

can have been no opportunity, or little opportunity, for deception to occur.

On an appeal from the Registrar by an applicant for registration, the onus is on the appellant to show affirmatively that his trade mark is not calculated to deceive.¹

Examples
and illustrations.

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

Contrasted Devices.

A pointer eating out of a pot, too near for registration to a similar dog standing by a pail with STANCH beneath it; *Jelley's Application*, 51 L. J. Ch. 689, n. A twisted curved horn, with a twig bearing two roses, too near a similar untwisted horn with a cord having two loops in the same place as the roses in the twig; *Rosing's Application*, 54 L. J. Ch. 975, n. A triangular frame with words upon it and a church inside, too near Bass's solid triangle; *Worthington's Tm.*, 14 C. D. 8; so also a white diamond within a red diamond; *Turney & Sons' Tm.*, 11 R. P. C. 37. A half-length figure of a milkmaid, with the word *Dairy-maid*, too near a full-length figure of a milkmaid carrying two pails; *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 C. D. 454; 3 R. P. C. 28. A woman's head wearing a helmet with ATHENA beneath, not too near a man's head with WAX beneath; *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102. A tower in an oval border, with a dog and harp, too near a tower, dog, and harp without any border; *Speer's Tm.*, 4 R. P. C. 521. An oval label containing interlaced triangular frames with a stag's head within them, too near an oval label with three superimposed solid triangles, although the lettering on the marks was conspicuously different; *Biegel's Tm.*, 4 R. P. C. 525; 57 L. T. 247. A sheep suspended by its middle, with the words GOLDEN FLEECE, too near a somewhat different sheep with the same words; *The Australian Wine Importers' Tm.*, 41 C. D. 278; 6 R. P. C. 311. A pig in outline, and H. B. & Co., not too near shaded pointer dog, and STANCH; *Haines, Batchelor & Co.'s Tm.*, 5 R. P. C. 669. A tobacco pipe and dart, not too near a tobacco

¹ *Eno v. Dunn*, 15 App. Ca. 252; 7 *Ltd.'s Application*, 23 R. P. C. 782 R. P. C. 311 (1889); *Capsuloid Co.*, (1906), Swinfen Eady, J.

pipe alone; *Lambert's Tm.*, 5 R. P. C. 542; 6 R. P. C. 344; 61 L. T. 138. A charging buffalo, too near a bull's head, both being placed in silver rings on similar yellow wrappers; *Farrow's Tm.*, 7 R. P. C. 260; 63 L. T. 233. A mark having as its sole essential particular a lion bearing a sheaf, too near a mark having as an essential particular a lion with a crown; *Murphy's Tm.*, 7 R. P. C. 163. An elephant in a border with lettering round it, an infringement of a somewhat different elephant alone; *Upper Assam Tea Co. v. Herbert & Co.*, 7 R. P. C. 183. A label bearing a winged cross surrounded by two circles in its upper third, not an infringement of a similar label, being a lighthouse similarly surrounded and placed; *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89. A label with two red medals and a balloon, an infringement of a similar label with two red medals only, both labels being used for polish known in India, from the latter label, as red medal polish; *Wilkinson v. Griffith*, 8 R. P. C. 370. A label with a cock in the centre, the groundwork being a piece of plaid with the words *Prince Charlie, King o' the Hieland Hearts*, in the upper part, too near a label bearing in the upper part the words *The Cock o' the North* with a cock in a central position over a coat of arms, with a Highlander on one side and a horse on the other; *Currie's Application*, 13 R. P. C. 681. A label bearing a representation of the Royal Exchange, Glasgow, and the words *Royal Exchange Whisky* below, refused registration because it would give the right to restrain a label bearing the same representation with the words *Bodega Special Whisky* below; *Rogers' Tm.*, 12 R. P. C. 149. C. B. & Co. and also C. B. D. held to infringe marks, one consisting of the device of a corset and the letters C. B. within a star, and the other of C. B. corsets; *Bayer v. Connell Bros.*, 16 R. P. C. 157.¹ The device of a red deer's head, not an infringement of a trade mark consisting of a moose head; *Alaska Packers' Association v. Crooks & Co.*, 16 R. P. C. 503, and 18 R. P. C. 129. The device of the cut side of half an apple cut vertically, with the word *Pomril* across it, too near a mark containing a representation of an apple and the words "apple brand," both marks being for cider; *Pomril Ltd.'s Application*, 18 R. P. C. 181. J. B. D. in an oval ring, an infringement of G. B. D. in an oval ring; *Maréchal and Ruchon v. M'Colgan*, 18 R. P. C. 262 (Ireland). A show-card

¹ In Ireland before Porter, M.R. See also *Bayer v. Baird*, 15 R. P. C. 615 (1897), Sc. Ct. of Session.

with a device having some of the features and lines of a diamond and the word "famous" on it, not an infringement of a plain diamond; *Bass, Ratcliff and Gretton, Ltd. v. Davenport & Sons' Brewery, Ltd.*, 19 R. P. C. 129 and 529. A sphinx in combination with Egyptian scenery not an infringement of a sphinx in a different position; *Lambert and Butler v. Goodbody*, 19 R. P. C. 377. A rampant cat on a horizontal barrel, known as the "Cat Brand" or "Cat and Barrel Brand," held to be infringed by a cat's head and fore-quarters out of the top of a barrel on end, with the words CAT BRAND; *Boord & Son v. Huddart*, 21 R. P. C. 149. The same trade mark held to be infringed by a cat sitting on the top of a barrel placed on end; *Boord & Son v. Thom & Cameron, Ltd.*, 24 R. P. C. 697. A label of which a signature was claimed as the essential feature held not to be infringed by a label similar in structure, but having the defendant's name prominently upon it; *Dawson v. Stewart*, 22 R. P. C. 250. An ace of spades with the word *Hub* on it held to be an infringement of an ace of clubs with the word *Club* on it; *Munday v. Carey*, 22 R. P. C. 273. A shamrock with a stalk twisted so as to form "& Co.," not too near a compound mark of a crown and a shamrock in a different position with the letters M. V. on it; *Shamrock & Co.'s Application*, 24 R. P. C. 569. A diamond divided into two triangles, and bearing upon it a device and monogram, refused registration on the ground, *inter alia*, of similarity to other diamond marks; *La Union Agricola's Trade Marks*, 25 R. P. C. 295. A representation of the head of a Red Indian allowed to proceed to advertisement notwithstanding the presence on the Register of the representation of a Red Indian on horseback with the words "Red Indian," which had been disclaimed, underneath; *Carborundum Co.'s Application*, 26 R. P. C. 504. Mark consisting of a swan within an oval and the words "Swann & Co." not too near a mark consisting of the device of a swan with a small boy sitting on its back used for goods sold as "Club Sauce" and "Continental Pickles," there having been concurrent user; *Holbrooks, Ltd.'s Application*, 26 R. P. C. 791. Trade mark consisting of a view of Blackfriars Bridge with St. Paul's Cathedral in the background held to be infringed by a view of a bridge with a supposed town containing a similar building in the background, the labels being of similar shape and each having at one end a device within a circle; *Price's Patent Candle*

Company, Ltd. v. Ogston & Tennant, 26 R. P. C. 797. Label for semolina held to have such resemblance to the plaintiffs' label for semolina as to be calculated to deceive, although the plaintiffs' and defendants' names were on their respective labels, and injunction against passing-off granted; *Wright, Crossley & Co. v. Blezard*, 27 R. P. C. 299. A representation of Eastern Dye Works held to be too near a different representation of the same subject, there being a probability of both marks becoming known by the same name; *Application of Chemische Fabrik Greisheim Electron*, 27 R. P. C. 201. A representation of a circular cake of dental composition with a raised edge and engine-turned with a band across it with the name "Stent's" on it, the letter "G" above, and a picture of a palate below the band, held not to infringe and not liable to be passed off as a representation of a circular cake of dental composition with a raised edge and engine-turned in a different pattern with the name "Stent's" across it in a panel and an impression plate above and below the panel, the plaintiffs not having a monopoly of the name "Stent," and the defendants' mark having been used for thirteen years, there being evidence that the limited class of purchasers for the goods would not be deceived; *Claudius Ash & Sons & Co., Ltd. v. Invicta Manufacturing Co., Ltd.*, 28 R. P. C. 252, 597, and 29 R. P. C. 465. Heart shaped design with the initials "E.A.S." within it, not infringed by a more conventionally shaped heart with a letter and number within it, the initials being the characteristic of the plaintiffs' trade mark; *Schwerdtfeger & Co. v. Hart Publishing Co.*, 29 R. P. C. 286. Trade marks consisting of the letters A, B, and A B, each within a diamond, held not to be infringed by the use of a mark consisting of the letters A, B, C, in a device representing interlocked pieces of steel, and, although the plaintiffs' steel of particular qualities was known as "A Steel," "B Steel," etc., an injunction restraining the defendant from passing off by describing his steel as "A, B, C Steel" dissolved; *John H. Andrew & Co., Ltd. v. Kuehnrich*, 30 R. P. C. 93, and on appeal, *Times*, August 2, 1913.¹ The get-up of motor cabs consisting of a colouring of the cabs which was common, coupled with the letters W. & G. in a peculiar script form, held to have been imitated by a get-up consisting of similar colouring with the letters M. G. painted in a deceptive manner; *W. & G. Du Cros, Ltd. v. Gold*, 30 R. P. C. 117.

¹ See Addenda.

Contrasted Words.

WHITE ROSE, too near ROSALINE; *White Rose Tm.*, 30 C. D. 505. CONDI-SANITAS and SANITANT, infringements of SANITAS; *Sanitas Co. v. Condy*, 4 R. P. C. 195 and 530; 56 L. T. 621. BOYD'S UNRIVALLED HARNESS COMPOSITION, in a label with the Arms of the City of Dublin, not an infringement of PROPERT'S IMPROVED HARNESS COMPOSITION in a label, with a fox's head, the labels being similarly got up; *Beddow v. Boyd*, 4 R. P. C. 310. APOLLINIS, an infringement of APOLLINARIS; *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478. STEINBERG, an infringement of STEINWAY, the words being used with devices showing a general similarity; *Steinway v. Henshaw*, 5 R. P. C. 77. EMOLLIO, too near EMOLLINE; *Grossmith's Tm.*, 6 R. P. C. 180; 60 L. T. 612. EMOLLIOLORUM, not too near MOLLISCORIUM; *Talbot's Tm.*, 11 R. P. C. 77. SWIFT'S SPECIFIC occurring in a trade mark, not calculated to deceive merely because the words were descriptive of the opponent's drug; *Swift Specific Co.'s Tm.*, 6 R. P. C. 352. OOMOO, not too near EMU; *Burgoyne's Tm.*, 6 R. P. C. 227; 61 L. T. 39. KOKOKO, too near the common word COCO; *Jackson & Co.'s Tm.*, 6 R. P. C. 80. DEMOTIC, an infringement of DEMON; *Slazenger v. Feltham*, 6 R. P. C. 531. DUNN'S FRUIT SALT BAKING POWDER, too near ENO'S FRUIT SALT; *Eno v. Dunn*, 41 C. D. 439; 15 A. C. 252; 7 R. P. C. 311; subsequently held to be an infringement, 10 R. P. C. 261. EL DEVINO, an infringement of EL DESTINO; *Pinto v. Trott*, 8 R. P. C. 173. Label with EL DESTINACION, an infringement of a similar label with EL DESTINO; *Pinto v. Badman*, 8 R. P. C. 181. Label with LONDON PICKLES, an infringement of a similar label with LONDON PICKLE Co.; *Hammond v. Malcolm, Brunner & Co.*, 9 R. P. C. 301. STAFFORD, an infringement of TRAFFORD; FORT of FORTRESS; NEW MISTRESS, but not NEW MATRON, NEW MASTER, or MASTER, of MISTRESS; but SOUTH AFRICAN not an infringement of a mark consisting of a negro's head and the word AFRICAN; *Smith and Wellstood v. Carron Co.*, 13 R. P. C. 108. VINCALIS, not too near WINGARNIS, the goods being different in appearance and use; *Coleman & Co., Ltd. v. Brown & Co.*, 16 R. P. C. 619 (passing-off). TRITICUMINA, not infringed by TRITICINE; *Meaby & Co., Ltd. v. Triticine, Ltd.*, 15 R. P. C. 1. Signature ROBERT CRAWFORD, not infringement of signature DANIEL CRAWFORD; *Crawford v. Bernard & Co.*, 11 R. P. C. 580.

MARGARITA, an infringement of LA FLOR DE MARGARETTA; *Benedictus v. Sullivan, Powell & Co.*, 12 R. P. C. 25. SAVOLINE, an infringement of SAVONOL; *Field, Ltd. v. Wagel Syndicate, Ltd.*, 17 R. P. C. 266. IVORY, for soap, not necessarily calculated to cause the goods to be confused with IVY soap; *Goodwin v. Ivory Soap Co.*, 18 R. P. C. 389.¹ NIGHT CAP, not too near RED CAP or MOTHER RED CAP; *Hedley's Tms.*, 17 R. P. C. 719. VALTINE, too near VALENTINE; *Valentine Meat Juice Co. v. Valentine Extract Co., Ltd.*, 17 R. P. C. 673, passing-off (and see 18 R. P. C. 175). S. GRIFFITHS, three stars and I. X. L., not infringed by E. GRIFFITHS and three stars, the stars being common marks of quality; *Marshall v. Sidebotham*, 18 R. P. C. 43. On an application for an interlocutory injunction, ST. IVES cheese held too similar to ST. IVEL, registered for cheese; *Aplin and Barrett v. Richards*, 20 R. P. C. 799. NEOSTYLE, not too near CYCLOSTYLE; *Neostyle Manufacturing Co.'s Tm.*, 20 R. P. C. 329 and 803. SECURINE, an infringement of SECCOTINE; *McCaw, Stevenson and Orr, Ltd. v. Nickols & Co.*, 21 R. P. C. 15. COCOSOLINE, not an infringement of COTTOLENE; *Fairbank Co. v. Cocos Butter Manufacturing Co.*, 21 R. P. C. 23. Mark including the words JOCK SCOTT, too near SCOTCH JOCK; *Booth Distillery Co.'s Application*, 21 R. P. C. 18. TABLONES, too near TABLOIDS; *Capsuloid Co., Ltd.'s Application*, 23 R. P. C. 782. NEOLA, not too near PIANOLA; *Pianotist Co., Ltd.'s Application*, 23 R. P. C. 774. LANCO, not too near LANCASHIRE; *Reddaway & Co., Ltd. v. Irwell and Eastern Rubber Co., Ltd.*, 23 R. P. C. 621; 24 R. P. C. 203, alleged passing-off, the goods being somewhat different. B. A. S., too near B. S. A.; *Birmingham Small Arms Co., Ltd. v. Webb & Co.*, 24 R. P. C. 27, passing-off. MIDLAND STAR, not too near STAR; *Star Cycle Co., Ltd. v. Frankenburgs*, 24 R. P. C. 46 and 405, alleged passing-off, there being several names in use in the trade which included the word star. GLEN THORNE for whisky, too near THORNE'S whisky; *R. Thorne & Son, Ltd. v. Pimms, Ltd.*, 26 R. P. C. 221, rectification and passing-off.² AQUATITE, not too near AQUASCUTUM, there being other names in

¹ The action was dismissed on another ground, and the appeal would apparently have failed also on that ground, namely, that the defendants had acquired a right to use the word Ivory. The only point of similarity lay in the names.

² The case turned, however, a good deal on the fact that the defendants' label had been registered during trading relations between them and the plaintiffs, which had ceased, and by arrangement with the plaintiffs.

the trade (waterproof garments) also beginning with "Aqua"; *Aquascutum v. Cohen and Wilks*, 26 R. P. C. 651, alleged passing-off. OSOWOOL, too near ORLWOOLA, *Application of H. N. Brock & Co., Ltd.*, 26 R. P. C. 681.¹ MURRILLO, too near MURALO; *Muralo Co. v. Taylor*, 27 R. P. C. 261; passing-off. COLONIAL not an infringement of or liable to be passed-off as COLONEL; *St. Mungo Manufacturing Co. v. Viper and Recovering Co.*, 27 R. P. C. 420. SAILOR beneath a picture of a sailor not too near SKIPPER, although the picture was associated with the word SKIPPER in respect of other goods; *Angus Watson & Co.'s Application*, 28 R. P. C. 313.² MURAD, too near MURATTI; *Muratti, Sons & Co., Ltd. v. Murad, Ltd.*, 28 R. P. C. 497. PICK THEM OUT, preceded by word BARGAINS, too near the device of a pick and the word PICK; *Briggs v. Dunn & Son*, 28 R. P. C. 704, infringement and passing-off.³ CARVINO, not too near WINCARNIS; *Coleman v. Stephen Smith & Co., Ltd.*, [1911] 2 Ch. 572; 28 R. P. C. 645; 29 R. P. C. 81.⁴ AQUA-REPELA, too near REPELLUS, owing to the probability of abbreviation to REPELA; *Wilks' Application*, 29 R. P. C. 21. Marks consisting of or containing the word SCHICHT held to be calculated to deceive by reason of the resemblance of that word to the word SUNLIGHT; *Georg Schicht, Actiengesellschaft, Applications by*, 29 R. P. C. 483. STATEROOM, too near STATE EXPRESS, the latter being in use often abbreviated to STATE; *United Kingdom Tobacco Co.'s Application*, 29 R. P. C. 489. LIMIT not too near SUMMIT; *Smith's Application*, 30 R. P. C. 863. HEROGEN, not too near CEREGEN, the goods being different, *British Drug Houses' Trade Mark*, 30 R. P. C. 74.

Concurrent User.

Concurrent
user.

By sec. 21:—

"In case of honest concurrent user or of other special circumstances which, in the opinion of the Court, make it proper so to do, the Court may permit the registration of the same trade mark, or of nearly identical trade marks, for the same goods or description of goods by more than one

¹ There was no appeal from this decision, but only from the decision that "Orlwoola" was a registrable trade mark. It was expunged on appeal: (1910) 1 Ch. 190; 26 R. P. C. 850.

² The applicants consented to amend

by substituting "Sailor Brand" for "Sailor."

³ On a motion for an interlocutory injunction, which was granted.

⁴ An injunction granted against passing-off by get-up was dissolved on appeal.

proprietor subject to such conditions, and limitations, if any, as to mode or place of user or otherwise, as it may think it right to impose."

Prior to the Act of 1905 the Court had held itself bound by the terms of the Acts to refuse registrations of two identical or similar marks for the same goods.¹ This was an undoubted hardship in the cases, which sometimes occurred, of a trader having built up a trade under a trade mark in ignorance of a similar registered trade mark of another person, the businesses of the traders under the marks being confined to different localities so as not to have clashed. Section 21 provides a remedy for such a state of things by conferring on the Court in cases of honest concurrent user or of other special circumstances power to permit registration, either of the unregistered trade mark, or, if neither is registered, of both trade marks, subject to such, if any, conditions and limitations as it may think fit.² Where neither of the marks has been registered, the owners can also, if they settle their claims by agreement to the approval of the Registrar or the Board of Trade, obtain registration under sec. 20;³ at least this appears to be the effect of secs. 20 and 21 taken together, but it may be held that the Court only can allow concurrent registration in cases which fall within the terms of sec. 21, although this would give a narrow interpretation to sec. 20. Restrictions as to mode or place of user⁴ are expressly authorised, and limitations as to colour⁵ or as to the goods on which the marks are to be used are amongst those which the Court can impose. No doubt in exercising its discretion under the section the Court will have regard to the interests of the public as well as those of the owners of the trade marks. Moreover, if the trade mark is one which ought not, under sec. 11, to be

¹ *Ehrmann's Tms.*, [1897] 2 Ch. 495; 14 R. P. O. 665; *Hall and Woodhouse, Ltd.'s Application*, 19 R. P. O. 58 (1902). An old mark has sometimes been registered notwithstanding the presence on the Register of a similar new mark: *Mouson v. Boehm*, 26 O. D. 398 (1884); *Jackson v. Napper*, 35 O. D. 162; 4 R. P. O. 45 (1887).

² In *Boord & Son v. Thom and Cameron, Ltd.*, 24 R. P. O. 697 (1907), Inner House, Scotland, the Court held that where in an action for infringe-

ment concurrent user is alleged, the defendant ought to ask to be put on the Register. It is doubtful whether the Court can do this, however, without an application to register the mark in the usual way.

³ Above, p. 250.

⁴ As to the view taken by the Courts in respect of limitations of locality under the previous Acts, see above, p. 82.

⁵ Sec. 10. See Chap. VIII., above, at p. 233.

registered by reason of its being deceptive or otherwise, sec. 21 ought not to be applied in favour of it.¹

Where an application is made for a trade mark, and another trader opposes it on the ground that it might interfere with the use by him of a trade mark of which he has had substantial concurrent user and alternatively asks that his trade mark also should be put on the Register, he should make a substantive application for registration of his trade mark, and in a proper case the first application will be ordered to stand over to enable him to do so.² In the *A. B. C.* case,³ where it was found that those letters were common to the trade, as those words had been interpreted by the Court in earlier cases, applications by rival applicants for marks which included those letters were ordered to proceed. In no case which has come before the Courts under the Act of 1905, has concurrent registration of marks similar in distinctive features been allowed, although in some cases duplicate claims have been raised.⁴

Concurrent
rights in
registered
mark.

Three other provisions of the Act may here be noticed, namely, that relating to apportionment of trade marks where a goodwill becomes divided on dissolution of partnership or otherwise;⁵ the proviso to sec. 39, which provides that where two or more persons are registered proprietors of the same (or substantially the same) trade mark in respect of the same goods, no rights of exclusive user of such trade marks shall (except so far as their respective rights shall have been defined by the Court) be acquired by any one of such persons as against any other by the registration thereof, but each of such persons shall otherwise have the same rights as if he were the sole registered proprietor thereof; and the following proviso to sec. 41 (which makes registration conclusive after a period of years):—

“ Provided that nothing in this Act shall entitle the proprietor of a registered trade mark to interfere with or

¹ *Compagnie Industrielle des Petrole's Application*, [1907] 2 Ch. 485; 24 R. P. O. 585, Warrington, J.

² *Applications of Javal and Parquet*, and of *Piesse and Lubin*, 29 R. P. O. 627 (1912).

³ *Applications of Albert Baker & Co.* (1898), *Ltd.*, and of *Acrated Bread Co.*, [1908] 2 Ch. 86; 25 R. P. O. 518, Eve, J. The case is more fully referred to under Disclaimer, above, p. 238.

⁴ See the cases cited under Duplicate

Claims, above, p. 250. In *Southall Bros.*, and *Barclay, Ltd.'s Application*, 28 R. P. O. 481, Neville, J., the applicants proved twenty years' user against five years' user by the opponent, and the opposition was disallowed. The opponent made no application to register. See also p. 202.

⁵ Assignment and transmission of trade marks, Chap. XIII., below, p. 384.

restrain the user by any person of a similar trade mark upon or in connection with goods upon or in connection with which such person has, by himself or his predecessors in business, continuously used such trade mark from a date anterior to the user of the first-mentioned trade mark by the proprietor thereof or his predecessors in business, or to object (on such user being proved) to such person being put upon the Register for such similar trade mark in respect of such goods under the provisions of section twenty-one of this Act."

II. Deceptive or Scandalous Marks.

It is provided by sec. 11 that—

"It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would by reason of its being calculated to deceive or otherwise,¹ be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design."

Sec. 11.

Deceptive or scandalous marks.

With certain alterations to be noticed, this section embodies the provisions of secs. 73 and 86 of the Act of 1883.² The latter section related to trade marks the use of which was contrary to law or morality. Section 73 of the Act of 1883 affected only words, whilst in the present section the more general term "matter" is used. The words "as a trade mark or part of a trade mark" are substituted for the words "as part of or in combination with a trade mark"; this is in harmony with the remainder of the present Act, which omits all provisions for registering additions to trade marks. Sec. 73 was apparently in one case applied to a trade mark consisting only of a single word.³ The word "exclusive" which qualified "use," both in the Act of 1875 and in the Act of 1883, was removed, upon the suggestion of Lord Herschell's Committee, by the Act of 1888.⁴ The Committee say: "Words might be offered for registration in conjunction with a trade mark for which the applicant did not claim, and of which he would not be entitled to claim the exclusive use, but the use of which might nevertheless be

"Exclusive use."

¹ See p. 308.

² See above, p. 274. The corresponding provision of the Act of 1875 was sec. 6.

³ *Eastman Photographic Materials Co. v. John Griffith's Cycle Corporation*, 15 R. P. C. 105 (1898), Romer, J.

⁴ Sec. 15.

calculated to deceive, and so be disentitled to the protection of a court of justice."

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

The Fruit Salt case.

The provisions as to deceptive marks were, no doubt, intended to embody the old rule of the Court of Chancery, which refused protection to the owner of a deceptive trade mark;¹ and it was held, by Jessel, M.R., that their operation was confined to cases where the marks were in themselves inherently deceptive;² but the Courts have held that the restriction is of wider scope than the old rule, or than this construction would suggest.³ The leading case in point is *Eno v. Dunn*,⁴ in which the House of Lords (Lord Halsbury and Lord Morris dissenting) overruled the judgment of the Court of Appeal (Lindley and Fry, L.JJ., Cotton, L.J., dissenting), and restored that of Kay, J. The question in that case was whether the words *Fruit Salt* occurring in a mark consisting of the words *Dunn's Fruit Salt Trade Mark Baking Powder*, and in a mark consisting of a distinctive label, quite different in character from the device used by the opponent, Eno, and bearing the words *Dunn's Fruit Salt Baking Powder*, were calculated to deceive, having regard to the well-known use of the words as the name of Eno's Fruit Salt. Eno, in the first instance, based his opposition to Dunn's application to register his marks partially upon his title as the owner of the mark *Fruit Salt*, registered as "a proprietary medicine for human use," and also as a "dry preparation for making a non-intoxicating beverage"; but finding that he could not prove user of that mark before 1875, and that the words were consequently not capable of registration under the Acts then in force, he was driven to consent to its removal from the Register, and to rely wholly upon the alleged deceptiveness of the marks propounded by Dunn. The marks were normally used for different goods. Dunn's preparation was a baking powder, and Eno's an aperient effervescing powder; but evidence was given that, in a very few instances,

¹ See Chap. XV., at p. 472, and *Ld. Macnaghten's* judgment in *Eno v. Dunn*, *infra*.

² *Horsburgh's Application*, 53 L. J. Ch. 237, n.; 50 L. T. 23, n. (1878) (*Valvoleum*).

³ See the judgment of Cotton, L.J., in which the majority of the law lords concurred, in *Eno v. Dunn*, 41 C. D. p. 448. The *Motorine* case, cited below, p. 300, and *Application of Albert Baker*

& Co. (1899), *Ltd.*, [1908] 2 Ch. 86; 25 R. P. C. 513, where it was held that sec. 11 of the Act of 1905 ought to be construed in the same manner.

⁴ 15 App. Ca. 252; 7 R. P. C. 911; *Dunn's Tm.* (1889). Subsequently an injunction was granted to restrain *Dunn & Co.* from using the words *Fruit Salt: Eno v. Dunn*, 10 R. P. C. 261 (1893), Kekewich, J.

Eno's salt had been used as a baking powder, although it was shown to be very unsuitable for the purpose. The majority of the law lords held that Dunn's marks were deceptive, and the application to register was dismissed. Lord Herschell and Lord Macnaghten based their judgments upon the discretion conferred on the Comptroller—apart from the sections considered in this chapter—to refuse marks from which it is not clear that deception might not result. Lord Herschell said: "I think it is enough to say that I am not satisfied that there would be no reasonable danger of the public being so deceived. The case was argued on behalf of the respondent, as if he had an absolute right to have any trade mark registered which was not proved to fall within the terms of either the 72nd or 73rd section of the Act. I do not so read the statute. Those sections prohibit the registration of a trade mark in certain specified cases; but there is no duty cast upon the Comptroller of registering every other trade mark that may be applied for. On the contrary, whilst he is in certain cases prohibited from registering, a discretion whether to register or not appears to me to be in all cases fairly conferred." And Lord Macnaghten said of the marks: "They are calculated, and I think designed, to create a confusion in the minds of those persons to whom Mr. Dunn's advertisements are addressed, and to lead the ordinary run of such persons to suppose that his baking powder is in some way or other connected with Mr. Eno's preparation"; and he held, therefore, that the marks ought to be rejected, for the "Comptroller ought to reject words which involve a misleading allusion or suggestion of that which is not strictly true, as well as words which contain a gross and palpable falsehood."

Doubtful
new marks to
be rejected.

Lord Her-
schell's judg-
ment.

Lord Mac-
naghten's
judgment.

Lord Watson, on the other hand, treated the case as one falling within the 73rd section of the Act of 1883. "These prohibitory clauses," he said, referring to secs. 73 and 72 (2), "cast upon the applicant the duty of satisfying the Comptroller, or the Court, that the trade mark which he proposes to register does not come within their scope. In an inquiry like the present, (the applicant) does not hold the same position which he would have occupied if he had been defending himself against an action for infringement. There, the onus of showing that his trade mark was calculated to mislead rests, not on him, but upon the party alleging infringement; here, he is *in petitorio*, and must justify the registration of his trade mark by showing affirmatively that

Lord
Watson's
judgment.

it is not calculated to deceive. It appears to me to be a necessary consequence that, *in dubio*, his application ought to be disallowed." And upon the question of fact he said: "There would be a supposed connection in the minds of many persons, who would naturally assume that the baking powder had been manufactured with the appellant's fruit salt, and purchase it in that belief; so that a batch of badly made baking powder might seriously injure the credit of the effervescing powder."¹

The following cases deserve special notice. In *Dewhurst's Application*² the words *The Golden Fan Brand* in Burmese characters were refused registration as an essential particular of a mark, there being on the Register for the same goods a fan which in use was coloured gold; and Kay, L.J., expressly based his judgment on sec. 73 of the Act of 1883, holding that the words would, in Burma, be calculated to deceive, in the event of the owner of the registered fan trading there. In *Eastman Photographic Materials Co. v. John Griffith's Cycle Corporation*,³ the last-named company had registered *Kodak* as a trade mark for cycles, and the plaintiffs, who moved to remove the mark from the Register, had identified that name with themselves and their goods, and in particular with bicycle cameras, and the name was comprised in several of their trade marks, but none of them was registered in class 22, which includes bicycles. Romer, J., held that the defendants intended, by the use of the name, to cause the public to think that they were connected with the plaintiff company, or that their goods were those of the plaintiff company, and, following *Eno v. Dunn*, he ordered the mark to be removed, as, when registered, being likely to deceive. It is not clear, however, whether the decision was one on sec. 73 or on the general discretion of the Comptroller to refuse a deceptive mark apart from any particular section of the Act.

In a recent case the proprietors of a trade mark consisting of the word *Motorine*, and registered for lubricating oils, opposed an application for registration of the word *Motricine* as a trade mark for petrol spirit, and the opposition was partly based on sec. 11, and the danger to the public by explosion, in case the petrol spirit were by reason of similarity of the name taken for the lubricating oil, was relied on. Warrington, J., decided that

¹ See above, p. 76, "the Registrar's discretion."

² [1896] 2 Ch. 137; 13 R. P. C. 288.

See above, pp. 259, 260.

³ 15 R. P. C. 105 (1896), Romer, J.

there was a possibility of confusion, and that serious consequences might ensue to the public, and he upheld the decision of the Registrar, who had refused registration.¹

In a recent case it was held that registration of the words "Royal Worcester" for corsets ought to be refused on the ground that the word "Royal" *prima facie* suggests Royal patronage, which did not exist, and that the words, if used in connection with corsets generally, and without reference to the place of manufacture, would suggest such patronage, and therefore be calculated to deceive within the meaning of sec. 11.²

A mark is not calculated to deceive merely because it contains an ordinary description of an article of commerce which is occasionally used to describe a rival trader's goods.³ To hold otherwise would certainly be, as Fry, L.J., said in *The Fruit Salt* case, to allow the objector "to enclose and appropriate as private property certain little strips of the great open common of the English language."⁴ Thus, where *The Smokeless Powder Co., Ltd.*, had registered a label bearing a target, with their name printed prominently upon it, supported on one side by the figure of a sportsman and on the other by that of a rifleman, an unsuccessful attempt was made by a rival powder-making company to have the mark removed from the Register, or to have a disclaimer of the words *Smokeless Powder* added to the registration. The application failed as to the disclaimer, because the words were not distinctive, and also because they were not additions within the meaning of sec. 74, and were part of the name of the proprietors of the mark. It was argued that the presence of the words in the label was in effect a claim of a monopoly of the words, although the manager of the respondent company stated that the company made no such claim; but Chitty, J., decided against the objection,⁵ and held that the use of the words in the mark was not calculated to deceive.⁶ No

Mark containing name of the opponent's goods not necessarily deceptive.

The Smokeless Powder Co. case.

¹ *Compagnie Industrielle des Petrole's Application*, [1907] 2 Ch. 435; 24 R. P. C. 585.

² *Royal Worcester Corset Co.'s Application*, [1909] 1 Ch. 459; 26 R. P. C. 185, Parker, J. The applicants were of Worcester, Massachusetts, and the words in question were used with additional words indicating American origin. It was also held that without such addition the words were not dis-

tinutive. And see above, pp. 194, 195.

³ See *Dexter's Application*, [1893] 2 Ch. 262; 10 R. P. C. 269, Wright, J. (*Star Tobacco*), above, p. 282.

⁴ 41 C. D. at p. 455.

⁵ See Chap. VIII., at p. 214, "Label." Cf. *Application of Albert Baker & Co.* (1898), *Ltd.*, [1908] 2 Ch. 86; 25 R. P. C. 513, Eve, J.

⁶ So also in *Faulder's Tm.*, 18 R. P. C. 37 (1901), Kekewich, J., held that

such identification of the words in question with the applicant's goods was proved in this case, as was shown in *The Fruit Salt* case of the words *Fruit Salt* with Eno's powder, and in *The Stone Ales* case¹ of the words *Stone Ales* with Joule & Sons' beer; but, apart from this, the case seems readily distinguishable, on the ground already mentioned, that the words concerned were the ordinary words which anyone would choose to describe the goods both of the applicants and the respondents, and words which, apart from the Acts, could never have become, for such goods, the subject of exclusive rights.²

Device suggesting the name of the opponent's goods.

And as the presence of a common word in a label does not make the label deceptive, although the word is used of the opponent's goods,³ so neither does the presence of a device which suggests such a word. Thus, in *Kutnow's* case,⁴ a label which included a picture of the Deer-leap rock at Carlsbad—a well-known and remarkable object in the environs of the town—was allowed to be registered for use with Carlsbad Salts, the name of the salts being common property, and applicable both to the natural product of the springs at Carlsbad and to artificial imitations of it. The opponents in the case were the Municipality of Carlsbad—who own both the springs and the rock in question—and their lessees of the springs. They sought to show that the use of the picture by the applicant would be calculated to lead purchasers to believe that the goods upon which it appeared were their goods; but the judge held that it would only suggest that the goods were Carlsbad Salts. And this would be true if, as he was bound to anticipate, the applicant used his mark honestly. The opponents had no monopoly in Carlsbad Salts.

Where a trade mark has been long used by a person who is applying to register it, it will not be refused on the ground of recent user of a similar mark by another trader. The mark does not by such recent user become calculated to deceive.⁵

"Silverpan" in a mark registered for jam was descriptive and not calculated to deceive. On appeal, however, it was held that the word was distinctive and ought to have been disclaimed under sec. 74 of the Act of 1889, [1902] 1 Ch. 125; 18 R. P. C. 535. The registered proprietors stated that they did not claim any exclusive use by reason of their registration.

¹ [1891] A. C. 218; 8 R. P. C. 361.

² Chap. II., at pp. 36 *et seq.* See also sec. 44.

³ See above, pp. 279, 280.

⁴ 10 R. P. C. 401 (1893), North, J. Cf. also *Hubbuck v. Brown*, 17 R. P. C. 148 and 638.

⁵ *Kenrick & Jefferson, Ltd.'s Application*, 26 R. P. C. 641 (1909); and *Southall Bros. and Barclay, Ltd.'s*

And where it was proved that for some years before the date of registration, the applicants for rectification had used the mark for similar goods and there had only been slight and recent user by the registered owners, the mark was expunged from the Register.¹

In *The Apollinaris* case, Fry, L.J., in delivering the judgment of the Court of Appeal, expressed an opinion that a label which bears the word "trade mark" so printed upon it as apparently to refer only to a device which forms part of the label, the whole label being, in fact, the trade mark, is calculated to deceive,² notwithstanding that the objection might have been, but was not, taken in the earlier case of *Hudson's Trade Marks*, where³ the Court of Appeal decided in favour of the mark propounded; and in *Re Wills' Trade Marks*, Wright, J., subsequently ordered a mark to be removed from the Register on this ground.⁴ This objection caused considerable uneasiness to proprietors of trade marks, and led to several applications to the Court, under sec. 92, for leave to amend registered marks, for the word *Trade Mark* is often printed upon labels and other trade marks; but it is to be observed that it is only objectionable where its presence apparently implies that part of the actual mark is the whole trade mark. In the mark to which Fry, L.J., was directly referring, the word was placed immediately under a red disc, which was the most prominent feature in the label. In *Hammond & Co. v. Malcolm, Brunner & Co.*,⁵ Chitty, J., said: "It is a question of fact in every case where a man puts the term 'trade mark' on his device, or some part of it, whether he does or does not so place the words as to indicate to the public that he is claiming a particular part of the trade mark only." The question came again before the Court of Appeal in *Bass's Tms.*,⁶ where the devices on which the words occurred were also separately registered, and the Court held the question to be

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

Application, 28 R. P. C. 481 (1911), both Neville, J.

¹ *Hoemouller's Tm.*, 28 R. P. C. 249 (1912), Joyce, J. (*Alpha*).

² [1891] 2 Ch. at p. 233; 8 R. P. C. 137.

³ 92 C. D. 811 (1886).

⁴ [1893] 2 Ch. 262; 10 R. P. C. 269. The order was made subject to an application to amend being made within

a reasonable time, but no such application was made.

⁵ 9 R. P. C. p. 307; and the observation of the same judge in *Gordon & Dilworth's Tm.*, 13 R. P. C. p. 634.

⁶ [1902] 2 Ch. 579; 19 R. P. C. 529. Romer, L.J., intimated that he would probably not have come to the same conclusion of fact in the *Apollinaris* case as the Court of Appeal did.

Alterations
of marks to
remove trade
mark.

one of fact, and decided that there was no deception. In *Colman's Trade Marks*,¹ Kekewich, J., allowed "trade mark" to be struck out of a number of labels, on condition that the proprietors should state what were and what were not the essential particulars of the marks.² But in a later case, *Chitty, J.*, refused to allow a similar alteration to be made in an old mark on the ground that, in accordance with the decisions of the Court, an old mark ought to be registered and kept registered, in all essential particulars, as it was used before August 13th, 1875.³ In the earlier case, two of the marks allowed to be altered had, in fact, been old marks, but in that case the Comptroller had raised no objection on this ground, as he did in the later case. In *Re Wills' Trade Marks*,⁴ the mark was ordered to be expunged unless an application to amend was made within a reasonable time, but in *Day v. Riley and Whittaker*,⁵ Buckley, J., refused to give such an opportunity. Section 25 of the Act of 1905 expressly permits separate registration of part of a registered trade mark, but the part so registered must itself possess all the qualifications of a good trade mark, and it must be registered as associated with the trade mark of which it forms part.⁶

Threats of
prosecution
in the mark
may be decep-
tive.

Fry, L.J., also suggested, in *The Apollinaris* case,⁷ that the indorsement, "imitations of this water will be prosecuted," upon a label registered for use in connection with a natural mineral water, *Hunyadi Janos*, caused the mark to be calculated to deceive, because it probably meant all imitations of the water, whether fraudulent or not, and was therefore addressed to artificial *Hunyadi Janos* waters which might have been legitimately made and legitimately sold under the name, provided that it was made clear that they were artificial waters.⁷

The Registrar
refuses patent,
registered,
copyright, &c.

It may be noted that the Registrar may refuse to register the words "patent," "patented," "by Royal Letters Patent,"

¹ [1891] 2 Ch. 402; 8 R. P. C. 209.

² Cf. sec. 64 (2) of the Act of 1883, as amended. The condition would probably not now be required, as an applicant is not required to specify in his application what the essential particulars of the mark are; and see Chap. IX. at pp. 236 and 237.

³ *Phillips' Tm.*, [1891] 3 Ch. 139; 8 R. P. C. 469; and see *Henry Clay & Co.'s Tm.*, [1892] 3 Ch. 549; 9 R. P. C.

449, Kekewich, J. Cf. sec 84 of the Act of 1905.

⁴ *Supra*, p. 303, note (4). The mark was a new one registered under the Act of 1883, as also was the mark referred to in the case next cited.

⁵ 17 R. P. C. 520 (1900).

⁶ See above, p. 117, and Appendix, p. 675.

⁷ Above, p. 303; [1891] 2 Ch. p. 226

“registered,” “registered design,” “copyright,” “entered at Stationers’ Hall,” or “to counterfeit this is a forgery.”¹ The word “Royal” may be deceptive as suggesting Royal patronage.²

The Geneva Convention Act, 1911,³ prohibits the use by any person for the purposes of his trade or business, or any other purpose whatsoever without the authority of the Army Council, of the emblem of a Red Cross on a white ground, or the words “Red Cross,” or “Geneva Cross,” under the penalty of a fine and forfeiture of the goods upon or in connection with which the emblem or words shall have been used, but the section contains a provision saving the right of the proprietor of a trade mark registered before the passing of the Act,⁴ and containing any such emblem or words, to continue to use the same for a period of four years from the passing of the Act, and to renew any such registration for that period without payment of any fee. Proceedings under the Act are not to be instituted in England or Ireland without the consent of the Attorney-General. The Act extends to His Majesty’s possessions outside the United Kingdom, subject to such necessary adaptations as may be made by order in Council.

Use of emblem of, or words “Red Cross” prohibited.

When there appears on a trade mark the name or a description of any goods the Registrar may refuse to register the mark in respect of any goods other than the goods so named or described.⁴

Mark referring to particular goods.

In an application to remove a trade mark, “Orlwoola,” it was held that the word, when applied to goods not wholly made of wool, was calculated to deceive, and the mark was removed from the Register on this and other grounds.⁵ And in *The Perfection Soap* case, Cozens-Hardy, M.R., and Farwell, L.J.,

¹ Rule 11, below, p. 657. See also *Meikle’s Tms.*, 46 L. J. Ch. 17 (1876), Hall, V.-C. In *Wright, Crossley & Co. v. Dobbin*, 15 R. P. C. 21 (1898), and *MacSymons’ Stores, Ltd. v. Shuttleworth*, 15 R. P. C. 748 (1898), it has been held both in Ireland and England that “registered” in a mark means registered in the United Kingdom.

² *Royal Worcester Corset Co.’s Application*, cited above, p. 301, and *Carron Co.’s Tm.*, 27 R. P. C. 412 (1910). But see *Royal Baking Powder’s Application*, 19 R. P. C. 261 (1902). As to Rule 12, which expressly prohibits registration of the Royal Arms and

other National emblems and devices, and the word “Royal,” see p. 721, where the Rule is set out in full, and above, p. 77. As regards the word “Royal,” it is not only the deceptive use of it which is aimed at by Rule 12, *Carron Co.’s Tm.*, 27 R. P. C. 412 (1910).

³ 1 & 2 Geo. 5, Chap. 20. The Act was passed on August 18th, 1911. It is set out in full in the Appendix, p. 898.

⁴ Rule 16. By the same rule registration with a variation of a name or description may be permitted.

⁵ *Orlwoola Tm.*, [1910] 1 Ch. 180; 26 R. P. C. 683, 850, C. A.

thought that the mark might become calculated to deceive by a change in the character of the goods, or that registration of it under an order of the Board of Trade might suggest that the merits of the soap had been inquired into by a Government department. Fletcher Moulton, L.J., however, said that he was not impressed by this suggestion.¹

Deceptive
representa-
tion as to
origin of
goods.

The questions Who can register a trade mark?² and What is the implication of a trade mark with regard to the origin of the goods?³ are dealt with elsewhere. It has been held that a mark comprising the consignees' names, and a representation of their house, which is used by the consignor, is calculated to deceive.⁴

And where a trade mark registered by retailers by arrangement with the manufacturers of the goods had become by reason of the severance of the relations calculated to deceive, it was removed from the register at the instance of the manufacturers.⁵

In a recent case a company had sold its business in the brakes of pedal cycles to another company, and had granted to the same company a licence under certain patents relating to Bowden wire for brakes and a licence to use a certain trade mark, registered after the sale, upon goods made under the patent licence, and the vendor company used the trade mark for brakes for motor cycles, and the purchaser company used it for pedal cycles. After the licences had expired, the vendor company brought an action to restrain the purchaser company from using the trade mark, which the purchaser company claimed the right to use on motor cycle goods as well as on pedal cycle brakes, and it alleged that the registration was bad on the ground, first, that the vendor company had registered the trade mark as trustees for the purchasing company, and on the ground that the use of it by the vendor company would lead to confusion, and the mark was therefore deceptive. It was held by Swinfen Eady, J., that the use by the purchaser company did not entitle it to prevent the vendor company from using the trade mark in the same manner as before, and that brakes for pedal cycles were not the same description of goods as the motor cycle brakes and accessories for which the vendor company used the trade mark, and that the mark was not deceptive and that

¹ *Crosfield & Sons' Application*, [1910] 1 Ch. 118; 26 R. P. C. 561, 897. The word "Perfection" was held not to be distinctive; see above, p. 185.

² Chap. IV., at p. 72.

³ Chap. II., at pp. 58 *et seq.*; see also Chap. XV., p. 425, "Joint trade marks."

⁴ *Jones' Tm.*, 53 L. T. 1 (1885), C. A.

⁵ *Thorne & Sons, Ltd. v. Pimms, Ltd.*, 26 R. P. C. 221 (1909), Neville, J.

subject to a variation made in the registration, in effect excluding the brakes of pedal cycles, the registration was valid.¹ On appeal, however, it was held that the trades were not distinct trades, and the mark was expunged on the ground that it had ceased to be distinctive and was liable to mislead.

The case of *Hill's Trade Mark*² furnishes a good illustration of a deceptive mark. The mark consisted of a fir tree, with the words *Forrest* above and *London* below it in large letters, and it was registered and used by a Coventry watch-maker, who had no connection with the business formerly carried on by Forrest in London. He alleged, in answer to an application to remove the mark, that the words in question were commonly used by the trade in Coventry, although, in a correspondence with the applicant, he had previously claimed an exclusive right to them. The judge held that the mark was calculated and intended to deceive.³

On the other hand, a suggestion that "Mazawattee" was deceptive, as leading people to suppose from the character of the name that the tea came from a particular estate, did not prevail.⁴ And a mark containing the Spanish words, "Los Alumbradores" meaning "The Lighters" and intended to be used for cigars made in Holland was held not to be deceptive and registration was allowed on the applicant's undertaking to put "made in Holland" on the boxes sold in this country.⁵

But a device intended to be used for goods not of Irish origin and consisting of a representation of a shamrock with the stalk twisted to represent "& Co.," Shamrock & Co. being the applicant's trading name, has been held to be calculated to deceive.⁶

A mark which has been used fraudulently, or for the purposes of a fraudulent trade, if offered for registration, is open to the objection that its further use will tend to continue the old deceptions, and it is therefore a deceptive mark, and registration of it should be refused.⁷ Thus the use of the words "Registered

¹ *Bowden Wire, Ltd. v. Bowden Brake Co., Ltd.*, 30 R. P. C. 45 (1913). The appeal is not yet reported, July 10th, 1913.

² 10 R. P. C. 113 (1893), Chitty, J.

³ Its use was unquestionably an offence under the M. M. A. 1887; see Appendix, p. 886. It appears from the report of *Thorneloe v. Hill*, 11 R. P. C. 61 (1894), that the Comptroller afterwards refused to register the tree alone on account of its having been part of a

fraudulent mark.

⁴ *Densham's Tm.*, [1895] 2 Ch. 176; 12 R. P. C. 75 and 271; and above, p. 178.

⁵ *Van de Leeuw's Application*, [1912] 1 Ch. 40; 28 R. P. C. 708, Parker, J.

⁶ *McGlennon's Application*, 25 R. P. C. 797 (1908), Warrington, J.

⁷ *Fuente's Tm.*, [1891] 2 Ch. 166; 8 R. P. C. 214, Romer, J.; see further, as to trade marks vitiated by misrepresentation, Chap. XV., at pp. 472 *et seq.*

Trade Mark" before registration would be a ground for refusal to register, except where, as in the cases cited below,¹ a *bond fide* mistake was proved to have been made or an adequate explanation was given.

"Or otherwise."

