

they are printed in the Act, as alternatives, and that the word *Somatose*, a compound of the Greek *σωμα* (body) with the common affix *ose*, could not be registered as a trade-mark for a chemical food described by the applicants as "a preparation . . . which can easily be absorbed and taken up into the human body."

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

Words having no reference to character or quality of goods.

The question under this clause is not whether the word which it is sought to place or retain on the register has in fact any reference to the character or quality of the goods, but whether it has it in appearance. For if it have, it must be either descriptive or deceptive, and in either case it is not entitled to be on the register (t). The clause seems to be equivalent to the phrase "obviously meaningless" in the decisions on the earlier Act (u), but apparently its explicit statement as to what is necessary gets rid of the requirement of an "innate and inherent character of fancifulness" (x), which, after those decisions, was the most indefinite branch of the exposition of the expression "fancy word" (y).

Old Marks.

By sect. 64 (3) (ii.) (z):

Old marks.

"Any special and distinctive word or words, letter, figure (a), or combination of letters or figures, or of letters and figures, used as a trade-mark before the

(s) See clause (d) above; and, as to geographical names, see above, pp. 147 to 149.

(t) *Edge's Tm.*, 8 R. P. C. 207 (1891), *Filtered Blue*, Stirling, J.

(u) See the Report of Lord Herschell's Committee upon which the amendment was made, above, p. 141.

(x) See the judgment of Lopes, L.J., in *Van Duzer's Tm.*, 34 C. D., p. 644, cited above, p. 143.

(y) Mr. Sebastian says: "This seems designed to include such terms as *Pharaoh's Serpents* toys, *United Service* soap, and *Charter Oak* stoves," 3rd ed. p. 48. In my opinion, the second of these examples, and probably the first also, is descriptive.

(z) Act of 1888, sect. 10.

(a) *Figure* means numeral, per Jessel, M.R., in *Exp. Stephens*, 3 C. D. 659 (1876).

“13th day of August, 1875 (*b*), may be registered as a trade-mark under this part of this Act.”

This clause is co-ordinate with the clauses (a) to (e) of sub-section (1). It is taken verbatim from the Act of 1883. Provision was made in the original Act for the registration of old marks. The clause corresponding to the present clause in that Act was as follows:

Special and distinctive.

“Any special and distinctive word or words, or combination of figures or letters used as a trade-mark before the passing of this Act may be registered as such under this Act” (*c*).

The amendment (letter, figure) was made in consequence of the decision that, under the sub-section as it originally stood, a single letter, although an old mark, could not be registered (*d*). It was the intention of the Act to allow to be registered anything which was protected as a trade-mark under the old law, and could not be registered under the other clauses of the section (*e*).

The requirement that the mark shall be “special and distinctive” only embodies the old law (*f*). *Special* means of such a character that the mark “separates the article to which it is applied from all others of the same class or character; something which points out the article as standing alone, which makes the man who sees or reads the word understand that the article has a special standing, a special existence, and is not one of the general class, for instance, of pianos, but belongs to a class of a particular character” (*f*). *Distinctive* means that the mark is a distinctive thing which points out that the goods are the goods of A. B. (*g*). Thus, in *The Eton Cigarette Case*, Fry, L.J., said: “It appears to me, that to satisfy the requirement of

(*b*) Date of commencement of the Act of 1875.

(*c*) Act of 1875, sect. 10.

(*d*) *Mitchell's Tm.*, 7 C. D. 36 (1877), Hall, V.-C., *A*, for steel pens.

(*e*) *Barrows' Tm.*, 5 C. D. 353 (1877), per Malins, V.-C.; *Bodega Co. v. Owens*, 6 R. P. C. 241, Chat-

erton, V.-C., (1888), in Ireland.

(*f*) *Re Hopkinson's Tm.*, (1892) 2 Ch. 116; 9 R. P. C. 102, Kekewich, J.; see as to this, *ante*, p. 119.

(*g*) *Richards v. Butcher*, (1891) 2 Ch. p. 536; 8 R. P. C. 249, Kay, J.; and *per* Halsbury, L.C., in *Perry, Davis & Son v. Harbord*, 16 App. Cas. p. 320; 7 R. P. C. 336 (1890).

“(this) definition the word or words must be distinctive in this sense, that they distinguish the manufacture of the person who has registered the trade-mark from the manufacture of all other persons” (h).

The decisions on the word distinctive, where it occurs in the earlier part of the section, have been already considered (i).

Where, therefore, a cigarette manufacturer had registered the word *Eton* as an old mark, but had sold the cigarettes in boxes bearing the words *St. Petersburg—P. Mavrogordato & Co.*, as well as *Eton*, thereby suggesting to purchasers that the goods were not of his manufacture, but were made in Russia, although the mark was known in the trade as, in fact, indicating his manufacture, it was held that he was not entitled to have it registered, and it was accordingly ordered to be removed (h).

Deceptive mark not distinctive.

It follows that words which were merely descriptive of the goods to which they are applied cannot be registered as old trade-marks under the clause, for, in fact, they could not be trade-marks at all (k). So, where fusees were manufactured under a patent which expired in 1881, and were called *braided fixed stars*, *fixed stars* being a common name for fusees, and *braided* descriptive of the process by which the particular goods were manufactured, and the words were registered as an old mark in 1877, they were ordered to be removed from the register, on this as well as on other grounds (l).

Descriptive words.

Before the Acts words which were *prima facie* descriptive might be acquired as trade-marks, if, by use as such, in connection with the goods of a particular trader, they, in fact, acquired a secondary distinctive meaning distinguishing the goods as his (m); and such words may still be so acquired as a “common law trade-mark” apart from

Words with a secondary distinctive meaning.

(h) *Wood v. Lambert*, 32 C. D. p. 262; 3 R. P. O. 81 (1886).

(i) *Palmer's Tm.*, 24 C. D. 504 (1882), C. A.; and see the cases cited below.

(j) Above, pp. 119 *et seq.*

(k) See Chap. II., pp. 35 *et seq.*, and pp. 127, 131.

(m) See Chap. II., p. 36.

registration (n). And it is submitted that wherever such words have been used and acquired as trade-marks before the 13th of August, 1875, they are "special and distinctive," and therefore capable of registration within the clause.

This was directly decided by Kekewich, J., in a recent case (o), where he held the words *J. & J. Hopkinson*, printed in ordinary type, to be "special and distinctive," and to be properly registered as an old mark. "In order to protect a trade-mark before the Act," he said, "you were obliged to prove by evidence and satisfy the Court that the words used as a trade-mark were known in the market, and, to use Lord Westbury's expression in *Leather Cloth Co. v. American Leather Cloth Co.* (p), gave a 'vendible' character to the articles to which they were attached, made those articles recognized as coming from a particular manufactory, and so gave them a character different from that of every other article in the trade. Therefore, it seems to me, that the Legislature in the Act of 1875 did no more than adopt the language of the cases, by reducing them into a compressed form, and say really that what the Court would have held to be a trade-mark independently of the Act should now be capable of registration as a trade-mark under the Act, provided only that the mark had been used as a trade-mark before the passing of the Act." And this accords with the opinions expressed by several other judges (q). The *Monopole* case was discussed (r), on the assumption that the word, though in

(n) *Reddaway v. Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9 R. P. C. 503, C. A., (*Camel Hair Belting*).

(o) (1892) 2 Ch. 116; 9 R. P. C. 102.

(p) Above, p. 47.

(q) *Malins, V.-C.*, in *Barrow's Tm.*, 5 C. D. 353. (1877); and *Porter, M.R.*, in *Watt v. O'Hanlon*, 4 R. P. C. p. 15 (1887); and *Chatterton, V.-C.*, in *Bodega Co.*

v. Owens, 6 R. P. C. 241 (1888), both Irish cases. In *Leonard & Ellis's Tm.*, 26 C. D. p. 295 (1884), Lord Selborne said: "As to the word *Valvoline*, I, for my part, am 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 it might have been registered under the Act." See also p. 158, note (y).

(r) *Fry, L.J.*, expressly reserved

itself descriptive, could be registered if it were shown to have been used before the Act of 1875 as a trade-mark; and in the *Stone Ales* (s) case, the only ground upon which the Court of Appeal proceeded in removing the mark *Stone Ale* was the want of proof of such user.

On the other hand, in *Perry, Davis and Son v. Harbord* (t), the question was treated as an open one by two of the Lords Justices, for Fry, L.J., said: "It is not necessary now to inquire whether the words must be special and distinctive from their own proper nature and internal force *ex vi terminorum*, or whether they may acquire a distinctive character by user as applied to the goods"; and Lopes, L.J., made use of similar language, and added: "Speaking for myself, I should be inclined to think (the word tendered for registration as an old mark) must be inherently special and distinctive" (u). And on the further appeal, Halsbury, L.C., and Lord Morris held that the words in question in the case, *Pain Killer* for a medicine, were not special and descriptive; the Lord Chancellor, on the ground that they were descriptive of a quality attributed to the goods to which they were applied (x). This decision is not in conflict with the conclusion stated above, for there was no finding or evidence that the medicine of the plaintiffs was distinguished from the same medicine made by others by the use of the words *Pain Killer*; on the contrary, it appeared that there was no competition in its manufacture. It seems, therefore, that the present state of the law is that laid down by Kekewich, J., in the case cited above, and this is, it is submitted, the proper construction of the Act.

So a geographical word may be registered if it was used

this question, *Richards v. Butcher*, (1891) 2 Ch. p. 547; 8 R. P. C. 249, Kay, J., & C. A.

(s) Page 159, note (b).

(t) 5 R. P. C. 333, Kay, J., & C. A. (1888); and 15 App. Cas. 316; 7 R. P. C. 336, H. L.

(u) The question was also referred to by Kay, J., in *Grossmith's Tm.*, 6 R. P. C. 180; 60 L. T. 612 (1889), (*Emollio Cream*).

(x) Cf. the *Nourishing Stout Case*, *Raggett v. Findlater*, L. R. 17 Eq. 29 (1873), Malins, V.-C.

as a trade-mark and had acquired a secondary distinctive meaning before the 13th of August, 1875 (*y*).

Examples of
old word-
marks.

The following words have been held not to be special and distinctive words: EMOLLIO cold cream, *Grocsmith's Tm.*, 6 R. P. C. 180; 60 L. T. 612; BAFFLE safes, *Talbot v. Webley*, 3 R. P. C. 276; PERRY-DAVIS' VEGETABLE PAIN KILLER, *Perry, Davis v. Harbord*, 15 App. Cas. 316; 7 R. P. C. 336.

And the following have been admitted to registration as such: FRIGIDOME, for a hot-house plant wrap, *Edgington's Tm.*, 6 R. P. C. 513; 61 L. T. 323; FAMILY SALVE, *Reinhardt v. Spalding*, 49 L. J. Ch. 57; EXCELSIOR SPRING MATTRESS, *Chorlton and Dugdale's Tm.*, 53 L. T. 337; J. & J. HOPKINSON (for pianos), *Hopkinson's Tm.*, (1892) 2 Ch. 116; 9 R. P. C. 102.

Used as a trade-mark.

Used as a
trade-mark.

What is use as a trade-mark has already been considered in Chapter II. The following paraphrase by Lord Esher (*s*) of the judgment of the Court of Appeal in *Palmer's Case* (*a*) sums up the rules there stated: "Let us see what was used in the trade, and let us see whether any article was ever in the market made by these people with these words only on them. If we find these words on goods in the market, which are said to be distinguishing marks on the goods, and on the same goods other marks, and never on any goods these words alone, then the conclusion of fact is that what was used upon the goods to distinguish them was all that was on the goods; and we are not going to enquire whether part of what was put on all the goods to distinguish them was at one end of the goods or at the other end of the goods, or whether they were an inch or half an inch apart, or even whether part was at the top

(*y*) See the judgments of Cotton, L.J., in *Van Duzer's Tm.*, 34 C. D. p. 635; 4 R. P. C. 31 (1887); and of Kay, J., in *Compagnia General de Tabacos v. Rehder*, 5 R. P. C. 61

(1887), (*Cavité*).

(*s*) *Spencer's Tm.*, 3 R. P. C. p. 74; 54 L. T. 659 (1886).

(*a*) 24 C. D. 504 (1883), (*Braided Fixed Stars*).

“and lapping over the side, or whether part was on one side and part on the other. If you find that they are on goods for the purpose of distinguishing the goods, that makes the user one user.”

In accordance with these principles, it has been held that words used only as a description of the goods (*b*), for instance, in ordering them from the applicant, are not used as trade-marks, and that a device employed as a pattern or design mark (*c*) is not so used either.

So also it has been considered that the use of words upon rough packing-cases containing bottles of wine (*d*), or sauce (*e*), or upon the side of a wine cork where they cannot be seen (*ee*), is not a use of them as a trade-mark, since it does not “sell the goods” (*f*), although in some cases, for example, where the goods are cigars, soap, or the better classes of candles, the trade-mark may be, and almost invariably is, put not upon the goods themselves, but on the boxes which contain them (*e*). But in such cases the boxes go into market and are bought with their contents by the purchasers, to whose attention the marks are directed.

Use on bottles or boxes only.

The use by the applicant of a trade-mark other than and distinct from the marks which he is seeking to place or maintain on the register as an old mark is a circumstance to be considered in determining whether he used the mark in question as a trade-mark, but it is not conclusive that he did not, for traders often have numerous trade-marks and they not infrequently use two or more of them on the same goods at once (*g*).

Where the applicant has another trade-mark.

(*b*) *Hayward's Tm.*, 54 L. J. Ch. 1003 (1885), Kay, J., (*Coker Canned*); *Talbot v. Webley*, 3 R. P. C. 276 (1886), Bacon, V.-C., (*Baffle Safes*); *Montgomery v. Thompson*, 41 C. D. 35; 6 R. P. C. 404 (1889), C. A., (*Stone Ale*); *Powell's Tm.*, (1893) 2 Ch. 388; 10 R. P. C. 63, 195 (*Yorkshire Relish*), Chitty, J., and C. A., aff. by H. L. (1894), A. C. 8.

691; 7 R. P. C. 25 (1889), Kekewich, J., (*Albion*).

(*d*) *Richards v. Butcher*, (1891) 2 Ch. 522; 8 R. P. C. 249, Kay, J., and C. A.

(*e*) *Powell's Tm.*, *supra*.

(*ee*) *Kinahan's Tm.*, 10 R. P. C. 393, above, p. 30.

(*f*) Chap. II., p. 30.

(*g*) *Powell's Tm.*, (1893) 2 Ch. pp. 394, 406, 411; 10 R. P. C. 63

(*e*) *Harrison's Tm.*, 42 C. D.

Old mark must have been used as registered, and alone.

And, as stated in the passage quoted above (*h*), the mark sought to be registered must have been used, in the form in which it is offered for registration (*i*), and alone (*h*), as a trade-mark before the 13th of August, 1875. So that words taken out of a label which was an old trade-mark (*l*), and words which had been used as a trade-mark when combined with a device (*m*), or with the name of the proprietor (*n*), or with other words (*o*), and which were not shown to have been separately used as trade-marks, apart from the other matter, have been refused registration or removed from the register.

Use for the same goods.

The mark must, moreover, have been used as a trade-mark for the class of goods in respect of which it is to be registered (*p*), for it is only an old mark in respect of them; and if registration is applied for in other classes the application, so far as regards such other classes, must be treated on the footing that the mark was not used before the 13th of August, 1875 (*q*). But use on goods essentially the same as those in the class to which the

& 195; (1894) A. C. 8, Chitty, J., C. A. & H. L., (*Yorkshire Relish*); *Richards v. Butcher*, (1891) 2 Ch. 522; 8 R. P. C. 249, Kay, J., & C. A., (*Monopole*); *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. C. 523; 35 L. J. Ch. 53 (1865).

(*h*) Page 158.

(*i*) *Mccus' Application*, (1891) 1 Ch. 41; 8 R. P. C. 25, Chitty, J., (*Key Brand Geneva*); *Fuente's Tm.*, (1891) 2 Ch. 166; 8 R. P. C. 214, Romer, J., both combination marks. As to the alteration of an old mark under sect. 92, see Chap. XI., p. 248.

(*k*) *Spencer's Tm.*, 3 R. P. C. 73; 54 L. T. 659 (1886), Chitty, J., & C. A., and the cases next cited.

(*l*) *Palmer's Tm.*, 24 C. D. 504 (1888), C. A., (*Braided Fixed Stars*); and see *The Stone Ale* and *Yorkshire Relish Cases*, *supra*.

(*m*) *Spencer's Tm.*, *supra*, *Diamond Cast Steel* combined with a cutler's mark; *Leonard & Ellis' Tm.*, 26 C. D. 288 (1884), Pearson, J., & C. A., (*Valvoline*).

(*n*) *Richards v. Butcher*, (1891) 2 Ch. 522; 8 R. P. C. 37, 249 (1891), Kay, J., & C. A., *Monopole*, with *Haidsieck & Co.*

(*o*) *Perry, Davis v. Harbord*, 15 App. Cas. 316; 5 R. P. C. 333; 7 R. P. C. 336 (1888), Kay, J., C. A. & H. L., (*Perry-Davis Vegetable Pain Killer*).

(*p*) Chap. V., p. 87.

(*q*) *Jelley, Son & Jones' Application*, 51 L. J. Ch. 639 n.; 46 L. T. 381 n. (1878), Jessel, M.R.; and see *Leonard & Ellis's Tm.*, 26 C. D. 288 (1884), C. A., cited p. 139; *Harrison v. Woodroffe*, 42 C. D. 691; 7 R. P. C. 25 (1889), Kekewich, J.

application relates, although they pass under a different name, owing to slight variations in size or shape, is sufficient to qualify a mark as an old mark. Thus a mark used on hatchets and augers has been admitted as an old mark for axes and gimlets (r).

The use must have been use as a trade-mark in the United Kingdom (s), and mere importation into a British port for the purpose of reshipment and transportation is not sufficient (s). Use in the United Kingdom.

User which was commenced and continued in fraud of the rights of the owner of another trade-mark cannot qualify a mark for registration (t). The registration of the mark in such case would, besides, almost necessarily be within the prohibition of sect. 72 or sect. 73, as calculated to deceive. Fraudulent user.

The owner of an old trade-mark does not lose his title to register by merely ceasing to use it for a time (u), provided that the cessation of user does not amount to abandonment (v), or because other traders have infringed his right (x), unless the infringements have been so extensive as to make the mark common (v). Temporary cessation of user.

Slight evidence of user as an old mark will be accepted, it is said, even the production of a single label (y), at any rate after the mark has been registered and used for a long Slight evidence of user sufficient.

(r) *Jackson & Co. v. Napper*, 35 C. D. 162; 4 R. P. C. 45 (1886), Stirling, J.

(s) *Meeus' Application*, (1891) 1 Ch. 41; 8 R. P. C. 25, Chitty, J.; *Monck's Application*, 50 L. T. 12 (1884), Chitty, J. In *Jackson & Co. v. Napper*, 35 C. D. p. 177; 4 R. P. C. 162, Stirling, J., said: "You must make out user in England"; but the learned judge probably used the name of the only part of the United Kingdom in which user had been suggested, without intending to exclude user in Scotland or Ireland. The question whether foreign user was

sufficient was raised as early as *Leonard & Ellis's Tm.*, 26 C. D. 288 (1884), C. A.

(t) *Heaton's Tm.*, 27 C. D. 570 (1884), Kay, J., (*Hoop L Iron*); *Monck's Application*, note (s).

(u) *Mouson v. Boehm*, 26 C. D. 398 (1884), Chitty, J., cited p. 325.

(v) Chap. XIV., p. 283.

(x) See *Heaton's Tm.*, *supra*.

(y) *Chorlton & Dugdale's Tm.*, 53 L. T. 337 (1888), Pearson, J.; *Palmer's Tm.*, 21 C. D. 47; 24 C. D. 504 (1882), Chitty, J., & C. A. The usual evidence is the production of old prints and dies or blocks for printing.

time. And where a mark has stood upon the register unchallenged for years, and important witnesses have died who might have given evidence of qualifying user before 1875, the Court accepts evidence of non-user put forward by any one who seeks to procure the removal of the mark from the register, with considerable hesitation (z).

Colour.

By sect. 67—

Trade-marks
may be
registered in
any colour.

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

This provision was introduced by the Act of 1883, and the words “or colours” were added in 1888. Under the Act of 1875 colours could not be registered (b).

Registration
in colours.

A trade-mark propounded for registration in colours must, however, be distinctive within the meaning of sect. 64, independently of the colours (c). An oblong label divided into three sections, which were respectively printed in red, white, and blue, was accordingly held not to be distinctive (d). Colour, said Kay, J., is treated as an accident, and if the mark were registered the applicant might use it in any colours he chose. “You may register a mark, which is otherwise distinctive, in colour, and that gives you the right to use it in any colour you like; but

(z) *Edgington's Tm.*, 6 R. P. C. 513; 61 L. T. 323 (1889), Kay, J.

(a) Act of 1888, sect. 11.

(b) See *Robinson's Tm.*, 29 W. R. 31 (1880), Jessel, M.R. The decision that a gold coin mark could not too nearly resemble a silver coin mark in this case, is inconsistent with the later authorities cited below.

(c) See above, p. 129.

(d) *Hanson's Tm.*, 37 C. D. 312; 5 R. P. C. 130 (1887), Kay, J. But the same mark, registered without colours, i.e., as a label with three parallel stripes and the words *red, white and blue*, had been protected from infringement by the use of a similar coloured label comprising the same words, *Hanson v. British Tea, &c. Association* (1884), Bacon, V.-C., & C. A.; Sebastian, 3rd ed. p. 368.

“you cannot register a mark of which the only distinction is the use of a colour, because, practically, under the terms of the Act, that would give you a monopoly of all the colours of the rainbow.”

The difficulties of registration in connection with mere colour marks, such as the line headings for cotton piece goods are referred to in the earlier part of the chapter (*e*).

The colours in which a mark is actually used, or is likely to be used, have often a material bearing upon questions of alleged resemblance calculated to deceive, or of infringement (*f*); for instance, a design similar in outline to that of the device in another mark, but filled up in a totally different manner, may have the distinctive filling up observed by the use of a deep colour in printing (*g*). And in a recent case the words *red star brand* were directed to be removed from the register on the ground that they constituted a mark having such resemblance to a star device mark, which was coloured red in actual use, as to be calculated to deceive (*h*).

Bearing of colour upon the resemblance of marks.

In some cases marks have been allowed to be entered or retained on the register upon the proprietors undertaking to use them in particular colours only, a note of the undertaking being placed on the register (*i*).

(*e*) Above, p. 136.

(*f*) *Mitchell v. Henry*, 15 C. D. 181 (1880), C. A.; *Turney and Sons' Tm.*, 11 R. P. C. 37 (1893), North, J.

(*g*) *Worthington's Tm.*, 14 C. D. 8 (1880), C. A.; *Biegel's Tm.*, 4 R. P. C. 525; 57 L. T. 247 (1887), Chitty, J., *Turney and Sons' Tm.*, *supra*.

(*h*) *Société, &c. de l'Etoile's Tm.*, (1894) 1 Ch. 61; (1894) W. N. 42; 10 R. P. C. 436; 11 R. P. C. 142; Stirling, J., and C. A.

(*i*) *Re Jeffrey & Co.*, 18 May, 1888, Stirling, J., registration allowed with note binding applicants not to use mark in black, or any colour so dark as to resemble black; *Re Johnson, Philpott & Co.*, 21 Feb. 1888, North, J., register rectified by consent, by adding note that the proprietor was only to use his mark in blue and white. Both cases are cited Sebastian, 3rd ed. p. 368.

CHAPTER IX.

ADDITIONS AND DISCLAIMERS.

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It is provided by sect. 64 of the Act (*a*) that a trade-mark for registration under the Act must consist of, or contain, one at least of the essential particulars enumerated in that section. It is not, however, necessarily confined to such essential particulars, but it may comprise other matter also, as, for instance, statements of quality or price (*b*), or descriptive or ornamental matter, and most trade-marks do, in fact, comprise some such additions to the parts of the marks which are claimed and protected as their essential particulars. All the Acts have provided for such

(*a*) Chap. VIII., p. 106.

(*b*) Cf. sect. 66, series of marks, above, p. 90.

additions; the provision in the present Act (*c*), which, with immaterial verbal changes, is the same as the corresponding sections of the Acts of 1875 (*d*) and 1883 (*e*), being in the following terms:—

“There may be added to any one or more of *these* Additions. [the essential] particulars [mentioned in this section] any letters, words, or figures (*ee*), or combination of letters, words, or figures, or any of them” (*f*).

Remarking upon this provision, Lord Herschell's Committee reported as follows (*g*):—“It is said, and we think truly, that it is not easy to understand what is the exact status of the added matter provided for by sect. 64. Where the added words are not common to the trade in the goods with respect to which the application is desired, the right of exclusive user need not be disclaimed (*h*), yet it is presumed that the proprietor of the trade-mark could not object to their use by any other person except in connection with the essential particular of his trade-marks. What purpose then do they serve? Perhaps they may be useful in the case of a colourable imitation of the essential particular. If, with such an imitation, the added words were used, it would assist the proprietor in establishing that his trade-mark had been infringed. But the added matter may, it is assumed, be of so distinctive a character as to form an essential part of the trade-mark so that its use might be an infringement. We think it would clearly be desirable that the added matter, which the proprietor does not claim the exclusive use of, should be disclaimed, so that the public may know exactly what is the trade-mark registered. We think, too, that all disclaimers should appear in connection with the mark in the official journal.”

Lord Herschell's Committee on additions and disclaimers.

(*c*) Sect. 64 (2), Act of 1888, s. 10.

(*d*) Sect. 10.

(*e*) Sect. 64 (2).

(*ee*) “Figures” here means numerals, *Exp. Stephens*, 3 C. D. 659 (1876); Jessel, M.R.

(*f*) The word in italics was repealed, and the words in brackets

were added by the Act of 1888, which added also to the sub-section the provision for identification of essential particulars and disclaimer of additions referred to below.

(*g*) Report of 1888, p. xii.

(*h*) That is, of course, under the Act of 1883, as unamended.

In consequence of this recommendation, what is now the latter part of sect. 64 (2), and also sect. 64 (3) (i) were added by the Act of 1888. The former provides that—

Disclaimers to be included in the application to register.

[“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.”]

Disclaimers in respect of additions which are *prima facie* distinctive, but are in fact common to the trade in question, were already required by the Act of 1883, and they are dealt with by a separate section of the Act, sect. 74, which is set out below.

The reason for requiring the essential particulars of a mark tendered for registration to be identified, and the remaining matter contained in it to be disclaimed is, then, that the exact status of the latter may be defined. It is an advantage to traders to have the whole trade-mark, with all the common marks and words, the descriptive additions and the other added matter, if any, all reproduced upon the register as it is printed when the trade-mark is in actual use (*l*); and, on the other hand, it is material that the public should know what parts of the mark as registered may be lawfully used by others than the proprietor. The statement and disclaimer are also of service to enable the comptroller and the Court to more readily determine whether a mark which it is sought to place upon, or to remove from, the register does or does not comply with the requirements of sect. 64.

The “essential particulars” of a registered trade-mark are not necessarily all its distinctive parts.

It is necessary to guard against a possible confusion which may arise from the use of the words “essential particulars” with somewhat different meanings in connection with trade-marks. All the material and distinctive parts of a trade-mark, and all its prominent features are sometimes spoken of as its essential particulars, and these may include items which do not fall within the list

(*l*) See *Kuhn & Co.’s Tm.*, 53 L. J. Ch. 238 n. (1878), Jessel, M.R.

of symbols in sect. 64 (1) ; for instance, they may comprise words which, although distinctive, are not capable of registration under sect. 64 (1) (d), or sect. 64 (1) (e). It follows, however, from the sub-section set out above, that all the items of a composite trade-mark which are not referable to any of the classes enumerated in the list contained in the Act, are to be treated as "added matter," and that no exclusive rights in regard to such items are conferred by the registration. Of course, the trade-mark may, as a whole, fall into one of the classes—for example, as a distinctive label or an old mark.

The provision that the statement and disclaimer shall be contained in the application is not merely directory. It cannot be waived by the Court on an appeal from the comptroller (*l*). The cases cited were both decided on sect. 74, and in respect of applications made before the Act of 1888 came into operation ; but the terms of sect. 74 and sect. 64 (2), as amended by the last-mentioned Act, correspond, and the same construction will, no doubt, be put upon them in the latter section as in the former.

Disclaimer on appeal.

It is further provided by sect. 64 (3) (i) 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"] (*m*).

The proprietor need not disclaim his own name.

This provision was also added by the Act of 1888. A trader has, as is shown elsewhere (*n*), a right to the exclusive use of his own name, limited by the rights of other traders to honestly use their own names, or the names which they honestly adopt. This exists independently of the law of trade-marks, and the report of Lord Herschell's Committee

Trade-name.

(*l*) *Goodall's Tm.*, 42 C. D. 566 (1889), North, J. ; *Re Mecus' Application*, (1891) 1 Ch. 41 ; 8 R. P. O. 25, Chitty, J. As to the comp-

troller's power of amendment, see Chap. IV., pp. 70 and 76.

(*m*) Act of 1888, s. 10.

(*n*) See Chap. XVI., p. 392.

Effect of the registration of a trade-name as part of a trade-mark.

in reference to the present clause, shows that it was intended to leave such right unaffected. The Committee say, "Some misapprehension might perhaps arise if the person registering the mark were compelled to disclaim his own name, or the foreign equivalent of it. We think, therefore, this might be excluded from the necessity of disclaimer; but it should be provided that the proprietor of the mark should not thereby acquire the right to prevent any other person *bonâ fide* using his own name in connection with his goods." It will be observed that the restriction arising out of the saving clause is more limited than the restriction which a disclaimer, if registered, would create. At common law, as already stated, a trader can only be prevented from using a name similar to that of another trader if he uses it so that his business would in the ordinary course of human affairs be likely to be confounded with that of the other (*o*); and if he is honestly using his own name, he cannot be interfered with at all. Under the Act, however, if the name or the description of the place of business registered as parts of the trade-mark are material parts, it is presumed that section 76 would confer on the proprietor exclusive rights to the use of the name and description under all circumstances, save only as against an owner of the same name, and, of course, only for use in connection with the goods for which the mark is registered (*p*).

Descriptive trade-name.

Name in possessive case.

It has been held under this proviso that a company need not disclaim common words which describe the article it deals in, and which appear upon its trade-mark, if they form part of its name and appear on the mark as such (*q*). And that the applicant's name in the possessive case occurring in a label need not be disclaimed either (*qq*).

(*o*) *Hendriks v. Montagu*, 17 Ch. D. 638 (1881) C. A.; and see *Tussaud v. Tussaud*, 44 C. D. 678 (1890), Stirling, J., and the cases there cited. See also Chap. XVI., p. 392.

(*p*) See Chap. XII., p. 255.

(*q*) *The Smokeless Powder Co.'s Tm.*, (1892) 1 Ch. 590; 9 R. P. C. 109, Chitty, J.

(*qq*) *Colman's Tm.*, (1894) W. N.

Additions are further provided for by sect. 74 of the Act of 1883, which deals with additions "common to the trade" in the goods with respect to which the registration is made. Additions which are common to the trade.

The section is in the following terms :

"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 13th day of August, 1875—

"Any distinctive device, mark, brand, heading, label, ticket, letter, word, or figure (*r*), 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 ; Common addition to old mark ;

"(b) In the case of an application for registration of a trade-mark not used before the 13th day of August, 1875— to new mark.

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

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

"[(2.) The applicant for registration of any such addition must, however, state in his application the essential particulars (*rr*) of the trade-mark, and must disclaim in his application any right to the exclusive Disclaimer.

30; 11 R. P. C. 129, Stirling, J., (*Colman's mustard*), cf. clause 64 (1) (a), above, p. 115. As to common words in a distinctive label,

see p. 172, below.

(*r*) *i. e.*, numeral, p. 165, n.

(*rr*) See p. 166, above.

“ 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.] (s)

The three
mark rule.

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

Sub-sect. (2) of the original section was replaced by the present sub-sect. (2) in order to bring the requirements of this section into accord with the corresponding provisions of sect. 64 as amended, which are in the same words.

The registra-
tion of com-
mon words in
a trade-mark
confers no
monopoly.

Under the Act of 1875, the disclaimer of common additions could not be forced upon an applicant who refused to consent to it as a condition of registration (t), although the fact of registration gave him no right to the exclusive use of them (u), and the present section was, no doubt, introduced in order that the register might be made to show that the additions were not appropriated by the registration.

Common
additions to
old and to
new marks.

It will be seen that the section distinguishes between old marks used before the 13th of August, 1875, and new marks first used since that date. As to the former, the policy of the Act is to put them upon the register exactly as they were used (x); and accordingly, while the addition

(s) Act of 1888, s. 16, above, p. 167.

(t) The register might have been rectified by placing a disclaimer upon it. See *Re Hayward's Tm.*, 54 L. J. Ch. 1003 (1885), Kay, J.

(u) *Hudson's Tm.*, 32 C. D. 311; 3 R. P. O. 155 (1886) O. A., decided upon the Act of 1875, though after that of 1883 was passed.

(x) *Phillip's Tm.*, (1891) 3 Ch.

authorized for new marks by the section is confined to "any distinctive word or combination of words," that authorized for old marks is "any distinctive device, mark, brand, heading, label, ticket, word, or figure, or combination of letters, words, or figures." So that while, apparently, the section adds nothing to what is allowed to be registered by sect. 64 (2) as an addition, namely, "any letters, words, or figures, or combination of letters, words, or figures, or of any of them," in the case of new marks, it considerably increases the list in the case of old marks.

The section is expressed to apply only to additions which are distinctive, but as those which are really distinctive (*y*) cannot be at the same time "common to the trade," distinctive must here mean *prima facie* distinctive (*z*), that is to say, the section applies to additions which would be distinctive if they were not common to the trade.

Distinctive means *prima facie* distinctive.

"Common to the trade" does not mean merely "commonly used in the trade," but "open to the trade to use," so that a word which has been once largely used in the trade, but has subsequently fallen out of use by all but one or two persons (*a*), or a word which is descriptive of the goods to which the mark is to be applied (*b*), if *prima facie* distinctive, must be disclaimed under the section. Of course, any word may lawfully be used by any trader until it has been appropriated by use or registration as a trade-mark, so that the statements in the cases just cited must be taken to mean that words, &c., which might lawfully be, and have been, used by traders other than the applicant for registration, or his predecessors in title, or which are incapable of appropriation—as descriptive words are—

Common to the trade.

Words used by one trader only.

139; 8 R. P. C. 469, Chitty, J.; *Henry Clay & Co.'s Tm.*, (1892) 3 Ch. 649; 9 R. P. C. 449, Kekewich, J. Under the Act of 1875, the descriptive words *Filtre Rapide* were allowed to be registered, with a signature; *Maignen's Tm.*, 28 W. R. 759 (1880), Jessel, M.R.

(*y*) See Chap. VIII., p. 122. The word refers back to sect. 64, see

the next case.

(*z*) *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J., (*Washerine*).

(*a*) *Burland v. Broxburn Oil Co.*, *supra*.

(*b*) *Humphries v. The Taylor Drug Co.*, 59 L. T. 820 (1888), Kekewich, J., (*Herbalin*).

are "common to the trade." And this accords with the view expressed in the Court of Appeal in *Thompson v. Montgomery*, that the words *Stone Ale* having never been used by any trader other than the trader who claimed them as a trade-mark, were not common to the trade (c). Lindley, L.J., said in that case: "Nothing, I apprehend, can be common to the trade, which is only used by one person in the trade."

The three
mark rule.

It was held also in *The Washerine Case* that the phrase in question is not limited by the three mark rule of subsect. (3). That sub-section contains a rule for the particular case to which it refers, not a definition. "It might have been a question whether user by three or four, or five or six persons would have made a word or combination of words common to the trade, and the proviso is introduced merely for the purpose of settling that question, which might have been a difficult one of fact, and saying that where you have user in the trade by more than three persons, then the name so used shall be deemed to be common to the trade" (d). The three mark rule was originally introduced by the Commissioners of Patents, but it was repeatedly recognized by the Courts before the present Act was passed (e). It applies whether the marks used by the three persons are precisely, or only substantially, similar, and whether they have been used as trade-marks or otherwise, provided that they have been used on the same or a similar description of goods (e). But use abroad does not fall within the rule (f).

Common
words in a
distinctive
label need not
be disclaimed.

Words comprised in a distinctive label, which are common to the trade within the meaning of the section, need not be disclaimed (g), although Cotton, L.J., seems to have

(c) 41 C. D. 35; 6 R. P. C. 404 (1889).

(d) *Per* Chitty, J., 42 C. D. p. 280, 6 R. P. C. 482 (1889).

(e) See *Jelley's Application*, 51 L. J. Ch. 639 n. (1878); *The Walkden, &c. Co.'s Application*, 54 L. J. Ch. 394 n., both Jessel, M.R.; and *Wragg's Tms.*, 29 O. D. 551 (1885),

Pearson, J.

(f) See *Münch's Application*, 50 L. T. 12 (1884), Chitty, J.

(g) *Smokeless Powder Co.'s Tms.*, (1892) 1 Ch. 590; 9 R. P. C. 109, Chitty, J.; *Apollinaris Co.'s Tms.*, (1891) 2 Ch. 233; 8 R. P. C. 137, C. A.

expressed a contrary opinion in *Hudson's Case* (h), for the label does not consist of each particular part of it, but consists of the combination of all the parts (i). This rule may probably be regarded as settled by the cases cited, but in the earlier case of *Burland v. The Broxburn Oil Co.* (k), an order was made that the descriptive word *Washerine*, appearing in a registered label, should be disclaimed.

In the last-mentioned case, Chitty, J., expressed an opinion that additions registered under sect. 74, are not part of the trade-mark to which they are attached (l), and the wording of the section obviously suggests the same view. If this is the correct construction of the Act, it would seem that no exclusive rights in the additions are conferred by registration, since sect. 76 grants such rights in the trade-mark only, and consequently the provision for the disclaimers required by the section was unnecessary, except for the purpose of showing that the registered proprietor has no such rights upon the face of the register. The additions allowed to the essential particulars enumerated in sect. 64, are referred to in the section in different language, and they are clearly part of the trade-mark itself where they are distinctive.

Common additions are not part of the trade-mark.

The effect of a disclaimer is that the proprietor of the registered trade-mark cannot claim any trade-mark rights under the Acts, in respect of the parts of the mark to which the disclaimer relates (m), so that, for instance, no action for infringement lies in respect of the use or imitation of the disclaimed particulars (n), and the mere presence of

Effect of registration with disclaimer.

(h) 32 C. D. 311; 3 R. P. C. 155 (1886); see above, p. 138.

(i) Per Lord Esher, M.R., in *Pinto v. Badman*, 8 R. P. C. 181 (1891), see Chap. X., p. 191.

(k) 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J. A similar order was made in *Edge's Tm.*, 8 R. P. C. 207 (1891), Stirling, J., (*Filtered Blue*).

(l) So, per North, J., in *Rosenthal*

v. Reynolds, *infra*.

(m) *Pirie v. Goodall*, (1892) 1 Ch. 35; 9 R. P. C. 17, V. Williams, J., and C. A., *Pirie's Parchment Bank*, the plaintiffs disclaimed *parchment* and *bank*, but sought to set up some right to the combination; *Baker v. Rawson*, 45 C. D. 529; 8 R. P. C. 89 (1890), North, J.

(n) *Rosenthal v. Reynolds*, (1892) 2 Ch. 301; 9 R. P. C. 189, North, J.

the disclaimed words in a second mark tendered for registration does not make it resemble an earlier registered mark within the meaning of sect. 72 (2) (*m*).

Advantages
of registration
with addi-
tions.

In comparing two marks which are alleged to too closely resemble each other, some account must be taken of elements common to the trade which are included in both (*o*); and on this ground the registration of a trade-mark, with the common words or other particulars which are actually used with it, may secure it a more efficient protection under sect. 72 against the subsequent registration of similar marks in the same class, than would be obtained by the registration of its distinctive elements only (*p*). Beyond this, it is difficult to see what substantial bearing upon the proprietor's rights the registration of disclaimed additions with a trade-mark can have; for if the places occupied by the matter which would have to be disclaimed are left blank upon the register, the proprietor forfeits none of his exclusive rights to the use of the registered and distinctive parts of the mark by filling up the blanks, in actual use, in any manner he pleases (*q*).

Registration
with blanks.

As already stated, traders prefer to register their marks as they are actually used (*r*), both because it saves the expense and trouble of preparing special prints for registration only, and for convenience of reference. On the latter ground, there seems to be good reason for making the registration of trade-marks as they are actually used compulsory in all cases.

(*m*) *Loftus' Tm.*, (1894) 1 Ch. 193; 11 R. P. C. 29; North, J. *Unco Guid* in each of two quite distinct labels; and the cases in note (*m*).

(*o*) See Chap. X., p. 193.

(*p*) And see the passage from the Committee's report above, p. 165.

(*q*) *Melachrino & Co. v. The Melachrino Egyptian, &c. Co.*, 4 R. P. C. 215 (1887); *Hammond v. Bruncker*, 9 R. P. C. 301 (1892), both Chitty, J.; and see Chap. XV., p. 331.

(*r*) See above, p. 166.

CHAPTER X.

RESTRICTIONS ON REGISTRATION.

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The comptroller's discretion is not limited by the express restrictions.

NOTHING can be entered upon the register which is not authorized by the sections set out and commented on in Chapter VIII. (a), and, as stated in the chapter referred to, the comptroller has a discretion, subject to appeal, to refuse to register marks which he thinks ought not to be accepted, although they comply with the provisions of the enabling sections. This discretion is, as has been shown, general, and it extends beyond the letter of the restrictions imposed by other sections of the Acts which are the subject of the present chapter.

The most important sections to be considered in this chapter, sects. 71, 72, and 73, are substantially the same as the corresponding sections of the Act of 1875, sects. 5 and 6.

I. Duplicate Marks for the same Goods.

It is provided by sect. 71 that—

Sect. 71.
Conflicting
claims to
registration.

“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.”

And by sect. 72. (1) that—

Sect. 72 (1).
Identical
marks not to
be registered
without leave.

“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

(a) Page 106, sects. 64 and 74, see “reasons for refusal,” p. 63.

“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.”

It will be observed that, while the former section gives the comptroller a discretion, the latter is imperative.

Where several applicants claim to be proprietors of the same mark the comptroller may require them to state their cases in writing, and to appear before him and give oral explanations with respect to such matters as he may require (*b*). And if the dispute is submitted to the Court under sect. 71, it is provided by the rules that the procedure to be adopted, unless the Court shall otherwise order, shall be that of a special case (*c*), which may be settled if need be by the comptroller (*d*); but in practice the application is always made by summons or motion, the summons or notice of motion asking for leave to have the question determined in that way (*e*).

Duplicate claims to the same mark.

Before the introduction of registration, when trade-mark rights could, except in a few special trades and in particular places (*f*), be acquired only by user, the duplication of marks for use in connection with the same description of goods, by use in different districts, was very common, and many duplicate old marks were admitted on to the register. A limit to the number of such duplicates which would be accepted was put by the adoption of the three mark rule which has been already referred to (*g*).

The three mark rule.

This rule was introduced by the Commissioners of Patents, under the Act of 1875, and it was repeatedly recognized by Jessel, M.R., and other judges (*h*), and its

(*b*) Rule 43, p. 602.

(*c*) Rule 44.

(*d*) Rule 45.

(*e*) See Sebastian, 3rd ed. p. 374, and Simpson, *Davies & Son's Tm.*, 15 O. D. at p. 527 (1880), Jessel, M.R.

(*f*) *e.g.*, the outlery trade in Sheffield.

(*g*) Chap. IX. p. 172; Act of 1883, sect. 74 (3).

(*h*) *Walkden, &c. Co.'s Application*, 54 L. J. Ch. 394 n. (1877), Jessel, M.R.; *Jelley's Application*, 51 L. J. Ch. 639 n. (1878), Jessel, M.R.; and *Wragg's Tm.*, 29 C. D. 551 (1885), Pearson, J.; *Benbow v. Low*, 44 L.T. 875 (1881), Bacon, V.-C.

test is adopted, with respect to additions common to the trade, by sect. 74 (3). According to the rule, three, but not more than three, identical or substantially identical (*i*) old marks may be registered for use upon the same, or substantially the same, class or description of goods, provided that the marks have been honestly and lawfully acquired and used. So that a mark which was originally unlawfully copied from another cannot claim registration along with the other under cover of the rule (*k*). If more than three such marks had been so acquired and used before the 13th of August, 1875, they were all treated as common to the trade (*l*); but the use of a mark abroad did not fall within the rule (*m*).

Lord
Herschell's
Committee
on the three
mark rule.

“Prior to the passing of the Act of 1883,” say Lord Herschell's Committee (*n*), “the late Master of the Rolls had laid down the rule that the comptroller might register three old marks, *i. e.*, marks in use prior to August, 1875, without the necessity of the parties resorting to the Court. It is suggested,” they add, “that this worked well; and although there is not complete unanimity of opinion on the point, we think the preponderance of reasons is in favour of reviving the practice as regards old marks.” The committee seem to have been in error as to the power of the comptroller to register a second mark without the leave of the Court under the old Act, for sect. 6 of that Act laid down substantially the same rule as sect. 72 (1) set out above. The rule was that, upon proof of the title of a second or of a third trader to the mark, leave to register it was granted notwithstanding the presence of a first or second prior registration of the same mark for the goods in question (*o*), and no alteration has been made in

(*i*) *White Rose Tm.*, 30 C. D. 505 (1885), Kay, J.

