*) *Leonard v. Wells*, *ubi supra*.

(*e*) *Harrison McGregor & Co.'s Trade Marks*, 42 Ch. D. 691.

(*f*) *Re Palmer's Trade Mark*, 24 Ch. D. 504, 518; *Leonard v. Wells*, *ubi supra*; *Perry Davis v. Harbord*, 15 App. Cas. 316.

(*g*) *Re Palmer's Trade Mark*, *ubi supra*.

(*h*) *Spencer's Trade Marks*, 3 R. P. C. 73.

(*i*) *King & Co.'s Trade Mark*, 9 R. P. C. 350, 353.

an old mark was expunged (*k*). So, also, the words "Pain Killer," which had only been used before the Act as part of the expression P's Vegetable Pain Killer, were held incapable of registration as an old mark (*l*). And where the words "Yorkshire Relish" had only been used as part of a label containing a willow pattern plate and other things, and the name of the maker, the registration of the words was expunged (*n*).

Sect. 64 (3).

NOTE.

User of the words "as a trade mark" means the impressing of those words either upon the goods, or upon some wrapper or case containing the goods, in such a way that the public would necessarily understand those words to be, and alone to be, the trade mark of the person who uses them (*o*).

Must have been used on the goods.

Thus, where the words "Excelsior Spring Mattress" had been stamped on the mattresses, and on billheads and notices, and photographs of the mattress had been published showing the stamp, it was held that the words had been used as a trade mark (*p*).

But where the words "Monopole" and "Dry Monopole," registered as old marks for champagne, had only been used before the Act (1) on bottle labels or wrappers, in connection with the grower's name and other words, (2) on the side of corks, the bottom of which was branded with a registered mark consisting of the grower's name and a device, (3) on cases containing bottles labelled and wrapped as above, each case having on one side the words in question, and on one end another registered mark of the grower which contained his name, it was held that the words had not been used as a trade mark within the Act, and the registration was expunged (*q*).

So, also, where the words "Diamond Cast Steel" had been used on files, but only in conjunction with the maker's name, though the latter was only on the other side of the file, it was held that there had been no sufficient user (*r*).

And the use of the words "Yorkshire Relish" stencilled on packing cases containing bottles of sauce having thereon labels of which the above words formed part, was held not to be such a user of the words as to entitle them to registration as an old mark (*s*).

(*k*) *Thompson v. Montgomery*, 41 Ch. D. 35.

(*l*) *Perry Davis v. Harbord*, 15 App. Cas. 316.

(*n*) *Re Powell's Trade Mark*, [1893] 2 Ch. 388; [1894] A. C. 8.

(*o*) *Per KAY, J., Richards v. Butcher*, [1891] 2 Ch. 522, 532; and see also judgment of Lord ESHER, M.R., *ibid.* p. 543, and in *Re*

Spencer's Trade Marks, 3 R. P. C. 74.

(*p*) *Re Chorlton and Dugdale's Trade Mark*, 34 W. R. 60.

(*q*) *Richards v. Butcher*, [1891] 2 Ch. 522. See also *Kinahan's Application*, 10 R. P. C. 393.

(*r*) *Spencer's Trade Marks*, 3 R. P. C. 73.

(*s*) *Powell's Trade Mark*, [1893] 2 Ch. 388; [1894] A. C. 8.

Sect. 64 (3). And it is doubtful whether user on packing cases which are returned by the customer is a use in connection with the goods in the packing case (*t*).

NOTE.

Where the words "H.'s Coker Canvas" were never stamped on the goods of the firm, and had never been advertised as a trade mark, but customers had inquired for "Coker Canvas" or "H.'s Coker Canvas," it was held that the words had not been used as a trade mark (*u*).

A trade mark is not used within the Act by being put up in a warehouse or by advertising it in a newspaper (*x*).

"Before the 13th day of August, 1875."—If the statement made to the comptroller on this point be untrue in fact, although it may have been made without fraud, the trade mark will be removed from the register (*y*).

"Letter, figure, . . . combination of letters and figures."—These words are additions to the Act of 1875, under which it was held that a single letter could not be registered as an old mark (*z*).

A word in foreign characters may be registered (*a*), but a transliteration and translation must be supplied to the comptroller (*b*).

Although words or devices indicating merely quality cannot be registered, combinations of letters, indicating to purchasers (1) that the goods are made by a particular firm, and (2) the quality and pattern of the goods, are valid trade marks, and may be registered (*c*).

Price is no part of a trade mark, and therefore registration was refused for a mark containing words of price; but registration of two old marks was allowed, with a note that the marks might be varied in respect of price (*d*).

Representative registration.

Where a firm had been in the habit of using as trade marks for iron the letters "B B H" which were the initials of the firm, and also the same marks coupled with symbols or words common to the trade, denoting the quality of the iron, and the registrar objected to separate registration of each mark, it was suggested by the Court of Appeal,

(*t*) See *per* Lord ESHER, M.R., *Richards v. Butcher*, [1891] 2 Ch. 522, 545.

(*u*) *Re Hayward's Trade Mark*, 54 L. J. Ch. 1003.

(*x*) See *per* Lord ESHER, M.R., *Re Spencer's Trade Marks*, 3 R. P. C. 74.

(*y*) *Baker v. Rawson*, 45 Ch. D. 519.

(*z*) *Re Mitchell's Trade Mark*, 7 Ch. D. 36.

(*a*) *In re Rotherham's Trade*

Mark, 11 Ch. D. 250; 14 Ch. D. 585. See also judgment of MALINS, V.-C., *Re Barrow's Trade Marks*, 5 Ch. D. 364.

(*b*) T. M. R., 1897, r. 15, *post*. So also if the trade mark contains a word in a foreign language, *ibid*.

(*c*) *Ransome v. Graham*, 47 L. T. (N.S.) 218; 51 L. J. (N.S.) Ch. 897. See also *Ainsworth v. Walmisley*, L. R. 1 Eq. 518.

(*d*) *Re Steedman's Trade Mark*, L. J. No. Ca. (1883), 83.

and accepted by the parties, on an appeal from a decision of **Sect. 64 (3).**
MALINS, V.-C., ordering separate registration, that the proper mode of
 registering was to register "B B H" "either used alone or in common
 with a crown, or with a horse-shoe, or with a crown and horse-shoe" (the
 symbols objected to as common to the trade), "or with any other mark,
 device, or words, signifying the quality of the iron" (e). And in a
 subsequent case of *Re Brooks' Trade Mark* (f), it was held by **HALL, V.-C.**,
 that this method of registration (which was known as representative
 registration) ought to be adopted in like cases, and that such a series
 of marks was not entitled to separate registration. As to registering
 such marks now, see *post*, s. 66.

NOTE.

In the words of this sub-section there is only a permission to register
 the mark. The comptroller is not bound to register it. He must look
 at all the facts of the case and see whether it is proper, under all the
 circumstances, to register the word (g). See also under s. 73, *post*.

Sub-section 3
 is permissive
 only.

65. A trade mark must be registered for particular goods
 or classes of goods (h).

Connexion
 of trade mark
 with goods.

See notes under s. 62 (3), *ante*, p. 378.

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) state-
 ments 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.

Registration
 of a series of
 marks.

See T. M. R. 1897, *post*, r. 14.

This section deals with what was known as representative registration
 (see *ante*, notes to s. 64 (3), p. 408), and the last clause secures to the

(e) *Re Barrow's Trade Marks*,
 5 Ch. D. 353.
 (f) 26 W. R. 791.

(g) See *per* KAY, J., *Re Gros-
 smith's Trade Mark*, 6 R. P. C. 182.
 (h) T. M. R., r. 6, and Third
 Schedule thereto, *post*.

Sect. 66.

NOTE.

proprietors of the marks the same rights as if there had been separate registration of each, and meets the objections to representative registration stated in the arguments to the cases of *Re Barrow's Trade Marks* and *Re Brooks*, cited above.

Trade marks
may be
registered in
any colour.

67. A trade mark may be registered in any colour, 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 (*i*).

By s. 11 of the Act of 1888, this section is amended as follows:—

In section sixty-seven of the principal Act the words “or colours” shall be added after the word “colour” in each place where that word occurs.

Under the Act of 1875 colours could not be registered, and therefore the court would not take similarity of colour into consideration on a question of piracy, but the plaintiff was bound to prove his case from a comparison of uncoloured diagrams (*k*). The fact that under that Act the mark might be printed in any colour was considered a reason for refusing registration of a mark which, though if printed in a different colour from the opponent's mark was sufficiently distinctive, would yet have been liable to deceive if printed in the same colour (*l*). And for the like reason, where a mark had been registered under the Act of 1875, a similar mark registered under the present Act was ordered to be expunged from the register (*m*).

But where a registered cotton-mark was a silver rupee, it was held that a gold mohur, which had been deposited under r. 8 of the rules under the Act of 1875 (now part of r. 13 of the Trade Marks Rules, 1890, *post*), and of which the representation could be seen, was not calculated to deceive, and could be registered for cotton goods (*n*).

Under this section, in its original form, it has been held that the mark, to be capable of registration, must be a distinctive device, independently of the colour; and a device of a label in three parallel stripes of equal width, two shaded and the middle unshaded, having on

(*i*) See *post*, p. 605, as to ornamental or coloured groundwork, part of a mark.

(*k*) *Nuthall v. Vining*, 28 W. R. 330. See also judgment of Earl CAIRNS, C., *Orr Ewing v. Registrar of Trade Marks*, 4 App. Cas. 185.

(*l*) *Re Worthington & Co.'s Trade Mark*, 14 Ch. D. 8.

(*m*) *Re Biegel's Trade Mark*, 4 R. P. C. 527.

(*n*) *Re Robinson's Trade Mark*, 29 W. R. 31.

it the words "French Coffee," and below this the words "red, white and blue," and other words in French and English, was held not sufficiently distinctive, and was refused registration (o).

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NOTE.

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. Advertisement of application.

By s. 12 of the Act of 1888, this section is amended as follows:—

In section sixty-eight of the principal Act after the word comptroller shall be added the words "unless the comptroller refuse to entertain the application."

See Trade Marks Rules, 1890, *post*, rr. 27—30.

69. (1.) Any person may within *two months* of the *first* 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. Opposition to registration.

(2.) Within *two months* 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 require him to give security in such manner and to such amount as the comptroller may require for such costs as may be awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement was made or such further time as the comptroller may allow, the opposition shall be deemed to be withdrawn.*

(4.) *If the person who gave notice of opposition duly gives such security as aforesaid, the comptroller shall inform the*

Sect. 69 *applicant thereof in writing, and thereupon the case shall be deemed to stand for the determination of the Court.*

The section in its original form was substantially an enactment of r. 16 of the Rules of August, 1876, as altered by r. 15 of the Rules of March, 1883, under the Act of 1875.

By s. 13 of the Act of 1888, sub-s. (1) is amended by substituting for the words "two months" the words "one month or such further time not exceeding three months as the comptroller may allow," and by omitting the word "first"; and sub-s. (2) is amended by substituting for the words "two months" the words "one month." And for sub-ss. (3) and (4) the following sub-sections are substituted:—

"(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.

"(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."

SUB-SECTION (1).

There may be various grounds of opposition under this section. Registration may be successfully opposed by a person who has had a

concurrent use of the same mark though not registered (*p*). So, also, Sect. 69 (1) where a foreigner, having a business in America, sent goods to England marked with his trade mark, it was held that he had used the mark in England and would have a right to oppose the registration of the mark by his consignees in their own names (*q*).

NOTE.

If the opposition is confined to the grounds mentioned in s. 72, and the case comes within that section, the comptroller cannot register. But there may be other grounds on which the court may decide that a trade mark ought not be registered. The court has a discretion, and must see whether, if the case is not within s. 72, the registration is one which the court ought not to allow (*r*). And if the marks sought to be registered are new marks, and the comptroller thinks the registration would be calculated to deceive, he is not bound to register even though the consent of the owners of similar marks already on the register is obtained (*s*).

Comptroller's discretion.

So, also, if the court comes to the conclusion that the application to register is made in order to obtain an illegitimate advantage over other persons, the application will be refused (*t*). See *post*, under ss. 72 and 73.

The comptroller has power to allow amendments of notices of opposition (*u*), but not when the appeal has been referred to the court (*x*), nor after the three months has expired (*y*).

The comptroller may, on an opposition, go into a case of fraud, and allegations of fraud may be introduced by amendment (*z*).

SUB-SECTION (2).

For form of counter-statement, see Appendix, *post*, p. 606.

SUB-SECTIONS (3), (4), (5).

Under the section as it stood in the Act of 1883, all opposed applications for registration of trade marks were determined by the court, and r. 29 of the Trade Marks Rules, 1883, provided for a summons

(*p*) *Roger's Trade Mark*, 12 R. P. C. 149. See also *Thewlis and Blakey's Trade Mark*, 10 R. P. C. 369.

(*q*) *European Blair Camera Co.'s Trade Mark*, 13 R. P. C. 600.

(*r*) *Re Australian Wine Importers, Limited*, 41 Ch. D. 278.

(*s*) *Dewhurst's Trade Mark*, [1896] 2 Ch. 137. See also *Currie's Application*, 13 R. P. C. 681.

(*t*) *Thewlis and Blakey's Trade Mark*, 10 R. P. C. 369.

(*u*) *Henri Moët's Trade Mark*, 7 R. P. C. 226.

(*x*) *Robertson, Sanderson & Co.'s Application*, [1892] 2 Ch. 245.

(*y*) *Ibid.*

(*z*) *Henri Moët's Trade Mark*, *ubi supra*.

Sect. 69 in the chambers of a judge of the High Court of Justice being taken
(3), (4), (5). out by the applicant for the purpose of obtaining such determination.

By the section as amended a new practice is introduced.

NOTE.

In opposed, as well as in unopposed, applications the comptroller decides in the first instance, and his decision is subject to appeal to the Board of Trade, who may, however, refer the appeal to the court (see notes under s. 62 (4) (5), *ante*, pp. 380, 381).

As to the power of the Board of Trade in these matters, see s. 102A, *post*.

The comptroller has, under sub-s. 5, power to award costs to the opponent where an application is abandoned after notice of opposition; but except in that case no provisions are made by this Act or the Act of 1888 as to the costs of proceedings before the comptroller or the Board of Trade.

**Appeal
referred to
the court.**

When the appeal is referred to the court, the court has no power to amend the notice of opposition (*a*).

The practice when the appeal is referred to the court is to move that the comptroller be directed to register the mark (*b*).

When the Board of Trade on the reference to the court directed that the parties should be at liberty to adduce such evidence as they might be advised, it was held that the motion should be heard in the ordinary way on affidavit evidence, but that if the parties desired to use the statutory declarations used before the comptroller, they might do so on verifying them by affidavit (*c*).

If, however, there has been no such direction by the Board of Trade, the case must, it would seem, be heard on the declarations, but the court, if dissatisfied, would give further directions and see the matter tried out (*d*).

A later form adopted by the Board of Trade in orders of reference to the court has been to state that the parties should be "at liberty to adduce such evidence by affidavit examination or cross-examination of witnesses, and otherwise as the court may see fit to direct or permit, in addition to the statutory declarations used before the comptroller, which for this purpose are, if necessary, to be verified by affidavit" (*e*).

This form of reference necessitates an application to the court for directions, and on such an application the court has given leave to the parties to file affidavits, and directed the motion to be heard on the

(*a*) *Robertson, Sanderson & Co.'s Application*, [1892] 2 Ch. 245.

(*b*) See statement of case, *Meyerstein's Application*, 7 R. P. C. 115.

(*c*) *Farrow's Trade Mark*, 7 R. P. C. 260.

(*d*) *Farrow's Trade Mark*, *ubi supra*.

(*e*) *Roger's Trade Mark*, 11 R. P. C. 637.

evidence mentioned in the order of the Board of Trade, and the affidavits (*f*). And cross-examination being desired, the motion was ordered to be set down in the witness list. (3), (4), (5).

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Sub-s. (4) in its original form was held not to be confined to questions as between the applicant and opponent, but the court might, where a mark had been registered, determine the question whether it was properly admitted to registration (*g*).

NOTE.

The court has no power to judicially amend an application by directing the registration only of the parts of the proposed trade mark which are within the definition "essential particulars" in s. 64 (*h*). And, therefore, where a proposed trade mark contained a key and the words "Geneva Key Brand," the court refused to register the key alone (*i*).

In order that declarations used before the comptroller may be used before the court on the appeal, each declaration must be verified by an affidavit of the declarant himself (*j*).

A foreign applicant resident out of the jurisdiction may be ordered to give security for the costs of the opponents; and where the order provided that until the security should be given the applicant should not take any further proceedings in the matter against the opponents, and the security was not given, it was, upon the application of the opponents, ordered that the security should be given within seven days, and that in default the application should be dismissed with costs without further order. Such an order can and ought to be made on summons in chambers (*l*). Security for costs.

When an appeal from an order giving leave to register a mark was not brought within the twenty-one days prescribed by Order LVIII, r. 15, Supreme Court Rules, 1883, the Court of Appeal gave special leave to appeal upon the appellants undertaking not to take proceedings to rectify the register under s. 90 upon the ground of the mark being improperly upon the register (*m*). Time for appeal.

COSTS OF OPPOSITION.

Where on an opposition to registration of a trade mark in different classes the applicant succeeds as to some and fails as to others, no costs are given on either side (*n*). But an unsuccessful opponent must pay

(*f*) *Roger's Trade Mark*, 11 R. P. C. 637.

(*g*) *Re Arbenz's Application*, 35 Ch. D. 248; 4 R. P. C. 144.

(*h*) *Mecus' Application*, [1891] 1 Ch. 41.

(*i*) *Mecus' Application*, *ubi supra*.

(*j*) *Kingsford and Sons' Application*, 15 R. P. C. 197.

(*k*) *Hürter's Trade Mark*, W. N. (1887), 71.

(*l*) *Hürter's Trade Mark*, *ubi supra*.

(*m*) *Arbenz's Application*, 35 Ch. D. 257.

(*n*) *Re Jelley, Son, and Jones*, 51 L. J. (N.S.) Ch. 639; Seb. Dig., p. 377; *Re Rosing*, Seb. Dig., p. 379.

Sect. 69 the costs, even though the opposition is by a public body in the public
(3), (4), (5). interest (*v*). And an application to rectify the register which failed
 was dismissed with costs, including the costs of the registrar (*p*).

NOTE.

In *Re Anderson's Trade Mark* (*q*) the costs of a successful opposition were given to the opponent, except the costs of charges of fraud, which failed, and which costs were ordered to be paid by the opponent.

And where opposition to the registration of a mark, consisting of a distinctive device in combination with certain words which had been also used by the opponent, was continued after the applicant had, subsequently to the application, offered to disclaim any right to the exclusive use of the words, it was held that down to the time of the offer the opponent was right, but that afterwards he was wrong, and no order was made as to costs (*r*).

Under the repealed sub-sections the court had no jurisdiction to make any order as to costs incurred previously to the matter coming before it (*s*).

If an application is abandoned after notice of opposition, the costs of opposition may, under sub.-s (5) be ordered to be paid by the applicant.

Assignment
and trans-
mission of
trade mark.

70. A trade mark, when registered, shall be assigned and transmitted (*t*) only in connexion 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.

This section is substantially a re-enactment of the corresponding part of s. 2 of the Act of 1875.

It is settled by a series of cases that both trade marks and trade names are, in a certain sense, property, and that the right to use them passes with the goodwill of the business to the successors of the firm that originally established them, even though the names of that firm be changed so that they are no longer strictly correct (*u*). But, in order that the new firm may be registered as owners, the provisions of this section must be complied with (*x*). The right, however, to use a

(*v*) *Re Rosing, ubi supra.*

(*p*) *Re Riviere's Trade Mark*, 26 Ch. D. 48.

(*q*) 26 Ch. D. 409, 416, on appeal 54 L. J. Ch. (N.S.) 1084.

(*r*) *Swift Specific Co.'s Trade Mark*, 6 R. P. C. 352.

(*s*) *Re Australian Wine Importers, Limited*, 41 Ch. D. 278.

(*t*) See T. M. R. *post*, rr. 36—40.

(*u*) *Per* Lord BLACKBURN, *Singer Manufacturing Co. v. Loog*, 8 App. Cas. 33, citing *Hall v. Barrows*, 4 De G. J. & S. 150; *Millington v. Fox*, 3 My. & Cr. 338. See also *Bury v. Bedford*, 4 De G. J. & S. 352.

(*x*) See *Re Bryant and May, Ltd.*, 4 Times R. 675.

name as property in itself and unconnected with any business cannot be validly assigned so as to confer rights against the public (*y*).

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NOTE.

"In connection with the good-will."—A trade-mark can only be assigned when it is transferred together with the manufactory of the goods to which the mark has been used to be affixed (*z*).

And when foreign manufacturers of cigars, which they sold under a particular name, sold the right to use the label to a firm in England, but sold no part of the business, it was held that the assignment was bad and that the English firm could not bring an action for infringement (*a*).

The words of the section, however, are very wide and ought not to be construed narrowly (*b*). And therefore, where an American firm, makers of anti-friction metal, registered a trade-mark for anti-friction metal bearings,—and it appeared that, though they sold no bearings in this country, but only the metal in ingots, a main object of their business here was the use of the metal for bearings, and that they dealt in bearings in America,—it was held that an assignment by them of the trade-mark with the good-will of their business was a sufficient assignment within the section, and that the assignee was entitled to be registered (*c*).

And the assignment of the trade marks need not be contemporaneous with the assignment of the goodwill (*d*); and when the goodwill of the business has always been vested in the person to whom the trade mark is assigned, the requirements of the section are satisfied. Thus, where the agents of a foreign firm registered in their own name, but for the benefit of their principals, the trade marks of the latter (which trade marks had only been used in connection with the business of the foreign firm carried on in England by the agents), and afterwards assigned the trade marks to the then members of the foreign firm, through whom the present members of the firm claimed, it was held that the trade marks had been transmitted in connection with the goodwill of the business of the foreign firm within the meaning of this section (*e*). See also form K, *post*, in the Second Schedule to the Trade Marks Rules, where the person desiring to register is only required to show that he is entitled to the trade mark and to the goodwill.

(*y*) *Thorneloe v. Hill*, [1894] 1 Ch. 569.

(*z*) *Per* BRETTE, M.R., *Pinto v. Badman*, 8 R. P. C. 181, 194.

(*a*) *Pinto v. Badman*, *ubi supra*.

(*b*) *Magnolia Metal Co.'s Trade Marks*, [1897] 2 Ch. 371.

(*c*) *Magnolia Metal Co.'s Trade Marks*, *ubi supra*.

(*d*) *Re Wellcome's Trade Mark*, 32 Ch. D. 213, 217.

(*e*) *Re Wellcome's Trade Mark*, 32 Ch. D. 213. See also *Re Farina*, 29 W. R. 391, 393; *Hammond v. Brunner*, 9 R. P. C. 301.

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NOTE.

The assignee of a trade mark with goodwill was held, under the Act of 1875, to be only entitled to the exclusive user of the trade mark in respect of the goods for which it had been used, although it was registered for the whole class, and had been on the register five years (*f*).

A son who, while in his father's employment, learnt a trade secret for the manufacture of a particular article, and after the father's death made the article and sold it under the old name, was held to have acquired no title to the name as a trade mark (*g*).

"Determinable with that goodwill."—See *Ralph's Trade Mark* (*h*).

Conflicting
claims to
registration.

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 (*i*).

"Proprietor of the same trade mark."—Where two persons had used the same mark independently and *bonâ fide* for several years, the mark was registered in both names (*j*). And an outgoing partner who was entitled to use the original mark was allowed, under the Act of 1875, to register this mark, although it was identical with the mark on the register used by the successors of the old firm (*k*).

Under the Act of 1875 three identical marks, with in each case the words "sparkling sherry," and the name of the particular firm, were registered in the same class on the joint application of the three firms (*l*).

But under the present Act in *Re Ehrmann's Trade Marks* (*m*) when on a dissolution of partnership the continuing partners and the outgoing partner agreed to form separate firms with liberty to each to use the trade marks of the old firm, it was held that the comptroller was justified in refusing in his discretion to register the marks (all of which were new marks) in the respective names of the two new firms.

Where a trade mark, which had been acquired by use by a trader but had not been registered, had been discontinued, though not abandoned,

(*f*) *Edwards v. Dennis*, 30 Ch. D. 454.

(*g*) *Horenden v. Lloyd*, 18 W. R. 1132.

(*h*) 25 Ch. D. 194.

(*i*) This is to be by special case. T. M. R., rr. 42—45.

(*j*) *In re Powell, In re Pratt*, Seb. Dig., p. 357.

(*k*) *Benbow v. Low*, 29 W. R. 837. See also *Dent v. Turpin*, 2 J. & H. 139.

(*l*) *Re Vergaras*, cited 30 Sol. J. 415.

(*m*) 14 R. P. C. 665.

and in the meantime another trader had adopted and registered the same mark, but without the knowledge or acquiescence of the first trader, and in ignorance of his mark, it was held that the latter was entitled to register his mark, and that the second trader was also entitled to retain his registration (*n*).

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NOTE.

But apparently the importation of goods with a distinctive label for the purpose of transshipment only would not be sufficient user to acquire a title (*o*).

Where a person had applied to be registered as proprietor of the same trade mark as one already on the register, a motion on behalf of the registered holder for an injunction restraining an alleged infringement of the registered mark by the applicant was ordered to stand over till after the result of the application to register was known (*p*).

