

Act preventing an action to restrain the use of a registered trade mark, there seems to be no reason why in a proper case such relief should be refused. It may be that, notwithstanding the proviso to sec. 39, such an action can in the case supposed, and apart from rights acquired by the defendant under sec. 41, be maintained, for sec. 39 confers on the defendant the exclusive right to the use of his trade mark only if the registration of it was valid, and on the supposed facts, namely, that the defendant's mark is identical with or closely resembles the plaintiff's mark, the registration of the defendant's mark could (apart from an independent right such as was established in *Lyle and Kinahan's* case) have been successfully opposed by the plaintiff. And furthermore, even if the period of seven years mentioned in sec. 41 had elapsed, the defendant's trade mark ought, on the supposed facts, not to have been registered, by reason of its offending against the provisions of sec. 11 of the Act.¹ It would appear, therefore, that in any such case, if the original registration could have been opposed by the plaintiff on the ground of the deceptiveness of the defendant's trade mark, and the defendant's mark is still deceptive, a defence founded on sec. 41 is not available to the defendant. But, as already stated, it is advisable for the plaintiff in such a case to apply to remove the defendant's mark from the Register.

If the plaintiff and defendant are severally entitled to, and are the proprietors of, two marks which are in ordinary markets distinct and unlikely to be confused, is it an infringement for the defendant to introduce his mark into a market where the plaintiff's is already known, if from the character of the customers there—their ignorance of English, for instance—its use is calculated to cause the defendant's goods to be taken for the goods of the plaintiff? It is submitted that it is an infringement, for the case put falls within the principle that one trader must not do what is calculated to cause his goods to be taken for those of another, and the defendant's action is in this sense the cause of deception. The question was raised, but not determined, in *Johnston v. Orr-Ewing*, in the House of Lords, and the words of the order of Fry, J., having special reference to the Bombay trade were, with the assent of the respondents, directed to be omitted. Lord Selborne said, in his judgment in the case: "Your Lordships are not called upon to decide

Is the introduction of the defendant's own mark into a new market an infringement?

¹ Above, p. 297.

whether a ticket, which was a rightful and *bonâ fide* trade mark of the trader using it, could be excluded by injunction from particular markets (though unimpeachable everywhere else) merely because in those markets it might be liable to be called by a name which the mark of another trader had already acquired there. . . . To that proposition I should not myself, as at present advised, be prepared to assent.”¹ The passage quoted above from the judgment of Buckley, L.J.,² supports the proposition that if the use of the mark in a new district would cause deception the plaintiff could succeed at all events in a passing-off action. On the other hand, Lord Alverstone, in the same case, after stating that the Court had not in that case the powers conferred by the Act of 1905, and after referring to the argument that the applicant’s concurrent user had only been in a certain district, said: “We have not the materials before us for saying so, but I feel very great difficulty, when once you get a *bonâ fide* concurrent user, in saying that a man is to be limited in a subsequent user if he is entitled to have the registered trade mark for the user that he then possessed. I do not want in any way to fetter the judgment of this Court, or my own judgment, in case it may turn out that some large and extended user would be unfair having regard to the circumstances of the case, but once you get that an honest trader is entitled to come and ask for a registration of his trade mark, I do not think it is an objection to the registration that he is going to use the trade mark in a much more widely competitive area than that in which he has been selling his goods in up to the time his application is made.” Within the United Kingdom, if the defendant’s mark is registered without limit of area, he has a *primâ facie* right so to use it, and in order to challenge that right the plaintiff should take proceedings to rectify the register.³

Introduction
into a new
trade.

The introduction of the defendant’s marks into a new trade in

¹ 7 App. Ca. p. 227 (1882). See also *Wilkinson v. Griffith*, 8 R. P. C. 370 (1891), Romer, J.; and *Royal Insurance Co., Ltd. v. Midland Insurance Co., Ltd.*, 26 R. P. C. 95 (1909), C. A., a trade name case, in which the notice of appeal asked for an injunction confined to the county of Lincoln, and the Court, whilst dismissing the appeal on the ground of the defendants’ name

not being calculated to deceive, expressed the difficulties it would have felt in any case in granting any such partial relief. An injunction, on the ground of “passing-off,” limited to Ireland, was granted in *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L.J.

² Above, p. 460.

³ See above, pp. 459 to 461.

goods for which it is not, and the plaintiff's mark is registered, is undoubtedly an infringement.¹

Where the case made is one of colourable infringement by using part of the registered mark, or a word taken from the registered mark, the defendant may show that he has a concurrent right to the use of the part or word, as, for instance, by prior user of it.²

Registration for copyright purposes of a mark at Stationers' Hall under the former Copyright Acts conferred no trade mark rights, and constituted no defence if the mark was an infringement of another person's trade mark.³

Registration
at Stationers'
Hall.

Where a partnership is dissolved without a sale of the goodwill, or any arrangement having been made for its disposal, or governing the use of the trade marks of the firm, each of the late partners who carries on the business may use the trade marks,⁴ for he is, as to a portion of the goodwill, a successor of the firm;⁵ but if the goodwill is sold as part of the assets of the firm, the exclusive right to use the trade marks may be sold with it, and in that case the late partners cannot lawfully use the trade marks, even though they set up a similar business in competition with the purchaser.⁶

Trade mark
rights on a
dissolution of
a partnership.

But a late partner cannot grant to others who are in no way

¹ Above, p. 458, note (6). In *Hodgson v. Kynoch*, 15 R. P. C. 465 (1898), Romer, J., the defendants were makers of ammunition. Their works were known as Lion Works, and they had lion trade marks. Held, that they were not justified in using lion marks for soap. And see *Nitedals Taendstik-fabrik v. R. Lehmann & Co., Ltd.*, 25 R. P. C. 793 (1908).