(*k*) *Jelley's Application*, p. 179.

(*l*) See *Burland v. Broxburn Oil Co.*, 42 C. D. at p. 280; 6 R. P. C. 274 (1889), Chitty, J.

(*m*) *Münch's Application*, 50 L. T. 12 (1884), Chitty, J.; and see

Jackson & Co. v. Napper, 35 C. D. at p. 178; 4 R. P. C. 45 (1886), Stirling, J.

(*n*) Page xiii.

(*o*) See *per Jessel, M.R.*, *Jelley's Application*, 51 L. J. Ch. at p. 640n. (1878).

regard to this by the present Acts. There cannot, one may suppose, be now remaining and unregistered any very large number of marks used before the 13th of August, 1875, which are likely to be put on the register under cover of the three mark rule; but the rule is still important, since questions as to the propriety of existing registrations are continually arising under sect. 90.

The rule has never been applied to marks first invented or used since the 13th of August, 1875 (*p*), for the Registration Acts make proper registration itself equivalent to public user, and evidence of the registered proprietor's right to the exclusive use of the mark (*q*). Title to a mark can still, however, be acquired by user, although registration is a condition precedent to any action by the proprietor in respect of its infringement (*r*). It is quite possible, therefore, that the circumstances which led to the adoption of the rule might arise in connection with new marks. If, for instance, the same mark is adopted by two traders for use upon the same class of goods, but in different districts, and there is no proof as to which first adopted it, then, according to the present practice, if one gets registered the other cannot do so. It was suggested to Lord Herschell's Committee that this should be altered (*s*), but no change has been made.

The rule does not apply to new marks.

Leave to register a second old mark is granted as of course, if an independent and honestly acquired title to the mark as a trade-mark is shown. In *Jelley's Case* (*t*), Jessel, M.R., said: "I have often had the case of a man in one town not knowing that another man in another town has the same mark, and he has got his trade-mark registered. The second applicant must prove his title, that

Application of the rule.

(*p*) *Jackson & Co. v. Napper*, 35 C. D. p. 169; 4 R. P. C. 45 (1886), Stirling, J.

(*q*) Act of 1883, sects. 75 and 76; Act of 1875, sects. 2 and 3.

(*r*) Act of 1883, sect. 77; and p. 260, below.

(*s*) See the evidence of the controller, Sir H. Reader Lack, Q. 3161.

(*t*) 51 L. J. Ch. 639 n. (1878).

“is all. The leave of the Court mentioned in sect. 6 (u) is not a capricious leave. The rule of the Court which I have just stated is always followed, and it merely means that the second man must show his title. You cannot deprive him of his trade-mark. Look at the monstrous injustice that would be done if a man who had a trade-mark for, perhaps, forty years, should lose it, because another man who had it for four years had happened to register it first.”

Registration of an old mark may be allowed although a similar mark has been on the register for more than five years (x).

The operation of sect. 72 is not limited by the classes into which goods are divided for the purposes of registration. And in this respect the wording of the present Act is wider than that of the corresponding section of the Act of 1875, for that section contained the words “the same goods or classes of goods” in place of the words “the same goods or description of goods.” Thus, in *The Australian Wine Importers’ Case*, the question arose whether an application to register a label containing a device and the words “Golden Fleece” for wine, could be opposed on the ground of the prior registration of what were held to be similar labels for spirits, both wine and spirits being in the same register class (42), and Kay, J., held that, whether sect. 72 applied or not, the use of the mark tendered, having regard to the presence on the register of the other marks, would be calculated to deceive within the meaning of the next section, and that it ought not to be registered. The Court of Appeal affirmed the decision, and Lindley, L.J., said (y), “For the purpose of deciding whether two sets of goods are of the same description, we must not, it appears to me, lay too much stress on the classification in the schedule to the rules. You find there goods of the same description in

After five years’ registration of opponent’s mark.

The same goods or description of goods.

Sect. 72 is not limited by the register classes.

(u) *i.e.*, of the Act of 1875, now sect. 72 (1).

(x) *Jackson & Co. v. Napper*, 35 C. D. 162; 4 R. P. C. 45; *Bancroft & Co.’s Tm.*, 5 R. P. C. 209

(1888), both Stirling, J. See further, as to the registration of old marks, Chap. VIII. pp. 154 *et seq.*

(y) 41 C. D. p. 291; 6 R. P. C. 311 (1889).

“different classes, and goods of different descriptions in the same class. For example, if you turn to classes 26—29, you will find that flax and hemp are in one class, and jute in another, though all of them are fibrous, and more or less of the same description for trade purposes. Then, if you turn to class 22, you will find bicycles and railway carriages in the same class. Now, for trade purposes, can you have any goods more different than bicycles and railway carriages? Of course, they are utterly different things, and yet they are put by the framers of these rules into the same class, so that we cannot be guided by their classification in construing the words ‘same goods or description of goods,’ which are the words used in sect. 72.” And the judges were all inclined to think that wines and spirits were of the same description of goods, although they did not decide the point. It has since been held that beer and rum are the same description of goods within the meaning of the section (*yy*). So, on the other hand, in *Brady & Co.’s* applications, North, J., allowed a new mark to be registered for galvanized iron sheets, although a similar mark was already registered and used for bar iron and wire, which goods were within the same register class as the iron sheets (*z*). The true test would seem to be supplied by the question—are the two sets of goods so commonly dealt in by the same trader, that his customers, knowing his mark in connection with one set, and seeing it upon the other would be likely to suppose that it was used upon them also to indicate that they were his goods (*a*). It has already been stated that the proprietor of a mark used for only part of a register class, even though it be registered for the whole, and *à fortiori* if the registration as well as the user is limited within the class, cannot prevent the use of the mark by other traders upon other descriptions of goods, although they may be

Use or registration for part of a register class.

(*yy*) *Turney & Sons’ Tm.*, 11 R. P. C. 37; 10 Times L. R. 175 (1893), North, J.

Jelley’s Application, 51 L. J. Ch. 639 n. (1878), Jessel, M.R.

(*a*) See *per* Kay, J., 41 C. D. at

(*z*) 21 C. D. 223 (1882); and see p. 281.

included in the same register class (*b*). But the fact that an opponent of an application for registration could not get an injunction to restrain the use which the registration sought is intended to cover, is by no means conclusive upon the question of the registration (*c*).

Registration of a second mark by agreement.

Note on the register.

A second mark is often admitted to registration by agreement with the proprietor of a mark already registered, who might otherwise oppose it under sects. 72 or 73, on the terms that it shall be limited to part only of the register class. The limitation is effected by placing a note on the register (*d*). And in the same way marks are allowed to be registered on the terms of being used in a particular manner, so as not to be confused with a mark already registered (*e*), or for use in a particular district (*f*). And the comptroller may be directed to put a note, in accordance with the agreement, upon the register (*f*). Where identical or similar marks are registered for different goods in the same register class, it is an infringement for the proprietor of either to use his mark upon the goods for which the other is registered (*g*).

II. Mark resembling a Registered Mark.

It is further provided by sect. 72 (2) that—

Sect. 72 (2), mark resembling a registered mark.

“[Except as aforesaid] (*h*) the comptroller shall not register with respect to the same goods or description of goods (*h*) a trade-mark so *nearly resembling* [having such resemblance to] (*i*) a trade-mark already on the register with respect to such goods, or description of goods, as to be calculated to deceive.”

(*b*) See p. 88, sect. 65; and see *Hargreaves v. Freeman*, (1891) 3 Ch. 39; 8 R. P. C. 237, Chitty, J.

(*c*) See *The Australian Wine Importers' Case*, *supra*, and p. 183, below.

(*d*) See *Re Rabone Bros. & Co.*, Sob. Dig. p. 395 (1879), Jessel, M.R.

(*e*) *Whiteley's Tm.*, 43 L. T. 627 n. (1879), Jessel, M.R.; *Sykes & Co.'s Tms.*, *ibid.* p. 626 (1880),

Hall, V.-C. For restrictions as to colour, see Chap. VIII. p. 163.

(*f*) *Keep's Tm.*, 26 C. D. 187 (1884), Pearson, J.; *Mitchell & Co.'s Tm.*, 28 C. D. 666 (1884), Chitty, J.; *Whiteley's Tm.*, 43 L. T. 627.

(*g*) *Upper Assam Tea Co. v. Herbert*, 7 R. P. C. 183 (1890), C. A.

(*h*) See above, p. 176.

(*i*) Act of 1888, sect. 14.

The sub-section corresponds to a part of sect. 6 of the Act of 1875. The words "except as aforesaid" refer back to sect. 72 (1) (*k*), and the exception is where the Court has decided that two or more persons are entitled to have identical, or substantially identical, marks registered, for instance, on the ground that trade-mark rights in them have been independently acquired. The words were added by the Act of 1888. The Act just cited also substituted "having such resemblance" for the words "so nearly resembling," which occurred in the Acts of 1875 and 1883. The change was in each instance made upon the recommendation of Lord Herschell's Committee, and in the latter was supported by the reasons stated in the extract from the report set out below (*l*). It is difficult, however, to see in what way the effect of the sub-section has been altered by the amendments.

What is meant by the same goods or description of goods has already been considered (*m*).

The provision of the sub-section embodies the old rule, that a mark which from its resemblance to an existing trade-mark is calculated to deceive cannot be protected as a trade-mark, for its use is an infringement of the other mark, which would be restrained by the Court (*n*). But the restriction extends beyond the rule, and it does not follow that because an opponent could not obtain an injunction against the use by the applicant of the mark he tenders for registration, that the latter is not calculated to deceive within this sub-section. Thus, in *Speer's Case* (*o*), Kay, J., said: "I could quite conceive a case

The section extends beyond infringing marks.

(*k*) Page 176.

(*l*) Page 188.

(*m*) Page 180, above.

(*n*) *Seizo v. Provezende*, 1 Ch. 192 (1865), Cranworth, L.-C.; and see *Cope v. Evans*, L. R. 18 Eq. 158 (1874), Hall, V.-C., and the cases there cited. Deceptive trade-marks

are not protected, see Chap. XV. p. 336.

(*o*) 4 R. P. C. at p. 524; 55 L. T. 880 (1887); and see *The Australian Wine Importers' Tm.*, 41 C. D. 278; 6 R. P. C. 311 (1889), C. A.

“in which the similarity would not be such as would 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 these marks are so nearly resembling one another, at any rate, that I will not, by allowing the registration, encourage the use of a mark which may lead to litigation hereafter. It seems to me that is a matter which the comptroller ought to consider.” And this is fully in accord with the judgments of the law lords in *The Fruit Salt Case (p)*.

Marks used in different Markets.

Limitation to particular market.

The question has been raised whether a mark which is sufficiently distinguishable from an opponent's mark everywhere except in a particular country or market, but has there such resemblance to it as to be calculated to deceive, on account of the local circumstances of the trade, for instance, because goods bearing the latter mark have locally acquired a particular name (*q*), falls within the section, and ought, therefore, to be refused registration (*r*). The question has not been directly decided, but it is submitted that the objection would be sufficient to justify the rejection of the mark unless the parties came to an arrangement for the limitation of the area of user of the applicant's mark (*s*). The authorities cited below (*t*) show that probability of deception in England only is not all that is to be con-

(*p*) *Eno v. Dunn*, 15 App. Cas. 252; 7 R. P. C. 311 (1890).

(*q*) See p. 199, below.

(*r*) In *The Société Anonyme des Verreries de l'Etoile*, (1894) 1 Ch. 61; 10 R. P. C. 436, the trades of the applicant for rectification and of the respondent were in fact competing in the colonies, and Stirling, J., held that the use of the applicants' mark on goods shipped in English ports for the colonies was use in England, where

the respondents' main trade was. Aff. by C. A., W. N. (1894) 42; 11 R. P. C. 142.

(*s*) As in *Keep's Tm.*, 26 C. D. 187 (1884). In *Re Rabone*, Seb. Dig. p. 396 (1879), upon simultaneous applications for the registration of similar old marks, Jessel, M.R., appears to have ordered the registration of both, subject to undertakings for specified local user only.

(*t*) Page 187.

sidered in cases of infringement, and it cannot be supposed that a mark would be admitted on to the register if it were shown that the proprietor would forthwith, upon the application of the opponent, be restrained from using it. It is true that, where old marks have been in use simultaneously for years in different markets, the injunctions granted in infringement cases have occasionally been locally limited (*u*), and such limitations have the support of a dictum of Cotton, L.J., in *Johnston v. Orr-Ewing* (*x*); but in that case, on appeal, Lord Cairns expressed a doubt whether the rightful and *bonâ fide* trade-mark of the trader using it could be excluded by injunction from particular markets (though unimpeachable everywhere else), merely because in those markets it might be liable to be called by a name which the mark of another had already acquired there (*y*). And it seems clear that the principle upon which the limitation of the injunctions in the cases referred to was based cannot avail to enable a new mark, which is deceptive in any market, to be registered without the consent of the owner of the mark with which it might there be confused, for the registration confers rights unlimited as to locality; and, although the owner of the previously registered mark may not yet have extended his trade to the particular market in question, it is open to him to do so. Thus, in *The John Bull Beer Cases*, where the two marks concerned were used by the plaintiffs and the defendants respectively in different districts of England, the more lately adopted mark was refused registration, and subsequently an injunction was granted to restrain the use of it (*z*). So, too, in *The Jackson Co.'s Case* (*a*), registration of a word was refused because it was the name of a common mark in the

(*u*) *Carver v. Bowker*, Sob. Dig. p. 350 (1877), Little, V.-C.; *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L.J.

(*x*) 13 C. D. p. 464.

(*y*) 7 App. Cas. p. 227. To that proposition, he said, he could not

assent.

(*z*) *Paine & Co. v. Daniells & Son's Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 71, 217.

(*a*) 6 R. P. C. 80 (1888), Kay, J., (*Kokoko*).

cotton trade among the Chippeway Indians, to whom the English cotton trade had not then extended.

Deceptive Resemblance.

Calculated
to deceive.

“Calculated to deceive” may mean either “intended to deceive” or “likely to deceive,” and the prohibition applies where the case falls within either meaning (*b*), although the latter, which is, of course, the more inclusive meaning, is sufficient to dispose of most, if not all, of the questions that arise under the section. The words are not equivalent to “capable of being used to deceive” (*c*), for it must be assumed, until the contrary is shown, that the applicant will make an honest use of his marks (*b*). A trade-mark is calculated, by its resemblance to another already on the register, to deceive, if in the course of its legitimate use in the trade it is likely to do so.

Two important questions are suggested by the section: A. Who are the persons whom the resemblance must be calculated to deceive? and, B. What rules of comparison are to be adopted in judging whether such resemblance exists?

A. What Persons are to be considered.

Whom the
mark must
be calculated
to deceive.

In accordance with the cases decided in suits and actions for the infringements of trade-marks before the Registration Acts, it is held that the persons to be considered in estimating whether the resemblance between the marks in question is calculated to deceive are all of those who are likely to become purchasers of the goods upon which the marks are used. So that, if such persons, using ordinary care (*d*) and intelligence, are likely to be deceived, then the comptroller ought not to accept the mark.

(*b*) *Kutnow's Tm.*, 10 R. P. C. 401 (1893), North, J., (*Carlsbad Salts*); and see the next case.
(*c*) *Lyndon's Tm.*, 32 C. D. 109;
3 R. P. C. 102 (1886), C. A.
(*d*) *Christiansen's Tm.*, 3 R. P. C. 54 (1886). See *per* Esher, M.R., p. 62, quoted below, p. 191.

It is clearly not enough for the applicant to show that retail dealers buying his goods for resale would not be deceived, since they might themselves fraudulently or carelessly make use of the ambiguous character of the trade-mark to deceive their customers, the ultimate purchasers (*e*). In fact, dealers who buy from the manufacturers in order to sell by retail are generally aware of attempted infringements, and are parties to the fraud (*f*). Nor is the inquiry to be confined to England, or to persons acquainted with the English language, where the goods in question have a foreign market (*g*). And it must not be assumed that a very careful or intelligent examination of the mark will be made (*h*); but, on the other hand, it can hardly be a bar to the admission of a mark that unusually stupid people, fools or idiots, may be deceived (*i*). The cases cited are nearly all cases of infringement, and, as already said, a weaker case than would entitle a plaintiff to succeed in an action for infringement, will enable an

The ultimate purchasers.

Foreigners.

Persons of ordinary ability and carefulness.

(*e*) *Wilkinson v. Griffith*, 8 R. P. C. at p. 374 (1891), Romer, J. See the judgment of Mellish, L.J., in *Ford v. Foster*, 7 Ch. 616 (1872); and the judgment of Lord Selborne, in *The Singer Manufacturing Co. v. Loog*, 8 App. Cas. 15 (1882).

(*f*) *Anglo-Swiss, &c. Co. v. Metcalf*, 31 C. D. 454; 3 R. P. C. 28 (1886), Kay, J.; *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), C. A. "In my opinion, the whole gist of the complaint against the defendants is, 'You have sold a weapon calculated to be used fraudulently by the middlemen,'" Cotton, L.J.

(*g*) *Johnston v. Orr-Ewing*, 7 App. Cas. 219 (1882); *Wilkinson v. Griffith*, *supra*.

(*h*) "Unwary purchasers." *Wotherspoon v. Currie*, L. R. 5 H. L. 508 (1872), Lord Chelms-

ford; *The Singer Manufacturing Co. v. Loog*, 8 App. Cas. 15 (1882), Lord Selborne. "Ordinary purchasers purchasing with ordinary caution," *Seizo v. Provezende*, L. R. 1 Ch. 192 (1866), Cranworth, L.C.

(*i*) "Whatever be the class of persons who buy these things (sewing machines), we must at all events assume that they are persons capable of reading and writing, or of reading, at all events," *per* James, L.J., 18 C. D. p. 413. "The possibility of such a mistake is not a cause of action (for passing off). The same thing might happen if the defendant issued circulars that his were *not* Singer sewing machines. For however large he printed the *not* some one might not see it," *per* Lord Bramwell, 8 App. Cas. p. 42.

opponent to successfully object to the registration of a new mark.

B. Rules of Comparison.

What amount of resemblance is calculated to deceive.

It is impossible to discover from the decided cases any criterion as to the amount of resemblance which will suffice to cause the rejection of a mark more definite than that expressed in the section itself, and probably no test could usefully be stated (*k*); but a perusal of the reported cases shows that the comptroller and the Court now apply the restriction much more strictly against new marks than formerly, and, as already shown, it is settled that the onus of showing that there is no reasonable probability of deception is cast on the applicant (*l*). In comparing the marks, the comptroller must, as is shown by the authorities referred to below, take into account all the circumstances of the case, and must consider whether, as a whole, the applicant's mark is substantially different from the opponent's. The report of Lord Herschell's Committee on this point admirably states what are conceived to be the critical tests, and it shows also what the amendment of the Act (*m*) was intended to effect. It will be useful to set out the whole passage.

1. The "Idea of the Mark" is to be regarded.

Lord Herschell's Committee on the principle of comparison.

"We have given very careful consideration to the evidence which has been laid before us by those interested in the trade of Lancashire. The number of marks registered in classes 23, 24, and 25, which are commonly described as the Cotton Classes, is very large; and the administration of the Act (*n*) in relation to these classes is of great

(*k*) "What degree of resemblance is necessary (to constitute an infringement) is, from the nature of things, a matter incapable of definition, *à priori*," *per* Cranworth, L.C., in *Seixo v. Provezende*, L. R. 1 Ch. 192 (1866).

(*l*) *Eno v. Dunn*, 16 App. Cas. 252; 7 R. P. C. 311 (1890).

(*m*) Substituting "having such resemblance" for "so nearly resembling."

(*n*) *i.e.*, the Act of 1883.

“importance to the trade. There can be no doubt that the working of the Trade-Marks Act has not given satisfaction in Lancashire. Even if at times there may have been a disposition to expect too much, we think there have been substantial grounds for the dissatisfaction which has prevailed. The great bulk of the goods manufactured in Lancashire, in respect of which trade-marks are used, is exported to other countries, and there can be no doubt that these marks fulfil important functions in the trade between Lancashire and India and other countries. One chief complaint has been that the usages of the trade and the character of the markets where the marks are intended to serve their purpose have not been sufficiently kept in view by the Patent Office. By sect. 72, sub-s. (2), the comptroller is directed not to register, with respect to the same description of goods, a trade-mark so nearly resembling a trade-mark already on the register with respect to such description of goods as to be calculated to deceive. It is on the question whether marks do so nearly resemble one another as to be calculated to deceive, and what extent of resemblance to an old mark ought to cause the rejection of an application, that the chief difference has arisen between the trade and those to whom the administration of the Act has been entrusted. The tendency of the office has been to construe the words of the Act more favourably towards applicants for new marks than the trade have thought right. We think the difference has arisen in part from the wording of the Act. The comptroller has felt unable to say that two marks ‘so nearly’ resemble each other as to be calculated to deceive. He has thus not considered himself at liberty to take into consideration to the extent he otherwise might, the character of the market in which the mark is to serve its purpose. Two marks, when placed side by side, may exhibit many and various differences, yet the main idea left on the mind by both may be the same; so that a person acquainted with the mark first registered, and not having the two side by side for comparison, might well be deceived, if the goods were

The idea of each mark to be considered.

“allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted. Take, for example, a mark representing a game of football; another mark may show players in a different dress, and in very different positions, and yet the idea conveyed by each might be simply a game of football (o). It would be too much to expect that persons dealing with trade-marked goods, and relying, as they frequently do, upon marks, should be able to remember the exact details of the marks upon the goods with which they are in the habit of dealing.

“In order to avoid misapprehension in the future, we recommend, even though it may not be absolutely necessary, a slight amendment of the Act, substituting for the words ‘so nearly resembling’ the words ‘having such resemblance to’; and further, we would suggest that when the question arises whether a mark applied for bears such resemblance to one on the register as to be calculated to deceive, it should be determined by considering what is the leading characteristic of each. The one might contain many, even most, of the same elements as the other, and yet the leading, or it may be the only, impression left on the mind might be very different; whilst, on the other hand, a critical comparison of two marks might disclose numerous points of difference, and yet the idea which would remain with any person seeing them apart at different times might be the same.”

The principle
is adopted by
the Court.

It is conceived that the principles which should guide the comptroller, and the Court on appeal from him, and also on applications under sect. 90, to remove a trade-mark from the register as offending against this subsection, are here stated in accordance with the leading cases on the subject.

*The Two
Elephant Case.*

Thus, in *Johnson v. Orr-Ewing* (p), where both plaintiff's and the defendant's marks consisted of tickets bearing

(o) Cf. *Barker's Tm.*, 53 L. T. 23 (1885), Kay, J. (*Huntsman*, or *Sportsman's cherry brandy*).
(p) 7 App. Cas. 219 (1882).

pictures of two elephants with a banner between them, the figures being differently arranged, Lord Selborne said (q): "Although the mere appearance of these two tickets could not lead anyone to mistake one of them for the other, it might easily happen that they might both be taken by natives of Aden or of India, unable to read and understand the English language, as equally symbolical of the plaintiff's goods. To such persons, or at least to many of them, even if they took notice of the differences between the two labels, it might probably appear that they were only differences of ornamentation, posture, and other accessories, leaving the distinctive and characteristic symbol substantially unchanged. Such variations might not unreasonably be supposed to have been made by the owners of the plaintiff's trade-mark themselves for reasons of their own."

And in *The Taenstikker Case* (r), where the Court of Appeal, reversing the decision of Chitty, J., held that a label for match-boxes so nearly resembled an older label registered for the same goods as to be calculated to deceive, the judgment of the Court proceeded on the ground that the net impression produced by both labels was the same. The appellant's label as registered consisted of a black oblong, bearing the word *taenstikker* printed at the bottom, and the word *nitedals* at the top, and a small geometrical device having two overlapping medals on each side of it in the middle. The respondent's label as registered showed the same elements, with the word *medals* instead of *nitedals*, two blank spaces having the same outline as the medals, and a cross instead of the device, the blanks and cross corresponding in size and shape with the medals and device. It was shown that in practice the respondents printed representations of medals over the blanks.

*The Taen-
stikker Case.*

(q) Page 225. See also *Baschiera's Tm.*, 33 Sol. J. 469; 5 Times L. R. 480 (1889), Chitty, J., where the ground of rejection was that "the dominating portion of each mark was a lion, and the goods were

designated by the prevailing feature, according to the custom of the trade."

(r) *Christiansen's Tm.*, 3 R. P. C. 54 (1886).

Lord Esher's judgment.

The marks to be compared as wholes.

There may be general resemblance with many differences in details.

"The trade-mark," said Lord Esher, "is the whole thing—the whole picture on each. You have, therefore, to consider the whole. Mr. Justice Chitty has looked at the distinguishing features. He, I think, only looked at it to see whether, with that distinction, the whole was like or unlike. That is what he did, but the argument raised by Mr. Romer, and which was not only shadowed but plainly put forward by his skilful cross-examination, was this: the moment there is any distinction in any part the things are at once unlike. That is his point. Therefore he cross-examined the people thus:—The lamps (s) or the medals are alike, and they are common?—Yes. The two things in the middle are unlike?—Yes. The word at the bottom is common to the trade, and it is the same in both?—Yes; but it is common to the trade. Therefore, he says, everything but the words *medals* and *nitedals* is common, and those two are different, and therefore the whole is different. It seems to me he has fallen into this fallacy—he takes each thing by itself, and says either it is common or it is the same, and leaves out altogether the mode in which the things are put together in the two pictures."

And Lindley, L.J., said: "The difference here, looking at the boxes, is simply this, that the word *medals* is used instead of the word *nitedals*, all the rest being, according to the evidence, common. Now I do not think that is a dissimilarity which is sufficient in this case, because, although I rather agree with the view taken by Chitty, J., that the leading feature is the name at the top or bottom of the label, one must not be misled by that. The question is, notwithstanding that, what is the effect of the use or introduction of that distinguishing character on the whole? When you look at the wholes, then it appears to me, I confess, that the dissimilarity is not enough to make the wholes dissimilar" (t).

Included

So that, where common marks are included in the trade-

(s) i. e., the blank spaces.

(t) "Though no one particular mark was exactly imitated, the combination was very similar and

likely to deceive," Hatherley, L.C., in *Abbott v. The Bakers', &c. Association, Ltd.*, W. N. (1872) 31.

marks to be compared, or in one of them, it appears, from the judgments just quoted (*u*), that the proper course is to look at the marks as wholes, and not to disregard the parts which are common, although Cairns, L.C., in the *Orr-Ewing Case*, expressed a different opinion (*r*).

common marks are not to be disregarded.

Farrow's Case (*y*) is a good illustration of Lord Esher's rule (*z*). There both the applicant and the opponent were mustard merchants, and both used square boxes covered with yellow labels printed in black and red, for these boxes were common to the trade. The applicant placed upon his labels a picture of a charging buffalo, and the opponent a picture of a bull's head; both pictures were contained within silver rings, and these rings were also common to the trade. Stirling, J., said that the buffalo and the bull's head, as printed in the *Trade-Marks Journal*, were very different, but when they were placed upon the coloured labels, the applicant's label too closely resembled that of the opponent to be admitted to the register.

Parts of the contrasted marks common to the trade not to be disregarded.

2. The Marks are to be compared as fairly used in Practice.

It is also clear that the comptroller or the Court ought not merely to look at the marks as they stand side by side, for, from the nature of the case, they will not be so put before any customer whom it is sought to deceive by means of either of them. He can only contrast the mark upon the goods offered to him with his recollection of the mark used upon those he is seeking to buy, and allowance must be made for this in estimating the probability of deception. Any other rule would be of no practical use (*a*). Moreover, variations in details might well be supposed by customers

Marks not to be merely compared side by side on a view;

(*u*) *Christiansen's Trm.*, 3 R. P. C. 54 (1886), above, p. 191; and see *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 39 (1890), North, J.
 (*x*) 4 App. Cas. 479 (1879).
 (*y*) 7 R. P. C. 260; 63 L. T.

233 (1890), Stirling, J.
 (*z*) Page 191, above.
 (*a*) *Seixo v. Provezende*, 1 Ch. 192 (1866), Cranworth, L. C.; *Wilkinson v. Griffith*, 8 R. P. C. 370 (1891), Romer, J.

to have been made by the owners of the trade-mark they are already acquainted with for reasons of their own (*b*).

but as seen
and remem-
bered in
actual use.

In comparing the marks, therefore, regard must be had not only to their form as they appear on the register (*c*), but also to the appearance they would present in actual use when fairly and honestly used; to the nature of the goods upon which they are to be employed; to the character and size of the marks themselves, and to the probability of their becoming partially or wholly blurred or modified as ordinarily stamped or printed, or by ordinary wear and tear (*d*).

Size of mark.

For instance, a mark which is used for hardware goods, and is stamped upon them with a die, is not likely to appear so definitely or to be so readily distinguishable from a similar mark as one which is engraved or printed upon a paper label, and so attached to the goods (*e*). In the former case, too, the mark will necessarily be used in a small size only (*e*). As regards size, however, even under circumstances in which, from the nature of the goods, large sizes showing the design distinctly can be, and generally are used,—since it is open to a registered proprietor to use his mark in any size,—size would not seem to be a material element in the comparison (*f*). It must not be assumed against the applicant or registered proprietor that he is going to use his mark unfairly, in the sense that he is

(*b*) *Johnston v. Orr-Ewing*, 7 App. Cas. 219 (1882), Lord Selborne, *ante*, p. 191.

(*c*) Jessel, M.R., held, in several cases, that the register only should be looked at. *Re Jelley*, 51 L. J. Ch. N. S. 639 n. (1878); *Robinson's Tm.*, 29 W. R. 31 (1880); *Mitchell v. Henry*, 15 C. D. 181 (1880); but in the latter case the C. A. dissented from his opinion and overruled his decision; *Christiansen's Tm.*, 3 R. P. C. 54 (1886), Chitty, J.

(*d*) *Rosing's Application*, 54 L. J. Ch. 975 n. (1878), C. A.; *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102, (1885), C. A.; *Haines, Batchelor & Co.'s Tm.*, 5 R. P. C. 669 (1888), Chitty, J.; *Lambert's Tm.*, 5 R. P. C. 542; 6 R. P. C. 344; 61 L. T. 138 (1889), C. A.

(*e*) See the two cases last cited, in which, however, the opposition failed; and see *Re Jelley*, 51 L. J. N. S. 639 n. (1878), Jessel, M.R.

(*f*) *Speer's Tm.*, 4 R. P. C. 521; 55 L. T. 880 (1887), Kay, J.

going to use something different (*g*), by leaving out or obliterating any parts of the mark, for instance, so as to make it more like that of the opponent (*h*), for the Court presumes that a trade-mark will be fairly used and without fraud (*i*). But the comptroller or the Court must consider any alterations which the applicant lawfully might make, without altering the essential features of his mark or losing the protection which would be conferred by registration (*k*). Thus he may use the mark in any colour, and in *Worthington's Case* (*l*) a triangular frame with the picture of a church inside was rejected on the ground that it would, if the whole were coloured red, too nearly resemble Bass' well-known solid red triangle. And if it is shown that the applicant does actually use, or intend to use, his mark so altered as more nearly to resemble that of the opponent, as, for example, in *The Taenstikker Case* (*m*), by filling up blanks left in the mark as registered, the mark so altered will, as against the applicant, be treated as the mark to be considered (*n*). On the other hand, such alteration of the opponent's mark, being something other than the ordinary effects of its lawful user in the registered form, is immaterial as against the applicant (*n*), for no one can extend the protection given to his registered mark by departing from the registered form. It is, however, no answer to an objection that the objector uses his mark in a form different to that in which it appears on the register, if the mark in question so nearly resembles the

Alteration of mark as used, from mark as registered, to be considered.

Variation in the use of the opponent's mark.

(*g*) *Biegel's Tm.*, 4 R. P. C. 525; 57 L. T. 247 (1887), Chitty, J.

(*h*) *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1886), C. A.

(*i*) *Lambert's Tm.*, 6 R. P. C. 344; 61 L. T. 138 (1889), C. A.; *Haines, Batchelor & Co.'s Tm.*, 5 R. P. C. 669 (1888), Chitty, J.; *Kutnow's Tm.*, 10 R. P. C. 401 (1893), North, J. (*Carlsbad salts*).

(*k*) *i. e.*, making his mark so different as to be practically an unregistered mark.

(*l*) 14 C. D. 8 (1879), Jessel, M. R., and C. A.; and see *Hanson's Tm.*, 37 C. D. 112 (1887), Kay, J.; see "colour," p. 163.

(*m*) *Christiansen's Tm.*, cited above, p. 191.

(*n*) *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1886), C. A.

Alteration of the opponent's registered mark in use cannot increase the objection.

objector's mark, as it there appears, as to be calculated to deceive (*o*), for such use is legal, although, so far as the mark used is substantially different from the mark registered, it is not protected. Even if the user were illegal, it could hardly act as an estoppel (*p*); and if the opponent were using his mark improperly, for instance, in aid of a fraudulent or illegal trade, or if his mark as used by him were calculated to deceive (*q*), the applicant's proper course would be to remove the mark out of the way by an application to rectify the register under sect. 90.

3. The Essential Particulars are to be specially attended to.

Undertaking not to vary registered mark in use.

Regard must, however, be specially directed to the essential particulars of the marks to be compared, for the remaining matter in any of them might, subsequently to registration, be changed on an application under sect. 92. On this ground, Stirling, J., refused, in *Murphy's Trade-Mark* (*r*), to allow a mark consisting of a lion carrying a sheaf, together with other matter, to be registered, there being already on the register another mark comprising a lion bearing a crown, although each mark had additional matter also, and the general appearances of the two were different, because the lions were the sole essential particulars of both. The applicants in this case offered an undertaking that they would use their mark only in the form tendered for registration, but this was not deemed sufficient by the proprietors of the opposing mark, and, as the mark was a new one, the judge refused to accept the offer as an answer to the difficulty raised by the resemblance of the essential particulars.

(*c*) *Melachrino v. The Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215 (1887), Chitty, J.; *Hammond v. Malcolm, Brunner & Co.*, 9 R. P. C. 301 (1892), Chitty, J., both cases of infringement.

(*p*) See *James' Tm.*, 33 C. D. 392; 3 R. P. C. 340 (1886), C. A.

(*q*) See *Newman v. Pinto*, 4 R. P. C. 508; 57 L. T. 31 (1887), C. A.

(*r*) 7 R. P. C. 163 (1890).

4. All the Circumstances of the Trade to be considered.

Further, the Court must have regard to all the circumstances of the trade in which the marks in question are employed, or are to be employed, and in particular to the nature of the market, whether a home or a foreign one; to the number of other trade-marks similar to the contrasted marks already circulating in connection with the same description of goods; to the common marks which are or may be combined with the contrasted marks or either of them; and, generally, to the customs and usages of the trade.

It is obvious that marks which are readily distinguishable by Englishmen, or persons who can read English, may so resemble each other as to be calculated to deceive foreigners whose language is not only different to English, but written in different characters and in a different manner (*s*). For them, if they are ignorant of English, the words upon a mark are only subordinate devices not readily distinguishable from other words occupying corresponding positions in any contrasted mark, and being of about the same length.

And in cases where there are a large number of marks similar to the mark propounded on the register, the Court may think that, though the applicant's mark might be fairly distinguishable from the opponent's if there were no other, and perhaps also from each of the others taken alone, yet the extension of the number of such marks may lead to deception. Thus, in *Hargreaves' Case* (*t*), there being four anchor marks already on the register in the same class, Hall, V.-C., refused to allow another anchor mark to be added to them, notwithstanding that the new

Numerous marks of the same kind on the register.

(*s*) *Johnston v. Orr-Ewing*, 7 App. Cas. 219 (1882); *Wilkinson v. Griffith*, 8 R. P. C. 370 (1891), Romer, J. and *Blakey's Tm.*, and *Hughes and Young's Tm.*, 10 R. P. C. 369 (1893), North, J.; and see *Orr-Ewing v. The Registrar of Tms.*, 4

(*t*) 11 C. D. 669 (1879); *Thewlis* App. Cas. 479 (1879).

Similar marks belonging to the applicant.

mark was sought to be registered for bacon and hams, while those already registered were used for different articles of food, such as biscuits, potted meat, &c., and that it was said to be distinguishable from them all. But the registration of other marks belonging to the applicant himself would not be material to defeat his application, since a trader often desires to register slightly differing marks to distinguish goods which are of different qualities or prices (*u*). Of course, the objection referred to in the present paragraph is much more material in the case of a new trade-mark than in that of an old one (*x*).

The distinction between the marks may be of a well-known kind.

In some cases, on the other hand, the existence of a number of marks, either as common marks or as trade-marks, may operate to render a finer distinction allowable than would otherwise be the case, for the persons concerned in the trade in question may have had their attention directed to the kind of distinction which exists between the mark propounded and any of the others, because it is analogous to the known distinctions existing between the latter. Thus, in *Mitchell v. Henry*, an action for infringement, the reasoning which led Jessel, M.R., to dismiss an application by the plaintiffs for an interlocutory injunction, was summed up by Cotton, L.J., as follows: "What is claimed by the plaintiffs is a double thread on a white selvage; if that is distinctive, then what the defendants are using, namely, a triple thread upon a white selvage, must be a distinctive trade-mark, and therefore I cannot restrain the defendants" (*y*).

Line headings.

The case just referred to forcibly illustrates the difficulties which led Lord Herschell's Committee to recommend that the line headings woven at the ends of lengths of piece goods should not be admitted as trade-marks upon the

(*u*) See "series," sect. 66, Chap. V., p. 90; and *per* Cotton, L.J., in *Mitchell v. Henry*, 15 C. D. at p. 193 (1880).

(*x*) See Lord Blackburn's judgment in *The Orr-Ewing Case*, 4 App.

Cas. 499; and that of Stirling, J., in *Murphy's Tm.*, 7 R. P. C. p. 166.

(*y*) 15 C. D. at p. 194 (1880). The application of this reasoning to the particular case was disapproved by the C. A.

register (z). As they are all constructed by weaving coloured threads into a narrow strip at the end of the piece, the range of possible variation is very closely limited, while the number of existing headings is extremely great, so that it was considered practically impossible to maintain effective distinctions between them, or to sufficiently identify and describe them on the register.

The bearing of marks common to the trade upon the distinctiveness of a mark propounded for registration has been already discussed (a); but besides affecting the right to registration in that way, the nature and number of the common marks with which it will be associated or contrasted may cause the mark propounded to be more or to be less distinguishable from a particular mark than if they did not exist. It is clear, therefore, that the comptroller or the Court must have regard to the marks common to the trade in applying sub-sect. 72 (2) (b).

Marks common to the trade may be material in estimating resemblance.

5. Where the Opponent's Goods are known by a Name suggested by the Mark.

Where the goods of a particular trader have become known by a name derived from his trade-mark, any other mark which would be likely to suggest the use of the same name for the goods on which it is used, so resembles the former as to be calculated to deceive.

Thus, where the trade-mark of the plaintiff was a crown and the word *Seixo*, and his goods had in consequence come to be known in the market as *Crown-Seixo* wine, the defendants were restrained from using marks which led their wine to be described by the same name (c), although evidence was given that *Seixo* was a common word in Portuguese. "The plaintiff," said Lord Cranworth, "had adopted a device or trade-mark which had caused his wines

Seixo v. Provezende.

(z) Report of 1888, p. ix.; see Chap. VIII., p. 136.

(a) Page 122, above.

(b) Per Cotton, L.J., in *Mitchell v. Henry*, 15 C. D. 193 (1880).

(c) *Seixo v. Provezende*, L. R. 1 Ch. 192 (1866).

*The Dairy-
maid Milk
Case.*

“to obtain celebrity under a name descriptive of that trade-mark. The defendants have adopted a trade-mark which could not fail to lead purchasers to attribute to the wines so marked the same name as that under which the plaintiff's wines were known, and so to believe that in purchasing them they would be purchasing the wines of the plaintiff. Against the use of such a trade-mark the plaintiff has, I think, a right to have the injunction of this Court.” So where a trade-mark consisted of the full-length figure of a milkmaid carrying two pails, one on her head and one in her right hand, with the words *milkmaid brand* above it, was registered for condensed milk, coffee and milk, cocoa and milk, chocolate and milk, and essence of coffee, and the goods upon which it was used were known as the *milkmaid* or *dairy-maid* brand, and subsequently another trade-mark consisting of a half-length figure of a woman carrying a pail under her right arm, with the words *dairy-maid* at the side of the figure, was registered for butterine and other fatty substances used as food or as ingredients in food, an order was made to rectify the register by confining the second registration to goods other than those included in the first, and to restrain the use of the second mark upon any of the goods for which the first was registered (*d*).

The objection is equally strong if the word suggested by the new trade-marks, although not the same as a word suggested by the older mark, yet so nearly resembles it, as to be calculated to deceive (*e*).

(*d*) *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 C. D. 454; 3 R. P. C. 28 (1886), Kay, J.; *Orr-Ewing v. Johnston*, 13 C. D. 434; 7 App. Cas. 219 (1879), Fry, J., C. A., and H. L., (*Two Elephant Yarn*); *Spicer's Tm.*, 4 R. P. C. 521; 55 L. T. 880 (1887), Kay, J., (*Dog, Tower, and Harp Linen*); *Read v. Richardson*, 45 L. T. 54 (1881), C. A., (*Dog Head Beer*); *Baschiera's Tm.*, 33 S. J. 469; 5 T. L. R. 480 (1889), Chitty, J., (*Lion Matches*); *La Société Anonyme des Verreries de l'Etoile*, 10 R. P. C. 436; (1894) 1 Ch. 61; 11 R. P. C. 142; W. N. (1894) 42, Stirling, J., and C. A., (*Star Glass*); *Wilkinson v. Griffith*, 8 R. P. C. 370 (1891), Romer, J., (*Red Med. Polish*); are to the same effect.

(*e*) e. g., *Ancross* for umbrellas

The cases just cited are cases where the name applied to the goods was taken from the device used as a trademark. The rule applies also to cases where the name is taken from some word or words appearing upon the mark. *The Osman Towel Case* (*f*) is an illustration of this, and *The Milkmaid Case* (*g*), already cited, and *Meeus' Application* (*h*), are instances belonging to both classes.

Where the alleged resemblance is put upon the probability of the application of the same name to the goods of both the applicant and the opponent, it is often contended in reply, (a) that the name is in fact the name or description of the goods themselves; (b) that it is suggested by words, or devices, comprised in the marks, which are common to the trade, or is itself a word or the name of a mark which is common to the trade; or (c) that the proprietor of the opposing mark is seeking to secure a monopoly in the word under cover of his mark.

Answers to objections founded upon names derived from marks.

(a) The first objection is really included in the second, but it is convenient to state it separately. It is a question of fact whether the name concerned is the name of the goods or of some quality (*i*) attributed to them, having no reference to the traders by whom they are made or dealt in, or whether it conveys a representation that the goods are made or dealt in by the proprietors of the opposing mark. The question has already been discussed (*k*). All the authorities relevant to it before 1890 were discussed and commented on in *The Osman Towel Case* (*l*) by Chitty, J., and the Court of Appeal. As has been shown elsewhere (*m*), where a name was first given by a trader to

(a) Where the name is descriptive of the goods.

Where the opponent has

in a new mark, was rejected because there were several old anchor marks; *Thewlis and Blakey's Tm.*, 10 R. P. C. 369 (1893), North, J.

(*f*) *Barlow v. Johnson*, 7 R. P. C. 395 (1890), C. A.

(*g*) *Supra*.

(*h*) (1891) 1 Ch. 41; 8 R. P. C. 25 (1890), Chitty, J., (*Key Brand Geneva*).

(*i*) *o. g.*, excellence: *Arbenz' Ap-*

plication, 35 C. D. 248; 4 R. P. C. 143 (1886), C. A., (*Gem Air-guns*); or size: *Wood v. Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A., (*Eton cigarettes*).

(*k*) Chap. II., p. 36; see *per* Lord Selborne, in *Singer v. Wilson*, 3 App. Cas. p. 376 (1878).

(*l*) *Barlow v. Johnson*, 7 R. P. C. 395.

(*m*) Chap. II., pp. 36 *et seq.*

had a monopoly in the goods.

goods in the manufacture or sale of which he had a monopoly, whether as of right under a patent (*n*), or in fact because he was the first inventor or introducer of the goods (*o*), the Court will more readily infer that the name is the name of the goods merely, and that it connotes no connection between them and the trader, and the probability that this is the case, is nearly, although not quite, as strong, where, in similar circumstances, the public themselves have taken the name from the trader's marks and applied it to the goods. Of course, it is much more difficult to make out that the name has no such connotation if it is not the sole name applied to the goods in the market.

If the fact is made out that the name suggested by the marks is merely descriptive, and there is no other resemblance which is calculated to deceive, the second mark is entitled to registration. Thus, in *Horsburgh & Co.'s* application, Messrs. Leonard and Ellis, in 1873, adopted, and subsequently registered, a trade-mark comprising the word *valvoline*; four years later the applicants sought to register a different mark comprising the word *valvoleum*. The words were held to be substantially the same, and each of them to be descriptive of the valve oil in connection with which both marks were to be used, and Jessel, M.R., allowed the second mark to be registered (*p*).

(b) Where the name is suggested by matter in the mark common to the trade.