The words "or otherwise" in the section, having regard to the last part of it, seem to be merely redundant.² They were, however, under the Act of 1875, held to be sufficient to exclude the registration, as part of a trade mark, of words which are merely descriptive of the article upon which the mark is to be used, whether they are merely descriptive from their nature, or whether they have become descriptive by the course of the trade and in the market.³ But the decision in the case referred to rested upon the opinion of the learned judge that, if he allowed the words in question to be registered as part of the applicant's mark, he would be giving him a monopoly in the words to which he was not entitled. In the Act of 1883 the word "disentitled" was substituted for the expression "not entitled," and in a later case⁴ the decision just referred to was distinguished on the ground of the different wording of sec. 73 of the Act of 1883, and it was held that, although the word "Silverpan" was descriptive when used for jam, it was not thereby "disentitled" to protection within the meaning of this section.

"Dis-entitled."

¹ *Altman's Application*, 21 R. P. C. 763 (1904), Kekewich, J.; *Lyle and Kinahan's Application*, 24 R. P. C. 87 and 249 (1907), Kekewich, J., and C. A.; in this case the representation as to registration had appeared for a short time only in a price list.

² Sec. 11 includes provisions formerly contained in a separate section, namely, sec. 86 of the Act of 1883.

³ *Anderson's Tm.*, 26 C. D. at p. 415 (1884), Chitty, J. (*Brand Baron Liebig*).

⁴ *Faulder's Tm.*, 18 R. P. C. 37 (1901), Kekewich, J. On appeal the Court did not decide this point, the word in question being held to be *prima facie* distinctive, [1902] 1 Ch. 125; 18 R. P. C. 535. See also *Smokeless Powder Co.'s Tm.*, [1892] 1 Ch. 590; 9 R. P. C. 109.

CHAPTER XI.

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PROVISION is made for the rectification of the Register by four sections of the Act. Sec. 35 provides for cases where any person is aggrieved by the omission from, or by the entry upon, the Register of any particulars without sufficient cause, and enables the Court to direct the necessary rectification to be made; sec.

32 authorises the Registrar at the request of the proprietor to correct clerical errors in the registration, to enter any change in the name or address of the proprietor, to cancel the entry of a trade mark on the Register, to strike out goods from those for which a mark is registered, and to enter on the Register certain disclaimers or memorandums; sec. 33 provides for the registration of the name and address of the new proprietor on assignment, transmission, or other operation of law;¹ and sec. 34 enables the Registrar to permit an addition to, or alteration of, a registered mark to be made in any manner not substantially affecting its identity. The Act also directs that after fourteen years from its registration a mark shall be removed from the Register unless the prescribed fee be paid. This provision is considered in another chapter.²

1. Rectification under Sec. 35.

Sec. 35³ is in the following terms:—

Subject to the provisions of this Act—

“(1) The Court may on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the Register of any entry, or by any entry made in the Register without sufficient cause, or by any entry wrongly remaining on the Register, or by any error or defect in any entry in the Register, make such order for making, expunging, or varying such entry, as it may think fit:

(2) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of the Register:

(3) In case of fraud in the registration or transmission of a registered trade mark, the Registrar may himself apply to the Court under the provisions of this section:

(4) Any order of the Court rectifying the Register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner, who shall upon receipt of such notice rectify the Register accordingly.”

This section corresponds to sec. 90 of the Act of 1883, which

¹ See Chap. XIII., at p. 398.

² Sec. 30; see Chap. XIV., p. 404.

³ Cf. Companies (Consolidation) Act,

1908, s. 32, and the Copyright Act, 1842 (5 & 6 Vict. c. 45), s. 14 (now repealed by the Copyright Act, 1911).

Section 25.

Rectification
of register.

underwent a slight amendment by the Act of 1888.¹ The terms of the new section are wider and more general than those of the repealed one; in particular its provisions are expressly applicable to an entry wrongly remaining on the Register, as in the case of a trade mark removable for non-user under sec. 37. It was, however, held, under sec. 90 of the Act of 1883, that a trade mark wrongly on the Register could be removed.² The general power of rectifying errors and defects is new. Sub-sec.(3), giving the Registrar power in certain cases to apply for an order for rectification, is also new.

The Court had under sec. 90 of the Act of 1883 power to award damages to the party aggrieved, but it was never exercised.³ In addition to this, other provisions contained in that section have been dropped, namely, those as to directing issues and as to costs; these are covered by the general powers of the Court.⁴

Certain new provisions introduced by the Act of 1905 materially affect the practical working of sec. 35. First, by sec. 36, no trade mark which was upon the Register at the commencement of the Act, and which under this Act is a registrable trade mark, is to be removed from the Register on the ground that it was not registrable under the Acts in force at the date of its registration. This provision, and the decisions on it, have been considered in the chapter on what may be registered.⁵

Secondly, the power of the Court to require a disclaimer is now expressly extended to a case in which the Court is deciding whether a trade mark shall remain on the Register;⁶ that is to say, on an application under sec. 35 to remove the trade mark.

Thirdly, by sec. 41, in applications under sec. 35, the original registration of a registered trade mark is, subject to certain exceptions mentioned in sec. 41, after the expiration of seven years from the date of such original registration (or seven years from the passing of the Act,⁷ whichever shall last happen), to be taken to be valid in all respects.⁸

¹ Sec. 23. For this section as amended, see Appendix, below, p. 703. The corresponding section of the Act of 1875 was sec. 5, Appendix, below, p. 712.

² *Batt's Tms.*, [1898] 2 Ch. 432; [1899] A. C. 428 (*sub nom. Batt v. Dunnett*, 15 R. P. C. 262, 534; 16 R. P. C. 411).

³ See, for instance, *Reid v. Thomson & Co.*, 22 R. P. C. 376 (1905), Scotland.

⁴ As to issues, see Orders XXXIII.

and XXXVI.; and as to costs, see Judicature Act, 1890, s. 5, and Order LXV., r. 1.

⁵ Chap. VIII., above, p. 135.

⁶ Sec. 15. See Chap. IX., Disclaimers, above, p. 236.

⁷ August 11th, 1905. The commencement of the Act was April 1st, 1906.

⁸ See Chap. XII., Effect of Registration, below, p. 359.

Who are persons aggrieved.

The application to rectify the Register must be made by a person who is aggrieved by the entry, if it is made without sufficient cause, or by the omission, error or defect complained of. The phrase in the section has been very liberally construed, and except, perhaps, in the case of a mark consisting of a name,¹ it would be difficult to find any person engaged in the trade concerned, or any allied or connected trade, who is prevented by the qualification which it requires from moving to rectify the Register. The persons who are aggrieved are, it is held, all persons who are in some way or other substantially interested in having the mark removed—where it is a question of removal—from the Register, or persons who would be substantially damaged if the mark remained. It is very difficult to frame a nearer definition than that.²

One of the leading cases on the subject is that of *The Apollinaris Co.'s Trade Marks*. In that case, Fry, L.J., in delivering the judgment of the Court of Appeal, said: "We approach this question (Are the applicants persons aggrieved?) on the assumption, which is necessary, of course, to answer this question, that the trade mark was wrongly on the Register; and, further, with these two observations: in the first place, that the question is merely one of *locus standi*;³ and in the second, that the words 'person aggrieved' appear to us to have been introduced into the statute to prevent the action of common informers, or of persons interfering from merely sentimental motives;⁴ but that they must not be so read as to make evidence of great and serious damage a condition precedent to a right to apply. Further, we are of opinion that, wherever one trader, by means of his wrongly registered trade mark, narrows the area of business open to his rivals, and thereby either immediately excludes,

All persons substantially inconvenienced if the registration is wrong.

The Apollinaris case.

The question is one of *locus standi* only.

¹ See *Wright, Crossley & Co.'s Tm.*, 15 R. P. C. 131 and 377 (1898), cited below, p. 315.

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

³ In *Crompton's Tm.*, [1902] 1 Ch. 758; 19 R. P. C. 265, Swinfen Eady, J., held that a person who sought to remove a trade mark on the ground (*inter alia*) that the registration added nothing to a prior registration by the

same proprietor was, if this were so, not a person aggrieved; but possibly he only intended to decide that such an objection was purely one for the Comptroller, and could not be taken after registration.

⁴ See Ld. Selborne's judgment, in *Rivière's Tm.*, 26 C. D. at p. 54 (1884), and the judgments of Lindley and Fry, L.JJ., on the subsequent hearing of the same case, 55 L. J. Ch. 545.

or with reasonable probability will in the future exclude, a rival from a portion of that trade into which he desires to enter, that rival is an 'aggrieved person.'"¹ And in the same case the Court of Appeal held, that the fact that the applicants for registration of certain new marks had attempted to support their application by reference to other marks already registered by them, notwithstanding that they subsequently abandoned the attempt, made the opponents to the registration of the former marks persons aggrieved by the registration of the marks already registered, and therefore persons entitled to apply for the removal of them from the Register.² They further held that an alleged infringer of a mark is always a person aggrieved by its registration.³ "The practical conclusion of this view," said Fry, L.J., "is, we think, a sound one. It will stop the practice, of which we have seen instances in this case, of a trader registering his mark without justification, using it as a means to intimidate or coerce other traders, and then, at the bar, alleging that the threat was idle, and the persons against whom it was used are not aggrieved thereby."⁴

Any person
intimidated
or harassed
by the regis-
tration.

Powell's case. The words in question have received their most liberal interpretation in the subsequent case of *Powell's Trade Mark*.⁵ In that case the applicants were being sued to restrain them from passing off a sauce called *London Relish* as the goods of the registered proprietor of a mark consisting of the words *Yorkshire Relish* by means of a label said to resemble one of his trade labels. They moved to expunge the mark *Yorkshire Relish*, and they were held to be "persons aggrieved" notwithstanding that they did not trade in Yorkshire Relish Sauce, and had not even considered the question of trading in it, and that the Court thought it probable that they could not trade in it under the same name without wrongfully causing their goods to be taken for those of the respondent, the registered proprietor of the mark. Lord Herschell, in giving judgment, said that, although the words were no doubt inserted to prevent officious interference by those who had no interest at all in the Register being correct, and to exclude a mere common informer, it was undoubtedly of public interest that they should not be unduly limited; and he

¹ [1891] 2 Ch. p. 224; 8 R. P. C. 137.

² [1891] 2 Ch. p. 228; 8 R. P. C. 137.

³ See also *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1891), North, J.

⁴ [1891] 2 Ch. p. 229.

⁵ [1893] 2 Ch. 388; [1894] A. C. 8; 10 R. P. C. 195; 11 R. P. C. 4, Chitty, J., C. A., and H. L.; followed in *Talbot's Tm.*, 11 R. P. C. 77 (1894), Stirling, J.

also said: "Wherever it can be shown, as here, that the applicant is in the same trade as the person who has registered the trade mark, and wherever the trade mark, if remaining on the Register, would or might limit the legal rights of the applicant, so that by reason of the existence of the entry on the Register he could not lawfully do that which but for the existence of the mark upon the Register he could lawfully do, it appears to me he has a *locus standi* to be heard as a person aggrieved." Lord Watson, in his judgment, said that the fact that a trader deals in the same class of goods, and could use the mark, was, *primâ facie*, sufficient evidence of his being aggrieved, which could only be displaced by the person who registered the mark, upon whom the onus lay, showing that there was no reasonable probability that the objector would have used it, although he were free to do so.

But the grievance of the applicant must be substantial, and a fanciful suggestion of grievance is insufficient. Thus, in *Wright, Crossley & Co.'s Trade Mark*,¹ a firm had registered their firm-name of "Wright, Crossley & Co." as an old trade mark, and a company, called the Royal Baking Powder Company, trading in the same trade, applied to remove it. There had been considerable litigation between the applicants and the registered owners as to the words "Royal Baking Powder," and it was suggested that the applicants had an interest as the mark was being used by the owners in connection with those words, and that there was a possibility of a wrongful user of the words "Trade Mark." It was also suggested that the applicants might at some time acquire the right to trade under the name Wright, Crossley & Co., or part of it. But Romer, J., and the Court of Appeal came to the conclusion that the suggestions of possible injuries to the applicants were fanciful, and that the applicants were not persons aggrieved. Rigby, L.J., pointed out that the judgments in the House of Lords in the *Yorkshire Relish* case did not support the contention that the mere fact that a man was in the same trade was sufficient to make him a person aggrieved. It is not necessary, however, for an applicant to show that he is interested in the sense of deriving any profit from his trade;² and it is sufficient to constitute trading if he is trading by his agents.² A merely sentimental grievance does

¹ 15 R. P. C. 131, 377 (1898), Romer, J., and O. A.

² *Harness' Tm.*, 17 R. P. C. 40 (1900), Farwell, J.

not make a person "aggrieved" within the meaning of the section.¹

Defendant in a passing-off action.

A defendant charged in an action with passing off his goods as those of the plaintiff² is aggrieved by the registration of a trade mark referred to in the plaintiff's pleadings, although no case of infringement is set up;³ and so also is a trader who wishes or may wish to use the registered mark, not as a trade mark, but as a description of his goods.⁴ And it is not necessary that the applicant should actually trade in the goods for which the mark is registered: it is sufficient if there is such a close connection between the business in those goods and the applicant's business that there is a probability that he may wish to extend his business to the other goods.⁵ And the applicant does not cease to be a person aggrieved because the registered proprietor offers to register a disclaimer, or to confine the use of the mark to particular goods in such manner that if the disclaimer or limitation were actually registered the applicant's grievance would be removed;⁶ for, as was pointed out by Fry, L.J., in the passage quoted above, the grievance is only necessary to give a *locus standi*, and it exists if, at the time when the application is launched, the registration is such as to occasion it.

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

Person who has actually used the trade mark. Exporter aggrieved by mark for home trade.

A person who has before registration used the registered trade mark is a person aggrieved.⁷

The exporter of goods made abroad, which are brought to England and then shipped to the Colonies, is a person aggrieved by the registration of a mark having such a resemblance to the mark which he has registered, and which he uses in his trade, as is calculated to deceive, although the mark objected to is employed in a trade confined wholly or almost wholly to England,

¹ *Ellis & Co.'s Tm.*, 21 R. P. C. 617 (1904), Farwell, J. (*Quaker, for spirits*). In this case it was held that the Society of Friends were not persons aggrieved by the registration.

² See Chap. XVI., p. 527.

³ *Gianacis' Tm.*, 6 R. P. C. 467; 58 L. J. Ch. 782 (1889), North, J.

⁴ *Ralph's Tm.*, 25 C. D. 194 (1883), Pearson, J. (*Homewasher*); *Rose v. Evans*, 48 L. J. Ch. 618 (1879), Hall, V.-C. (*Limetta*); *Powell's Tm.*, supra, p. 814; *Talbot's Tm.*, 11 R. P. C. 77; 63 L. J. Ch. 264 (1894), Stirling, J.

(*Emolliolorum*).

⁵ *Eastman, &c. Co., Ltd. v. John Griffith's Cycle Corporation, Ltd.*, 15 R. P. C. 105 (1898), Romer, J. There was no express finding, however, as to the applicants being persons aggrieved; but it was held that they could have successfully opposed the registration.

⁶ *Batt's Tm.*, 6 R. P. C. 493 (1889), Chitty, J.; *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1891), North, J.

⁷ *Zonophone Tm.*, 20 R. P. C. 450 (1903), Byrne, J.

and not extending to the Colonies.¹ So also a person who had made the goods in this country and exported them marked with the registered word from a date prior to its registration was held to be clearly a person aggrieved.²

And a foreigner may be a "person aggrieved" by the registration of a mark. This was decided by the Court of Appeal, overruling the judgment of Pearson, J., in *Rivière's* case,³ where the applicants, who carried on business in India, but did not trade or intend to trade in England, alleged that, on their request to register the mark in question for them, the registered proprietors had wrongfully registered it in their own names; and the Court, in holding that the applicants might be aggrieved, assumed, but did not decide,⁴ that, as foreign traders, the applicants could not themselves have registered the mark. Foreigner.

On the further hearing of the case just cited,⁵ it was shown that the registered mark was an old mark belonging to the respondents, *Rivière & Co.*, but that they had for many years allowed it to be used upon labels bearing the name of the applicants, *McDowell & Co.*, for brandy manufactured by *Rivière & Co.*, and shipped by them to *McDowell & Co.* for sale in India. The labels were used by *McDowell & Co.* upon brandy not made by or purchased from *Rivière & Co.*, after the rupture of business relations between the parties, and *Rivière & Co.* had commenced proceedings in India for infringement in respect of this user. Under these circumstances, Pearson, J., and the Court of Appeal held that the applicants were not in fact aggrieved by the registration, but that it was rightly made, and they refused to annul it. Lindley, L.J., said: "Aggrieved in the sense of being annoyed (*McDowell & Co.*) certainly were, and, I think, not without cause; but aggrieved in the sense in which it is necessary they should be aggrieved—in the sense of sustaining legal damage either immediate or prospective—they Wider view now taken than in the earlier cases.

¹ *Société Anonyme des Verreries de l'Étoile*, [1894] 1 Ch. 61; [1894] 2 Ch. 26; 10 R. P. C. 436; 11 R. P. C. 142, Stirling, J., and C. A.

² *Neostyle Manufacturing Co.'s Tm.*, 20 R. P. C. 803 (1903), C. A.

³ 26 O. D. 48 (1884), decided on the Act of 1875. Also *European Blair Camera Co.'s Tm.*, 13 R. P. C. 600; 75 L. T. 63 (1896), Stirling, J., where the applicants' predecessor had used the

mark in England.

⁴ It is clear that the later Acts contemplate registrations by foreign traders; see secs. 103 and 104 of the Act of 1883, and sec. 8 of the Act of 1888. These sections were not repealed by the Act of 1905, but are now replaced by sec. 91 of the Patents and Designs Act, 1907. See also sec. 14 (11) and rule 9.

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

have not shown that they were"; and Fry, L.J., said it was possible that they might be injured, but there was no reason to suppose that they would be, and therefore they were not within the section.¹ In subsequent cases the section, and the phrase "person aggrieved," has been more stringently construed against the registered proprietor; and although there is no conflict between this decision² and the decisions cited above, it is plain that in them a view was taken of the section different from that acted upon in it.

Purity of
the register,

In one case it was suggested that, although the applicant was not a person aggrieved, the Court would, in the interests of the public, rectify the Register if the mark was bad;³ but, even if the Court would, under any circumstances, take such a course in the absence of a person aggrieved,⁴ it would only do so in the case of a registration which was on the face of it illegal or improper.⁵

Applications
as to matters
otherwise
dealt with in
the Act.

Under the Act of 1883 a refusal by the Comptroller to cause the name of a person who had become entitled by assignment, transmission, or other operation of law to a registered trade mark to be entered as proprietor of the trade mark in the Register under sec. 87 would have constituted such person a "person aggrieved" and given the Court jurisdiction under sec. 90 to order the entry to be made,⁶ but if a person applied to the Comptroller for an alteration in a case for which the Acts did not provide, and it was refused, he was not a "person aggrieved."⁶ Under the Act of 1905 both these matters are provided for by special sections with special rights of appeal,⁷ and recourse should not be had to sec. 35.

In an application by the Registrar under sub-sec. (3) he would, of course, be in the position of a person aggrieved.

¹ I.e., sec. 5 of the Act of 1875.

² Because the Court held that the mark was properly registered.

³ *Wright, Crossley & Co.'s Tm.*, infra, note (5).

⁴ See the judgment of Bowen, L.J., in *Paine & Co. v. Daniells & Sons' Breweries*, quoted infra, p. 320. In that case, however, the defendants, being sued, were clearly persons

aggrieved.

⁵ *Wright, Crossley & Co.'s Tm.*, 15 R. P. C. 131, 377 (1898), especially the judgment of Romer, J.

⁶ *New Ormonde Cycle Co.'s Tm.*, [1896] 2 Ch. 520; 13 R. P. C. 475, North, J. See also *Patent Plumbago Crucible Co.'s Tms.*, 7 R. P. C. 282 (1890), Stirling, J.

⁷ Secs. 33 and 34.

The Exercise of the Jurisdiction under the Section.

The question of the grievance of the applicant being merely one of *locus standi*, if on the face of the proceedings the applicant is enabled, as a person aggrieved, to bring his application before the Court, the Court has jurisdiction to rectify the Register, which, in the case of a mark not belonging to the class of marks admitted to registration under the Acts,¹ it ought to exercise, even under circumstances in which the applicant is precluded from exercising the right with which the registration interferes. Thus, in *The Stone Ales* case,² the Court of Appeal removed the plaintiffs' mark, *Stone Ale*, from the Register on the application of the defendant, although they maintained the injunction granted by Chitty, J., restraining the defendant from selling goods not of the plaintiffs' manufacture under the name in question.

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

And the demerits of the applicant in any such case are irrelevant to the question whether rectification should be ordered or not, for the question is not between the applicant on the one hand and the respondent on the other, but between the public and the respondent. Where, therefore, a mark on the Register bearing the words *Forrest London* was shown to be deceptive, because it was used by a Coventry watch-maker who had no connection with the business of Forrest once carried on in London, Mr. Justice Chitty refused to enter upon an inquiry whether the conduct and the trade of the applicant were tainted with fraud, as the respondent alleged. "I state my opinion," he said, "that directly it is apparent that any part of the trade mark is calculated to deceive, it is the duty of the Court to order it to be removed."³

The conduct of the applicant is irrelevant.

So an agreement by which the respondents, the registered proprietors of a mark, appointed the applicants sole agents for the goods which they sold under the mark, and the applicants agreed to sell no goods but those of the respondents under the

¹ See Chap. VIII., p. 135. See also sec. 36, below, p. 325.

² *Thompson v. Montgomery*, 41 C. D. 85; 6 R. P. C. 404 (1889). There was no appeal to the H. L. against this order. The words had not been used as a trade mark before August 13th, 1875, and were not fancy words. See

Powell's Tm., [1893] 2 Ch. 388; 10 R. P. C. 63, 195; [1894] A. C. 8; 11 R. P. C. 4; Chitty, J., C. A. and H. L. (*Yorkshire Relish*), above, p. 314.

³ *Hill's Tm.*, 10 R. P. C. 113 (1893); see also *Eno v. Dunn*, 15 App. Ca. 252; 7 R. P. C. 311 (1890).

mark, was held to furnish no answer to an application to remove the mark from the Register, and Chitty, J., said: "This is not a question of equity; this is a question of right under the statute; and the defence, which I find really a difficulty in appreciating, appears to me to fail altogether. I am at a loss to discover how any such agreement as this can displace the applicants' right to have the Register of trade marks disencumbered of that which is not a trade mark at all."¹

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

Paine v. Daniells.

But in cases where the mark attacked belongs to the class of symbols which are capable of registration, the Court has a discretion, under the Acts, either to expunge or vary the registration or to refuse the application. This was decided by the Court of Appeal in the case of *Paine & Co. v. Daniells & Sons' Breweries*,² where the matter was fully considered. In that case the defendants, in an action for infringement and passing off, applied to remove the words *John Bull* and *John Bull Brand* from the plaintiffs' registered labels. It appeared that at the time of the registration of the labels certain third persons, unknown to the plaintiffs, were using *John Bull* as a trade description of their goods in a district, in and around Sheffield, to which the plaintiffs' trade did not extend, but such user had wholly ceased before the date of the application to rectify. And it was assumed by the Court that these persons might have successfully opposed the registrations had they known of them and thought fit to do so. In the view which the Court of Appeal took, the defendants had been guilty for years of deliberate infringement of the plaintiffs' trade mark. The Court refused to direct the marks to be removed, and the following passage from the judgment of Bowen, L.J., fully explains the grounds of their decision:—

The Court has a discretion.

"The purity of the Register of trade marks—if one may use the expression—is of much importance to trade in general, quite apart from the merits or demerits of particular litigants. If on a motion like the present the attention of the Court is called to the entry on the Register of a trade mark which cannot in law be justified as a trade mark, it seems to me that the Court's duty may well be, whatever are the demerits of the applicant, to purify the Register and to expunge the illegal entry in the interests of

¹ *Ainslie & Co.'s Tm.*, 4 R. P. C. 212 (1887).

² [1893] 2 Ch. 567; 10 R. P. C. 71,

217. See also *Wright, Crossley & Co.'s Tm.*, 15 R. P. C. 131, 377 (1898), Romer, J., and C. A.

trade, as was done in *The Stone Ales* case.¹ As a rule, the Court, on being seised of the matter, would doubtless put an end to the existence of a trade mark which could not possibly be justified by law. But the matter is wholly different when the trade mark complained of is one which is not in itself illegal or improper, although at the date of registration its registration might have been, perhaps, successfully opposed by some third party who did not in fact oppose it. In such a case, the defect in the Register is not a defect of which the law is bound to take cognizance at the instance of every complainant. Consent by the *Sheffield* company would, in the present case, have removed all difficulty in the registration of the plaintiff's trade mark.² The defendants have no right, as it appears to me, to take the point that such consent was not in fact shown to have been given by the *Sheffield* firm, in order to displace a trade mark which they have been meanwhile dishonestly infringing. I am of opinion that the Court is not bound under sec. 90 of the Act of 1883, on the application of an unmeritorious applicant, to displace an entry on the Register, which, on the face of it, is not illegal, because the original registration might have been opposed on the ground of prior user by a third person who never opposed it on any such ground, and who, at the time of the motion to rectify, has discontinued his user."

The construction of sec. 90 of the Act of 1883, here adopted, was certainly in accordance with the apparent meaning of the section, for its terms empowered the Court to make "such order . . . as the Court thinks fit," or to refuse the application. Similar words occur in the present section.

So, in a case where the registered proprietor of a mark had adopted and registered it in ignorance of the rights of the applicant, who previously possessed, but had temporarily ceased to use, a similar mark, and the proprietor had largely used his mark for two years, an application to remove it from the Register was refused. The applicant, however, was allowed to register his mark also.³

Independent title acquired by registration and user.

¹ *Supra*, p. 319. Any interest which the public may have in the matter is to be considered: *Harness' Tm.*, 17 R. P. C. 40 (1900).

² The *Sheffield* company had not registered *John Bull* beer, and therefore the question of conflicting registered

marks would not have arisen.

³ *Mouson & Co. v. Boehm*, 26 C. D. 398; 53 L. J. Ch. 932 (1884), Chitty, J. In *Verity's Tm.*, 19 R. P. C. 58 (1902), Buckley, J., refused to apply this case to a new mark. See now sec. 21, above, p. 294.

There are, however, some reported cases which can hardly be reconciled with the view taken by the Court of Appeal in *The Stone Ales* case¹ by the distinction suggested in the judgments in *Paine v. Daniells*² between marks which are good marks under the Acts upon the face of them, although the registration of them might for some extrinsic reason have been opposed, and marks which are bad in themselves.

Mark allowed to remain in pursuance of a compromise.

Thus, in a case where Chitty, J., had ordered a mark to be removed from the Register, on the ground that it did not comply with sec. 64 of the Act of 1883, the Court of Appeal expressed a strong opinion that the applicant (the defendant) had made a binding agreement with the registered proprietor (the plaintiff) not to use the mark, and, the applicant consenting, they set aside the order for removal.³ And, in an earlier case,⁴ Kekewich, J., allowed an order expunging a mark from the Register to be varied (subject to any objection being made by the Comptroller) with the consent of the applicant, although he held that, having been used to indicate a design, and not as a trade mark, it ought not to have been registered.

Res judicata.

If the applicant for registration is a person who has opposed the registration of the trade mark, and the grounds on which he is claiming rectification are such as were taken in the opposition, and the opposition was disallowed by the Court, the matter might be held to be *res judicata* between the parties, and the application for rectification refused, for an applicant for rectification probably does not represent the public as the petitioner for revocation of a patent does.⁵ No direct decision has, however, been given on the point. In one case, in which an opponent was out of time in appealing to the Court of Appeal in an opposition, the Court in giving leave to appeal, required the opponent to give an undertaking not to apply to rectify the Register.⁶ In a recent case, the Court had in an appeal in an opposition on special grounds refused leave to the opponents to take certain objections to the registration not in the notice of opposition, but in rectification proceedings

¹ See note (2), ante, p. 319.

² See note (2), ante, p. 320.

³ *Hodgson v. Sinclair*, 9 R. P. C. 22 (1892).

⁴ *Harrison, McGregor & Co.'s Tm.*, 42 C. D. 691; 7 R. P. C. 25 (1889) (*Albion*). The variation is not stated

in the Law Reports.

⁵ *Deeley's Patent*, 12 R. P. C. 192 at p. 199 (1895) C. A. See, however, *Hill's Tm.*, 10 R. P. C. 113 at p. 116 (1893), Chitty, J.

⁶ *Re Arbenz's Application*, 35 C. D. 257; 4 R. P. C. 143 (1887).

by the opponents the Court held that it was not *res judicata* that the opponents could not raise these objections, and a motion to strike them out failed.¹

It was well established under the Act of 1883 that on an application to remove a trade mark from the Register the onus was on the applicant,² and by sec. 40 of the Act of 1905 registration is expressly made *prima facie* evidence in applications under sec. 35 of the validity of the original registration and of all subsequent assignments and transmissions.³ Where a trade mark has been long registered, and the validity of the registration depends on the facts which existed at or prior to the date of registration,⁴ the Court will give the registered owner the benefit of any doubt.⁵ The onus may be shifted, however, in the course of the hearing.⁶

Onus is on the applicant.

The fact that the Registrar has exercised his discretion in favour of the registration of a mark, and has allowed it to be registered, does not prevent the Court from ordering its removal if the registration was made without sufficient cause;⁷ but an applicant for rectification is in a somewhat less advantageous position than an opponent to registration.⁸

The Registrar's decision is no bar to rectification.

Section 90 of the Act of 1883 was held not to be limited by sec. 76 of that Act, so that a mark registered without sufficient cause could be removed notwithstanding the fact that it had been five years upon the Register.⁹ Section 41 of the Act of 1905, which makes registration valid after a period of seven years from original registration or the passing of the Act, whichever shall last happen, is expressly extended to applications under sec. 35.¹⁰

Effect of sec. 41.

¹ *Kenrick & Jefferson's Tms.*, 28 R. P. C. 45 (1911), Warrington, J.

² *Leonard and Ellis' Tm.*, 26 C. D. 288 (1884), C. A.; *Benjamin Edgington, Ltd. v. John Edgington & Co.*, 6 R. P. C. 513 (1889); *Chesebrough Manufacturing Co.'s Tm.*, [1902] 2 Ch. 1; 19 R. P. C. 342, C. A.; *Boord & Son v. Thom and Cameron, Ltd.*, 24 R. P. C. 697 (1907) (Scotland).

³ Below, p. 367.

⁴ The *Chesebrough* case, cited in note (2); also *Bass, Ratcliff and Gretton, Ltd.'s Tms.*, 19 R. P. C. 529, C. A. Romer, L.J., said that where there had been long uninterrupted user, and the mark had been long registered without attack, every reasonable intendment

ought to be made by the Court in favour of the registration.

⁵ *Burroughs, Wellcome & Co.'s Tms.*, [1904] 1 Ch. 736; 21 R. P. C. 217, C. A.

⁶ *Edgington v. Edgington*, note (2), and *Dewar & Sons, Ltd. v. Dewar*, 17 R. P. C. 341 (Scotland).

⁷ Sec. 54; and see *Arbens's Application*, 35 C. D. p. 260; 4 R. P. C. 143 (1887), C. A. (*Gen.*), and above, p. 107.

⁸ See *Société, &c. de l'Étoiles Tm.*, p. 324, note (1), and cases on delay.

⁹ *Lloyd & Sons' Tm.*, 27 C. D. 646 (1884), Chitty, J.; *Edwards v. Dennis*, 30 C. D. 454 (1885), C. A.; *Verity's Tm.*, 19 R. P. C. 58 (1902), Buckley, J.

¹⁰ The section is treated of in Chap. XII., p. 359.

Delay in making the application to rectify is generally no bar,

but delay may have a bearing on the evidence.

The delay of the applicant in coming to the Court to ask for rectification of the Register is not of itself any bar to his application,¹ and marks have been removed or varied after being registered for long periods to the knowledge of the applicant,² and this may still be so under the Act of 1905, in cases not covered by sec. 41, for instance, cases of obtaining registration by fraud. But where the objection alleged to a mark is that it is the same as that of the applicant, or that it has such resemblance to his as to be calculated to deceive, it will be some evidence against the applicant, on whom the burden lies of showing that the registration was made without sufficient cause, if he has stood by and allowed the registered proprietor to use the mark objected to for a length of time, especially if no case of actual deception is proved.³ Where an opposition to an application to register on such a ground would have been successful two things are to be considered: first, what was the reason of the delay in the application to expunge; and, secondly, whether any substantial injury has been caused by the delay to the person who has registered.⁴ Thus, if the objection depends upon proof of a state of facts at a given time—for instance, upon the question whether an old mark was used before August 13th, 1875, in the form registered—after a long lapse of time, and especially if important witnesses have died, the Court will receive the evidence of the applicant upon the point with hesitation.⁵

Prior to the Act of 1905, it was held that an entry made with-

Entry formerly, to be vacated or rectified if originally wrongly made.

¹ *Great Tower Street Tea Co. v. Smith*, 6 R. P. C. 165 (1889), North, J.; *Société, &c. de l'Étoile's Tm.*, [1894] 1 Ch. 61; 10 R. P. C. 436; [1894] 2 Ch. 26; 11 R. P. C. 142; *Talbot's Tm.* (1894), W. N. 12; 11 R. P. C. 77, Stirling, J.; *Bourne v. Swan & Edgar, Ltd.*, [1903] 1 Ch. 211; 20 R. P. C. 105, Farwell, J. But acquiescence may possibly be a bar in a case in which the ground of applying for rectification is that the applicant could have opposed the mark by reason of having rights in it. See *Neostyle Manufacturing Co.'s Tm.*, 20 R. P. C. 329, at p. 335 (1903), Kekewich, J. The case was reversed on appeal, 20 R. P. C. 803, being decided on other grounds.

² For instance in *The Apollinaris*

case, some of the marks removed had been registered for fourteen years; [1891] 2 Ch. 186; 8 R. P. C. 137, C. A. See also *Paine & Co. v. Daniells & Sons' Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 71, 217, C. A.

³ *Talbot's Tm.*, supra, note (1).

⁴ *Eastman Photographic Materials Co., Ltd. v. John Griffith's Cycle Corporation, Ltd.*, 15 R. P. C. 105, at p. 111 (1898), Romer, J. In *Société, &c. de l'Étoile's Tm.*, supra, three years' delay, which was explained by want of knowledge of the registration, was held by Stirling, J., and the Court of Appeal not to disentitle the applicant to relief.

⁵ *Benjamin Edgington, Ltd. v. John Edgington & Co.*, 6 R. P. C. 513; 61 L. T. 323 (1889), Kay, J.

out sufficient cause ought to be expunged, even though, so far as appeared at the hearing of the application to rectify, an application to re-register could be successfully made at once, for there ought to be fresh advertisements and a fresh opportunity for objectors to oppose the registration.¹ So, where a misstatement as to the length of time during which the mark had been used was made, not fraudulently but through carelessness in the application for registration, North, J., directed the registration to be vacated.² And in *The Apollinaris* case, in dealing with the objection that the company, when only importers, had registered marks belonging to the producers of the goods as their own, Fry, L.J., said³: "On behalf of the Apollinaris Co. an argument was addressed to us to this effect, that as they had, in the year 1881, become the sole owners of the produce of the spring, they could now get these marks on the Register, and that we ought not to remove marks which, as soon as we have taken them off, can be put on again. But even assuming that the respondents are *prima facie* entitled now to be placed on the Register, as to which we say nothing, we are of opinion that the course suggested is rendered impossible by the statutory provision for advertisements. To allow a mark which ought not to have been on the Register to remain on by reason of some intervening event would be to preclude the public from challenging the new title of the applicant for registration." But the rule laid down did not compel the Court to order the removal of a mark if the registration of a note, partial removal, or other variation met the justice of the case.⁴

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

The policy of the Act of 1905 is different, and sec. 36 provides that a trade mark shall not be removed from the Register if it is a registrable trade mark under the Act, although it was not registrable under the Acts in force at the date of its registration.⁵ Moreover, the Court has now power to order a disclaimer,⁶ and

Act of 1905.

¹ In *Hayward's Tm.*, however, where the objection was that the application on which the mark was registered ought to have been treated as abandoned, Kay, J., allowed the mark to stand, with a note limiting the date from which the five years should run before the registered proprietor acquired an absolute title to the date of actual registration; 54 L. J. Ch. 1003 (1885).

² *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1891).

³ [1891] 2 Ch. p. 230; 8 R. P. C. p. 163.

⁴ See note (1) and the instances cited below, pp. 331, *et seq.*

⁵ The section has been considered above, p. 140. All marks registered before the passing of the Act of 1905 now come under the operation of sec. 41, the period of seven years mentioned in that section having expired.

⁶ Sec. 15, above, p. 236.

may, under sec. 35, vary the entry. It may do this instead of expunging the entry, on the application of the respondent in a suitable case.¹

Entry, originally rightly made, may be expunged or varied.

Under the Act of 1883 the Court of Appeal took the view that an order could be made under the section to remove from the Register a mark the presence of which on the Register was not legitimate, even although the original registration was proper. In *Batt's Trade Marks*, Lindley, M.R., delivering the judgment of the Court, and referring to the words "entry made without sufficient cause in any such Register," said: "We are not disposed to put a narrow construction on this expression, nor to read it as if the word 'made' were the all-important word, and as if the words 'made without sufficient cause' must be read as if they were 'made without sufficient cause at the time of registration,' so as to be confined to that precise time. If any entry is at any time on the Register without sufficient cause, however it got there, it ought, in our opinion, to be treated as covered by the words of the section."² As pointed out in the judgment referred to, in the view taken by the Court of the facts the decision of the point was not necessary to the decision of the case, and no order was made, it is believed, under the earlier Acts for the removal of a mark originally rightly registered.³ The principle has, however, been recognised in sec. 35 of the Act of 1905, for a person aggrieved by any entry wrongly remaining on the Register may apply to expunge it. Thus, where a trade mark registered by retailers by arrangement with manufacturers and applied only to the goods of such manufacturers had by severance of the relations between the retailers and manufacturers become calculated to deceive, it was ordered to be removed from the Register.⁴

Removal for non-user, &c.

In *Batt's* case,⁵ already referred to, it was decided by the

¹ *Gestetner's Tm.*, [1907] 2 Ch. 478; 24 R. P. C. 545; [1908] 1 Ch. 513; 25 R. P. C. 156.

² [1898] 2 Ch. 432; 15 R. P. C. 534, Lindley, M.R., Chitty and Collins, L.JJ. The case was affirmed in the House of Lords, but no decision was given on this point.

³ In *Valentine Extract Co.'s Tm.*, 18 R. P. C. 175 (1901), Farwell, J., the trade mark *Valtine* was ordered to be removed from the Register, an injunc-

tion having been granted at the instance of the applicants against its use (Appendix, p. 806), but they could no doubt have successfully opposed the registration.

⁴ *Thorne & Sons, Ltd. v. Pimms, Ltd.*, 26 R. P. C. 221 (1909), Neville, J. (*Glen Thorne Whisky*).

⁵ Decided in the House of Lords *sub nom. Batt v. Dunnett*, [1899] A. C. 428; 16 R. P. C. 411. It has been followed in several cases in which the registration

House of Lords, that a trade mark not registered by the proprietor with a *bonâ fide* intention of using it may be removed from the Register. With respect to this and non-user, sec. 37 of the Act of 1905 provides as follows:—

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

The section creates special grounds of removal under sec. 35 of a trade mark from the Register, and, although the exercise of the jurisdiction is discretionary, the entry of a mark, which is liable to removal under this section, is one wrongly remaining on the Register. The application must be made by a person aggrieved.¹ There are two distinct grounds of removal under the section,² they are alternatively either registration without any *bonâ fide* intention to use the mark in connection with the particular goods and no *bonâ fide* user in fact, or no *bonâ fide* user during the five years immediately preceding the application.³ Where a trade mark has been registered for five years,

has been limited by striking out goods for which there was no intention to use the mark, *Hart's Tm.*, [1902] 2 Ch. 621; 19 R. P. C. 569; *Suter, &c. Composition Co.'s Tm.*, 19 R. P. C. 42; *Anglo-Swiss Condensed Milk Co.'s Tms.*, 20 R. P. C. 509; 21 R. P. C. 261 (1904). In *Louise v. Gainsborough*, 20 R. P. C. 61 (1903), Farwell, J., said that in order to remove a trade mark from the Register on the ground of non-user, there must be shown either want of *bonâ fide* intention to use at the date of registration and that it has not been used, or that it has been abandoned.

¹ Above, p. 313.

² *Ramsay's Tm.*, 28 R. P. C. 497 (1911), Swinfen Eady, J., where the mark, consisting of the word “Murad,” with the signature “Allan Ramsay,” registered for cigarettes, was removed from the Register on the first-mentioned ground, at the instance of R. Muratti, Sons & Co., Ltd., who also obtained an injunction against the use of the name *Murad, Ltd.*, by a newly formed company. See also *Andrew v. Kuehnrich* in Addenda.

³ The Legislature is here evidently referring to non-user *after* registration.

the last ground will obviously be the one selected by an applicant for rectification. If it has been registered for less than five years, then the applicant must show in addition to non-user that it was registered without *bond fide* intention to use it in connection with the goods, and it is doubtful whether the want of such *bond fide* intention to use it would be inferred merely from non-user in fact. In *Batt's* case¹ the want of such intention was inferred from non-user, but the trade marks had been registered for many years. Other circumstances might assist to show the absence of intention to use, for instance, the fact that the proprietor's business had never extended to the particular goods, for the section enables an application for rectification to be made in respect of any of the goods for which the mark is registered.²

The proprietor may, although a *prima facie* case is made against him, show that the non-user is due to special circumstances in the trade³ and not to any intention not to use or to abandon the mark in respect to the goods in question.⁴

In a recent case in which the plaintiffs had sold that part of their business which consisted in making Bowden cycle brakes for pedal cycles to the defendants and afterwards registered a trade mark which included the word "Bowden" (the exclusive use of which was disclaimed) for brakes for velocipedes and other road vehicles, but had not since such sale, which took place in 1901, made or sold any brake for a pedal cycle and had no intention of doing so, the Register was rectified by excluding velocipedes or pedal cycles wholly propelled by the physical force of the rider.⁵

Associated
trade marks.

Where a trade mark and a portion or portions of it are separately registered as associated trade marks, user of the whole trade mark is for the purposes of the Act to be deemed to be also a user of such registered trade marks as it contains.⁶

¹ Cited above, p. 326.

² In *Ramsay's Tm.*, cited p. 327, note (2), the registered proprietor gave evidence and was cross-examined, and Swinfen Eady, J., was satisfied that he had never any *bond fide* intention of using the mark, which had been registered nearly five years.

³ "A man who has a trade mark may properly have regard to the state of the market and the demand for the goods; it would be absurd to suppose

that he lost his trade mark by not putting more goods on the market when it was glutted." Per Chitty, J., in *Mouson v. Boehm*, 26 C. D. 398 (1884). Cf. *Daniel and Arter v. Whitehouse*, [1898] 1 Ch. 685; 15 R. P. C. 134.

⁴ Abandonment, p. 412.

⁵ *Bowden Wire, Ltd. v. Bowden Brake Co., Ltd.*, 30 R. P. C. 45 (1913), Swinfen Eady, J. On appeal the mark was wholly removed, see above, p. 307.

⁶ Sec. 25.

And it is also provided generally by sec. 27 that, where under the provisions of the Act user of a registered trade mark is required to be proved for any purpose, the tribunal may, if and so far as it shall think right, accept user of an associated registered trade mark,¹ or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for such user.

Section 41, which makes registration for a period of seven years from the date of original registration or from the passing of the Act (whichever shall last happen) conclusive as to the validity of the original registration,² subject to certain exceptions, contains no exception referring to sec. 37, but it would seem that it would not avail to save a trade mark from removal on the ground of non-user for five years immediately before the application to remove it, that being a matter subsequent to registration,³ and, as already pointed out, where the trade mark has been registered, but not used, for five years, it is not necessary under sec. 37 to show a want of intention to use it at the date of registration.

What Orders may be made under the Section.

The section empowers the Court to make "such order for making, expunging, or varying the entry," of the omission or registration of which complaint is made, as the Court thinks fit. The Court may therefore (1) direct an entry to be made on the Register; (2) order an entry already appearing thereon to be wholly removed; or (3) to be partially removed; or (4) to be modified by a disclaimer; or (5) by limiting it to particular goods; or (6) by limiting it to one or more specified colours; or (7) by the entry of conditions; or (8) to be varied as to its form; or (9) date; or (10) the name of its registered proprietor; or (11) by correcting any error or defect in the entry.

(1) The jurisdiction to order a new entry to be made seems to be specially referable to the preceding words of the section, "aggrieved by the non-insertion in or omission from the Register of any entry," but the Court is not empowered by the section to order to be entered upon the Register a mark which the Registrar has refused, for a special mode of appeal from the Registrar's

New entries.

New marks cannot be registered under the section.

¹ Associated trade marks, see above, p. 116.

² See below, p. 368.

³ See p. 370.

decision to the Board of Trade or to the Court is provided by sec. 12, and, consequently, no other appeal is permitted.¹ And it cannot direct a new mark to be registered with regard to which the proper procedure by application and advertisement has not been resorted to.² So far as actual marks are concerned, the reference to entries to be made upon the Register must, therefore, notwithstanding the words quoted above, be taken to refer only to the variation of marks already registered by addition to them.

Total
removal.

Reasons for
removal.

(2) Orders for total removal of entries from the Register have been made in a great number of cases, and many examples have been given already in this and the two preceding chapters. The entry is to be expunged if made without sufficient cause, or if wrongly remaining on the Register. What is a sufficient cause for refusing an application to register is considered in Chapter IV,³ and generally the same reasons will afford grounds for removing an entry inadvertently made. But the Court has a discretion to refuse to vacate the registration of a mark, independently adopted and extensively used by the proprietor, if it falls within the class of symbols which may be registered as trade marks, and the only objection is that it had been previously used or acquired as his trade mark by another person.⁴ The proprietor of a registered mark stands in a better position than an applicant for registration, since the Registrar's discretion⁵ has been exercised in his favour, and the onus of showing that the registration was made without sufficient cause is cast upon the person applying to vary it.⁶

The reasons for removing a mark may be classified as follows: namely, that the registered proprietor is not the person

¹ *The Normal Co.'s Tm.*, 35 C. D. 231; 4 R. P. C. 123 (1887), Chitty, J., and C. A., decided under the Act of 1883.

² *Rivière's Tm.*, 55 L. J. Ch. 545; 53 L. T. 237 (1885), C. A.; and as to transfers from one name to another, see below, p. 336, and cf. p. 325. In *Jackson v. Napper* there was an application for registration, and the summons was an application to proceed under sec. 62. It seems to have been irregular in any case, as there was no appeal from the Comptroller to the Board of Trade, so far as the report

shows: 35 C. D. 162 (1886), Stirling, J.

³ At page 76.

⁴ *Mouson v. Boehm*, 26 C. D. 398 (1884), Chitty, J.; *Paine & Co. v. Daniells & Sons' Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 217, above, p. 320. The Court can now allow the objector's trade mark to be registered under sec. 21, but a substantive application in the prescribed manner would no doubt be necessary.

⁵ Chap. IV., at p. 76; but see above, p. 323.

⁶ Above, p. 323.

entitled to use it;¹ the mark was not capable of registration,² or it fell within the restrictions forbidding registration contained in the Acts;³ the registration was procured by a material misstatement;⁴ or the person who registered had no *bonâ fide* intention to use the mark, and has not used it in fact⁵ or has not used it for five years immediately preceding the application.⁵

The Court of Appeal held, under the Act of 1883, that the words "made without sufficient cause" did not relate merely to the date of registration,⁶ and that there was jurisdiction to rectify although there had been no mistake or error in the original registration. This point does not arise under sec. 35 of the Act of 1905, because express power is given to the Court to remove an entry wrongly remaining on the Register. As already noticed, a trade mark can be removed for non-user, and it would seem that if a registered proprietor ceases to carry on business, or abandons all further intention to trade in the goods for which the mark is registered,⁷ or in any other way renders it improper that the mark should remain on the Register, it can be removed. It has been decided that no events subsequent to the date of registration can be appealed to by the registered proprietor to defend his mark.⁸

(3) If part only of a composite mark is objectionable, that part may be removed. This course was adopted in *Biegel's Trade Mark*,⁹ where the applicants, Younger & Co., complained that the use of three interlaced triangles in the respondent's

Alteration of circumstances subsequent to registration.

Abandonment or mis-user of mark.

Partial removal.

¹ Chap. IV., at p. 72.

² Chap. VIII., p. 135. This ground is subject to the provisions of sec. 36, see above, pp. 140 and 325.

³ Chap. X., p. 246. For an instance where a trade mark was expunged as being calculated to deceive, at the instance of applicants, who proved that they had long used the mark before the registration of it, see *Hoemouller's Tm.*, 28 R. P. C. 249 (1912), Joyce, J. (*alpha*).

⁴ *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1891), North, J.; *Gordon and Dilworth's Tm.*, 13 R. P. C. 629 (1896); *Eastman, &c. Co. v. John Griffith's Cycle Corporation, Ltd.*, 15 R. P. C. 105 (1898), cited p. 300.