The mere proof that a person has used, without interference, a trade mark which is claimed by another, does not of itself entitle to registration, since the original proprietor may not have known that it was being so used (*q*).

Cases of opposition founded on rival claims to the same trade mark will, it would appear, still be dealt with by the court under this and the following section, notwithstanding the provisions of the new sub-ss. 3 and 4 of s. 69 *ante*, p. 412.

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

(2.) The comptroller shall not register with respect to the same goods or description of goods a trade mark *so nearly resembling* a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive.

By s. 14 of the Act of 1888, sub-s. 2 of this section is amended as follows :—

In sub-section two of section seventy-two of the principal Act, the following words shall be added at the beginning of

(*n*) *Mouson v. Boehm*, 26 Ch. D. 398.

(*o*) *Mecus' Application*, [1891] 1 Ch. 41.

(*p*) *Edwards v. Elkan*, 5 R. P. C. 71.

(*q*) *Re Farina*, 27 W. R. 456; *Re Hodson & Co.*, cited 30 Sol. J. 415.

Sect. 72 (2). the sub-section, namely, "except as aforesaid," and for the words "so nearly resembling" shall be substituted the words "having such resemblance to."

This section, both in its original and amended form, materially differs from the corresponding section of the Act of 1875, under which the registrar was forbidden to register, in respect of the same goods or classes of goods, marks identical with marks on the register, or so nearly resembling as to be calculated to deceive.

But the court has a discretion to determine whether, although the case is not within the words of this section, the registration is one which ought to be directed (*r*).

SUB-SECTION 1.

"Already on the register."—On the question of similarity, the court has regard only to marks which have been registered, and not to pending applications (*s*).

Sub-division
of classes:
"three mark"
rule.

"Same goods or description of goods."—Under the Rules of August, 1876, sub-division of classes was allowed (*t*); but the registrar would not register the same mark in respect of more than three descriptions of goods of the same class, whether the mark were new or old (*u*); and this was enforced even where the articles on which the mark was to be used, though in the same class, were different in character from the goods for which the mark was already registered (*x*). Subject, however, to this rule, a new mark might be registered for some of the goods in a class, though a similar old mark had already been registered for other goods in the same class, provided that the goods and trades were sufficiently distinct for no confusion to take place (*y*), and old marks might be registered up to the number of three by different persons in respect of the same goods, even if identical (*z*); and this rule is still followed by the court (*a*).

Thus, a device of a pointer eating out of a porridge-pot was registered as a new mark for "fencing" in Class 5, and as an old mark for

(*r*) *Re Australian Wine Importers and Mason*, 41 Ch. D. 278, 286.

(*s*) *Re Dugdale's Application*, 49 L. J. (N.S.) Ch. 393.

(*t*) *Ex parte Barrow & Co.*, W. N. (1877), 119; *Re Jelley, Son, and Jones*, 51 L. J. (N.S.) Ch. 639, n.

(*u*) *Re Walkden Aerated Waters Co.*, 54 L. J. (N.S.) Ch. 395, n; *Re Hyde & Co.'s Trade Mark*, 54 L. J.

(N.S.) 395, n; *Re Jelley, Son, and Jones*, 51 L. J. (N.S.) Ch. 639, n.

(*x*) *Re Hargreaves*, 11 Ch. D. 669.

(*y*) *Re F. Braby & Co.*, 21 Ch. D. 223; S.C. 51 L. J. (N.S.) 637; *Ex parte Barrow & Co.*, W. N. (1877), 119.

(*z*) *Re Jelley, Son, and Jones*, 51 L. J. (N.S.) Ch. 639, n.

(*a*) *Re Bancroft & Co.'s Trade Mark*, 5 R. P. C. 209.

“screw wrenches,” etc., in Class 13 (metal goods not included in other Sect. 72 (1) classes), though a device of a pointer standing at a pail, with the word “Stanch” under, was on the register as an old mark in Class 5, for “unwrought metals used in manufacture,” and in Class 13 generally (*b*).

NOTE.

And the mark “T. H. H.” under a crown was held entitled to registration as an old mark for tin plates and iron plates, though another firm had a mark in the same class, “B. B. H.” over a crown, for bar iron (*c*). So, also, a new mark, consisting of a device of a rising or half sun, was registered for galvanized iron, although there was an old mark on the register of a sun for bar iron in the same class (*d*).

But to entitle an old mark to registration under the “three mark rule,” the user must have been in England (*e*).

A mark may be registered as an old mark even though so similar to a mark already on the register that if new it would have been refused registration (*f*).

Where the mark had been used by one or two persons as an old mark, it could not be registered by another person as a new mark for the same goods, except with the consent of the prior owner or owners (*g*).

In deciding whether two sets of goods are of the same “description,” too much stress must not be laid on the classification in the schedule to the Trade Marks Rules. The question must be looked at from a business point of view (*h*).

“**Identical.**”—It has been said that the test of two marks being identical is that they so closely resemble one another that the use of one might be restrained in an action by the owner of the other (*i*).

Under this section, where there already is a trade mark on the register either the same as or nearly identical with one proposed to be registered, the comptroller is justified in refusing to register the latter without the leave of the court (*k*).

Although identical marks are not to be registered for the same goods, or description of goods, unless the court has first decided that two or

(*b*) *Re Jelley, Son, and Jones, ubi supra.*

(*c*) *Ex parte Barrow & Co., W.N. (1877), 119.*

(*d*) *Re F. Braby & Co., 21 Ch. D., 224; S.C. 51 L. J. (N.S.) 637.*

(*e*) *In re Münch's Application, 50 L.T. (N.S.) 12; Jackson v. Napper, 35 Ch. D. 162, 177; and In re Mees's Application, [1891] 1 Ch. 41.*

(*f*) *Re White Rose Trade Mark, 30 Ch. D. 505.*

(*g*) *Re Walkden's Aerated Waters Co., 54 L. J. (N.S.) Ch. 395, n. See now Dewhurst's Trade Mark, [1896] 2 Ch. 137.*

(*h*) See per LINDLEY, L.J., *Re Australian Wine Importers, Ltd.*, 41 Ch. D. 284, 291; see also *Furney and Sons Trade Mark*, 11 R. P. C. 37.

(*i*) *Re Walkden's Aerated Waters Co., 54 L. J. (N.S.) Ch. 395, n.*

(*k*) Per PEARSON, J., *Re Price's Patent Candle Co.*, 27 Ch. D. 681.

Sect. 72 (1). more persons are entitled to the mark, there appears to be no reason why identical marks should not, subject to the provisions of s. 74 (3), *post*, still be registered in respect of different descriptions of goods in the same class, as was provided for by Rule 20 of the Rules of March, 1883, under the Act of 1875; and if the descriptions of goods in the same class be sufficiently dissimilar not to be within s. 74 (3), it would seem that more than three identical marks might be registered in the same class.

NOTE.

SUB-SECTION 2.

“Having such resemblance to.”—These words would appear to give a wider discretion to the comptroller than the words “so nearly resembling,” which were contained in the section as it originally stood.

“Calculated to deceive.”—The words mean a mark calculated to deceive when that mark, fairly used, is so like a mark on the register also fairly used, as that one is likely to be mistaken for the other (*l*). The court looks to the nature of the goods, nature and size of mark, mode of fixing, and probable result in practice (*m*), and has regard to the mark, not merely as it is registered, but as it will probably be used in the course of trade (*n*), and will not consider what might be done by a fraudulent user (*o*).

Where there was on the register as a mark for beer a plain triangle coloured red, registration was refused to a triangle with a double outline inscribing within the name of the brewery, the inner triangle having a conspicuous figure of a church; the ground of decision being that, as the latter might be printed in a red colour, it would, if so printed, be too similar to the other mark (*p*). So, also, where a male hand pointing upwards was on the register as a trade mark, the registration of a female hand pointing horizontally with letters on it was not allowed (*q*).

And where there was on the register the device of a bull's head as a mark for mustard, the registration of a buffalo's head for the same goods was refused (*r*).

(*l*) *Per* FRY, L.J., *Lyndon's Trade Mark*, 32 Ch. D. 121 (see also judgment of BOWEN, L.J., in the same case); *Haines, Bachelor & Co.'s Trade Mark*, 5 R. P. C. 669; *Lambert's Trade Mark*, 6 R. P. C. 344, 351.

(*m*) *Re Rosing*, 54 L. J. Ch. 975.

(*n*) *Worthington's Trade Mark*, 14 Ch. D. 15; *Christiansen's Trade Mark*, 3 R. P. C. 55, 59.

(*o*) *Lambert's Trade Mark*, 6 R. P. C. 344, 351, (COTTON, L.J.); *Kutnow's Trade Mark*, 10 R. P. C. 401.

(*p*) *Re Worthington & Co.'s Trade Mark*, 14 Ch. D. 8.

(*q*) *Allsopp v. Walker*, Seb. Dig., p. 325.

(*r*) *Farrow's Trade Mark*, 7 R. P. C. 260.

And where a new mark for matches was very similar to an old mark subsequently registered, both marks having representations of lamp shades, which in the new mark as registered were blank, while in the old mark as registered they were filled up with representations of prize medals, and it was proved that in practice the new mark was never used with the lamp shades in blank, but always with medals in the blanks, the new mark was expunged from the register on the motion of the owners of the old mark (s).

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NOTE.

And where there was a registered trade mark for cherry brandy consisting of a hunting scene with the word "Sportsman," under which the article had become known as "Huntsman Cherry Brandy," a trade mark of a rival trader with a different hunting scene, and the word "Huntsman" instead of "Sportsman," was ordered to be expunged from the register (t).

And where the word "Sanitas" as part of a sentence was already on the register in respect of two different marks for medicine, the registration of "Sanitas" by itself as a mark for medicine was not allowed (u).

And a mark consisting of a sheep suspended by a band with the words "Golden Fleece," was refused registration in connection with wines, there being on the register similar marks of another tradesman having after the above words the words "rum" and "whisky" (x).

Where the words "Pirie's Parchment Bank" were on the register as a trade mark for paper, an application by a rival trader to register the device of a heart in combination with a number of words which included the words "Parchment Bank," was refused (y).

But the combination of a signature with the words "Filtre Rapide" was registered, although the words "Rapid Water Filter" were already on the register (z). And where there was on the register a mark having in a prominent part the words "Unco Guid," which were disclaimed, it was held that a mark having the same words (also disclaimed), and a quite distinct device, was not calculated to deceive (a).

Where A. had registered a coat of arms and a medallion as part of his mark, and B. proposed to register the medallion and arms alone, the latter was considered sufficiently distinctive, and was registered, as

(s) *Christiansen's Trade Mark*, 3 R. P. C. 55. See also *Biegel's Trade Mark*, 4 R. P. C. 525.

(t) *Barker's Trade Mark*, 53 L. T. (N.S.) 23.

(u) *Sanitas Co.'s Trade Mark*, 4 R. P. C. 533.

(x) *Re Australian Wine Importers and Mason*, 41 Ch. D. 278. See also

Turney and Son's Trade Mark, 11 R. P. C. 37.

(y) *Goodall's Trade Mark*, 42 Ch. D. 566.

(z) *Re Maignen*, 28 W. R. 759.

(a) *Loftus's Trade Mark*, [1894] 1 Ch. 193.

Sect. 72 (2) the simple medallion and arms could not be taken to be the same as A.'s compound mark (b).

NOTE.

And where there was on the register a mark consisting of a man's head with "way" beneath, which had become known as the "Headway" mark, another mark consisting of a helmeted head with the word "Athena" underneath, both marks being intended to be stamped on the goods, was allowed to be registered, it being considered that if both marks were fairly used the latter mark did not so resemble that on the register as to be calculated to deceive (c).

**Concurrent
usur.**

So, also, where it was shown that a mark consisting of a pipe and dart had been used on cutlery for many years, and a mark of a pipe had also been used on cutlery of the same description for the same time and without any evidence to show that one had been mistaken for the other, a motion by the owner of the pipe mark to expunge the other from the register was refused, although it was possible that by unfair stamping the dart might be made not to appear on the goods of the owner of the pipe and dart mark, no fraud, however, being suggested (d).

And where there were on the register several marks for tobacco, registered by different manufacturers, of which the word "star," or the device of a star, formed part, it was held that the registered owner of a mark consisting of an eight-pointed star, whose goods were frequently ordered by the public as "star" goods, could not successfully oppose the registration of a new mark containing the words "Star of Hope" and a marine picture with a six-pointed star in the sky (e).

But the circumstance that the mark sought to be registered and the registered mark have for some years been used independently by rival traders, and no deception has occurred, will not be taken into account if the court is of opinion that the registration proposed is, in fact, calculated to deceive (f).

**Words
expressing a
registered
device.**

Words which express to the ear what a device already on the register expresses to the eye are "calculated to deceive," and will not be registered. Thus, where there was on the register the device of a star as a trade mark for window glass, a subsequent registration by rival traders of the words "Red Star Brand" for the same article was expunged (g).

(b) *Re Farina*, 26 W. R. 261.

(c) *Lyndon's Trade Mark*, 32 Ch. D. 109. See also *Haines, Bachelor & Co.'s Trade Mark*, 5 R. P. C. 669.

(d) *Lambert's Trade Mark*, 6 R. P. C. 344. See also *Talbot's Trade Mark*, 11 R. P. C. 77, 81.

(e) *Wilus's Trade Marks*, [1893] 2 Ch. 262.

(f) *Curris & Co.'s Application*, 13 R. P. C. 681.

(g) *Re La Société Anonyme des Verreries de l'Étoile*, [1894] 2 Ch. 26.

So, also, where there was on the register the device of a golden fan, Sect. 72 (2). the registration of words in Burmese characters which meant "Golden Fan Brand" was refused (h).

NOTE.

And where the essential part of a mark proposed to be registered so nearly resembled the essential part of a mark already registered as to be calculated to deceive, registration was refused, although the mark as a whole was different in appearance from the registered mark, and although the applicants offered to undertake to use it always in its present form (i). Resemblance of essential parts to be considered.

In deciding questions under this sub-section, as between two marks, the comptroller may take into consideration the ordinary course of trade (k).

In *Re Farina* (l) it was said by HALL, V.-C., on an opposition under the Act of 1875 by the owner of a mark already on the register, that the question whether registration should be refused or not depended on whether the party opposing registration would, independently of the Trade Marks Registration Act, have been entitled to restrain the use of the proposed mark by the applicant.

But there may be cases in which the similarity would not be such as to induce the court on that fact alone to grant an injunction, but in which the comptroller would still be entirely within his duty in saying that the marks so nearly resemble one another that he will not, by allowing the registration, encourage the use of a mark which may lead to litigation (m). Comptroller's discretion.

It is a reasonable exercise of the comptroller's discretion to refuse to register a trade mark when it is not clear that deception might not result (n).

The applicant must justify the registration by showing affirmatively that the proposed mark is not calculated to deceive. *In dubio*, the application ought to be disallowed (o).

The question whether the mark is calculated to deceive is purely one of fact. And if the English court thinks the mark objectionable on this ground, registration will be refused, although a foreign Court of Appeal, differing from the Court of First Instance, has allowed the mark to be registered, the foreign decisions being regarded merely as

(h) *Dewhurst's Trade Mark*, [1896] 2 Ch. 137.
 (i) *Murphy's Trade Mark*, 7 R. P. C. 163; *Currie & Co.'s Application*, 13 R. P. C. 681.
 (k) *Speer's Trade Mark*, 4 R. P. C. 521.
 (l) 26 W. R. 261.
 (m) Per KAY, J., *Speer's Trade Mark*, 4 R. P. C. 521. See also *Heaton's Trade Mark*, 27 Ch. D. 570, 582; *Re Australian Wine Importers*, 41 Ch. D. 278.
 (n) *Eno v. Dunn*, 15 App. Cas. 252, 262.
 (o) See per Lord WATSON, *Eno v. Dunn*, 15 App. Cas. 257. See also per Lord HERSCHELL, *ibid.* 262.

Sect. 72 (2). opposite verdicts of juries (*p*). And this question does not depend merely on evidence, but the court will look at the marks themselves and form its own opinion (*q*). Thus, where a Sheffield corporate mark for cutlery and metal goods consisted of a plain horn suspended by a looped cord, a mark being a sprig of two roses and a twisted horn was considered too similar, especially when stamped on the metal, to be admitted to registration in the same class (*r*).

NOTE.

Where certain marks are cited by the comptroller as *prima facie* calculated to deceive it is frequently the practice to supply consents from the owners of the registered marks. These may be received by the comptroller as evidence that the marks will not clash, or as evidence that the goods are not of the same description, though these consents do not in any way bind the comptroller to put the mark on the register (*s*).

Practice on applications to register "identical" marks.

It will be observed that the comptroller has no jurisdiction in any case to register a mark identical with one already on the register for the same goods or description of goods. Where the mark applied for is an "old mark" the course is to get the comptroller formally to refuse registration, and then to appeal to the Board of Trade from his refusal, requesting the Board of Trade to refer the appeal to the court.

The Board of Trade by the order for reference directs notice to be served on the comptroller and on the owners of the conflicting marks. See order in *H. J. Neill's Trade Mark, No. 1*, Appendix, *post*, and see *Bancroft's Trade Mark (t)*.

The court can then on the appeal exercise its jurisdiction on such terms as it thinks fit. *Prima facie* the court will, subject to the "Three Marks Rule," direct an "old mark" to be registered as of course.

The practice is the same in the case of new marks which are refused by the comptroller, but it is much more difficult, if not impossible, to induce the court to direct the registration of a "new" mark identical with one already on the register (*u*).

Where, on an application to register a mark for particular goods in a class, the comptroller refused on the ground that for other goods of the same class there was a mark on the register which too nearly resembled the applicant's mark, the application was with the consent of the owners of the registered mark allowed to proceed upon the undertaking of the applicant not to use his mark for the goods in respect of which the existing mark was registered (*x*).

(*p*) *Re Farina*, 27 W. R. 457.

(*q*) See judgment of JESSEL, M.R., *Re Jelley, Son and Jones*, 51 L. J. Ch. (N.S.) 640, n.; and judgment of Lord ESHER, M.R., *Re Christiansen's Trade Mark*, 8 R. P. C. 55, 60.

(*r*) *Re Rosing*, 54 L. J. Ch. 975.

(*s*) See *Re Dewhurst's Trade Mark*, [1896] 2 Ch. 137.

(*t*) 5 R. P. C. 209; *Kenrick and Jefferson's Trade Mark*, 7 R.P.C. 321.

(*u*) See *Re Hargreaves*, 11 Ch. D. 669.

(*x*) *Kenrick and Jefferson's Trade Mark*, 7 R. P. C. 321, Seton, 1991.

When the comptroller refused to register on the ground that there was a similar mark on the register belonging to a foreign company, and the applicant moved for an order to the comptroller to proceed, and gave full information by letter to the foreign company of the nature of the application, and the latter did not appear, although there was evidence that they had received the communication, the comptroller was directed to proceed without prejudice to any opposition, the applicant undertaking to give full notice to the foreign company of the advertisement (y).

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NOTE.

As to proceeding with the registration of an old mark with consent of the registered owner of conflicting marks, and with disclaimer of exclusive use of particular devices used by other persons, see the order in *H. J. Neill's Trade Mark, No. 2*, Appendix, *post*, and see also under s. 74.

Where a trade mark has been invented for a joint adventure by two or more parties it does not, in the absence of contract, after the termination of the joint adventure belong exclusively to any of the parties (z); and even if there were a contract that the trade mark should become the property of one of the parties, it is doubtful whether it could be registered in his name, as such a registration would be calculated to deceive (a).

Trade mark
invented
for joint
adventure.

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.

Further
restriction on
registration.

By s. 15 of the Act of 1888 this section is amended by the omission from it of the word "exclusive." In its original form the section was a re-enactment of the latter part of s. 6 of the Act of 1875.

Further restrictions on registration will be found in s. 86, and the notes to that section (*post*, p. 458.)

"By reason of their being calculated to deceive," etc.—In *Re Horsburgh's Trade Mark (b)*, it was said by JESSEL, M. R., in reference to the corresponding section of the Act of 1875, that "the deception in the Act of Parliament refers to the words themselves being calculated to deceive, not to deception being occasioned because they are like another trade mark. . . . It is not competition between two marks to which reference is made; what is meant is, a thing deceptive in itself—something representing the goods to be that which they are not for the

(y) *Stringer's Application*, 8 R. P. C. 445. And see also *Kenrick and Jefferson's Trade Mark*, 7 R. P. C. 321.

(z) *Robinson v. Finlay*, 9 Ch. D. 487.
(a) *Re Jones' Trade Mark*, 53 L. T. (N.S.) 1.
(b) 53 L. J. Ch. 237.

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NOTE.

purpose of deception." And therefore an opposition by oil merchants, owners of a mark being a device containing the word "Valvoline," to the registration of another different device with the word "Valvoleum," on the ground that the similarity of the two words was calculated to deceive, was not allowed to prevail.

But ss. 72 and 73 point to this, that registration ought not to be allowed if the court in its discretion should think the mark would be calculated to deceive (c), and the judgments in the House of Lords in the case of *Eno v. Dunn* (d) seem to show that under the present Act the comptroller's discretion is not limited as suggested in *Re Horsburgh's Trade Mark*.

In *Eno v. Dunn*, cited above, (a case under the present section as it stood before the Act of 1888), where it was shown that the words "fruit salt" had been for many years used on a well known medical preparation, it was held by the House of Lords (Lord HALSBURY, L. C., and Lord MORRIS, *diss.*), on an application to register the words "fruit salt baking powder," that the registration of the applicant's words would be calculated to deceive, and they were accordingly refused registration. And it was said that the comptroller ought to reject words which involve a misleading allusion or a suggestion of that which is not strictly true as well as words which contain a gross and palpable falsehood (e).

And where the word "Coco" had been used in connection with cotton goods, but not as a trade mark, the registration of the words "Kokoko" as a trade mark for the same class of goods was refused (f).

Where, however, the words sought to be registered consisted partly of the applicants' name, the mere circumstance that the opponent of the same name had used the same combination of words, there being no evidence that the goods sold by the applicants were being sold as those of the opponent, was held not sufficient to justify the refusal of the registration (g).

"Be deemed disentitled to protection," etc.—If there is false representation in the mark, or if the trade itself is fraudulent, a Court of Equity will not interfere for its protection. And it was said by MELLISH, L. J., that the same would be the rule at common law, and that the case would come within the maxim *Ex turpi causâ non oritur actio* (h). The first of these cases is that alone which is dealt with in

(c) *Per* COTTON, L.J., *Re Australian Wine Importers and Mason*, 41 Ch. D. 284. And see also *Re Grossmith's Trade Mark*, 6 R. P. C. 180, 183, and *Eno v. Dunn*, 15 App. Cas. 252.

(d) 15 App. Cas. 252.

(e) *Per* Lord MACNAGHTEN, *Eno v. Dunn*, 15 App. Cas. 263.

(f) *Re Jackson & Co.'s Trade Mark*, 60 L. T. (N.S.) 93.

(g) *Swift Specific Co.'s Trade Mark*, 6 R. P. C. 352.

(h) *Ford v. Foster*, L. R. 7 Ch. 611, 630, 631. See, however, observations by VAUGHAN WILLIAMS, L. J., *Jamieson v. Jamieson*, 15 R. P. C. 169, 191.

this section. Cases in which the trade itself is fraudulent will be considered under s. 77. Sect. 73.

As to fraudulent representation in the mark itself—

In *Pidding v. How* (i) plaintiff was refused relief in respect of certain tea which he sold in packets labelled "Howqua's Mixture," Howqua being a celebrated Chinese merchant, and it being proved that plaintiff's tea was neither made nor sold by Howqua. NOTE.
False representation in the mark itself.

Where the plaintiffs had succeeded to the business of a firm of J. R. and C. P. Crockett, who were manufacturers of leather cloth, but plaintiffs did not themselves carry on business in that name, the insertion on the trade mark of the words "J. R. and C. P. Crockett, Manufacturers," was held to be a misrepresentation disentitling the plaintiffs to relief. So, also, the insertion in the mark of the words "Tanned, patented," where the mark was used for goods neither tanned nor patented (k).

And where a company claimed to use the words "Anglo-Portugo Oysters" upon a trade mark for oysters, whether the oysters were or were not brought from Portugal and fattened in English waters, as had been the case with the oysters in connection with which the name was first used, registration was refused (l).

And where a trade mark contained the words "sole makers," and the persons registering the mark were not in fact the "sole makers" of the article, the registration was ordered to be expunged (m).

So, also, the words "H.'s coker canvas" were not considered a proper old trade mark, it being shown that though goods were asked for as "coker canvas" or "Hayward's coker canvas," the latter three words were never stamped on the goods, and it being also shown that a former partner named H. was also carrying on business and selling "coker canvas" (n).

And where a trade mark comprising amongst other things two shields had been registered by the plaintiff with the centres of the shields blank, and was used by the plaintiff having the blanks filled in with words which the court held to convey a misrepresentation, an injunction was refused (o).

Where a trade mark has been invented for a joint adventure by two persons, one of them cannot after the determination of the joint adventure register it as his own, whether there is or is not a contract for that purpose, as such a registration might mislead the public (p).

(i) 8 Sim. 477.

(k) *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. 523.

(l) *Re Saunior & Co.*, Seb. Dig., p. 331. See also a case of guano made in England sold as "Peruvian guano," mentioned in the judgment of MELLISH, L.J., in *Ford v. Foster*, L. R. 7 Ch. 631.