(b) Where the name is suggested by words or devices which are common to the trade and which form part of the trade-mark offered for registration, the words or devices

(*n*) *Wheeler & Wilson Co. v. Shakespear*, 39 L. J. Ch. 36 (1869), James, V.-C.; *Linoleum Co. v. Nairn*, 7 C. D. 334 (1878), Fry, J.; and *Palmer's Tm.*, 24 C. D. 504 (1882), Chitty, J., and C. A.; *Slazenger v. Feltham*, 6 R. P. C. 531 (1889), C. A., (*Demon Raquets*), is a case of an invalid patent.

(*o*) *Leonard and Ellis' Tm.*, 26 C. D. 288 (1884), C. A., (*Valvoline*); *Arbenz' Application*, 35 C. D. 248; 4 R. P. C. 143 (1887), C. A., (*Gem*

Air-guns); *Waterman v. Ayres*, 39 C. D. 29; 5 R. P. C. 368 (1888), C. A., (*Reversi*).

(*p*) 53 L. J. Ch. 237 n. (1878). The opponents had also registered *Valvoline* alone as a trade-mark. It was subsequently removed from the register; *Leonard and Ellis' Tm.*, 26 C. D. 288 (1884), C. A.; *Blair v. Stock*, 52 L. T. 123 (*Strathmore Blend Whisky*); *Loftus' Tm.*, above, p. 174, note (*m*).

must be disclaimed in the application (*q*), and if they form part of the opponent's mark also, a disclaimer should be registered in connection with that mark, and the matter disclaimed cannot be, by itself, relied on to support the opposition (*r*). But the presence of the common elements in both may be an element in creating a general resemblance between the marks looked at as wholes. It seems that where there is no disclaimer on the register, and no application to rectify, the Court will not pay attention to evidence that any part of the opponent's mark is common to the trade (*s*).

The opponent cannot rely on disclaimed matter or words in his mark.

The Star Tobacco Mark Case (*t*) is an authority to show that the suggestion both by the mark of the applicant and by that of the opponent of a word which is common to the trade because it is a name or description for the goods in connection with which both marks are used, is not a sufficient reason for refusing the application to register. There the opponents had registered as an old mark a characteristic eight-pointed star, and also, as a new mark, a label with the star, another device and the word *star*, and they asserted that their goods were frequently sold and ordered as star goods. The applicant's mark consisted of a sea picture within a ring, having a small six-pointed star in the clouds at the top, and a conspicuously drawn anchor in the lower part of the picture, and the words *star of hope*. The judge found that the device of a star, although not the particular star of the opponent's old mark, was common to the trade, and he allowed the registration. "I think," he said, "that

Where the name is common to the trade.

(*q*) Sect. 74. Chap. IX., p. 164 ; *Meeus' Application*, (1891) 1 Ch. 41 ; 8 R. P. C. 25, Chitty, J., (*Key Brand Genera*) ; i.e., unless they are parts of a distinctive label, p. 172.

(*r*) *Pirie v. Goodall*, (1892) 1 Ch. 35 ; 9 R. P. C. 17, C. A., (*parchment bank paper*) ; *Rosenthal v. Reynolds*, (1892) 2 Ch. 301 ; 9 R. P. C. 189, North, J., (*W. R. corsets*) ; *Watt v. O'Hanlon*, 4 R. P. C. 1 (1886),

Porter, M.R., an Irish case, *Loftus' Tm.*, (1894) 1 Ch. 193 ; 11 R. P. C. 29, North, J., (*Unco Gaud Whisky*).

(*s*) *Goodall's Tm.*, 42 C. D. 566 (1889), North, J., (*parchment bank paper*) ; cf the rule that an application to rectify cannot be made by counterclaim, Chap. XI., p. 238.

(*t*) *Re Dexter's Application, Re Wills' Tm.*, (1893) 2 Ch. 262 ; 10 R. P. C. 269, Wright, J.

“the use of the word *star* and the use of the figure of a star are matters *publici juris*, and have been *publici juris* at all material times, except so far as some particular trader may have appropriated a particular phrase in which *star* is used in some special manner, or may have appropriated a particular design in which the figure of a star has assumed a special form, or has been so combined with other matters as to produce a specific thing different from what may be called the ordinary image of a star.”

(c) Where the name is said to give a practical monopoly.

(c) The third ground of reply has been also dealt with in several cases, and it is settled that a trader will not be allowed to acquire or use a mark which will probably lead to his goods being mistaken for those of another, even though this may make it difficult for him to truly describe the place of origin of his goods, or to present them to purchasers in the form in which they expect to receive goods of the class (*u*). Thus, in *Wilkinson v. Griffith* (*x*), an infringement case, Romer, J., in restraining the defendants from using their label, relied upon evidence that the plaintiff's goods were known as red stamp polish from the figures upon his labels, although it was urged on the defendant's behalf that the plaintiff's claim practically involved a claim to a monopoly in red labelled goods. The judge, however, expressly stated that the plaintiff was not entitled to any such monopoly. “I by no means hold, nor do I think, the evidence as a whole can fairly be said to establish,” he said, “that any red mark on a label of the defendant would render that label deceptive. I can imagine many red marks, or even red medals, being so used as to prevent deception.” But it is for the applicant for registration of the mark which is alleged to be deceptive to make it clear that it is not.

The Red Medal Polish Case.

(*u*) *Wotherspoon v. Currie*, 5 L. R. H. L. 508 (1872), (*Glenfield Starch*); *Montgomery v. Thompson*, (1891) A. C. 217; 8 R. P. C. 361, (*Stone Ales.*) It is to be noted, however, that these were both cases of at-

tempted frauds. *Johnston v. Orr-Ewing*, 7 App. Cas. 219 (1887) H. L., (*Two Elephant Yarns*).

(*x*) 8 R. P. C. 370 (1891), Romer, J., (*Red Stamp Polish*).

Evidence (*y*).

It follows that upon any question with respect to the registration of a mark which arises under sub-sect. 72 (2) it is material for the comptroller or the Court to be furnished with evidence of the matters of fact involved in the propositions stated above wherever it is alleged that they tend to increase or diminish the resemblance referred to in the sub-section.

Evidence material to the question of resemblance.

Besides this evidence, the evidence of persons who are well acquainted with the trade concerned is constantly tendered by the parties to show that in the opinion of such persons, as experts, the alleged resemblance between the contrasted marks is, or is not, calculated to deceive. Judges have often expressed much impatience of evidence of this class (*z*), and certainly it frequently presents in an eminent degree the characteristic vices of expert testimony. It consists in general of opinions formed after the dispute has arisen; not upon any judicial balance of the opposing contentions, but upon a scrutiny of the subject directed to discover what can be said in favour of one side only. And where the question is as to the degree of a resemblance between two words or designs, or as to whether a difference in particular parts of two contrasted labels is substantial or immaterial, reasons can rarely be found by the witnesses to recommend an opinion to anyone who has not conceived it for himself without their assistance.

Expert evidence as to probability of deception.

The judge must in the end act upon his own view upon a comparison of the marks, having regard to the matters of fact referred to above (*a*); but it is settled that the expert evidence is admissible, and in particular cases it

(*y*) As to the evidence upon applications to register generally, see Chap. IV., pp. 73, 74 and 83. Where the appeal to the Court is by summons the evidence should be completed before the adjournment into Court, *per* Stirling, J., in *Jackson & Co. v. Napper*, 35 C. D. p. 166; 4 R. P. C. 45.

(*z*) *Re Jelley*, 51 L. J. Ch. 639, n., Jessel, M. R. (1878); *Pinto v. Badman*, 8 R. P. C. 181 (1891) C. A.

(*a*) The question is to be decided partly by the judge's eyesight, and partly by his view of the evidence. *Farrow's Tm.*, 7 R. P. C. 260; 63 L. T. 233 (1890), Stirling, J.

may be of importance, for evidence of what are the surroundings of the marks and the circumstances of the trade concerned may not suffice to enable the Court to judge sufficiently of the influence which a practical acquaintance with such matters would have upon the impression made by the marks on the minds of persons engaged in the trade. Thus, in *Mitchell v. Henry*, the case of the coloured thread marks woven into the selvages of cloth, Cotton, L.J., considered the probability of deception essentially a question for experts (b).

Direct evidence of probability of deception.

Evidence of ordinary members of the public who are not acquainted with the usages of the trade involved, or even of experts, that they think they would, or would not be deceived by the resemblance of one mark to another, is of little assistance in the determination of questions of alleged deceptive similarity (c).

Evidence of actual deception.

If one or more cases of actual deception are made out to the satisfaction of the Court, this will, of course, afford very strong evidence that the resemblance of the marks in question is so close as to be calculated to deceive. But the absence of evidence of actual deception is a circumstance which varies greatly in weight according to the nature of the case. It is conceived that it can never be conclusive by itself (d); but where the marks have been circulating side by side in the market where deception is alleged to be probable, the fact that no one appears to have been misled is very material (e), unless the absence of evidence is ex-

(b) 15 C. D. p. 195 (1880); and see *Christiansen's Tm.*, 3 R. P. C. 54 (1885), Chitty, J., and C. A.

(c) See *Kutnow's Tm.*, 10 R. P. C. 401 (1893), North, J., (*Carlsbad salts*). In the *Apollinaris Case*, Fry, L.J., compared this evidence to the oaths of compurgators in a mediæval trial. (1891) 2 Ch. 186; 8 R. P. C. 137.

(d) *Edelsten v. Edelsten*, 1 D. G. J. & S. 185 (1893), Westbury, L.C.; *Compania Général de Tabacos v. Rehder*, 5 R. P. C. 61 (1887), Kay,

J.; *Reddaway & Co. v. Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9 R. P. C. 503, C. A.; *Line & Co. v. Daniell & Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 71, C. A.

(e) *Cope v. Evans*, 18 L. R. Eq. 138 (1874), Hall, V.-C.; *Rodgers v. Rodgers*, 31 L. T. 285 (1874), Mellish, L.J.; *Estcourt v. The Estcourt Hop Essence Co.*, L. R. 10 Ch. 276 (1875), C. A.; *Lambert's Tm.*, 5 R. P. C. 556; 61 L. T. 138

plained by the difficulty of procuring witnesses from a distant foreign market (*f'*), or otherwise, satisfactorily. On the other hand, if one or both of the marks is new or nearly new there can have been no opportunity, or little opportunity, for deception to occur.

The cases following, of marks held to have, or not to have, such resemblance to each other as to be calculated to deceive, illustrate the principles referred to above. Many of them have been cited already.

Examples and illustrations.

Contrasted Devices.

A pointer eating out of a pot, too near for registration to a similar dog standing by a pail with STANCH beneath it; *Jelley's Application*, 51 L. J. Ch. 639, n. A twisted curved horn, with a twig bearing two roses, too near a similar untwisted horn with a cord having two loops in the same place as the roses in the twig; *Rosing's Application*, 54 L. J. Ch. 975, n. A triangular frame with words upon it and a church inside, too near Bass's solid triangle; *Worthington's Tm.*, 14 C. D. 8; so also a red diamond within a blue diamond; *Turney and Sons' Tm.*, 10 Times L. R. 175. A half-length figure of a milkmaid, with the word *Dairy-maid*, too near a full length figure of a milkmaid carrying two pails; *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 C. D. 454; 3 R. P. C. 28. A woman's head wearing a helmet with ATHENA beneath, not too near a man's head with WAY beneath; *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102. A tower in an oval border, with a dog and harp, too near a tower, dog, and harp without any border; *Speer's Tm.*, 4 R. P. C. 521. An oval label containing interlaced triangular frames with a stag's head within them, too near an oval label with three superimposed solid triangles, although the lettering on the marks was conspicuously different; *Biegel's Tm.*, 4 R. P. C. 525; 57 L. T. 247. A sheep suspended by its middle, with the words GOLDEN FLEECE, too near a somewhat different

(1888), North, J.; and *Baker v. Tm.*, *infra*, p. 229.

Rowson, 45 C. D. 619; 8 R. P. C. (f) *Wilkinson v. Griffith*, 9 R. P. C. 370 (1891), Rozaer, J. at p. 107 (1889), North, J.; *Talbot's*

sheep with the same words; *The Australian Wine Importers' Tm.*, 41 C. D. 278; 6 R. P. C. 311. A pig in outline, and H. B. & Co., not too near shaded pointer dog, and STANCH; *Haines, Batchelor & Co.'s Tm.*, 5 R. P. C. 669. A tobacco pipe and dart, not too near a tobacco pipe alone; *Lambert's Tm.*, 5 R. P. C. 542; 6 R. P. C. 344; 61 L. T. 138. A charging buffalo, too near a bull's head, both being placed in silver rings on similar yellow wrappers; *Farrow's Tm.*, 7 R. P. C. 260; 63 L. T. 233. A mark having as its sole essential particular a lion bearing a sheaf, too near a mark having as an essential particular a lion with a crown; *Murphy's Tm.*, 7 R. P. C. 163. An elephant in a border with lettering round it, an infringement of a somewhat different elephant alone; *Upper Assam Tea Co. v. Herbert & Co.*, 7 R. P. C. 183. A label bearing a winged cross surrounded by two circles in its upper third, not an infringement of a similar label, being a lighthouse similarly surrounded and placed; *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89. A label with two red medals and a balloon, an infringement of a similar label with two red medals only, both labels being used for polish known in India, from the latter label, as red metal polish; *Wilkinson v. Griffith*, 8 R. P. C. 370.

Contrasted Words.

WHITE ROSE, too near ROSALINE; *White Rose Tm.*, 30 C. D. 505. CONDI-SANITAS and SANITANT infringements of SANITAS; *Sanitas Co. v. Condy*, 4 R. P. C. 195 and 530; 56 L. T. 621. BOYD'S UNRIVALLED HARNESS COMPOSITION, in a label with the Arms of the City of Dublin, not an infringement of PROPERT'S IMPROVED HARNESS COMPOSITION in a label, with a fox's head, the labels being similarly got up; *Beddow v. Boyd*, 4 R. P. C. 310. APOLLINIS an infringement of APOLLINARIS; *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478. STEINBERG, an infringement of STEINWAY, the words being used with devices showing a general similarity; *Steinway v. Henshaw*, 5 R. P. C. 77. EMOLLIO too near EMOLLINE; *Grossmith's Tm.*, 6 R. P. C. 180; 60 L. T. 612. SWIFT'S SPECIFIC

occurring in a trade-mark not calculated to deceive, merely because the words were descriptive of the opponent's drug; *Sicist Specific Co.'s Tm.*, 6 R. P. C. 352. OOMOO, not too near EMU; *Burgoyne's Tm.*, 6 R. P. C. 229; 61 L. T. 39. KOKOKO, too near the common word COCO; *Jackson Co.'s Tm.*, 6 R. P. C. 80. DEMOTIC, an infringement of DEMON; *Slazenger v. Feltham*, 6 R. P. C. 531. DUNN'S FRUIT SALT BAKING POWDER, too near ENO'S FRUIT SALT; *Eno v. Dunn*, 41 C. D. 439; 15 App. Cas. 252; 7 R. P. C. 311; subsequently held to be an infringement, 10 R. P. C. 261. EL DEVINO, an infringement of EL DESTINO; *Pinto v. Trott*, 8 R. P. C. 173. Label with EL DESTINACION, an infringement of a similar label with EL DESTINO; *Pinto v. Badman*, 8 R. P. C. 181. Label with LONDON PICKLES, an infringement of similar label with LONDON PICKLE Co.; *Hammond v. Malcolm, Brunner & Co.*, 9 R. P. C. 301.

III. Deceptive Marks.

It is provided by sect. 73 that—

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

Sect. 73.
Deceptive
marks.

This is taken from sect. 6 of the Act of 1875, except that in the last line “justice” is substituted for “equity,” and the word “exclusive” which qualified “use,” both in the old Act and in the Act of 1883, was removed, upon the suggestion of Lord Herschell's Committee, by the Act of 1888. The Committee say: “Words might be offered for registration in conjunction with a trade-mark for which the applicant did not claim, and of which he would not be entitled to the exclusive use, but the use of which might

“Exclusive
use.”

(*g*) See p. 217, below.

“nevertheless be calculated to deceive, and so be disentitled to the protection of a court of justice.”

The restriction of the section would not seem to be carried any further by sect. 86, which authorizes the comptroller to refuse to register a trade-mark of which the use would, in his opinion, be contrary to law or morality.

The section extends beyond the old rule of estoppel by misrepresentation.

The Fruit Salt Case.

The provisions of the section were, no doubt, intended to embody the old rule of the Court of Chancery, which refused protection to the owner of a deceptive trade-mark (*h*); and it was held, by Jessel, M.R., that their operation was confined to cases where the marks were in themselves inherently deceptive (*i*); but the Courts have held that the restriction is of wider scope than the old rule, or than this construction would suggest (*k*). The leading case in point is *Eno v. Dunn* (*l*), in which the House of Lords (Lord Halsbury and Lord Morris dissenting) overruled the judgment of the Court of Appeal (Lindley and Fry, L.JJ., Cotton, L.J., dissenting), and restored that of Kay, J. The question in that case was whether the words *fruit salt* occurring in a mark consisting of the words *Dunn's Fruit Salt Trade-Mark Baking Powder*, and in a mark consisting of a distinctive label, quite different in character from the device used by the opponent, Eno, and bearing the words *Dunn's Fruit Salt Baking Powder*, were calculated to deceive, having regard to the well-known use of the words as the name of Eno's Fruit Salt. Eno, in the first instance, based his opposition to Dunn's application to register his marks partially upon his title as the owner of the mark "Fruit Salt," registered as

(*h*) See Chap. XV., p. 336; and Lord Macnaghten's judgment in *Eno v. Dunn*, *infra*.

(*i*) *Horsburgh's Application*, 53 L. J. Ch. 237 n. (1878), (*Valvoleum*).

(*k*) See the judgment of Cotton, L.J., in which the majority of the law lords concurred, in *Eno v.*

Dunn, 41 C. D. p. 448.

(*l*) 15 App. Cas. 252; 7 R. P. C. 311; *Dunn's Tm.* (1889), subsequently an injunction was granted to restrain Dunn & Co. using the words *Fruit Salt*; *Eno v. Dunn*, 10 R. P. C. 261 (1893), Kekewich, J.

“a proprietary medicine for human use,” and also as a “dry preparation for making a non-intoxicating beverage”; but finding that he could not prove user of that mark before 1875, and the words were consequently not capable of registration, he was driven to consent to its removal from the register, and to rely wholly upon the alleged deceptiveness of the marks propounded by Dunn. The marks were normally used for different goods. Dunn’s preparation was a baking powder, and Eno’s an aperient effervescing powder; but evidence was given that, in a very few instances, Eno’s salt had been used as a baking powder, although it was shown to be very unsuitable for the purpose. The majority of the law lords held that Dunn’s marks were deceptive, and the application to register was dismissed. Lord Herschell and Lord Macnaghten based their judgments upon the discretion conferred on the comptroller—apart from the sections considered in this chapter—to refuse marks from which it is not clear that deception might not result. Lord Herschell said: “I think it is enough to say that I am not satisfied that there would be no reasonable danger of the public being so deceived. The case was argued on behalf of the respondent, as if he had an absolute right to have any trade-mark registered which was not proved to fall within the terms of either the 72nd or 73rd section of the Act. I do not so read the statute. Those sections prohibit the registration of a trade-mark in certain specified cases; but there is no duty cast upon the comptroller of registering every other trade-mark that may be applied for. On the contrary, whilst he is in certain cases prohibited from registering, a discretion whether to register or not appears to me to be in all cases fairly conferred.” And Lord Macnaghten said of the marks: “They are calculated, and I think designed, to create a confusion in the minds of those persons to whom Mr. Dunn’s advertisements are addressed, and to lead the ordinary run of such persons to suppose that his baking powder is in some way or other

Doubtful new marks to be rejected.

Lord Herschell’s judgment.

Lord Macnaghten’s judgment.

“connected with Mr. Eno’s preparation”; and he held, therefore, that the marks ought to be rejected, for 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.”

Lord
Watson’s
judgment.

Lord Watson, on the other hand, treated the case as one falling within the 73rd section. “These prohibitory clauses,” he said, referring to sects. 73 and 72 (2), “cast upon the applicant the duty of satisfying the comptroller, or the Court, that the trade-mark which he proposes to register does not come within their scope. In an inquiry like the present, (the applicant) does not hold the same position which he would have occupied if he had been defending himself against an action for infringement. There, the onus of showing that his trade-mark was calculated to mislead rests, not on him, but upon the party alleging infringement; here, he is *in petitorio*, and must justify the registration of his trade-mark by showing affirmatively that it is not calculated to deceive. It appears to me to be a necessary consequence that, *in dubio*, his application ought to be disallowed.” And upon the question of fact, he said: “There would be a supposed connection in the minds of many persons, who would naturally assume that the baking powder had been manufactured with the appellant’s fruit salt, and purchase it in that belief; so that a batch of badly made baking powder might seriously injure the credit of the effervescing powder” (!).

Mark contain-
ing name of
the oppo-
nent’s goods
not necessa-
rily deceptive.

But a mark is not calculated to deceive merely because it contains an ordinary description of an article of commerce which is occasionally used to describe a rival trader’s goods (*m*). To hold otherwise would certainly be, as Fry, L.J., said, in *The Fruit Salt Case*, to allow the objector “to enclose” and appropriate as private property

(*l*) See above, p. 64, “the Comptroller’s discretion.”

(*m*) See *Dexter’s Application*,

(1893) 2 Ch. 262; 10 R. P. C. 269, Wright, J., (*Star Tobacco*), above, p. 203.

“certain little strips of the great open common of the English language” (*n*). Thus, where *The Smokeless Powder Co., Ltd.*, had registered a label bearing a target, with their name printed prominently upon it, supported on one side by the figure of a sportsman, and on the other by that of a rifleman, an unsuccessful attempt was made by a rival powder making company to have the mark removed from the register, or to have a disclaimer of the words *Smokeless Powder* added to the registration. The application failed as to the disclaimer, because the words were not distinctive, and also because they were not additions within the meaning of sect. 74, and were part of the name of the proprietors of the mark. It was argued that the presence of the words in the label was in effect a claim of a monopoly of the words, although the manager of the respondent company stated that the company made no such claim; but Chitty, J., decided against the objection (*o*), and held that the use of the words in the mark was not calculated to deceive. No such identification of the words in question with the applicant's goods was proved in this case, as was shown in *The Fruit Salt Case* of the words *Fruit Salt* with Eno's powder, and in *The Stone Ales Case* (*p*) of the words *Stone Ales* with Joule and Sons' beer; but, apart from this, the case seems readily distinguishable, on the ground already mentioned, that the words here concerned were the ordinary words which any one would choose to describe the goods both of the applicants and of the respondents, and words which, apart from the Acts, could never have become, for such goods, the subject of exclusive rights (*q*).

The Smokeless Powder Co. Case.

And as the presence of a common word in a label does not make the label deceptive, although the word is used of the opponent's goods (*r*), so neither does the presence of a device which suggests such a word. Thus, in *Kutnow's*

Device suggesting the name of the opponent's goods.

(*n*) 41 C. D. at p. 455.

(*p*) (1891) App. Cas. 218; 8

(*o*) See Chap. VIII., p. 138,

R. P. O. 361.

“Label.”

(*q*) Chap. II., pp. 35 *et seq.*

(*r*) See above, p. 201.

Case (s), a label, in which a picture of the Deer-leap rock at Carlsbad, a well-known and remarkable object in the environs of the town, was allowed to be registered for use with Carlsbad Salts, the name of the salts being common property, and applicable both to the natural product of the springs at Carlsbad and to artificial imitations of it. The opponents in the case were the Municipality of Carlsbad,—who own both the springs and the rock in question,—and their lessees of the springs. They sought to show that the use of the picture by the applicant would be calculated to lead purchasers to believe that the goods upon which it appeared were their goods; but the judge held that it would only suggest that the goods were Carlsbad Salts. And this would be true if, as he was bound to anticipate, the applicant used his mark honestly. The opponents had no monopoly in Carlsbad Salts.

Trade-mark attached to part of the mark only may be deceptive.

In *The Apollinaris Case*, Fry, L.J., in delivering the judgment of the Court of Appeal, expressed an opinion that a label which bears the word trade-mark so printed upon it as apparently to refer only to a device which forms part of the label, the whole label being, in fact, the trade-mark, is calculated to deceive (*t*), notwithstanding that the objection might have been, but was not, taken in the earlier case of *Hudson's Trade-Marks* (*u*), where the Court of Appeal decided in favour of the mark propounded; and in *Re Wills' Trade-Marks*, Wright, J., subsequently ordered a mark to be removed from the register on this ground (*x*). This objection has caused considerable uneasiness to proprietors of trade-marks, and has led to several applications to the Court, under sect. 92, for leave to amend registered marks, for the word trade-mark is often printed upon labels and other trade-marks; but it is to be observed that it is only objectionable where its presence apparently implies that part of the actual mark is the whole trade-

(*s*) 10 R. P. C. 401 (1893),
North, J.

(*u*) 32 C. D. 311 (1886).

(*t*) (1891) 2 Ch. at p. 233; 4
R. P. C. 478.

(*x*) (1893) 2 Ch. 262; 10 R. P. C.

mark. In the mark to which Fry, L.J., was directly referring, the word was placed immediately under a red disc, which was the most prominent feature in the label. "It is a question of fact in every case where a man puts the term 'trade-mark' on his device, or some part of it, whether he does or does not so place the words as to indicate to the public that he is claiming a particular part of the trade-mark only" (y). In *Colman's Trade-Marks* (z), Kekewich, J., allowed "trade-mark" to be struck out of a number of labels, on condition that the proprietors should state what were and what were not the essential particulars of the marks (a). But in a later case (b), Chitty, J., refused to allow a similar alteration to be made in an old mark on the ground that, in accordance with the decisions of the Court, an old mark ought to be registered and kept registered, in all essential particulars, as it was used before the 13th of August, 1875. In the earlier case, two of the marks allowed to be altered had, in fact, been old marks, but in that case the comptroller had raised no objection on this ground, as he did in the later case (b).

Alterations of marks to remove trade-mark.

Fry, L.J., also suggested, in *The Apollinaris Case* (c), that the indorsement, "imitations of this water will be prosecuted," upon a label registered for use in connection with a natural mineral water, *Hunyadi Janos*, caused the mark to be calculated to deceive, because it probably meant all imitations of the water, whether fraudulent or not, and was therefore addressed to artificial *Hunyadi Janos* waters which might have been legitimately made and legitimately sold under the name, provided that it was made clear that they were artificial waters (c). It may be noted that the comptroller refuses to register the words "registered,"

Threats of prosecution in the mark may be deceptive.

The comptroller refuses

(y) *Per* Chitty, J., in *Hammond & Co. v. Malcolm, Brunner & Co.*, 9 R. P. C. p. 307.

(z) (1891) 2 Ch. 402; 8 R. P. C. 209.

(a) Cf. sect. 64 (2), and see Chap. IX., p. 166.

(b) *Phillips' Tm.* (1891) 3 Ch. 139; 8 R. P. C. 469; and see *Henry Clay & Co.'s Tm.*, (1892) 3 Ch. 549; 9 R. P. C. 449, Kekewich, J.

(c) *Supra*; (1891) 2 Ch. p. 226.

registered,
copyright, &c.

“registered design,” “copyright,” “entered at Stationers’ Hall,” or “to counterfeit this is a forgery” (*d*). And in the case of the word “registered” this refusal has been supported by the Court (*e*).

Mark refer-
ring to parti-
cular goods.

And when there appears on the face of a trade-mark an indication of the goods to which the mark is to be applied, the claim for its registration must be in respect of those goods only (*f*).

Deceptive
representa-
tion as to
origin of
goods.

The questions—Who can register a trade-mark? (*g*), and, What is the implication of a trade-mark with regard to the origin of the goods? (*h*), are dealt with elsewhere. It has been held, that a mark comprising the consignees’ names, and a representation of their house, which is used by the consignor, is calculated to deceive (*i*).

The recent case of *Hill’s Trade-Mark* (*k*) furnishes a good illustration of a deceptive mark. The mark consisted of a fir tree, with the words *Forrest* above and *London* below it in large letters, and it was registered and used by a Coventry watch-maker, who had no connection with the business formerly carried on by Forrest in London. He alleged, in answer to an application to remove the mark, that the words in question were commonly used by the trade in Coventry, although, in a correspondence with the applicant, he had previously claimed an exclusive right to them. The judge held that the mark was calculated and intended to deceive (*l*).

A mark which has been used fraudulently, or for the purposes of a fraudulent trade, if offered for registration, is open to the objection that its further use will tend to

(*d*) Instructions, 29, p. 631.

(*e*) *Meikle’s Tms.*, 46 L. J. Ch. 17 (1876), Hall, V.-C.

(*f*) Instructions, 31; see *ante*, p. 89.

(*g*) Chap. IV., p. 58.

(*h*) Chap. II., pp. 49 *et seq.*; see also Chap. XV., p. 301, “joint trade-marks.”

(*i*) *Jones’ Tm.*, 53 L. T. 1 (1885), C. A.

(*k*) 10 R. P. C. 113 (1893), Chitty, J.

(*l*) Its use was unquestionably an offence under the M. M. A., 1887; see Book II., Chap. I., p. 491.

continue the old deceptions, and it is therefore a deceptive mark, and registration of it should be refused (*m*).

The words "or otherwise" in the section, having regard to sect. 86, referred to above, and other parts of the Acts, seem to be merely redundant. They have, however, been held to be sufficient to exclude the registration, as part of a trade-mark, of words which are merely descriptive of the article upon which the mark is to be used, 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*). But the decision in the case referred to rested upon the opinion of the learned judge that, if he allowed the words in question to be registered as part of the applicant's mark, he would be giving him a monopoly in the words, to which he was not entitled.

"Or otherwise."

(*m*) *Fuente's Tm.* (1891) 2 Ch. 166; 8 R. P. C. 214, Romer, J.; see further, as to trade-marks vitiated by misrepresentation,

Chap. XV., pp. 336 *et seq.*

(*n*) *Anderson's Tm.*, 26 C. D. at p. 415 (1884), Chitty, J., (*Brand Baron Liebig*).

CHAPTER XI.

RECTIFICATION OF THE REGISTER.

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PROVISION is made for the rectification of the register by three sections of the Act. Sect. 90 provides for cases where any person is aggrieved by the omission from, or by the entry upon, the register of any particulars without sufficient cause, and enables the Court to direct the necessary rectification to be made; sect. 91 authorizes the comptroller to correct clerical errors in the registration, and, at the request of the proprietor, to cancel the entry, or part of the entry, of a trade-mark on the register; and sect. 92 enables the Court, upon application, to permit an addition to, or alteration of, a registered mark to be made in any non-essential particular. The Act also directs that after fourteen years from its registration a mark shall be removed from the register unless the prescribed fee be paid. This provision is considered in another chapter (*a*).

(*a*) Sect. 79; see Chap. XIII., p. 291.

1. Rectification under Sect. 90.

Sect. 90 (*b*) is in the following terms:—

Section 90.

“ (1) The Court may, on the application of any person aggrieved by the omission without sufficient cause of the name of any person [or of any other particulars] (*c*) from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging, or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.

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

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

Decisions on the Act of 1875.

This section corresponds to parts of sect. 5 of the Act of 1875 (*d*), and is to the same effect, but is expressed in more general terms. No distinction between the construction of the two enactments appears to have been taken (*e*), but, on the contrary, decisions under the former are constantly cited and applied in cases falling under the present section (*f*).

“ Any other particulars.”

The amendment “or of any other particulars” was made upon the recommendation of Lord Herschell’s Committee (*g*), so as to make the jurisdiction of the Court

(*b*) Cf. Companies Act, 1862, sect. 35.

(*c*) Act of 1888, sect. 23.

(*d*) Appendix, p. 588.

(*e*) Except that appeals from the comptroller on applications to register are now governed by a separate

section, sect. 62; see *Normal Co.’s Trm.*, 35 C. D. 231; 4 R. P. C. 123 (1886), Chitty, J., and C. A.

(*f*) See *Baker v. Rawson*, 45 C. D. at p. 531; 8 R. P. C. 89, (1890), North, J.

(*g*) Report of 1888, p. xiv.

to rectify applicable to every particular which ought to be entered upon the register.

Who are persons aggrieved.

The application to rectify the register must be made by a person who is aggrieved by the entry or omission complained of if it is made without sufficient cause. In recent judgments, the phrase in the section has been very liberally construed, and it would be difficult to find any person engaged in the trade concerned, or any allied or connected trade, who was prevented by the qualification which it requires from moving to rectify the register. The persons who are aggrieved are, it is held, all persons who are in some way or other substantially interested in having the mark removed—where it is a question of removal—from the register, or persons who would be substantially damaged if the mark remained. It is very difficult to frame a nearer definition than that (*h*).

All persons substantially inconvenienced if the registration is wrong.

The leading case on the subject is that of *The Apollinaris Co.'s Trade-Marks*. In that case, Fry, L.J., in delivering the judgment of the Court of Appeal, said: "We approach this question (Are the applicants persons aggrieved?) on the assumption, which is necessary, of course, to answer this question, that the trade-mark was wrongly on the register; and, further, with these two observations: in the first place, that the question is merely one of *locus standi*; and in the second, that the words 'person aggrieved' appear to us to have been introduced into the statute to prevent the action of common informers, or of persons interfering from merely sentimental motives (*i*); but that they must not be so read as to make evidence of great and serious damage a condition precedent to a right to apply. Further, we are of opinion that, wherever one trader, by means of his wrongly

The Apollinaris Case.

The question is one of *locus standi* only.

(*h*) *Per* Bowen, L.J., in *Powell's Tm.*, (1893) 2 Ch. 388; 10 R. P. C. 195.

(1884), and the judgments of Lindley and Fry, L.JJ., on the subsequent hearing of the same case, 5. . J. Ch. 545.

(*i*) See Lord Selborne's judgment, in *Rivière's Tm.*, 20 C. D. at p. 54

“registered trade-mark, narrows the area of business open to his rivals, and thereby either immediately excludes, or with reasonable probability will in the future exclude, a rival from a portion of that trade into which he desires to enter, that rival is an ‘aggrieved person’” (k). And in the same case the Court of Appeal held, that the fact that the applicants for registration of certain new marks had attempted to support their application by reference to other marks already registered by them, and notwithstanding that they subsequently abandoned the attempt, made the opponents of the registration of the former marks persons aggrieved by the registration of the marks already registered, and therefore persons entitled to apply for the removal of them from the register (l); and, further, that an alleged infringer of a mark is always a person aggrieved by its registration (m). “The practical conclusion of this view,” Fry, L.J., said, “is, we think, a sound one. It will stop the practice, of which we have seen instances in this case, of a trader registering his mark without justification, using it as a means to intimidate or coerce other traders, and then, at the bar, alleging that the threat was idle, and the persons against whom it was used are not aggrieved thereby” (n).

Any person
intimidated
or harassed
by the regis-
tration.

Powell's Case.

The words in question have received their most liberal interpretation in the recent case of *Powell's Trade-Mark* (o). In that case the applicants were being sued to restrain them from passing off a sauce called *London Relish* as the goods of the registered proprietor of a mark consisting of the words *Yorkshire Relish* by means of a label said to resemble one of his trade labels. They moved to expunge the mark *Yorkshire Relish*, and they were held to be “persons aggrieved” notwithstanding that they did not trade in *Yorkshire Relish Sauce*, and had not even considered the question of trading in it, and that the Court thought it

(k) (1891) 2 Ch. p. 224; 8 R. P. C. 137.

(l) *Ibid.*, p. 228.

(m) See also *Baker v. Rawson*, 45 C. D. 579; 8 R. P. C. 89 (1890), North, J.

(n) (1891) 2 Ch. p. 229.

(o) (1893) 2 Ch. 388; (1894) A. C. 8; 10 R. P. C. 195; 11 R. P. C. 4, Chitty, J., C. A., and H. L.

probable that they could not trade in it under the same name, without wrongfully causing their goods to be taken for those of the respondent, the registered proprietor of the mark.

It has been held that a defendant charged in an action with passing off his goods as those of the plaintiff (*p*), is aggrieved by the registration of a trade-mark referred to in the plaintiff's pleadings, although no case of infringement is set up (*q*); and so also a trader who wishes to use the registered mark, not as a trade-mark, but as a description of his goods (*r*). And the applicant does not cease to be a person aggrieved because the registered proprietor offers to register a disclaimer, or to confine the use of the mark to particular goods in such manner that if the disclaimer or limitation were actually registered the applicant's grievance would be removed (*s*); for, as was pointed out by Fry, L.J., in the passage quoted above, the grievance is only necessary to give a *locus standi*, and it exists if at the time when the application is launched the registration is such as to occasion it.

Defendant in a passing off action.

Offer of a disclaimer is no answer to an application to rectify.

The exporter of goods made abroad, which are brought to England and then shipped to the Colonies, is a person aggrieved by the registration of a mark having such a resemblance to the mark which he has registered, and which he uses in his trade, as is calculated to deceive, although the mark objected to is employed in a trade confined wholly or almost wholly to England, and not extending to the Colonies (*t*).

Exporter aggrieved by mark for home trade.

And a foreigner may be a "person aggrieved" by the registration of a mark. This was decided by the Court of Appeal, overruling the judgment of Pearson, J., in *Rivière's*

Foreigner.

(*p*) See Chap. XVI., p. 295.

(*q*) *Gianacis' Tm.*, 6 R. P. C. 467; 58 L. J. Ch. 782 (1889), North, J.

(*r*) *Ralph's Tm.*, 25 C. D. 194 (1883), Pearson, J., (*Homewasher*); *Rose v. Evans*, 48 L. J. Ch. 618 (1879), Hall, V.-C., (*Limetta*).

(*s*) *Batt's Tm.*, 6 R. P. C. 493 (1889), Chitty, J.; *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1890), North, J.

(*t*) *The Société Anonyme des Verreries de l'Etoile*, (1894) 1 Ch. 61; W. N. (1894) 42; 10 R. P. C. 436; 11 R. P. C. 142, Stirling, J., and C. A.

Case (u), where the applicants, who carried on business in India, but did not trade or intend to trade in England, alleged that on their request to register the mark in question for them, the registered proprietors had wrongfully registered it in their own names, and the Court, in holding that the applicants were aggrieved, assumed, but did not decide (*x*), that, as foreign traders, the applicants could not themselves have registered the mark.

Wider view
now taken
than in the
earlier cases.

On the further hearing of the case just cited (*y*), it was shown that the registered mark was an old mark belonging to the respondents, Rivière & Co., but that they had for many years allowed it to be used upon labels bearing the name of the applicants, McDowell & Co., for brandy manufactured by Rivière & Co., and shipped by them to McDowell & Co. for sale in India. The labels were used by McDowell & Co. upon brandy not made by or purchased from Rivière & Co., after the rupture of business relations between the parties, and Rivière & Co. had commenced proceedings in India for infringement in respect of this user. Under these circumstances, Pearson, J., and the Court of Appeal held that the applicants were not in fact aggrieved by the registration, but that it was rightly made, and they refused to annul it. Lindley, L.J., said: "Aggrieved in the sense of being annoyed (McDowell & Co.) certainly were, and, I think, not without cause; but aggrieved in the sense in which it is necessary they should be aggrieved—in the sense of sustaining legal damage either immediate or prospective—they have not shown that they were"; and Fry, L.J., said it was possible that they might be injured, but there was no reason to suppose that they would be, and therefore they were not within the section (*z*). In subsequent cases the section, and the phrase "person aggrieved," has been more stringently

(*u*) 26 C. D. 48 (1884), decided on the Act of 1875.

(*x*) It is clear that the present Act contemplates registrations by foreign traders; see sects. 103 and

104, and sect. 8 of the Act of 1888.

(*y*) 55 L. J. Ch. 545; 53 L. T. 237 (1885).

(*z*) *i. e.*, sect. 5 of the Act of 1875.

construed against the registered proprietor, and although there is no conflict between this decision (*a*) and the decisions cited above, it is plain that a different view was taken of the section in them to that acted upon in it.

The Exercise of the Jurisdiction under the Section.

The question of the grievance of the applicant being merely one of *locus standi*, if on the face of the proceedings the applicant is enabled, as a person aggrieved, to bring his application before the Court, the Court has jurisdiction to rectify the register, which, in the case of a mark not belonging to the class of marks admitted to registration under the Acts (*b*), it ought to exercise, even under circumstances in which the applicant is estopped from exercising the right with which the registration interferes. Thus, in *The Stone Ales Case* (*c*), the Court of Appeal removed the plaintiffs' mark, *Stone Ale*, from the register on the application of the defendant, although they maintained the injunction granted by Chitty, J., restraining the defendant from selling goods not of the plaintiffs' manufacture under the name in question.

Where the mark was incapable of registration it must be removed.

And the demerits of applicant in any such case are irrelevant to the question whether rectification should be ordered or not, for the question is not between the applicant on the one hand and the respondent on the other, but between the public and the respondent. Where, therefore, a mark on the register bearing the words *Forrest London* was shown to be deceptive, because it was used by a Coventry watch-maker who had no connection with the business of Forrest once carried on in London, Mr. Justice Chitty refused to enter upon an inquiry

The conduct of the applicant is irrelevant.

(*a*) Because the Court held that the mark was properly registered.

(*b*) See Chap. VIII., p. 106.

(*c*) *Thompson v. Montgomery*, 45 C. D. 35; 6 R. P. C. 404 (1889). There was no appeal to the H. L. against this order. The words had

not been used as a trade-mark before 13th August, 1875, and were not fancy words. See *Powell's Tm.*, (1893) 2 Ch. 388; 10 R. P. C. 63, 195; (1894) A. C. 8; 11 R. P. C. 4; Chitty, J., C. A. and H. L. (*Yorkshire Relish*), above, p. 222.

whether the conduct and the trade of the applicant were tainted with fraud, as the respondent alleged. "I state my opinion," he said, "that directly it is apparent that any part of the trade-mark is calculated to deceive, it is the duty of the Court to order it to be removed" (*d*).

So an agreement by which the respondents, the registered proprietors of a mark, appointed the applicants sole agents for the goods they sold under the mark, and the applicants agreed to sell no goods but those of the respondents under the mark, was held to furnish no answer to an application to remove the mark from the register, and Chitty, J., said: "This is not a question of equity; this is a question of right under the statute; and the defence, which I find really a difficulty in appreciating, appears to me to fail altogether. I am at a loss to discover how any such agreement as this can displace the applicants' right to have the register of trade-marks disencumbered of that which is not a trade-mark at all" (*e*).

Where the mark was capable of registration but might have been opposed.

Paine v. Daniells.

But in cases where the mark attacked belongs to the class of symbols which are capable of registration, the Court has a discretion, under the Acts, whether to expunge or vary the registration or to refuse the application. This was decided by the Court of Appeal in the recent case of *Paine & Co. v. Daniells & Sons' Breweries* (*f*), where the matter was fully considered. In that case the defendants, in an action for infringement and passing off, applied to remove the words *John Bull* and *John Bull Brand* from the plaintiffs' registered labels. It appeared that at the time of the registration of the labels certain third persons, unknown to the plaintiffs, were using *John Bull* as a trade description of their goods in a district, in and around Sheffield, to which the plaintiffs' trade did not extend, but such user had wholly ceased before the date

(*d*) *Hill's Tm.*, 10 R. P. C. 113 (1893); see also *Eno v. Dunn*, 15 App. Cas. 252; 7 R. P. C. 311 (1890).

(*e*) *Ainslie & Co.'s Tm.*, 4 R. P. C. 212 (1887).

(*f*) (1893) 2 Ch. 567; 10 R. P. C. 71, 217.

of the application to rectify. And it was assumed by the Court that these persons might have successfully opposed the registrations had they known of them, and thought fit to do so. In the view the Court of Appeal took, the defendants had been guilty for years of deliberate infringement of the plaintiffs' trade-mark. The Court refused to direct the marks to be removed, and the following passage from the judgment of Bowen, L.J., fully explains the grounds of their decision:—

“The purity of the register of trade-marks—if one may use the expression—is of much importance to trade in general, quite apart from the merits or demerits of particular litigants. If on a motion like the present the attention of the Court is called to the entry on the register of a trade-mark which cannot in law be justified as a trade-mark, it seems to me that the Court's duty may well be, whatever are the demerits of the applicant, to purify the register and to expunge the illegal entry in the interests of trade, as was done in *The Stone Ales Case* (g). As a rule, the Court, on being seised of the matter, would doubtless put an end to the existence of a trade which could not possibly be justified by law. But the matter is wholly different when the trade-mark complained of is one which is not in itself illegal or improper, although at the date of registration its registration might have been, perhaps, successfully opposed by some third party who did not in fact oppose it. In such a case, the defect in the register is not a defect of which the law is bound to take cognizance at the instance of every complainant. Consent by the *Sheffield* company would, in the present case, have removed all difficulty in the registration of the plaintiff's trade-mark. The defendants have no right, as it appears to me, to take the point that such consent was not in fact shown to have been given by the *Sheffield* firm, in order to displace a trade-mark which they have been meanwhile dishonestly infringing. I am of opinion that the Court is

The Court has a discretion.

(g) *Supra*, p. 225.

“not bound under sect. 90 of the Act of 1883, on the application of an unmeritorious applicant, to displace an entry on the register, which, on the face of it, is not illegal, because the original registration might have been opposed on the ground of prior user by a third person who never opposed it on any such ground, and who, at the time of the motion to rectify, has discontinued his user.”

