

while the defendants had only recently commenced to use their mark, and their trade was admittedly not dependent on it, the plaintiffs had a large trade in connection with which they used the label which the defendants' mark was alleged to infringe, and their rights would have been irremediably and incalculably injured unless the injunction were granted, if their allegation that the defendants' mark was an infringement should be supported and their title to sue should be established at the trial. The defendants' mark had been registered as well as the plaintiffs', and they asserted that the plaintiffs' action was barred because the plaintiffs had, before registration, printed the words "specially registered trade-mark" upon their labels (*p*).

As appears from the cases just cited, it is not necessary for the plaintiff, upon the interlocutory application, to give conclusive evidence as to his title to the mark. If he makes it appear probable that he will succeed at the hearing, that is sufficient, at least, to bring the question of balance of convenience before the Court, and where there is reason to doubt the good faith of the defendant, the Court is more easily induced to interfere (*q*).

The interim injunction will not be granted if the plaintiff has delayed interfering until the defendant has built up a large trade in which he has notoriously used the mark. But a slight use, chiefly upon sales to a few purchasers for their private use, will not prevent the Court from interfering in a case where the plaintiff's trade is considerable (*r*).

Interim injunction refused on account of delay.

(*p*) As to this plea, see above, p. 345. Jessel, M.R., had refused the injunction on the ground of no apparent infringement.

(*q*) *Radde v. Norman*, L. R. 14 Eq. 348 (1872), Wickens, V.-O.

(*r*) *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478 (1881), Chitty, J.,

and C. A. *Apollinis*, used in Germany from 1876, and in England from 1881. *Derby Photographic Dry Plate Co., Ltd. v. Pollard*, 2 Times L. R. 276 (1880), Bacon, V.-O.; *Isaacson v. Thompson*, 41 L. J. Ch. 101 (1871), Bacon, V.-O.

Application
adjourned to
the trial.

Interim
injunction
limited as
closely as
possible;

only granted
on under-
taking as to
damages.

And if no actual infringement is in progress, and no harm is likely to be done, the motion is usually referred to the trial (s).

The interim injunction being intended only to preserve the plaintiff's rights from serious detriment until the hearing is, at any rate in cases which appear to be doubtful or honestly disputed, limited as closely as possible to what is sufficient to attain that end (t). It is only granted upon the plaintiff undertaking to be responsible in damages for the loss (if any) occasioned by it to the defendant, should it turn out at the hearing that it ought not to have been granted (u).

A common form of interlocutory injunction is to restrain a wharfinger or consignee from passing into the market goods alleged to bear spurious marks until the trial or further order (x).

Since registration is *prima facie* evidence of title, and, in the absence of an application to rectify, conclusive evidence after five years, if the plaintiff's mark is registered, but it is desired to dispute his title to it, the defendant's proper course is to apply to expunge the mark under sect. 90 (y). This is the course usually adopted, and a large proportion of the seriously contested trademark cases commence with cross motions for an interim injunction, and to expunge or vary the plaintiff's registered mark.

In a case where the defendant claimed a right to the mark in question, and had applied to register it himself, an interlocutory motion for an injunction by the plaintiff

(s) As in *The Linoleum Manufacturing Co. v. Nairn*, 7 C. D. 834 (1877), Hall, V.-C.

(t) See *The Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478 (1887), Chitty, J., and C. A.

(u) As to the calculation of the damages covered by the undertaking, see *Mansell v. The British Linen Co. Bank*, (1892) 3 Ch. 159.

(x) *Rivero v. Norris* (1868), Seb. Dig. p. 178; Seton, 4th ed., p. 236, Giffard, V.-C.; *Del Valle v. Mayer*, (1870), Seb. Dig. p. 195; Seton, *ibid.*, James, V.-C.

(y) *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478 (1887), Chitty, J., and C. A.; *Read v. Richardson*, 45 L. T. 54, cited p. 352.

Cross motions
for injunction
and to ex-
punge.

was ordered to stand over pending the result of the application (z).

And sometimes, where there is a substantial case to be tried, the application for an interim injunction is ordered to stand over to the hearing upon the defendant undertaking to keep an account of his sales under the mark objected to (a). Undertaking to keep an account.

Breaches of the injunction are contempts of Court, which may be punished by the committal or attachment (b) of the guilty person, or by ordering him to pay a fine or costs. "Committal was the proper remedy for doing a prohibited act, and attachment the proper remedy for neglecting to do some act ordered to be done," but there is now no substantial difference between the two (c). The course usually adopted is to move to commit, the notice of motion being served upon the respondent, or if this is impracticable, leave for substituted service being obtained (d). Enforcement of the injunction.

The order granting the injunction should be forthwith drawn up and served upon the defendant, but no formal service or notice of it is necessary to enable the Court to enforce it. It is sufficient that the defendant or other respondent is shown to have been in fact aware of the order for the injunction having been granted or made to subject him to the risk of committal if he infringes it (e).

The principal question upon an application to commit for breach of an injunction restraining the infringement of a trade-mark is, generally: Does the new mark of the defendant constitute an infringement or not? And it Unintentional breach of the injunction.

(z) *Edwards v. Elkan*, 5 R. P. C. 147; *Harvey v. Harvey*, 26 C. D. 70 (1887), Stirling, J. p. 654; *Evans v. Norton*, (1893) 1

(a) *Mitchell v. Henry*, 15 C. D. Ch. 252.

181 (1880), C. A.; *Apollinaris Co. v. Snook*, 7 R. F. C. 474 (1890), North, J. (d) See the notes to O. 44, r. 1, in the Annual Practice.

(b) O. 42, r. 7, or in the case of a corporation, by sequestration of its property or attachment of its officers, O. 42, r. 31. (e) *Marcovitch v. Bramble, Wilkins & Co.*, Seb. Dig. p. 363 (1878), Malins, V.-C. Annual Practice note to O. 42, r. 7; and see *United Telephone Co. v. Dale*, 25 C. D. 778.

(c) *Callow v. Young*, 56 L. T.

may be assumed that if the Court is satisfied that the defendant has honestly tried to select a mark which is not objectionable, having regard to its order, it will be unwilling to send him to prison because he has failed in his endeavour. But the Court has jurisdiction to commit for disobedience to an order which is not shown to have been wilful (*f*).

Choice of a
new mark by
the defendant.

It may be safely assumed also that in the case just put the Court will be careful not to compel an honest trader to alter his mark more than is necessary to protect the plaintiff's rights. But the following passage from Lord Romilly's judgment, in *Bass v. Dawber* (*g*), goes, perhaps, too far, for the plaintiff is entitled to have the full extent of his right secured to him, without reference to the loss which it occasions to the defendant. "If a person has *bonâ fide* taken a label or trade-mark which does resemble the label of another person, and this is not done with the intention to deceive, the Court will not require him to change it completely, because the change of a trade-mark is a serious thing. . . . It is like beginning a new firm."

In a case where the plaintiff refused to take any notice of a label which the defendant suggested and proposed to adopt in lieu of the label against the use of which the injunction was granted, Langdale, M.R., himself undertook to determine whether the distinction between the labels was sufficient (*h*).

Delay in
application to
commit.

If the plaintiff delays taking steps to enforce the injunction for a considerable time after he knows of the fresh infringement, the delay may cause the Court to refuse to commit; but if the infringement is continuing, it has been said that "there must—in order to deprive the party who has obtained the injunction of the right to move for committal upon the breach of it—be a case made out almost amounting to such a licence to the party enjoined, to do the act enjoined against, as would enable him to maintain a bill against others for doing the act. The party enjoined

(*f*) *Hewitt v. Mansell*, 29 Sol. J. 66.

(*g*) 19 L. T. N. S. 626 (1869),
Seb. Dig. p. 186.

(*h*) *Croft v. Day*, 28 Leg. Obs.

378; Seb. Dig. p. 39 (1844), on a
motion to commit.

“must, I think, show such acquiescence as would be sufficient to create a new right in him” (i). In the case just quoted, the injunction was granted in 1847, the new infringement began in 1848, and was continued until the motion to commit in 1853. The Lords Justices, however, were not satisfied that the plaintiffs were aware of it. Stuart, V.-C., refused the motion on the ground of the delay, but the Lords Justices directed that the defendant should be committed unless, within a week, he suggested, and undertook to use for the future, a mark which the Court should consider satisfactory, and they ordered that he should pay the costs of the motion.

In *Cartier v. May* (k), where the plaintiff delayed moving for fifteen months after the defendant had commenced a new infringement not expressly covered by the injunction, Wood, V.-C., refused to commit the defendant, but ordered him to pay the costs of the application, and enlarged the injunction so as to make it extend to the new fraud.

(ii.) Delivery up of the Marked Articles.

The Court not only forbids further infringement by its injunction, but, where the defendant is proved to have spuriously marked articles in his possession or under his control, it also orders the erasure of the marks (l), or the delivery up of the marked articles for that purpose, or, if erasure is impracticable, for destruction (m). Thus, in

Erasure of
the spurious
marks.

(i) *Per* Turner, L.J., in *Rodgers v. Newill*, 3 D. G. M. & G. 614; 22 L. J. Ch. 404 (1853).

(k) Seb. Dig. p. 111 (1861).

(l) *Dent v. Turpin*, 2 J. & H. 139; 30 L. J. Ch. 495 (1861), Wood, V.-C.; *Upmann v. Elkan*, L. R. 12 Eq. 240; 7 Ch. 130, Romilly, M.R., and Hatherley, L.C., note (p) below.

(m) *Farina v. Silverlock*, 4 K. & J. 656 (1858), Wood, V.-C. The

repealed Merchandise Marks Act of 1862, s. 21, empowered the Court to direct any chattel to which any trade-mark had been fraudulently applied, or which had been exposed for sale with a forged or counterfeited trade-mark applied to it, to be destroyed or otherwise disposed of. The Act of 1887 forfeits every chattel by means of, or in relation to which, an offence under the Act has been committed,

Slazenger v. Feltham (*n*), where the word *Demotic*, an infringement of the plaintiffs' mark *Demon*, was stamped upon the defendants' tennis racquets, the order of Kekewich, J., for the destruction of the racquets, was varied by the Court of Appeal, upon it being pointed out that the spurious mark could be planed off; and it was ordered that the defendants should make an affidavit verifying the number of the racquets, and that they should either deliver up the racquets to the plaintiffs, to be destroyed, or satisfactorily erase from them the name *Demotic*, in the presence of the plaintiffs or their agent.

Interests of innocent persons in the marked goods unaffected.
Lien for costs.

The lien of a wharfinger for his charges in regard to goods deposited with him, including the costs he is put to by being made a defendant in a trade-mark action, is not destroyed if the goods turn out to be spuriously marked (*o*); and although, in some earlier cases (*p*), the plaintiff was adjudged to have a lien upon the goods, subject to that of any wharfinger or mortgagee who had an earlier charge, and who was innocent in regard to the infringement, the Court of Appeal, in the case last cited (*o*), expressed considerable doubt whether such a lien could be supported. Of course, neither the wharfingers nor any other persons interested in the goods would be allowed to sell or dispose of the goods until the spurious marks were removed.

The duty of the bailee of infringing goods.

A wharfinger, transport agent, or other bailee who finds that goods committed to his charge are spuriously marked, therefore, is justified in refusing to deliver them up until the objectionable marks have been erased (*q*). And, further,

to her Majesty, and it contains a power for the Court to order the destruction of the forfeited articles; sect. 2 (3), (4); Book II., Chap. I., pp. 514, 522.

(*n*) 6 R. P. C. 531 (1889), Kekewich, J., and C. A.

(*o*) *Moet v. Pickering*, 6 C. D. 770; 8 C. D. 372 (1877), C. A. reversing Fry, J.

(*p*) *Ponsardin v. Peto*, 33 Beav. 642; 33 L. J. Ch. 371 (1863), Romilly, M.R.; *Upmann v. Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. 130 (1871), Romilly, M.R., and Hatherley, C.

(*q*) *Hunt v. Maniere*, 34 Beav. 157; 34 L. J. Ch. 142 (1864), Romilly, M.R., and L.JJ. Action by indorsee of dock warrants against wharfingers restrained.

he is entitled to an indemnity from the bailor against the damages and costs incurred by him by reason of his dealing with the goods at the latter's request (*r*). His proper course, on being informed by the owner of the trade-mark infringed, or his agents, that goods in his possession are spuriously marked, is to give all necessary information to enable them to stop the infringement, to undertake that the goods shall not be removed or dealt with until the spurious marks have been obliterated, and to give the persons injured all requisite facilities for that purpose (*s*). If he takes this course, the costs of any proceedings subsequently taken against him by the plaintiff will be ordered to be paid to him (*t*); but he must pay the costs of proceedings previously taken, even though in an action commenced without notice to him (*u*), unless the value of the infringing goods in his possession is trifling (*x*).

(iii.) Damages.

It was long ago decided at common law, that the mere proof of an infringement entitles the plaintiff to nominal damages (*y*), and that, consequently, no allegation of special damage is a necessary part of his case (*z*). And the natural consequence of an infringement, even though it be made in complete ignorance of the plaintiff's rights, is that the infringer must pay at least nominal damages, and the costs of action, so that, if he acted under the direction of a third person, he may reasonably compound with the proprietor of the trade-mark on these terms, and claim an indemnity from his employer (*a*).

Nominal
damages.

Indemnity to
agent or
purchaser.

(*r*) *Dixon v. Fawcus*, 3 E. & E. 537; 30 L. J. Q. B. 137 (1861).

(*s*) *Upmann v. Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. 130 (1871), *Romilly, M.R.*, and *Hatherley, C.*

(*t*) Last case, and *Moet v. Pickering*, 6 C. D. 770; 8 C. D. 372 (1877), *Fry, J.*, and *C. A.*

(*u*) See last cases, and *Upmann v. Forester*, 24 C. D. 231 (1883), *Chitty, J.*

(*x*) *American Tobacco Co. v. Guest*,

(1892) 1 Ch. 630; 9 R. P. C. 218, *Stirling, J.*

(*y*) *Blofeld v. Payne*, 4 B. & Ad. 410; 2 L. J. K. B. N. S. 68 (1833).

(*z*) *Rodgers v. Nowill*, 5 C. B. 109; 17 L. J. C. P. 52 (1847).

(*a*) *Dixon v. Fawcus*, 3 E. & E. 537; 30 L. J. Q. B. 137 (1861).

As to implied warranty by the use of a trade-mark, see below, Chap. XVII., p. 432.

Onus of showing substantial damage lies on the plaintiff.

But, if the plaintiff claims substantial damages, the onus of showing that he has incurred them through loss of custom, of trade reputation (*b*), or otherwise, by reason of the defendant's conduct, lies upon him; and it will not be presumed, in the absence of evidence, that the amount of goods sold by the defendant under the fraudulent trade-mark would have been sold by the plaintiff but for the defendant's unlawful use of the plaintiff's mark (*c*). The proper form of an order for an inquiry as to damages occasioned by the infringement of a trade-mark is, therefore, what damage (if any) has the plaintiff sustained (*d*).

If the infringement is a continuing one, the damages ought to be assessed down to the time of the assessment (*e*).

Plaintiff not solely entitled to the mark.

It has been held, that the plaintiff is entitled to the ordinary inquiry as to damages or account of profits, though he is not the only person entitled to the use of the infringed mark (*f*).

(iv.) Account of Profits or Inquiry as to Damages.

When the plaintiff has succeeded in establishing that his trade-mark rights have been seriously infringed, a recurrence of the wrong is forbidden by the grant of an injunction, and by way of redress for the injury, if any appears to have been caused, which has already been occasioned to him, the plaintiff may, in general, make his choice of either an account and payment to him of the profits which the defendant has gained by his wrongful conduct, or an inquiry as to, and payment of, the damages occasioned to the plaintiff by reason of it, that is, unless the case is tried before a jury and damages are assessed

(*b*) *Sykes v. Sykes*, 3 B. & Cr. 541; 3 L. J. K. B. O. S. 46 (1824).

(*c*) *Leather Cloth Co. v. Hirschfield*, L. R. 1 Eq. 299 (1865), Wood, V.-C.

(*d*) *Davenport v. Rylands*, L. R. 1 Eq. p. 308, per Wood, V.-C.

(*e*) O. 36, r. 58.

(*f*) *Southorn v. Reynolds*, 12 L. T. N. S. 75 (1865), Wood, V.-C.; see also *Dent v. Turpin*, 2 J. & H. 139; 30 L. J. Ch. 495 (1861), Wood, V.-C.

by the jury at once, or assessed by the judge sitting alone, acting as a jury.

The account and inquiry are alternative remedies (g), for, though in some of the earlier cases they were both allowed, they are now considered to be inconsistent. "If you take an account of profits, you condone the infringement," Lord Westbury said, in a patent case (h), and the same rule applies in trade-mark cases also.

Account of profits and damages are alternative.

But neither an account nor an inquiry as to damages will be granted if the evidence of sales under the objectionable mark is not sufficient to make it worth while (i), or if it appears that the defendant has only used his mark for a short time (k). For instance, no account or damages was allowed or given in a case where the only infringement proved was by the defendant, at the request of a customer, filling with lime-juice, of his own make, a bottle embossed with the plaintiff's mark, removing the plaintiff's label, and replacing it by his own (l).

Account or inquiry only granted if substantial damage is shown.

Damages can only be recovered, and the profits to be included in the account can only be reckoned, in respect of infringements occurring within six years from the issue of the writ (m).

They only go back for six years;

It has been shown that it is no answer to the claim for an injunction that the infringement was effected innocently, in ignorance of the existence of trade-mark rights; but damages or an account of profits are only calculated as against an innocent dealer in, or purchaser of, the spuriously marked goods, in respect of sales, dealings, or other infringements, if any, of which he is guilty after becoming aware of the plaintiff's rights (n).

and, as against innocent purchasers or bailees, only to notice of infringement.

(g) *Per* Cotton, L.J., in *Leet v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887).

R. P. C. 530 (1887), *Kekewich, J.*

(h) *Neilson v. Betts*, L. R. 5 H. L. 1 (1871); followed in *De Vitre v. Betts*, L. R. 6 H. L. 319 (1872).

(k) *McAndrew v. Bassett*, 10 Jur. N. S. 495 (1864), *Westbury, C.*

(l) *Rose v. Loftus*, 47 L. J. Ch. 576 (1878), *Malins, V.-C.*

(i) *Sanitas Co., Ltd. v. Condy*, 4

(m) *Per* Mellish, L.J., in *Ford v. Foster*, L. R. 7 Ch. p. 633 (1872).

(n) *Edelsten v. Edelsten*, 1 De G.

The case of a manufacturer who copies a mark he finds on goods which he knows are not his own is different. He may not know whose mark it is, and may possibly be in doubt whether it is a trade-mark or not, but he knows that he has no right to the mark, and the damages or account are therefore calculated as against him from the first infringement, within six years of the writ (*o*).

Refused because of delay or acquiescence.

The Court has refused, in some cases, to order an account of profits where the plaintiff has neglected to take proceedings after becoming aware of the infringement (*p*); and it may be assumed that it certainly would not assist the plaintiff to recover profits which he had deliberately allowed the defendant to earn in the expectation of obtaining them from him (*q*). But delay to obtain evidence necessary to establish his case would not bar the plaintiff of his ordinary remedy (*r*), nor, it is submitted, would any reasonable delay in the hope of avoiding litigation after a definite warning to the defendant.

Limited because of misrepresentation.

In a case where there had been some delay, and some amount of misrepresentation in his business, on the plaintiff's part, and the defendant's proper trade was larger than that of the plaintiff's, the account was limited to profits earned since the commencement of the suit, and Mellish, L.J., said that it was a case where a jury would have given forty shillings damages only (*s*).

Form of order for account.

The ordinary form of the order for an account directs an account of the profits made by the defendant in selling or

J. & S. 185 (1863), Westbury, L.C.; *Moet v. Couston*, 33 Beav. 578; 10 L. T. N. S. 395 (1864), Romilly, M.R.; *Ellen v. Slack*, 24 Sol. J. 290 (1880), Jessel, M.R.

(*o*) *Moet v. Couston*, *supra*; *Cartier v. Carlile*, 31 Beav. 292 (1862), Romilly, M.R.

(*p*) *Harrison v. Taylor*, 11 Jur. N. S. 408; 12 L. T. N. S. 339; *Beard v. Turner*, 13 L. T. N. S. 746, both (1865), Wood, V.-C.

(*q*) Cf. *Anglo-Swiss Condensed Milk Co. v. Swiss Condensed Milk Co.* (1871), W. N. 163, Malins, V.-C., cited above, p. 351; *Beard v. Turner*, *supra*.

(*r*) See *Cave v. Myers* (1868), Seb. Dig. p. 181, Giffard, V.-C.; and *Lee v. Haley*, 21 L. T. N. S. 546; L. R. 5 Ch. 155 (1869), Malins, V.-C., and Giffard, L.J.

(*s*) *Ford v. Foster*, L. R. 7 Ch. p. 633 (1872), L.JJ.

otherwise disposing of the goods with the spurious mark or marks which he is proved to have used in infringement of the plaintiff's rights, to be taken by the chief clerk or the official referee, and orders payment of the amount found to be made by the defendant to the plaintiff within a time fixed from the date of the certificate or report (t).

In the case just cited, it was objected that the account should be limited to sales made to persons who bought the goods as and for the goods of the plaintiff, by reason of the use of the infringing mark upon them; but the Court overruled this objection (u). For the mischief done by the spurious marking of the goods is not merely that it is calculated to deceive immediate purchasers from the infringers, but that it puts "a weapon calculated to be fraudulently used by the middlemen" (x) into their hands, by which they may, intentionally or not, deceive the ultimate purchasers.

The costs of the inquiry as to damages or the account of profits, should generally be reserved until the result of the inquiry or account is known (y), at any rate, unless it is clear that it will be of substantial value to the plaintiff; for if no damage or profits are found to have been made (z), or if the proceedings subsequent to the judgment are oppressively conducted by the plaintiff, he ought to pay the costs. But where the defendant had filed a false affidavit greatly understating the number of goods sold, although the account showed that he had made no profit, Chitty, J., said it was a case for investigation, and allowed the plaintiff the costs (a).

Costs of
inquiry or
account.

(t) *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A.; Appendix, p. 652.

(u) See also *Edelsten v. Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, L.C.

(x) *Per Cotton, L.J.*, in *Lever v. Goodwin*.

(y) *Per Fry, J.*, in *Stark v. Midland Rail. Co.*, 16 C. D. 81 (1880), a case of nuisance.

(z) *Tongo v. Ward*, 21 L. T. N. S. 480 (1869), Romilly, M.R.

(a) *Dicks v. Jackson*, 31st March, 1884, cited Sebastian, 3rd ed. p. 255.

7. Costs.

Costs in the discretion of the judge.

Subject to sect. 77a of the Act, which is referred to below, the costs of and incident to an action for the infringement of a trade-mark, as the costs in any other action, are in the discretion of the Court or judge, and the Court or judge has full power to determine by whom and to what extent such costs shall be paid (*b*). Provided that where the action is tried with a jury, the costs follow the event, unless the judge by whom it is tried, or the Court, for good cause, otherwise orders (*c*).

Unsuccessful party usually ordered to pay costs.

The Court or judge in general follows the ordinary rule that the unsuccessful party shall pay the costs of the litigation, such costs being taxed upon the usual scale between party and party; but the discretion conferred by the Act and rule just cited is constantly exercised in trade-mark cases, where the nature of the case, or the conduct of the parties, or of one of them, makes it just that the ordinary practice should be departed from.

Infringer must offer complete redress before action.

An unsuccessful defendant must usually pay costs, although he has only defended a mark which he honestly adopted without being aware of its too great resemblance to the plaintiff's mark (*d*), and though he has acted without fraud and in ignorance of the plaintiff's rights (*e*), and the action has been commenced against him without notice (*f*). But by offering the plaintiff all that he is entitled to, that is, in the case of the innocent holder of spuriously marked goods, an undertaking not to part with them until the spurious marks have been removed (*g*), and all requisite

(*b*) Supreme Court of Judicature Act, 1890, s. (5).

(*c*) O. 65, r. 1.

(*d*) *Blair v. Stock*, 52 L. T. 123 (1884), Kay, J.; cf. the registration cases, *Hyde & Co.'s Tm.*, 7 C. D. 724; *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238 n., both (1878), Jessel, M.R.

(*e*) *Edelsten v. Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, L.C.; *Tonge v. Ward*, 21 L. T. N. S. 480 (1869), Romilly, M.R.

(*f*) *Field v. Lewis*, Seb. Dig. p. 167 (1867), Wood, V.-C.; *Upmann v. Forester*, 24 C. D. 231 (1883), Chitty, J.

(*g*) An innocent consignee or

information to enable him to stop the infringement (*h*) and the payment of the taxed costs (*i*) (if any) already incurred by him in the action, if an action has been commenced, the defendant may escape liability for subsequent costs; and if the plaintiff, after such an offer has been made, commences or continues proceedings against the defendant making it, he will be ordered to pay him his costs subsequently incurred (*k*).

In *Moet v. Pickering* (*l*), where wharfingers with whom the spuriously marked goods had been warehoused in the ordinary course of trade, and who were entitled to a lien for their charges, were added as defendants, and the plaintiffs proceeded to trial against them, the Court of Appeal, reversing Fry, J., ordered that their costs of action should be paid by the plaintiffs. The wharfingers had pleaded that they had no knowledge of the infringement, and that they submitted to act as the Court should direct, upon payment of their charges and costs; but the Court of Appeal regarded this as meaning only that they claimed nothing adversely to the plaintiffs or the infringer. The case does not conflict with the rules stated above, for the plaintiffs had claimed to override the wharfingers' lien by a lien of their own for costs, and this was held to be wrong; and besides, it was clearly unnecessary to have added the wharfingers as defendants or to have proceeded to trial against them, since not only had they made no threat to

bailee may become liable for damages if he sends the spurious goods out of the country, or otherwise puts them beyond the control of the Court. *Upmann v. Elkan*, *infra*.

(*h*) Above, p. 358. The plaintiff is not entitled to the publication of an apology. *Hudson v. Bennett*, 14 L. T. N. S. 698 (1866), Stuart, V.-C.

(*i*) *Burgess v. Hills*, 26 Beav. 244; 28 L. J. Ch. 356 (1858), Romilly, M.R.; *McAndrew v. Bassett*, 33 L. J. Ch. 561; 4 De G.

J. & S. 380 (1864), Wood, V.-C., and Westbury, C.; *Fennessy v. Day and Martin*, 55 L. T. 161 (1886), Bacon, V.-C.

(*k*) *Millington v. Fox*, 3 My. & Cr. 338 (1838), Cottenham, C.; *Moet v. Couston*, 33 Beav. 578 (1864), Romilly, M.R.; *Upmann v. Elkan*, L. R. 12 Eq. 140; 7 Ch. 130 (1871), Romilly, M.R., and Hatherley, C.; *Moet v. Pickering*, 6 C. D. 770; 8 C. D. 372 (1877), Fry, J., and C. A.

(*l*) A similar order was made in *Upmann v. Elkan*, last note.

part with the goods, but after notice of the injunction obtained against the infringer it would have been a contempt of Court for them to do so.

Stay of proceedings.

And where the plaintiff has obtained, or is offered, all that he is entitled to, the Court will stay further proceedings in the action, at the defendant's instance (*m*).

Trivial cases.

And in a trivial case, where an action had been commenced without notice against the innocent purchaser of an inconsiderable quantity of spuriously marked goods, and he at once submitted to do as the Court directed, Stirling, J., refused to give any costs (*n*).

And it is no reason for not giving costs that the defendant is an infant (*o*).

Costs refused because plaintiff claimed too much.

Costs have been refused to a successful plaintiff because he claimed, besides the injunction to which he was entitled, an account to which he was not, against an innocent purchaser of the spuriously marked goods (*p*); and in a similar case, where the plaintiffs set up claims to a copyright in a music tutor, as well as an exclusive right to its title, and failed as to the copyright, they were allowed only half their taxed costs of action (*q*). On similar grounds, plaintiffs have been ordered to pay (*r*), or have been deprived of (*s*), the costs occasioned by allegations which they have failed to prove, although they have succeeded and obtained the general costs of their actions. But where the plaintiff, in an action for infringing his trade-mark and also for "passing off," failed as regards the infringement in respect of some of the goods for which he used, but had not registered, the trade-mark, and

(*m*) *Rudd v. Rowe*, L. R. 10 Eq. 610 (1870), James, V.-C; *Curtis and Harvey v. Pape*, 5 R. P. C. 146 (1888), North, J., (*Diamond Gunpowder*).

(*n*) *American Tobacco Co. v. Guest*, (1892) 1 Ch. 630; 9 R. P. C. 218; cf. *Rose v. Loftus*, 47 L. J. Ch. 576 (1878), Malins, V.-C.

(*o*) *Chubb v. Griffiths*, 35 Beav.

127 (1865), Romilly, M.R.

(*p*) *Moet v. Couston*, 33 Beav. 578 (1864), Romilly, M.R.

(*q*) *Metzler v. Wood*, 8 C. D. 606 (1877), Malins, V.-C., and C. A.

(*r*) *Pierce v. Franks*, 15 L. J. Ch. 122 (1846), Knight-Bruce, V.-C.

(*s*) *Standish v. Whitwell*, 14 W. R. 512 (1866), Wood, V.-C., an affidavit charging fraud.

succeeded as to the rest of the action, and the defendant was held to have been guilty of deliberate infringement in breach of an undertaking previously given by him, Keke-wich, J., refused to deprive the plaintiff of any part of his costs (*t*).

And in a recent case, where an action for infringement and two motions by the defendants, one to expunge the plaintiffs' registration, and the other for an order to the comptroller to register a mark, propounded by the defendants, were tried together, and the action and the second motion failed, but the first motion succeeded, and both parties made unfounded allegations of fraud, North, J., refused to give any costs to either, principally on the ground that it was absolutely impossible for any taxing master to do justice between the parties by distinguishing the costs of one part of the case from another (*u*).

A successful defendant is much more often deprived of his costs than a successful plaintiff, for the plaintiff may fail in his action although the evidence makes it clear that the defendant has acted, or intended to act, dishonestly, and in such a case, although the Court decline to assist the plaintiff, it generally refuses to give costs to the defendant. Successful defendant deprived of costs.

Where, for example, the plaintiff failed because of misrepresentations contained in his trade-mark (*x*), but the defendant had closely imitated the mark, the action was dismissed without costs; and the same course was followed where there was no sufficient proof that the defendant's mark was calculated to deceive, having regard to the long delay of the plaintiff to take proceedings, and the absence of evidence of actual deception (*y*); and in cases where

(*t*) *Jay v. Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888).

(*u*) *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1890); *Jackson v. Napper*, 35 C. D. 162; 4 R. P. C. 162 (1886), Stirling, J.

(*x*) *The Leather Cloth Co., Ltd. v. The American Leather Cloth Co., Ltd.*,

4 De G. J. & S. 137; 33 L. J. Ch. 199; 11 H. L. C. 523; 35 L. J.

Ch. 53 (1863), Westbury, L. C., and H. L. The House of Lords held that there was no infringement.

(*y*) *Rodgers v. Rodgers*, 31 L. T. N. S. 285 (1874), L.JJ.

the action was dismissed, but the Court thought that the defendant's conduct had been uncandid and unfair (z).

So, too, no costs were given where it was proved that the defendant had represented the goods he sold as being those of the plaintiff, although the proof of the plaintiff's title failed (a).

In *The Patent Plumbago Case* (b), however, where the plaintiffs failed on the ground of misrepresentation, but the imitation of their trade-name was clearly made out, the action was dismissed with costs, the plaintiffs having continued to misdescribe their goods as "patent" after a summons taken out at their instance had been dismissed by the magistrate on that ground.

Defendant in
pari delicto.

So, in cases in which the plaintiff fails because he is carrying on a fraudulent trade, and the defendant stands *in pari delicto*, the practice is to dismiss the action without costs (c).

Unfounded
charges of
fraud.

And a successful defendant has also been deprived of costs because he has made an unfounded charge of fraud (d).

Costs of
appeal.

In a recent trade-name case, where the plaintiffs' action was dismissed by the Court of Appeal on the ground that they were not satisfied that the name adopted by the defendants would cause any deception likely to occasion damage to the plaintiffs, costs, both of the appeal and in the Court below, were refused because the Lords Justices believed that the defendants had chosen the name in dispute with

(z) *Estcourt v. The Estcourt Hop Essence Co.*, 31 L. T. N. S. 567; L. R. 10 Ch. 276 (1874), Malins, V.-C., Cairns, C., and L.JJ.; *Maxwell v. Hogg*, 15 L. T. N. S. 204; L. R. 2 Ch. 310 (1866), Stuart, V.-C., and L.JJ.

(a) *Ainsworth v. Walmsley*, L. R. 1 Eq. 518 (1866), Wood, V.-C.; and see *Browne v. Freeman*, (1), 12 W. R. 305 (1864), Wood, V.-C., where the defendant misdescribed

his goods as *The Original Chlorodyne*.

(b) *Morgan v. McAdam*, 36 L. J. Ch. 228 (1866), Wood, V.-C.

(c) *Newman v. Pinto*, 4 R. P. C. 508; 59 L. T. 31 (1887), C. A.

(d) *Humphries v. The Taylor Drug Co.*, 59 L. T. 820 (1888), Kekewich, J.; *Hargreaves v. Freeman*, (1891) 3 Ch. 39; 8 R. P. C. 237, Chitty, J.

the hope of obtaining some illicit advantage from the plaintiff's reputation (e).

But these reasons for depriving the defendant of costs do not apply to the costs of an appeal brought by the plaintiff against the dismissal of his action which fails. Thus, the appeal to the House of Lords in *The Leather Cloth Case* (f), and the appeal to the Court of Appeal in *Newman v. Pinto* (c), were both dismissed with costs. In the former case the plaintiff obtained judgment in the first instance, and when this was reversed on appeal by Lord Westbury no costs were given (g).

The Court or judge may order the costs adjudged to be paid to be taxed upon the higher scale, if special grounds arising out of the nature and importance, or the difficulty or urgency, of the case, appear to exist (h). Such an order was made, by North, J., in *The Great Tower Street Tea Co. v. Smith* (i), where the hearing occupied a long time, and the facts were complicated, and a great number of witnesses were called. But some special reason for the order must be shown, for, although the application is almost always made in heavy trade-mark or patent actions, it is not granted as of course (k); and it is not granted as a punishment (l), or merely because a case of gross fraud is made out (k). That scientific witnesses are necessarily called has been held to be a special reason (m).

(e) *Borthwick v. The Evening Post*, 37 C. D. 449 (1888), C. A.

(f) 11 H. L. C. 523; 35 L. J. Ch. 53.

(g) 4 De G. J. & S. 137; 33 L. J. Ch. 199. This course was taken also in *Borthwick v. The Evening Post*, *supra*.

(h) O. 65, r. 9. See the note in the Annual Practice.

(i) 6 R. P. C. 165 (1889).

(k) *Sanitas Co., Ltd. v. Condy*, 4 R. P. C. 530 (1887), Kekewich, J.

In *Rodgers v. Rottgen*, 5 Times L. R. 678 (1889), Kay, J., said he gave costs on the higher scale very charily.

(l) *Hudson v. Osgerby*, 32 W. R. 566; 50 L. T. 323 (1884), Pearson, J.; and see *Pooley's Trustees v. Whetham*, 33 C. D. p. 120; and *Paine v. Chisholm*, (1891) 1 Q. B. 531, and the cases there cited.

(m) *Ellington v. Clark*, 58 L. T. 818 (1888), C. A.; *The Robin*, (1892) P. 95, Jeune, J.

It is provided by sect. 77 (a) (n) that—

Costs as between solicitor and client.

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

This section corresponds to the provision of sect. 31 of the Act with regard to actions for the infringement of a patent (o).

Certificate that title to trade-mark came in question.

A certificate cannot be granted unless the right to the exclusive use of the trade-mark has, in fact, come in question, and, therefore, it was refused in a case where the defendant's counsel admitted that, upon the failure of the defendant's application to remove the plaintiff's mark from the register, he had no defence to the action (p).

In a case where the Court of Appeal refused an application by the defendant to expunge the plaintiffs' marks, partly on the ground that the defendant was a deliberate infringer, they declined to give the plaintiffs a certificate under the section (q).

The order granting a certificate is not appealable (r).

Costs of motion to rectify in aid of defence.

Similar considerations govern the grant or refusal of costs in respect of the application to rectify the register by expunging or varying the registration of the plaintiff's mark, which is an ordinary incident of the defence in an action for infringement. The usual practice is to give the

(n) Act of 1888, sect. 18.

(o) See Edmunds on Patents, pp. 329 *et seq.* and 487.

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

(q) *Paine & Co. v. Daniells and Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 217, cited p. 313.

(r) *Haslam & Co. v. Hall*, 5 R. P. C. 144 (1888), C. A.

applicant costs, if he succeeds (s); but if the application is made for the purposes of the action by the defendant, and it is doubtful whether he is not acting fraudulently, the costs may be reserved till the trial (t), or may be refused (u).

8. Appeal.

In a case where the defendant desired to appeal against an interim injunction which the plaintiff had obtained, the Court, on his application, and on the ground that the continuance of the injunction would do irreparable damage to his business, advanced the case to the head of the list (x). Appeal advanced.

An application to stay a new trial ordered to take place by the Court of Appeal, pending an appeal against the order to the House of Lords, was refused in *Edge v. Johnson* (y). Stay of order.

In *Burgess v. Burgess* (z), delay for five months in appealing against an order for an interim injunction, where the plaintiff was appellant, seeking to have the scope of the order enlarged, was held to be a bar to the appeal. Barred by delay.

If an appeal is brought, and the defendant succeeds, judgment is entered in his favour, not a non-suit (a); but the Court of Appeal, in dismissing the plaintiff's action, may reserve to him liberty to sue again in respect of any part of his claim. This course was adopted in an action where the plaintiff sought to raise a new case of "passing Non-suit.

(s) *Richards v. Butcher*, (1891) 2 Ch. 522; 8 R. P. C. 37, Kay, J.

(t) *Gianacis' Tm.*, 6 R. P. C. 467; 58 L. J. Ch. 782 (1889), North, J.

(u) *Perry-Davis' Tm.*, 5 R. P. C. 333 (1888), Kay, J.; *Bradley's Tm.*, 9 R. P. C. 205 (1892), Chitty, J. See further Chap. XI., p. 244.

(x) *Lazenby v. White*, L. R. 6 Ch. 89 (1870), James, L.J.

(y) 9 R. P. C. 134 (1892).

(z) 3 De G. M. & G. 896; 22 L. J. Ch. 675 (1853), L.J.J. So also in *Re Palmer's Application*, 22 C. D. 88 (1882), C. A., where the Court had decided against a preliminary objection. The time for appealing against an interlocutory order is now fourteen days. Rules of 1893, O. 58, r. 15A.

(a) *Pinto v. Badman*, 8 R. P. C. 181 (1891), C. A.

off," not set up by the pleadings, at the trial, and was not allowed to proceed with it (*b*).

9. Practice.

Pleadings.

There are no rules as to pleadings which are peculiar to actions for the infringement of trade-marks (*bb*); all that is necessary, therefore, is that the statement of claim, defence, and reply, if any, in any such action, shall respectively contain a statement, in a summary form, of the material facts upon which the party pleading relies for his claim or defence (*c*), giving particulars of the frauds, if fraud is alleged (*d*). What are material facts, having regard to the circumstances of the case, may be gathered from the statement of substantive law, given in the earlier part of the present chapter.

Forms in the Rules of the Supreme Court.

The forms provided by the appendices to the Supreme Court Rules, are set out below. They are, when applicable, and when they are not applicable forms of a like character, and as near as may be to them, to be used for all pleadings; and, where they are applicable and sufficient, any longer forms are to be deemed prolix, and the costs occasioned by such prolixity are to be disallowed, or to be borne by the party so using the same, as the case may be (*e*).

INDORSEMENT ON THE WRIT.

The plaintiff's claim is for damages for wrongfully using (or imitating) the plaintiff's trade-mark.

STATEMENT OF CLAIM.

(1.) The defendant has infringed the plaintiff's trade-mark.

(2.) The trade-mark is (*describe it*). (*If the plaintiff*

(*b*) *Native Guano Co. v. Sewage Manure Co.*, 8 R. P. C. 125 (1888), C. A. and H. L.

(*bb*) Sect. 9 of the Merchandise Marks Act, 1887, provides that in any pleading, proceeding, or document in which any trade-mark or forged trade-mark is intended to be mentioned, it shall be sufficient,

without further description and without any copy or facsimile, to state that trade-mark or forged trade-mark to be a trade-mark or forged trade-mark.

(*c*) O. 19, r. 4.

(*d*) O. 19, r. 6.

(*e*) O. 19, r. 5.

is not the original proprietor of the trade-mark, show shortly how his title is derived.)

(3.) The following acts are complained of, viz. :—
(*Set them out.*)

The plaintiff claims an injunction to restrain the defendant, his servants and agents, from infringing the plaintiff's said trade-mark, and in particular from (*stating any particular injunction sought*).

The plaintiff also claims an account or damages (*f*).

DEFENCE.

- (1.) The trade-mark is not the plaintiff's.
- (2.) The alleged trade-mark is not a trade-mark.
- (3.) The defendant did not infringe.

It will be observed that the form of statement of claim here given does not comprise an allegation that the plaintiff's trade-mark has been registered, or that sect. 77 of the Act has been otherwise complied with; but such an allegation is certainly proper, and, it is submitted, necessary.

Some more elaborate and detailed forms are given in the Appendix (*g*).

The ordinary rule (*h*) that the parties must state the Particulars. facts upon which they rely and which they plead in their pleadings, or in particulars separately delivered, with sufficient particularity to prevent their opponents being taken by surprise at the trial, applies to trade-mark cases.

So where a plaintiff alleged that the defendant's mark was calculated to induce, and had in fact induced, divers persons to purchase the defendant's preparation as and for the goods of the plaintiff, he was ordered to give particulars of the divers persons referred to (*i*).

(*f*) Rules of the Supreme Court, and 7 in the Annual Practice.
Appendix C., sect. 6, Form 5.

(*g*) Pages 343 *et seq.*

(*h*) See the notes to O. 19, rr. 6

(*i*) *Humphries v. Taylor Drug Co.*, 39 C. D. 693; 5 R. P. O. 687 (1888), Kekewich, J.

Discovery.

The ordinary rules (*k*) governing discovery also apply to trade-mark actions (*l*).

Orders for discovery in trade-mark cases modified to prevent abuse.

But a process which enables a rival trader to extract from his opponent information concerning his customers, his trade, and his mode of doing business, is extremely likely to be abused, and in cases where a large trade-mark business is affected, even the ordinary order for discovery of documents upon oath may be very oppressive (*m*). The Court, therefore, will, upon a proper case being shown, modify the ordinary orders so that they shall occasion no more inconvenience to the party to whom they are directed than is necessary to ascertain the rights of his opponent.

Thus, in *Carver v. Pinto Leite* (*n*), it was held that the defendants, in a suit for infringement, who had been ordered to file an affidavit of documents and to produce the documents in the ordinary way, ought not to be ordered to disclose the names of customers, or of persons to or from whom letters referring to the matters in issue were sent or received, inasmuch as such discovery might be used in a manner prejudicial to the defendants in their trade, and was not likely to assist the plaintiffs in making out their case at the hearing.

Disclosure of sales.

Discovery in regard to the sales effected by the defendant under the disputed mark is not, in general, where the infringement is denied, material, until the fact that the

(*k*) O. 31. The Merchandise Marks Act, 1887, provides that nothing in that Act shall entitle any person to refuse to make a complete discovery, or to answer any question or interrogatory in any action: sect. 19.

(*l*) *Orr v. Diaper*, 4 C. D. 92 (1876), Hall, V.-C., demurrer to an action for discovery against shippers, brought in aid of an intended action against the consignors, dismissed.

(*m*) *Wills' Tms.*, (1892) 3 Ch. 201; 10 R. P. C. 269, C. A.

(*n*) L. R. 7 Ch. 90 (1871), C. A. See also *Bendow v. Low*, 16 C. D. 93 (1880), C. A.; and *The Attorney-General v. The North Metropolitan Tramways Co.*, (1892) 3 Ch. 70, North, J. Full discovery was ordered in *Howe v. McKernan*, 30 Beav. 547 (1862), Romilly, M.R., where the defendant was charged with advertising himself as the plaintiff's agent after the agency was determined.

mark is an infringement of the plaintiff's rights has been decided (o); but where the giving of an account would occasion little trouble to the defendant, and might enable the plaintiff to get final judgment at the trial, without further inquiry, the judge, in his discretion, might order it to be given (o). In a case where the questions of fact had been ordered to be tried by a jury, such discovery was refused, before the trial, on the ground that the plaintiff had not elected whether to claim damages or an account of profits if he succeeded (p). After an account of profits has been directed, discovery of the names of the persons to whom the marked goods were sold, or, if this cannot be had, goods which the accounting party cannot swear were not marked with the objectionable mark were sold, may be ordered (q).