² *Edge v. Gallon*, 16 R. P. C. 509, and 17 R. P. C. 557 (1900), C. A. and H. of L. (*Dolly Blue*); *Meaby v. Triticine*, 15 R. P. C. 1 (1897), North, J., both "passing-off" cases. In an infringement action, the defendant would probably argue alternatively that he had not infringed or that the plaintiff's mark was wrongly registered. See also *Lyle and Kinahan, Ltd.'s Application*, 24 R. P. C. 87 and 249 (1907), Kekewich, J., and C. A.

³ *Reinhardt v. Spalding*, 49 L. J. Ch. 57 (1879), Hall, V.-C. (*Family Salve*); *Paine v. Daniells & Sons' Breweries*,

[1893] 2 Ch. 567; 10 R. P. C. 217.

⁴ *Banks v. Gibson*, 34 Beav. 566 (1865), Romilly, M.R.; *Condy v. Mitchell*, 37 L. T. N. S. 268 and 766 (1877), Bacon, V.-C., and C. A.; *Enbow v. Low*, 44 L. T. N. S. 875 (1881), Bacon, V.-C. See Chap. XIII., p. 392. As to cases where the severance of business relations determines a joint trade mark, see *Robinson v. Finlay*, 9 C. D. 487; and *Jones' Tm.*, 53 L. T. N. S. 1. As to trade name on dissolution of partnership, see next chapter, p. 590.

⁵ The Act of 1905 permits the apportionment of trade marks by arrangement and with the approval of the Registrar on a dissolution of partnership or other division of goodwill, sec. 23, above, pp. 392 and 393. As to the law under the Act of 1883, see *Ehrmann's Tms.*, [1897] 2 Ch. 495; 14 R. P. C. 665, Stirling, J.

⁶ See *Re David and Matthews*, [1899] 1 Ch. 878, Romer, J., cited below, p. 590, where all the authorities are reviewed.

successors to the firm's business, or any part of it, a right or licence to use the trade marks, even though he be registered as proprietor of the marks. The case of *Hanson v. Game, Harrison and Larner, Limited*,¹ was decided on the construction of a consent order under which the partnership in question had been dissolved, and which provided that the late partners "and any partners they may take respectively" were to have the common use of the trade marks; but it is submitted that the decision might have been put on the general ground that the defendants—a limited company, of which one late partner was a shareholder and director—could not use the marks without infringing the rights of the plaintiffs, the other late partner and his partners, because they were not possessed of the goodwill of any part of the old business.

Sale of trade marks in bankruptcy.

So if the trustee in bankruptcy of a trader sells the goodwill and trade marks of the latter's business, the trader has no right to continue to use the marks.²

Honest use of the defendant's name, place of business, or description of the goods is no infringement.

A trader who is honestly using his own name in his business will not be guilty of infringement because its similarity to a name appearing in another's trade mark is calculated to lead to deception. Section 44 provides that no registration under the Act of 1905 shall interfere with any *bonâ fide* use by a person of (*inter alia*) his own name³ 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.⁴ But to support the defence that the defendant is *bonâ fide* using his own name, the business must be the defendant's own, for a fraudulent attempt to cover an infringement by employing or taking into partnership a man who happens to bear the name which is to be used to effect the fraud, still less by buying from him the right to use his name, will not avail to protect the offender.⁵

(3) The necessity for registration of the plaintiff's marks, having regard to sec. 42, has already been discussed.⁶

(4) And so has the question, What constitutes an infringement? including the special provisions of secs. 43 and 44 of the Act.⁷

¹ 9 R. P. C. 186 (1892), Stirling, J.

² *Hammond v. Bruncker*, 9 R. P. C. 301 (1892), Chitty, J.; *Hudson v. Osborne*, 89 L. J. Ch. 79 (1869), James, V.-C.; *Melrose Drover, Ltd. v. Heddle*, 4 Fraser, 1120 (1902), Scotland.

³ See the corresponding provision of

the Act of 1888, s. 10.

⁴ See below, p. 653.

⁵ See the next chapter, p. 593, where this matter is fully discussed in relation to trade names.

⁶ Above, p. 429, Chap. XII., at p. 373.

⁷ Above, pp. 491 *et seq.*

Estoppel.

(5) (a) With the exception of the several defences which are considered below, there is nothing peculiar to the law of trade marks to determine what agreements, or what circumstances constituting a personal estoppel, will prevent a plaintiff from suing a particular defendant for infringement. It is to be remembered, however, that an infringement is primarily a fraud on the public, in respect of which the plaintiff is allowed to sue, because its natural effect is to cause damage to him.¹ An agreement, therefore, not to prosecute future infringements would be an agreement to permit a fraud, and although, if established, it would undoubtedly prevent the Court from interfering in favour of any party to it,¹ it could not be specifically enforced, and, unless the intention were clearly indicated, the Court would presume that a lawful arrangement, for instance, a waiver of the remedy in respect of past infringements only, was intended.²

Agreement to condone infringements.

As an instance of estoppel by conduct, the case of *Maxwell v. Hogg*³ may be taken. There the defendants had received, and published for reward from the plaintiffs, advertisements of an intended new magazine, bearing the title of a magazine which they were themselves preparing to publish, without warning the plaintiffs of their own intention; and this uncandid conduct was held to be sufficient ground for dismissing the cross suit of the defendants for an injunction to prevent the plaintiffs using the name.

Uncandid conduct.

And anything in the nature of a representation by the plaintiff to the defendant that his mark was not an infringement, or that it might be lawfully used,⁴ or of an encouragement to him to continue using it, would be an answer to a subsequent claim for damages for infringement, although a mere failure by the

Failure to give warning.

¹ See *Grezier v. Autran*, 13 R. P. C. 1 (1896) (*Chartreuse*), where an agreement was set up, Chitty, J., said, "I need hardly state that the plaintiffs do not move in any sense on behalf of the public."

² *Oldham v. James*, 12 Ir. Ch. 393; 14 Ir. Ch. 81 (1862), Brady, C., and Blackburn, L.J.