The construction of sect. 90, here adopted, is certainly in accordance with the apparent meaning of the section, for its terms empower the Court to make “such order . . . as the Court thinks fit,” or to refuse the application.

Independent title acquired by registration and user.

So, in a case where the registered proprietor of a mark had adopted and registered it in ignorance of the rights of the applicant, who previously possessed, but had temporarily ceased to use, a similar mark, and the proprietor had largely used his mark for two years, an application to remove it from the register was refused. The applicant, however, was allowed to register his mark also (*h*).

There are, however, some reported cases which can hardly be reconciled with the view taken by the Court of Appeal in *The Stone Ales Case* by the distinction suggested in the judgments in *Paine v. Daniells* between marks which are good marks under the Acts upon the face of them, although the registration of them might, for some extrinsic reason, have been opposed, and marks which are bad in themselves.

Mark allowed to remain in pursuance of a compromise.

Thus, in a case where Chitty, J., had ordered a mark to be removed from the register, on the ground that it did not comply with sect. 64 of the Act, the Court of Appeal expressed a strong opinion that the applicant (the defendant) had made a binding agreement with the registered proprietor (the plaintiff) not to use the mark, and, the applicant consenting, they set aside the order for removal (*i*). And, in an earlier case (*k*), Kekewich, J.,

(*h*) *Mouson & Co. v. Boehm*, 26 C. D. 398 (1884), Chitty, J.

(*i*) *Hodgson v. Sinclair*, 9 R. P. C. 22 (1892).

(*k*) *Harrison, McGregor & Co.'s Tm.*, 42 C. D. 691; 7 R. P. C. 25 (1889), (*Albion*). The variation is not stated in the Law Reports.

allowed an order expunging a mark from the register to be varied (subject to any objection being made by the comptroller) by the consent of the applicant, although he held that, having been used to indicate a design, and not as a trade-mark, it ought not to have been registered.

The fact that the comptroller has exercised his discretion in favour of the registration of a mark, and has allowed it to be registered, does not prevent the Court from ordering its removal if the registration was made without sufficient cause (*l*).

And it is elsewhere shown that sect. 90 is not limited by sect. 76, so that a mark registered without sufficient cause can be removed, notwithstanding the fact that it has been five years upon the register (*m*).

The delay of the applicant in coming to the Court to ask for rectification of the register is not of itself any bar to his application (*n*), and marks have been removed or varied after being registered for long periods to the knowledge of the applicant (*o*). But where the objection alleged to a mark is that it is the same as that of the applicant, or that it has such resemblance to his as to be calculated to deceive, it will be some evidence against the applicant, on whom the burden of showing that the registration was made without sufficient cause lies, if he has stood by and allowed the registered proprietor to use the mark objected to for a length of time. And if the objection depends upon proof of a state of facts at a given time, for instance, upon the question whether an old mark was used before the 13th of August, 1875, in the form registered, after a long lapse of time, and especially if important witnesses

The comptroller's decision is no bar to rectification ;

nor is five years' registration ;

generally, is delay in making the application to rectify ;

but delay may have a bearing on the evidence.

(*l*) *Arbenz's Application*, 35 C. D. p. 260 ; 4 R. P. C. 143 (1887), C. A., (*Gem*).

(*m*) Chap. XII., p. 258.

(*n*) *Great Tower Street Tea Co. v. Smith*, 6 R. P. C. 165 (1889), North, J. *Société, &c., de l'Etoile's Tm.*, ante, p. 223 ; *Talbot's Tm.*, (1894) W. N. 12 ; 11 R. P. C. 77,

Stirling, J.

(*o*) For instance, in *The Apollinaris Case*, some of the marks removed had been registered for fourteen years ; (1891) 2 Ch. p. 186 ; 8 R. P. C. 137, C. A. See also *Paine & Co. v. Daniells & Sons' Breweries*, (1893) 2 Ch. 567 ; 10 R. P. C. 71, 217, C. A.

have died, the Court will receive the evidence of the applicant upon the point with hesitation (*p*).

Entry to be vacated or rectified if originally wrongly made.

An entry which has been made without sufficient cause ought to be expunged, even though, so far as appears at the hearing of the application to rectify, an application to re-register could be successfully made at once, for there ought to be fresh advertisements and a fresh opportunity for objectors to oppose the registration (*q*). So where a misstatement as to the length of time during which the mark had been used was made, not fraudulently, but through carelessness, in the application for registration, North, J., directed the registration to be vacated (*r*). And in *The Apollinaris Case*, in dealing with the objection that the company, when only importers, had registered marks belonging to the producers of the goods as their own, Fry, L.J., said (*s*): "On behalf of the Apollinaris Co. an argument was addressed to us to this effect, that as they had, in the year 1881, become the sole owners of the produce of the spring, they could now get these marks on the register, and that we ought not to remove marks which, as soon as we have taken them off, can be put on again. But even assuming that the respondents are *prima facie* entitled now to be placed on the register, as to which we say nothing, we are of opinion that the course suggested is rendered impossible by the statutory provision for advertisements. To allow a mark which ought not to have been on the register to remain on by reason of some intervening event, would be to preclude the public from challenging the new title of the applicant for registration."

Judgment of Fry, L.J., in *The Apollinaris Case*.

(*p*) *Benjamin Edgington; Ltd. v. John Edgington & Co.*, 6 R. P. C. 513; 61 L. T. 323 (1889), Kay, J.

(*q*) In *Hayward's Tm.*, however, where the objection was that the application on which the mark was registered ought to have been treated as abandoned, Kay, J., allowed the mark to stand, with a note limiting the date from which

the five years should run before the registered proprietor acquired an absolute title, to the date of actual registration; 54 L. J. Ch. 1003 (1885).

(*r*) *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 39 (1890).

(*s*) (1891) 2 Ch. p. 230; 8 R. P. C. 137.

But the rule here laid down does not compel the Court to order the removal of a mark if the registration of a note, partial removal, or other variation meets the justice of the case (*t*).

Conversely, an alteration in the circumstances connected with the mark after its registration, cannot cause the entry on the register to have been "made without sufficient cause." So, where after an application for the registration of a mark belonging to a firm had been made, a change in the constitution of the firm took place, the Court refused to order the register to be rectified by the entry upon it of the name of the new proprietors in place of that of the old (*u*). The proper course to be adopted was the registration of a transmission of title (*u*).

Entry, if originally rightly made, not to be varied.

What Orders may be made under the Section.

The section empowers the Court to make "such order for making, expunging, or varying the entry" of the omission or registration of which complaint is made as the Court thinks fit. The Court may therefore (1) direct an entry to be made on the register; (2) order an entry already appearing thereon to be wholly removed; or (3) to be partially removed; or (4) to be modified by a disclaimer; or (5) by limiting it to particular goods; or (6) to be varied as to its form; or (7) date; or (8) the name of its registered proprietor.

(1.) The jurisdiction to order a new entry to be made seems to be specially referable to the preceding words of the section "aggrieved by the omission without sufficient cause of the name of any person or of any other particulars" from the register; but the Court is not empowered by the section to order to be entered upon the register a mark which the comptroller has refused,

New entries.

New marks cannot be registered under the section.

(*t*) See note (*q*) and the instances cited below, pp. 234 *et seq.*

(*u*) *Ward, Sturt, and Sharp's Tms.*, 50 L. J. Ch. 347 (1881), Hall, V.-C., and see below, p. 236.

although, under the corresponding section of the earlier Act, it might have done so, for a special mode of appeal from the comptroller's decision to the Board of Trade, and to the Court only by reference from them, is provided by sect. 62, and consequently, no other appeal is permitted (*x*). And it cannot direct a new mark to be registered with regard to which the proper procedure by application and advertisement has not been resorted to (*y*). The reference to entries to be made upon the register must therefore, notwithstanding the words quoted above, be taken to refer only to the variation by addition of marks already registered.

Total
removal.

Reasons for
removal.

(2.) Orders for total removal of entries from the register have been made in a great number of cases, and many examples have been given already in this and the two preceding chapters. The entry is to be expunged if made without sufficient cause. What is a sufficient cause for refusing an application to register is considered in Chapter IV. (*z*), and generally the same reasons will afford grounds for removing an entry inadvertently made. But the Court has a discretion to refuse to vacate the registration of a mark, independently adopted and extensively used by the proprietor, if it falls within the class of symbols which may be registered as trade-marks, and the only objection is that it had been previously used or acquired as his trade-mark by another person (*a*). The proprietor of a registered mark stands, however, in a better position

(*x*) *The Normal Co.'s Tm.*, 35 C. D. 231; 4 R. P. O. 123 (1886), Chitty, J., and C. A.

(*y*) *Rivière's Tm.*, 55 L. J. Ch. 645; 53 L. T. 237 (1885), C. A.; and as to transfers from one name to another, see below, p. 236, and cf. p. 230. In *Jackeen v. Napper* there was an application for registration, and the summons was not, as stated in 4 R. P. O. 45, an application to

rectify under sect. 90, but to proceed under sect. 62. It seems to have been irregular in any case, as there was no appeal from the comptroller to the Board of Trade, so far as the report shows; 35 C. D. 162 (1886), Stirling, J.

(*z*) Page 63.

(*a*) *McLison v. Boehm*, 26 C. D. 398; *Pains & Co. v. Daniells & Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. O. 217, above, p. 226.

than an applicant for registration, since the comptroller's discretion (*b*) has been exercised in his favour, and the onus of showing that the registration was made without sufficient cause is cast upon the person applying to vary it (*c*).

The reasons for removing a mark may be classified as follows: the registered proprietor is not the person entitled to use it (*d*); the mark was not capable of registration (*e*), or it fell within the restrictions forbidding registration contained in the Acts (*f*); the registration was procured by a material misstatement (*g*).

There does not appear to be any jurisdiction under the section to remove a mark because the registration, rightly made at its date, has by subsequent events become a cause of grievance to the applicant. If, for instance, the registered proprietor ceases to carry on business (*h*), agrees with another trader not to use his mark or to have it removed from the register, or uses it fraudulently or deceptively, it would seem that no redress can be had under the section. For the words "made without sufficient cause" are in the past tense, and they relate to the date of registration (*i*), and the term rectification is only applicable where there has been some mistake or error in the original registration (*i*). And this construction accords with the decisions that no events subsequent to the time of registration can be appealed to by the registered proprietor to defend his mark (*k*).

Alteration of circumstances subsequent to registration.

Abandonment or misuser of mark.

(3.) If part only of a composite mark is objectionable, that part may be removed. This course was adopted in

Partial removal.

(*b*) Chap. IV., p. 64; but see above, p. 229.

(*c*) See *Leonard and Ellis' Tm.*, 26 C. D. 288 (1884), C. A.; *Benjamin Edgington, Ltd. v. John Edgington & Co.*, 6 R. P. C. 518; 61 L. T. 323 (1889), Kay, J.

(*d*) Chap. IV., p. 60.

(*e*) Chap. VIII., p. 196.

(*f*) Chap. X., p. 175.

(*g*) *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1890), North, J.

(*h*) As regards the removal of an abandoned mark, see below, p. 291.

(*i*) *Ward, Sturt, and Sharp's Tms.* 59 L. J. Ch. 347 (1881), Hall, V.-C.

(*k*) Above, p. 230.

Biegel's Trade-Mark (l), where the applicants, Younger & Co., complained that the use of three interlaced triangles in the respondent's label caused it to resemble too closely their own label, which contained three superimposed solid triangles similarly placed. The remainder of the label was distinctive, and the applicants did not complain of it. The order made was to strike out the triangular device. Where, however, the registered mark consisted of a fir tree, with the words Forrest above and London below printed in large letters, and the proprietor, being a Coventry watch-maker, having no connection with the business formerly carried on by Forrest in London, the mark was deceptive, Chitty, J., directed the whole mark to be struck out, but without prejudice to any application the respondent might make to register the fir tree alone (*m*).

Deceptive
mark wholly
removed.

In the case last cited it was argued on behalf of the comptroller that sect. 90 does not authorize the alteration of a registered mark, and that any application to vary must be made under sect. 92; but this contention is opposed to the express words of the first mentioned section, and it would leave unprovided for the large number of cases which do not fall within sect. 92, and among others all those arising on hostile applications.

Registration
of a dis-
claimer.

(4) Registration with a disclaimer has already been discussed (*n*). *Edge's Trade-Mark (o)* is an example of the compulsory registration of a disclaimer. The respondent had registered the words *Edge's Filtered Blue*, and a label containing these words with certain devices. The judge held that the word *filtered* was either descriptive or deceptive, and therefore the respondent could have no exclusive right to use it. He accordingly directed the first mark to

(l) 4 R. P. C. 525; 57 L. T. 247 (1887), Chitty, J.; *Blair v. Stock*, 52 L. T. 123 (1884), Kay, J.; *Strathmore* struck out of mark.

(m) *Hill's Tm.*, 10 R. P. C. 113 (1893).

(n) Chap. IX., p. 164.

(o) 8 R. P. C. 207 (1891), Stirling, J. (see above, p. 138); *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J., (*Washerine*); *Hayward's Tm.*, 54 L. J. Ch. 1003 (1885), Kay, J., are other instances.

be removed from the register, and the exclusive right to the use of *filtered* in the other to be disclaimed.

(5) A limitation restricting the registration of a trademark to those goods for which the registered proprietor actually used the mark, and to which alone the goodwill of the business transferred to him with the mark by the former proprietor extended, was adjudged to be notified upon the register in *Edwards v. Dennis* (p). And in *The Milkmaid Brand Case* (q), where the defendant's mark too nearly resembled the previously registered mark of the plaintiffs, it was ordered that the registration of the former should be confined to goods for which the plaintiffs' mark was not registered.

Limitation of the registration—
to particular goods;

So the Court may under the section order a note of an undertaking by the registered proprietor restricting the use of the mark, in accordance with an agreement between the proprietor and the applicant, to be entered on the register (r).

to particular market.

(6) The only variation in the form of a registered mark ordered under sect. 90, which occurs in any reported case is variation by striking out part of the mark (s). Any alteration which substantially changed the mark would be open to the objection that it would cause a new mark to be entered on the register, the application for which had not been advertised (t), and which had not been approved by the comptroller.

Variation in form of mark.

(7) A variation of the date of registration was directed in *Hayward's Case* (u). There a mark was registered in 1885 on an application made in 1879, and it was held that the registration not having been completed within one year ought to have been treated as abandoned, under sect. 63 of the Act of 1883. Kay, J., however, refused to expunge the registration, but ordered that the five years

Variation of date of entry.

(p) 30 C. D. 454 (1885), C. A.

undertakings for local user.

(q) *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 C. D. 454; 3 R. P. O. 28 (1886), Kay, J.

(s) See above, p. 233.

(t) See above, pp. 230 and 232.

(r) *Mitchell & Co.'s Tm.*, 28 C. D. 666 (1885), Chitty, J.; cross

(u) 54 L. J. Ch. 1003 (1885), Kay, J.

which make registration conclusive evidence of exclusive right of user should run from the date of the actual registration instead of from the date of the application to register.

Variation
of name of
propriet

Registration
in the wrong
name.

(8) The register cannot be rectified under sect. 90, where a mark has been wrongfully registered in the name of someone other than the proprietor, by expunging the name and substituting that of the person entitled to the mark. The whole entry may be expunged, but the true proprietor must be left to make a fresh application for registration, which will be advertised in the ordinary course, and may lead to opposition (*x*). So where an agent wrongfully registered his principal's trade-mark in his own name, Jessel, M.R., refused to order the name to be changed (*y*). And the same rule is applied where the entry is innocently made in the wrong name by mistake, as by a partner in his own name instead of his firm's (*z*), or by an agent acting for two principals, in the name of the wrong principal (*a*). In the former case the proper course is for the registered owner to assign, and for the assignee's name to be registered under sect. 87 (*b*). But in a case where a partner registered the mark in his own name thus—"Arthur Rust, trading as T. W. Rust & Co."—Jessel, M.R., allowed the names of all the partners to be substituted for "Arthur Rust" (*c*); and this case was distinguished in the later judgment, on the ground that the true proprietors, the firm, were there expressly mentioned on the register. And where the owners of the mark changed the name under which they were carrying on

(*x*) *Rivière's Tm.*, 55 L. J. Ch. 545, cited above, p. 224.

(*y*) *Marler's Tm.*, 44 L. T. 98 n. (1878).

(*z*) *Farina's Tm.*, 44 L. T. 99 n. (1881), Jessel, M.R.

(*a*) *Kingsford & Son's Application*, 6 R.P.C. 413; 41 L. T. 426 (1889), Kay, J.

(*b*) *Greenlees' Tm.*, 9 R. P. C. 93 (1892), Stirling, J.; and *Farina's Tm.*, *supra*. Sect. 70 (trade-mark to be assigned only with goodwill) is not an obstacle to such assignment, *Welcome's Tm.*, 32 C. D. 213; 3 R. P. C. 76 (1886), Chitty, J.

(*c*) *Rust's Tm.*, 44 L. T. 98 n. (1880).

business, Stirling, J., on an application under the section, allowed the new name to be entered, with a note that the firm formerly traded under the old name (*d*). In *Re The Australian Wine Co.* (*e*) a mark had been registered in his own name by the sole consignee of wines from a particular vineyard, the consignee intending to use the registration solely for the protection of such wines, and so long only as he should remain consignee. The mark was transferred by his trustee in bankruptcy, with the consignee's business, to a purchaser who procured the entry on the register of his own name as proprietor. Subsequently, upon the application, under sect. 90, of the then owners of the vineyard, Chitty, J., directed their names to be entered as proprietors of the mark in lieu of that of the purchaser of the consignee's business, on the ground that the mark was registered in the first instance for the benefit of the owner of the vineyard, not for that of the owner of the business.

And in a case where the registered proprietor of a mark had assigned her business and the use of the mark for six years to the respondents, and they had procured the registration of their own names as assignees, upon their application it was ordered that the register was rectified by removing their names and restoring that of the original proprietor (*f*).

Procedure on an Application under sect. 90.

“The Court” in England is Her Majesty's High Court of Justice (*g*), or, with reference to marks of which the registration was applied for in the Manchester Trade-Marks Office (*h*), the Palatine Court of Chancery (*i*); and those Courts have jurisdiction to rectify a registered mark, “The Court.”

(*d*) *The Plumbago Crucible Co.'s Trs.*, 7 R. P. O. 282 (1890); cf. applications under sect. 92, below, p. 248.

(*e*) 61 L. T. 427 n. (1886).

(*f*) *Re Avril*, 20th April, 1888,

Stirling, J.; Sebastian, 3rd ed. p. 404.

(*g*) Sect. 117.

(*h*) Chap. VII., p. 103.

(*i*) Sect. 112a, Act of 1888, sect. 26.

whether the registered proprietor is domiciled or resident in England, or in Scotland, or Ireland, or elsewhere (*k*), although it is probable that where he is domiciled or resident in Scotland or Ireland, the Scotch or Irish Courts have a concurrent jurisdiction (*l*).

In practice, proceedings to rectify are almost always taken in the Chancery Division, except where they occur in the course of an action for infringement or passing off, commenced against the applicant in the Queen's Bench Division (*m*), and unless disputed questions of fact are involved which it is desirable to try by the aid of a jury, the Chancery Division will almost always be found to provide the more satisfactory tribunals for the trial of trade-mark questions.

Procedure by
action.

Neither the Acts nor the Rules contain any regulations as to the manner in which the application to the Court must be made; and it follows the applicant must approach it by one of those means by which the High Court is usually approached, that is, either by writ or by summons, or by notice of motion (*n*). There is no reported case where the application has been made by action; and in *Pinto v. Badman* (*m*), Bowen, L.J., suggested that to proceed in that way would be an abuse of the process of the Court. It may be assumed, at any rate, that the plaintiff in an action, unless he could show some good ground for adopting a course which is both unusual and, in general, unnecessarily expensive, would have to pay the extra costs incurred, even though he were successful.

Not by
counterclaim.

In the case last cited, it was held that the application could not be made by counterclaim, apparently on the ground that it did not fall within sect. 24 (3) of the Judicature Act of 1873.

(*k*) *Re King & Co.'s Tm.*, (1832) 2 Ch. 462; 9 R. P. O. 350, Kekewick, J., and C. A. As to notice of motion in such cases, see below, p. 240.

(*l*) See the case last cited, and

sect. 111 (2).

(*m*) As in *Pinto v. Badman*, 8 R. P. O. 181 (1891).

(*n*) *Per Kay, L.J.*, in *King & Co.'s Tm.*, (1892) 2 Ch. p. 488; 10 R. P. O. 350.

Applications under the section are frequently made both by summons and by motion. Each mode of proceeding offers some advantages peculiar to it. A simple case, where there is no very determined contest between the parties, might be dealt with inexpensively and quickly in chambers, and, on the other hand, if the case is certain to be adjourned into Court, it can usually be brought to a hearing more rapidly on an application by motion. If an action is pending in the matter, however, the summons or motion will almost always be adjourned to the hearing of the action, and a summons will then be the cheaper course. And where there is no action in question, some judges object to dispose finally of an application affecting important property rights on motion day, and, if the application is by motion, and is to be decided on affidavit evidence, direct it to be placed in the non-witness list.

By summons
or motion.

The summons, unless taken out in a pending action, will be an originating summons (*o*). The notice of motion must, as the summons must, if issued in the Chancery Division, be marked with the name of a judge (*p*), and the notice must, unless special leave for short notice is given by the Court or a judge, be served two days before the motion is made (*q*).

In any case, by Rule 49 of the Trade-Mark Rules, four clear days' notice of every application to the Court under sect. 90 for the rectification of the register must be given to the comptroller, but it does not seem to be necessary to make him a respondent to the motion or summons (*r*), and he frequently does not appear on the hearing.

Notice to the
comptroller.

It is proper, when the registered proprietor of the trade-mark in question is resident within the jurisdiction, to serve him with the notice of motion or the summons (*r*); but if he is resident abroad, under the existing rule of Court this cannot be done, and it is not necessary to enable the Court to

Service on the
registered
proprietor.

(*o*) Ord. 5, r. 9 (b); Rules of P. C. 350. Form, p. 642.
1893, Ord. 54, rr. 4 (b) to (e).

(*q*) Ord. 52, r. 5.

(*p*) Ord. 5, r. 9 (b) (c); *King & Co.'s Tms.*, (1892) 2 Ch. 469; 10 R.

(*r*) See *King & Co.'s Tms.*, *supra*.

Where the proprietor is resident abroad.

entertain the application in question (r). In the case of *La Cie. Générale d'Eaux Minérales, &c.*, notice of motion to remove a mark belonging to a foreign company not carrying on business in England was served upon the company in Paris, and Stirling, J., upon their application, set aside the service, because it would have founded a jurisdiction to give costs and damages against the company, and there is, he held, nothing in the Acts to warrant this in the case of such a respondent. The notice of motion had been served abroad without the leave of a judge, but that was really immaterial, as there is no jurisdiction under Ord. XI. or otherwise to grant leave in respect of the application in question. On a subsequent application the learned judge directed that the name of the company should be struck out of the notice of motion, leaving the comptroller as the sole respondent, but that information of the application should be given to the company (s). This course was adopted and approved in *King & Co.'s Case* (t), where the registered proprietors of the mark in question were a company having its registered office and carrying on business in Ireland. In that case the Court of Appeal held that service of the formal notice of motion was not required to enable the Court to deal with the application, and that, as the Acts and rules were silent on the subject, all that was required by natural justice, and therefore all that the Court would insist on, was that the persons interested in the mark should have actual notice of the application to be made respecting it (u). If they should take advantage of the notice to appear and oppose the application it was, the Court held, open to them to do so, but in that event they would be liable, if they failed, to be ordered to pay costs. Lindley, L.J., expressed a doubt whether it was necessary, in the case before Stirling, J., to strike out the name of the foreign respondents from the notice (x). He said: "If you go down to the root of the

Notice of motion not to be served out of the jurisdiction.

Notice by letter only.

Foreigner appearing on the application may be made liable for costs.

(r) See *King & Co.'s Tms.*, *supra*.

(s) (1891) 3 Ch. 461; 8 R. P. C. 446.

(t) *Supra*.

(u) Cf. Ord. 52, r. 3.

(x) (1892) 2 Ch. p. 482.

“argument there is nothing in it except a false analogy based on the supposition that, because the notice of motion is marked by an English judge, the parties interested must be technically named at the foot of it as respondents, and you must get leave to serve them if they are to be affected by it. It appears to me that all that they want for the purposes of this Act is notice, and that they have had” (y).

It has been held that a foreigner who is the registered proprietor of a mark which it is sought to remove from the register, is entitled, on receipt of information as to the intended application to rectify, to appear upon the application without giving security for costs, on submitting to the jurisdiction (z).

Security for costs by foreigner.

The Court has in several cases refused to allow actions for infringement to be brought or proceeded with in England where it has considered the Scotch or Irish Courts to be more convenient, notwithstanding that motions to rectify were pending in it with regard to the same matters (a).

Action for infringement in Scotland or Ireland.

Evidence on the Application.

The evidence is, in accordance with the usual rule, generally given in the first instance by affidavit, subject to cross-examination of the deponents if ordered by the Court or a judge (b). But applications under the section are very frequently heard upon *viva voce* evidence given in Court. And the Court has, by the terms of the section (c), power to direct an issue to be tried for the determination of any fact arising upon the application, but this is rarely, if ever, done.

(y) Cf. *Bancroft & Co.'s Tm.*, 5 R. P. O. 209 (1888), and *Robertson, Sanderson & Co.'s Tm.*, (1892) 2 Ch. 245; 9 R. P. O. 213, where notices of appeals from the comptroller were sent to persons out of the jurisdiction, but the notices of motion were not served on them.

(z) *La Société, &c. de l'Etoile's Tm.*,

10 R. P. O. 290 (1893), Stirling, J.; *Miller's Patent*, W. N. (1894) 4; 11 R. P. O. 55, Kekewich, J.

(a) *Kinahan v. Kinahan*, 45 O. D. 78; 8 R. P. O. 18 (1890), Kekewich, J.; *Marshall v. Marshall*, 38 O. D. 330 (1888), O. A.

(b) Ord. 38, r. 1.

(c) Sect. 90 (2).

Declarations
of the pro-
prietor.

Statutory declarations, or certified copies of 'declarations' made on the application for registration of the mark sought to be removed or varied, and on the occasion of transfers of the mark by predecessors in title of the owner of the mark may be put in evidence by the applicants, but not declarations made by persons who are neither parties to the application nor predecessors in title of the respondents (*d*).

Evidence to
be completed
before the
summons
comes into
Court.

Where the application is made by summons the evidence on each side should be completed before the matter is adjourned into Court, and Stirling, J., has announced that he will not in future allow the rule to be departed from by permitting evidence to be filed subsequently (*e*).

Discovery.

In a proper case discovery of documents may be ordered to be made by either party to the application (*f*). In *Wills' Trade-Marks* (*g*), on an application by notice of motion to remove certain marks from the register, and after the evidence had been completed (except as to the cross-examination of two witnesses, which was to be taken in Court), the applicants took out a summons for an order for discovery of documents by the respondents, the proprietors of the marks, and Kekewich, J., required the applicants to make a statement in writing of the grounds upon which they sought to have the marks removed, and upon it formulated six questions relative to the use of the marks by the respondents, and ordered that a member of the respondents' firm should make discovery of the documents relating to the several questions, not disclosing all the documents, but only specimens representative of each class of them. The Court of Appeal held that this order, carefully limited as it was, was oppressive at the then stage of the proceedings, and upon the respondents undertaking to deliver to the applicants a statement of the labels on which they intended to rely, and to have the relevant

(*d*) *Theobald & Blakey's Tm.*, 10 R. P. C. p. 373 (1893), North, J.

(*e*) *Jackson & Co. v. Napper*, 85 O. D. p. 166 (1896).

(*f*) Ord. 31, r. 12; see *Re Norwich Town Cross Estate Charity*, 46 O. D. 310.

(*g*) (1892) 3 Ch. 301; 9 R. P. C. 346.

documents in Court at the hearing, and not to object to produce them, the Court set aside the order, without prejudice to any order the judge at the trial might think fit to make as to discovery of documents.

If the case set up is that the mark objected to is deceptive, and it is alleged that it has in fact deceived certain persons, particulars as to the persons deceived may be ordered to be given (*h*).

An office copy of any order to rectify must be left forthwith at the Trade-Marks Branch of the Patent Office, and the register is to be thereupon rectified or altered, or the purport of the order to be otherwise duly entered on the register, as the case may be (*i*). The comptroller is directed, if he thinks that the rectification or variation should be made public, to publish, by advertisement or otherwise, and in such manner as he thinks just, the circumstances attending the rectification or variation in the register at the expense of the person applying for it (*k*).

Particulars.

Order to be served on the comptroller.

Damages under section 90.

It is difficult to see what damages can be given under the section. In several of the older cases under sect. 35 of the Companies Act of 1862, upon which sect. 90 is founded, the difference between costs as between solicitor and client and as between party and party were given as damages (*l*); but these cases were overruled (*m*), and, though it has since been held (*n*) that solicitor and client costs may be given in the Chancery Division under the jurisdiction inherited from the old Court of Chancery in any proper case, there is no reason to suppose that the cases first referred to would now be followed.

(*h*) *Humphries v. The Taylor Drug Co.*, 39 C. D. 693; 5 R. P. O. 687 (1868), Kekewich, J. An action for infringement.

(*i*) Rule 46.

(*k*) Rule 50.

(*l*) e.g., *Anderson's Case*, 17 C. D. 373.

(*m*) *Cockburn v. Edwards*, 18 C. D. 449; Buckley on the Companies Acts, 6th ed. p. 140.

(*n*) *Andros v. Barnes*, 39 C. D. 133, Kay, J., and C. A.

Possibly in a case where the presence of the wrongly registered mark of the respondent upon the register has caused the applicant to fail in proceedings taken to register a mark which he was otherwise entitled to register, the costs of these abortive proceedings might be given as damages under the section. There is no reported case in which damages have been given under the section.

In any event, it seems that damages could only be granted where an order for rectification is made (o).

Costs (p).

The ordinary rule that the unsuccessful party must pay the costs of the proceedings is rarely departed from (q), and these costs include the comptroller's costs, if he think fit to appear. The comptroller is never directed to pay costs.

The Court has, however, a discretion whether to give costs or not, and, in the exercise of this discretion, Kekewich, J., refused to give costs to a successful applicant who could not have been interfered with in the slightest degree in his business had he allowed the mark to remain unaltered (r); and in a case where the defendant in an action for passing off his goods as those of the plaintiff, successfully applied to expunge the plaintiff's registered mark, North, J., reserved the costs of the application till after the hearing of the action (s). And where in a similar case the plaintiff obtained an injunction against the defendant, on the ground of the fraudulent passing off of the latter's goods as his, and the defendant's motion to rectify failed, and was dismissed with costs at the trial, but, when urged on other grounds, succeeded in the Court of Appeal, no costs of the appeal on that point were given,

(o) *Ottos Kopye Diamond Mines, Ltd.*, (1893) 1 Ch. 618, a company case.

(p) See also Chap. IV., p. 85; and Chap. XV., p. 364.

(q) *Hyde & Co.'s Tm.*, 7 O. D. 724 (1878); *Kuhn & Co.'s Tm.*, 53 L. J.

Ch. 238 n. (1878), both Jessel, M.R.

(r) *Humphries v. Taylor Drug Co.*, 53 L. T. 820 (1889), Kekewich, J., (*Herbalin*); see also *Perry Davis' Tm.*, 5 R. P. O. 337, Kay, J.

(s) *Gianaclis' Tm.*, 6 R. P. O. 467; 58 L. J. Ch. 782 (1889).

because the objection was not urged in the Court below, and the rest of the appeal was dismissed with costs (*t*).

In *Hill's Trade-Mark* the application to rectify was proceeded with at the applicant's instance, without waiting for the further investigation of charges of improper trading brought against him by the respondent, upon his undertaking not to ask for costs in any event (*u*).

In *Talbot's Trade-Mark* (*v*), where the application to rectify succeeded, no costs were given, because the applicant failed in regard to one of the grounds relied on, and he had delayed to move for three years.

As regards security for costs where the respondent is resident abroad, see above, p. 241.

Appeal.

An order made on an application under sect. 90 is a final order, and an appeal to the Court of Appeal against it must consequently be heard by not less than three judges (*x*). The appeal must be brought within fourteen days, and must be by a fourteen days' notice of motion (*y*).

The Court may stay execution of its order to rectify pending an appeal, and it will sometimes do so (*z*), but the appeal itself does not act as a stay (*a*). In *Re Palmer's Application* (*b*) the Court of Appeal, having reversed the decision of the judge of first instance on a preliminary

Stay of execution.

(*t*) *Thompson v. Montgomery*, 41 C. D. 35; 6 R. P. C. 404 (1888), Chitty, J., and C. A., (*Stone Ale*).

(*u*) 10 R. P. C. 113 (1893), Chitty, J.

(*v*) W. N. (1894) 12; 11 R. P. C. 77, Stirling, J., (*Emolliorum*).

(*x*) *Rivière's Tm.*, 26 C. D. 48 (1884), C. A.; Judicature Act, 1875, sect. 12; see the notes to Ord. 58, rr. 3 and 15, in the Annual Practice.

(*y*) Ord. 58, rr. 3, 9 and 15; see *Re Blyth and Young*, 13 C. D. 416;

and *Onslow v. The Commissioners of the Inland Revenue*, 25 Q. B. D. 465; and of. *Arbenz's Tm.*, 35 C. D. 248; 4 R. P. C. 143 (1887), C. A., where it was held that an appeal on an application to proceed must be brought within twenty-one days (now changed to fourteen days, Orders of 1893).

(*z*) *Harrison v. Woodroffe*, 7 R. P. C. 25; 42 C. D. 691, Kekewich, J.

(*a*) Ord. 58, r. 16.

(*b*) 22 C. D. 88 (1882).

objection, refused to stay the proceedings on the merits before the judge pending an appeal to the House of Lords against their decision.

2. Correction and Cancellation of Entries at the Proprietor's Request.

By sect. 91 (b) and (c) (a) the comptroller is empowered to correct any clerical error in the name, style, or address of the registered proprietor, and to cancel the entry of a trade-mark on the register, wholly or in part.

The sub-sections provide that—

Sect. 91.

“The comptroller may, on request in writing accompanied by the prescribed fee (b)—

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

“(c) Cancel the entry or part of the entry of a trade-mark on the register: provided that the applicant accompanies his request by a statutory declaration (c) 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.”

Alteration of address.

Rule 48 directs the comptroller to enter any alteration of the address of the registered proprietor on application (d) and payment of the prescribed fee (d).

Amendment or cancellation only at the proprietor's request.

It is not expressly stated in sub-sect. (b) by whom the request is to be made, but obviously it is intended to be made by the registered proprietor only, and the forms attached to the rules and referred to above are drafted on the assumption that this is so. It is suggested that the proviso printed in the Act as part of sub-sect. (c) is to be construed as applicable to the whole section. A similar

(a) Sub-sects. (a) and (d) deal with the correction of errors in or in connection with an application to register, and the omission of any of the goods referred to in it.

(b) 5s.

(c) Rule 61. Forms O. and P., Appendix, p. 612.

(d) 5s. Form M., Appendix, p. 612.

error in printing to that suggested is to be found in sect. 64 (3) (ii.).

Sub-sect. (c) providing for cancellation of an entry at the proprietor's request, corresponds to the rule of February, 1878, made under the old Act. A registered proprietor may wish to cancel the whole or part of a trade-mark registered in his name, because he has ascertained that it ought not to have been registered, and so to avoid the costs of any application under sect. 90 to expunge it which might be made by a person aggrieved, or because it stands in the way of some other registration he desires to be effected, or in pursuance of an arrangement with other traders, or to cancel part of a mark in order to more readily support the registration of the remainder.

Cancellation of an entry.

Sub-sect. (b) only relates to the correction of clerical errors. Any other alteration of the register must be effected under sect. 90, already discussed, or under sect. 92.

3. Alterations in Non-Essential Particulars.

Sect. 92 provides that—

“(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. Sect. 92.

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

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

This section corresponds to the rule 35 of the old code under the Act of 1875.

(e) Ten shillings.

What is an essential particular

The alteration can only be permitted in any particular which is not an essential particular within the meaning of the Act. Reference is obviously intended to be made to the essential particulars enumerated in sect. 64 (*f*), which must, under the Act of 1888, be stated in the application for the registration of any mark made subsequently to the 1st of January, 1889 (*g*).

Alteration of old marks.

As regards an old mark, however, that is, a mark registered under sect. 64 (3) (ii.), no part of the mark is specified as an essential particular, and "essential" must therefore be read as equivalent to "substantial" (*h*) or "material."

The section has accordingly a much more restricted operation in regard to old marks than in regard to marks first used since 13th August, 1875, and registered under the provisions applying to new marks. The policy of the Acts is that old marks should be registered and kept registered substantially as they were used before the date mentioned (*i*). In the absence of special circumstances, therefore, no alteration at all should be permitted (*k*). But the section allows some alterations to be made in old marks. For instance, the Court has authorized the addition of the word *limited* to a mark where the proprietors had assigned their rights to a company bearing their old firm name with that addition (*l*), and has permitted the name of certain works abandoned by the proprietors to be struck out, and the name of other works retained by them to be printed in a different position in the registered mark (*m*).

(*f*) The proviso in the old rule ran, "so that he do not alter any one or more of the particulars in such mark which are declared by sect. 10 of the Act (of 1875) to be the essential particulars of a trademark." A signature mark, therefore, cannot be altered, above, p. 118.

(*g*) Chap. VIII., p. 112.

(*h*) *Adams' Tms.*, 9 R. P. C. 174; 66 L. T. 610 (1892), Kekewich, J.; cf. *per* Lord Cairns in

Orr-Ewing v. The Registrar of Tms., 4 App. Cas. p. 484 (1879).

(*i*) *Phillips' Tms.*, (1881) 3 Ch. 139; 8 R. P. C. 469, Chitty, J.; *Adams' Tms.*, *supra*. And see Chap. VIII., p. 160.

(*k*) *Re Henry Clay*, (1892) 3 Ch. 549; 9 R. P. C. 449, Kekewich, J.

(*l*) *Guinness & Co.'s Tm.*, 5 R. P. C. 316 (1888), Chitty, J.

(*m*) *Burham Brick, & Co.'s Tm.*, 9 R. P. C. 422 (1892), Stirling, J.

But it has refused to expunge *trade-mark* so printed upon a label as to suggest that part only of the matter of the label was the trade-mark (*n*), in a case where the mark had stood for twelve years on the register (*o*); to strike out *patent* printed as part of the name of the goods upon a label, there being in fact no letters patent (*p*), and to substitute the name of one former proprietor of a mark for that of another in the mark (*q*).

“Trade-mark.”
“Patent.”

In the case of new marks, alterations in matters other than the essential particulars are more readily permitted, and in estimating the resemblance referred to in sect. 72 (2), it is proper to have regard to the possibility of such alteration (*r*).

Alterations allowed in new marks.

But no alteration to the prejudice of other registered proprietors, or such as to cause the altered entry to infringe the restrictions of the Acts can be allowed. Thus, in *Reiss' Trade-Mark* (*s*), the applicant, having a registered combination device trade-mark bearing the words *Grass Bleach, Best Quality*, and having ceased to use the method of grass bleaching, desired to substitute for *Grass* their own trade name, *Reiss*. The comptroller required (*t*) them to inform the Court that there were certain other trade-marks containing the name *Reiss*, and North, J., refused to grant the application until he was satisfied that the altered mark would bear no resemblance to any of the marks referred to.

None allowed to the prejudice of other persons.

Amongst the alterations allowed in reported cases are the addition of *limited* to a name (*u*); the correction of an

Instances of alterations.

(*n*) See Chap. X., p. 214.

(*o*) *Phillips' Tm.*, *supra*. This alteration was allowed in the case of a new mark in *Colman's Tms.*, (1892) 2 Ch. 402; 8 R. P. C. 209, by Kekewich, J., the proprietors of the mark undertaking to register a statement of the essential particulars of their marks and to disclaim the remainder of them.

(*p*) *Adams' Tm.*, *supra*.

(*q*) *Re Henry Clay*, *supra*.

(*r*) *Murphy's Tm.*, 7 R. P. C. 163 (1890), Stirling, J.

(*s*) 5 R. P. C. 291 (1888), North, J.

(*t*) He consented not to appear on their undertaking to read his letters in the matter to the Court.

(*u*) *Bryant & May's Tm.*, 4 T. L. R. 675 (1887), Stirling, J.; *Guinness & Co.'s Tm.*, 5 R. P. C. 316 (1888), Chitty, J.; *Burke's Tms.*, W. N. (1891) 2, North, J.

English letter printed by mistake for a Russian letter (*x*); the omission of certain words (*y*); and the alteration of the name of the proprietor's works (*z*).

Procedure on an Application under Section 92.

The procedure to be adopted is generally the same as that on an application under sect. 90 (*a*), with such differences as are occasioned by the fact that on applications under that section the registered proprietor is usually a respondent to the application, while on applications under sect. 92 he is himself the applicant, and there is usually no respondent other than the comptroller.

Notice of the application and order to the comptroller.

Fourteen days' notice of the intended application must be given to the comptroller (*b*), and if leave is granted the applicant is directed to forthwith supply to the comptroller such a number of representations of the trade-mark, as altered, as the comptroller may deem sufficient (*c*). The person in whose favour the order is made, or such one of them if more than one, as the comptroller may direct, must forthwith leave at the Patent Office, Trade-Marks Branch, an office copy of the order. The register is thereupon to be rectified or altered, or the purport of the order to be otherwise duly entered on the register, as the case may be (*d*).

Advertisement by the comptroller.

The comptroller must, if he thinks the rectification or variation should be made public, at the expense of the applicant, publish by advertisement or otherwise, and in such manner as he thinks just, the circumstances attending the rectification or variation of the register (*e*).

The comptroller may

The comptroller is entitled to appear and to be heard

(*x*) *Ermen & Roby's Tm.*, 4 R. P. O. 70; 56 L. J. 177 (1886), Chitty, J.
 (*y*) *Burke's Tm.*, *supra*.
 (*z*) *Burham Brick, & Co.'s Tm.*, 9 R. P. O. 422 (1892), Stirling, J.
 For other orders, see Sebastian,

3rd ed. p. 406.

(*a*) See above, p. 237.

(*b*) Sect. 92 (2), r. 51, p. 603.

(*c*) Rule 51.

(*d*) Rule 46.

(*e*) Rule 50.

on the application. If he thinks there is no objection to the alteration sought to be made, or that it is sufficient to see that the facts are brought before the Court (*f*), he does not usually appear. He frequently signifies to the applicant that he has no objection to the proposal, and his acquiescence is, of course, of material importance in inclining the Court to accede to the application. appear on the application.

The applicant is always directed to pay the costs of the comptroller, if the comptroller appears (*g*). The applicant must pay his costs.

(*f*) See *Reiss' Tm.*, 5 R. P. O. 291, *supra*, p. 249, n.

(*g*) Further as to costs, see above, p. 244.

CHAPTER XII.

EFFECT OF REGISTRATION.

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Object of the Acts.

THE general object of the Registration Acts was not to create new rights, but to regulate the use of, and the means of, protecting trade-marks (a). Their main effect,

(a) *London's Tr.*, 32 C. D. p. 117; 3 R. P. C. 102 (1886), per Cotton, L.J.

however, has been (1) to provide a new way in which title to a trade-mark may be acquired, namely, by registration; (2) to simplify infringement actions, by making registration evidence, and, under certain circumstances, conclusive proof of title; and (3) to constitute registration, in general, a condition precedent to an action for infringement. The first of these changes was a substantive alteration of the old law.

The Acts have also defined and limited the classes of symbols which can be registered as trade-marks (*b*), and thereby, as a consequence of the third alteration just referred to, have restricted the number of marks in which trade-mark rights can, as such, be effectively protected (*c*).

1. Title to New Trade-Mark conferred by Registration.

Registration, if properly made in accordance with the Acts in force at the date of the application to register (*d*), confers upon the registered proprietor trade-mark rights in the registered mark in respect of the goods for which it is registered and upon which it is used, subject to the rights appearing from the register to be vested in any other person (*e*), and subject, for five years from the date of the application to register, to the conflicting rights existing at that date of any other person in the same mark (*f*). And the rights so acquired date back to the date of the application to register.

Title to new mark.

As registration gives an independent title, the owner of trade-mark rights acquired by user, when he has registered his mark, will only need to avail himself of his earlier title if the propriety of the registration is questioned, or if, within the five years, conflicting rights to the mark are set up.

Trade-mark acquired by user before registration.

(*b*) Chap. IV., p. 58.

(*c*) As to this, see below, p. 266.

(*d*) Chap. VIII., p. 106.

(*e*) Sect. 87; see *Mitchell's Tm.*, 28 O. D. 666 (1885), Chitty, J., and p. 255.

(*f*) Sect. 76, p. 255.

Before the Acts (except in the case of Sheffield cutlers' marks) user of the mark was the only way in which trade-mark rights in it could be acquired (*g*). It was of the very essence of such rights (*h*), and it is provided, by sect. 75, that—

Sect. 75.
Registration
equivalent to
user.

“ [Application for] (*i*) 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 (*k*), be deemed to be, and as from the 1st of January, 1876, to have been, the date of registration] ” (*i*).

The amendment of this section was effected upon the recommendation of Lord Herschell's Committee (*l*). The alteration was merely directed to give legislative authority to the rule already in force.

New and
unused trade-
marks may be
registered.