Discovery in aid of inquiry or account.

Inspection, &c.

The Court or a judge has wide powers, under Ord. 50, r. 3, to make any order for the detention, preservation, or inspection (r) of any property or thing, being the subject of litigation, and to authorize any persons to enter upon or into any land or building in the possession of any party to the litigation, and, for all or any of the purposes aforesaid, to authorize any samples to be taken, or any observation to be made, or experiment to be tried, which may be

(o) *Benbow v. Low*, 16 C. D. 93 (1880), C. A. See also O. 31, r. 20, and the notes in the Annual Practice thereon. And for the decisions in patent cases, see Edmunds on Patents, p. 308, and *De la Rue v. Dickinson*, 3 K. & J. 388 (1857).

(p) *Fennessy v. Clark*, 37 C. D. 184 (1887), Kay, J., and C. A.

(q) *The Leather Cloth Co., Ltd. v. Hirschfeld*, 1 H. & M. 295 (1863), Wood, V.-C.

(r) Sect. 21 of the repealed Merchandise Marks Act of 1862 gave jurisdiction to order inspec-

tion. As to the powers of justices to issue *search warrants* for goods by means of or in relation to which an offence has been committed under the Merchandise Marks Act, 1887, see sect. 12 of that Act, p. 520. A person charged with an offence under the Act may find it necessary to show that "on demand made by or on behalf of the prosecutor he gave all the information in his power with respect to the persons from whom he obtained such goods or things"; sect. 2 (2), and sect. 6. See Book II., pp. 502, 509, and 511.

necessary or expedient for the purpose of obtaining full information or evidence.

Under this power the Court could, for instance, authorize the plaintiff to inspect goods upon which he showed reasonable grounds for suspecting that a mark infringing his mark had been placed (s).

The application is made in the Chancery Division by motion or summons; in the Queen's Bench Division by summons (t).

Documents referred to in the pleadings, &c.

Production and inspection of copies of the trade-marks or of other documents which are referred to in any of the pleadings or affidavits of any of the parties in a case, may be obtained by giving notice in writing to such party to produce them, unless some cause or excuse for not complying with the notice is shown, which the Court or judge deems sufficient (u).

Evidence.

The comptroller's certificate, and sealed copies of the register.

The registration of the plaintiff's mark, or the refusal to register it, is proved by the production of a certificate under the hand of the comptroller, and the actual terms of the registration, and proof of the mark itself as it is registered, are shown and given by the production of an extract or copy from the register certified by the comptroller and sealed with the seal of the Patent Office (x).

The request for the certificate should be made to the comptroller in writing, stating for what purpose it is required, in the form given in the schedule to the rules (y). It may be sent by post (z). The fee for a certificate for use in legal proceedings is one pound.

(s) Such inspection is frequently authorized in patent cases. See Edmunds on Patents, p. 307; and *Neilson v. Betts*, L. R. 5 H. L. p. 11, *per* Lord Westbury.

(t) See the Annual Practice notes to O. 50, rr. 3 and 6.

(u) O. 31, r. 15. *Smith v. Harris*, 48 L. T. 869 (1883),

Chitty, J. The learned judge refused to order barrels branded with the mark to be produced. See also *Wills' Tms.*, above, p. 242.

(x) Sect. 88, Rule 52, Chap. III., p. 57.

(y) Rule 60, Form S., p. 614.

(z) Sect. 98.

By sect. 89—

“Printed or written copies or extracts, purporting to be certified by the comptroller, and sealed with the seal of the Patent Office, of or from (patents, specifications, disclaimers, and other documents in the Patent Office, and of or from) registers and other books kept there shall be admitted in evidence in all Courts in her Majesty’s dominions, and in all proceedings, without further proof or production of the originals.”

Copies of the register.

And by sect. 96—

“A certificate purporting to be under the hand of the comptroller of any entry, matter, or thing which he is authorized by this Act, or any general rules made thereunder, to make or do, shall be *prima facie* evidence of the entry having been made and of the contents thereof, and of the matter or thing having been done or left undone.”

Comptroller’s certificates.

This section corresponds to sect. 8 of the Act of 1875.

The registered mark is, in practice, usually shown by the production of a copy of the advertisement in the Trade-Marks Journal, leading to its registration, and this is generally accepted as sufficient.

Where the mark is registered, and the plaintiff is the registered proprietor, proof of the registration, and of the identity (if any question as to this is raised) of the registered proprietor with the plaintiff is *prima facie* evidence of the plaintiff’s right to the exclusive use of the mark, and, after five years from the date of the application for registration, is conclusive evidence of his right, until the registration is annulled upon an application under sect. 90 (a).

Proof of title of registered proprietor;

If the plaintiff claims, by devolution or assignment, through the registered proprietor, he must prove the devolution or assignment by giving the proper evidence of the facts which effect it, and must prove in the same way that the goodwill of the business concerned has also devolved upon or been assigned to him (b).

of title by assignment, &c.;

(a) Sects. 75 and 76. See above, p. 364.

(b) Sect. 70, Chap. XIII., p. 272.

of infringe-
ment;

The infringement must be proved by showing that the defendant, his servants, or agents, have dealt in, or threaten, or are about to deal in goods of the kind to which the plaintiff's trade-mark rights extend, in such a manner as to infringe his trade-mark (c).

of probability
of deception.

The nature of the evidence which should be adduced to satisfy the Court that the defendant's mark has such a resemblance to the plaintiff's as to be calculated to deceive, has already been discussed (d). It has been shown that the Court, in general, attaches little weight to the mere statements of opinion by persons who are called as expert witnesses, or, as Fry, L.J., put it, in *Turton v. Turton* (e), as "compurgators," to say that they think there is no probability of deception.

The regis-
trar's books
are not evi-
dence that a
mark is
publici juris.

In *Orr-Ewing v. Johnston* (f), Fry, J., held, that the books kept by the registrar of trade-marks were not evidence, in an action for infringement, to show that marks like the plaintiff's mark were in common use and had been refused registration, and that the plaintiff's mark was consequently *publici juris*. The books were only evidence, the learned judge held, that other persons had made claims. Certified copies of entries on the register are, however, evidence of such entries, and if they show that three or more marks other than, but similar to, the plaintiff's have been registered for the same goods, that would, it is submitted, be evidence that the mark is a common mark (g).

(c) *Ante*, p. 305.

(d) Above, p. 314, and Chap. X., p. 186.

(e) 42 C. D. 149 (1889). See also *Cope v. Evans*, L. R. 18 Eq.

138 (1874), Hall, V.-C.

(f) 13 C. D. at p. 442 (1879).

(g) See the "Three Marks Rule," Chap. X., p. 177.

CHAPTER XVI.

THE ACTION FOR "PASSING OFF."

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Foundation of
the action.

It is an actionable wrong for the defendant to represent, for trading purposes, that his goods or business are the goods or business of the plaintiff, either by direct statements, or by using any of the badges by which the goods of the plaintiff are known to be his, or any badges colourably resembling these, in connection with goods of the same kind, not being the goods of the plaintiff, in such manner as to be calculated to cause the goods to be taken by ordinary purchasers for the goods of the plaintiff. Provided that the defendant may honestly trade under his own name, or under the names of the members of his firm, and may honestly describe his goods, and their place of origin, manner of manufacture, and other characteristics in the ordinary terms current in his trade.

Comparison
with the ac-
tion for the

The action to restrain the defendant from passing off his goods as the goods of the plaintiff, is obviously the

generalized form of the action to restrain the infringement of a trade-mark (a); and the old principles from which the latter action grew up, are still recognized and put into force by the Courts (b). The action for infringement has been specialized, and the proof of the plaintiff's case in it greatly facilitated and simplified by the registration of trade-marks and the provisions of the Acts; but the plaintiff's trade-mark, although the most important, is only one of the badges by which his trade or his goods are, or may be, identified with him; and it is equally a wrong, according to the principles laid down in the judgments quoted in the Introduction, and in the cases last cited, to imitate or copy any of the others—his trade-name or the get-up of his goods, for instance—so as to damage his trade by passing off other goods as his, or by leading his customers to suppose that there is a connection between such other goods and his, which does not in fact exist (c).

infringement
of a trade-
mark.

In a trade-mark action the plaintiff must prove his title to the mark he claims, that it is registered as his mark or as the mark of his predecessor in business, or that sect. 77 has been otherwise complied with, and that the defendant has infringed the mark (d). And, generally, proof of the registration is, at least *prima facie*, proof of title also. Further, if the mark has been actually or substantially copied, that constitutes an infringement, although it is not shown that the copy is calculated to deceive (e). In a passing off action the plaintiff's case is very similar to this, but registration forms no part of it, and the plaintiff must prove by direct evidence that the conduct of the defendant is calculated to pass off the defendant's goods as his; and to do this, he must show either that the defendant has

(a) See Chap. I., pp. 5 and 13, and Chap. XV., p. 297.

(b) See Chapters I. and II. *Leo v. Haley*, L. R. 5 Ch. 155 (1869), Malins, V.-C., and Giffard, L.J.; *Somerville v. Schembri*, 12 App. Cas. 453; 4 R. P. C. 179 (1887) P. C.; *Montgomery v. Thompson*, 41 C. D.

35; (1891) A. C. 217; 8 R. P. C. 361, (*Stone Ales*).

(c) See *Borthwick v. The Evening Post*, 37 C. D. 449 (1888), Kay, J., and C. A., cited below, p. 403.

(d) See the last Chapter.

(e) See p. 312.

actually represented that his goods or business are those of the plaintiff, or—and this is the common case—that he has used certain symbols or badges in connection with his goods or business, which are reputed in the market to import that the goods or business in connection with which they are used are the plaintiff's goods or business. A plaintiff may, therefore, fail to make out a case of infringement of trade-mark rights by failing to prove his title to the trade-mark, or its registration, or that its registration extends to the goods (*f*), or to all of the goods (*g*), in question, or because the registration is ordered to be expunged (*h*), and may yet show that by imitating the mark claimed as a trade-mark, or otherwise, the defendant has done what is calculated to pass off his goods as those of the plaintiff. It follows that a case of "passing off" is generally added as a second string to an action for infringement, and is frequently successful where the trade-mark action proper breaks down (*i*).

Where trade-mark action fails, passing off action may succeed on the same evidence.

The two actions are frequently combined.

Sect. 77 affords no bar to a passing off action.

The Acts, and in particular the definition sections and the sections barring, in certain events, proceedings to prevent or to recover damages for the infringement of unregistered trade-marks (*k*), seem to have been undoubtedly intended to limit and define the classes of symbols which could be appropriated as trade-marks, to restrict the latitude of choice of trade-marks which existed before 1875 (*l*), and to make registration a condition pre-

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

(*g*) *Jay v. Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

(*h*) *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A.; *Montgomery v. Thompson*, 41 C. D. 35; (1891) A. C. 217; 8 R. P. C. 361, C. A. and H. L.

(*i*) See the cases cited in the last three notes. *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, J.; and the judgment of Lindley, L. J., in *Reddaway & Co. v. Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9

R. P. C. 503, C. A., (*Camel Hair Belling*.) See also *Compania Général de Tabacos v. Rehder*, 5 R. P. C. 61 (1887), Kay, J., and *Curtis and Harvey v. Pape*, 5 R. P. C. 146 (1887), North, J., where the trade-mark questions were left undecided.

(*k*) Act of 1875, sect. 1; Act of 1883, sect. 77; see Chap. XII., pp. 255 *et seq.*

(*l*) See the judgment of Cotton, L. J., in *Van Duzer's Tm.*, 34 C. D. p. 624; 4 R. P. C. 31 (1887); and above, p. 263.

cedent to all litigation in respect of subsequently acquired trade-marks corresponding to the trade-mark cases before the Acts; but this intention was not clearly expressed, and the Acts have, in consequence, been construed so as practically to leave a plaintiff in possession of all the rights he would have had if they had not been passed, while greatly facilitating the protection of such trade-marks as may be and are properly registered.

As the cases cited above show, it is no bar to an action for passing off that the trade-name, get-up, or any other of the badges identified with the plaintiff, which are alleged to have been copied or imitated by the defendant, might have been, but are not, registered under the Acts as trade-marks (*m*), even though the evidence is wholly addressed to what may be a mark capable of registration (*n*). Judges have even referred to such unregistered marks as "common law trade-marks" (*n*).

Common law trade-marks.

But a plaintiff who has raised no issue upon his pleadings except in regard to the infringement of his trade-mark, has been refused leave to amend his claim at the trial, so as to start a fresh case of "passing off" in order to save his action (*o*). In the case first cited in the note, however, leave was reserved to the plaintiffs to bring a fresh action to restrain the defendants from passing off their goods as the plaintiffs'. If a charge of fraud is to be made at the trial, it is essential that it should be put forward clearly and prominently on the pleadings (*p*).

New case of passing off or of fraud raised at the trial.

Passing off cases are usually cases of deliberate and

(*m*) See above, Chap. XII., p. 265, and *Great Tower Street Tea Co. v. Langford & Co.*, 5 R. P. C. 66 (1887), Stirling, J.

(*n*) *Reddaway & Co. v. Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; 9 R. P. C. 503, Lindley, L.J.; *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, J.

(*o*) *Native Guano Co. v. Sewage Manure Co.*, 4 R. P. C. 478; 8

R. P. C. 125 (1887), Kay, J., C. A. and H. L. Leave was granted, the defendants not objecting, in *Jay v. Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.; and also in *Barber v. Manico*, *supra*, where the defendants raised the objection.

(*p*) *Leahy, Kelly and Leahy v. Glover*, 10 R. P. C. 141 (1893), H. L.

Proof of fraudulent intention is not essential.

"Property" in trade-names and get-up.

intentional misrepresentation, and they have been referred to in many reported judgments even in recent cases, in which the attention of the Court was not directed to the point, as though fraud were a necessary element of the right of action; but it is well settled that this is not the case (*q*). Proof that the defendant intended to deceive, if his conduct is shown to be calculated to pass off his goods as those of the plaintiff, or to cause them to be so passed off, is no more necessary than in an action for infringement (*r*). And if it were necessary, it would be sufficient evidence of fraud to show that the defendant continued, or sought to continue, to use the deceptive badges or descriptions, after the danger of mistake arising from their use had been brought to his notice (*s*). For it has never been held that innocent inception is a defence (*t*).

It is obvious, therefore, that a trader has much the same right in respect of his trade-name, the get-up of his goods, and all the other distinctive badges and descriptions by which goods are known to be his, as he has in respect of his trade-marks, although the latter right is called a right of property, and the former is commonly, but not invariably (*u*), denied that title (*x*). There are, however, important practical differences between the two rights. A

(*q*) *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 376 (1877), Cairns, L.C., cited above, p. 14; *Johnston v. Orr-Ewing*, 7 App. Cas. 219 (1882); *Singer Manufacturing Co. v. Loog*, 8 App. Cas. 15; *Reddaway v. Bentham*, (1892) 2 Q. B. 639; 9 R. P. C. 503, C. A.; and see the judgments of Cotton, L.J., in *Borthwick v. The Evening Post*, 37 C. D. 449 (1888), and *Turton v. Turton*, 42 C. D. 128 (1889), cited below, p. 421.

(*r*) Chap. XXV., p. 313. This rule seems to have been too well settled to be disturbed by the judgments in *Derry v. Peek*, 14 App. Cas. 337 (1889), although it

originally rested upon that extension of the action of deceit, and analogous actions to cases where there was no intentional deception, which was reprobated in that case.

(*s*) See p. 317, above.

(*t*) *Paine & Co. v. Daniells and Sons' Breweries*, (1893) 2 Ch. 567; 10 R. P. C. 217, C. A.

(*u*) *Clement v. Maddick*, 1 Giff. 98 (1859), Stuart, V.-C.; *Borthwick v. The Evening Post*, 37 C. D. 449 (1887), Kay, J., property in the name of a newspaper.

(*x*) See *per* Lord Blackburn, in *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. p. 400.

trade-mark, being deliberately assumed and invented as a distinctive mark to identify the goods of its proprietor because of its supposed fitness for the purpose, could hardly be adopted by any other trader for similar goods in the same market without its use by him being calculated to deceive. But the other badges and descriptions referred to, although by use they may become more or less identified with the trader who used them first, or most extensively, may have been adopted merely for purposes of convenience or of ornament, and may have been suggested by the circumstances of the trade in question, or of the trader himself; and the same considerations or circumstances may suggest the use of the same badges and descriptions to others also, and their use of them will not necessarily be calculated to deceive. The cases in which a defendant can plead an independent right to the use of badges or descriptions which are not trade-marks—for instance, to the use of the same trade-name as the plaintiff—are much more important than the rare cases in which he can claim a right to use the trade-mark of the plaintiff or a trade-mark closely resembling it (*y*).

It is immaterial to the existence of the plaintiff's right of action that the goods passed off as his are as good or better than his own (*z*); but it would seem that if they are not inferior no case of damage by injury to the plaintiff's trade reputation could be made out.

It will be seen from the definition stated at the beginning of the chapter, and the comparison of the two actions in the preceding pages, that the rules and principles collected in the last chapter, with regard to the action of infringement, in general apply also to the action for "passing off," substituting proof of repute for evidence of title and registration. The defences available, the relief

Inferiority of the spurious goods need not be shown.

Rules and practice of infringement action apply, in general, to passing off action.

(*y*) See *per* Cotton, L.J., in *Turton v. Turton*, 42 C. D. p. 142, and Chap. XV., p. 325.

(*z*) *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.; *per* Lord Blackburn, in *Singer Manufacturing Co. v. Loog*, 4 App. Cas. p. 29.

granted, and the practice and procedure in both actions are the same.

1. Direct Misrepresentation as to Business or Goods.

Where there is a direct representation by the defendant that his own goods are the goods of the plaintiff, by reason of which they are likely to be sold or bought as such, the case presents no difficulty.

No case if the defendant believed that his representation was true.

Thus, in *Ainsworth v. Walmsley* (a), it was shown that the defendant had sold certain spools of thread wound and marked like the plaintiff's thread, with a representation that it was of the plaintiff's make. The defendant asserted that he had himself bought it on a like representation, which he believed, and this assertion was not disproved. The Vice-Chancellor accordingly dismissed the suit, for if the defendant in fact believed that the thread was the plaintiff's thread, he had committed no act of which the plaintiff could complain. Had he known it was not, there would have been a clear case for an injunction. "The use (by one manufacturer) of the name of another manufacturer," the Vice-Chancellor said, "whether *scienter* or not, is an interference with his business which this Court will interpose to prevent, on the ground that the defendant is endeavouring to pass off the goods of his own, or somebody else's, manufacture, as the manufacture of the plaintiff." But, he added, "taking the case most strongly against the defendant, it merely amounts to this, that Walmsley stated to the purchaser, 'I sell you thread which I have bought of Wreford, but which I know to be Ainsworth's.'"

Representation that the defendant's business is that of the plaintiff.

And cases in which the defendant directly represents that his business is the plaintiff's business, or a branch of it, are equally clear as soon as the false representation is made out.

False pretence of a business connection.

A partner or servant who has left a well-known firm and set up a similar business of his own, is entitled to

(a) L. R. 1 Eq. 518 (1866), Wood, V.-C.

advertise his former connection (*b*), unless restrained from doing so by contract with his late partners or employers (*c*); but he must take care to do it so as not to suggest that the connection is still existing between them and him (*d*), or that they have ceased to carry on business and he is their successor (*e*).

And the same rule holds good of a trader who (*f*), or whose trustee in bankruptcy (*g*), has sold the goodwill of his business.

Thus, where the son of the plaintiff quitted his father's employment, and described himself as "late of 107, Strand" (*d*), an injunction was granted to restrain him from continuing to do so. So, in *Scott v. Scott* (*h*), a door-plate, bearing the words "Scott and Nixon, late Robert and Walter Scott," was held to be a representation that Walter Scott had retired, and that Scott and Nixon were carrying on the business of his old firm.

False representation of succession to business.

"Late."

And in a case where no such connection as those referred to had ever existed between the defendants and the plaintiffs, but the defendants, having obtained a lease of clay mines formerly leased to the plaintiffs, described themselves in advertisements, referring not only to the mines, but to certain works also, where they carried on a trade similar to that of the plaintiffs, as *E. and J. Pearson* (late Harpers and Moore); the description was held to be a representation calculated to lead the public to believe that

(*b*) *Clark v. Leach*, 32 Beav. 14; 1 De G. J. & S. 409; 32 L. J. Ch. 290 (1862), Romilly, M.R., and Westbury, L.C.

(*c*) As in *Wolmershausen v. O'Connor*, 36 L. T. N. S. 921 (1877); and *Selby v. The Anchor Tube Co.*, W. N. (1877), 191, both Bacon, V.-C., where the style and goodwill passed, under the articles, to one partner on a dissolution.

(*d*) *Burgess v. Burgess*, 3 De G. M. & G. 896; 22 L. J. Ch. 675 (1853), Kindersley, V.-C., and

L.JJ.; and see p. 323.

(*e*) See the cases next cited, and *Labouchere v. Dawson*, L. R. 13 Eq. 322 (1872), Romilly, M.R.

(*f*) *Churton v. Douglas*, Johns. 174; 28 L. J. Ch. 841 (1859), Wood, V.-C.; *Fullwood v. Fullwood*, W. N. (1873), 93 and 135, Malins, V.-C., and L.JJ.

(*g*) *Hudson v. Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C. See further, as to this, below, p. 417.

(*h*) 16 L. T. N. S. 143 (1866), Wood, V.-C.

Description of new comer as "the old established."

the plaintiffs, Harpers and Moore, had retired from business (*i*). So where the plaintiff and defendant were carrying on business as rival dentists in the same street, and, on the expiration of his tenancy, the plaintiff was compelled to remove, the defendant put up a board describing himself as the "old established dentist," so as to suggest that the plaintiff had removed to his place of business. An interim injunction would have been granted had the defendant not undertaken to put his name very conspicuously upon the board (*j*).

Pretence of agency.

Another description of false representation of a business connection which sometimes comes before the Courts, is where the defendant has pretended to be agent for the sale of the plaintiff's goods (*k*).

Deceptive circulars.

Names over shops.

Executing orders intended for the plaintiff.

The fraud is commonly effected by issuing misleading circulars or advertisements (*l*), or by placing the deceptive name or title on the fascia over the defendant's shop (*m*), and by opening and replying to letters addressed to, or intended for, the plaintiff, and executing the orders contained in them (*n*); or some one or more of these devices.

(*i*) *Harpers v. Pearson*, 3 L. T. N. S. 547 (1860), cited p. 302; *Stevens v. Paine*, 18 L. T. N. S. 600 (1868), Giffard, V.-C.

(*j*) *Mallam v. Davis*, 3 Times L. R. 221 (1887), Stirling, J.

(*k*) *Howe v. McKernan*, 30 Beav. 547 (1862), Romilly, M.R., (discovery ordered); *Wheeler and Wilson Co. v. Shakespear*, 39 L. J. Ch. 36 (1869), James, V.-C., (injunction granted).

(*l*) As in *Purser v. Brain*, 17 L. J. Ch. 141 (1848), Shadwell, V.-C.; *Burrows v. Foster*, 32 Beav. 18 (1862), L.JJ.; *Graveley v. Winchester*, Seton, 4th ed. 257; Seb. Dig. p. 162 (1867), Wood, V.-C., (circulars ordered to be given up); *Stevens v. Paine*, 18 L. T. N. S. 600 (1868), Giffard, V.-C.; *Selby*

v. Anchor Tube Co., W. N. (1877) 191, Bacon, V.-C., (defendants restrained from soliciting or executing orders obtained by the misrepresentations); *Mogford v. Courtenay*, 45 L. T. N. S. 303; *Vernon v. Hallam*, 34 C. D. 748 (1886), Stirling, J.

(*m*) *Foot v. Lea*, 13 Ir. Eq. 484 (1850), Smith, M.R.; *Burgess v. Burgess*, 3 Do G. M. & G. 896; 22 L. J. 675 (1853), Kindersley, V.-C., and L.JJ.; *Scott v. Scott*, 16 L. T. N. S. 143 (1866), Wood, V.-C., (door plate); *Hookham v. Pottage*, L. R. 8 Ch. 91 (1872), Malins, V.-C., and L.JJ.

(*n*) *Schiele v. Brackell*, 11 W. R. 796 (1863), Stuart, V.-C.; *Edgington v. Edgington*, 10 L. T. N. S. 299 (1864), Wood, V.-C., (a single

In the old case of *Clark v. Freeman* (o), Lord Langdale, M.R., refused to restrain the defendant from selling a quack medicine as "Sir J. Clarke's Consumption Pills," at the instance of the Sir J. Clark referred to, who was an eminent physician, on the ground that the plaintiff carried on no business in pill-making, and that the wrong done to him was a libel only, which the Court of Chancery had no jurisdiction to restrain (p). It has always been considered (q) that a narrow view was taken of the facts of this case, as the sale of pills under a well-known doctor's name is eminently calculated to suggest that the pills are prepared according to his directions, and to injure his practice if they do not meet with a favourable reception by purchasers who are, or who might become, his patients; but, in a similar recent case, *Kay, J.*, refused to treat the older authority as no longer law, at least, upon an interlocutory application (r).

Unauthorized use of the name of a non-trader.

2. Imitations of Trade-Name, Get-up, &c.

Actions based upon direct misrepresentation are comparatively rare. The plaintiff's case more commonly is that the defendant has copied or imitated the trade-name, or the get-up, or some other badge or description by which the plaintiff's business and goods are known to be his. Where the charge is one of indirect misrepresentation of this sort, the onus is cast upon the plaintiff, in the first place, to show that the things copied or imitated are reputed in the market to connote a connection between himself or his

The name or get-up must be known as that of the plaintiff or his predecessors whose business he has.

instance proved, injunction refused); *Witt v. Concoran*, 2 C. D. 69 (1873), Bacon, V.-C.

(o) 11 Beav. 112, 17 L. J. Ch. 142 (1848).

(p) As to this see *Bonnard v. Perryman*, (1891) 2 Ch. 269; *Collard v. Marshall*, (1892) 1 Ch. 571, and *Monson v. Tussauá*, 10 Times L. R. 227 (1894).

(q) Lord Selborne said the case had seldom been cited except to be disapproved. *Re Rivière's Tm.*, 26 C. D. 48 (1884). See also *Maxwell v. Hogg*, L. R. 2 Ch. 307 (1867), Lord Cairns; *Springhead Spinning Co. v. Riley*, L. R. 6 Eq. 551 (1868), Malins, V.-C. As to authors' names, see p. 410, below.

(r) *Williams v. Hodge*, 4 Times L. R. 175 (1887).

predecessors in business, and the business or goods in, upon, or in reference to which they are used. And this is precisely the proof which the plaintiff had to adduce in trade-mark actions before the Acts, and, so far as regards matters applied or attached to the goods themselves, it has been considered, and the authorities relevant to it have been collected in a previous chapter (s).

It is not, however, necessary to show that the customers who knew the goods of the plaintiff's firm by a particular name or get-up knew anything whatever about the plaintiff. It is immaterial that they did not even know his name (t); for it is sufficient to prove that purchasers of his goods recognized, by the presence of the marks in question in connection with them, that they were goods of a particular class, and that such class is, in fact, constituted by his goods.

Evidence of
repute.

Where the existence of such repute is not shown, the action cannot succeed (u). Thus, in a case where the plaintiff claimed only as the mortgagee of a business and its trade-name, and had never used, and did not intend to use, the trade-name (x), and in a case in which the plaintiffs were carrying on no business in England (y), the actions were dismissed. But no length of time during which the use of the badges in question by the plaintiff or his predecessors must have extended can be laid down (z), although it seems safe to assume that an actual and practical knowledge of the connection between them and him

(s) Definition of a trade-mark, Chapter II., p. 24; *Lawson v. The Bank of London*, 18 C. B. 84; 25 L. J. C. P. 188 (1856).

(t) *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A., (*Sunlight Self-washer Soap*).

(u) *Goodfellow v. Prince*, 35 C. D. 9 (1887), C. A.

(x) *Beazley v. Soares*, 22 C. D. 660 (1882), Pearson, J.; cf. *Clark*

v. Freeman, ante, p. 389.

(y) *Robineau v. Charbonnel*, W. N. (1876) 160, Malins, V.-C. The plaintiffs were confectioners (*quatre dressmakers*) in Paris, having no agency in England. Held, no probability of injury.

(z) This was stated to be a question for a jury in the old case of *Purser v. Brain*, 17 L. J. Ch. 141 (1848), Shadwell, V.-C., (*The London Manure Co.*).

by a number, apparently considerable, of probable dealers in, or purchasers of, the goods must be shown, and that, therefore, a name, get-up, or other badge just adopted and brought into use, would not be protected, as a newly adopted trade-mark would have been before the Registration Acts (a), and would be now, if registered, under sect. 76.

It has been held that three days' use of the name of a new weekly newspaper, of which fifteen copies had been sold (before the defendant's publication began), was not sufficient to give the owners any right to stop other persons using the same name for a rival paper (b).

The reputed connection must be a connection between the trade or goods, in or upon which the name, get-up, or other badges are used, and the plaintiff himself, or his predecessors as owners of the business in which he is at the time of action, using, or intending to use them. And trade-names may be assigned and may devolve in connection with the goodwill of the business (c). The rules in regard to assign-
 ment already discussed in relation to trade-marks (d), apply, therefore, to trade-names and similar matters, for if the things which the defendant has copied or imitated connote a connection, not with the plaintiff, but with someone else, he can have no claim to sue in respect of the deception which, he alleges, the defendant's use of them is

Assignment
and devolu-
tion of trade-
name, &c.

(a) *Maxwell v. Hogg*, L. R. 2 Ch. 307 (1867), L.J.J.; *Hall v. Barrows*, 32 L. J. Ch. 548 (1863), Romilly, M.R.; *McAndrew v. Bassett*, 33 L. J. Ch. 561 (1864), Wood, V.-C., ante, p. 34.

(b) *Licensed Victuallers' Newspaper Co. v. Bingham*, 38 C. D. 139 (1888), North, J., and C.A.; Cotton, L.J., said, that the larger sale of the plaintiffs' paper subsequently was immaterial; cf. *Maxwell v. Hogg*, supra, and p. 33 above.

(c) "I think it is settled by a series of cases, of which *Hall v.*

Barrows (note (a)) is, I think, the leading one, that both trade-marks and trade-names are, in a certain sense, property, and that the right to use them passes with the goodwill of the business to the successors of the firm which originally established them, even though the name of that firm be changed, so that they are no longer strictly correct"; per Lord Blackburn, in *Singer Manufacturing Co. v. Loog*, 8 App. Cas. p. 33 (1882).

(d) Chap. XIII. p. 272.

calculated to occasion. Thus, in *Pinto v. Badman*, the jury at the trial found upon the same facts that the defendant had infringed the plaintiff's trade-mark, and had passed off his goods as those of the plaintiff. On the appeal it appeared that the label and brand copied by the defendant had, not long before the commencement of the action, been assigned, without the business with which they were connected, by certain third parties to the plaintiff. Upon this ground the Court of Appeal set aside the verdict, and entered judgment for the defendants, notwithstanding the finding as to "passing off" (e). And neither a license to use, nor an absolute assignment of a trade-name without the goodwill of the business to which it was attached, can enable the licensee or assignee to sue to restrain the use of the name by another trader (f).

The question as to repute is not generally considered separately.

The question of repute is, however, rarely considered separately, for, as a right of property in respect of the exclusive use of marks or badges other than registered trade-marks (and, to some extent, the trade-name of the plaintiff) is not recognized, it is generally more convenient to deal directly with the more general question: Is the defendant's conduct calculated to pass off his goods as those of the plaintiff?

The imitation by the defendant of any of the badges by which the plaintiff's goods are known to be his, falls within the scope of the action to restrain passing off; but the most important of these badges are the trade-name of the plaintiff, and the trade-name and the get-up of his goods.

A. The Plaintiff's Trade-name.

A man's own name, or the name under which he trades, may be an ordinary trade-mark, if used as such, that, if

(e) 8 R. P. C. 181 (1891). The case, so far as regards passing off, was not expressly referred to in the judgments, but the principles stated were as applicable to that as to the case for infringement.

(f) *Thorneloe v. Hill*, W. N. (1894) 15, Romer, J., (*John Forrest*). It follows that the mere right to use a name cannot be sold; see below, p. 401.

applied or attached to the goods he deals in (*g*), and if it is "printed, impressed, or woven in some particular and distinctive manner," or in the form of "a written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade-mark," it may be entered upon the register (*h*). But if it is not so used or registered, and it therefore does not become a trade-mark, its use by the defendant for trading purposes in connection with goods which are not the plaintiff's, is obviously calculated to mislead, unless it happens to be the name of the defendant also, or a name under which he is entitled to trade (*i*).

The ground upon which the Court acts in protecting a trade-name was stated by James, L.J., in *Lery v. Walker* (*k*) in the following passage: "It should never be forgotten that in these cases the sole right to restrain anybody from using any name he likes in the course of any business he chooses to carry on is a right in the nature of a trade-mark, that is to say, a man has a right to say, 'You must not use a name, whether fictitious or real—you must not use a description, whether true or not, which is to represent, or calculated to represent, to the world that your business is my business, and so, by a fraudulent (*l*) misstatement, deprive me of the profits of the business which would otherwise come to me.' An individual plaintiff can only proceed on the ground that, having established a business reputation under a particular name, he has a right to restrain anyone else from injuring his business by using that name" (*m*).

Principle on which a trade-name is protected.

(*g*) See Chap. I., p. 24.

(*h*) Sect. 64, Chap. VIII., pp. 114 and 117.

(*i*) See *per Wood*, V.-C., *Ainsworth v. Walsley*, L. R. 1 Eq. 518 (1866), and p. 420, below.

(*k*) 10 C. D. p. 447 (1879).

(*l*) See above, pp. 14 and 384.

(*m*) Cf. Lord Chelmsford's statement in *Du Boulay v. Du Boulay*,

L. R. 2 P. C. p. 441 (1869): "The right to the exclusive use of a name in connection with a trade or business is familiar to our law; and any person using that name after a relative right of this description has been acquired by another, is considered to have been guilty of a fraud, or, at least, of an invasion of another's right, and renders

It may belong to others beside the plaintiff.

The name taken or copied by the defendant need not be that under which the plaintiff alone, and no other person, is properly trading. Thus, in *Dent v. Turpin* (n), Wood, V.-C., held that each of two firms carrying on business separately as watchmakers under the name *Dent*, might sue a third person who set up a similar business under the same name for an injunction, delivery up of the marked articles, and an account of profits.

It need not be the plaintiff's family name.

And, as stated by James, V.-C., in the judgment quoted above, the name need not be the personal name of the plaintiff (o). It need not even be that of a predecessor in business, for a trader may lawfully adopt and trade under any name which is unappropriated for businesses of the same kind, and when the name has become his by repute, he is as well entitled to protection for it as if it were his own (p). A recent case before North, J., is an illustration of this rule. There the plaintiffs made and sold a sauce which, by his permission, they called by the name of one of their servants, "Holbrook's Worcester Sauce." The servant left them and joined the defendants, who thereupon advertised that they had acquired the right to make "Holbrook's Worcester Sauce." It was shown that the sauce sold by the plaintiffs was well known as theirs by the name, and the learned judge held that they had a right to the name in question, and that Holbrook could not sell it to the defendants (q). In this case the sauce was identified by the name with the plaintiffs, and not with Hol-

himself liable to an action, or he may be restrained from the use of the name by injunction"; and *Clark v. Freeman*, cited *ante*, p. 389; see also the judgment of James, L.J., and Jessel, M.R., quoted above, pp. 1 and 13.

(n) 2 J. & H. 139; 30 L. J. Ch. 495 (1861); *Southorn v. Reynolds*, 12 L. T. N. S. 75 (1865), Wood, V.-C.

(o) Cf. "Defences," below, p. 425.

(p) In *Isaacson v. Thompson*, 41 L. J. Ch. 101 (1871), Bacon, V.-C., for instance, the plaintiff traded as *Mme. Louise*.

(q) *Birmingham Vinegar Brewery Co. v. Liverpool Vinegar Co.*, W. N. (1888) 139, an interlocutory injunction was granted; cf. *Dence v. Mason*, W. N. (1877) 23, (1878) 42, Malins, V.-C. (*Brand's Essence of Beef*).

brook; an opposite result would have been reached if the name had been understood to indicate that the latter person was the actual maker of the goods, and that they were his goods of which plaintiffs happened to be vendors (*r*). Thus, in *Franke v. Chappell* (*s*), although the plaintiff had organized series of concerts known as "Richter Concerts" for many years, when Herr Richter made arrangements to conduct the rival concerts of the defendant, it was held that the defendant might rightly advertise their series under the name, since it was understood to mean, not concerts got up by the plaintiff, but anybody's concerts conducted by Richter.

In the case of a company registered under the Companies Act, 1862, it is enacted that (*t*)—

"No company shall be registered under a name identical with that by which a subsisting company is already registered, or so nearly resembling the same as to be calculated to deceive, except in a case where such subsisting company is in the course of being dissolved (*u*), and testifies its consent in such manner as the registrar requires."

The trade-name of a company.

Sect. 20 of the Companies Act, 1862.

And the section further makes provision for a change of the name of any company which, through inadvertence or otherwise, is registered under a name which falls within the prohibition.

As Mr. Buckley points out in his note to the section (*x*), it is to be observed (1) that it only applies to the case of taking the name of a subsisting company already registered, and not to a case like *Hendriks v. Montagu* (*y*), where a new company proposes to register in the name of, or in a name closely resembling, the name of an old-

(*r*) As to joint trade-marks, see p. 301, above.

(*s*) 57 L. T. N. S. 141 (1867), Chitty, J.

(*t*) 25 & 26 Vict. c. 89, s. 20.

(*u*) For example, upon a reconstruction.

(*x*) Buckley on the Companies Acts, 6th ed., p. 24; see also Palmer's Company Precedents, 5th ed., p. 309.

(*y*) 17 C. D. 638 (1881), Jessel, M.R., and C. A.

established company, which is not registered, or of a firm or individual trader (z); (2) that so soon as the new company is registered, the section has ceased to be applicable, so that the old registered company cannot found upon the section any claim for an injunction to restrain the newly registered company from trading in the name; (3) that the Act forbids registration in the same or a similar name, irrespective of the fact whether the business to be carried on under the name is the same or not.

The section is supplementary to the common law.

But the provision of the section is merely in supplement of the ordinary principle upon which the Court acts in protecting trade-names, and that principle is in no way limited by the registration of the name objected to by the plaintiff in any case as the name of the defendant company (a). An injunction will therefore be granted to restrain the defendant from carrying on the same trade as that of the plaintiff under a name so nearly resembling his as to be calculated to deceive, whether it has been registered as the name of the defendant company or not, and, in the latter event, to restrain the defendants also from applying for registration of the name. In *Hendriks v. Montagu* (b), the leading case on the point, the plaintiff, on behalf of the *Universal Life Assurance Society*, sued certain persons who were the promoters of an intended new company, to be called the *Universe Life Assurance Association*, and an injunction in the following form was granted:—

Hendriks v. Montagu.

The injunction granted.

“To restrain the defendants from applying to the registrar of joint stock companies in England, for registration under the Companies Acts, of any company to be incorporated under the name of the *Universe Life Assurance Association*, or any other name likely to mislead or deceive the public into the belief that the company, being incorporated as aforesaid, is the same as the *Universal Life*

(z) *Hoby v. The Grosvenor Library Co., Ltd.*, 28 W. R. 386.

(a) *Merchant Banking Co. of London v. Merchants Joint Stock Bank*,

9 C. D. 560 (1878), Jessel, M.R.

(b) 17 C. D. 638 (1881), Jessel, M.R. and C. A.

“ *Assurance Society*, from issuing or publishing advertisements, circulars, or prospectuses representing that a company is to be incorporated pursuant to the Companies Act, 1862, under the name of the *Universe Life Assurance Association, Limited*, or any such other name as aforesaid; and from carrying on or commencing any business under the name of the *Universe Life Assurance Association, Limited*, or any such other name as aforesaid.”

The Master of the Rolls had refused the first branch of the injunction (as to the application to register), on the ground that no case could be made for granting it except under the section, and that the section did not apply, because the plaintiffs were not a registered company, and he had refused the second and third branches (as to advertising and carrying on business), on the ground that it was not shown that the defendants would carry on the same business as the plaintiffs, or that, if they did, the resemblance of the names must necessarily lead to the unfair appropriation by them of part of the plaintiffs' business; but the Court of Appeal overruled all these objections. The Lords Justices held, that the defendants were shown to have threatened and intended to carry on the same business, and that it was morally certain that, if they did so under the name they had adopted, persons who had heard of the *Universal* would be misled into going to the *Universe*. And this, the Court said, according to the rules of equity, was sufficient, without reference to the Act, to entitle the plaintiffs to the injunction they claimed.

The ground of the interference of the Court is, that the use of the defendant company's name, or its intended name, is calculated to deceive, and so to divert business from the plaintiff to the defendant, or to occasion a confusion between the two businesses. If this is not made out there is no case (c).

And the mere employment of a term which is descrip-

No monopoly allowed in names merely descriptive.

(c) See the cases collected below.

be accepted as sufficient to make out the plaintiff's case (*d*). If it were it would give the first user a monopoly in the term. "If a company which does colonial business cannot call itself colonial, it is obvious that, under a species of assertion that the word colonial is symbolical, the plaintiffs might prevent every other person using it as descriptive of his trade" (*e*).

Cases of company trade-names.

In *The Guardian Fire and Life Assurance Co. v. The Guardian and General Insurance Co.* (*f*), the plaintiff company were a very old-established institution, and were commonly known as *The Guardian* or *The Guardian Assurance Co.*, and the defendant company had been lately formed by the re-construction of the *Guardian Horse and Vehicle Insurance Association*. They had assumed powers to carry on general insurance business, and their offices were near those of the plaintiffs, in Lombard Street. It was shown that there were two other companies doing some insurance business in other parts of London, under names comprising the word *guardian*; but notwithstanding this, Jessel, M.R., held, that the defendants' new name was calculated and intended to deceive, and he would have granted an injunction, had they not undertaken to call themselves the "Guardian Horse, Vehicle, and General Insurance Company."

Injunctions granted.

Injunctions were granted also in *Hoby v. The Grosvenor Library Co., Ltd.* (*g*), where the plaintiff's library was called the Grosvenor Library, and in *The Accident Insurance Co., Ltd. v. The Accident, Disease, and General Insurance Co.*,

(*d*) Cf. the rule against descriptive trade-marks, Chap. II., p. 127; Chap. VIII., p. 127; and as to infringement in similar cases, Chap. X., pp. 201, 202, and below, p. 406.

(*e*) Per Lord Romilly, in *The Colonial Fire Assurance Co. v. The Home and Colonial Assurance Co., Ltd.*, 33 Beav. 548; 33 L. J. Ch.

741 (1864); see also *India and China Tea Co. v. Teide*, W. N. (1871) 241, Jessel, M.R.; and *The Australian Mortgage, Land, and Finance Co. v. The Australian and New Zealand Mortgage Co.*, W. N. (1880) 6, C. A., cited p. 399.

(*f*) 50 L. J. Ch. 253 (1880), Jessel, M.R.

(*g*) 28 W. R. 386.

Ld. (h), where the plaintiff company was popularly known as *The Accident Company* or *The Accident*.

In the following cases injunctions were refused: *London and Provincial Law Assurance Society v. London and Provincial Joint Stock Life Assurance Co. (i)*, although there was evidence that the former company were usually called the *London and Provincial Insurance Co.*; *London Assurance v. London and Westminster Assurance Corporation (k)*; *Colonial Life Assurance Co. v. Home and Colonial Assurance Co., Ld. (l)*; *London and County Banking Co. v. Capital and Counties Bank* (cited in the next case); *Merchant Banking Co. of London v. Merchants Joint Stock Bank (m)*; *The Army and Navy Co-operative Society, Ld. v. The Junior Army and Navy Stores, Ld. (n)*; *Australian Mortgage Land and Finance Co. v. Australian and New Zealand Mortgage Co. (o)*. In *Bamstead v. The General Reversionary Co., Ld.*, an interlocutory injunction was refused, because, although the defendant company had adopted a name resembling that of the company of which the plaintiff was secretary, the General Reversionary and Investment Co., yet there was no probability of deception because the former was a small Liverpool concern, and the latter a very large London one (*p*).