³ L. R. 2 Ch. 307 (1867), Turner and Cairns, L.JJ., cited p. 95.

⁴ A defence of this nature was success-

ful on appeal in *Burgoyne v. Godfree*, 21 R. P. C. 550; 22 R. P. C. 168 (1905), Warrington, J., and C. A., where wine rejected by the plaintiffs and sold on their orders was contained in casks bearing the words "Burgoyne, London," and the defendants bought it, and afterwards sold it as Burgoyne's wine under a *bona fide* mistake on their part which, it was held, the conduct of the plaintiffs had induced.

plaintiff as soon as he had knowledge of the infringement to warn the defendant, would be no bar.¹

The plaintiff is not barred because he uses his registered mark with additions.

It is sometimes urged, on behalf of the defendant, as an objection to the plaintiff's case, that the plaintiff in actual practice uses his mark in a form different from that for which he has obtained registration; but the variation of his registered mark by the plaintiff, provided it is not an infringement of any other person's mark, or a breach of any agreement binding upon him, is perfectly lawful, although so far as the mark actually used differs substantially from his registered mark, it is an unregistered mark, as has been already pointed out. If the registered mark is in substance not used at all, that would be an independent objection to the plaintiff's action.² It is well settled that the use of a varied mark by the plaintiff does not in any way estop him from proceeding against infringers. Thus, in *The Melachrino* case,³ the plaintiffs had tried to register a label comprising three coats of arms, but the coats of arms had been rejected and the label registered without them. The plaintiffs, nevertheless, always used the labels with the arms in it, and the defendants, who had imitated the label, were enjoined from continuing the infringement. In a subsequent case,⁴ Chitty, J., said: "I adhere to what I said in *Melachrino's* case, that the mere addition of something, as, in that case, a coat of arms, to the trade marks, is not sufficient to disentitle a person who otherwise uses the whole of his trade marks to sue for an injunction."

Similarly, it is no ground of estoppel that the plaintiff extends the use of his mark to goods in respect of which it is not registered.⁵

Acquiescence. (b) Acquiescence in the infringement on the part of the plaintiff is a complete defence,⁶ but it can only be inferred where he is

¹ See *Proctor v. Bennis*, 86 C. D. 740 (1887), C. A., a patent case; and the notes to *Savage v. Foster*, 2 White & Tudor's Leading Cases, 6th ed., 680. The rule is "*qui potest et debet vetare jubet*"; *Osborn v. Lees*, 9 Mod. 96; *Willmott v. Barber*, 15 C. D. 96; 17 C. D. 772. As to delay, see p. 468.

² Above, p. 428.

³ *Melachrino & Co. v. The Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215 (1887), Chitty, J.; *Newman v. Pinto*, 4 R. P. C. 508; 57 L. T. 31 (1887), Keke-

wich, J., and C. A. In *Rowland v. Michell*, 13 R. P. C. 457; 14 R. P. C. 37 (1896), Romer, J., and C. A., the plaintiff omitted some of the added words and used other words. This was held to be immaterial.

⁴ *Hammond v. Bruncker*, 9 R. P. C. p. 307 (1892).

⁵ *Jay v. Ladler*, 40 C. D. 649; 6 R. P. C. 186 (1888), Kekewich, J.

⁶ Per Chitty, J., in *Mouson & Co. v. Boehm*, 26 C. D. p. 406 (1884).

shown to have had knowledge of it.¹ And, assuming that it is shown that the plaintiff knows of the infringement, the Court will not readily infer that he has assented to what is likely to be so detrimental to his property. It has been held that, where it is pleaded in answer to a motion to commit the defendant for the breach of an injunction restraining him from infringing, it must amount to a licence "sufficient to create a new right in him."²

In *Rowland v. Mitchell*³ Romer, J., said: "I quite agree that merely threatening a person in cases of this kind, without taking proceedings, is not sufficient. If the plaintiff really does stand by and allow a man to carry on business in the manner complained of, to acquire a reputation, and to expend money, he cannot then, after a long lapse of time, turn round and say that the business ought to be stopped." On the other hand, Lord Russell, L.C.J.,⁴ said in the same case: "It cannot be stated as a general proposition in respect of a person, irrespective of the character of the trade done, and the extent of that trade in respect of the position and impecuniosity of that person, that the moment it comes to the knowledge of a manufacturer that somebody has been trying to do a fraudulent thing on his part he is bound to take proceedings, or if he does not take proceedings, it is concluded against him that he means to acquiesce in the right of that other person to continue to do what he has been doing."⁵ The facts of each case must be examined to see whether there has been an acquiescence or not.

A licence by the plaintiff to the defendant to use the mark Licence.

¹ *Weldon v. Dicks*, 10 C. D. 247 (1878), Malins, V.-C.; *Re Farina*, 27 W. R. 456 (1879), Hall, V.-C., and the last case. See, generally, *De Bussche v. Alt*, 8 C. D. 286, C. A.; and *Willmot v. Barber*, 15 C. D. 96; 17 C. D. 772, Fry, J., and C. A.

² *Rodgers v. Nowill*, 3 De G. M. & G. 614; 22 L. J. Ch. 404 (1853), per Turner, L.J. As to what constitutes acquiescence, see *Proctor v. Bennis*, ante, p. 466, note (1); "delay," p. 468; and *Hogg v. Scott*, L. R. 18 Eq. 444, Hall, V.-C.; *Weldon v. Dicks*, 10 C. D. 247, Malins, V.-C. (copyright); and *Smith v. Smith*, L. R. 20 Eq. 500, Jessel, M.R. (ancient lights). See also, generally, the article *Acquiescence* in the Encyclopædia

of English Laws.

³ 13 R. P. C. p. 464. It was held there had been no acquiescence or abandonment in this case, see below, p. 470, note (7). See also on the defence of "standing by," per Byrne, J., in *Jamieson v. Jamieson*, 15 R. P. C. 169, at p. 179.