(m) *Hayward's Trade Mark*, 54 L. J. Ch. 1003.

(n) *Hayward's Trade Mark*, ubi *sup. a.*

(o) *Newman v. Pinto*, 4 R. P. C. 508.

(p) *Re Jones' Trade Mark*, 53 L. T. (N.S.) 1.

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NOTE.

Where the registered mark has been fraudulently used, as where registered owners of the word "Eton" for cigarettes sold "Eton" cigarettes in boxes so labelled as to denote manufacture at St. Petersburg by a Russian firm (*q*), an injunction at the suit of such registered owners was refused, and the mark was on the application of the defendants in the action expunged from the register. But this was held not to apply in a case where, although the goods were not made by the owner of the mark, it was used in such a way as only to imply that they were sold by him (*r*).

Where the user of the mark had its inception in fraud and was calculated to deceive, registration was refused, though the mark had actually been used by the applicants for fifty years, and the court did not impute to the present applicants for registration any intention to commit fraud (*s*). And where the mark had been used with a fraudulent addition, implying an untruth as to the place of manufacture, the court refused to allow it to be registered *minus* the fraudulent addition (*t*).

But the use of the word "Habana" on boxes of cigars, with the words "British manufacture" (*u*), was held not to vitiate the registration. And the mere use on a label of the word "registered," with a number, does not imply that it is registered as a trade mark, or constitute such a deception as to disentitle the plaintiff to sue (*x*).

So, also, where it was shown that a medicinal preparation sold as "Syrup of Figs," though it was not entirely composed of fig syrup, contained that article as a large factor in its composition and added the flavouring, an objection that plaintiff was not entitled to relief failed (*y*).

If the wrongful representation on the trade mark has been abandoned before action, the plaintiff may be entitled to relief (*z*).

Use of
the word
"patent."

The question of deceptiveness in the mark itself has most commonly arisen on the use of the word "patent" or "patented," or the like, in the trade mark.

If the article had never been patented, the use of the word "patent" or "patented" on the mark was held to disentitle the plaintiff to relief (*a*), unless from the usage of many years the goods have acquired

(*q*) *Wood v. Lambert*, 32 Ch. D. 247.

(*r*) *Wills's Trade Marks*, [1893] 2 Ch. 262.

(*s*) *In re Heaton's Trade Mark*, 27 Ch. D. 570.

(*t*) *Fuente's Trade Marks*, [1891] 2 Ch. 166.

(*u*) *Hargreaves v. Freeman*, 8 R. P. C. 237. See also *Wills's Trade Marks*, [1893] 2 Ch. 262.

(*x*) *Benedictus v. Sullivan*, 12 R. P. C. 25.

(*y*) *California Fig Syrup Co. v.*

Taylor's Drug Co., 14 R. P. C. 341, reversed on other points in C. A. 14 R. P. C. 564.

(*z*) *Benedictus v. Sullivan*, 12 R. P. C. 25, 32.

(*a*) *Flaxel v. Harrison*, 10 Ha. 467; *Morgan v. McAdam*, 36 L. J. Ch. 228; *Leather Cloth Co. v. Lorrison*, L. R. 9 Eq. 352; *Lamplough v. Bulmer*, W. N. (1867), 293; *Nixon v. Roffey*, W. N. (1870), 227. And see *Melachrino v. Melachrino, etc. Co.* 4 R. P. C. 215, 224.

the designation in the trade generally of "patent" (*b*), or there was some foundation for the use of the word, as that patented machinery was used in the manufacture of the article (*c*), or that the plaintiff had registered the article as a design (*d*).

But if the article had once been the subject of a patent, and the word "patent" was used as descriptive only, relief was not refused (*e*), unless the word was used in the mark in such a manner as to imply that the patent was still subsisting (*f*); and *a fortiori* if the plaintiff's advertisements and circulars stated that he had no patent right, or the word had become merely descriptive of the article made (*g*).

In connection with this subject it must now be remembered that henceforth the use of such words where no patent has been granted may render the party using them liable to a penalty (*post*, s. 105).

If it be intended to rely on the wrongful use by the plaintiff of the word "patent," the question must be raised on the pleadings of the defendant, otherwise he will not be allowed to cross-examine plaintiff upon it at the trial (*h*). And where the question was not raised till the trial, leave to amend was refused (*i*).

In an action for infringement of trade mark to which the defendant replied by a motion to expunge the registration, it was held that the use by the defendant of the word "patented," even if unfounded, would not bar his right to resist the plaintiff's claim (*k*).

Placing the words "special registered trade mark" on a label when the mark was not, in fact, registered, though an application had been sent in for registration, was held not to disentitle the plaintiff to an injunction the object of which was the protection not of the label but of the name acquired by its use (*l*). So, also, as to the mere use of the words "trade mark" on a label, the question is whether the words are so used that a claim is wrongfully made to a particular part only (*m*).

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NOTE.

(*b*) *Marshall v. Ross*, 8 Eq. 651; *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. 523, judgment of Lord KINGSDOWN.;

(*c*) *Cochrane v. MacNish*, 13 R. P. C. 100.

(*d*) *Care v. Myers*, Seb. Dig., p. 181.

(*e*) *Sykes v. Sykes*, 3 B. & C. 541; *Edelsten v. Vick*, 11 Ha. 78; *Leather Cloth Co. v. Hirschfeld*, 1 N. R. 551. See also *Gridley v. Swinborne*, 5 Times R. 71.

(*f*) *Cheavin v. Walker*, 5 Ch. D. 850; *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. 523. And

see the Merchandise Marks Act, 1887 (50 & 51 Vict. c. 28), ss. 2 (d) and 3 (e).

(*g*) *Ransome v. Graham*, 47 L. T. 218.

(*h*) *Lever v. Godwin*, W. N. (1887), 107.

(*i*) *Ibid.*

(*k*) *National Starch, etc. Co. v. Munn's Patent Maizena, etc. Co.*, [1894] A. C. 275, 282.

(*l*) *Read v. Richardson*, 45 L. T. 54. See judgment of COTTON, L. J., p. 59.

(*m*) *Hammond v. Brunner*, 9 R. P. C. 301.

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“Or otherwise.”—Another ground on which words have been held disentitled to protection as trade marks is that they are merely descriptive or mere indications of quality.

NOTE.

Descriptive words.

The words “or otherwise” in this section “are sufficient to exclude the registration as part of a trade mark of words which are merely descriptive of the article, whether they are merely descriptive from their nature, or whether they have become descriptive by the course of the trade and in the market” (n).

It will be convenient to consider these in order :

Words from their nature descriptive.

1. *Words merely descriptive from their nature*, as “Paraffin Oil” (o), “Nourishing Stout” (p), “Castle Album” (for a photograph album, with descriptive pictures of castles) (q).

And the words—“Anglo-Portugo Oysters” (r), “Porous,” or “A—s Porous Plaster,” as applied to a particular kind of plaster (s); “Reversi,” as the name of a new game which depended on the player “reversing” his adversary’s counters (t); “Emollio,” as a name for a perfumery cream (u); “Monobrut,” meaning “very dry” as a mark for champagne (x), have been refused registration, or struck off the register as being only descriptive.

Words which have become descriptive by usage.

2. *Words originally not merely descriptive, but which have become so by the course of the trade and in the market.*

Of these there are two classes :—

(a.) Fancy names originally applied to new articles which are patented, such as “Linoleum” (y), “Paraffin Oil” (z), “Maizena” (a), “Home Washer” (b), “Braided Fixed Stars” (c), “Native Guano” (d); or of which the first producer is for some time the sole maker, such as “Macassar” (e), “Golden

(n) See per CHITTY, J., *Re Anderson's Trade Mark*, 26 Ch. D. 415; *Re Arbenz's Application*, 35 Ch. D. 248.

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

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

(q) *Schore v. Schwinke*, 33 Ch. D. 546.

(r) *Re Saunion & Co.*, Seb. Dig., p. 381.

(s) *Re Brandreth*, Seb. Dig., p. 382.

(t) *Watorman v. Ayres*, 39 Ch. D. 29.

(u) *Re Grossmith's Trade Mark*, 6 R. P. C. 180.

(x) *Vignier's Trade Mark*, 6 R. P. C. 490.

(y) *Linoleum Co. v. Nairn*, 7 Ch. D. 834.

(z) *Young v. Macrae*, *ubi supra*.

(a) *National Starch, etc., Co. v. Munn's Patent Maizena, etc., Co.*, [1894] A. C. 275.

(b) *Ralph's Trade Mark*, 25 Ch. D. 194.

(c) *In re J. B. Palmer's Trade Mark*, 24 Ch. D. 504.

(d) *Native Guano Co. v. Sewage Manure Co.*, 4 R. P. C. 475; 8 R. P. C. 125.

(e) *Rowland v. Breidenbach*, Seb. Dig., p. 230.

Ointment" (*f*), "Chlorodyne" (*g*), "Angostura Bitters" (*h*), "Valvoline" (*i*), "Gem" as applied to an air gun (*j*).

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NOTE.

(b.) Words connected with the name of the original maker or discoverer, such as "Velno's Vegetable Syrup" (*k*), "Dr. Johnson's Yellow Ointment" (*l*), "Taylor's Patent Solid-headed Pins" (*m*), "Burgess' Essence of Anchovies" (*n*), "Lieutenant James' Horse Blister" (*o*), "Liebig's Extract of Meat" (*p*), "Condy's Fluid" (*q*), "Wheeler and Wilson" (*r*), or "Singer System" (*s*), as applied to sewing machines.

In all these cases, where the patent has expired (*t*), or the secret has become known (*u*), or the manufacture has from any cause become general (*v*), the right, originally exclusive, will be lost (*x*). It has been said that the test whether the name has become *publici juris* is that the use of it by other persons has ceased to deceive the public as to the maker of the article (*y*). But no full or exhaustive definition can be given of the circumstances which will make a word or name *publici juris*; each case must depend on its own facts (*z*).

The books of the Registrar, showing the marks of which registration has been refused, are not evidence that those marks have become *publici juris* (*a*).

In the case of an article patented by the first maker of it, the fact that in the specifications of subsequent patents he describes it under a

(*f*) *Green v. Rooke*, W.N. (1872), 49.

(*g*) *Browne v. Freeman*, W. N. (1873), 178.

(*h*) *Siegert v. Findlater*, 7 Ch. D. 801.

(*i*) *Leonard v. Wells*, 26 Ch. D. 288.

(*j*) *Re Arbenz's Application*, 35 Ch. D. 248.

(*k*) *Canham v. Jones*, 2 V. & B. 218.

(*l*) *Singleton v. Bolton*, 3 Doug. 293.

(*m*) *Edelsten v. Vick*, 11 Ha. 78.

(*n*) *Burgess v. Burgess*, 3 D. M. & G. 896.

(*o*) *James v. James*, L. R. 13 Eq. 421.

(*p*) *Liebig's Extract of Meat Co. v. Hamburg*, 17 L.T.(N.S.) 298; *Same v. Anderson*, L. J. No. Ca. (1882), 119; W. N. (1882), 147; W. N. (1883), 185.

(*q*) *Condy v. Mitchell*, 37 L. T. (N.S.) 268, 766; 26 W. R. 269.

(*r*) *Wheeler and Wilson Manufacturing Co. v. Shakespear*, 39 L. J.

(N.S.) Ch. 36. See also *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 376.

(*s*) *Singer Manufacturing Co. v. Loog*, 8 App. Cas. 15, 26.

(*t*) *Linoleum Co. v. Nairn*, 7 Ch. D. 834; *In re J. B. Palmer's Trade Mark*, 24 Ch. D. 504; *Ralph's Trade Mark*, 32 W. R. 168; S. C. 49 L. T. (S.S.) 504; *Leonard v. Wells*, 26 Ch. D. 303; *Native Guano Co. v. Sewage Manure Co.*, 8 R. P. C. 125, 132, 134; *Davis's Trade Mark*, 14 R. P. C. 903.

(*u*) *James v. James*, L. R. 13 Eq. 421.

(*v*) *Canham v. Jones*, 2 V & B. 221.

(*x*) *Magnolia Metal Co.'s Trade Mark*, [1897] 2 Ch. 371, 391.

(*y*) *Burd v. Foster*, L. R. 7 Ch. 611.

(*z*) *National Starch, etc. Co. v. Munn's Patent Maizena, etc. Co.*, [1894] A. C. 275, 280.

(*a*) *Orr Ewing v. Johnston*, 13 Ch. D. 434.

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particular name, shows that the name has become descriptive, and he cannot afterwards claim the exclusive use of that name (b).

NOTE.

When the name of a patented article has been registered as a trade mark, it may be removed from the register, although the patent is still in force (c).

Names too general to be appropriated.

There are also other words which, as being too general, are held incapable of appropriation, such as "Colonial" (d), or "London and Provincial" (e), or "London Assurance" (f), as applied to an insurance company; "India and China," as applied to a tea company (g); "Merchants," as the name of a bank (h); "Chronicle" (i), "Pictorial" (k), or "Mail" (l), as names of newspapers; "Post Office," as applied to a directory (m). And, generally, any name which merely describes the nature of the business or the locality of its operations (n).

It will be remembered that the present Act gives a rule for ascertaining, at least for the purpose of registration, whether a trade mark has become non-exclusive, *post*, s. 74, sub-s. (3). And by that section marks common to the trade may, in certain cases, be registered as additions to trade marks.

Mark indicating quality.

The courts would also refuse protection to a so-called trade mark, which was, in fact, a mere advertisement of the character and quality of the goods (o), or a mere description of an article as made according to a particular patent (p). And the word "guaranteed," as applied to a corset, was held not entitled to protection (q).

When descriptive words registered.

Descriptive words may, however, be registered as non-essential parts of a mark (r). Thus, under the Act of 1875, the words "Valvoline"

(b) *Native Guano Co. v. Sewage Manure Co.*, 4 R. P. C. 473; 8 R. P. C. 125, 134.

(c) See *Magnolia Metal Co.'s Trade Mark*, *ubi supra*; *Mcaby v. Triticine, Ltd.*, 15 R. P. C. 1.

(d) *Colonial Life Assurance Co. v. Home and Colonial Assurance Co.*, 33 Bea. 548.

(e) *London and Provincial Law Assurance Society v. London and Provincial Joint Stock, etc. Co.*, 17 L. J. Ch. 37.

(f) *London Assurance v. London and Westminster Assurance Corporation, Ltd.*, 32 L. J. Ch. 664.

(g) *India and China Tea Co. v. Teede*, W. N. (1871), 241.

(h) *Merchants' Banking Co. of London v. Merchants' Joint Stock Bank*, 9 Ch. D. 560.

(i) *Cowen v. Hulton*, 46 L. T. (N.S.) 897.

(k) *Spottiswoode v. Clarke*, 2 Ph. 154.

(l) *Walter v. Emmott*, 54 L. J. Ch. 1059.

(m) *Kelly v. Byles*, 13 Ch. D. 683.

(n) *Per JAMES, L.J., Australian Mortgage Land and Finance Co. v. Australian and New Zealand Mortgage Co.*, W. N. (1880), 6.

(o) *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. 523.

(p) *Cheavin v. Walker*, 5 Ch. D. 850.

(q) *Symington v. Footman*, 3 Times R. 488.

(r) *Re Hudson's Trade Marks*, 32 Ch. D. 311. See also observations of MALINS, V.-C., *Re Barrow's Trade Marks*, 5 Ch. D. 358.

and "Valvoleum," both being considered descriptive only, were held non-essential parts of two trade marks of which the devices were different, and the registered owner of a mark with the one word was held not entitled to prevent the registration of the mark containing the other word (s). And the words, "Carbolic Acid Soap Powder," though common to the trade and merely descriptive, were admitted to registration as part of a trade mark (t). So, also, a motion to rectify the register by expunging the words "The Sanitary Filter, easily cleaned," from a mark consisting of a device with these words round it, which had been registered under the Act of 1875, was refused (u).

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NOTE.

When the mark consisted of the combination of a device with the words "Swift's Specific," it was registered, the applicant, on the opposition of a person of the same name who had used the words in his business, disclaiming any right to the exclusive use of the words (x).

In the above cases, however, it is the device only and not the descriptive word which is protected (y). And see now, *ante*, s. 64 (2).

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—

Saving for power to provide for entry on register of common marks as additions to trade marks.

(a.) In the case of an application for registration of a trade mark used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive 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 thirteenth day of August one thousand eight hundred and seventy-five—

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 ;

(s) *Re Horsburgh*, 53 L. J. Ch. 237.

(t) *Re Hudson's Trade Marks*, *ubi supra*.

(u) *Re Atkins' Trade Mark*, 3 R. P. C. 164.

(x) *Swift Specific Co.'s Trade Mark*, 6 R. P. C. 352. See also *Smokeless Powder Co.'s Trade Mark*, [1892] 1 Ch. 590.

(y) *Re Horsburgh*, *ubi supra*; *Re Hudson's Trade Marks*, *ubi supra*; *Re Atkins' Trade Mark*, *ubi supra*.

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(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 thirteenth day of August one thousand eight hundred and seventy-five, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods.

By s. 16 of the Act of 1888, the following is substituted for sub-s. (2) of this section :—

“(2.) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

“Provided that a person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, 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.”

This section appears to relate only to marks not already registered. With regard to marks already registered, see s. 92, *post*, p. 484. The section only applies where there are words and figures or other marks common to the trade (z). It provides that a trade mark may be registered if it contains some distinctive device, mark, etc., which is made by the Act an essential particular, although coupled with some feature which is common to the trade, provided that the right to the exclusive use of such common feature be disclaimed (a). For an order by consent for the comptroller to proceed with the registration of an old mark on the applicant's disclaiming the exclusive use of particular devices in use by other persons see *H. J. Neill's Trade Mark, No. 2, Appendix, post*.

(z) *Thompson v. Montgomery*, 41 Ch. D. 35, 49.

(a) *Per NCBTH, J., Baker v. Rawson*, 45 Ch. D. 519, 532.

“**Distinctive**,” that is, *prima facie* distinctive (*b*). And see under s. 64 (1) (*c*). Sect. 74.

NOTE.

“**Common to the trade.**”—This expression does not mean “in common use at the time of application,” it means “open to the trade” (*c*).

A mark was held to be common to the trade because similar, though not in each case identical, marks were in use by more than three persons engaged in the same trade; although in some of the cases the mark was not actually placed on the goods, but was only used on billheads, trade circulars, advertisements, or show cards (*d*).

Where a brewery had been carried on by the plaintiffs at Stone, and their ale had become known as “Stone ale,” it was held that the word “Stone” was not common to the trade within this section (*e*).

When a firm had on the register a mark consisting of a winged cross, and afterwards sought to register as an old mark the winged cross surrounded by two circles, with a disclaimer of the circles as common to the trade, the application was refused as absurd (*f*).

SUB-SECTION 2.

The disclaimer here contemplated is of matter common to the trade, and where a proposed mark consisted of a key and the words “Geneva Key Brand,” which were not common to the trade, being only used by the applicants and the opponents, it was held that a disclaimer of the words could not be required (*g*). Disclaimer.

The words “Smokeless Powder” are not distinctive, and therefore a disclaimer of them was not required under this section (*h*).

Words contained in a label registered as a whole are not an addition to the label and need not be disclaimed (*i*).

And see also notes under s. 64 (2) (3), *ante*, pp. 396, 398.

The disclaimer must be made at the time of application and cannot, at the instance of the applicant, be added subsequently (*k*).

(*b*) See *per* CHITTY, J., *Burland v. Broxburn Oil Co.*, 42 Ch. D. 274.

(*c*) *Burland v. Broxburn Oil Co.*, 42 Ch. D. 274; *Humphries v. Taylor Drug Co.*, 59 L. T. (N.S.) 820; *Apollinaris Co.'s Trade Mark*, [1891] 2 Ch. 186.

(*d*) *Re Wragg's Trade Mark*, 29 Ch. D. 551.

(*e*) *Thompson v. Montgomery*, 41 Ch. D. 35. See also *Barlow v. Johnson*, 7 R. P. C. 395.

(*f*) *Baker v. Rawson*, 45 Ch. D. 519, 530.

(*g*) *Mecus' Application*, [1891] 1 Ch. 47, 49.

(*h*) *Smokeless Powder Co.'s Trade Mark*, [1892] 1 Ch. 590.

(*i*) *Apollinaris Co.'s Trade Marks*, [1891] 2 Ch. 186, 233; *Smokeless Powder Co.'s Trade Mark*, *ubi supra*.

(*k*) *Goodall's Trade Mark*, 42 Ch. D. 566; *Mecus' Application*, [1891] 1 Ch. 41.

Sect. 74 (2). When the registration was made on an application before January 1st, 1884, that is, under the Act of 1875, this disclaimer could not be enforced, that Act containing no provision similar to this section (*l*).
NOTE.

But in a case where words too general formed part of the label, the order allowing the registration stated that no exclusive right to the use of the words was acquired thereby (*m*).

When the mark has been registered under the present Act, a disclaiming note may be ordered on an application to that effect made by the defendant to an action for infringement of the mark (*n*).

“Provided that a person need not . . . disclaim his own name,” etc.—Where the label contained the words “Smokeless Powder Co.,” which was the name of the company registering the label, it was held that no disclaimer could be required of the first two words, as they were part of the name of the owner of the mark (*o*).

SUB-SECTION 3.

This was the rule under the Act of 1875 (*p*). See also, *post*, s. 90.

“Publicly used by more than three persons.”—These words do not mean that the mark has been used by such persons as an exclusive trade mark, but include user in any manner (*q*).

The words are not a definition, or explanatory of the words “common to the trade,” except so far as that user by more than three persons is to be deemed common to the trade, and, therefore, where it was shown that a word was descriptive only, and, as such, open to the trade, a disclaimer of exclusive use was ordered, although the word was not shown to have been used by any persons except the owner of the registered mark and the applicant seeking to rectify the register (*r*).

Effect of Registration.

Registration
equivalent to
public use.

75. Registration of a trade mark shall be deemed to be equivalent to public use of the trade mark.

By s. 17 of the Act of 1888, the following is substituted for this section :

(*l*) *Re Hudson's Trade Marks*, 32 Ch. D. 311; *Re Atkins' Trade Mark*, 3 R. P. C. 164.

(*m*) *Re Hudson's Trade Marks*, 3 R. P. C. 155, 161.

(*n*) *Burland v. Broxburn Oil Co.*, 42 Ch. D. 274; *Thompson v. Miller*, 13 R. P. C. 35.

(*o*) *Smokeless Powder Co.'s Trade Mark*, [1892] 1 Ch. 590.

(*p*) *Re Jelley, Son, & Jones*, 51 L. J. Ch. (N.S.) 640 n.

(*q*) *Re Wragg's Trade Mark*, 29 Ch. D. 556.

(*r*) *Burland v. Broxburn Oil Co.*, 42 Ch. D. 274, 280. See also *Humphries v. Taylor Drug Co.*, 59 L. T. (N.S.) 820.

“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 first day of January one thousand eight hundred and seventy-six to have been, the date of the registration.” Sect. 75.

The section in its original form is a re-enactment of the last clause of s. 2 of the Act of 1875. That clause was for the benefit of those making new trade marks (s), and altered the old law under which a person who had not acquired by use a reputation for a mark had no exclusive right to it (t). The fact of there having been no previous user does not prevent the registration of a trade mark either under this Act or the Act of 1875. See *ante*, p. 377. But there must be a *bonâ fide* intention of using the mark (u).

“The date of application,” etc.—The new section makes retrospective the rule which was established by the Trade Marks Rules, 1883, r. 32, as to applications under the Act of 1883.

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. Right of first proprietor to exclusive use of trade mark

Under the corresponding section (s. 3) of the Act of 1875, it was held that a mark which is not a trade mark, and which, therefore, ought not to be registered, does not acquire the character of a trade mark by being on the register for five years, and may be removed from the register (x).

If a word has been wrongly registered as a trade mark, not being capable of registration at all, the owners of the mark cannot thereby obtain any right to the exclusive use of the word, although in fact they may during the registration have had practically the sole use of it (y).

(s) *Per* Lord BLACKBURN, *Orr Ewing v. Registrar of Trade Marks*, 4 App. Cas. 496.

(t) *Hudson's Trade Mark*, 32 Ch. D. 312; *Wilson v. Maxfield*, Seb. Dig. p. 275.

(u) *Batt & Co.'s Trade Mark*, [1898] W. N. 44 (15).

(x) *Re Palmer's Application*, 21 Ch. D. 48; *Leonard v. Wells*, 26 Ch. D. 288, 300; *Palmer's Trade Mark*, 24 Ch. D. 504; *Edwards v. Dennis*, 30 Ch. D. 454; *Wood v. Lambert*, 32 Ch. D. 247.

(y) *Leonard v. Wells*, 26 Ch. D. 299.

Sect. 76.**NOTE.**

So, also, where the mark was *prima facie* a distinctive trade mark, capable as such of registration, but was at the time common to the trade (z).

These principles apply to cases under the present Act (a).

But a defendant in an action for infringing a trade mark which has been on the register five years cannot set up as a defence that the mark ought not to have been registered as a trade mark. If that point is to be raised, it must be by a motion to rectify the register (b).

Where the mark has been on the register for five years, an injunction may be obtained against the use of a mark which infringes, even though the latter be also registered (c). And a defendant who had registered a mark was restrained from using it for goods which by that user came to bear the same name in the market which the plaintiff's goods had acquired by reason of a mark previously registered by him (d).