Injunctions refused.

In the recent case of *Tussaud v. Tussaud (q)*, an unsuccessful *Tussaud v. Tussaud.*

(*h*) 54 L. J. Ch. 104 (1884), Pearson, J.; see also *Wolmershausen v. G. S. Wolmershausen & Co., Ld.*, W. N. (1892) 87, Chitty, J.; and *Saunders v. The Sun Life Assurance Co. of Canada* (1894) 1 Ch. 537; 10 Times L. R. 183, Stirling, J.

(*i*) 17 L. J. Ch. 37 (1848), Shadwell, V.-C.

(*k*) 32 L. J. Ch. 664 (1862), Stuart, V.-C.

(*l*) 33 Beav. 548; 33 L. J. Ch. 741 (1864), Romilly, M.R.

(*m*) 9 C. D. 560 (1878), Jessel, M.R.

(*n*) Seb. Dig. p. 393 (1879), Jessel, M.R.

(*o*) W. N. (1880) 6, C. A., James, L.J., said: "The difficulty in these cases was, that while the business name of another could not be appropriated, a man could not, on the other hand, give himself any monopoly in a name which, as in this case, merely described the nature of the business or the locality of its operations"; see above, p. 397.

(*p*) 4 Times L. R. 621 (1888), Stirling, J.

(*q*) 44 C. D. 678 (1890), Stirling, J.: *Rendle v. Rendle*, 63 L. T. 94 (1890), Kay, J., is a somewhat similar case.

cessful attempt was made by the defendant to shelter himself under the general exception to the principle stated at the head of this chapter, that anyone may honestly trade under his own name, which is discussed more fully below (*r*). In that case the plaintiffs, Madame Tussaud and Sons, Limited, were the owners of a waxwork exhibition originally founded by a Madame Tussaud, and subsequently carried on by the father and uncles of the defendant. Their business, according to the evidence, was often referred to as *Madame Tussaud's*, and, not infrequently, as *Tussaud's* only. The defendant, who was a wax modeller by trade, was promoting a company to be called *Louis Tussaud, Ltd.*, to open and carry on a waxwork exhibition under that name in Shaftesbury Avenue, the plaintiffs' exhibition being situated in the Marylebone Road. He was to be engaged as manager of the exhibition, and modeller of the exhibited figures. He had never carried on, and did not possess the goodwill of, any business in any such exhibition.

The judgment
of Stirling, J.

It follows, Stirling, J., said, in his judgment in this case, "from the decisions in *Burgess v. Burgess* (*s*) and *Turton v. Turton* (*t*), that the defendant is at perfect liberty to open on his own account, and to carry on in his own name an exhibition of waxworks. Further, he might take partners into his business, and carry it on under the name *Louis Tussaud & Co.* That seems to me to have been expressly decided in *Turton v. Turton*. Having commenced business on his own account, I apprehend that he might sell it with the benefit of the goodwill to third parties, and that the third parties might, if they thought fit, continue to carry on the business under the same name—that of the defendant; that is to say, they would be entitled to the full benefit of the goodwill which they had honestly and legitimately purchased from the defendant. Again, the

(*r*) Page 420.

(*s*) 3 D. M. & G. 896; 22 L. J. Ch. 675 (1853), Knight-Bruce and

Turner, L.JJ., cited p. 423.

(*t*) 42 O. D. 128 (1889), C. A., reversing North, J., cited p. 421.

“third parties might transfer the business and the goodwill to a joint stock company, and (without expressing a final opinion on the point) I am not prepared at present to say that that company might not be registered under the same name as had previously been used in connection with the business” (u).

But the defendant could not, the learned judge held, sell the right to use his name in connection with a business which he had never carried on, and in which he had no interest whatever, or in which he stood simply in the position of a paid servant (x). And the proper inference to be drawn from the facts of the case *prima facie* was, he concluded, that the object of the defendant in promoting the proposed company was to induce the world to believe that the business intended to be carried on was that of the plaintiff company or a branch of it, notwithstanding that the prospectus issued by the defendant plainly stated on the face of it that the new exhibition had no connection with the plaintiff company. An interim injunction in the terms of that in *Hendriks v. Montagu* (y), set out above, was accordingly granted.

Right to use a name cannot be sold.

A trader has the same rights in respect of the name of the house, shop (z), or factory (a), where he carries on his trade or business, as he has in respect of his trade-name. He can,

Name of business, house, or factory.

(u) 44 C. D. p. 687.

(x) Cf. *The Birmingham Vinegar Brewery Co. v. The Liverpool Vinegar Co.*, *supra*, p. 394; and *Warner v. Warner*, 5 Times L. R. 327, 359 (1889), Stirling, J., and C. A., (*Warner's Cure*); and see below, p. 425.

(y) *Ante*, p. 396.

(z) *Hudson v. Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C., (*Osborne House*); *Boulnois v. Peake*, 13 C. D. 512 n. (1868), Giffard, V.-C., (*The Carriage Bazaar*); *Bodega Co. v. Owens*, 6 R. P. C. 236; 7 *ib.* 31; 23 L. R. Ir. 371 (1889),

Chatterton, V.-C., (*Bodega Wine Shop*). A number of American decisions are cited by Mr. Sebastian, 3rd ed., p. 294. In *Charleston v. Campbell*, 4 Sess. Cas. 4th ser. 149, an injunction to restrain the use of the “Royal Station Hotel,” at the instance of the proprietor of the “Station Hotel,” was refused.

(a) *Braham v. Beachin*, 7 C. D. 848 (1878), Fry, J., (*Radstock Colliery*); *Montgomery v. Thompson*, 41 C. D. 35 (1891), A. C. 217; 8 R. P. C. 361, Chitty, J., C. A., and H. L., (*Stone Brewery*).

therefore, support an action for passing off, and obtain an injunction by showing that the name of the house, &c., has a reputed connection with his trade or business or goods, and that the defendant, without having any independent right to do so (*a*), is using for business purposes a name which is calculated to cause his trade, business, or goods to be taken for, or to be confounded with, the plaintiff's (*b*). There is no right to the exclusive use of the name of a mere private house (*c*), and no cause of action arises where, although the defendant has adopted, for business purposes, an address likely to be confused with that of the plaintiff, yet the businesses of the parties are so different that no damage can result to the plaintiff's trade (*d*).

B. The Trade-name of the Plaintiff's Goods.

A name which is applied or attached to a trader's goods when they are offered for sale, so as to distinguish them from similar goods, and to identify them with him, or with his successors as the owners of a particular business, as being made, worked upon, imported, selected, certified, or sold by him or them, is a trade-mark (*e*). And if it is within any of the classes enumerated in sect. 64 it may be registered as a trade-mark. But whether the name is applied or attached to the goods, so as to conform to the definition just stated, or is registered as a trade-mark or not, if it is in fact known in the market as the distinctive name of the goods of a particular trader, it is an actionable interference with his rights to sell or deal in goods of the kind for which the name has acquired such significance, not being his goods, under the name in question, if such

(*a*) As in *Mason v. Queen*, 23 Scot. Law Rep. 641, where the defendant, as tenant of a railway company, who had bought the plaintiff's hotel, re-opened it as the "Old Waverley," the plaintiff, on the sale, having moved his business to another building.

(*b*) See note (*z*) on preceding page.

(*c*) *Day v. Brownrigg*, 10 C. D. 294 (1878), C. A.

(*d*) *Street v. Union Bank of Spain and England*, 30 C. D. 156 (1885), Pearson, J.; the plaintiffs were advertising agents, (telegraphic cypher).

(*e*) Chap. II., p. 25.

use of the name is, as it almost necessarily must be, calculated to pass off the goods sold or dealt in as his goods.

The acquisition of a trade-name by the use of it in connection with the plaintiff's goods has already been considered, and the authorities bearing on the subject have been collected in the chapter on the definition of a trade-mark. It will be sufficient, therefore, to summarize shortly the results deduced from the reported cases.

The qualified right in the trade-name,—a right to prevent a defendant from passing off his goods as those of the plaintiff by the use of it,—exists only with regard to goods of the kind for which the plaintiff uses it, and to which the connection with his business indicated by the name extends (*f*). So, where the proprietors of *The Morning Post* sought to restrain the publishers of a new evening newspaper from calling their paper *The Evening Post*, the Court of Appeal thought there was no probability of the defendant's paper being taken for the plaintiff's, or being taken to have any connection with it so as to cause damage to the plaintiffs, and they accordingly dismissed the action (*g*).

Right restricted to particular goods.

The Evening Post Case.

And anyone may use the name in connection with goods which are in fact the goods of the plaintiff (*h*).

The name may be used on the right goods.

It is the essence of the plaintiff's case that the use of the name should be understood in the market to imply that the goods sold or dealt in under it are the plaintiff's goods (*i*).

It must be distinctive of the plaintiff's goods;

In *The Two D. Case* (*j*), Herschell, L.C., said, the founda-

(*f*) Page 31; and cf. the rule in respect of the infringement of trade-marks, Chap. XV., p. 308.

(*g*) *Borthwick v. The Evening Post*, 37 C. D. 449 (1888), C. A., overruling Kay, J.; but see *Re The Australian Wine Importers, Ltd.*, 41 C. D. 278; 6 R. P. C. 311 (1889), Kay, J., and C. A., where a mark for wine was refused registration, as too closely resembling a mark for spirits, and the Court left open the question whether its use would amount to infringement or

passing off; and other cases, cited above, p. 180. Injunctions were granted in *Walter v. Emmott*, 54 L. J. Ch. 1059 (1885), C. A. (*The Morning Mail*) and *Reed v. O'Meara*, 21 L. R. Ir. 216 V.-C. (*The Grocer*).

(*h*) Pages 32 and 309; and *Ainsworth v. Walmsley*, L. R. 1 Eq. 518 (1866), Wood, V.-C., cited p. 386.

(*i*) Page 35.

(*j*) *Leahy, Kelly and Leahy v. Glover*, 10 R. P. C. p. 155 (1893), H. L.

tion of a passing off case "is that the party alleging it should prove, in the first instance, that any name which he claims as his trade-name has been so extensively used in connection with his manufacture or with the goods which he sells, that his goods have come to be known in the market by that name; that anyone using that name would intend to refer to his goods; and that anyone to whom the name was used would understand that his goods were referred to."

not the mere name of the goods.

Hence the critical question of fact in cases under this head is often whether a word or term is the distinctive name of the plaintiff's goods, or the name of anybody's goods of the kind (*k*), like *Liebig's Extract* (*l*), *Chlorodyne* (*m*), *Linoleum* (*n*), *Wellington Boots*, *Gladstone Bag*, and *Hansom Cab*, or a mere description of the goods, denoting only their pattern (*o*), mode of manufacture (*p*), or sale (*pp*), ingredients (*q*), or place of origin (*r*), or the use for which they are intended.

Descriptive names may have a second-

Words and terms which *prima facie* are merely descriptive in the sense just explained may, however, acquire by

(*k*) See pp. 36 and 201 *et seq.*

(*l*) *Liebig's Extract of Meat Co., Ltd. v. Hanbury*, 17 L. T. N. S. 298 (1867), Wood, V.-C.; *Liebig Co. v. Anderson*, 55 L. T. 206 (1887), Chitty, J.

(*m*) *Broune v. Freeman*, (1) 12 W. R. 305 (1864), Wood, V.-C.; (2) W. N. (1873) 178, L.JJ.

(*n*) *Linoleum Manufacturing Co. v. Nairn*, 7 C. D. 834 (1878), Fry, J.

(*o*) *Ford v. Foster*, L. R. 7 Ch. 616 (1872), L.JJ., (*Eureka Shirts*); *Hirst v. Denham*, L. R. 14 Eq. 542 (1872), Bacon, V.-C.; *Harrison's Tm.*, 42 C. D. 691; 7 R. P. C. 25 (1889), Kekewich, J.

(*p*) *Singer Manufacturing Co. v. Wilson*, 2 C. D. 434; 3 App. Cas. 376 (1875); *Id. v. Loog*, 18 C. D. 395; 8 App. Cas. 15 (1877); *Id. v. Spence & Co.*, 10 R. P. C. 297 (1893), Romer, J., (*Singer System, Singer*

Sewing Machines), cited *ante*, p. 38.

(*pp*) *Symington v. Footman*, 56 L. T. 696 (1885), Kay, J. (*Guaranteed corset*).

(*q*) *Massam v. Thorley's Cattle Food Co.*, 14 C. D. 748 (1880), C. A.

(*r*) *McAndrew v. Bassett*, 4 D. G. J. & S. 380; 33 L. J. Ch. 561, (*Anatolia Liquorice*); *Seixo v. Provezende*, L. R. 1 Ch. 192 (*Seixo Wine*); *Wotherspoon v. Currie*, 5 L. R. H. L. 508, (*Glenfield Starch*), all cited pp. 45 and 46; see also *The Reading Biscuit Case, Huntley & Palmer v. The Reading Biscuit Co., Ltd.*, 10 R. P. C. 277 (1893), Chitty, J.; and *The Rugby Portland Cement Case, Rugby Portland Cement Co., Ltd. v. The Rugby and Newbold Portland Cement Co.*, 8 R. P. C. 241; 9 R. P. C. 46 (1891), V. Williams, J., and C. A.

use and reputation a secondary distinctive meaning (s), so that, although no longer treated as trade-marks proper, even where they are used as such, and not admitted, unless as old marks, to registration under the Acts, they may be practically monopolized for use in connection with certain classes of goods by a particular trader, since their employment by anyone else would be calculated to deceive (t). “I take it to be clear from the evidence,” Lord Westbury said, in *The Glenfield Starch Case* (u), “that long antecedently to the operations of the respondent, the word *Glenfield* had acquired a secondary signification or meaning in connection with a particular manufacture—in short, it had become the trade denomination of the starch made by the appellants. It was wholly taken out of its ordinary meaning, and in connection with starch had acquired that peculiar secondary signification to which I have referred. The word *Glenfield*, therefore, as a denomination of starch, had become the property of the appellants.”

secondary distinctive meaning.

This is well illustrated by the recent case of *Reddaway & Co. v. Bentham Hemp Spinning Co.* (v), in which the Court of Appeal ordered a new trial on the ground that there was evidence that the use of the expression *Camel Hair Belting* by the defendants was calculated to pass off their goods as the goods of the plaintiffs.

The name of the inventor or first introducer of goods which are new to the market, or the name which he gives to those he manufactures or sells, is very readily adopted as the name of goods by whomsoever they are made; and in the case of goods made under a patent, the Court is careful not to extend the patentee's monopoly by forbidding other manufacturers, after the patent has expired, to sell goods lawfully made by them according to its specification under the only name by which they are known (x).

Name of introducer or patentee.

(s) Chap. II., p. 36.

(u) See note (r), p. 404.

(t) See the cases cited in the last three notes, and *Montgomery v. Thompson*, 41 C. D. 35; (1891) A. C. 217; 8 R. P. C. 361, (*Stone Ales*).

(v) (1892) 2 Q. B. 639; 9 R. P. C. 503. See the Pleadings, Appendix, p. 646.

(x) See Chap. II., p. 42.

In *James v. James* (y), Romilly, M.R., said that any one who was possessed of the secret of an invention might make the goods according to it, and might sell them under the name of the inventor after his death, but might not sell them in his lifetime, so as to suggest that they were made by him. But the distinction here suggested was questioned by James, L.J. (z), in a later case, for the death of the inventor would not necessarily prevent the use of his name being calculated to pass off the goods of others, as goods manufactured in the business lately carried on by him, if his successors were continuing it, and, on the other hand, during his lifetime, if there was no monopoly in the manufacture, anyone might state that the goods were made according to his system. It is material also to remember that the name of the first maker or inventor is often understood to imply the good quality of work or materials which has brought the new goods into favour rather than the mode of manufacture or the nature of the ingredients employed (a). Where this is the case the use of the name by traders who have no connection with him must almost always be calculated to deceive.

Names may become *publici juris*.

On the other hand, names which once carried a distinctive reference to a particular trader may, in consequence of successful piracies, or of their use by the trader himself for goods which are the goods of others, or are put forward as such (b), or for other reasons, lose it and fall into common use and become *publici juris* (c), in the same way as trade-marks may be lost or abandoned.

Mere use of descriptive word.

No case of passing-off can be made out, therefore, merely by showing that the defendant has adopted and

(y) L. R. 13 Eq. 421 (1872), (*Lieutenant James' Horse Blister*).

(z) *Massam v. Thorley's Cattle Food Co.*, 14 C. D. p. 754 (1880).

(a) See the last case; and cf. the use of "original," above, p. 44.

(b) *Wood v. Butler*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A., (*Eton Cigarettes*).

(c) Chap. II., p. 37; and Chap. XIV., p. 283.

used a descriptive or other "open" word previously used by the plaintiff (*d*).

A word, or other particular, forming part of a registered label or other trade-mark, and which the plaintiff has disclaimed as a condition of registration, is necessarily open, for the plaintiff cannot, it would appear, be heard to allege that it forms a distinctive mark (*e*). The same rule does not hold good of a word or particular which has been expunged from the register without the plaintiff's assent, for the removal of the mark does not prevent the plaintiff from showing that the mark is, nevertheless, distinctive of his goods. It has already been shown that a trade-mark which has never been registered, or which has been removed from the register, may be the basis of a passing off case (*f*). *The John Bull Beer Case* (*g*)—in which the Court of Appeal assumed that the plaintiff's action must fail if his trade-mark were expunged from the register, although it was brought, not only in respect of infringement, but also in respect of passing off—is not in conflict with this, for the only matter which led the Court to think the defendants' conduct was calculated to pass off their goods as those of the plaintiffs, was the use by the former of a label, bearing the words *Registered* and *John Bull*, whereas, in fact, the only registered John Bull mark was that of the plaintiffs.

Disclaimed
word.

Expunged
trade-mark.

(*d*) *Kelly v. Byles*, 13 C. D. 682 (1880), Bacon, V.-C., and C. A., (*Post Office Directory*); *Schove v. Schmincke*, 33 C. D. 546 (1886), Chitty, J., (*Castle Album*); *Great Tower Street Tea Co. v. Smith*, 6 R. P. C. 165 (1889), North, J., (*Tower Tea*); *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J., (*Washerine*); *Rugby Portland Cement Co., Ltd. v. Rugby and Newbold Portland Cement Co.*, 8 R. P. C. 241; 9 R. P. C. 46 (1891), V. Williams, J., and C. A.,

(*Rugby Portland Cement*); and cf. Chap. X., p. 201; and *The Colonial Fire Assurance Co. v. The Home & Colonial Assurance Co., Ltd.*, ante, p. 398.

(*e*) *Rosenthal v. Reynolds*, (1892) 2 Ch. 301; 9 R. P. C. 189, North, J., (*W. R. Corsets*), interim injunction refused, ante, p. 203.

(*f*) Above, p. 282; Chap. XII., p. 265.

(*g*) *Paine & Co. v. Daniells & Sons' Breweries Co., Ltd.*, (1893) 2 Ch. 567; 10 R. P. C. 217.

Use of common word by defendant may be an element in a get-up case.

But an open, that is to say, a non-distinctive word, or open words, may be an important element in the plaintiff's labels, and the use of the same word or words by the defendant in the same manner, especially if coupled with the use of other details of "get-up" which are similar to those which the plaintiff uses, may be strong evidence to support a passing off case based upon imitation of get-up (*h*).

This was pointed out by Wood, V.-C., in *Woollam v. Ratcliff* (*i*), where, in commenting upon *The Omnibus Case* (*k*), he said, "the words *Conveyance Company*, the green omnibus, &c., were held sufficient together to entitle the plaintiffs to an injunction. The defendant might have had those words painted on a yellow omnibus without objection, and so of the other resemblances; the wrong lay in their accumulation, not in any one of them alone."

Mere honest description of the defendant's goods.

As personal names which are adopted as trade-names or trade-marks are subject to the inconvenience that they may lawfully be used by anyone who, in using them, is only honestly trading in his own name (*l*); so a trade-name which is *prima facie* geographical, or otherwise descriptive, is subject to a similar interference by its honest and proper use by persons other than the owner of the trade-name. Thus, in *Braham v. Beachin* (*m*), the plaintiff, being owner of all the collieries in Radstock, except a very small one, traded as the "Radstock Coal Co.," and the defendants began to sell coal under the same name, and also as "The Radstock Colliery Proprietors." An injunction was granted, "to restrain the defendants, unless and until they shall acquire a colliery

(*h*) As in *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A., (*Sunlight Self-Washer*, and *Goodwin's Self-Washing Soap*); and see the report of Lord Herschell's Committee on disclaimed additions, Chap. IX.,

p. 165.

(*i*) 1 H. & M. 259 (1863).

(*k*) *Knott v. Morgan*, 2 Keen, 213 (1836), Lord Langdale, M.R., and Cottenham, L.C.

(*l*) Below, p. 420.

(*m*) 7 C. D. 848 (1878), Fry, J.

“or coal mine within the parish of Radstock, from trading under, or using, the name or style of ‘The Radstock Colliery Proprietors,’ or any other name or style signifying that the defendants or either of them are proprietors of any colliery or collieries at Radstock.” Subsequently the defendants acquired a colliery, but not in Radstock, and began to trade as “The Radstock Coal and Waggon Co., Colliery Proprietors, Radstock, Somerset,” and a motion to commit for breach of the injunction was refused on the ground that the terms used by them did no more than imply that they were proprietors of collieries, and that their place of business was at Radstock, and this was true (n). So, in *The Whitstable Oyster Case* (o), where it was held that the name “Whitstable Native Oysters” meant the plaintiffs’ oysters, and could not be fairly used of French oysters relaid and brought to maturity at Whitstable; the learned judge said, the plaintiffs’ right in respect of the name was subject to the inconvenience that the name might honestly be used by anyone to describe real Whitstable natives, whether the plaintiffs’ oysters or not.

It may, perhaps, be doubted whether the decision in *The Radstock Colliery Case*, and the dicta just referred to, are quite consistent with the judgments delivered in the House of Lords, in *The Stone Ales Case* (p), where, although the right of the appellant to state that his beer was brewed at Stone was recognized, it was held to be subject to an obligation not to do so in any manner calculated to cause the appellant’s beer to be passed off as that of the respondents, which was commonly known as *Stone Ale*, and the learned lords were clearly of opinion that the obligation would prevent the appellant from using the last-mentioned term at all.

(n) Seb. Dig. p. 633 (1878), Fry, J. to restrain the use of *native*.

(o) *Free Fishers of Whitstable v. Elliot*, 4 Times L. R. 273; W. N. (1888) 27, Stirling, J., injunction (1891) A. C. 217; 8 R. P. C. 361.

(p) *Montgomery v. Thompson*,

Author's
name.

An author can restrain the publication under his name of books which are not written by him, on the same principles as a trader can obtain an injunction to protect his trade-name, or that of his goods (*q*). And, further, it has been held that the writer of a work can maintain an action against the owner of the copyright for the damage occasioned to his reputation by the publication of a new edition of the book, purporting to be prepared by him, but in fact not so prepared (*r*). But in the case of a serial publication, the purchaser of the goodwill of the business of conducting it—sometimes, but erroneously, called the copyright in the publication—is at liberty to publish subsequent numbers under the old name after determining his business relations with the author or editor of earlier numbers, and notwithstanding that the name is that of the first editor or author (*s*).

Title of book.

Titles of books, newspapers, or other publications (in regard to which no copyright can exist (*t*)), are also protected on the same principles, that is, as trade-names, and no cause of action arises, therefore, unless it is shown that the title is known to indicate the plaintiff's book or paper, so that its use by the defendant would be calculated to lead to deception (*u*).

(*q*) *Lord Byron v. Johnson*, 2 Mer. 29 (1816), Eldon, L.C.; cf. *Barnard v. Pillow*, W. N. (1868) 94, Romilly, M.R. (music); and *Martin v. Wright*, 6 Sim. 297 (1833), Shadwell, V.-C., copy of work of diorama painter.

(*r*) *Archbold v. Sweet*, 1 M. & R. 162; 5 C. & P. 219 (1832), Lord Tenterden, C.J.

(*s*) *Ward v. Beeton*, L. R. 19 Eq. 207 (1874), Malins, V.-C., (*Beeton's Christmas Annual*); cf. *Condy v. Mitchell*, 37 L. T. N. S. 766 (1877), C. A., (*Condy's Fluid*); a late editor would be restrained from advertising that a serial is discontinued;

Bradbury v. Dickens, 27 Beav. 53; 28 L. J. Ch. 667 (1859), Romilly, M.R., (*Household Words*).

(*t*) *Dicks v. Yates*, 18 C. D. 76 (1880), Bacon, V.-C., and C. A., (*Splendid Misery*); *Licensed Victuallers' Newspaper Co. v. Bingham*, 38 C. D. 139 (1888), North, J., and C. A. (*Licensed Victuallers' Mirror*).

(*u*) *Shove v. Schmincke*, 33 C. D. 546 (1886), Chitty, J., (*Castle Album*); *Borthwick v. The Evening Post*, 37 C. D. 449 (1888), Kay, J., and C. A.; and cases in the last note.

C. Imitation of Get-up.

The general appearance of a trader's goods as they are presented to purchasers is often the most important of the signs by which the goods are recognized as his, and an imitation of it frequently affords the readiest means by which a fraudulent rival, and fraudulent retail dealers in collusion with him, can pass off his goods as the goods of the other. The cases falling under this head are almost necessarily cases of deliberate fraud, for such similarity of "get-up" as is calculated to deceive is the result, as a rule, of a resemblance, more or less close, in a number of corresponding details, and this can hardly happen by accident or coincidence. In effect, if the get-up of the defendant's goods appears, on first inspection, to closely resemble that of the plaintiff's, and it is shown that it has recently been adopted by him, the only explanation, consistent with honest conduct, that can ordinarily be given is, that the leading features of the get-up, as the square tin box covered in yellow paper, bearing red and black letters, for the mustard trade (*x*), are common to the trade in question.

Get-up common to the trade.

What is compendiously called the "get-up" of goods—the dress in which they are presented to the buyer (*y*)—comprises, in particular, the size and shape of the packages, where the goods have no definite outline, or none which is shown to the buyer, the material, colour, and decoration of their wrappers, and the lettering and arrangement of their labels. Thus, in *Lever v. Goodwin* (*z*), the plaintiffs sold their soap in packets wrapped up in a peculiar parchment paper, with *Sunlight Self-washer* printed in spaced type upon the wrapper; the defendants began to use similar packets and

(*x*) See *Farrow's Tm.*, 7 R. P. C. 260; 63 L. T. 233 (1890), *Stirling, J.*

(*y*) In *Knott v. Morgan*, 2 Keen, 213 (1836), Langdale, M.R., and Cottenham, L.C., the fraud consisted in the imitation of the painting of

the plaintiff's omnibuses, the uniforms of their servants, and the use of their descriptive title—the London Conveyance Co.

(*z*) 36 C. D. 1; 4 R. P. C. 492 (1887), *Chitty, J.*, and C. A.

paper, with the words *Goodwin's Self-washing Soap* printed upon it in similar type. It was treated as an obvious case of fraud (a).

No monopoly in the constituent elements.

"Looking at the two tablets," Cotton, L.J., said, "one cannot but see that there is a strong general resemblance between them, and especially in the eyes of people who cannot read. But (the defendants') contention was this: there is no trade-mark in *Self-washer* or *Self-washing* (b); there is no monopoly in this parchment paper; there is no monopoly in the spaced printing; then why should we be restrained, in carrying on business, from using those things as to which the plaintiffs cannot claim any monopoly? That is an obvious fallacy. There may be no monopoly at all in the individual things, but if they are so combined by the defendants as to pass off the defendants' goods as the plaintiffs' then the defendants have brought themselves within the old common law doctrine in respect of which equity will give to the aggrieved party an injunction to restrain the defendants from passing off their goods as those of the plaintiffs" (c).

Imitation of part of get-up.

It is not, however, necessary that every part of the get-up should be imitated, for, though no exclusive right to the use of any single feature of it which is not a registered trade-mark is recognized, yet a part of the get-up, a picture, for instance, which is used on the label or wrapper, may be shown to be so identified with the plaintiff's goods that its use for similar goods is calculated to pass them off as his. The picture, in effect, may become—as the trade-

(a) Imitations of the descriptive and commendatory inscriptions, and of the directions for use printed on the covers of patent medicines and proprietary articles are very common; *Franks v. Weaver*, 10 Beav. 297 (1847), Langdale, M.R.; and *Massam v. Thorley's Cattle Food Co.*, 14 C. D. 743 (1880), C. A., are instances.

(b) It had been struck off the

register on the defendants' application.

(c) *Blofield v. Payne*, 4 B. & Ad. 410; 2 L. J. K. B. N. S. 68 (1833), imitation of envelope; *Great Tower Street Tea Co. v. Langford & Co.*, 5 R. P. O. 66 (1887), Stirling J., of packets; *Hammond v. Brunner*, 9 R. P. C. 301 (1892), Chitty, J., of label; *Stephens v. Peel*, 16 L. T. N. S. 145 (1867), Wood, V.-C., of bottle, and *Steel-pens for Stephens*.

name of the plaintiff's goods may—a "common law trade-mark" (*d*).

Thus, in *Jay v. Ladler* (*e*), the plaintiff used the device of a lady and a bear, in his trade as a furrier, by attaching it to the wrappers and boxes in which he sent out his goods, but he had registered it only as a trade-mark for sealskin mantles and coats. The defendant began to issue a circular, bearing a similar mark, in connection with his trade, which was also that of a furrier. Two injunctions were granted, one, restricted to the mantles and coats, to restrain infringement of the trade-mark, the other, not so restricted, to restrain the defendant from using the device so as to deceive the public.

And, on the other hand, the imitation of a number of things, each of which is in itself not distinctive of the plaintiff's goods, may make a strong case on account of the cumulative effect of the detailed resemblances (*f*).

3. Use in Connection with the Defendant's Goods.

The spurious badges must be used in connection with goods which are not the plaintiff's, but they need not be stamped or printed upon them or their envelopes. The fraudulent trade-names, for instance, in most of the cases where injunctions have been granted, were used as descriptions of the defendants for general purposes, and in their advertisements and circulars (*g*), or were placed over their shop doors (*h*). In *Jay v. Ladler* (*i*), the deceptive repre-

Name, &c.
need not be
attached to
the goods.

(*d*) Above, p. 383.

(*e*) 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.; see also *Hart v. Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J.; and *Great Tower Street Tea Co. v. Langford & Co.*, 5 R. P. C. 66 (1887), Stirling, J.; and see p. 408 above.

(*f*) See the judgment in *Lever v. Goodwin*, quoted above; and *per Wood, V.-O.*, in *Wollam v. Rad-*

cliff, 1 H. & M. 259, cited *ante*, p. 408.

(*g*) See the injunctions in *Hendriks v. Montagu*, 17 C. D. 638; and *Massam v. Thorley*, 14 C. D. 748; Appendix, p. 650.

(*h*) *Burgess v. Burgess*, 3 De G. M. & G. 896; 22 L. J. Ch. 675.

(*i*) 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

sentation was effected by sending to the defendant's customers a circular inclosing a print of a design resembling the plaintiff's distinctive design. The action extends to every kind of representation which is calculated to pass off the defendant's goods as the plaintiff's.

4. Probability of Deception.

Where deception is intended.

The Court must be satisfied that the defendant's conduct is calculated to pass off other goods as those of the plaintiff, or, at least, to produce such confusion in the minds of probable customers or purchasers as would be likely to lead to the other goods being bought and sold for his (*k*). This is the foundation of the action.

But if it is shown to have been intended to deceive in this way, the Court will not generally push the inquiry further (*l*).

Badges of fraud:
unexplained similarities;
colourable differences;

The existence of unexpected and unexplained similarities (*m*) between the goods of the defendant and those of the plaintiff, or of similarities which have been modified by colourable differences (*n*) or by differences and distinctions so arranged as to escape notice (*o*); the use by the defendant of descriptions, which, as applied to himself or his own trade, are inaccurate, and by reason of their inaccuracy approach more nearly to the proper description of the plaintiff (*p*), and the gradual approximation of the defendants' names, get-up, or description to those of the plaintiff (*q*), are all obvious badges of fraudulent intention

gradual approximation.

(*k*) *Hendriks v. Montagu*, 17 C. D. 638 (1881); see *per James*, V.-C., p. 646.

(*l*) "Why should we be astute to say that (the defendant) cannot succeed in doing what he is straining every nerve to do"? Lindley, L.J., asked, in *Slazenger v. Feltham*, 6 R. P. C. p. 538 (1889).

(*m*) *Taylor v. Taylor*, 2 Equity, 230; 23 L. J. Ch. 255 (1854). Wood, V.-C.

(*n*) *Slazenger & Sons v. Feltham & Co.*, 6 R. P. C. 551 (1889), C. A., (*Demon, Demotic*).

(*o*) e.g., "*late of*," &c., in small letters, Chap. XV., p. 322.

(*p*) *Holloway v. Holloway*, 13 Beav. 209 (1850), Langdale, M.R.

(*q*) *Boulnois v. Peake*, 13 C. D. 513 n. (1868), Giffard, V.-C., *Carriage Repository* changed to *New Carriage Bazaar*; *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478 (1887),

frequently recurring in the cases which come before the Court (*r*).

Instances of actual deception need not be proved if the Court is otherwise satisfied of the probability of deception (*s*); and on the other hand, they are not necessarily conclusive where they have occurred, in cases, for example, where their number is comparatively insignificant (*t*).

The question what resemblance is calculated to deceive, and the modes of comparison adopted, have been sufficiently considered in the preceding chapters (*u*).

5. Proof of Damage.

Proof of damage is not in every case essential to enable the plaintiff to maintain his action, for if he shows that the defendant is acting so as to pass off goods which are not the plaintiff's as his, it will generally be assumed that the plaintiff is thereby prevented from selling as many of the goods as he otherwise would. But if this assumption is negatived by the circumstances of the case, proof of actual or probable damage is necessary (*x*). For the assumption of a name (*y*), or an address (*z*), similar to the name or address of the plaintiff, without malicious intent, although it may cause annoyance and inconvenience to him,—for

C. A., (*Apollinis*); *Sanitas Co., Ltd. v. Condy*, 4 R. P. C. 195, 530; 56 L. T. 621 (1886), Kay, J., (*Condi-Sanitas*).

(*r*) See further, p. 322.

(*s*) See the last chapter, p. 316.

(*t*) *Civil Service Supply Association v. Dean*, 13 C. D. 512 (1879), Malins, V.-C.; *Borthwick v. The Evening Post*, 37 C. D. 449 (1888), C. A.; *Leahy, Kelly, & Leahy v. Glover*, 10 R. P. C. 141 (1893), H. L.

(*u*) Chap. XV., p. 314; Chap. X., p. 183; see also *Goodfellow v. Prince*, 35 C. D. 9 (1887), C. A., (plaintiff and defendant both mere importers); *Bodega Co. v. Owens*, 6 R. P. C. 236; 7 R. P. C. 31; 23 L. R. Ir. 371

(1889), Chatterton, V.-C., (defendant called his wine-shop in Belfast *Bodega*; plaintiff had no *Bodega* shop in Ireland outside Dublin); and the cases in the last note.

(*x*) So that a non-trader has no action, *ante*, p. 308; *Delondre v. Shaw*, 2 Sim. 237 (1828), Shadwell, V.-C.

(*y*) *Borthwick v. The Evening Post*, *supra*; *Du Boulay v. Du Boulay*, L. R. 2 P. C. 430.

(*z*) *Day v. Brownrigg*, 10 C. D. 294 (1878), C. A.; *Street v. Bank of Spain and England*, 30 C. D. 156 (1885), Pearson, J., adoption by the defendants (bankers) of the same cypher telegraphic address as that of the plaintiff.

instance, by delaying his letters,—is not actionable, unless it is shown to be calculated to injure him in his trade. And no action lies at the suit of any private individual for deception practised upon the public, unless it incidentally causes, or is calculated to cause, damage to him as an individual; if this is not the case, the wrongdoer can only be punished through the criminal law, or in a civil action on information brought in the name of the Attorney-General (*a*).

6. Defences.

The defences, other than a simple denial of the acts alleged, which are commonly set up, may be tabulated as follows: that—

- (1.) The name, or other badge, which the plaintiff charges the defendant with having imitated, carries no distinctive reference to the plaintiff's goods.
- (2.) The defendant has an independent or a concurrent right to use them (*b*).
- (3.) The name or other badge which the defendant is using, is not such, or is not so used, as to be calculated to pass off other goods for those of the plaintiff (*c*).
- (4.) 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 (*d*) (other than those next alluded to); (*b*) acquiescence (*e*); (*c*) delay (*f*); (*d*) deceptive use of the name or badges he relies on, or because his trade is fraudulent (*g*).

(*a*) *Per* Cotton, L.J., in *The Native Guano Co. v. The Sewage Manure Co.*, 8 R. P. C. p. 128 (1891); see also *Clark v. Freeman*, and *Williams v. Hodge*, cited above, p. 389; *Batty v. Hill*, 1 H. & M. 264 (1863), Wood, V.-C., false pretence of award of gold medal.

(*b*) See, as to the right to use a man's own name, p. 420; and as to the right to honestly describe

the place of origin, &c. of his goods, p. 408; and, further, the last chapter, "infringement," pp. 325 *et seq.*

(*c*) Above, p. 414; and Chap. XV., p. 314.

(*d*) Page 330.

(*e*) Page 332.

(*f*) Page 333.

(*g*) Page 346.

(1.) This is a traverse of part of the plaintiff's case. It may take the form of an allegation that the name or other badge is merely descriptive (*h*). If so, the defence falls under the second head also. Denial of repute.

(2.) This defence is discussed below. The most important case is the right of any man, apart from restriction by contract, to trade honestly under his own name. That right is, of course, an answer only to a case which rests wholly upon an alleged imitation or adoption of the trade-name which the plaintiff is using. Concurrent right.

(3.) This defence also is a mere traverse. It has been considered already (*k*). Denial of deception.

(4.) The defences collected under the fourth head are precisely analogous to those discussed in the last chapter; they depend on the same considerations, and are governed by the same rules (*l*). Estoppel.

Concurrent Right.

The defendant may have as good a title to use the name or other matters in question as the plaintiff has to use that with which it or they are, as he alleges, likely to be confused. For instance, on the dissolution of a partnership, in the absence of special agreement, and unless the firm name is sold with the goodwill, as it may be (*m*), each partner has an equal right to use it, if he continues to carry on the same business as that of the late firm (*n*). Partners after dissolution.

It is convenient to note here, in passing, that the purchaser of the goodwill of a business, or a partner succeeding to it under agreement upon dissolution of partnership, has a right to use the trade-name under which it was con- Purchaser of goodwill.

(*h*) Above, pp. 406 *et seq.*

(*k*) Note (*c*), above.

(*l*) See *Reed v. Richardson*, 45 L. T. N. S. 54 (1881), C. A. (*Dog's Head Beer*).

(*m*) *Hall v. Barrows*, 4 Do G. J. & S. 150; 33 L. J. Ch. 204 (1863), Westbury, L.C.; and see Lindley

on Partnership, 5th ed., p. 445.

(*n*) *Banks v. Gibson*, 34 Beav. 566; 34 L. J. Ch. 591 (1865), Romilly, M.R.; *Levy v. Walker*, and *Chappell v. Griffiths*, *infra*; and see further on this subject, Sebastian, 3rd ed., p. 289.

ducted (*o*). And this, even though it comprise the personal name of a late partner (*p*), or of any other late owner of the goodwill, but not so as to cast any risk of liability upon the late owner (*q*) or his late partners by using their personal names in such manner as to represent that they are still members of the firm (*r*).

Trader may use his own name after the sale of his business, where no contrary agreement;

But where the goodwill of a business is sold, or is taken over on the dissolution of a partnership by agreement, without any restrictive condition being imposed upon the late owner or the retiring partner which restrains him from exercising his ordinary right, he is at liberty to start in the same trade again at once under his own name, so long as he uses it honestly, even though it be the same as, or be similar to, the name under which the old business was, and continues to be, carried on (*s*). The case most commonly arises after a sale, by the trustee in bankruptcy of a trader, of the goodwill of the debtor's business (*t*), for a careful

(*o*) *Levy v. Walker*, 10 C. D. 436 (1879), C. A.

(*p*) *Condy v. Mitchell*, 37 L. T. N. S. 268, 766 (1877), Bacon, V.-C., and C. A. (*Condy's Fluid Co.*); *Chappell v. Griffith*, 53 L. T. N. S. 459 (1885), Kay, J.

(*q*) *Chatteris v. Isaacson*, 57 L. T. N. S. 177 (1887), Kekewich, J. The vendor of the business of "Mme. Elise" agreed that the purchaser should have the exclusive right to use the name "Mme. Elise & Co." Mme. Elise was his wife's name. Held, the purchaser must use the addition "& Co."

(*r*) *Dickson v. McMaster & Co.*, 18 Ir. Jur. 202 (1866), Brady, C.; *Scott v. Rowland*, 26 L. T. N. S. 391 (1872), Wickens, V.-C.; *Gray v. Smith*, 43 C. D. 208 (1889), C. A.; *Thynno v. Shore*, 45 C. D. 677 (1890), Stirling, J. There can be no risk where the late partner is dead, *Webster v. Webster*, 3

Swan. 490 (1791), Thurlow, L.C.; see Lindley on Partnership, 5th ed., p. 446.

(*s*) *Churton v. Douglas, Johnson*, 174; 28 L. J. Ch. 841 (1859), Wood, V.-C.; *Johnson v. Helleley*, 34 Beav. 63; 34 L. J. Ch. 32, 179; 2 De G. J. & S. 446 (1864), Romilly, M.R., and L.J.J.; *Labouchere v. Dawson*, L. R. 13 Eq. 322 (1872), Romilly, M.R. The decisions in this case and in *Mogford v. Courtenay*, 45 L. T. N. S. 303 (1881), Fry, J., that the vendor must not solicit the old customers to trade with him, are now overruled; *Pearson v. Pearson*, 27 C. D. 145 (1884), Baggallay and Cotton, L.J.J., Lindley, L.J., dissenting; *Vernon v. Hallam*, 34 C. D. 748 (1886), Stirling, J.

(*t*) *Cruttwell v. Lye*, 17 Ves. 335 (1810), Eldon, L.C.; *Hudson v. Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C.

purchaser would hardly consent to buy the goodwill of a business from its owner without stipulating for the exclusive use of the trade-name; but the trustee in bankruptcy has no power to contract on the debtor's behalf, so as to restrict the right of the debtor to trade under his own name (*u*).

"It has been settled," James, V.-C., said, in *Hudson v. Osborne* (*x*), "that there is no implied covenant of any kind in the sale by an individual himself of the goodwill of his business; but it seems to be settled that a trader, whose business, and the goodwill of whose business, have been sold by himself, or by any person deriving title under him, has no right to represent himself as carrying on that identical business; he has no right to use the trade-marks which were the marks of that business, or, by the use of the name, or of a title of the firm, to represent himself as being the continuer of that identical business which has been sold." If the restriction stated in the last sentence of the quotation covers, as it appears to, the mere honest use of the trader's own name, it is, according to other decisions, too widely expressed (*y*). But it is clear that the late owner or partner must do nothing, other than such honest use of his own name, calculated to suggest that he is carrying on the old business (*z*).

but not represent that his business is the old business, or its successor.

Thus, in *Churton v. Douglas* (*a*), a partner who had sold his share in the business of "John Douglas & Co." to his co-partners, who continued to trade as "Churton, Bankart, and Hirst, late John Douglas & Co.," was restrained from trading as "John Douglas & Co." The question whether a late partner, or other late owner of a business which has passed into the hands of the plaintiff, is representing that he is still carrying it on, or that his present business is its successor, or is only fairly working and advertising the

(*u*) *Walker v. Mottram*, 19 C. D. 355 (1881), C. A.

(*x*) *Supra*, note (*t*).

(*y*) See the next division of this chapter.

(*z*) As to the use of the word

"late," see above, p. 322.

(*a*) Note (*s*); *Will v. Concoran*, 2 C. D. 69 (1873), Bacon, V.-C., is a similar case. *Benbow v. Low*, 44 L. T. 875; 29 W. R. 837 (1881), Bacon, V.-C.

latter business as his own, is often one of great nicety (b). The case of *Mogford v. Courtenay* (b), probably falls very near the line. There the partnership between the parties having expired by effluxion of time, and the goodwill passing under the partnership articles to the plaintiff, but without any restrictive covenant binding the defendant not to use the firm name or any similar name, the defendant was restrained from issuing a circular to the old customers stating the fact of dissolution, and that he had joined a new firm, and asking the customers for a "continuance" of their custom. This was held to be a suggestion that he was about to carry on, not merely a similar business, as he lawfully might, but the identical business which had passed to the plaintiff.