⁴ 14 R. P. C. at p. 44. See also Kekewich, J., in *Ripley v. Bandy*, 14 R. P. C. at p. 596.

⁵ Followed in *Reddaway v. Stevenson and Brother, Ltd.*, 20 R. P. C. 276 (1903), Hall, V.-C., where the plaintiffs knew of the acts complained of three and a half years before action, but took no proceedings after inquiring into the defendants' position.

would be proof of acquiescence in user falling within the terms of the licence, and would be a defence.¹ Under sec. 87 of the Act of 1883, any registered proprietor could grant licences to use the mark, subject to any equities affecting it, unless, for instance, he had agreed with the plaintiff not to do so.² But the Act of 1905 contains no power for the registered proprietor to grant licences,³ and a licence to a person who has no interest in the goodwill of the business would seem to be invalid as leading to deception,⁴ but it would if given by the plaintiff estop him from complaining of the improper use.

Delay does not bar the right of action

(c) Mere delay, after knowledge of the infringement, to take proceedings, not sufficient to call the Statute of Limitations into operation, or where the infringement continues, is no bar to the action. Before the Judicature Acts it might have furnished an answer to an application for an injunction,⁵ at least until the plaintiff had established his rights by recovering damages in an action at law, unless the deception resulting from the use of the defendant's mark were still continuing.⁶ But both branches of the Court now enforce legal and equitable rights together, and consequently, wherever an injunction could have been obtained after an action for damages, it can now be obtained at once or concurrently with the judgment for damages. The rule is not peculiar to trade mark cases, but is part of the general law.⁷ It was stated by Fry, J., in the following terms, in *Fullwood v. Fullwood* (2):⁸ "In my opinion that delay" (from early in 1875, when the plaintiff first knew of the infringement, till November, 1876, when he commenced his action) "—and it is simply delay—is not sufficient to deprive the plaintiff of his rights. The

¹ *Kinahan v. Bolton*, 15 Ir. Ch. 75 (1863), Brady, C. But neither the licence nor the user under it entitles the licensee to continue to use the trade mark after the expiration of the licence; so held by Swinfen Eady, J., in *Bowden Wire, Ltd. v. Bowden Brake Co., Ltd.*, 30 R. P. C. 45 (1913), in which case the licence to use the trade mark was co-terminous with a licence under a patent, see above, p. 395.

² *Hanson v. Game, Harrison and Larner, Ltd.*, 9 R. P. C. 186 (1892), Stirling, J.

³ Cf. sec. 38 with sec. 87 of the Act of 1883.

⁴ See above, p. 394.

⁵ *Hovenden v. Lloyd*, 18 W. R. 1132 (1870), Bacon, V.-C., fifteen months' delay; *Estcourt v. The Estcourt Hop Essence Co.*, 10 Ch. 276 (1875), Cairns, L.C., and L.JJ., seven months delay.

⁶ *Rodgers v. Rodgers*, 31 L. T. N. S. 285 (1874), L.JJ.

⁷ See *The Three Towns Banking Co. v. Maddever*, 27 C. D. 533 (1884), C. A.

⁸ 9 C. D. p. 178 (1878); and see *L. C. & D. Rail. Co. v. Bull*, 47 L. T. 419; and *Sander v. Mauling* (1878), W. N. 181, where it was held that a nuisance could be stopped although it had been going on for many years.

right asserted by the plaintiff in this action is a legal right. He is, in effect, asserting that the defendants are liable to an action for deceit. It is clear that such an action is subject to the Statute of Limitations,¹ and it is also clear that the injunction is sought merely in aid of the plaintiff's legal right. In such a case the injunction is, in my opinion, a matter of course, if the legal right be proved to exist. In saying that I do not shut my eyes to the possible existence in other cases of a purely equitable defence, such as acquiescence or acknowledgment,² and the various other equitable defences which may be imagined. But lapse of time, unaccompanied by anything else (and to that I confine my observations), has, in my judgment, just as much effect, and no more, in barring a suit for an injunction as it has in barring an action for deceit. In my judgment, the same rule applies since the Judicature Act as formerly applied in the Court of Chancery when the legal right had to be determined in an action at law."³

But delay may affect the nature of the relief granted. It may cause the Court to refuse the ordinary interlocutory injunction, either on terms of the defendant keeping an account, or absolutely,⁴ or to refuse to give damages, or to direct an account of profits in lieu of damages, or to restrict such account to profits made since the beginning of the action.⁵

but delay
may modify
the relief
granted:

And in a case where the plaintiffs took no action on hearing that the defendant had received a small consignment of spuriously marked goods, preferring to wait until he received a larger consignment, *Malins, V.-C.*, ordered the injunction to be directed to future receipts by the defendant only.⁶ Unless, however, this case can be supported on the ground of acquiescence, it is submitted that it is inconsistent with the rule established by the cases cited above.

In *Liebig's Extract of Meat Co. v. Chemists' Co-operative Society*,⁷ the defendants had used the wrapper complained of

¹ But where the tort is continuing, the right of action is also continuing.

² *Quære* abandonment.

³ Cf. the judgment of Mellish, L.J., upon the defence of misrepresentation in *Ford v. Foster*, L. R. 7 Ch. p. 632.

⁴ See below, "Interlocutory injunction," p. 493.

⁵ See below, "Profits," p. 499 *et seq.* The American law is the same on both points.

It is well stated in *McLean v. Fleming*, 96 U. S. Rep. 245, followed in *Menendez v. Holt*, 128 U. S. Rep. 514 (both Supreme Court), Cox, pp. 326; 467.

⁶ *The Anglo-Swiss Condensed Milk Co. v. The Swiss Condensed Milk Co.* (1871), W. N. 163.