⁵ Above, pp. 326 and 327.

⁶ *Batt's Tms.*, [1898] 2 Ch. 432; 15 R. P. C. 534; supra, p. 326; *Ward, Sturt, and Sharp's Tms.*, 50 L. J. Ch. 347 (1881), Hall, V.-C., was to the contrary effect. In *Louise & Co., Ltd. v. Gainsborough*, 20 R. P. C. 61 (1903), Farwell, J., said that to remove a mark for non-user either want of *bonâ fide* intention to use the mark or abandonment must be shown.

⁷ Cf. *Batt's Tms.*, supra, p. 326; and as regards the removal of an abandoned mark, see below, p. 414.

⁸ Above, p. 325. This, however, is subject to sec. 36.

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

Deceptive
mark wholly
removed.

label caused it to resemble too closely their own label, which contained three superimposed solid triangles similarly placed. The remainder of the label was distinctive, and the applicants did not complain of it. The order made was to strike out the triangular device. Where, however, the registered mark consisted of a fir tree, with the words *Forrest* and *London* below printed in large letters, and, the proprietor being a Coventry watchmaker, having no connection with the business formerly carried on by Forrest in London, the mark was deceptive, Chitty, J., directed the whole mark to be struck out, but without prejudice to any application the respondent might make to register the fir tree alone.¹

In the case last cited it was argued on behalf of the Comptroller that sec. 90 of the Act of 1883 did not authorise the alteration of a registered mark, and that any application to vary must have been made under sec. 92 of that Act;² and a similar contention may perhaps be raised on secs. 34 and 35 of the Act of 1905; but such a contention is opposed to the express words of sec. 35, and it would leave unprovided for cases which do not fall within sec. 34, which is confined to applications by registered proprietors themselves.

Registration
of a dis-
claimer.

(4) Registration with a disclaimer has already been discussed.³ *Edge's Trade Mark*⁴ is an example of the compulsory registration of a disclaimer. The respondent had registered the words *Edge's Filtered Blue*, and a label containing these words with certain devices. Mr. Justice Stirling held that the word *filtered* was either descriptive or deceptive, and that the respondent could have no exclusive right to use it. He accordingly directed the first mark to be removed from the Register, and the exclusive right to the use of *filtered* in the other to be disclaimed. So, an order for the disclaimer of the exclusive use of the words *white*

¹ *Hill's Tm.*, 10 R. P. C. 113 (1893). Such an application was made, but refused: see the report of *Thorncloe v. Hill*, 11 R. P. C. 67 (1894).

² See now sec. 34, below, p. 353.

³ Chap. IX., p. 236.

⁴ 8 R. P. C. 207 (1891), Stirling, J. (see above, p. 218); *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J. (*Washerine*); *Hayward's Tm.*, 54 L. J. Ch. 1003 (1885), Kay, J.; *Thompson v. Miller*,

13 R. P. C. 35 (1896), Stirling, J. (*Roadster*), are other instances. But see *The Smokeless Powder Co.'s Tm.*, [1892] 1 Ch. 590; 9 R. P. C. 109, Chitty, J.; *Clement et Cie.'s Tm.*, [1900] 1 Ch. 114; 16 R. P. C. 173, 611, Kekewich, J., and C. A. (*St. Raphael*), where disclaimers were not ordered, and *Faulder's Tm.*, [1902] 1 Ch. 125; 18 R. P. C. 37 and 535 (*Silverpan*), where the jurisdiction under the Acts then in force was questioned.

zinc and of the word *patent* and of the Royal Arms was made in the case of an old mark.¹ In some cases under the repealed Acts, it was, at the instance of the Comptroller, made a condition for granting leave to make alterations in a mark, that an entry be made of a statement of the essential particulars and a disclaimer of the exclusive use of the added matter;² the principle being that the applicants should put themselves in the same position as if they were registering under the Act for the time being in force; but under the present procedure such a statement of essential particulars is not required to be made in an application to register. Under sec. 15 the Court has now express power to require a disclaimer as a condition of a trade mark remaining on the Register.³

(5) A limitation restricting the registration of a trade mark to those goods for which the registered proprietor actually used the mark, and to which alone the goodwill of the business transferred to him with the mark by the former proprietor extended, was adjudged to be notified upon the Register in *Edwards v. Dennis*.⁴ And in the *The Milkmaid Brand* case,⁵ where the defendant's mark too nearly resembled the previously registered mark of the plaintiffs, it was ordered that the registration of the former should be confined to goods for which the plaintiff's mark was not registered. In *Banks and James' Trade Mark*⁶ the registration of a mark registered for cigars, cigarettes, and tobacco was, on a motion to rectify, and with the consent of the proprietor, ordered to be limited to cigars.⁷

Limitation of the registration—
to particular goods;

Section 37, which enables a trade mark to be removed from the Register on the ground of non-user, has been referred to earlier in this chapter,⁸ and it is there pointed out that the mark may be removed in respect of any of the goods for which it is registered. In *Bowden Wire, Ltd. v. Bowden Brake Co., Ltd.*,⁹ Swinfen

¹ This appears in the report of *Hubbuck v. Brown*, 17 R. P. C. 148, where the mark is shown.

² *Colman's Tms.*, [1891] 2 Ch. 402; 8 R. P. C. 209, Kekewich, J.; *Orlando Jones & Co.'s Tms.*, 12 R. P. C. 278 (1895), Stirling, J.

³ See above, p. 236.

⁴ 30 C. D. 454 (1885), G. A.

⁵ *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 C. D. 454; 3 R. P. C. 28 (1886), Kay, J.

⁶ 12 R. P. C. 333 (1895), Chitty, J.

⁷ And in *Batt's Tms.*, 15 R. P. C.

534 (1898), one of the marks was only expunged as regards goods in one class.

⁸ Above, p. 327.

⁹ 30 R. P. C. 45 (1913). On appeal the Registration was wholly expunged, see above, p. 307. *Harc's Tm.*, 24 R. P. C. 263 (1907), Swinfen Eady, J., is another instance of limitation under the Act of 1905. The trade mark was registered by oil and colour manufacturers for all goods included in Class 1, but not including mineral dyes or goods of a like kind. An order was made excluding photographic dry

Eady, J., made an order under the section varying the entry of a trade mark registered in respect of brakes for velocipedes and other road vehicles by restricting it to brakes for road vehicles other than velocipedes or pedal cycles wholly propelled by the physical force of the rider, the registered owners not having since the registration made brakes for pedal cycles and having no intention of doing so.

The following cases were decided under the former Acts on the principle of *Edwards v. Dennis*¹ and *Batt's Trade Marks*.² In *Suter, &c. Composition Co.'s Trade Marks*,³ a trade mark registered for chemical substances used in manufacture, photography and philosophic research, anti-corrosives and anti-foulers, was limited to anti-corrosives and anti-foulers, for which only it was intended, and the registration of another mark was limited to such goods as, on the respondent's evidence, it had been used for. In this case it was said that on an application of this nature, the order should not be simply to exclude the articles in respect of which the applicant is interested, but to amend the entry so as to confine it to the goods in respect of which the registered mark has been used, so as to avoid further applications to limit. In *Hart's Trade Mark*,⁴ an order was made excluding condensed milk from the goods for which the trade mark was registered, although the mark had been registered for twenty years, and the proprietor dealt in condensed milk, and had at the date of the application for rectification determined to use the mark on condensed milk. He had used other marks for such goods. In the *Anglo-Swiss Condensed Milk Co.'s Trade Marks*⁵ an order was made excluding butter from the goods for which a trade mark was registered on the ground that there had never been any intention to use it for butter, the mark having been registered without such use for over twenty years.

In *Bourne v. Swan and Edgar, Ltd.*,⁶ the word "Swanbill," which was registered for ladies' corsets and other ready-made

plates and films, and all goods of a like kind. The respondent did not oppose at the hearing, but was ordered to pay the costs. *Paine & Co., Ltd.'s Tm.*, 25 R. P. C. 329 (1903), is another instance. At the hearing the respondents, who were registered for all goods in Class 42 except peas and beans, did not oppose the exclusion of toffee and confectionery.

¹ Note (4), p. 333 and p. 113.

² Above, pp. 326 and 114.

³ 19 R. P. C. 42 (1902), Byrne, J.

⁴ [1902] 2 Ch. 621; 19 R. P. C. 569, Byrne, J.

⁵ 20 R. P. C. 509; 21 R. P. C. 261 (1904), Joyce, J., and C. A.

⁶ [1903] 1 Ch. 211; 20 R. P. C. 105, Farwell, J.

underclothing, was held to be descriptive of a particular shape of corset, and the Register was ordered to be rectified by confining the goods to ladies' ready-made underclothing other than corsets.

The Court has under sec. 90 of the Act of 1883 ordered a note of an undertaking by the registered proprietor restricting the use of the mark, in accordance with an agreement between the proprietor and the applicant, to be entered on the Register,¹ and the Court has probably power under the present Act to impose limitations and conditions, including limitations of area, as a condition of a trade mark remaining on the Register.²

to particular market.

(6) Under sec. 10 of the Act a trade mark may now be registered with a limitation as to the whole or a part to one or more specified colours; and in cases where that is done colour may be taken into consideration for the purpose of distinctiveness.³ This being so, if a registration without colour were successfully challenged, but the trade mark would be unobjectionable if confined to the colours in which it was used, it is probable that the Court would exercise its discretion by imposing a limitation to those colours instead of removing the mark from the Register.⁴

Limitation to specified colours.

(7) As already pointed out, registration subject to conditions is now permissible,² and in a proper case the Court could probably therefore enter a condition on the Register instead of expunging the mark.

Entry of conditions.

(8) The only variation in the form of a registered mark ordered under sec. 90 of the Act of 1883 which occurs in any reported case is variation by striking out part of the mark.⁵ Any alteration which, to use the language of sec. 34 of the Act of 1905, substantially affected the identity of the mark would be open to the objection that it would cause a new mark to be entered on the Register, the application for which had not been advertised,⁶ and had not been approved by the Registrar.

Variation in form of mark.

¹ *Mitchell & Co.'s Tm.*, 28 C. D. 666 (1885), Chitty, J.; cross undertakings for local user. As to entering such undertakings or at all events those referring to locality, on the Register, under the Acts of 1883 and 1888, see *Dewhurst's Tm.*, [1896] 2 Ch. 137; 13 R. P. C. 288, and *supra*, p. 255; and *Eastman, &c. Co., Ltd. v. J. Griffith's Cycle Corporation, Ltd.*, 15 R. P. C. at

p. 109 (1898) (the Comptroller's objection).

² Cf. sec. 12 (4) and sec. 14 (6).

³ Colour, above, p. 233.

⁴ Cf. sec. 36.

⁵ See above, p. 331; and as to alterations under sec. 34, see below, p. 353.

⁶ See above, pp. 325, 329, and 330.

Possibly the Court would in a suitable case under the present Act adjourn the hearing to enable the respondent to make an application under sec. 34.

Variation
of date of
entry.

(9) A variation of the date of registration was directed in *Hayward's* case.¹ There a mark was registered in 1885 on an application made in 1879, and it was held that the registration, not having been completed within one year, ought to have been treated as abandoned, under sec. 63 of the Act of 1883. Kay, J., however, refused to expunge the registration, but ordered that the five years which under that Act made registration conclusive evidence of exclusive right of user² should run from the date of the actual registration instead of from the date of the application to register.

Variation
of name of
proprietor.

(10) The Register could not be rectified under sec. 90 of the Act of 1883, where a mark had been wrongfully registered in the name of someone other than the proprietor, by expunging the name and substituting that of the person entitled to the mark, and this is probably so under the Act of 1905. The whole entry may be expunged, but the true proprietor must be left to make a fresh application for registration, which will be advertised in the ordinary course, and may lead to opposition.³ So where an agent wrongfully registered his principal's trade mark in his own name, Jessel, M.R., refused to order the name to be changed.⁴ And the same rule was applied where the entry was innocently made in the wrong name by mistake, as by a partner in his own name instead of his firm's,⁵ or by an agent acting for two principals, in the name of the wrong principal.⁶ In the former case, the proper cause was for the registered owner to assign, and for the assignee's name to be registered under sec. 87.⁷

Registration
in the wrong
name.

¹ 51 L. J. Ch. 1003 (1885), Kay, J.

² See sec. 41 of the Act of 1905, below, p. 368.

³ *Rivière's Tm.*, 55 L. J. Ch. 545 (1885), C. A., cited above, p. 317; *Harness' Tm.*, 17 R. P. C. 40 (1900), Farwell, J.

⁴ *Marler's Tm.*, 44 L. T. 98, n. (1878). In the case of a design the name has been altered in the absence of fraud: *In re Grocott's Design*, 17 R. P. C. 139 (1900); but different considerations apply in the case of designs, and the case does not affect the practice as to trade marks. In *Casson's Tm.*, 27 R.

P. C. 65 (1910), Eve, J., a trade mark was removed from the Register at the instance of former employers, on the ground that the registration by the registered proprietor in his own name was inconsistent with the good faith which ought to obtain between employee and employer.

⁵ *Farina's Tm.*, 44 L. T. 99, n. (1881), Jessel, M.R.

⁶ *Kingsford & Son's Application*, 6 R. P. C. 413; 61 L. T. 426 (1889), Kay, J.

⁷ *Greenlees' Tm.*, 9 R. P. C. 93 (1892), Stirling, J.; and *Farina's Tm.*, supra.

But in a case where a partner registered the mark in his own name thus—"Arthur Rust, trading as T. W. Rust & Co."—Jessel, M.R., allowed the names of all the partners to be substituted for "Arthur Rust";¹ and this case was distinguished in the later judgment, on the ground that the application had been made in the name of the true proprietors, the firm. Where in an application for rectification the applicants asked alternatively that they might be registered as subsequent proprietors or alternatively as joint proprietors with the registered proprietors of the trade marks, and it was held that the trade marks were joint property, the applicants were ordered to be registered as co-proprietors.² Where the owners of the mark changed the name, under which they were carrying on business, Stirling, J., on an application under the section, allowed the new name to be entered, with a note that the firm formerly traded under the old name.³ But in a later case, North, J., held that on an alteration of the name of a limited company, who were the proprietors of a trade mark, the Comptroller could enter the new name of the proprietors on the Register under sec. 87 of the Act of 1883, and unless he refused, the Court could not order rectification under sec. 90.⁴ The Registrar now has power on request by the registered proprietor, or by some person entitled by law to act in his name, to enter any change of name of the person who is registered as proprietor of a trade mark;⁵ so that an application under sec. 35 is not necessary for this purpose, and probably would not be entertained in a case to which sec. 32 applied. In *Re The Australian Wine Co.*⁶ a mark had been registered in his own name by the sole consignee of wines from a particular vineyard, the consignee intending to use the registration solely for the protection of such wines, and so long only as he should remain consignee. The mark was transferred by his trustee in bankruptcy, with the consignee's business, to a purchaser who procured the entry on the register of his own

Change of
name of
proprietor.

Sec. 33 of the Act of 1905 corresponds to this part of sec. 87 of the Act of 1883. Sec. 70 of the Act of 1893 (sec. 22 of the Act of 1905, trade mark to be assigned only with goodwill) was not an obstacle to such assignment: *Welcome's Tm.*, 32 C. D. 213; 3 R. P. C. 76 (1886), Chitty, J.

¹ *Rust's Tm.*, 44 L. T. 98, n. (1880).

² *Tarantella Tms.*, 27 R. P. C. 573

T.M.

(1910), Eve, J.

³ *Plumbago Crucible Co.'s Tms.*, 7 R. P. C. 282 (1890); followed by Kekewich, J., in *Burgon v. Wilkinson*, 40 Sol. J., p. 336 (1896).

⁴ *New Ormonde Cycle Co.'s Tm.*, [1896] 2 Ch. 520; 13 R. P. C. 475.

⁵ Sec. 32, below, p. 351.

⁶ 61 L. T. 427, n. (1885).

name as proprietor. Subsequently, upon the application, under sec. 90 of the Act of 1883, of the then owners of the vineyard, Chitty, J., directed their names to be entered as proprietors of the mark, in lieu of that of the purchaser of the consignee's business, on the ground that the mark had been registered for the benefit of the owner of the vineyard, not for that of the owner of the business.

And in a case where the registered proprietor of a mark had assigned her business and the use of the mark for six years to the respondents, with an express provision for the same reverting to her, and they had procured the registration of their own names as assignees, upon their application it was ordered that the Register should be rectified by removing their names and restoring that of the original proprietor.¹

In another case an alleged assignment of trade marks was held to be wrongly registered, and was ordered to be expunged.²

Where an assignor by mistake purported to assign a mark and goodwill after a previous agreement to assign to a third person, and the assignee was registered as proprietor, his name was expunged on the application of the executors of the person with whom the agreement had been made, the second assignment being inoperative by reason of there being no goodwill to assign.³

(11) The Court has power on the application of a person aggrieved by any error or defect in any entry on the Register to vary the entry as it may think fit. Some of the cases under the former Act referred to above under (10) would be covered by these words.⁴

Procedure on an Application under sec. 35.

“The Court.” “The Court” in England is His Majesty's High Court of Justice,⁵ or, with reference to marks of which the registration was applied for in the Manchester Trade Marks Office,⁶ the Palatine Court of Chancery;⁷ and those Courts have jurisdiction

¹ *Re Avril*, April 20th, 1888, Stirling, J.; Sebastian, 5th ed. pp. 640, 649.

² *Rey v. Lecouturier*, 25 R. P. C. 265 (1908), C. A.

³ *Harness' Tm.*, 17 R. P. C. 40 (1900),

Farwell, J.

⁴ Cf. sec. 32 (1), below, p. 351.

⁵ Sec. 3 (sec. 117 of the Act of 1883).

⁶ Chap. VII., p. 129.

⁷ Sec. 71; Act of 1888, sec. 26.

to rectify a registered mark, whether the registered proprietor is domiciled or resident in England, or in Scotland, or Ireland, or elsewhere;¹ although where he is domiciled or resident in Scotland or Ireland, the Scotch or Irish Courts have, perhaps, a concurrent jurisdiction.² The question of the jurisdiction of the Scotch and Irish Courts to rectify the Register is somewhat doubtful. Under the Act of 1883 the Irish Courts held that they had no jurisdiction to rectify,³ but it was held by the Scotch Courts that they had jurisdiction to make a declaration that an entry in the Register is invalid, and that thereupon sec. 111, sub-sec. (2), of the Act of 1883⁴ became applicable.⁵ That sub-section is not, however, reproduced in the present Act, but sub-sec. (4) of sec. 35, which is in general terms without express reference to proceedings in Scotland or Ireland, enacts that any order of the Court rectifying the Register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner, who shall upon the receipt of such notice rectify the Register accordingly. The omission in the new Act of sub-sec. (2) of sec. 111 of the Act of 1883 does not strengthen the contention that there is jurisdiction in the Scotch or Irish Courts to order rectification of the Register.⁶

In practice, proceedings to rectify are almost always taken in the Chancery Division, except where they occur in the course of an action for infringement or passing-off, commenced against the applicant in the King's Bench Division;⁷ and unless disputed questions of fact are involved which it is desirable to try by the aid of a jury, the Chancery Division will almost always be found to provide the more satisfactory tribunal for the trial of trade mark questions.

Section 35 states that the application is to be made in the prescribed manner, which in relation to proceedings before the Court means prescribed by rules of Court,⁸ but no rules have

¹ *Re King & Co.'s Tm.*, [1892] 2 Ch. 462; 9 R. P. C. 350, Kekewich, J., and C. A. As to notice of motion in such cases, see below, p. 342.

² See the case last cited, and sec. 111 (2).

³ *Bayer v. Connell Bros.*, 14 R. P. C. 275 (1897).

⁴ Appendix, p. 709.

⁵ *Dewar & Sons, Ltd. v. Dewar*, 17 R. P. C. 341 (1900), followed in *Dawson*

v. Stewart, 22 R. P. C. 250, and *Reid v. Thomson & Co.*, 22 R. P. C. 376, at p. 379 (1905), and in *Boord & Son v. Thom and Cameron, Ltd.*, 24 R. P. C. 697 (1907), Inner House, Scotland.

⁶ Cf. secs. 94 and 95 of the Patents and Designs Act, 1907.

⁷ As in *Pinto v. Badman*, 8 R. P. C. 181 (1891).

⁸ Sec. 3.

been made under the Act prescribing the manner in which the application to the Court must be made. In practice the procedure has in recent years always been by motion, though formerly applications by originating summons were not infrequent.

Not by
action.

There is no reported English case where the application has been made by action; and in *Pinto v. Badman*,¹ Bowen, L.J., suggested that to proceed in that way would be an abuse of the process of the Court. It may be assumed, at any rate, that the plaintiff in an action, unless he could show some good ground for adopting a course which is both unusual and, in general, unnecessarily expensive, would have to pay the extra costs incurred, even though he were successful.

Not by
counter-
claim.

In the case last cited, it was held that the application could not be made by counterclaim, apparently on the ground that it did not fall within sec. 24 (3) of the Judicature Act of 1873.²

By motion.

As already stated, the application is now always made by motion. If an action is pending in the matter, the motion will almost always be adjourned to the hearing of the action. The notice of motion must, if issued in the Chancery Division, be marked with the name of a judge,³ and the notice must, unless special leave for short notice is given by the Court or a judge, be served two days before the motion is made.⁴ By Rule 129 of the Trade Mark Rules, 1906, every application to the Court under the Act must be served on the Registrar. And sec. 47 of the Act provides as follows:—

Service on
the Regis-
trar.

Sec. 47.

“In any legal proceeding in which the relief sought includes alteration or rectification of the Register, the Registrar shall have the right to appear and be heard, and shall appear if so directed by the Court. Unless otherwise directed by the Court, the Registrar in lieu of appearing and being heard may submit to the Court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting the same or of the practice of the office in like cases, or of such other matters relevant to the issues, and within his knowledge as

¹ As in *Pinto v. Badman*, 8 R. P. C. 181 (1891).

² Cf. sec. 32, Patents and Designs Act, 1907.

³ Ord. 5, r. 9 (c); *King & Co.'s Tm.*, [1892] 2 Ch. 469; 10 R. P. C. 350. Form, p. 723.

⁴ Ord. 52, r. 5.

such Registrar, as he shall think fit, and such statement shall be deemed to form part of the evidence in the proceeding."

Under the old practice the Comptroller had the right to appear on an application to rectify¹; but the latter part of the section is new in substance as well as in form. It is intended to enable the Registrar to save the parties the cost of an appearance on his behalf. The words "particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting the same" would apply to appeals under secs. 23, 32, 33 or 34, in which the matter would have come before the Registrar in the first instance, and on appeal might come before the Court, directly (under sec. 33) or on a reference by the Board of Trade. They might also apply in cases under sec. 35 where there has been a previous decision of the Registrar relating to the entry.

No special terms should be inserted in an order for rectification, even by consent, unless the Registrar has notice of them.² In cases where the Board of Trade does not think it necessary that the Registrar should be represented on the hearing of the motion, an intimation is sent to the applicant asking for an undertaking that in the case of each mark no order shall be applied for in any way affecting the Registrar except a simple order for the removal of the mark, or if any settlement is proposed between the parties, that the applicant will serve the solicitor to the Board of Trade with a copy of the terms proposed, giving him a reasonable opportunity, if so advised, of objecting thereto on behalf of the Registrar before an order is taken; the undertaking also binds the applicant, should he have the carriage of the order, to supply draft minutes whatever order be made, and to give due notice of all appointments to settle the same.

The Court may in any application for rectification review a decision of the Registrar relating to the entry in question or correction sought to be made.³ But where there has been a decision of the same matter by the Court between the parties, for instance, on an appeal from the Registrar to the Court arising out of an opposition, the matter might perhaps be held to be

¹ Rule 49 of 1890; notice of an application to rectify had to be given to the Comptroller.

² See *Golding's Tm.*, 19 R. P. C. 375 (1902), Joyce, J.

³ Sec. 54.

res judicata, thereby preventing the question from being reopened under sec. 35 by the defeated party.¹

Service on
the registered
proprietor.

Where the
proprietor is
resident
abroad.

It is proper when the registered proprietor of the trade mark in question is resident within the jurisdiction, to serve him with the notice of motion;² formerly this could not be done, if he were resident abroad, nor was it necessary to enable the Court to entertain the application in question.³ In the case of *La Cie. Générale d'Eaux Minérales, &c.*, notice of motion to remove a mark belonging to a foreign company not carrying on business in England was served upon the company in Paris; and Stirling, J., upon their application, set aside the service, because it would have founded a jurisdiction to give costs and damages⁴ against the company, and there is, he held, nothing in the Acts to warrant this in the case of such a respondent. The notice of motion had been served abroad without the leave of a judge, but that was really immaterial, as there was no jurisdiction under Order XI. or otherwise to grant leave in respect of the application in question. On a subsequent application the learned judge directed that the name of the company should be struck out of the notice of motion, leaving the Comptroller as the sole respondent, but that information of the application should be given to the company.⁵ This course was adopted and approved in *King & Co.'s* case,⁶ where the registered proprietors of the mark in question were a company having its registered office and carrying on business in Ireland. In that case the Court of Appeal held that service of the formal notice of motion was not required to enable the Court to deal with the application, and that, as the Acts and Rules were silent on the subject, all that was required by natural justice, and therefore all that the Court would insist on, was that the persons interested in the mark should have actual notice of the application to be made respecting it.⁷ If they should take advantage of the notice to appear and oppose the application it was, the Court held, open to them to do so, but in that event they would be liable, if they failed, to be ordered to pay costs. Lindley, L.J.,

Notice of
motion not
to be served
out of the
jurisdiction.
Notice by
letter only.

Foreigner
appearing on
the applica-
tion may be
made liable
for costs.

¹ See *Normal Co.'s Tm.*, 35 C. D. 231; 3 R. P. C. 269; 4 R. P. C. 123 (1887). See also above, p. 102.

² See *King & Co.'s Tm.*, [1892] 2 Ch. 462; 9 R. P. C. 350.

³ See *King & Co.'s Tm.*, supra, and *Royal Baking Powder Co.'s Tms.*, 14 R. P. C. 425 (1897), Romer, J. And the

steps taken by the applicant in *Ashton's Tm.*, 43 W. R. 389 (1900), where the registered proprietor, resident abroad, could not be traced.

⁴ As to damages, see above, p. 312.

⁵ [1891] 3 Ch. 451; 8 R. P. C. 446.

⁶ Supra, note (2).

⁷ Cf. Ord. 52, r. 3.

expressed a doubt whether it was necessary, in the case before Stirling, J., to strike out the name of the foreign respondents from the notice.¹ He said: "If you go down to the root of the argument there is nothing in it except a false analogy based on the supposition that, because the notice of motion is marked by an English judge, the parties interested must be technically named at the foot of it as respondents, and you must get leave to serve them if they are to be affected by it. It appears to me that all that they want for the purposes of this Act is notice, and that they have had."²

Now, under Rule 9, the Registrar may require the proprietor of a registered trade mark who does not reside or carry on business within the United Kingdom to give an address for service within the United Kingdom, and such address may be treated as the actual address of the proprietor for all purposes connected with such trade mark. Cases, however, may occur in which at the date of rectification proceedings, the proprietor is resident abroad and yet this Rule may give no assistance; and in such cases there seems to be no reason why the practice prior to the enactment of the Rule should not be resorted to.³

Where an application was made to remove a trade mark on the ground of non-user for five years, and the registered proprietor, who had formerly carried on business in this country, being pressed by creditors, had left his registered address some years previously to go abroad, but nothing had since been heard of him, and the applicants had taken every reasonable step for the purpose of ascertaining his whereabouts, but unsuccessfully, the Court treated service at the registered address as service on the registered proprietor.⁴

If it appears that the registered proprietor has not the equitable interest, the person having such interest ought to be added as a respondent unless he distinctly disclaims all interest.⁵

It has been held that a foreigner who is the registered

Service where registered proprietor cannot be found.

Security for costs by foreigner.

¹ [1892] 2 Ch. p. 482.

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

³ See also R. S. C. Order XI., Rules

1 (c) and 8 (a), and the notes thereto in the Annual Practice. But, as stated in the text, service has been held not to be necessary.

⁴ *Smollens' Tm.*, 29 R. P. C. 158, [1912] W. N. 35.

⁵ *Re Zonophone Tm.*, 20 R. P. C. 450 (1903), Byrno, J.

proprietor of a mark which it is sought to remove from the Register is entitled, on receipt of information as to the intended application to rectify, to appear upon the application without giving security for costs, on submitting to the jurisdiction;¹ but if he appeal from an order made on the motion, he may be ordered to give security.²

Action for
infringement
in Scotland
or Ireland.

The Court has in several cases refused to allow actions for infringement to be brought or proceeded with in England where it has considered the Scotch or Irish Courts to be more convenient, notwithstanding that motions to rectify were pending before it with regard to the same matters.³

Evidence on the Application.

The evidence is, in accordance with the usual rule, generally given in the first instance by affidavit, subject to cross-examination of the deponents if ordered by the Court or a judge.⁴ But applications under the section are very frequently heard upon *vivâ voce* evidence given in Court. And the Court had, by the terms of sec. 90 of the Act of 1883, power to direct an issue to be tried for the determination of any fact arising upon the application, but this was rarely, if ever, done. No special provision in this respect is contained in the Act of 1905, the matter being covered by the general powers of the Court.⁵ Where an action is pending by the proprietor of the mark against the applicant, it is very usual, especially in cases where the application to rectify depends on questions of fact, to order the application to stand over until the trial, and to come on to be heard with the action, with leave to use the affidavits and cross-examine on them, and to adduce oral evidence. In such a case the applicant for rectification is generally ordered to give particulars of his objections to the entry attacked.

Declarations
of the pro-
prietor.

Statutory declarations, or certified copies of declarations, made

¹ *Société, &c. de l'Étoile's Tm.*, 10 R. P. C. 290 (1893), Stirling, J.; *Miller's Patent*, W. N. (1894), 4; 11 R. P. C. 55, Kekewich, J.

² In *Société, &c. de l'Étoile's Tm.*, 11 R. P. C. 142, an order was made by consent, the appellants having no place of business in England. On the other hand, in *Re Apollinaris Co.'s Tms.*, [1891] 1 Ch. 1, a foreign applicant who

appealed was not ordered to give security, he having ample assets within the jurisdiction.

³ *Kinahan v. Kinahan*, 45 C. D. 78; 8 R. P. C. 18 (1891), Kekewich, J.; *Marshall v. Marshall*, 38 C. D. 330 (1888), C. A.

⁴ Ord. 38, r. 1.

⁵ Ords. 33 and 36.

on the application for registration of the mark sought to be removed or varied, and on the occasion of transfers of the mark by predecessors in title of the owners of the mark, may be put in evidence by the applicants, but no declarations made by persons who are neither parties to the application nor predecessors in title of the respondents.¹

In a proper case discovery of documents may be ordered to be made by either party to the application.² In *Wills' Trade Marks*,³ on an application by notice of motion to remove certain marks from the Register, and after the evidence had been completed (except as to the cross-examination of two witnesses, which was to be taken in Court), the applicants took out a summons for an order for discovery of documents by the respondents, the proprietors of the marks. Kekewich, J., required the applicants to make a statement in writing of the grounds upon which they sought to have the marks removed, and upon it formulated six questions relative to the use of the marks by the respondents, and ordered that a member of the respondents' firm should make discovery of the documents relating to the several questions, not disclosing all the documents, but only specimens representative of each class of them. The Court of Appeal held that this order, carefully limited as it was, was oppressive at that stage of the proceedings, and upon the respondents undertaking to deliver to the applicants a statement of the labels on which they intended to rely, and to have the relevant documents in Court at the hearing, and not to object to produce them, the Court set aside the order, without prejudice to any order the judge at the trial might think fit to make as to discovery of documents.

A statement in writing made by the Registrar under sec. 47 may form part of the evidence in the proceeding.⁴

Besides the particulars of objections referred to above, further particulars which are necessary to make the applicant's case clear are sometimes ordered. If the case set up is that the mark objected to is deceptive, and it is alleged that it has in fact deceived certain persons, particulars as to the persons deceived may be ordered to be given.⁵ In a case in which

¹ *Thewlis and Blakey's Tm.*, 10 R. P. C. p. 373 (1893), North, J.

² Ord. 31, r. 12; see *Re Norwich Town Close Estate Charity*, 40 C. D. 310 (1889).

³ [1892] 3 Ch. 201; 9 R. P. C. 346.

⁴ See above, p. 340.

⁵ *Humphries v. The Taylor Drug Co.*, 39 C. D. 693; 5 R. P. C. 687 (1888), Kekewich, J., an action for infringe-

Discovery.

Written
Statement
by Registrar.

Particulars.

common use in the trade was alleged, particulars of three instances of such user and certain other particulars were ordered.¹

Order to be served on the Registrar.

An office copy of any order to rectify must be left forthwith at the Trade Marks Branch of the Patent Office together with Form TM No. 30, and the Register is to be thereupon rectified accordingly. The person to leave the order is the person in whose favour the order has been made, or such one of them, if more than one, as the Registrar shall direct.² The Registrar may, if he thinks that the order should be made public, publish it in the Trade Marks Journal.³

Certificate.

It is provided by sec. 46 :—

Certificate of validity.

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

This section corresponds to sec. 77A of the Act of 1883, introduced into that Act by sec. 18 of the Act of 1888.⁴ The important change is that under the new section a certificate may be given in any legal proceeding in which the validity of a trade mark comes into question, and not merely in an action for infringement. Questions as to validity generally arise upon motions to rectify the Register, but under sec. 77A a certificate could not be given in such a proceeding, although in some cases in which an action for infringement and a motion to rectify were

ment. See also *Whitstable Oyster Co. v. Hayling Fisheries, Ltd.*, 17 R. P. C. 461; 18 R. P. C. 434 (1901), Buckloy, J., and C. A., a passing-off case.

¹ *Aquascutum, Ltd. v. Moore and Scantlebury*, 20 R. P. C. 640 (1903), Kekewich, J. See also the particulars of common use ordered in *Schwepes,*

Ltd. v. Gibbens, 22 R. P. C. 113, at p. 116, a passing-off case, and the cases cited below, pp. 520, 521.

² Sec. 35 (4) and Rule 129. For Form TM No. 30, see Appendix, p. 760.

³ Rule 130.

⁴ Appendix, p. 699.

heard together and on the same evidence, the Court gave the certificate.¹

Moreover, where a certificate has been given, costs as between solicitor and client are recovered, subject to a certificate by the Court to the contrary, by the proprietor of the trade mark on obtaining a final order or judgment in any subsequent legal proceeding in which the validity of the trade mark comes into question. The old section only gave a right to such costs in subsequent actions for infringement, but it gave such right whether the validity again came into question or not, subject to the power of the Court to certify to the contrary.²

The giving of the certificate of validity is a matter of discretion,³ as is also the refusal of solicitor and client costs in the subsequent proceeding.⁴ A certificate that validity has come into question has in several patent cases been given where invalidity has been alleged in the defence and particulars of objections, notwithstanding that the defendant has not appeared at the trial.⁵ But where, on the hearing of an action for infringement and a motion to rectify, the defendant abandoned the motion as to one mark, a certificate as to that mark was refused under the circumstances of the case, it appearing that there was a fair question which might be raised at a future time as to some of the goods for which the trade mark was registered.⁶

“Subsequent legal proceeding” means one commenced after the date of the certificate of validity.⁷ The form of the certificate to be given under the new section is that the validity of the trade mark came into question and was decided in favour of the proprietor. This, however, is only a change of form.

¹ *Field, Ltd. v. Wagel Syndicate, Ltd.*, [1900] 1 Ch. 651; 17 R. P. C. 266, Buckley, J.; *Burroughs, Wellcome & Co. v. Thompson and Capper*, 21 R. P. C. 69 (1904), Byrne, J. See also *De Kuyper v. W. & G. Baird, Ltd.*, 20 R. P. C. 581 (1903), Porter, M.R., Ireland.

² Cf. the patent cases, *Welsbach Incandescent Gas Light Co., Ltd. v. Daylight Incandescent Mantle Co., Ltd.*, 16 R. P. C. 344, at p. 354, and the cases there cited. In several cases where the only question raised was infringement the full costs have been withheld: *Saccharin Corporation, Ltd. v. Dawson*,

19 R. P. C. at p. 173; *Edison Bell Consolidated Phonograph Co., Ltd. v. Waterfield Clifford & Co.*, 19 R. P. C. 329 (1902).

³ *Bourne's Tm.*, [1903] 1 Ch. 211; 20 R. P. C. 105, Farwell, J.

⁴ See the cases referred to in note (2).

⁵ E.g., in *J. B. Brooks & Co., Ltd. v. E. Lycett, Ltd.*, 20 R. P. C. 390 (1903).

⁶ *Bourne v. Swan and Edgar, Ltd.*, [1903] 1 Ch. 211; 20 R. P. C. 105.

⁷ *Automatic Weighing Machine Co. v. International Hygienic Society*, 6 R. P. C. 475 (1889).

The order granting a certificate is not appealable.¹

Certificates have been given under sec. 46 in some cases.²

Costs.³

The ordinary rule that the unsuccessful party must pay the costs of the proceedings is rarely departed from,⁴ and these costs include the Registrar's costs, if he think fit to appear. His costs are in the discretion of the Court, but he cannot be ordered to pay costs.⁵

The Court has, however, a discretion whether to give costs or not, and, in the exercise of this discretion, Kekewich, J., refused to give costs to a successful applicant who could not have been interfered with in the slightest degree in his business had he allowed the mark to remain unaltered;⁶ and costs were refused to applicants who had asked by their notice of motion not only for the expunging of the proprietor's name, but also for the entry of their own names on the Register, and they were ordered to pay the Comptroller's costs;⁷ and, in a case where the defendant in an action for passing off his goods as those of the plaintiff successfully applied to expunge the plaintiff's registered mark, North, J., reserved the costs of the application till after the hearing of the action.⁸ And where in a similar case the

¹ *Haslam v. Hall*, 5 R. P. C. 144 (1888), C. A.

² See, for instance, *Boord & Son v. Thom and Cameron, Ltd.*, 24 R. P. C. at p. 722; *Major Bros. v. Franklin*, 25 R. P. C. 406 (1908), Jelf, J.

³ See also Chap. IV., at p. 107, and Chap. XV., at p. 506.

⁴ *Hyde & Co.'s Tm.*, 7 C. D. 724 (1878); *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238, n. (1878), both Jessel, M.R.; and where the mark is expunged costs may be given not only against the registered proprietor, but against another person who has claimed to be interested in the mark and brought proceedings in consequence: *Davis' Tms.*, 14 R. P. C. 903 (1897), North, J. (*Compactum*). The general rule as to costs applies to applications to limit a registration as regards the goods; see, for instance, *Hare's Tm.*, 24 R. P. C. 263 (1907), Swinfen Eady, J.; and *Paine's Tms.*, 25 R. P. C.

329 (1909), Eve, J., where the respondents had made various offers to submit to some limitation, but these were held to have been insufficient. As to whether an order for rectification is a "final judgment" within sec. 4, subsec. 1 (8), of the Bankruptcy Act, 1883, cf. *Re Owen*, Sol. J., Vol. 45, p. 103, Dec. 8, 1900.

⁵ Sec. 48, see p. 681.

⁶ *Humphries v. Taylor Drug Co.*, 59 L. T. 820 (1888), Kekewich, J. (*Herbalin*); see also *Perry Davis' Tm.*, 5 R. P. C. 337; 58 L. T. 695 (1888), Kay, J.

⁷ *Harness' Tm.*, 17 R. P. C. 40 (1900), Farwell, J. The Comptroller is in the Act of 1905 referred to as the Registrar, sec. 4.

⁸ *Gianacis' Tm.*, 6 R. P. C. 467; 58 L. J. Ch. 782 (1889); and in *Thompson v. Miller*, 13 R. P. C. 35 (1896), Stirling, J., whilst giving the costs of the

plaintiff obtained an injunction against the defendant, on the ground of the fraudulent passing off of the latter's goods as his, and the defendant's motion to rectify failed, and was dismissed with costs at the trial, but, when urged on other grounds, succeeded in the Court of Appeal, no costs of the appeal on that point were given, because the objection was not urged in the Court below, and the rest of the appeal was dismissed with costs.¹

In *Hill's Trade Mark* the application to rectify was proceeded with at the applicant's instance, without waiting for the further investigation of charges of improper trading brought against him by the respondent, upon his undertaking not to ask for costs in any event.²

In *Talbot's Trade Mark*,³ where the application to rectify succeeded, no costs were given, because the applicant failed in regard to one of the grounds relied on, and he had delayed to move for three years.

Where the registration of a trade mark was upheld, but at the same time an injunction was granted against the owners to restrain them from using what was held to be a deceptive get-up, and it was held that the use of the trade mark had assisted deception, although it was not deceptive independently of get-up, the motion to rectify was refused without costs; and although, on appeal, it was held that the get-up was not calculated to deceive, and the injunction was dissolved, and a cross-appeal by the plaintiffs in the motion to rectify was dismissed with costs, no variation was made of the order below as to the costs of the motion.⁴

In a case in which an action for infringement and a motion to rectify were heard together, it was held that there was jurisdiction to deal with the costs of both together and divide the whole of them fractionally.⁵

motion to the defendant in the action, added a direction that such costs were not to include the costs of the affidavits used, except so far as should be directed at the trial.

¹ *Thompson v. Montgomery*, 41 C. D. 35; 6 R. P. C. 404 (1889), Chitty, J., and C. A. (*Stone Ale*).

² 10 R. P. C. 113 (1893), Chitty, J.

³ W. N. (1894), 12; 11 R. P. C. 77, Stirling, J. (*Emollivorum*).

⁴ *Coleman & Co., Ltd. v. Stephen Smith & Co., Ltd.*, [1911] 2 Ch. 572; 28 R. P. C. 645; 29 R. P. C. 81, Swinfen Eady, J., and C. A. There was apparently no appeal by the respondents as to the costs of the motion.

⁵ *Bourne v. Swan and Edgar, Ltd.*, [1903] 1 Ch. 211; 20 R. P. C. 105, following *In re Pollard* (1902), W. N. 49, Kekewich, J.

Where the respondents did not appear, and the notice of motion did not ask for costs, but in a letter prior to the motion the applicants had warned the respondents that they would ask for costs, the respondents were ordered to pay the costs.¹

Although Appendix N of the Rules of the Supreme Court does not provide for a fee for instructions on brief on an originating motion, the same can be allowed.²

As regards security for costs where the respondent is resident abroad, see above, p. 343.

Appeal.

An order made on an application under sec. 35 is a final order, and an appeal to the Court of Appeal against it must consequently be heard by not less than three judges,³ except under the Supreme Court of Judicature Act, 1899,⁴ by which the consent of all parties is requisite. The appeal must be brought within fourteen days, and must be by a fourteen days' notice of motion.⁵

Stay of
execution

The Court may stay execution of its order to rectify pending an appeal, and it will generally do so,⁶ but the appeal itself does not act as a stay.⁷ In *Re Palmer's Application*⁸ the Court of Appeal, having reversed the decision of the judge of first instance on a preliminary objection, refused to stay the proceedings before the judge on the merits pending an appeal to the House

¹ *North Shore Mill Co., Ltd.'s Tms.*, 22 R. P. C. 599 (1905).

² *Burroughs, Wellcome & Co.'s Tms.*, 22 R. P. C. 164 (1905), Warrington, J. This was under Ord. 65, r. 27 (29). In the same case the costs of three counsel at the trial and in the Court of Appeal were allowed, see below, p. 516.

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

⁴ 62 Vict. c. 6. As to the necessary consents, &c., see *Re Hope*, 43 Sol. J. 649; W. N. (1899), 113.

⁵ Ord. 58, rr. 3, 9 and 15; see *Re Blyth and Young*, 13 C. D. 416 (1879); and *Onslow v. The Commissioners of the Inland Revenue*, 25 Q. B. D. 465

(1890); and cf. *Arbenz's Tm.*, 35 C. D. 248; 4 R. P. C. 143 (1887), C. A., where it was held that an appeal on an application to proceed must be brought within twenty-one days (now changed to fourteen days, Orders of 1893).

⁶ *Harrison v. Woodroffe*, 7 R. P. C. 25; 42 C. D. 691 (1889), Kekewich, J.; see also *In re Tm. Bovril*, 13 R. P. C. 387; 74 L. T. 805 (1896), where Kekewich, J., said that if he had decided that the mark ought to be removed he should have stayed execution. In *Hommel v. Bauer & Co.*, 21 R. P. C. 576 (1904), Warrington, J., a stay was refused.

⁷ Ord. 58, r. 16.

⁸ 22 C. D. 88 (1882).

of Lords against their decision, and in *Neostyle Manufacturing Co.'s Trade Mark*¹ the Court of Appeal refused to stay their order expunging the mark pending an appeal to the House of Lords.

Security for costs of the appeal may be ordered under special circumstances.²

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

By sec. 32—

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

Correction of Register.

- (1) Correct any error in the name or address of the registered proprietor of a trade mark; or
- (2) Enter any change in the name or address of the person who is registered as proprietor of a trade mark; or
- (3) Cancel the entry of a trade mark on the Register; or
- (4) Strike out any goods or classes of goods from those for which a trade mark is registered; or
- (5) Enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of such trade mark.

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

This section deals with alterations of entries in the Register. Alterations in the registered trade mark itself are dealt with in sec. 34. The section corresponds to those parts of sec. 91 of the Act of 1883 which related to alterations of entries in the Register,³ namely (b) and (c), so far as relates to trade marks, but it is much wider. The sub-sections referred to enabled the Comptroller to (b) correct any clerical error in the name, style, or address of the registered proprietor of a trade mark;

¹ 20 R. P. C. 803 (1903). Cf. *Re Bayer's Design*, 24 R. P. C. 65 (1907), where a stay was ordered on terms. It appears from the report of *The Neostyle* case that there is no established practice at the office not to act, pending an appeal, on an order to remove a trade mark from the Register.

² Ord. 58, r. 15. Security was

ordered in *Re Tm. Bovril*, 13 R. P. C. p. 387. As to such security in the case of foreigners, see *supra*, pp. 343, 344.

³ Appendix, p. 704. The parts (a) and (d) of sec. 91, as amended by the Act of 1883, relating to correction and amendment of applications are now replaced by sub-sec. (6) of sec. 12.

(c) cancel the entry or part of the entry of a trade mark on the Register.

Sub-sec. (b) only related to errors, and not to changes, of name or address. Changes of address were, however, provided for by Rule 48 of 1890. Clause (2) of the new section now expressly authorises the entry of change of the name or address of the registered proprietor.¹ Changes of proprietorship come under sec. 33, and not under this section. Clauses (3), (4) and (5) deal with cancellations and alterations in the registration, either annulling in whole or in part, or altering without extending, the rights of the registered proprietor arising out of the registration. Where a registered proprietor finds that he cannot support the registration as it stands, it is often expedient for him, especially if threatened with a motion to rectify,² to cancel his mark, or, as the present section enables him to do, to apply to confine the registration to part only of the goods for which it is registered, or to enter a disclaimer or memorandum. Non-user in connection with any of the goods for which a trade mark is registered may form a ground for removing the trade mark from the Register in respect of such goods.³

Disclaimers may be required on the original registration of a trade mark or as a condition of its remaining on the Register, *e.g.*, when an application is made to remove it.⁴ "Memorandum" seems to contemplate some entry not a disclaimer, *e.g.*, a note better defining the rights covered by the trade mark, or possibly the entry of a condition which might have been required on the application to register.⁵

Where the registered proprietor is desirous of cancelling the mark only with a view to another registration, as, for instance, a registration on dissolution of partnership, the existing registration being an obstacle to the intended registration, it is doubtful whether he could make an application under sub-sec. (3) for the cancellation conditionally on the other registration being effected; but in the course of the proceedings for registration of the new mark the result might perhaps be arrived at, assuming no other objection to be taken by the Registrar, by an acceptance

¹ In *New Ormonde Cycle Co.'s Tm.*, [1896] 2 Ch. 520; 13 R. P. C. 475, North, J., held that on a change of name of a company the Comptroller could enter the new name on the Register, and, if he refused, the Court

could make the alteration.

² Sec. 35, above, p. 311.

³ Sec. 37, above, p. 327.

⁴ Sec. 15, above, p. 236.

⁵ Sec. 12 and sec. 14, above, pp. 71 and 93.

of the mark conditional on the proper application for cancellation being made.¹

The rules in regard to matters under this section are Rules 82 and 90 to 92.² An application for a disclaimer or memorandum is to be advertised in order to enable any person desiring so to do to state in writing any reasons against the applicant being allowed to make such disclaimer or memorandum.³ An application may be made under the section by the trustee in bankruptcy or liquidator (as the case may be) of the registered proprietor;⁴ but applications on changes of proprietorship come under sec. 33. If a mark is removed from the Register, a record is to be entered of such removal and of the cause of it.⁵

There is a right of appeal to the Board of Trade,⁶ but there is no right of appeal to the Court,⁷ although the Board may refer the appeal to the Court under sec. 59.