The right to Trade under one's own Name.

Anyone may honestly trade under his own name.

The most important limitation of the principle stated above is the rule that a man may honestly trade under his own name, or the names of himself and his partners, even though their similarity to the name under which other persons have been previously carrying on business in the same trade may occasionally cause his goods, or his firm's goods, to be passed off for theirs.

"All the Queen's subjects have a right to sell (their goods)," Knight-Bruce, L.J., said, in a suit between father and son (c), "in their own names, and not the less that they bear the same name as their father"; but, he added, "if any circumstance of fraud had accompanied, and were continuing to accompany, the case, it would stand very differently."

And where a man named Warner bought a business in a medicine, at the time known as Ashton's Gout and

(b) 45 L. T. N. S. 303 (1881), *Fearson v. Fearson*, 27 C. D. 145.
 Fry, J. The decision that the defendant might not solicit the old customers is, as already stated (p. 418, note (c)), not now law; *(c) Burgess v. Burgess*, 3 De G. M. & G. 896; 22 L. J. Ch. 675 (1853), *infra*.

Rheumatic Cure, and proceeded to sell his goods as *Warner's Cure*, in imitation of a well-known and widely advertised medicine called *Warner's Cure*, or *Warner's Safe Cure*, the Court of Appeal said that no injunction could be granted unless it were shown that the defendant was making a fraudulent use of his name (d).

The subject was recently fully discussed by the Court of Appeal in the important case of *Turton v. Turton* (e). In that case the plaintiffs, Thomas Turton and Sons, Limited, were carrying on a widely known and extensive business acquired by the company in 1886, but established many years previously, under the name of *Thomas Turton and Sons*, in Sheffield, and one of the trade-marks of the company bore that name upon it. The defendants, John Turton and his two sons, were carrying on a business of a similar description in the same town. Their business had also been established for many years, although not for so long as that of the plaintiffs. For ten years before June, 1888, its style had been *John Turton & Co.*, but John Turton then took his sons into partnership, and changed the style to *John Turton and Sons*, the name the plaintiffs complained of. There was evidence that the plaintiff company were often referred to as *Turton and Sons*, and *Thomas*, or *T. Turton and Sons*, and there were conflicting affidavits by persons engaged in the trade as to whether the distinction between the trade-names was sufficient to prevent mistakes being made. It was also shown that letters intended for the plaintiffs had, in some instances, been delivered to the defendants, but, apart from the adoption of the addition *and Sons*, in place of *and Co.*, there was no evidence that the defendants' conduct was intended or calculated to pass off their goods as those of the plaintiffs.

*Turton v.
Turton.*

(d) The C. A. thought it very probable the plaintiff would succeed in proving fraud, and accordingly they granted an interim injunction,

5 Times L. R. 327, 355 (1869).

(e) 42 C. D. 128 (1889), C. A., reversing North, J.

Mr. Justice North, at the trial, granted an injunction in the terms of that in *Hendriks v. Montagu* (f); but the Court of Appeal reversed this order, and dismissed the action.

In the view of the facts taken by the Court of Appeal, the defendant, John Turton, was not shown to have done anything to give to the name objected to any other meaning than that he was carrying on business in partnership with his sons; he had not done anything with the intent or for the purpose of making the use of his simple name look as if his name were the name of the plaintiffs.

Lord Esher's judgment.

"In some cases," Lord Esher said, "besides using the names, parties have, to use what, I think, is a happy phrase of my brother Cotton's, 'garnished that use'—that is, they have done things besides using the name, in order that the use of that name might look as if it were being used by the old firm. There is nothing of that kind here."

Lord Justice Cotton's judgment.

The principle to be applied, said Cotton, L.J., is this: "No man must pass off his goods as the goods of another. Of course," he added, "that may be done unintentionally; but where there is a manifest and natural meaning in the words used, that the goods are the goods of somebody else, and the man who uses those terms uses not his name only, but somebody else's, he would be stopped from doing so as soon as he is aware of the facts which make the *prima facie* intention and result of what he is doing—passing off his goods as the goods of somebody else. It was formerly said that no action could be maintained unless a man had done so fraudulently and intentionally; but when he finds out that the natural construction of what he is doing, when the facts are known, is to represent his goods to be somebody else's, then he would be stopped, even though he had originally done that unintentionally and innocently."

Notwithstanding the possibility of mistakes between the two firms being made by careless people, therefore, the

(f) *Ante*, p. 396.

Court held that the defendants were justified in adopting the name complained of, and in continuing its use after the possibility of mistake had been brought to their knowledge, and the action was accordingly dismissed.

The decision is certainly not in conflict with the earlier cases, and it is probably a final authority on the question involved; but one may venture to regret that the Court did not adopt the slight extension of the principles appealed to which would have been necessary to forbid the defendants from choosing out of several alternative styles, all equally accurate as descriptions, and equally convenient according to business usage, the only one which was calculated to lead to mistake. If *Turton & Co.* did not suit the defendants, they might have been satisfied with *Turton, Turton and Turton*, or *Turton* preceded by the initials of the partners.

The foundation of the judgments of all the Lords Justices was that the statement comprised in the defendant's name was nothing other than a statement of the actual fact that their business was the business of Joseph Tarton and his sons, expressed in the "ordinary mercantile way" (g), and made "truly, honestly, and in the usual manner in which such statements are made in the course of business" (h). The case is, therefore, readily distinguishable from cases where a "fancy name" which is not descriptive of actual facts in ordinary language is adopted (i), such as, for instance, the name—the "Universal Life Assurance Association"—in *Hendriks v. Montagu* (i); and there is no justification for the adoption and use of any such name if it is calculated to deceive. And the decision accords with the earlier authorities next referred to.

In *Burgess v. Burgess* (k), the defendant, who had recently left the employment of his father, the plaintiff, and set up a rival business in King William Street, was

A man may describe his firm in the ordinary mercantile way;

not necessarily by any "fancy name."

Burgess v. Burgess.

(g) Colton, L.J., p. 142.

(h) Fry, L.J., p. 147.

(i) *Ante*, p. 396; and see the latter part of the judgment of Colton, L.J., 42 O. D. 145.

(k) 3 D. M. & G. 896; 22 L. J. Ch. 675 (1853), *Kindersley, V.-C.*, and *Knight-Bruce and Turner*, L.JJ.

restrained from describing his business as "late of 107, Strand," his father's address; but the Court refused to forbid him to trade under his own name, or to describe his goods as "Burgess' Essence of Anchovies."

Massam v. Thorley.

Massam v. J. W. Thorley's Cattle Food Co., Ltd. (l), closely resembled the case of *Tussaud v. Tussaud* already referred to (m). There the plaintiffs, as executors of one Joseph Thorley, were carrying on a well-known business in a particular food for cattle established by their testator. The defendant company had engaged as their manager J. W. Thorley, who was a brother of Joseph Thorley, and, having been in his employment some ten years previously, had become possessed of the recipe according to which the cattle food was made by the plaintiffs' testator. J. W. Thorley was also the holder of a one-shilling share in the company. The defendants endeavoured to defend their use of the name they had adopted on the ground of their relations with J. W. Thorley, but unsuccessfully, and the Court of Appeal were further of opinion that the defendants had imitated the get-up of the plaintiffs' goods, and had intentionally acted so as to induce buyers to take their goods for them.

The injunction granted left the defendants at liberty to use their name, and to use the word *Thorley* in connection with their goods (if they could) in any way not calculated to mislead the public (n).

The injunction in this case might, in the view of the facts the Lords Justices took, have been granted on the fraudulent intention of the defendants alone, for, as appears from the judgments quoted above, it is only the honest use of a man's own name which is a defence (o).

(l) 14 C. D. 748 (1880), C. A., reversing *Malins, V.-C.*

(m) *Ante*, p. 400.

(n) See the form of injunction, 14 C. D. 762; and Appendix, p. 661.

(o) See also *Warner v. Warner*,

5 Times L. R. 327, 359, cited p. 420; *Huntley & Palmer v. The Reading Biscuit Co.*, 10 R. P. C. 277 (1893), Chitty, J.; and *Clayton v. Day*, where one Day joined one Martin in a fraudulent attempt to carry on business as "Day and

And the justification only extends to the use of a man's own name, or that of his predecessor who founded his business and established it under the name which the defendant is using (*p*); not to the use of that of his servant (*q*), or of an alleged partner who has really no interest in his business and has been brought into it only in aid of an attempt to cover the employment of a deceptive name (*r*). Still less to the use of the name of a stranger (*s*), even though it is alleged that he has authorized the defendant to use it (*t*).

Name must be the defendant's own name;

not a bought name,

Such practices are badges of fraud rather than grounds of defence. So, where the defendant has altered his name in such a way as to make it more nearly resemble the plaintiff's, the inference is almost inevitable that fraud is intended (*u*), and whether it is or not, the rule in question only applies to the use of the defendant's name in its ordinary form.

or a name altered to resemble the plaintiff's;

But it is submitted that the name need not be that which the defendant received from his parents. A name he has adopted and used until it has come to be his name by repute is as much his name as that by which his parents

but may be the defendant's name of repute.

Martin," in unfair competition with the well-known firm, 26 Sol. J. 43 (1881), Chitty, J.

(*p*) See *Turton v. Turton*, ante, p. 421; *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, J.

(*q*) *Southern v. Reynolds*, 12 L. T. N. S. 75 (1865), Wood, V.-C., (*Southern's Broseley Pipes*); *Birmingham Vinegar Brewery Co. v. Liverpool Vinegar Co.*, W. N. (1888) 139, North, J., cited p. 394; *Tussaud v. Tussaud*, ante, p. 400.

(*r*) See *Croft v. Day*, infra; *Schweitzer v. Atkins*, 37 L. J. Ch. 847 (1868); *Dence v. Mason*, W. N. (1877) 22, (1878) 42, (*Brand's Essence of Beef*), both Malins, V.-C.

(*s*) *Isaacson v. Thompson*, 41 L. J.

Ch. 101 (1871), Bacon, V.-C., (*Madame Louise*), defendant used his daughter's name, *E. Louise*; interim injunction refused on account of delay.

(*t*) *Croft v. Day*, 7 Beav. 84 (1843), Langdale, M.R., (*Day and Martin*); *Shrimpton v. Lnight*, 18 Beav. 164 (1854), Romilly, M.R.; *Melachrino & Co. v. The Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215 (1887), Chitty, J.

(*u*) *Taylor v. Taylor*, 23 L. J. Ch. 255 (1854), Wood, V.-C.; *James v. James*, L. R. 13 Eq. 421 (1872), Romilly, M.R., (*Robert Joseph James called himself Robert James*); and see *Slazenger v. Feltham*, 6 R. P. C. 531 (1889), C. A.

were known (x). Of course, a new name adopted at the time of, or shortly before, the alleged deceptive user of it would generally be taken to have been adopted for fraudulent purposes, even if it could be shown by the date of the trial to have become the defendant's name by repute.

It must be used *simpli-*
citer, not gar-
nished to look
like the
plaintiff's.

In most of the reported cases in which a defendant has been restrained from passing off his goods as those of the plaintiff under cover of a similar name, the defendant has added the "circumstances of fraud," to which Knight-Bruce, L.J., referred, in *Burgess v. Burgess* (y), or, in the phrase of Cotton, L.J., in *Turton v. Turton* (z), has "garnished the use of his name" by imitating the get-up of the plaintiff's goods (a), or his labels and show-cards (b), or has issued circulars or advertisements (c) calculated to foster the error which the resemblance of his name and that of the plaintiff's was calculated to produce.

Thus, in *Moët v. Clybourn* (d), the defendant claimed to be entitled to use the names *Meadows* and *Clybourn*, and, by virtue of such right, to brand upon the corks of his champagne bottles the letters *M. & C.* in a circle on the bottom, and the word *England* at the side, in obvious imitation of the plaintiff's practice. And in *Holt v. Smith* (e), the defendant bought the business of H. Newman and changed

(x) See *per James, L.J., and Bramwell, L.J., in Massam v. Thorley, &c.*, 14 C. D. pp. 757 and 760. It has already been shown that a name of repute is protected as a trade-name, above, p. 394.

(y) *Ante*, p. 420; e.g., by adding & Co.; *Graveley v. Winchester*, Seb. Dig. p. 162 (1867), Giffard, V.-C.; *Churton v. Douglas*, Johnson, 174; 28 L. J. Ch. 841 (1859), Wood, V.-C.; *Witt v. Concoran*, 2 C. D. 69 (1873), Bacon, V.-C.

(z) *Ante*, p. 422.

(a) *Holloway v. Holloway*, 13 Bev. 209 (1850), Langdale, M.R.;

Taylor v. Taylor, note (u); *Schweitzer v. Atkins*, note (r); *Fullwood v. Fullwood* (1), W. N. (1873) 93, 185, Malins, V.-C., and L.JJ.

(b) *Croft v. Day*; *Melachrino v. The Melachrino Egyptian Cigarette Co.*, note (t).

(c) *Massam v. J. W. Thorley's Cattle Food Co.*, *supra*.

(d) Seb. Dig. p. 316 (1877), Jessel, M.R., (*Moët and Chandon*).

(e) 4 Times L. R. 329 (1886), Kay, J. Action stayed on the defendant undertaking to use *H. and drop Co.*; defendant to pay costs.

its name to Newman & Co., in imitation of the plaintiff's trade-name.

The proximity of the place where the defendant sets up his business to that where a well-known firm is already trading may be evidence to show that, although trading under his own name, the defendant is seeking to take fraudulent advantage of its similarity to the plaintiff's name. The case of somebody finding a man named *Bass* and setting up a brewery at Burton as *Bass & Co.* (*f*), and the case of a man starting business as a banker in the Strand under the name of *Coutts* (*g*), have been cited as instances in which it is scarcely conceivable that the use of the name could be honest (*h*). In *Turton v. Turton* (*i*), the defendants were trading in the same town, Sheffield, as the plaintiff, but their presence there was reasonably accounted for, because their business had been established in the town long before the circumstances which led them to adopt the name complained of arose.

Proximity may be a badge of fraud.

7. The Relief granted.

The relief granted to the plaintiff, if he succeeds in a passing off action, corresponds to that granted in the action for infringement of a registered trade-mark to which the first-mentioned action is so closely allied. It comprises, therefore—(i.) an injunction restraining the defendant from passing off, or doing or continuing acts which are calculated to pass off, his goods as those of the plaintiff (*k*); (ii.) an order for the delivery up for destruction,

(*f*) James, L.J., in *Massam v. Thorley, &c.*, 14 C. D. p. 757.

(*g*) Cautty, J., in *Melachrino v. The Melachrino, &c. Co.*, 4 R. P. C. p. 221.

(*h*) *Lee v. Hailey* is another illustration. There the plaintiff's late manager set up in business as the "Pall Mall Guinea Coal Co.," in the Strand, and afterwards removed to 46, Pall Mall. The

plaintiffs traded, at 22, Pall Mall, as "The Guinea Coal Co."

An injunction was granted; 21 L. T. N. S. 546; 22 *ib.* 251; L. R. 5 Ch. 155, Malins, V.-J., and Giffard, L.J.

(*i*) Page 421.

(*k*) Last chapter, p. 348. See the orders collected in the Appendix, pp. 648 *et seq.*

or for the erasure of the names or other badges, of any goods already marked with the deceptive names or badges, and in the possession or under the control of the defendant (*l*); and (iii.) damages in respect of the past interferences with the plaintiff's rights (*m*); or (iv.) an account of the profits made by the defendant by the sale of goods under the deceptive names or badges (*n*), or some one or more of these.

Injunction.

The general principles governing the grant of an injunction have been sufficiently considered in the last chapter.

Form of the injunction.

The form of the injunction granted varies considerably, according to the nature of the deceptive representation which the defendant is shown to have made use of, or threatened to make use of.

Where he has imitated or adopted the plaintiff's trade-name, the order may be an absolute injunction that he shall not carry on business under that name (*o*).

Injunction in *Massam v. Thorley*.

A very full form of order was adopted in *Massam v. Thorley's Cattle Food Co.* (*p*). It restrained the defendant company and their servants from selling, or procuring to be sold, and from in any manner representing any goods manufactured by them as the goods of the late Joseph Thorley or the plaintiffs, his successors; from in any manner representing, or doing anything which should lead to the belief that the defendant company were carrying on the business of the late Joseph Thorley; from affixing to their goods, or otherwise employing, any labels, wrappers, or marks used by him or the plaintiffs, or so contrived as to represent, or lead to the belief, that the goods manufactured or sold by the defendant company were his goods or those of the plaintiffs; and from using or circulating any circulars or advertisements, used or circulated by him or the plaintiffs, or which should in any manner represent or lead to

(*l*) Page 356.

(*m*) Page 359.

(*n*) Page 360.

(*o*) As in *Hendriks v. Montagu*,

17 C. D. 638, set out above, p. 396.

(*p*) 14 C. D. p. 762, set out in the Appendix, p. 650.

the belief that the defendant company had been or were carrying on the business of the late Joseph Thorley, or were his successors.

But a device or name, which is not a trade-mark or the trade-name of the plaintiff, may always be used by the defendant in any way which is not calculated to deceive, if such way can be found; and the injunction in passing off cases is usually drawn so as to preserve this right, the order not to use a particular device or word being qualified by the addition "so as to represent, or lead to the belief," that the defendant's goods are the plaintiff's (g).

Only deceptive use of open word, &c. restrained.

Thus, in *Massam v. Thorley's Cattle Food Co.*, the Lords Justices refused to prohibit the defendants from using the word Thorley in connection with cattle food altogether (r). And in *Slazenger v. Feltham*, the Court of Appeal modified the order of Kekewich, J., forbidding the defendants to stamp *Demotic* on their lawn-tennis bats, by adding the words "so as to represent that (they) are manufactured by the plaintiffs, or in any other way from passing off their lawn-tennis bats as the goods of the plaintiffs."

So, where a word is an open word, although associated with the plaintiff's trade or goods, the form of injunction is sometimes directed to prevent the defendant from using it without clearly distinguishing his goods from the plaintiff's. This was the form adopted in the infringement cases *Seixo v. Provezende* (s), and *Johnston v. Orr-Ewing* (t), and in *The Stone Ales Case*, where the action was to restrain passing off, several of the Lords of Appeal referred to it as the proper form to adopt unless the plaintiff had a claim to the exclusive use of the word, name, or other mark in question (u).

(g) *Slazenger & Sons v. Feltham & Co.*, 6 R. P. C. 531 (1889); *Jay v. Ladler*, 40 C. D. p. 656; 6 R. P. C. 136 (1886), Kekewich, J.

(r) 14 C. D. 763.

(s) L. R. 1 Ch. 194 (1865), Wood, V.-C., and Cranworth, L.C.

(t) 13 C. D. 434; 7 App. Cas. 219, Fry, J., C. A., and H. L.

(u) Lord Watson and Lord Macnaghten, *Montgomery v. Thompson*, (1891) A. C. 217; 8 R. P. C. 361; see also *Thompson v. Bent's Brewery Co., Ltd.*, 8 R. P. C. 479 (1891), Chitty, J.

*The Stone
Ales Case.*

In the last-mentioned case, however, the injunction to restrain the defendant (*inter alia*) from selling beer not of the plaintiff's manufacture, under the term *Stone Ales* or *Stone Ale*, or in any way so as to induce the belief that such ale was of the plaintiff's manufacture, was, under the circumstances, maintained, the Lords of Appeal, referred to above, holding that the *Scixo v. Provezende* form of injunction would be more stringent, as it would, in effect, prevent the defendant using the term *Stone Ale* at all (x).

And the defendant has, in some instances, been restrained from using a word or words which could not be used by him at all, except deceptively, so long as this should continue to be the case; for instance, from calling his bitters *Angostura Bitters* until he should find out how to make the real *Angostura Bitters* (y); or from using the name *Radstock Colliery Proprietors* until he should be able to sell coal from Radstock (z).

Interim
injunctions.

Interim injunctions are granted in passing off actions on the same terms and according to the same principles as in infringement actions (s).

8. Costs, Appeals, and Practice.

And the rules and principles in regard to costs (a), appeals (b), and practice (c), are also the same in both actions, except in so far as they depend upon registration and the Registration Acts, which do not extend to or affect passing off actions.

(x) See above, p. 408; and *Braham v. Beacham*, *supra* cited.

(y) *Siegert v. Findlater*, 7 C. D. 801 (1878), Fry, J.

(z) Chap. XV., p. 352.

(a) Page 364.

(b) Page 371.

(c) Page 372; forms of pleadings, p. 643.

CHAPTER XVII.

WARRANTY OF TRADE-MARKS AND TRADE DESCRIPTIONS (a).

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It is provided by sect. 17 of the Merchandise Marks Act, 1887, that:—

“ On the sale or in the contract for the sale of any goods to which a trade-mark (b), or mark, or trade description (c) has been applied (d), the vendor shall be deemed to warrant that the mark is a genuine (e) trade-mark and not forged (f) or falsely applied (g), or that the trade description is not a false trade description (h) within the meaning of this Act, unless the contrary is expressed in some writing signed by or on behalf of the vendor and delivered at the time of the sale or contract to and accepted by the vendee.”

This section corresponds to sect. 19 of the Merchandise

(a) The references in this chapter are to the Merchandise Marks Act, 1887, which is set out and commented on in Book II.

(b) “trade-mark,” sect. 3 (1), see next page.

(c) “trade description,” sect. 3 (1), p. 476.

(d) “applied,” sect. 3 (2), and sect. 5 (1), p. 473.

(e) “genuine,” cf. sect. 2 (2) (a), p. 511.

(f) “forged,” sect. 4, p. 468.

(g) “falsely applied,” sect. 5 (3), p. 474.

(h) “false trade description,” sect. 3 (1), pp. 476, 478.

Marks Act, 1862, but the older section applied only to trade-marks which were applied to goods sold, and the implied warranty was that the trade-marks were "genuine and true, and not forged or counterfeit, and not wrongfully used."

Trade-mark.

Trade-mark (*g*) here means registered trade-mark or trade-mark protected by law in any British possession or foreign state to which sect. 103 of the Patents, &c. Act, 1883, is applicable (*h*). The section, however, imports a warranty of the genuineness of unregistered English trade-marks, at any rate when the application of them to the goods is reasonably calculated to lead persons to believe that the goods are the manufacture or merchandise of the proprietor of the trade-mark, and also of any trade-mark, whether registered or not, which the mark applied to the goods purports to be, for in such cases the unregistered trade-mark is a false trade description applied to the goods (*i*). "Mark," where it first occurs in the section, can hardly include an unregistered trade-mark, for the warranty implied is that the mark is a genuine trade-mark, that is, a genuine registered trade-mark, and that it does not purport to be. "Mark," where it occurs the second time, should be trade-mark or mark.

The several terms occurring in the section have the meanings given to them respectively by the sections of the Merchandise Marks Act, 1887, which are referred to in the notes (*k*). The general effect of the implied warranty is that the trade-marks, or marks purporting to be trade-marks, applied to the goods, are used with the assent of the proprietor of the trade-marks which they purport to be, and that the statements made or implied by the trade descriptions are true.

Implied warranty at common law.

Apart from the statutory warranties implied by the Merchandise Marks Act, it is held, at common law (*l*),

(*g*) "trade-mark," sect. 3 (1), p. 465.

(*i*) Sect. 3 (2), p. 476.

(*h*) See Chap. XX., p. 454, and

(*k*) See Book II., Chap. I., p. 430.

the list in the Appendix, p. 656.

(*l*) Warranties of the genuineness of marks are implied, in re-

that when a purchaser orders goods from a firm who are manufacturers only of such goods, and not dealers in them, then, unless it is shown that in the particular trade, or as regards the particular goods, there is a custom for the manufacturer to supply the goods of other makers, the purchaser must be assumed to have contracted with the particular manufacturers in reliance on the general excellence of the work of their firm, and he is entitled (in the absence of any express stipulation to the contrary) to have goods of the manufacturer's own make delivered in performance of the contract (*m*).

It is a question of fact, or, if there is a written contract, of construction, whether a manufacturer or vendor has agreed to deliver goods, which are referred to by a trade-mark in the contract, stamped with the mark, and being, therefore, goods of the kind properly denoted by it, or whether he has agreed only to deliver goods of the same quality as those which are denoted by the mark. Thus, in *Hopkins v. Hitchcock* (*n*), where the contract was for iron described as "S. and H. (crown) bars," and the vendors were Hopkins & Co., the successors of Snowden and Hopkins, iron marked "H. & Co." with a crown was delivered, and the jury found that the mark was not a material part of the bargain. Judgment was given for the vendors in an action for the price of the iron, and the Court of Queen's Bench upheld the judgment, on the ground that the contract was for iron of a particular quality, not for iron bearing a particular mark.

Warranty where goods are described by a trade-mark.

A somewhat similar question has arisen upon sales of pictures under the names of the supposed painters of them, and in such cases the matter to be decided is whether the

Pictures ascribed to particular artists.

spect of anchors and chain cables, by 37 & 38 Vict. c. 51, s. 4, and in respect of hops, by 29 & 30 Vict. c. 37, s. 8.

(*m*) Per Cotton, L.J., in *Johnson v. Raylton*, 7 Q. B. D. 438 (1881),

Cotton and Brett, L.JJ., Bramwell, L.J., dissenting; *Starey v. Chilworth Gunpowder Co.*, 24 Q. B. D. 90 (1889), Div. Court.

(*n*) 14 C. B. N. S. 65; 32 L. J. C. P. 154 (1863).

use of the artist's name amounts to a warranty by the vendor that the picture in question is his, or merely to an expression of the vendor's opinion.

In a case where pictures had been sold as "Views in Venice, Canaletto," and they were not by Canaletto (*o*), the question was left to the jury; but where the supposed artist was an old master, Lord Kenyon, at *Nisi Prius*, held that it was impossible to make the case one of warranty. The pictures, he said, were the work of artists of some centuries back, and, there being no way of tracing the picture itself, it could only be matter of opinion whether the picture in question was the work of the artist whose name it bore or not, the catalogue only expressed the opinion of the vendor, but left the determination to the buyer's own judgment" (*p*).

Remedy for breach of the warranty.

The remedy for breach of warranty, whether implied under the section set out above, or at common law (*q*), or imported by express agreement in any contract in regard to goods sold or agreed to be sold, is an action for damages, reduction of the agreed price, or rescission of the contract. The rules determining the nature and extent of the remedy are now contained in the Sale of Goods Act, 1893 (*r*), from which the following sections are quoted:—

"53.—(1.) Where there is a breach of warranty by the seller, or where the buyer elects, or is compelled, to treat any breach of a condition on the part of the seller as a breach of warranty, the buyer is not by reason only of such breach of warranty entitled to reject the goods; but he may—

"(a) Set up against the seller the breach of warranty in diminution or extinction of the price; or

(*o*) *Power v. Barham*, 7 C. & P. 356; 4 Ad. & E. 472; 5 L. J. K. B. N. S. 88 (1835); (Canaletto died in 1768). The jury found there was a warranty.

(*p*) *Jendwine v. Slade*, 2 Esp. N.

P. C. 572 (1797), (Teniers and Claude Lorraine, who died in 1694 and in 1682 respectively).

(*q*) See Benjamin on Sale, Book IV., Part II., Chap. I.

(*r*) 56 & 57 Vict. c. 71.

“(b.) Maintain an action against the seller for damages for the breach of warranty.

“(2.) The measure of damages for breach of warranty is the estimated loss directly and naturally resulting, in the ordinary course of events, from the breach of warranty.

“(3.) In the case of a breach of warranty of quality such loss is *prima facie* the difference between the value of the goods at the time of delivery to the buyer and the value they would have had if they had answered to the warranty.

“(4.) The fact that the buyer has set up the breach of warranty in diminution or extinction of the price, does not prevent him from maintaining an action for the same breach of warranty if he has sustained further damage.

“(5.) Nothing in this section shall prejudice or affect the buyer’s right of rejection in Scotland as declared by this Act.”

54. “Nothing in this Act shall affect the right of the buyer or seller to recover interest or any special damages in any case where by law interest or special damages may be recoverable, or to recover money paid where the consideration has failed.”

The right to rescind the contract and return the goods is dealt with by an earlier section of the same Act.

Rescission of the contract for breach of warranty.

“11.—(1) In England or Ireland—

“(a.) Where a contract of sale is subject to any condition to be fulfilled by the seller, the buyer may waive the condition, or may elect to treat the breach of such condition as a breach of warranty, and not as a ground for treating the contract as repudiated.

When condition is to be treated as warranty.

“(b.) Whether a stipulation in a contract of sale is a condition the breach of which may give rise to a right to treat the contract as repudiated, or a warranty, the breach of which may

“ give rise to a claim for damages, but not to a right to reject the goods and treat the contract as repudiated, depends in each case upon the construction of the contract. A stipulation may be a condition, though called a warranty in the contract (s).

“(c.) Where a contract is not severable, and the buyer has accepted the goods, or part thereof, or where the contract is for specific goods, the property in which has passed to the buyer, the breach of any condition to be fulfilled by the seller can only be treated as a breach of warranty, and not as a ground for rejecting the goods and treating the contract as repudiated (t), unless there be a term of the contract, express or implied, to that effect.

“(2.) In Scotland, failure by the seller to perform any material part of a contract of sale is a breach of contract, which entitles the buyer either within a reasonable time to reject the goods and treat the contract as repudiated, or to retain the goods and treat the failure to perform such material part as a breach which may give rise to a claim for compensation or damages.

“(3.) Nothing in this section shall affect the case of any condition or warranty, fulfilment of which is excused by law by reason of impossibility or otherwise.”

The warranty implied by the Merchandise Marks Act will accordingly operate to enable an innocent purchaser of goods which have been forfeited under that Act, or which have led to a prosecution, entailing expenses upon him, to recover damages in respect of the loss or expenses

(s) See *Behn v. Burness*, 3 B. & 460 (1831); *Heyworth v. Hutchinson*, S. 756; 32 L. J. Q. B. 204 (1863), L. R. 2 Q. B. 447 (1867); *Hooper v. Blackburn on Sale*, 2nd ed., p. 198. *Balfour*, 62 L. T. 646 (1890); *Re Green and Balfour*, 63 L. T. 97, 325 (1890).

(t) *Street v. Blay*, 2 B. & Ad.

The Scotch rule.

Damages for breach of warranty of trade-mark.

from the vendor, for such damages directly and naturally result in the ordinary course of events from the breach of warranty. It will also enable the purchaser to recover from the vendor any damages which may have been recovered from the purchaser by a sub-purchaser upon a resale by him, at any rate where the goods were known by the vendor to have been bought for the purpose of resale (u).

A manufacturer has at common law, and apart from any question of implied warranty, a right of indemnity by his customer, if, in compliance with the customer's orders, he innocently places a mark upon goods made for him, and the mark turns out to be an infringement of some third person's trade-mark, so that the manufacturer is rendered liable to an action by the owner of the trade-mark (x).

Indemnity to manufacturer infringing a trade-mark at his customer's request.

(u) *Hammond v. Bussey*, 20 Q. B. D. 79 (1887), C. A. See further, as to consequential damages, *The Argentino*, L. R. 13 P. D. 191 (1888), C. A.

(x) *Dixon v. Faucus*, 3 Ell. & Ell. 537; 30 L. J. Q. B. 137 (1861).

As to the defence of the manufacturer in any such case upon proceedings under the Merchandise Marks Act, see sect. 2 (2), sect. 6, and sect. 19 (3) of that Act, and Book II., Chap. I., below.

CHAPTER XVIII.

TRADE-LIBEL AND TRADE-NAME.

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There is no
threats action
in respect of a
trade-mark;

UNDER sect. 32 of the Patents, &c. Act, 1883, an action for damages or an injunction lies against any person claiming to be a patentee, who by circulars, advertisements, or otherwise, threatens any other person with legal proceedings or liability, at the instance of anyone who is aggrieved by the threats (a). But the section does not extend to threats in respect of the use of a trade-mark or trade-name, and there is no precisely corresponding right apart from it. So that the publication in good faith of a statement that the plaintiff is infringing the defendant's trade-mark, and that the defendant intends to take proceedings against all persons dealing in the infringing

(a) See Edmunds on Patents, C. A.; *Johnson v. Edge*, (1892) 2 p. 348; *Challender v. Royle*, 30 C. Ch. 1; 9 R. P. C. 142, C. A. D. 425; 4 R. P. C. 363 (1887),

goods, is not actionable, and cannot be restrained by injunction (b).

But disparaging statements calculated to injure the plaintiff's trade or to diminish the value of his goods, if they are not made in good faith, are actionable; and the continued publication of them after they have been shown, or have been held by the Court to be untrue may be restrained (c). For they amount to libels on the plaintiff in the way of his trade, or to slander of title (d).

but the threats may amount to libel or slander of title.

A fair warning to the public, or to probable purchasers of the goods, or customers of the businesses concerned, by a trader that he regards the conduct of another as an infringement of his rights, for instance, that the latter's marks are, in his view, an infringement of his trade-marks, published in good faith, and in the belief that it is well-founded, is not libellous (e), although it may turn out to be mistaken (f). So, anyone who thinks his trade-name is likely to be confused with that of another business may

A warning against infringements, &c. may be issued in good faith.

(b) *Colly v. Hart*, 44 C. D. 179; 6 R. P. C. 17 (1888), North, J. (interim injunction refused as to the trade-mark).

(c) *Wren v. Weild*, L. R. 4 Q. B. 213 and 730 (1869); *Halsey v. Brotherhood*, 15 C. D. 514; 19 C. D. 386 (1880), Jessel, M.R., and C. A. (both patent cases before the Act).

(d) A false and malicious statement in writing, printing, or by word of mouth, injurious to any person's title to property, and causing special damage, is an actionable slander of title. Tindal, C.J., in *Malachy v. Soper*, 3 Bing. N. C. 371 (1835).

(e) *Wren v. Weild*, L. R. 4 Q. B. 730 (1869), a patent threats action before the Act of 1883. In *Halsey v. Brotherhood*, 19 C. D. p. 392 (1881), a similar action, Lindley, L.J., said: "*Wren v. Weild* comes to this: that if I am a patentee, so

long as I act honestly, I am entitled to say, without running the risk of having an action for damages brought against me, that somebody is infringing my patent, or that somebody else's manufacture is an infringement of my patent. . . . If I say it dishonestly, I am so liable; and if I know that what I say is untrue, it would not take much to persuade a jury that I was acting dishonestly."

(f) In *Dicks v. Brooks*, 15 C. D. p. 40 (1880), Bramwell, L.J., said: "Although, according to our opinion, they would have been wrong in their law with respect to its being a piracy, I think their saying so would not have been actionable, because a man is not bound to be correct in his statement of law, though he is bound to be correct in his statement of facts."

publish a warning that there is no connection between his business and the other (*g*). And this, notwithstanding the pendency of proceedings in which the right of the proprietor of the other to use the name or marks he has adopted comes into question (*h*). But under pretence of the honest publication of a fair warning there is no excuse for an allegation that the goods of the other party are spurious (*i*), or that he is foisting a fictitious article upon the public (*g*), or is fraudulently endeavouring to pass off his goods as those of the person who issues the advertisement or circular complained of (*h*).

Suggestion that the plaintiff's goods are spurious.

Thus, in *Thorley's Cattle Food Co. v. Massam* (*l*), the defendants had published an advertisement warning the public that any goods purporting to be Thorley's Cattle Food, and not signed by their trade-name "Joseph Thorley," were not of their manufacture, and alleging that they were the only persons possessed of the secret recipe according to which the food was compounded, and also a circular stating that the plaintiffs were seeking to "foist upon the public an article which they pretend is the same as that manufactured by the late Joseph Thorley." The defendants were the executors of the late Joseph Thorley, the inventor of the cattle food, and they were carrying on his business; but the statement that they alone possessed the secret recipe, and the suggestion that the goods of the plaintiffs were not prepared according to it, were false, for one Josiah Thorley, a brother of Joseph Thorley, who had obtained the recipe from him, was manager of the plaintiff company (*m*). An injunction

(*g*) *Thorley's Cattle Food Co. v. Massam*, 14 C. D. 763 (1880), C. A.; *William Coulson and Sons v. James Coulson and Sons*, 3 Times L. R. 740 (1887), Div. Court. In this case the defendants added to their warning a statement that the plaintiff firm was lately bankrupt.

(*h*) *Coats v. Chadwick*, (1894), 1 Ch. 347, Chitty, J.; see p. 443.

below; *Anderson v. Liebig, & Co.*, 45 L. T. 757 (1881), Chitty, J.

(*i*) *Thorley's Case*, *supra*.

(*k*) *Coats v. Chadwick*, *supra*.

(*l*) *Supra*; *Liebig, & Co. v. Anderson*, 55 L. T. 206 (1887), Chitty, J.

(*m*) A suit for an injunction by the defendants to restrain the use of the name *Thorley's Cattle Food* by the plaintiffs had been aban-

was granted at the trial to restrain the defendants from advertising, or representing, or suggesting in their advertisements or circulars that they, or the proprietors of their testator's business, were alone possessed of the secret recipe, and from representing or suggesting, or doing anything calculated to represent or suggest, that the cattle food manufactured or sold by the plaintiffs was spurious or not genuine.

And in *Thomas v. Williams* (n), the publication of circulars suggesting that the goods of the plaintiff were not genuine, but were imitations of goods sold by the defendants, was restrained.

But a mere puff of the defendant's own goods, such as a statement that his patent food is "far more nutritious than any other preparation known" is not a libel of the goods of rival traders (nn).

In the cases just cited it was held that no evidence of special damage was necessary in order to obtain the injunction where, in the opinion of the Court, the libellous statement was calculated to do a serious injury to the plaintiff's business (o); but if this is not clear and no appreciable damage is proved to have been caused by the publication of the statement, an inquiry as to damages will be refused, and if, in addition to this,—there being no threat to continue the publication,—there is no case for an injunction, the action should, it seems, be dismissed with costs (p).

Evidence of special damage is not essential,

but proof of probable damage is.

done, after an application in it for an interim injunction had failed; 6 C. D. 583, Malins, V.-C. The defendants subsequently succeeded in a trade-name and passing-off action against the plaintiffs, *ante*, p. 424.

(n) 14 C. D. 884 (1880), Fry, J.; *Liebig, & Co. v. Anderson*, note (h), "only genuine brand."

(nn) *Mellin v. White*, (1894) W. N. 59, Romer, J.

(o) So also, *per* North, J., in *Hayward & Co. v. Hayward & Sons*,

34 C. D. 207 (1886), cited below.

(p) *Dicks v. Brooks*, 15 C. D. 22 (1879), C. A. There the defendants, who owned the copyright in an engraving of Millais' "Huguenots," had threatened proceedings against persons who bought copies of the plaintiff's paper containing a wool-work pattern, wrongly alleged to be an infringement of the copyright. Only two or three numbers were shown to have been returned or not sold in consequence of the threats.

And in a case where the only evidence of damage to the plaintiff having been occasioned by the publication of a libellous circular misstating the result of an action for passing off the plaintiff's goods as those of the defendant, was the plaintiff's own affidavit alleging that his business had fallen off, and the plaintiff had delayed bringing his action for three months after he first knew of the publication, North, J., assessed the damages at 5%, but granted an injunction, and gave the plaintiff the costs of the action (q).

The threat or warning must be *bona fide*.

It is essential, in order to entitle the plaintiff to redress in respect of the publication of a threat or warning, that he should make out that the statements complained of are not published in good faith, and upon an application for an interim injunction to restrain the publication of threats by the defendant, it is not sufficient, if it is any, proof of want of good faith, to show that he has commenced an action for infringement of trade-mark, or for passing off goods as his against the plaintiff, but has neglected to apply in it for an interlocutory injunction (r).

Misleading report of a trade-mark action.

The publication of a misleading report of a trade-mark action, or of an order obtained by the successful party therein either at the trial or on an interlocutory application, may be a trade-libel falling within the principles of the cases referred to in this chapter. Thus, where an action for passing off had failed and been dismissed without costs, the evidence showing only a few instances of representations that the defendant's goods were those of the plaintiff's, and that these were made by the defendant's agents without his knowledge or authority, but the defendant had offered an undertaking that he would never make such representations, and this undertaking was inserted in the order at the desire of the judge, the plaintiffs published a circular headed "Caution," which, referring to the action, alleged that:—

"By the judgment the defendant was ordered to undertake

(q) *Hayward & Co. v. Hayward & Sons*, 34 C. D. 198 (1886).

(r) *Anderson v. Liedig's Extract of Meat Co.*, 45 L. T. N. S. 757 (1881), Chitty, J.; see next note.

“not to represent that his firm is, or that the plaintiff’s firm is not, the original firm of Richard Hayward & Co.,” and added that the plaintiffs, “finding that serious misrepresentations were in circulation to their prejudice, felt themselves compelled to bring the above action.” In a subsequent action (s), brought by the former defendants against the former plaintiffs, this circular was held to be untrue and libellous, and to have been published maliciously, and an injunction was granted to restrain its further publication.

So far as the case against an advertisement or other publication rests upon its being a libel, proof that the statements complained of in it are, in fact, true, is an answer to any action for damages, or an injunction in respect of its publication (t).

True statements are not libellous.

Accordingly, an action for publishing a statement that certain persons, meaning the plaintiff company, had wrongfully used the word *Singer* to designate machines not manufactured by the defendant company, which came on for trial after the latter company had established, in a passing off action against the former, that the use of the word by the plaintiff company was actually wrongful, was dismissed with costs (t).

So the publication of an apology actually made by the plaintiffs to the defendants is justifiable, though it may have been extracted from the plaintiffs under duress of civil or criminal proceedings in respect of the false marking of their goods (u).

Publication of an apology.

But the publication of a statement which turns out to be true may be improper pending legal proceedings in which the matters it refers to are in issue, not as being libellous, but as contempt of Court, if it tends to interfere with the fair trial of the action, or to embarrass one of the parties in the preparation or conduct of his case. And such con-

But a statement pending proceedings, whether true or not, may be a contempt of Court.

(s) *Hayward & Co. v. Hayward & Sons*, 34 O. D. 198 (1886), North, J.; *Liebig’s & Co. v. Anderson*, 55 L. T. 206 (1887), Chitty, J.

(t) *Nähmaschinen Fabrik, &c. v. Singer Manufacturing Co.*, 13 R. P. O. 310 (1893), Romer, J.

(u) *Fisher v. Apollinaris Co.*, L. R. 10 Ch. 297 (1875), L.JJ.

tempt may be punished by imprisonment (*x*), fine, or sequestration of goods, or the publication may be restrained by injunction, upon a summary application by motion in the action (*y*). The reluctance of the Court to interfere by interlocutory injunction to restrain the further publication of an alleged libel which the defendant justifies, does not extend to such cases as these. As already stated, the parties are at liberty to warn the trade as much as they like, notwithstanding the pendency of the action; but they are bound to refrain during its pendency from public discussion on the merits or demerits of the case (*z*). "You can warn as much as you like," Kay, J., said, in *Goulard v. Lindsay* (*y*), "but can you advertise: 'I have brought an action against A. B. which is certain to succeed'?" And the learned judge added that to advertise a positive statement that the defendants had infringed the plaintiff's patent was wrong.

Statement in reply to one published by the other side.

It is no answer to an application for an injunction in respect of a publication alleged to be a contempt of Court, to say that it was made in reply to a statement published by the applicant himself with reference to the same matter, although this circumstance may influence the Court in dealing with the costs of the application (*a*).

But every publication bearing upon the matters in question *pendente lite* is not a contempt. A fair and accurate report of interlocutory proceedings, for instance, is allowable (*b*). And the Court may refuse to restrain a

(*x*) *Roach v. Hall*, 2 Atk. 469 (1742), Hardwicke, L.C. The respondents were imprisoned for publishing statements calling some of the witnesses "affidavit men." *Kitcat v. Sharp*, 31 W. R. 227 (1883), Fry, J., (defendant restrained from publishing the statement of claim and correspondence).

(*y*) *Coate v. Chadwick*, (1894) 1 Ch. 347, Chitty, J. The plaintiffs, in an action for passing off, were restrained from publishing a circu-

lar charging the defendants with fraudulent imitation of their goods. *Goulard v. Lindsay*, 4 E. P. C. 189 (1887), Kay, J., (a patent case).

(*z*) *Per Chitty, J.* (1894), 1 Ch. 350.

(*a*) *Coleman v. West Hartlepool Ry. Co.*, 8 W. R. 734 (1860), Wood, V.-C.