⁷ 13 R. P. C. 635, 736 (1896), Keke-wich, J., and C. A., a trade name and passing-off case.

in 1893. The plaintiffs discovered in 1894 that the defendants were using it, but they did not know to what extent. They commenced their action in May, 1896, and obtained full relief, *i.e.*, an injunction, an inquiry as to damages, and costs.¹

In an Irish case, where there had been over a year's delay in bringing the action, the injunction was stayed for six weeks to allow the defendant time to make the arrangements necessary for the alterations of his trade name required by it.²

and may amount to abandonment.

But delay to pursue infringers, where the infringements are numerous and notorious, may amount to abandonment³ of the trade mark, and lead to its becoming *publici juris*.⁴ Mere adverse user unknown to the owner of the mark will not make the mark *publici juris*, however, if begun in fraud, and if the mark is still deceptive.⁵

Delay may be explained.

The delay may be of little importance if it appears that the plaintiff had been led to believe that the infringement had ceased,⁶ or if the infringement is of slight amount. Its bearing on the case must always depend upon the circumstances under which it occurs. Thus in *Rowland v. Mitchell*⁷ the plaintiff knew of an infringement by a third party in 1892. The third party when threatened with proceedings refused to stop, but was not worth suing. The plaintiff lost sight of him, and thought that the infringement had stopped. The action was begun in October, 1895, and the plaintiff obtained an injunction, with an inquiry as to damages and costs.

¹ In *Reddaway v. Stevenson and Brother, Ltd.*, 20 R. P. C. 276 (1903), Hall, V.-C., damages were refused after a delay of three and a half years.

² *Grant v. Levitt*, 18 R. P. C. 361 (1901), Porter, M.R. (*Globe Furnishing Co.*).

³ Page 412.

⁴ As in *Hyde & Co.'s Tm.*, 7 C. D. 724 (1878), Jessel, M.R. (*Bank of England Sealing Wax*); Chap. XIV., p. 405. See also *National Starch Manufacturing Co. v. Munns & Co.*, [1894] A. C. 275; 11 R. P. C. 281 (*Maizena*), there cited. In *Ripley v. Bandey*, 14 R. P. C. 591 (1897), Kekewich, J. (*Oval Blue*), the action was dismissed, because the plaintiff had known of the use by others of the get-up of which he complained beginningsixteen years before the action.

This use was at first small, but ultimately became important. An appeal was compromised, 14 R. P. C. 944.

⁵ *Heaton's Tm.*, 27 C. D. 570 (1884), Kay, J., referring to the use by the applicants of the word "Warranted" in connection with the Hoop L, described it as a falsehood which gained nothing in respectability by being repeated.

⁶ *Daniel and Arter v. Whitehouse*, [1898] 1 Ch. 685; 15 R. P. C. 134, Gorell Barnes, J.

⁷ 18 R. P. C. 457; 14 R. P. C. 37, Romer, J., and C. A., not reported on this point in L. R. The third party was a costermonger. See the passages quoted above, p. 467. Cf. *Ripley v. Bandey*, p. 467, note (4).

And, as already pointed out, delay may have an important bearing on the weight of the evidence in the case, for if, in spite of long user by the defendant of the alleged infringing mark, no case of actual deception is proved, and the absence of evidence of such deception is not otherwise accounted for, it may be difficult for the Court to believe that the defendant's mark is calculated to deceive. Thus where the owners of a trade mark consisting of the word "glacier" registered for transparencies sued for infringement by the use of the word "glazine," and they had known of the defendant's user for at least four years, and no case of deception was proved, the action was dismissed.¹ Where the defendants had, although unknown to the plaintiffs, used their get-up for thirteen years and no case of fraudulent inception had been set up in the pleadings, the Court of Appeal, reversing Warrington, J., held that there was no probability of deception, and this decision was affirmed in the House of Lords.² It has been suggested that, where the infringement has lasted a number of years, it is necessary for the plaintiff to prove that some persons have actually been deceived,³ but this is not, it is submitted, a rule of law.⁴

It has a bearing on the weight of evidence.

In passing-off cases, where the transaction complained of is purely oral, it is matter of comment if the defendant's attention is not called to it as early as possible.⁵

Moreover, lapse of time may prevent conduct which would at first be an infringement from being calculated to deceive. Thus, in *The Marquis of Londonderry v. Russel*,⁶ an action against the defendant, for sending coals to the London market as "Londonderry Wallsend Coal," was dismissed because the defendant had used the name for twenty-five years, and the plaintiff had long

¹ *McCaw, Stevenson & Orr, Ltd. v. Lee*, 23 R. P. C. 1 (1906), Swinfen Eady, J. Cf. *Liebig's Extract of Meat Co. v. Chemists' Co-operative Society*, cited on p. 469, where no instance of actual deception was proved.

² *Claudius Ash, Son & Co. Ltd. v. Invicta Manufacturing Co.*, 28 R. P. C. 252 and 597; 29 R. P. C. 465 (1912).

³ *Rodgers v. Rodgers*, 31 L. T. N. S. 285 (1874), per Mellish, L.J.; *Isaacson v. Thompson*, 41 L. J. Ch. 101 (1871), Bacon, V.-C.

⁴ See "Proof of Actual Deception,"

p. 287.

⁵ *Carr & Sons v. Crisp & Co., Ltd.*, 19 R. P. C. 497 (1902), Byrne, J.

⁶ 2 Times L. R. 848; 3 Times L. R. 360 (1886), Bacon, V.-C., and C. A.; and see *Gledhill & Sons, Ltd. v. British Perforated Toilet Co., Ltd.*, 28 R. P. C. 429 and 714 (1911), where Eve, J., held that "Gledhill's Coils" meant in 1902 the plaintiff's goods, but in 1909 had become generic. The Court of Appeal doubted whether the plaintiffs could have succeeded even in 1902.

known of his use of it. Whatever might have been the result had the plaintiff applied in 1861 to restrain the defendant from selling his coals under the name, it was clear, as the Court of Appeal held, that at the time of their judgment the defendant's conduct could not be taken to amount to any representation that his coals came from the plaintiff's Londonderry collieries.