3. Alteration of a Registered Trade Mark.

Sec. 34 provides that—

Sec. 34.

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

This section relates to alterations in the mark itself, and does not extend to alterations in the Register,⁸ to which matter sec. 32 relates.

¹ The matter was considered in *Ehrmann's Tms.*, [1897] 2 Ch. 495; 14 R. P. C. 665, where the Comptroller refused to accept an undertaking to cancel the existing marks. See now sec. 12 (2).

² Appendix, pp. 730, 731. Forms, on change of address, TM No. 20; for correction of clerical error, TM No. 22; on change of name, TM No. 23; for cancellation of entry, TM No. 24; on

application to strike out goods, TM No. 25; on request to enter disclaimer, &c., TM No. 26; pp. 752 *et seq.*; fee in each case, 5s.

³ Rule 92.

⁴ Rule 90.

⁵ Rule 74.

⁶ See p. 351.

⁷ Sec. 54.

⁸ *New Ormonde Cycle Co.'s Tm.*, [1896] 2 Ch. 521; 13 R. P. C. 475,

Act of 1883.

The corresponding section of the Act of 1883 was sec. 92, from which two important changes have been made.¹ In the first place, under that section the Court alone had power to make an alteration in a registered trade mark, whereas under the Act of 1905 the Registrar has jurisdiction, and the Board of Trade on appeal from him. The Court has no jurisdiction, under sec. 34, except where an appeal to the Board of Trade is referred to the Court.² But it has on an application under sec. 35 power to vary the entry on the Register to which the application relates.³ Secondly, a much wider power of altering a registered trade mark is conferred on the Registrar than was given to the Court under the old section, which excepted essential particulars from the part of a trade mark which might be varied.⁴

Section 34 allows alterations in the trade mark itself, notwithstanding that the change of an essential particular is involved. But the addition or alteration must not substantially affect the identity of the trade mark.

Old marks.

Under the repealed Acts it was more difficult to obtain the alteration of a trade mark registered as an "old mark," *i.e.*, as used before August 13th, 1875, than of a new mark; and this may still be the case. The policy of the Acts has always been that old marks should be registered and kept registered substantially as they were used before the date mentioned.⁵ In the absence of special circumstances therefore no alteration at all should be permitted.⁶ The power to allow alterations is, however, in both cases subject to precisely the same limitation, which is also embodied in sec. 9.⁷ That section allows an old mark to be registered "either in its original form or with additions or alterations not substantially affecting

North, J., under the Act of 1883. See also *National Wholesale Tea Supply Association*, 10 R. P. C. 164 (1893), Chitty, J.; and *Patent Plumbago Crucible Co.'s Tms.*, 7 R. P. C. 282 (1890), Stirling, J.

¹ See the section below, p. 704.

² Sec. 59, below, p. 684.

³ Above, p. 320.

⁴ Essential particulars, sec. 9, above, p. 142. See *Hammond and Stow's Tm.*, 22 R. P. C. 299 (1905), where the Comptroller objected to the addition of

"Limited" to a signature, which was an essential particular, and no such alteration was made. Cf. *Guinness & Co.'s Tm.*, 5 R. P. C. 316 (1888) (an old mark) and *Hayward & Sons' Tms.*, 13 R. P. C. 729 (1896).

⁵ *Phillips' Tms.*, [1891] 3 Ch. 139; 8 R. P. C. 469, Chitty, J.; *Adams' Tms.*, 9 R. P. C. 174; 66 L. T. 610 (1892), Kekewich, J.

⁶ *Re Henry Clay*, [1892] 3 Ch. 549; 9 R. P. C. 449, Kekewich, J.

⁷ Above, p. 137.

the identity of the same." This corresponds to the words of sec. 34.¹

The more restricted operation of sec. 92 of the Act of 1883 in regard to old marks was partly due to the fact that old marks registered under sec. 64 (3) (ii.) of the Act, like old marks registered under sec. 9 of the Act of 1905, had no "essential particulars" necessarily, but were registered, if distinctive, as a whole, so that in regard to them "essential" in sec. 92 had to be read as equivalent to "substantial"² or "material." The following are instances of alterations in old marks allowed or disallowed by the Court under the Act of 1883. The Court has authorised the addition of the word *limited* to an old mark where the proprietors had assigned their rights to a company bearing their old firm name with that addition;³ and has permitted the name of certain works abandoned by the proprietors to be struck out, and the name of other works retained by them to be printed in a different position in the registered mark;⁴ and has allowed the addition of *and Son* to a name, and the substitution of new addresses for former ones;⁵ and the alteration of a firm name;⁶ and in *Orlando Jones & Co.'s Trade Marks*,⁷ it allowed certain words to be added to two marks registered as old marks. Minor alterations have also been permitted.⁸ But the Court has refused to expunge *trade mark* so printed upon a label as to suggest that part only of the matter of the label was the trade mark,⁹ in a case where the mark had stood for twelve years on the Register;¹⁰ or to strike out *patent* printed as part of the

"Trade mark."

"Patent."

¹ Cf. sec. 26 (c) and sec. 27.

² *Adams' Tms.*, 9 R. P. C. 174; 66 L. T. 610 (1892), Kekewich, J.; cf. per Ld. Cairns in *Orr-Ewing v. The Registrar of Tms.*, 4 App. Ca. p. 484 (1879).

³ *Guinness & Co.'s Tm.*, 5 R. P. C. 316 (1888), Chitty, J.

⁴ *Burham Brick, &c. Co.'s Tm.*, 9 R. P. C. 422 (1892), Stirling, J.

⁵ *Brown's Tms.*, 11 R. P. C. 365; 71 L. T. 156 (1894), Stirling, J. The Comptroller objected to mere striking out, so as to leave blank spaces. Also *Cockle's Tm.*, 20 R. P. C. 353 (1903), Farwell, J. In this case the order was, at the instance of the Comptroller, made in the form of allowing alterations as shown on an exhibited label, and on an undertaking to supply the Comp-

troller with a block of the mark as altered; see Rule 94, below, p. 731. This form of order was followed in *Davenport's Tm.*, 21 R. P. C. 726 (1904), Joyce, J.; Appendix, p. 808.

⁶ *Maw, Son and Thompson's Tm.*, 19 R. P. C. 260 (1902), Buckley, J.

⁷ 12 R. P. C. 278 (1895), Stirling, J. The words added were: "This label is issued only by *Orlando Jones & Co., Ltd.*" There appears to have been no opposition by the Comptroller. Presumably the marks had been used with these words, but *query* as to this.

⁸ *E.g.*, in *Davenport's Tm.*, above, note (5).

⁹ See Chap. X., at p. 303.

¹⁰ *Phillips' Tm.*, *supra*. This alteration was allowed in the case of a new

name of the goods upon a label, there being in fact no letters patent;¹ or to substitute the name of one former proprietor of a mark for that of another in the mark.² And in a mark consisting partly of Russian characters, alterations in the words on the mark, which were held to be alterations so material as possibly to prevent persons in England recognising it, were refused.³

Decision under Act of 1905.

"Royal."

The only reported decision under the Act of 1905 as to alteration of an old mark is that in *Carron Company's Tms.*⁴ The applicants proposed to add the word "founded" above the date "1759" which already appeared in the mark, to delete the word "Carron" which appeared underneath the rest of the mark, and to surround the mark with an oval ring containing the words "Carron Company incorporated by Royal Charter, 1773." The Registrar objected only to the third alteration, and refused it on the ground of the presence of the word "Royal." The applicants appealed, but the appeal was dismissed. The Court held on the construction of Rule 12 that that Rule contained a prohibition against registration as a part of a mark of the word "Royal," and that the prohibition was not limited to cases where the description was erroneous; and further that the saving contained in sec. 68 as to old marks did not apply, for as regards the alteration the mark was a new one; and further, that the proper legal designation of the applicants was "Carron Company" and not, as had been contended, "Carron Company—incorporated by Royal Charter."⁵

Alterations allowed in new marks.

In a case in which the registration of a new mark was objected to on the ground of its resemblance to a registered trade mark,

mark in *Colman's Tms.*, [1891] 2 Ch. 402; 8 R. P. C. 209, by Kekewich, J., the proprietors of the mark undertaking to register a statement of the essential particulars of their marks and to disclaim the remainder of them. A similar condition for certain alterations in a new mark was made in *Orlando Jones' Tms.*, 12 R. P. C. 278 (1895), Stirling, J. Such statements are not now required in applications to register, as they were under the Act of 1888.

¹ *Adams' Tm.*, supra, note (2), p. 355. It appears from the report of *Hubbuck v. Brown*, 17 R. P. C. 148 (1899), Kekewich, J., that in 1879 an order had

been made for rectification of an old trade mark appearing in the report by entry of a disclaimer of the exclusive right to the words *White Zinc and Patent*, and the Royal Arms.

² *Re Henry Clay*, p. 354, note (6).

³ *Savin's Tm.*, 13 R. P. C. 21 (1896), North, J.

⁴ 27 R. P. C. 412 (1909), Swinfen Eady, J.

⁵ The Court intimated that the Registrar would probably see no objection to adding after the words "Carron Company," the words "Incorporated by Charter, 1773," or "Charter of Incorporation, 1773."

the judge, in deciding against the mark applied for, referred to the possibility of alteration in non-essential particulars.¹

No alteration to the prejudice of other registered proprietors, or such as to cause the altered entry to infringe the restrictions of the Acts, can be allowed. Thus, in *Reiss' Trade Mark*,² the applicants, having a registered combination device trade mark bearing the words *Grass Bleach, Best Quality*, and having ceased to use the method of grass bleaching, desired to substitute for *Grass* their own trade name, *Reiss*. The Comptroller required³ them to inform the Court that there were certain other trade marks containing the name *Reiss*, and North, J., refused to grant the application until he was satisfied that the altered mark would bear no resemblance to any of the marks referred to.

None allowed to the prejudice of other persons.

Amongst the alterations allowed in reported cases under the repealed Acts are the addition of *limited* to a name;⁴ the correction of an English letter printed by mistake for a Russian letter;⁵ the omission of certain words;⁶ the alteration of the name of the proprietor's works or place of business;⁷ the substitution of the initials of the new name of a limited company for those of its former name;⁸ the substitution of certain words so as to change the old name of a limited company to its new name, such name not being printed in a particular or distinctive manner.⁹ An application to omit two oval lines from a trade mark was, in one case, refused, the Comptroller contending that the mark was a combination mark,¹⁰ and the addition of the words "superior quality," which were alleged to have been omitted on

Instances of alterations.

¹ *Murphy's Tm.*, 7 R. P. C. 163 (1890), Stirling, J.

² 5 R. P. C. 291 (1888), North, J.

³ He consented not to appear on their undertaking to read his letters in the matter to the Court.

⁴ *Bryant and May's Tm.*, 4 T. L. R. 675 (1887), Stirling, J.; *Guinness & Co.'s Tm.*, 5 R. P. C. 316 (1888), Chitty, J.; *Burke's Tms.*, W. N. (1891) 2, North, J.; *Hayward & Sons' Tms.*, 13 R. P. C. 729 (1896), Stirling, J., but *Ltd.* was refused. *Holbrook's Tms.*, 18 R. P. C. 447 (1901), Cozens-Hardy, J. See also *Hammond and Stow's Tm.*, 22 R. P. C. 299 (1905), Farwell, J.

⁵ *Ermon and Roby's Tm.*, 4 R. P. C. 70; 56 L. J. 177 (1886), Chitty, J.

⁶ *Burke's Tms.*, supra, note (4).

⁷ *Burham Brick, & Co.'s Tm.*, 9 R. P. C. 422 (1892); *Brown's Tms.*, 11 R. P. C. 365 (1894), both Stirling, J.

⁸ *National Wholesale Tea Supply Association, Ltd.'s Tms.*, 10 R. P. C. 164 (1893), Chitty, J.

⁹ *Stock-Owners' Meat Co. of New South Wales, Ltd.'s Tms.*, 14 R. P. C. 733 (1897), Romer, J. The company under its new name appears to have been registered as proprietor. See the practice laid down in *New Ormonde Cycle Co.'s Tm.*, [1896] 2 Ch. 520; 13 R. P. C. 475; and supra, p. 351.

¹⁰ *Orlando Jones & Co.'s Tms.*, 12 R. P. C. 278 (1895), Stirling, J.

registration by the applicant's mistake, was refused, except on certain conditions as to disclaimer,¹ the mark having been registered for eighteen years.

When a limited company, which is the registered proprietor of a trade mark, changes its name, it should apply to the Registrar, under sec. 32, to make the necessary alteration in the Register, and should not, where no alteration in the mark itself is desired, apply to the Registrar under sec. 34.²

If a proprietor wishes to continue the registration and use of the unaltered mark he can apply to register the altered mark as an associated trade mark.³

Procedure.

The procedure under sec. 34 is regulated by Rules 93 and 94.⁴ The application for alteration must be made on Form TM No. 27,⁵ and the applicant must furnish the Registrar with six copies of the mark as it will be when altered. The Registrar may also require the applicant to furnish a block for the purpose of advertisements, and may advertise the fact of the application having been made. No procedure as to opposition is, however, provided by the section or rules. The only course therefore for a person thinking himself aggrieved by a proposed alteration is to submit his reasons to the Registrar,⁶ or, if the alteration is allowed, to apply to the Court under sec. 35 for rectification. Advertisement of the trade mark after leave has been given is required by the section and provided for in Rule 94. The Registrar may refuse the application or may grant leave to alter the trade mark on such terms as he may think fit.

Appeal.

The only appeal against a refusal by the Registrar to allow the alteration or against conditions imposed by him is to the Board of Trade, but the latter can, under sec. 59,⁷ refer the appeal to the Court.

¹ See supra, p. 355, note (10).

² *New Ormonde Cycle Co.'s Tm.*, [1896] 2 Ch. 520; 13 R. P. C. 475, North, J.; decided under the Act of 1888, and see supra, p. 351.

³ Sec. 24, above, p. 116.

⁴ Appendix, p. 371.

⁵ Appendix, p. 754. Fee £1 for first mark, 10s. for every other mark if the addition or alteration is the same in each case.

⁶ Cf. Rule 92.

⁷ Below, p. 684, and see sec. 54.

CHAPTER XII.

EFFECT OF REGISTRATION.

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Object of the Acts.

THE general object of the Registration Acts was not to create new rights, but to regulate the use of, and the means of protecting, trade marks.¹ Their main effects, however, have been (1) to provide a new way in which title to a trade mark may be acquired, namely, by registration; (2) to simplify infringement actions, by making registration evidence, and, under certain circumstances, conclusive proof of title; and (3) to constitute registration, in general, a condition precedent to an action for infringement. The first of these changes was a substantive alteration of the old law.

The Acts have also defined and limited the classes of symbols which can be registered as trade marks,² and thereby, as a consequence of the third alteration just referred to, have restricted the number of marks in which trade mark rights can, as such, be effectively protected.³

1. Title to New Trade Marks conferred by Registration.

Title to new mark.

Registration, if properly made in accordance with the Acts,⁴ confers upon the registered proprietor trade mark rights in the registered mark in respect of the goods for which it is registered and upon which it is used, subject (1) to the rights appearing from the Register to be vested in any other person;⁵ (2) to rights conferred by concurrent registrations;⁶ (3) to the rights of persons who have used their marks before the user of the registered trade marks;⁷ (4) until the expiration of the period mentioned in sec. 41, to the conflicting rights of any other person in the same mark.⁷ And the rights so acquired date back to the date of the application to register.

Trade mark acquired by user before registration.

As registration gives an independent title, the owner of trade mark rights acquired by user, when he has registered his mark, will only need to avail himself of his earlier title if the propriety of the registration is questioned, or if, within the period mentioned in sec. 41, conflicting rights to the marks are set up.

Before the Acts (except in the case of Sheffield cutlers' marks) user of the mark was the only way in which trade mark rights in it could be acquired.⁸

¹ *Lyndon's Tm.*, 32 C. D. p. 117; 3 R. P. C. 102 (1886), per Cotton, L.J.

² Chap. VIII., p. 135.

³ As to this, see below, p. 378.

⁴ Chap. VIII., p. 135.

⁵ Sec. 38; Act of 1883, sec. 87; see

Mitchell's Tm., 28 C. D. 666 (1885), Chitty, J., and p. 363.

⁶ Proviso to sec. 39; see also sec. 21, above, p. 294.

⁷ Proviso contained in sec. 41.

⁸ Chap. II., p. 23.

A serious question arose on the construction of the original Act, of 1875, as to whether new marks which had never been used could be registered under it;¹ but the view expressed above, that the Act created a new mode of acquiring trade mark rights, which had been acted upon from the first, was finally affirmed in *Hudson's Trade Marks*.² "In my opinion," Cotton, L.J., said in that case, "the language (of the Act), though not appropriate, means this, that a man who designs one of those special things pointed out in sec. 10³ is, as designer, to be considered as the proprietor of it, and if there is no one else who has used it, or who can be interfered with by the registration and subsequent assertion of title to the mark, then he is to be considered as entitled, within the meaning of the Act, to the exclusive use of that which, in fact, has never been in any way used, but which has only been designed by him, and which he can be treated as the person entitled to register, if no one else had so used it, as that his user would be interfered with by the registration."⁴

New and unused trade marks may be registered.

Act of 1875.

Hudson's case.

The point decided in *Hudson's case* was provided for in the Act of 1883⁵ by sec. 75, which enacted that—

Acts of 1883 and 1888.

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

The words included in the brackets were added by the Act of 1888⁶ upon the recommendation of Lord Herschell's Committee.⁷ The alteration was merely directed to give legislative authority to the rule already in force.

Any other construction of the Acts would have led to very strange results, for no length of user was required to be shown in the actions or suits for infringement before the Acts.⁸

But it was held under the Acts of 1883 and 1888, that although actual use of the mark was not a condition precedent to

Applicant for registration must intend to use the mark.

¹ See *Edwards v. Dennis*, 30 C. D. 454 (1885); *Lyndon's Tm.*, 32 C. D. 109; 3 R. P. C. 102 (1886), both C. A.

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

³ *I.e.*, of the Act of 1875.

⁴ See per Chitty, J., in *Barlow v. Johnson*, 7 R. P. C. at p. 404 (1890).

⁵ The case was decided, however, in 1886, after the passing of the Act of 1883.

⁶ Sec. 17.

⁷ Report of 1888, p. 13.

⁸ See Chap. II., at p. 36.

registration, the applicant must intend to use it for the goods for which it is to be registered, and that if he registered without such an intention the mark ought to be removed from the Register. Thus, where two marks had been registered for goods in class 42 for many years, but, on an application to remove them, Romer, J., found that there had been no real user before registration, and that there had been no real user in respect of such goods since registration, and that at the date of the registration there was no *bonâ fide* intention on the part of the applicants to so use the marks, he ordered the marks to be removed, and the decision was upheld by the Court of Appeal and the House of Lords.¹ Lindley, M.R., who delivered the judgment of the Court of Appeal, said: "Although sec. 75 of the Act of 1883 said that 'registration of a trade mark shall be equivalent to public use of the trade mark,' this language, even when in force, did not and could not mean that continued registration was equivalent to continued use. So to construe the language would lead to the irrational conclusion that a man might properly register a trade mark for any goods he chose, although he carried on no trade or business in them at all. . . . Section 75 was addressed to the time of registration; it substituted registration for previous user and reputation gained by it." And it was pointed out that the alteration of the section by the Act of 1888 made the matter still plainer. The subject of non-user is now dealt with in sec. 37 of the Act of 1905.²

Act of 1905.

The Act of 1905 contains no provision corresponding to the first part of sec. 75, but the definition for the purposes of the Act of a "trade mark" contained in sec. 3 includes a mark "proposed to be used" as well as a mark used, so that it is clear that the acquirement by registration of a trade mark not actually used before registration is authorised; and this is effected in a simpler manner than under sec. 75 of the Act of 1883.

Date of registration.

By sec. 16 of the Act of 1905, a trade mark, when registered, shall be registered as of the date of the application for registration, and such date is to be deemed for the purposes of the Act to be the date of registration. This corresponds to the last part of sec. 75, which, as already stated, was introduced by the Act of

¹ *Batt & Co.'s Tms.*, [1898] 2 Ch. 432; 15 R. P. C. 262, 534, in H. of L. (*sub nom. Batt & Co. v. Dunnett*), [1899] A. C. 428; 16 R. P. C. 411. See also *Edwards v. Dennis*, 30 C. D. 454

(1885); *Apollinaris Co.'s Tms.*, [1891] 2 Ch. p. 234; 8 R. P. C. 137; and *Hedley's Tms.*, 17 R. P. C. 719 (1900).

² Above, p. 327.

1888. Sec. 16, however, only applies to trade marks registered under the Act of 1905. As regards trade marks on the Register existing at the commencement of the Act and incorporated with the new Register, it is expressly provided that such trade marks shall retain their original date.¹

2. Registration as Evidence of Title.

This subject was dealt with in sec. 76 of the Act of 1883, Act of 1883, which provided that the registration of a person as proprietor of a trade mark should be *primâ facie* evidence of his right to the exclusive use of the trade mark, and should, after the expiration of five years from the date of registration, be conclusive evidence of his right to the exclusive use of the trade mark, subject to the provisions of the Act.

The most important of the provisions of the Act of 1883 referred to were the sections which enabled a second person who had an independent title to an old mark identical with or similar to a mark already registered, to be registered as proprietor of it;² the provision of sec. 65 that a trade mark must be registered for particular goods; the provision of sec. 70 for the assignment of registered marks in connection with the goodwill of the business to which they belong; and the provision of sec. 90 for the rectification of the Register. The operation of the last-mentioned section was to diminish very considerably the value of five years' registration as conclusive evidence of title.³

The Act of 1905 contains new provisions on the subject, namely, secs. 39, 40 and 41, differing considerably in substance from those of the Act of 1883, and being differently planned. Section 39 deals with the rights of the proprietor of a registered trade mark arising out of registration, if valid, and secs. 40 and 41 with the fact of registration being evidence, *primâ facie* or conclusive, of the validity of the registration.

Section 39 is as follows:—

“Subject to the provisions of section forty-one of this Act and to any limitations and conditions entered upon the Register, the registration of a person as proprietor of a trade mark shall, if valid, give to such person the exclusive right

Rights of proprietor of trade mark.

¹ Sec. 6.

² Secs. 62, 71, and 72 (1); *Jackson v. Napper*, 35 C. D. 162; 4 R. P. C. p. 55 (1887), *Stirling, J.*; and see *Mouson v.*

Boehm, 26 C. D. 398, cited below, p. 413, and the “three mark rule,” Chap. X., at p. 249.

³ Above, p. 323.

to the use of such trade mark upon or in connection with the goods in respect of which it is registered: Provided always that where two or more persons are registered proprietors of the same (or substantially the same) trade mark in respect of the same goods no rights of exclusive user of such trade mark shall (except so far as their respective rights shall have been defined by the Court) be acquired by any one of such persons as against any other by the registration thereof, but each of such persons shall otherwise have the same rights as if he were the sole registered proprietor thereof."

Registration is evidence of title. The phrase now used is that it gives the right "if valid," but by sec. 40 registration is *prima facie* evidence of the validity of the original registration, and by sec. 41, after seven years¹ the validity of that registration can only be attacked on the ground that it was obtained by fraud, or that the use of the mark is calculated to deceive or disentitled to protection in a Court of Justice. It would appear, therefore, that the onus of showing that the registered proprietor has no title, even within the seven years, rests upon any person denying it.² Under the old practice, a defendant in an action for infringement of a registered trade mark who sought to dispute the plaintiff's title applied to rectify the Register; and the same practice prevails under the Act of 1905.

The title obtained by registration is, of course, of the essence of the Act. Before registration was inaugurated, it was practically possible for a trader to protect his trade mark by calling evidence to show that the use of the mark by the defendant was calculated to pass off the defendant's goods as his goods, and this is still possible, and is often done, where the mark in question is not registered.³ But the evidence to be adduced on behalf of the plaintiff in such an action must often be elaborate and expensive, and is sometimes difficult to procure, while if the registration is properly effected, all that is necessary is to produce the Registrar's certificate.

Limitations
on rights.

The right of exclusive use conferred by registration is subject to the general proviso to sec. 41 in favour of any person who has used a similar mark before the use of the registered mark by the

¹ That is, from the date of original registration or from the passing of the Act, whichever shall last happen.

² Below, p. 367.

³ Sec. 45, below, p. 377.

proprietor or his predecessor in business.¹ A trade mark may be registered subject to conditions,² and in some cases, at all events, to limitations;³ and, if so registered, the rights conferred are limited in a corresponding manner.

Section 39 confines the rights conferred by it to use of the trade mark upon or in connection with the goods in respect of which it is registered. Although the old sec. 76 did not specify what was the extent of the exclusive right conferred, yet it was well settled that registration conferred no rights except in regard to the goods for which the mark was registered, whether that was the whole or only part of a register class,⁴ and if the registration was limited by a note entered on the Register to some only of the goods which would be otherwise included under it, the rights conferred were limited also in the same way.⁵ There is thus no alteration of the law in this respect. Sec. 39 is limited by the words "if valid"; so far as the trade mark is not protected by sec. 41 from an application for rectification, an application may be made either to remove the trade mark wholly or partially or to limit the entry as regards the goods for which it is registered, or otherwise vary the entry. Among other grounds for rectification is that under sec. 37 of non-user in respect of any of the goods for which the mark is registered. In substance, therefore, the exclusive right under sec. 39 is limited to goods in respect of which the trade mark is not open to attack under sec. 37, but an application to rectify may be necessary.⁶ It was held under the repealed Acts that if a mark were actually used for certain descriptions of goods only, although registered for others also, the exclusive rights conferred by sec. 76 did not extend to the latter. Thus, where the plaintiff in an action was the assignee of a mark registered for "unwrought and partly wrought metals used in manufacture," and, in fact, he only used it upon sheet iron goods, his business being confined to

Right limited to goods for which the mark is registered.

Registration restricted to goods for which the mark is used. *Edwards v. Dennis.*

¹ Below, p. 369.

² Sec. 12 (2) and (4), sec. 14 (4) and (6), sec. 21.

³ Sec. 21.

⁴ *Hart v. Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J. The right of opposing an application for registration of another mark extends, however, to the same description of goods, above, Chap. X., at p. 252.

⁵ *Jay v. Ladler*, 40 C. D. 649; 6

R. P. C. 136 (1889), Kekewich, J. In this case, besides the ordinary injunction to restrain infringement on the goods for which the mark was registered, the plaintiff obtained an injunction to restrain the defendant from using the plaintiff's trade mark, on other goods, so as to deceive. The head-note is too loosely stated.

⁶ Sec. 37 is set out and considered above, p. 327.

such goods, and the defendant was the agent of the proprietors of a similar mark subsequently registered for steel and iron wire, and had sold wire with the latter mark upon it, it was held that the plaintiff had no cause of action, and an order was made that the registration of the plaintiff's mark should be rectified by confining it to sheet iron.¹ In the case just cited the plaintiff was assignee of the registered mark, and the decision turned to some extent upon the rule that a registered mark can only be assigned in connection with the goodwill of the business concerned in the goods for which it has been registered,² the plaintiff's business being confined, as already stated, to sheet iron goods; but all the judges in the Court of Appeal indicated an opinion that the rights of the original registered proprietor would in any case have been limited by his actual user of the mark.³ This opinion was subsequently adopted and followed by Chitty, J., in the case of *Hargreaves v. Freeman*;⁴ and in *Batt & Co.'s Trade Marks*,⁵ the Court of Appeal considered that the principle of the decision in *Edwards v. Dennis* was that the original proprietor ought not to have registered the mark for goods with which he had no concern, and, applying it to the case before them, they upheld the removal of certain marks from the Register on the ground that there had been no user and no intention to use them.⁶

However, it will probably be held that the right to apply for rectification on the ground of non-user is confined under the Act of 1905 to the cases specified in sec. 37, and the question may arise in an action for infringement whether the defendant can set up by way of defence a non-user which would not afford ground for rectification of the Register. The solution, perhaps, of the question would be found in refusing under the general discretion of the Court an injunction to restrain a use of the mark which could not possibly damage the plaintiff.⁷

Section 39 confers the exclusive right to the use of the trade mark upon or "in connection with" the goods in respect of which it is registered. "In connection with" may refer to a physical

Upon or in connection with the goods.

¹ *Edwards v. Dennis*, 30 C. D. 454 (1885), C. A.

² Sec. 70 of the Act of 1883. Sec. 22 of the Act of 1905.

³ And see *Hudson's Tm.*, 32 C. D. at p. 319 (1886), and *supra*, p. 361.

⁴ [1891] 3 Ch. 39; 8 R. P. C. 237.

⁵ Cited *supra*, note (1), p. 362.

⁶ The decision was affirmed in the House of Lords. See *supra*, note (1), p. 362.

⁷ See the cases above cited, and particularly *Hargreaves v. Freeman*, note (4).

connection, but it is submitted that it means any such use as indicates that the goods are the goods of the proprietor, whether the mark is attached to the goods or used in invoices, trade descriptions or advertisements.¹

The proviso to sec. 39² follows the provision for the concurrent registration of identical, or nearly identical, marks which is contained in secs. 19 to 21, and it is substantially new. Before the Acts and apart from them, each of two persons who were entitled to the same mark could sue an infringer for an injunction,³ but if the plaintiff claimed on account of profits he was only entitled to the share appropriate to his own interest in the mark.⁴ Although the present section says expressly that each proprietor shall have the same rights as if he were the sole registered proprietor, the old ruling as to profits ought, it is submitted, to be maintained. The right of a successful plaintiff in an action for infringement of trade mark or for passing-off to elect between profits or damages has been affirmed by the House of Lords.⁵

Section 39 is also to be read in conjunction with sec. 44, which provides that no registration under the Act shall interfere with any *bonâ fide* use by a person of his own name or place of business, or that of any of his predecessors in business, or the use by any person of any *bonâ fide* description of the character or quality of his goods.⁶ Sec. 44.

By sec. 40—

“In all legal proceedings relating to a registered trade mark (including applications under sec. 35 of this Act) the fact that a person is registered as proprietor of such trade mark shall be *primâ facie* evidence of the validity of the original registration of such trade mark and of all subsequent assignments and transmissions of the same.”

Registration
to be *primâ
facie* evidence
of validity.

This section corresponds to the first part of sec. 76 of the Act of 1883, which provided that the registration of a person as proprietor of a trade mark should be *primâ facie* evidence of his right to the exclusive use of the trade mark; except that now by sec. 40 registration is made *primâ facie* evidence of its validity,

¹ See below, Infringement, pp. 431 below, p. 427.
et seq.

⁴ *Dent v. Turpin*, above.

² Above, p. 364.

³ *Weingarten Bros. v. Bayer & Co.*, 22 R. P. C. 341 (1905).

⁵ *Dent v. Turpin*, 2 J. & H. 199; 30 L. J. Ch. 495 (1861), *Wood, V.-O.*, and

⁶ Below, p. 443.

and if the registration be valid, the right to the exclusive use follows by virtue of sec. 39.

The main purpose of sec. 40 is to facilitate the proof of title by a plaintiff suing for an alleged infringement of his mark; in place of the evidence of user and reputation, by which he would have had to show his right to the mark before the Acts, he has only to produce his certificate¹ of registration of his mark, and that will be *primâ facie* evidence of his title.²

Registration
primâ facie
valid in appli-
cation for
rectification.

Evidence
rebutted by
the plaintiff's
own case.

Registration is also *primâ facie* evidence in applications under sec. 35, that is to say, applications to rectify the Register, so that the onus is thrown on an applicant.³

The evidence afforded by the registration may be rebutted, if the registration is less than for the period named in sec. 41, that is, seven years from original registration or from the passing of the Act,⁴ whichever shall last happen. Under the Act of 1883 the period was five years.⁵ Thus, in the case just cited,⁶ the plaintiffs were not content to rest their title, as in the first instance they might have, merely upon the registration, but they set out in their pleadings the steps by which they alleged that the trade mark in question had been transferred to them, and thereby showed that the original proprietors of the mark, and of the cigar factory and business in connection with which it had been acquired, had purported to assign the trade mark without assigning the goodwill of the business. It followed, therefore, that the assignment was a nullity,⁷ and, as the registration was less than five years old, the *primâ facie* title conferred by it was consequently rebutted by the evidence furnished by the plaintiffs' own case.

Registration
to be con-
clusive after
seven years.

Sec. 41 provides as follows:—

“In all legal proceedings relating to a registered trade mark (including applications under section thirty-five of this Act) the original registration of such trade mark shall after the expiration of seven years from the date of such original registration (or seven years from the passing of this Act,⁴

¹ Sec. 51, rule 102, Form TM No. 84, below, pp. 682, 733, 761.

² *Pinto v. Badman*, 8 R. P. C. 181 (1889), C. A.

³ Above, p. 323.

⁴ August 11th, 1905.

⁵ Sec. 76. Thus, in *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., held that the words *Self*

Washer, although they had been two years on the Register, were not a trade mark. The case nevertheless succeeded on the ground of passing-off. See further the chapter on infringement, p. 430, note (2).

⁶ *Pinto v. Badman*, above, note (2).

⁷ Sec. 70 of the Act of 1883.

whichever shall last happen) be taken to be valid in all respects unless such original registration was obtained by fraud, or unless the trade mark offends against the provisions of section eleven of this Act:

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

This section replaces the last part of sec. 76 of the Act of 1883, which provided that the registration of a person as proprietor of a trade mark should, after the expiration of five years from the date of registration, be conclusive evidence of his right to the exclusive use of the trade mark, subject to the provisions of that Act.

Section 41 effects one of the most important changes made by the Act of 1905. Although the old sec. 76 in terms provided that registration should be conclusive after five years, the provision was construed to be subject to the liability to removal from the Register under the rectification section.¹ The consequence of this was that an application to rectify the Register became part of the regular course of the defence of an action for infringement. This is now altered, and after seven years the original registration is to be treated as valid, unless obtained by fraud, or unless it is calculated to deceive or otherwise disentitled to protection in a Court of Justice.² The presumption of validity does not extend to subsequent assignments entered

Change made by the Act of 1905.

¹ *Edwards v. Dennis*, 30 C. D. 454 (1885), decided under the Act of 1875; *Baker v. Rawson*, 45 C. D. 519; S. R. P. C. 89 (1891), North, J.; *Verity's Tm.*, 19 R. P. C. 58 (1902), Buckley, J. In *Batt & Co.'s Tms.*, [1899] A. C. 428, cited above, p. 362, the trade marks had been registered more than five years. But a mark which had been

long registered had every presumption made in favour of its validity: *Cheshbrough Manufacturing Co.'s Tm.*, [1902] 2 Ch. 1; 19 R. P. C. 342, C. A. (*Vaseline*); and *Burroughs, Wellcome & Co.'s Tms.*, [1904] 1 Ch. 736; 21 R. P. C. 217, C. A.

² Above, p. 368.

on the Register,¹ and it is subject to the proviso at the end of the section for the protection of prior users of the mark. It is also subject to sec. 37,² at any rate so far as that section deals with the effects of non-user subsequent to the original registration.

The advantage which this section offers to traders in regard to their own marks is to some extent balanced by the necessity under which they will now be of carefully watching the advertisements of applications to register, in order to see that nothing is registered or allowed to remain on the Register long enough to profit by the section which is likely to interfere with their business or with marks which they are actually using in it. As the period of seven years from the passing of the Act of 1905 expired on August 11th, 1912, sec. 41 has now come into operation as regards all trade marks registered before the passing of the Act; as regards a mark registered under the Act the period of seven years from the date of registration must have elapsed before the section operates with respect to it.

Name of
patented
goods.

A question which may have to be considered under the present section, or under it and sec. 44, is, how far the use of the name of a new article manufactured under patent rights can be permanently monopolised by the person who owned the patent, if he has registered and used the name as a trade mark while the patent rights subsisted. The common law rule is that such a name becomes merely descriptive when the patent expires,³ and can be used by anyone to describe the article,⁴ but when the seven years mentioned in sec. 41 have expired, the original registration of the name can no longer be attacked. The solution of the difficulty is, it is submitted, to be found in the consideration that when the name becomes merely descriptive on the expiration of the patent rights, it ought to be removed from the Register, not on the ground that it was not originally distinctive, but on the ground that its distinctiveness has ceased. At all events the

¹ Cf. sec. 40, above, p. 367.

² Above, p. 327. In *Andrew v. Kuehnrich*, Times, August 2nd, 1913, on appeal from Swinfen Eady, J., 30 R. P. C. 93, the Court of Appeal expunged a trade mark registered in 1884 on the ground of non-user for upwards of five years; see Addenda.

³ Query, whether it is not from the first descriptive of the name of the

article.

⁴ *Linoleum Co. v. Nairn*, 7 C. D. 834 (1878), Fry, J., and other authorities cited pp. 45 *et seq.* In *Chesebrough Manufacturing Co.'s Tm.*, [1902] 2 Ch. 1; 19 R. P. C. 342, Cozens-Hardy, L.J., expressed the opinion that the doctrine was not limited to the names of patented articles, but extended to names given to new articles; see above, pp. 50 *et seq.*

right of the public to use the name, once it has become merely descriptive, is secured by sec. 44.

The provision that registration is to be conclusive of the validity of the original registration after the expiration of the period named in the section is subject to the following savings or exceptions.

(1) If the original registration was obtained by fraud. In this case the Registrar himself may apply to rectify the Register,¹ at all events if the fraud was directed against possible objections by the Registrar or otherwise with a view to deceive the office. But the exception is a general one, and the person defrauded is not prevented by sec. 41 from applying for rectification. It might be a fraud for a person to procure the registration of a trade mark of which he knows he is not entitled to claim the exclusive use—for instance, if he knows that it is in use by another trader; and although the proviso to the section might protect the other trader from interference, it is submitted that he would be able not merely to claim the benefit of the mark jointly with the registered proprietor, but to object to the registration notwithstanding the lapse of seven years. Another case of fraud which may be suggested is where the agent of a foreign manufacturer registers the trade mark of the latter in his own name. The extent which will be given to the exception of fraud can, however, only be learnt from the practical working of the Act.

(2) If the trade mark offends against the provisions of sec. 11 of the Act. That section forbids the registration as a trade mark or part of a trade mark of any matter, the use of which would by reason of its being calculated to deceive or otherwise be disentitled to protection in a Court of Justice, or would be contrary to law or morality or any scandalous design. The provisions of sec. 11 have been fully considered in Chapter X,² and it will be seen from the decisions there referred to that a wide meaning has been placed on the words "calculated to deceive." Section 11 only extends in terms to registration; but, where by reason of events which have happened since registration the use of the trade mark would be calculated to deceive,³ it is probable that the trade mark would be held to offend against

Fraud.

Marks forbidden by sec. 11 to be registered.

¹ Sec. 35 (3), above, p. 311.

² Above, p. 297.

³ See, for instance, *R. Thorne & Sons,*

Ltd. v. Pimms, Ltd., 26 R. P. C. 221 (1909), where, however, the period mentioned in sec. 41 had not expired.

the provisions of sec. 11, although it did not so offend at the date of registration.

Concurrent registrations.

(3) The proviso to sec. 39 saves the rights of persons concurrently registered in respect of the same goods for the same (or substantially the same) trade mark.¹ So that such a person does not need any protection which may also be conferred on him by the more general proviso contained in sec. 41.

Trade marks of anterior date.

(4) If the proviso to sec. 41 applies to a case at all, it extends to the whole Act, not merely to sec. 41. It is new and is a necessary consequence of conferring a conclusive title on the registered owner. In a few cases under the old Acts the person who had been an earlier user of the mark was registered along with a later user who had got upon the Register.² The registration of identical, or nearly identical, marks for the same description of goods under the Act is dealt with in secs. 19, 20 and 21.³

The first part of the proviso applies whether the earlier user obtains registration under sec. 21 or not, but it is conditional upon his having used the mark continuously. The phrase "continuously used" must, it is submitted, receive a reasonable business interpretation. There are no such saving words in this section with regard to non-user due to special circumstances and not due to an intention to abandon the mark as appear in sec. 37.⁴ Nevertheless, it cannot be intended that a mere temporary cessation of user should cause the forfeiture of the right to a valuable mark. "A man who has a trade mark may properly have regard to the state of the market and the demand for the goods; it would be absurd to suppose that he lost his trade mark by not putting more goods on the market when it was glutted."⁵

In a judgment in a recent action for infringement, in which the plaintiffs sued on a mark not used by them until some time after their application for registration, and the defendants alleged some use of their trade mark after the date of the plaintiffs' application but before any actual use by the plaintiffs

¹ Above, p. 364.

² *Jelley's case*, 51 L. J. Ch. 639, n. (1878), Jessel, M.R.; *Mouson v. Boehm*, 26 C. D. 398 (1884), Chitty, J. See also *Verity's Tm.*, 19 R. P. C. 58 (1902), Buckley, J.

³ Above, pp. 247, 248, 294.

⁴ Above, p. 327.

⁵ Per Chitty, J., in *Mouson v. Boehm*, 26 C. D. 398; cf. *Daniel and Arter v. Whitehouse*, [1898] 1 Ch. 685; 15 R. P. C. 134. As to abandonment, see p. 412.

of their mark and relied on the proviso to sec. 41, the view was expressed that the prior user referred to in the proviso must be something like substantial user, and also prior to the application to register; but on the facts it was held that there had been no user by the defendants prior to the plaintiffs' user.¹

(5) Matters subsequent to the original registration. These are not strictly excepted from sec. 41, inasmuch as the effect of the first part of sec. 41 does not extend beyond the original registration. Among the matters subsequent to the original registration which may give rise to rectification of the Register are (a) wrongful registration of assignments or transmissions, (b) non-user of the trade mark for a period giving ground for removal of the trade mark under sec. 37,² (c) assignment of the trade mark without any goodwill in the whole or part of the goods for which it is registered.³

Matters subsequent to registration.

3. Registration as a Condition precedent to an Action for Infringement.

It is provided by sec. 42 that:—

Sec. 42.

“No person shall be entitled to institute any proceeding to prevent or to recover damages for the infringement of an unregistered trade mark, unless such trade mark was in use before August 13th, 1875, and has been refused registration under this Act. The Registrar may, on request, grant a certificate⁴ that such registration has been refused.”

A trade mark can still be acquired by use,⁵ but, if the trade mark is unregistered, trade mark rights in respect of it cannot be enforced except in the case of an old mark which has been refused registration under this Act.

Trade mark can be acquired by use.

The above section corresponds to sec. 77 of the Act of 1883,⁶ which was as follows:—

Act of 1883, s. 77.

“A person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of a trade mark

¹ *Williams's, Ltd. v. Massey, Ltd.*, 28 R. P. C. 512 (1911), Leigh Clare, V.-C.

² Above, p. 327.

³ Sec. 22, Chap. XIII., p. 385.

⁴ See p. 375.

⁵ *Sen-Sen Co. v. Britten*, [1899] 1 Ch. 692; 16 R. P. C. 137, Stirling, J. *Kenrick and Jefferson's Application*, 26 R. P. C. 641 (1909), Neville, J.

⁶ The corresponding section of the Act of 1875 was sec. 1, but was amended by the Acts of 1876 and 1877. The principal sections of the Acts of 1875, 1876, and 1877 will be found in the Appendix, pp. 712-715. The provisions referred to have no substantial bearing on the present Act.

unless, in the case of a trade mark capable of being registered under this Act, it has been registered in pursuance of this Act, or of an enactment repealed by this Act, or, in the case of any other trade mark in use before the thirteenth of August one thousand eight hundred and seventy-five, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused. The Comptroller may, on request, and on payment of the prescribed fee, grant a certificate that such registration has been refused."

New marks.

In the case of new marks, no substantial change is effected, but the change of language avoids some questions left open by the wording of the old sec. 77, and especially by the words "a trade mark capable of being registered under this Act." These words referred to the trade marks described in sec. 64 of the Act of 1883, and after the passing of the Act of 1888, to those described in sec. 10 of that Act.¹ They correspond to the expression "registrable trade mark" which is defined by sec. 3 of the Act of 1905,² and is used in sec. 9.³ Section 77 of the Act of 1883 did not expressly enact that a new mark, incapable of registration, shall not be the subject of trade mark rights, but the general words of prohibition, as also the savings contained in the section, plainly showed that it was intended to prohibit proceedings to enforce rights in new unregistered marks, and although there was no direct decision as to a new mark incapable of registration, this is the view which was always taken of the effect of the section as to such a mark.⁴ The Act of 1905 makes the matter quite clear; no action for infringement of an unregistered trade mark can now be maintained, unless it is in respect of an old mark which has been refused registration under the Act of 1905.

Old marks.

The policy of the Acts has been to preserve old trade mark

¹ Printed in the Appendix, p. 692. See secs. 27 and 28 of the Act of 1888.

² Above, p. 25.

³ Above, p. 137.

⁴ In *The Normal Co.'s Tm.*, 35 C. D. 235; 3 R. P. C. 269 (1886), Chitty, J., said: "The result (of sec. 77) is that a person, who, I will assume, is entitled to be, but by some error has not been, put on the Register by the Comptroller or by the Board of Trade, loses his right, because it is useless to have a trade mark which you cannot protect in case

of infringement; as to old marks, however, a distinction is drawn. And where there has been a refusal, there is a right to institute proceedings to prevent infringement. . . . So that the validity of the old trade marks does not depend on the (non-)registration." See also Cotton, L.J., as to the policy of the Acts in *Van Duzer's case*, 34 C. D. 634; 4 R. P. C. 31 (1887); and cf. *Apollinaris Co.'s Tms.*, [1891] 2 Ch. at pp. 234 and 235; 8 R. P. C. 137, per Fry, L.J.

rights substantially without alteration.¹ Section 77 of the Act of 1883 excepted from its operation all old marks of which registration under that Act, or of an enactment repealed by it,² had been refused, and a similar saving was introduced into the Act of 1875 by the amending Act of 1876.³ The new section, however, makes no exception in favour of old marks that have been refused registration under any of the repealed Acts; in order to obtain the benefit of the section there must be a refusal under the Act of 1905. Probably the draftsman had in mind that the Act of 1905 opened the Register to many trade marks formerly incapable of registration. It is provided in sec. 9 that any special or distinctive word or words, letter, numeral, or combination of letters or numerals used as a trade mark by the applicant or his predecessors in business before August 13th, 1875, which has continued to be used (either in its original form or with additions or alterations not substantially affecting the identity of the same) down to the date of the application for registration⁴ shall be registrable as a trade mark under this Act.⁵ But, apart from this proviso, registration of trade marks that have in fact become "distinctive" within the meaning of that word in sec. 9,⁶ can be registered.

Lord Herschell's Committee advised that the certificate of refusal should be altered to a certificate that the trade mark is incapable of being registered under the Act, on the ground that the former tends to prejudice the proprietor of the mark, especially in proceedings abroad;⁷ but the suggestion was not adopted. The fee payable for the certificate of refusal is £1. The form of application is Form 'TM No. 31.'⁸

Certificate of refusal.

It was suggested by Malins, V.-C., in *The Twentsche Stoom Bleekery Goor v. Ellinger & Co.*,⁹ that the prohibition of sec. 77 did not apply to foreign owners of trade marks; but it is submitted that the suggestion was ill-founded, and that no distinction can be drawn between trade marks owned by subjects and those owned by aliens.¹⁰

¹ Per Ld. Blackburn, *Orr-Ewing v. Registrar of Tms.*, 4 App. Ca. p. 498 (1879).

² Acts of 1875, 1876 and 1877.

³ 39 & 40 Vict. c. 33, s. 1, below, p. 714.

⁴ Rule 20, p. 722, as to verification of the fact of user.

⁵ Above, p. 222.

⁶ Above, p. 204.

⁷ Report of 1888, p. xiii. In many countries a foreigner cannot obtain registration for a trade mark not registered in his own country.

⁸ Appendix, p. 760.

⁹ 26 W. R. 70 (1877).

¹⁰ See *Goodfellow v. Prince*, note (2), p. 376; and Chap XV., at p. 423.

Registration
a condition
precedent to
action ;

The section makes registration, in the cases falling within it, a condition precedent¹ to an action for infringement. Where, therefore, the sole consignee of goods for which his consignors had a label registered as a trade mark in France sought to restrain the use of a name which formed a material feature in the label, it was held that the action was in substance an action to restrain an infringement of the label, and, as that might have been registered in England as a trade mark under sec. 103 of the Act of 1883, it fell within the prohibition.² An action to restrain the use of a registered mark on goods for which the registration does not avail is also within the prohibition, for it is in effect an action in respect of an unregistered mark.³

not to acqui-
sition of a
trade mark.

The section does not enact that a man shall not have a trade mark until he registers,⁴ and it has been compared⁴ to sec. 24 of the Copyright Act, 1842,⁵ which was satisfied by a registration made subsequently to the wrongful act complained of, but before the commencement of the action. If a person has adopted and used words as a trade mark in this country, but has not registered them as a trade mark, it does not necessarily follow that, by describing such words on the goods as his trade mark, he is making a misrepresentation.⁶

Only the
registered
proprietor or
his assignee
can sue.