Where a photograph of a foreign picture of which at the time there was no copyright in England had been registered by the defendants as a trade mark, it was held that they had an interest within s. 6 of the International Copyright Act, 1886, in advertising it by show cards and trade lists, and could not be prevented from so doing by persons who had subsequently acquired and registered in England copyright in the picture (e).

"The date of the registration"—that is, the date of the application. See the amended s. 75, *ante*, p. 439, and T. M. R. 1890, r. 34, *post*.

"Subject to the provisions of this Act."—These words make this section subject to s. 90, and, therefore, any person aggrieved may, even after the five years, show that the registered device is one which ought not to have been registered, and accordingly, when it was, after a lapse of five years from the date of registration, shown that the mark was at the date of registration in use by more than three persons, an application to remove it from the register was granted (f).

(z) *Wragg's Trade Mark*, 29 Ch. D. 551.

(a) *Baker v. Rawson*, 45 Ch. D. 519, 531; and see *Wragg's Trade Mark*, *ubi supra*.

(b) *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478, 483; *Apollinaris Co. v. Snook*, 7 R. P. C. 474; 8 R. P. C. 166. See *Edwards v. Dennis*, 30 Ch. D. 477. A contrary view had been suggested by JESSEL, M.R., *Re Palmer's Application*, 21 Ch. D. 59, 60.

(c) *Edwards v. Dennis*, 30 Ch. D. 457 (A. L. SMITH, J.). The injunction was dissolved in the Court of Appeal (30 Ch. D. 466), but not on grounds affecting the law as here held.

(d) *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 Ch. D. 454.

(e) *Schauer v. Field*, [1893] 1 Ch. 35.

(f) *Lloyd & Son's Trade Mark*, 27 Ch. D. 646; *Wragg's Trade Mark*, 29 Ch. D. 551; *Wood v. Lambert*, 32 Ch. D. 247.

77. A person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of a trade mark unless, in the case of a trade mark capable of being registered under this Act, it has been registered in pursuance of this Act, or of an enactment repealed by this Act, or, in the case of any other trade mark in use before the thirteenth of August one thousand eight hundred and seventy-five, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused. The comptroller may, on request (*g*), and on payment of the prescribed fee, grant a certificate that such registration has been refused.

Sect. 77.

Restrictions
on actions for
infringement,
and on
defence to
action in
certain cases.

“Unless, in the case of a trademark capable of being registered,” etc.—These words appear to include not merely all marks, whether new or old, within s. 64 (1) and (2), but also old marks which, under the authority given by s. 64 (3), are allowed to be registered; and a certificate of refusal of registration appears to be sufficient only in the case of actions brought for infringement of *other trade marks in use, etc.*, that is, old marks which, though in use as trade marks before August 13th, 1875, are not permitted to be registered, such, for instance, as the single letter in the case of *Re Mitchell's Trade Mark (h)* under the Act of 1875 (*i*).

As to marks in this position, the owner, on obtaining a certificate that the registration has been refused, is in the same situation for suing for the protection of his trade mark as if the Act had not passed (*j*).

But there are two cases to which the section does not appear to apply, viz. :—

- (a.) New trade marks within the definition of s. 64, sub-s. (3), not capable of registration as new marks, but which, if old, could have been registered under that sub-section.
- (b.) Names, whether new or old, which are “so appropriated by user as to come to mean the goods of a particular person, though ‘the name’ is not, and never was, impressed on the goods or on the packages in which they are contained, so as to be a trade mark properly so called, or within” the Trade Marks Registration Acts (*k*).

(*g*) See T. M. R. Form L.

(*h*) 7 Ch. D. 36.

(*i*) See *Goodfellow v. Prince*, 35 Ch. D. 9.

(*j*) Per MALINS, V.-C., *Re Barrow's Trade Marks*, 5 Ch. D. 359.

(*k*) See *Singer Manufacturing Co. v. Loog*, judgment of Lord BLACKBURN, 8 App. Cas. 32. See also *Somerville v. Schembri*, 12 App. Cas. 453.

Sect. 77.**NOTE.**

Old law preventing one man from selling his goods as the goods of another not altered.

The principles on which the court acts in preventing a man from passing off his goods as those of another have not been altered by the Trade Marks Registration Act (*l*), and therefore relief may still be had in classes (a.) and (b.) mentioned above, in cases where relief would have been given before the Acts. The principles referred to are thus laid down by Lord KINGSDOWN (*m*): "The fundamental rule is that one man has no right to put off his goods for sale as the goods of a rival trader, and he cannot therefore (in the language of Lord LANGDALE in *Perry v. Truefitt* (*n*), ('be allowed to use names, marks, letters, or other *indicia* by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another person.')" And again, in *The Singer Manufacturing Co. v. Looy* (*o*), Lord BLACKBURN said: "The original foundation of the whole law is this, that when one knowing that goods are not made by a particular trader sells them as and for the goods of that trader, he does that which injures that trader. At first it was put upon the ground that he did so when he sold inferior goods as and for the trader's; but it is established alike at law, *Blofeld v. Payne* (*p*), and in equity, *Edelsten v. Edelsten* (*q*), that it is an actionable injury to pass off goods known not to be the plaintiff's as and for the plaintiff's, even though not inferior."

Infringement of common law trade mark.

And in *Somerville v. Schembri* (*r*), it was held, upon the general principles of commercial law, that "as soon as a trade mark has been so employed in the market as to indicate to purchasers that the goods to which it is attached are the manufacture of a particular firm, it becomes to that extent the exclusive property of the firm; and no one else has a right to copy it or even to appropriate any part of it, if by such appropriation unwary purchasers may be induced to believe that they are getting goods which were made by the firm to whom the trade mark belongs." Such a trade mark has been called a "common law trade mark" as distinguished from a registered mark (*s*).

Upon these principles it was held that a question of alleged infringement of a trade mark registered as a white selvage could not be decided without considering whether the alleged infringement (which in fact was dark grey) was not, according to the custom of the trade, a white

(*l*) *Mitchell v. Henry*, 15 Ch. D. 181; *Price's Patent Candle Co.*, 27 Ch. D. 681; *Great Tower Street Tea Co. v. Langford*, 5 R. P. C. 66; *Edwards v. Dennis*, 30 Ch. D. 454; *Jay v. Ludler*, 40 Ch. D. 649; 60 L. T. (N.S.) 27.

(*m*) *Leather Cloth Co. (Limited) v. American Leather Cloth Co.*, 11 H. L. C. 538, cited with approval by

Lord BLACKBURN; *Johnston v. Orr Ewing*, 7 App. Cas. 228.

(*n*) 6 Bea. 66, 73.

(*o*) 8 App. Cas. 15, 29.

(*p*) 4 B. & Ad. 410.

(*q*) 1 D. J. & S. 185.

(*r*) 12 App. Cas. 453, 457 (Judgment of Lord WATSON).

(*s*) See *per* LINDLEY, L.J., *Reddaway v. Bentham Hemp Spinning Co.*, [1892] 2 Q. B. 639, 641.

selvage, and if it was, then whether the differences in quality and position of the threads in the defendant's selvage were sufficient to distinguish the defendant's goods from those of the plaintiff so as to prevent purchasers from being misled (*t*).

Sect. 77.

NOTE.

The mere circumstance that a word is descriptive will not, if it has in fact come to denote exclusively the goods of a particular trader, entitle another trader to use it for his goods, without so distinguishing it as to avoid deception (*u*). And the use of such a word may be restrained, although it is incapable of registration as a trade mark. Thus injunctions were granted to prevent the use of the word "Stone," as a name for ale (*x*), "Yorkshire Relish," as a name for sauce (*y*), although the words were held incapable of registration, and expunged from the register.

Use of descriptive words: how far restrained

So also, when the plaintiff's mark had become distinctive of his goods, of descriptions other than those for which it was registered, he was held entitled to protection (*z*).

And if the mark has become distinctive of the plaintiff's goods, it will be protected against a rival trader even though the reputation was acquired by the exertions of the latter as an importer and vendor on behalf of the plaintiff (*a*).

And where the plaintiff had registered the words "The Self Washer" as a trade mark for soap, and sued the defendants (who used the words "Self Washing") for infringement of trade mark, and also for passing off their goods as goods of the plaintiff, and the court held the trade mark incapable of registration, and dismissed the action so far as it sought protection for the trade mark, the injunction was granted as to the other relief sought (*b*).

If the mark complained of be calculated to deceive, and the court sees reason to believe that it is used to enable defendant to pass off his goods as those of the plaintiff, the injunction will be granted to restrain infringement of the registered mark, without considering the question

(*t*) *Mitchell v. Henry*, 15 Ch. D. 181.

(*u*) *Reddaway v. Banham*, [1896] A. C. 199 (the order is printed p. 222). See also *Magnolia Metal Co. v. Atlas Metal Co.*, 14 R. P. C. 389; *Huntley & Palmer v. Reading Biscuit Co.*, 10 R. P. C. 277. See also order in *Wolmershausen v. Wolmershausen*, Seton, Addenda, p. 2112.

(*x*) *Thompson v. Montgomery*, 41 Ch. D. 35; [1891] A. C. 217.

(*y*) *Powell v. Birmingham Vinegar Brewery Co.*, [1896] 2 Ch. 54; affirmed in H. L. 14 R. P. C. 720. See also *Thompson v. Miller*, 13 R. P. C. 35.

(*z*) *Jay v. Ladler*, 40 Ch. D. 649.

(*a*) *Saxlehner v. Apollinaris Co.*, [1897] 1 Ch. 893; 14 R. P. C. 645.

(*b*) *Lever v. Goodwin*, 4 R. P. C. 492. See also *Humphries v. Taylor Drug Co.*, 5 Times R. 41; *Slazenger v. Feltham* (No. 2), 6 R. P. C. 536; *Hart v. Colley*, 7 R. P. C. 93.

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whether or not the registration is good (c); and the injunction may be granted even though some part of the mark was capable of registration and has not been registered (d).

Where a plaintiff had a patent and sold his goods as "Patent Cups," which name was understood in the trade to denote articles made by plaintiff according to his patent, defendant, who had registered a design for a similar article, was restrained from selling his articles as "Patent Cups" (e).

But in the case of a descriptive word the injunction will only be granted against using the word without distinguishing the defendant's goods from those of the plaintiff (f), and if the defendant does in fact so distinguish his goods, the injunction will not be granted at all (g).

Question is whether public misled.

In considering whether, in an action for infringement, the alleged trade mark is calculated to deceive, the question is not whether it is calculated to deceive the trade, but whether the public will be likely to be misled (h). And in order to obtain an injunction it is not necessary to prove an intention to mislead, nor that any one has in fact been misled (i). And where the defendant sold to middlemen and not to retailers, and an injunction was granted, the account of profits was directed as to all sales by the defendant, and was not limited to those sales in which it could be shown that purchasers had bought the defendant's article in the belief that it was the plaintiff's (k).

But where the words were capable of registration as a trade mark, and had not been registered, and there was no evidence to show such appropriation by user of the words as to cause them to mean the goods of the plaintiff, an injunction was refused (l).

So also where a registered trade mark included certain letters the exclusive use of which was disclaimed, and the alleged infringement consisted in the use of these letters (m).

(c) *Compania General de Tabacos v. Rehder*, 5 R. P. C. 61.

(d) *Great Tower Street Tea Co. v. Langford*, 5 R. P. C. 66.

(e) *Lawrie v. Baker*, 2 R. P. C. 215; and see *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 Ch. D. 454.

(f) *Magnolia Metal Co. v. Atlas Metal Co.*, 14 R. P. C. 389. And see cases in note (u), p. 443.

(g) *Linoleum Co. v. Nairn*, 7 Ch. D. 834.

(h) *Steinway v. Henshaw*, 5 R. P. C. 77; *Great Tower Street Tea Co. v. Langford*, *ubi supra*; *Upper Assam Tea Co. v. Herbert*, 7 R. P. C. 183.

(i) *Reddaway v. Benthall Hemp Spinning Co.*, [1892] 2 Q. B. 639, 644; *Millington v. Fox*, 3 My. & Cr. 338; *Johnston v. Orr Ewing*, 7 App. Cas. 219; *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 376, 391; *Paine v. Daniells*, [1893] 2 Ch. 567; *Saxlehner v. Apollinaris Co.*, [1897] 1 Ch. 893; 14 R. P. C. 645.

(k) *Lever v. Goodwin*, 4 R. P. C. 492; *Edelsten v. Edelsten*, 1 Le G. J. & S. 189, 203.

(l) *Goodfellow v. Prince*, 35 Ch. D. 9.

(m) *Rosenthal v. Reynolds*, [1892] 2 Ch. 301.

Where plaintiff had registered a mark of an elephant for tea, and the defendants had registered a mark of an elephant for coffee, an interlocutory injunction was granted restraining the defendants from using their mark for tea, although the word "Coffee" appeared in the mark and the figures of the elephant and the get up of the plaintiff's and defendants' packets were different in many respects (n).

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NOTE.

Infringement
of registered
trade mark.

And where the word "Demon" was registered as part of a trade mark, and was used to denote articles made under a patent which was held invalid, it was nevertheless held that the defendant could be restrained from using in respect to the same article the word "Demotic" so as to represent that the articles were made by the plaintiff (o).

Where the only act complained of was the taking of a part marked with the plaintiff's registered mark, and attaching it to the defendant's machine, there being no evidence that the public was thereby induced to believe that the whole machine was made by the defendant, it was held that there was no infringement of the trade mark (p).

Although a descriptive word may have been registered as a trade mark, the registration gives no right to restrain any use of it except as a trade mark, and therefore where the word "Bodega" (a word understood to mean a superior class of wine shop), which had been registered as plaintiff's trade mark, was used to describe the shop of the defendants, but not in such a way as to be calculated to lead to the belief that it was the place of business of the plaintiff, an interlocutory injunction was refused (q).

A registered trade mark containing a facsimile signature of the owner, is not infringed by the mere use of another facsimile signature of a rival trader bearing the same surname (r).

The mere fact that the plaintiff uses his registered mark with additions which form no part of his mark, and which cannot be registered, does not affect his right to sue to restrain infringement of his registered mark (s). And where the trade mark is registered with certain blanks which are afterwards filled up, the trade mark is not so different from the one registered as to give grounds for any objection to

(n) *Upper Assam Tea Co. v. Herbert*, 7 R. P. C. 183.

(o) *Slazenger v. Feltham* (No. 2), 6 R. P. C. 531. See also *Hart v. Colley*, 7 R. P. C. 93.

(p) *Harrison v. Woodroffe*, 7 R. P. C. 25.

(q) *Bodega Co. v. Owens*, 6 R. P. C. 236. It was afterwards, on

the evidence, granted at the trial, 7 R. P. C. 31. See also *Singer Co. v. Loog*, 8 App. Cas. 33.

(r) *Crawford v. Bernard*, 11 R. P. C. 580.

(s) *Melachrino v. Melachrino*, 4 R. P. C. 215; *Hammond v. Brunker*, 9 R. P. C. 301; *Cochrane v. Mac Nish*, 13 R. P. C. 100.

Sect. 77. an action for infringement, at any rate in the case of a defendant who is using the mark as filled up (*t*).

NOTE. When there was only one case of alleged misrepresentation (which was made by servants), and there was no reason to suppose that the misrepresentation would be repeated, the injunction was refused (*u*).

Where the name of the article has been registered as a trade mark, and the article is sold by the makers in bulk to the retailers, the latter may sell it in bottles marked with the name, and even though the article may have been deteriorated by keeping (*x*).

If a trade mark consists of a device in combination with a word which, being merely descriptive, could not by itself be registered, the mark will only be infringed if the device itself is encroached upon (*y*).

If the trade mark is on the register an assignee may sue, although at the time of bringing the action the assignment has not been registered (*z*). But persons having the sole right to sell in this country goods marked with the trade mark of the foreign manufacturers, but not being themselves owners of the mark, have no right to sue for infringement (*a*).

An action for infringement of a registered trade mark survives, and may be continued by the executor of the registered owner (*b*).

Under the Copyright Act, 1842 (*c*), where registration is required as a condition precedent to suing, the day may be divided into fractions, so that it is sufficient if the writ, though issued on the same day as the registration is effected, is issued after the registration has been made (*d*).

When the trade itself is fraudulent.

Cases of false representation in the trade mark itself have been already dealt with under s. 73. But the trade itself may be fraudulent, and in such a case the Court of Equity has been accustomed not to interfere (*e*).

Thus, in *Pidding v. How* (*f*), the plaintiff, a tea-dealer, who sold under the name of "Howqua's Mixture" a mixed tea composed of different kinds of teas, sought to restrain the defendant from selling teas under the same name, and in packages with labels resembling the

(*t*) *Newman v. Pinto*, 4 R. P. C. 508.

(*u*) *Leahy v. Glover*, 10 R. P. C. 141.

(*x*) *Condy v. Taylor*, 3 Times R. 665.

(*y*) *Ante*, p. 435, under s. 73.

(*z*) *Ihlee v. Henshaw*, 31 Ch. D. 323.

(*a*) *Richards v. Butcher*, 7 R.P.C. 288.

(*b*) *Oakey v. Dalton*, 35 Ch. D. 700. See also *Hatchard v. Mège*, 18 Q. B. D. 771; *Jones v. Simes*, 62 L. T. (N.S.) 447.

(*c*) 5 & 6 Vict. c. 45.

(*d*) *Warne v. Lawrance*, W. N. 1886, 55.

(*e*) Nor apparently could the plaintiff have succeeded at law. See judgment of MELLISH, L.J., *Ford v. Foster*, L. R. 7 Ch. 630.

(*f*) 8 Sim. 477.

plaintiff's. The plaintiff, however, had stated in his labels and advertisements that the mixture was made by one Howqua, a celebrated Canton merchant, and was purchased from him and imported into this country in the packages in which it was sold, and that the tea which gave it its peculiar flavour was rare in China, and could not be procured in England. All these statements were proved to be untrue, and on that ground SHADWELL, V.-C., although satisfied that the defendant's proceedings were improper, refused to interfere by injunction until the plaintiff had established his right at law.

So, also, in the case of *Perry v. Truefitt (g)*, the plaintiff, a maker of a preparation which he called "Medicated Mexican Balm," sought to restrain the sale by a rival trader of a different preparation under the same name. The plaintiff's advertisement, however, having stated his preparation to have been "made from an original recipe of the learned J. F. Blumenbach, and recently presented to the proprietor by a very near relative of that illustrious physiologist," whereas in fact he had purchased the preparation from one Leathart, an injunction was refused, but the motion was ordered to stand to the hearing, with liberty for the plaintiff to bring an action at law.

Where plaintiff sold under the name of "Estcourt's Hop Supplement," an article which was a substitute for hops, and was intended to deceive the public, he was held not entitled to protection (*h*).

But a merely collateral misrepresentation by the owner of the trade mark, as, for instance, a statement in invoices and a few advertisements that he was a patentee when he was not (*i*), or a statement, contrary to the fact, that he was a professor (*k*), was insufficient to disentitle the plaintiff to relief, either at law or in equity.

Notwithstanding the registration of a trade mark, the court will still act on the principles laid down before the passing of the Registration Acts, and refuse, as in *Pidding v. How (l)*, "to extend its protection to persons whose case is not founded in truth."

Thus, where the plaintiff, having a registered trade mark for cigars, used it on a box stamped with various devices forming an "elaborate concatenation of pictorial lies," which represented that the cigars were made in Havana, when in fact they were not, it was held that he was engaged in a fraudulent trade, and an injunction was refused (*m*).

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NOTE.

(g) 6 Ben. 66.

(h) *Estcourt v. The Estcourt Hop Essence Co.*, L. R. 10 Ch. 276.

(i) *Ford v. Foster*, L. R. 7 Ch. 611. See per VAUGHAN WILLIAMS, L.J., *Jamieson v. Jamieson*, 15 R.P.C. 191.

(k) *Holloway v. Holloway*, 13 Ben. 209.

(l) 8 Sim. 477.

(m) *Newman v. Pinto*, 4 R. P. C. 508. (See judgment of BOWEN, L.J., p. 519). See also *Apollinaris Co. v. Snook*, 7 R. P. C. 474, 476.

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The questions arising on the use of the word "patent" have been already considered under s. 73.

NOTE.

The last part of the marginal note to the section is an error (*n*).

77A. 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.

This section was added by the Act of 1888, s. 18, and introduces into actions for infringement of a registered trade mark the practice as to costs which, under s. 31, applies to actions for infringement of patent. See notes under that section, *ante*, p. 316.

Where the defendants to an action for infringement of trade mark moved to expunge the registration of the trade mark, and failed on the ground that they had not discharged the *onus* which lay upon them of showing that the mark ought not to be on the register, and it was admitted that on the motion failing there was no defence to the action, and the court accordingly gave judgment in the action for the plaintiff, it was held that the validity of the trade mark had not been tried in the action, and a certificate under this section was refused (*o*).

Register of Trade Marks.

Register of
trade marks.

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 (*p*).

See s. 81 as to the "Sheffield Register" for the registration of cutlery marks on applications by applicants in Hallamshire, or within six miles thereof. See also s. 87.

(*n*) The marginal notes form no part of an Act of Parliament, *Sutton v. Sutton*, 22 Ch. D. 513.

(*o*) *Edgington v. Edgington*, 6 R. P. C. 513.

(*p*) See T. M. R. rr. 32—51.

79. (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.

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Removal of
trade mark
after fourteen
years unless
fee paid.

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

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

(4.) Where after the said three months a trade mark has been removed from the register for nonpayment 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 nonpayment of the fee or otherwise, such trade mark shall nevertheless for the purpose of any application for registration during *the five years* next after the date of such removal, be deemed to be a trade mark which is already registered (q).

By s. 19 of the Act of 1888, sub-s. 5 of this section is amended as follows:

(1.) In sub-section five of section seventy-nine of the principal Act, for the words "the five years" shall be substituted the words "one year."

(q) T. M. R. r. 47.

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(2.) To the same sub-section the following words shall be added ; namely, “ unless it is shown to the satisfaction of the comptroller that the nonpayment 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.”

This section is substantially a re-enactment of rules 29 to 32 of the Trade Marks Rules of March, 1883.

Fees.

Fees for
registration,
etc.

80. There shall be paid in respect of applications and registration and other matters under this part of this Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade ; and such fees shall be levied and paid to the account of Her Majesty's Exchequer in such manner as the Treasury may from time to time direct (*r*).

Sheffield Marks.

Registration
by Cutlers'
Company of
Sheffie'd
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 cutlery, edge tools, or raw steel and the goods mentioned in the next sub-section, all the trade marks entered before the commencement of this Act in*

respect of cutlery, edge tools, or raw steel and such goods in the register established under the Trade Marks Registration Act, 1875, belonging to persons carrying on business in Hallamshire, or within six miles thereof, and shall also enter in such register, in respect of the same goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the commencement of this Act, but which have not been entered in the register established under the Trade Marks Registration Act, 1875 :

- (3.) An application for registration of a trade mark used on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge, 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 (s) :
- (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

(s) T. M. R. rr. 56—59.

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application to the Cutlers' Company, and have the same effect as if the application had been made to the comptroller on that day :

- (7.) *The provisions of this Act, and of any general rules made under this Act, with respect to application for registration in the register of trade marks, the effect of such registration, and the assignment and transmission of rights in a registered trade mark shall apply in the case of applications and registration in the Sheffield register ; and notice of every entry made in the Sheffield register must be given to the comptroller by the Cutlers' Company, save and except that the provisions of this sub-section shall not prejudice or affect any life, estate, and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register :*
- (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 Cutler's 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 (t) :
- (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.

By s. 20 of the Act of 1888, this section is amended as follows :—

(1.) For sub-section two of section eighty-one of the principal Act the following sub-section shall be substituted :

“(2.) The Cutlers' Company shall enter in the Sheffield register, in respect of metal goods as defined in this section, all the trade marks entered before the first day of January one thousand eight hundred and eighty-nine in respect of metal goods either in the register established under the Trade Marks Registration Act, 1875, or in the register of trade marks under this Act, belonging to persons carrying on business in Hallamshire or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal

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goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January one thousand eight hundred and eighty-four, but which have not been entered in either of the said other registers."

(2.) In sub-sections three and eight of the same section, for the words "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," shall be substituted the words "on metal goods."

(3.) For sub-section seven of the same section the following sub-section shall be substituted :

(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.

(4.) To the same section the following sub-sections shall be added ; namely,—

(14.) For the purposes of this section the expression "metal goods" means all metals, whether wrought,

unwrought, or partly wrought, and all goods Sect. 81.
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.

These provisions differ considerably from the corresponding provisions in the Act of 1875.

A list and short abstract of the Cutlers' Company's Acts is given in "Sebastian on Trade Marks," Third Edition, Appendix G.

Where the Cutlers' Company opposed the registration of a trade mark for cutlery for three classes of goods, on the ground that it so nearly resembled a Sheffield corporate mark previously assigned to another manufacturer of cutlery, and still used by him, as to be calculated to deceive, and in the Court of Appeal succeeded as to two of the classes, but abandoned their opposition as to the third class, it was held that applicant must pay the costs of the appeal, but that no costs of the motion in the court below could be given (*u*).

SUB-SECTION (2).

This sub-section relates only to old marks, and the duty of registration thereby thrown on the company is merely ministerial, and is not subject to any appeal to the comptroller under sub-s. (12) (*v*).

Under this section, in its original form, it was held that old marks might be registered for more goods than the mark is actually used for (*x*).