Deceptive
trade mark
and fraudu-
lent trade.

(d) The Court will not interfere to protect the use of a deceptive trade mark, or to assist a trader who is using his mark for the purposes of a fraudulent trade. This principle was well established in the Court of Chancery, and, although no case seems to be reported upon the point, it would no doubt have been recognised also in the Courts of Common Law before the Judicature Acts, had any case occurred, for the maxim *ex turpi causa non oritur actio* is a rule of law.¹

"The plaintiff," Lord Westbury said, in *The Leather Cloth case*,² "desires to restrain the defendant from selling his own goods as the goods of another person; but if, by the use of the trade mark in question, the plaintiff himself is representing and selling his goods as the goods of another, or if his trade mark gives a false description of the article, he is violating the rule upon which he seeks relief against the defendant."

Deceptive
trade marks
are outlawed.

The deceptive mark, in Sir Roundell Palmer's phrase, adopted by James, V.-C., in *The Leather Cloth Co. v. Lorsche*,³ is "outlawed."

Collateral
misrepresenta-
tion.

The earliest of the cases commonly cited, in which the Court of Chancery refused to interfere, on the ground of the plaintiff's

¹ See the judgment of Mellish, L.J., in *Ford v. Foster*, L. R. 7 Ch. p. 631 (1872), cited below, p. 473. In a "got up" case, *Jamieson v. Jamieson*, 15 R. P. C. 169, V. Williams, L.J., said, *obiter*, that misrepresentation to the public would be no answer to an action for damages. The misrepresentation alleged was not comprised in the matter sought to be protected, and the Court, in fact, thought there was no misrepresentation. In *Wolff v. Nopitsch*, 18 R. P. C. 27 (1901), Ld. Alverstone, L.C.J., said that he wished to reserve his opinion on the question whether there was any distinction between cases of trade mark and of fraudulent passing off. In *Bile Bean Manufacturing Co. v. Davidson*, 23 R. P. C. 725 (1906), Inner House,

Scotland, Ld. Stormonth Darling said that he could not imagine a principle of so general a nature and intended to protect the public against fraud as turning on any mere question of proceeding as between courts of law and courts of equity; and the principle was there applied to a trade name case, see below, p. 486; and the principle was held by Farwell, J., to be applicable in a trade name case, *Cropper Minerva Machines Co., Ltd. v. Cropper Charlton & Co., Ltd.*, 23 R. P. C. 388 (1906), in which he considered that the description "the old and original firm" was not justified by the circumstances.

² 4 De G. J. & S. 137; 33 L. J. Ch. 199 (1863).

³ L. R. 9 Eq. p. 352 (1869).

own deceptive conduct, until the plaintiff had established his right by action at law, is *Pidding v. How*,¹ and the leading authority on the subject is the judgment of Mellish, L.J., in *Ford v. Foster*.² There it was objected by the defendants that the plaintiff in certain invoices and advertisements had falsely described himself as a patentee; but as the false description was collateral and did not appear in the mark in question, and the plaintiff's trade was not shown to be fraudulent, the Court decided that the plaintiff's legal right of action in respect of the defendants' infringement was not barred, and that he was consequently entitled to an injunction, with an account from the filing of the bill, and costs. If the false representation had been in the trade mark itself, the Lord Justice held, no Court of Equity, and, according to his opinion, no Court of law, would have entertained the plaintiff's action, and the same rule would apply if the trade were fraudulent; but, he said, "where the trade is, as in this case, a perfectly honest trade, and where the trade mark is, as in this case, a perfectly honest trade mark, I am clearly of opinion that there is no common law principle upon which it is possible to hold that the fact that the plaintiff has been guilty of some collateral fraud would be an answer to an action. It would be impossible to plead at law as a justification for the defendant's committing the fraud, that the plaintiff had committed a fraud on some one else." "It is true," he added, "that in this case the bills containing the false representation as to its being a patented article are proved to have been given to the defendants themselves; but there is not the slightest evidence, or the slightest reason for supposing, that the defendants were ever deceived by that representation, because they knew perfectly well that there was no patent for these shirts."³

*Ford v.
Foster.*

The judg-
ment of
Mellish, L.J.

¹ 8 Sim. 477; 6 L. J. Ch. (N. S.) 845 (1837), Shadwell, V.-C. Lying advertisements as to the origin of tea (*Howqua's Mixture*). The Vice-Chancellor said, "It is a clear rule, laid down by Courts of equity, not to extend their protection to persons whose case is not founded upon truth."

² L. R. 7 Ch. 611 (1872) (*Eureka Shirts*). For the American authorities, which are very numerous, see Mr. Cox's note to this case.

³ See p. 472, note (1), above. The matter is well stated in an American case. "Courts of equity will not protect a

trade mark that deceives the public. We do not suppose, however, that that deception need be of such a character as to work positive injury to purchasers, nor, on the other hand, that every erroneous impression which the public or a portion of the public may receive will be sufficient to destroy the validity of a trade mark. The question is whether . . . the representation is of such a character as to defeat the petitioner's claim to protection": *Meriden Britannia Co. v. Parker*, 12 Amer. Rep. 401, cited by Cox, p. 29.

Examples of collateral misrepresentations.