Only the registered owners, or the assignees of the registered owners, of the trade mark can sue in respect of an infringement of it,⁷ but it is not necessary that an assignee should have registered the assignment before commencing his action.⁸

The judgment of North, J., in the case last cited seems to go further and to be founded on the view that an unregistered

¹ Per Ld. Blackburn in *Orr-Ewing v. Registrar of Tms.*, 4 App. Ca. 498, 499.

² *Goodfellow v. Prince*, 35 C. D. 9 (1887), C. A.

³ *Hargreaves v. Freeman*, [1891] 3 Ch. 39; 8 R. P. C. 237, Chitty, J.; cf. *Jay v. Ladler* and *Hart v. Colley*, cited below, p. 379, note (4). That the registration was blocked by delay at the office was considered to be no excuse; *Hazzopulo v. Kaufmann*, 23 Sol. J. 819 (1879), Little, V.-C.

⁴ *Sen-Sen Co. v. Britten*, [1899] 1 Ch. 692; 16 R. P. C. 137; Stirling, J.; and per Chitty, J., in *Barlow v. Johnson*, 7 R. P. C. at p. 405 (1890). See also Cotton, L.J., in *Hudson's Tms.*, 32

C. D. at p. 320; 3 R. P. C. at p. 161 (1886).

⁵ 5 & 6 Vict. c. 45, now repealed by the Copyright Act, 1911.

⁶ *Sen-Sen Co. v. Britten*, supra, note (4), distinguishing and explaining *Lewis v. Goodbody*, 67 L. T. N. S. 194, Kekewich, J. See observations of Kekewich, J., on the last-mentioned case, in *Hubbuck v. Brown*, 17 R. P. C. at p. 156 (1900).

⁷ *Richards v. Butcher*, 7 R. P. C. 288; 62 L. T. 687 (1890), Kay, J. Action by sole purchasers from registered proprietors. Leave to add the proprietors.

⁸ *Ihlee v. Henshaw*, 31 C. D. 323; 3 R. P. C. 15 (1886), North, J.

assignee can sue. In *The Magnolia Metal Company v. Atlas Metal Company*,¹ however, Collins, J., dismissed the action as to trade mark on the ground that the plaintiffs had not at the date of judgment been registered as proprietors of the marks sued on.² *Ihlee v. Henshaw*³ does not seem to have been cited, and the two cases appear to conflict, for sec. 77 of the Act of 1883, like sec. 42 of the Act of 1905, expressly referred to the institution of proceedings, and therefore, if registration of an assignment is necessary at all, it would appear to be necessary before the action is commenced.

The Prohibition does not affect Passing-off Actions.

Section 42 of the Act of 1905 has, and sec. 77 of the Act of 1883 had, no application to actions to restrain a trader passing off his goods, or doing what is calculated to pass off his goods, as the goods of another. This is now expressly provided by sec. 45 of the Act of 1905, which enacts that nothing in the Act shall be deemed to affect rights of action against any person for passing off goods as those of another person, or the remedies in respect thereof.

Two questions arise in trade mark actions and in allied actions: first, is the defendant using a mark which is the same as, or which is a colourable imitation of, the plaintiff's registered trade mark? and secondly, is the defendant selling goods so marked as to be designed or calculated to lead purchasers to believe that they are the plaintiff's goods?⁴ The two questions are distinct, and the injunctions granted by the Court to meet the wrongs complained of are different in the two cases. Thus, in *Jay v. Ladler*,⁵ the defendant was restrained "from infringing the plaintiff's said trade mark by issuing, publishing, or circulating, or causing to be issued, published, or circulated, any circular, advertisement, or notice containing or bearing the trade mark in the pleadings mentioned, or any colourable imitation thereof,

Distinction between trade mark and passing-off cases.

¹ 14 R. P. C. 389 (1897).

R. P. C. 15 (1886), North, J.

² It appears from the report of *Magnolia Co.'s Trns.*, 14 R. P. C. at p. 266, however, that the plaintiffs were registered as proprietors on the day before the trial: but it is presumed that this fact was not in evidence in the action.

⁴ *Mitchell v. Henry*, 15 C. D. 181 (1880), Thesiger, L.J.; *Edwards v. Dennis*, 30 C. D. 454 (1885), Fry, L.J.; see Chap. I., p. 13, and Chap. XVI., p. 531.

⁵ 40 C. D. 649; 6 R. P. C. 136 (1889), Kekewich, J.

³ *Ihlee v. Henshaw*, 31 C. D. 323; 3

in connection with sealskin mantles and sealskin coats (the only goods for which the trade mark was registered), or otherwise using the said trade mark in that connection," and he was also restrained "from using the device of a lady and bear (the trade mark in question), so as to deceive the public," that is, so as to lead the public to believe that the goods of the defendant were the goods of the plaintiff.

The jurisdiction to grant the last-mentioned injunction is part of the general jurisdiction of the Courts to prevent and to give compensation for frauds which cause injury to the person who comes to complain of them,¹ and this jurisdiction, which was well established before the Trade Marks Registration Acts, has not been taken away or altered by anything contained in them.²

Unregistered
trade marks
practically
protected.
*The Stone
Ales case.*

It is no defence, therefore, to an action for passing off the defendant's goods as those of the plaintiff, that the grant of an injunction would practically confer on the plaintiff trade mark rights in an unregistered trade mark. This is well shown by *The Stone Ales* case. There the plaintiffs had registered the words *Stone Ale* as a trade mark, and they had other registered marks which comprised the same words. An application was made by the defendant to vary the registration of the first-mentioned mark, by adding a disclaimer of the right to the exclusive use of the word *Stone*, and this application Chitty, J., refused. The Court of Appeal, however, ordered the mark *Stone Ale* to be removed from the Register altogether, on the ground that it was not shown to have been used separately as a trade mark before August 13th, 1875, but they, and subsequently the House of Lords, nevertheless maintained the injunction granted by Chitty, J. The injunction³ restrained the defendant from "carrying on the business of a brewer at Stone, under the title of 'Stone Brewery,' or 'Montgomery's Stone Brewery,' or under any other title, so as to represent that the defendant's brewery is the brewery of the plaintiffs, and from selling, or causing to be sold, any ale or beer not of the plaintiffs' manufacture, under

¹ See Chap. I., p. 1.

² *Mitchell v. Henry*, 15 C. D. 181 (1880), C. A.; *Singer, &c. Co. v. Loog*, 8 App. Ca. at p. 32 (1882), per Ld. Blackburn; *Goodfellow v. Prince*, 35 C. D. 9 (1887), C. A.; *Montgomery v.*

Thompson, [1891] A. C. 217; 8 R. P. C. 361 (*Stone Ale*); *Reddaway v. Banham*, [1896] A. C. 199; 13 R. P. C. 218; *Lever Bros., Ltd. v. Beddingfield*, 16 R. P. C. 3; 80 L. T. 100 (1899), C. A.

³ [1891] A. C. p. 218.

the term 'Stone Ales,' or 'Stone Ale,' or in any way so as to induce the belief that such ale or beer is of the plaintiffs' manufacture, and from infringing the plaintiffs' registered trade marks, or any of them."

"The respondents," Lord Herschell said,¹ "are entitled to ask that a rival manufacturer shall be prevented from selling his ale under such a designation as to deceive the public into the belief that they are obtaining the ale of the respondents, and he ought not the less to be restrained from doing so because the practical effect of such restraint may be much the same as if persons seeking the injunction had a right of property in the particular name."²

Lord Herschell's judgment.

In a later case in which it was contended that sec. 77 of the Act of 1883 was a bar to a passing-off action, Vaughan Williams, L.J., said that he read the section as defining the conditions which were necessary if anyone claimed the benefit of the statute, and it was held that the section was no answer to the claim in respect of passing-off.³

In *The Stone Ales* case just quoted the deception was practised by the use of the trade name of the plaintiffs' goods upon the defendant's goods. The jurisdiction existing, apart from the Acts, extends equally to cases where it is practised by the adoption of the plaintiff's trade mark, or of the "get up" of his goods, and it affords no ground of defence that the trade mark,⁴ or an essential part of the get up,⁵ might have been, but is not registered under the Acts.

Passing off by the imitation of an unregistered trade mark.

In *Thorneloe v. Hill*,⁶ where the plaintiff sued on trade name, Romer, J., expressed the view that, as the name had been used only as a trade mark, the plaintiff could not sue on it, as it had not been registered; but a distinction seems to have been there made between setting up a pure right of property in a name and

¹ [1891] A. C. p. 220.

² See also *Birmingham Vinegar Co. v. Powell*, [1897] A. C. 710; 14 R. P. C. 720, where the words *Yorkshire Relish* had been expunged from the trade marks Register: and *Reddaway v. Banham*, [1896] A. C. 199; 13 R. P. C. 218 (*Camel Hair Belling*). These cases are fully discussed below in Chap. XVI.

³ *Faulder & Co., Ltd. v. Rushton*, 20 R. P. C. 477 (1903), C. A. (*Silverpan Jam*), where a trade mark including

the word *Silverpan* had been expunged from the Register on the ground that that word ought to have been disclaimed.

⁴ *Jay v. Luller*, 40 C. D. 649; 6 R. P. C. 136 (1889), Kekewich, J.; *Hart v. Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J.

⁵ *Great Tower Street Tea Co. v. Langford*, 5 R. P. C. 66 (1887), Stirling, J.

⁶ 11 R. P. C. 61 (1894).

seeking protection from passing off by means of the name, and the latter ground of action failed for other reasons.

In *Birmingham Vinegar Co. v. Powell*,¹ Lord Halsbury, after quoting Lord Justice Turner's words in *Burgess v. Burgess*,² "that no man can have any right to represent his goods as the goods of another person," stated that that was the only question of law which could arise in such cases; all the rest were questions of fact.

*Pinto v.
Badman.*

In the case of *Pinto v. Badman*,³ the jury found, as a fact, that the defendant had fraudulently sold his cigars as those of the plaintiffs, and also that he had infringed the plaintiffs' trade mark, and Day, J., gave judgment in the plaintiffs' favour. The Court of Appeal reversed the decision and gave judgment for the defendant, on the ground that the trade mark on which the plaintiffs relied had been assigned to them without the goodwill of the business in the goods to which it belonged. The question whether the plaintiffs were not, notwithstanding, entitled to retain their judgment on the ground of the finding of the jury, first stated above, does not seem to have been argued, and the plaintiffs' case appears to have been substantially based upon their assumed trade mark right. The decision, therefore, cannot be regarded as conflicting with the proposition that passing-off cases lie outside the Acts.

The operation
of sec. 77 of
Act of 1883.

The cases cited above considerably limited the operation of the prohibition contained in sec. 77 of the Act of 1883. Trade mark rights, as was shown in the introductory chapter of this book,⁴ grew out of the right of a trader to prevent and to obtain compensation for deceptions practised upon the public, which caused, or were likely to cause, damage to him as an individual; and long after property in a trade mark had been practically recognised by the judgment of Lord Cottenham in *Millington v. Fox*,⁵ Lord Westbury held that imposition on the public was the test of the property in a trade mark having been invaded or injured, although it was not the ground on which the Court rested its jurisdiction.⁶

¹ See p. 379, note (2).

² 3 De G. M. & G. 896 (1853).

³ 8 R. P. C. 181 (1891), C. A.

⁴ Page 1.

⁵ 8 My. & Cr. 338 (1838); Chap. I., p. 4.

⁶ *Hall v. Barrows*, 4 De G. J. & S. 150; 33 L. J. Ch. 204 (1863), Westbury, L.C.; *Leather Cloth Co. v. American Leather Cloth Co.*, 4 De G. J. & S. 137; 33 L. J. Ch. 199 (1863), Westbury, L.C.; 11 H. L. C. 523; 35 L. J. Ch. 53; and

The Registration Acts have altered the old law to this extent, that they give the registered proprietor of a mark, so long as he remains registered, the exclusive right to the use of the mark on the goods for which it is registered, so that if it, or an essential part of it, is appropriated by another trader, the proprietor can interfere to restrain the appropriation.¹ But where the complaint is not the appropriation but the colourable imitation of his mark, the test to be applied is still—Is the defendant's mark, by its resemblance to the registered mark, calculated to pass off his goods as the goods of the plaintiff?¹

The alteration is not, however, of substantial importance, for it was settled law, apart from the Acts, that if a trader has taken a substantial part of the trade mark of another, the onus of showing that he is not using it in a manner calculated to deceive is cast upon him,² and this onus he could hardly discharge if the mark had, in fact, become identified by use with the other trader. So that the change is, in effect, no more than the natural consequence of treating registration as equivalent to public use of the registered mark.³

In most of the cases where the Court has interfered to prevent the passing off of the defendant's goods as those of the plaintiff, the deception has been found to have been deliberately practised; but fraud is not necessary to enable the Court to act;⁴ accordingly, the presence of fraud does not constitute a material distinction between cases where actions in respect of the unlawful imitations of trade marks do or do not fall within the prohibition of sec. 42.

It can rarely happen, therefore, that the prohibition of sec. 42 will prevent the owner of an unregistered mark, which has, in fact, become known to the public, or to a considerable although

Proof of fraud is not necessary to escape the prohibition.

Failure to register only deprives the proprietor of the advantages of the Acts.

see *Ld. Blackburn's judgment in Orr-Ewing v. The Registrar of Tms.*, 4 App. Ca. at p. 494 (1879).

¹ Secs. 39, 40 and 41 of the Act of 1905; sec. 76 of the Act of 1883; see per Cotton, L.J., in *Mitchell v. Henry*, 15 C. D. at p. 193 (1880); in *Edwards v. Dennis*, 30 C. D. at p. 471 (1885); and in *Lyndon's Tm.*, 32 C. D. at p. 117 (1886); and Chap. XV., at p. 444.

² *Orr-Ewing v. Johnston*, 13 C. D. 434, C. A.; 7 App. Ca. 219 (1882). This case was begun in 1877, before

sec. 1 of the Act of 1876 came into operation; it was therefore decided under the old law; see 7 App. Ca. p. 228.

³ Sec. 75 of the Act of 1883, above, p. 361.

⁴ Chap. I., p. 4, and *Chivers & Sons v. S. Chivers & Co., Ltd.*, 17 R. P. C. 420 (1900), Farwell, J.; and *Yeatman v. Homberger*, 29 R. P. C. 561, 645 (1912), Eve, J., and C. A. (*Taylor's Port*). See Chap. XVI., p. 532.

indefinite number of purchasers, as indicating that the goods upon which it appears are his goods, from protecting it against infringement, for the adoption of the mark, or of a substantial part, or a colourable imitation of it, can hardly fail to be calculated to pass off the goods of others as those of the owner; but the want of registration will cast upon the plaintiff in any action the necessity of proving that goods bearing the mark are known as his, and that goods bearing the mark complained of are likely, by reason of the resemblance between the marks, to be mistaken for his. And where an injunction is granted to restrain the use of a mark calculated to pass off the defendant's goods as those of the plaintiff, by reason of its resemblance to his unregistered mark, it should be so limited as to leave it open for the defendant to use any part, or the whole, of the plaintiff's unregistered mark, if he can do so, in any manner which is not calculated to lead to deception.¹

Goodfellow v. Prince.

The case of *Goodfellow v. Prince*,² which is the only reported case³ in which sec. 77 of the Act of 1883 proved fatal to a plaintiff where he sought relief on the ground of passing off, as well as in respect of an infringement of his trade mark, turned upon the view taken by the Court of Appeal that, as both plaintiff and defendants were importers, not producers, of the goods in question, the mark complained of was not calculated to suggest that the goods sold by the defendant were those of the plaintiff, but only that they were those of the producer from whom he bought.⁴

Unregistered trade marks and the Merchandise Marks Act, 1887.

Failure to register a trade mark, whether it be occasioned by the incapacity of the mark for registration, having regard to the definition clauses, or be due to any other reason, is material on other grounds than those depending upon sec. 42, for the definition of a trade mark contained in the Merchandise Marks Act, 1887, is, as regards Great Britain and Ireland, restricted to trade marks registered under the Act of 1883, or, since the commencement of the Act of 1905, under that Act.⁵ An

¹ See the judgments in *Montgomery v. Thompson*, [1891] A. C. 217; 8 R. P. C. 361; *Reddaway v. Banham*, [1896] A. C. 199; 13 R. P. C. 218; and *Powell v. Birmingham Vinegar Co., Ltd.*, 11 R. P. C. at p. 572; 12 R. P. C. at p. 517.

² 35 C. D. 9 (1887), C. A.

³ But see *Thorneloe v. Hill*, supra, p. 379.

⁴ As to this, see also *Dental Manufacturing Co., Ltd. v. De Trey & Co.*, [1912] 3 K. B. 76; 29 R. P. C. 617 (C. A.).

⁵ Interpretation Act, 1889, sec. 38, Appendix, p. 718.

unregistered mark is consequently deprived of the very valuable protection, under the criminal law, constituted by the penalties and punishments provided by the former statute for forging trade marks, falsely applying trade marks to goods, or selling, exposing, or having in possession for sale, or for any purpose of trade or manufacture, any goods or things to which a forged trade mark is applied. The provisions of the statute as to applying a false trade description do, however, extend to unregistered trade marks.¹

¹ Sec. 3 (2); Appendix, p. 886.

CHAPTER XIII.

ASSIGNMENT AND DEVOLUTION OF TRADE MARKS.

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A trade mark is assignable only with the goodwill.

TITLE to a trade mark cannot be assigned or devolve in gross ; but, unless the mark connotes a personal connection between its original owner and the goods in connection with which it is used, it may be assigned and transmitted, together with the goodwill¹ of the business in such goods.

¹ See the definitions of goodwill contained in *Commissioners of Inland Revenue v. Muller & Co.'s Margarine,*

Ltd., [1901] A. C. 217, quoted below, p. 402.

This proposition was fully established before the first Registration Act was passed, and, as regards registered trade marks, it was, in part, embodied in that Act and subsequently in the Act of 1883. It is also contained in sec. 22 of the Act of 1905, which is as follows :—

“A trade mark when registered shall be assigned and transmitted only in connection with the goodwill of the business concerned in the goods for which it has been registered and shall be determinable with that goodwill.¹ But nothing in this section contained shall be deemed to affect the right of the proprietor of a registered trade mark to assign the right to use the same in any British possession or protectorate or foreign country in connection with any goods for which it is registered together with the goodwill of the business therein in such goods.”

Sec. 22.
Assignment and transmission of trade marks.

The corresponding provisions of the Acts of 1875 and 1883² only differed from the first sentence of the above sections in having the words “in the particular goods or classes of goods” instead of the words “in the goods” simply. A trade mark must be registered for particular goods or classes of goods,³ and the rights conferred by registration are limited to the goods for which it is registered.

Until it was established that there could be property in a trade mark, there could, of course, be no question of the assignment of trade mark rights,⁴ although the successors of the original founders of a business no doubt took over and continued to use the old trade marks employed in it, and were protected when other traders sought to pass off their goods as the goods of the lawful users of the marks.⁵ But as soon as trade marks were recognised as the subjects of property, the alienation of them, as of any other property rights, was permitted, subject only to such limitations as were necessary to prevent the use of the marks becoming deceptive.

And, conversely, it was held that the sale and transfer of the goodwill of a business assigned the trade marks used in the business to the purchaser and transferee by implication, and

Transfer by implication with goodwill.

¹ See the next Chapter.

² Act of 1875, part of sec. 2; Act of 1883, sec. 70.

³ Sec. 8, above, p. 112.

⁴ See per Fry, L.J., in *Pinto v. Badman*, 8 R. P. C. at p. 194 (1891).

⁵ See for instance, *Webster v. Webster*, 3 Swan. 490 (1791), Thurlow, L.C.; and *Motley v. Downman*, 3 My. & Cr. 1; 6 L. J. Ch. (N. S.) 308 (1837), Cottenham, L.C.

without any express grant being needed ;¹ but it is a question of intention, to be gathered from the assignment as a whole, whether the trade marks do or do not pass, and an intention not to assign them may appear notwithstanding the use of the word "goodwill" in the assignment.²

*Hall v.
Barrows.*

The leading cases on the subject are *Hall v. Barrows*³ and *The Leather Cloth Co. v. The American Leather Cloth Co.*⁴ They were decided at the same time, in 1863, by Lord Westbury, and his judgment in the latter case was affirmed by the House of Lords; in the first case, the question at issue was whether, in determining the sum to be paid by the surviving partner of a firm who took over the partnership assets at a valuation under the articles of partnership, the value of the trade mark used in the business ought to be taken into account, and the Lord Chancellor, reversing the decision of Romilly, M.R., held that it ought to be so taken, the valuation being made, however, on the footing that the surviving partner was entitled to carry on a similar business and to use the trade mark in it without payment.⁵

Trade mark comprising the name of the original proprietor.

The trade mark consisted of the letters B. B. H. (the initials of the partners composing the original firm), surmounted by a crown, and the Master of the Rolls had held that it could not be sold, because it designated the firm which manufactured the particular goods. "It would," he said, "obviously be a fraud on the public if the Court of Chancery were to attempt to sell to another person the right of holding out to the public that the goods manufactured by him were, in fact, goods manufactured by another and distinct firm." And he distinguished the mark in question from marks indicating the manufacture of a particular factory, which might rightly be transferred with the factory. Lord Westbury dissented from the view that the trade mark was a personal mark. "It must be borne in mind," he said, "that a name, although originally the name of the first maker, may in

Lord Westbury's judgment.

¹ *Shipright v. Clements*, 19 W. R. 599 (1871), Malins, V.-C. See also *Currie v. Currie*, 15 R. P. C. 399 (1898), where on an informal agreement goodwill was held to pass, and therefore the trade marks.

² *Roger's Tm.*, 12 R. P. C. 149 (1895), North, J.

³ 32 L. J. Ch. 548; 83 L. J. Ch. 204; 4 De G. J. & S. 150, Romilly, M.R., and Westbury, L.C.

⁴ 1 H. & M. 271; 32 L. J. Ch. 721; 4 De G. J. & S. 197; 33 L. J. Ch. 199; 11 H. L. C. 523; 35 L. J. Ch. 53, Wood, V.-C., Westbury, L.C., and H.L. See also *Bury v. Bedford*, 32 L. J. Ch. 741; 4 De G. J. & S. 352; 33 L. J. Ch. 465 (1863), Romilly, M.R., and L.J.J.

⁵ As to this, see also the cases discussed in Chap. XVI., below, pp. 588 *et seq.*

time become a mere trade mark or sign of quality, and cease to denote or be current as indicating that any particular person is the maker." And he held, as a fact, that the connection represented by the mark was a connection with the business and the factory at which it was carried on, not a connection with the persons who were the owners of these, and that, accordingly, the trade mark belonged to the partnership as part of its property, and might be sold with the business and works.

In *The Leather Cloth* case,¹ the plaintiffs sued the defendants for an alleged infringement of their trade mark, and Lord Westbury, reversing the decision of Wood, V.-C., dismissed the suit on the ground that the trade mark of the plaintiffs contained material misrepresentations. The plaintiffs had purchased the marks from an American company—the Crockett International Leather Cloth Co.,—who were the successors of Crocketts & Co., and the marks contained the names both of the company and of the firm, as well as an American address which was not the address of the plaintiffs. The presence of the names and address amounted, in Lord Westbury's opinion, to a representation that the goods on which the mark was used were the goods of the original firm or of the American company, and the marks, therefore, could not be properly used by the plaintiffs, and consequently could not be validly assigned to them. And this judgment was fully indorsed by the House of Lords, although Lord Cranworth and Lord Kingsdown, on the appeal, based their judgments chiefly on the ground that there was in fact no infringement, and Lord Westbury placed his upon wider grounds than those he had adopted on the appeal from the Vice-Chancellor, namely, that the alleged trade marks were in fact only advertisements and not trade marks at all.

The Leather Cloth case.

The mark is unassignable if deceptive when used by an assignee.

The following passage from Lord Kingsdown's judgment in the House of Lords² shows the principle upon which the assignment of trade marks and trade names, as well as the limitations restricting such assignment, are based: "By the usage of trade, the name of a firm is understood not to be confined to those who first adopted it, but to extend to and include persons who had afterwards been introduced as partners, or persons to whom the original partners have transferred their business. The name of a firm continues to be used in many cases long after all the

Lord Kingsdown's judgment in *The Leather Cloth* case.

¹ Note (4) p. 386. The case is further stated at p. 56, above.

² 35 L. J. Ch. p. 64; 11 H. L. C. 523.

original traders have died, or have ceased to have any interest in the concern—as in the great banking houses of Child and Coutts, and many other mercantile houses. If a manufacturing company uses the name of the firm, and stamps the name of its firm upon its goods, though the name of the firm no longer represents the same persons as at first, it is no fraud upon the public for the reasons I have already mentioned. For the same reason, the use of the old trade mark of the firm by the new partners or their successors (if the term ‘trade mark’ be understood in what I have already said is its proper sense)¹ is no fraud upon the public; it is only a statement that the goods are the goods of the firm whose trade mark they bear.” And Lord Cranworth said: “The right to a trade mark may, in general, treating it as property or as an accessory to property, be sold or transferred upon a sale and transfer of the manufactory of the goods on which the mark has been used to be affixed, and may be lawfully used by the purchaser.”²

The mark used by the assignee must indicate what it indicated when used by the assignor.

In the case of *Pinto v. Badman*,³ Fry, L.J., stated the rule governing the assignment of a trade mark in concise and definite terms: “It may be assigned,” he said, “if it is indicative of origin, when the origin is assigned with it. It cannot be assigned when it is divorced from its place of origin, or when, in the hands of the transferee, it would indicate something different to what it indicated in the hands of the transferor.”

A mark comprising the trader's name is assignable.

And as the judgments quoted above show, a trade mark is not deceptive in the hands of an assignee of the business of the original proprietor, and consequently unassignable, merely because it comprises the name or initials of the original proprietor, or of any of the former owners of the business.⁴ But in special cases, as for instance where the reputation of goods depends on the personal skill of an artist or artizan, the use of his name or mark by a successor might be a misrepresentation, and in such a case the name or mark is not properly assignable.⁵

¹ I.e., a symbol or emblem, come by use to be recognised in the trade as the mark of the goods of a particular person (above, pp. 24 and 36).

² 35 L. J. Ch. p. 61.

³ 8 R. P. C. 181 (1891), C. A.

⁴ *Hall v. Barrows*; *Bury v. Bedford*, above, p. 386, notes (3), (4). See also *Hudson v. Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C.

⁵ Per Ld. Kingsdown in *Leather Cloth Co. v. American Leather Cloth Co.*, ubi supra, and per Romer, J., in *Thorneloe v. Hill*, 11 R. P. C. at p. 70 (1894). See also the judgment of Ld. Westbury in *Leather Cloth Co. v. American Leather Cloth Co.*, 4 De G. J. & S. 137; 33 L. J. Ch. 199, as to marks becoming deceptive on assignment.

So, the right to use a trade mark for a sauce cannot be sold without the business in the sauce, or the secret of its manufacture,¹ or the right to the use of a brand for cigars, without the factory and business of the manufacturer who first acquired it;² and where a mark contains a special indication of the locality of the origin of the goods, it could not be properly assigned so as (using Lord Justice Fry's expression) to be divorced from such place of origin.³

As already stated, an assignment of a trade mark is inoperative if the assignor has no goodwill to assign.⁴ And the goodwill must be that of a business in the United Kingdom.⁵ The question whether an assignor has a goodwill of a business in the particular goods to assign may, of course, give rise to difficult questions of fact; but the words of the section as to goodwill are not to be construed narrowly.⁶ Thus, where a mark was registered for anti-friction metal bearings, but the registered proprietors, who were an American company, had never sold such bearings in the United Kingdom, but they had imported specimens and also ingots of the anti-friction metal, with the mark on them, for making bearings, such ingots being purchased by an English firm; and the American company had a special agreement with the English firm, under which, as the Court held, the latter were in some respects, and particularly as to trade marks, agents of the company, and the goodwill was to revert on the determination

There must be a business to assign in the United Kingdom.

¹ *Cotton v. Gillard*, 44 L. J. Ch. 90 (1874), Jessel, M.R.

² *Pinto v. Badman*, 8 R. P. C. 181 (1891), C. A.

³ See judgment of Ld. Westbury referred to in note (5), p. 388 supra, and judgment of Fry, L.J., quoted on p. 388, and *Mason v. Queen*, 23 Sc. L. R. 641 (1886).

⁴ *Harness' Tm.*, 17 R. P. C. 40 (1900), Farwell, J., is an example of an assignment being held inoperative on this ground. See also *Valentine Extract Co., Ltd.'s Tms.*, 18 R. P. C. 175 (1901). Cf. *Linotype Co., Ltd.'s Application* (No. 2), 17 R. P. C. 380.

⁵ See the case of *Rey v. Lecouturier*, cited below on p. 390, and see also *Magnolia Metal Co.'s Tms.*, below, note (6), where the point is assumed both by Kekowich, J., and C. A. In *Ullmann v.*

Leuba Freres, 25 R. P. C. 673 (1903), P. C., it was held that the plaintiffs (the respondents) had not acquired any goodwill in Hong Kong, where the action was brought, for although their watches were exported there to one customer, the business in Hong Kong was hers, and not the plaintiffs. Cf. also *Société Anonyme Panhard et Levassor v. Panhard Levassor Motor Co., Ltd.*, [1901] 2 Ch. 513; 18 R. P. C. 405 (Farwell, J.), a trade name case, where the plaintiffs were held to have an English market, although they had no place of business or agent in England. There appears to be no conflict between these cases and the cases on the Stamp Acts quoted below, p. 401.

⁶ Per Rigby, L.J., in *Magnolia Metal Co.'s Tms.*, [1897] 2 Ch. 371; 14 R. P. C. 621.

of the agreement to the company; it was held that the company had a business concerned with metal bearings sufficient to support an assignment by them of the trade mark and goodwill.¹ "The main object," Rigby, L.J., said, "of the restrictions upon assignments imposed by the Act was to prevent confusion or deception by suggesting that the articles to which the mark is applied continue to have some connection or other with the original registered owner."

And the English goodwill must be assigned.

And the English goodwill must pass by the assignment. This is well illustrated by *The Chartreuse* case,² in which the assignee of the goodwill of a business in France and of French trade marks had procured himself to be registered as proprietor of the English trade marks used in the same business, but the registration of the assignment was expunged, as the person registered as assignee was held not to be the assignee of the goodwill in England nor entitled to the English trade marks. The case arose out of the manufacture by the Carthusian monks of Chartreuse by a secret process. Under French penal law the goodwill in France of the business of that manufacture and the French trade marks became vested, as was held by the French Court, in Lecouturier, a judicial officer, and he claimed also to have become entitled to the goodwill in England and the English trade marks, and on his application he was registered as proprietor of those trade marks in the place of Rey, who was a trustee for the monks. On the other hand, the Carthusian monks and a Spanish company claiming under them claimed that the monks remained in possession of the secret process, and applied to rectify the Register of trade marks by expunging the entries of the name of Lecouturier from the Register, and they also brought an action to restrain him and persons claiming under him from passing off liqueurs not manufactured by the plaintiffs, complaining of the use of the word "Chartreuse" and of advertisements and statements issued

¹ *Magnolia Metal Co.'s Tms.*, above, p. 389, note (6), Lindley, Lopes, and Rigby, L.J.J., reversing Kekewich, J., on this point. See also *European Blair Camera Co.'s Tm.*, 13 R. P. C. 600, where Stirling, J., held that there was user of the word *Bull's-eye* by a foreign importer in connection with cameras in this country, he having imported the

cameras in cases which had the word on them, and having sent therewith to the consignee pamphlets containing the word. See above, p. 230, note (7).

² *Rey v. Lecouturier* (in the House of Lords *Lecouturier v. Rey*), [1908] 2 Ch. 715; [1910] A. C. 262; 25 R. P. C. 265; 27 R. P. C. 268.

by the defendants in connection with their trade in England. The plaintiffs succeeded both in the Court of Appeal and in the House of Lords, it being held that, although under the French penal law, the property of the monks in France became vested in Lecouturier, that law did not affect the goodwill in England nor the English trade marks.¹ The Register was rectified accordingly, and in the action the plaintiffs were held to have established their claim, and injunctions in a limited form were granted.

Trade marks used in a part of a business may be sold with the goodwill of that part only, and if the goodwill sold is restricted to some only of the goods in which the vendor dealt, the purchaser will only obtain the right to use the trade marks assigned to him upon the goods in question, even though they be registered for other goods. Thus a mark was registered for "unwrought and partly wrought metals used in manufacture," and the proprietors assigned it together with their goodwill, "in the trade or business of galvanised iron merchants and manufacturers"; but the business, in fact, being entirely confined to sheet iron, the assignee's rights were held to be restricted to that description of goods only.²

It is not essential that the assignments of the trade mark and the transfer of the goodwill should be exactly contemporaneous,³ or even that there should be any legal conveyance of the latter, if the assignee is equitably entitled to it.⁴ An assignment to the owner of the business in connection with which the trade mark is used or intended to be used has, consequently, been permitted in some cases where the mark has been registered by mistake or accident in the name of a person other than that owner.⁵

Sale of trade marks with the goodwill of part of the business.

Transfer of goodwill and trade mark not necessarily contemporaneous.

¹ And see *Johnson's Tms.*, 26 R. P. C. 195 (1908).

² *Edwards v. Dennis*, 30 C. D. 454 (1885), C. A. Cf. *Hart's Tm.*, [1902] 2 Ch. 621; 19 R. P. C. 569, Byrne, J. The Register (*semble*) can be rectified, even after seven years, if the trade mark is assigned without goodwill, above, p. 385.

³ *Welcome's Tm.*, 32 C. D. 213; 8 R. P. C. 76 (1886), Chitty, J.; *Hammond v. Malcolm, Brunner & Co.*, 9 R. P. C. 301 (1892), Chitty, J.

⁴ In *McMillan v. Ehrmann Bros., Ltd.*, 21 R. P. C. 357, 647 (1904), Buckley, J., and C. A., a trade name case, a point was raised, but not decided, whether the plaintiffs, to whom the business and trade name was only assigned, after action brought, by a limited company, the real owners, could sue.

⁵ See Chap. XI., at p. 336, *Greenlees' Tm.*, 9 R. P. C. 93 (1892), Stirling, J.; *Leahy v. Glover*, 10 R. P. C. 141 (1893), H. L.; and see note (i.), p. 390.

Where a company sold its trade marks and the goodwill of its business, but was dissolved without its making any assignment to the purchaser, the equitable owner was registered as the proprietor of the trade marks.¹

Foreign trade marks and goodwill.

The goodwill² of a business may extend to more than one country, and the new provision contained in the latter part of the section expressly saves the right of the proprietor of a trade mark to assign the trade mark rights in any country, but only in connection with the goodwill therein. Registration under the Act is only operative for the United Kingdom and Isle of Man, and the proviso seems to have been inserted by way of precaution. The divisibility of goodwill is also recognised in sec. 23.

Trade marks on bankruptcy and dissolution of partnership.

Upon the dissolution of a partnership, in the absence of special agreement,³ the trade marks of the firm are part of its assets, and are saleable as such with the goodwill;⁴ but it seems that each of the partners is at liberty to make use of the trade name of the firm, and of its trade marks, provided he can do so and does so in such a way as to avoid deceiving the public, or casting any risk or liability upon his late partners.⁵ Similarly, upon the death or bankruptcy⁶ of a trader, his trade marks may be sold with the goodwill of his business by his executors or trustees.

Under certain circumstances, where the goodwill of a business becomes divided, as on a dissolution of partnership, an apportionment of trade marks can be affected. Section 23 provides—

¹ This appears in the report of *In re Taylor's Agreement Trusts*, 21 R. P. C. 713 at p. 715.

² As to the elements constituting goodwill, see below, p. 402.

³ For instances of this, see *Bury v. Bedford*, 32 L. J. Ch. 741; 4 De G. J. & S. 352; 33 L. J. Ch. 465; and *Hanson v. Game, Harrison and Larner, Ltd.*, 9 R. P. C. 186 (1892). This topic is fully discussed below, Chap. XVI., p. 588.

⁴ *Hall v. Barrows*, above, p. 336, note (3).

⁵ See the last case, and *Hookham v. Pottage*, L. R. 8 Ch. 91 (1872), C. A.; *Thynne v. Shove*, 45 C. D. 577 (1890), Stirling, J.; and *Burchell v. Wilde*, [1900] 1 Ch. 551, Byrne, J., and C. A. Where a business is conducted at two

places and the goodwill at each is sold separately without special stipulations, the purchasers might have concurrent rights to the use of the trade name. In *Townsend v. Jarman*, 17 R. P. C. 649 (1900), Farwell, J., it was contended that such was the case, but in the particular case the defendant failed to establish a concurrent right with the plaintiff.

⁶ *Hammond v. Malcolm, Brunner & Co.*, 9 R. P. C. 301 (1892), Chitty, J.; in *Melrose Drover, Ltd. v. Heddle & Co.*, 4 Fraser 1120 (1902), Ct. of Sess. interdict was granted against the use by the trader of the firm name, trade marks and labels, all of which had been assigned by the trustee in sequestration.

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

Apportionment of marks on dissolution of partnership.

This section is new and is designed to meet the hardship which occurred in *Ehrmann's Tms.*,¹ where on the dissolution of a firm it was agreed that one partner should trade as “Ehrmann Frères,” and the other as “Ehrmann Brothers,” and that new registrations should be made of the old trade marks with consequential alterations; but the new registrations were refused in view of the confusion that might arise. Possibly the scheme proposed in that case would not be allowed under the present section, as the Registrar will, no doubt, only give his approval where the proposed apportionment does not conflict with the interests of the public. But where an apportionment does not involve the entry of duplicate marks on the Register for the same description of goods, then, notwithstanding that the goodwill in such goods is divided and becomes vested in more than one person, the section contemplates that one of such persons may take some marks and another other marks. The section applies not only on dissolution of partnership, but in all cases where a person ceases to carry on business and the goodwill becomes divided, *e.g.*, under the provisions of a will.

Associated trade marks, however, are only assignable or transmissible as a whole,² so that it would appear that an apportionment of them under sec. 23 could not be made.

The only appeal from the Registrar is to the Board of Trade,³ but the Board of Trade may refer the appeal to the Court.⁴

The procedure under sec. 23 is regulated by Rules 87 to 89.⁵ An application must be made on Form TM No. 21,⁶ and must

¹ [1897] 2 Ch. 495; 14 R. P. C. 665.

² Sec. 27, above, p. 119.

³ Sec. 54, below, p. 683.

⁴ Sec. 59, below, p. 684.

⁵ Appendix, p. 730.

⁶ Below, p. 752.

be accompanied by a case setting out all the facts fully. The Registrar may call for evidence and is to give the parties an opportunity of being heard, if necessary. Upon an apportionment a note is to be entered in the Register in connection with each of the marks of the fact of apportionment and referring to the date of the Registrar's decision.

Section 38 provides as follows:—

“ Subject to the provisions of this Act—

Power of registered proprietor to assign.

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

No notice of any trust expressed, implied, or constructive is to be entered in the Register, nor is any such notice to be receivable by the Registrar.¹

This section corresponds to the latter part of sec. 87 of the Act of 1883; the first part of that section relating to registration of assignments is now dealt with in a separate section.²

Licences.

The old section, which applied to patents and designs as well as to trade marks, contained a reference to the granting of licences.³ This is now wholly dropped, no doubt because licences are inapplicable in respect of the rights in a trade mark acquired by registration. A licence to use a trade mark is unnecessary if the trade mark is to be used in connection with the goods of the proprietor of the trade mark,⁴ and is illegal, because leading to deception, if it is to be used in connection with the goods of anyone else.⁵ The principle of sec. 22 seems to be as applicable to a partial assignment as to an absolute assignment.

Lease of goodwill and trade marks.

¹ Sec. 5.

² Sec. 33, below, p. 398.

³ For a decision under the section see *The Bowden Brake* case, cited below, p. 395.

⁴ Chap. II., at p. 34.

⁵ *Oldham v. James*, 13 Ir. Ch. 393; 14 Ir. Ch. 81 (1862); and see the

remarks of North, J., in *Roger's Tm.*, 12 R. P. C. at p. 158 (1895), and those of Moulton, L.J., in *Boussod, Valadon & Co. v. Marchant*, 25 R. P. C. at p. 53 (1908), a trade name case; also *Thorneloe v. Hill*, 11 R. P. C. 61 (1894).

use the trade marks identified with it would during the term pass to the lessee, in the absence of special agreement; and, if it were reserved, on the principles stated above the lessor could not rightly use the marks.¹ It seems that the registration of the lessee as assignee of the marks without the consent of the lessor, would not, however, be rightly made.² Where a company, which had carried on business at Glasgow and elsewhere, sold its Glasgow businesses, and agreed not to carry on business there during ten years from the assignment, and expressly licensed the assignee to use certain trade marks during that term, and the assignee applied to register a trade mark containing a representation of Glasgow Town Hall similar to one that had appeared on labels for whisky bottled at Glasgow by the assignors (the label not being expressly mentioned in the assignment), and the assignors opposed the registration, as they did not admit the applicant's right to the exclusive use of the device, although they did admit his right to use it, the application for registration was refused.³

Although, if the whole goodwill of a business is leased, the lessor cannot as a rule use the trade marks during the lease; yet where a foreigner, who had registered trade marks for metal bearings, entered into an agreement with persons in this country under which they were during a term of years to purchase the particular alloy for the bearings from him, and were to have the exclusive sale in this country, and the agreement contained clauses under which the goodwill was on the determination of the agreement to revert to the foreigner, it was held that he had sufficient goodwill in bearings during the continuance of the agreement to support an assignment by him of the trade marks and such goodwill.⁴

In a very recent case,⁵ the plaintiffs, the owners of a patent for the application of an article, known as Bowden Wire, to

*The Bowden
Brake case.*

¹ But in *Warwick Tyre Company, Ltd. v. New Motor and General Rubber Co., Ltd.*, 27 R. P. C. 161 (1910), Neville, J., the plaintiffs, who did not themselves manufacture or sell "Warwick" tyres, and had conferred on another company the right to sell such tyres for them during a term of years, were held entitled to sue in a passing-off action for the protection of their trade name "Warwick."

² *Re Avril*, Stirling, J., April 20th, 1888, cited above, p. 338.

³ *Roger's Tm.*, 12 R. P. C. 149 (1895), North, J.

⁴ *Magnolia Metal Co.'s Tms.*, [1897] 2 Ch. 371; 14 R. P. C. 265 and 621; see above, pp. 389, 390.

⁵ *Bowden Wire, Ltd. v. Bowden Brake Co., Ltd.*, 30 R. P. C. 45 (1913), Swinfen Eady, J.

bicycle brakes, sold to the defendants that portion of their business which consisted of making Bowden cycle brakes and all trade marks, if any, connected therewith, and granted to the defendants an exclusive licence, subject to certain then existing licences, under the patent for the purpose of cycle brakes, the licence being subsequently limited to brakes for cycles propelled solely by the rider. Subsequently, the plaintiffs registered a trade mark for brakes for velocipedes and other road vehicles and licensed the defendants to use it on cycle brakes made and sold under the patent licence. The plaintiffs manufactured brakes for motor cycles and other accessories both before and after the registration of the licence, and used the mark in connection with them. After the expiration of the patent and the licences, the defendants continued to use the trade mark in connection with their push cycle brakes, and they claimed the right to use it also on other articles, and the plaintiffs brought the action to restrain infringement of the trade mark, and of a similar trade mark registered for accessories other than brakes. The defendants moved to rectify the Register by expunging the marks and based their application on several grounds, including allegations that the plaintiffs were constructive trustees of the brake mark for the defendants, and that the marks were calculated to deceive and not distinctive. It was contended that the plaintiffs had so dealt with their marks that they had lost all right to them, and that the defendants had the right to use them generally in their trade. Swinfen Eady, J., however, held that the user by the defendants under the licence, being thereby authorised only for a limited term, gave the defendants no right to use the mark after that term had expired and no right to prevent the plaintiffs continuing to use the mark in the same manner as they had used it. The applications to expunge were refused,¹ except that an order was made restricting the goods for which the brake mark was registered to brakes for road vehicles other than velocipedes or pedal cycles wholly propelled by the physical force of the rider, and an injunction was granted against the defendants restraining them from infringing the trade marks with similar words of exclusion. The licence to use the trade mark was granted whilst the Act of 1883, with its provision as to licences

¹ On appeal (not yet reported) both marks were expunged on the ground of not being distinctive, but being calculated to deceive, July 10th, 1913.

above mentioned, was in force; and it is to be observed that at the date when the licence was granted the defendants were in possession of the goodwill in connection with brakes for push cycles granted to them by the plaintiffs.

The sole authorised dealer in goods bearing a particular trade mark in the United Kingdom, who is in a sense a licensee of the trade mark rights, cannot sue for infringement of the trade mark.¹ But a true licensee of the rights, if there can lawfully be such a person, could not sue either.²

Action by licensee.

A difficult question of fact may arise in considering whether under particular circumstances a person has purchased the right to represent that he is the successor in business of another. Such a question arose in *Rickerby v. Reay*,³ where the plaintiff had bought the stock in trade and patterns of a business at a price arrived at on the footing that the chattels were for use in a going concern, and had taken a lease of the premises, and during the lease he continued to use the device of a crown, and the word "crown" which had been previously used in connection with machines sold by the old firm. On the determination of the lease he removed to other works, and questions then arose as to his rights in the goodwill and such name and device. Byrne, J., referred to Lord Lindley's judgment in *Commissioners of Inland Revenue v. Muller & Co.'s Margarine, Ltd.*,⁴ and added, "I may also say that it appears to me that one or more of the elements going to make up what is called goodwill may be retained while others may be parted with, and that all or every⁵ of such elements may be disposed of without express mention," and the learned judge held on the facts that the purchaser acquired the right to describe himself as carrying on the business formerly carried on by the old firm, and to use the patterns and device as well as the name "crown" to describe his machines, and that his rights did not determine with the lease.⁶

Purchase or lease of goodwill.

Registered proprietor can make a title.

The registered proprietor can make a good title to a purchaser

¹ *Richards v. Butcher*, 7 R. P. C. 288 (1890), Kay, J., and see *Dental Manufacturing Co. v. De Trey*, [1912] 3 K. B. 76; 29 R. P. C. 617, C. A.

² *Hcap v. Hartley*, 42 C. D. 461; 5 R. P. C. 603 (1888) (a patent case); *Woolley v. Broad*, [1892] 1 Q. B. 806; 9 R. P. C. 208, 429 (a design case).

³ 20 R. P. C. 380 (1903). See also *Currie v. Currie*, 15 R. P. C. 339 (1898), where on a dissolution of partnership

without any deed or formal agreement, one partner bought the share of the other partner in the assets, and these were held to include the goodwill and therefore the trade marks.

⁴ Quoted below, p. 402.

⁵ This should obviously be "any."

⁶ A question also arose as to the name of the premises; see below, p. 560.

of the trade mark and goodwill, who has no notice of any conflicting equitable rights in either which may exist in a third person. But sub-sec. (2) keeps all equities open, so that they may be enforced in like manner as in respect of any other personal property.¹ Therefore in a patent case licensees who took their licence with notice of an agreement for assignment by the licensors and registered the licence were held not to have obtained a valid licence against the assignees, although the actual assignment was made subsequently to the licence, and no notification of the agreement was entered on the Register at the date of the licence.¹

“Subject to the provisions of this Act,”

“Subject to the provisions of this Act” in sec. 38 means, subject to the rule of sec. 22, that a trade mark shall not be assigned or transmitted without the goodwill of the business in the goods for which it has been registered,² and subject to the provision that associated trade marks are assignable or transmissible only as a whole and not separately.³

An assignment is subject to all rights appearing from the Register to be vested in other persons. These may appear in the registration of the trade mark assigned in the form of limitations or conditions,⁴ or by the registration of identical or nearly identical trade marks having been permitted under the provisions of secs. 19, 20, 21.

Section 33 provides as follows:—

Registration of assignments, &c.

“Subject to the provisions of this Act where a person becomes entitled to a registered trade mark by assignment, transmission, or other operation of law, the Registrar shall, on request made in the prescribed manner, and on proof of title to his satisfaction, cause the name and address of such person to be entered on the Register as proprietor of the trade mark. Any decision of the Registrar under this section shall be subject to appeal to the Court or, with the consent of the parties, to the Board of Trade.”

This section corresponds to the first part of sec. 87 of the Act of 1883, which, so far as regards trade marks, was in the same terms except that the words “subject to the provisions of this Act” are added in the new section, and that the provision for an appeal is new.⁵ The Board of Trade may under sec. 59 refer

¹ *New Ixion Tyre and Cycle Co., Ltd. v. Spilsbury*, [1898] 2 Ch. 137, 484; 15 R. P. C. 380, 567, Kekewich, J., and C. A.

² Above, p. 385.

³ Sec. 27, Associated Marks, above, p. 119.

⁴ Sec. 12 and sec. 14. Above, pp. 71 and 93.