A serious question arose on the construction of the original Act, of 1875, which contained no provision equivalent to sect. 75, as to whether new marks which had never been used could be registered under it (*m*); but the view expressed above, that the Act created a new mode of acquiring trade-mark rights, which had been acted upon from the first, was finally affirmed in *Hudson's Trade-Marks* (*n*). “ In my opinion,” Cotton, L.J., said, in that case, “ the language (of the Act), though not appropriate, means this, that a man who designs one of those special things pointed out in sect. 10 (*o*) is, as designer, to be considered as the proprietor of it, and if there is no one else who has used it, or who can be interfered with by the registration and subsequent assertion of title to the mark, then he is to be considered as entitled, within the

(*g*) Chap. II., p. 24.

(*h*) *Hudson's Tms.*, 32 C. D. 311; 3 R. P. C. 155 (1886), C. A.

(*i*) Act of 1888, s. 17.

(*k*) *i. e.*, the principal Act, the Act of 1883; see Act of 1888, s. 27.

(*l*) Report of 1888, p. 15.

(*m*) See *Edwards v. Dennis*, 30

C. D. 454 (1885); *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1885), both C. A.

(*n*) 32 C. D. 311; 3 R. P. C. 155 (1886), C. A. The application was made, and the case was decided, under the Act of 1875.

(*o*) *i. e.*, of the Act of 1875.

“meaning of the Act, to the exclusive use of that which, in fact, has never been in any way used, but which has only been designed by him, and which he can be treated as the person entitled to register, if no one else had so used it, as that his user would be interfered with by the registration” (p). And new marks have since been constantly registered. Any other construction of the Acts would have led to very strange results, for no length of user was required to be shown in the actions or suits for infringement before the Acts (q). In any case, sect. 75 makes the matter absolutely clear, for, having regard to sect. 76 of the Act of 1883, quoted below, and the corresponding section of the earlier Act, it is difficult to see what operation it could have except in regard to new marks.

But although actual use of the mark is not a condition precedent to registration, the applicant must intend to use it, so that the registration of a mark merely for the purpose of preventing other traders from using it will not confer upon the proprietor any title to it, and, if registered for such a purpose only, it ought to be removed from the register (r).

Applicant for registration must intend to use the mark.

2. Registration as Evidence of Title.

Sect. 76 provides that :

“The registration of a person as proprietor of a trade-mark shall be *prima facie* evidence of his right to the exclusive use of the trade-mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade-mark, subject to the provisions of this Act.”

Sect. 76. Registered proprietor of mark to have right to exclusive use of it.

Registration being declared by the preceding section of the Act to be equivalent to public user, the section is in

Comparison with the earlier Act.

(p) See *per* Chitty, J., in *Barlow v. Johnson*, 7 R. P. C. at p. 404 (1890).

(r) *Apollinaris Co.'s Tm.*, (1891) 2 Ch. p. 234; 8 R. P. C. 137, Fry, L.J.

(q) See Chap. II., p. 34.

accordance with the old law. It is identical in terms with sect. 3 of the Act of 1875, except that by a verbal amendment "proprietor" has been substituted for "first proprietor," and the proviso of the last clause is now general, whereas in the earlier Act it stood "subject to the provisions of this Act as to its connection with the goodwill of a business."

"Subject to the provisions of this Act."

The most important of the provisions of the Act referred to are the sections which enable a second person who has an independent title to an old mark identical with or similar to a mark already registered, to be registered as proprietor of it (*s*); the provision of sect. 65 that a trademark must be registered for particular goods; the provision of sect. 70 for the assignment of registered marks in connection with the goodwill of the business to which they belong; and the provision of sect. 90 for the rectification of the register. It will be seen that the operation of the last-mentioned section is to very considerably diminish the value of five years' registration as conclusive evidence of title (*t*).

Right limited to goods for which the mark is registered.

The registration confers no rights except in regard to the goods for which the mark is registered, whether that be the whole or only part of a register class (*u*), and if the registration is limited by a note entered on the register to some only of the goods which would be otherwise included under it, the rights conferred are limited also in the same way (*x*).

Registration restricted to goods for which the mark is used.

Further, if the mark is actually used for certain goods only, although registered for others also, the exclusive rights conferred by the section do not extend to the latter.

(*s*) Sects. 62, 71, and 72 (1); *Jackson v. Napper*, 35 C. D. 162; 4 R. P. O. p. 55 (1886), *Stirling, J.*; and see *Mouson v. Boehm*, 26 C. D. 398, cited below, p. 290, and the "three mark rule," Chap. X., p. 177.

(*t*) See p. 258.

(*u*) *Hart v. Colley*, 44 C. D. 193; 7 R. P. O. 93 (1890), *North, J.*

(*x*) *Jay v. Ladler*, 40 C. D. 649; 6 R. P. O. 136 (1888), *Kekewich, J.* In this case, besides the ordinary injunction to restrain infringement on the goods for which the mark was registered, the plaintiff obtained an injunction to restrain the defendant from using the plaintiff's trade-mark, on other goods, so as to deceive. The head-note is too loosely stated.

Thus, where the plaintiff in an action was the assignee of a mark registered for "unwrought and partly wrought metals used in manufacture," and, in fact, he only used it upon sheet iron goods, his business being confined to such goods, and the defendant was the agent of the proprietors of a similar mark subsequently registered for steel and iron wire, and he had sold wire with the latter mark upon it, it was held that the plaintiff had no cause of action, and an order was made that the registration of the plaintiff's mark should be rectified by confining it to sheet iron (y).

Edwards v. Dennis.

In the case just cited the plaintiff was assignee of the registered mark, and the decision turned to some extent upon the rule that a registered mark can only be assigned in connection with the business to which it belongs (z), the plaintiff's business being confined, as already stated, to sheet iron goods; but all the judges in the Court of Appeal indicated an opinion that the rights of the original registered proprietor would in any case have been limited by his actual user of the mark (a), and this opinion has since been adopted and followed by Chitty, J., in the recent case of *Hargreaves v. Freeman* (b).

The main purpose of sect. 76 is to facilitate the proof of title by a plaintiff suing for an alleged infringement of his mark; in place of the evidence of user and reputation, by which he would have had to show his right to the mark before the Acts, he has only to produce the certificate (c) of registration of his mark, and that will be *prima facie* evidence of his title (d).

Certificate of registration is evidence of title; *prima facie* or conclusive.

The evidence afforded by the registration may be rebutted, if the registration is less than five years old, at the date when the fact of registration is put in evidence (e).

Evidence rebutted by the plaintiff's own case.

(y) *Edwards v. Dennis*, 30 O. D. 237. 454 (1885), C. A.

(c) Sect. 96, rule 60.

(z) Sect. 70.

(d) *Pinto v. Badman*, 8 R. P. C.

(a) And see *Hudson's Tm.*, 32 C. D. at p. 319 (1886).

181 (1891), C. A.

(b) (1891) 3 Ch. 39; 8 R. P. C.

(e) Thus, in *Lever v. Goodwin*, 4 R. P. C. 492 (1886), Chitty, J.,

Thus, in the case last cited (*i*), the plaintiffs were not content to rest their title, as in the first instance they might have, merely upon the registration, but they set out in their pleadings the steps by which they alleged that the trade-mark in question had been transferred to them, and thereby showed that the original proprietors of the mark, and of the cigar factory and business in connection with which it had been acquired, had purported to assign the trade-mark without assigning the goodwill of the business. It followed, therefore, that the assignment was a nullity (*f*), and, as the registration was less than five years old, the *prima facie* title conferred by it was consequently rebutted by the evidence furnished by the plaintiff's own case.

Five years' registration.

If the register shows that the registration was five years old at the date when it is put in evidence (*g*), it will be conclusive evidence of the title of the registered proprietor, or, subject to sect. 70, of his assignee, so long as the registration stands; but it is open to the defendant, as a person aggrieved by the registration, if it has been made without sufficient cause (*h*), to apply by motion or summons, under sect. 90, to have it expunged or restricted. The application cannot be made by counterclaim in the action (*i*).

Register may be rectified at any time.

The words of sect. 76 appear to make that section subject to sect. 90, and, therefore, to make the rights conferred by it subject to the rectification of the register, even though the mark in question has been registered for five years, and this has been held to be the case. The same result was arrived at upon the construction of sect. 3

held that the words *Self Washer*, although they had been two years on the register, were not a trade-mark. The case, nevertheless, succeeded on the ground of passing off; see further, p. 304, note (*t*).

(*f*) Sect. 70, and Chap. XIII., p. 272.

(*g*) See *Hayward's Tms.*, 64 L. J. Ch. 1003 (1885), Kay, J., where a note post-dating the registration was inserted on the register, cited above, p. 235.

(*h*) Chap. XI., p. 220.

(*i*) *Pisto v. Badman*, *supra*, note (*d*).

of the Act of 1875, notwithstanding the dictum to the contrary of Jessel, M.R., in *Hyde's Trade-Mark (k)*, although the saving in that section applied in express terms only to a particular provision of the Act, namely, that relating to assignment. The following are cases in which marks were removed or varied on the grounds stated, after being upon the register for five years or more. As the cases are constantly referred to, it will be convenient to tabulate them.

The words BRAIDED FIXED STARS, removed, because they were descriptive and common to the trade, and because, though registered as an old mark, they had not been used alone before the Act of 1875, *Palmer's Tm.*, 21 C. D. 47 (1882), C. A.; 24 C. D. 504, C. A.; VALVOLINE, removed on similar grounds, *Leonard and Ellis' Tm.*, 26 C. D. 288 (1884), C. A.; LA MINERVA-HABANA, removed, because the words were common to the trade, *Lloyd and Sons' Tm.*, 27 C. D. 646 (1884), Chitty, J.; a syphon-bottle device, removed, because used by more than three persons before the registration, *Wragg's Tm.*, 29 C. D. 551 (1885), Pearson, J.; a Neptune and trident device, restricted to the goods over which the proprietor's rights extended, *Edwards v. Dennis*, 30 C. D. 454 (1885), C. A.; the word ETON, registered as an old mark, removed, because, as used by the proprietor, it was not "special and distinctive," *Wood's Tm.*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A.; the word ALBION, registered as an old mark, removed on the ground that it was descriptive of a particular pattern, and not used as a trade-mark, *Harrison, McGregor & Co.'s Tm.*, 42 C. D. 691; 7 R. P. C. 25 (1889), Kekewich, J.; a device, removed because its registration was procured by material misrepresentation as to user before 1875, *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1889), North, J.; deceptive trade-marks, *Hill's Tm.* (*ante*, p. 216), and *Wills' Tm.* (*ante*, p. 214).

Examples of trade-marks removed or varied after five years' registration.

(k) 7 C. D. 724 (1878).

Sect. 76 is subordinate to sect. 90.

In most of the cases just cited, it was urged, but unsuccessfully, that five years' registration constitutes, under sect. 76 of the Act of 1883, or sect. 3 of the Act of 1875, an indefeasible title; and, in *Baker v. Rawson*, it was contended that the previous decisions only applied where the mark sought to be removed was common to the trade, or otherwise incapable of registration, that they were all cases on the older Act (*l*), and that the present Act must be construed differently; but North, J., overruled all the objections, and held that the earlier decisions had finally concluded the question. It may, consequently, be considered as settled law, that the conclusive evidence of title furnished by five years' registration, is no answer to an application to rectify the register, by removing or varying the mark under sect. 90.

Registration conclusive if no application under sect. 90.

In the absence of an application to rectify, the five years' registration is conclusive evidence of title in an action for infringement, so that the defendant cannot allege that the mark in question ought not to have been registered (*m*).

3. Registration is a Condition precedent to an Action for Infringement.

It is provided by sect. 77 that:—

Sect. 77.

“A person shall not be entitled to institute any proceedings to prevent or to recover damages for the infringement of a trade-mark unless, in the case of a trade-mark capable of being registered under this Act, it has been registered in pursuance of this Act, or of an enactment repealed by this Act, or, in the case of any other trade-mark in use before the 13th of August, 1875, registration thereof under this part of this Act, or (of) (*n*) an enactment repealed by this Act, has been refused. The comptroller may, on

(*l*) *Wragg's Case*, *ante*, p. 259, was decided under the Act of 1883.

(*m*) *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478 (1887), C. A.; see

also *Leahy, Kelly, and Leahy v. Glover*, 10 R. P. C. 141 (1893), H. L.

(*n*) *Sic*, without the brackets.

“ request, and on payment of the prescribed fee, grant a certificate (o) that such registration has been refused.”

The corresponding section of the Act of 1875 was part of sect. 1. It was in the following terms: “ From and after the 1st day of July, 1876, a person shall not be entitled to institute any proceeding to prevent the infringement of any trade-mark, as defined by this Act, until and unless such trade-mark is registered in pursuance of this Act.”

The corresponding sections of earlier Acts.

It was found that the time allowed between the commencement of the Act of 1875—namely, the 13th of August, 1875, and the 1st of July, 1876—was insufficient for the registration of the very numerous trade-marks already in use (p); and by the Act of 1876 (q), the period allowed for registration was extended, and, at the same time, the terms of the enactment were amended, so as, on the one hand, to make the prohibition extend to an action for damages, as well as to an action for an injunction, in respect of an infringement of a trade-mark, as defined by the Act of 1875, and, on the other hand, to exempt from its scope any trade-mark in use before that Act which had been refused registration under it. This amendment was in accord with the policy of the Acts to preserve old trade-mark rights substantially without alteration (r).

By the Act of 1877 (s), and an Order in Council made thereunder, the time for registration, in the case of trade-marks used in the textile industries, was further extended to the 30th of June, 1878.

There does not seem to be any material difference between the amended section of the Act of 1876 and sect. 77 of the present Act.

(o) See p. 264.

(p) In 1879 there were still 44,000 applications to register pending and undisposed of in the Trade-Marks Office at Manchester; *Haccopulo v. Kaufmann*, 23 Sol. J. 819.

(q) 39 & 40 Vict. c. 33, s. 1.

(r) See *per* Lord Blackburn, *Orr-Ewing v. The Registrar of Tms.*, 4 App. Cas. p. 498 (1879); see Chap. XI., p. 248.

(s) 40 & 41 Vict. c. 37.

Act of 1888.

The only Act, making provision as to what may be registered, repealed by the Act of 1883, is the Act of 1875. By the Act of 1888, the Act of 1883 is, as from the 1st of January, 1889, to take effect subject to the additions, omissions, and substitutions required by the later Act; but nothing in the later Act is to affect the validity of any act done, right acquired, or liability incurred before the date mentioned (*t*). So that the marks capable of registration under the present Act, within the meaning of sect. 77, are those described in sect. 10 of the Act of 1888.

The prohibition of the section does not in terms extend to (a) any new (*u*) mark incapable of registration under the present Act, whether it was or was not capable of registration under a repealed Act, and whether it has been refused or never tendered for registration under any of the Acts; or to (b) any old mark which was incapable of, and was refused, registration under a repealed Act, but is capable of registration under the present Act.

New marks
incapable of
registration

(a.) Although the section does not expressly enact that a new mark, incapable of registration under the Act, that is, not falling within any of the classes of marks enumerated in sect. 64 (*x*), shall not be the subject of trade-mark rights, yet the saving contained in it, with regard to old marks which have been refused registration (*y*), plainly shows that this was the result contemplated by the draftsman. And the Acts have always been regarded as limiting the classes of symbols in which trade-mark rights can be, or, since they came into operation, can have been, acquired by the descriptions comprised in their several definition clauses (*z*).

(*t*) Act of 1888, ss. 27 and 28.
 (*u*) *i. e.*, not used as a trade-mark before 13th August, 1875.
 (*x*) Chap. IV., p. 58.
 (*y*) But see next page, note (*e*).
 (*z*) In *The Normal Co.'s Tm.*, 35 C. D. p. 235; 3 R. P. C. 269

(1886), Chitty, J., said: "The result (of sect. 77) is that a person, who, I will assume, is entitled to be, but by some error has not been, put on the register by the controller or by the Board of Trade, loses his right, because it is useless

Thus, Cotton, L.J., said, in *Van Duzer's Case* (a), "The Act was also intended to protect the public, by having a register of marks, so that they might know what it was that was protected by the trade-marks adopted, and also by cutting down the numerous forms of words and other things, by the use of which traders tried to secure themselves exclusive rights." are within the prohibition.

And applications to expunge the plaintiffs' trade-marks from the register have been constantly made in actions for infringement of the trade-marks, and have been treated as effectual defences if successful, unless in any case the plaintiff could make out a case of "passing off" (b) by the use of his trade-mark (c). The question has, however, so far as I am aware, never been directly raised and decided by the Court, and the term "common law trade-mark" has been judicially applied to marks which, being incapable of registration, have been protected in passing off actions (d).

(b.) There is no ground, apparently, for a suggestion that an old mark once refused registration need be tendered again in order to escape the prohibition of the section, because it might possibly be accepted under an Act subsequently passed. There is, in fact, little probability of the question arising, although letters and figures excluded by the Act of 1875, as old marks, are now admitted to registration (e). Old marks refused registration.

to have a trade-mark which you cannot protect in case of infringement; as to old marks, however, a distinction is drawn. And where there has been a refusal, there is a right to institute proceedings to prevent infringement. . . . So that the validity of the old trade-marks does not depend on the (non-)registration."

(a) 34 C. D. p. 634; 4 R. P. C. 31 (1887); cf. *Apollinaris Co.'s Tms.*, (1891) 2 Ch. at p. 235; 8 R. P. C. 137, *per* Fry, L.J.

(b) See below, p. 265.

(c) Chap. XVI., p. 379.

(d) *Reddaway & Co. v. Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9 R. P. C. 503, Lindley, L.J.

(e) Lord Blackburn, in his judgment in *Orr-Ewing v. The Registrar of Tms.*, 4 App. Cas. pp. 498 and 499 (1879), seems to have regarded the Act of 1876 as barring all actions in respect of old marks which were incapable of registration, and the permission to sue if a certificate of refusal to register

Certificate of refusal.

Lord Herschell's Committee advised that the certificate of refusal should be altered to a certificate that the trade-mark is incapable of being registered under the Act, on the ground that the former tends to prejudice the proprietor of the mark, especially in proceedings abroad (*f*); but the suggestion was not adopted. The fees payable for the certificate of refusal are 1*l.* for one mark, and 10*s.* in addition for each mark beyond the first. The form of application is Form L. (*g*).

It was suggested by Malins, V.-C., in *The Twentsche Stoom Bleekery Goor v. Ellinger & Co.* (*h*), that the prohibition of sect. 77 does not apply to foreign owners of trade-marks; but it is submitted that the suggestion is ill-founded, and that no distinction can be drawn between trade-marks owned by subjects, and those owned by aliens (*hh*).

Registration a condition precedent to action;

The section makes registration, in the cases falling within it, a condition precedent (*i*) to an action for infringement. Where, therefore, the sole consignee of goods for which his consignors had a label registered as a trade-mark in France, sought to restrain the use of a name which formed a material feature in the label, it was held that the action was in substance an action to restrain an infringement of the label, and, as that might have been registered in England as a trade-mark under sect. 103 of the Act, it fell within the prohibition (*k*). An action to restrain the use of a registered mark on goods for which the registration does not avail is also within the prohibition, for it is in effect an action in respect of an unregistered mark (*l*).

were given, as only intended to meet cases where the mark ought to have been registered, pending an appeal to the Court. He says the owner of the trade-mark "may seek for more speedy redress" by bringing his action for infringement instead of appealing against the registrar's decision. It is submitted, however, that this view is inconsistent with the express words

of that Act and of sect. 77.

(*f*) Report of 1888, p. xiii.

(*g*) Appendix, p. 611.

(*h*) 28 W. R. 70 (1877).

(*hh*) See *Goodfellow v. Prince*, note (*k*); and Chap. XV., p. 300.

(*i*) *Per* Lord Blackburn in *Orr-Ewing's Case*, note (*e*).

(*k*) *Goodfellow v. Prince*, 35 C. D. 9 (1887), C. A.

(*l*) *Hargreaves v. Freeman*, (1891)

It is not an enactment that a man shall not have a trade-mark until he registers (*m*), and it has been compared (*m*) to sect. 24 of the Copyright Act (*n*), which is satisfied by a registration made subsequently to the wrongful act complained of, but before the commencement of the action. It is sufficient if the registration is effected before the hearing (*o*).

not to acquisition of a trade-mark.

Only the registered owners, or the assignees of the registered owners, of the trade-mark can sue in respect of an infringement of it (*p*), but it is not necessary that an assignee should have registered the assignment before commencing his action (*q*).

Only the registered proprietor or his assignee can sue.

The Prohibition does not affect Passing Off Actions.

Sect. 77 has no application to actions to restrain a trader passing off his goods, or doing what is calculated to pass off his goods, as the goods of another. Two questions arise in trade-mark actions and in allied actions: first, is the defendant using a mark which is the same as, or which is a colourable imitation of, the plaintiff's registered trade-mark; and secondly, is the defendant selling goods so marked as to be designed, or calculated to lead purchasers to believe that they are the plaintiff's goods (*r*). The two questions are distinct, and the injunctions granted by the Court to meet the wrongs complained of are different in the two cases. Thus, in *Jay v. Ladler* (*s*), the defendant

Distinction between trade-mark and passing off cases.

3 Ch. 39; 8 R. P. C. 237, Chitty, J.; cf. *Jay v. Ladler* and *Hart v. Colley*, cited below, p. 267. That the registration is blocked by delay at the office was considered to be no excuse; *Hazzopulo v. Kaufmann*, 23 Sol. J. 819 (1879), Little, V.-O.

(*m*) *Per* Chitty, J., in *Barlow v. Johnson*, 7 R. P. C. at p. 405 (1890).

(*n*) 5 & 6 Vict. c. 45.

(*o*) *Hazzopulo v. Kaufmann*, *supra*.

(*p*) *Richards v. Butcher*, 7 R. P. C. 288 (1890), Kay, J. Action by

sole purchasers from registered proprietors. Leave to add the proprietors.

(*q*) *Ihlee v. Henshaw*, 31 C. D. 323; 3 R. P. C. 15 (1886), North, J.

(*r*) *Mitchell v. Henry*, 15 C. D. 181 (1880), Thesiger, L.J.; *Edwards v. Dennis*, 30 C. D. 454 (1885), Fry, L.J.; see Chap. I., p. 12, and Chap. XVI., p. 382.

(*s*) 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

was restrained "from infringing the plaintiff's said trade-mark by issuing, publishing, or circulating, or causing to be issued, published, or circulated, any circular, advertisement, or notice containing or bearing the trade-mark in the pleadings mentioned, or any colourable imitation thereof, in connection with sealskin mantles and sealskin coats (the only goods for which the trade-mark was registered), or otherwise using the said trade-mark in that connection," and he was also restrained "from using the device of a lady and bear (the trade-mark in question), so as to deceive the public," that was, so as to lead the public to believe that the goods of the defendant were the goods of the plaintiff.

The jurisdiction to grant the last-mentioned injunction is part of the general jurisdiction of the Courts to prevent and to give compensation for frauds which cause injury to the person who comes to complain of them (*t*), and this jurisdiction, which was well established before the Trade-Marks Registration Acts, has not been taken away or altered by anything contained in them (*u*).

Unregistered
trade-marks
practically
protected.

It is no defence, therefore, to an action for passing off the defendant's goods as those of the plaintiff, that the grant of an injunction would practically confer on the plaintiff trade-mark rights in an unregistered trade-mark. This is well shown by *The Stone Ale Case*. There the plaintiffs had registered the words *Stone Ale* as a trade-mark, and they had other registered marks which comprised the same words. An application was made by the defendant to vary the registration of the first-mentioned mark, by adding a disclaimer of the right to the exclusive use of the word *Stone*, and this application Chitty, J., refused. The Court of Appeal, however, ordered the mark *Stone Ale* to be removed from the register altogether, on

The Stone Ale Case.

(*t*) See Chap. I., p. 1. *Prince*, 35 C. D. 9 (1887), C. A.;
 (*u*) *Mitchell v. Henry*, 15 C. D. 181 (1880), C. A.; *Singer, &c. Co. v. Loog*, 8 App. Cas. at p. 32 (1882), per Lord Blackburn; *Goodfellow v. Montgomery v. Thompson*, (1891) A. C. 217; 8 R. P. C. 361, (*Stone Ale*).

the ground that it was not shown to have been used separately as a trade-mark before the 13th of August, 1875, but they, and subsequently the House of Lords, nevertheless, maintained the injunction granted by Chitty, J. The injunction (x) restrained the defendant from "carrying on the business of a brewer at Stone, under the title of 'Stone Brewery,' or 'Montgomery's Stone Brewery,' or under any other title, so as to represent that the defendant's brewery is the brewery of the plaintiffs, and from selling, or causing to be sold, any ale or beer not of the plaintiffs' manufacture, under the term 'Stone Ales,' or 'Stone Ale,' or in any way so as to induce the belief that such ale or beer is of the plaintiffs' manufacture, and from infringing the plaintiffs' registered trade-marks, or any of them."

"The respondents," Lord Herschell said (y), "are entitled to ask that a rival manufacturer shall be prevented from selling his ale under such a designation as to deceive the public into the belief that they are obtaining the ale of the respondents, and he ought not the less to be restrained from doing so, because the practical effect of such restraint may be much the same as if persons seeking the injunction had a right of property in the particular name."

Lord
Herschell's
judgment.

In the case just quoted the deception was practised by the use of the plaintiffs' trade name upon the defendant's goods. The jurisdiction existing, apart from the Acts, extends equally to cases where it is practised by the adoption of the plaintiff's trade-mark, or of the "get up" of his goods, and it affords no ground of defence that the trade-mark (z), or an essential part of the get up (a), might have been, but is not, registered under the Acts.

Passing off
by the imi-
tation of an
unregistered
trade-mark.

(x) (1891) A. C. p. 218.

(y) (1891) A. C. p. 220.

(z) *Jay v. Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.; *Hart v. Colley*, 44 C. D.

193; 7 R. P. C. 93 (1890), North, J.

(a) *Great Tower Street Tea Co. v. Langford*, 5 R. P. C. 66 (1887), Stirling, J.

*Pinto v.
Badman.*

In the case of *Pinto v. Badman* (b), the jury found, as a fact, that the defendant had fraudulently sold his cigars as those of the plaintiffs, and also that he had infringed the plaintiffs' trade-mark, and Day, J., gave judgment in the plaintiffs' favour. The Court of Appeal reversed the decision, and gave judgment for the defendant, on the ground that the trade-mark on which the plaintiffs relied had been assigned to them without the goodwill of the business in the goods to which it belonged. The question whether the plaintiffs were not, notwithstanding, entitled to retain their judgment on the ground of the finding of the jury, first stated above, does not seem to have been argued, and the plaintiffs' case appears to have been substantially based upon their assumed trade-mark right. The decision, therefore, cannot be regarded as conflicting with the proposition that passing off cases lie outside the Acts.

The operation
of sect. 77.

The cases cited above have considerably limited the operation of the prohibition contained in sect. 77. Trade-mark rights, as was shown in the introductory chapter of this book (c), grew out of the right of a trader to prevent, and to obtain compensation for deceptions practised upon the public, which caused, or were likely to cause, damage to him as an individual, and, long after property in a trade-mark had been practically recognized by the judgment of Lord Cottenham in *Millington v. Fox* (d), Lord Westbury held, that imposition on the public was the test of the property in a trade-mark having been invaded or injured, although it was not the ground on which the Court rested its jurisdiction (e).

The Registration Acts have altered the old law to this extent that, after five years' registration, they give the

(b) 8 R. P. C. 181 (1891), C. A.

(c) Page 5.

(d) 3 My. & Cr. 338 (1838);
Chap. I., p. 4.

(e) *Hall v. Barrows, Leather Cloth*

Co. v. American Leather Cloth Co.,
cited below, p. 314; and see Lord
Blackburn's judgment in *Orr-
Ewing v. The Registrar of Tms.*, 4
App. Cas. at p. 494 (1879).

registered proprietor of a mark, so long as he remains registered, the exclusive right to the use of the mark on the goods for which it is registered, so that if it, or an essential part of it, is appropriated by another trader the proprietor can interfere to restrain the appropriation (*f*). But where the complaint is not the appropriation but the colourable imitation of his mark, the test to be applied is still—Is the defendant's mark calculated to pass off his goods as the goods of the plaintiff? (*f*)

The alteration is not, however, of substantial importance, for it was settled law, apart from the Acts, that, if a trader has taken a substantial part of the trade-mark of another, the onus of showing that he is not using it in a manner calculated to deceive is cast upon him (*g*), and this onus he could hardly discharge if the mark had, in fact, become identified by use with the other trader. So that the change is, in effect, no more than the natural consequence of treating registration as equivalent to public use of the registered mark (*h*).

In most of the cases where the Court has interfered to prevent the passing off of the defendant's goods as those of the plaintiff, the deception has been found to have been deliberately practised; but fraud is not necessary to enable the Court to act (*i*); accordingly, its presence does not constitute a material distinction between cases where actions in respect of the unlawful imitations of trade-marks do or do not fall within the prohibition of sect. 77.

It can rarely happen, therefore, that the prohibition of sect. 77 will prevent the owner of an unregistered mark, which has, in fact, become known to the public, or to a

Proof of fraud is not necessary to escape the prohibition.

Failure to register only deprives the proprietor of

(*f*) Sect. 76; see *per* Cotton, L.J., in *Mitchell v. Henry*, 15 C. D. at p. 193 (1880); in *Edwards v. Dennis*, 30 C. D. at p. 471 (1885); and in *Lyndon's Tm.*, 32 C. D. at p. 117 (1886); and Chap. XV., p. 314.

D. 434, C. A.; 7 App. Cas. 219 (1882). This case was begun in 1877, before sect. 1 of the Act of 1876 came into operation; it was therefore decided under the old law; see 7 App. Cas. p. 228.

(*h*) Sect. 75.

(*g*) *Orr-Ewing v. Johnston*, 13 C.

(*i*) Chap. I., p. 14.

the advantages of the Acts.

considerable, although indefinite, number of purchasers, as indicating that the goods upon which it appears are his goods, from protecting it against infringement, for the adoption of the mark, or of a substantial part, or a colourable imitation of it, can hardly fail to be calculated to pass off the goods of others as those of the owner; but the want of registration will cast upon the plaintiff in any action the necessity of proving that goods bearing the mark are known as his, and that goods bearing the mark complained of are likely, by reason of the resemblance between the marks, to be mistaken for his. And where an injunction is granted to restrain the use of a mark calculated to pass off the defendant's goods as those of the plaintiff, by reason of its resemblance to his unregistered mark, it should be so limited as to leave it open for the defendant to use any part, or the whole, of the plaintiff's unregistered mark, if he can do so, in any manner which is not calculated to lead to deception (*k*).

Goodfellow v. Prince.

The case of *Goodfellow v. Prince* (*l*), which is the only reported case in which sect. 77 has proved fatal to a plaintiff where he sought relief on the ground of passing off, as well as in respect of an infringement of his trade-mark, turned upon the view taken by the Court of Appeal that, as both plaintiff and defendant were importers, not producers, of the goods in question, the mark complained of was not calculated to suggest that the goods sold by the defendant were those of the plaintiff, but only that they were those of the producer from whom he bought.

Unregistered trade-marks and the Merchandise Marks Act, 1887.

Failure to register a trade-mark, whether it be occasioned by the incapability of registration of the mark, having regard to the definition clauses, or be due to any other reason, is material on other grounds than those depending upon sect. 77, for the definition of a trade-mark contained in the Merchandise Marks Act, 1887, is, as regards Great

(*k*) See the judgments in *Montgomery v. Thompson*, (1891), A. C. 217; 8 R. P. O. 361; and above,

p. 266.

(*l*) 35 C. D. 9 (1887), C. A.

Britain and Ireland, restricted to trade-marks registered under the Act of 1883, and an unregistered mark is consequently deprived of the very valuable protection, under the criminal law, constituted by the penalties and punishments provided by the former statute for forging trade-marks, falsely applying trade-marks to goods, or selling, exposing, or having in possession for sale, or for any purpose of trade or manufacture, any goods or things to which a forged trade-mark is applied. The provisions of the statute as to applying a false trade description do, however, extend to unregistered trade-marks (*m*).

(*m*) Sect. 3 (2); see Book II., Chap. I., p. 492.

CHAPTER XIII.

ASSIGNMENT AND DEVOLUTION OF TRADE-MARKS.

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A trade-mark
is assignable
only with the
goodwill.

TITLE to a trade-mark cannot be assigned, and cannot devolve in gross, but, unless the mark connotes a personal connection between its original owner and the goods in connection with which it is used, it may be assigned and transmitted, together with the goodwill of the business in such goods.

This proposition was fully established before the first Registration Act was passed, and, as regards registered trade-marks, it was, in part, embodied in that Act. The section in question, sect. 2, so far as it related to

assignment and transmission, was identical in terms with the corresponding section of the present Act here set out.

By sect. 70—

“A trade-mark, when registered, shall be assigned and transmitted only in connection with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that goodwill” (a). Sect. 70.

Until it was established that there could be property in a trade-mark, there could, of course, be no question of the assignment of trade-mark rights (b), although the successors of the original founders of a business no doubt took over and continued to use the old trade-marks employed in it, and were protected when other traders sought to pass off their goods as the goods of the lawful users of the marks (c). But as soon as trade-marks were recognized as the subjects of property, the alienation of them, as of any other property rights, was permitted, subject only to such limitations as were necessary to prevent the use of the marks becoming deceptive.

And, conversely, it was held, that the sale and transfer of the goodwill of a business assigned the trade-marks used in the business to the purchaser and transferee by implication, and without any express grant being needed (d). Transfer by implication with goodwill.

The leading cases on the subject are, *Hall v. Barrows* (e), and *The Leather Cloth Co. v. The American Leather Cloth Co.* (f). They were decided at the same time, in 1863, *Hall v. Barrows.*

(a) The last clause of the section adds, “and shall be determinable with that goodwill,” see the next chapter.

(b) See *per Fry, L.J.*, in *Pinto v. Badman*, 8 R. P. C. at p. 194 (1891).

(c) See, for instance, *Webster v. Webster*, 3 Swan. 490 (1791), *Thurlow, L.C.*; and *Motley v. Downman*, 3 My. & Cr. 1 (1837), *Cottenham,*

L.C.

(d) *Skipright v. Clements*, 19 W. R. 599 (1871), *Malins, V.-C.*

(e) 32 L. J. Ch. 548; 33 L. J. Ch. 204; 4 De G. J. & S. 150, *Romilly, M.R.*, and *Westbury, L.C.*

(f) 1 H. & M. 271; 32 L. J. Ch. 721; 4 De G. J. & S. 137; 33 L. J. Ch. 199; 11 H. L. C. 523; 35 L. J. Ch. 53, *Wood, V.-C.*,

by Lord Westbury, and his judgment in the latter case was affirmed by the House of Lords; in the first case, the question at issue was, whether, in determining the sum to be paid by the surviving partner of a firm who took over the partnership assets, at a valuation, under the articles of partnership, the value of the trade-mark used by the business ought to be taken into account, and the Lord Chancellor, reversing the decision of Romilly, M.R., held that it ought to be so taken, the valuation being made, however, on the footing that the surviving partner was entitled to carry on a similar business and to use the trade-mark in it without payment. The trade-mark was the letters B. B. H. (the initials of the partners composing the original firm), surmounted by a crown, and the Master of the Rolls had held that it could not be sold, because it designated the firm which manufactured the particular goods. "It would," he said, "obviously be a fraud on the public if the Court of Chancery were to attempt to sell to another person the right of holding out to the public that the goods manufactured by him were, in fact, goods manufactured by another and distinct firm." And he distinguished the mark in question from marks indicating the manufacture of a particular factory, which might rightly be transferred with the factory. Lord Westbury dissented from the view that the trade-mark was a personal mark. "It must be borne in mind," he said, "that a name, although originally the name of the first maker, may in time become a mere trade-mark or sign of quality, and cease to denote or be current as indicating that any particular person is the maker." And he held, as a fact, that the connection represented by the mark was a connection with the business and the factory at which it was carried on, not a connection with the persons who were the owners of these, and that, accordingly, the trade-mark

Trade-mark comprising the name of the original proprietor.

Lord Westbury's judgment.

Westbury, L.C., and H. L. See J. Ch. 465 (1863), Romilly, M.R. also *Bury v. Bedford*, 32 L. J. Ch. and L.JJ. 741; 4 De G. J. & S. 352; 33 L.

belonged to the partnership as part of its property, and might be sold with the business and works.

In *The Leather Cloth Case* (g), the plaintiffs sued the defendants for an alleged infringement of their trade-mark, and Lord Westbury, reversing the decision of Wood, V.C., dismissed the suit on the ground that the trade-mark of the plaintiffs contained material misrepresentations. The plaintiffs had purchased the marks from an American company—the Crockett International Leather Cloth Co.,—who were the successors of Crocketts & Co., and the marks contained the names both of the company and the firm, as well as an American address which was not the address of the plaintiffs. The presence of the names and address amounted, in Lord Westbury's opinion, to a representation that the goods on which the mark was used were the goods of the original firm or of the American company, and the marks, therefore, could not be properly used by the plaintiffs, and consequently could not be validly assigned to them. And this judgment was fully indorsed by the House of Lords, although Lord Cranworth and Lord Kingsdown, on the appeal, based their judgments chiefly on the ground that there was in fact no infringement, and Lord Westbury placed his upon wider grounds than those he had adopted on the appeal from the Vice-Chancellor, namely, that the alleged trade-marks were in fact only advertisements and not trade-marks at all.

The Leather Cloth Case.

The mark is unassignable if deceptive when used by an assignee.

The following passage from Lord Kingsdown's judgment in the House of Lords (h) shows the principle upon which the assignment of trade-marks and trade-names, as well as the limitations restricting such assignment, are based:—"By the usage of trade, the name of a firm is understood not to be confined to those who first adopted it, but to extend to and include persons who had afterwards been introduced as partners, or persons to whom the

Lord Kingsdown's judgment in *The Leather Cloth Case.*

(g) Note (f). The case is further stated at p. 47, above.

(h) 35 L. J. Ch. p. 64; 11 H. L. C. 523

“original partners have transferred their business. The name of a firm continues to be used in many cases long after all the original traders have died, or have ceased to have any interest in the concern—as in the great banking houses of Child and Coutts, and many other mercantile houses. If a manufacturing company uses the name of the firm, and stamps the name of its firm upon its goods, though the name of the firm no longer represents the same persons as at first, it is no fraud upon the public for the reasons I have already mentioned. For the same reason, the use of the old trade-mark of the firm by the new partners or their successors (if the term ‘trade-mark’ be understood in what I have already said is its proper sense (*i*)), is no fraud upon the public; it is only a statement that the goods are the goods of the firm whose trade-mark they bear.” And Lord Cranworth said, “The right to a trade-mark may, in general, treating it as property, or as an accessory to property, be sold or transferred upon a sale and transfer of the manufactory of the goods on which the mark has been used to be affixed, and may be lawfully used by the purchaser (*k*).

The mark used by the assignee must indicate what it indicated when used by the assignor.

In the recent case of *Pinto v. Badman* (*l*), Fry, L.J., stated the rule governing the assignment of a trade-mark in concise and definite terms: “It may be assigned,” he said, “if it is indicative of origin, when the origin is assigned with it. It cannot be assigned when it is divorced from its place of origin, or when, in the hands of the transferee, it would indicate something different to what it indicated in the hands of the transferor.”

A mark comprising the trader's name is assignable.

And as the judgments quoted above show, a trade-mark is not deceptive in the hands of an assignee of the business of the original proprietor, and consequently unassignable, merely because it comprises the name or initials of the

(*i*) *i.e.*, a symbol or emblem, come by use to be recognised in the trade as the mark of the goods

of a particular person (above, p. 25).

(*k*) 35 L. J. Ch. p. 61.

(*l*) 8 R. P. O. 181 (1891), C. A.

original proprietor, or of any of the former owners of the business (*m*).

So, the right to use a trade-mark for a sauce cannot be sold without the business in the sauce, or the secret of its manufacture (*n*), or the right to the use of a brand for cigars, without the factory and business of the manufacturer who first acquired it (*o*).

But the trade-marks used in a part of a business may be sold with the goodwill of that part only, and if the goodwill sold is restricted to some only of the goods in which the vendor dealt, the purchaser will only obtain the right to use the trade-marks assigned to him upon the goods in question, even though they be registered for other goods. Thus a mark was registered for "unwrought and partly wrought metals used in manufacture," and the proprietors assigned it together with their goodwill "in the trade or business of galvanized iron merchants and manufacturers," but the business, in fact, being entirely confined to sheet iron, the assignor's rights were held to be restricted to that description of goods only (*p*).

Sale of trade-marks with the goodwill of part of the business.

It is not essential that the assignments of the trade-mark and the transfer of the goodwill should be exactly contemporaneous (*q*), or even that there should be any legal conveyance of the latter, if the assignee is equitably entitled to it. An assignment to the owner of the business in connection with which the trade-mark is used or intended to be used has, consequently, been permitted in some cases where it has been registered by mistake or accident in the name of a person other than that owner (*r*).

Transfer of goodwill and trade-mark not necessarily contemporaneous.

(*m*) *Hall v. Barrows; Bury v. Bedford*, above, p. 274. See also *Hudson v. Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C.

(*n*) *Cotton v. Gillard*, 44 L. J. Ch. 90 (1874), Jessel, M.R.

(*o*) *Pinto v. Badman*, 8 R. P. C. 181 (1891), C. A.

(*p*) *Edwards v. Dennis*, 30 C. D. 454 (1885), C. A.

(*q*) *Welcome's Tm.*, 32 C. D. 213; 3 R. P. C. 76 (1886), Chitty, J.; *Hammond v. Malcolm, Brunner & Co.*, 9 R. P. C. 301 (1892), Chitty, J.

(*r*) See Chap. XI. p. 236; *Greenlees' Tm.*, 9 R. P. C. 93 (1892), Stirling, J.; *Zeahy v. Glover*, 10 R. P. C. 141 (1893), H. L.; and see last note.

Trade-marks on bankruptcy and dissolution of partnership.

Upon the dissolution of a partnership in the absence of special agreement (*s*), the trade-marks of the firm are part of its assets, and are saleable as such with the goodwill (*t*); but it seems that each of the partners is at liberty to make use of the trade-name of the firm, and of its trade-marks, provided he can and does do so in such a way as to avoid deceiving the public, or casting any risk or liability upon his late partners (*u*). Similarly, upon the death or bankruptcy (*x*) of a trader, his trade-marks may be sold with the goodwill of his business by his executors or trustees.

The register of trade-marks comprises notifications of assignments, and of transmissions of trade-marks (*y*), and it is provided by sect. 87 that:—

Sect. 87.
Registration of assignments.

“Where a person becomes entitled by assignment, transmission, or other operation of law (to a patent, or to the copyright in a registered design, or) to a registered trade-mark, the comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of (the patent, copyright in the design, or) trade-mark, in the register of (patents, designs, or) trade-marks (as the case may be). The person for the time being entered in the register of (patents, designs, or) trade-marks as proprietor of a (patent, copyright in a design, or) trade-mark (as the case may be) shall, subject to [the provisions of this Act, and to] (*z*) any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with the same, and to give effectual receipts for any consideration

(*s*) For instances of this, see *Bury v. Bedford*, 32 L. J. Ch. 741; 4 De G. J. & S. 352; 33 L. J. Ch. 465; and *Hanson v. Game, Harrison and Lerner, Ltd.*, 9 R. P. O. 186 (1892).

(*t*) *Hall v. Barrows*, above, p. 274.

(*u*) See the last case; *Hookham v. Pottage*, 8 Ch. 91 (1872), C. A.;

and *Thynne v. Shove*, 45 C. D. 577 (1890), Stirling, J.

(*x*) *Hammond v. Malcolm, Brunner & Co.*, 9 R. P. C. 301 (1892), Chitty, J.

(*y*) Sect. 78.

(*z*) Act of 1888, sect. 21, see below, p. 280.

“in connection with the goodwill of the business concerned in the particular goods or classes of goods for which the trade-mark has been registered.

Declaration to accompany request.

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

Further proof of title if required.

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

“Subject to the provisions of this Act.”

The amendment “subject to the provisions of this Act” in sect. 87 means, subject to the rule of sect. 70, that a trade-mark shall not be assigned or transmitted without the goodwill of the business in the goods for which it has been registered (*dd*).

Refusal to register an assignment.

If the comptroller refuses to enter an assignment upon the register, the assignee can apply to the Court under sect. 78, and also under sect. 90, as a person aggrieved by the omission of his name without sufficient cause from the register, for an order directing the registration. He must in any such case satisfy the Court that the goodwill of the business has been transferred to him (*e*), and that he is otherwise entitled to use the mark.

Action before registration.

Registration of the assignment is not, as registration of the mark itself is, a condition precedent to any action for infringement by the assignee (*f*).

Alteration of registered mark in consequence of assignment.

In some cases the assignment of a trade-mark to new proprietors makes an alteration in its form necessary or advisable. In the case of registered marks, such alteration

(*d*) See Rule 61, Appendix, p. 605. And as to the comptroller's power to dispense with evidence, Rule 53, p. 603.

(*dd*) Cf. sect. 76 above, p. 256.

(*e*) *Bancroft's Tm.*, 5 R. P. C. 209 (1888), Stirling, J.