(*b*) A newspaper report published contemporaneously, if otherwise libellous, would be privileged under the Law of Libel Amendment Act, 1888.

report which it thinks unfair or discreditable to the persons responsible for it, if not convinced that the report is calculated to obstruct the course of justice, or to prejudice the public mind (c).

Where the publication of a statement *pendente lite* is restrained as being a contempt of Court, the applicant is not required to give an undertaking to be answerable in damages to the respondent for any loss occasioned by the injunction if it turns out that the respondent was in the right (d), as is usual upon the grant of an interlocutory injunction, for the publication is wrong in any event, whether the statements are found in the end to be false or to be well-founded.

The rule under which the publication of biassed comments reflecting on matters in issue in pending litigation, and calculated to interfere with the fair trial of the action, is restrained, is of general application, and it is not confined to publications made by, or at the instance of, interested parties. Applications under it to commit the editors of newspapers have, of late years, become very frequent, and, in spite of the constantly expressed reluctance of the judges to interfere where it is not necessary to protect the fair prosecution of the action (e), the applications generally result in the costs incurred, or part of them (f), and some-

(c) *Brook v. Evans*, 29 L. J. Ch. 616 (1860), Stuart, V.-C. and L.JJ. The plaintiffs advertised that they had established that they first used the word *Glacé*, but that the defendants relied on the lapse of time as an answer to the motion, although the plaintiffs had constantly protested against the defendants' use of the word. The defendants, in fact, had not been called upon on the motion.

(d) *Fenner v. Wilson*, (1893) 2 Ch. 656, Kekewich, J.

(e) *In re Clements*, 46 L. J. Ch. 383 (1877), Jessel, M.R., said:

"I say that a judge should be most careful to see that the cause cannot be fairly prosecuted to a hearing unless this extreme mode of dealing with persons brought before him on accusations of contempt should be adopted." In *The Plating Co. v. Farquharson*, 17 C. D. 49 (1881), the C. A. dismissed an application to commit the editor of a paper in respect of an advertisement asking for subscriptions and evidence to assist the appeal in a patent case.

(f) See *Duncan v. Sparling*, *The Times*, 9th March, 1894.

times a substantial fine (*g*), being thrown upon the respondents if they have ventured at all beyond a mere accurate report, or a colourless account of the proceeding.

Injunction
to restrain
trade-libels.

Before the Judicature Act the Courts had no jurisdiction to restrain the publication of a libel, even though it affected the plaintiff's trade or property (*h*); but the jurisdiction is conferred by that Act upon all the divisions of the High Court, and it has been exercised in many cases (*i*).

Interlocutory
injunction.

The Court has also jurisdiction to interfere by interlocutory injunction to restrain the further publication of an alleged trade libel, which is the subject of an action, until the hearing. But it will only do so if it is satisfied, upon the facts and evidence before it, that the statements complained of are false (*k*), however much the balance of convenience may be in favour of staying the publication (*kk*), and only in the clearest cases (*l*)—where, as it has been put, the plaintiff's case is so strong that if the jury at the trial found for the defendant, their verdict would be set aside as unreasonable (*m*).

For the question, libel or no libel, is peculiarly a question for a jury; and in order to interfere before the hearing the Court must determine that question in advance, without the jury's assistance (*n*). The reluctance to interfere by

(*g*) *Re The Crown Bank*, 44 C. D. 649 (1890), (a bad case of contempt).

(*h*) *Prudential Assurance Association v. Knott*, L. R. 10 Ch. 142 (1875), Cairns, L.C. and L.JJ.

(*i*) *Thorley's Cattle Food Co. v. Massam*, 6 C. D. 582 (1877), Malins, V.-C.; 14 C. D. 763 (1880), Malins, V.-C., and C. A.; *Thomas v. Williams*, 14 C. D. 864 (1880), Fry, J.; *Saxby v. Easterbrook*, 3 C. P. D. 339 (1878), Div. Court, and the cases cited below.

(*k*) *Collard v. Marshall*, (1892) 1 Ch. 571, Chitty, J. The libel was that the plaintiffs were "sweaters," and that their work was not properly executed. The defendants

said the statements were, in substance, true, but did not suggest that they had any further evidence not before the Court. They were willing to treat the motion as the trial. An interim injunction was granted. *Punch v. Boyd*, 16 L. R. Ir. 476 (1885).

(*kk*) *Société des Manufactures des Glaces v. Tilghman's Patent Sand Blast Co.*, 25 C. D. 1 (1883), C. A.

(*l*) *Monson v. Tussaud*, (1894) 1 Q. B. D. 671, C. A., per Davey, L.J., (case of a personal libel).

(*m*) Per Lord Esher, M.R., in *Coulson v. Coulson*, 3 Times L. R. 846, adopted in *Bonnard v. Perryman*, (1891) 2 Ch. 269, C. A.

interlocutory injunction is so strong, that the cases cited of *Bonnard v. Perryman* (*mm*), and *Monson v. Tussaud* (*n*), seem to show that, where the defendant alleges justification, and reserves the particulars of his case, and the evidence in support of it, the injunction ought never to be granted. In any case, the probability of very serious injury to the plaintiff if the libellous statements are allowed to continue must be made out (*o*).

An action in respect of a trade-mark for slander of title, unlike a mere personal libel, survives to the executors since it occasions an injury to the estate of the testator (*p*). Action survives to executors.

(*mm*) See note (*m*) *ante*, p. 446.

(*n*) Note (*l*). These were not, however, trade libels, but the rule was applied in *Champion & Co. v. The Birmingham Vinegar Brewery Co.*, 10 Times L. R. 163 (1893), Div. Court, (which was a trade case).

(*o*) *Salmons v. Knight*, (1891) 2 Ch. 294, North, J., and C. A.; *Mogul Steamship Co. v. McGregor, Gow & Co.*, 15 Q. B. D. 476 (1885), Coleridge, L.C.J., and Fry, L.J.

(*p*) *Hatchard v. Mege*, 18 Q. B. D. 771 (1887), Div. Ct.

CHAPTER XIX.

TRADE-SECRET AND TRADE-NAME.

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Use of the trade-name of a secret preparation.

It has been shown that anyone is entitled to use a name or mark for the goods to which that name or mark is properly applied (a). Thus, anyone who is in possession of goods made or sold by the owner of a trade-mark or trade-name, may apply the trade-name or trade-mark to them (b), and may, for instance, replace the old labels upon the goods by new ones (c). So, the name of a secret preparation may be used by anyone for goods actually prepared according to the recipe (d), for they are the goods indicated by the name, whether prepared by the original inventor of the recipe, or his successors in business, or not. Until

(a) See Chap. II., p. 32, and Chap. XV., p. 309.

(b) *Condy v. Taylor*, 56 L. T. 891 (1887), Kekewich, J.

(c) *Farina v. Silverlock*, 6 De G. M. & G. 214; 26 L. J. Ch. 11 (1856), Cranworth, L.C., cited, p. 32.

(d) *Canham v. Jones*, 2 V. & B. 218 (1813), Plumer, V.-C., (*Felno's Vegetable Syrup*); *James v. James*, L. R. 13 Eq. 421 (1872), Romilly,

M.R., (*Lieutenant James' Horse Blister*); *Condy v. Mitchell*, 37 L. T. N. S. 268, 766 (1877), Bacon, V.-C., and C. A., (*Condy's Fluid*); and see the injunction in *Siegert v. Findlater*, 7 C. D. 801 (1878), Fry, J., cited p. 309, (*Angostura Bittere*). In *Benbow v. Low*, 44 L. T. N. S. 875 (1881), Bacon, V.-C., held that an outgoing partner who retained the receipt could use the name of a secret preparation.

the secret is discovered or betrayed the goods of the original inventor or his successors can be the only goods to which the name is applicable, or which are denoted by it; but when other people can make them, the difficult question of fact, discussed in a previous chapter of this book (*e*), arises, whether the name is merely that of the goods themselves, or that of goods of the kind prepared or sold by the original inventor or his successors in business. This was well put by Fry, J., in the *Angostura Bitters Case* (*f*). "I cannot say," the learned judge said, "that Meinhard (*g*) may not, if he can, make a bitter identical with the plaintiffs', and, if he does, I cannot prevent him from selling it as *Angostura Bitters*. It is to be observed that the person who produces a new article, and is the sole maker of it, has the greatest difficulty (if it is not an impossibility) in claiming the name of that article as his own, because, until somebody else produces the same article, there is nothing to distinguish it from. No distinction can arise from using the name of the class, so long as the class consists of only one species, for then the name of the species and the name of the class will be the same."

But, as regards any particular person or persons, the use of a mark or name which is open to the world at large may be restrained by reason of a contract he has entered into, or of circumstances which make it contrary to conscience for him or them to avail themselves of their general right. Putting aside cases of express contract,—as where, for instance, a partner or servant has covenanted not to use the firm name, or any particular name or marks, or not to engage in any particular business, after the determination of the partnership or employment,—the most important cases of this kind are cases of trade secrets. The law relating to trade secrets does not properly fall within the scope of this book, but as it touches upon the

The use of the name or secret may be a breach of contract or of confidence.

(*e*) Above, pp. 36 *et seq.*

(*g*) The maker of the defendant's

(*f*) *Siegert v. Findlater*, 7 C. D. bitterc.

p. 813.

limitation of trade-mark and trade-name rights referred to above, it is convenient to shortly refer to the leading cases on the subject.

Wherever a secret information has been obtained under circumstances which import a contract not to disclose or make use of it, or by breach of confidence, or under other circumstances which make the disclosure, or the use of the information, contrary to conscience, the Court will restrain the person who has obtained it, or anyone to whom it has been communicated by him, from using or disclosing it.

Information
obtained by
breach of
contract or of
confidence.

Thus, in *Prince Albert v. Strange* (*h*), the publication of a catalogue of a number of etchings made by the Queen and Prince Albert for their private use and amusement, and never published or authorized to be published by them, and the exhibition of the etchings, was restrained, the copies of the etchings which had passed into the defendant's possession having been obtained surreptitiously and in breach of confidence from or through a printer employed to print them. And in *Morison v. Moat* (*i*) the defendant, who had obtained the secret of manufacturing *Morison's Universal Medicine* from his father, was restrained from using it. Both the defendant and his father had formerly been in partnership with the plaintiff, but the father of the plaintiff, to whom alone the original inventor had disclosed the secret, had entered into a covenant not to divulge it to any other person. The injunction restrained the defendant, his agents, &c., from selling, under the title of *Morison's Universal Medicine*, any medicine made by him or under his directions, and also

(*h*) 2 De G. & Sm. 652; 1 Mac. & G. 25; 18 L. J. Ch. 120 (1849), Knight-Bruce, V.-C., and Cottenham, L.-C.

(*i*) 9 Haro, 241; 20 L. J. Ch. 513; 21 *ibid.* 248 (1851), Turner, V.-C., and Knight-Bruce, and Lord Cranworth, L.JJ., App., p. 648. The case of *Canham v. Jones*, 2 Ves. & B. 219, was distinguished by Turner,

V.-C., on the ground that it was not put forward as one of breach of confidence or contract; but the report shows that the bill stated the employment of the defendant, and that the plaintiff's counsel, on the demurrer, to some extent rested their case on breach of confidence. The case would now be differently decided on the alleged facts.

from making any medicines according to the secret, or in any manner using the secret of compounding the medicines, or any part thereof.

Injunctions have been granted on the same principles to restrain the use or publication of secret information obtained by a clerk or servant in the course of his employment (*k*), and it is said that "every clerk employed in a merchant's counting-house is under an implied contract that he will not make public that which he learns in the execution of his duty as a clerk" (*l*); of a table of details of the dimensions of machinery designed by, or for the plaintiffs, collected from their plans by one of their draftsmen, although the details could all have been gathered from the machines made according to the designs and sold, if access could have been obtained to them (*m*); of materials for the construction of a book of advertisements collected by the plaintiff's advertising canvassers (*n*); of lectures delivered to a class of students, and not published or authorized to be published by the lecturer (*o*); of private letters written by the plaintiff, or by a person whose estate the plaintiff represents (*p*); of copies of the plaintiffs' pictures, delivered to the defendants for the making of copies, in excess of the number made for and delivered to the plaintiffs (*q*); and of prints from a photographic negative likeness of the plaintiff, which the defendants had been employed by the plaintiff to take (*r*).

Information obtained by a clerk;

table of dimensions by engineer's draftsman;

book of advertisements by canvasser; lectures;

private letters;

copies of pictures by lithographer;

photographs of the plaintiff.

(*k*) *Youatt v. Winyard*, 1 Jac. & W. 394 (1820), Eldon, L.C.

462; (1893) 1 Ch. 218, Chitty, J., and C. A.

(*l*) *Per Wigram, V.-C.*, in *Typing v. Clarke*, 2 Haro, 383 (1842); and *per North, J.*, in *Pollard v. Photographic Co.*, 40 C.D. 345 (1888).

(*o*) *Abernethy v. Hutchinson*, 3 L. J. Ch. O. S. 214 (1824), Eldon, L.C.; *Caird v. Sime*, 12 App. Cas. 326 (1887).

(*m*) *Merryweather v. Moore*, (1892) 2 Ch. 518, Kekewich, J. The defendant had been apprenticed to the plaintiffs, and had remained in their employment after his articles expired; cf. *Reuter's Telegram Co. v. Byron*, cited below, p. 452.

(*p*) *Perceval v. Phipps*, 2 Ves. & B. 19 (1813), Plumer, V.-C.; *Earl of Lytton v. Devey*, 54 L. J. Ch. 293 (1884), Bacon, V.-C.

(*q*) *Tuck and Sons v. Priester*, 19 Q. B. D. 629 (1887), C. A.

(*n*) *Lamb v. Evans*, (1892) 3 Ch.

Pollard v. Photographic Co. note (*l*).

The jurisdiction rests on implied contract.

“Different grounds have been assigned for the exercise of the jurisdiction. In some cases it has been referred to property, in others to contract, and in others, again, it has been treated as founded upon trust or confidence, meaning, as I conceive, that the Court fastens the obligation on the conscience of the party, and enforces it against him in the same manner as it enforces, against a party to whom a benefit is given, the obligation of performing a promise, on the faith of which the benefit has been conferred” (s). But it is submitted that the true ground is always implied contract (t), for if information, which both parties understand the present possessor intends to be kept, and to remain secret, is communicated by him to another, or the means of obtaining it are placed by him within the reach of another, for particular purposes, for instance, in the course of an employment, an undertaking not to use or disclose the information ought almost necessarily to be inferred.

Use of agent's information where no breach of contract or confidence.

Reuter's Co. v. Byron.

The mere fact that the defendant obtained the information in question as, and while he was the agent of the plaintiff, is not a sufficient ground for restraining him from using it, provided there is nothing of a secret character in the information itself, or confidential or surreptitious in the manner in which it was communicated or obtained, so that a contract not to communicate or use it can be implied. “The plaintiffs here do not seek to restrain the defendant from publishing anything,” Jessel, M.R., said, in *Reuter's Telegram Co. v. Byron* (t), “but from making use of knowledge acquired while the relation of principal and agent subsisted, after that relation had terminated. Now I am not aware of any authority in which this has been done in the absence of a contract, expressed or implied.” But he added, “that being so, the jurisdiction of the Court cannot be stretched on an

(s) *Per Turner, V.-C., in Morison v. Moat*, 20 L. J. Ch. p. 522. So, *per Kekewich, J., in Merryweather v. Moore*, (1892) 2 Ch. p. 522.

(t) *Merryweather v. Moore, supra; Reuter's Telegram Co. v. Byron*, 43 L. J. Ch. 661 (1874), Jessel, M.R.

“interlocutory application. I do not mean to say it cannot be done at all.” The circumstances of the case just cited were, that the plaintiffs had invented a large number of telegraphic cyphers indicating the names of their customers, which were communicated to the defendant while he was the plaintiffs’ agent, and after he had left their employment, and started a rival business, he sent circulars to the customers, stating that he had their cyphers, and soliciting their custom. It was said that the defendant had committed no breach of confidence with regard to the cyphers, because these were known to the customers, and could have been obtained by the defendant from such of them as chose to do business through him. It may be doubted whether the importance of having access to the large number of cyphers invented or collected by the plaintiffs was fully appreciated in this case, and whether the decision is consistent with the reasoning accepted in the later cases of *Lamb v. Evans*, and *Merryweather v. Moore*, cited above (u). It was, however, as appears from the judgment of the learned Master of the Rolls, a decision on an interlocutory application only. The principle stated in the judgment, and quoted above, is undoubtedly sound, whatever may be thought of its application to the facts of the case.

Following the ordinary rule in regard to injunctions, no injunction to restrain the communication of a secret will be granted unless by reason of a threat or otherwise, the Court is satisfied that there is a danger of the communication being made (x).

No injunction unless there is danger of the secret being communicated.

(u) Page 451.

(x) *Morison v. Moat*, 20 L. J. Ch. p. 529.

CHAPTER XX.

REGISTRATION OF FOREIGN AND COLONIAL TRADE-MARKS.

BEFORE the introduction of a register of trade-marks a foreigner, not being an alien enemy, was allowed to sue for the infringement of his trade-mark in the English Courts (*a*), provided the trade-mark had become his trade-mark in England by user, or to prevent or obtain damages for the passing off the goods of others as his goods, in the same way and on the same terms as an English subject. And many treaties existed by which this country agreed to give to the subjects of other countries the same right of protection, in respect of their trade-marks, as it gave to its own subjects (*b*). The prohibition contained in sect. 77 of the present Act, and the corresponding section of the Act of 1875, restraining actions in respect of the infringement of unregistered trade-marks (*c*), however, apply to the trade-marks of foreigners (*d*), and therefore actions for infringement could not, since 1875 (in general (*c*)), be brought by a foreigner without his trade-mark being registered in England; actions for passing off, to which the prohibitory sections of the former or the present Acts do not apply, remaining as before.

A foreigner, or any resident in a British possession, may apply for and obtain registration under sect. 62; but if he does not apply under the convention mentioned below,

(*a*) *The Collins Co. v. Reeves*, 28 L. J. Ch. 56 (1858), Stuart, V.-C.

(*b*) See a paper presented to Parliament, 1872, C. 633.

(*c*) For the precise effect of the

section, see its terms, and Chap. XII., pp. 260, 268.

(*d*) *Goodfellow v. Prince*, 35 C. D. 9 (1887), C. A., see above. pp. 264, 270.

and is out of the United Kingdom at the time of making the application, he must give an address for service in the United Kingdom (e); and under sects. 103 and 104 of the Act, further provisions are made in his favour if he is a subject of a state in respect of which, or a British subject resident in a British possession to which, these sections have been, by Order in Council, declared to be applicable.

The sections referred to, so far as they relate to trade-marks (f), provide that—

“103. (1.) If her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of trade-marks, then any person who has applied for protection for any trade-mark in any such state, shall be entitled to registration of his trade-mark under this Act, in priority to other applicants; and such registration shall have the same date as the date of the protection obtained [the application (g)] in such foreign state.

International arrangements for protection of inventions, designs, and trade-marks.

“Provided that his application is made, in the case of a trade-mark, within four months from his applying for protection in the foreign state with which the arrangement is in force.

“Provided that nothing in this section contained shall entitle the proprietor of the trade-mark to recover damages for infringements happening prior to the date of the actual registration of his trade-mark in this country (h).

“(2.) The use in the United Kingdom, or the Isle

(e) Act of 1888, s. 8 (62 (6)), ante, p. 60.

(f) The words referring only to patents or designs are here omitted; the full text is printed in the Appendix, p. 572.

(g) Act of 1888, s. 6.

(h) The ordinary rule is, that where trade-mark rights exist,

damages for infringements before the registration may be recovered; *Barlow v. Johnson*, 7 R. P. C., p. 411 (1890), Chitty, J., ante, p. 265. Cf. with this sub-section the International Copyright Act. See *Moul v. Groenings*, (1891) 2 Q. B. 443; and *Schauer v. Field*, (1893) 1 Ch. 35.

“ of Man, during such period of the trade-mark, shall not invalidate the registration of the trade-mark.

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

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

Provision for
colonies and
India.

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

“ (2.) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for her Majesty in Council to revoke any Order in Council made under this Act” (l).

At the time when these sections were passed into law the international convention for the protection of industrial property, as it was originally settled at Paris, had been

(i) Sect. 62, Chap. IV., p. 68.

see Appendix, p. 656.

(ii) See p. 459.

(kk) The brackets are not part

(k) For list of States and Possessions to which the sections apply,

of the Act; see note (f) above.

drawn up and agreed to by several of the countries which are parties to it, and in the following year (l) this country acceded to the convention. Amendments of the convention were agreed to at the subsequent Conference at Madrid, in 1891, and practically all civilized states, except Germany, Austria and Russia, and Norway and Denmark, have now acceded to the original convention. The text of the convention, and a list of the countries and British possessions to which the above sections have been made applicable by Orders in Council, are set out in the Appendix (m).

The international convention.

The convention and the accession thereto of this country may be referred to by the Court as a matter of history, in order to enable it to understand under what circumstances the sections were passed (n); but the terms of the convention cannot be employed as a guide to interpret the sections (o), for a treaty with a foreign state binds the subjects of the Crown only in so far as it has been embodied in legislation passed into law in the ordinary way (p).

The provisions of the sections, in fact, do not carry out the international agreements constituted by the convention, for, by Art. VI. of the Convention, it is agreed that "every trade-mark duly registered in the country of origin shall be admitted for registration, and protected in the forms originally registered in all other countries of the Union" (q); and by clause 4 of the final protocol, it is explained that this article "is to be understood as meaning that no trade-mark shall be excluded from protection in any State of the Union, from the fact alone that it does not satisfy, in regard to the signs composing it, the conditions of the

Foreign trade-mark may be refused registration.

(l) 20th March, 1883.

(m) Pages 656, 658.

(n) *Carter Medicine Co.'s Tms.*, (1892), 3 Ch. 472; 9 R. P. C. 401, North, J.

(o) *Californian Fig Syrup Co.'s Tm.*, 40 C. D. 620; 6 R. P. C. 126

(1888), Stirling, J.

(p) See last case, and *Walker v. Baird*, (1892) A. C. 491.

(q) i. e., the union of the contracting states for the protection of industrial property.

“legislation of the State, provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in the said country of origin”; but it has, nevertheless, been decided that, in order to be qualified for registration, a mark tendered under these sections, just as any other mark which is sought to be registered, must fall within the descriptions of sect. 64. So that the words *Syrup of Figs* (r), and the words *Carter's Little Liver Pills* (s), were refused registration as trade-marks, although registration of them respectively had been duly applied for and actually obtained in the United States, one of the states to which sect. 103 has been applied.

The effect of the decisions just referred to is to reduce the operation of the convention, in regard to trade-marks (t) in this country, to very narrow limits. As between applicants for the registration of new marks, or marks acquired as trade-marks since the application for protection in a foreign state within the Union, the applicant in the foreign state is to have priority, provided that he makes his application in this country within four months from the date of the foreign application on which he relies. And this priority is not affected by the success or failure of the foreign application.

Publication
of foreign
trade-mark.

The proviso that use of the trade-mark in this country during the period of four months shall not invalidate the registration, is surplusage, if it is directed to use by the applicant himself, as it seems intended to be, for the publication or use of a mark by the applicant before registration in no case prejudices, although it may confer (u), a right to registration. The proviso might

(r) *Californian Fig Syrup Co.'s Tm.*, 40 C. D. 620; 6 R. P. C. 126 (1888), Stirling, J.

(s) *Carter Medicine Co.'s Tms.*, (1892) 3 Ch. 472; 9 R. P. C. 401, North, J.

(t) Another part of the convention, relating to false marking and

false trade description and the seizure on importation of falsely marked goods, has been carried into effect by the Merchandise Marks Act, see p. 526, below.

(u) i. e., if the mark, being capable of registration, is acquired by user as a trade-mark.

have some useful meaning and operation, if it were construed to prevent an opponent, who had first used the trade-mark in question after the application in a foreign state by the applicant for registration here, relying on his use of the mark, or the title acquired by him in consequence of that use, as an objection to the registration of the applicant. But so long as the convention is not embodied in legislation, as already stated, it can have no operation upon the right to registration at all. It might, however, if it is submitted, properly affect the comptroller's discretion.

The last clause of sub-sect. (3), providing that "any trade-mark the registration of which has been duly applied for in the country of origin may be registered under this Act," does not give an independent or new right of registration under the Act (*x*), and it seems to bear no other construction than that suggested on behalf of the comptroller in *The Carter Medicine Co. Case* (*x*), namely, that "may be registered" is to be read as "may be the subject of application for registration," although this construction reduces it also to surplusage.

The application of the sections to any foreign state can, under no circumstances, afford any answer to a motion under sect. 90 to remove from the register a mark which was originally registered without sufficient cause (*y*).

(*x*) *Californian Fig Syrup Co.'s Tm.*, and *Carter Medicine Co.'s Tms.*; *supra*.

(*y*) *Vignier's Tm.*, 3 R. P. C. 490 (1889), Kay, J., (*Monobrut Champagne*).

BOOK II.

THE CRIMINAL LAW OF FALSE MARKING.

CHAPTER I.

THE MERCHANDISE MARKS ACT, 1887.

(50 & 51 VICT. c. 28.)

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A SHORT introductory account of the Merchandise Marks Act, 1887 (a), and of the Act of 1862, which it repealed and replaced, will be found in Chap. I. of Book I. (p. 17), and the nature of the contents and subject-matter of the Act can be readily gathered from the table placed at the head of this chapter, and sect. 2 of the Act which is set out on the following page. The table of sections given in the

(a) This Act is quoted throughout this and the following chapter as "M. M. A. 1887," and the Merchandise Marks Act, 1891, as "M. M. A. 1891." The Report of the Select Committee of the

House of Commons of 1862 is quoted as "M. M. A. Report, 1862," that of the Committee of 1887, as "M. M. A. Report, 1887," and that of the Committee of 1890, as "M. M. A. Report, 1890."

Queen's Printers' copy and the text of the statute itself, are printed in the Appendix (p. 666).

The most important substantive enactments of the Merchandise Marks Act, 1887, are comprised in the sub-sections. (1) and (2) of sect. 2 of the Act, which enumerate the principal offences against which the Act was directed, the greater part of the remainder of the statute being directed to the definition and explanation of the terms employed in the sub-sections referred to, and the provision of machinery for the prosecution and punishment of the offences created by them. In addition to the provisions relating to these offences, the Act contains a very important provision (sect. 16) prohibiting the importation of deceptively or spuriously marked goods, and some special provisions as to marks on watches (sects. 7 and 8). Two subsidiary sections of the Act, namely, sect. 17, dealing with the statutory warranty implied by the sale of marked goods (*b*), and sect. 20, imposing a penalty for false representations as to royal warrants (*c*), are considered in other chapters of this work.

Sect. 2 is divided into six sub-sections, which deal respectively with the offences against the Act, (1) and (2); penalties, (3) (*d*); destruction of forfeited articles, (4) (*e*); appeals against convictions, (5) (*f*); and prosecutions, (6) (*e*).

Sub-sections. (1) and (2) are as follows:—

Offences as to trade-marks and trade descriptions.

“ 2.—(1.) Every person who—

“ (a) forges any trade-mark; or

“ (b) falsely applies to goods any trade-mark or any mark so nearly resembling a trade-mark as to be calculated to deceive; or

“ (c) makes any die, block, machine, or other instrument for the purpose of forging, or of being used for forging, a trade-mark; or

“ (d) applies any false trade description to goods; or

(*b*) Book I., Chap. XVII., p. 431.

(*c*) Below, p. 542.

(*d*) Page 513.

(*e*) Page 514.

(*f*) Page 519.

“ (e) disposes of or has in his possession any die, block, machine, or other instrument for the purpose of forging a trade-mark; or

“ (f) causes any of the things above in this section mentioned to be done,

shall, subject to the provisions of this Act, and unless he proves that he acted without intent to defraud, be guilty of an offence against this Act.

“ (2.) Every person who sells, or exposes for, or has in his possession for, sale, or any purpose of trade or manufacture, any goods or things to which any forged trade-mark or false trade description is applied, or to which any trade-mark or mark so nearly resembling a trade-mark as to be calculated to deceive is falsely applied, as the case may be, shall, unless he proves—

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

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

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

Every person.]—Person means person or persons (*g*), and includes any body of persons corporate or unincorporate (*h*). According to the letter of the statute, therefore, a corporation or a private partnership, or trade society, could, as such, be convicted and fined for an offence under the statute. In modern cases, no difficulty has been felt in construing statutes so as to cast a duty, which is enforceable through

Offences by a corporation or a partnership.

(*g*) 52 & 53 Vict. c. 63, s. 1.

(*h*) M. M. A., s. 3 (1).

the criminal law, upon corporations (*i*), notwithstanding the objections that a corporation cannot act except through its agents, who have no authority to do any criminal or other illegal act (*k*); that a principal is never criminally liable (*l*) for the acts of his agent, which he has not specially authorised, unless expressly made so by statute in any particular case (*m*); and that a specific criminal intent cannot be attributed to a corporation (*n*). It would be a serious curtailment of the usefulness of the Act if the limited liability companies, by which so much of the trade of the country is now carried on, could not be reached by the pecuniary penalties instituted by it, for proceedings against their officers for their own share in causing or participating in the offences charged might often be inadequate to stop the mischief aimed at by the Act (*o*).

If a corporation can be convicted under the Act and fined, there seems to be no principle upon which unincorporated bodies can be held to be outside its operation. And where all the members of a partnership are individually guilty of an offence there is no further difficulty in holding the partnership itself liable also, since its property, upon which the fine inflicted would be levied, is

(*i*) See *The Queen v. Tyler*, (1891) 2 Q. B. 588, and the cases there cited; and *per* Lord Blackburn in *Pharmaceutical Society v. London and Provincial Supply Association*, 5 App. Cas. p. 869.

(*k*) *Re The Royal British Bank, Ex parte Nicol*, 3 De G. & J. 387; 28 L. J. Ch. 267.

(*l*) It was held in *The Queen v. Stephens*, L. R. 1 Q. B. 702, that the owner of works carried on by agents for his profit, might be indicted for a nuisance committed by the agents without his knowledge and against his general directions, on the ground that the case was in substance a civil proceeding.

(*m*) *Chisholm v. Doulton*, 22 Q.

B. D. 736; *Budd v. Lucas*, (1891) 1 Q. B. 408.

(*n*) On the general question of the liability of a corporation for crimes, see Brice's *Ultra Vires*, 3rd ed., Chap. XIII., and for torts, Chap. XII., and Buckley on the Companies Acts, 6th ed., pp. 104 and 494; *Barwick v. English Joint Stock Bank*, L. R. 2 Ex. 259; *Houldsworth v. City of Glasgow Bank*, 5 App. Cas. 317; and *British Mutual Banking Co., Ltd. v. Charnwood Forest Ry. Co.*, 18 Q. B. D. 714.

(*o*) See *per* Denman, C.J., in *The Queen v. Great North of England Ry. Co.*, 9 Queen's Bench Rep. 315; 16 L. J. M. C. 16.

the property of the several partners. A question may, however, arise,—if some partners establish on their own account one of the defences specified in the Act, for instance, show that they acted without intent to defraud, under sect. 2 (1), or that they complied with the provisions of sect. 2 (2), (a) and (b), while others fail to do so,—whether the partnership, and through it the innocent partners, according to their interest in its property, are liable to be fined for the offences charged, because the proceedings have been taken against the firm. The case is precisely similar to that of an offending corporation having some innocent corporators; and, it is submitted, the question must be answered in the affirmative.

As regards persons employed on behalf of others, see sect. 6 (*p*). That section does not apply to offences under the clauses in sect. 2 (1) (a), and sect. 2 (1) (e), although it is difficult to see why it should not. And as regards the acts of a servant, done in obedience to the instructions of his master, see sect. 19 (3) (*q*).

Liability of servants and workmen.

Sect. 2 (1) deals with three groups of offences: forging trade-marks, (a), (c), and (e); falsely applying trade-marks to goods, (b); and applying false trade descriptions, (d); the general clause (f) adding: causing any of the other offences to be committed.

1. Forging Trade-Marks.

“(a) Forges any trade-mark;

Sect. 2 (1).

“(c) Makes any die, block, machine, or other instrument for the purpose of forging, or of being used for forging, a trade-mark;

“(e) Disposes of or has in his possession any die, block, machine, or other instrument for the purpose of forging a trade-mark.”

Trade-mark.]—For the purposes of the Act—

What is a trade-mark.

“The expression ‘trade-mark’ means a trade-mark

(*p*) “Persons employed,” p. 501.

(*q*) Page 500.

“registered in the register of trade-marks kept under the Patents, Designs, and Trade-Marks Act, 1883, and includes any trade-mark which, either with or without registration, is protected by law in any British possession or foreign state to which the provisions of the 103rd section (*r*) of the Patents, Designs, and Trade-Marks Act, 1883, are, under Order in Council, for the time being applicable” (*rr*).

Registered
trade-mark.

The register is kept under sect. 78 of the Patents, &c. Act, and the questions: What may be Registered (*s*)? and, What is the Effect of Registration (*t*)? have already been discussed at length. Any entry made on the register without sufficient cause may be expunged or varied by the Court, upon application, under sect. 90 of the Patents, &c. Act (*u*).

Proof of registration is effected by a copy of, or extract from, the register, purporting to be certified by the comptroller, and sealed with the seal of the patent office (*x*), or by a certificate purporting to be under the hand of the comptroller (*y*).

Where the
trade-mark
is improperly
registered.

The question may arise whether registered, in the above definition, means only “actually registered,” or means “properly registered.” It is submitted that registered in fact is the true construction, for any other would, to a great extent, defeat the operation of the Act. It cannot have been intended that, in the summary proceedings before two justices contemplated by the Act, inquiries should be entered upon, such as those undertaken on applications under sect. 90, to remove trade-marks from the register, for instance, inquiries whether a registered trade-mark was a common mark or a descriptive mark, or whether, if registered as an old mark, it was, in fact, used as registered before the 13th of August, 1875 (*z*). A

(*r*) See Book I., Chap. XX., p. 454.

(*rr*) Sect. 3 (1).

(*s*) Sects. 62 and 64, Book I., Chap. VIII., p. 106.

(*t*) Sects. 75 and 76, Chap. XII., p. 252.

(*u*) Chap. XI., p. 218.

(*x*) Act of 1883, s. 89.

(*y*) Ibid., s. 96.

(*z*) See Book I., Chap. XI., p. 218,

“Rectification of the Register.”

similar question arises with regard to "the proprietor" of a registered trade-mark (*a*). By sect. 76 of the Act of 1883, the registration of a person as the proprietor of a trade-mark is *prima facie* evidence of his right to the exclusive use of the trade-mark, and is, after the expiration of five years from the date of registration, conclusive evidence of his right to the exclusive use of the trade-mark, subject to the provisions of the Act. And, in civil proceedings, it has been held, under this provision, that registration after five years is conclusive, both as to the title of the proprietor and as to the propriety of the registration itself, in the absence of an application to rectify, under sect. 90 (*b*). No doubt, if a plausible claim for rectification were seriously put forward in criminal proceedings based upon a registered trade-mark, an adjournment, to enable an application to the High Court to be made under sect. 90, would be granted pending the result of such application. And the existence of such a claim might of itself, in many cases, be sufficient to negative the intent to defraud, which is an element of each of the offences under the M. M. A., sect. 2 (1), or to show that the person charged had acted innocently, within the meaning of the M. M. A., sect. 2 (2).

The Act of 1862 applied only to trade-marks as defined by the Act (*c*). No register of trade-marks existed when the Act was passed.

The M. M. A.,
1862.

Unregistered trade-marks within the United Kingdom are not protected by the Act as trade-marks, but they are in many cases protected by the provisions relating to the application of a false trade description under the extension of that term contained in sect. 3 (2) and (3) (*d*). The number of such trade-marks in use is enormous, exceeding, it is said, the number of registered trade-marks (*e*); and, as

Unregistered
trade-marks.

(*a*) *Infra*, p. 259.

(*c*) 25 & 26 Vict. c. 88, s. 2, set

(*b*) *Apollinaris Co. v. Herrfeldt*,

out *ante*, p. 26.

4 R. P. C. 478 (1887), C. A.;

(*d*) See below, pp. 491—495.

Pinto v. Badman, 8 R. P. C. 181

(*e*) M. M. A. Report, 1887, evi-

(1891), C. A., above, p. 257 *et seq.*

dence of Mr. Courtony Boyle,

has been shown in the earlier part of this book, infringements of them, in general, can be restrained in actions for "passing off" (*f*), even where, under sect. 77 (*g*) of the Act of 1883, they do not form the subject of an action for infringement, properly so called.

Trade-marks
in British
possessions.

"British possession," in the definition of a trade-mark, means any part of her Majesty's dominions, exclusive of the United Kingdom, and where parts of such dominions are under both a central and a local legislature, all parts under the central legislature are, for the purposes of this definition, to be deemed one British possession (*h*).

By sect. 9—

Trade-mark,
how described
in pleading.

"In any indictment, pleading, proceeding, or document, in which any trade-mark or forged trade-mark is intended to be mentioned, it shall be sufficient, without further description and without any copy or facsimile, to state that trade-mark or forged trade-mark to be a trade-mark or forged trade-mark."

Forges.]—By sect. 4—

What is
forging a
trade-mark.

"A person shall be deemed to forge a trade-mark who either—

"(a) without the assent of the proprietor of the trade-mark makes that trade-mark or [*a*¹] (*i*) a mark so nearly resembling that trade-mark as to be calculated to deceive; or

"(b) falsifies any genuine trade-mark, whether by alteration, addition, effacement, or otherwise; and any trade-mark or mark so made or falsified is in this Act referred to as a forged trade-mark.

"Provided that in any prosecution for forging a trade-mark the burden of proving the assent of the proprietor shall lie on the defendant" (*k*).

Qq. 400, 420. The bulk of the cotton marks are unregistered; evidence of Mr. Wright, Q. 3981.

(*f*) Book I., Chap. XVI., p. 379.

(*g*) *Ibid.* Chap. XII., p. 266.

(*h*) Interpretation Act, 1889, sect. 18 (2).

(*i*) [*a*¹] is not in the Act.

(*k*) Below, p. 505. Cf. sect. 5 (3), p. 474.

So that the phrase covers the three distinct offences, (a), [a¹], and (b):

At common law the offence of forgery is the making or alteration of a writing or document to the prejudice of another person's right with intent to defraud (*l*), and a trade-mark is not a writing or document within the definition (*m*). But the sale of goods under a spurious mark, which the vendor knew to be spurious, has been held in many cases to constitute obtaining money by false pretences (*n*).

Forgery of a trade-mark at common law.

In *R. v. Smith* (*m*), where the prisoner was charged with having forged imitations of Borwick's baking powder labels, Pollock, C.B., said: "The issuing of this wrapper without the stuff within it would be no offence. In the printing of these wrappers there is no forgery; the real offence is the issuing them with fraudulent matter in them" (*o*). The offence under the M. M. A. is, however, complete, whether the forged trade-marks be applied to goods or not, unless intent to defraud is disproved. The application of a trade-mark, whether forged or genuine, to goods other than the goods of the proprietor of the trade-mark, is an offence under sects. 2 (1) (b), 2 (1) (d), and 3 (2).

(a) *The proprietor*—is the registered proprietor (*p*), or his assignee, who is possessed of the goodwill of the business for which the trade-mark in question was acquired and used (*q*). It has been held, in civil cases, that the assignee of a registered trade-mark need not register the assignment before commencing proceedings to restrain, or obtain damages in respect of, an infringement (*r*), and the

The proprietor.

(*l*) Not necessarily to defraud a particular person. 24 & 25 Vict. c. 98, s. 44; Archbold, 21st ed. p. 643.

(*m*) *R. v. Smith*, 8 Cox, 32; 27 L. J. M. C. 225 (1858), C. C. R.; Seb. Dig. p. 89.

(*n*) *R. v. Dundas*, 6 Cox, 380; *R. v. Ardley*, L. R. 1 C. C. R. 301; Seb. Dig. "False Pretences."

(*o*) Cf. the civil case of *Farina v. Silverlock*, above, p. 32.

(*p*) Act of 1883, sect. 78. Cf. *ante*, p. 60.

(*q*) *Ibid.* sect. 70, Book I., Chap. XIII., p. 272, Assignment and Devolution of Trade-marks.

(*r*) *Ihles v. Henshaw*, 31 C. D. 323; 3 R. P. C. 15 (1886), North, J.

rule will, no doubt, apply also in proceedings under the M. M. A. The question, whether a defendant charged under the Act can go behind the register and deny the title of the registered proprietor, has already been referred to (s).

“Proprietor” includes any body of persons, corporate or unincorporate (t).

Assent of the proprietor.

Without the assent of the proprietor, &c.]—The owner of goods of the kind which a trade-mark is properly used to indicate, that is to say, goods of the manufacture or selection, &c. (u) of the proprietor of the trade-mark, and of the class for which the trade-mark is used, is entitled to apply the trade-mark to them. He may, for instance, lawfully replace soiled labels (x), or refill, with the proprietor's goods, stamped bottles or cases, and he may label goods purchased in bulk, and broken up into smaller quantities, with the vendor's mark (y). Where such goods have been purchased of the proprietor, it is submitted, he would be estopped from denying his assent to the use of the trade-mark. In any case, such use would not be use with intent to defraud. And if it were shown that the marks made by the person charged were made solely for such use, he would not, it is submitted, be guilty of any offence under the Act. In *Farina v. Silverlock* (x), Lord Cranworth held, that the defendant, a printer, who copied the Farina Eau de Cologne labels, was not guilty of infringement if he established his allegation that he printed the copies only to replace worn-out labels properly used in connection with the plaintiff's scent, but this he, in fact, failed to do (a).

(s) *Ante*, p. 466.

(t) Sect. 3 (1).

(u) Book I., Chap. II., p. 49; Chap. XIX., p. 448.

(x) *Farina v. Silverlock*, 1 K. & J. 509; 24 L. J. Ch. 832; 6 De G. M. & G. 214; 26 L. J. Ch. 11 (1855), Wood, V.-C., and Cran-

worth, C.

(y) *Condy v. Taylor*, 56 L. T. 891 (1887), Kekewich, J., and *ante*, pp. 309, 310.

(a) 30 L. T. 242; 31 L. T. 99, Q. B.; and 4 K. & J. 650, Wood, V.-C.

[a¹] *So nearly resembling, &c.*—This is taken from the civil law with regard to trade-marks. Such resemblance is the test of infringement where a mark is not actually copied (*b*). The rules of comparison adopted in the Courts, have been stated in the earlier part of this work (*c*). And it has been shown that the persons whom the alleged spurious mark must be calculated to deceive are, in actions for infringement or passing off, taken to be any class of probable purchasers of the goods in connection with which the marks are to be used, whether the immediate purchasers from the manufacturers, the ultimate purchasers from the last retailers, or intermediate purchasers. Foreign purchasers are to be considered, if the marks circulate in foreign markets, and the bearing of their probable ignorance of the English language upon the question whether the resemblance between the marks before the Court is calculated to deceive is also material. There seems no ground for holding that buyers within the United Kingdom only are to be considered in the application of the Act.

Making a mark nearly resembling a trade-mark.

Where a trade description is used only so as to be brought to the notice of expert dealers in the goods to which it is applied, it is not treated by the Customs House authorities as false or falsely applied, under sect. 16 of the Act, if it does not deceive such dealers, although it might deceive the buyers who have no expert knowledge (*d*). It may be assumed that a corresponding construction would be applied in the case of marks which nearly resemble trade-marks.

The phrase “so nearly resembling,” &c., appears also in sect. 2 (1) (*b*) and sect. 5 (3). In sect. 3 (2), the words used are “calculated to lead persons to believe that the goods (to which a false trade description is applied) are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really

(*b*) Book I., Chap. XV., p. 314.

(*d*) See below, p. 537.

(*c*) Pages 186 *et seq.*, 314 *et seq.*

“are.” This is the deception a forged or false trade-mark is calculated to produce, and it is difficult to see how the more general expression “calculated to deceive” in the present and the first above-named sub-sections can have any different meaning.

Falsifying a trade-mark.

(b) *Falsifies any genuine trade-mark.*]—The assent of the proprietor (*e*) is no defence under this head, that is, unless it in fact negatives any intent to defraud.

This sub-section reproduces the substance of part of sect. 5 of the Act of 1862.

An alteration of a genuine trade-mark, such as to make it resemble another registered trade-mark, might fall under (a) or [a¹].