⁵ Cf. sec. 12 (3) and sec. 14 (5).

to the Court an appeal made to it. The words "subject to the provisions of this Act," refer to the rule embodied in sec. 22, that a trade can only be assigned in connection with goodwill,¹ and to the provisions of sec. 27 that associated trade marks cannot be assigned separately.²

This section relates to changes of proprietorship; a change of, or correction of an error in, the name or address of the registered proprietor comes under sec. 32.³

In view of the appeal expressly conferred by the section from the decision of the Registrar, an application under sec. 35 for the purpose of reversing a decision of the Registrar would probably not be allowed. Under the Act of 1883, an application to rectify was the only remedy against a refusal of the Registrar to register an assignment or other change of proprietorship.⁴

Registration of the assignment is not, as registration of the mark itself is, a condition precedent to any action for infringement by the assignee.⁵

Action before registration.

In some cases the assignment of a trade mark to new proprietors makes an alteration in its form necessary or advisable. In the case of registered marks, such alteration may be obtained under sec. 34, provided that the mark is not altered in a manner substantially affecting its identity.⁶ Thus in *Guinness & Co.'s Trade Mark*,⁷ Chitty, J., allowed the word *limited* to be added to the name upon an old mark, the business and trade marks of the old firm having been taken over by a company bearing the name of the firm with "limited" added to it, and in other cases the same alteration has been allowed in new marks.⁸ But in the case of an old mark the Court, in whom the discretion was formerly vested by sec. 92 of the Act of 1883, was very unwilling to allow any alteration to be made, although it had jurisdiction to do so if special circumstances render it necessary, for it was considered that a mark registered as an old mark ought to be kept on the Register as it was actually used before

Alteration of registered mark in consequence of assignment.

¹ Above, p. 385.

² Above, p. 119.

³ Above, p. 351.

⁴ Secs. 78, 87 and 90 of the Act of 1883; see *Bancroft's Tm.*, 5 R. P. C. 209 (1888), Stirling, J., and *New Ormonde Cycle Co.'s Tm.*, [1896] 2 Ch. 520; 13 R. P. C. 475, North, J.

⁵ *Ihlee v. Henshaw*, 31 C. D. 323; 3

R. P. C. 15 (1884), North, J.; *Richards v. Butcher*, 7 R. P. C. 288 (1890), Kay, J. See, however, *Magnolia Metal Co. v. Atlas Metal Co.*, 14 R. P. C. 389 (1897), and above, p. 377.

⁶ *Murphy's Tm.*, 7 R. P. C. 163 (1890), W. N. 84.

⁷ 5 R. P. C. 316 (1888).

⁸ See Chap. XI., at p. 357.

August 13th, 1875. So, in *Re Henry Clay, and Bock & Co.*,¹ Kekewich, J., refused to allow an old mark to be altered by substituting, for the initials of one predecessor of the proprietors, the name of another and later predecessor, notwithstanding that the mark in its altered form had been registered for some years in Havana, and had been extensively used by the applicants in England.² The present Act allows alterations in old marks under sec. 34, and appears to contemplate changes in them from time to time not substantially affecting their identity.³

Procedure.

The procedure by which registration of assignments and transmissions of title are governed is laid down in the following rules.⁴

Assignment.

Joint request for entry of assignment.

“76. The Registrar may on request made jointly by a registered proprietor of a mark and the person to whom he has assigned such mark, together with the goodwill of the business concerned in the goods for which it has been registered, register the assignee as proprietor of the mark. Such application shall be in the Form TM No. 16.⁵ If the Registrar so require, the assignee shall furnish a declaration in Form TM No. 17.⁶

Request for entry of assignment by subsequent proprietor.

77. Where no such joint request is made, any person who has become entitled to a registered trade mark by assignment, transmission or other operation of law, may leave a request at the Office for the entry of his name in the Register as proprietor of such trade mark. The request shall be on the Form TM No. 18,⁷ and such request shall contain the name, address, and description of the person claiming to be entitled to the trade mark, hereinafter called the claimant.

Case accompanying request.

78. Together with such request the claimant shall leave a case stating full particulars of the assignment, transmission, or other operation of law by virtue of which he claims to be entitled to be entered in the Register as proprietor of the trade mark, so as to show the manner in which and the person or persons to whom the trade mark has been assigned or transmitted, and so as to show further that it has been so assigned or transmitted in connection with the goodwill of the business concerned in the goods for which the trade mark has been registered.

¹ [1892] 3 Ch. 549; 9 R. P. C. 449.

Trade Mark Rules, 1890.

² See further, Chap. XI., p. 309.

⁵ Appendix, p. 750.

³ See the proviso to sec. 9.

⁶ Appendix, p. 750.

⁴ The old rules were 36 to 40 of the

⁷ Appendix, p. 751.

79. Such request shall in the case of an individual be made and signed by the claimant, and in the case of a firm or partnership by one or more members of such firm or partnership, and in the case of a body corporate shall be signed by a director or by the secretary or other principal officer of such body corporate.

Signature of request.

80. Where the Registrar shall determine that the case sets out particulars such as entitle the claimant to be registered as proprietor of such trade mark, he shall call upon the claimant to furnish a statutory declaration (Form TM No. 19)¹ verifying the several statements in the case and declaring that the particulars given comprise every material fact and document affecting the proprietorship of the trade mark claimed by such request.

Statutory declaration in support of request.

81. In any case, the Registrar may call on any person who desires to be registered as proprietor of a trade mark for such proof or additional proof of title and of the existence and ownership of such goodwill as aforesaid as the Registrar may require for his satisfaction.”

Proof of title.

On an assignment for value of trade marks and goodwill the *ad valorem* stamp duty applicable to a conveyance or transfer on sale is payable.

In one case it was held that in the case of a foreign trader who had no place of business in the United Kingdom, but had registered a trade mark here, and had sent goods into this country, the trade mark and right to use it and the business connection here were property within sec. 59 of the Stamp Act, 1891, and, moreover, were not “property locally situate out of the United Kingdom” within the exception contained in the same section, notwithstanding that they were assigned with freehold premises in America.² But the Court of Appeal has subsequently held that where goodwill and the exclusive right to use a trade name are assigned with premises entirely situate out of the United Kingdom, the goodwill is *primâ facie* annexed to the premises, and is, in the absence of facts rebutting the *primâ facie* presumption, property locally situate out of the United Kingdom.³ In the case referred to the question was as to the

Stamp on assignment of goodwill and trade marks, &c.

¹ Appendix, p. 751.

² *Brooke & Co. v. Commissioners of Inland Revenue*, [1896] 2 Q. B. 356, Pollock, B., and Bruce, J.

³ *Muller & Co.'s Margarine, Ltd. v. Commissioners of Inland Revenue*, [1900] 1 Q. B. 310; distinguishing

Smelting Co. of Australia v. Commissioners of Inland Revenue, [1897] 1 Q. B. 175 (sole licence to work patent). Cf. *Lecouturier v. Rey*, [1908] 2 Ch. 715; [1910] A. C. 262; 25 R. P. C. 265; 27 R. P. C. 268; cited above p. 390.

What constitutes goodwill.

stamping of an agreement for the sale of a wholesale manufacturing business carried on abroad, and having no customers in the United Kingdom or anywhere but in Germany. On appeal to the House of Lords¹ the judgment of the Court of Appeal was affirmed. The question what constitutes goodwill was very fully considered, and the following passages occur in the judgments.

Lord Macnaghten said: "It" (goodwill) "is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation, and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates. Goodwill is composed of a variety of elements. It differs in its composition in different trades and in different businesses in the same trade. One element may preponderate here and another element there. . . . For my part, I think that if there is one attribute common to all cases of goodwill it is the attribute of locality. For goodwill has no independent existence. It cannot subsist by itself. It must be attached to a business. Destroy the business and the goodwill perishes with it, though elements remain which may perhaps be gathered up and be revived again. No doubt where the reputation of a business is very widely spread, or where it is the article produced rather than the producer of the article that has won popular favour, it may be difficult to localise goodwill. But here, I think, there is no difficulty. We have it in evidence that the firm of Muller & Co. had no customers out of Germany, and it is a significant fact that the protected area—the limit within which the vendor is prohibited from setting up in business—is the limit of fifty miles from Gildehaus.² Moreover, under the Stamp Act, 1891, we are not required to define the local situation of the goodwill. We have only to determine whether it is or is not situate out of the United Kingdom."

And Lord Lindley said: "Goodwill regarded as property has no meaning except in connection with some trade, business or

¹ *Commissioners of Inland Revenue v. Muller & Co.'s Margarine, Ltd.*, [1901] A. C. 217.

² Where the factory was situate.

calling. In that connection I understand the word to include whatever adds value to a business by reason of situation, name and reputation, connection, introduction to old customers, and agreed absence from competition, or any of these things, and there may be others which do not occur to me. In this wide sense, goodwill is inseparable from the business to which it adds value, and, in my opinion, exists where the business is carried on. Such business may be carried on in one place or country or in several, and if in several there may be several businesses, each having a goodwill of its own.”¹

¹ This passage was quoted by Byrne, J., in *Rickerby v. Reay*, 20 R. P. C. 380, quoted above, p. 397. It is clearly not necessary, however, for the purpose of sec. 22 of the Act that the assignor of a trade mark should have a place of business in England, he may have a

goodwill in England without that. See *Magnolia Metal Co.'s Tms.*, [1897] 2 Ch. 371; 14 R. P. C. 621, C. A.; *Société Anonyme Panhard and Levassor v. Panhard Levassor Motor Co., Ltd.*, [1901] 2 Ch. 513; 18 R. P. C. 405, Farwell, J.

CHAPTER XIV.

DETERMINATION OF TRADE MARK RIGHTS.

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Modes of de-
termination.

THE right of the proprietor of a mark (subject to the rights of other proprietors, if any, of the same mark)¹ to the exclusive use of it upon the goods of the kind in respect of which the right existed is determined :—

- (1) When the mark so used ceases to be distinctive;
- (2) When the proprietor is no longer able to use it in the business in connection with which the right was acquired;
- (3) When he has abandoned it; and

¹ See the "three mark rule," p. 249, sec. 38, p. 394, and sec. 39, p. 363.

(4) When he has forfeited his claim to protection of his right by using the mark deceptively or in a fraudulent trade.¹

In the first case the mark can no longer be the subject of trade mark rights, and anyone may use it; but in the others, if there are any independent proprietors of the mark for the same class of goods, their rights will be unaffected by the determination; and in the fourth case their rights will continue to be qualified by the right of the former proprietor to use the mark himself on the goods, so long as he uses it in the business in connection with which it was acquired.

The proprietor may, in general, use the mark after his exclusive rights have determined.

1. Loss of Distinctiveness.

The first case follows immediately from the definition of a trade mark. It is shown in Chapter II., both from the authorities and the statutory definition contained in the Act of 1905, that the function of a trade mark is to distinguish the goods to which it is applied or attached from similar goods, and to identify them with a particular trader and his successors in business. And distinctiveness is an essential condition of capacity for registration under the Acts.² Further, the test of infringement is that the use of the mark, or of a similar mark, by others than the proprietor, is calculated to cause their goods to be bought as his.³ So that, apart from the Acts, a mark which has ceased to be distinctive is incapable of being the subject of trade mark rights, and no action for infringement could be successfully brought to prevent any trader using it, and if not already registered, it would be incapable of registration under the Acts.

The elements of distinctiveness have been considered at length elsewhere,⁴ and it will be sufficient here to refer to some of the modes in which a mark may cease to be distinctive, and to give a few examples of cases in which the question has arisen. Marks are not distinctive if they are merely descriptive,⁵ and, in particular, if they have been adopted in the trade concerned as the names of the goods for which they are claimed as trade marks,⁶

How distinctiveness may be lost.

¹ See Chap. XV., "the action for infringement," defences, at pp. 472 *et seq.*

² Chap. VIII., p. 135.

³ *Mitchell v. Henry*, 15 C. D. 181 (1880), James, L.J.; *Edwards v. Dennis*, 30 C. D. 454 (1885), Cotton, L.J.; see also *Ford v. Foster*, 7 C. D. 611, cited

below, p. 407.

⁴ Chap. II., at p. 36; Chap. VIII., at p. 180.

⁵ See above, descriptive marks, pp. 39 and 205; devices, p. 206; words, p. 151.

⁶ Page 39.

or are common marks,¹ or marks common to the trade,² or if they connect the goods not with their proprietor but with some other trader.³

By the action
of the pro-
prietor

Distinctiveness may be lost through the action of the proprietor, or by reason of successful piracy.

Thus, if the proprietor abandons his mark,⁴ it will almost inevitably become a common mark, unless there are other persons who have trade mark rights in it which they assert.⁵ So, if he uses it himself as the name of the goods he deals in, the trade will probably adopt the same course, especially if he is for a time the only dealer in the goods.⁶

Before the Registration Acts a difficult question of fact was often raised in trade mark cases where admittedly a name or other mark had been introduced by the plaintiff, but it was alleged that it had by repeated use on the goods of other traders lost its original significance indicating a connection with the plaintiff, and had become *publici juris*.⁷ A case of this type came before the Privy Council on appeal from New South Wales in *The National Starch Manufacturing Company v. Munn's Patent Maizena, &c. Company*.⁸ The plaintiffs had invented the word *Maizena* for flour made from maize and had introduced flour under that name to New South Wales in 1863, but they had not registered the word there until 1889. The defendants' predecessors commenced to sell *Maizena* in New South Wales in 1867, and the plaintiffs took no steps against them there until the action, which was founded on the trade mark and common law rights, but they had taken proceedings successfully in other countries to restrain the use of *Maizena* in connection with the defendants' flour. It was held that, in view of the use in New South Wales by the defendants and other firms of the word in question before 1889, it had become *publici juris*, and the action

¹ Page 199; see also the "three mark rule," Chap. IX., at p. 240.

² Page 239.

³ *Wood v. Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A. (*Eton Cigarettes*); *Wolff v. Nopitsch*, 17 R. P. C. 321 (1900), Cozens-Hardy, J. (*Spanish Graphite*); see, however, in C. A., 18 R. P. C. 27 (1901). See also above, p. 224, note (1).

⁴ See below, p. 412.

⁵ As, for instance, in *Daniel and Arter v. Whitehouse*, [1898] 1 Ch. 685; 15 R. P. C. 134; Barnes, J., a passing-

off case, where the defendant lost a concurrent right by non-user for some years.

⁶ *Linoleum Manufacturing Co. v. Nairn*, 7 C. D. 834 (1878), Fry, J.; *Gestetner's Tm.*, [1907] 2 Ch. 478; [1908] 1 Ch. 513; 24 R. P. C. 545; 25 R. P. C. 156, Neville, J., and C. A. (*cyclostyle*).

⁷ See *Ford v. Foster*, 7 Ch. 611 (1872); *Singer Manufacturing Co. v. Wilson*, 2 C. D. 434; 3 App. Ca. 376 (1875).

⁸ [1894] A. C. 275; 11 R. P. C. 281.

was dismissed and the mark removed from the Register. The plaintiffs contended that the defendants' user had been originally fraudulent and was continued in fraud, but this was not so found. On this point Lord Ashbourne said: "If during the period in question,¹ the word was only used in the colony for the fraudulent purpose of counterfeiting their goods, the right of the appellants to register it as their trade mark would not be impaired. If, on the contrary, it was used and understood before 1889 as a term descriptive of the article, as a product of maize, and did not denote such product to be the manufacture or merchandise of a particular person, then it must be regarded as having become, in the sense of law, *publici juris*." The difficulty is not so likely to arise in the case of a registered mark,² since the public advertisement of the registration, and the readiness with which the infringement of a properly registered mark can be prevented,³ both tend to warn other traders against the use of the mark and to enable the proprietor to protect his rights.

Extensive infringement by a single trader can hardly suffice to make a trade mark common. "It has been said that one murder makes a villain, and millions a hero; but I think it would hardly do to act on that principle in such matters as this, and to say that the extent of a man's piratical invasion of his neighbour's rights is to convert his piracy into a lawful trade."⁴ Nor will a few unprosecuted scattered infringements by several traders.⁵

By extensive piracy.

"There is no doubt, I think," said Mellish, L.J., in *Ford v. Foster*,⁶ "that a word which was originally a trade mark, to the exclusive use of which a particular trader, or his successors in trade, may have been entitled, may subsequently become *publici juris*, as in the case which has been cited of *Harvey's Sauce*.⁷ I think the test must be whether the use of it by other persons is still calculated to deceive the public,⁸ whether it may still have

The test whether a mark has become *publici juris*.

¹ 1865 to 1889.

² See *Hudson's Application*, 24 R. P. C. 582 (1907), Joyce, J. (*Thunderer* for whistles), where the investigation on applications for registration by rival traders disclosed the fact that the name was *publici juris*.

³ Secs. 39, 40 and 41. See above, pp. 363, 367, 368. Act of 1883, sec. 76.

⁴ Per James, L.J., in *Ford v. Foster*,

L. R. 7 Ch. p. 625.

⁵ *Kinahan v. Bolton*, 15 Ir. Ch. 75 (1863), Brady, C.; *Rowland v. Mitchell*, below, p. 409, note (2).

⁶ L. R. 7 Ch. p. 628 (1872).

⁷ *Lazenby v. White*, 41 L. J. Ch. 354 n. (1871).

⁸ So the long duration of fraudulent user is immaterial, if it is still calculated to deceive: *Heaton's Tm.*, 27 C. D. 570

the effect of inducing the public to buy goods not made by the original owner of the trade mark as if they were his goods. If the mark has come to be so public and in such universal use that nobody can be deceived by it, and can be induced from the use of it to believe that he is buying the goods of the original trader, it appears to me, however hard to some extent it may appear on the trader, yet practically, as the right to a trade mark is simply a right to prevent the trader from being cheated by other person's goods being sold as his goods through the fraudulent use of his trade mark, the right to the trade mark must be gone."¹

A mark may be *publici juris* in a particular branch of the trade only.

Upon the facts of the case, the Lords Justices held that the name in question had become *publici juris* to this extent, "that by the use of it in trade circulars, which are issued only to retail dealers, or by shirts being invoiced by the wholesale dealers as '*Eureka Shirts*,' no retail dealer would be likely to be deceived, or be led to buy shirts which were not made by Ford believing they were Ford's shirts," but that a considerable portion of the public who buy shirts for the purpose of wearing them would still be very liable to be deceived by the use of the word *Eureka* on the shirt itself. And the injunction granted by the Court accordingly left the defendants at liberty to advertise the name *Eureka* as between themselves and the trade.²

Amount of common user necessary.

Where common user is alleged of a trade mark that has been long used and registered, in order to establish this, the use by other persons should be substantial. Thus where it was alleged that a cat and barrel were common to the trade in gin at the date of the plaintiff's registration in 1879, it was held not to be sufficient to have proved nothing more than "a very sporadic use of the labels with a cat and barrel on them." It was found that there had been in the case of none of the users of such labels, other than the plaintiffs, any trade that would associate their goods with a cat and barrel.³ But it has been held that it may be sufficient to prove common use in the trade in advertisements,

(1884), Kay, J. (*Hoop & Iron*); and the judgment of Ld. Ashbourne in the *Maizena* case, quoted above, p. 406.

¹ See also *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 238, n.; and *Hyde & Co.'s Tm.*, 7 C. D. 724, both (1878), Jessel, M.R.

² L. R. 7 Ch. p. 634; cf. *Singer, & Co. v. Spence*, 10 R. P. C. 297 (1893), Romer, J., and *Singer, & Co. v. British Empire Manufacturing Co., Ltd.*, 20

R. P. C. 318 (1909), Kekewich, J.

³ *Boord & Son v. Thom and Cameron, Ltd.*, 24 R. P. C. 697, at p. 721 (1907), Court of Session. Query whether it is necessary that there should be such user as would (if the mark were not common) associate the goods with the person using it. See the next case cited.

show cards, &c., without actual use on the goods, if by reason of such use the mark is not distinctive of the goods of the alleged proprietor.¹

Where a plaintiff is alleged to have lost his rights by not interfering with infringers, the character and extent of the trade of the latter, as well as their position, must be taken into account in considering whether he is barred by his neglect to take proceedings.²

2. Separation of the Mark from the Goodwill.

It has been shown in the last chapter that the trade mark rights in a mark are inseparable from the goodwill of the business in the goods upon which the mark is used, for the function of the mark is to connect the goods with the trader who owns the business, and his successors.³ The indication of that connection is its original signification, and it cannot legally be used as a trade mark with any other.⁴ It follows that if the goodwill is lost, or passes into other hands than those of the proprietor of the mark,⁵ the exclusive rights of the proprietor in respect of the use of the mark are determined, and this rule is recognised by the Acts in the case of registered marks. Section 22 of the Act of 1905 enacts that a trade mark "shall be assigned and transmitted only in connection with the goodwill of the business concerned in the goods" for which it has been registered, and the section expressly adds "and shall be determinable with such goodwill."⁶ And, although an assignment of a trade mark be inoperative by reason of being an assignment in gross, the assignor may lose his right to the mark by such assignment, at all events if the assignee has acted upon the assignment. Thus,

Sec. 22.

¹ *Louise v. Gainsborough*, 20 R. P. C. 61 (1903), Farwell, J.

² *Rowland v. Michell*, 13 R. P. C. 457; 14 R. P. C. 37 (1897), Romer, J., and C. A.; and see also *Ripley v. Bandey*, 14 R. P. C. 591 (1897), Kekewich, J., where judgment was given for the defendant on the ground of the neglect of the plaintiff to assert his right against infringers. An appeal was settled, 14 R. P. C. 944; and see below, pp. 468-470.

³ See the statutory definition, Chap.

II., p. 25, and the judgment of Mellish, L.J., in *Ford v. Foster*, cited above, and Chap. II., p. 23.

⁴ See the judgment of Fry, L.J., in *Pinto v. Badman*, 8 R. P. C. 181 (1891), cited above, p. 388.

⁵ *Thorneloe v. Hill*, 11 R. P. C. 61 (1894); and cf. *Harness' Tm.*, 17 R. P. C. 40 (1900).

⁶ Sec. 2 of the Act of 1875 and sec. 70 of the Act of 1883, below, p. 697, were to the like effect.

where an exclusive licence in gross for a term of years to use a trade name was granted, it was held that the assignor had at the end of the term lost his right to claim that the name indicated his manufacture.¹

No exclusive right in a registered mark apart from the goodwill.

No question seems to arise as to whether the registered owner of a trade mark which has determined by separation from the goodwill of the business can sue for infringement; for sec. 39, which grants the right of exclusive use to the proprietor of a registered mark, makes the grant subject to the registration being valid, and consequently subject to sec. 22. Sec. 41 does not appear to assist a plaintiff in such a case. And by sec. 40 registration is *prima facie* evidence only of the validity of the original registration, and of all subsequent assignments and transmissions.

By Rule 81 the Registrar may call on any person who desires to be registered as proprietor of a trade mark for such proof or additional proof of title and of the existence and ownership of such goodwill as aforesaid (that is, of the business concerned in the goods for which the trade mark has been registered) as he may require for his satisfaction.²

Removal of mark when the goodwill is determined.³

It was provided by Rule 34 of the Rules of 1876, that—"The Court may, on the application of any person aggrieved, remove any trade mark from the Register on the ground, after the expiration of five years from the date of the registry thereof, that the registered proprietor is not engaged in any business concerned in the goods within the same class as the goods with respect to which a trade mark is registered." And in *Ralph's* case,⁴ where the registered proprietor had not manufactured the machine for which the mark was registered for twenty-one months before the date of the application, Pearson, J., in accordance with the rule, directed the mark to be removed.

The rule has not been since re-enacted, and the Act of 1883 contained no express provision enabling a properly registered mark to be removed except for non-payment of fees after fourteen years,⁵ or at the request of the proprietor.⁶ But it was held under that Act that a mark was not properly registered, and it might be removed, if it was not registered with a *bonâ fide* intention to use it for the goods in respect of which it is

¹ *Thorneloe v. Hill*, 11 R. P. O. 61 (1894), Romer, J.

² Above, p. 401.

³ See below, p. 414.

⁴ 25 C. D. 194 (1883), cited below, p. 411.

⁵ Sec. 79.

⁶ Sec. 91.

registered;¹ and the judgment of the Court of Appeal in *Batt's Trade Mark* supports the proposition that if at any time after registration the proprietor ceased to have such intention, the mark was on the Register without sufficient cause and might be removed.²

The rectification section of the Act of 1905 (sec. 35) expressly extends to the case of a mark "wrongly remaining on the Register," so that if the goodwill of the business concerned in the goods for which a trade mark has been registered determines, it seems clear that by the combined operation of secs. 22 and 35 the trade mark would be liable to be removed from the Register.³ Moreover, although there has not been a total determination of goodwill, and although the proprietor still trades in the goods in question, yet non-user may be a ground for removal from the Register.⁴

A mere temporary cessation of business,⁵ or delay in the transfer of the goodwill,⁶ would not determine the trade mark rights. The judgment of Pearson, J., in *Ralph's case*,⁷ notwithstanding the repeal of the Rule on which it was founded, may be referred to on the question what length of cessation of a business determines the goodwill, and therefore also the trade mark rights attached to it. "The only question I have to determine," he said, "is whether one year and nine months is sufficient cesser on the part of Mr. Ralph to show that he comes within the (34th) rule. I am of opinion that one year and nine months is quite sufficient. If I had any doubt about it, I am able by analogy to say that I should not be wrong in concluding that one year and nine months is sufficient, from the fact that under the Companies Act you may wind up a company if it has ceased to carry on business for a year. The Legislature in that has shown by its enactment when a business is supposed to be carried on, and what amount of cesser shows that the business

Temporary separation from the goodwill or disuse of mark is immaterial.

¹ *Batt v. Dunnett*, [1899] A. C. 428; 16 R. P. C. 411; and *supra*, p. 326 *et seq.*

² [1898] 2 Ch. 492; 15 R. P. C. 534.

³ In *Johnson's Tms.*, 26 R. P. C. 195 (1909), Warrington, J., it was held that either the goodwill in respect of which the trade marks were registered had come to an end altogether by the dissolution of a limited company which had been entitled thereto or the assignments made to the registered proprietor

did not include the goodwill, and the marks were expunged from the Register.

⁴ Sec. 37. It is fully dealt with above, p. 327.

⁵ See p. 413. Sec. 31 suggests three years non-user as a minimum. See p. 415.

⁶ *Welcome's Tm.*, 32 C. D. 213; 3 R. P. C. 76 (1886); *Hammond v. Bruncker*, 9 R. P. C. 301 (1892), both Chitty, J.

⁷ Above, p. 410, note (5).

is not being carried on." And it made no difference, he held, that the cessation of business was due to the ill-health of the proprietor. But the view that a goodwill would determine in so short a time is not consistent with the facts of ordinary business.¹

In a case where the licensees of a patent had, by arrangement with the patentees, registered a trade mark and used it on the patented goods, and on the determination of the licence the patentees contended that the mark ought to be expunged from the Register on the ground that the goodwill of the licensees had determined, as they could not make the patented goods, the application was dismissed, it being held that the mark in fact indicated the licensees as the source of the goods.²

3. Abandonment.

A trade mark right, as any other right, can, of course, be abandoned by the owner; but, so long as he remained the registered proprietor of the mark and carried on the business to which the mark was attached, it would be difficult, if not impossible, to show abandonment, unless, either by repeated and undisturbed infringements, or by the use of the mark by the proprietor himself in some way inconsistent with the maintenance of its character as a trade mark, it had become a common mark so as to fall under the first case,³ or a case could be made by any particular defendant sued for infringement by the owner to show that he had been led by the conduct of the plaintiff to believe that the mark was a common mark, and so to set up an estoppel.⁴

Agreement to
abandon
trade mark.

The possible case of an agreement by the proprietor to abandon his mark stands by itself. The other party to the agreement, if sued for infringement, could no doubt rely upon it as a defence, and probably could, if the mark were registered, obtain the

¹ See p. 413. Sec. 31 suggests three years non-user as a minimum. See p. 415.

² *Freeman Bros. v. Sharp Bros. & Co., Ltd.*, 16 R. P. C. 205 (1899), North, J.

³ Above, p. 405.

⁴ See the next chapter; estoppel, p. 465; acquiescence, p. 466; and delay, p. 468. See also *Browne v. Freeman*, 12

W. R. 305; 4 New Rep. 476 (1864), Wood, V.-C., where the dismissal, at his own request, of a previous suit by the plaintiff against the defendant, to restrain the use by the latter of *Chlorodyne*, was treated as conclusive against him that he had no exclusive right to use the word. He brought a third suit in 1873; W. N. 178.

removal of the mark from the Register, or an order, by way of specific performance of an implied term in the agreement, that the proprietor should apply under sec. 32 to cancel the registration.

Mere disuse of the mark does not amount to abandonment of trade mark rights in respect of it. For "A man who has a trade mark may properly have regard to the state of the market and the demand for the goods; it would be absurd to suppose that he lost his trade mark by not putting more goods on the market when it was glutted."¹ Accordingly, in the case cited, a mark was directed to be registered concurrently with a similar mark in the same class which had been previously registered, and which the Court refused to expunge, although the proprietor of the former mark, having adopted it in 1874 and used it largely in the two years following, from 1876 to 1882 had used it less and less, and had in the last-mentioned year forgotten and ceased to use it altogether. He had not, however, broken up the moulds he used for the marked goods, or erased the mark from his books or price lists. But if a proprietor ceases to have an intention of dealing in the goods for which the mark is registered, that would necessarily entail an abandonment of the mark so far as such goods were concerned.² And from a long disuse an intention to abandon might be inferred.³

Not mere disuse.

Under sec. 37 of the Act of 1905 non-user for five years in connection with any goods for which the trade mark is registered may be a cause for removal of the mark from the Register, and in effect in such a case is treated as an abandonment of the trade mark so far as rights arising from registration are concerned, unless "such non-user is shown to be due to special circumstances in the trade, and not to any intention not to use or to abandon such trade mark in respect of such goods."⁴ The Court, however, has a discretion under the section.

The adoption of a new mark may be evidence of the abandonment of an old one.⁵ But the fact of itself is not conclusive, for

Adoption of a new mark.

¹ Per Chitty, J., in *Mouson v. Boehm*, 26 C. D. 898 (1884). But if in the meantime the mark had come to indicate exclusively the manufacture of the registered owner, its use by another would have been deceptive. Cf. *Daniel and Arter v. Whitehouse*, [1898] 1 Ch. 685; 15 R. P. C. 184 (a passing-off case).

² *Batt's Tm.*, see above, p. 326.

³ Per Farwell, J., in *Louise & Co., Ltd. v. Gainsborough*, 20 R. P. C. 61 (1903); and see *Hart's Tm.*, [1902] 2 Ch. 621; 19 R. P. C. 569.

⁴ Sec. 37 is more fully considered above, p. 327.

⁵ *Lea v. Miller*, Seb. Dig. p. 305 (1876), Jessel, M.R.

it is no justification for the defendant to say, "The plaintiff has two ways of identifying his goods, and I have only stolen one of them."¹ So where, in opposition to the registration in 1896 of a mark as an old mark, it was shown that a new label had been adopted in 1877, and it was contended that the old mark had been abandoned either then or previously, but it was proved that a large number of the old labels had been ordered in 1877, and that there had been occasional user of them since, and that the stock of them had never been exhausted, it was held that there had been no abandonment.² The fact that the owner of a word mark uses it always in connection with his own name is not conclusive to show that the mark is not a trade mark, or that he has waived his rights in it as such.¹

Use in connection with the proprietor's name.

Neglect to prosecute infringements.

Neglect to proceed in respect of infringements which do not amount to user sufficient to affect the distinctiveness of the mark does not affect the proprietor's rights if he is aware of the infringements,³ still less if he is not.⁴

4. Forfeiture of Right to Protection.

The forfeiture of the right of the proprietor of a trade mark to have his trade mark protected by the Court is discussed elsewhere, under the head of defences to an action for infringement.⁵

5. Removal of Mark from the Register.

A trade mark may be removed from the Register, (a) at the instance of the registered proprietor or some person entitled by law to act in his name;⁶ (b) by the Court on an application to rectify the Register under sec. 35;⁷ or (c) by the Registrar on non-payment of renewal fees.

Removal by the Registrar for non-payment of fees.

Under the Act of 1883 the registration was perpetual, subject to liability to removal on non-payment of the prescribed fee at the end of each period of fourteen years.⁸ Under the Act of

¹ Per Wood, V.-C., in *Braham v. Bustard*, 1 H. & M. 447; 9 L. T. N. S. 199 (1863) (*Excelsior White Soap*).

² *Wright, Crossley & Co.'s Application*, [1900] 2 Ch. 218; 17 R. P. O. 386, Byrne, J.

³ *Kinahan v. Bolton*, 15 Ir. Ch. 75 (1863), Brady, C.; *Ford v. Foster*, L. R. 7 Ch. 611 (1872), L.J.J.; *Rowland v. Mitchell*, 13 R. P. O. 457; 14 R. P. O. 37 (1897), Romer, J., and C. A.; and see

above, p. 409.

⁴ *Re Farina*, 27 W. R. 456 (1879), Hall, V.-C. See the next chapter, at p. 468.

⁵ Chap. XV., at p. 472.

⁶ Sec. 32, above, p. 351.

⁷ Above, p. 311. Sec. 37 provides for rectification under sec. 35 on a special ground.

⁸ Sec. 79 of the Act of 1883.

1905, registration is only for a period of fourteen years, but is renewable from time to time. The position is substantially the same assuming that, as is submitted is the case, the sections printed below do not authorise the Registrar to impose conditions other than those relating to the time and manner of the application for renewal. The sections of the Act of 1905 and the Rules dealing with the renewal of registration are as follows:—

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

Duration of registration.

“29. The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period, renew the registration of such trade mark for a period of fourteen years from the expiration of the original registration or of the last renewal of registration, as the case may be, which date is herein termed ‘the expiration of the last registration.’

Renewal of registration.

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

Procedure on expiry of period of registration.

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

Status of unrenewed trade mark.

The Rules are as follows:—

“68. At any time not less than two months and not more than three months before the expiration of the last registration of a trade mark any person may leave at the office a fee for the renewal

of the registration of the mark upon Form TM No. 12.¹ Such person shall indorse upon such form his name and address, and before taking any further step the Registrar may require such person to furnish within five days an authority to pay such fee signed by the registered proprietor, and if such person does not furnish such authority, may return such fee and treat it as not received.

Notification of receipt of renewal fee.

“ 69. When he does not require such authority, the Registrar shall upon receipt of such fee communicate with the registered proprietor at his registered address, stating that the fee has been received and that the registration will in due course be renewed.

Notice before removal of trade mark from Register.

“ 70. At a date not less than one month and not more than two months before the expiration of the last registration of a mark, if no fee upon the Form TM No 12 has been received, the Registrar shall send to the registered proprietor at his registered address a notice in the Form O No. 3.²

Second notice before removal of trade mark from Register.

“ 71. At a time not less than fourteen days and not more than twenty-eight days before the expiration of the last registration of a mark, the Registrar shall, if no renewal fee has been received, send a notice to the registered proprietor at his registered address in the Form O No. 4.³

Advertisement of non-payment.

“ 72. If at the date of the expiration of the last registration of a mark the renewal fee has not been paid, the Registrar shall advertise the fact forthwith in the Journal, and if within one month of such advertisement the renewal fee upon Form TM No. 13,⁴ together with an additional fee upon Form TM No. 14,⁵ is received, he may renew the registration without removing the mark from the Register.

Removal of trade mark from Register.

“ 73. Where after one month from such advertisement such fees have not been paid, the Registrar may remove the mark from the Register as of the date of the expiration of the last registration, but may upon payment of the renewal fee upon Form TM No. 13, together with the additional fee upon the Form TM No. 15,⁶ restore the mark to the Register if satisfied that it is just so to do, and upon such conditions as he may think fit to impose.

¹ Appendix, p. 748. The ordinary fee is £1 for each mark, but there are concessions in the case of a series of marks, and in the case of a mark registered under sec. 62 for goods in more than one class, see List of Fees, p. 737.

² Appendix, p. 748.

³ Appendix, p. 748.

⁴ Appendix, p. 749.

⁵ Appendix, p. 749, additional fee, 10s.

⁶ Appendix, p. 750, additional fee, £1.

“74. Where a trade mark has been removed from the Register the Registrar shall cause to be entered in the Register a record of such removal and of the cause thereof. Cause of removal to be registered.

“75. Upon the renewal of a registration a notice to that effect shall be sent to the registered proprietor at his registered address and the renewal shall be advertised in the Journal.” Notice and advertisement of renewal.

The time table laid down by the above sections and rules is as follows:—During the third month before expiration of the registration, the registered proprietor or an authorised person may apply for renewal; in default the Registrar during the second month before expiration gives the first warning notice, on further default he gives a second warning notice during the fourth or third week before expiration; up to the date of expiration the ordinary fee only is payable; in default of renewal before expiration there is advertisement in the Journal forthwith, and if the additional fee is paid within one month after the advertisement, the Registrar may renew; in default the Registrar may remove the mark, but a discretion is given to him to restore it on payment of a higher additional fee. There appears to be an absolute right to renewal under sec. 29, if the application is made in the prescribed time and manner, including the payment of fee; and it is submitted that the words “the conditions as to fees and otherwise,” in sec. 30, only authorise conditions as to fees, time, and manner, so that, for instance, the Registrar could not impose a condition that the registered proprietor should disclaim part of the registered mark; and this seems to be the view taken in drafting the forms of notice referred to in Rules 70 and 71. It is clear, however, that if the trade mark has been properly removed from the Register, the Registrar has a discretion as to restoring it, and it may be also that he has some discretion if the renewal has not been made before expiration, the wording of Rule 72 being permissive. Right to renewal.

The owner of a trade mark which has been removed from the Register for non-payment of fees may, of course, make a new application for registration, but the removal may entail serious consequences, for the owner on a fresh application must justify the registration as at the date of the application. This is illustrated in a case in which an old mark had been removed for accidental non-payment of fees and was re-registered after a lapse of two years; but it was held that before the fresh registration the mark had, as to certain of the goods for which it was Re-registration.

registered, become descriptive of the article, and that registration was therefore held to be invalid as to such goods.¹

Status of removed mark.

Section 31 has reference to sec. 19;² its main object is the protection of the public. It is directed to prevent the registration by another trader, for the same goods or description of goods, of a mark the same as the removed mark, or so nearly resembling it as to be calculated to deceive, until such time after the removal of the other as is considered sufficient to allow the other to be forgotten, so that the new mark may not be taken for that of the proprietor of the old mark. The period provided for by the Act of 1883 was five years, but this was altered by the Act of 1888 to one year on the recommendation of Lord Herschell's Committee.³ The proviso "unless, &c.," is new,⁴ being substituted for one added by sec. 19 of the Act of 1888, which was as follows: "Unless it is shown to the satisfaction of the Comptroller that the non-payment of fees arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under the proprietor or under his bankruptcy is using the trade mark."

If the proprietor of the removed trade mark is in fact using it, then even after the expiration of the two years prescribed by the section he would have the ordinary right of the owner of an unregistered trade mark to oppose re-registration of the mark, or registration of a mark closely resembling it, on the ground that the proposed trade mark would be calculated to deceive.⁵

¹ *Bourne v. Swan and Edgar, Ltd.*, [1903] 1 Ch. 211; 20 R. P. C. 105, Farwell, J. (*Swanbill* for corsets).

² Chap. X., p. 247. It corresponds to sub-sec. 5 of sec. 79 of the Act of 1883,

which was amended by sec. 19 of the Act of 1888.

³ Report of 1888, p. xiii.

⁴ Cf. sec. 37.

⁵ Sec. 11, above, p. 297.

CHAPTER XV.

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It is convenient to deal separately with actions which are brought to prevent or to recover damages for the infringement of trade marks, and with what are compendiously described as "passing-off actions." In an action of the first class the plaintiff complains that the defendant has infringed his trade mark by taking it in its entirety, or by taking a substantial portion of it, or by colourably imitating it, and he relies on his title to the exclusive use of the mark in question for goods of a specified kind; in an action of the second class the plaintiff's case is less specialised, for he complains that the defendant is using means which are calculated to pass off, or to cause to be passed off, the goods of the defendant as and for those of the plaintiff, and the means may or may not comprise or consist of an infringement of a trade mark to which the plaintiff has a title. The distinction between the two classes of actions has been accentuated by the provision, already discussed, which makes registration a condition precedent, in general, to the institution of actions ranking in the first class, that is, trade mark actions proper.¹ They are, however, closely connected, and in practice they are frequently combined, the statement of claim alleging both infringement and passing-off. The first class is in reality a specialised variety of the second, having been divided off from other passing-off actions when property in a trade mark was first adopted as the ground of jurisdiction.²

Actions for
infringement
of trade mark
and actions
for passing-
off.

¹ Chap. XII., p. 373.

² Chap. I., pp. 4 and 13.

Moreover, as the test of infringement is still whether, by reason of its resemblance to the plaintiff's mark, the defendant's mark is calculated to lead purchasers to believe that the goods on which it appears are those of the plaintiff, every case of infringement would be a case of passing-off but for the fact that where the actual mark is taken, or an obvious imitation is made, the Court does not trouble to inquire whether deception is likely to result, and, in the former case, it seems that it is precluded from doing so by the provision that registration, if valid, gives an exclusive title to the use of the registered mark.¹

1. Commencement of the Action.

In what Court
a trade mark
action should
be com-
menced.

Jury.

The great majority of actions in respect of the infringement of trade marks are commenced in the Chancery Division of the High Court,² but such actions are not specially assigned to that division, and they have been occasionally transferred from it to the King's Bench Division in order to be there tried by jury.³ This was done by Kay, J., in a case where the defendant submitted to a perpetual injunction and the question of damages only remained, on the ground that in trade cases a jury is the best tribunal to assess damages;⁴ but in an earlier case, where the right to the injunction was contested, the defendants having given notice requiring the trial to be by a judge and a special jury, Bacon, V.-C., ordered that the action should be by a judge alone.⁵ The last-named judge also refused to order the complicated and difficult case of *The Singer Manufacturing Co. v. Loog*⁶ to be transferred to the Common Law Division so that the issues involved might be there tried with a jury, on the ground that the questions to be determined involved matters of law as well as fact, and were unfit to be dealt with by a jury.

No jurisdic-
tion in the
County Court.

An action for infringement of a trade mark cannot be brought in the County Court,⁷ although a trade mark is not a franchise,

¹ Sec. 39, Chap. XII., p. 363; and see *Edwards v. Dennis*, 30 C. D. 454 (1885), C. A.

² Or the Court of Chancery of the County Palatine of Lancaster. This Court has jurisdiction under sec. 71 of the Act of 1905, replacing sec. 112 of the Patents, &c., Acts, 1883 (Act of 1888, s. 26).

³ See *Re Martin, Hunt v. Chambers*, 20 C. D. 365 (1882); and Ord. 36, r. 6.

⁴ *Fennessy v. Rabbits*, 56 L. T. 138 (1887).

⁵ *Spratt's Patent v. Ward & Co.*, 11 C. D. 240 (1879).

⁶ 11 C. D. 656 (1879). In *Fennessy v. Clark*, 37 C. D. 184 (1887), the issues of fact were ordered to be tried by a judge and special jury.

⁷ *Bow v. Hart*, [1905] 1 K. B. 392; 22 R. P. C. 222, C. A.

as a patent is.¹ Such an action is not a personal action within the meaning of sec. 56 of the County Courts Act, 1888.

Service of the writ out of the jurisdiction may be allowed if the case falls under any of the classes enumerated in Order 11, rule 1, for instance, if the plaintiff seeks an injunction to restrain infringements within the jurisdiction;² but if the defendant carries on business in Ireland or Scotland, and not at all, or only to an inconsiderable extent, in England, leave to serve the writ upon him in either of the first-mentioned countries will be refused, and the plaintiff will be left to pursue his remedies in the local Courts.³ On this ground leave to serve out of the jurisdiction has been refused even where an application to register the defendant's mark was pending before the Comptroller in London on which the same witnesses would be required as in the action,⁴ and also where a motion to expunge the defendant's mark was pending in the English Courts.⁵ In the former case⁶ the refusal was based partly on the fact that if an injunction were granted it could not be enforced against the defendant personally in England, but only against his agents. But where a Scotch manufacturing company had three branches and an important business in England, leave was granted to sue them here.⁷

Service out of the jurisdiction.

An alien, not being the subject of a country actually at war with England, if he is the proprietor of a trade mark which exists as such in this country, may sue in the English Courts in respect of infringements in England.⁸ So in a trade name case in which the plaintiffs had prior to the commencement of

Action by foreigners.

¹ *Queen v. County Court Judge of Halifax*, [1891] 2 Q. B. 263; 8 R. P. C. 338, Pollock and Charles, JJ., and C. A.

² See *Badische Anilin v. Johnson*, [1896] 1 Ch. 25; 12 R. P. C. 535, C. A. Difficult questions of fact often arise as to whether a foreign corporation is resident within the jurisdiction; see, for instance, in the patent case, *Dunlop Pneumatic Tyre Co., Ltd. v. Actien Gesellschaft, &c., Vorm, Cudell & Co.*, [1902] 1 K. B. 342; 19 R. P. C. 46, where the defendants had simply a stand at an exhibition for show and sale of their goods; and other cases cited in Annual Practice, under Ord. IX., r. 8.

³ *Kinahan v. Kinahan*, 45 C. D. 78;

8 R. P. C. 18 (1890), Kekewich, J. As to the rectification of the registrations of marks belonging to foreigners, see Chap. XI., at p. 342.

⁴ *Marshall v. Marshall*, 38 C. D. 330 (1888), C. A.

⁵ *Kinahan v. Kinahan*, supra; cf. *King & Co.'s Tm.*, [1892] 2 Ch. 462; 9 R. P. C. 350.

⁶ *Marshall v. Marshall*, 38 C. D. 330 (1888), C. A.

⁷ *Burland v. Broxburn Oil Co.*, 41 C. D. 542; 6 R. P. C. 482 (1889), Chitty, J.

⁸ *The Collins Co. v. Brown*, 3 K. & J. 423 (1857), Wood, V.-C.; *The Collins Co. v. Reeves*, 28 L. J. Ch. 56 (1858), Stuart, V.-C.

action no place of business or agent in this country, yet as England was a market for their goods, it was held that they could sue to protect their trade name.¹ But sec. 42, prohibiting actions in respect of the infringements of unregistered trade marks, applies to trade marks belonging to foreigners.²

Notice of
action is un-
necessary.

No notice need be given to the alleged infringer before the action is brought,³ and the plaintiff's right to bring the action is not affected by ignorance on the part of the defendant of the plaintiff's claim to the mark, or the readiness of the defendant to cease the infringement when called upon to do so.⁴ "A plaintiff in these cases," Chitty, J., said, in *Upmann v. Forester*,⁵ "is placed in circumstances of difficulty, because if he were to give notice there is great probability of the defendant at once getting rid of the spurious articles before the plaintiff could interfere; and the plaintiff therefore would in many instances be affording the defendant an opportunity of doing what the injunction would have prevented. I well remember that the late Master of the Rolls, Sir G. Jessel, stated that he was, when at the Bar, accustomed in cases like this to advise his clients not to give any notice, but to move at once."⁶ And in a case in which the defendants had used a name to the exclusive use of which the plaintiffs were not entitled, but had also imitated a special scroll used by the plaintiffs, and it was suggested that the plaintiffs ought before action to have written to the defendants, stating that it was the scroll that they objected to, Lord Macnaghten said, "I cannot think that there is any substance in that objection. Why should a person assailed and injured by unfair competition teach his opponent how far he may safely go in undermining a rival business which he wishes to destroy? Why should he throw away the only chance of obtaining by process of law redress for injury already done?" Consequently the omission to give notice before action does not disentitle the plaintiff to costs.⁷

¹ *Société Anonyme, &c. Panhard et Levassor v. Panhard Levassor Motor Co., Ltd.*, [1901] 2 Ch. 518; 18 R. P. C. 405, Farwell, J.

² See *Goodfellow v. Prince*, 35 C. D. 9 (1886), C. A.; and above, Chap. XII., p. 375; although Malins, V.-C., expressed a contrary opinion in *Twentsche, &c. v. Ellinger & Co.*, 26 W. R. 70 (1887).

³ *Pierce v. Franks*, 15 L. J. Ch. 122 (1846), Knight Bruce, V.-C.

⁴ *Burgess v. Hately*, 26 Beav. 249 (1858), Romilly, M.R.

⁵ 24 C. D. 231 (1883).

⁶ *Ibid.* The very life of a trade mark depends upon the promptitude with which it is vindicated. *Johnson v. Orr-Ewing*, 7 App. Ca. 219 (1882).

⁷ See below, p. 506.

The action is one of tort, and, consequently, every infringer is liable to be sued, whether he acted on his own behalf or as agent for a principal. But a mere servant should not, it seems, be added as a defendant.¹ An innocent partner of the infringer defendant, who has repudiated the wrongful act of his co-partner, is not, it appears, liable to be sued.²

Agents and partners of infringer.

Directors of a limited company which is sued for infringement should not be joined as defendants if there are no specific allegations against them other than that they are directors.³

Directors.