(*f*) *Ihlee v. Henshaw*, 31 C. D. 323; 3 R. P. C. 15 (1884), North, J.; *Richards v. Butcher*, 7 R. P. C. 288 (1890), Kay, J.

may be allowed by leave of the Court obtained under sect. 92, provided that the mark is not altered in an essential particular (*g*). Thus in *Guinness and Co.'s Trade-mark* (*h*), Chitty, J., allowed the word *limited* to be added to the name upon the mark, the business and trade-marks of the old firm having been taken over by a company bearing the name of the firm with "limited" added to it. But in the case of an old mark the Court is very unwilling to allow any alteration to be made, although it has jurisdiction to do so if special circumstances render it necessary, for a mark registered as an old mark ought to be kept on the register as it was actually used before the 13th of August, 1875. So, in *Re Henry Clay, and Bock and Co.* (*i*), Kekewich, J., refused to allow an old mark to be altered by substituting, for the initials of one predecessor of the proprietors, the name of another and later predecessor, notwithstanding that the mark in its altered form had been registered for some years in Havanah, and had been extensively used by the applicants in England (*k*).

The part of sect. 87 which relates to licences would seem to apply, not to trade-marks, but exclusively to patents and to copyright in designs, with which the section also deals, for a licence to use a trade-mark would be either unnecessary or illegal: unnecessary if the mark were to be put upon the goods made or dealt in in the business to the goodwill of which the trade-mark was attached, since any person may lawfully attach a trade-mark to the goods which are in fact the goods it indicates (*l*); illegal if it were to be put upon any other goods (*m*). This was the view of Lord Herschell's Committee, and they advised that the part of the section relating to trade-marks should be separated from the rest. The passage in their report is as follows. After

Licence to use a trade-mark.

(*g*) *Murphy's Tm.*, 7 R. P. C. 449.
163 (1890), W. N. 84.

(*k*) See further, Chap. XI. p. 248.

(*h*) 5 R. P. C. 316 (1888); *Re Bryant & May, Ltd.*, 4 Times L. R. 675, Stirling, J.

(*l*) See Chap. II. p. 32.

(*m*) *Oldham v. James*, 13 Ir. Ch. 393; 14 Ir. Ch. 81 (1862).

(*i*) (1892) 3 Ch. 549; 9 R. P. C. 393; 14 Ir. Ch. 81 (1862).

quoting sections 70 and 87, they say (*n*), "It has been suggested that this (sect. 87) gives power to assign, or at all events to grant licences to use, a trade-mark apart from the goodwill of the business concerned in the goods for which it has been registered. Probably the two sections read together may receive a consistent construction; but in order to avoid doubt it would be well to amend sect. 87 by dealing specifically with trade-marks, omitting the words as to granting licences, and providing that assignments are to be subject to the provisions of the Act." But the only amendment made by the Act of 1888 was the interpolation of the words quoted above.

Lease of goodwill and trade-marks.

If the goodwill of a business be leased for a term, the right to use the trade-marks identified with it would during the term pass to the lessee, in the absence of special agreement; and if it were reserved on the principles stated above, the lessor could not rightly use the marks. It seems that the registration of the lessee as assignee of the marks without the consent of the lessor, would not, however, be rightly made (*o*).

Action by licence.

The only authorized dealer in goods bearing a particular trade-mark in the United Kingdom, who is in a sense a licensee of the trade-mark rights, cannot sue for infringement of the trade-mark (*p*). But a true licensee of the rights, if there can lawfully be such a person, could not sue either (*q*).

(*n*) Report of 1888, p. xiv.

(*o*) *Re Avril*, Stirling, J., 20th April, 1888; Sebastian, 3rd ed. p. 404, cited above, p. 237.

(*p*) *Richards v. Butcher*, 7 R. P. C. 288 (1890), Kay, J.

(*q*) *Heap v. Hartley*, 42 C. D. 461; 5 R. P. C. 603; a Patent Case; *Woolley v. Broad*, (1892) 1 Q. B. 808; 9 R. P. C. 208, 429; a Design Case.

CHAPTER XIV.

DETERMINATION OF TRADE-MARK RIGHTS.

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THE right of the proprietor of a mark (subject to the rights of other proprietors, if any, of the same mark (a)) to the exclusive use of it upon the goods of the kind in respect of which the right existed is determined :—

Modes of de-
termination.

(1) When the mark so used ceases to be distinctive ;

(2) When the proprietor is no longer able to use it in

(a) See the three mark rule, p. 177, and sect. 87, p. 278.

the business in connection with which the right was acquired ;

- (3) When he has abandoned it; and
- (4) When he has forfeited his claim to protection of his right by using the mark deceptively or in a fraudulent trade (*b*).

The proprietor may, in general, use the mark after his exclusive rights have determined.

In the first case the mark can no longer be the subject of trade-mark rights, and anyone may use it; but in the others, if there are any independent proprietors of the mark for the same class of goods, their rights will be unaffected by the determination; and in the third and fourth cases, their rights will continue to be qualified by his right to use the mark himself on the goods, so long as he uses it in the business in connection with which it was acquired.

1. Loss of Distinctiveness.

The first case follows immediately from the definition of a trade-mark given in Chapter II. It is there shown that the function of a trade-mark is to distinguish the goods, to which it is applied or attached, from similar goods, and to identify them with a particular trader and his successors in business. And distinctiveness is an essential condition of capacity for registration under the Acts (*c*). Further, the test of infringement is that the use of the mark, or of a similar mark, by others than the proprietor, is calculated to cause their goods to be bought as his (*d*). So that, apart from the Acts, a mark which has ceased to be distinctive is incapable of being the subject of trade-mark rights, and no action for infringement could be successfully brought to prevent any trader using it, and if not already registered, it would be incapable of registration under the Acts.

(*b*) See Chap. XV., "the action for infringement," defences, pp. 336 *et seq.*

(*c*) Chap. VIII. p. 106.

(*d*) *Mitchell v. Henry*, 15 C. D.

181 (1880), James, L.J.; *Edwards v. Dennis*, 30 C. D. 454 (1885), Cotton, L.J.; see also *Ford v. Foster*, 7 C. D. 611, cited below, p. 286.

The elements of distinctiveness have been considered at length elsewhere (*e*), and it will be sufficient here to refer to some of the modes in which a mark may cease to be distinctive, and to give a few examples of cases in which the question has arisen. Marks are not distinctive if they are descriptive (*f*), and, in particular, if they have been adopted in the trade concerned as the names of the goods for which they are claimed as trade-marks (*g*), or are common marks (*h*), or marks common to the trade (*i*), or if they connect the goods, not with their proprietor, but with some other trader (*k*).

How distinctiveness may be lost.

Distinctiveness may be lost through the action of the proprietor, or by reason of successful piracy.

By the action of the proprietor.

Thus, if the proprietor abandons his mark (*l*), it will almost inevitably become a common mark, unless there are other persons who have trade-mark rights in it which they assert. So, if he uses it himself as the name of the goods he deals in, the trade will probably adopt the same course, especially if he is for a time the only dealer in the goods (*m*).

Before the Registration Acts a difficult question of fact was often raised in trade-mark cases where admittedly a name or other mark had been introduced by the plaintiff, but it was alleged that it had by repeated use on the goods of other traders lost its original significance indicating a connection with the plaintiff, and had become *publici juris* (*n*). As already pointed out, this difficulty is not likely to arise in the case of a registered mark, since the public advertisement of the registration, and the readiness with which the infringement of a properly registered mark

(*e*) Chap. II. p. 35; Chap. VIII. p. 119.

(*f*) See above, descriptive marks, p. 36; devices, p. 131; words, p. 145.

(*g*) Page 36.

(*h*) Page 122; see also the "three mark rule," Chap. IX., p. 172.

(*i*) Page 171.

(*k*) *Wood v. Lambert*, 32 C. D. 247; 3 R. P. O. 51 (1886), C. A., (*Eton*

Cigarettes).

(*l*) See below, p. 289.

(*m*) *Linoleum Manufacturing Co. v. Nairn*, 7 C. D. 834 (1878), Fry, J.

(*n*) See *Ford v. Foster*, 7 Ch. 611 (1872); *Singer Manufacturing Co. v. Wilson*, 2 C. D. 434; 3 App. Cas. 376 (1875).

can be prevented, under sect. 76, both tend to warn other traders against the use of the mark, and enable the proprietor to protect his rights.

By extensive piracy.

Extensive infringement by a single trader can hardly suffice to make a trade-mark common. "It has been said that one murder makes a villain, and millions a hero; but I think it would hardly do to act on that principle in such matters as this, and to say that the extent of a man's piratical invasion of his neighbour's rights is to convert his piracy into a lawful trade (o)." Nor will a few unprosecuted scattered infringements by several traders (p).

The test whether a mark has become *publici juris*.

"There is no doubt, I think," Mellish, L.J., said, in *Ford v. Foster* (q), "that a word which was originally a trade-mark, to the exclusive use of which a particular trader, or his successors in trade, may have been entitled, may subsequently become *publici juris*, as in the case which has been cited of *Harvey's Sauce* (r). I think the test must be whether the use of it by other persons is still calculated to deceive the public (s), whether it may still have the effect of inducing the public to buy goods not made by the original owner of the trade-mark as if they were his goods. If the mark has come to be so public and in such universal use that nobody can be deceived by it, and can be induced from the use of it to believe that he is buying the goods of the original trader, it appears to me, however hard to some extent it may appear on the trader, yet practically, as the right to a trade-mark is simply a right to prevent the trader from being cheated by other person's goods being sold as his goods through the fraudulent use of his trade-mark, the right to the trade-mark must be gone" (t).

(o) *Per James, L.J., in Ford v. Foster*, L. R. 7 Ch. p. 625.

(p) *Kinahan v. Bolton*, 15 Ir. Ch. 75 (1863), Brady, C.

(q) L. R. 7 Ch. p. 628.

(r) *Lazenby v. White*, 41 L. J. Ch. 354 (1871).

(s) So the long duration of

fraudulent user is immaterial if it is still calculated to deceive: *Heutor's Tm.*, 27 C. D. 570 (1884), Kay, J., (*Hoop & Iron*).

(t) See also *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238 n.; and *Hyde & Co.'s Tm.*, 7 C. D. 724, both (1878), Jessel, M.R.

Upon the facts of the case, the Lords Justices held that the name in question had become *publici juris* to this extent, "that by the use of it in trade circulars, which are issued only to retail dealers, or by shirts being invoiced by the wholesale dealers '*Eureka Shirts*,' no retail dealer would be likely to be deceived, or be led to buy shirts which were not made by Ford believing they were Ford's shirts," but that a considerable portion of the public who buy shirts for the purpose of wearing them would still be very liable to be deceived by the use of the word *Eureka* on the shirt itself. And the injunction granted by the Court accordingly left the defendants at liberty to advertise the name *Eureka* as between themselves and the trade (*u*).

A mark may be *publici juris* in a particular branch of the trade only.

2. Separation of the Mark from the Goodwill.

It has been shown in the last chapter that the trade-mark rights in a mark are inseparable from the goodwill of the business in the goods upon which the mark is used, for the function of the mark is to connect the goods with the trader who owns the business, and his successors (*x*). The indication of that connection is its original signification, and it cannot legally be used as a trade-mark with any other (*y*). It follows that if the goodwill is lost, or passes into other hands than those of the proprietor of the mark, the exclusive rights of the proprietor in respect of the use of the mark are determined, and this rule is recognized by the Acts in the case of registered marks. Sect. 2 of the Act of 1875, and sect. 70 of the present Act of 1883, enact that a trade-mark "shall be assigned and transmitted only in connection with the goodwill of the business concerned in the particular goods or classes of goods" for which it has been registered, and the latter

Sect. 70.

(*u*) L. R. 7 Ch. p. 634; of *Singer, & Co. v. Spence*, 10 R. P. C. 297 (1893), Romer, J.

(*x*) See the judgment of Mellish, L.J., in *Ford v. Foster*, cited above,

and Chap. II., p. 24.

(*y*) See the judgment of Fry, L.J., in *Pinto v. Badman*, 8 R. P. C. 181 (1891), cited above, p. 276.

section expressly adds "and shall be determinable with such goodwill."

No exclusive right in a registered mark apart from the goodwill.

No question therefore arises as to whether the registered owner of a trade-mark which has determined by separation from the goodwill of the business can sue for infringement, for sect. 76, which grants the right of exclusive use to the proprietor of a registered mark, makes the grant "subject to the provisions of this Act," and consequently subject to sect. 70.

Removal of mark when the goodwill is determined (z).

It was provided by rule 34 of the Rules of 1876, for which the Rules of 1890 are now substituted, that—"The Court may, on the application of any person aggrieved, remove any trade-mark from the register on the ground, after the expiration of five years from the date of the registry thereof, that the registered proprietor is not engaged in any business concerned in the goods within the same class as the goods with respect to which a trade-mark is registered." And in *Ralph's Case* (a), where the registered proprietor had not manufactured the machine, for which the mark was registered, for twenty-one months before the date of the application, Pearson, J., in accordance with the rule, directed the mark to be removed.

The rule has not been re-enacted, and there is now no provision enabling a properly registered mark to be removed except for non-payment of fees after fourteen years (b), or at the request of the proprietor (c).

Temporary separation from the goodwill or disuse of mark is immaterial.

A mere temporary cessation of business (d), or delay in the transfer of the goodwill (e), would not determine the trade-mark rights. The judgment of Pearson, J., in *Ralph's Case* (f), notwithstanding the repeal of the rule on which it was founded, may be useful to indicate what length of cessation of a business determines the goodwill, and there-

(z) See below, p. 291.

(a) 25 C. D. 194 (1883), cited *infra*.

(b) Sect. 79.

(c) Sect. 91.

(d) See the next page.

(e) *Welcome's Tm.*, 32 C. D. 76; 3 R. P. O. 213 (1886); *Hammond v. Brunner*, 9 R. P. O. 301 (1892), both Chitty, J.

(f) *Supra*.

fore also the trade-mark rights attached to it. "The only question I have to determine," he said, "is whether one year and nine months is sufficient cesser on the part of Mr. Ralph to show that he comes within the (34th) rule. I am of opinion that one year and nine months is quite sufficient. If I had any doubt about it, I am able by analogy to say that I should not be wrong in concluding that one year and nine months is sufficient, from the fact that under the Companies Act you may wind up a company if it has ceased to carry on business for a year. The legislature in that has shown by its enactment when a business is supposed to be carried on, and what amount of cesser shows that the business is not being carried on." And it made no difference, he held, that the cessation of business was due to the ill-health of the proprietor.

3. Abandonment.

A trade-mark right, as any other right, can, of course, be abandoned by the owner; but so long as he remained the registered proprietor of the mark and carried on the business to which the mark was attached, it would be difficult, if not impossible, to show abandonment, unless, either by repeated and undisturbed infringements, or by the use of the mark by the proprietor himself in some way inconsistent with the maintenance of its character as a trade-mark, it had become a common mark so as to fall under the first case (*g*), or a case could be made by any particular defendant sued by the owner for infringement to show that he had been led by the conduct of the plaintiff to believe that the mark was a common mark, and so to set up an estoppel (*h*).

(*g*) *Ante*, p. 284.

(*h*) See the next chapter: estoppel, p. 330; acquiescence, p. 332; and delay, p. 333. See also *Browne v. Freeman*, 12 W. R. 305; 4 New Rep. 476 (1864), Wood, V.-O., where the dismissal, at his own request, of a previous suit by the

plaintiff against the defendant to restrain the use by the latter of *Chlorodyne*, was treated as conclusive against him that he had no exclusive right to use the word. He brought a third suit in 1873, W. N. 178.

Agreement
to abandon
trade-mark.

The possible case of an agreement by the proprietor to abandon his mark stands by itself. The other party to the agreement, if sued for infringement, could no doubt rely upon it as a defence, and might possibly, if the mark were registered, obtain an order, by way of specific performance of an implied term in the agreement, that the proprietor should apply under sect. 91 to cancel the registration.

Not mere
disuse.

Mere disuse of the mark does not amount to abandonment of trade-mark rights in respect of it. For "A man who has a trade-mark may properly have regard to the state of the market and the demand for the goods; it would be absurd to suppose that he lost his trade-mark by not putting more goods on the market when it was glutted" (i). Accordingly, in the case cited, a mark was directed to be registered concurrently with a similar mark in the same class which had been previously registered, and which the Court refused to expunge, although the proprietor of the former mark, having adopted it in 1874 and used it largely in the two years following, from 1876 to 1882 had used it less and less, and had in the last-mentioned year forgotten, and ceased to use it altogether. He had not, however, broken up the moulds he used for the marked goods, or erased the mark from his books or price lists.

Adoption of
a new mark.

The adoption of a new mark may be evidence of the abandonment of an old one (k). But the fact of itself is not conclusive, for it is no justification for the defendant to say, "The plaintiff has two ways of identifying his goods, and I have only stolen one of them" (l). And the fact that the owner of a word-mark uses it always in connection with his own name, is not conclusive to show that the mark is not a trade-mark, or that he has waived his rights in it as such (l).

Use in con-
nection with
the proprie-
tor's name.

Neglect to
prosecute in-
fringements.

Neglect to proceed in respect of infringements, which do not amount to user sufficient to affect the distinctiveness of

(i) *Per* Chitty, J., in *Mouson v. Boehm*, 26 C. D. 398 (1884).

(k) *Lea v. Miller*, Seb. Dig. p. 305 (1876), Jessel, M.R.

(l) *Per* Wood, V.-C., in *Braham v. Hustard*, 1 H. & M. 447 (1883),

(*Excelsior White Soap*).

the mark, does not affect the proprietor's rights if he is aware of the infringements (*m*), still less if he is not (*n*).

A corporate trade-mark, not re-registered in the Sheffield Register before the 1st of January, 1889, is to be deemed to have been abandoned (*nn*). Old corporate mark.

4. Forfeiture of Right to Protection.

The forfeiture of the right of the proprietor of a trade-mark to have his trade-mark protected by the Court, is discussed elsewhere, under the head of defences to an action for infringement (*o*).

5. Removal of Mark from the Register.

No provision is made in the present Act or rules for the removal from the register of marks in which the trade-mark rights have determined, except for non-payment of fees. For sect. 90 only applies to entries on the register originally made without cause (*p*), and rule 34 of the Rules of 1876 has not been renewed (*q*). But it is submitted that the Court has jurisdiction to order the registration of a mark, which is no longer a trade-mark, to be expunged, on the ground that the register is intended by the Acts to be a register of trade-marks only (*r*). The Court is not, however, constituted the custodian of the register by any part of the Acts, but is expressly empowered by sections 90 and 92 to make orders affecting it in the cases included under the sections respectively. In *Welcome's Case* (*s*), Chitty, J., upon an application under sect. 78, directed an assignment to be registered, although that section contains no reference to the Court, or to ratification of the register; but the question of jurisdiction, so far as can be gathered from the report, was not argued. Where the trade-mark has determined.

(*m*) *Kinahan v. Bolton*, 15 Ir. Ch. 75 (1863), Brady, C.; *Ford v. Foster*, L.R. 7 Ch. 611 (1872), L.JJ.

(*n*) *Re Farina*, 27 W. R. 456 (1879), Hall, V.-C. See the next chapter, p. 333.

(*nn*) Sect. 81 (9).

(*o*) Chap. XV., p. 336.

(*p*) Chap. XI., p. 220.

(*q*) Above, p. 288.

(*r*) See sect. 78.

(*s*) 32 C. D. 213; 3 R. P. C. 76 (1886).

Possibly, however, the intention of the legislature was to leave a registered mark in respect of which the trade-mark right had determined by abandonment, or otherwise, upon the register, as an obstacle to the registration of similar marks for the same goods or description of goods, until it should be removed under the provision next referred to.

It is provided by sect. 78, that :—

For non-
payment of
fees.

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

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

Restoration
of the mark.

“(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 non-payment of the prescribed fee, the comptroller may, if satisfied that it is just so to do, restore such trade-mark to the register, on payment of the prescribed additional fee.

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

Removed mark an obstacle to later registrations.

The section corresponds to rules 30 to 33 of the old rules of 1876.

Sub-sect. (5) refers to sect. 72 (*u*). It is directed to prevent the registration by another trader for the same goods or description of goods, of a mark the same as the removed mark, or having such resemblance to it as to be calculated to deceive, until such time after the removal of the other as is considered sufficient to allow the other to be forgotten, so that the new mark may not be taken for that of the proprietor of the old mark. The period provided for by the Act of 1883 was five years, but this was altered by the Act of 1888 to one year on the recommendation of Lord Herschell's Committee (*x*). With their approval also the proviso “unless, &c.” was added at the end of the sub-section, it being considered unnecessary to refuse the re-registration of the mark for a year if the late proprietor were dead or bankrupt, and no one claiming under his bankruptcy were using the mark, and if any other successor to his business neglected to pay the fee.

Notwithstanding the amendments, it is assumed that so long as the recollection of the removed mark survives in

A new mark may be deceptive by

(*t*) Act of 1888, sect. 19.

(*x*) Report of 1888, p. xiii.

(*u*) Chap. X. p. 175.

resemblance
to a removed
mark.

the trade, the use of it, or a mark resembling it, might be calculated to deceive, and might therefore be properly refused by the comptroller under sect. 73, or in his discretion.

Cause of
removal to be
registered.

It is provided by rule 47 that: "Where a trade-mark has been removed from the register for non-payment of the prescribed fee or otherwise, under the provisions of sect. 79 of the said Act, the comptroller shall cause to be entered in the register a record of such removal and the cause thereof."

Fees.

The fee for continuance of a registered mark at the expiration of fourteen years is 1*l*. Where the fee is not paid within three months after the expiration of the fourteen years there is an additional fee of ten shillings. The additional fee for restoration of a trade-mark where it has been removed for non-payment of the fee is 1*l*. (*y*). The forms of applications for continuance and restoration are forms X, Y, and Z (*z*).

Forms.

(*y*) Appendix, p. 606.

(*z*) *Ibid.*, p. 616.

CHAPTER XV.

THE ACTION FOR INFRINGEMENT.

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**Actions for
infringement
of trade-mark
and actions**

IT is convenient to deal with actions which are brought to prevent or to recover damages for the infringement of trade-marks, and with what are compendiously described

as "passing off actions," separately. In an action of the first class the plaintiff complains that the defendant has infringed his trade-mark by taking it in its entirety, or by taking a substantial portion of it, or colourably imitating it, and he relies on his title to the exclusive use of the mark in question for goods of a specified kind; in an action of the second class the plaintiff's case is less specialized, for he complains that the defendant is using means which are calculated to pass off, or to cause to be passed off, the goods of the defendant as and for those of the plaintiff, and the means may or may not comprise or consist of an infringement of a trade-mark to which the plaintiff has a title. The distinction between the two classes of actions has been accentuated by the provision, already discussed, which makes registration a condition precedent in general to the institution of actions ranking in the first class, that is, trade-mark actions proper (*a*). They are, however, closely connected, and in practice they are frequently combined, the statement of claim alleging both infringement and passing off. The first class is in reality a specialized variety of the second, having been divided off from other passing off actions when property in a trade-mark was first adopted as the ground of jurisdiction (*b*). And as the test of infringement is still whether, by reason of its resemblance to the plaintiff's mark, the defendant's mark is calculated to lead purchasers to believe that the goods on which it appears are those of the plaintiff, every case of infringement would be a case of passing off; but that where the actual mark is taken, or an obvious imitation is made, the Court does not trouble to inquire whether deception is likely to result, and, in the former case, it seems that it is precluded, by the provision that registration after five years shall give an exclusive title to the use of the registered mark, from doing so (*c*).

(*a*) Chap. XII., p. 260.

(*b*) Chap. I., pp. 4 and 13.

(*c*) Sect. 76, Chap. XII., p. 255;
Edwards v. Dennis, 30 C. D. 454
(1885), C. A.

1. Commencement of the Action.

In what Court
a trade-mark
action should
be com-
menced.

Jury.

The great majority of actions in respect of the infringement of trade-marks are commenced in the Chancery Division of the High Court (*d*), but such actions are not specially assigned to that division, and they have been occasionally transferred from it to the Queen's Bench Division in order to be there tried by a jury (*e*). This was done by Kay, J., in a case where the defendant submitted to a perpetual injunction and the question of damages only remained, on the ground that in trade cases a jury is the best tribunal to assess damages (*f*); but in an earlier case, where the right to the injunction was contested, the defendants having given notice requiring the trial to be by a judge and a special jury, Bacon, V.-C., ordered that the action should be by a judge alone (*g*), and the last-named judge also refused to order the transfer of the complicated and difficult case of *The Singer Manufacturing Co. v. Loog* (*h*) to be transferred to the Common Law Division so that the issues involved might be there tried with a jury, on the ground that the questions to be determined involved matters of law as well as fact, and were unfit to be dealt with by a jury.

Jurisdiction
of the County
Court.

An action for damages not exceeding 50*l.* for infringement of a trade-mark, might probably be brought in the County Court, for it is a personal action, and does not fall within any of the exceptions of the County Courts Act, 1888, s. 56. In practice, however, such a course is rarely, if ever, adopted, and it was certainly not contemplated when the Trade-Mark Acts were passed; for the Court upon which jurisdiction is conferred to rectify the register, to

(*d*) Or the Court of Chancery of the County Palatine of Lancaster. This Court has jurisdiction under the Patents, &c. Acts, sect. 112a (Act of 1888, sect. 26).

(*e*) See *Re Martin, Hunt v. Chambers*, 20 C. D. 365 (1882); and Ord. 36, r. 6.

(*f*) *Fennessy v. Rabbits*, 56 L. T. 138 (1887).

(*g*) *Spratt's Patent v. Ward & Co.*, 11 C. D. 240 (1879).

(*h*) 11 C. D. 656 (1879). In *Fennessy v. Clark*, 37 C. D. 184 (1887), the issues of fact were ordered to be tried by a judge and special jury.

grant certificates to a successful litigant entitling him to solicitor and client costs (*i*) in future actions respecting the same mark, and for other purposes, is the High Court (*k*). It has been held that an action for the infringement of a patent, the validity of which is disputed, cannot be brought in the County Court, on the ground that a patent is a franchise within the section 56 above mentioned (*l*); and in the judgments in the case referred to, some stress is laid upon the fact that the Patents, Designs, and Trade-Marks Act of 1883 does not contemplate that patent actions should be brought in a County Court, but this was not, and, it is submitted, could not have been, the ground of decision; for if the jurisdiction to try either patent or trade-mark actions exists in the County Court it is much older than the Act of 1883, and as a trade-mark right is not a franchise, the decision does not modify the jurisdiction to determine trade-mark actions which is apparently conferred by the County Courts Act.

Service of the writ out of the jurisdiction may be allowed if the case falls under any of the classes enumerated in Order 11, rule 1, for instance, if the plaintiff seeks an injunction to restrain infringements within the jurisdiction; but if the defendant carries on business in Ireland or Scotland, and not at all, or only to an inconsiderable extent, in England, leave to serve the writ upon him in either of the first-mentioned countries will be refused, and the plaintiff will be left to pursue his remedies in the local courts (*m*). On this ground leave to serve out of the jurisdiction has been refused even where an application to register the defendant's mark has been pending before the comptroller in London, on which the same witnesses would be required as in the action (*n*), and also where a motion

Service out of the jurisdiction.

(*i*) Sect. 77a (Act of 1888, sect. 18).

(*k*) Sect. 117; or the Palatine Court, sect. 112a.

(*l*) *Queen v. County Court Judge of Halifax*, (1891) 2 Q. B. 263, C. A.

(*m*) *Kinahan v. Kinahan*, 45 C.

D. 78; 8 R. P. C. 18 (1890), Kekewich, J. As to the rectification of the registrations of marks belonging to foreigners, see Chap. XI., p. 240.

(*n*) *Marshall v. Marshall*, 38 C. D. 330 (1888), C. A.

to expunge the defendant's mark was pending in the English Courts (*l*). In the former case (*m*) the refusal was based partly on the fact that if an injunction were granted it could not be enforced against the defendant personally in England, but only against his agents. But where a Scotch manufacturing company had three branches, and an important business in England, leave was granted to sue them here (*n*).

Actions by
foreigners.

An alien, not being a subject of a country actually at war with England, if he is the proprietor of a trade-mark which exists as such in this country, may sue in the English Courts in respect of infringements by English traders (*o*). But sect. 77, prohibiting actions in respect of the infringement of unregistered trade-marks applies to trade-marks belonging to foreigners (*p*).

Notice of
action is un-
necessary.

No notice need be given to the alleged infringer before the action is brought (*q*), and the plaintiff's right to bring the action is not affected by the ignorance of the defendant of the plaintiff's claim to the mark, or the readiness of the defendant to cease the infringement when called upon to do so (*r*). "A plaintiff in these cases," Chitty, J., said, in *Upmann v. Forester* (*s*), "is placed in circumstances of difficulty, because if he were to give notice there is great probability of the defendant at once getting rid of the spurious articles before the plaintiff could interfere; and the plaintiff therefore would in many instances be affording the defendant an opportunity of doing what the injunction would have prevented. I well remember that the late

(*l*) *Kinahan v. Kinahan*, *supra*; cf. *King & Co.'s Tm.*, (1892) 2 Ch. 462; 9 R. P. C. 350.

(*m*) *Marshall v. Marshall*, 38 C. D. 330 (1888), C. A.

(*n*) *Burland v. Broxburn Oil Co.*, 41 C. D. 542; 6 R. P. C. 482 (1889), Chitty, J.

(*o*) *The Collins Co. v. Brown*, 3 K. & J. 422 (1857), Wood, V.-C.; *The Collins Co. v. Reeves*, 28 L. J. Ch. 56 (1858), Stuart, V.-C.

(*p*) See *Goodfellow v. Prince*, 35 C. D. 9 (1886), C. A.; and above, Chap. XII., p. 264; although Malins, V.-C., expressed a contrary opinion in *Ticentsche, &c. v. Ellinger & Co.*, 26 W. R. 70 (1877).

(*q*) *Pierce v. Franks*, 15 L. J. Ch. 122 (1846), Knight-Bruce, V.-C.

(*r*) *Burgess v. Hately*, 26 Beav. 249 (1858), Romilly, M.R.

(*s*) 24 C. D. 231 (1883).

“Master of the Rolls, Sir G. Jessel, stated that he was, when at the Bar, accustomed in cases like this to advise his clients not to give any notice, but to move at once” (*t*). And consequently the omission to give notice before action does not disentitle the plaintiff to costs (*u*).

2. The Plaintiff's Title.

The plaintiff must be owner of the trade-mark (*r*) which is alleged to have been infringed, and the onus of proving that he is entitled to the exclusive use of the mark for the particular class of goods (subject, if the case is so, to the concurrent rights of persons, other than the defendant, who are also owners of the same or a similar trade-mark) is cast upon him (*x*). So where a manufacturer, a shipper and a foreign consignee, devised a trade-mark in concert, and used it for goods sent by the manufacturer through the shipper to the consignee, and afterwards the manufacturer began to use it for goods not sent through the shipper, and the shipper for goods not obtained from the manufacturer, and cross-actions for infringement were brought by the shipper and the manufacturer, it was held that neither of them could make out a title to exclusive use, and both actions were dismissed (*y*). Joint trade-marks.

In a case where Messrs. Harper and Moore, the plaintiffs, had been the lessees of certain brickworks, and had been accustomed to make bricks of the clay produced by mines of which they were lessees also, and after the expiration of their leases, the defendants, who had obtained a lease of the brickworks only, advertised themselves as “E. & J. Pearson (late Harper and Moore),” thereby suggesting

(*t*) 24 C. D. 231 (1885).

(*u*) See below, p. 364.

(*v*) The questions, What is a Trade-Mark, and, What can be Registered as a Trade-Mark, are discussed in Chap. II, p. 24; and Chap. VIII., p. 106.

(*x*) *Robinson v. Finlay*, 9 C. D. 487 (1877), C. A.

(*y*) Last case. A custom in Manchester, by which the shipper, in the absence of agreement, was the owner of the trade-mark, was alleged but not proved. *Jones' Tm.*, 53 L. T. 1 (1885), C. A., is a similar case. See also *Rivière's Tm.*, 55 L. J. Ch. 545; 53 L. T. 237 (1884), Pearson, J., cited p. 224.

that they were successors to the old brick-making business, Wood, V.-C., granted an injunction to restrain the advertisements, and he said he would have granted it as a matter of course had the owner of the mines been plaintiff in the suit. The learned Vice-Chancellor seems, therefore, to have been of opinion that both he and the plaintiffs were interested in the old firm name (z).

A mere importer has no title to sue for infringement of the trade-marks of the consignor or producer (a).

Where the plaintiff is the sole purchaser from the proprietor.

The plaintiff does not become owner of the trade-mark, or acquire any interest in it sufficient to enable him to sue for infringement, by a contract with the proprietor for the exclusive purchase of the marked goods consigned to a particular district (b); but it is submitted that if the contract were for the exclusive purchase of all the marked goods manufactured by the proprietor, so that no goods could be rightly marked which did not pass through the plaintiff's hands (subject to any question of registration (c)), he might maintain the action against any person who used the mark, or a spurious mark infringing it, on goods which were not the goods of the manufacturer. The question whether a trader, exclusively entitled by contract with the proprietor to purchase his goods, could rightly register the proprietor's mark as his own, of course with the proprietor's assent, was discussed but left undetermined in the *Apolinaris Case* (d).

Action by one proprietor or by several.

One or more of several persons concurrently entitled

(z) *Harpers v. Pearson*, 3 L. T. N. S. 547 (1860); cf. *Motley v. Downman*, 3 My. & Cr. 1; 6 L. J. Ch. N. S. 308 (1837), Cottenham, L.C.

(a) *Hirsch v. Jonas*, 3 C. D. 584 (1876), Jessel, M.R.; see Chap. II., p. 49; and Chap. IV., p. 61; and *Goodfellow v. Prince*, 35 C. D. 9 (1887), C. A.

(b) *Richards v. Butcher*, 7 R. P. C. 288 (1890), Kay, J., leave to

add the proprietor as plaintiff granted; cf. *Woolley v. Broad*, (1892) 1 Q. B. 806, exclusive licensee of registered design; and *Heap v. Hartley*, 42 C. D. 461 (1889), exclusive local licensee of a patent cannot sue.

(c) *Goodfellow v. Prince*, 35 C. D. 9 (1887), C. A.

(d) (1891) 2 Ch. p. 231; 8 R. P. C. 137, Fry, L.J.

may bring the action (*e*), and several plaintiffs so entitled may join together to sue although their interests are distinct and separate (*f*).

It would seem that the plaintiff must be using, or intending to use, the mark, for no damage would otherwise be occasioned to him by the infringement. It has been held that a mortgagee who does not intend to use the mark cannot bring an action in respect of its infringement (*g*), and intention to use is one of the conditions precedent to proper registration (*h*).

Plaintiff must use or intend to use the mark.

Infringement of a trade-mark is an interference with a right of property injuring the personal estate of the owner, and consequently the right of action in respect of it is not determined by the death of the owner, and proceedings may be begun or continued (*i*) by his executors. Of course, if the executors have possession of the goodwill of their testator's business, and are carrying on his trade, they can themselves be registered, and can sue as owners of the trade-marks employed in the business and attached to the goodwill (*k*).

Action survives to executors, and they may sue.

3. Registration.

If the mark is capable of being registered, the plaintiff must, at the date of the hearing (*l*), be the registered proprietor, or be the successor in title of the registered proprietor, and if the mark is not capable of being registered, in the case of a mark in use before the 13th of August, 1875, the plaintiff must show that registration of it has been refused (*m*). In each case the registration and

Proof of registration of the trade-mark.

(*e*) *Hinc v. Lart*, 7 L. T. O. S. 41 (1846), Shadwell, V.-C.; *Southern v. Reynolds*, 12 L. T. N. S. 75 (1865), Wood, V.-C.

(*f*) *Dent v. Turpin*, 2 J. & H. 139; 30 L. J. Ch. 495 (1861), Wood, V.-C.; *Southern v. Reynolds*, 12 L. T., N. S. 75 (1865), Wood, V.-C.

(*g*) *Beazley v. Soares*, 22 C. D. 660 (1882), Pearson, J., a Trade-Name Case.

(*h*) *The Apollinaris Co.'s Tms.*, (1891); 2 Ch. p. 233; 8 R. P. C.

137; see Chap. VIII., p. 110.

(*i*) *Oakey v. Dalton*, 35 C. D. 700; 4 R. P. C. 313 (1887), Chitty, J.

(*k*) See Chap. XIII., p. 272; and *Massam v. J. W. Thorley's Cattle Food Co.*, 6 C. D. 574; 14 C. D. 748 (1877), Malins, V.-C., and C. A.

(*l*) *Hazzopulo v. Kaufmann*, 23 Sol. J. 819 (1879), Little, V.-C.

(*m*) Sect. 77; see Chap. XII., p. 261.

the name of the registered proprietor, or the refusal, must be shown by the certificate of the comptroller (*n*), and by sealed and certified copies of or extracts from the register (*o*).

Registration of assignment is unnecessary before action.

But the registration of the successor in title of the original proprietor—his assignee for instance—is not necessary to enable the successor to sue (*p*).

Registration is evidence of title.

The registration of a person as proprietor of a trade-mark is *prima facie* evidence of his right to the exclusive use of his trade-mark, and is (in the absence of an application to rectify the register (*q*)), after five years from the date of the application for registration (*r*), conclusive evidence of such right (*s*).

So that after five years (*t*), the question whether the mark was capable of registration, and therefore the subject of trade-mark rights under the Acts, cannot be raised against the plaintiff (*u*), unless an application to rectify the register is before the Court. Other objections may, however, be taken; it may be shown, for instance, that the plaintiff does not possess the goodwill of the business to which the mark is attached (*x*).

And, it is submitted, the question whether the registered proprietor was entitled to the mark when he caused it to be registered, cannot be raised under such circumstances. The dictum of Fry, L.J., in *The Apollinaris Case*,

(*n*) Sects. 77 and 84.

(*o*) Sects. 88 and 89.

(*p*) *Ihlee v. Henshaw*, 31 C. D. 323 (1886), North, J.

(*q*) Chap. XII., p. 258.

(*r*) Sect. 75 (Act of 1888, s. 17).

(*s*) Sect. 76; Chap. XII., p. 255.

(*t*) In *The Apollinaris Co. v. Snook*, 7 R. P. C. 474 (1890), although the mark had not been registered for five years, Kekowich, J., refused to listen to an argument that it ought not to have been registered; but, apparently, his attention was not called to the point in question. And in *Compagnie Générale v. Rehder*, 5 R. P. C. 65 (1887), Kay, J.,

took a similar course upon an application for an interim injunction. In *Stuart v. Scottish Val de Travers Co.*, 13 Ct. of Sess. Ca. 1 (1885); and *Lever v. Goodwin*, 4 R. P. C. 492 (1886), Chitty, J., objections to marks registered for less than five years were allowed at the hearing, there being no application to rectify.

(*u*) *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478 (1887), C. A.; *Edwards v. Dennis*, 30 C. D. 454 (1885), C. A.

(*x*) *Pinto v. Badman*, 8 R. P. C. 181 (1891), C. A.

that "a man who puts another's trade-mark on the register cannot be a person entitled under the Act" (*y*); was made in a case founded on an application to rectify, and was not, therefore, directed to the operation of sect. 76.

But the registration is, of course, evidence only of such title as it shows, and the plaintiff's right is, accordingly, subject to the modification imported by any note or limitation entered upon the register in connection with it. In particular, if there is a disclaimer of part of the registered mark, the registered proprietor has no title to sue in respect of an alleged infringement effected by the adoption of such part of the mark, for the disclaimer is an indication to all the world that he has no monopoly whatever in the use of that part (*z*).

Registration modified by a disclaimer or otherwise.

And the right to exclusive use, of which registration is evidence, is subject to the concurrent and independent rights, if any exist, of other persons to use the mark whether they have obtained registration or not (*a*).

By concurrent rights.

The five years' registration does not, it is submitted, prevent the defendant, although he has made no application to rectify, or although the Court has no jurisdiction to entertain any such application which he has made, from setting up as a defence that the plaintiff's right has determined by abandonment or otherwise, or has been wholly assigned to another (*b*). And it is, of course, no answer to a personal bar which disentitles the plaintiff to sue.

Plaintiff's title determined or barred.

4. What constitutes Infringement.

Infringement is the use by the defendant, for trading purposes (*c*) in connection with goods of the kind for which

(*y*) (1891) 2 Ch. 186; 8 R. P. C. 137. The importers had registered the mark of the owners of the spring.

(*z*) *Rosenthal v. Reynolds*, (1892) 2 Ch. 301; 9 R. P. C. 189, North, J.; *Pirie v. Goodall*, (1892) 1 Ch. 35;

9 R. P. C. 17, C. A.; Chap. IX., p. 173.

(*a*) See below, p. 325.

(*b*) This follows from the fact that an unregistered assignee can sue, see p. 304.

(*c*) Page 307.

the plaintiff's right to exclusive use exists (*d*), (*i. e.*, for which his mark is registered and used), not being the goods of the plaintiff (*e*), of a mark identical with (*f*) the plaintiff's mark, or either comprising some of its essential features or colourably resembling it (*g*), so as to be calculated to cause the goods to be taken by ordinary purchasers (*h*) in any market where the marks circulate (*i*) for the goods of the plaintiff.

Inferiority of the defendant's goods.

It was originally an element of the right of action for infringement at common law, that the goods sold by the defendant as and for the goods of the plaintiff were inferior in quality to the genuine goods of the latter, but it has long been settled that the question of the relative qualities of the plaintiff's and the defendant's goods is not relevant to the title to maintain either action for infringement or "passing off" (*k*), and it has, accordingly, no place in the above definition. It may, however, affect the amount of the damages to be recovered by the plaintiff if he succeeds, for damages are sometimes claimed and allowed in respect of injury occasioned to the trade reputation of the plaintiff by the defendant's infringement or fraud; but if the defendant's goods are as excellent as his own, the reputation of the plaintiff cannot have been injured.

Single act of infringement.

The Court has refused to regard an isolated act, done at the request of the plaintiff's agent, who was laying a trap for the defendant, as an infringement (*l*). This must be

(*d*) Page 308.

(*e*) Page 309.

(*f*) It is usually so expressed. What is meant is, of course, "similar to"; but "similar to" and "resembling" are constantly used to convey the proper meaning of the latter word; see *Welch v. Knott*, 4 K. & J. 747 (1857), Wood, V.-C.

(*g*) Page 314.

(*h*) Page 318.

(*i*) Page 307.

(*k*) *Blofield v. Payne*, 4 B. & Ad. 410; 2 L. J. K. B. N. S. 68 (1833); *Edelsten v. Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, L.C.; and see *per* Lord Blackburn, in *Singer Manufacturing Co. v. Loog*, 4 App. Cas. p. 29.

(*l*) *Hennessey v. Kennett*, Seb. Dig. p. 331 (1877), Malins, V.-C.; cf. *Leahy, Kelly & Leahy v. Glover*, 10 R. P. C. 141 (1893), where a single instance of the sale of goods

taken as a special case, however, for, in general, proof of a single act of infringement by the defendant is sufficient to justify the plaintiff in bringing his action, and the evidence relied on is frequently the sale by the defendant of the spurious goods to the plaintiff or his agent, who has bought them merely for the purpose of procuring evidence.

The defendant must be shown to have used or intended to use the goods marked with the spurious mark for trading purposes, whether for sale or as samples to enable him to sell similar goods,—and whether these are or are not themselves so marked,—for the essence of the wrong is that purchasers of the spuriously marked goods are defrauded, and the plaintiff incidentally suffers by the loss of their custom which would or might, but for the fraud, come to him (*m*). But the Court will not readily believe that the defendant does not intend to use vendible goods marked with the spurious mark for trading purposes if they are found in his possession, and either he is a trader in goods of the kind, or the quantity of the goods is considerable (*n*). So, where the defendant, a china manufacturer, had imported 5,000 spuriously marked cigars, he was held liable, although he did not know that the mark was spurious, and said that he intended the cigars “for family use.”

Defendant must use or intend to use the marked goods for trading purposes.

And the infringement must occur in a market where the plaintiff's mark circulates. But this condition is fulfilled if the areas of the trades of the plaintiff and defendant, although substantially local and distinct, are beginning to overlap (*o*), or if the spuriously marked goods are brought

Infringement must be in the plaintiff's market.

by the defendant's shopwoman, not shown to have been with his authority, was considered insufficient to support a case of passing off. In *Tonge v. Ward*, 21 L. T. N. S. 480 (1869), Romilly, M.R.; and *Twentsche v. Ellinger*, 20 W. R. 70 (1877), Malins, V.-O., the defendants were held liable for infringements by their agents without their

knowledge.

(*m*) *Levy v. Walker*, 10 C. D. 436 (1879), C. A.; *Richards v. Butcher*, 7 R. P. C. 288 (1890), Kay, J.

(*n*) *Upmann v. Forester*, 24 C. D. 231 (1883), Chitty, J.

(*o*) *Paine & Co. v. Daniells & Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 71, 217, (*John Bull Beer*). Chap. X., p. 184.

into this country for export to a country where the plaintiff's trade and marks are known (*p*).

Defendant must use the mark upon the goods for which the plaintiff's right exists,

The use must be in connection with the goods for which the plaintiff's right exists. "There can be no right to the exclusive ownership of any symbols or marks universally in the abstract. Thus, an iron-founder who has a particular mark for his manufactures in iron could not restrain the use of the same mark when impressed on cotton or woollen goods; for a trade-mark consists in the exclusive right to the use of some name or symbol as applied to a particular manufacture or vendible commodity" (*q*). And the third essential ingredient for constituting an infringement, enumerated by the judge just quoted in *McAndrew v. Bassett* (*r*), is "that the defendants have imitated the mark for the purpose (*s*) of passing in the market other articles of a similar description."