The following are some miscellaneous examples of cases where objections to the plaintiff's case on the ground of collateral misrepresentation failed:¹ title of a magazine protected, although the magazine purported to be written by some one other than the author, *Hogg v. Kirby*, 8 Ves. 215; 7 R. R. 30; similar cases with regard to songs, *Chappell v. Sheard*, 2 K. & J. 117; *Chappell v. Davidson*, 2 K. & J. 123; 8 De G. M. & G. 1; "Holloway's pills and ointment" protected, although the plaintiff called himself Professor Holloway without warrant, and published exaggerated commendations of his pills, *Holloway v. Holloway*, 13 Beav. 209; an objection on the ground that the plaintiffs retained a brass plate on the door of their business premises, bearing their predecessor's name, overruled, *Hudson v. Osborne*, 39 L. J. Ch. 79. Somewhat analogous to the cases cited, is that of *R. Paterson & Sons v. Kit Coffee Co.*, 27 R. P. C. 594, where the plaintiffs sought in Scotland a declaration of invalidity of the defendants' registered trade mark "Kit" for coffee, alleging that subsequent to its registration, fraudulent misrepresentations had been made, not by the defendants, but by their predecessors in title, that "Kit" coffee essence was the same as the plaintiffs' "Camp" coffee essence; but it was held that, even if the misrepresentations should be proved, being extraneous to the mark, the use of the mark by the defendants was not necessarily deceptive, and the proceedings were on the pleadings held to be irrelevant, and were dismissed.

Section 11 provides 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 be disentitled to protection in a Court of Justice, or would be contrary to law or morality, or any scandalous design,² and the registered proprietor of a trade mark offending against this section acquires no rights under sec. 41 of the Act, after seven years' registration.

Application to remove mark from the Register.

It follows that a trade mark which contains false statements or misrepresentations ought not to be entered or retained upon the Register, and, in modern cases, if the defendant wishes to rely upon the defence now under consideration, and to allege that the plaintiff's trade mark itself is deceptive, he commonly applies under sec. 35 to have it removed from the

¹ See also the cases as to the use of the word "patent" cited below, pp. 478 and 479.

² Chap. X., p. 297.

Register.¹ This is a convenient method of bringing the question to an issue, if the plaintiff is suing in respect of a registered mark, and it is the most advantageous course for the defendant; but there is no reason to suppose that the Court would be any more ready to interfere to protect a deceptive trade mark because it was registered, or that it is not open to the defendant to give evidence in support of a plea of the defence in question without there being any application under sec. 35 before the Court.²

(i.) Where the trade mark itself contains misrepresentations—

In *The Leather Cloth* case,³ the plaintiffs' case failed because, in the label in question, they had described their goods as "tanned leather cloth," "patented," and "J. R. and C. P. Crockett" as the manufacturers, adding an American address, whereas, in fact, much of the cloth for which the mark was used was not tanned, none of it was made under any patent, and the manufacturers were not J. R. and C. P. Crockett, but the plaintiffs themselves, who had no American address. It was urged on behalf of the plaintiffs that the misrepresentations, and in particular the representation that the goods were tanned, could not deceive any ordinary purchaser; but in answer to this Lord Westbury said: "I cannot receive it as a rule either of morality or equity that the plaintiffs are not responsible for a falsehood because it is so gross and palpable that no one is likely to be deceived by it. If there is a wilfully false statement, I will not stop to inquire whether it is too gross to mislead."⁴

The Leather Cloth case.

It is immaterial that the misrepresentation does not deceive;

It is no answer to the objection that the trade, or any other given class of persons, know the actual facts and are not deceived;⁵ for, as in the case of the test of infringement, the question is—is the mark calculated to deceive any probable purchasers who buy from the plaintiff directly or indirectly through others to whom he sells?

or that the facts are known to the trade.

¹ *Wood v. Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A.; *Dexter's Tm.*, [1893] 2 Ch. 262; 10 R. P. C. 269, Wright, J. See Chap. X., p. 297.

² As to this point, see *Hubbuck v. Brown*, 17 R. P. C. 638 (1900), C. A.

³ 4 De G. J. & S. 137; 33 L. J. Ch. 199, Ld. Westbury; and 11 H. L. C. 523; 35 L. J. Ch. 53; H. L. overruling 1 H. & M. 271; 32 L. J. Ch. 721, *Wood, V.-C.* (1863). See also *Newman*

v. Pinto, 4 R. P. C. 508; 57 L. T. 31 (1887), C. A., mark representing German cigars as of Havana make, cited, p. 486.

⁴ 33 L. J. Ch. p. 203. So per Fry, L.J., in *Newman v. Pinto*, 4 R. P. C. p. 520 (1887).

⁵ *Wood v. Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A., false suggestion of origin, cited above, pp. 223 and 224; cf. *Eno v. Dunn*, 10 R. P. C. 261 (1893).

False claim
of patent
right.

The wrongful use of the word "patent," or other similar expression, should be pleaded, and cross-examination of the plaintiff's witnesses to show such use will not be allowed unless the point is raised in the pleadings.¹

The employment of the word "patent" in a mark used for goods which are not manufactured under an existing patent right has given rise to much discussion;² but the authorities do not seem to have established any more definite rule than that it is in each case a question whether or not the employment of the word makes a false and deceptive claim to a non-existent patent right for the goods.³ It is not necessarily deceptive to describe as "patent" goods made according to a process which once was patented, or even those made according to a process which is, or was when the epithet was first applied, different from the common process, though never protected by a patent, for ordinary usage and understanding have long sanctioned such description, as the names patent leather, patent medicine, patent metal, patent yellow, and patent hoe, show.⁴

Lord Kings-
down's judg-
ment in *The
Leather Cloth*
case.

The following passage from Lord Kingsdown's judgment, in *The Leather Cloth* case,⁵ in reference to the subject under consideration, is very frequently cited in argument: "If a trade mark represents an article as protected by a patent, when in fact it is not so protected, it seems to me that such a statement *prima facie* amounts to a misrepresentation of an important fact, which would disentitle the owner of the trade mark to relief in a Court of Equity against anyone who pirated it. In *Flavel v. Harrison*,⁶ Wood, V.-C., intimated his opinion that this would be so when there never had been any patent at all. But in the subsequent

¹ *Lever v. Goodwin* (1887), W. N. 107; *Boake Roberts & Co., Ltd. v. Wayland*, 26 R. P. C. 251 (1909); in both cases leave to amend was refused.