SUB-SECTIONS (3), (4), (5), (6).

These sub-sections apply only to new marks (*y*).

SUB-SECTION (7).

As to the assignment of a corporate trade mark granted by the Cutlers' Company, see *Bury v. Bedford* (*z*).

As to the construction of this sub-section, see *Re Lambert's Trade Mark* (*a*).

(*u*) *Re Rosing*, 54 L. J. Ch. 975.

(*v*) *Re Lambert's Trade Mark*, 5 R. P. C. 542; affirmed 5 Times R. 367; 6 R. P. C. 344.

(*x*) *Re Lambert's Trade Mark*, 5 R. P. C. 555.

(*y*) *Re Lambert's Trade Mark*, *ubi supra*.

(*z*) 4 De G. J. & S. 352. See also *In re Rabone Brothers*, Seb. Dig., p. 395.

(*a*) 5 R. P. C. 542, 554.

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SUB-SECTION (12).

NOTE.

This sub-section relates to cases in which a decision has been arrived at by the Cutlers' Company, not to cases under sub-s. (2), where the company have merely a ministerial duty to perform (b).

PART V.

GENERAL.

Patent Office and Proceedings thereat.

Patent Office

82. (1.) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as the Patent Office.

(2.) Until a new patent office is provided, the offices of the Commissioners of Patents for inventions and for the registration of designs and trade marks existing at the commencement of this Act shall be the patent office within the meaning of this Act.

(3.) The patent office shall be under the immediate control of an officer called the comptroller general of patents, designs, and trade marks, who shall act under the superintendence and direction of the Board of Trade.

(4.) Any act or thing directed to be done by or to the comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorised by the Board of Trade.

Officers and clerks.

83. (1.) The Board of Trade may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the comptroller-general of patents, designs, and trade marks, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

(b) *Re Lambert's Trade Mark, ubi supra.*

(2.) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by Parliament.

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84. There shall be a seal for the patent office, and impressions thereof shall be judicially noticed and admitted in evidence. Seal of patent office.

See *ante*, s. 12 (2), p. 60.

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. Trust not to be entered in registers.

Before the passing of this Act, the Patent Office registered deeds of trust relating to patents (c). As regards trade marks, this section is an enactment of Rule 22 of the Rules of August, 1876, re-enacted in Rule 23 of the Rules of March, 1883.

Under this section it is irregular to enter, on the register of two similar trade marks in the same class, a note that the user of the marks is subject to an agreement merely referred to and not stated (d), or being in the nature of a trust (e). But a note of the mutual undertakings of the parties restricting the user of the trade mark may be entered on the register (f).

Where a patentee entered into an agreement under which the other party to the agreement was to promote a company for working the patents, and was to have a share in the proceeds of sale, and containing provisions for making it void in certain events, it was held that such an agreement ought not to be entered on the register, and the registration was expunged (g).

But in *Casey's Patents* (h) it was held by the Court of Appeal that the section only excludes notices of trusts and does not exclude documents which affect the proprietorship, whether by creating trusts or otherwise, and a letter written by owners of certain patents agreeing to give their

(c) Johnson's Patentees' Manual, 4th ed., p. 221.

(d) *Mitchell & Co.'s Trade Mark, and Houghton & Hallmark's Trade Mark*, 28 Ch. D. 666.

(e) *De Otaduy's Trade Mark*, W. N. 1885, p. 177.

(f) *Ibid.*; *Mitchell & Co.'s Trade Mark, ubi supra*; *Re Rabone & Co.*, Seb. Dig., p. 396.

(g) *Haslett v. Hutchinson*, 8 R. P. C. 457.

(h) [1892] 1 Ch. 104.

Sect. 85. manager a share in consideration of his services was held to be an equitable assignment and to have been properly entered on the register.

NOTE.

Refusal to grant patent, etc., in certain cases. **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.

Restrictions on registration. The comptroller will also decline to register as part of any trade mark the Royal arms, or arms so nearly resembling them as to be calculated to deceive (except in the case of old marks); or the words "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To counterfeit this is Forgery"; or, except as old marks or parts of old marks, representations of the Queen or Royal Family, or of the Royal Crown, or the national arms or flags of Great Britain.

It will be remembered that the "Instructions" issued by the Patent Office, in which these restrictions appear (see Appendix, *post*), are merely office regulations and have not the force of rules made under s. 101 of the Act (*i*). But as to some of the words mentioned, they merely express the decision of the courts (*k*); and whether they are or are not binding, the court will be very slow to depart from the practice established thereby (*l*). And see, also, notes under ss. 62, 69 (*ante*, pp. 380, 413), as to the discretion given to the comptroller.

Entry of assignments and transmissions in registers. **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 (*m*). 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 any rights appearing from

(*i*) See *Re Rotherham's Trade Mark*, 11 Ch. D. 250; affirmed 14 Ch. D. 585.

(*k*) See *Re Royal Baking Powder Co.*, *ante*, p. 404, and *Re Meikle's Trade Mark*, W. N. 1876, 248.

(*l*) *König & Ebhardt's Trade Mark*, 13 R. P. C. 449.

(*m*) See P. R. rr. 67—71; D. R. rr. 20—28; T. M. R. rr. 32—41, *post*.

such register to be vested in any other person, have power absolutely to assign, grant licenses as to, or otherwise deal with, the same and to give effectual receipts for any consideration for such assignment, license, 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. Sect. 87.

By the Act of 1888, s. 21, this section is amended as follows :—

In section eighty-seven of the principal Act, after the words “subject to,” shall be added the words “the provisions of this Act and to.”

See *ante*, ss. 23, 55, 78.

PATENTS.

“**Assignment.**”—See s. 36. The right of assignment depends on the words of the patent itself (*n*); and in the form in the First Schedule (*post*, p. 504) the grant is to the “patentee,” which word, by a previous recital, is made to include his assigns.

A patentee may assign a distinct and separate part (*o*), or an undivided share (*p*) of a patent, and the assignee, whether of the entirety, or of a part or share, takes the legal interest, and is not to be considered merely as a licensee (*q*).

Where a patentee agreed with a purchaser that upon making certain payments the purchaser should become part owner of the patent with the patentee, and should have the sole right to manufacture and sell the patented article subject to certain conditions, one of which was the payment of half the future cost of maintaining the patent, “and thereupon the purchaser should be and continue such part owner as aforesaid,” it was held that on the purchaser failing to pay half of a sum which became payable as duty for keeping up the patent, he ceased to be part owner, and an injunction was granted at the suit of the patentee restraining subsequent assignees of the trustee in liquidation of the purchaser from infringing the patent (*r*). Agreement as to co-ownership of patent on conditions.

The law as to the rights of co-owners of a patent is thus laid down by LINDLEY, L.J. (*s*): “In the case of a patent belonging to several co-owners Rights of

(*n*) Hindmarch on Patents, p. 234.

(*o*) *Dunnicliff v. Mallet*, 7 C. B. (N.S.) 209.

(*p*) *Walton v. Lavater*, 8 C. B. (N.S.) 162.

(*q*) *Per ERLE, C.J., ibid.*, p. 184.

(*r*) *King v. Oliver*, 1 R. P. C. 23, 42.

(*s*) Lindley on Partnership, 6th ed. p. 36, citing *Dunnicliff v. Mallet*, 7

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persons in common, each co-owner can assign his share, and sue for an infringement, and can also work the patent himself and give licences (t) to work it; and sue for royalties payable to him for its use; and it is now settled that even if he be a mortgagee of the other share he is entitled to retain for his own benefit whatever profit he may derive from the working, although it is perhaps still open to question whether he is not liable to account for what he receives in respect of the licences."

Where two persons entered into a partnership for working a patent belonging to one, it was held by BACON, V.-C., that the patent was an asset of the partnership, and that neither partner could assign it without the other, but that both had a licence to work the invention, and when they separated each could work it on his own account (u).

Where a patentee on assigning his patents reserved a right to work them personally, such liberty not to be transferable, an injunction was granted to restrain the patentee's firm from working the patent (x).

Form and
effect of
assignment.

An assignment of a patent must be by deed (y), but an equitable assignment may be placed on the register (z).

An assignment of a patent does not, in the absence of express covenant, warrant the validity of the patent (a); nor does a sale of a patented article warrant that the patent is valid or that it does not infringe another patent (b). And in an action by the vendor for specific performance of an agreement to purchase a patent, a defence that the patent was invalid was struck out as embarrassing under S. C. R. Order XXVII, r. 1 (c).

Mortgagor
and
mortgagee.

Where the assignees of a patent by way of mortgage were not registered as proprietors but as mortgagees, it was held that the mortgagor might sue alone without joining the registered mortgagees (d), and it would seem that this would be the case even if the mortgagees were registered as proprietors (e).

C. B. (N.S.) 209; *Walton v Lavater*, 8 C. B. (N.S.) 162; *Sheehan v. Great Eastern Rail. Co.*, 16 Ch. D. 59; *Stears v. Rogers*, [1892] 2 Ch. 13, on appeal [1893] A. C. 232; *Mathers v. Green*, L. R. 1 Ch. 29. See also *Hancock v. Bewley*, Johns. 601.

(t) See, however, as to licences, *Powell v. Head*, 12 Ch. D. 686, 690, p. 469, *post*.

(u) *Kenny's Patent Button-holeing Co. v. Somercill*, 25 W. R. 787.

(x) *Howard v. Tweedales*, 12 R. P. C. 519.

(y) *Casey's Patents*, [1892] 1 Ch. 104.

(z) *Ibid.*

(a) *Hall v. Conder*, 2 C. B. (N.S.) 22; *Smith v. Neale*, *ibid.*, 67; 26 L. J., C. P. (N.S.) 143.

(b) *Monforts v. Marsden*, 12 R. P. C. 266.

(c) *Liardet v. Hammond Electric etc. Co.*, 31 W. R. 710.

(d) *Van Gelder, etc. Co. v. Sowerby Bridge, etc. Society*, 44 Ch. D. 374.

(e) *Ibid.*

Where a patent was assigned to two persons who covenanted that they, "their executors, administrators, and assigns," would endeavour to introduce the patent apparatus into use, and that the patentee should receive a certain percentage on the profits derived by them "or the survivor of them, or the executors or administrators of such survivor, their or his assigns," it was held that a company purchasing with notice of this covenant were bound by it and must account to the patentee (*f*).

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"Assigns."

An agreement by a vendor of a patent to assign to a purchaser all future patent rights which the vendor may "hereafter acquire of a like nature to the patent sold" is not void as against public policy (*g*). Future patent rights.

A covenant to assign improvements of which the assignor shall become possessed will not extend to patented improvements of which the assignor is only part owner with others (*h*). Improvements.

Where in a deed of assignment the patentee covenanted to communicate to the plaintiffs, and render available for their exclusive benefit, all further improvements which might be made by him in connection with a certain invention relating to a particular manufacture, it was held that an interlocutory injunction to restrain the patentee from selling, dealing with, or communicating, or disposing of to any person other than the plaintiffs, any invention relating to the particular manufacture, could not be granted, as that would be compelling specific performance of the covenant on an interlocutory application (*i*).

When persons engaged in manufacturing a patented machine set about experiments to remedy defects in it and alter the machine for that purpose, that is an "improvement" of the original machine (*j*). Ordinarily speaking, an improvement of an invention would mean a development of it (*k*). A contrivance differing largely from another may be an improvement upon it without being an improvement of it (*l*). And an invention may be an improvement within a clause as to improvements though not an infringement of the original patent (*m*). What are improvements.

"License."—The right of a patentee to grant licences is derived from the patent itself. By the patent the Crown grants to the patentee the Need not be under seal.

(*f*) *Werderman v. Société Générale d'Electricité*, 19 Ch. D. 246.

(*g*) *Printing and Numerical Registering Co. v. Sampson*, L. R. 19 Eq. 462. See also *Leather Cloth Co. v. Loxton*, L. R. 9 Eq. 345.

(*h*) *Pneumatic Tyre Co. v. Dunlop*, 13 R. P. C. 553.

(*i*) *London & Leicester Hosiery Co. v. Griswold*, 3 R. P. C. 252.

(*j*) *Wilson v. Barbour*, 5 R. P. C. 686.

(*k*) *Ibid.*, p. 254.

(*l*) *Ibid.*

(*m*) *Wilson v. Barbour*, 5 R. P. C. 245, 675.

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sole privilege, etc., that "the said patentee by himself, his agents, or licensees and no others," may use the invention during the specified term. The Crown then prohibits all persons from practising the invention during the term "without the consent, licence, or agreement of the said patentee in writing under his hand and seal." But notwithstanding these words it was held in *Chanter v. Dewhurst* (n) that a licence to persons to manufacture and use the patented machine need not be under seal. "To grant a licence not under seal may be a contempt of the Crown, but does not exempt the man to whom it is granted and who derives a benefit from it from paying the price of it" (o). And if parties by writing not under seal agree the one to grant and the other to accept, a licence, then in equity they stand in the same position as if the formal legal document had been executed, and on the one hand the grantees are bound to pay the royalties, and on the other hand the grantors are in the same position as if they had executed a licence and the powers stipulated for had been actually reserved (p).

Where there had been negotiations, but no concluded agreement, between the plaintiff and defendants for a licence by deed to use the plaintiff's patented invention, and the defendants had agreed to pay and did pay royalties and used the patented articles, it was held that there was a licence during a period covered by the agreement, and the defendants were held liable to account as licensees (q).

Not a grant
of the patent.

A licence to use a patented invention, even though it is exclusive and for a limited time, is not in any sense a grant of the Letters Patent, but is simply a licence to do that which without that licence would be a violation of the monopoly of the patentee (r).

Therefore an exclusive licence is not equivalent to an assignment, and the exclusive licensee cannot, without the concurrence of the patentee, sue infringers (s).

Mutual
covenants
going to the
whole
considera-
tion.

An ordinary licence generally contains covenants on the part of the licensor and of the licensee. Where these are mutual covenants and go to the whole of the consideration on both sides, they are mutual conditions the one precedent to the other. But when they go only to a part of the consideration, when a breach may be paid for in damages, then the defendant has a remedy on his covenant and cannot plead it as a condition precedent (t).

(n) 12 M. & W. 823.

(o) *Per* ALDERBON, B., *Chanter v. Dewhurst, ubi supra.*

(p) See *per* STIRLING, J., *Post Card Automatic Supply Co. v. Samuel*, 6 R. P. C. 560, 562.

(q) *Tweeddale v. Howard and Bullough*, 13 R. P. C. 522.

(r) *Heap v. Hartley*, 42 Ch. D. 461, judgment of COTTON, L. J., 469.

(s) *Heap v. Hartley, ubi supra.*

(t) See *per* Lord MANSFIELD, C. J., *Bonne v. Eyre*, 1 H. Bl. 273 n.

Thus where there was an agreement that the defendants should have the exclusive right to use certain inventions comprised in several patents, and should pay to the plaintiff an annuity as the consideration for such licence, and one of the patents was void, it was held that the consideration was entire and the payment to be made by the defendants was entire, and the consideration having failed partially had therefore failed entirely, and that no action for the annuity would lie (u).

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—
NOTE.

But where there was an agreement that in consideration of 500*l.* to be paid by the defendant to the plaintiff, the plaintiff would teach the defendant the invention and permit him to use it, and the plaintiff in consideration of 250*l.* paid and of the further sum of 250*l.* covenanted to be paid by the defendant, covenanted to teach the defendant, and the defendant covenanted to pay the further sum of 250*l.*, it was held that the plaintiff might sue on the covenant to pay without averring that he had taught the defendant as agreed. And Lord KENYON, C.J., said that the agreement of the plaintiff having been executed in part by transferring to the defendant a right to exercise the patent, he ought not to keep that right without paying the remainder of the consideration because he might have sustained some damage by the plaintiff not having instructed him (v).

Independent
covenants.

So also in *Otto v. Singer* (w), the patentee, before the filing of his complete specification, granted a licence to use the invention for a year certain, and then from year to year on payment of certain royalties and covenanted to complete the patent and to defend it in the event of its being contested, and that if the patent was declared void by a court of law the royalties should cease, with power for either party to determine the licence. While the licence was in force the defendants refused to pay royalties after the first year, on the ground that the Letters Patent were obtained for an invention less than the whole of that described in the provisional specification. It was held by DENMAN, J., without deciding the latter question, that as the right to use the invention passed by the deed, there had not been a total failure of the consideration, and that the royalties must be paid.

And in *Mills v. Carson* (x), the patentee granted an exclusive licence for the unexpired term of the patent at a fixed yearly sum, payable on certain named days, the last of which was shortly after the last day of the term. The licence contained the usual covenant by the licensees to pay the royalty, and covenants by the patentee for quiet enjoyment by the licensees, and that he would take proceedings against infringers,

(u) *Chanter v. Leese*, 4 M. & W. 295; 5 M. & W. 698; 1 Webst. 295.

(v) *Campbell v. Jones*, 6 T. R. 573.

See also *Cutler v. Bower*, 11 Q. B. 973.

(w) 7 R. P. C. 7.

(x) 10 R. P. C. 12.

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and that if by reason of his not taking proceedings the patent should become void or ineffectual, the royalties should determine. And the patentee also entered into the usual covenant as to improvements. The patent lapsed through non-payment of the renewal fees by the patentee. The defendants declined to pay the royalties any longer, alleging that the non-payment of the renewal fees was a breach of the covenant for quiet enjoyment. It was held by the Court of Appeal, that even assuming this was so, the covenant for quiet enjoyment and the covenant to pay royalties were independent covenants, and the defendants were bound to pay the royalties, notwithstanding the patent had lapsed.

And where there was a licence to use several patented inventions "during all the residues then unexpired of the terms granted by the Letters Patent respectively," and the licensees covenanted to pay a certain royalty "in respect of all steel produced by them during the continuance of the licence in the production of which the said inventions or any of them should be employed," and it was also provided that the royalties should continue "until the expiration by effluxion of time of all the terms" of the patents, it was held that the royalties must be paid so long as any of the patents were in existence, although the patents which covered the process actually used by the licensees had expired (*y*).

Implied covenants.

The Court will not imply contracts or covenants in deeds, unless the inference that such contracts or covenants were in the contemplation of the parties is irresistible (*z*). And, therefore, where in an exclusive licence the grantor entered into express covenants for quiet enjoyment by the licensees, and as to taking proceedings against infringers and as to improvements, the Court of Appeal refused to imply a further covenant by the patentee to pay the fees necessary to keep up the patent (*a*).

So, also, where in a deed of assignment of a patent for a lump sum and the other considerations therein appearing, the patentee covenanted for quiet enjoyment of the patent by the assignees "during the term subsisting therein," and the assignees covenanted to pay to the patentee a royalty for every article which should be manufactured or sold by the assignees under the patent "while subsisting," it was held that there was no implied covenant on the part of the assignees to keep up the patent, and in the same case it was held, in the absence of express

(*y*) *Siemens v. Taylor*, 9 R. P. C. 393.

(*z*) *Per LOPES, L.J., Mills v. Carson*, 10 R. P. C. 12, 19; *Hamlyn v. Wood*. [1891] 2 Q. B. 488. See

also *Cutlan v. Dawson*, 14 R. P. C. 249.

(*a*) *Mills v. Carson*, 10 R. P. C. 12.

covenant, that there was no obligation on the part of the assignees to manufacture the patented articles (b).

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But an exclusive licence implies on the part of the grantor a covenant not himself to use the invention (c), and also a contract not to grant leave to anyone else to use it (d).

NOTE.

Where in an exclusive licence the patentees covenanted to protect and defend the patent from all infringement, and that in default of their doing so the royalties should cease to be payable, and the patent lapsed by reason of non-payment of duties by the patentees, it was held in an action for royalties, that there being an express obligation to protect, the case of *Mills v. Carson*, cited above, did not apply, and that the royalties had ceased to be payable (e).

If there is a simple licence to use the invention on payment of royalty, no term being specified, the licensee may at any time put an end to the license, and will then not be liable to pay the royalty. This was decided in *Crossley v. Dixon* (f), where the respondent was manufacturing under a verbal agreement on payment of a royalty on certain machines supplied to him by the appellant, and afterwards used other machines, which infringed the patent, and it was held that so long as the agreement subsisted the respondent could not dispute the validity of the patent. But it was held that the licensee might put an end to the agreement under the liability, of course, to be treated as an infringer, and a decree of the court below, which had directed an inquiry as to infringing machines unlimited in point of time, was varied by confining it to machines bought during the continuance of the agreement. And on the authority of this case, it was held in *Redges v. Mulliner* (g), where by an agreement in writing a patentee granted a right to manufacture under the patent, subject to the payment of a royalty for each article manufactured, that the licensee could determine the licence, and that having done this and paid into court a sum which he alleged was sufficient to cover the royalties on articles made while the licence subsisted, he was not liable to render any further account except at the plaintiff's risk.

An exclusive licence containing mutual covenants imposing obligations both on the licensor and licensee is not in the absence of an express power of revocation revocable by the licensor (h) nor, apparently,

(b) *Re Railway and Electric Appliances Co.*, 38 Ch. D. 597.

(c) *Guyot v. Thomson*, [1894] 3 Ch. 397, LINDLEY, L.J.

(d) *Heap v. Hartley*, 42 Ch. D. 470, *per* FRY, L.J.

(e) *Lines v. Usher*, 13 R. P. C. 685; 14 R. P. C. 206.

(f) 10 H. L. C. 293.

(g) 10 R. P. C. 25.

(h) *Guyot v. Thomson*, [1894] 3 Ch. 388.

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by the licensee (i). In such a case the remedy for breach of any of the covenants is by action (j).

NOTE.

What sufficient notice to revoke.

Where the owners of a patent entered into an agreement by deed that they would grant to a certain company a licence to use the invention, during the continuance of the patent, upon certain specified terms and conditions, it was held that the licence having been forfeited by breach of the conditions, a letter was a sufficient indication of the intention of the patentee to take advantage of the forfeiture, and that an instrument under seal was not necessary to determine the licence (k).

But an allegation in a pleading that a licence has been determined is not a sufficient notice to determine (l).

Grounds of revocation.

Where a licence was to determine if the patent were held invalid, and a judgment which had been obtained against the patent was afterwards reversed on terms of compromise, it was held that the judgment could not be relied upon, and that the licence was still in force (m).

Where the patentee granted an exclusive licence to use the invention and to sell the articles manufactured according thereto, when and as the licensees should think fit, it was held that they were not bound to manufacture according to the precise details of the specification (n).

Waiver of right to revoke.

Where a licence was determinable by the licensors, on failure by the licensees to pay an annual minimum royalty which they covenanted to pay and the licensors accepted a less annual sum, it was held that they had thereby elected not to act on previous breaches of the covenant as grounds of forfeiture, and could not on those breaches determine the licence (o).

Covenant to endeavour to develop sale.

Where there was an agreement between the plaintiff, the patentee, and the defendants that the latter should manufacture the patented machines and pay the plaintiff a royalty, and that the defendants should use their best endeavours to develop the sale of the machines, and that all future improvements on the patent, whether invented by the plaintiff or the defendants, should "belong to the patent," it was held that the defendants, having pushed the sale of a number of machines fitted with a certain apparatus invented by themselves, but which were

(i) *Graydon v. Basset*, 13 R. P. C. 537, 543, 545; *S. C.* on appeal to H. L. 14 R. P. C. 701.

(j) *Guyot v. Thomson*, *ubi supra*, p. 394, ROMER, J.

(k) *Ward v. Livesey*, 5 R. P. C. 102.

(l) *Cheetham v. Nuthall*, 10 R.P.C. 321, 333.

(m) *Cheetham v. Nuthall*, 10 R. P. C. 321.

(n) *Guyot v. Thomson*, [1894] 3 Ch. 388, 394, ROMER, J.

(o) *Warwick v. Hooper*, 3 M. & G. 36.

improvements within the meaning of the agreement, for which they had not paid any royalty, had not used their best endeavours to develop the sale of the patented machines and were liable in damages (*p*).

In such a case the measure of damages was the royalties on the machines fitted with the defendants' apparatus, and it was held that the plaintiff could not in addition recover damages for breach of contract (*q*).

The patentee may impose whatever conditions he thinks fit on the use by the licensee of the invention (*r*), as, for instance, that there shall be affixed to the articles sold licence plates purchased from the patentee (*s*), or that the article shall be stamped with particular words in a particular part (*t*), or that it shall be used only in a particular manner (*u*). And these conditions may be enforced by injunction (*r*). Conditions.

But in order that a restrictive condition may be enforced against a purchaser of the article, it must be brought to his mind at the time of sale (*x*).

As to licences for a limited district, see *ante*, p. 338.

Where there was a licence to use the invention within the United Kingdom for the purpose of applying it to the wheels of bicycles made by the licensees, with a proviso that the licence should not authorize the licensees to make articles according to the invention to be applied to the wheels of bicycles made by any person other than the licensees, and that the licence should only authorize the use of the invention by the licensees jointly, or such of them as should carry on the business now carried on by the licensees at a certain place named, it was held that the assignees of the licence were not limited to the original business of the licensees, but might start other businesses elsewhere and apply the patent article to bicycles made by them in such other businesses (*y*).

The grant of the sole right of constructing a patented machine does not imply a right to use it when constructed (*z*).

When a defendant in answer to an action for infringement set up on the motion for injunction an agreement for a licence, which the plaintiff alleged was revoked, and also alleged the invalidity of the Estoppel.

(*p*) *Wilson v. Barbour*, 5 R. P. C. 245, 675.