The limits of the class of goods over which the right in respect of a registered mark extends have been discussed already (*t*), and the class has been shown to be not necessarily co-extensive with any register class (*u*), and it has also been shown that the registered proprietor's right ought to be limited, and the registration to be restricted to the kinds of goods upon which he actually uses or intends to use the mark, and in which he possesses the goodwill of the business to which the trade-mark is attached (*x*).

and is registered,

The plaintiff cannot sue for infringement in respect of

(*p*) *Joseph Rodgers & Sons v. Rottgen*, 5 *Times L. R.* 678 (1889), *Kay, J.*; *Tm. of the Société, &c. des Verreries de l'Etoile*, (1894) 1 *Ch.* 61; (1894) *W. N.* 42; 10 *R. P. C.* 436; 11 *R. P. C.* 142, *Stirling, J.*, and *C. A.*, (*Red Star Glass*).

(*q*) *Per Lord Westbury*, in *Hall v. Barrows*, 4 *De G. J. & S.* 150 (1863).

(*r*) 4 *De G. J. & S.* 380 (1863).

(*s*) Fraudulent intent is not now essential, *post*, p. 316.

(*t*) *Chap. V.*, p. 87, and *Chap.*

XII., p. 256.

(*u*) Marks may be calculated to deceive, though in different register classes, p. 180; *Australian Wine Importers' Tm.*, 41 *C. D.* 278; 6 *R. P. C.* 311 (1889), *Kay, J.*, and *C. A.*, (wines and spirits); *Eno v. Dunn*, 10 *R. P. C.* 261 (1893), *Kekewich, J.*, (an aperient drink and baking powder); *Turney & Sons' Tm.*, 11 *R. P. C.* 37 (1893), *North, J.*, (beer and rum).

(*x*) *Edwards v. Dennis*, 30 *C. D.* 454 (1885), *C. A.*, cited p. 88.

goods for which his mark is not registered (*y*), although, if he can make a case, he may sue to restrain passing off. And if his mark is registered generally for a register class and used. which includes a kind of goods for which he does not use it, or for which it is unsuitable, it is not to be considered as registered for such goods. Thus, the proprietor of a mark registered for class 45, "tobacco whether manufactured or unmanufactured," used it only for cut tobacco, and the mark contained the words *Three Crowns Mixtu*. It was held that he could not sue to restrain an infringement in respect of cigars (*z*).

Further, the use of the defendant's mark, which is relied on as an infringement, must be a use upon goods which are not those for which the plaintiff's mark is properly used, for anyone may use the plaintiff's mark on the plaintiff's goods, since that cannot cause the deception which is the test of infringement (*a*). So the retailer of goods obtained from the plaintiff may lawfully place or renew (*b*) the labels upon them, and have sufficient labels printed for the purpose (*c*). In the case last cited, the defendant failed to satisfy the jury, in an action at common law, that he had in fact printed the labels only for use on the genuine goods of the plaintiff; and the injunction, which had been granted in a suit in Chancery by Wood, V.-C., and dissolved on appeal by Cranworth, L.C., was accordingly restored (*d*). The rule just stated is well illustrated by *The Angostura Bitters Case*, where the injunction granted was so expressed as not to prevent the name being applied to an article identical with the plaintiff's,

The infringement must be in respect of spurious goods.

(*y*) *Jay v. Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.;

Hart v. Colley, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J.

(*z*) *Hargreaves v. Freeman*, (1891) 3 Ch. 39; 8 R. P. C. 237, Chitty, J.; and see *Beazley v. Soares*, 22 C. D. 660 (1882), Pearson, J. A person who does not use the mark at all cannot sue; last case, and *Delondre*

v. Shaw, 2 Sim. 237 (1828), Shadwell, V.-C.

(*a*) Chap. II., p. 32.

(*b*) *Condy v. Taylor*, 56 L. T. 891 (1887), Kekewich, J.

(*c*) *Farina v. Silverlock*, 1 K. & J. 509; 24 L. J. Ch. 632; 6 De G. M. & G. 214; 26 L. J. Ch. 11 (1855).

(*d*) 4 K. & J. 650 (1850).

should any other person discover the secret of manufacture and make the goods (*e*).

Adulterations,
and goods
comprising
authentic
parts.

But goods of the plaintiff, adulterated by some other person (*f*), are not goods on which the mark may lawfully be placed; nor is the manufacture by the defendant of an article made up of several parts the less an infringement because one genuine part of the plaintiff's manufacture, and bearing his mark, is included in it (*g*).

What connec-
tion with the
spurious
goods is
sufficient.

It is not necessary that the spurious mark should be actually affixed to the goods, provided it is so used in connection with them as to be calculated to cause them to be taken for the plaintiff's goods (*h*). Use on the wrapper in which they are sold, or upon a slip placed in the package with them, or in circulars or advertisements offering them for sale is sufficient (*h*). So printing the plaintiff's trade-mark labels, without showing that they were for use on genuine goods only (*i*), or using the plaintiff's marked or stamped bottles (*k*), casks (*l*), or boxes (*m*) for goods other than his genuine goods, is an infringement, unless the Court is satisfied that the use under the circumstances is not calculated to deceive (*n*).

But the use of a descriptive word registered as an old trade-mark, not in connection with the goods, but in price lists referring to them only, has been held to be no infringement (*o*).

In a recent case Vaughan Williams, J., said: "I am,

(*e*) *Siebert v. Findlater*, 7 C. D. 801 (1878), Fry, J.

(*f*) *Condy v. Taylor*, 56 L. T. 891 (1887), Kekewich, J.

(*g*) *Richards v. Williamson*, 30 L. T. N. S. 746 (1874), Bacon, V.-C., a gun with stamped lock.

(*h*) *Jay v. Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

(*i*) *Farina v. Silverlock*, note (*c*); *Guinness v. Ullmer*, 10 L. T. O. S. 127 (1847), Shadwell, V.-C.

(*k*) *Rose v. Henley*, 47 L. J. Ch.

577 (1877), Malins, V.-C.; *Rose v. Loftus*, *ibid*.

(*l*) *Hennessy v. Cooper*, Seb. Dig. p. 327 (1877), Malins, V.-C.

(*m*) *Barnett v. Leuchars*, 13 L. T. N. S. 405 (1865), Stuart, V.-C.

(*n*) As in *Welch v. Knott*, 4 K. & J. 747 (1857), Wood, V.-C.

(*o*) *Talbot v. Webley*, 3 R. P. C. 276 (1886), Bacon, V.-C., (*Baffle*, for safes); cf. "Singer system," in *Singer v. Loog*, 8 A. C. 15 (1882), H. L.; and above, p. 38.

“for my own part, not at all sure that you can prove an infringement of a trade-mark without proving that the defendants have imitated the plaintiffs’ trade-mark upon something capable of receiving the impression of the mark. Either the material itself, or the paper which is used, or the sacks, or bags, or boxes, or whatever it is that the material is put into, I should have thought must have been imitated to constitute an infringement of a trade-mark” (*p*). The question actually decided in the case was that the sale of goods by the descriptive name *Rugby Cement* was not an infringement of a trade-mark comprising those words; and the decision was undoubtedly correct; but it is submitted, with great deference, that, had the words been distinctive and an essential feature of the mark, it would have been an infringement to use them to effect the sale of goods other than those of the plaintiffs. The distinction between cases where a name or device taken from a trade-mark is affixed to the goods, and cases where a name so taken is used in respect to them,—for instance, in advertisements to push their sale,—and the rule that fraud must be proved in cases of the second class, which were laid down by Jessel, M.R., and adopted by the Court of Appeal (*q*) in *The Singer Manufacturing Co. v. Wilson*, were not approved by the House of Lords (*r*). The abstract question is, however, of little or no importance, since, in the case put, the words would almost necessarily come by the legitimate user of the mark to denote the plaintiff’s goods, and the use of them by the defendant, in any manner calculated to deceive, could be restrained in a “passing off” action. “It will be observed,” Fry, J., said, in *The Linoleum Case* (*s*), “that the inquiry with regard to the use of the word *Linoleum* as a constituent element in the trade-mark,

(*p*) *Rugby Portland Cement Co. Ltd. v. Rugby and Newbold Portland Cement Co., Ltd.*, 8 R. P. C. 241; affirmed on appeal, 9 R. P. C. 46 (1891).

(*q*) 2 C. D. 434 (1874).

(*r*) 3 App. Cas. 376; see Lord Cairns’ judgment, cited Chap. II., p. 14.

(*s*) *Linoleum Manufacturing Co. v. Nairn*, 7 C. D. p. 836 (1878).

“and the inquiry as to the use of the word *Linoleum* as a misrepresentation, are one and the same inquiry, and I must consider what the word *Linoleum* meant as used at the time when the defendants intended to attribute it to their manufacture.”

The infringing mark may either (a) be an actual or substantial copy of the plaintiff's mark; (b) consist of or comprise its essential features; or (c) be a colourable imitation of it.

Where the plaintiff's mark has been copied.

(a) The first case presents no difficulties. By sect. 76, the registration of the plaintiff as proprietor of the trade-mark is *prima facie* evidence, and, after five years (in the absence of an application to rectify), is conclusive evidence of his right to the exclusive use of the trade-mark (*t*). The registered proprietor can therefore make a case in an action for the mere using of his mark in connection with goods of the class over which his right extends, without showing that the use is calculated to deceive (*u*). And this is not, substantially, an alteration of the law as it stood before the Acts (*x*), if registration be taken as equivalent to public user, although proof of the probability of deception was usually, but not invariably (*y*), mentioned as an element of right of action; for if the defendant had taken a “material and substantial” portion of the plaintiff's mark, and, *a fortiori*, if he had taken the whole, the onus of showing that his conduct was not calculated to deceive was cast upon him (*z*), and it was,

(*t*) Above, p. 304.

(*u*) See the judgment of Cotton, L.J., in *Edwards v. Dennis*, 30 C. D. 454 (1885).

(*x*) Cf., with the judgment last referred to, that of Hall, V.-C., in *Cope v. Evans*, 18 L. R. Eq. 138 (1874).

(*y*) For instance, see the judgment of Jessel, M.R., in *The Singer Manufacturing Co. v. Wilson*, 2 C. D. p. 422 (1875). “The right which a manufacturer has in his trade-

mark is the exclusive right to use it for the purpose of indicating where, by whom, or at what manufactory, the article to which it is affixed was manufactured,” *per* Lord Cranworth, in *The Leather Cloth Case*, 11 H. L. C. p. 533; 35 L. J. Ch. 53 (1865).

(*z*) *Ford v. Foster*, 7 Ch. 611 (1872), James, L.J.; *Orr-Ewing v. Johnston*, 13 C. D. 434 (1879), Fry, J., and C. A.

practically, at any rate, impossible for him to support it. Moreover, unless he could give a reasonable explanation to show how he came to adopt a mark identical with that of the plaintiff, the Court would infer that he intended to deceive (*a*), and would not consider whether or not his attempt was likely to be successful (*b*).

The infringement proved in *Paine & Co. v. Daniells & Sons' Breweries* (*c*) was effected in a very unusual way. The plaintiffs' marks consisted of labels bearing a figure of John Bull, and the words *John Bull* and *John Bull Brand*. The defendants used a label bearing a different figure of John Bull, with the words *John Bull, Registered*. Their label, though entered as their copyright at Stationers' Hall, had been, in 1835, refused registration as a trademark, on the ground of the plaintiffs' opposition, but they had, notwithstanding the refusal, continued to use it in their business. Although the labels had been in use so long, no evidence of actual deception was tendered, for the trades of the plaintiffs and defendants had been carried on in different districts, and were only beginning to overlap at one point at the date of the trial. There was no other evidence than that furnished by the labels themselves, that the defendants' label was calculated to deceive; but the Court of Appeal regarded the false claim of registration in their label as amounting in effect to a representation that the plaintiffs' marks—the only John Bull marks which really were registered—were their own, and this was held to be an undoubted infringement (*d*).

False claim to the plaintiff's registered marks.

(*b*) The right of the registered proprietor exists in regard to the whole mark, not in regard to any particular part of it (*e*), and an infringement must be an infringe-

Where an essential feature has been copied.

(*a*) See the last case, in the H. L., 7 App. Cas. 219; *Taylor v. Taylor*, 23 L. J. Ch. 255 (1854), Wood, V.-C.

(*b*) See *per* Lindley, L.J., in *Slazenger v. Feltham*, 6 R. P. C. p. 538 (1889).

(*c*) (1892) 2 Ch. 567; 10 R. P. C.

71, 217, C. A.

(*d*) *Lawrie v. Baker*, 2 R. P. C. 213 (1885), Day, J., is a similar case. There the defendant described his goods as *patent cups*, the plaintiff having the only patent.

(*e*) *Hudson's Tm.*, 32 C. D. 311;

ment of the whole mark (*f*). But the adoption of a single characteristic distinctive particular from the plaintiffs' mark, and its use alone, or with other matter, may well be an infringement of the entire mark. At any rate, it throws upon the defendant the onus of proving the contrary (*g*). But it is not an infringement to take non-essential particulars from a mark: for instance, to take merely descriptive or other common words (*h*).

Colourable Imitation.

Where there is a colourable imitation.

(c) A colourable imitation is the most common case, for, if the resemblance is intended, the defendant will have tried to introduce apparent differences sufficient to prevent the Court from interfering, while preserving a likeness which is near enough to enable him to profit by the reputation of the plaintiff's mark. So far as the Court succeeds in carrying into effect the principles which govern its interference, the two ends are inconsistent with each other.

The test of infringement.

In both the second and third cases the test of infringement is the question whether or not the defendant's mark is calculated to cause his goods to be taken by ordinary purchasers for the goods of the plaintiff (*i*), and the Regis-

3 R. P. C. 155 (1886), Cotton, L.J.; *Christiansen's Tm.*, 3 R. P. C. 54 (1886), C. A.

(*f*) *The Rugby Portland Cement Co., Ltd. v. The Rugby and Newbold Portland Cement Co., Ltd.*, 8 R. P. C. 241 (1891), V. Williams, J.

(*g*) *Ford v. Foster*, 7 Ch. 611 (1872), James, L.J.; *Johnston v. Orr-Ewing*, 13 C. D. 434 (1879), Fry, J., and C. A.

(*h*) *Linoleum Manufacturing Co. v. Nairn*, 7 C. D. 834 (1878), Fry, J., (*Linoleum*); *Watt v. O'Hanton*, 4 R. P. C. 1 (1886), Porter, M.R., (*Old Innishoven*); *Humphries v. Taylor's Drug Co.*, 59 L. T. 820 (1888), Kekewich, J., (*Herbalin*);

Native Guano Co. v. Sewage Manure Co., 8 R. P. C. 125 (1888), C. A. and H. L., (*Native Guano*); *Rugby Portland Cement Co., Ltd. v. Rugby and Newbold Portland Cement Co., Ltd.*, 8 R. P. C. 241; 9 R. P. C. 46 (1891), V. Williams, J., and C. A.; cf. Chap. X., p. 201; and *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, J.

(*i*) *Hall v. Barrows*, 4 De G. J. & S. 150; 33 L. J. Ch. 204 (1863), Westbury, L.C.; *Leather Cloth Co., Ltd. v. The American Leather Cloth Co., Ltd.*, 4 De G. J. & S. 137; 33 L. J. Ch. 199 (1863), Westbury, L.C.; and 11 H. L. C. 523; 35 L. J. Ch. 53.

tration Acts have made no alteration of the law in this respect (*k*).

“It is not a question whether this (the use of the defendant’s mark) necessarily is deceptive, but whether there is not a strong probability of its causing deception” (*l*). So that the imitation of the plaintiff’s mark cannot be justified by showing either that the device or inscription on the imitated mark is ambiguous, and capable of being understood by different persons in different ways, or that a person who carefully and intelligently examined and studied it might not be misled (*m*).

There can be no infringement, therefore, in cases where the plaintiff’s mark is not actually copied if there is no reasonable probability of deception (*n*). It was held by the Court of Common Pleas, as early as 1847, that the following questions were properly left to the jury by Williams, J., in *Rodgers v. Nowell* (*o*):—(1) Whether there was such a resemblance to the plaintiffs’ marks, in the marks put on the knives made by the defendants, as was calculated to make an ordinary person believe that the marks were the marks of the plaintiffs, denoting that the knives were the knives of the plaintiffs? and (2) Did the defendants, with an intention to deceive, sell these knives representing them to be the manufacture of the plaintiffs? It will be shown immediately that if the plaintiffs’ mark was their trademark, the second question has long been held to be imma-

Questions
for the jury.

(*k*) *Mitchell v. Henry*, 15 C. D. 181 (1880), C. A.; *Singer Manufacturing Co. v. Loog*, 18 C. D. 395, C. A.; and 8 App. Cas. 15 (1870); *Edwards v. Dennis*, 30 C. D. 454 (1885), Cotton, L.J.

(*l*) Per Cotton, L.J., in *The Upper Assam Tea Co. v. Herbert & Co.*, 7 R. P. C. p. 186 (1889).

(*m*) Per Lord Selborne, in *The Singer Manufacturing Co. v. Loog*, 8 App. Cas. p. 18 (1882).

(*n*) *Cope v. Evans*, 18 L. R. Eq. 138 (1874), Hall, V.-C.; *Beddow &*

Sons v. Boyd, 4 R. P. C. 317 (1887), Chatterton, V.-C.; see also *Woolam v. Radcliffe*, 1 H. & M. 259 (1863), Wood, V.-C.; *Bradbury v. Becton*, 39 L. J. Ch. 57 (1869), Malins, V.-C.; *Civil Service Supply Association v. Dean*, 13 C. D. 512 (1879), Malins, V.-C.; and *Borthwick v. The Evening Post*, 37 C. D. 449 (1888), Kay, J., and C. A., in all of which an injunction was refused.

(*o*) 5 C. B. 109; 17 L. J. C. P. 52.

terial, except so far as it dealt with the mere fact of the sale of the knives.

Actual deception need not be proved;

Proof of actual deception, if the mark is, in the opinion of the Court, calculated to deceive, or if the plaintiff's registered mark has been substantially copied (*p*), is unnecessary, although the absence of it, where the plaintiff's and defendant's marks have circulated side by side for a considerable time, may go far to negative the probability of deception, unless it is explained, for instance, by the practical impossibility of calling evidence from a distant country to show that purchasers there have been deceived (*q*). The plaintiff is not bound to wait to see whether his customers will, in fact, be deceived, for "the very life of a trade-mark depends upon the promptitude with which it is vindicated" (*r*).

nor yet an intention to deceive.

Nor, where the defendant's mark has in fact deceived, or is, in the opinion of the Court, calculated to do so, is it necessary to show that the defendant intended to deceive. This was first decided by Lord Cottenham, in *Millington v. Fox* (*s*) as regards the relief by an injunction, and by Lord Westbury, in *Edelsten v. Edelsten* (*t*), as regards both injunction and account. It is now well-settled law (*u*). The dicta of Lord Chelmsford, in *The Glenfield Starch Case*, that where the trade-mark is not actually copied, fraud is a necessary element in the plaintiff's case—"that is, the party accused of piracy must be proved to have done the act complained of with the fraudulent design of passing off his own goods as those of the party exclusively entitled to the trade-mark" (*v*), and of Jessel, M.R., and the Court of Appeal, in *The Singer Manufacturing Co. v.*

(*p*) Above, p. 312; and see *Paine & Co. v. Daniells & Sons' Breweries*, cited *ante*, p. 313.

(*q*) Page 206.

(*r*) *Johnston v. Orr-Ewing*, per James, L.J., 13 C. D. p. 464; and Lord Blackburn, 7 App. Cas. p. 230 (1880).

(*s*) 3 My. & Cr. 338 (1338).

(*t*) 1 Do G. J. & S. 185 (1863).

(*u*) *Reddaway v. Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9 R. P. C. 503, C. A.; *Johnston v. Orr-Ewing*, 7 App. Cas. 219 (1882).

(*v*) *Wotherspoon v. Currie*, L. R. 5 H. L. p. 519 (1872).

Wilson (*x*), that, where the defendant has not actually put the plaintiff's trade-mark, or a colourable imitation of it, on his goods, or on the bottles or boxes containing them, but has otherwise acted so as to represent his goods as those of the plaintiff (*y*), a fraudulent intent must be proved, cannot now be taken to be law. In the former case, Lord Hatherley said it had been pointed out that a *mala fides* towards the first purchaser was not the ground of the Court's interference; for it is sufficient if such purchaser is furnished by the defendant with goods bearing a label, of which the necessary consequence is that he is enabled to deceive others by means of them (*z*). And in *The Singer Case*, Lord Cairns said: "I wish to state in the most distinct manner that, in my opinion, fraud is not necessary to be averred or proved in order to obtain protection for a trade-mark" (*a*); and in this Lord O'Hagan concurred (*b*). Lord Blackburn said: "I am not as yet prepared to assent either to the position that there is a right of property in a name, or, what seems to me nearly the same thing, to assent to its full extent to the proposition that it is not necessary" (in trade-name cases) "to prove fraud" (*c*). But the last-mentioned judge, in a subsequent case, stated that he thought it clear, at any rate, that if the defendant persevered in using a trade-mark calculated to deceive after notice of the facts, that would be evidence to support a claim for damages for knowingly selling his goods as and for those of the plaintiff (*d*). "However honest or inadvertent the original

(*x*) 2 C. D. 432 (1875).

(*y*) As already shown, these may be cases of infringement if the representation is effected by using a mark in connection with the defendant's goods (though not on them) which resembles the plaintiff's mark, or by using a distinctive name taken from the plaintiff's mark; above, p. 310.

(*z*) L. R. 5 H. L. p. 517.

(*a*) 3 App. Cas. p. 391, quoted and adopted in *The Bodega Co., Ltd. v. Owens*, 7 K. P. C. 31 (1889), Chatterton, V.-C.

(*b*) 3 App. Cas. 396.

(*c*) Page 463.

(*d*) *Singer Manufacturing Co. v. Loog*, 8 App. Cas. 31 (1882).

“mistake may have been, the continuation of the use of it after that was pointed out is of itself evidence of a fraudulent intention” (*e*).

And it has already been shown that the proprietor of a trade-mark may obtain an injunction against an innocent consignee of spuriously marked goods, and an order for the spurious marks to be expunged from the goods, without having given the defendant any notice before the commencement of the action (*f*).

What resemblance is calculated to deceive.

It follows that the question to be answered when an infringement without taking the actual mark is alleged, is the same question as arises when a mark tendered for registration is objected to, or, having been registered, is sought to be removed from the register, on the ground that it has such resemblance to a trade-mark already on the register as to be calculated to deceive, within the restriction of sect. 72 (2); and the principles governing the comparison of the marks, and determining what amount of resemblance is calculated to deceive, are the same in both cases, although a higher standard of resemblance must be conformed to in an action for infringement than that set up in cases of the other class. These principles have been already discussed at length (*g*), and it will, therefore, be sufficient in this place to shortly summarise the conclusions to be deduced from an examination of the authorities.

The probable purchasers are to be considered.

(1) The persons to whom the test question—Is the spurious mark calculated to deceive them?—is to be referred, are the persons who are probable purchasers, whether they buy, or are likely to buy, directly from the plaintiff or defendant, or from, or through, intermediate purchasers from either of them, whether they are English or foreign,

(*e*) *Per* James, L.J., in *Orr-Ewing v. Johnston*, 13 C. D. p. 454 (1880); see also *Paine & Co. v. Daniells & Sons' Breweries*, (1892) 2 Ch. 567; 10 R. P. C. 217, C. A.

(*f*) *Ante*, p. 300; *Upmann v. Forester*, 24 C. D. 231 (1883), *Chitty, J.*; *American Tobacco Co. v. Guest*, (1892) 1 Ch. 630; 9 R. P. C. 218, *Stirling, J.*

(*g*) Chap. X., pp. 186 *et seq.*

and not merely very careful or intelligent persons, but ordinary unwary purchasers (*h*).

(2) No definite rule as to the amount of resemblance required can be formulated *à priori*, but the net impression produced, and “the main idea left on the mind” by each mark must be compared, for marks may well be confused by purchasers, who see the defendant’s mark when they have present in their memories only an indefinite recollection of the plaintiff’s, in cases where the marks could not be mistaken for each other if they were seen side by side (*i*). So that the whole mark of the defendant may too nearly resemble that of the plaintiff, although all the essential particulars of the two are distinguishable (*k*); but special regard must, nevertheless, be paid to the essential features of the plaintiff’s mark in considering whether the defendant has infringed it (*l*).

The net impressions left by the marks are to be contrasted.

(3) Further, the marks must be compared as they are seen in actual ordinary use (*m*) on the goods they are used for; remembering, however, that so far as the plaintiff’s mark substantially differs from the mark on the register, it is an unregistered mark (*n*).

The marks are to be considered as seen in ordinary use.

(4) The circumstances of the trade and market in which the marks are used must be considered also,—the language of the purchasers, for instance, and the number of analogous marks in use in connection with the same goods (*o*).

Regard is to be paid to all the circumstances surrounding the marks in use.

But, since colour is not admitted to consideration in estimating the distinctiveness of a mark tendered for registration (*p*), and cannot, on account of the practical difficulties, be registered as an essential element of a trade-mark, similarity of colour is not to be greatly relied upon in deciding a question of infringement (*q*), although it is an element to be considered.

Colour.

(*h*) Page 186; and *Shrimpton v. Laight*, 18 Beav. 164 (1854), Romilly, M.R.

(*i*) Page 188.

(*k*) Page 192.

(*l*) Page 196.

(*m*) Page 193.

(*n*) Page 196.

(*o*) Page 198.

(*p*) *Hanson’s Tm.*, 37 C. D. 112; 5 R. P. C. 130 (1887), Kay, J., above, p. 162.

(*q*) *Nuthall v. Vining*, 28 W. R. 330 (1880), C. A.

And, in particular, to the adoption of a special name for goods bearing the plaintiff's mark.

If the plaintiff's mark, or some feature of it, has led to the application of a particular name to his goods, it is an infringement for the defendant to use a mark which is calculated to cause the same name to be applied to his (*r*), unless the name is applied, not merely to the plaintiff's goods, but to all goods of the kind (*s*), for instance, because it is suggested by matter in the mark which is common to the trade (*t*); and the defendant's use of his mark is none the less an infringement of the plaintiff's rights, because the exclusive use of the name may give the plaintiff a practical monopoly in certain goods in a particular market (*u*).

What importance is to be attached to differences between the marks.

Attention must be paid, of course, not only to the points of resemblance between the marks, but also to the points of difference. But it will not be sufficient for the defendant to show that the differences might prevent purchasers being deceived, the Court must hold that they are "such as to prevent its being likely that they would be deceived" (*x*).

Instances of infringements by marks which prominently displayed the defendant's name.

In the following cases it was held that the use of words taken from the plaintiff's mark by the defendant was an infringement, notwithstanding that he always added his own name:—*Perry v. Truefitt*, 6 Beav. 66, PERRY'S MEDICATED MEXICAN BALM, TRUEFIT'S MEDICATED MEXICAN BALM; *Braham v. Bustard*, 1 H. & M. 447, BUSTARD & Co.'s EXCELSIOR WHITE SOFT SOAP; *Kinahan v. Bolton*, 15 Ir. Ch. 75, KINAHAN'S LL WHISKY, BOLTON'S LL WHISKY; *Ford v. Foster* (*y*), L. R. 7 Ch. 611, FORD'S EUREKA SHIRTS, FOSTER, PORTER & Co.'s IMPROVED EUREKA SHIRTS; *Eno v. Stephens*, Seb. Dig. p. 372; *Eno v. Dunn*, 10 R. P. C. 261, ENO'S FRUIT SALT, STEPHENS & Co.'s EFFERVESCING VINOUS FRUIT SALTS; DUNN'S FRUIT SALT AND CHLORATE OF POTASH LOZENGES. In *The Glenfield*

(*r*) Pages 199 *et seq.*

(*s*) Page 201.

(*t*) Page 202.

(*u*) Page 204.

(*x*) *Per Lord Blackburn*, in *Johnston v. Orr-Ewing*, 7 App. Cas. p.

230 (1882), quoted and followed by the Privy Council in *Somerville v. Schembri*, 12 App. Cas. p. 458; 4 R. P. C. 179 (1887)

(*y*) Cited, p. 37.

Starch Case (z), *Wotherspoon v. Currie*, 5 L. R. H. L. 508, the defendant's own name appeared in bold letters upon the infringing labels, and this was also the case in *Johnston v. Orr-Ewing*, 13 C. D. 434, and 7 App. Cas. 219, but there the Indian customers of the plaintiff could not, it was assumed, read English (a). So, in *Rose v. Lefstus*, 47 L. J. Ch. 576, the defendant washed the plaintiff's labels off the bottles, leaving only the moulded marks, and pasted his own labels upon the bottles in their place, but was, nevertheless, held to have committed an infringement. And in *Curtis and Harvey v. Pape*, 5 R. P. C. 146, an imitation of a diamond mark was held to be an infringement, although the defendant put a K in the middle of his diamond which did not appear in that of the plaintiffs.

On similar grounds it is held to be no excuse for a clear infringement of a trade-mark that the infringing mark is used upon goods of which the get-up differs *in toto* from that of the plaintiff's goods (b). Different
get-up.

But the use of the defendant's name as part of the mark complained of is an element to be considered, and in some cases it has turned the scale in his favour. Thus, in *Beard v. Turner*, 13 L. T. N. S. 746, KIRBY'S NE PLUS ULTRA NEEDLES, on a label, was held not to be infringed by TURNER'S NE PLUS ULTRA NEEDLES on a label generally resembling the plaintiff's, the words NE PLUS ULTRA being common to the trade; and in *Blackwell v. Crabb*, 36 L. J. Ch. 504, BLACKWELL'S PICKLES on a label, not to be infringed by CRABB'S PICKLES on a label resembling the plaintiffs', the name of the manufacturer, under the circumstances of the case, being the thing which a customer would rely on most to establish the identity of the goods he wanted. In each of these cases the elements of all the labels were for the most part common to the trade.

(z) Cited, p. 46.

(a) *Henderson v. Jorss*, Seb. Dig. p. 110 (1861), Wood, V.-C., is a similar case.

(b) *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478 (1887), Chitty, J., and C. A., (*Apollinis*).

Differences which may be removed by retailers are disregarded.

Where any such additions or precautions are relied on by the defendant to rebut an alleged infringement, it is necessary to inquire whether they may not be removed or obliterated by fraudulent retail dealers leaving the imitated marks to effect deception without any check. On this ground, in *Barlow v. Johnson* (c), the Court paid no regard to the tickets and labels attached by the defendant to the towels sold by him under the name, *Osman*, which he had taken from the plaintiff's trade-mark.

Decided cases do not assist in determining the question of fact.

Probability of deception is, of course, a question of fact, and, except so far as they lay down any general principle of comparison, the decided cases are of no assistance in the determination of new questions of fact raised upon other materials. "How can observations of judges upon other and quite different facts bear upon the present case, in which the only question is what is the result of the evidence?" Lord Watson asked, in *Johnston v. Orr-Ewing* (d), but the habit of referring to reported cases at the trial of such questions is inveterate, and it has been thought useful, therefore, to collect the cases just cited, and those cited at pp. 207 and 208, above.

Inconspicuous additions a badge of fraud.

The reported cases show that attempts are frequently made to prevent the interference of the Court by using along with the spurious or deceptive marks, words, descriptions, or other additions which, if carefully examined, would prevent the deception, and at the same time, by writing the additions in small letters, or otherwise causing them to be comparatively inconspicuous, to make the probability of careful examination as small as the infringer thinks he safely can. It is obvious that, so far from affording an answer to a charge of infringement, such colourable precautions are themselves a badge of fraud. The defendant is met at once with the questions, if the additions are necessary, why are they not made conspicuous? and, if they are superfluous, why are they used

(c) 7 R. P. C. 395 (1890), North, J., and C. A. (d) 7 App. Cas. 219 (1882).

at all? In the following cases the several additions noted in small capitals were added in small letters to the plaintiff's name or trade-mark, or to an imitation of it: EQUAL to Day & Martin's, injunction granted, *Day v. Binning*, C.P. Cooper, 489; LATE OF Lundy, Foot & Co., dismissed pending verdict at law, *Foot v. Lea*, 13 Ir. Eq. 484; FROM Thresher & Glenny, injunction granted, *Glenny v. Smith*, 2 Dr. & Sm. 476; FROM Hookham & Pottage, injunction granted, *Hookham v. Pottage*, L. R. 8 Ch. 91; AGENT FOR Mason & Brand's Essence of Beef, injunction granted, *Dence v. Mason*, W. N. (1877) 23; W. N. (1878) 42.

5. Defences.

The defences commonly set up may be tabulated as follows, that:— The ordinary defences.

- (1.) The plaintiff has no title to the trade-mark in question (*e*);
- (2.) The defendant has an independent or a concurrent right to use the mark complained of;
- (3.) The plaintiff has not complied with the provision of sect. 77 by obtaining the registration or refusal of the mark (*f*);
- (4.) There is no infringement (*g*);
- (5.) The plaintiff is barred from suing the defendant for all or part of the relief he seeks by (a) an agreement or some personal estoppel (other than those next alluded to); (b) acquiescence or licence; (c) delay; or (d) because the trade-mark is deceptive, or his trade is fraudulent (*gg*).

(1), (3), and (4) are traverses of parts of the plaintiff's case, but (1) may be something more.

(*e*) Pages 301, *et seq.* 324. The question whether the mark concerned is a trade-mark at all, as to which see Chap. II., p. 24, seldom arises in practice, except on an ap-

plication to annul an entry on the register.

(*f*) Chap. XII., p. 260.

(*g*) Page 305.

(*gg*) Page 330.

Application to vary.

Attack on
the plaintiff's
title.

(1) If the plaintiff's mark has been registered for five years (*h*), whether in his name or in that of his predecessor in title (*i*), the registration is conclusive evidence of his right to the exclusive use of the mark, subject to the provisions of the Act—that is, subject to his possessing the goodwill in the business in the goods to which the trade-mark is attached (*k*); and the defendant can adduce evidence to show (*l*), or he may show from the plaintiff's own evidence (*m*), that this condition is not complied with; but he cannot attack the plaintiff's title generally, for instance, by showing that the mark is not a trade-mark (*n*), or is not within the classes of registerable symbols enumerated in sect. 64, except on an application under sect. 90 (*o*). The application cannot be made by counterclaim in the action (*p*).

Application
to expunge
or limit the
plaintiff's
registration.

It follows that the defendant in an infringement action, unless satisfied that the plaintiff's title cannot safely be attacked, generally moves to expunge the mark of the latter from the register, or to so limit it as to defeat the action, and, according to the usual practice, the application comes on for hearing with the trial of the action, or with the plaintiff's motion for an interlocutory injunction (*q*), if any. The Court will, in a proper case, adjourn the decision of the last-mentioned motion in order to enable the defendant to make his cross application to rectify or expunge (*r*).

Determina-
tion of the
plaintiff's
title.

In any case, it is submitted, and notwithstanding that there is no application to rectify, the defendant may show

(*h*) Sect. 70, *ante*, p. 304.

(*i*) Sect. 87.

(*k*) *Ante*, p. 287.

(*l*) *Edwards v. Dennis*, 30 C. D. 454 (1885), C. A.

(*m*) As in *Pinto v. Badman*, 8 R. P. C. 181 (1891), C. A.

(*n*) See Chap. II., p. 24.

(*o*) As to which see Chap. XI., p. 218.

(*p*) *Pinto v. Badman*, *supra*.

(*q*) On an interlocutory motion for an injunction to restrain infringement, registration, though for less than five years, is generally treated as sufficient evidence of title for the purposes of the motion. *Compania Generala de Tabacos v. Rehder*, 5 R. P. C. 61 (1887), Kay, J. See p. 304, note (*t*).

(*r*) Cf. *Edwards v. Elkan*, *infra*, note (*v*).

that the plaintiff's right has determined by abandonment or otherwise (*s*).

Concurrent Right.

Where the Court has so decided, two or more persons may be registered as proprietors of the same mark for the same goods (*t*), and they will then have concurrent rights. But where more than three persons are independently entitled to use a mark for the same goods it is treated as common to the trade, so that if any of them has obtained registration, the entry ought to be expunged (*u*).

Concurrent or independent right.

The defendant, if he have an independent right, can therefore apply for registration himself, and in a proper case the Court will order a motion for an interlocutory injunction to stand over until his application is disposed of (*v*); or, if he allege that the mark is common, he can apply to remove the plaintiff's mark from the register.

In *Mouson v. Boehm* (*x*), where the plaintiffs had independently adopted, and, in 1880, had registered, a mark closely resembling a mark which the defendant had previously acquired for the same goods, and which he had never abandoned, the plaintiffs brought their action to restrain the defendant from using the latter mark. The defendant applied to register the mark as his, and moved to have the entry of the plaintiff's mark expunged from the register. The application to register came before the Court on a summons to proceed, and was heard, together with the motion for an injunction, at the trial of the action. Chitty, J., allowed the defendant to be registered as a proprietor of the mark, but he refused to order the

Mouson v. Boehm.

(*s*) See Chap. XIV., p. 283.

(*v*) *Edwards v. Elkan*, 5 R. P. O. 70 (1887), Stirling, J.

(*t*) Sects. 71 and 72. It must be a right to use the mark as a trademark; not, for instance, as a family crest, *Standish v. Whitwell*, 14 W. R. 612; *Beard v. Turner*, 13 L. T. N. S. 746, both (1866) Wood, V.-O.

(*x*) 26 C. D. 308 (1884), Chitty, J. A similar case of an old mark is cited by Mr. Sebastian, *Re United Vineyards, &c. Co.* (1880), Stirling, J.; and *Re Bryant and May*, 4 Times L. R. 676 (1888), Stirling, J., is another.

(*u*) Chap. X., p. 177.

registration of the plaintiff's mark to be expunged, and he dismissed the action.

*Jackson v.
Napper.*

Jackson v. Napper (y) is a similar case. There the defendant, in 1876, applied through an agent to register a mark as his trade-mark, and he supposed that it was registered accordingly, but, in fact, the application was not proceeded with and was, as the Court held, abandoned. In the next year the plaintiffs registered a similar mark, and more than five years after their registration they brought the action to restrain the defendant from using his mark, and thereupon the defendant took out a summons for a direction to the comptroller to proceed with the registration of his mark. Stirling, J., found that the defendant had acquired and used his mark as a trade-mark before the 13th of August, 1875, in respect of the goods in question, except one particular class (sheep-shears), and he held that, notwithstanding that the five years' registration of the plaintiffs was conclusive evidence of their right to the "exclusive use" of their mark, he had jurisdiction to allow the defendant to be registered in respect of his own mark, upon the analogy of the rule that an entry on the register may be rectified, under sect. 90 (s), after five years' registration. He accordingly directed the defendant to be registered as proprietor of his mark for the goods in question, other than the sheep-shears, and dismissed the action, except so far as regarded the last-mentioned goods, in respect of which he granted the injunction the plaintiffs sought.

The defendant should apply to register his own mark or to expunge the plaintiff's.

It will have been observed that in both the cases last cited there was before the Court an application to register the defendant's mark, and, upon the analogy of the decisions cited above (a), that, in the absence of an application to rectify, the registration of the plaintiff's mark is, after five years, conclusive proof of his right, it would seem that where the plaintiff's mark has been registered

(y) 35 C. D. 162; 4 R. P. C. 45 (1886), Stirling, J.

(z) Chap. XII., p. 268.

(a) Page 304.

for the period named, the defendant, if he wishes to plead an independent right, must apply either to register his own name, or to rectify the registration of that of the plaintiff.

It is assumed in the judgments delivered in the above-cited cases, and is besides clearly implied by the Act, that registration when properly made gives the defendant an equal title to use the mark with the plaintiff, but only, of course, according to the terms of the entry. It is just as much an infringement for the defendant to use a registered mark for goods (b), or in a market in respect of which it is not registered, and the plaintiff's mark is registered, as if the defendant's mark were not registered at all. If the plaintiff alleges that the use of the registered mark of the defendant for the goods in respect of which it is registered is an infringement of his mark, his proper course is to apply in the first place to remove the defendant's mark from the register before commencing, or concurrently with (c), the action for infringement.

Registration gives the defendant a right to use his mark *prima facie* or conclusive.

If the defendant's mark has been registered for five years, on the principle referred to above (d), the plaintiff cannot question the right *prima facie* conferred by the registration except upon an application to vary or expunge the entry; but, as in the corresponding case of the plaintiff's registered mark, where the registration is less than five years old, it appears to be open to the plaintiff to prove by evidence in the action that it does not, in fact, confer any right to the use of the mark (e).

Registration for copyright purposes of a mark at Registration

(b) *Upper Assam Tea Co. v. Herbert*, 7 R. P. C. 183 (1889), C. A.

(c) As in *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 C. D. 454; 3 R. P. C. 28 (1886), Kay, J., where the register was rectified by limiting the class of goods for which the defendant's mark was

registered, and an injunction was granted in respect of goods excluded from the class.

(d) Page 304.

(e) *Read v. Richardson*, 45 L. T. 54 (1881), C. A., cited p. 345; *Goodwin v. Venning*, 24 Sol. J. 690 (1880), Jessel, M.R.

at Stationers' Hall.

Stationers' Hall confers no trade-mark rights, and constitutes no defence if the mark is an infringement of another person's trade-mark (f).

Is the introduction of the defendant's own mark into a new market an infringement?

If the plaintiff and defendant are severally entitled to, and are the registered proprietors of, two marks which are, in ordinary markets, distinct and unlikely to be confused, is it an infringement for the defendant to introduce his mark into a market where the plaintiff's is already known, if from the character of the customers there,—their ignorance of English, for instance,—its use is calculated to cause the defendant's goods to be taken for the goods of the plaintiff? It is submitted that it is an infringement, and that a note, limiting the use of the defendant's mark to markets other than the one in question, ought to be entered upon the register, for the case put falls within the principle that one trader must not do what is calculated to cause his goods to be taken for those of another, and the defendant's action is in this sense the cause of deception. The question was raised, but not determined, in *Johnston v. Orr-Ewing*, in the House of Lords, and the words of the order of Fry, J., having special reference to the Bombay trade were, with the assent of the respondents, directed to be omitted. There Lord Selborne said, in his judgment: "Your Lordships are not called upon to decide whether a ticket, which was a rightful and *bonâ fide* trade-mark of the trader using it, could be excluded by injunction from particular markets (though unimpeachable everywhere else) merely because in those markets it might be liable to be called by a name which the mark of another trader had already acquired there. . . . To that proposition I should not myself, as at present advised, be prepared to assent" (g).

(f) *Reinhardt v. Spalding*, 49 L. J. Ch. 57 (1879), Hall, V.-C., (*Family Salve*).

(g) 7 App. Cas. p. 227 (1882). See also *Wilkinson v. Griffith*, 8 R.

F. O. 570 (1891), Romer, J. An injunction limited to Ireland was granted in *Barber v. Manico*, 10 R. P. O. 93 (1893), A. L. Smith, J.

Where a partnership is dissolved without a sale of the goodwill, or any arrangement having been made for its disposal, or governing the use of the trade-marks of the firm, each of the late partners who carries on the business may use the trade-marks (*h*), for he is, as to a portion of the goodwill, a successor of the firm; but if the goodwill is sold as part of the assets of the firm, the exclusive right to use the trade-marks may be sold with it, and in that case the late partners cannot lawfully use the trade-marks, even though they set up a similar business in competition with the purchaser (*i*).

Trade-mark rights on the dissolution of a partnership.

But a late partner cannot grant to others who are in no way successors to the firm's business, or any part of it, any right or licence to use the trade-marks, even though he be registered as proprietor of the marks under sect. 87, or otherwise. The case of *Hanson v. Game, Harrison and Larner, Limited* (*k*), was decided on the construction of a consent order under which the partnership in question had been dissolved, and which provided that the late partners "and any partners they may take respectively" were to have the common use of the trade-marks; but it is submitted that the decision might have been put on the general ground that the defendants—a limited company, of which one late partner was a shareholder and director—could not use the marks without infringing the rights of the plaintiffs, the other late partner and his partners, because they were not possessed of the goodwill of any part of the old business.

So if the trustee in bankruptcy of a trader sells the

Sale of trade-

(*h*) *Banks v. Gibson*, 34 Beav. 566 (1865), Romilly, M.R.; *Condy v. Mitchell*, 37 L. T. N. S. 268 and 766 (1877), Bacon, V.-C., and C. A.; *Benbow v. Low*, 44 L. T. N. S. 875 (1881), Bacon, V.-C. See Chap. XIII., p. 278. As to cases where the severance of business relations determines a joint trade-mark, see

Robinson v. Finlay, 9 C. D. 487; and *Jones' Tm.*, 53 L. T. N. S. 1, cited p. 50.

(*i*) See the last case, and *Hall v. Barrows*, 4 De G. J. & S. 150; 33 L. J. Ch. 204 (1863), Westbury, L.C.

(*k*) 9 B. P. C. 186 (1892), Stirling, J.

marks in
bankruptcy.

Honest use
of the defen-
dant's name
is no infringe-
ment.

goodwill and trade-marks of the latter's business, the trader has no right to continue to use the marks (*l*).