2. The Plaintiff's Title.

The plaintiff must be owner of the trade mark⁴ which is alleged to have been infringed, and the onus of proving that he is entitled to the exclusive use of the mark for the particular class of goods (subject, if the case is so, to the concurrent rights of persons, other than the defendant, who are also owners of the same or a similar trade mark) lies upon him.⁵ So where three persons, a manufacturer, a shipper, and a foreign consignee, devised a trade mark in concert, and used it for goods sent by the manufacturer through the shipper to the consignee, and afterwards the manufacturer began to use it for goods not sent

Joint trade marks.

¹ *Daniel and Arter v. Whitehouse*, 16 R. P. C. 71 (1899), North, J. (a motion to commit).

² *Magnolia Metal Co. v. Atlas Metal Co.*, 14 R. P. C. 389 (1896), Collins, J., and C. A. A passing-off case in which the innocent partner had repudiated the acts of his co-partners and sought a dissolution, and had, of course, separated in his defence. It was said by Collins, J., and Chitty, L.J., that the passing-off was not within the scope of the authority given by one partner to another, but the same remark would apply to an innocent employer whose manager commits the wrong. Cf. *Grierson, Oldham & Co. v. Birmingham Hotel Co.*, 18 R. P. C. 158 (1901), Buckley, J., where an hotel company was held responsible for passing-off by waiters contrary to orders; also *Cusenier Fils v. Gaiety Bars and Restaurant Co., Ltd.*, 19 R. P. C. 357 (1902), Buckley, J., and *Havana Cigar and Tobacco Factories, Ltd. v. Tiffin* (1905), *Ltd.*, 26 R. P. C. 177, 473 (1909), C. A., reversing Warrington, J. It is

submitted that *The Magnolia* case must not be considered as an authority for the general proposition that only partners who are aware of the wrongful acts can be sued. As to damages against an infringer who is innocent of fraud, see below, p. 502.

³ *Cropper Minerva Machines Co., Ltd. v. Cropper, Charlton & Co., Ltd.*, 23 R. P. C. 388 (1906), Farwell, J. Cf. with the patent case, *Betts v. De Vitre*, 3 Ch. 441 (1868).

⁴ The questions, What is a Trade Mark? and What can be Registered as a Trade Mark? are discussed in Chap. II., p. 23; and Chap. VIII., p. 135. The special right of suing to restrain the use of the Royal Arms, &c., conferred by sec. 68 is not, of course, a right to sue for infringement of a trade mark, and constitutes, therefore, no exception to the rule; see below, p. 428.

⁵ *Robinson v. Finlay*, 9 C. D. 487 (1877), C. A. As to concurrent rights, see below, p. 456.

through the shipper, and the shipper for goods not obtained from the manufacturer, and cross-actions for infringement were brought by the shipper and the manufacturer, it was held that neither of them could make out a title to exclusive use, and both actions were dismissed.¹

In a case where Messrs. Harper and Moore, the plaintiffs, had been the lessees of certain brickworks, and had been accustomed to make bricks of the clay produced by mines of which they were lessees also, and, after the expiration of their leases, the defendants, who had obtained a lease of the brickworks only, advertised themselves as "E. & J. Pearson (late Harper and Moore)," thereby suggesting that they were successors to the old brick-making business, Wood, V.-C., granted an injunction to restrain the advertisements, and he said he would have granted it as a matter of course had the owner of the mines been plaintiff in the suit. The learned Vice-Chancellor seems, therefore, to have been of opinion that both he and the plaintiffs were interested in the old firm name.²

Where lamps known as Stewart Arc Lamps had been manufactured by a company in America to the special order of an English company who had acted as the sole agents in this country of the American company, it was held that the name Stewart Arc Lamps had become associated in this country with the English company, and that their successors had the right to use the name and were entitled to an injunction to prevent the American Company from using the word "Stewart" without clearly distinguishing their lamps from those of the successors of the English company.³

A mere importer has no title to sue for infringement of the trade marks of the consignor or producer.⁴

¹ Last case. A custom in Manchester, by which the shipper, in the absence of agreement, was the owner of the trade mark, was alleged but not proved. *Jones' Tm.*, 53 L. T. 1 (1885), C. A., is a similar case. See also *Rivière's Tm.*, 55 L. J. Ch. 545; 53 L. T. 237 (1885), Pearson, J., cited p. 313. Cf. *Van Zeller v. Mason, Cattley & Co.*, 25 R. P. C. 37 (1908), Joyce, J. (*Küpke Roriz*), where that mark was held to indicate the produce of a particular vineyard, and not such produce when sold and

shipped by a particular firm only.

² *Harpers v. Pearson*, 3 L. T. N. S. 547 (1860); cf. *Motley v. Downman*, 3 My. & Cr. 1; 6 L. J. Ch. (N. S.) 308 (1837), Cottenham, L.C.

³ *Defries & Son, Ltd. v. Electric and Ordnance Accessories Co., Ltd.*, 23 R. P. C. 341 (1906), Joyce, J.

⁴ *Hirsch v. Jonas*, 8 C. D. 584 (1876), Jessel, M.R.; see Chap. II., at p. 58: Chap. IV., at p. 73, and *Goodfellow v. Prince*, 35 C. D. 9 (1887), C. A.

The plaintiff does not become owner of the trade mark, or acquire any interest in it sufficient to enable him to sue for infringement, by a contract with the proprietor for the exclusive purchase of the marked goods consigned to a particular district.¹ Even if the contract were for the exclusive purchase of all the marked goods manufactured by the proprietor, so that, if the contract was duly observed, no goods could be rightly marked which did not pass through the plaintiff's hands, the mere fact of the plaintiff having by contract this exclusive right would not, it would seem, confer on him the right to sue for infringement of the mark, or to prevent other persons from using it on goods which were not the goods of the manufacturer; quite apart from matters of registration,² unless the mark was his in the sense that it indicated that the goods had passed through his hands, he would have no right of action for infringement nor for passing-off.³ The question whether a trader, exclusively entitled by contract with the proprietor to purchase his goods, could rightly register the proprietor's mark as his own, of course with the proprietor's assent, was discussed but left undetermined in *The Apollinaris* case.⁴

Where the plaintiff is the sole purchaser from the proprietor.

One or more of several persons concurrently entitled may bring the action.⁵ This is expressly so provided by the proviso to sec. 39 of the Act of 1905 (the section which confers the exclusive right to use), which enacts that where two or more persons are registered proprietors of the same (or substantially the same) trade mark in respect of the same goods, no rights of exclusive user of such trade mark shall (except so far as their

Action by one proprietor or by several.

¹ *Richards v. Butcher*, 7 R. P. C. 288 (1890), Kay, J., leave to add the proprietor as plaintiff granted; *Dental Manufacturing Co., Ltd. v. De Trey*, a passing-off case cited in note (3); cf. *Woolley v. Broad*, [1892] 1 Q. B. 806, exclusive licensee of registered design; and *Heap v. Hartley*, 42 C. D. 461 (1889), exclusive local licensee of a patent cannot sue.

² See *Goodfellow v. Prince*, 85 C. D. 9 (1887), C. A.

³ *Goodfellow v. Prince*, cited in last note, a trade name case; *Richards v. Butcher*, above note (1); and *Dental Manufacturing Co., Ltd. v. De Trey*, [1912] 3 K. B. 76; 29 R. P. C. 617, a passing-off action brought after the

contractual relationship had been determined; see also *Warwick Tyre Co., Ltd. v. New Motor and General Rubber Co., Ltd.*, 27 R. P. C. 161 (1910), Neville, J., cited above, p. 395, where the plaintiffs were held to have a right of action, although the whole of the manufacture and sale was done by other companies under contracts between them and the plaintiffs.

⁴ [1891] 2 Ch. p. 231; 8 R. P. C. 137, Fry, L.J., cited above, p. 313.

⁵ *Hine v. Lart*, 7 L. T. (O. S.) 41 (1846), Shadwell, V.-C.; *Dent v. Turpin*, 2 J. & H. 139; 30 L. J. Ch. 495 (1861), Wood, V.-C.; *Southorn v. Reynolds*, 12 L. T. (N. S.) 75 (1865), Wood, V.-C. As to passing-off actions, see below, p. 527.

respective rights shall have been defined by the Court) be acquired by any one of such persons as against any other by the registration thereof, but each of such persons shall otherwise have the same rights as if he were the sole registered proprietor thereof. Several plaintiffs so entitled may join together to sue although their interests are distinct and separate.¹ But only a limited number of persons or firms can be concurrently entitled to a mark. If a large number, and, apparently, if more than three, become so entitled, the mark becomes a common mark.²

Plaintiff must use or intend to use the mark.

It would seem that the plaintiff must be using, or intending to use, the mark, for no damage would otherwise be occasioned to him by the infringement.³ It has been held that a mortgagee who does not intend to use the mark cannot bring an action in respect of its infringement,⁴ and intention to use is one of the conditions precedent to proper registration.⁵

Action survives to executors, and they may sue.

Infringement of a trade mark is an interference with a right of property injuring the personal estate of the owner, and consequently the right of action in respect of it is not determined by the death of the owner, and proceedings may be begun or continued⁶ by his executors. Of course, if the executors have possession of the goodwill of their testator's business, and are carrying on his trade, they can themselves be registered, and can sue as owners of the trade marks employed in the business and attached to the goodwill.⁷

Unauthorised assumption of the Royal Arms, &c., may be restrained.

A person who, without proper authority, uses the Royal Arms or arms so closely resembling them as to be calculated to deceive, or any device, emblem, or title in a manner calculated to lead to the belief that he is employed by or supplies goods to a member of the Royal Family, is liable to be restrained from so doing at the suit of any person who is authorised to use such arms, device, emblem, or title, or is authorised by the Lord Chamberlain

¹ *Dent v. Turpin*, above, p. 427, note (5), and *Universities of Oxford and Cambridge v. Gill*, [1899] 1 Ch. 55, Stirling, J.

² *Ehrmann's Tms.*, [1897] 2 Ch. 495; 14 R. P. C. 665, Stirling, J. The question was as to the rights of the partners on dissolution of a firm. See now sec. 23 and cf. sec. 74, sub-sec. (3) of the Act of 1883, Appendix, p. 698.

³ And see above, p. 366.

⁴ *Beazley v. Soares*, 22 C. D. 660 (1882), Pearson, J., a trade name case.

⁵ Sec. 87; and *Apollinaris Co.'s Tms.*, [1891] 2 Ch. p. 233; 8 R. P. C. 137; *Batt & Co.'s Tm.*, [1898] 2 Ch. 432; [1899] A. C. 428; 15 R. P. C. 262, 534; 16 R. P. C. 411; see above, Chap. XI., at pp. 326 and 327.

⁶ *Oakey v. Dalton*, 35 C. D. 700; 4 R. P. C. 813 (1887), Chitty, J.

⁷ See Chap. XIII., p. 384; and *Masam v. J. W. Thorley's Cattle Food Co.*, 6 C. D. 574; 14 C. D. 748 (1877), Malins, V.-C., and C. A.

to take proceedings in that behalf.¹ Such an action, although analogous to an action for infringement of trade mark, is a purely statutory one, and differs in particular from an ordinary infringement action in that the person suing is not the proprietor of the mark, the unauthorised use of which is complained of in the action. In several actions under the section injunctions have been granted.²

3. Registration.

The plaintiff must, before the commencement of the action, or, at any rate, at the date of the hearing,³ be the registered proprietor, except that if the mark was in use before August 13th, 1875, the plaintiff may show that registration of it has been refused.⁴ In each case the registration and the name of the registered proprietor, or the refusal, may be shown by the certificate of the Registrar, or by sealed and certified copies of or extracts from the Register.⁵

Proof of registration of the trade mark.

But the registration of the successor in title of the original proprietor—his assignee, for instance—is not necessary to enable the successor to commence an action.⁶

Registration of assignment is unnecessary before action.

The registration of a person as proprietor of a trade mark is *prima facie* evidence of the validity of the original registration and of all subsequent assignments and transmissions,⁷ and is, subject to certain exceptions, after seven years from the date of the original registration, or from August 11th, 1905⁸ (whichever shall last happen), conclusive evidence of the validity of the original registration;⁹ and registration, if valid, confers the

Registration as evidence of title.

¹ Sec. 68. The section is fully set out below, p. 689. There is a proviso saving the right (if any) of the proprietor of a trade mark containing such arms, device, &c.

² For instance, in *Royal Warrant Holders' Association v. Slade & Co., Ltd.*, 25 R. P. C. 245 (1908), Swinfen Eady, J., and *Same v. Dean and Beal, Ltd.*, [1912] 1 Ch. 10; 28 R. P. C. 721.

³ *Hassopulo v. Kaufmann*, 23 Sol. J. 819 (1879), Little, V.-C.; *Magnolia Metal Co. v. Atlas Metal Co.*, 14 R. P. C. 389, at p. 394 (1897), Collins, J. See further, above Chap. XII., at p. 376.

⁴ Sec. 42; see Chap. XII., p. 373.

⁵ Secs. 7, 50 and 51 of the Act of 1905 and sec. 64 of the Patents and Designs Act, 1907, replacing sec. 84 of the Act of 1883. Form of Request for Certificate of Registration to be used in legal proceedings, TM No. 34, Appendix, p. 761. Fee £1. Form of Request for Certificate of Refusal to Register, TM No. 32, Appendix, p. 760. Fee £1.

⁶ *Ihlee v. Henshaw*, 31 C. D. 323; 3 R. P. C. 15 (1886), North, J. See further, above, Chap. XII., at p. 376.

⁷ Sec. 40; Chap. XII., at p. 367.

⁸ The passing of the Act.

⁹ Sec. 41; Chap. XII., at p. 368.

exclusive right to the use of the trade mark for the goods in respect of which it is registered.¹

So that after the expiration of the above-mentioned period of seven years² objections to the original registration cannot be raised against the plaintiff,³ unless the registration was (a) obtained by fraud, or (b) unless the trade mark is calculated to deceive, or otherwise offends against sec. 11 of the Act.⁴ Other objections may, however, be taken;⁵ it may be shown, for instance, that the plaintiff does not possess the goodwill of the business to which the mark is attached.⁶

Registration modified by a disclaimer or otherwise.

But the registration is, of course, evidence only of such title as it shows, and the plaintiff's right is accordingly subject to the modification imported by any limitation or condition entered upon the Register in connection with it.⁷ In particular, if there is any disclaimer of part of the registered mark, the registered proprietor has no title to sue in respect of an alleged infringement constituted by the adoption of such part of the mark, for the disclaimer is an indication to all the world that he has no monopoly, by reason of the registration, of the use of that part, at all events by itself.⁸

¹ Sec. 39; Chap. XII., at p. 363.

² In *Apollinaris Co. v. Snook*, 7 R. P. C. 474 (1890), although the mark had not been registered for five years (the period under the Act of 1883), Kekewich, J., at the hearing refused to listen to an argument that it ought not to have been registered; but, apparently, his attention was not called to the point in question. And in *Compagnie Générale v. Rehder*, 5 R. P. C. 61, at p. 65 (1888), Kay, J., took a similar course upon an application for an interim injunction. See also *Hommel v. Bauer & Co.*, 20 R. P. C. 802 (1903), Byrne, J. In *Stuart v. Scottish Val de Travers Co.*, 13 Ct. of Sess. Ca. 1 (1885); and *Lever v. Goodwin*, 4 R. P. C. 492 (1887), Chitty, J., objections to marks registered for less than five years were allowed at the hearing, there being no application to rectify. And in *Free Fishers of Whitstable v. Elliot*, below, p. 576 (not reported on this point), Stirling, J., decided that this could be done. See also the Scotch case of *Dewar, Ltd. v. Dewar*, 17 R. P. C. 841 (1900), which, however,

turned on the question of an inherent jurisdiction in the Scotch Court.

³ For cases under the Act of 1883, see *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478 (1887), C. A.; *Edwards v. Dennis*, 30 C. D. 454 (1885), C. A.; and *Verity's Tm.*, 19 R. P. C. 58 (1902), Buckley, J.

⁴ Sec. 41, Chap. XII., at p. 368.

⁵ Above, Chap. XII., at pp. 370-378.

⁶ Sec. 22; *Pinto v. Badman*, 8 R. P. C. 181 (1891), C. A.; *Ullmann & Co. v. Leuba*, [1903] A. C. 443; 25 R. P. C. 673.

⁷ Sec. 39, above, p. 363.

⁸ *Rosenthal v. Reynolds*, [1892] 2 Ch. 801; 9 R. P. C. 189, North, J.; *Pirie v. Goodall*, [1892] 1 Ch. 85; 9 R. P. C. 17, C. A.; Chap. IX., at p. 242. A dictum of Ld. Alverstone in *Hubbuck v. Brown*, 17 R. P. C. 638 (1900), suggests that although the exclusive use of part of a mark is disclaimed, nevertheless the proprietor may rely on the whole combination; see also *Pirie v. Goodall*, [1892] 1 Ch. 85. As to passing-off cases based upon disclaimed matter, see next chapter, p. 574.

The exclusive right to use conferred by sec. 39 is subject to the provisions of sec. 41, preserving the rights of users anterior to the first use of the registered mark. It is also subject to the general provision contained in sec. 44, that no registration under the Act shall interfere with any *bonâ fide* use by any person of his own name or place of business, or that of any of his predecessors in business, or to the use by any person of any *bonâ fide* description of the character or quality of his goods.

And the right to exclusive use is subject to the rights of any person who has obtained concurrent registration,¹ and to the concurrent rights, if any exist, of other persons to use the mark upon obtaining registration.²

By concurrent rights.

The seven years' registration does not, it is submitted, prevent the defendant, although he has made no application to rectify, or although the Court has no jurisdiction to entertain any such application which he has made, from setting up a defence that the plaintiff's right has determined by abandonment or otherwise,³ or has been wholly assigned to another.⁴ And it is, it is also submitted, no answer to a personal bar which disentitles the plaintiff to sue.

Plaintiff's title determined or barred.

4. What constitutes Infringement.

Infringement is the use by the defendant, for trading purposes⁵ upon or in connection with goods of the kind for which the plaintiff's right to exclusive use exists⁶ (*i.e.*, goods in respect of which his mark is registered,⁶) not being the goods of the plaintiff,⁷ of a mark identical with⁸ the plaintiff's mark, or comprising some of its essential features, or colourably resembling it,⁹ so as to be calculated to cause goods to be taken by ordinary purchasers¹⁰ for the goods of the plaintiff.

It has long been settled that the question of the relative excellence of the plaintiff's and the defendant's goods is not relevant

Inferiority of the defendant's goods.

¹ The proviso to sec. 39, fully set out above, p. 364.

² Sec. 21 and below, p. 456.

³ Chap. XIV., p. 404.

⁴ This is consistent with the fact that an unregistered assignee can sue, see p. 429.

⁵ Page 433.

⁶ Sec. 39, below, p. 435.

⁷ Page 437.

⁸ It is usually so expressed. What is meant is, of course, "similar to"; but "similar to" and "resembling" are constantly used to convey the proper meaning of the latter word; see *Welch v. Knott*, 4 K. & J. 747 (1857), Wood V.-C.

⁹ Page 444.

¹⁰ Page 448.

to the right of the plaintiff to maintain an action either for infringement or for "passing-off,"¹ and this has, accordingly, no place in the above definition. It may, however, affect the amount of the damages to be recovered by the plaintiff if he succeeds, for damages are sometimes claimed and allowed in respect of injury occasioned to the trade reputation of the plaintiff by the defendant's infringement or fraud.² If the defendant's goods are as excellent as his own, the reputation of the plaintiff cannot have been injured by a substitution of one for the other.

Single act of infringement.

The Court has refused to regard an isolated act, done at the request of the plaintiff's agent, who was laying a trap for the defendant, as an infringement.³ This must be taken as a special case, however, for, in general, proof of a single act of infringement by the defendant is sufficient to justify the plaintiff in bringing his action,⁴ and the evidence relied on is frequently the sale by the defendant of the spurious goods to the plaintiff or his agent,

¹ *Blofield v. Payne*, 4 B. & Ad. 410; 2 L. J. K. B. (N. S.) 68 (1833); *Edelsten v. Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, L.C.; and see *per* Ld. Blackburn, in *Singer Manufacturing Co. v. Loog*, 8 App. Ca. p. 29.

² See, for instance, *Alexander v. Henry*, 12 R. P. C. 360 (1895), Kekewich, J.

³ *Hennessy v. Kennett*, Seb. Dig. p. 331 (1877), Malins, V.-C.; cf. *Leahy, Kelly and Leahy v. Glover*, 10 R. P. C. 141 (1893), where a single instance of the sale of goods by the defendant's shopwoman, not shown to have been with his authority, was considered insufficient to support a case of passing-off; *Rutter v. Smith*, 18 R. P. C. 49 (1901), Kekewich, J.; and *Knight & Sons, Ltd. v. Crisp & Co., Ltd.*, 21 R. P. C. 671 (1904), Warrington, J., similar cases; *Burberrys v. Watkinson*, 23 R. P. C. 141 (1906), Warrington, J., an isolated instance of mistake; *Donohoe, Ltd. v. Cherry Bros., Ltd.*, 26 R. P. C. 545 (1909), M.R. Ireland, where a few mistakes only in a large trade were established; and *Armstrong Oiler Co., Ltd. v. Patent Axlebox and Foundry Co., Ltd.*, 27 R. P. C. 362, an isolated instance of a mistake by a workman, and the plaintiffs, who failed

on the rest of the case, were ordered to pay the costs, except so far as they had, down to the giving of an undertaking, been increased by this complaint. See also *Carr & Sons v. Crisp & Co., Ltd.*, 19 R. P. C. 497 (1902), where Byrne, J., said that if one instance only had been proved he would have followed *Leahy v. Glover*; and *Kodak, Ltd. v. Grenville*, 25 R. P. C. 416 (1908), Eve, J., where the only question was as to costs. Cf. *Hennessy & Co. v. Neary*, 19 R. P. C. 36 (1902), Chatterton, V.-C., Ireland. Where, in a passing-off case, it appeared that the defendants had issued 35,000 circulars containing an incorrect statement, the Court refused to treat this as an isolated act, and held that it was not sufficient that the defendants had offered an undertaking before action, but without doing anything to neutralise the effect of this issue of the circulars, *Yeatman v. Homberger & Co.*, 29 R. P. C. 561 and 645 (1912) (*Taylor's Port*); before the hearing of the appeal the defendants had issued a circular correcting the error.

⁴ See, for instance, *American Tobacco Co. v. Guest*, [1892] 1 Ch. 630; 9 R. C. P. 218, where an injunction was granted but costs refused.

who has bought them merely for the purpose of procuring evidence.¹ Whenever trap orders are resorted to, they should be scrupulously fair.²

An employer will be held responsible for the wrongful acts of infringement or passing-off on the part of his servants done in the course of the employer's business and within the scope of his employment, notwithstanding that the acts were done without the employer's knowledge,³ or even contrary to his express orders;⁴ but it does not follow that an injunction will be granted in every case where this is established.⁵

Employer responsible for servant's acts.

The defendant must be shown to have used or intended to use the goods marked with the spurious mark for trading purposes whether for sale or as samples to enable him to sell similar goods, —and whether these are or are not themselves so marked—for the essence of the wrong is that purchasers of the spuriously marked goods are deceived, and the plaintiff incidentally suffers by the loss of their custom which would or might, but for the

Defendant must use or intend to use the marked goods for trading purposes.

¹ *Dunlop Pneumatic Tyre Co. v. Neal*, [1899] 1 Ch. 807; 16 R. P. C. 247, North, J., a patent case, where the plaintiffs succeeded, although the only infringement proved was done for their agent.

² *Californian Fig Syrup Co. v. Taylor's Drug Co.*, 14 R. P. C. 564 (1897), C. A. Trap orders should, wherever possible, be in writing, and, whenever complete, some warning, by proceedings or otherwise, should as soon as possible be given to the defendant that the transactions are going to be called in question: *Carr & Sons v. Crisp & Co., Ltd.*, 19 R. P. C. 497 (1902), Byrne, J. And see *Burberrys v. Watkinson*, 23 R. P. C. 141 (1906), Warrington, J.

³ *Tonge v. Ward*, 21 L. T. (N. S.) 480 (1869), Romilly, M.R.; *Twentsche v. Ellinger*, 26 W. R. 70 (1877), Malins, V.-C.; *Cusenier Fils v. Gaiety Bars and Restaurant Co., Ltd.*, 19 R. P. C. 357 (1902), Buckley, J.; *Hennessy & Co. v. Neary*, 19 R. P. C. 36 (1902), Chatterton, V.-C., Ireland; and *Havana Cigar, &c., Factories, Ltd. v. Tiffin (1905) Ltd.*, 26 R. P. C. 473 (1909), where the Court of Appeal held the defendant company liable for the acts

of the persons intrusted by it with the selling of the particular goods.

⁴ *Criverson, Oldham & Co. v. Birmingham Hotel Co., Ltd.*, 18 R. P. C. 158 (1901), Buckley, J. (*Big Tree Brand*); *Monro v. Hunter*, 21 R. P. C. 296 (1904), Channell, J. But in a Scotch case, *Montgomerie & Co., Ltd. v. Young*, 20 R. P. C. 781; 21 R. P. C. 285 (1904), Inner House, reversing Lord Ordinary, Ld. Young held that where a servant, either accidentally or otherwise, violates the express orders of her master not to commit a wrong of this nature, interdict ought not to be granted against the master. Ld. Trayner also held that in view of the precautions taken by the master, even if a few instances had arisen from inadvertence on the part of servants, an interdict should not be granted. The case was a somewhat special one, and a different view as to an employer's liability has been taken in the English cases. See *Parozone Co., Ltd. v. Gibson*, 21 R. P. C. 317 (1904), Ld. Low, Scotland; also above, p. 425, note (2).

⁵ *Lever Bros., Ltd. v. Masbro' Equitable Pioneers Society, Ltd.*, 29 R. P. C. 34 and 225 (1912), Joyce, J., and C. A.

fraud, come to him.¹ But the Court will not readily believe that the defendant does not intend to use vendible goods marked with the spurious mark for trading purposes if they are found in his possession, and either he is a trader in goods of the kind, or the quantity of the goods is considerable.² So where the defendant, a china manufacturer, had imported 5,000 spuriously marked cigars, he was held liable, although he did not know that the mark was spurious, and said that he intended the cigars "for family use."²

And the use of the plaintiff's mark on goods for which it is registered may be an infringement, although it is intended merely as an advertisement of another description of goods.³

Infringement must be within the realm.

And the infringement must occur within the realm.⁴ It is sufficient if the spuriously marked goods are brought by the defendant into this country for export to a country where the plaintiff's trade and marks are known,⁵ and it is, of course, sufficient if goods are spuriously marked by him in this country for export.⁶

Whether infringement must be in plaintiff's market.

If the plaintiff's registered mark, or its essential particulars, are actually copied, it appears to be immaterial, in order to entitle the plaintiff to an injunction, whether the infringement

¹ *Levy v. Walker*, 10 C. D. 486 (1879), C. A.; *Richards v. Butcher*, 7 R. P. C. 288 (1890), Kay, J.

² *Upmann v. Forester*, 24 C. D. 231 (1883), Chitty, J.

³ *Nitedals Taendstikfabrik v. Lehmann & Co., Ltd.*, 25 R. P. C. 793 (1908), Joyce, J., interlocutory injunction granted. The plaintiffs were the registered proprietors of the device of a cow and the word "cow" in respect of matches, and the defendants were held to have infringed by selling matches in boxes having on them the device of a cow and the words "Cow Brand," to advertise their "Cow Brand" condensed milk.

⁴ Cf. the patent cases, *British Motor Syndicate v. Taylor*, [1900] 1 Ch. 577; [1901] 1 Ch. 122; 17 R. P. C. 189, 723, where goods were bought in England and sold abroad, with *Badische Fabrik v. Basle Chemical Works*, [1898] A. C. 200; 14 R. P. C. 919, where the defendants, who had effected a sale by post in Switzerland, and had despatched

the goods addressed to an English trader from there, were held not to be liable. An English Court has no jurisdiction to prevent infringements which take place wholly abroad: *Morocco Bound Syndicate v. Harris*, [1895] 1 Ch. 584, Kekewich, J. (copyright); and see the patent case, *Badische Fabrik v. Hickson*, [1906] A. C. 419; 23 R. P. C. 433, where there was held to have been no vending in England; and the design case, *Potter v. Braco de Prata Printing Co., Ltd.*, 8 R. P. C. 218 (1891), Court of Sess., but as to designs, see now sec. 60 of the Patents and Designs Act, 1907, and *Haddon & Co. v. Bannerman & Son*, [1912] W. N. 193; 29 R. P. C. 611.

⁵ *Joseph Rodgers & Sons v. Rottgen*, 5 Times L. R. 678 (1889), Kay, J.; *Tm. of The Société, &c. des Verreries de l'Étoile*, [1894] 1 Ch. 61; 2 Ch. 26; 10 R. P. C. 436; 11 R. P. C. 142, Stirling, J., and C. A. (*Red Star Glass*).

⁶ *Orr-Ewing v. Johnston*, 13 C. D. 434; 7 App. Ca. 219, is an illustration.

takes place within the area in which the mark is known or not, because the exclusive right conferred by the Act extends, in the absence of any limitation on the Register, to the whole Kingdom.

If the case is one of colourable infringement, and the plaintiff's case is founded on the probability of deception in a particular market, the injunction granted might under special circumstances be limited to that market;¹ but, except in such cases, it is submitted that the question whether there is a probability of deception must be considered on the assumption of the defendant's mark coming into competition with the plaintiff's mark, and that the fact that the marks had hitherto been respectively confined to different districts within the jurisdiction would not be a defence in law. An injunction has been granted where the plaintiff's and the defendant's areas, though substantially local and distinct, were both within the realm and were beginning to overlap.²

The use must be upon or in connection with the goods for which the plaintiff's right exists. The exclusive use conferred by sec. 39 is expressly so limited.³ The authorities prior to the Act were to the same effect. "There can be no right to the exclusive ownership of any symbols or marks universally in the abstract. Thus an ironfounder who has a particular mark for his manufactures in iron could not restrain the use of the same mark when impressed on cotton or woollen goods; for a trade mark consists in the exclusive right to the use of some name or symbol as applied to a particular manufacture or vendible commodity."⁴ And the third essential ingredient for

Defendant must use the mark upon or in connection with the goods for which the plaintiff's right exists

¹ In "passing-off" cases where the plaintiff's mark has been used only in a limited area, he sometimes obtains an injunction restricted to such area. See next chapter, at p. 612. In the *Orr-Ewing* case, Cotton, L.J., thought that the injunction ought to have been limited to Eastern markets, had the defendants been trading in any others. It would rarely be practicable to give complete protection in such manner. See *Société V. de l'Étoile Tm.*, [1894] 1 Ch. 61, p. 67; 10 R. P. C. 441, Stirling, J.; and the observations of Kay, L.J., in the same case, during argument on appeal, 11 R. P. C. 145.

² *Paine & Co. v. Daniells & Sons*

Breweries, [1893] 2 Ch. 567; 10 R. P. C. 71, 217, C. A. (*John Bull Beer*). The injunction was unlimited. In a passing-off case it is no defence that the plaintiff's trade in the defendant's market is small: *Grant v. Levitt*, 18 R. P. C. 361 (1901), Porter, M.R., Ireland (*Globe Furnishing Co.*); *Faulder & Co., Ltd. v. Rushton, Ltd.*, 20 R. P. C. 477, at pp. 484, 492, 494. And see *Passing Off*, Chap. XVI., pp. 567, 612.

³ Above, p. 365.

⁴ *Per* Ld. Westbury, in *Hall v. Barrows*, 4 De G. J. & S. 150; 33 L. J. Ch. 204 (1863).

constituting an infringement, enumerated by Lord Westbury in *McAndrew v. Bassett*,¹ is "that the defendants have imitated the mark for the purpose² of passing in the market other articles of a similar description."

The limits of the class of goods over which the right in respect of a registered mark extends have been discussed already,³ and the class has been shown to be not necessarily co-extensive with any register class,⁴ and it has also been shown that the registered proprietor's right ought to be limited, and the registration restricted substantially to the kinds of goods upon which he actually uses or intends to use the mark,⁵ and that the Court would probably refuse relief in respect of other goods.

and is regis-
tered,
and used.

The plaintiff cannot sue for infringement in respect of goods for which his mark is not registered,⁶ although, if he can make a case, he may sue to restrain passing-off. And if his mark is

¹ 4 De G. J. & S. 380; 33 L. J. Ch. 561 (1863).

² Fraudulent intent is not now essential, post, p. 446.

³ Chap. V., p. 112, and Chap. XII., p. 359.

⁴ Marks may be calculated to deceive, though in different register classes, p. 252; *Australian Wine Importers' Tm.*, 41 C. D. 278; 6 R. P. C. 311 (1889), Kay, J., and C. A. (wines and spirits); *Eno v. Dunn*, 10 R. P. C. 261 (1893), Kekewich, J. (an aperient drink and baking powder); *Turney & Sons' Tm.*, 11 R. P. C. 37 (1893), North, J. (beer and rum). In some instances the Courts have interfered to prevent a defendant using or imitating the trade name of a well-known firm with the object of fraudulently suggesting that he has a connection of some sort with the firm, even where the defendant's trade is different from that of the firm, but the difference is not so great as to make the success of the fraudulent suggestion very improbable. *Eastman Co. v. John Griffiths Cycle Corporation*, 15 R. P. C. 105 (photographic materials and cycles); *Dunlop Pneumatic Tyre Co. v. Dunlop Lubricant Co.*, 16 R. P. C. 12, both 1898, Romer, J. (cycle tyres, &c., and cycle lubricants); *Valentine Meat Juice Co. v. Valentine Extract Co., Ltd.*, 17 R. P. C. 673, C. A., overruling

17 R. P. C. 1 (1900), Stirling, J. (meat extract for food and for medicinal purposes); and *Walter v. Ashton*, [1902] 2 Ch. 282, Byrne, J. ("Times" cycles). In *Lucas, Ltd. v. Fabry Automobile Co., Ltd.*, 23 R. P. C. 33 (1906), Warrington, J. (cycle and motor accessories and motor tyres), and in *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Motor Co., Ltd.*, 23 R. P. C. 761; 24 R. P. C. 572 (1907), H. of L. (tyres and cycle and motor repairs), the similarity of the businesses was held not to be so close as to make deception or confusion probable. See also *Passing Off*, p. 585, and "same description of goods," above, p. 253.

⁵ *Edwards v. Dennis*, 30 C. D. 454 (1885), C. A., cited p. 113. In this case the goods were substantially different, as pointed out in *Boord & Son v. Huddart*, 21 R. P. C. 149 (1904), Swinfen Eady, J., where it was held that an old mark used before 1875 for gin, but not sloe gin, might be extended to sloe gin, and, being registered so as to cover it, was held to be infringed. See also *Finlay v. Shamrock Co.*, 22 R. P. C. 307, Porter, M.R., Ireland.

⁶ *Jay v. Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.; *Hart v. Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J.

registered generally for a register class comprising a kind of goods for which he does not use it, or for which it is unsuitable, it is not to be considered as registered for such goods. Thus, the proprietor of a mark registered for class 45, "tobacco whether manufactured or unmanufactured," used it only for cut tobacco, and the mark contained the words *Three Crowns Mixture*. It was held that he could not sue to restrain an infringement in respect of cigars.¹ But in a recent case a label registered as an old mark for fermented liquors and spirits, including liqueurs, was held to be infringed by a label used for sloe gin, although the registered label contained the words "Cordial Old Tom," which were not used on the mark when employed by the plaintiffs for sloe gin.²

Further, the use of the defendant's mark, which is relied on as an infringement, must be a use upon goods which are not the genuine goods—i.e., those upon which the plaintiff's mark is properly used—for anyone may use the plaintiff's mark on the plaintiff's goods, since that cannot cause the deception which is the test of infringement.³ So the retailer of goods obtained from the plaintiff may lawfully place or renew⁴ the proper labels upon them, and may have sufficient labels printed for the purpose.⁵ In the case last cited, the defendant failed to satisfy the jury, in an action at common law, that he had in fact printed the labels only for use on the genuine goods of the plaintiff; and the injunction, which had been granted in a suit in Chancery by Wood, V.-C., and dissolved on appeal by Cranworth, L.C., was accordingly restored.⁶ The rule just stated is well illustrated by *The Angostura Bitters* case, where the injunction granted was so expressed as not to prevent the name being applied to an article identical with the plaintiff's, should any other person discover the secret of manufacture and make the goods.⁷

The infringement must be in respect of spurious goods.

¹ *Hargreaves v. Freeman*, [1891] 3 Ch. 39; 8 R. P. C. 273, Chitty, J.; and see *Beazley v. Soares*, 22 C. D. 660 (1892), Pearson, J. A person who does not use the mark at all cannot sue: last case, and *Delondre v. Shaw*, 2 Sim. 237 (1828), Shadwell, V.-C.

² *Boord & Son v. Huddart*, 21 R. P. C. 149 (1904), Swinfen Eady, J.

³ Chap. II., p. 34.

⁴ *Condy v. Taylor*, 56 L. T. 891 (1887), Kekewich, J.

⁵ *Farina v. Silverlock*, 1 K. & J. 509; 24 L. J. Ch. 632; 6 D. G. M. & G. 214; 26 L. J. Ch. 11 (1855).

⁶ 4 K. & J. 650 (1850).

⁷ *Siegert v. Findlater*, 7 C. D. 801 (1878), Fry, J. In *The Yorkshire Relish* case (next chapter, p. 570) the defendant's sauce differed from the plaintiffs' by a "pinch of salt," but if the two had been indistinguishable the name would still (according to the evidence) have meant the latter only.

Adulterations, inferior qualities, and goods comprising authentic parts.

But goods of the plaintiff, adulterated by some other person,¹ are not goods on which the mark may lawfully be placed; nor may a mark used by the owner to denote one quality of his goods be put on goods of such owner of an inferior quality;² nor is the manufacture by the defendant of an article made up of several parts the less an infringement because one genuine part of the plaintiff's manufacture, and bearing his mark, is included in it.³

What connection with the spurious goods is sufficient.

It is not necessary that the spurious mark should be actually affixed to the goods, provided it is so used in connection with them as to be calculated to cause them to be taken for the plaintiff's goods.⁴ Use on the wrapper in which they are sold, or upon a slip placed in the package with them, or on a show-card to which the goods are attached,⁵ or in circulars or advertisements offering them for sale is sufficient.⁴ So printing the plaintiff's trade mark labels, without showing that they were for use on genuine goods only,⁶ or using the plaintiff's marked or stamped bottles,⁷ casks,⁸ or boxes⁹ for goods other than his genuine goods, is an infringement, unless the Court is satisfied that the use under the circumstances is not calculated to deceive.¹⁰

Before the Act of 1905 it was to some extent doubtful whether

¹ *Condy v. Taylor*, 56 L. T. 891 (1887), Kekewich, J.

² *Jameson & Sons, Ltd. v. Clarke*, 19 R. P. C. 255 (1902), Chatterton, V.-C., Ireland; *Teacher v. Levy*, 23 R. P. C. 117 (1906), Swinfen Eady, J.; *Palestine Wine and Trading Co., Ltd. v. Cohen*, 23 R. P. C. 568 (1906), Warrington, J., and see *Moseley & Sons, Ltd. v. Nathan & Co.*, 23 R. P. C. 345 (1906), Warrington, J. These, however, all seem to have been passing-off cases.

³ *Richards v. Williamson*, 30 L. T. (N. S.) 746 (1874), Bacon, V.-C., a gun with stamped lock.

⁴ *Jay v. Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

⁵ *Chameleon Patents, &c. Co. v. Marshalls*, 17 R. P. C. 527 (1900), Kekewich, J. (passing-off).

⁶ *Farina v. Silverlock*, p. 437, note (5); *Guinness v. Ullmer*, 10 L. T. (O. S.) 127 (1847), Shadwell, V.-C.; *Jameson & Son, Ltd. v. Johnston & Co.*,

Ltd., 18 R. P. C. 259 (1901); *Kuyper & Son v. Baird, Ltd.*, 20 R. P. C. 581, both Porter, M.R., Ireland.

⁷ *Rose v. Henley*, 47 L. J. Ch. 577 (1877), Malins, V.-C.; *Rose v. Loftus*, *ibid.* Filling syphons marked with the plaintiff's trade mark and sending them out to be resold held to be an infringement: *Barr & Co. v. Mair*, 21 R. P. C. 665 (1904), Ld. Kyllachy, Scotland. See also *Thwaites & Co. v. McEvilly*, 21 R. P. C. 897, C. A. Ireland; and cf. *Woolley & Son v. Morrison*, 21 R. P. C. 63, Ld. Kyllachy, Lord Ordinary; *Stone v. Burns*, 103 L. T. 540, 74 J. P. 456 (1910) (Div. Court), and *Donohoe, Ltd. v. Cherry Bros., Ltd.*, 25 R. P. C. 545 (1909), M.R., Ireland.

⁸ *Hennessy v. Cooper*, Seb. Dig. p. 327 (1877), Mallins, V.-C.

⁹ *Barnett v. Leuchars*, 13 L. T. (N. S.) 495 (1865), Stuart, V.-C.

¹⁰ As in *Welch v. Knott*, 4 K. & J. 747 (1857), Wood, V.-C.

there could be infringement by the verbal use of a trade mark, or by its use otherwise than in some physical connection with the goods. The use of a descriptive word registered as an old trade mark, not in connection with the goods, but only in price lists referring to them, was held to be no infringement.¹ But on the other hand, in *Jay v. Ladler*,² a circular was held to be an infringement of a trade mark, and in a more recent case *Farwell, J.*, after considering the case last mentioned, and referring to an argument that the use by the defendants of the alleged infringing device as an embellishment in advertisements and circulars, and other ways, was not infringement, said that he did not think it was necessary that the mark should be used by the defendants as a trade mark, but that the mode of use was an element to be considered, and he held that there was in fact no infringement.³ The question was also discussed in the Court of Appeal with reference to a pictorial poster.⁴

In a case in which all that the defendants had done was to supply their goods in response to written orders for "Rugby" cement, that word being a prominent part of the trade mark, *Vaughan Williams, J.*, said: "I am, for my own part, not at all sure that you can prove an infringement of a trade mark without proving that the defendants have imitated the plaintiff's trade mark upon something capable of receiving the impression of the mark. Either the material itself, or the paper which is used, or the sacks, or bags, or boxes, or whatever it is that the material is put into, I should have thought must have been imitated to constitute an infringement of a trade mark."⁵ The question actually decided in the case was that the sale of goods by the descriptive name *Rugby Cement* was not an infringement of a trade mark comprising those words. In one case in Scotland the use of the plaintiff's trade mark by

¹ *Talbot v. Webley*, 3 R. P. C. 276 (1886), Bacon, V.-C. (*Baffle*, for safes); cf. "Singer system," in *Singer v. Loog*, 8 App. Ca. 15 (1882), and above, p. 42.

² 40 C. D. 649; 6 R. P. C. (1889), *Kekewich, J.*

³ *Bourne v. Swan & Edgar, Ltd.*, [1903] 1 Ch. 211; 20 R. P. C. 105.

⁴ *Price's Patent Candle Co., Ltd. v. Jeyes' Sanitary Compounds Co.*, 19 R. P. C. 17 (1901). In *Bass, Ratcliff &*

Gretton, Ltd. v. Davenport & Sons' Brewery, Ltd., *Kekewich, J.*, 12 R. P. C. 129 (1902), considered, as a question of infringement of trade mark, the question whether a show-card infringed the plaintiffs' rights.

⁵ *Rugby Portland Cement Co., Ltd. v. Rugby and Newbold Portland Cement Co., Ltd.*, 8 R. P. C. 241; affirmed on appeal, 9 R. P. C. 46 (1891).

application by word of mouth to articles sold was held to be an infringement.¹

The abstract question was, however, of little or no importance, since, in the case put, the use of the word mark by the defendant, in any manner calculated to deceive, could be restrained in a "passing-off" action. "It will be observed," Fry, J., said, in *The Linoleum* case,² "that the inquiry with regard to the use of the word *Linoleum* as a constituent element in the trade mark, and the inquiry as to the use of the word *Linoleum* as a misrepresentation, are one and the same inquiry, and I must consider what the word *Linoleum* meant as used at the time when the defendants intended to attribute it to their manufacture."

By sec. 39 of the Act of 1905 the exclusive right conferred on the registered proprietor of a trade mark is "to the use of such trade mark upon or in connection with the goods in respect of which it is registered." And this accords with the statutory definition of a trade mark.³ It is submitted that the words quoted are sufficiently wide to cover any such use as indicates, or purports to indicate, the proprietorship of the goods, whether the mark is attached to the goods, or used in invoices, trade descriptions, or as a trade name of the goods;⁴ but it is doubtful whether there could be a verbal infringement.

The infringing mark may either (a) be an actual or substantial copy of the plaintiff's mark; (b) consist of or comprise its essential features; or (c) be a colourable imitation of it.⁵

¹ *Montgomerie & Co., Ltd. v. Young*, 20 R. P. C. 781 (1903), *Ld. Kyllachy*; on appeal the decision was reversed on other grounds, 21 R. P. C. 285 (1904). In *Kodak, Ltd. v. London Stereoscopic Co.*, 20 R. P. C. 337 (1903), *Swinfen Eady, J.*, it was practically admitted by the defendants' counsel that their use of the plaintiffs' trade marks in invoices was an infringement, and an injunction against infringement of trade mark was granted. Under the Merchandise Marks Act, 1887, a description in an invoice sent with goods has been held to be "applied to goods" within sec. 5 (d): *Budd v. Lucas*, [1891] 1 Q. B. 408,

Pollock and Charles, JJ.

² *Linoleum Manufacturing Co. v. Nairn*, 7 C. D., p. 836 (1878).

³ Sec. 3.

⁴ It has been held by *Warrington, J.*, on an interlocutory application, that merely supplying goods in response to a written order in which the goods were described by the trade mark would not be an infringement of trade mark: *Peters v. Domestic Inventions Co.*, 25 R. P. C. 387 (1908).

⁵ It will be seen that (b) and (c) are not distinct cases, although they are separated for convenience in the text. The test of infringement is the same in

(a) The first case presents no difficulties: By sec. 40, the registration of the plaintiff as proprietor of the trade mark is *prima facie* evidence of the validity of the registration,¹ and, after the period of seven years mentioned in sec. 41 and subject to certain exceptions, conclusive evidence of his right to the exclusive use of the trade mark.² The registered proprietor can therefore make a case in an action for the mere using of his mark in connection with goods of the class over which his right extends, without showing that the use is calculated to deceive.³ And this is not, substantially, an alteration of the law as it stood before the Acts⁴ if registration be taken as equivalent to public user,⁵ although proof of the probability of deception was usually, but not invariably,⁶ mentioned as an element of right of action; for if the defendant had taken a "material and substantial" portion of the plaintiff's mark, and, *à fortiori*, if he had taken the whole, the onus of showing that his conduct was not calculated to deceive was cast upon him,⁷ and it was practically, at any rate, impossible for him to support it. Moreover, unless he could give a reasonable explanation to show how he came to adopt a mark identical with that of the plaintiff, the Court would infer that he intended to deceive,⁸ and would not consider whether or not his attempt was likely to be successful.⁹

Where the plaintiff's mark has been copied.

The infringement proved in *Paine & Co. v. Daniells & Sons'*

each (p. 444). In case (b) the whole mark must be infringed, and in case (c) essential features are necessarily imitated or copied.

¹ Above, p. 367.

² This is the effect of secs. 39 and 41 combined. The exceptions are dealt with above, p. 371.

³ See the judgment of Cotton, L.J., in *Edwards v. Dennis*, 30 C. D. 454 (1885), and *Lambert v. Goodbody*, 19 R. P. C. 377 (1902), Farwell, J.

⁴ Cf. with the judgment last referred to that of Hall, V.-O., in *Cope v. Evans*, L. R. 18 Eq. 138 (1874).

⁵ See sec. 75 of the Act of 1883, p. 698.

⁶ For instance, see the judgments of Jessel, M.R., in *Singer Manufacturing Co. v. Wilson*, 2 C. D. p. 442 (1875),

and of Ld. Cranworth in *The Leather Cloth* case, 11 H. L. C. p. 533; 35 L. J. Ch. 53 (1865).

⁷ *Ford v. Foster*, 7 Ch. 611 (1872), James, L.J.; *Orr-Ewing v. Johnston*, 13 C. D. 494 (1879), Fry, J., and C. A. See also Ld. Herschell in *Reddaway v. Banham*, 13 R. P. C. at p. 228.

⁸ See *The Orr-Ewing* case, in the H. L., 7 App. Ca. 219; *Taylor v. Taylor*, 23 L. J. Ch. 255 (1854), Wood, V.-C.

⁹ See *per Lindley, L.J.*, in *Slazenger v. Feltham*, 6 R. P. C. p. 538 (1880). See, however, *Lever v. Beddingfield*, 16 R. P. C. 3, at p. 10 (1899), but the defendant's label as a whole was held not to be a copy of the plaintiff's label.

False claim to the plaintiff's registered marks.