(*q*) *Wilson v. Barbour*, *ubi supra*.

(*r*) *Incandescent Gas Light Co. v. Cantelo*, 12 R. P. C. 262, 264.

(*s*) *Grocer & Baker Sewing Machine Co. v. Millard*, 8 Jur. (N.S.) 713.

(*t*) *Crossthaite v. Steel*, 6 R. P. C. 190.

(*u*) *Incandescent Gas Light Co. v. Cantelo*, *ubi supra*.

(*r*) *Grocer & Baker Sewing Machine Co. v. Millard*; *Crossthaite v. Steel*, *ubi supra*.

(*x*) *Incandescent Gas Light Co. v. Cantelo*, *ubi supra*.

(*y*) *Bown v. Humber*, 6 R. P. C. 9.

(*z*) *Basset v. Graydon*, 14 R. P. C. 701.

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patent, and being put to his election whether he would insist on his rights under the licence, or dispute the validity of the patent, elected to take the latter course, he was ordered to pay the costs of the motion for injunction, and to remove from the articles he was using the words "manufactured under licence from A B" (a).

A patentee accepting royalties from the assignee of a licence granted by him cannot dispute the validity of the assignment (b).

A person who constructs a patented machine under an agreement giving him the "sole right of constructing" is a licensee, and cannot dispute the validity of the patent (c).

Register of
Proprietors
Act of 1852.

By the Act of 1852 (d) a "register of proprietors" was required to be kept at the Great Seal Patent Office, in which an entry of all assignments of letters patent, or of any interest or share, was to be made, and all licences, etc., and it was provided that until such entry should have been made the grantee of the letters patent should be deemed the sole proprietor thereof.

Under this section it was held, in *Chollet v. Hoffman* (e), that an assignee could not sue until his assignment had been registered, otherwise, as the statute provides that before such registry the original patentee shall be deemed the sole owner, a defendant would be liable to be sued at one and the same time by the grantee and assignee of the letters patent. The reasoning in this case appears equally to apply to the present section, and it would seem that under this present Act, as under the Act of 1852, registration of the assignment is necessary to enable an assignee to maintain an action for infringement.

The case of *Chollet v. Hoffman* was, however, a case of litigation between the assignee of a patent and third parties. As between the assignor and assignee the rule was held not to apply, and an assignee might maintain a suit against the assignor, and licensees from the assignor subsequent to and with notice of the assignment, although the assignment has not been registered (f).

It was not decided whether and how far the registration of an assignment related back. In *Chollet v. Hoffman* the court expressly refused to decide the point, but in *Hassall v. Wright* it seems to have been the opinion of Sir RICHARD MALINS, V.-C., that registration under the Act of 1852 related back to the date of the assignment, and that

(a) *Post Card Automatic Supply Co. v. Samuel*, 6 R. P. C. 560.

(b) *Lawson v. Donald Macpherson & Co.*, 14 R. P. C. 696.

(c) *Basset v. Graydon*, 14 R. P. C. 701 (H. L.).

(d) 15 & 16 Vict. c. 83, s. 35.

(e) 7 E. & B. 636.

(f) *Hassall v. Wright*, L. R. 10 Eq. 510.

an assignee whose assignment was registered might maintain a suit to restrain infringement instituted after the date of the assignment and before registration.

An assignment by executors of a patentee made after probate, but before the probate was registered, the assignment itself being registered after the registration of the probate, gave under the Act of 1852 a valid title to the assignee to sue (*g*).

In an action for infringement brought under the Act of 1852, it was objected that the plaintiff had not proved his title, because the title of his assignors only appeared by a recital in the assignment to him, but the objection was not pressed. It was, however, held by the Court of Appeal that the objection, if pressed, would not have been allowed to prevail, since the defect might have been cured under Supreme Court Rules, Ord. LVIII. r. 4 (*h*).

Upon the bankruptcy of a patentee, letters patent which have been granted to him will vest in the trustee (*a*), and he may therefore maintain a suit to restrain infringement committed before the bankruptcy; but it is presumed that the title of the trustee must be registered.

Letters patent granted to any person vest on his death in his executor or administrator (*b*), who may sue in respect of an infringement committed during the life of the patentee (*c*), the probate of the will being previously registered in the Great Seal Patent Office. See also s. 34.

The register will apparently be conclusive as between persons interested in the patent and third parties, who, it would seem, may safely, in the absence of notice of other claims, deal with the persons appearing on the register.

It is the practice of the Patent Office to register mortgagees not as proprietors of the patent but only as mortgagees, and this practice is right (*d*).

DESIGNS.

In *Powell v. Head* (*e*) it was held by JESSEL, M.R., that one part owner of the copyright of a dramatic entertainment could not grant a licence for its representation without the consent of all the other owners. This decision was grounded on the provision of the 3 &

(*g*) *Ellwood v. Christy*, 17 C. B. (N.S.) 754; 10 Jur. (N.S.) 1079.

(*h*) *Nordenfelt v. Gardner*, 1 R. P. C. 61, 73.

(*a*) *Hesse v. Stevenson*, 3 Bos. & P. 565; *Bloxam v. Elsec*, 6 B. & C. 169; *S. C.* 9 Dowl. & R. 215.

(*b*) *Williams on Executors*, 9th ed. Vol. I., p. 724. See also *Form of Patent*, *post*, p. 504.

(*c*) *Hindmarch on Patents*, p. 252.

(*d*) See *per* COTTON, L.J., *Van Gelder v. Sowerby, etc.*, 44 Ch. D. 389.

(*e*) 12 Ch. D. 686.

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NOTE.

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NOTE.

4 Will. 4, c. 15, forbidding representation except with the consent of the "author or other proprietor," which words, by the effect of s. 4 of the same statute, meant "authors or other proprietors." On similar grounds it would seem that, since s. 58 of the present Act requires the consent of the registered proprietor to the use of a registered design, and by 52 & 53 Vict. c. 63, words in an Act of Parliament importing the singular include the plural, the consent of all the registered proprietors is necessary, and that one of several registered co-owners cannot alone grant a licence for the use of a design.

Similar reasoning seems to show that, whatever may have been the law hitherto, a valid licence for the use of an invention comprised in a joint patent can only be made with the concurrence of all the grantees whose names appear on the Register of Patents.

TRADE MARKS.

As to assignment of trade marks, see s. 70.

Where two persons who carried on distinct trades at different places of business had derived from a common predecessor in the respective businesses the right to use one and the same particular name as a trade mark, each was held entitled separately to sue to restrain infringement (*f*).

When on a dissolution of partnership between A, B, and C, it was agreed that A, B, and C, and any partners they might take respectively, were to have the common use of all trade marks of the firm, it was held that they could not separately grant licences to use the trade marks, and further, that when one of them was a shareholder and director of a limited liability company, and also had debenture stock in the company he was not a partner with the company, and it could not use the marks (*g*).

Inspection of
and extracts
from
registers.

88. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed; and certified copies, sealed with the seal of the patent office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee (*h*).

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

(*g*) *Hanson v. Game*, 9 R. P. C. 186.

(*h*) P. R. rr. 78, 79; D. R. rr. 33, 34; T. M. R. rr. 52, 60, *post*.

By the Act of 1888, s. 22, this section is amended as follows :—

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In section eighty-eight of the principal Act, after the words “subject to,” shall be added the words “the provisions of this Act and to.”

This section must be read (so far as it relates to the register of designs) as subject to the provisions of ss. 52 and 53.

89. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the patent office, of or from patents specifications disclaimers and other documents in the patent office, and of or from registers and other books kept there, shall be admitted in evidence in all courts in Her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

Sealed copies
to be received
in evidence

A re-enactment, with alterations, of 16 & 17 Vict. c. 115, s. 4. By that Act the sealed copies were receivable in evidence in all proceedings relating to letters patent for inventions. The present section is general, and applies to all proceedings.

90. (1.) The Court may (*i*) on the application of any person aggrieved by the omission without sufficient cause of the name of any person 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.

Rectification
of registers
by court.

(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.

(i) P. R. r. 74 ; D. R. rr. 27, 28 ; T. M. R. rr. 46, 49, 50, *post*.

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

By the Act of 1888, s. 23, this section is amended as follows :—

In section ninety of the principal Act, after the words “ of the name of any person,” shall be added the words “ or of any other particulars.”

This section combines the powers of the Act of 1852, s. 38, and the Act of 1875, s. 5, and makes these provisions applicable to all the subjects of this Act. “ Making,” an entry is, as to patents, an addition to the old powers.

In a trade mark case it was held, under the Act of 1875, that the powers of rectification of the register are only exerciseable in cases of mistake or error in the registration, and not where there is a mere devolution of interest (*k*). In such a case the proceeding should be under s. 87, *ante*.

“ **The Court.**”—In *King & Co.'s Trade Marks* (*l*), it was held by the Court of Appeal that the High Court of Justice in England has jurisdiction to rectify the register of trade marks, although the registered proprietor may be domiciled in Scotland or Ireland. But the question whether the Scotch and Irish Courts have jurisdiction in such a case was left undecided. In *Bayer v. Connell* (*m*), it was held by PORTER, M.R., that the Irish Courts have no such jurisdiction. On the other hand, in *Cowie v. Herbert* (*n*), in a Scotch case, the objection was not taken, and the Lord Ordinary therefore assumed that he had jurisdiction, though he stated that s. 111 (*post*), on which it seemed to depend, is very obscure. In the result, the rectification in this case was not insisted on, and the application was dismissed.

PATENTS. (See P. R., *post*, r. 74.)

Under the corresponding section of the Act of 1852 (*o*), by which the jurisdiction was given to the Master of the Rolls alone, it was held that any entry fraudulently made on the register could be expunged, and that any facts relating to the proprietorship could be entered, but not the legal inferences from those facts (*p*).

(*k*) *Re Ward, Sturt, and Sharp's Trade Marks*, 29 W. R. 395.

(*l*) [1892] 2 Ch. 462, 480.

(*m*) 14 B. P. C. 275.

(*n*) 14 R. P. C. 436, 444.

(*o*) Section 38.

(*p*) *Re Morey's Patent*, 25 Bea. 581.

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NOTE.

Thus, where a patentee, having assigned his patent to persons who omitted to register the assignment, afterwards assigned the patent to his father, which assignment was registered at once, the Master of the Rolls ordered the entry of the latter assignment to be expunged (*q*). In this case it appears from the subsequent case of *Re Morey's Patent* (*r*), that there was evidence that the second assignment was clearly fraudulent.

And so, also, an entry made by one of two joint patentees of a deed whereby he assigned his share of the patent, and purported to release his assignee from all claims by himself and his co-patentee, was expunged at the instance of the latter (*s*).

But where a patentee assigned half his patent to A., and afterwards assigned the whole to B. by a deed reciting that he had already granted a licence to A., and B.'s assignment was first registered, Lord ROMILLY, M.R., although holding that B. had on the face of the deed notice of A.'s right, would not (there being no other evidence of notice) enter a statement to that effect on the register, but ordered an entry to be made that the licence referred to in the assignment to B. was the deed of assignment to A. (*t*).

And where a deed is perfectly good and *bonâ fide*, it would seem that no entry could be made on the register qualifying its effect or giving it a construction (*u*).

In *Re Horsley and Knighton's Patent*, cited above, it was contended that the entry ought not to be expunged, as so far as the entry stated the deed to be an assignment it was correct. But Lord ROMILLY, M.R., held that, as he could not alter the deed, the only course was to strike out the whole entry.

In *Re Berdan's Patent* (*x*), it was held that the Master of the Rolls, as Keeper of the Records, had power to order a disclaimer, which had been filed without the consent of the patentee, to be taken off the file. This jurisdiction would seem to be strictly within the present section, "amendments" being entered in the register of patents (see s. 23).

Orders made by the Master of the Rolls under the Act of 1852, s. 38, were not, prior to the Judicature Acts, subject to appeal (*y*), but by these Acts the jurisdiction was transferred to the High Court of Justice, and could be appealed like any order of the court (*z*).

(*q*) *Re Green's Patent*, 24 Bea. 145.

(*r*) 25 Bea. 584.

(*s*) *Re Horsley and Knighton's Patent*, L. R. 8 Eq. 475.

(*t*) *Re Morey's Patent*, 25 Bea. 581.

(*u*) *Per* Lord ROMILLY, M.R., *Re Morey's Patent*, 25 Bea. 584.

(*x*) L. R. 20 Eq. 347.

(*y*) *Re Horsley and Knighton's Patent*, L. R. 4 Ch. 784.

(*z*) *Re Morgan's Patent*, 24 W. R. 245; *Re Myer's Patent*, W. N. 1882, 53, 56.

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DESIGNS.

NOTE.

A design not sufficiently new or original which has been registered may, at the instance of a person sued for alleged infringement of it, be removed from the register under this section (*a*), even though it may have been independently invented by the registered proprietor (*b*).

On a motion to rectify the register by striking out the name of the person registered as proprietor and substituting the name of the applicant on the ground that he is the author of the design or the proprietor under s. 61 (*ante*, p. 374), the burden of proof is on the applicant (*c*).

Four clear days' notice of every application under this section for rectification of the register of designs is to be given to the comptroller (*d*).

TRADE MARKS.

“**Person aggrieved.**”—“Any trader is,” in the sense of the statute, “aggrieved whenever the registration of a particular trade mark operates in restraint of what would otherwise have been his legal rights” (*e*).

Thus “whenever one trader, by means of his wrongly registered trade mark, narrows the area of business open to his rival, and thereby either immediately excludes or, with reasonable probability will, in the future, exclude a rival from a portion of that trade into which he desires to enter, that rival is an aggrieved person. Again, if the effect produced, or likely to be produced, by the wrongful trade mark, is not the exclusion but the hampering of a rival trader, that rival trader again is an aggrieved person. A man in the same trade as the one who has wrongfully registered a mark and who desires to deal in the article in question, is *prima facie* an ‘aggrieved person’” (*f*).

And persons are “aggrieved” who are in some way or other substantially interested in having the mark removed from the register or persons who would be substantially damaged if the mark remained (*g*).

Upon these principles a person against whom an injunction is sought to restrain the use of a registered trade mark (*h*), and the defendant

(*a*) *Le May v. Welch*, 28 Ch. D. 24; *Smith v. Hope*, 6 R. P. C. 200; *Bach's Design*, 42 Ch. D. 661; *Plackett's Design*, 9 R. P. C. 438; *Clarke's Design*, [1896] 2 Ch. 44.

(*b*) *Smout v. Slaymaker*, 7 R. P. C. 90.

(*c*) *Heinrich's Design*, 9 R. P. C. 73.

(*d*) D. R., r. 27.

(*e*) *Per* Lord WATSON, *Powell v. Birmingham Vinegar, etc. Co.*, [1894] A. C. 12.

(*f*) *Per* FRY, L.J., *Apollinaris Trade Marks*, [1891] 2 Ch. 186, 225.

(*g*) *Per* BOWEN, L.J., *Powell's Trade Mark*, [1893] 2 Ch. 388, 406. See as to “substantially,” *Re Wright, Crossley & Co.*, 15 R. P. C. 131.

(*h*) *Ralph's Trade Mark*, 25 Ch. D. 194, 198.

in an action seeking to restrain him from using a certain name for his goods when the plaintiff sues on the ground that the name is substantially the same as a registered mark of the plaintiff (*i*) and a dealer who has used a particular word in connection with the article in which he deals (*k*), and a person whose application to register a mark has been refused by reason of the existence of a rival mark on the register (*l*), have been held to be "persons aggrieved" within the Act.

So, also, defendants in an action for infringement of a trade mark, who themselves have a mark registered in the same class as the plaintiff's mark, are "persons aggrieved" (*m*). But as to certain classes in which the defendants' trade mark was not, but the plaintiff's was, registered, it was held that the defendants were not "persons aggrieved" and must fail as to these classes (*n*).

And certain champagne growers who had registered as trade marks for champagne the words "Monopole" and "Dry Monopole," were held (whether their own marks were or were not good trade marks) to have a sufficient interest in the question whether a mark "Monobrut," which had been registered for champagne by a rival firm, should remain on the register to entitle them as "persons aggrieved" to expunge it as being merely descriptive (*o*).

Under the corresponding s. 5 of the Act of 1875, it was held that a person may be aggrieved, within that section, by the entry of a trade mark on the register, though not himself entitled to register the mark (*p*).

And where the words "Yorkshire Relish" had been registered as a name for a sauce, persons in the same trade, though not at the time intending to sell that particular sauce, though if the mark were removed they might possibly do so, were held entitled as "persons aggrieved" to move to expunge the mark from the register (*q*).

And foreigners not carrying on or intending to carry on business in England, may be "persons aggrieved" by the wrongful registration of a trade mark in this country (*r*).

And the fact that persons have agreed with the owners of a registered trade mark to act as their sole agents, and to sell under the mark only articles supplied by such owners, does not prevent their being

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NOTE.

(*i*) *Gianaclis' Trade Mark*, 6 R. P. C. 467.

(*k*) *Rose v. Evans*, 48 L. J. Ch. 518; *Ralph's Trade Mark*, 25 Ch. D. 194.

(*l*) *Butt's Trade Mark*, 6 R. P. C. 494.

(*m*) *Baker v. Rawson* 45 Ch. D. 519.

(*n*) *Ibid.*

(*o*) *Vignier's Trade Mark*, 6 R. P. C. 490.

(*p*) *Re Riviere's Trade Mark*, 26 Ch. D. 54.

(*q*) *Powell's Trade Mark*, [1893] 2 Ch. 388, affirmed in H. L. See *Powell v. Birmingham Vinegar, etc. Co.*, [1894] A. C. 8.

(*r*) *Re Riviere's Trade Mark*, 26 Ch. D. 54.

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“persons aggrieved” within the present section if the mark is not properly on the register, and they may move to have it struck off the register (s).

NOTE.

Where English consignees from a foreign manufacturer had registered under an alleged agreement with him the foreigner's trade mark in their own name, the purchasers of the foreign business were held entitled as “persons aggrieved” to move to expunge the registration (t).

“Entry made without sufficient cause.”—Where the circumstances are such that, if the applicant for rectification had been opposing the registration, the comptroller would have been justified in refusing to register, the entry has been made without sufficient cause (u).

But if the trade mark on the register is one which is not in itself illegal or improper, it will not be removed from the register merely because at the date of registration its registration might have been perhaps successfully opposed by some third party who did not in fact oppose it (x).

A trade mark wrongly registered will not be allowed to remain on the register on the ground that if removed it could by reason of change of circumstances be at once re-registered, as the public ought, by means of advertisements, to have the opportunity of opposing the new application (y).

The purity of the register is of much importance to the trade in general, apart from the merits or demerits of particular litigants. And therefore if on a motion to expunge, the attention of the court is called to an entry on the register of a trade mark which cannot in law be justified as a trade mark, the duty of the court may well be, whatever the demerits of the applicant, to purify the register and to expunge the illegal entry in the interests of trade (z).

The section presupposes the mark to be on the register, and does not enable the court to order the comptroller to register a trade mark which he has refused to register on the ground that it was not a trade mark within s. 64 of the Act. In such a case the applicant must appeal to the Board of Trade under s. 62 (4), *ante*, p. 376, (a).

Common
mark

If a mark which is common to the trade, or which contains words or devices common to the trade, has got on the register, it may, on the

(s) *Ainslie & Co.'s Trade Mark*, 4 R. P. C. 213.

(t) *European Blair Camera Co.'s Trade Mark*, 13 R. P. C. 600.

(u) *La Société Anonyme des Verreries de l'Etoile*, [1894] 1 Ch. 61.

(x) *Paine v. Daniell & Sons' Breweries*, [1893] 2 Ch. 567, 585.

(y) *Apollinaris Co's Trade Mark*, [1891] 2 Ch. 186.

(z) *Per BOWEN, L.J., Paine v. Daniell's Breweries*, [1893] 2 Ch. 567, 584. See also *Re Talbot's Trade Marks*, 11 R. P. C. 77, 81; *Re Wright, Crossley & Co.*, 15 R. P. C. 131.

(a) *Re Trade Mark "Normal"*, 35 Ch. D. 231, 246.

application of other persons in the same trade, be removed (*b*), even after the lapse of five years (*c*); or a note may be added that a particular word (*d*), or a particular device (*e*), or particular words and devices (*f*), in the mark is or are common to the trade; or that the registered proprietor is not entitled to the exclusive use of particular words (*g*), or that a particular device in the mark is not claimed *per se*, but only in combination (*h*). This, however, will not be done in the absence of the registered owner without his consent (*i*). And see now s. 74, (*ante*, p. 435).

Where a word has been wrongly registered as having been "used as a trade mark" when it has not been, in fact, so used, it may be removed from the register on the application of a person aggrieved (*k*).

And when the mark has the effect of causing goods to be known by the name which goods of a previously registered owner have acquired, a note may be added to the register limiting the use of the mark to goods which will not clash with the goods of the owner of the first mark (*l*).

A word originally registered as a trade mark may, by the *laches* of the registered proprietor in enforcing his rights, become common to the trade, and may then be expunged from the register (*m*).

And a new mark which is on the register may be expunged on the motion of the owner of an old mark subsequently registered if the new mark was calculated to deceive (*n*).

Where a foreigner had, under circumstances which the court held to be user, used his trade mark in England, and consignees from him registered the trade mark in their own name without the sanction of the foreigner, who subsequently sold his business and trade mark to an American company, it was held, on the application of the latter, that the entry on the register had been made without sufficient cause, and the registration was expunged (*o*).

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NOTE.

removed or
note added to
register.

(*b*) *Re Hyde & Co.'s Trade Mark*, 7 Ch. D. 724; *In Re Palmer's Trade Mark*, 21 Ch. D. 504; *Leonard v. Wells*, 26 Ch. D. 289.

(*c*) *Re Lloyd & Son's Trade Mark*, 27 Ch. D. 646; *Re Wragg's Trade Mark*, 29 Ch. D. 551. See also *ante*, p. 439, under s. 76.

(*d*) *Re Mitchell's Trade Mark*, W. N. 1878, 101.

(*e*) *Baker v. Rawson*, 45 Ch. D. 519, 535.

(*f*) *Re Leonardt*, Seb. Dig. p. 373.

(*g*) *Re Hayward's Trade Mark*, 54 L. J. Ch. 1003; *Humphries v. Taylor Drug Co.*, 5 Times R. 41; W. N. 1888, p. 214; *Burland v.*

Broxburn Oil Co., 42 Ch. D. 274; *Thompson v. Miller*, 13 R. P. C. 35.

(*h*) *Re Kuhn & Co.*, Seb. Dig. p. 390.

(*i*) *Re Mitchell's Trade Mark*, W. N. 1878, 101.

(*k*) *Leonard v. Wells*, 26 Ch. D. 289.

(*l*) *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 Ch. D. 454.

(*m*) *National Starch Manufacturing Co. v. Munn's Patent Maizena, etc. Co.*, [1894] A. C. 275.

(*n*) *Christiansen's Trade Mark*, 3 R. P. C. 55.

(*o*) *European Blair Camera Co.'s Trade Mark*, 13 R. P. C. 600.

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NOTE.

Although an application to register a mark has been duly advertised, a person who has not seen the advertisement, and who desires to rectify the register in respect of that mark, is not prejudiced by delay if he come to the court with due diligence after the fact has come to his knowledge (*p*), but the delay must be accounted for (*q*).

And when a trader did not move to expunge the mark till the registered owner had commenced an action against him to restrain him from using a similar mark, which he alleged he was entitled to use, it was held that the delay was no answer to the motion (*r*).

When a mark had been registered by the sole consignee in England of wines from a vineyard in Australia, as a trade mark for wines and with the intention only to use it for wines from this vineyard, and the trustees in liquidation of the consignee sold the consignee's business and trade mark to a company who registered themselves as owners of the mark, the register was, on the motion of the owners of the vineyard, rectified by removing the company's name, and inserting the names of the owners of the vineyard as proprietors of the mark (*s*).

Registration
in wrong
name.

Where a person has registered in his own name the trade mark of another person without the knowledge or consent of the true proprietor, the register of trade marks cannot be rectified by transferring the registration into the name of the true proprietor. The false entry will be expunged, and the true owner must apply in the usual way to register the mark (*t*). And he will not be entitled to an order for substitution of his name as owner of the mark, as every new registration requires fresh advertisements, etc. (*u*).

And when the trade mark of A. had been registered in the name of B., it was held on an application of A. and B. to expunge B.'s name from the register, and insert that of A., that the application, so far as it sought to register the name of A., must be refused, and that A. must apply for registration in the usual way (*x*).

Where a trade mark belonging to a firm has, on an application by one of the partners described as trading under the firm's name, been registered in the name of that partner, the register may be rectified by cancelling the name of that partner as registered proprietor, and inserting the names of all the partners trading under the firm's name (*y*). But

(*p*) *Re Hyde & Co.'s Trade Mark*,
7 Ch. D. 726.

(*q*) *Ransome v. Graham*, 51 L. J.
(N.S.) Ch. 903.

(*r*) *Great Tower Street Tea Co. v.*
Smith, 6 R. P. C. 165.

(*s*) *Australian Wine Co.*, 61 L. T.
(N.S.) 427.

(*t*) *Ex parte Lawrence Brothers*,
29 W. R. 392. See *Re European*
Blair Camera Co.'s Trade Mark, 13
R. P. C. 600.

(*u*) *Re Rivière*, 55 L. J. Ch. 545.

(*x*) *Kingsford & Son's Application*,
6 R. P. C. 413.