The retailer of goods bearing a trade-mark might alter the mark with intent to pass off it, and the goods upon which it appeared, as his own. The use of a trade-mark so altered would fall within sect. 2 (1) (b) and sect. 5 (1) (d) as a false application of the trade-mark, and it might also amount to the application of a false trade description within sect. 2 (1) (d) and sect. 3 (2). The sub-section is probably intended to meet cases of fraudulent alterations, such as that suggested, where no use or application can be proved.

2. Falsely applying a Trade-mark to Goods.

Sect. 2 (1).

“(b) Falsely applies to goods any trade-mark (*f*), or any mark so nearly resembling (*g*) a trade-mark as to be calculated to deceive.”

Goods.

Goods].—This is defined by sect. 3 (1) to mean anything which is the subject of trade, manufacture, or merchandise.

Trade-marks are registered only for definite classes of goods (*i*), and the rights of the proprietor of a trade-mark are restricted to goods of the class for which it is registered, and for which it is actually used or intended to be used.

(e) *Ante*, p. 470.

(f) Page 465, “trade-mark.”

(g) Page 471, “So nearly resem-

bling.”

(h) Act of 1883, sects. 65 and 66.

Book I., Chap. V., p. 87.

He can have no right in respect of its user upon goods in which he does not deal (*i*). It is submitted, upon the same principle, that it would not be an offence under this head to apply a trade-mark registered for cotton goods, for instance, to ironware, without the assent of the proprietor of the trade-mark, even if such use could be held to be a use with intent to defraud.

Applies to goods.]—By sect. 5—

Sect. 5 (1).

“(1.) A person shall be deemed to apply a trade-mark or a mark or a trade description to goods who—

Applying
marks and
descriptions.

“(a) applies it to the goods themselves; or

“(b) applies it to any covering, label, reel, or other thing in or with which the goods are sold or exposed or had in possession for any purpose of sale, trade, or manufacture; or

“(c) places, or encloses, or annexes any goods which are sold or exposed or had in possession for any purpose of sale, trade, or manufacture, in, with, or to any covering, label, reel or other thing to which a trade-mark or trade description has been applied; or

“(d) uses a trade-mark or mark or trade description in any manner calculated to lead to the belief that the goods in connection with which it is used are designated or described by that trade-mark or mark or trade description.

“(2.) The expression ‘covering’ includes any stopper, cask, bottle, vessel, box, cover, capsule, case, frame, or wrapper; and the expression ‘label’ includes any band or ticket.

Sect. 5 (2).

Covering.

Label.

“A trade-mark, or a mark, or trade description, shall be deemed to be applied whether it is woven, impressed, or otherwise worked into, or annexed, or affixed to the goods, or to any covering, label, reel, or other thing” (*k*).

What is a sufficient application of a spurious trade-mark

(*i*) See above, p. 256.

(*k*) For sect. 5 (3) see next page.

to goods to constitute an infringement, has already been considered (*l*).

Sub-sect. (1) (*o*) covers such cases as the refilling of bottles to which a trade-mark or trade description has previously been applied (*m*).

Sub-sect. (1) (*d*) is exceedingly general in its terms. It has been held, in cases of trade description, to extend to a description in an invoice sent with the goods (*n*). In *Starey v. Chilworth Gunpowder Co.* (*o*), the false trade description was painted on the barrels in which gunpowder was delivered by government contractors to the government agents.

The words "calculated to lead to the belief," &c., at the end of the sub-section, may be compared with the corresponding words "calculated to deceive," used elsewhere in the Act (*p*).

Falsely applies, &c.].—By sect. 5—

"(3.) A person (*q*) shall be deemed to falsely apply to goods (*r*) a trade-mark or mark, who without the assent of the proprietor (*s*) of a trade-mark (*t*) applies (*u*) such trade-mark, or a mark so nearly resembling it as to be calculated to deceive (*x*); but in any prosecution for falsely applying a trade-mark or mark to goods the burden of proving the assent of the proprietor shall lie on the defendant" (*y*).

This sub-section corresponds to sect. 4 (*a*) (*z*), defining the offence of forging a trade-mark. The reference in it to a mark resembling a trade-mark is redundant, as to

(*l*) See above, pp. 310 and 413.

(*m*) As in *Wood v. Burgess*, 24 Q. B. D. 162 (1889), a case under the Act; and the earlier infringement cases, cited on p. 310, *ante*.

(*n*) *Budd v. Lucas*, (1891) 1 Q. B. 408, Pollock and Charles, JJ.

(*o*) 24 Q. B. D. 90 (1888), Coleridge, L.C.J., and Mathew, J.

(*p*) See above, p. 471.

(*q*) "Person," p. 463.

(*r*) "Goods," p. 472.

(*s*) "Proprietor," p. 469; "assent of the proprietor," p. 470.

(*t*) "Trade-mark," p. 465.

(*u*) "Applies to goods," p. 473.

(*x*) "So nearly resembling," p. 471.

(*y*) Below, p. 505; cf. sect. 4, p. 468.

(*z*) Page 468.

falsely apply a mark so nearly resembling a trade-mark, &c. is, by sect. 2 (1) (b), declared to be a distinct offence.

3. Applying a False Trade Description to Goods.

“(d) Applies any false trade description to goods” (a). Sect. 2 (1) (d).

The sale of goods under a false trade description may constitute an offence of cheating or obtaining goods by false pretences at common law. The application of a false trade description was made a substantive offence by the Act of 1862, from which Act the provisions in the present Act under this head are substantially taken. That Act did not, and the present Act does not, extend to descriptions of quality as apart from kind, but it is the intention of the present Act, under the sections dealing with trade-marks, of which the office is to indicate the maker, vendor, or selector of the marked goods (b), and which are, therefore, of the nature of trade descriptions, and under the sections dealing with false trade descriptions, extended by sect. 3 (2) and (3) to marks in general which fill the office of trade-marks, to reach all false merchandise marks, other than marks of quality (c).

The Act does not extend to false descriptions of quality.

(a) “Goods,” p. 472.

(b) See Book I., Chap. II., p. 49.

(c) *Quality*.—Adulteration, or the sale of goods not of the nature or quality demanded, or pretended, is made a criminal offence by other statutes in many special instances. By far the most important of these statutes are the Sale of Food and Drugs Acts, 1875 and 1879 (38 & 39 Vict. c. 63, and 42 & 43 Vict. c. 30), by which it is an offence to mix injurious ingredients with any article of food, or any drug, with intent that the same may be sold, or to sell the article of food or drug so mixed; to sell articles of food or drugs not of the nature, substance, and quality demanded by the purchaser; and to abstract

from an article of food, with intent that the same may be sold without notice, any part of it so as injuriously to affect its quality, substance, or nature, or to sell (without notice) the article so altered. For cases under these Acts see the Law Reports Digest “Adulteration.” Among other statutes may be mentioned 6 & 7 Will. 4, c. 37 (Bread); 4 Geo. 2, c. 14, 17 Geo. 3, c. 29 (Tea); 5 Geo. 1, c. 11, s. 23 (coffee); 37 & 38 Vict. c. 49, s. 14, 48 & 49 Vict. c. 51, s. 8 (beer); 32 & 33 Vict. c. 112 (seeds); 56 & 57 Vict. c. 56 (agricultural fertilizers and feeding stuffs); and the Margarine Act, 50 & 51 Vict. c. 29.

Trade description.]—By sect. 3 (1)—

What is a trade description.

“The expression ‘trade description’ means any description, statement, or other indication, direct or indirect,—

“ (a) as to the number, quantity, measure, gauge, or weight of any goods, or

“ (b) as to the place or country in which any goods were made or produced, or

“ (c) as to the mode of manufacturing or producing any goods, or

“ (d) As to the material of which any goods are composed, or

“ (e) As to any goods being the subject of an existing patent, privilege, or copyright,

Customary trade description.

and the use of any figure (*d*), word, or mark which, according to the custom of the trade, is commonly taken to be an indication of any of the above matters, shall be deemed to be a trade description within the meaning of this Act.”

M. M. A., 1891.

Customs entry.

And by the M. M. A. 1891, s. 1 it is provided that—

“ [f] the Customs entry (*e*) relating to imported goods shall, for the purposes of the M. M. A. 1887, be deemed to be a trade description applied to goods.”

Verbal trade description.

It has been held by a stipendiary magistrate at Sheffield, that a false trade description within the Act may be verbal (*f*). This was decided upon the construction of sect. 5 (1) (d), which provides that a person shall be deemed to apply a trade description who uses it in any manner calculated to lead to the belief that the goods in connection with which it is used are designated or described by it. But this is not the common view of the construction

(*d*) *i.e.*, numeral. *Ex parte Stephens*, 3 C. D. 660, see above, p. 165.

(*e*) See p. 486, below.

(*f*) German-made scissors were

verbally described and sold as Sheffield made. The newspaper report of the case is set out in M. M. A. Report, 1890, p. 359. but there is no judgment.

of that sub-section (*g*), and Mr. Poland, Q.C., has advised that to make a verbal false statement, is not to apply a false trade description within the meaning of the Act (*h*). It is submitted that this opinion is correct, for every other part of the Act deals with marks or statements which are in writing, and sect. 5 (1) (*d*) itself couples trade descriptions with trade-marks and marks which cannot be verbal statements. And it is hardly consistent with the ordinary employment of the words to speak of "the use" of a verbal statement, for use suggests the idea of repetition, and therefore of permanence in the thing used. Sect. 17 of the Act, which deals with implied warranties of trade-marks and trade descriptions, seems to contrast (among other things) a trade description with a verbal statement, since it cannot have been intended that the purchaser should be able to set up a warranty upon a verbal statement, and that the vendor should be required by the section to refer to a signed writing to contradict it. And the Act throughout appears to relate to descriptions which are permanent and capable of giving information to, or deceiving, or being calculated to suggest beliefs to any persons who may see them, not merely the persons to whom they are spoken. The definition above given, by which trade description means any description, *statement*, or other indication, throws no light on the question, since statement may reasonably be understood to mean written statement. It is expressly provided that a trade description shall be deemed to be applied whether it is woven, impressed, or otherwise worked into, or annexed, or affixed to the goods, or to any covering, label, reel, or other thing (*i*), and this sub-section can only have been drafted upon the assumption that, without it, the trade descriptions referred to in the Act would, or might, be confined to descriptions written, printed, or painted in the ordinary way.

(*g*) Cf. Mr. Hughes' evidence, M. M. A. Report, 1890, Q. 4994.

(*h*) See the case and opinion set out M. M. A. Report, p. 166.

(*i*) Sect. 5 (2), p. 473.

Frauds effected under cover of verbal false descriptions.

Imitation Demarara sugar.

The non-inclusion of verbal statements leaves a large class of frauds untouched by the Act. Goods, for instance, which have passed through the Customs under cover of an explanation placed upon their coverings may be sold retail without the explanation, and with a verbal false description; as, of course, may also goods which, bearing no description at all, or no false description, could not be stopped on importation, or home-made goods. In his opinion, on the case above referred to (*k*), Mr. Poland, Q.C., expressed the view that the imitation of the crystals of Demarara sugar in beet-root sugar, and its sale as Demarara sugar, was not an offence under the Act. Sales upon such verbal false statements may, however, amount to the offence of cheating, or obtaining money by false pretences (*l*), if they are deliberate false statements of matters of fact known to the person charged, and are made in order to induce, and do actually induce, the buyer to purchase.

Imitations of "get-up."

Goods may be passed off as those of the manufacture or merchandise of some person other than the person whose they are, without any explicit description of them as the goods of the first person, or any piracy or colourable imitation of his trade-mark or trade-name. This fraud forms the ground of a civil action (*m*). Such imitations are false trade descriptions applied to the goods under sect. 3 (2) (*n*).

Words forming part of the goods.

Words forming part of the goods upon which they appear cannot, it would seem, be taken to be a trade description applied to those goods within the meaning of the Act, although they may, in fact, give or suggest some description, statement, or other indication within the definition just cited, for the description is treated in the definition as an addition to the "goods," which are complete without it. This is the view taken by the Customs

(*k*) *Ante*, p. 477.

(*l*) *Ante*, p. 469.

(*m*) Book I., Chap. XVI., p. 379.

(*n*) *Infra*, p. 491.

authorities in the application of sect. 16 (o). For instance, English words in verses on Christmas cards; the title of a book; the words *fast* and *slow* upon the regulator of a watch; mottoes and words of friendship on handkerchiefs, crockery, and so forth, are not treated by the Customs authorities as indications that the goods were produced in an English-speaking country. "On *such* goods, made abroad, it has been thought" by the Customs authorities "wiser to regard (with some exceptions) English wording which goes no farther than above mentioned (that is to say, which does not go into such statements as 'printed in England,' or 'very superfine cards,' or 'London lever watch,' &c.), as part of the 'goods,' and as not, therefore, rendering the goods liable under the Act, even though the general appearance given to them may be on this account, and on account of the wording, unquestionably English" (p).

The trade description may be a trade-mark or part of a trade-mark (q), or may include a trade-mark (r); but the case of a false name or initials is dealt with specially (s). Trade description may be a trade-mark.

(a.) *Number, &c.*]—This sub-section is directed to descriptions applied to coverings (t) purporting to contain a specified or indicated number, quantity, &c. of goods, as well as to descriptions attached to the goods themselves. It meets frauds, such as the practice of marking upon cotton goods the number of laps or folds by a figure so placed as to be "commonly taken" to indicate the number of yards in the marked piece, the true number of yards being in fact less than the number marked (u). Number.

It has been questioned whether the words in the clause cover indications of width, dimension, and weight per unit

(o) See M. M. A. Report, 1890, Appendix I., p. 276, a paper handed in by Mr. Follett, Solicitor of the Board of Customs, from which the illustrations in the text are taken.

(p) From the paper referred to in the last note.

(q) Sect. 3 (1). "False trade description," p. 478.

(r) Sect. 3 (2), p. 491.

(s) Sect. 3 (3), p. 493.

(t) Sect. 5 (2), p. 473.

(u) See the evidence of Mr. Bailey, Qq. 1866 *et seq.* M. M. A. Report, 1890.

of length, which are of great importance in the textile trades; but it is submitted that they do, and it is said, that the Manchester magistrates have so construed them (v).

Measure.]—The description of casks of beer as *barrels* in an invoice sent with them, has been held to be a statement within the definition that the casks contain thirty-six gallons each (x).

Weight.]—In a civil case it has been held that goods done up in cases and supplied according to contract, the cases being marked as one pound cases, could not be forced upon a purchaser if they were actually under the weights indicated, although not deficient by more than an alleged customary allowance, on the ground that the purchaser could not sell them without committing an offence under the Act (y).

(b.) *Place or country.*]—This sub-section was regarded by many of the advocates of the bill as the most important clause of the definition; it is under cover of it that goods made abroad and so marked as to suggest that they are made in England, are brought within the Act, and are made liable to seizure by the Customs authorities in accordance with sect. 16 (z).

Place of
origin.

The chief difficulty in the application of this clause of the definition arises from the fact that the clause is apparently framed on the assumption that all goods will be wholly made or produced in one place or country, whereas, in fact, many kinds of goods are worked upon in several before they are finished and ready for the market, or are made up of parts made or produced in different countries. The difficulty, however, is partly met by the definition of a false trade description as one which is false

(v) See note (u) on previous page.

(x) *Budd v. Lucas*, (1891) 1 Q. B. 408, Pollock, B., and Charles, J.

(y) *Hooper v. Balfour*, W. N. (1890) 61; 62 L. T. 646; *Green and Balfour's Arbitration*, W. N. (1890)

139, 156, Kay, J., and C. A.

(z) And in accordance with the agreements arrived at by the Commissioners at the International Convention, Conference of Rome, in 1886. This convention has not been ratified.

in a material respect, for this reduces it to a question of fact. No doubt any Court, in determining whether the indication of a particular country as the place of manufacture was false in this sense or not, would be guided by the custom of the trade in the goods concerned, that is, supposing it to be consistent with honesty. The description of goods, partly made in each of two countries, as made in a third, would, it may be assumed, be indefensible under any custom, unless it fell within the general saving of sect. 18 as a "conventional" or "generic" description lawfully and generally used at the passing of the Act, as, for instance, *French polish*, *American leather*, or *Indian rubber*. The last-mentioned section, however, extends to a trade description of place or country, calculated to mislead as to the place or country where the goods to which it is applied were actually made or produced, the goods not being actually made or produced in the place or country indicated or suggested, only if there is added to the trade description, immediately before or after the name of that place or country, in an equally conspicuous manner with that name, the name of the place or country in which the goods were actually made or produced, with a statement that they were made or produced there (a). From this has arisen the now familiar notices, "made in Germany," "made in France," &c.

It is to be observed that the provision in sect. 18 requiring the addition of the name of the place or country of actual manufacture is only applicable where the trade description is calculated to mislead (b). It is not necessary, for instance, to mark *Morocco* leather or *Brussels* carpets as made in England, since the term is not calculated to lead any buyer to think the leather was made in Morocco or the carpet in Brussels.

By sect. 10 (2)—

"In the case of imported goods, evidence of the port of shipment shall be *prima facie* evidence of the place or country in which the goods were made or produced."

Evidence of country of origin.

And the port of shipment is stated in the Customs

(a) Sect. 18, *infra*, p. 493.

(b) Cf. "So nearly resembling," *ante*, p. 471.

entry (c), which is now itself a trade description applied to the goods referred to by it (d).

Customs practice as to country of origin.

The practice of the Customs authorities, under sect. 16, with regard to the matters above referred to, was described by Mr. Follett, to the Committee of 1890, in the following terms (e): "As general rules, the board have acted on the principle that goods must (as indeed is in accordance with sect. 10 of the Act) be held *prima facie* to have been the make or produce of the country from which they last come; and that if a qualifying description to that effect is remonstrated against on the ground that it would be untrue as to a material part, there must be a statement as to that part. For instance, if there were an importation of German cutlery with the name of an English dealer, and a qualification of *made abroad* were objected to on the ground that the handles (taking it to be knives), or the woodwork (taking it to be planes), were made in England and sent out by the dealer to be fitted, then it would be required that these should be stated, *blades (or woodwork) made in Germany*. Similarly (although as to the important part of the goods the circumstances are just reversed), it was required that if British goods were sent abroad to be finished in any respect, as, for instance, yarns to be dyed, that fact must be stated, *dyed abroad*, when they are re-imported.

Goods finished abroad.

Foreign goods finished in England.

"As regards goods coming in in an incomplete state, or merely as parts of an intended complete article, the board have felt that they could do no more than deal with them as they stand, taking care that there is no description either of the parts themselves, or of the whole goods to which they are going to be added, which can form an incorrect indication as to the make of the imported portion."

Imports from inland country.

In the case of goods imported through the ports of a country other than that of their origin, for example, Swiss goods coming through a French port, and marked as Swiss, the practice of the authorities is to detain them until a declaration by the importer, or other evidence regarded as satisfactory, is tendered to show that the goods are in fact Swiss.

(c) Below, p. 486.

(d) M. M. A., 1891, s. 1.

(e) *Ante*, p. 479, n.

It has recently been held in an Irish case that the description of bacon, which was killed in America and was cured by the defendant Lipton, partly in America and partly in Ireland, as "Lipton's cure," and "own cure at Lipton's market," was not a false trade description, although the magistrates and one of the judges who heard the case thought the use of the description by an Irish shopkeeper was likely to be deceptive (*ee*).

It is provided by sect. 16 (4) (*f*) that—

"Where there is on any goods a name which is identical with or a colourable imitation of the name of a place in the United Kingdom, that name, unless accompanied by the name of the country in which such place is situate, shall be treated for the purposes of this section as if it were the name of a place in the United Kingdom."

Goods bearing the name of an English place.

This provision is expressly restricted to the purposes of the section in which it occurs, that is, the section dealing with the importation of deceptively or spuriously marked goods, but the rule laid down in the clause would probably be adopted in regard to any suggested false trade description by the use upon goods of a name like the name of an English, Scotch, or Irish place. Goods marked simply "Rugby," for example, would be taken to be falsely described if made in Rugby, Tennessee.

(*c*.) *Mode of manufacturing, &c.*]—In the Irish case referred to above it was also held that the description in question was not an offence within this clause (*ee*).

(*d*.) *Material, &c.*]—In a case where goods were marked and described as "natural wool" goods, this was held by the magistrates at Leicester to be an indication within the definition that the goods were all, or substantially all, woollen, although a custom to call cheap mixtures of cotton and a little wool "natural wool" was alleged (*g*).

Material.

(*ee*) *R. v. Lipton*, 32 L. R. Ir. "customs entry," p. 486.
115 (1892), Q. B. D.

(*g*) *Times Newspaper*, 20 Oct.,

(*f*) See further, p. 535, and 1893.

Patent.

(e.) *Existing patent.*]—By sect. 105 of the Patents, &c. Act, 1883, it is provided that—

Sect. 105 of
the Act of
1883.

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

“(2) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade-mark is registered if he sells the article with the word ‘patent,’ ‘patented,’ ‘registered,’ or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to the article.”

Application for a patent (*h*), or provisional protection (*i*), does not authorize the use of the words patent or patented so as to avoid the penalty of this enactment; but the acceptance of the complete specification for a patent does, for it entitles the applicant to “the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance” (*k*).

The section just cited from the Patents, &c. Act does not apply to the case of a representation in respect of an article for which a patent has at some time been granted, but which has ceased to exist by effluxion of time or otherwise; the M. M. A. is not so limited. On the other hand, the section applies to every representation within its terms, whether made with intent to defraud or not.

There is no provision similar to sub-sect. (2) of the above section in the M. M. A., and the use of the words patent or patented does not necessarily, therefore, amount to a description, statement, or other indication that the goods to which they are applied are subject to an existing patent. A false claim of patent rights contained in a trade-mark is a bar to the interference of the Court for

(*h*) So held by a magistrate in *R. v. Crampton*, 3 R. P. C. 367 (1886).

(*i*) So held by a magistrate in *R. v. Wallis*, 3 R. P. C. 1 (1886).

(*k*) Act of 1883, sect. 15.

the protection of the trade-mark, and the cases decided on this subject will, no doubt, apply, so far as they go, in the construction of the present sub-section, but they do not lay down any definite rules (*l*).

In *Gridley v. Swinborne* (*m*), a case under the present Act, Coleridge, L.C.J., said, that where the original patentee continued to use his old labels containing the word *patent*, there was no necessary implication of fraud, and the Court held that the defendant, who had sold goods, made from gelatine, under a patent which expired in 1847, as *Swinborne's patent refined isinglass*, was not guilty of any offence under the Act.

Custom of the trade (*n*).]—Custom does not here mean the custom of merchants, which is part of the common law (*o*), or any of the six *consuetudines* mentioned by Coke (*p*). It is more akin to the custom or usage of a particular trade or market which is resorted to in order to import terms into commercial contracts not inconsistent with their words, or to explain the meaning of the expressions employed in them, that is, a particular custom to be established by evidence (*q*), or to the “custom of the country” imported into agricultural tenancies and leases, of which it is said it “must be applied to the approved habits of husbandry in the neighbourhood under circumstances of the like nature” (*r*). The custom is, therefore, the existing and generally recognized practice or usage of the trade, whether old or recent; but if recent, sufficiently old to have become generally recognized and followed (*s*).

Custom of the trade.

The words may be compared to those used in the first

(*l*) See Book I., Chap. XV., p. 339, above.

(*m*) 52 J. P. 739, 791; 5 T. L. R. 71 (1888), Coleridge, L.C.J., and Grantham, J.

(*n*) Cf. “Common repute” in sect. 7, below, p. 522.

(*o*) Blackstone, Vol. 1, p. 74.

(*p*) 2 Inst. 58.

(*q*) See *Wriggleworth v. Dallison*, 1 Smith L. C. 8th ed., p. 569, and

the cases cited in the notes.

(*r*) 2 Platt, 279, cited in Stroud's Dic. s. v.

(*s*) “Usago of trade is a general and prevailing course of business, and witnesses who are called to prove it should cause their minds to revolve over instances known to them of its having been acted upon.” *Hall v. Benson*, 7 C. & P. 711.

sentence of sect. 18—"lawfully and generally applied to goods of a particular class, or manufactured by a particular method, to indicate the particular class or method of manufacture of such goods" (t).

In judging whether an alleged trade-mark, or a mark tendered for registration as a trade-mark, is calculated to deceive by reason of its resemblance to another trade-mark or otherwise, the Civil Courts, as has already been shown, consider all the circumstances of the trade concerned, and admit the evidence of persons engaged in the trade as experts (u).

The evidence to prove a custom within the definition above stated, must obviously be similar to the expert evidence just mentioned, that is to say, it must be given by persons engaged in the trade, whether as manufacturers, merchants, or retailers, or by persons in the employment of such persons, or otherwise practically acquainted (for instance, as conductors of technical or trade journals), with the customs they depose to.

In a case where an alleged custom in the furniture trade, to deliver goods upon sale or return, was set up in answer to a claim under the reputed ownership clauses of the Bankruptcy Act, Cave, J. said the question was, "whether it amounted to a custom of the trade of so notorious a character that anyone making inquiry of persons cognizant of the trade might ascertain that it was a custom" (v).

Customs
entry.

[*Customs entry.*]—The Customs entry for imported goods is a statement made up from the bill of lading (x) for purposes of Customs duty, and signed and declared to be true by the importer or his agent. It contains the name of the port or place from whence the goods come, and a description of the number of packages and of the quantity

(t) See p. 498.

(u) Book I., Chapter X., "Restrictions on Registration," pp. 197, 205.

(v) *Ex parte Nassau*, 2 T. L. R. 339 (1886).

(x) See Mr. Seymour's evidence, M. M. A. Report, 1890, Q. 4824.

and description of goods, in accordance with the requirements of the Official Import List. It was made a trade description under the principal Act by the Act of 1891, upon the recommendation of the Committee of 1890, and in accordance with the following passage from their report :

“The evidence given before your Committee has, in their opinion, conclusively proved that goods (notably, articles of consumption) come into this country in large quantities in an adulterated form, but cannot, according to the evidence given by the Customs authorities, be detained under sect. 3 (d) (y) of the M. M. A., because, in most instances, they bear no trade description, as defined by sects. 3 and 5 of the said Act. Your Committee are of opinion that much harm is being done to legitimate trade by the impunity with which spurious articles are introduced into this country. They therefore propose that the Act should be amended by making the Customs ‘entry,’ which must bear a description of the goods imported, a ‘trade description’ within the meaning of the Act. The adoption of this amendment would, in the opinion of your Committee, give the Customs power to detain goods, the ‘trade description’ of which is false as to the material of which they are composed.”

Report of the M. M. A. Committee of 1890 on fraudulent importations.

The Committee refused to recommend that it should be made compulsory to mark all goods with an indication of origin, on the ground that this “would seriously restrict trade, and virtually destroy the business of warehousemen, commission agents, and small masters.”

No general obligation to mark the place of origin.

False trade description (s).]—By sect. 3 (1)—

“The expression ‘false trade description’ means a trade description which is false in a material respect as regards the goods to which it is applied, and includes every alteration of a trade description, whether by way of addition, effacement, or otherwise, where that alteration makes the description false in a material

What is a false trade description.

(y) False trade description as to the material of which any goods are composed.

(z) “Trade description,” p. 476.

“respect, and the fact that a trade description is a trade-mark, or part of a trade-mark, shall not prevent such trade description being a false trade description within the meaning of this Act.”

The last part of the definition would have been more appropriately placed in the definition a “trade description” (a).

The “false name or initials of a person” is specially dealt with by sect. 3 (3) (b), and the definition just stated is expanded by sect. 3 (2), which is set out below (c).

So that “false trade description” under the Act includes—

- (1.) A trade description false in a material respect as regards the goods to which it is applied.
- (2.) An alteration of a trade description, whether false or not, such as to make it false in a material respect.
- (3.) Figures, words, or marks, or an arrangement or combination thereof, such as are reasonably calculated to lead persons to believe that the goods to which they are applied are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are (sect. 3 (2)).

- (4.) A false name or initials within sect. 3 (3) (b).

False.]—False is construed by the Customs authorities in the application of sect. 16 to mean, not “misleading” but simply “untrue” (d). The expression “false description” is taken from the Act of 1862, s. 7, where it certainly means a description intended to deceive, since it is coupled with the phrase “for the purpose of falsely indicating, &c.,” but the construction just mentioned seems, on the whole, to be that intended by the Act, for *false* is contrasted with *genuine* in sects. 2 (2) (a), 4 (b), 6 (c), and 17; false declarations are referred to in sect. 8 (3); and sect. 18 seems

(a) “Trade description,” p. 476.

(b) Below, p. 493.

(c) Page 491.

(d) See Mr. Follett's evidence, ante, p. 479, n.

to contemplate that some false descriptions within its scope may not be misleading. It is doubtful, however, whether, for the purposes of the Act, there is any substantial difference in effect between the two meanings. The essence of a description is that it should suggest something, and if it suggests what is untrue, it is misleading.

In *The Patent Isinglass Case (c)*, Coleridge, L.C.J., said that a false description within the Act meant something more than a mere inaccurate or mistaken description. There must be a criminal intent, a *mens rea* in the application; this is inferred because the Act creates criminal offence, and the construction adopted is consistent with the reference to "intent to defraud" in sect. 2 (1), and the defence that the person charged had "acted innocently," which is admitted by sect. 2 (2).

False in a material respect.]—This expression was chosen, after much consideration, to meet the case of descriptions which are partly false; for instance, descriptions of mixed or composite goods, referring to some or one only of their composite parts. The clause was inserted "because it was considered impossible to test the exact percentage of a particular material, the name of which was signed to the article" (*f*). Under it, the Court is left to decide as a question of fact whether it is false, for example, to describe textile goods made partly of cotton as *natural wool (g)*; a cask containing less than thirty-six gallons of beer as a barrel (*h*); gelatine made from eod sounds as patent isinglass (*i*); or a watch with an English case and an English movement but a Swiss regulator, as an English watch (*k*); or, generally, goods partly made in the United

Material
respect.

(c) *Gridley v. Swinborne*, 52 J. P. 739, 791; 5 T. L. R. 71 (1888).

(f) See the evidence of Mr. Courtenay Boyle, assistant secretary to the Board of Trade, M. M. A. Report, 1887, Qq. 38 *et seq.*

(g) See *The Leicester Case*, *ante*, p. 483, *Times Newspaper*, 20 Oct., 1893.

(h) *Budd v. Lucas*, (1891), 1 Q. B. 408.

(i) *Gridley v. Swinborne*, 52 J. P. 739, 791; 5 T. L. R. 71 (1888).

(k) As to watches, see sect. 7, below, p. 522. It is said that all English watches have Swiss regulators.

Kingdom and partly abroad, as made in the United Kingdom (*l*).

Materially or substantially false.

“False in a material respect” is here treated as equivalent to materially or substantially false, so that the question is one of degree, and as regards some of the attributes referred to in the definition of trade description, no other meaning could be given to it. A description of weight, for example, can only be false by being too great or too small. But, as regards some of the other attributes referred to, the phrase seems more properly to mean that the matter falsely stated is material to be truly stated to the persons concerned, that is, the probable buyers, or others to whom the description is addressed. For example, if goods go through different stages in the course of manufacture in different countries, it is conceivable that only the country where they are finished, or where any other particular stage is passed, is material to be named (*m*), and that, therefore, for the purposes of the Act, the goods may be well described only as made in that country. So, if the material of which goods are made is a metallic alloy, as the gold of commerce, it may be immaterial to state truly the nature of the baser metal (provided there is no false statement as to its absence, or its proportion in the mixture).

Limits of error allowed.

The Committee of 1890 were strongly urged to recommend the adoption, as part of the Act, of certain definite limits in regard to measure, within which a deficiency from the measure actually indicated by a trade description should not be, but beyond which it should be deemed to be, false in a material respect; but they declined to suggest the enactment as a rule of law of what they regarded as properly a matter of evidence.

The limits suggested by the Manchester Chamber of Commerce, in 1888, and adopted under the Indian Merchandise Marks Act, are set out in the Appendix (*n*).

(*l*) See p. 480, “place or country,” and *R. v. Lipton*, ante, p. 483.

(*m*) Cf. the case of watches, below, p. 524.

(*n*) Page 705. M. M. A. Report, 1890, p. 322. Evidence of Mr. Bailey, Q. 2024.

Alteration.]—The person who makes the alteration which causes the trade description to be false, applies the false trade description (*o*). Alteration
of a trade
description.

This clause of the definition relates only to alterations of the description, not to alterations of the goods described so that the description becomes false as applied to them. An alteration, for example, by the adulteration of marked goods, such as to make them cease to be the goods described, may be an offence against the Act, if, within sect. 5 (1) (c) or (d), the person making the alteration applies the description to the altered goods, since it is false as regards them.

Applies any false trade description.]—Sect. 5 defines when a person shall be deemed to apply a trade description to goods. It has been already set out (*p*).

By sect. 3—

“(2.) The provisions of this Act respecting the application of a false trade description to goods shall extend to the application to goods (*q*) of any such figures (*r*), words (*s*), or marks, or arrangement or combination thereof, whether including a trade-mark or not, as are reasonably calculated to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are.”

This sub-section does not in terms refer to goods to which a false trade description has been applied, as the next and corresponding sub-sect. 3 (3) does. It is difficult to see any reason for the change of language, and, it is submitted, it makes no difference in the construction of the Act, for it is not possible to extend the definition of “application” without extending correspondingly the class of things to which the application is made.

(*o*) Cf. forgery of a trade-mark by altering a genuine trade-mark, sect. 4 (b), above, p. 468.

(*p*) Above, p. 473.

(*q*) See sect. 5, above, p. 473.

(*r*) *i. e.*, numerals. *Ex parte Stephens*, 3 C. D. 659 (1876), Jessel, M.R.

(*s*) For names and initials, see sect. 3 (3), below, p. 493.

The name *Chilworth Gunpowder Co., Ltd.*, placed by contractors for the supply of gunpowder to the Government, upon barrels of powder, in the place where the name of the contractor was required to be inserted, was held in *Starey v. Chilworth Gunpowder Co. (t)*, to be a false trade description, the powder being imported German powder, and not the manufacture of the defendants, and it being clear, as the Court held, that, in the particular case, contractor meant manufacturer, the defendants having dealt with the Government as manufacturers only, although it is commonly a word of ambiguous meaning, capable of signifying either maker or vendor, or both. This decision must have been under sect. 3 (2), for sect. 3 (3) did not apply; but the question suggested above was not argued or referred to.

An unregistered trade-mark may be a trade description.

The sub-section makes the offence of applying a false trade description include that of forging a (registered) trade-mark, which is itself a separate offence under sect. 2 (1) (a), and also that of forging a trade-mark which is unregistered and not a trade-mark within the meaning of the Act (u), for the office of a trade-mark is to indicate that goods are the manufacture or merchandise of the persons with whose business or goods the trade-mark is identified by registration or use.

Names and initials.

The following sub-section deals with false names and initials. That sub-section may possibly be held to be restricted to a very small class of such names and initials (x), and the question may then arise whether names and initials which are so used as not to fall within it, are *words* within the present sub-section. On a strict construction it may be difficult to hold that a general word in one sub-section can include a particular meaning introduced by an appropriate word into a co-ordinate sub-section immediately following the first; but there are many cases of overlapping sections

(t) 24 Q. B. D. 90 (1889),
Coleridge, L.C.J., and Mathew, J.

(u) See sect. 3 (i), above, p. 465,
"trade-mark."

(x) See below, p. 494.

and provisions in the present Act, and, if it be necessary in order to carry out the obvious intention of the Act, it is submitted that the interpretation suggested ought to be adopted.

Calculated to lead, &c.]—The phrase may be compared with “calculated to deceive,” of sect. 2 (2) and 4 (a) (y), “intent to defraud” of sect. 2 (1) (z). The persons intended are any class of probable purchasers of, or dealers in, the goods, so that it would be no defence to prove that the immediate purchasers, the persons to whom the goods falsely described were sold, if the offence were committed upon a sale, were not in fact deceived. This is the rule adopted in infringement cases (a). In such cases proof of actual deception is not a necessary part of the plaintiff’s case (b), although its unexplained absence may be significant, if the alleged deceptive mark has been long in the market (c); and it is no excuse for the defendant to show that the actual buyers from him of the spuriously marked goods knew whose goods they were. They generally do know, and are parties to the intended frauds (d).

Calculated to lead persons to believe, &c.

(4.) By sect. 3—

“(3.) The provisions of this Act respecting the application of a false trade description to goods, or respecting goods to which a false trade description is applied (e), shall extend to the application to goods of any false name or initials of a person (f), and to goods with the false (g) name or initials of a person applied, in like manner as if such name or initials were a trade description, and for the purpose of this enactment the expression false name or initials means,

False name or initials.

(y) Above, p. 471.

(z) Page 507, *post*.

(a) See Book I., Chap. X., p. 186; Chap. XV., p. 318.

(b) Above, p. 316.

(c) Page 206.

(d) *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 472 (1887), C. A., cited

p. 363.

(e) This clause is omitted from the last sub-section 3 (2).

(f) “Person,” sect. 3 (1), p. 463.

(g) Cf. “false trade description,” sect. 3 (1), p. 487, and “falsely apply,” sect. 5 (3), p. 474.

“as applied to any goods, any name or initials of a person which—

“ (a) are not a trade-mark (*h*) or part of a trade-mark, and

“ (b) are identical with, or a colourable imitation of the name or initials of a person carrying on business in connection with goods of the same description, and not having authorized the use of such name or initials, and (*i*)

“ (c) are either those of a fictitious person or of some person not *bonâ fide* carrying on business in connection with such goods.”

This is an awkwardly drawn sub-section, not in harmony with the remainder of the Act. The insertion of the negative clause (a), for instance, is not in accord with the general plan of allowing sections creating similar and similarly punished offences to overlap, and the expression colourable imitation is in other sections represented by the phrase “so nearly resembling, &c.”

The sub-section seems to be intended to extend the protection of the Act to trade-names which are protected by the civil law much in the same way as trade-marks (*j*), and also to stay frauds perpetrated by the use of “blind names” (*k*), that is, names belonging, in fact, to no one, but so used as to appear to be the names of respectable firms.

By the letter of the sub-section, a name or initials, to fall within its terms must fulfil each of the conditions (a), and (b), and (c); but it is submitted that the second *and* should be *or*, for no name can be identical with the name of a person carrying on business in connection with the goods, and at the same time be that of a person not *bonâ fide* so carrying on business (*kk*). The Courts have no

(*h*) “Trade-mark,” *i.e.*, registered trade-mark, sect. 3 (1), p. 465.

(*i*) *Quære*, “or,” see lower down.

(*j*) See Book I., Chap. XVI., p. 379.

(*k*) Below, p. 497.

(*kk*) The view suggested has now been adopted by the Q. B. D. in Ireland, *R. v. Lipton*, *infra*, p. 498.

difficulty in reading *or for and* where the context requires it (*l*).

Reading (b) and (c) as alternatives, the operation of the sub-section is to forbid the use of any false name or initials (not being a registered trade-mark (*m*), or part of a registered trade-mark) which is either an unauthorized copy or imitation of a trade-name or trade-initials, or is the trade-name or trade-initials of no one, or no one *bond fide* carrying on business, *i. e.*, is a "blind name." If this is the correct view of the sub-section, it is an offence within sect. 2 (1) (d) or sect. 2 (2), to apply to any goods any name or initials of a person other than the trade-name of a person who has authorized the application, or to sell, &c. any goods to which any name or initials of a person, other than the trade-name of a person applied with his authority, have been applied.

For the civil law relating to trade-names, see Book I., Chap. XVI., and for the right of a man to honestly use his own name in his trade, p. 420.

Name.]—"The expression 'name' includes any abbreviation of a name" (*n*).

False name or initials.]—The adjective false governs the whole sub-section. Its effect seems to be to restrict the operation of the section to names and initials which are not the personal or the trade-names or initials of the persons applying them (*o*).

(a) *Not a trade-mark.*]—Trade-mark means trade-mark registered or otherwise within sect. 3 (1) (*p*). Many trade-marks consist of or include the names of their proprietors, or of the predecessors in trade of their proprietors, and a

(*l*) As in *Townsend v. Read*, 10 C. B. N. S. 317; 30 L. J. M. C. 245; and see Stroud's Dictionary, "or for and."

(*m*) Or trade-mark which, either with or without registration, is protected by law in any British possession or foreign state to

which the provisions of sect. 103 of the Act of 1883 are applied. See p. 465.

(*n*) Sect. 3 (1).

(*o*) Cf. "false," above, p. 488; and see p. 497, below.

(*p*) Page 465, "trade-mark."

trade-name, if used in connection with the goods its owner deals in, almost necessarily becomes a trade-mark if it is distinctive (*p*). The reason for excluding trade-marks and parts of trade-marks, seems to be that they are elsewhere dealt with under the heads of forgery and false application of a trade-mark (*q*); but this is not the case as regards parts of a trade-mark which do not so nearly resemble the trade-mark as to be calculated to deceive within the meaning of sect. 4 (*r*). Trade-marks which are or include names or initials, and which do not fall within the definition (*s*), are included within this sub-section if they comply with conditions (*b*) and [or] (*c*).

(*b*) *A colourable imitation, &c.*]—This expression is commonly used in infringement and passing off cases. It is equivalent to the phrase, used elsewhere in the Act, so nearly resembling as to be calculated to deceive (*t*), which has been already discussed.

Of the same description.]—Both trade-mark and trade-name rights are limited to the class of goods for which they are registered or used (*u*).

Proof of
authority of
proprietor.

Not having authorized.]—This is more generally expressed than “without the assent of the proprietor,” which is the phrase used elsewhere in the Act (*v*), and already discussed, but it has probably just the same meaning.

There is no provision in the present sub-section casting the onus of proving the authority in question upon the defendant. This is probably due to an oversight.

(*c*) *Either those of a fictitious person or of some person not bonâ fide carrying on business in connection with the goods.*]—Apart from this Act it is perfectly legal, and the practice is very common, for a trader to use as his trade-name some name other than his own, and either the name of his predecessors in business, or a name chosen for some other

(*p*) See Book I., Chap. VIII., p. 114, “name-marks.”

(*q*) Sect. 2 (1) (a), p. 465; and 2 (1) (b), p. 474.

(*r*) Page 468.

(*s*) Page 465, “trade-mark.”

(*t*) Sect. 4 (a), p. 471.

(*u*) See Book I., Chap. V. p. 87.

(*v*) Sect. 4 (a), p. 470; sect. 5 (3), p. 474.

reason, not being such a name as to infringe the rights of any other person in respect of his trade-name (*x*). It is submitted that the Act does not make the practice illegal, but that the above sub-section, under clause (c), is directed against the application to goods of any name which is not the trade-name of the person who applies it, whether that trade-name is his personal name or not, for the whole sub-section is governed by the use of the words "false name" and "false name or initials," and the trade-name of the person using it is not a false name, nor are his trade-initials false initials (*y*).

Trade-name of repute.

Evidence was given before the Committee of 1887 (*z*) of the fraudulent use of well-sounding names which were not trade-names at all, and were used, not to identify the goods to which they were applied with the person applying them, or with any other manufacturer or merchant, but to suggest that they were the manufacture or merchandise of some seemingly respectable firm. Spanish sounding names on pseudo Spanish cigars; "The Sheffield Knife Company," there being no such company, and the trade-names of defunct firms, were cited as examples of such "blind names," as they are called. Sub-sect. 3 (3) (c) seems to have been directed to stop the use of such names as these. It was stated before the Committee of 1890, that the Act had failed in this particular (*a*), but the statement was made under the assumption that the conditions (a), (b), and (c) were all required to be complied with, (b) and (c) not being treated as alternative, as is suggested above. The Committee did not think fit to recommend any alteration of the sub-section.

Blind names.

Fictitious.]—The words "a fictitious or non-existing person," in sect. 7 (3) of the Bills of Exchange Act, 1882,

(*x*) Book I., Chap. XVI., p. 394.

Hughes, *Ibid.*, Q. 1805; and Mr. Lockwood, *Ibid.*, Q. 1992.

(*y*) Cf. as to the meaning of false, p. 488, above.

(*a*) Evidence of Mr. Hughes, M. M. A. Report, 1890, Q. 5011, and Mr. Follett, p. 277.

(*z*) See, for instance, the evidence of Mr. Freeman, M. M. A. Report, 1887, Qq. 2871 *et seq.*; of Mr.

have been held to apply to a case where the name used, as that of the payee of a forged bill, was the name of an actual person who was known to the acceptor and accustomed to have business dealings with him, but who had not, and was never intended by the drawer to have, any interest in the bill (*b*).

The description of bacon cured by Lipton as "Tracey's cure," where Tracey was Lipton's foreman curer, has been held, in Ireland, to be an offence under sect. 3 (3) (c); although a custom was alleged for bacon dealers to describe their second quality goods by the names of their foremen curers (*bb*). No evidence of the custom was adduced.