*Breweries*¹ was effected in a very unusual way. The plaintiffs' marks consisted of labels bearing a figure of John Bull, and the words *John Bull* and *John Bull Brand*. The defendants used a label bearing a different figure of John Bull, with the words *John Bull, Registered*. Their label, though entered as their copyright at Stationers' Hall, had been, in 1885, refused registration as a trade mark, on the ground of the plaintiffs' opposition, but they had, notwithstanding the refusal, continued to use it in their business. Although the labels had been in use so long, no evidence of actual deception was tendered, for the trades of the plaintiffs and defendants had been carried on in different districts, and were only beginning to overlap at one point at the date of the trial. There was no evidence other than that furnished by the labels themselves that the defendants' label was calculated to deceive; but the Court of Appeal regarded the false claim of registration in their label as amounting in effect to a representation that the plaintiffs' marks—the only John Bull marks which really were registered—were their own, and this was held to be an undoubted infringement;² and in a later case the use of the word "registered" on the label complained of, registration of which had been refused, was held to be a disparagement of the plaintiffs' mark as registered, and to be an element tending to show want of good faith in the manufacturers who issued the label.³

Where an essential feature has been copied.

(b) The right of the registered proprietor exists in regard to the whole mark, not in regard to any particular part of it,⁴ and an infringement must be an infringement of the whole mark.⁵ "It is established by the history of the defendant's label and by comparing it with the plaintiffs' label of 1894, that the central

¹ [1893] 2 Ch. 567; 10 R. P. C. 71, 217, C. A.

² *Lawrie v. Baker*, 2 R. P. C. 213 (1885), Day, J., is a similar case. There the defendant described his goods as *patent cups*, the plaintiff having the only patent. Cf. *Pneumatic Stamp Co. v. Lindner*, 15 R. P. C. 525.

³ *Boord & Son v. Huddart*, 21 R. P. C. 149 (1904), Swinfen Eady, J. See also *Finlay v. Shamrock Co.*, 22 R. P. C. 301, Porter, M.R., Ireland. Cf. *Warsop & Sons, Ltd. v. Warsop*, 21 R. P. C. 481 (1904), Kekewich, J., where the defendant's use of "registered" was as

between him and the plaintiffs innocent.

⁴ *Hudson's Tm.*, 32 C. D. 311; 3 R. P. C. 155 (1886), Cotton, L.J.; *Christiansen's Tm.*, 3 R. P. C. 54 (1886), C. A.

⁵ *Lever v. Bedingfield*, 16 R. P. C. 3, at p. 10 (1899) (*Sunlight and Redmaid Soaps*); so *Rugby Cement Co. v. Rugby and Newbold Co.*, below, p. 443, n. (4), and *Hennessy & Co. v. Dompé*, 19 R. P. C. 333 (1902), Kekewich, J.; on appeal, in this case, however, the defendants admitted that they had infringed by the use of the labels complained of, 20 R. P. C. 175.

space and curved scroll on the plaintiffs' label have been utilised, and to some extent copied, by the person employed by the defendant to prepare his label. If, notwithstanding this circumstance, the defendant's label as a whole is not a copy of the plaintiffs' labels, and is not as a whole a colourable imitation of them, it cannot be truly said that the defendant has infringed the rights conferred upon the plaintiffs by the registration of their marks."¹ But the adoption of a single characteristic and distinctive particular from the plaintiff's mark, and its use alone, or with other matter, may well be an infringement of the entire mark. At any rate, it throws upon the defendant the onus of proving the contrary.² What are the characteristic features of the plaintiffs' trade mark is a matter of fact, on which statements by the plaintiffs in advertisements or the evidence of trade witnesses may be material.³ It is not an infringement to take non-essential particulars from a mark: for instance, to take merely descriptive or other common words⁴ or common matter.⁵ In particular, it is provided by sec. 44 of the Act of 1905 that no registration shall interfere with any *bond fide* use by a person of his own name or place of business or that of any of his predecessors in business, or the use by any person of any

¹ Per Lindley, M.R., in *Lever v. Bedingfield*, p. 442, n. (5).

² *Ford v. Foster*, 7 Ch. 611 (1872), James, L.J.; *Johnston v. Orr-Ewing*, 13 C. D. 494 (1879), Fry, J., and C. A. See *Finlay v. Shamrock*, 22 R. P. C. 301 (1904), Porter, M.R., Ireland, where, the plaintiff being registered for a shamrock leaf, the defendants had taken the top leaf only of the trefoil, but used it in connection with the word "shamrock." This was held to be an undoubted infringement.

³ *Hennessy v. Keating*, 25 R. P. C. 125 and 361 (1908), C. A., Ireland, and H. of L., where the plaintiffs had in their advertisements pointed out what they considered the characteristic features of their trade mark, and *Schwerdtfegeraktiengesellschaft v. Hart Publishing Co.*, 29 R. P. C. 236 (1912), where Parker, J., held that in a trade mark consisting of the initials E.A.S. within a heart of special shape, the initials formed the distinguishing part of the mark. He came to this

conclusion partly on his own inspection, partly on the evidence of witnesses to that effect, and partly on the plaintiff's own advertisements.

⁴ *Linoleum Manufacturing Co. v. Nairn*, 7 C. D. 834 (1878), Fry, J. (*Linoleum*); *Watt v. O'Hanlon*, 4 R. P. C. 1 (1886), Porter, M.R. (*Old Innishowen*); *Humphries v. Taylor's Drug Co.*, 59 L. T. 820 (1888), Kekewich, J. (*Herbalin*); *Native Guano Co. v. Sewage Manure Co.*, 8 R. P. C. 125 (1888), C. A. and H. L. (*Native Guano*); *Rugby Cement Co. v. Rugby and Newbold Co., Ltd.*, 8 R. P. C. 241; 9 R. P. C. 46 (1891), Vaughan Williams, J., and C. A.; cf. Chap. X., pp. 279 and 280; and *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L.J. See, further, next chapter, p. 563.

⁵ See *Hennessy v. Dompé*, 19 R. P. C. 333 (1902), Kekewich, J. (reversed by consent on appeal), 20 R. P. C. 175; and *Hennessy v. Keating*, cited in note (3).

bonâ fide description of the character or quality of the goods. Usages of the trade. By sec. 43 the Court trying the question of infringement shall admit evidence of the usages of the trade in respect to the get-up of the goods for which the trade mark is registered, and of any trade marks or get-up legitimately used in connection with such goods by other persons.

Where there is a colourable imitation. (c) A colourable imitation is the most common case, for, if the resemblance is intended, the defendant will have tried to introduce apparent differences sufficient to prevent the Court from interfering, while preserving a likeness which is near enough to enable him to profit by the reputation of the plaintiff's mark. So far as the Court succeeds in carrying into effect the principles which govern its interference, the two ends are inconsistent with each other.

Colourable Imitation.

The test of infringement. In both the second and third cases the test of infringement is the question whether or not the defendant's mark is calculated to cause his goods to be taken by ordinary purchasers¹ for the goods of the plaintiff,² and the Registration Acts have made no alteration of the law in this respect.³

"It is not a question whether this (the use of the defendant's mark) necessarily is deceptive, but whether there is not a strong probability of its causing deception."⁴ So that the imitation of the plaintiff's mark cannot be justified by showing either that the device or inscription on the imitated mark is ambiguous, and capable of being understood by different persons in different ways, or that a person who carefully and intelligently examined and studied it might not be misled.⁵

¹ See above, p. 261.

² *Hall v. Barrows*, 4 De G. J. & S. 150; 33 L. J. Ch. 204 (1863), Westbury, L.C.; *Leather Cloth Co., Ltd. v. The American Cloth Co., Ltd.*, 4 De G. J. & S. 187; 33 L. J. Ch. 199 (1863), Westbury, L.C.; 11 H. L. C. 523; 35 L. J. Ch. 53. The suggestion in the Scotch case of *Crawford v. Bernard*, 11 R. P. C. 580 (1894), Ld. Kyllachy, that colourable infringement can be judged of apart from probability of deception, is not in accordance with the authorities.

³ *Mitchell v. Henry*, 15 C. D. 181 (1880), C. A.; *Singer Manufacturing Co. v. Loog*, 18 C. D. 395, C. A.; 8 App. Ca. 15 (1870); *Edwards v. Dennis*, 30 C. D. 454 (1885), Cotton, L.J.; *Lever v. Bedingsfield*, p. 442, note (5); *Lambert & Butler Ltd. v. Goodbody*, 19 R. P. C. 377 (1902), Farwell, J.

⁴ Per Cotton, L.J., in *The Upper Assam Tea Co. v. Herbert & Co.*, 7 R. P. C. p. 186 (1889).

⁵ Per Ld. Selborne in *The Singer Manufacturing Co. v. Loog*, 8 App. Ca. p. 18 (1882).

There can be no infringement in cases where the plaintiff's mark is not actually copied, if there is no reasonable probability of deception.¹ In a recent case *Cozens Hardy, M.R.*, said that, although it was not necessary that a trade mark should be copied in full, a thing must, in order to infringe, be so like and differ so slightly that, when used on the goods, it would be calculated to deceive.² It was held by the Court of Common Pleas, as early as 1847, that the following questions were properly left to the jury by Williams, J., in *Rodgers v. Nowill*:³—(1) Whether there was such a resemblance to the plaintiffs' marks, in the marks put on the knives made by the defendants, as was calculated to make an ordinary person believe that the marks were the marks of the plaintiffs, denoting that the knives were the knives of the plaintiffs? and (2) Did the defendants, with an intention to deceive, sell these knives representing them to be the manufacture of the plaintiffs? It will be shown immediately that, if the plaintiffs' mark was their trade mark, the second question has long been held to be immaterial, except so far as it dealt with the mere fact of the sale of the knives.

Questions for the jury.

The same test, as will be shown in the next chapter, applies also to actions for "passing-off." It is sometimes suggested that a less degree of resemblance between the plaintiff's and defendant's marks will suffice to support an action for "passing-off" than is required to support an action for infringement, or, what is the same thing, proof of a lower degree of probability of deception. This distinction is, it is submitted, unnecessary and inconvenient. In the cases before the Acts, when the two classes of actions were not yet separated, there could have been no ground for it, and there is nothing in the Acts to require its introduction. The essential difference is plain enough. In an infringement action the plaintiff can rely only upon the imitation of his registered mark, while in an action for "passing-off" he may rely on other things, or on additional things, which are proved to be connected with his trade or goods.

Actions for infringement and for passing-off.

¹ *Cope v. Evans*, L. R. 18 Eq. 138 (1874), Hall, V.-C.; *Beddow & Sons v. Boyd*, 4 R. P. C. 310 (1887), Chatterton, V.-C.; see also *Woollam v. Radcliff*, 1 H. & M. 259 (1868), Wood, V.-C.; *Bradbury v. Beeton*, 39 L. J. Ch. 57 (1869), Malins, V.-C.; *Civil Service Supply Association v. Dean*, 13 C. D. 512 (1879), Malins, V.-C.; and *Borth-*

wick v. The Evening Post, 37 C. D. 449 (1888), Kay, J., and C. A., in all of which an injunction was refused.

² *Claudius Ash Sons & Co. Ltd. v. Invicta Manufacturing Co., Ltd.*, 28 R. P. C. 597; the decision was affirmed by the House of Lords, 29 R. P. C. 465 (1913).

³ 5 C. B. 109; 17 L. J. C. P. 52.

Actual deception need not be proved;

Proof of actual deception, if the mark is, in the opinion of the Court, calculated to deceive, or if the plaintiff's registered mark has been substantially copied,¹ is unnecessary, although the absence of it, where the plaintiff's and defendant's marks have circulated side by side for a considerable time, may go far to negative the probability of deception, unless it is explained, for instance, by the practical impossibility of calling evidence from a distant country to show that purchasers there have been deceived.² The plaintiff is not bound to wait to see whether his customers will, in fact, be deceived, for "the very life of a trade mark depends upon the promptitude with which it is vindicated."³

nor yet an intention to deceive.

Nor where the defendant's mark has in fact deceived, or is, in the opinion of the Court, calculated to do so, is it necessary to show that the defendant intended to deceive. This was first decided by Lord Cottenham, in *Millington v. Fox*,⁴ as regards the relief by an injunction, and by Lord Westbury, in *Edelsten v. Edelsten*,⁵ as regards both injunction and account. It is now well-settled law.⁶ The dicta of Lord Chelmsford in *The Glenfield Starch* case, that, where the trade mark is not actually copied, fraud is a necessary element in the plaintiff's case—"that is, the party accused of piracy must be proved to have done the act complained of with the fraudulent design of passing off his own goods as those of the party exclusively entitled to the trade mark"⁷—and of Jessel, M.R., and the Court of Appeal, in *The Singer Manufacturing Co. v. Wilson*,⁸ that, where the defendant has not actually put the plaintiff's trade mark, or a colourable

¹ Above, p. 441; and see *Paine & Co. v. Daniells & Sons' Breweries*, cited ante, p. 442.

² Page 287; and see *Lambert and Butler, Ltd. v. Goodbody*, 19 R. P. C. 377 (1902); *Bourne v. Swan and Edgar, Ltd.*, 20 R. P. C. 105 (1903), both Farwell, J., and *Iron Ox Remedy Co. v. Co-operative Wholesale Society, Ltd.*, 24 R. P. C. 425 (1907), Parker, J., a passing-off case. In *Liebig's Extract of Meat Co. v. Chemists' Co-operative Society*, 13 R. P. C. 635 (1896), Kekewich, J., a passing-off case in which the plaintiffs succeeded, no instance of actual deception was proved, although the wrappers complained of, or similar ones, had been in use for at least two years.

³ *Johnston v. Orr-Ewing*, per James, L.J., 13 C. D. p. 464; and *Ld. Blackburn*, 7 App. Ca. p. 230 (1880).

⁴ 3 My. & Cr. 338 (1838).

⁵ 1 De G. J. & S. 185; 10 L. T. N. S. 780 (1863).

⁶ *Reddaway v. Bentham Hemp Spinning Co.*, [1892] 2 Q. B. 639; 9 R. P. C. 503, C. A.; *Johnston v. Orr-Ewing*, 7 App. Ca. 219 (1882); *Powell v. Birmingham Vinegar Co.*, [1896] 2 Ch. 54; 13 R. P. C. 235, in the C. A. As to damages at law, see the first-mentioned case.

⁷ *Wotherspoon v. Currie*, L. R. 5 H. L. p. 516 (1872).

⁸ 2 C. D. 434 (1875).

imitation of it, on his goods, or on the bottles or boxes containing them, but has otherwise acted so as to represent his goods as those of the plaintiff,¹ a fraudulent intent must be proved, cannot now be taken to be law.² In the former case, Lord Hatherley said it had been pointed out that a *mala fides* towards the first purchaser was not the ground of the Court's interference; for it is sufficient if such purchaser is furnished by the defendant with goods bearing a label, of which the necessary consequence is that he is enabled to deceive others by means of them.³ And in *The Singer* case Lord Cairns said: "I wish to state in the most distinct manner that, in my opinion, fraud is not necessary to be averred or proved in order to obtain protection for a trade mark";⁴ and in this Lord O'Hagan concurred.⁵ Lord Blackburn said: "I am not as yet prepared to assent either to the position that there is a right of property in a name, or, what seems to me nearly the same thing, to assent to its full extent to the proposition that it is not necessary" (in trade name cases) "to prove fraud."⁶ But the last-mentioned judge, in a subsequent case, stated that he thought it clear, at any rate, that if the defendant persevered in using a trade mark calculated to deceive after notice of the facts, that would be evidence to support a claim for damages for knowingly selling his goods as and for those of the plaintiff.⁷ However honest or inadvertent the original mistake may have been, the continuation of the use of it after that was pointed out is of itself evidence of a fraudulent intention."⁸

And it has already been shown that the proprietor of a trade mark may obtain an injunction against an innocent consignee of

¹ As already shown, these may be cases of infringement if the representation is effected by using a mark in connection with the defendant's goods (though not on them) which resembles the plaintiff's mark, or by using a distinctive name taken from the plaintiff's mark; above, p. 438.

² See, for instance, *Boord & Son v. Thorn and Cameron, Ltd.*, 24 R. P. C. 697 at p. 721 (1907), Court of Sess., where fraudulent intention was expressly held not to have existed, and an interdict against passing-off was refused, although an interdict was granted against infringement.

³ L. R. 5 H. L. p. 517.

⁴ 3 App. Ca. p. 391, quoted and adopted in *Bodega Co., Ltd. v. Owens*, 7 R. P. C. 31 (1889), Chatterton, V.-C.

⁵ 3 App. Ca. 396.

⁶ Page 400.

⁷ *Singer Manufacturing Co. v. Loog*, 8 App. Ca. 31 (1882); and *Cochrane v. McNish*, [1896] A. C. 225; 13 R. P. C. 100, Privy Council.

⁸ Per James, L.J., in *Orr-Ewing v. Johnston*, 13 C. D. p. 454 (1880); see also *Paine & Co. v. Daniells & Sons Breweries*, [1893] 2 Ch. 567; 19 R. P. C. 217, C. A., cited above, p. 442.

spuriously marked goods, and an order for the spurious marks to be expunged from the goods, without having given the defendant any notice before the commencement of the action.¹

On the other hand, the mere intention of the defendant to deceive, if the Court is clearly of opinion that the mark complained of is not calculated to deceive, cannot constitute an infringement;² but if there be an intention to deceive, success will easily be presumed.³

What resemblance is calculated to deceive.

It follows that the question to be answered, when an infringement without taking the actual mark is alleged, is the same question as arises when a mark tendered for registration is objected to, or, having been registered, is sought to be removed from the Register, on the ground that it so nearly resembles a trade mark already on the Register as to be calculated to deceive, within the restriction of sec. 19. The principles governing the comparison of the marks, and determining what amount of resemblance is calculated to deceive, are the same in both cases, although a higher standard of resemblance must be conformed to in an action for infringement than that set up in cases of the other class. These principles have been already discussed at length,⁴ and it will therefore be sufficient in this place to shortly summarise the conclusions deduced from an examination of the authorities.

The probable purchasers are to be considered.

(1) The persons with regard to whom the test question—Is the spurious mark calculated to deceive them?—ought to be asked are the persons who are probable purchasers, whether they buy, or are likely to buy, directly from the plaintiff or defendant, or from, or through, intermediate purchasers from either of them, and whether they are English or foreign, and not merely very careful or intelligent persons, but ordinary unwary purchasers.⁴ No rule has, or probably can be, laid down as to what amount of intelligence or knowledge of the trade in question ought to be attributed to them, since this must necessarily vary with the nature of the case.⁵

¹ Above, p. 424; *Upmann v. Forester*, 24 C. D. 281 (1883), Chitty, J.; *American Tobacco Co. v. Guest*, [1892] 1 Ch. 680; 9 R. P. C. 218, Stirling, J.

² See next chapter, p. 588.

³ Chap. X., pp. 260, *et seq.*

⁴ Page 261; and *Shrimpton v. Laight*, 18 Beav. 164 (1854), Romilly, M.R. As to infringements alleged to be instru-

ments of fraud in the hands of retailers, see below, p. 453.

⁵ See the "passing-off" cases, *Payton v. Snelling*, 17 R. P. C. 48; and *Payton v. Titus Ward*, *ibid.* 58 (both 1899, C. A.), and above, pp. 261 and 262. The first-mentioned decision was affirmed in the H. of L., 17 R. P. C. 628.

(2) No definite rule as to the amount of resemblance required can be formulated *à priori*, but the net impression produced and "the main idea left on the mind" by one mark must be compared with that left by the other, for marks may well be confused by purchasers, who see the defendant's mark when they have present in their memories only an indefinite recollection of the plaintiff's, in cases where the marks could not be mistaken for each other if they were seen side by side.¹ So that the whole mark of the defendant may too nearly resemble that of the plaintiff, although all the essential particulars of the two are distinguishable;² but special regard must, nevertheless, be paid to the essential features of the plaintiff's mark in considering whether the defendant has infringed it.³

The net impressions left by the marks are to be contrasted.

(3) Further, the marks must be compared as they are seen in actual ordinary use⁴ on the goods for which they are used; remembering, however, that so far as the plaintiff's mark substantially differs from the mark on the Register it is an unregistered mark.⁵

The marks are to be considered as seen in ordinary use.

(4) The circumstances of the trade⁶ and market in which the marks are used must be considered also,—the language of the purchasers, for instance, and the number of analogous marks in use in connection with the same goods.⁷ Section 43 of the Act of 1905 provides that in an action for the infringement of a trade mark the Court trying the question of infringement shall admit evidence of the usages of the trade in respect to the get-up of the goods for which the trade mark is registered, and of any trade marks or get-up legitimately used in connection with such goods by other persons. Where the defendant's mark is identical with or substantially the same as the plaintiff's registered trade mark, the similarity or dissimilarity of the get-up of the respective goods can have little, if any, bearing on the question of infringement;⁸ but where there is no such close resemblance, the get-up of the goods may become a material factor. Thus in a passing-off case where it was alleged that the defendants' "Ivory" soap was calculated to deceive on account of its similarity to the plaintiffs'

Regard is to be paid to all the circumstances surrounding the marks in use.

Usages of the trade.

¹ Page 263.

² Page 266.

³ Pages 263 and 273; and cases in note (5), p. 448; also *Hubbuck v. Brown*, 17 R. P. C. 148 and 638 (1900), Kekewich, J., and C. A., and *Marshall v. Sidebotham*, 18 R. P. C. 43 (1901), Kekewich, J.

⁴ Page 270.

⁵ Pages 272 and 273.

⁶ *Cochrane v. McNish*, [1896] A. C. 225; 13 R. P. C. 100, P. C. (*Club Soda*).

⁷ Page 275.

⁸ *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478 (1887), Chitty, J., and C. A.

“Ivy” soap, and there was no similarity in the get-up of the goods, the action and an appeal by the plaintiffs were dismissed.¹ Also the distinctiveness or degree of distinctiveness of a trade mark may be affected by other trade marks used by rival traders. Thus the owner of a registered trade mark consisting of a star might be prevented from claiming the exclusive right to use such a device generally by the existence of other star trade marks, but might at the same time have a perfectly good right to protect his special form of star.²

Colour.

But, since colour is not admitted to consideration in estimating the distinctiveness of a mark tendered for registration, unless the mark be limited in whole or in part to one or more specified colours,³ similarity of colour is not to be greatly relied upon in deciding a question of infringement,⁴ although it is an element to be considered. If a trade mark is registered with a limitation to a certain colour or to certain colours, there could be no infringement by the use in other colours, for by sec. 39 the exclusive use is only conferred subject to the limitation, but a case of passing-off might be established.

And, in particular, to the adoption of a special name for goods bearing the plaintiff's mark.

If the plaintiff's mark, or some feature of it, has led to the application of a particular name to his goods, it is an infringement for the defendant to use a mark which is calculated to cause the same name to be applied to his,⁵ unless the name is applied not merely to the plaintiff's goods, but to all goods of the kind,⁶ for instance, because it is suggested by matter in the mark which is common to the trade;⁷ and the defendant's use of his mark is none the less an infringement of the plaintiff's rights because the exclusive use of the name may give the

¹ *Goodwin v. Ivory Soap Co.*, 17 R. P. C. 689; 18 R. P. C. 389 (1901), Kekewich, J., and C. A.

² See *Wills' Tms.*, 10 R. P. C. 269 (1893), Wright, J.; *Bass, Ratcliff and Gretton, Ltd.'s Tms.*, 19 R. P. C. 129 and 529 (1902), C. A., reversing Kekewich, J., and *Star Cycle Co., Ltd. v. Frankenburgs*, 24 R. P. C. 46 and 405 (1907), Swinfen Eady, J., and C. A., a passing-off case in which, the plaintiffs having at a certain stage in the case claimed the word “Star” in any combination, evidence was admitted of users by other persons of such combinations as “Eastern Star.”

³ Sec. 10. *Hanson's Tm.*, 37 C. D.

112; 5 R. P. C. 130 (1887), Kay, J., above, p. 233.

⁴ *Nuthall v. Vining*, 28 W. R. 330 (1880), C. A. If, and so far as, a trade mark is registered without limitation of colour, it is to be deemed to be registered for all colours, sec. 10. Colour is often of great importance in a case of “get up.” See the next chapter.

⁵ Page 277 *et seq.* This appears to have been treated rather as “passing-off” than infringement by Romer, J., in *Hodgson v. Kynoch*, 15 R. P. C. 465, at p. 476 (1898).

⁶ Page 280.

⁷ Page 281. See note (5), p. 448, above.

plaintiff a practical monopoly in certain goods in a particular market.¹

Attention must be paid, of course, not only to the points of resemblance between the marks, but also to the points of difference. But it will not be sufficient for the defendant to show that the differences might prevent purchasers being deceived. If there is a case for him to answer, the Court must hold that they are "such as to prevent its being likely that they would be deceived."²

In the following cases it was held that the use of words taken from the plaintiff's mark by the defendant was an infringement, notwithstanding that he always added his own name:—*Perry v. Truefitt*, 6 Beav. 66, PERRY'S MEDICATED MEXICAN BALM, TRUEFIT'S MEDICATED MEXICAN BALM; *Braham v. Bustard*, 1 H. & M. 447, BUSTARD & Co.'s EXCELSIOR WHITE SOFT SOAP; *Kinahan v. Bolton*, 15 Ir. Ch. 75, KINAHAN'S LL WHISKY, BOLTON'S LL WHISKY; *Ford v. Foster*,³ L. R. 7 Ch. 611, FORD'S EUREKA SHIRTS, FOSTER, PORTER & Co.'s IMPROVED EUREKA SHIRTS; *Eno v. Stephens*, Seb. Dig. p. 372; *Eno v. Dunn*, 10 R. P. C. 261, ENO'S FRUIT SALT, STEPHENS & Co.'s EFFERVESCING VINOUS FRUIT SALTS; DUNN'S FRUIT SALT AND CHLORATE OF POTASH LOZENGES. In *The Glenfield Starch* case,⁴ *Wotherspoon v. Currie*, L. R. 5 H. L. 508, the defendant's own name appeared in bold letters upon the infringing labels, and this was also the case in *Johnston v. Orr-Ewing*, 13 C. D. 434, and 7 App. Ca. 219, but there the Indian customers of the plaintiff could not, it was assumed, read English.⁵ So, in *Rose v. Loftus*, 47 L. J. Ch. 576, the defendant washed the plaintiff's labels off the bottles, leaving only the moulded marks, and pasted his own labels upon

What importance is to be attached to differences between the marks.

Instances of infringements by marks which prominently displayed the defendant's name.

¹ Page 283. See *The Yorkshire Relish* case, cited below, pp. 570 and 571.

² Per Ld. Blackburn, in *Johnston v. Orr-Ewing*, 7 App. Ca. p. 230 (1882), quoted and followed by the Privy Council in *Somerville v. Schembri*, 12 App. Ca. p. 458; 4 R. P. C. 179 (1887). Cf. note (4).

³ Cited p. 39.

⁴ Cited p. 55. In *The Yorkshire Relish* case, cited pp. 570 and 571, the defendants did everything possible to distinguish their goods, the name of Holbrook, their predecessor in business, being prominent on the labels, but this

proved to be insufficient while they used the (unregistered) trade mark. The name *Stevenson's*, prefixed to "camel hair belting," which by itself admittedly meant the plaintiff's belting (see *Reddaway v. Banham*, cited p. 44), was held not to distinguish sufficiently. *Reddaway & Co., Ltd. v. Stevenson and Brother, Ltd.*, 20 R. P. C. 276 (1903), Hall, V.-C.; but cf. *Same v. Frictionless Engine Packing Co., Ltd.*, 19 R. P. C. 504 (1902), Hall, V.-C.

⁵ *Henderson v. Jorss*, Seb. Dig. p. 110 (1861), Wood, V.-C., is a similar case.

the bottles in their place, but was, nevertheless, held to have committed an infringement. And in *Curtis and Harvey v. Pape*, 5 R. P. C. 146, an imitation of a diamond mark was held to be an infringement, although the defendant put a K in the middle of his diamond which did not appear in that of the plaintiffs. Again in *Boord and Son v. Thorn and Cameron, Ltd.*, 24 R. P. C. 697, the CAT-AND-BARREL case, the defendants' name appeared prominently on the labels which were held to be infringements.¹

In *Daniel and Arter v. Whitehouse*, 16 R. P. C. 71, a passing-off case, F. WHITEHOUSE'S BRAZILIAN SILVER was held to be a breach of an injunction against the use of the words BRAZILIAN SILVER without distinguishing the goods from the plaintiff's goods.

But the use of the defendant's name as part of the mark complained of is an element to be considered, and in some cases it has turned the scale in his favour. Thus, in *Beard v. Turner*, 13 L. T. N. S. 746, KIRBY'S NE PLUS ULTRA NEEDLES, on a label, was held not to be infringed by TURNER'S NE PLUS ULTRA NEEDLES on a label generally resembling the plaintiff's, the words NE PLUS ULTRA being common to the trade; and in *Blackwell v. Crabb*, 36 L. J. Ch. 504, BLACKWELL'S PICKLES on a label, was held not to be infringed by CRABB'S PICKLES on a label resembling the plaintiff's, the name of the manufacturer, under the circumstances of the case, being the thing which a customer would rely on most to establish the identity of the goods he wanted. In each of these cases the elements of all the labels were for the most part common to the trade.² In *Thorne & Co., Ltd. v. Sandow*, 29 R. P. C. 440, a label containing the word "Health" and the full-length figure of a woman and registered for cocoa was held not to be infringed by a label containing the words "Sandow's Health and Strength Cocoa" and the figure of a woman, the plaintiffs having no exclusive right to the word "Health" in connection with cocoa. And in *Jewsbury and Brown v. Andrews and Atkinson*, 28 R. P. C. 293, the fact that the defendants had their name

¹ See also *Wright, Crossley & Co. v. Blezard*, 27 R. P. C. 299, where the words "packed by Thomas Blezard" appeared on the defendants' label.

² See also the "passing-off" cases, *Jamieson v. Jamieson*, 15 R. P. C. 169

(1898), C. A.; *Payton v. Snelling*, 17 R. P. C. 48 and 628 (1900), C. A. and H. of L.; and *Payton v. Titus Ward*, *ibid.* 58 (1899), C. A., cited p. 268; and *King & Co., Ltd. v. Gillard & Co., Ltd.*, 22 R. P. C. 327 (1903), C. A.

prominently on their label, was referred to as one of the grounds for holding it not to be an infringement of the plaintiffs' label.

Where any such additions or precautions are relied on by the defendant to rebut an alleged infringement, it is necessary to inquire whether they may not be removed or obliterated by fraudulent retail dealers leaving the imitated marks to effect deception without any check.¹ On this ground, in *Barlow v. Johnson*,² the Court paid no regard to the tickets and labels attached by the defendant to the towels sold by him under the name, *Osman*, which he had taken from the plaintiff's trade mark.

Differences which may be removed by retailers are disregarded.

Probability of deception is, of course, a question of fact, and, except so far as they lay down any general principle of comparison, the decided cases are of no assistance in the determination of new questions of fact raised upon other materials. "How can observations of judges upon other and quite different facts bear upon the present case, in which the only question is what is the result of the evidence?" Lord Watson asked, in *Johnston v. Orr-Ewing*,³ but the habit of referring to reported cases at the trial of such questions is inveterate, and it has been thought useful, therefore, to collect the cases just cited, and those cited at pp. 288 and 292, above.

Decided cases do not assist in determining the question of fact.

The reported cases show that attempts are frequently made to prevent the interference of the Court by the use, along with the spurious or deceptive marks, of words, descriptions, or other additions which, if carefully examined, would prevent the deception, and at the same time, by writing the additions in small letters, or otherwise causing them to be comparatively inconspicuous, to make the probability of careful examination as small as the infringer thinks he safely can. It is obvious that, so far from affording an answer to a charge of infringement, such colourable precautions are themselves a badge of fraud. The defendant is met at once with the questions, if the additions are necessary, why are they not made conspicuous? and, if they are superfluous, why are they used at all?⁴ In the following cases the several additions noted in brackets were added in small

Inconspicuous additions a badge of fraud.

¹ See below, p. 504.

² 7 R. P. C. 395 (1890), Chitty, J., and C. A.

³ 7 App. Ca. 219 (1882).

⁴ *Bayer v. Baird*, 15 R. P. C. 615 (1896), Court Sess.; *Bayer v. Connell*, 16 R. P. C. 157 (1899), M.R. of Ireland.

letters to the plaintiff's name or trade mark, or to an imitation of it: [Equal to] Day & Martin's, injunction granted, *Day v. Binning*, C. P. Cooper, 489; [Late of] Lundy, Foot & Co., dismissed pending verdict at law, *Foot v. Lea*, 13 Ir. Eq. 484; [From] Thresher & Glenny, injunction granted, *Glenny v. Smith*, 2 Dr. & Sm. 476; [From] Hookham & Pottage, injunction granted, *Hookham v. Pottage*, L. R. 8 Ch. 91;¹ [Agent for] Mason & Brand's Essence of Beef, injunction granted *Dence v. Mason*, W. N. (1877), 23; W. N. (1878), 42; C. B. [& Co.], the plaintiff's mark was C. B., the infringing goods were made by Connell Brothers & Co., injunction granted, *Bayer v. Baird*;² [Successors to] Jefferson Dodd, held on a motion to sequester to be calculated to deceive, the name being on the fascia of the shop, and the words "successors to" on the plate glass front, *Jefferson Dodd, Ltd. v. Dodd's Drug Stores, Ltd.*, 25 R. P. C. 16 (1908).

5. Defences.

The ordinary defences.

The defences commonly set up may be tabulated as follows, that:—

- (1) The plaintiff has no title to the trade mark in question;³
- (2) The defendant has an independent or a concurrent right to use the mark complained of;
- (3) The plaintiff has not complied with the provision of sec. 42 by obtaining the registration or refusal of the mark;⁴
- (4) There is no infringement;⁵
- (5) The plaintiff is debarred from suing the defendant for all or part of the relief he seeks by (a) an agreement or some personal estoppel (other than those next alluded to); (b) acquiescence or licence; (c) delay; or (d) because the trade mark is deceptive, or his trade is fraudulent.⁶

(1), (3) and (4) are traverses of parts of the plaintiff's case, but (1) may be something more.

¹ Where the widow of a late servant of the plaintiffs continued his business with the use of the words "from G. F. Cockerell & Co., Ltd." rightly used by him, an injunction against such use by her was refused; *Rickett, Cockerell & Co., Ltd. v. Nevill*, 21 R. P. C. 394 (1904), Kekewich, J.

² See note (4), p. 453.

³ Pages 425 *et seq.* and 455. The question whether the mark concerned is a trade mark at all, as to which see Chap. II., p. 23, seldom arises in practice, except on an application to expunge an entry from the Register.

⁴ Chap. XII., p. 373.

⁵ Page 431.

⁶ Page 465.

Application to vary.

(1) If the plaintiff's mark has been registered for seven years from the date of the original registration or from the date of the passing of the Act of 1905 (August 11th, 1905),¹ whether in his name or in that of his predecessor in title,² the registration is conclusive evidence of his exclusive right to the use of the mark,³ subject to the provisions of the Act.⁴ The defendant is not, however, precluded from proving the invalidity of any assignment or transmission, but the registration of the plaintiff as proprietor is *prima facie* evidence of the validity of his title in these respects.⁵ The defendant can adduce evidence to show,⁶ or he may show from the plaintiff's own evidence,⁷ that the plaintiff does not possess the goodwill of the business in the goods to which the trade mark is attached; but he cannot attack the plaintiff's title generally, for instance, by showing that the mark is not a trade mark,⁸ or is not within the classes of registrable symbols enumerated in sec. 9, except on an application under sec. 35,⁹ and can only so attack the original registration if the plaintiff is not protected by sec. 41. The application cannot be made by counterclaim in the action.¹⁰

Attack on the plaintiff's title.

If the plaintiff's mark has not been registered for the period mentioned in sec. 41, the defendant can (probably) attack his title without an application to vary the Register.¹¹

It follows that the defendant in an infringement action, unless satisfied that the plaintiff's title cannot safely be attacked, generally applies to expunge the mark of the latter from the Register, or to so limit it as to defeat the action, and, according to the usual practice, the application comes on for hearing with the trial of the action, or with the plaintiff's motion for an interlocutory injunction, if any. The Court will, in a proper case, adjourn the decision of the last-mentioned motion in order to enable the defendant to make his cross application to rectify or expunge.¹²

Application to expunge or limit the plaintiff's registration.

¹ Sec. 41, ante, p. 368.

² Above, p. 368.

³ Secs. 39 and 41. Above, pp. 363 et seq.

⁴ Above p. 371.

⁵ Sec. 40, above, pp. 367 and 373.

⁶ *Edwards v. Dennis*, 30 C. D. 454 (1885), C. A.

⁷ As in *Pinto v. Badman*, 8 R. P. C.

181 (1831), C. A.

⁸ See Chap. II., p. 23.

⁹ As to which see Chap. XI., p. 309.

¹⁰ *Pinto v. Badman*, supra. Cf. sec. 32 of the Patents and Designs Act, 1907. As to procedure in Scotland, see above, p. 338.

¹¹ See above, p. 430, note (2).

¹² Cf. *Edwards v. Elkan*, p. 456, note (5).

Determina-
tion of the
plaintiff's
title.

In any case, it is submitted, and notwithstanding that there is no application to rectify, the defendant may show that the plaintiff's right has determined by abandonment or otherwise by matters subsequent to the original registration.¹

Concurrent Right.

Concurrent or
independent
right.

(2) Where the Court has so decided, and in certain cases by agreement approved by the Registrar or the Board of Trade, two or more persons may be registered as proprietors of the same mark for the same goods,² and they will then have concurrent rights. In such cases no rights of exclusive user are (except so far as their respective rights shall have been defined by the Court)³ acquired by any one of such persons as against any other by the registration. But where more than three persons are independently entitled to use a mark for the same goods it is treated as common to the trade, so that if any of them has obtained registration, the entry ought to be expunged.⁴

The defendant, therefore, if he have an independent right, can apply for registration himself, and in a proper case the Court will order a motion for an interlocutory injunction in an action against him to stand over until his application is disposed of;⁵ or, if he allege that the mark is common, he can, subject to sec. 41, apply to remove the plaintiff's marks from the Register.

Mouson v.
Boehm.

In *Mouson v. Boehm*,⁶ where the plaintiffs had independently adopted, and in 1880 had registered, a mark closely resembling a mark which the defendant had previously acquired by user for the same goods, and which he had never abandoned, the plaintiffs brought their action to restrain the defendant from using the latter mark. The defendant applied to register the mark as his, and moved to have the entry of the plaintiffs' mark expunged

¹ See Chap XIV., p. 404.

² Secs. 19, 20, and 21. It must be a right to use the mark as a trade mark; not, for instance, as a family crest: *Standish v. Whitwell*, 14 W. R. 512; *Beard v. Turner*, 13 L. T. N. S. 746, both (1866), Wood, V.-O.

³ And presumably except so far as such rights have been defined by agreement under sec. 20, although sec. 39 does not in the proviso so provide; see first part of the section.

⁴ Chap. X., p. 249.

⁵ *Edwards v. Elkan*, 5 R. P. C. 70

(1887), Stirling, J.

⁶ 26 C. D. 398 (1884), Chitty, J. A similar case of an old mark is cited by Mr. Sebastian, *Re United Vineyards, &c. Co.* (1889), Stirling, J.; and *Re Bryant and May*, 4 Times L. R. 675 (1888), Stirling, J., is another. In *Daniel and Arter v. Whitehouse*, [1898] 1 Ch. 685; 15 R. P. C. 134, Gorell Barnes, J. (*Brazilian Silver*), cited below, p. 578, the defendant lost by non-user a concurrent right to an (un-registered) trade name.

from the Register. The application to register came before the Court on a summons to proceed, and was heard, together with the motion for an injunction, at the trial of the action. Chitty, J., allowed the defendant to be registered as a proprietor of the mark, but he refused to order the registration of the plaintiff's mark to be expunged, and he dismissed the action.

*Jackson v. Napper*¹ is a similar case. There the defendant, in 1876, applied through an agent to register a mark as his trade mark, and he supposed that it was registered accordingly, but, in fact, the application was not proceeded with and was, as the Court held, abandoned. In the next year the plaintiffs registered a similar mark, and more than five years after their registration² they brought the action to restrain the defendant from using his mark, and thereupon the defendant took out a summons for a direction to the Comptroller to proceed with the registration of his mark. Stirling, J., found that the defendant had acquired and used his mark as a trade mark before August 13th, 1875, in respect of the goods in question, except one particular class (sheep-shears); and he held that, notwithstanding that the five years' registration of the plaintiffs was conclusive evidence of their right to the "exclusive use" of their mark, he had jurisdiction to allow the defendant to be registered in respect of his own mark, upon the analogy of the rule that an entry on the Register might be rectified, under sec. 90 of the Act of 1883,³ after five years' registration. He accordingly directed the defendant to be registered as proprietor of his mark for the goods in question, other than the sheep-shears, and dismissed the action, except so far as regarded the last-mentioned goods, in respect of which he granted the injunction the plaintiffs sought.

*Jackson v.
Napper.*

In the two cases above cited, the defendants' marks were old trade marks, and in a case prior to the Act of 1905⁴ the Court refused to extend the principle of those cases so as to allow the registration of a new mark similar to one already registered.⁵

Defendant
should apply
for registra-
tion.

¹ 35 C. D. 162; 4 R. P. C. 45 (1886), Stirling, J.

² Sec. 76 of the Act of 1883 after this period made the Register conclusive evidence in the absence on an application to rectify. Sec. 8 of Act of 1875.

³ Chap. XI., p. 323.

⁴ *Hall and Woodhouse's Application*, 19 R. P. C. 58 (1902), Buckley, J.; and see *Ehrmann's Tms.*, [1897] 2 Ch. 495; 14 R. P. C. 665, Stirling, J.

⁵ In a more recent case it was held that applicants for a trade mark had established equal rights by concurrent user with the opponents of the word "Kinahan's" in connection with whisky, and that their mark would not be deceptive by reason of that word appearing on the mark as used: *Lyle and Kinahan, Ltd.'s Application*, 24 R. P. C. 37 and 249 (1907), Kekewich, J., and C. A.

But, as already stated, the Act of 1905 permits concurrent registration of identical or nearly identical trade marks in cases of honest concurrent user or under other special circumstances. Where the defendant wishes to set up an independent right, he should, unless he has a defence under sec. 41, apply to register his own mark, and apply for a stay of proceedings pending a decision of his rights under such application.¹ Prior and continuous user by the defendant is, however, under sec. 41, a good defence to an action for infringement. The proviso to that section is as follows: "Provided that nothing in this Act shall entitle the proprietor of a registered trade mark to interfere with or restrain the user by any person of a similar trade mark upon or in connection with ² goods upon or in connection with which such person has, by himself or his predecessors in business, continuously used such trade mark from a date anterior to the user of the first-mentioned trade mark by the proprietor thereof or his predecessors in business, or to object (on such user being proved) to such person being put on the Register for such similar trade mark under the provisions of sec. 22 of this Act." The first part of the proviso applies whether the earlier user obtains registration under sec. 21³ or not, but it is conditional upon his having used the mark continuously. The meaning of the phrase "continuously used" and the nature and extent of the prior user necessary under this proviso have been considered in an earlier chapter.⁴

Defence
under sec. 41.

Registration
gives the
defendant a
right to use
his mark
prima facie or
conclusive.

It was assumed in the judgments delivered in the cited cases of *Mouson v. Boehm* and *Jackson v. Napper*, and is besides clearly implied by the Act, that registration when properly made gives the defendant an equal title to use the mark with the plaintiff, but only, of course, according to the terms of the entry.⁵ It is just as much an infringement for the defendant to use a registered mark for goods,⁶ or in a market, in respect of which it is not registered, and the plaintiff's mark is registered,⁷ as if the

¹ In *Boord & Son v. Thom and Cameron*, 24 R. P. C. 697 (1907), Inner House, Scotland, it was held in an action commenced in 1905 that the defendants could not set up a concurrent right without a claim that they were entitled to have their mark put on the Register. It is submitted, however, that an application to the Patent Office in the ordinary way is necessary,

and that the Court could not deal with an application for registration.

² Above, pp. 485 and 488.

³ Above, p. 294.

⁴ Chap. XIV., at p. 413.

⁵ Sec. 39.

⁶ *Upper Assam Tea Co. v. Herbert*, 7 R. P. C. 183 (1889), C. A.

⁷ But, of course, if the plaintiffs' registration is, on a motion to rectify

defendant's mark were not registered at all. If the plaintiff alleges that the use of the registered mark of the defendant for the goods in respect of which it is registered is an infringement of his mark, his proper course is to apply in the first place to remove the defendant's mark from the Register before commencing, or concurrently with,¹ the action for infringement. But the registration of the defendant's trade mark may possibly be held to be no answer to an action of infringement based on the use of that mark, at all events in a case in which the defendant has not acquired by the lapse of the period of seven years mentioned in sec. 41 rights under that section. Thus, where under the Act of 1875 the defendant's mark had been registered for less than the period of five years mentioned in sec. 3 of that Act, an interlocutory injunction was granted by the Court of Appeal in terms which in effect restrained the use of the defendant's mark.² And in a later case under similar circumstances a final injunction was granted by the Court of Appeal in an action founded on trade name and passing-off which in effect restrained the use of a registered trade mark.³ And where an action for passing-off was commenced and very shortly afterwards the plaintiffs gave notice of motion to rectify the Register by the removal of the defendant's mark, and the action and motion were heard together, the defendants' mark was ordered to be expunged from the Register, and the defendants were restrained from using it.⁴ In both the cases last cited the defendants were endeavouring to get the benefit of the plaintiffs' trade reputation by the use of the mark.

heard with the action, limited to exclude the goods in which the defendants deal or some of them, the plaintiff cannot obtain an injunction against the use by the defendants of the mark on the goods so excluded. See *Bowden Wire Co., Ltd. v. Bowden Brake Co., Ltd.*, 30 R. P. C. 45 (1913).

¹ As in *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 C. D. 454: 3 R. P. C. 28 (1886), Kay, J., where the Register was rectified by limiting the goods for which the defendant's mark was registered, and an injunction was granted in respect of other goods. And see *Eastman Photographic Materials Co., Ltd. v. John Griffiths Cycle Corporation, Ltd.*, 15 R. P. C. 105 (1898), Romer, J., and *Macmillan v. Ehrmann*,

21 R. P. C. 357 (1904), Buckley, J.

² *Read v. Richardson*, 45 L. T. 54 (1881). See also *Goodwin v. Venning*, 24 Sol. J. 690 (1880), Jessel, M.R. See now the proviso to sec. 39, above, p. 364, and referred to below, p. 461.

³ *Valentine Meat Juice Co. v. Valentine Extract Co., Ltd.*, 17 R. P. C. 673 (1900). No point seems to have been taken by the defendants as to their having registered "Valtino" as a trade mark. The plaintiffs subsequently obtained the removal of the mark from the Register: *Valentine Extract Co.'s Tm.*, 18 R. P. C. 175.

⁴ *Eastman Photographic Materials Co., Ltd. v. John Griffiths Cycle Corporation, Ltd.*, 15 R. P. C. 105 (1898), Romer, J.

The question whether, in a passing-off action, it would be a defence that the defendant's mark was a registered trade mark arose in a recent case in which the registration of the trade mark was opposed on the ground that it would be deceptive if used with a certain blank in it filled up in the manner proposed; a concurrent user within a certain area was established, and Buckley, L.J., in giving his judgment, said, in reference to an argument that the registration of the applicant's mark would give them a right to use it everywhere in the United Kingdom: "The registration of a trade mark does not confer any right at all of the description there pointed to, but it does confer a right, and the only right is the right to prevent anybody else from using that trade mark as a mark for their goods, but it does not give the registered owner of the trade mark any right to use that trade mark if the trade mark would deceive. I conceive that if at the date when application is made to register a trade mark there is no ground of objection upon the footing that it will be calculated to deceive, and if subsequently by alterations in the character of the business of the two parties respectively the use of the trade mark will be calculated to deceive and a passing-off action were brought by one party against the other, it would be no defence at all on the part of the owner of the registered trade mark to say—'Deception or no deception I am entitled to do it because that is my registered trade mark.' That could not be advanced for a moment. In other words, the registration of a trade mark does not confer any right to do that which could not have been done irrespective of the trade mark, in the sense of doing any acts which would be competition in business. The only right which it confers is a right to restrain others from using that trade mark."¹ The passage quoted seems not to deal directly with the question whether the proprietor of a registered trade mark can maintain an infringement action in respect of the mere use by the defendant of a registered trade mark, or whether he must first obtain the removal of the defendant's trade mark from the Register. The principle, however, seems to be the same whether the action is founded on infringement of trade mark or passing-off, and whether by means of an unregistered or registered mark, so that, unless there is anything in the

¹ *Lyle and Kinahan, Ltd.'s Application*, 24 R. P. C. 249 (1907), C. A., at p. 262. See also *Van Zeller v. Mason*, *Cattley & Co.*, 25 R. P. C. 37 (1908), Joyce, J.