A trader who is honestly using his own name in his business will not be guilty of infringement because its similarity to the name of another, or to a name appearing in another's trade-mark, is calculated to lead to deception; but to support this defence the business must be his own, for a fraudulent attempt to cover an infringement by employing or taking into partnership a man who happens to bear the name which is to be used to effect the fraud, still less by buying from him the right to use his name, will not avail to protect the offender (*m*).

(3.) The necessity for registration of the plaintiff's marks, having regard to sect. 77, has already been discussed (*n*).

(4.) And so also has the question, What constitutes an infringement? (*o*).

Estoppel.

(a) Except with regard to the several defences which are considered under separate headings, there is nothing peculiar to the law of trade-marks to determine what agreements, or what circumstances constituting a personal estoppel, will prevent a plaintiff from suing a particular defendant for infringement. It is to be remembered, however, that an infringement is primarily a fraud on the public, in respect of which the plaintiff is allowed to sue, because its natural effect is to cause damage to him. An agreement, therefore, not to prosecute future infringements would be an agreement to permit a fraud, and although, if established, it would undoubtedly prevent the Court from interfering in favour of any party to it, it could not be

Agreement
to condone in-
fringements.

(*l*) *Hammond v. Brunker*, 9 Il. P. C. 301 (1892), Chitty, J.; *Hudson v. Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C.

(*m*) See *Turton v. Turton*, 42 O. D. 128 (1889), C. A.; and *Tussaud v. Tussaud*, 44 O. D. 678

(1890), Stirling, J., and the earlier cases cited in these, and Chap. XVI., pp. 420 *et seq.*

(*n*) Above, p. 303; Chap. XII., p. 260.

(*o*) Above, p. 305.

specifically enforced, and, unless the intention were clearly indicated, the Court would presume that a lawful arrangement, for instance, a waiver of the remedy in respect of past infringements only, was intended (*p*).

As an instance of estoppel by conduct, the case of *Maxwell v. Hogg* (*q*) may be taken. There the defendants had received, and published for reward from the plaintiffs, advertisements of an intended new magazine, bearing the title of a magazine which they were themselves preparing to publish, without warning the plaintiffs of their own intention; and this uncandid conduct was held to be sufficient ground for dismissing the cross suit of the defendants for an injunction to prevent the plaintiffs using the name. Uncandid conduct.

And anything in the nature of a representation by the plaintiff to the defendant that his mark was not an infringement, or that it might be lawfully used, or of an encouragement to him to continue using it, would be an answer to a subsequent claim for damages for infringement, although a mere failure by the plaintiff as soon as he had knowledge of the infringement to warn the defendant, would be no bar (*r*). Failure to give warning.

It is sometimes urged as an objection to the plaintiff's case, on behalf of the defendant, that the plaintiff in actual practice uses his mark in a form different from that for which he has obtained registration; but the variation of his registered mark by the plaintiff, provided it is not an infringement of any other person's mark, or a breach of any agreement binding upon him, is perfectly lawful, although so far as the mark actually used by the plaintiff differs substantially from his registered mark, it is an unregistered mark, as has been already pointed out; and if The plaintiff is not barred because he uses his registered mark with additions.

(*p*) *Oldham v. James*, 13 Ir. Ch. 393; 14 Ir. Ch. 81 (1862), Brady, C., and Blackburne, L.J.

(*q*) L. R. 2 Ch. 307 (1867), *Turner and Cairns*, J.J., cited p. 33.

(*r*) See *Proctor v. Bonnis*, 36 C. D.

740 (1887), C. A., a patent case; and the notes to *Savage v. Foster*, 2 White & Tudor's Leading Cases, 6th ed., 680. The rule is "*qui potest et debet vetare jubet*"; *Osborn v. Lees*, 9 Mod. 96; *Willmott v. Barber*, 15 C. D. 96; 17 C. D. 772.

the registered mark is in substance not used at all, that would be an independent objection to the plaintiff's action (s). It is well settled that the use of a varied mark by the plaintiff does not in any way estop him from proceeding against infringers. Thus, in *The Melachrino Case* (t), the plaintiffs had tried to register a label comprising three coats of arms, but the coats of arms had been rejected and the label registered without them. The plaintiffs, nevertheless, always used the labels with the arms in it, and the defendants, who had imitated the label, were enjoined from continuing the infringement. In a subsequent case (u), Chitty, J., said: "I adhere to what I said in *Melachrino's Case*, that the mere addition of something, as, in that case, a coat of arms, to the trade-marks, is not sufficient to disentitle a person who otherwise uses the whole of his trade-marks to sue for an injunction."

Similarly, it is no ground of estoppel that the plaintiff uses his mark for goods in respect of which it is not registered (x).

Acquiescence.

(b) Acquiescence in the infringement on the part of the plaintiff is a complete defence (y), but it can only be inferred where he is shown to have had knowledge of it (z). And, assuming that it is shown that the plaintiff knows of the infringement, the Court will not readily infer that he has assented to what is likely to be so detrimental to his property. It has been held that, where it is pleaded in answer to a motion to commit the defendant for the breach of an injunction restraining him from infringing, it must amount to a licence "sufficient to create a new right in him" (a).

(s) Above, p. 303.

(t) *Melachrino & Co. v. The Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215 (1887), Chitty, J.; *Newman v. Pinto*, 4 R. P. C. 508; 57 L. T. 31 (1887), Kekewich, J., and C. A.

(u) *Hammond v. Brunker*, 9 R. P. C. p. 307 (1892).

(x) *Jay v. Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

(y) *Per Chitty, J.*, in *Mousen & Co. v. Boehm*, 26 C. D. p. 406 (1884).

(z) *Weldon v. Dicks*, 10 C. D. 247 (1878), Malins, V.-C.; *Re Farina*, 27 W. R. 456 (1879), Hall, V.-C., and the last case.

(a) *Rodgers v. Nowill*, 3 De G. M.

A licence by the plaintiff to the defendant to use the mark would be proof of acquiescence in user falling within the terms of the licence, and would be a defence (b). Any registered proprietor can grant licences to use the mark, subject to any equities affecting it (c), unless, for instance, he has agreed with the plaintiff not to do so (d). But it is submitted that a licence by some registered proprietor, other than the plaintiff, would not be a defence unless the defendant were possessed of the goodwill of the business, or part of it, to which the trade-mark was attached (e).

(c.) Mere delay, after knowledge of the infringement, to take proceedings, not sufficient to call the Statutes of Limitation into operation, is no bar to the action. Before the Judicature Acts it might have furnished an answer to an application for an injunction (f), at least until the plaintiff had established his rights by recovering damages in an action at law, unless the deception resulting from the use of the defendant's mark were still continuing (g); but both branches of the Court now enforce legal and equitable rights together, and consequently, wherever an injunction could have been obtained after an action for damages, it can now be obtained at once or concurrently with the judgment for damages. The rule is not peculiar to trade-mark cases, but is part of the general law (h).

Licence.

Delay does not bar the right of action;

& G. 614; 22 L. J. Ch. 404 (1853), per Turner, L.J. As to what constitutes acquiescence, see *Proctor v. Bennis*, ante, p. 331; "delay," section (c); and *Hogg v. Scott*, L. R. 18 Eq. 444, Hall, V.-C., *Weldon v. Dicks*, 10 C. D. 247, Malins, V.-C. (copyright); and *Smith v. Smith*, L. R. 20 Eq. 500, Jessel, M.R. (ancient lights).

(b) *Kinahan v. Bolton*, 15 Ir. Ch. 75 (1863), Brady, C.

(c) Scot. 87.

(d) *Hanson v. Game, Harrison and*

Larner, Ltd., 9 R. P. C. 186 (1892), Stirling, J.

(e) See Chap. XIII., p. 281, and sect. 70.

(f) *Horenden v. Lloyd*, 18 W. R. 1132 (1870), Bacon, V.-C., fifteen months' delay; *Estcourt v. The Estcourt Hop Essence Co.*, 10 Ch. 276 (1875), Cairns, L.C. and L.JJ.; seven months' delay.

(g) *Rodgers v. Rodgers*, 31 L. T. N. S. 285 (1874), L.JJ.

(h) See *The Three Towns Banking Co. v. Maddox*, 27 C. D. 533 (1884), C.A.

It was stated by Fry, J., in the following terms, in *Fullwood v. Fullwood* (2) (i): "In my opinion that delay" (from early in 1875, when the plaintiff first knew of the infringement, till November, 1876, when he commenced his action) "—and it is simply delay—is not sufficient to deprive the plaintiff of his rights. The right asserted by the plaintiff in this action is a legal right. He is, in effect, asserting that the defendants are liable to an action for deceit. It is clear that such an action is subject to the Statute of Limitations, and it is also clear that the injunction is sought merely in aid of the plaintiff's legal right. In such a case the injunction is, in my opinion, a matter of course, if the legal right be proved to exist. In saying that I do not shut my eyes to the possible existence in other cases of a purely equitable defence, such as acquiescence or acknowledgment (k), and the various other equitable defences which may be imagined. But lapse of time, unaccompanied by anything else (and to that I confine my observations), has, in my judgment, just as much effect, and no more, in barring a suit for an injunction as it has in barring an action for deceit. In my judgment, the same rule applies since the Judicature Act as formerly applied in the Court of Chancery when the legal right had to be determined in an action at law" (l).

but may
modify the
relief granted;

But delay may affect the nature of the relief granted. It may cause the Court to refuse the ordinary interlocutory injunction, either on terms of the defendant keeping an account, or absolutely (m), or to refuse to give damages, or to direct an account of profits in lieu of damages, or to restrict such account to profits made since the beginning of the action (n).

And in a case where the plaintiffs took no action on hearing that the defendant had received a small consign-

(i) 9 C. D. p. 178 (1878).

(k) *Quere* abandonment.

(l) Cf. the judgment of Mellish, L.J., upon the defence of misrepresentation in *Ford v. Foster*,

L. R. 7 Ch. p. 682.

(m) See below, "Interlocutory injunction," p. 353.

(n) See below, "Account," p. 360.

ment of spuriously marked goods, preferring to wait until he received a larger consignment, Malins, V.-C., ordered the injunction to be directed to future receipts by the defendant only (o). Unless, however, this case can be supported on the ground of acquiescence, it is submitted that it is inconsistent with the rule established by the cases cited above.

But delay to pursue infringers, where the infringements are numerous and notorious, may amount to abandonment (p) of the trade-mark, and lead to its becoming *publici juris* (q). and may amount to abandonment.

And, as already pointed out, it may have an important bearing on the weight of the evidence in the case, for if, in spite of long user by the defendant of the alleged infringing mark, no case of actual deception is proved, and the absence of this evidence is not otherwise accounted for, it may be difficult for the Court to believe that the defendant's mark is calculated to deceive. It has been suggested that, where the infringement has lasted a number of years, it is necessary for the plaintiff to prove that some persons have actually been deceived (r), but this is not, it is submitted, a rule of law (s). It has a bearing on the weight of evidence.

Moreover, lapse of time may prevent conduct which would at first be an infringement being calculated to deceive. Thus, in *The Marquis of Londonderry v. Russel* (t), an action against the defendant, for sending coals to the London market as "Londonderry Wallsend Coal," was dismissed because the defendant had used the name for twenty-five years, and the plaintiff had long known of his use of it.

(o) *The Anglo-Swiss Condensed Milk Co. v. The Swiss Condensed Milk Co.*, (1871) W. N. 163.

(p) Page 289.

(q) As in *Hyde & Co.'s Tm.*, 7 C. D. 724 (1878), Jessel, M.R., (*Bank of England Sealing Wax*); Chsp. XIV., p. 284.

(r) *Rodgers v. Rodgers*, 31 L. T. N. S. 285 (1874), per Mellish, L.J.; *Isaacson v. Thompson*, 41 L. J. Ch. 101 (1871), Bacon, V.-C.

(s) See "Proof of Actual Deception," p. 206.

(t) 2 Times L. R. 843; 3 Times L. R. 360 (1886), Bacon, V.-C., and C. A.

Whatever might have been the result had the plaintiff applied in 1861 to restrain the defendant from selling his coals under the name, it was clear, the Court of Appeal held, that at the time of their judgment the defendant's conduct could not be taken to amount to any representation that his coals came from the plaintiff's Londonderry collieries.

Deceptive trade-mark and fraudulent trade.

(d.) The Court will not interfere to protect the use of a deceptive trade-mark, or to assist a trader who is using his mark for the purposes of a fraudulent trade. This principle was well established in the Court of Chancery, and, although no case seems to be reported upon the point, it would no doubt have been recognized also in the Courts of Common Law before the Judicature Acts, had any case arisen, for the maxim *ex turpi causa non oritur actio* is a rule of law (u).

The plaintiff, Lord Westbury said, in *The Leather Cloth Case* (x), "desires to restrain the defendant from selling his own goods as the goods of another person; but if, by the use of the trade-mark in question, the plaintiff himself is representing and selling his goods as the goods of another, or if his trade-mark gives a false description of the article, he is violating the rule upon which he seeks relief against the defendant."

Deceptive trade-marks are outlawed.

The deceptive mark, in Sir Roundell Palmer's phrase; adopted by James, V.-C., in *The Leather Cloth Co. v. Lonsont* (y), is "outlawed."

Collateral misrepresentation.

Ford v. Foster.

The earliest of the cases commonly cited, in which the Court of Chancery refused to interfere, on the ground of the plaintiff's own deceptive conduct, until the plaintiff had established his right by action at law, is *Pidding v. How* (z), and the leading authority on the subject is the judgment of Mellish, L.J., in *Ford v. Foster* (a). There it

(u) See *per Mellish, L.J., in Ford v. Foster, L. R. 7 Ch. p. 631 (1872).*

(x) 4 De G. J. & S. 187; 33 L. J. Ch. 199 (1863).

(y) L. R. 9 Eq. p. 352 (1869).

(z) 8 Sim. 477; 6 L. J. Ch. N. S. 345 (1837), Shadwell, V.-C. Lying advertisements as to the origin of tea (*Howqua's Mixture*).

(a) L. R. 7 Ch. 611 (1872), (*Eureka Shirts*).

was objected by the defendants that the plaintiff in certain invoices and advertisements had falsely described himself as a patentee; but as the false description was collateral and did not appear in the mark in question, and the plaintiff's trade was not shown to be fraudulent, the Court decided that the plaintiff's legal right of action in respect of the defendant's infringement was not barred, and that he was consequently entitled to an injunction, with an account from the filing of the bill, and costs. If the false representation had been in the trade-mark itself, the Lord Justice held, no Court of Equity, and, according to his opinion, no Court of law, would have entertained the plaintiff's action, and the same rule would apply if the trade were fraudulent; but, he said, "where the trade is, as in this case, a perfectly honest trade, and where the trade-mark is, as in this case, a perfectly honest trade-mark, I am clearly of opinion that there is no common law principle upon which it is possible to hold that the fact that the plaintiff has been guilty of some collateral fraud would be an answer to an action. It would be impossible to plead at law as a justification for the defendant's committing the fraud, that the plaintiff had committed a fraud on some one else." "It is true," he added, "that in this case the bills containing this false representation as to its being a patented article are proved to have been given to the defendants themselves; but there is not the slightest evidence, or the slightest reason for supposing, that the defendants were ever deceived by that representation, because they knew perfectly well that there was no patent for these shirts."

The judgment of Mellish, L.J.

The following are some miscellaneous examples of cases where objections to the plaintiff's case on the ground of collateral misrepresentation failed: title of a magazine protected, although the magazine purported to be written by someone other than the author, *Hogg v. Kirby*, 8 Ves. 215; similar cases with regard to songs, *Chappell v. Sheard*, 2 K. & J. 117; *Chappell v. Davidson*, 2 K. & J. 123; 8 De G. M. & G. 1. "Holloway's pills and ointment" protected,

Examples of collateral misrepresentations.

although the plaintiff called himself Professor Holloway without warrant, and published exaggerated commendations of his pills, *Holloway v. Holloway*, 13 Beav. 209; an objection on the ground that the plaintiffs retained a brass plate on the door of their business premises, bearing their predecessor's name, overruled, *Hudson v. Osborne*, 39 L. J. Ch. 79.

Sect. 73 provides that it shall not be lawful to register as part of, or in combination with, a trade-mark, any words the use of which would by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a Court of Justice (b).

Application to remove deceptive mark from the register.

It follows that a trade-mark which contains false statements or misrepresentations ought not to be entered or retained upon the register, and, in modern cases, if the defendant wishes to rely upon the defence now under consideration, and to allege that the plaintiff's trade-mark itself is deceptive, he commonly applies under sect. 90 to have it removed from the register (c). This is a convenient method of bringing the question to an issue, if the plaintiff is suing in respect of a registered mark, and it is the most advantageous course for the defendant; but there is no reason to suppose that the Court would be any more ready to interfere to protect a deceptive trade-mark because it was registered, or that it is not open to the defendant to give evidence in support of a plea of the defence in question without there being any application, under sect. 90, before the Court.

(i.) Where the trade-mark itself contains misrepresentations—

The Leather Cloth Case.

In *The Leather Cloth Case* (d), the plaintiffs' case failed

(b) Chap. X., p. 209.

(c) *Wood v. Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A.; *Dexter's Tm.*, (1893) 2 Ch. 262; 10 R. P. C. 269, Wright, J. See Chap. X., p. 209.

(d) 4 Do G. J. & S. 137; 33 L. J. Ch. 199, Lord Westbury;

and 11 H. L. C. 523; 35 L. J. Ch. 53; H. L. overruling 1 H. & M. 271; 32 L. J. Ch. 721, *Wood, V.-O.* (1863). See also *Newman v. Pinto*, 4 R. P. C. 608; 57 L. T. 31 (1887), C. A., mark representing German cigars as of Havana make, cited p. 347.

because, in the label in question, they had described their goods as "tanned leather cloth," "patented," and "J. R. and C. P. Crockett" as the manufacturers, adding an American address, whereas, in fact, much of the cloth for which the mark was used was not tanned, none of it was made under any patent, and the manufacturers were not J. R. and C. P. Crockett, but the plaintiffs themselves, who had no American address. It was urged on behalf of the plaintiffs that the misrepresentations, and in particular the representation that the goods were tanned, could not deceive any ordinary purchaser; but in answer to this Lord Westbury said: "I cannot receive it as a rule either of morality or equity that the plaintiffs are not responsible for a falsehood because it is so gross and palpable that no one is likely to be deceived by it. If there is a wilfully false statement, I will not stop to inquire whether it is too gross to mislead" (e).

It is immaterial that the misrepresentation does not deceive;

It is no answer to the objection that the trade, or any other given class of persons, know the actual facts and are not deceived (f); for, as in the case of the test of infringement, the question is—is the mark calculated to deceive any probable purchasers who buy from the plaintiff directly or indirectly through others to whom he sells?

or that the facts are known to the trade.

The employment of the word "patent" in a mark used for goods which are not manufactured under an existing patent right has given rise to much discussion (g); but the authorities do not seem to have established any more definite rule than that it is in each case a question whether or not the employment of the word makes a false and deceptive claim to a non-existent patent right for the goods. It is not necessarily deceptive to describe as "patent" goods which are made according to a process which once was patented, or even those made according to

False claim of patent right.

(e) 33 L. J. Ch. p. 203. So per Fry, L.J., in *Newman v. Pinto*, 4 R. P. C. p. 520 (1887).

cf. *Eno v. Dunn*, 10 R. P. C. 261.

(f) *Wood v. Lambert*, 32 C. D. 247; 3 R. P. C. 31 (1886), C. A.;

(g) Its use may amount to a criminal offence; sect. 105, and Merchandise Marks Act, 1887, s. 3 (1) (e); Book II., Chap. I., p. 483.

a process which is, or was when the epithet was first applied, different to the common process, though never protected by a patent, for ordinary usage and understanding have long sanctioned such descriptions, as the names patent leather, patent medicine, patent metal, patent yellow, and patent hoe, show (h).

Lord Kingsdown's judgment in *The Leather Cloth Case*.

The following passage from Lord Kingsdown's judgment, in *The Leather Cloth Case* (i), in reference to the subject under consideration, is very frequently cited in argument: "If a trade-mark represents an article as protected by a patent, when in fact it is not so protected, it seems to me that such a statement *prima facie* amounts to a misrepresentation of an important fact, which would disentitle the owner of the trade-mark to relief in a Court of Equity against anyone who pirated it. In *Flavel v. Harrison* (k), Wood, V.-C., intimated his opinion that this would be so when there never had been any patent at all. But in the subsequent case of *Edelsten v. Vick* (l), he seems to doubt whether the rule would be the same if there had originally been a patent, and the statement in the trade-mark being true when first introduced, had been continued after it had ceased to be true. I confess that I should have had great difficulty in assenting to that distinction. If the word 'patent' be not so used as to indicate the existing protection of a patent, but merely as part of the designation of an article known in the market by that term (and this I collect to have been the main ground of his Honour's decision), then I quite agree with his view. In such case nobody is meant to be deceived, or is deceived.

(h) See *per* Wood, V.-C., in *Edelsten v. Vick*, 11 Hare, 78 (1853); *Morgan v. McAdam*, 36 L. J. Ch. 228 (1866), (*Patent Plumbago Crucibles*); and *Gridley v. Swinborne*, 5 Times L. R. 71; 52 J. P. 791 (1888), Coleridge, L.C.J., and Grantham, J., cited p. 485, (*Swinborne's Patent Refined Isinglass*).

"The illustrious race whose drops and pills, have patent powers to vanquish human ills"—Crabbe, quoted in Ogilvie's Dictionary.

(i) 11 H. L. C. 523; 35 L. J. Ch. p. 64 (1865).

(k) 10 Hare, 467; 22 L. J. Ch. 866 (1853).

(l) 11 Hare, 78 (1853).

“A patent may have expired fifty years ago, and yet the name of patent may have become attached to the article, and be used in the trade as designating it. But if the trade-mark represents the article as protected by patent, when in fact it is not so protected, I cannot think that it can make any difference whether the protection has never existed or has ceased to exist.”

And in a later case, Jessel, M.R., said: “No doubt a man may use the word ‘patent’ so as to deceive no one. It may be so used as to mean that which was a patent but is not so now. In other words, you may state in so many words, or by implication, that the article is manufactured in accordance with a patent which has expired. But if you suggest that it is protected by an existing patent, you cannot obtain the protection of that representation as a trade-mark. Protection only extends to the time allowed by statute for the patent, and if the Court were afterwards to protect the use of the word as a trade-mark, it would, in fact, be extending the time for protection given by the statute. It is, therefore, impossible to allow a man who has once had the protection of a patent to obtain a further protection by using the name of his patent as a trade-mark. But further, no man can claim a trade-mark in a falsehood. It is a falsehood to represent that the patent is still existing” (m).

From the principles stated in these judgments, and from the decided cases, it follows that the use of the word “patent” in a trade-mark for unpatented goods is not to be taken to be misleading where either it is shown that the market name of the goods comprises the word (n), or where the goods are made according to an expired patent, and the word is so used as to be understood to refer to this (o).

Expired patent.

Where “patent” is not deceptive.

(m) *Cheavin v. Walker*, 5 C. D. p. 862 (1877), C. A.

(n) *Marshall v. Ross*, L. R. 8 Eq. 651, (*Patent Thread*); cf. *Leather Cloth Co. v. Lonsont*, L. R. 9 Eq. 345, both (1869), James, V.-C.

(o) *Ransome v. Graham*, 51 L. J. Ch. 897 (1892), Bacon, V.-C. In *Morgan v. McAdam*, 36 L. J. Ch. 228 (1866), Wood, V.-C., suggested that in these cases the date of the patent should be given.

Summary of cases where "patent" used.

Action barred.

The following is a summary of the reported cases on the subject (*p*):—

First, where the plaintiff's action was barred: FLAVEL'S PATENT KITCHENER, no patent, *Flavel v. Harrison*, 10 Ha. 467; 22 L. J. Ch. 866; PATENTED JAN. 24, '56, patent void, *Leather Cloth Co., Ltd. v. American Leather Cloth Co., Ltd.*, p. 339; *Leather Cloth Co., Ltd. v. Lorseant*, L. R. 9 Eq. 345; PATENT PLUMBAGO CRUCIBLES, no patent, *Morgan v. McAdam*, p. 340; ROYAL LETTERS PATENT, no patent, but duty paid in respect of a patent medicine, *Lamp-lough v. Balmer*, W. N. (1867) 293; MANUFACTURER AND PATENTEE, no patent, *Nixey v. Roffey*, W. N. (1870) 227; G. CHEAVIN'S IMPROVED PATENT GOLD MEDAL SELF-CLEANING RAPID WATER FILTER, expired patent, *Cheavin v. Walker*, p. 341.

Action not barred.

Secondly, where the plaintiff's action was not barred: SYKES' PATENT, patent invalid, no plea having reference to the misrepresentation, *Sykes v. Sykes*, 3 B. & C. 541; TAYLOR'S PATENT SOLID-HEADED PINS, expired patent, labels printed from the old blocks in use while the patent existed, *Edelsten v. Vick*, 11 Hare, 78; PATENT THREAD, no patent, evidence that patent was understood in the market to denote the character of the goods, *Marshall v. Ross*, L. R. 8 Eq. 651. The case of *Ransome v. Graham*, 51 L. J. Ch. 897, must probably be explained as one of collateral misrepresentation, if it can be supported at all. There the trade-mark consisted of letters and numbers stamped upon the working parts of the plaintiff's ploughs, and "patent" was stamped also, although the only patent which had ever existed related to the plough-shares merely, and had expired in 1817. The plaintiff's advertisements and catalogues stated that the patent had expired, but this could hardly be an answer to the objection, as the notice would not, or might not, reach all the persons who saw the stamp.

(*p*) The pages given refer to this book. See also *Adams' Tm.*, 9 R. P. C. 174; 66 L. T. N. S. 610 (1892), where Kekewich, J., re-

fused to allow "patent" to be struck out of an old mark for furniture polish.

It is a misrepresentation which disentitles a label or other trade-mark to protection or to registration, to indorse upon it anything which is calculated to mislead the public as to what is the mark of which the proprietor claims the exclusive use. The matter was first brought forward in *The Apollinaris Case* (q), where some of the labels in question had the word *trade-mark* printed immediately under the red triangle or disc, which was their most prominent feature, although other parts of the labels, and, in particular, the words *Apollinaris* and *Friedrichshall*, were claimed as essential features of the trade-marks. The application before the Court was to remove the marks from the register on several grounds; and Fry, L.J., who delivered the judgment of the Court of Appeal, dealt with the present objection in the following passage (r):—

“Trade-mark.”

The Apollinaris Case.

“One (objection) was, that the mark was calculated to mislead, inasmuch as the whole label is registered as a trade-mark, and yet contains the assertion that the red disc, which is the most conspicuous part of the whole label, is ‘the trade-mark’—not saying ‘a trade-mark,’ not saying part of ‘the trade-mark’—but an assertion pointing to the conclusion that it, and it alone, is ‘the trade-mark,’ and therefore that the label, as a whole, is not the trade-mark. Such would have been the impression produced (I am speaking for myself) on my own mind, had I approached the reading of the label unbiassed by what I have learned while sitting in this seat, and such, we think, is the true result of this case. An owner of a registered trade-mark may put it on a registered label, but not so as to mislead a reader of that label, and induce him to believe the only thing registered is the distinctive mark.” It is true, the learned Lord Justice added, that the objection might, apparently, have been taken in *Hudson’s Case*, where the mark there in question was upheld by the Court of Appeal (s), but it was, in fact,

(q) (1891) 2 Ch. 186; 8 R. P. C. 137, C. A.

(s) 32 C. D. 311; 3 R. P. C. 155 (1886).

(r) (1891) 2 Ch. p. 233.

neither discussed in argument nor considered by the Court.

This judgment caused a number of applications, under sect. 92, for leave to remove "trade-mark" from registered marks to be made to the Court. The results of these are stated in Chapter X. (t).

It is to be observed that Fry, L.J., does not say that the use of the words trade-mark within a label is necessarily misleading; it may be, but it is a question of fact whether it is or not.

*Hammond v.
Brunker.*

In *Hammond v. Brunker* (u), the registered label of the plaintiffs comprised a number of devices, and among them a small blank shield in the middle of the upper half. In use, the plaintiffs printed within the blank shield a hand and forearm holding a dart, and having the words "trade-mark" beneath it. Chitty, J., in rejecting an objection founded upon this, said (x): "It is a question of fact in every case where a man puts the term 'trade-mark' on his device, or some part of it, whether he does or does not so place the words as to indicate to the public that he is claiming a particular part of the trade-mark only. In *The Apollinaris Case*, the Lord Justice's observations were addressed to a label which had been registered, and had the term *Friedrichshall* above a disc, with a quantity of printed matter; the disc was coloured red, and underneath the disc were the words 'trade-marks.' Without expressing a final opinion on the matter (y), the Lord Justice thought that there were grounds for saying, on that label, that the trade-mark referred to the disc, and if I may say so myself, with great respect, it seems to me that there were grounds. But, as I say, this is a question of fact, and I am satisfied that these words 'trade-mark' in the middle of this label do not indicate to the public that the shield only is the trade-mark. In *The Apollinaris*

(t) Page 215.

(u) 9 R. P. O. 301 (1892).

(x) Page 307.

(y) This is hardly borne out by the report of the judgment of Fry, L.J.

“Case there was no other device except the disc, which was coloured red, in use (z). That being so, I think that these two grounds of objection to the plaintiff’s suing, namely, the addition of the arrow and the forearm, and the addition of the words ‘trade-mark,’ do not disentitle the plaintiff to ask for an injunction with regard to his trade-mark.”

In the most recent reported case (a), on the other hand, Wright, J., held the objection to be fatal to one of the respondent’s marks, a label, and ordered it to be removed from the register. There the main portion of the label was occupied by a picture of the head of a negro, inclosed by a circular band containing the words *W. D. & H. O. Wills, Bristol*. Underneath this picture was printed in very large letters the word *Star*. At the side of the label, on the right, was a representation of an eight-pointed star; and in immediate proximity to the star the words “trade-mark” occurred.

It is a penal offence to describe a trade-mark as registered when it is not (b); but it is not clear that this misrepresentation is sufficient to deprive the proprietor of the mark of his right to protection against infringers, or against persons who pass off their goods as his under cover of the mark. In *The Melachrino Case* (c), Chitty, J., held, that the use of the word registered with a mark in which blanks appearing on the registered form were filled up by coats of arms in use, was not a bar to the plaintiff’s case; and it has been held by the Court of Appeal that the use of the words “special registered trade-mark,” before registration had been obtained, was not a sufficient objection to prevent the Court granting an interlocutory injunction (d). And the Court of Appeal has allowed a mark

False assertion of registration.

(z) But there were the important words *Apollinaris* and *Friedrichshall*.

(a) *Dexter’s Tm. and Wills’ Tm.*, (1893) 2 Ch. 262; 10 R. P. C. 269.

(b) Act of 1883, s. 105, below, p. 540; Merchandise Marks Act, s. 3 (1) (e); see Book II., Chap. I., p. 476.

(c) 4 R. P. C. 215 (1887).

(d) *Read v. Richardson*, 45 L. T. 54 (1881), C. A. In *Lewis v. Goodbody*, 67 L. T. 194 (1892), Kekewich, J., refused an interlocutory injunction in a passing-off case, because the plaintiffs had represented that their mark was a registered trade-mark.

to be registered which had been used with the words "registered shape," both the mark, a dome-topped cylinder, and the words being impressed on the blocks of blacklead, which were the goods in question, although the registration of the shape as a design had expired in 1864; but the case was not argued on behalf of the respondents (e).

Other mis-
leading
statements.

It was further suggested, in *The Apollinaris Case*, and the Court of Appeal were inclined to hold, that the indorsement upon one of the labels used for natural mineral waters, and claimed as a trade-mark, "imitations of this water will be prosecuted," meant all imitations, whether fraudulent or not, of the water, and was addressed, therefore, to artificial waters which might lawfully be made and sold as imitations of the natural water, and that, if it bore this meaning, it was calculated to deceive (f).

And by the practice of the registry the words "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To counterfeit this is forgery," will not be registered under the Acts, and should not, therefore, appear upon the representations of trade-marks forming part of an application (g).

The operation of a deceptive misstatement as to the origin of the goods in destroying the distinctive character of the mark, has been referred to in an earlier chapter (h). In *The Eton Cigarette Case* (i), it was held that an English tobacconist, who put a Russian name, as that of the maker, upon his goods, could not protect the mark which they also bore as his trade-mark against infringements.

Fraudulent
trade.

(ii) Where the plaintiff uses the trade-mark in aid of a fraudulent trade, the rule which bars his action is so clear that it will be sufficient to summarise the few cases reported on the subject.

Summary of
cases.

A plea that the plaintiff made a practice of selling by short weight, failed because it was not supported by the evidence, *The Guinea Coal Case*, *Lee v. Haley*, L. R. 5 Ch. 155;

(e) *James' Tin.*, 33 C. D. 392; p. 631.

3 R. P. C. 340 (1886), (h) Chap. VIII., p. 155.

(f) (1861) 2 Ch. p. 226.

(i) *Wood v. Lambert*, 32 C. D.

(g) Instructions 29, Appendix, 247; 3 R. P. C. 81 (1886), C. A.

Piano-forte Tutor, described as "600th edition, specially revised by Hemy," although the musician referred to had not revised the work for ten years, held not to be misleading, evidence being given that in the trade an issue of 250 was called an edition, *Metzler v. Wood*, 8 C. D. 606; trade in German cigars sold in boxes bearing a label with the words LA PUREZA (an old Havana brand), HABANA, RAMON ROMEDO, and additional labels with other words and a sham address in Spanish, held to be fraudulent, the whole get-up being described by Bowen, L.J., as "an elaborate concatenation of pictorial lies" intended to pass off the cigars as made in Havana, although evidence was given that the name *Havana* in the cigar trade indicates the shape of the cigars only, *Newman v. Pinto*, 4 R. P. C. 508; 57 L. T. 31 (k); but the sale of English cigars under a label bearing the word HABANA, but in boxes marked BRITISH MANUFACTURE, was held not to be fraudulent in the absence of evidence that the plaintiffs represented that their cigars were made in Havana, *Hargreaves v. Freeman*, (1891) 3 Ch. 39; 8 R. P. C. 237.

Havana
cigars.

A label containing misrepresentations adopted by the plaintiff after the commencement of his action against the defendant, cannot operate to bar the action. So Fry, J., stated in *Siegert v. Findlater* (l), for, he said, applying the test laid down by Mellish, L.J., in *Ford v. Foster* (m), its adoption could not, before Sir John Rolt's Act, have warranted the Court of Chancery in restraining the action, had it been previously commenced in a common law Court. The learned Judge held, however, that in the case before him there was in fact no fraudulent misrepresentation which ought, in any case, to debar the plaintiffs. It is submitted, with great deference, that on principle it can make no difference, supposing the plaintiff is seeking the aid of the Court for a fraudulent trade, or for a trade con-

Misrepresenta-
tion commencing
after action
brought.

(k) Cf. *Fuente's Tms.*, (1891) 2 Ch. 166; 8 R. P. C. 214; and *Dexter's Application*, (1893) 2 Ch. 262; 10 R. P. C. 269.

(l) 7 C. D. 801 (1878), (*Angestura Bitters*).

(m) L. R. 7 Ch. 611, cited p. 337.

ducted by fraudulent means, that the frauds commenced after the action was begun. The objection is not that the plaintiff's case is incomplete, or that the defendant has any answer as of right to oppose to it, but that the plaintiff and his business are, when the Court takes cognizance of the matter, unworthy of its protection or assistance.

6. The Relief granted.

If the plaintiff succeeds in an action for infringement, he may obtain an order for—(i.) an injunction restraining further infringements of his rights; (ii.) the delivery up for destruction, or for the erasure of the marks of any goods already marked with the spurious mark and in the possession or under the control of the defendant; (iii.) and damages in respect of the past infringement, or in lieu of damages; (iv.) an account of the profits made by the defendant by the sale of the spuriously marked goods, or for some one or more of these.

(i.) Injunction.

This was the characteristic remedy by which the Court of Chancery protected trade-marks, either after the plaintiff had recovered damages for past infringements at law (n), or where it had been appealed to in the first instance and no action had been brought. It is generally the most beneficial relief for the plaintiff, because it summarily stops the particular infringement which the defendant has practised, and makes it highly dangerous for him to commence any other, and it is operative against impetuous infringers who might care little for repeated judgments for damages against them. The Merchandise Marks Act of 1862 (o), empowered a court of law, in any action for fraudulent infringement, to grant an injunction to the successful plaintiff; and, since the Judicature Acts,

(n) See *Ford v. Foster*, L. R. 7 Ch. 616 (1872), L.JJ.

(o) 25 & 26 Vict. c. 88, s. 21, now repealed; see Chap. I., p. 18.

both divisions of the High Court have the same power as that formerly exercised by the Court of Chancery.

The grant of an injunction in trade-mark cases is governed by the general rules governing it where other rights are concerned. There must be some threat or probability that the infringement will be commenced, continued, or repeated, or the Court will not interfere (*p*); but if an actual infringement is shown to have occurred that is usually sufficient, and the plaintiff is not bound to wait until it has been frequently repeated, or until warning has been given and been disregarded (*q*), for "the life of a trade-mark depends upon the promptitude with which it is vindicated" (*r*). So an injunction has been granted where the defendant had altered the device and discontinued the use of the labels complained of, and offered to undertake not to use any more of them (*s*), although, in some instances, the undertaking of an innocent infringer has been accepted by the Court (*t*). Nor is it necessary that any actual infringement should have occurred if it is proved that the defendant contemplates committing or has threatened to commit one (*u*), and it is sufficient evidence of this that he is in possession of a considerable quantity of spuriously marked goods (*q*), even though it is only as a forwarding agent (*x*).

Further infringement must be threatened or be likely to occur.

It has already been shown that the fact that the infringement was not fraudulent (*y*), or even that it was

Proof of fraud not necessary.

(*p*) The Court will presume that a trader will use his mark so as not to be deceptive, if it is capable of being used without the probability of being deceptive, unless some reason to the contrary is shown; *Kutnow's Tm.*, 10 R. P. C. 401 (1893), cited p. 214.

(*q*) See *Upmann v. Forester*, 24 C. D. 231 (1883), Chitty, J., see above, p. 300.

(*r*) *Johnston v. Orr-Ewing*, 7 App. Cas. 219.

(*s*) By Malins, V.-C., in *Guinness*

v. Heap, Seb. Dig. p. 377 (1878); cf. *Tonge v. Ward*, 21 L. T. N. S. 480 (1869), Romilly, M.R.

(*t*) *Rose v. Loftus*, 47 L. J. Ch. 576 (1878), Malins, V.-C.

(*u*) See *The Emperor of Austria v. Day and Kossuth*, 3 De G. F. & J. 217; 30 L. J. Ch. 690 (1861), Campbell, C. and L.JJ.

(*x*) *Upmann v. Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. 130 (1871), Romilly, M.R., and Hatherley, C.

(*y*) *Millington v. Fox*, 3 My. & Cr. 338 (1838), Cottenham, C.

made in ignorance of the plaintiff's right (*x*), is no defence to the claim for an injunction.

Form of
injunction (*c*).

The injunction is sometimes directed generally to restrain the infringement of the plaintiff's trade-marks to which his title is established in the case (*a*), but it is usually expressed with more particularity, to restrain the use by the defendant of such trade-marks, or of marks only colourably differing from them, in connection with goods of the kind for which they are registered, by selling or otherwise disposing of the goods marked with such marks. Sometimes the particular colourable infringement of which the defendant has been proved to have been guilty, is expressly referred to in the order, a general restraint being added. And, in some cases, the form of injunction which seems more appropriate to the unspecialized action for "passing off" is made use of also, the defendants being restrained from "in any other way passing off their goods as those of the plaintiff" (*b*). To avoid a discussion upon a motion to commit for an alleged breach of the injunction, it is obviously advantageous for the plaintiff to combine in the order a particular reference to the form of the infringement which has actually been committed or threatened, with general words, as wide as are obtainable, directed to prevent a colourable evasion of the decree (*c*).

As it is not an infringement to use the plaintiff's mark upon his own goods, that is, goods which possess the attribute connoted by the mark (*d*), the injunction is commonly expressed so as to prevent this being a breach of its terms (*e*).

(*c*) *Moet v. Couston*, 33 Beav. 578 (1864), Romilly, M.R.; *Edelsten v. Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, C.

(*a*) *The Bodega Co. Ltd. v. Riviere*, 6 R. P. O. 243 (1888), Chatterton, V.-C.; *Montgomery v. Thompson*, (1891) A. C., p. 218; 8 R. P. C. 361.

(*b*) *Slazenger and Sons v. Feltham & Co.*, 6 R. P. O. 531 (1889), C. A.

(*e*) See the forms of injunction collected in the Appendix, p. 648, and in Soton, 5th ed., Vol. I., 534.

(*d*) Chap. II., p. 32. And see *Condy v. Taylor*, 56 L. T. 891 (1887), Kekewich, J.

(*e*) Cf. the "passing off" cases;

And in cases where the infringement has been effected by the employment of a word, to the exclusive use of which the plaintiff has no title, the injunction should, it seems, be directed to restrain the defendant from using the word without clearly distinguishing his goods from those of the plaintiff, not to forbid his using it altogether (*f*).

In a case where the plaintiffs refrained from taking proceedings on learning that the defendants had received a small quantity of the infringing goods, but waited until they had got a larger consignment, Malins, V.-C., ordered the injunction to be directed to stop the sale of future consignments only (*g*). It is submitted, however, with great deference, that the calculated conduct of the plaintiffs was not a sufficient reason for allowing the goods already received to be sold under the deceptive labels, although it might well have been an answer to a claim for damages for past infringements. It has certainly been held that acquiescence, not sufficient to bar the plaintiff's right, may, in some classes of actions, cause the Court to refuse relief by injunction, and to grant the plaintiff's damages only (*h*), but the case cited did not involve any continuing fraud or deception (*i*).

The injunction may also be limited with reference to the use of the mark in a particular country or market (*k*),

Injunction directed to future consignments of goods only.

Injunction refused because of acquiescence.

Injunction limited to a particular market.

Siebert v. Findlater, 7 C. D. 801; and *Braham v. Beacham*, 7 C. D. 848, both (1878), Fry, J.

(*f*) *Seixo v. Provezende*, L. R. 1 Ch. (1865), Wood, V.-C., and Cranworth, L.C.; *Johnston v. Orr-Ewing*, 13 C. D. 434; 7 App. Cas. 219 (1880), Fry, J., C. A. and H. L.; and see *Montgomery v. Thompson*, (1891) App. Cas. 217; 8 R. P. C. 361.

(*g*) *The Anglo-Swiss Condensed Milk Co. v. The Swiss Condensed Milk Co.*, W. N. (1871), 163.

(*h*) *Sayers v. Collyer*, 28 C. D.

103, per Fry, L.J. A restrictive covenant in regard to buildings case.

(*i*) The action for infringement may wholly fail, because the defendant has used the plaintiff's mark so long that there is no longer any deception, as in *The Marquis of Londonderry v. Russel*, 2 Times L. R. 843; 3 Times L. R. 360 (1886), Bacon, V.-C., and C. A.

(*k*) *Carver v. Bowker*, Seb. Dig. p. 350 (1877), Little, V.-C.; *Barber v. Manico*, 10 R. P. C. 93 (1893),

for instance, is calculated to deceive there only (*l*), or in a particular manner, as by sending goods marked with it to English ports for shipment to the colonies (*m*).

Interlocutory application for an interim injunction.

The plaintiff in an infringement or "passing off" action usually moves, as soon as the action is commenced, for an interim injunction to restrain the defendant, until the hearing of the action or further order, from continuing or committing the infringement or deceptive conduct of which he complains, either getting leave to serve notice of motion with the writ (*n*), or serving it after the defendant has appeared. In a plain case the motion is, in the first instance, often made *ex parte* for an injunction until the day for which the notice of motion is given; and in a case where the defendant is committing a deliberate fraud, it is important, if possible, to obtain an *ex parte* order before giving him a notice which may lead to the disposal of the spurious goods which he is about to put upon the market.

Balance of convenience.

Where the plaintiff's title is disputed, or the fact of infringement is doubtful, or misrepresentation amounting to a bar to the action, or some other defence is plausibly alleged upon the interlocutory motion, the Court, in granting or refusing the interim injunction, is guided principally by the balance of convenience, that is, by the relative amounts of damage which seem likely to result if the injunction is granted and the plaintiff ultimately fails, or if it is refused and he ultimately succeeds. Thus, in *Read v. Richardson* (*o*), on the defendants undertaking to keep an account, Jessel, M.R., refused an interlocutory injunction; but the Court of Appeal granted it because,

A. L. Smith, J.; see *Société, &c. de l'Etoile's Tm.*, 10 R. P. C. 436; (1894) 1 Ch. 61, Stirling, J.

(*l*) See *Wilkinson v. Griffith*, 8 R. P. C. 370 (1891), Romer, J., and above, p. 204.

(*m*) *Rodgers v. Rottgers*, 5 Times L. R. 678 (1889), Kay, J.

(*n*) O. 52, r. 9.

(*o*) 45 L. T. 54 (1881), (*Dog's*

Head Deer). In *Evans v. Smith*, 3 Times L. R. 390 (1887), Kay, J., refused an interlocutory injunction because it was a serious question whether the plaintiff's registered trade-mark *Montserrat* was a "special and distinctive word." But *quære* whether sufficient weight was given to sect. 76 in this case; see above, p. 304 note (*l*).