Not bonâ fide carrying on business, &c.]—The name and initials of a person who is carrying on business in connection with the goods are dealt with under the preceding head, sect. 3 (3) (b).

Conventional description.]—By sect. 18—

"Where at the passing of this Act (*c*), a trade description is lawfully and generally applied to goods of a particular class, or manufactured by a particular method, to indicate the particular class or method of manufacture of such goods, the provisions of this Act with respect to false trade descriptions shall not apply to such trade description when so applied: Provided that where such trade description includes the name of a place or country, and is calculated to mislead as to the place or country where the goods to which it is applied were actually made or produced, and the goods are not actually made or produced in that place or country, this section shall not apply unless there is added to the trade description, immediately before or after the name of that place or country, in an equally conspicuous manner, with that name, the name of the place or country in which the goods were actually made or produced, with a statement that they were made or produced there" (*d*).

Provisions of the Act as to false description not to apply in certain cases.

(*b*) *The Governor and Company of the Bank of England v. Vagliano Brothers*, (1891) A. C. 107.

(*bb*) *R. v. Lipton*, 32 L. R. Ir. 115 (1892), Q. B. D.

(*c*) 23 August, 1887.

(*d*) Cf. page 480, "place or country," and see the Madrid Convention, Art. VI., p. 665.

This general saving with regard to what are commonly called "generic descriptions," but may more accurately be termed "conventional descriptions," seems to have been suggested by a discussion which took place before the Committee of 1887, as to whether the name *Balbriggan hose* was properly applied to hosiery manufactured in Ireland, at Balbriggan only, or to hosiery of the same description made at several places in England, and in particular at Nottingham. It is based upon the fact that descriptions at first applied to, and appropriate for, a group within a class, constantly become used for the whole class, and are at length as appropriate for the rest of it as for the particular group. The case of trade-marks in this way become *publici juris* by piracy, misuse or abandonment, has been several times noticed in the preceding book (e). *Liebig's Extract, American leather cloth, French chalk, patent leather*, are examples of conventional descriptions within the section. The question whether an alleged conventional description does indicate the particular class or method of manufacture of the goods, *i.e.*, the kind of goods, is of course a question of fact to be established by evidence. It corresponds to the question whether an alleged trade-mark or trade-name of goods was the symbol or name of any goods of the kind, or the symbol or name of the plaintiff's goods of the kind only, which constantly arose for determination in trade-mark cases before the Registration Acts, and still frequently arises in trade-name and passing off cases (f).

It is to be noted that the section only applies to trade descriptions lawfully and generally applied at the passing of the Act.

Lawfully must mean not only so as not to be obnoxious to any then existing trade-name or trade-mark rights, or to particular statutes, such as the Cutlers Acts (g), but also so as not to be within the prohibitions of the Merchandise Marks Act of 1862. That Act, however, contained a

(e) See Chap. XIV., p. 283.

(g) Below, p. 542.

(f) See above, pp. 36 and 404.

section (sect. 9) corresponding to sect. 18, but not limited to descriptions in use at the commencement of the Act. Generally applied means, it is submitted, applied by probable purchasers and persons dealing in the goods in question.

In *The Patent Isinglass Case (h)*, the Court held that a good defence might have been raised under this section upon the finding of the magistrate that the article in question had been known to the trade as patent isinglass, although it was made from cod sounds. But it may be doubted whether such a finding would be sufficient if it were shown that the description deceived the public, although it was understood by the trade (*i*).

4. Causing an Offence to be Committed.

Sect. 2 (1).

“(f) Causes any of the things above in this section mentioned to be done.”

Master and servant.

Master and servant.]—“There is nothing in the present Act to alter the general rule of law (*k*) that a master is not criminally responsible for the unauthorized acts of his servants. There are, no doubt, certain Acts of Parliament (*l*), such as the Licensing Acts, which do introduce an exception in that respect into the general rule; but this is not one of those Acts” (*m*). Moreover, the existence of a criminal intent in the person charged is of the essence of an offence under the Act, although the onus of proving that he acted without intent to defraud, or innocently, is cast upon the defendant, and such intent must necessarily be personal.

(*h*) *Gridley v. Swinborne*, 52 J. P. 739, 791; 5 T. L. R. 71 (1888), Coleridge, L.C.J., and Grantham, J. See also per Holmes, J., in *R. v. Lipton*, p. 498, note (*bb*).

(*i*) See *Ford v. Foster*, L. R. 7 Ch. 611, cited p. 37, and above, pp. 285, 286. And see *Hooper v. Balfour*, W. N. (1890) 61, 139, cited *ante*, p. 480, under “weight.”

(*k*) *Chisholm v. Doulton*, 22 Q. B. D. 736 (1889), Field and Cave, JJ., a case on the Smoke Nuisances Act.

(*l*) For instance, the Food and Drugs Act, 1875. *Pain v. Boughtwood*, 24 Q. B. D. 353; *Brown v. Foot*, 61 L. J. M. C. 110; but, query, as to the master's liability if the act is in contravention of his instructions. *Newman v. Jones*, 17 Q. B. D. 132; *Kearley v. Tonge*, 60 L. J. M. C. 159. And the Adulteration Act, 6 & 7 Will. 4, c. 37; *Core v. James*, 7 L. R. 7 Q. B. 135.

(*m*) Per Pollock, B., in *Budd v. Lucas*, (1691) 1 Q. B. 408.

By sect. 19 (3)—

“Nothing in this Act shall be construed so as to render liable to any prosecution or punishment any servant of a master resident in the United Kingdom who *bonâ fide* acts in obedience to the instructions of such master, and, on demand made by or on behalf of the prosecutor, has given full information as to his master.”

It seems an obvious inference from this section and from sect. 6 (*n*), relating to persons employed by others in the ordinary course of business, that servants and persons employed who do not come within the terms of the sections are to be liable for acts done in obedience to the instructions of their masters or employers (though they may, of course, be able to show that they acted without intent to defraud, or innocently). And this accords with the ordinary law that every person who either actually does, or authorizes, or procures to be done, a criminal act is guilty of the crime (*o*).

Thus, under the Pharmacy Act, 1868 (*p*), an unregistered chemist's assistant has been held liable to penalties for selling poisons on behalf of his master who was himself duly registered.

Both sect. 19 (3) and sect. 6 are restricted to cases of masters or employers resident in the United Kingdom.

Bonâ fide.]—It is difficult to attach any definite meaning to this expression in the section. It can hardly be construed to import the requirements of reasonable precaution, and having no reason to suspect the genuineness of the trade-mark or trade description, expressed in sect. 6 (b) and (c). It may mean without knowledge of the illegal character of the act, or merely that the person excepted has in reality, and not colourably only, acted as a servant and in obedience to his master's instructions. The last meaning suggested, however, would make the words mere surplusage.

(*n*) See next page.

(*o*) See Archbold, 21st ed. p. 9; and sect. 11, below, p. 504.

(*p*) 31 & 32 Vict. c. 121, s. 15.

*The Pharmaceutical Society v. Wheel-
don*, 24 Q. B. D. 683 (1890), Div.
Court. An action for penalties.

On demand has given full information.]—Compare sect. 2 (2) (b), (g), and sect. 6 (d).

Persons employed.]—By sect. 6—

Exemption
of certain
persons em-
ployed in
ordinary
course of
business.

“Where a defendant is charged with making any die, block, machine, or other instrument for the purpose of forging, or being used for forging, a trade-mark, or with falsely applying to goods any trade-mark or any mark so nearly resembling a trade-mark as to be calculated to deceive, or with applying to goods any false trade description, or causing any of the things in this section mentioned to be done, and proves—

“(a) That in the ordinary course of his business he is employed, on behalf of other persons, to make dies, blocks, machines, or other instruments for making, or being used in making, trade-marks, or as the case may be, to apply marks or descriptions to goods, and that in the case which is the subject of the charge he was so employed by some person resident in the United Kingdom, and was not interested in the goods by way of profit or commission dependent on the sale of such goods; and

“(b) That he took reasonable precautions against committing the offence charged; and

“(c) That he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the trade-mark, mark, or trade description; and

“(d) That he gave to the prosecutor all the information in his power with respect to the persons on whose behalf the trade-mark, mark, or description was applied—

he shall be discharged from the prosecution, but shall be liable to pay the costs incurred by the prosecutor, unless he has given due notice to him that he will rely on the above defence.”

This section appears, in effect, to offer to any person charged with either of the offences mentioned in it the alternative of satisfying the four requirements specified in it, or of proving that he acted without intent to defraud within the meaning of sect. 2 (1) (r). It is probable that

(g) Page 512, below.

(r) *Infra*, p. 507, “intent to defraud.”

the latter will usually be the easier course, and it is submitted, although with some doubt, that in judging whether the defendant has acted without intent to defraud, the fact that he has not acted as the section indicates,—for instance, has taken no precautions,—is not to be regarded where he shows that he did not know, believe, or suspect, that the mark or description in question was forged, or false, or falsely applied.

Much evidence was given before the Committee of 1887 on behalf of the Association of Bleachers, whose members are accustomed in the ordinary course of their business to mark trade-marks and descriptions upon goods, and to pack the goods according to their customers' orders, to show that from the enormous number of the marks (s) and descriptions employed in the textile trade, and the fact that many contain words in Oriental languages with which the bleachers are not acquainted, it would be a great hardship to cast upon them the duty of verifying the title to, and the genuineness of every mark furnished to them by their customers. The association presented a memorial to the chairman of the Committee protesting against the Bill under their consideration in its then form, and suggested for insertion into it a section nearly corresponding to the present section, but without the modifications (b), (c), and (d). The section was, no doubt, based upon these representations and proposals (t).

The
Bleachers'
protest.

Clauses 2 (1) (a) (forges any trade-mark), and 2 (1) (e) (disposes of or has in his possession any die, &c. for the purpose of forging a trade-mark) are omitted from the section, and so also is sub-sect. 2 (2) (exposing, &c. for sale goods to which a forged trade-mark, &c. has been applied).

The first condition (a) is triple, so that the person charged must prove in all six propositions to bring himself within the section.

(s) 60,000 cotton marks were registered as trade-marks before 1887. There were probably many more unregistered, but in use.
(t) M. B. A. Report, 1887, pp. 254, 266.

Precautions :—Information.]—Clauses (b) and (c) correspond to clause (a) of sect. 2 (2); clause (d) to clause (b) of sect. 2 (2), (u), except that the words “on demand made by or on behalf of the prosecutor” are there inserted. Under the present section, it seems, the party charged must volunteer the information if it is not demanded, but, on the other hand, he can give it at any time down to the hearing of the charge.

Penalty.]—Compare sect. 14 (x). This penalty is omitted from sect. 2 (2), because the information there referred to must be given on demand as a condition of the special defence allowed by the sub-section.

Accessories.

Accessories.]—The offences dealt with by the Act are all misdemeanours, and there are, accordingly, no accessories to them. The provision of the Act of 1862 (sect. 13) making every person who shall aid, abet, counsel, or procure the commission of an offence under the Act guilty of a misdemeanour, has not been introduced into the present Act, and any such person can, consequently, only be convicted of an offence if he has committed it as a principal under sect. 2 (1) (f) (causes any of the things above in this section mentioned to be done), or under one of the special headings. Sect. 11, set out below, is not directed to the punishment of accessories generally, as the side-note wrongly suggests, but to the punishment of offences committed abroad.

Offences committed abroad.]—By sect. 11—

“Any person who, being within the United Kingdom, procures, counsels, aids, abets, or is accessory to the commission, without the United Kingdom, of any act, which, if committed in the United Kingdom, would under this Act be a misdemeanour, shall be guilty of that misdemeanour as a principal, and be liable to be indicted, proceeded against, tried, and

Punishment
of accessories
[to offences
committed
abroad].

(u) See below, pp. 509, 511.

(x) Page 518, below. Similar penalties as to costs are imposed by the Margarine Act, 50 & 51 Vict.

c. 29, s. 7, and the Sale of Food and Drugs Act, 38 & 39 Vict. c. 63, s. 26.

“convicted in any county or place in the United Kingdom in which he may be, as if the misdemeanour had been there committed.”

The side-note to this section in the Queen's Printers' copy (punishment of accessories) is misleading. The section is directed to meet offences committed abroad by persons in the United Kingdom. In general, offenders can only be prosecuted in the counties or districts where their offences were committed (*y*), and penal Acts are to be read, if possible, as not creating any offence to be committed outside the country for which they are enacted (*z*).

The civil courts will interfere by injunction to prevent steps being taken, or anything done within the jurisdiction, with a view to, or for the purpose of, infringing the plaintiff's trade-mark, or passing off goods as his abroad (*a*).

5. Defences under Sect. 2 (1).

The sub-section concludes with the words “shall, subject to the provisions of this Act, and unless he proves that he acted without intent to defraud, be guilty of an offence against this Act.”

The provisions of the Act referred to are sect. 6 (*b*) (persons employed); sect. 13 (*c*) (vexatious indictments); sect. 15 (*d*) (limitation for prosecutions); and sect. 19.(3) (*e*) (servants acting under their masters' orders).

Unless he proves (f).]—The policy of the Act is, when once it has been established that a trade-mark has been Proof of innocence.

(*y*) See Archbold, Ch. 1, sect. 3. There are many exceptions by statute. See, in particular, as regards the places mentioned in the list at p. 657, 53 & 54 Vict. c. 37.

(*z*) *Macleod v. Att.-Gen. for New South Wales*, (1891) A. C. 455.

(*a*) *Rodgers and Son, Ltd. v. Rottgen*, 5 T. L. R. 678 (1889), Kay, J.; *Société Anonyme des Verriers de l'Etoile's Tm.*, (1894) 1 Ch. 61; W. N. (1894) p. 42; 10 R. P. C. 290, 436, 11 R. P. C. 142, Stirling,

J., and C. A.

(*b*) Page 502.

(*c*) Page 517.

(*d*) Page 517.

(*e*) Page 500.

(*f*) Cf. the second part of sect. (2), p. 511, and the Food and Drugs Act, 1875, 38 & 39 Vict. c. 63; s. 24, by which, if a defendant relies on any provision or exception in the Act, he must prove that he falls within it.

Proof of
innocence.

made without the assent of the proprietor, or that a false description has been applied to goods, or that goods to which a forged trade-mark has been applied have been sold by the person charged, or any other thing done which, if done with such a criminal intent as is contemplated by the Act, would be an offence, to cast upon the person charged the onus of disproving the existence of such intent, and this is carried further by casting upon him also the onus of proving the assent of the proprietor (*g*), where that is material. Great stress was laid upon this feature of the Act when the bills upon which the Act was founded were before the Committee of 1887, as the almost total failure of the Act of 1862 was believed to be due to the necessity for the prosecutor in prosecutions under it to prove the intent to defraud (*h*). There are now upon the statute book a good many Acts by which the onus of proof of justification or excuse is cast on the person charged (*i*). For instance, the application of any of the marks scheduled to the Public Stores Act, 1875 (*j*), without authority (proof of which authority lies on the party accused), is a misdemeanour; and so is being found at night having in possession house-breaking implements without lawful excuse (proof of which excuse lies on the party charged) (*k*). Purchasing, or receiving, or having in possession forged bank-notes or bills, knowing them to be forged (*l*), and making or having in possession coining tools (*m*) without lawful authority (the proof of which authority lies on the party accused), are felonies. The Sale of Food and

(*g*) Sect. 4 (2); sect. 5 (3). Proof of the authority required under sect. 3 (3) (b) is not thrown on the person charged.

(*h*) M. M. A. Report, 1887. See the evidence of Messrs. Hughes, Lockwood, and Uttley. The Committee of 1862 were strongly urged to report in favour of the insertion of similar provisions as to the onus of proof in the

Act of that year, but they declined to do so. M. M. A. Report, 1862, evidence of J. T. Smith, Q. 2643.

(*i*) See a paper by Mr. J. T. Smith in M. M. A. Report, 1862, p. 162.

(*j*) 38 & 39 Vict. c. 25, s. 4.

(*k*) 24 & 25 Vict. c. 96, s. 58.

(*l*) 24 & 25 Vict. c. 98, s. 13.

(*m*) 24 & 25 Vict. c. 99, s. 24.

Drugs Act, 1875 (*n*), and the Margarine Act, 1887, are other instances (*o*).

And by the common law, wherever the act charged is not indifferent, but in itself unlawful, the proof of justification or excuse in such case lies on the defendant, and on failure thereof, the law implies a criminal intent (*p*).

Intent to defraud.]—This does not mean intent to defraud any particular person (*q*). So that an offence may be committed, although precautions are taken to prevent the immediate purchaser from the person charged being deceived, as, for example, by adding to a false trade description upon a covering a label which bears the name of the person whose manufacture or merchandise the goods within the covering really are, or which is otherwise explanatory, for the label may be intended to be removed, and the goods passed on to the ultimate purchasers with the false trade description unqualified (*r*).

Intent to defraud.

The provision of the Act of 1862, s. 12, that, where in proceedings in respect of an offence under that Act it should be necessary to allege or mention an intent to defraud, it should not be necessary to allege or prove an intent to defraud any particular person (*s*), has not been reproduced, probably because the onus of proof has, in the present Act, been shifted to the person charged. It appears that the absence of the provision makes no difference to the effect of the Act.

(*n*) See sects. 5 and 8. *Betts v. Armstead*, 20 Q. B. D. 771.

(*o*) Cf. also the presumption of guilty knowledge from evidence of possession of recently stolen goods. *Archbold*, 21st ed. p. 275.

(*p*) Per Lord Mansfield, *R. v. Woodfall*, 5 Burr. 2667, note (*i*), *supra*.

(*q*) *Wood v. Burgess*, *infra*. Cf. forging a trade-mark, above, p. 469, *v*.

(*r*) *Wood v. Burgess*, 21 Q. B. D. 162 (1889), Coleridge, L.C.J., and

Mathew, J., a case under sect. 2 (2). And of. "so nearly resembling," sect. 4 (*a*), *ante*, p. 471, and "calculated to lead," sect. 3 (2), above, p. 493; and the civil law rule, above, pp. 187, 322, and *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), C. A.

(*s*) Similar sections occur in 24 & 25 Vict. c. 98, s. 44 (forgery), 24 & 25 Vict. c. 96, s. 88 (false pretences), and 24 & 25 Vict. c. 97, s. 58 (malicious injuries to property).

“The words ‘intent to defraud’ in this Act mean more than an intent to cheat a customer.” They apply to cases “where a person uses a particular mark without any intent in so doing to induce a buyer to accept goods which might otherwise be rejected (*t*). And in a case where the offence consisted in English manufacturers placing their name on goods manufactured by other persons, but equal in quality to their own (*t*), Coleridge, L.C.J., said: “In the present case all further controversy is superfluous when once one has ascertained with certainty what *fraud* means in the Act. I agree that if the word is used in the sense of putting off a bad article on a customer in order to get money unfairly, there is no evidence here of anything of the kind having been done. On the contrary, it is expressly found that the article supplied was as good as that contracted for. But that, I think, is not the correct meaning of the word *fraud* as used in this Act of Parliament. The Act is directed against the abuse of trade-marks, and the putting off on a purchaser of not a bad article, but an article different from that which he intended to purchase and believes he is purchasing. It would apply to cases where a particular article, manufactured by a particular person, had acquired a wide-spread reputation (as, for instance, happened in the celebrated case of the fish sauces (*u*)), and some one supplied another and a different article under that name, so as to make the purchaser take something which he did not know he was taking.”

On the other hand, the Act does not apply to mere cases of inaccurate or mistaken descriptions. The charges under it are criminal charges, and, according to the ordinary rule, a criminal intent—a *mens rea* in the person charged—must be made out (*v*).

(*t*) *Per* Mathew, J., in *Starey v. Chilworth Gunpowder Co.*, 24 Q. B. D. 90 (1869).

(*u*) *Burgess v. Burgess*, 3 De G. M. & G. 896; 22 L. J. Ch. 675, cited p. 423.

(*v*) *Gridley v. Swinborne*, 52 J. P. 739, 791; 5 T. L. R. 71 (1888), Coleridge, L.C.J., and Grantham, J.; *Budd v. Lucas*, (1891) 1 Q. B. 408.

Reasonable precautions.—Giving information.]—Where special defences are provided by the Act, in sect. 2 (2) (a) and (b) (x), and sect. 6 (y), the matters to be proved by the person charged include, that he took all reasonable precautions against committing an offence against the Act, and that he gave all the information in his power (z) with respect to the persons from whom he obtained the marked goods, or the person on whose behalf the mark or description in question was applied. No doubt it was intended by the draughtsmen of the Act to make these matters tests of innocent conduct on all charges under the Act, but it is submitted that the provisions respecting them cannot be imported into sections, as the above section, where they are not expressed. If this is so, the most ordinary evidence to show that the party charged acted without intent to defraud, or “otherwise innocently” (a), will be evidence of ignorance of the facts on which the charge is based: for instance, evidence that he did not know or suspect that the mark forged was a trade-mark; that the goods to which the trade description was applied were not the goods described; or evidence that he believed he had the assent or authority of the proprietor of the trade-mark in question to apply it.

Evidence of the defendant.]—By sect. 10 (1) (in any prosecution for an offence against this Act)—

Evidence of the defendant and his wife.

“A defendant, and his wife, or her husband, as the case may be, may, if the defendant thinks fit, be called as a witness, and, if called, shall be sworn and examined, and may be cross-examined and re-examined in like manner as any other witness.”

Rebutting evidence.]—If the person charged gives, or calls evidence to show that he acted without intent to defraud, the prosecutor may give rebutting evidence, and, in particular, evidence of transactions similar to the offence

(x) Below, p. 511.

(y) Above, p. 501.

(z) See also sect. 19 (3), above, p. 504.

(a) Sect. 2 (2) (c), *infra*, p. 511.

charged, in which the person charged was concerned, and antecedent (but, it is said, not subsequent (*b*)) to that offence (*c*).

6. Sale or Possession of Falsely-Marked Goods.

Sub-sect. 2 (2) provides that—

“Every person (*d*) who sells, or exposes for, or has in his possession for, sale, or any purpose of trade or manufacture, any goods or things to which any forged trade-mark (*e*) or false trade description (*f*) is applied (*g*), or to which any trade-mark or mark so nearly resembling a trade-mark as to be calculated to deceive is falsely applied (*h*), as the case may be, shall” (unless he establishes one of specified defences (*i*)) “be guilty of an offence against this Act.”

Cases where possession or sale is an offence *prima facie*.

Some other cases where possession is made an offence *prima facie*, are collected at p. 506. Imitating the mark of the Birmingham Proof House for gun barrels, or knowingly selling any barrel bearing an imitation of such mark (*k*); marking the mark of a hammer on cutlery not made of hammered steel, or having in possession for the purposes of sale articles so marked; marking cutlery, or having in possession for sale cutlery marked, with a false indication of quality, or with the words *London* or *London made*, unless the cutlery were manufactured in the city of London (*l*), or within twenty miles thereof, are misdemeanours.

By the Margarine Act, 1887 (*m*), s. 6, it is provided that

(*b*) *R. v. Holt*, 30 L. J. M. C. 11.
 (*c*) *Budd v. Lucas*, (1891) 1 Q. B. 408, Pollock, B., and Charles, J. Evidence of previous short deliveries. *R. v. Francis*, L. R. 2 C. C. R. 128, a case of false pretences. See Archbold, 21st ed. p. 251.

(*d*) Page 463.

(*e*) Pages 465, 468.

(*f*) Pages 476, 487.

(*g*) Page 473.

(*h*) Page 474.

(*i*) See next page.

(*k*) 53 Geo. 3, c. 115.

(*l*) 59 Geo. 3, c. 7. See a paper by Mr. J. T. Smith, M. M. A. Report, 1862, p. 162.

(*m*) 50 & 51 Vict. c. 29.

every package, whether open or closed, and containing margarine, shall be branded or marked in a certain way, and that "if such margarine be exposed for sale, by retail, there shall be attached to each parcel thereof so exposed, and in such manner as to be clearly visible to the purchaser" a specified label. It has been held that a parcel of margarine placed behind a screen out of the sight of purchasers in a shop, and from which portions were cut for sale to them, is not (*n*), but that parcels done up in wrappers and placed in the shop so that the wrappers, but not the margarine itself, could be seen by purchasers, are, "exposed for sale" within the meaning of this section (*o*).

7. Defences under Sect. 2 (2).

Sub-sect. (2) declares the person charged, if he falls within the earlier part of the sub-section, to be guilty of an offence against the Act—

"Unless he proves—

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

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

"(c) That otherwise he had acted innocently."

The onus of establishing the innocence of any person charged, whose case is shown to fall within the earlier part of the section, is, therefore, as under the corresponding

(*n*) *Crane v. Laurence*, 25 Q. B. D. 152 (1890), *Cave and Smith*, JJ.

(*o*) *Wheat v. Brown*, (1892) 1 Q. B. 418, *Lawrance and Wright*, JJ.

(*p*) Page 509. Cf. sect. 6 (c), p. 502, and sect. 17, p. 431, and also "false," p. 488.

(*q*) Pages 504, 509, and 512.

sub-sect. (1) (s), already considered, cast upon the person charged.

The special defences (a) and (b) correspond to (b), (c), and (d) of sect. 6 (t), except that the information here referred to is to be given on demand, and in sect. 6 there is a special provision as to costs, which does not occur here. Rebutting evidence may be given by the prosecution to displace these defences (u).

Gave all the information.]—In the evidence given before the Committees of 1862 and 1887, great stress was laid upon the importance of compelling retail traders and others found in possession of spurious goods, or found offering them for sale, to give such information as should lead to the discovery of the real, or the original, offenders. For frauds by false marking can usually only be detected when the goods are offered to the general public, and the goods are then in the hands of persons who are, or may be, or may speciously pretend to be, innocent of the frauds. Mr. Hindmarch, Q.C., the draughtsman of the Act of 1862, described the provisions for disclosure as of the essence of the bill upon which the Act was founded (x).

Provision for disclosure in the M. M. A., 1862.

By sect. 6 of the last-mentioned Act (y), a person who sold, &c. any article together with a forged trade-mark, &c., was bound, upon demand in writing, by or on behalf of the persons whose trade-mark was forged, &c., and within twenty-four hours after the demand, to give full information in writing of the name and address of the person from whom, and the time when, he obtained the article. And any justice of the peace might order such information to be given. Refusal or neglect to comply with the order was punishable by a penalty of 5*l.*, and was *prima facie* evidence of guilty knowledge at the time when he sold the article, on the part of the person refusing or neglecting.

(s) Page 505.

(t) Page 502.

(u) Page 509.

(x) M. M. A. Report, 1862, Q. 2865.

(y) 25 & 26 Vict. c. 88. The section is much abbreviated.

There is no provision in the present Act corresponding to this and enabling an order for disclosure to be made, or making refusal or neglect to give information evidence of guilty knowledge or intent. Proof that the person charged has given all the information in his power is made a term of the special defences under sect. 2 (2) (b), and sect. 6 (d), and under sect. 14 the Court, upon a prosecution, in making an order for costs, may have regard to the information given by, and the conduct of, the defendant and prosecutor respectively; but it is quite conceivable that a defendant might refuse to give information with impunity, except as to payment of costs, and secure an acquittal under the general defences of sect. 2 (1) (without intent to defraud), or sect. 2 (2) (c) (acted innocently). In a civil action against him, based upon the same offences, the person charged could, of course, be compelled to make the disclosure on "discovery," if it were relevant to the issues raised.

(c) *That otherwise he had acted innocently.*]—Compare "without intent to defraud," above, p. 507. Whether the defendant tenders evidence or not, and whether any of the special defences sanctioned by the Act is set up or not, the Court must, in order to convict, be satisfied that he acted with a criminal intent in doing the acts complained of (s).

8. Punishment.

By sect. 2 (3) and (4)—

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

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

"(ii.) on summary conviction to imprisonment, with or without hard labour, for a term not exceed-

Fine and imprisonment.

(s) *Gridley v. Swinborne*, 52 J. P. Coleridge, L.C.J., and Grantham, J.
739, 791; 5 T. L. R. 71 (1888),

Forfeiture of
the goods.

“ing four months, or to a fine not exceeding twenty pounds, and in the case of a second or subsequent conviction to imprisonment, with or without hard labour, for a term not exceeding six months, or to a fine not exceeding fifty pounds; and

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

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

Forfeiture and destruction (a).]—Sect. 21 of the Act of 1862 authorized the Court in any suit at law or in equity for forging a trade-mark, &c., to order the goods bearing the spurious marks to be destroyed; and the various sections of the Act imposing penalties contained provisions for forfeiture and destruction to the same effect as the sections set out above.

It has been shown in the earlier part of the book that the Court of Chancery would have interfered, and now the High Court of Justice interferes, independently of sect. 21 of the Act of 1862, to order the destruction of spuriously marked articles, but that if the marks can be completely removed, the Court permits this to be done without requiring the articles to be destroyed (*b*).

9. Prosecution.

By sect. 2—

“ (6.) Any offence for which a person is under this Act liable to punishment on summary conviction may

(a) Cf. sect. 12 (3), p. 521, by which compensation for loss may be awarded to an innocent party out of the proceeds of forfeited goods. And as to forfeiture on importation, see sect. 16, p. 526.
(b) Beck L. Chanc. XV., p. 537. *Slezinger & Sons v. Feltham & Co.*, 6 R. P. C. 531 (1889), C. A.

“be prosecuted, and any articles liable to be forfeited under this Act by a Court of summary jurisdiction may be forfeited, in manner provided by the Summary Jurisdiction Acts (c): Provided that a person charged with an offence under this section before a Court of summary jurisdiction shall, on appearing before the Court, and before the charge is gone into, be informed of his right to be tried on indictment, and if he requires be so tried accordingly.”

The Court in Scotland is the Sheriff Court (d), and the Summary Jurisdiction Acts there mean the Summary Procedure Act, 1864, and any Acts amending the same (d). In Dublin, the Summary Jurisdiction Acts are the Acts regulating the powers and duties of justices of the peace for the police district of Dublin metropolis, and, as regards the rest of Ireland, the “Summary Jurisdiction Acts” means the Petty Sessions (Ireland) Act, 1851, and any Act amending the same. The “Court of summary jurisdiction” means justices acting under those Acts (e).

Indictment and information.]—For forms of these, see the Appendix, p. 708.

Official prosecutions.]—It is provided by sect. 2 of the M. M. A. 1891, that—

“2.—(1.) The Board of Trade may, with the concurrence of the Lord Chancellor, make regulations providing that in cases appearing to the Board to affect the general interests of the country, or of a section of the community, or of a trade, the prosecution of offences under the Merchandise Marks Act, 1887, shall be undertaken by the Board of Trade, and prescribing the conditions on which such prosecutions are to be so undertaken. The expenses of prosecutions so undertaken shall be paid out of moneys provided by Parliament.

Official
prosecutions.

(c) 42 & 43 Vict. c. 49.

(d) Sect. 21.

(e) Sect. 22. The compromise of

a prosecution is, it seems, not improper. See *Fisher v. Apollinaris Co.*, 10 L. R. Ch. 297 (1875), L.JJ.

“(2.) All regulations made under this section shall be laid before Parliament within three weeks after they are made if Parliament is then sitting, and if Parliament is not then sitting, within three weeks after the beginning of the next session of Parliament, and shall be judicially noticed, and shall have effect as if enacted by this Act, and shall be published under the authority of her Majesty’s Stationery Office.

“(3.) Nothing in this Act shall affect the power of any person or authority to undertake prosecutions otherwise than under the said regulations.”

This provision was made upon the recommendation of the Committee of 1890.

The regulations made by the Board of Trade under the Act (*f*) are set out in the Appendix, p. 707. The fifth of such regulations provides that the Board may, before undertaking a prosecution at the instance of any applicant, require the applicant to give security for costs on such terms and in such manner as it thinks proper.

Right to be tried by indictment.]—If notice of this right be not given to the person charged on his appearing in Court, and before the charge is gone into, the proceedings are invalid (*g*). This was so held in a case under sect. 17 of the Summary Jurisdiction Act, 1879, by which a similar duty of informing a defendant, charged with one of the offences included under the section, of his right to be tried by a jury is cast upon the court of summary jurisdiction (*h*).

(*f*) 21 May, 1892. A list of the prosecutions instituted by the Board of Trade is given in Appendix M. to the Report of the Lords’ Committee on Marking of Foreign Meat, 1893, from which it appears that down to April, 1893, nine prosecutions had been instituted, and four convictions obtained.

(*g*) Cf. 38 & 39 Vict. c. 63, s. 14, under which it is a condition precedent to the right of the purchaser

of adulterated goods to take proceedings, that he should have given the seller notice of his intention to have the goods analysed. *Parsons v. Birmingham Dairy Co.*, 9 Q. B. D. 172 (1882), Div. Court. See also *Carle v. Elkington*, 40 W. R. 610.

(*h*) *Re Holeton*, *Times Newspaper*, 29 June, 1885; *Stone’s Justices’ Manual*, 23rd ed. p. 508.

There are numerous special Acts comprising corresponding provisions (i).

Limitation of prosecutions.]—By sect. 15—

“No prosecution for an offence against this Act shall be commenced after the expiration of three years next after the commission of the offence, or one year next after the first discovery thereof by the prosecutor, whichever expiration first happens.”

Sect. 18 of the Act of 1862 was to the same effect. The ordinary period of limitation upon the summary prosecution of offences is six months (k).

A question may arise as to whether the above section applies to a prosecution for the special offences created by sect. 8 or sect. 20 of the Act (l), since the phrase “an offence against this Act” which occurs in it, is taken from sect. 2, and does not occur in those sections. It is submitted that sect. 15 does not apply, and that, accordingly, the ordinary rule of six months’ limitation holds for prosecutions under sect. 8 or sect. 20.

Vexatious Indictments Act.]—By sect. 13—

“The Act of the session of the twenty-second and twenty-third years of the reign of her present Majesty, chapter seventeen, intituled ‘An Act to prevent vexatious indictments for certain misdemeanours’ (m), shall apply to any offence punishable on indictment under this Act, in like manner as if such offence were one of the offences specified in section one of that Act, but this section shall not apply to Scotland.”

The effect of this is, that no bill of indictment can be presented to, or found by, any grand jury for an offence under the Act, unless either the prosecutor has been bound over to prosecute or give evidence; or the person charged has been committed to or detained in custody, or has been

(i) See Glen’s Summary Jurisdiction Acts, 6th ed. p. 126.

(k) Summary Jurisdiction Act, 1848, sect. 11; Stone’s Justices’ Manual, p. 31; Glen, pp. 39, 45.

(l) Sect. 8 (3) (false declaration as to watch). Sect. 20 (pretended royal warrant).

(m) 22 & 23 Vict. c. 17.

bound over to answer an indictment for the offence; or the indictment is preferred with the consent of a judge, the attorney-general, or the solicitor-general. And where a justice refuses to commit, or to hold to bail a person charged with an indictable offence under the Act to be tried for the same, the justice may, and must at the desire of the prosecutor, take the recognizance of the prosecutor to prosecute and transmit the recognizance, information, and depositions, if any, to the Court in which the indictment ought to be preferred, in the same manner as if he had committed the person charged for trial (*n*).

Costs.

By sect. 14—

“On any prosecution under this Act the Court may order costs to be paid to the defendant by the prosecutor, or to the prosecutor by the defendant, having regard to the information (*o*) given by and the conduct of the defendant and prosecutor respectively.”

This is subject to the special rule of sect. 6 (*p*), where the defence allowed by that section is set up.

The section gives the Court unlimited jurisdiction over the costs, without reference to the result of the prosecution, except so far as this is made a subject for consideration by the reference to conduct. It may be compared with Ord. 65, r. 1 (*q*), and sect. 5 of the Judicature Act, 1890, which deal with the costs of civil proceedings (*r*). Under Ord. 65, r. 1, it is held that a lump sum, assessed by the Court, may be awarded as costs (*s*); that a successful plaintiff may be ordered to pay the costs of the action (*t*); but that the defendant cannot be ordered to pay them

(*n*) Stone's Justices' Manual, 23rd ed. p. 549.

(*o*) See above, p. 512, “information.”

(*p*) Above, p. 501.

(*q*) See the note to this in the Annual Practice, from which the cases next cited are taken.

(*r*) As to costs in actions for infringement, see Book I. Chap. XV. p. 364.

(*s*) *Willmott v. Barber*, 17 C. D. p. 774.

(*t*) *Harris v. Petherick*, 4 Q. B. D. 611; *Fane v. Fane*, 13 C. D. 228.

where the plaintiff had no cause of action (*u*). The discretion must, of course, be exercised judicially and on fixed principles of general application (*x*).

The ordinary rule as to the costs of summary proceedings is, that if a conviction or order is made, the justices may order the defendant to pay to the prosecutor or complainant, and if the information or complaint is dismissed, the prosecutor or complainant to pay to the defendant, such costs as they think just and reasonable (*y*).

Where a fine ordered to be paid on a conviction by a court of summary jurisdiction does not exceed five shillings, then, except so far as the Court may think fit to expressly order otherwise, an order shall not be made for payment by the defendant to the informant of any costs, and the Court shall, except so far as they think fit to expressly order otherwise, direct all fees payable or paid by the informant to be remitted or repaid to him; the Court may also order the fine or any part thereof to be paid to the informant in or towards the payment of his costs (*z*).

Under sect. 12 (3) (*a*) compensation may be awarded to an innocent party out of the proceeds realized from forfeited goods for any loss sustained by him in dealing with such goods.

Appeal.

By sect. 2 (5)—

“If any person feels aggrieved by any conviction made by a court of summary jurisdiction, he may appeal therefrom to a court of quarter sessions.”

The appeal will be governed by sect. 31 of the Summary

(*u*) *Dicks v. Yates*, 18 C. D. 73; *Foster v. G. W. Ry. Co.*, 8 Q. B. D. 515.

(*x*) *Cooper v. Whittingham*, 15 C. D. 501; *Jones v. Curling*, 13 Q. B. D. 265; *The Monkseaton*, 14 P. D. 51. And see the trade-mark cases *Upmann v. Forrester*, 24 C. D. 231, and the *American Tobacco Co.*

v. Guest, (1892) 1 Ch. 630; 9 R. P. C. 218, cited above, pp. 364, 366.

(*y*) Summary Jurisdiction Act, 1848, sect. 18; Stone's Justices' Manual, 23rd ed. p. 61.

(*z*) Summary Jurisdiction Act, 1879, sect. 8.

(*a*) Page 521, below.

Jurisdiction Act, 1879, and the provisions of that section must be complied with (*b*).

The decision of justices upon any point of law, or if it is alleged to be in excess of jurisdiction, may also be questioned by requiring the justices to state a case for the determination of the Queen's Bench Division (*c*); an order or conviction made by them without jurisdiction may be quashed upon a *certiorari* (*d*); and if they have refused to hear and determine a case in which they have jurisdiction they may be ordered to do so by *mandamus* (*d*).

Saving of other Proceedings.

By sect. 19 (1) and (2)—

“(1.) This Act shall not exempt any person from any action, suit, or other proceeding which might, but for the provisions of this Act, be brought against him.

“(2.) Nothing in this Act shall entitle any person to refuse to make a complete discovery, or to answer any question or interrogatory in any action, but such discovery or answer shall not be admissible in evidence against such person in any prosecution for an offence against this Act (*dd*).”

Search Warrant.

By sect. 12—

“(1.) Where, upon information of an offence against this Act (*e*), a justice has issued either a summons requiring the defendant charged by such information to appear to answer to the same, or a warrant for the

Where a prosecution is pending.

(*b*) See Glen's Summary Jurisdiction Acts, 6th ed. p. 148; Stone's Justices' Manual, 23rd ed. p. 645.

(*c*) 20 & 21 Vict. c. 43, s. 3; 42 & 43 Vict. c. 49, s. 33. The statement of the case must be requested in writing within seven days of the date of the proceeding to be questioned. S. J. Rule 17;

Stone, p. 79.

(*d*) See Stone, p. 645. See Shortt and Mellor's Crown Office Practice.

(*dd*) Cf. sect. 23, by which rights, penalties, &c. under the M. M. A. 1862 are saved.

(*e*) Sect. 2 (1) and (2), p. 462.

“arrest of such defendant, and either the said justice on or after issuing the summons or warrant, or any other justice, is satisfied by information on oath that there is reasonable cause to suspect that any goods or things by means of or in relation to which such offence has been committed are in any house or premises of the defendant, or otherwise in his possession or under his control in any place, such justice may issue a warrant under his hand by virtue of which it shall be lawful for any constable named or referred to in the warrant, to enter such house, premises, or place at any reasonable time by day, and to search there for and seize and take away those goods or things; and any goods or things seized under any such warrant shall be brought before a court of summary jurisdiction for the purpose of its being determined whether the same are or are not liable to forfeiture (*f*) under this Act (*g*).

“(2.) If the owner of any goods or things which, if the owner thereof had been convicted, would be liable to forfeiture under this Act, is unknown or cannot be found, an information or complaint may be laid for the purpose only of enforcing such forfeiture, and a court of summary jurisdiction may cause notice to be advertised stating that, unless cause is shown to the contrary at the time and place named in the notice, such goods or things will be forfeited, and at such time and place the Court, unless the owner or any person on his behalf, or other person interested in the goods or things, shows cause to the contrary, may order such goods or things or any of them to be forfeited.

Where the owner of the goods cannot be found.

“(3.) Any goods or things forfeited under this section, or under any other provision of this Act (*f*),

Disposal of forfeitures, compensation

(*f*) See sect. 2 (3) (iii), p. 514.

(*g*) As to search warrants generally, see Glen's Summary Jurisdiction Acts, 6th ed., p. 302, where

a list of the numerous Acts authorizing the granting of them is given.

to innocent party.

“ may be destroyed or otherwise disposed of, in such manner as the Court by which the same are forfeited may direct, and the Court may, out of any proceeds which may be realized by the disposition of such goods (all trade-marks and trade descriptions being first obliterated), award to any innocent party any loss he may have innocently sustained in dealing with such goods.”

Forfeiture without conviction.]—An offence against the Act comprises two distinct elements: first, the doing of one of the specified acts, for instance, making a trade-mark without the assent of the proprietor, applying a false trade description to goods, or having in possession for sale any goods to which a forged trade-mark is applied; and, secondly, doing this with intent to defraud, or not innocently, and without any of the special defences mentioned in the Act. The existence of the first element can be ascertained from the chattel, article, instrument, or thing by means of, or in relation to which the offence (*h*), if committed at all, has been committed; but the existence of the second can only be established in relation to the conduct of a particular person, here referred to generally as “the owner” of the goods or things. The Act, however, in almost all cases casts the onus of establishing that he acted without intent to defraud, or otherwise innocently, or a special defence upon the person charged, and in the absence of any evidence by “the owner,” for the purpose of forfeiting the goods under the section, evidence supplied by inspection of the goods themselves, or otherwise given in relation to them, and the marks applied to them will be sufficient (*i*).

Marks on Watch Cases.

By sect. 7—

“ Where a watch case has thereon any words or marks which constitute, or are by common repute (*k*)

Application of the Act to watches.

(*h*) Sect. 2 (3) (iii.), p. 514.

(*k*) Cf. “custom of the trade,”

(*i*) Cf. sect. 16, below, p. 531, in sect. 3 (1), *ante*, p. 486.

“such goods.”

“considered as constituting, a description of the country (*l*) in which the watch was made, and the watch bears no description of the country where it was made, those words or marks shall *prima facie* be deemed to be a description of that country within the meaning of this Act, and the provisions of this Act with respect to goods to which a false trade description has been applied (*m*), and with respect to selling or exposing for or having in possession for sale, or any purpose of trade or manufacture, goods with a false trade description (*n*), shall apply accordingly, and for the purposes of this section the expression ‘watch’ means all that portion of a watch which is not the watch case (*n*).”

Gold or silver watch cases, whether of British make or imported into Great Britain, are required to be stamped with assay marks, of which the most important are the hall-marks, showing the standard of purity of the metal (*o*). Evidence was adduced before the Committee of 1887 to show that the English hall-mark upon a watch case containing a foreign movement was understood by buyers to be an indication that the movement was of English make, and further, that the introduction of the letter *F* into the hall-marks put upon imported watch cases, which had been provided for by the Customs Tariff Act, 1876 (*p*), was not sufficient to enable buyers to distinguish foreign from English-made cases. The section set out above, and sect. 8 of the Act, were accordingly introduced for the purpose of preventing the assay marks from leading, or being used to lead, to deception (*q*). It is said that the provisions have been successful, and have proved highly beneficial to the English watch trades (*q*).

(*l*) See sect. 3 (1), “place or country,” p. 480.