(*y*) *Rust & Co.'s Trade Mark*, 29
W. R. 393.

this could not be done where the registration had been applied for and obtained through a mistake of the firm in the sole name of one of the partners, without any mention of the firm's right to the mark. In such a case the proper course was, under the old practice, for the registered partner to assign the trade mark to the firm (z), and this is still the practice (a).

When a firm changed their style after registering a trade mark and applied to be registered as proprietors under their new name, the comptroller refused the application on the ground that the alteration could only be made by the court, and on an application to the court under this section, an order was made directing the comptroller to enter on the register the new firm (by its name) "*formerly trading as,*" the old firm (naming it) (b).

Under the corresponding section of the Act of 1875 (c), it was held that the application should be by motion, of which two clear days' notice should be given, and that an affidavit of the applicant verifying his case would be all the evidence that was required (d).

If the owner becomes bankrupt after notice of motion has been given the trustee may be added as respondent (e).

The burden of proof lies on the person seeking to remove the mark from the register (f). His own evidence may be insufficient, but the *onus* is discharged if it appears from the evidence of the owner of the mark that it ought not to be on the register (g).

Although the 90th section points to a name it enables any entry improperly made to be struck out (h).

When the original maker of a material registered in respect of it, in 1878, the word "Frigidomo" as an old mark, and on a motion made by the defendant in an action for injunction to remove this from the register, on the ground that it had not been used as a trade mark before 1875, it was shown that in 1876, the original maker had registered an arrow as a trade mark for the same article which he described as an article "prepared by him and called by him Frigidomo," and had stated in his application that he had used the arrow as the trade mark for three years before 1876. It was held that the original owner being dead, and the application to expunge not being made till 1889, and then only under the stress of an action for infringement, and in the

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NOTE.

(z) *Farina's Trade Mark*, 29 W. R. 391.

(a) *Greenlces's Trade Mark*, 9 R. P. C. 93.

(b) *Patent Plumbago Crucible Co.'s Marks*, 7 R. P. C. 282.

(c) 38 & 39 Vict. c. 91, s. 5.

(d) *Ex parte Stephens*, W. N. 1876, 202.

(e) *Rowe's Trade Mark*, 48 L. T. (N.S.) 388.

(f) *Leonard v. Wells*, 26 Ch. D. 289. See also *Edgington v. Edgington*, 6 R. P. C. 513.

(g) *Leonard v. Wells*, *ubi supra*.

(h) *Arbenz's Application*, 35 Ch. D. 260, 261.

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absence of evidence that anyone but the defendant and the assignee of the original proprietor had ever used the words, the defendant had not discharged the *onus* of showing that the words ought not to be on the register (i).

Under s. 5 of the Act of 1875, which, in express terms, enabled an aggrieved person to apply to rectify the register if the name of the person "who is not for the time being entitled to the exclusive use" of the mark is entered on the register, the words "for the time being" were held to apply to the time when the registration is made (k).

When an entry has been wrongly made, because the application ought to have been treated under s. 63 as abandoned, the court is not bound to expunge the entry, but may rectify the register by stating the date from which the registration is to run (l).

The register cannot be rectified on an application by way of counterclaim (m).

Under the 34th rule of the Trade Marks Rules, 1875, a trade mark could be removed at the suit of any person aggrieved, if the registered proprietor were not engaged in any business concerned in the goods within the same class as the goods in respect of which the mark was registered. This rule was acted on in *Re Ralph's Trade Mark* (n). This provision is not re-enacted in the present Act or rules; but if there is no real user before or after registration and no *bonâ fide* intention at the date of registration to use the mark it may be expunged from the register (o).

Registered
owner out of
jurisdiction.

A notice of motion to rectify the register by removing a mark registered in the name of a foreigner cannot be served out of the jurisdiction, and the foreigner resident out of the jurisdiction ought not to be named on the notice of motion. The notice of motion should be addressed to the comptroller alone, and a copy sent to the foreigner with an intimation that proceedings are pending which may affect his interests (p). And where the applicants resided in Scotland, and had given no address for service, it was held on an appeal by the opponents from a decision of the comptroller allowing registration, that the course above indicated should be followed (q). And when the registered proprietor of a trade mark was resident in Ireland it was held that sending him a copy of a notice of motion, addressed to the comptroller, to expunge the mark, with a letter informing him that proceedings had been commenced which might affect his interests was sufficient and the

(i) *Edgington v. Edgington*, 6 R. P. C. 513.

(k) *Wood v. Lambert*, 32 Ch. D. 247.

(l) *Hayward & Son's Trade Mark*, 54 L. J. Ch. 1003.

(m) *Pinto v. Badman*, 8 R. P. C. 181, 190.

(n) 25 Ch. D. 191.

(o) *Batt & Co.'s Trade Mark*, [1898] W. N. 44 (15).

(p) *La Compagnie Générale d'Eaux Minérales, etc.*, [1891] 3 Ch. 451.

(q) *Robertson, Sanderson, & Co.'s Application*, 9 R. P. C. 213.

court made an order to expunge the mark, although the registered proprietor did not appear (*r*). Sect. 90 (1).

A foreign company having no address for service in this country, but who have had notice of a motion to expunge their trade mark, may appear, and, on submitting to the jurisdiction, be added as respondents without giving security for costs (*s*).

Applications may be made under this section in relation to old corporate marks placed on the register by the Cutlers' Company under s. 81 (2) (*t*).

When an order is made under this section, the comptroller may, if he thinks any rectification or variation of the register should be made public, publish at the expense of the applicant the circumstances attending such rectification or variation (*u*).

It is convenient that an applicant seeking to expunge a trade mark from the register should state in writing the grounds of his application (*x*).

Four clear days' notice of every application under this section for rectification of the register of trade marks must be given to the comptroller (*y*).

COSTS.

Patents.—In *Re Green's Patent* (*z*), the original assignor and the second assignee, and in *Re Horsley and Knighton's Patent* (*a*), the persons who put the wrong entry on the register, were ordered to pay the costs of rectifying the register; but in *Re Morey's Patent* (*b*), the order was made without costs.

Trade marks.—Where a trade mark, which had, in fact, been common to the trade, had been registered as an old mark by a firm of traders, and it was shown that they had known of its user by other firms for above six years before registration, they were ordered to pay the costs of a successful application for its removal from the register (*c*); and it was held that it was no objection to the allowance of the costs that the applicants, who had not seen the advertisements in the "Trade Marks Journal," had not opposed the registration (*d*); nor in a similar

(*r*) *King & Co.'s Trade Mark*, [1892] 2 Ch. 462; *Royal Baking Powder Co.'s Trade Marks*, 14 R.P.C. 425 (in this case the registered proprietors were foreigners).

(*s*) *Re La Société Anonyme des Verreries de l'Etoile*, 10 R. P. C. 290.

(*t*) *Lambert's Trade Mark*, 5 R. P. C. 542, 555, affirmed 6 R. P. C. 314.

(*u*) T. M. R. r. 50.

(*x*) *Wills's Trade Marks*, [1892] 3 Ch. 201.

(*y*) T. M. R. r. 49.

(*z*) 24 Bea. 145.

(*a*) L. R. 8 Eq. 475

(*b*) 25 Bea. 581.

(*c*) *Re Hyde & Co.'s Trade Mark*, 7 Ch. D. 725. See also *Re Kuhn & Co.*, Seb. Dig., p. 390.

(*d*) *Re Hyde & Co.'s Trade Mark*, *ubi supra*.

Sect. 90 (1). case that the applicants had not informed the person on the register of their intention to take action (e).

NOTE.

But if a mark has actually become common by being copied without the owner's permission, and is then registered by the original owner, it may be that the costs of an application to remove it will not be given (f).

And where a person had adopted, without inquiry, some words which had been registered as the trade mark of another, and afterwards, being sued by the owner of this trade mark for infringement, moved to expunge the trade mark from the register, on the ground that it was incapable of registration, the court, although directing the mark to be expunged from the register, refused, under the circumstances, to give the applicant any costs (g).

So, also, when the applicant had imitated the get-up of the boxes in which the owner of the mark expunged sold his goods (h).

Where there was an action to restrain the defendant from passing off his goods as the goods of the plaintiff, founded to some extent on a trade mark of the plaintiff, though no injunction to restrain infringement of the mark was asked in terms, the costs of a successful motion by the defendant to expunge the mark were reserved till the trial of the action (i).

Where it was desired to disclaim the words "trade mark" from a registered mark and the application was granted upon terms, it was ordered that the comptroller's costs should be paid (k).

When an order as to an entry on the register had been obtained *ex parte*, and was afterwards, on the application of the comptroller, varied on the ground that in its original form it was against s. 85 of the Act, the respondents had to pay the costs of the application to vary (l).

When, on a motion to expunge a trade mark on various grounds an order had been made directing the owners of the trade mark to make an affidavit of documents relating to certain specified questions, as to the first use of the mark, whether it was common to the trade, and the like, the order was discharged by the Court of Appeal as likely to be oppressive, but without prejudice to any order the judge at the trial might think fit to make with respect to the discovery of documents (m).

(e) *Re Kuhn & Co.*, Seb. Dig., p. 390.

(f) *Re Kuhn & Co.*, *ubi supra*.

(g) *Perry Davis's Trade Mark*, 5 R. P. C. 333.

(h) *Re Bradley's Trade Mark*, 9 R. P. C. 206.

(i) *Gianacis' Trade Mark*, 6 R. P. C. 457.

(k) *Colman's Trade Marks*, 8 R. P. C. 209, 213.

(l) *Mitchell & Co.*, and *Houghton and Hallmark's Trade Marks*, 28 Ch. D. 669.

(m) *Re Wills's Trade Marks*, [1892] 3 Ch. 201.

Where an applicant for removal of a trade mark from the register served notice of discontinuance of the proceedings on the registered owner, it was held that it was doubtful whether the respondent could have his costs under Order XXVI., r. 1, and that he was justified in coming to the court and asking for the costs of the motion as an abandoned motion (*n*). Sect. 90 (1).
—
NOTE.

SUB-SECTION 2.

See *Re Salamon* (*o*), where an action was directed.

The provision as to damages was introduced by the present Act.

SUB-SECTION 3.

When an order is made under this section, an office copy of the order is to be left at the Patent Office (*p*).

91. The comptroller may, on request in writing accompanied by the prescribed fee,— Power for
comptroller
to correct
clerical
errors.

(a.) Correct any clerical error in or in connexion with an application for a patent, or for registration of a design or trade mark (*q*); 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 (*r*): 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.

By the Act of 1888, s. 24, the following clause is added to the section :—

“(d.) Permit an applicant for registration of a design or trade mark to amend his application by omitting

(*n*) *Re Dyson's Trade Mark*, W. N. 1891, p. 176.

(*o*) Seb. Dig., p. 340.

(*p*) P. R. r. 74; T. M. R. r. 46; D. R. r. 28.

(*q*) P. R. Form P.; D. R. Form M.; T. M. R. r. 48, and Forms M. and Q.; *post*. In the case of designs and trade marks, the Rules include amendment of drawings.

(*r*) T. M. R. Forms O. and P.

Sect. 91

NOTE.

any particular goods or classes of goods in connexion with which he has desired the design or trade mark to be registered."

(a.) All documents for the amending of which no special provision is made by the Act may be amended if and on such terms as the comptroller may think fit (P. R., r. 16). This will include clerical errors in a specification, and, apparently, whether provisional or complete (*Ibid.* Form P). See, also, D. R., r. 30; T. M. R., r. 54.

(c.) If more than mere cancellation is required, the application must be made to the court under s. 92.

Under the old Act a mark might be struck out of the register on the application of the registered proprietor (s).

Alteration of
registered
mark.

92. (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 (t).

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

Substantially a re-enactment of rr. 34 and 35 of the Rules of March, 1883.

Certain additions to marks, the subject of applications for registration, may be made by the comptroller under ss. 64 (2) and 74, *ante*. But as to marks already registered, the applicant must proceed under this present section.

Act of 1875.

Under the Act of 1875 leave was given, on the application of the registered proprietor, to alter the mark by substituting in it a new for an existing word, denoting the address of the proprietor (y); to rectify the register by limiting the registration to particular goods (z); to vary

(s) *Ex parte Sales, Pollard & Co.*,
Seb. Dig., p. 378.

(t) T. M. R. r. 51.

(u) *Ibid.* r. 46, and Form N.

(a) First Schedule, T. M. R.

(y) *Ex parte Walker & Co.*, Seb.
Dig., p. 381.

(z) *Re Lynght*, Seb. Dig., p. 381.

the address and change the type (a), or to substitute the name of an assignee for that of the assignor, where the latter was printed in ordinary type (b), or to remove the name of the proprietor from a mark, leaving a blank space, with permission to insert therein the name of the firm for the time being (c). But the substitution of the name of the assignee for that of the assignor was not allowed when the latter name had been printed in the form of a signature, so as to be an essential particular of the mark (d).

Sect. 92.

NOTE.

A limited company which had taken over the business and trade marks of a firm, and was incorporated under the name of the firm, was held entitled to add the word "limited" to a facsimile signature of the firm, which was part of the trade mark (e). But leave to add the abbreviation "Ltd." was refused (f). Present practice.

Where a trade mark for cotton goods consisted of an elaborate device with the words "Grass Bleach—1st Quality," the owners were allowed, under this section, to alter the mark by substituting their own name for the word "Grass," upon satisfying the court that two other marks on the register, in which the same name appeared, belonged to other firms than the applicants, and that the devices on their marks were altogether different from that on the applicants' mark (g).

And where the name of a company owning a trade mark was changed, and the initials of the old name were on the registered mark, the mark was altered by substituting the initials of the new name (h).

Where the application was to alter certain registered trade labels by expunging the word "trade mark" which appeared on the labels, leave was granted under this section, but only on the terms of the applicants' undertaking to endorse on their application and enter on the register a statement of the essential particulars of each mark, and a disclaimer of any exclusive right to the added matter, if any, to the satisfaction of the comptroller (i).

There is an important distinction under this section between old and new marks. A mark registered as an old mark ought to be registered, and kept registered, just as it was used, with the exception of such

(a) *Ex parte Lazenby*, Sebastian on Trade Marks, 3rd ed. p. 406.

(b) *Re Dewhurst*, *ibid.*

(c) *Re Boord*, *ibid.* But this is now objected to. See *Brown's Trade Marks*, 11 R. P. C. 365.

(d) *Re Dewhurst*, *ubi supra*.

(e) *Re Guinness & Co.'s Trade Mark*, 5 R. P. C. 316; *Re Bryant & May, Limited*, 4 Times R. 575;

Re Burke's Trade Marks, [1891] W. N. 2.

(f) *Hayward & Sons' Trade Mark*, 13 R. P. C. 729.

(g) *Reiss' Trade Mark*, 5 R. P. C. 291.

(h) *National Wholesale Tea Supply Association's Trade Mark*, 10 R. P. C. 164.

(i) *Colman's Trade Marks*, [1891] 2 Ch. 402. The Order is printed, 8 R. P. C. 213.

Sect. 92.

NOTE.

alterations or additions as the circumstances of the case from time to time render necessary (*j*).

And therefore in old marks, applications to expunge the words "trade mark" (*k*), or to alter the initials of a former proprietor into the name of a subsequent proprietor (*l*) were refused, though, as appears above, similar alterations have been allowed in new marks.

So, also, where an old mark contained the word "patent," leave to strike out the word was refused (*m*).

And where the applicants desired to add words of quality to an old mark, they were only allowed to do so on condition of disclaiming the exclusive use, not merely of the words added, but also of other words on the mark which they would be bound to disclaim if they were registering under the present Act (*n*).

And where a mark was a combination mark consisting of certain oval lines and a device, the proprietors were not allowed to alter the mark by omitting the oval lines (*o*).

The name of the "works" mentioned in a trade mark is not an essential particular. And where a trade mark had the words "Burham Works" at the top, and the words "Murston Works" at the bottom, it was allowed to be altered by striking out the latter words and altering the position of the former words so as to read "Burham" at the top and "Works" at the bottom (*p*).

And the name of a firm is not of necessity an essential particular, and therefore in a proper case a new name of the registered owners of the trade mark may be substituted for their old name (*q*).

Where, by a clerical error in a mark in the Russian character, the initial letter was printed in English character, the mistake was rectified under this section (*r*). But leave was refused to strike out the name of a place in Russian characters and substitute the owner's name in English characters, since, to a person not understanding Russian, the mark, when altered, would be different to the original mark, and altered in a material particular (*s*).

Where an order has been made under this section, an office copy of the order is to be left at the Patent Office (*t*).

(*j*) *Per* KEKEWICH, J., *Clay and Bock & Co.'s Trade Mark*, 9 R. P. C. 449.

(*k*) *Phillips' Trade Marks*, [1891] 3 Ch. 139.

(*l*) *Clay and Bock & Co.'s Trade Mark*, *ubi supra*.

(*m*) *Adams' Trade Marks*, 9 R. P. C. 174.

(*n*) *Orlando Jones & Co.'s Trade Marks*, 12 R. P. C. 278.

(*o*) *Orlando Jones & Co.'s Trade Marks*, 12 R. P. C. 278.

(*p*) *Re Burham, etc. Co.'s Trade Marks*, 9 R. P. C. 422.

(*q*) *Re Stock Owners' Meat Co. of New South Wales*, 14 R. P. C. 733.

(*r*) *Ermen and Roby's Trade Mark*, 4 R. P. C. 70.

(*s*) *Savin's Trade Mark*, 13 R. P. C. 21.

(*t*) T. M. R. r. 46, *post*. And if the

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 misdemeanor. Sect. 93.
Falsification of entries in registers.

A re-enactment in substance of s. 37 of the Act of 1852.

That section, however, only related to patents, but the present section applies to every register kept under this Act.

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 (*u*). Exercise of discretionary power by comptroller.

95. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers for directions in the matter. Power of comptroller to take directions of law officers.

96. A certificate (*x*) purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone. Certificate of comptroller to be evidence.

A re-enactment of s. 8 of the Act of 1875, making its provisions generally applicable to this Act.

97. (1.) Any application, notice, or other document authorised or required to be left made or given at the Applications and notices by post.

comptroller thinks that the rectification or variation of the register should be made public, he may publish the same at the expense of the applicant, T. M. R. r. 50.

(*u*) See P. R. rr. 11—14; D. R.

rr. 12—14; T. M. R. rr. 17—19; *post*.

(*x*) P. R. *post*, r. 79, Second Schedule, Form Q.; D. R. *post*, r. 34, Forms G., J.; T. M. R. *post*, r. 60, Form U.

Sect. 97 (1). patent office or to the comptroller, or to any other person under this Act (*y*), 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.

Where a witness produced a copy of a letter which he said was made by him, and swore that he should, in the ordinary course of business, have posted the original, it was held that this was evidence of the posting, and that the original not being produced the copy was good secondary evidence (*z*). But neither proof of an entry made by a deceased person in the ordinary course of business in a postage-book of a letter to be posted, nor proof of possession by the deceased person for the purpose of posting, is sufficient evidence of postage (*a*).

Provision as to days for leaving documents at office.

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.

Declaration by infant, lunatic, etc.

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

(*y*) Or under the rules; see P. R. r. 16A, *post*. D. R. r. 11, and T. M. R. r. 16, are similar.

(*z*) *Trotter v. Maclean*, 13 Ch. D. 574.

(*a*) *Rowlands v. De Vecchi*, 1 Cab. & Phil. 10.

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.

Sect. 99.

Taken from Rule 67 of the Trade Marks Rules of March, 1883.

100. Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the Patent Office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

Transmission of certified printed copies of specifications, etc.

A re-enactment, with modifications, of 16 & 17 Vict. c. 115, s. 5.

101. (1.) The Board of Trade may from time to time make such general rules (b) and do such things as they think expedient, subject to the provisions of this Act—

Power for Board of Trade to make general rules for classifying goods and regulating business of patent office.

- (a.) For regulating the practice of registration under this Act :
- (b.) For classifying goods for the purposes of designs and trade marks :

(b) F. R. 1890 and 1892, D. R. 1890 and 1893, and T. M. R. 1890 and 1897.

- Sect. 101 (1).
- (c.) For making or requiring duplicates of specifications, amendment, drawings, and other documents :
 - (d.) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications drawings amendments and other documents :
 - (e.) For securing and regulating the making printing publishing and selling of indexes to, and abridgments of, specifications and other documents in the patent office; and providing for the inspection of indexes and abridgments and other documents :
 - (f.) For regulating (with the approval of the Treasury) the presentation of copies of patent office publications to patentees and to public authorities, bodies, and institutions at home and abroad :
 - (g.) Generally for regulating the business of the patent office, and all things by this Act placed under the direction or control of the comptroller, or of the Board of Trade.

(2.) Any of the forms in the First Schedule to this Act may be altered or amended by rules made by the Board as aforesaid (c).

(3.) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as herein-after mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.

(4.) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the comptroller.

(5.) If either House of Parliament, within the next forty days after any rules have been so laid before such House,

(c) This has been done as to certain Forms in the Schedule to the Act. See the various Rules, *post*.

resolve that such rules or any of them ought to be annulled, Sect. 101 (5).
 the same shall after the date of such resolution be of no effect,
 without prejudice to the validity of anything done in the
 meantime under such rules or rule or to the making of any
 new rules or rule.

As to the power of making Rules conferred by this section on the
 Board of Trade, see *Chartered Institute of Patent Agents v. Lockwood (d)*.

102. The comptroller shall, before the first day of June
 in every year, cause a report respecting the execution by or
 under him of this Act to be laid before both Houses of
 Parliament, and therein shall include for the year to which
 each report relates all general rules made in that year under
 or for the purposes of this Act, and an account of all fees,
 salaries, and allowances, and other money received and paid
 under this Act. Annual
reports of
comptroller.

102a. (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. Proceedings
of Board of
Trade.

(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.

This section was added by the Act of 1888, s. 25.

For definition of the expression "Board of Trade," see 52 & 53 Vict.
 c. 63, s. 12 (8).

(d) 10 R. P. C. 167; on appeal to H. L., 11 R. P. C. 374; 1894, A. C. 347.

Sect. 103.*International and Colonial Arrangements (e).*

International
arrangements
for protection
of inventions,
designs, and
trade marks.

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 protection obtained* 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 Sect. 103 (3).
 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.

This section is amended by the Act of 1885, s. 6, which enacts that in
 the above sub-s. 1 the words "date of the application" shall be
 substituted for the words "date of the protection obtained" (f).

Since the passing of this Act an international convention for the
 protection of industrial property has been entered into at Paris between
 various foreign Governments, and her Majesty's Government have
 become parties to the convention. See *post*.

SUB-SECTION (1).

"Any person who has applied."—A patent under the International
 Convention can only be granted to the person who has made the foreign
 application (g). Therefore, applications by the agent of the assignee of
 the foreign patent (h), and by the director of a foreign company, who
 were applicants for a foreign patent, that a patent might be granted to
 the company's agent in England (i), were refused.

It would seem that there is no distinction under this section between
 Englishmen and foreigners (k). And further, that corporations can
 apply under this section (l).

"Trade Mark."—The trade mark to be capable of registration
 under this section must be within the definition of s. 64 of the Act (m).

"Any such state."—Although the state may only have come into
 the convention after the date of the foreign application in that state,
 the foreign applicant is within this section, and if he satisfies it in other

(f) As to the meaning of these
 words, see *Nordenfelt v. Gardner*,
 cited *ante*, p. 347.

(g) *Shallenberger's Application*,
 6 R. P. C. 550.

(h) *Shallenberger's Application*,
ubi supra.

(i) *Carez's Application*, 6 R. P. C.
 552.

(k) *Shallenberger's Application*,
ubi supra.

(l) *Carez's Application*, *ubi*
supra.

(m) *Carier Medicine Co.'s Trade*
Mark (1892), 3 Ch. 472.

Sect. 103 (1). respects, is entitled to have his English patent dated in priority to a patent on an English application made before the accession of the foreign state to the convention, but after the date of the foreign application (n).

NOTE.

"In priority to other applicants."—Where an Englishman applied for a patent on August 20th, 1886, and two Frenchmen applied, on October 8th, 1886, for a patent for the same invention, and the Englishman, being on May 28th, 1887, in a position to oppose, gave notice of opposition, on the ground that the invention had already been patented on his application, and it appeared that the Frenchmen on August 18th, 1886, applied for a patent for their invention in France, it was held under this section that they were entitled to have their English patent ante-dated to the last-mentioned date (o). But on the same application it was held that a notice of opposition to the grant of the Englishman's patent, given by the Frenchmen subsequent to the Englishman's application, conferred on them no *locus standi* to oppose under s. 11, and the Englishman's patent was allowed (p).

Where foreigners' English specification contained claims of inventions not described in their foreign specification, they were allowed, on applying to have their patent ante-dated to the date of their foreign application, to strike out the claim applicable to so much as was not described in the French specification, leaving, however, the description of the new portion; and the law officer refused to consider this as an application for amendment which would justify his imposing any terms on granting the foreigners' patent (q).

In a conflict between foreigners and an Englishman under this section the law officer will not require it to be shown that the foreigners' English complete specification is in terms and actual words in the form of the foreign specification (r).

It may be doubtful whether this section applies if the English patent has been completely granted before the foreign application in this country is made (s).

"Provided that his application is made," etc. — Where a foreigner, the subject of a state which had acceded to the International Convention, did not apply for registration in England of his trade mark within four months of his applying to register in the foreign state, it was held that under this section, notwithstanding Article VI. of the International Convention (*post*), registration must be refused (t).