(*m*) Sect. 2 (2).

(*n*) *i.e.* The “movement.”

(*o*) The statutes are very numerous. See Appendix, p. 711.

(*p*) 39 & 40 Vict. c. 35, s. 1, amended by the Revenue Act, 1883, 46 & 47 Vict. c. 55, s. 10.

(*q*) See “Watches” in the indexes to the M. M. A. Reports, 1887 and 1890.

On examination, sect. 7 appears to be a special case falling within provisions elsewhere contained in the Act, for words or marks which constitute, or are by common repute considered as constituting a description of the country in which the movement was made, marked upon the case would seem to be a "trade description" within sect. 3 (1) (r) "applied to" the whole watch within sect. 5 (s), and if the movement has not, in fact, been made in the country indicated by the description, the trade description is false within sect. 3 (1) (t). This is another instance of overlapping, of which several cases occur in the Act. It is submitted that the construction of the wider general provisions ought not to be affected, in regard to watches, by the presence of the narrower special section here referred to (u).

The section applies only where the double condition that the watch case has upon it words or marks which constitute, or are by common repute considered as constituting a description, of the country where the movement was made, and that the movement bears no description of the country where it was made, is fulfilled. It does not, therefore, extend to the sale of a watch in a case marked so as to indicate that the movement was made in any country other than that where it was, in fact, made, if the movement itself is marked with a description of the country in which it was made, although a purchaser who did not notice or appreciate the conflict between the marks, might be misled by the mark on the case. But any such sale would, it is submitted, fall within the general provisions dealing with false trade descriptions of the Act.

Description of the country where it was made.]—It is often difficult to say what country is the country where a movement was made, since almost, if not quite, all English movements contain foreign made parts, for instance, the chain, hair spring, and regulator, and sometimes foreign-

Movements
partly made
abroad.

(r) Page 476.

(s) Page 473.

(t) Page 487.

(u) Cf. p. 492.

made movements are imported in the rough and are finished in England. In regard to the former case there was a general, but not unanimous, agreement among the expert witnesses called before the Committee of 1887 that, at any rate, if the foreign-made parts are only those mentioned, the movement may fairly be described as English made, but in regard to the latter there was a decided difference of opinion (*x*). This difficulty has already been referred to in considering what is meant by "false in a material respect" (*y*). It must be solved in each case according to the view the Court takes, having regard to such usages of the trade as are proved to exist, and as can be supposed to be familiar to the ultimate buyers.

Prima facie be deemed.]—It is impossible to attach any sensible meaning to the words *prima facie* in this section. They were probably intended only to enable the person charged to show that the words or marks in question do not constitute, and are not by common repute considered as constituting a description of the country in which the movement was made, as alleged, but for this they are both unnecessary and inappropriate.

Marking watch cases.]—By sect. 8—

"(1.) Every person (*s*) who after the date (*a*) fixed by Order in Council sends or brings a watch case, whether imported or not, to any assay office in the United Kingdom for the purpose of being assayed, stamped, or marked, shall make a declaration declaring in what country or place the case was made. If it appears by such declaration that the watch case was made in some country or place out of the United Kingdom, the assay office shall place on the case such a mark (differing from the mark placed by the office on a watch case made in the United Kingdom), and

(*x*) See "Watches" in the index to M. M. A. Report, 1887. sect. 18, p. 498.

(*s*) Sect. 3 (1), p. 463, "person."

(*y*) Above, p. 483. See also "place or country," p. 482, and

(*a*) 28 Nov. 1887; *London Gazette*, 9 Dec. 1887.

“ in such a mode as may be from time to time directed by Order in Council.

“(2.) The declaration may be made before an officer of an assay office, appointed in that behalf by the office (which officer is hereby authorized to administer such a declaration), or before a justice of the peace, or a commissioner having power to administer oaths in the Supreme Court of Judicature in England or Ireland, or in the Court of Session in Scotland, and shall be in such form as may be from time to time directed by Order in Council.

“(3.) Every person who makes a false declaration for the purposes of this section shall be liable, on conviction on indictment, to the penalties of perjury, and on summary conviction to a fine not exceeding twenty pounds for each offence” (b).

See sect. 7, above, p. 522. The Order in Council is printed in the Appendix, p. 707.

The section is only directed to secure that foreign made cases shall bear a distinctive mark. It does not prevent English movements being put into foreign cases, or foreign movements into English cases.

Watches and
clocks.

Importation of marked watches.]—By sect. 42 of the Customs Act, 1876 (c), the importation of clocks and watches, or any other article of metal impressed with any mark or stamp representing, or in imitation of, any legal British assay, mark, or stamp, or purporting by any mark or appearance to be of the manufacture of the United Kingdom, is prohibited.

10. Prohibition on Importation.

By sect. 16 (d)—

“Whereas it is expedient to make further provision for prohibiting the importation of goods which, if

(b) See sect. 15, p. 517, “limitation.”

(c) 39 & 40 Vict. c. 36.

(d) The sub-sections are badly arranged. (4) should have been placed second.

“ sold, would be liable to forfeiture under this Act; be it therefore enacted as follows :

“ (1.) All such goods, and also all goods of foreign manufacture bearing any name or trade-mark being or purporting (*e*) to be the name or trade-mark of any manufacturer, dealer, or trader in the United Kingdom, unless such name or trade-mark is accompanied by a definite indication of the country in which the goods were made or produced, are hereby prohibited to be imported into the United Kingdom, and, subject to the provisions of this section (*f*), shall be included among goods prohibited to be imported as if they were specified in section forty-two of the Customs Consolidation Act, 1876 (*g*).

Goods liable to forfeiture under the Act, or bearing British or Irish trade-marks or names.

“ (2) Before detaining any such goods or taking any further proceedings with a view to the forfeiture thereof under the law relating to the Customs, the Commissioners of Customs may require the regulations under this section, whether as to information, security, conditions, or other matters, to be complied with, and may satisfy themselves in accordance with those regulations that the goods are such as are prohibited by this section to be imported.

Customs regulations.

“ (3.) The Commissioners of Customs may from time to time make, revoke and vary, regulations, either general or special, respecting the detention and forfeiture of goods the importation of which is prohibited by this section, and the conditions, if any, to be fulfilled before such detention and forfeiture, and may by such regulations determine the information, notices, and security to be given, and the

(*e*) For the interpretation of “purports” in the Customs Regulations of 22 Dec. 1887, see r. 8, Appendix, p. 681.

(*f*) i.e., sub-sects (2) and (3).
 (*g*) 39 & 40 Vict. c. 36. See last page.

THE MERCHANDISE MARKS ACT, 1887.

Names like
names of
places in
the United
Kingdom.

Customs
regulations.

Customs Act,
1870.

“ evidence requisite for any of the purposes of this section, and the mode of verification of such evidence.

“ (4.) Where there is on any goods a name which is identical with or a colourable imitation of the name of a place in the United Kingdom, that name, unless accompanied by the name of the country in which such place is situate, shall be treated for the purposes of this section as if it were the name of a place in the United Kingdom.

“ (5.) Such regulations may apply to all goods the importation of which is prohibited by this section, or different regulations may be made respecting different classes of such goods or of offences in relation to such goods.

“ (6.) The Commissioners of Customs, in making and in administering the regulations, and generally in the administration of this section, whether in the exercise of any discretion or opinion, or otherwise, shall act under the control of the Commissioners of her Majesty's Treasury.

“ (7.) The regulations may provide for the informant reimbursing the Commissioners of Customs all expenses and damages incurred in respect of any detention made on his information, and of any proceedings consequent on such detention.

“ (8.) All regulations under this section shall be published in the ‘London Gazette’ and in the ‘Board of Trade Journal.’

“ (9.) This section shall have effect as if it were part of the Customs Consolidation Act, 1876 (*h*), and shall accordingly apply to the Isle of Man as if it were part of the United Kingdom.

(*h*) 39 & 40 Vict. c. 36, s. 42, pp. 526, 530.

“(10.) Section two of the Revenue Act, 1883 (i), shall be repealed as from a day (k) fixed by regulations under this section, not being later than the first day of January, one thousand eight hundred and eighty-eight, without prejudice to anything done or suffered thereunder.”

This section is a most important part of the scheme of the Act, for it, so far as it is effective, stops at the outset a class of frauds which, according to the evidence given before the Committees of 1862 and 1887, were widely prevalent and continually increasing, to the grave detriment of English manufacturers. Its main provisions are in accordance with the legislation now adopted in most civilized countries, under the International Convention, drawn up at conference on the subject of Industrial Property and Merchandise Marks, at Paris, in 1883, and amended at the subsequent Conference at Madrid, in 1889. The terms of the several Conventions are set out in the Appendix, pp. 658—665.

The Inter-
national
Conventions.

According to English law these terms, or the terms of any of the numerous treaties concluded between this country and other countries for the mutual protection of the trade-mark and allied rights of their respective subjects, have no application to or between subjects, and cannot be recognized as having any legal effect, except so far as they have been embodied in the municipal law of the several countries (l). An English Court is not competent

(i) 46 & 47 Vict. c. 55, s. 2, amending the last-cited section.

(k) 1st of Jan. 1888. Customs Regulations, of 1 Dec. 1887.

(l) See Art. IX. of the International Convention, Book I. Chap. XX., p. 454; and *The Californian Fig Syrup Co.'s Tm.*, 40 C. D. 620; 6 R. P. C. 126 (1888), Stirling, J., decided on sect. 103 of

the Patents, &c. Act, 1883; and *Lauri v. Renad*, (1892) 3 Ch. 402. The Court may refer to a treaty, in accordance with which an Act has been passed, to ascertain the circumstances to which the Act was intended to apply, as an aid to its construction. *Re Carter Medicine Co.'s Tm.*, (1892) 3 Ch. 472; 9 R. P. C. 401, North, J.

to inquire into a matter involving the construction of treaties or other acts of state, or to treat them as in any way operative to create or modify rights or duties, and the Crown cannot sanction any invasion by its officers of the rights of private individuals as they exist according to the municipal law, on the ground that it is necessary in order to comply with or compel obedience to a treaty (n).

France was, apparently, the first country to take effective steps to stop the importation of goods made abroad, but bearing words or marks describing them as made in the country of importation (o); but sect. 42 of the Customs Act of 1876, amended by the now repealed section of the Revenue Act of 1883, was amply sufficient for the purpose, if it had been effectively enforced.

Sect. 42 of
the Customs
Act, 1876.

Sect. 42 of the Customs Act, 1876, contains a list of goods among which the goods enumerated in this section are to be considered as included, and it provides that—

“The goods enumerated and described in the following table of prohibitions and restrictions inwards are hereby prohibited to be imported or brought into the United Kingdom, save as thereby excepted (p); and if any goods so enumerated and described shall be imported or brought into the United Kingdom contrary to the prohibitions or restrictions contained therein, such goods shall be forfeited, and may be destroyed or otherwise disposed of as the Commissioners of Customs may direct” (q).

Only marked
goods come
within the
prohibition.

The policy of the Act is to prevent fraudulent marking, whether by means of forged trade-marks or false trade descriptions, and this section, as the remainder of the Act, only applies to goods which bear marks bringing them within its terms. There is no general obligation to stamp

(n) *Walker v. Baird*, (1892) A. C. 491.

(o) See M. M. A. Report, 1887, Index, “France.”

(p) There are no general exceptions, but only exceptions relative

to particular classes of goods, none of which are here material.

(q) For the section dealing with the importation of watches, see p. 526.

imported goods with any indication of origin (*r*). And if the deceptive marks which make such an indication necessary under the Act appear only upon the covering or package of goods, it is considered sufficient that the qualifying indication of origin should be stamped on the covering or package only also (*s*).

All such goods.]—The goods which are liable to forfeiture under this section (*t*), in addition to those specially enumerated in sub-sect. (1), are goods which, if sold, would be liable to forfeiture under the Act, that is, by the joint operation of sect. 2 (3) (iii.) and sect. 2 (1), goods or things to which any forged trade-mark (*u*) or false trade description (*x*) is applied (*y*), or to which any trade-mark (*s*), or mark so nearly resembling a trade-mark as to be calculated to deceive (*a*), is falsely applied (*b*). It is submitted that the words “*if sold*” must here be construed to mean if sold with such guilty intent as is necessary to justify a conviction under the Act (*c*). This is in accordance with the principle of throwing upon the person charged the onus of proving that he acted without intent to defraud, or that he is protected by one of the special defences specified in the Act, or that he acted otherwise innocently (*d*). Otherwise there could be no forfeiture under this part of the section, except where an offence would have actually been committed had the goods been sold; and sale by an innocent person would not constitute an offence. The construction contended for accords with the remainder of the section, and with the older Acts, for it is plain that the forfeitures constituted by the latter part of sub-sect. (1)

(*r*) M. M. A. Report, 1890.

(*s*) See below, p. 534, n.

(*t*) See the summary in the Customs General Order of 22 Dec. 1887, rr. 6 and 11, Appendix, p. 630.

(*u*) Page 468.

(*x*) Page 487.

(*y*) Page 473.

(*s*) Page 465.

(*a*) Page 471.

(*b*) Page 474.

(*c*) The same construction is arrived at by treating sect. 2 (2) as imported without the qualifications contained in it. Cf. *Re Anglesea Colliery Co.*, L. R. 1 Ch. 555, a decision on sects. 38 and 74 of the Companies Act, 1862.

(*d*) Sect. 2 (2) (c), p. 511.

are independent of proof of guilty intention on the part of anyone, and the clauses of sect. 42 of the Customs Consolidation Act of 1876, and sect. 2 of the Revenue Act of 1883, which are replaced by this section, contained no reference to the knowledge, intention, or purposes of the importer, or of any other person in relation to the goods (*e*).

Goods bearing English words or names.

So far as can be judged from the summary of agricultural produce detained under the Act in the years 1888 and 1889, which is appended to the M. M. A. Report, 1890, a very large proportion of the goods seized upon importation is seized because they bear words or lettering in the English language (*f*).

As regards words forming parts of the goods on which they appear, see *ante*, p. 478; and as regards goods partly made in two or more countries, p. 480.

Goods from the Colonies or the United States.

The practice of the Customs House authorities in the matter was stated by Mr. Follett, in the paper already cited (*g*), to be based upon the conclusion that "the use of the English language and of English trade descriptions was misleading and *prima facie* inadmissible on foreign goods; but that this could not be held to apply to foreign goods coming from the United States or the Colonies."

Goods bearing British or Irish trade-marks or names.

All goods of foreign manufacture, &c.]—The prohibition of this part of sub-sect. (1) is absolute (subject to the proviso contained in it) without regard to intention, or to any licence or right to use the name or trade-mark from the proprietor, and it applies where the name or trade-mark has been applied by the proprietor himself, or in accordance with his orders, for the section is intended to guard against the importation of goods which appear to be home-made, because they bear the name or trade-mark of a manufacturer, &c., in the United Kingdom, in cases where the name or trade-mark is used honestly, and in cases where it

(*e*) Cf. sect. 12, "Search warrant," and "Forfeiture without conviction," pp. 520, 522.

(*f*) See sect. 3 (1) (b), "place or country," p. 480.

(*g*) M. M. A. Report, 1890, Appendix, p. 275. As to when the officers are expected to detain offending goods without special information, see p. 680.

is used with, as well as where it is used without, the concurrence of the manufacturer (*h*). The last cases are already provided for, since the goods would be liable to forfeiture under the earlier parts of the Act.

Manufactured goods only come within this part of the sub-section, although the Act generally applies to all goods whatsoever which are the subject of trade, manufacture, or merchandise (*i*). According to the view of the Act taken by the Customs authorities, goods which have undergone any process of manufacture, for instance, ground wheat, or hides tanned in the least degree, are manufactured goods (*k*).

Only manu-
factured
goods are
included.

Bearing any name, &c.]—It is unfortunate that the expression “having applied to them,” which is defined in the Act (*l*), was not here used instead of “bearing.” It is doubtful whether a name or mark which is not placed upon the goods or their covering, but is otherwise used in connection with them in any manner calculated to lead to the belief that the goods are designated or described by it, would be borne by the goods within the meaning of the sub-section (*m*).

Name (n).]—This includes any abbreviation of a name (*o*), and, therefore, initials which are the equivalent of a name in the market, as, for instance, D. L. R. & Co. for De La Rue & Co. (*p*).

Trade-mark.]—According to the definition of the Act, trade-mark means a registered trade-mark, or a trade-mark which is protected in any British possession or foreign state to which the provisions of sect. 103 of the Patents, &c. Act, 1883, are applied (*q*); but the draughtsman of this section of the Act must have intended to include other marks, for a mark purporting to be the trade-mark of a

(*h*) See Customs General Order 32 Dec. 1887, r. 15, Appendix, p. 683.

(*i*) Sect. 3 (1), “goods.”

(*k*) M. M. A. Report, 1890, Evidence of Messrs. Seymour and Follett, Q. 286.

(*l*) Sect. 5, p. 473.

(*m*) This would be within sect.

5 (d), p. 473. And cf. the use of a trade-mark which constitutes an infringement, above, p. 310.

(*n*) See “names and initials,” p. 492.

(*o*) Sect. 3 (1).

(*p*) Follett, M. M. A. Report, 1890, p. 276.

(*q*) Sect. 3 (1).

manufacturer, and not being such trade-mark, could hardly be a registered trade-mark. It is probably impossible to adopt this meaning in the construction of the Act, having regard to the express words of the interpretation clause. In other parts of the Act marks nearly resembling trade-marks are specially mentioned (*r*).

Customs
register of
names and
marks.

To enable the Customs officers to carry out the provisions of the section prohibiting the importation of goods marked with the names or trade-marks of manufacturers, dealers, or traders within the United Kingdom, registers of the names and trade-marks of such persons as choose to avail themselves of them are kept at the various ports of the United Kingdom in accordance with rules 13—15 of the Customs General Order of 22nd December, 1887 (*s*).

“Made in
Germany.”

Indication of the country, &c.]—The particular country must be indicated. The Committee of 1890 refused to recommend that the words “made abroad” be accepted as sufficient to pass the goods instead of the words “made in Germany,” &c., at present required, where, without the statement as to origin, the goods marked would fall within the section (*t*).

An indication which can readily be removed, for instance, words on a label attached by a string, is not accepted as sufficient to take the goods out of the section (*u*). It is, of course, a question of fact whether the explanation does accompany the objectionable name or trade-mark, and a merely pretended accompanying would be of no account. Rule 7 of the Customs General Order of 22nd December,

(*r*) *o.g.*, sect. 4 (a), and sect. 5 (3).

(*s*) Appendix, p. 682. See the form of declaration on registration, p. 686.

(*t*) Cf. the case of goods bearing English words, p. 482. Where a trade description suggesting an English origin has to be explained, and it does not fall within sect. 16 (1), the qualification “made abroad” is sufficient.

(*u*) M. M. A. Report, 1890, Q. 1953. ‘The Lords’ Committee on the Marking of Foreign Meat (1893) have recently reported that: “Traders complain that importers are only compelled by the M. M. Act to apply the mark of foreign origin to the package, and that the contents are systematically branded by English importers with English titles.” Report, p. x.

1887, requires the Customs House officers, in cases falling within it, to satisfy themselves that the name of some foreign country, or of some place in a foreign country, is applied to the goods in a manner equally indelible or irremovable, and as equally conspicuous as the name or trademark (which makes the qualifying name of the foreign country or place necessary), and in close proximity to it (*x*).

Importation.]—This includes transit (*y*), and, in spite of a strong appeal from shipping agents and other traders, whose businesses were said to be adversely affected by the working of the Act, the Committee of 1890 refused to recommend any alteration in this respect. Goods in transit.

Name of place in the United Kingdom.]—Sub-sect. (4), dealing with offences effected by false trade descriptions as to place or country (*z*), is more stringent than the proviso of sect. 18, since that only applies where the use of the name of a place or country is calculated to deceive.

Cases under this sub-section include cases—(a) where the name is intended to refer to the place in the United Kingdom of which it is the name, and to that alone; (b) where the name is that of a foreign place to which it is intended to refer, for instance, Boston; (c) where the name has originally been taken from the place in the United Kingdom, but is used to describe the goods or their process of manufacture, without any reference to the place being intended.

(a) Goods supplied according to an order from an English trader to a foreign manufacturer requiring the latter to put the address of the former on goods manufactured for him, would come under the first class, and so also would goods bearing such inscriptions as “A present from Brighton,” as well as goods expressly marked *English*,

(*x*) Appendix, p. 681. Cf. General Order of 1 Feb. 1889, r. 7, as to qualifying marks added as a condition of release. *Ibid.*, p. 703.

(*y*) See Customs Order of 1887, r. 27, Appendix, p. 685. Under

the Madrid Convention of 1891, the authorities are not bound to effect the seizure of goods in transit.

(*z*) Sect. 3 (1) (b), “place or country,” p. 480; sect. 18, p. 498.

Irish, London-made, or with any similar express misstatements (a); (b) the second class is unimportant; (c) Kidderminster carpets, Windsor soap, Balbriggan hose, Shetland shawls (b), and Cheddar cheese, are examples of the third class. The saving contained in sect. 18 with regard to conventional or generic descriptions (c) does not apply to sect. 16 (4), for the words of the latter are precise, that the name shall be treated as if it were the name of a place in the United Kingdom, and therefore not a description of the goods. In any case, however, the proviso of sect. 18 requires the name of the place or country where the goods were actually made or produced to be added, if the description includes the name of a place or country, and is calculated to mislead.

Customs regulations.]—The general orders (d) and other regulations (d) issued by the Customs authorities under the Acts are set out in the Appendix. The regulations provide, in accordance with the Act, that where goods are detected by the officers to be such as are prohibited to be imported, they are to be detained (f). They do not, however, contemplate that the officers will be competent of their own knowledge to detect the attempted infringement of the Act in all cases, or in all classes of cases (g); and accordingly they make provision for the officers to act upon information (h) given by private persons, for instance, by the owners of trade-marks or names which are likely to be wrongly used on imported goods, and in certain cases they require the informants to give security (i), or to make a deposit of money (k), as a condition of the detention of

(a) Cf. Customs General Order of 22 Dec., 1887, rr. 6 and 10. Appendix, p. 680.

(b) These examples are given in the Customs General Order, r. 9.

(c) Above, p. 498.

(d) Appendix, pp. 678 *et seq.*

(f) Pages 680, 690.

(g) General Order of 22 Dec.,

1887, rr. 6, 16, and 17.

(h) Regulations 2 and 3. Form of notice to Customs officer, p. 692. General Order of 22 Dec., 1887, rr. 19 to 23.

(i) Form of bond, p. 693. Regulations 3, 4, 7, and 29.

(k) General Order of 22 Dec., 1887, r. 24.

the goods. The register of names and trade-marks for the use of Customs officers has already been referred to (*l*).

Special regulations as to particular goods have been made in some cases, besides the general regulations just referred to. The earliest of these relate to watches (*m*). The others exempt from detention under the Act packing cases (containing goods) having the name of a port or place of destination applied to them in which the goods are clearly not intended to be sold or exposed for sale (*n*); inscriptions applied to goods by labels or tickets, or to boxes, &c. containing goods, for the convenience of dealers and shopkeepers, and not specially intended to attract the eye of the customer (*o*); Swedish iron bearing the words Lancashire Swedish (*p*); packages of natural flowers, fresh fruit, vegetables, and potatoes bearing address marks such as *Wm. Evans, Leeds*, and such packages coming from the Channel Islands, Malta, Gozo, and Gibraltar, and bearing, in addition to the address marks, any words in the English language describing the goods (*q*); sardines from places other than France bearing the trade description *Sardines à l'huile* (*r*); grain imported in bulk and transferred into marked sacks on board the importing ship (*s*); and bales of wool imported from New Zealand and the Australian and Cape Colonies marked with the names of the station upon which the wool was grown, which are identical with the names of towns or districts in the United Kingdom (*t*). And by the General Order of the 1st of February, 1889 (*u*), discretionary powers were conferred on collectors, inspectors, and surveyors, without a special order, to admit goods within the letter of the Act which are either articles, not dutiable, sent to an individual as

Special regulations as to particular goods.

Marks not intended to reach purchasers.

Lancashire Swedish iron. Addresses on fruit, &c.

Sardines.

Grain in bulk.

Colonial wool.

Goods for private use.

(*l*) Page 534; General Order of 22 Dec., 1887, rr. 13—15. Form of declaration, p. 686.

(*m*) G. O., 18 Jan., 1888, p. 693, and the last section of the G. O. next cited.

(*n*) G. O., 4 Feb., 1888, p. 697.

(*o*) G. O., 10 Mar., 1888, p. 698.

(*p*) G. O., 24 Mar., 1888, p. 699.

(*q*) G. O., 9 April, 1888, p. 699.

(*r*) G. O., 18 Dec., 1888, p. 700.

(*s*) G. O., 31 Dec., 1888, p. 700.

(*t*) G. O., 25 Jan., 1890, p. 703.

(*u*) Page 701.

Goods for
repair.

Samples.

Returns.

Practice of
the Customs
authorities.

Proceedings
against the
Customs
authorities.

presents or for personal use; articles, not new and manifestly private property, and old, used, or damaged articles sent into the United Kingdom for repairs; returned samples of no value, made by competing firms in the United Kingdom; certain foreign samples imported for purposes of manufacture or comparison, or British returned goods, not dutiable, or in respect of which no drawback could have been received.

The authorities when they have seized goods as contravening the Act, either forfeit and destroy or sell them, or release them upon receiving satisfactory explanations, or upon the removal or qualification of the objectionable marks, and, in some instances, upon the payment of fines (*x*). The officers are directed to take care that, in all cases where the Board allow qualifying words to be added before the delivery of goods, such words are applied in characters clear, conspicuous, and as indelible as the marks requiring qualification, and in close proximity to those marks (*y*).

Any proceedings taken against the Customs authorities or their officers, in respect of anything done or omitted in execution or intended execution of their duties under the Act, fall within the Public Authorities Protection Act, 1893 (*z*), so that the proceedings must be commenced within six months; judgment for the defendant carries costs between solicitor and client; the defendant may plead a tender of amends, and if the plaintiff does not recover more than the amount tendered, the defendant is entitled to costs (but this provision is not to affect costs on any injunction in the action); and if, in the opinion of the Court, the plaintiff has not given the defendant a sufficient opportunity of tendering amends before the commencement

(*x*) See the return of goods detained in transit down to March, 1890, M. M. A. Report, 1890, Appendix, p. 326.

(*y*) G. O., 1 Feb. 1889, r. 7, p. 703.

(*z*) 56 & 57 Vict. c. 61, which has repealed 39 & 40 Vict. c. 36, ss. 267 to 272, and 40 & 41 Vict. c. 13, s. 4.

of the proceedings, the Court may award to the defendant costs as between solicitor and client (a).

It has been held that an officer is not liable in trespass for detaining goods while in doubt whether they ought to be detained or not, and until the Commissioners of Customs had given directions concerning them, although he might, it was said, have been liable in damages for so detaining them for an unreasonable time (b). In an earlier case, it was held that for a wrongful refusal, except upon payment of an excessive amount of duty, to sign a bill of entry in order to enable goods to pass, an officer might be sued (c). The orders of his superior officer do not afford any defence for an officer who has acted illegally to the prejudice of any British subject (d).

(a) This replaces the old requirement of one month's notice of action.

(b) *Jacobsohn v. Blake*, 6 M. & G. 919; 7 Scott, N. R. 772 (1844).

(c) *Barry v. Arnaud*, 10 Ad. & Ell. 670 (1839).

(d) See *Walker v. Baird*, (1892) A. C. 491; *Sands v. Child*, 3 Lev. 352 (1693), and *Entick v. Carrington*, 19 State Trials, 1043 (1765).

CHAPTER II.

MISCELLANEOUS MATTERS.

False representation as to grant of patent or registration of design or trade-mark.—By sect. 105 of the Patents, &c., Act, 1883—

Penalty on
falsely repre-
senting
articles to be
patented.

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

“(2.) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade-mark is registered, if he sells the article with the word ‘patent,’ ‘patented,’ ‘registered,’ or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.”

The offences here dealt with are applications of false trade descriptions (*b*), but the liability to punishment under the Merchandise Marks Act would afford no answer to a prosecution under the above section (*c*).

And an infringement of the section is no bar to an

(*a*) As to the Isle of Man, see Act of 1883, sect. 112; and as to Ireland, *ibid.* sect. 117.

(*b*) See M. M. A., 1887, s. 3 (*a*), above, pp. 476, 484.

(*c*) M. M. A., sect. 19 (1), above, p. 520.

application for the registration of the trade-mark which has been wrongly described as registered (*d*).

Sub-sect. (2), if taken literally, makes the use of "patent" unlawful in cases where, apart from its provision, the use of the word would not have been held to amount to a false or misleading claim of a patent right, as, for example, where no patent has ever existed but the word has become part of the trade-name of the goods and has been used by the manufacturer in his description of them (*e*). It also prohibits the use of such ordinary names of commerce as "patent leather" and "patent medicine" (*f*). It is submitted that some limitation must be placed upon the literal meaning of the enactment which will exclude these cases from the section (*ff*).

Falsification of the Register of Patents, Designs, and Trade-marks.]—By sect. 93 of the above-mentioned Act of 1883—

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

Falsification of entries in registers.

False declaration as to country or place where a watch case was made.]—By sect. 8 (3) of the Merchandise Marks Act, 1887—

"Every person (*g*) who makes a false declaration False declara-

(*d*) *James' Tm.*, 33 C. D. 392; 3 R. P. C. 340 (1886), C. A.; see above, p. 345.

(*e*) *Edolsten v. Vick*, 11 Hare, 78 (1858), Wood, V.-C., (*Taylor and Co.'s Patent Solid-headed Pins*); see further, Book I. Chap. XV. p. 339; *Gridley v. Swinborne*, 52 J. P. 739, 791; 5 T. L. R. 71 (1888), Div. Court, *Swinborne's Patent Refined Isinglass*. held not to be a false trade description, see the last Chapter, p. 484.

(*f*) See above, p. 341.

(*ff*) Application for a patent, or provisional protection, does not authorize the use of the word patent; but, it is submitted, the acceptance of the complete specification of a patent does. See above, p. 484.

(*g*) "Person" includes corporation and partnership, above, p. 463; as to limitation of time for proceedings, see above, p. 517; for sect. 8, see p. 525.

tion as to
watch case.

“for the purposes of this section shall be liable, on conviction on indictment, to the penalties of perjury, and on summary conviction, to a fine not exceeding 20*l.* for each offence.”

False representation as to Royal warrant.]—By sect. 20 of the Merchandise Marks Act of 1887—

False repre-
sentation as
to Royal
warrant.

“Any person (*h*) who falsely represents that any goods are made by a person holding a Royal warrant, or for the service of Her Majesty, or any of the Royal Family, or any government department, shall be liable, on summary conviction (*i*), to a penalty not exceeding 20*l.*”

Unauthorized assumption of Royal arms.]—By sect. 106 of the Patents, &c. Act of 1883—

Penalty on
unauthorised
assumption
of Royal
arms.

“Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any government department, assumes or uses in connection with any trade, business, calling, or profession, the Royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction (*k*) to a fine not exceeding twenty pounds.”

The Cutlers'
Marks Act,
1819.

Cutlery marks.]—By the Act 59 Geo. 3, c. 7, it is forbidden to mark cutlery and the other goods mentioned in the Act with the figure of a hammer, unless the goods have been wrought or forged, or to place false marks of quality upon such goods, or to falsely mark them as London made; and the offences created by the Act extend to selling, or having in possession for the purposes of sale, such goods marked in breach of the Act. The material provisions of the Act (*l*) may be summarised as follows:—

(*h*) See note (*g*), above.

(*i*) In Scotland, in the Sheriff Court (sect. 21); and in the Dublin police district, the courts of the justices under the Petty Sessions

Act, 1851 (sect. 22).

(*k*) As to the Isle of Man, see Act of 1883, sect. 112; and as to Ireland, *ibid.* sect. 117.

(*l*) Sect. 17 has been repealed by

1. Where any knives, knife-blades, forks, razors, razor-blades, scissors, shears, and other articles of cutlery, edge tools and hardware requiring a cutting edge, of wrought steel, or of iron and steel, are made by means of the hammer, the maker may mark the figure of a hammer upon them before they are ground. Hammer marks.

3. No one may mark such figure on any of the goods enumerated not so made, before the *bonâ fide* sale of the goods to the user, or have in his possession for the purpose of sale, or sell any such goods not so made, and being marked with such figure, under penalty of forfeiture of the goods and a fine of 5*l.* for every dozen.

4. No one may mark on any of the goods enumerated, whether made with the hammer or cast in a mould, before the *bonâ fide* sale of the same to the user, "any word or words which shall or may denote or indicate the quality of such articles to be otherwise than the real and true quality thereof," or have in his possession for the purpose of sale, or sell any such goods so marked, under penalties as aforesaid. Quality marks.

5. No one may mark on any of the goods enumerated, whether made with the hammer or cast in a mould, before the *bonâ fide* sale of the same to the user, the word or words *London* or *London made*, or any word or words having any similitude thereto, unless the goods were made in the City of London, or within twenty miles distance therefrom, or have in his possession, &c., or sell (as before) under a penalty of forfeiture and fine of 10*l.* a dozen articles. London made.

7. Any one having in his possession for the purposes of sale, or selling any of the goods aforesaid contrary to the Act, who shall, before information or complaint laid against him, prove satisfactorily by oath before one or more justice or justices that he purchased the goods with the marks thereon without knowing they were marked Innocent purchasers.

the Stat. Law Rev. Act, 1873, sects. 11-13 and 15 wholly, repealed and sect. 2 by the Stat. Law Rev. Act, 1874, sects. 8-10 in part, and by 47 & 48 Vict. c. 43, s. 4.

contrary to the Act, and shall discover to two or more justices the name of the person from whom he bought, so that the latter shall be prosecuted to conviction, shall not be liable to penalties himself (*m*), but shall be entitled to two-thirds of the penalty recovered from his vendor, as any other informer.

Counterfeit-
ing Sheffield
corporate
marks.

The Cutlers' Co. Act of 1814 contains a provision inflicting penalties upon any person who counterfeits or imitates assigned corporate marks; and by sect. 81 (13) of the Patents, &c. Act of 1883, this provision has been extended to any mark entered in the Sheffield Register (*n*). The section of the first-mentioned Act is as follows (*o*):—

“If any member or members of the Cutlers' Company, or any other person or persons using, exercising, or carrying on any of such arts or trades as aforesaid within the said lordship or liberty, or six miles compass of the same, shall at any time after the passing of this Act strike, engrave, impress or use, or cause or procure to be stricken, engraved, impressed or used upon his or their goods, wares, or manufactures, any mark, device, stamp, or impression, with intent to counterfeit or imitate any mark or device assigned, or which may hereafter be assigned, by the said master, wardens, or searchers and assistants of the said company, to be used by any other person, the person or persons so offending shall, for every such offence, forfeit and pay (in lieu of the penalty imposed by the said last recited Act (*p*)) any sum not exceeding 20*l.*, one moiety whereof shall be paid to the person whose mark shall have been so counterfeited or imitated, and the other moiety to the said master and wardens of the said company; and the provisions in the said last recited Act (*p*) contained for the recovery and application of the penalty thereby imposed shall

(*m*) Cf. M. M. A., sect. 2, “unless he proves,” above, p. 505.

(*n*) Above, p. 101.

(*o*) 54 Geo. 3, c. 110, sect. 5, (local).

(*p*) The Cutlers' Co. Act of 1791, see above, p. 92.

“be used, applied, and put in force for the recovery and application of the penalty hereby made payable, as fully and effectually as if the same provisions were in this Act severally and separately repeated and re-enacted.”

The sections of the Cutlers' Co. Act of 1791 (*q*), which are referred to and incorporated by the last-mentioned section, provide (sect. 26) that the penalties may be sued for by the company, or (sect. 27) recovered summarily before a justice or justices of the West Riding of York, or of the county of Derby, who shall have power to award costs, and to issue a distress warrant, or, if the goods of the offender are insufficient, to commit him to the House of Correction for one month to enforce payment of the penalty. Sect. 28 contains a form of conviction, and sect. 29 gives an appeal to quarter sessions.

A number of statutes of little general importance, requiring special marks to be placed upon particular classes of goods, are summarized in the Appendix, p. 710. Statutes relating to particular goods.

(*q*) 31 Geo. 3, c. 58, (local).

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APPENDIX.

No. 1.

THE PATENTS, DESIGNS, AND TRADE-MARKS ACT, 1883, AS AMENDED BY THE ACT OF 1888 (a).

ARRANGEMENT OF SECTIONS.

SECTION

PART I.—PRELIMINARY.

1. Short title.
2. Division of Act into parts.
3. Commencement of [the Acts].

PART IV.—TRADE-MARKS.

Registration of Trade-Marks.

62. Application for registration.
63. Limit of time for proceeding with application.
64. Conditions of registration of trade-mark.
65. Connexion of trade-mark with goods.
66. Registration of a series of marks.
67. Trade-marks may be registered in any colour.
68. Advertisement of application.
69. Opposition to registration.
70. Assignment and transmission of trade-mark.
71. Conflicting claims to registration.
72. Restrictions on registration.
73. Further restriction on registration.
74. Saving for power to provide for entry on register of common marks as additions to trade-marks.

Effect of Registration.

75. Registration equivalent to public use.
76. Right of first proprietor to exclusive use of trade-mark.
77. Restrictions on actions for infringement, and on defence to action in certain cases.
- [77a. Certificate as to exclusive use and costs thereon.]

Register of Trade-Marks.

78. Register of trade-marks.
79. Removal of trade-mark after fourteen years unless fee paid.

Fees.

80. Fees for registration, &c.

Sheffield Marks.

81. Registration by Cutlers' Company of Sheffield marks.

(a) These Acts have been printed from Mr. Lewis Edmunds' "Patents, &c. Acts, Consolidated," by his permission.

PART V.—GENERAL.

- SECTION** *Patent Office and Proceedings thereat.*
82. Patent Office.
 83. Officers and clerks.
 84. Seal of Patent Office.
 85. Trust not to be entered in registers.
 86. Refusal to grant patent, &c. in certain cases.
 87. Entry of assignments and transmissions in registers.
 88. Inspection of and extracts from registers.
 89. Scaled copies to be received in evidence.
 90. Rectification of registers by court.
 91. Power for comptroller to correct clerical errors.
 92. Alteration of registered mark.
 93. Falsification of entries in registers.
 94. Exercise of discretionary power by comptroller.
 95. Power of comptroller to take directions of law officers.
 96. Certificate of comptroller to be evidence.
 97. Applications and notices by post.
 98. Provision as to days for leaving documents at office.
 99. Declaration by infant, lunatic, &c.
 100. Transmission of certified printed copies of specifications, &c.
 101. Power for Board of Trade to make general rules for classifying goods and regulating business of patent office.
 102. Annual reports of comptroller.
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Repeal ; Transitional Provisions ; Savings

113. Repeal and saving for past operation of repealed enactments, &c.
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General Definitions.

117. General definitions.

The FIRST SCHEDULE.—Forms of application, &c.

The THIRD SCHEDULE.—Enactments repealed.

46 & 47 VICT. c. 57.

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

51 & 52 VICT. c. 50.

An Act to amend the Patents, Designs, and Trade-Marks Act, 1883. [24th December, 1888.]

* * The general text of the Act of 1883 is adhered to. The repealed parts are printed in italics, and the additions in square brackets. The amending Act and section are quoted in the margin.

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

PART I.—PRELIMINARY.

1. This Act may be cited as the Patents, Designs, and Trade-Marks Act, 1883. Short title.

By Act 1888, s. 29, the principal Act of 1883, and the Amending Acts of 1885, 1886, and 1888, may be cited collectively as the Patents, Designs, and Trade-Marks Acts, 1883 to 1888.

The Acts of 1885 and 1886, do not relate to trade-marks.

2. This Act is divided into parts, as follows:—

Part I.—PRELIMINARY.

II.—PATENTS.

III.—DESIGNS.

IV.—TRADE-MARKS.

V.—GENERAL.

Division of Act into parts.

3. This Act, except where it is otherwise expressed, shall commence from and immediately after the thirty-first day of December one thousand eight hundred and eighty-three. Commencement of Act.

[The Act of 1888 shall, except so far as is thereby otherwise specially provided, commence and come into operation on the first day of January one thousand eight hundred and eighty-nine.] Act, 1888, s. 28.

What Act applied to pending registrations, p. 111.

PART IV.—TRADE-MARKS.

Registration of Trade-Marks.

Application
for registra-
tion.

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

The comptroller, p. 53, and sect. 82.

Discretion to refuse registration, although the mark tendered is within sect. 64, p. 63.

Registration of trade-marks, Chap. IV., p. 58.

Person includes firm or partnership (Rule 7, p. 596), and body corporate, sect. 117.

Proprietor, see as to who may apply to register, p. 60.

Procedure on application to register, p. 68.

Application by agent, p. 62. The agent must be authorised to the satisfaction of the comptroller. Rule 9, p. 596.

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

Act, 1888,
s. 8.

Form of application, p. 68, Form F., p. 608.

Address of the Patent Office, p. 53; Instructions 8, p. 628; Rule 8, p. 596.

Applications in classes 23, 24, or 25, go to the Manchester Branch Office, Chap. VII., p. 103; Instructions 8, p. 628; Rule 8, p. 596.

As to Sheffield marks, see Chap. VI., p. 91, sect. 81, Rules 56—59, p. 604.

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

Representations, Instructions 9, 15 and 16, p. 628; Rules 14 and 15, p. 597.

Classes of goods, Chap. V., p. 87; list of classes, p. 618.

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

Discretion to refuse, p. 63.

Applicant is entitled to be heard before the refusal, p. 67, sect. 94, Rule 17 and 18, p. 597.

Appeal to Board of Trade, p. 78; Forms, pp. 610, 637; Rules 20 to 26, p. 598.

Registration subject to conditions, p. 83. See also sect. 69 (3).

(5.) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court; and in that event

the Court shall have jurisdiction to hear and determine the appeal and may make such order as aforesaid.

Reference of the appeal to the Court, p. 80.

No direct appeal to the Court, p. 80.

The Court, p. 81, sect. 117 (1).

Summons or notice of motion, p. 81; Forms, p. 635 *et seq.*

Costs, p. 85.

An order of the Court allowing an appeal must be served on the comptroller, Rule 46, p. 602.

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

Act, 1888,
s. 8.

Page 82, cf. opponent's address, sect. 69 (6).

International convention, Chap. XX., p. 454, sect. 103. The con-
vention is printed at p. 658.

As to applications to rectify where the registered proprietor is resident
abroad, see p. 240.

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

Limit of time
for proceeding
with applica-
tion.
Act, 1888,
s. 9.

Abandonment of application, pp. 69, 235.

It is no bar to a subsequent application by the same person and in
respect of the same mark, p. 69.

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

Conditions of
registration of
trade-mark.

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

Repealed.
Act, 1888,
s. 10.

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

(c) *A distinctive device, mark, brand, heading, label, ticket,
or fancy word or words not in common use.*

Fancy word, p. 142.

Not in common use, p. 149.

(2.) *There may be added to any one or more of these particulars any letters words or figures, or combination of letters words or figures, or of any of them.*

(3.) *Provided that any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures used as a trade-mark before the thirteenth day of August one thousand eight hundred and seventy-five may be registered as a trade-mark under this part of this Act.*

Conditions of
registration of
trade-mark.

Act, 1888,
s. 10.

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

As to what marks may be registered as trade-marks, see Chap. VIII., p. 106.

As to what Act applies to pending registrations, p. 111, Act of 1883, sect. 113; Act of 1888, sect. 27, p. 586.

For comparison with repealed sections, see p. 109.

Essential particulars, pp. 112, 167.

Additions, p. 113, sect. 64 (2). Additions common to the trade, p. 169, sect. 74.

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

Name marks, p. 114; trade-name, 392.

Mere name in nominative case, p. 115.

Particular and distinctive manner, pp. 116, 118.

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

Signature, p. 117.

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

Distinctive, pp. 118—127; loss of distinctiveness, p. 285.

Descriptive marks, pp. 36, 127, 145.

The mark must be distinctive, apart from colour, pp. 129, 163.

Distinctiveness is an essential element of a trade-mark, apart from the Acts, Chap. II., p. 35.

Device, p. 128; copyright design, p. 78, n.; words not a device, p. 129.

Mark, p. 132.

Brand, p. 133.

Heading, p. 135; line headings, 198.

Label, p. 137; disclaimer of words in, pp. 138, 172.

Ticket, p. 139.

(d) An invented word or invented words; or

Word marks, p. 140.

Invented word, p. 152.

(e) A word or words having no reference to the character