(n) *Main's Patent*, 7 R. P. C. 13.

(o) *L'Oiseau & Pierrard's Patent*, Griffin, L. O. C. 36.

(p) *Everitt's Patent*, No. 10680 of 1886, Griffin, L. O. C. 28.

(q) *L'Oiseau & Pierrard's Application*, Griffin, L. O. C. 36.

(r) *L'Oiseau & Pierrard's Application*, *ubi supra*.

(s) *Main's Patent*, 7 R. P. C. 13.

(t) *Californian Fig Syrup Co.'s Trade Mark*, 6 R. P. C. 126.

Where the application in the foreign state was a renewed application, Sect. 103 (1), there having been a prior application which had become abortive and of no force and effect, and it was shown that the applicant had no right under that prior application, and that the proceedings in the foreign state under the renewed application were the same in all respects as if no prior application had been made, it was held that, for the purposes of this section, the time was to be reckoned from the date of the renewed application (u).

NOTE.

SUB-SECTION (2).

Section 103 gives a double right to a foreign inventor. He may apply for the restricted right given by the section, in which case he does not get the full term of fourteen years, or he may apply in the ordinary way for a patent for the full term. In the latter case the patent will be invalidated by a publication in England after the date of the foreign patent, and before that of the English application (x). And the date of the English patent is conclusive as to whether the patentee has or has not availed himself of the section (y).

Where a foreigner, owner of a label which was registered in France, and which could have been registered in England under this section as his trade mark, did not so register the label, he was held to be precluded by s. 77 (*ante*, p. 441) from suing in this country to restrain infringement of the label as a trade mark (z).

When the grant to the foreign applicant was opposed on the ground that the invention had been patented in this country on an application of prior date, that prior date being subsequent to the date of the application of the foreigner in the foreign state, and the comptroller under this section ante-dated the foreigner's English patent, it was held that s. 11 (1) applied, and that there was an appeal from the comptroller to the law officer (a).

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

Provision for colonies and India.

(u) *Van de Poole's Patent*, 7 R. P. C. 69.

(x) *British Tanning Co. v. Groth*, 8 R. P. C. 113.

(y) *British Tanning Co. v. Groth*, *ubi supra*.

(z) *Goodfellow v. Prince*, 35 Ch. D. 9.

(a) *Main's Patent*, 7 R. C. P. 13.

Sect. 104(1). 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.

Offences.

Penalty on falsely representing articles to be patented.

105. (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 five pounds.

(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.

This section is based on s. 7 of the Act of 1835 (*b*), as to patents, and s. 11 of the Act of 1842, as to designs. As to trade marks, see also the Merchandise Marks Act, 1887 (*c*).

Where a defendant, intending to induce the plaintiff to desist from printing a particular design, and to acquire the same for himself, falsely stated to the plaintiff that the design was registered, it was held, on demurrer, that the action would lie (*d*).

"When no patent has been granted."—This section does not apply to cases of false representation of an expired patent as being still subsisting, such as in *Cheavin v. Walker* (*e*), cited, *ante*, p. 431. But such a representation is a false "trade description" within s. 3 (*e*) of the Merchandise Marks Act, 1887, and as such is a criminal offence under s. 2 (*d*) of that Act.

(*b*) See *Myers v. Baker*, 3 H. & N. 802.

(*c*) 50 & 51 Vict. c. 28.

(*d*) *Barley v. Walford*, 9 Q. B. 197.

(*e*) 5 Ch. D. 863.

An article which is only the subject of provisional protection must not be sold as patented (*f*). But the section does not apply if the complete specification has been accepted, as the applicant has then, under s. 15 (*ante*, p. 65), the rights of a patentee (*g*).

Sect. 105.

NOTE.

“Registered.”—Using the word “registered” on a trade mark not registered within the United Kingdom is an offence within this section, although the trade mark is registered abroad (*h*).

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 twenty pounds.

Penalty on unauthorised assumption of Royal arms.

Scotland ; Ireland ; etc.

107. In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those courts.

Saving for courts in Scotland.

For the purposes of this section, “court of appeal” shall mean any court to which such action is appealed.

The last part of this section is a re-enactment of part of s. 43 of the Act of 1852.

108. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the sheriff court.

Summary proceedings in Scotland.

(*f*) *R. v. Wallis*, 3 R. P. C. 1 ;
R. v. Crampton, 3 R. P. C. 367. And
see *Melachrino v. Melachrino, etc. Co.*,
4 R. P. C. 215, 224.

(*g*) *R. v. Townsend*, 13 R. P. C.
265.

(*h*) *Wright v. Dobbin*, 15 R. P. C.
21.

Sect. 109.

Proceedings
for revocation
of patent in
Scotland.

109. (1.) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.

(2.) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

See *ante*, s. 26.

Sub-s. 1 is a re-enactment of the last part of s. 43, and sub-s. 2 of part of s. 35 of the Act of 1852.

Reservation
of remedies
in Ireland.

110. All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.

A re-enactment of the last clause of s. 29 of the Act of 1852.

Before that Act it was the practice to grant separate patents for the three kingdoms, and under that practice it was held, in *Brown v. Annandale* (*h*), that the public use of an invention in England prior to the date of letters patent for Scotland invalidated the letters patent.

Upon this case it is observed by Mr. Webster (*i*), that neither in *Roebuck's* nor in *Brown's Case* was the grantee of the letters patent the true and first inventor in England, and he suggests that the decision would not be held to apply to a case in which the true and first inventor in one part of the realm was the grantee of the letters patent in the other part; and this view was followed in *Magill v. Ewing* (*k*), where it was held by the Lord Chancellor of Ireland that where an inventor who had obtained letters patent in England subsequently obtained letters patent in Ireland for the same invention, the Irish patent was not invalid by reason of prior publication in England.

In *Bovill v. Finch* (*l*), it was held under the Act of 1852 and the amending Act of 1853 (*m*), that a prolongation patent, which, by those Acts, was under the Great Seal of the United Kingdom, was to be considered as granting three separate prolongations of three distinct

(*h*) 1 Webst. 433, following *Roebuck v. Stirling*, 1 Webst. 45. See also *Re Pow's Patent*, 2 Webst. 5; *S.C.* under name *Robinson's Patent*, 5 Moo. P. C. 65.

(*i*) 1 Webst. 454, n.
(*k*) 11 L. Jur. (N.S.) 164.
(*l*) 11 R. & C. P. 523.
(*m*) 15 & 16 Vict. c. 83; 16 & 17 Vict. c. 115.

patents, and that although the prolongation might be invalid as to one grant (the Scotch) by reason of the want of novelty in Scotland at the time of the original patent, it might be good as to the English and Irish grants. The court did not, however, decide what would be the effect of want of novelty in one kingdom in the case of an original grant for the three kingdoms under one seal, which has been the case with all patents since 1852, and is continued by the present Act. See *ante*, s. 36.

Sect. 110.

NOTE.

A strict construction of this section might lead to the conclusion that the patent can only be revoked as regards Ireland by an Irish Court. But such a construction cannot, it is submitted, be correct, since it is inconsistent with the general power given in s. 26 (2), which is unlimited, and moreover would make it possible that there should at the same time be a patent in force in one branch of the United Kingdom while revoked in another, which, having regard to s. 16, can hardly have been intended. It would appear, therefore, that the present section must be construed to relate only to patents which have never been revoked by any of the courts mentioned in s. 111 as included in the word "court" where used in the Act.

111. (1.) The provisions of this Act conferring a special jurisdiction on the court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade marks; and with reference to any such proceedings in Scotland, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of the said Court; and with reference to any such proceedings in Ireland, the terms "the Court" and "the Court of Appeal" respectively mean the High Court of Justice in Ireland and Her Majesty's Court of Appeal in Ireland.

General saving for jurisdiction of courts.

(2.) If any rectification of a register under this Act is required in pursuance of any proceeding in a court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification, shall be served on the controller, and he shall rectify the register accordingly.

The High Court of Justice in England has jurisdiction to rectify the register of trade marks notwithstanding the registered proprietor is

Sect. 111. domiciled in Scotland or Ireland⁽ⁿ⁾, and it would seem that such jurisdiction is an exclusive one^(o).

NOTE.
Isle of Man.

112. This Act shall extend to the Isle of Man, and—

- (1.) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade mark competent to those Courts ;
- (2.) The punishment for a misdemeanor under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court ;
- (3.) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Jurisdiction
of Lancashire
Palatine
Court.

112A. The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade marks the registration whereof is applied for in the Manchester Office, have the like jurisdiction under this Act as her Majesty's High Court of Justice in England, and the expression "the court" in this Act shall be construed and have effect accordingly.

Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that court in other cases.

This section was added by the Act of 1888, s. 26, *post*. And now by s. 3 of the Chancery of Lancaster Act, 1890 (*p*), the Court of Chancery of the

(n) *King & Co.'s Trade Mark*, [1892] 2 Ch. 462.

(o) *Bayer v. Connell*, 14 R. P. C. 275 ; see, however, *Cowie v. Herbert*

ibid. 436, in which no objection was taken to jurisdiction.

(p) 53 & 54 Vict. c. 23.

County Palatine of Lancaster has, as to all persons and property within its jurisdiction, the same powers and jurisdiction as the Chancery Division of the High Court.

Sect. 112.

NOTE.

Repeal ; Transitional Provisions ; Savings.

113. The enactments described in the third schedule to this Act are hereby repealed. But this repeal of enactments shall not—

Repeal and saving for past operation of repealed enactments, etc.

- (a.) Affect the past operation of any of those enactments, or any patent or copyright or right to use a trade mark granted or acquired, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act ; or
- (b.) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed ; or
- (c.) Take away or abridge any protection or benefit in relation to any such action or proceeding.

The following cases have been divided under this section, but as its provisions are now or will shortly become inoperative by lapse of time, the cases are not here stated at length.

Singer v. Stassen, 1 R. P. C. 121, 125. *Hayward's Trade Marks*, 54 L. J. Ch. (N.S.) 1003. *Jackson v. Napper*, 35 Ch. D. 162. *Wittman v. Oppenheim*, 27 Ch. D. 260, 266. *Brandon's Patent*, 9 App. Cas. 589. *Jablochkoff's Patent*, [1891] A. C. 293.

114. (1.) The registers of patents and of proprietors kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of patents kept under this Act.

Former registers to be deemed continued.

(2.) The registers of designs and of Trade marks kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of designs and the register of trade marks kept under this Act.

Sect. 115. **115.** All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed (q) altered or amended by the Board of Trade, as if they had been made by the Board under this Act, but so that no such repeal alteration or amendment shall take effect before the commencement of this Act; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act.

Saving for prerogative.

116. Nothing in this Act shall take away abridge or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

A re-enactment of part of s. 16 of the Act of 1852.

The grant of a patent is discretionary in the Crown, and may be stopped at any stage of the proceedings (r).

The Patent Office declines to receive an application from a person resident abroad for an invention being a communication from abroad. See *ante*, p. 8.

Section 4 of the Statute of Monopolies (s), giving a right of action to persons "hindered, grieved, disturbed, or disquieted," by any monopoly or letters patent refers to invalid and improper exercises of the prerogative, and does not refer to letters patent for inventions granted under s. 6 of the same Statute (t).

General Definitions.

117. (1.) In and for the purposes of this Act, unless the context otherwise requires,—

"Person" includes a body corporate :

"The Court" means (subject to the provisions for Scotland, Ireland, and the Isle of Man) Her Majesty's High Court of Justice in England :

(q) This was done by P. R. 1883, r. 78; D. R. 1883, r. 37; T. M. R. 1883, r. 60. These Rules have now themselves been repealed by the Rules of 1890, *post*.

(r) Hindmarch on Patents, p. 17.
(s) 21 Jan. 1, c. 3
(t) *Pech v. Hindes*, 67 L. J. Q. B. 272; 14 Times R. 164.

General definitions.

“ Law Officer ” means Her Majesty’s Attorney-General or Solicitor-General for England : Sect. 117.

“ The Treasury ” means the Commissioners of Her Majesty’s Treasury :

“ Comptroller ” means the Comptroller-General of Patents, Designs, and Trade Marks :

“ Prescribed ” means prescribed by any of the schedules to this Act, or by general rules under or within the meaning of this Act :

“ 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.

In the application of this Act to Ireland, “ summary conviction ” means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District, the Acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.

“ **The Court.** ”—In *Proctor v. Sutton Lodge Chemical Co.* (u), it was held that the Court of Appeal, sitting on appeal from the Vice-Chancellor of the County Palatine of Lancaster, is not a court within the meaning of the Act. But now, by s. 112A, ante, added by the Act of 1888, the Court of Chancery of the County Palatine of Lancaster has, with respect to any action or other proceeding in relation to trade marks, the registration whereof is applied for in the Manchester office, the like jurisdiction under this Act as the High Court of Justice in England. And see also 53 & 34 Vict. c. 23, s. 3, cited under s. 112A, ante, p. 500.

“ **Scotland, Ireland, and Isle of Man.** ”—See ss. 107—112, ante.

(u) 5 R. P. C. 184.

Schedule 1.

SCHEDULES.

THE FIRST SCHEDULE.

Forms of application, etc. (a).

FORM A.—Form of application for Patent.

FORM B.—Form of Provisional Specification.

FORM C.—Form of Complete Specification.

FORM D.—Form of Patent.

Section 33.

VICTORIA, by the grace of God, of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith: To all to whom these presents shall come greeting:

Whereas *John Smith* of 29, *Perry Street, Birmingham*, in the county of Warwick, engineer, hath by his solemn declaration represented unto us that he is in possession of an invention for "*Improvements in Sewing Machines*," that he is the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief:

And whereas the said inventor hath humbly prayed that we would be graciously pleased to grant unto him (hereinafter together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) our Royal Letters Patent for the sole use and advantage of his said invention:

And whereas the said inventor hath by and in his complete specification particularly described the nature of his invention:

And whereas we being willing to encourage all inventions which may be for the public good, are graciously pleased to condescend to his request:

Know ye, therefore, that We, of our especial grace, certain knowledge, and mere motion do by these presents, for us, our heirs and successors, give and grant unto the said patentee our especial license, full power, sole privilege, and authority, that the said patentee (b) by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the

(a) Under the powers given by s. 101 (2), *ante*, p. 490, the Board of Trade have substituted for the forms in this schedule other forms. See Forms A, A1, A2, B, and C, Second Schedule, P. R. *post*; Form E, Second Schedule, D. R. *post*; Form F, Second Schedule, T. M. R., *post*. The forms A, B, and C in the Sche-

dule to the Act are, therefore, not printed here.

(b) In the case of patents granted to two or more persons jointly, the form adopted at the Patent Office uses the word "patentees" throughout for the word "patentee," and interprets the word "patentees" as meaning the grantees, "together

said invention within our United Kingdom of Great Britain and Ireland, and Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage (c) from time to time accruing by reason of the said invention, during the term of fourteen years from the date hereunder written of these presents: and to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, We do by these presents for us, our heirs and successors, strictly command (d) all our subjects whatsoever within our United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent licence or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law for his damages thereby occasioned: Provided that these our letters patent are on this condition, that, if at any time during the said term it be made to appear to us, our heirs, or successors, or any six or more of our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland, and Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid, these our letters patent shall forthwith determine, and be void to all intents and purposes, notwithstanding anything herein-before contained: Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these letters patent, or in respect of any matter relating thereto at the time or times, and in manner for the time being by law provided; and also if the said patentee shall not supply or cause to be supplied, for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our letters patent, and all privileges and advantages whatever hereby granted, shall determine and become void notwithstanding anything herein-before contained: Provided also that nothing herein contained shall prevent the granting of licences in such manner and for such considerations as they may by law be granted: And lastly, we do by these presents for us, our heirs and successors, grant unto the said

Schedule 1.

FORM D.

with their executors, administrators, and assigns," adding the word "successors" when one of the grantees is a company.

(c) As to these words, see *Elmslie v. Boursier*, L. R. 9 Eq. 217; *Van Heyden v. Neustadt*, 14 Ch. D. 232.

(d) These prohibitory words, though addressed only to the subjects of the Crown, are in aid of the grant and not in derogation of it, and therefore form no ground of objection to an injunction against foreigners coming into this country. *Caldwell v. Van-rlissengen*, 9 Ha. 415, 428.

Schedule 1. patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee (c). In witness whereof we have caused these our letters to be made patent this one thousand eight hundred and and to be sealed as of the one thousand eight hundred and .

(Seal of Patent Office.)

Section 47.

FORM E.

Form of Application for Registration of Design.

See now Design Rules, 1890, *post*.

Section 62.

FORM F.

Form of Application for Registration of Trade Mark.

See now Trade Mark Rules, 1890, *post*.

Section 24.

THE SECOND SCHEDULE.

Fees on Instruments for obtaining Patents, and Renewal.

These fees are all included in the list of fees, P. R. 1892 (Second Set), *post*, p. 539, and are therefore not here printed.

Section 113.

THE THIRD SCHEDULE.

Enactments repealed.

21 James 1, c. 3. [1623.]	The Statute of Monopolies. In part; namely,— Sections ten, eleven, and twelve.
5 & 6 Will. 4, c. 62. [1835.] In part.	The Statutory Declarations Act, 1835. In part; namely,— Section eleven.
5 & 6 Will. 4, c. 83. [1835.]	An Act to amend the law touching letters patent for Inventions.
2 & 3 Vict. c. 67. [1839.]	An Act to amend an Act of the fifth and sixth years of the reign of King William the Fourth, intituled "An Act to amend the law touching letters patent for inventions."
5 & 6 Vict. c. 100. [1842.]	An Act to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
6 & 7 Vict. c. 65. [1843.]	An Act to amend the laws relating to the copyright of designs.

(c) See remarks of LINDLEY, L.J., on this clause, *Automatic Weighing Machine Co. v. Knight*, 6 R. P. C. 307.

7 & 8 Vict. c. 69 (a) [1844.] In part.	An Act for amending an Act passed in the fourth year of the reign of His late Majesty, intituled "An Act for the better administration of justice in His Majesty's Privy Council, and to extend its jurisdiction and powers." In part; namely,— Sections two to five, both included.
13 & 14 Vict. c. 104. [1850.]	An Act to extend and amend the Acts relating to the copyright of designs.
15 & 16 Vict. c. 83. [1852.]	The Patent Law Amendment Act, 1852.
16 & 17 Vict. c. 5. [1853.]	An Act to substitute stamp duties for fees on passing letters patent for inventions, and to provide for the purchase for the public use of certain indexes of specifications.
16 & 17 Vict. c. 115. [1853.]	An Act to amend certain provisions of the Patent Law Amendment Act, 1852, in respect of the transmission of certified copies of letters patent and specifications to certain offices in Edinburgh and Dublin, and otherwise to amend the said Act.
21 & 22 Vict. c. 70. [1858.]	An Act to amend the Act of the fifth and sixth years of Her present Majesty, to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
22 Vict. c. 13. [1859.]	An Act to amend the law concerning patents for inventions with respect to inventions for improvements in instruments and munitions of war.
24 & 25 Vict. c. 73. [1861.]	An Act to amend the law relating to the copyright of designs.
28 & 29 Vict. c. 3. [1865.]	The Industrial Exhibitions Act, 1865.
33 & 34 Vict. c. 27. [1870.]	The Protection of Inventions Act, 1870.
33 & 34 Vict. c. 97. [1870.]	The Stamp Act, 1870,— In part; namely,— Section sixty-five, and in the Schedule the words and figures. "Certificate of the registration of a design...£5 0 0. And see section 65."
38 & 39 Vict. c. 91. [1875.]	The Trade Marks Registration Act, 1875.
38 & 39 Vict. c. 93. [1875.]	The Copyright of Designs Act, 1875.
39 & 40 Vict. c. 33. [1876.]	The Trade Marks Registration Amendment Act, 1876.
40 & 41 Vict. c. 37. [1877.]	The Trade Marks Registration Extension Act, 1877.
43 & 44 Vict. c. 10. [1880.]	The Great Seal Act, 1880. In part; namely,— Section five.
45 & 46 Vict. c. 72. [1882.]	The Revenue, Friendly Societies, and National Debt Act, 1882. In part; namely,— Section sixteen.

(a) NOTE.—Sections 6 and 7 of this Act are repealed by the Statute Law Revision (No. 2) Act, 1874.

THE PATENTS, DESIGNS, AND TRADE MARKS
(AMENDMENT) ACT, 1885.

(48 & 49 VICT. c. 63.)

*An Act to amend the Patents, Designs, and Trade Marks
Act, 1883.* [14th August 1885.]

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

Construction
and short
title.

1. This Act shall be construed as one with the Patents, Designs, and Trade Marks Act, 1883 (in this Act referred to as the principal Act).

This Act may be cited as the Patents, Designs, and Trade Marks (Amendment) Act, 1885, and this Act and the principal Act may be cited together as the Patents, Designs, and Trade Marks Acts, 1883 and 1885.

Amendment
of s. 5 of
46 & 47 Vict.
c. 57.

2. Whereas sub-section two of section five of the principal Act requires a declaration to be made by an applicant for a patent to the effect in that sub-section mentioned, and doubts have arisen as to the nature of that declaration, and it is expedient to remove such doubts: Be it therefore enacted that :

The declaration mentioned in sub-section two of section five of the principal Act may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed.

Amendment
of ss. 8, 9,
and 12 of
46 & 47 Vict.
c. 57.

3. Whereas under the principal Act, a complete specification is required (by section eight) to be left within nine months, and (by section nine) to be accepted within twelve months, from the date of application, and a patent is required

by section twelve to be sealed within fifteen months from the date of application, and it is expedient to empower the comptroller to extend in certain cases the said times : Be it therefore enacted as follows :

Sect. 3.
—

A complete specification may be left and accepted within such extended times, not exceeding one month and three months respectively after the said nine and twelve months respectively as the comptroller may on payment of the prescribed fee allow, and where such extension of time has been allowed, a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent ; and the principal Act shall have effect as if any time so allowed were added to the said periods specified in the principal Act.

4. Where an application for a patent has been abandoned, or become void, the specification or specifications and drawings (if any) accompanying or left in connexion with such application, shall not at any time be open to public inspection or be published by the comptroller.

Specifications etc. not to be published unless application accepted.

Notwithstanding this section the court, for the purposes of justice, can allow the specification to be produced, and can look at it. (*f*).

5. Whereas doubts have arisen whether under the principal Act a patent may lawfully be granted to several persons jointly, some or one of whom only are or is the true and first inventors or inventor ; be it therefore enacted and declared that it has been and is lawful under the principal Act to grant such a patent.

Power to grant patents to several persons jointly.

See *ante*, under Act of 1883, s. 5, sub-s. 2, *ante*, p. 5.

6. In sub-section one of section one hundred and three of the principal Act, the words "date of the application" shall be substituted for the words "date of the protection obtained."

Amendment of s. 103 of 46 & 47 Vict. c. 57.

(*f*) *Pneumatic Tyre Co. Ltd. v. The English Cycle, etc. Co.*, 14 R. P. C. 851.

THE PATENTS ACT, 1886.

(49 & 50 VICT. c. 37).

An Act to remove certain doubts respecting the construction of the Patents, Designs, and Trade Marks Act, 1883, so far as respects the drawings by which specifications are required to be accompanied, and as respects exhibitions.

[25th June 1886.]

46 & 47 Vict.
c. 57.

WHEREAS by section five of the Patents, Designs, and Trade Marks Act, 1883, specifications, whether provisional or complete, must be accompanied by drawings if required, and doubts have arisen as to whether it is sufficient that a complete specification refers to the drawings by which the provisional specification was accompanied, and it is expedient to remove such doubts :

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

Short title
and construc-
tion.
46 & 47 Vict.
c. 57.
48 & 49 Vict.
c. 63.

1. This Act may be cited as the Patents Act, 1886, and shall be construed as one with the Patents, Designs, and Trade Marks Acts, 1883 and 1885, and, together with those Acts, may be cited as the Patents, Designs, and Trade Marks Acts, 1883 to 1886.

The same
drawings may
accompany
both specifi-
cations.

2. The requirement of sub-section four of section five of the Patents, Designs, and Trade Marks Act, 1883, as to drawings shall not be deemed to be insufficiently complied with by reason only that instead of being accompanied by drawings the complete specification refers to the drawings which accompanied the provisional specification. And no

patent heretofore sealed shall be invalid by reason only that the complete specification was not accompanied by drawings but referred to those which accompanied the provisional specification.

Sect. 2.
—

3. Whereas by section thirty-nine of the Patents, Designs, and Trade Marks Act, 1883, as respects patents, and by section fifty-seven of the same Act as respects designs, provision is made that the exhibition of an invention or design at an industrial or international exhibition, certified as such by the Board of Trade, shall not prejudice the rights of the inventor or proprietor thereof, subject to the conditions therein mentioned, one of which is that the exhibitor must, before exhibiting the invention, design, or article, or publishing a description of the design, give the Controller the prescribed notice of his intention to do so :

Protection of
patents and
designs
exhibited at
international
exhibitions.

And whereas it is expedient to provide for the extension of the said sections to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows :

It shall be lawful for Her Majesty, by Order in Council, from time to time to declare that sections thirty-nine and fifty-seven of the Patents, Designs, and Trade Marks Act, 1883, or either of those sections, shall apply to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions, specified in the said sections, of giving notice to the Controller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as to Her Majesty in Council may seem fit.