² Its use may amount to a criminal offence; sec. 89 of the Patents and Designs Act, 1907, replacing similar provisions of sec. 105 of the Act of 1883, below, p. 650; and Merchandise Marks Act, 1887, s. 3 (1) (e), Appendix, p. 886.

³ The authorities cannot easily be reconciled under one rule: per Kekewich, J., *Hubbuck v. Brown* (1899), W. N. 251; 17 R. P. C. p. 156.

⁴ See per Wood, V.-C., in *Edclsten v. Vick*, 11 Hare, 78 (1853); *Morgan v. McAdam*, 36 L. J. Ch. 228 (1866) (*Patent Plumbago Crucibles*); and *Gridley v. Swinborne*, 5 Times L. R. 71; 52 J. P. 791 (1883), Coleridge, L.C.J., and Grantham, J. (*Swinborne's Patent Refined Isinglass*). "The illustrious race whose drops and pills, have patent powers to vanquish human ills"—Crabbe, quoted in Ogilvie's Dictionary.

⁵ 11 H. L. C. 528; 35 L. J. Ch. p. 64 (1865).

⁶ 10 Hare, 467; 22 L. J. Ch. 866 (1853).

case of *Edelsten v. Vick*,¹ he seems to doubt whether the rule would be the same if there had originally been a patent, and the statement in the trade mark being true when first introduced, had been continued after it had ceased to be true. I confess that I should have had great difficulty in assenting to that distinction. If the word 'patent' be not so used as to indicate the existing protection of a patent, but merely as part of the designation of an article known in the market by that term (and this I collect to have been the main ground of his Honour's decision), then I quite agree with his view. In such case nobody is meant to be deceived, or is deceived. A patent may have expired fifty years ago, and yet the name of patent may have become attached to the article, and be used in the trade as designating it. But if the trade mark represents the article as protected by patent, when in fact it is not so protected, I cannot think that it can make any difference whether the protection has never existed or has ceased to exist."

And in a later case, Jessel, M.R., said: "No doubt a man may use the word 'patent' so as to deceive no one. It may be so used as to mean that which was a patent but is not so now. In other words, you may state in so many words, or by implication, that the article is manufactured in accordance with a patent that has expired. But if you suggest that it is protected by an existing patent, you cannot obtain the protection of that representation as a trade mark. Protection only extends to the time allowed by statute for the patent, and if the Court were afterwards to protect the use of the word as a trade mark, it would, in fact, be extending the time for protection given by the statute. It is, therefore, impossible to allow a man who has once had the protection of a patent to obtain a further protection by using the name of his patent as a trade mark. But further, no man can claim a trade mark in a falsehood. It is a falsehood to represent that the patent is still existing."²

Expired
patent.

In *The Club Soda* case the plaintiff's mark consisted of a label bearing the words "Club Soda," and also "Manufactured in Ireland by H.M. Royal Letters Patent." This was explained to mean "manufactured by the aid of patented machinery." The offending words were also used in advertisements, but the goods

¹ 11 Hare, 78 (1853).

of Neville, J., in *Boake Roberts & Co., Ltd. v. Wayland*, 26 R. P. C. at p. 257 (1909).

² *Cheavin v. Walker*, 5 O. D. p. 862 (1877), O. A. See also the observations

were never called "patent club soda water." The Privy Council held that, having regard to the nature of the goods, no one could be deceived, and they gave judgment for the plaintiff.¹

Where
"patent" is
not deceptive.

From the principles stated in these judgments, and from the decided cases, it follows that the use of the word "patent" in a trade mark for unpatented goods is not to be taken to be misleading where either it is shown that the market name of the goods comprises the word,² or where the goods are made according to an expired patent, and the word is so used as to be understood to refer to this,³ or wherein from the nature of the cases it is unlikely to mislead.⁴

The following is a summary of the reported cases on the subject⁵ :—

Summary of
cases where
"patent"
used.
Action
barred.

First, where the plaintiff's action was barred: FLAVEL'S PATENT KITCHENER, no patent, *Flavel v. Harrison*, 10 Hare, 467; 22 L. J. Ch. 866; PATENTED JAN. 24, '56, patent void, *Leather Cloth Co., Ltd. v. American Leather Cloth Co., Ltd.*, p. 475; *Leather Cloth Co., Ltd. v. Lorsont*, L. R. 9 Eq. 345; PATENT PLUMBAGO CRUCIBLES, no patent, *Morgan v. McAdam*, p. 476, note 4; ROYAL LETTERS PATENT, no patent, but duty paid in respect of a patent medicine, *Lamplough v. Balmer*, W. N. (1867), 293;⁶ MANUFACTURER AND PATENTEE, no patent, *Nixey v. Roffey*, W. N. (1870), 227; G. CHEAVIN'S IMPROVED PATENT GOLD MEDAL SELF-CLEANING RAPID WATER FILTER, expired patent, *Cheavin v. Walker*, p. 477. In *Hubbuck v. Brown*, 17 R. P. C. 638, where the mark included the words HUBBUCK'S PATENT LONDON in circular form with the words WHITE ZINC within the circle, the mark being an old one registered for paints, it was shown that the plaintiffs had never

¹ *Cochrane v. Macnish*, [1896] A. C. 225; 13 R. P. C. 100.

² *Marshall v. Ross*, L. R. 8 Eq. 651 (*Patent Thread*); cf. *Leather Cloth Co. v. Lorsont*, L. R. 9 Eq. 345, both (1869), James, V.-C.

³ *Ransome v. Graham*, 51 L. J. Ch. 897 (1882), Bacon, V.-C. In *Morgan v. McAdam*, 86 L. J. Ch. 228 (1866), Wood, V.-C., suggested that in these cases the date of the patent should be given. Cf. sec. 83 of the Patents and Designs Act, 1907, as to marking being notice to infringers.

⁴ See note (1).

⁵ The pages given refer to this book. See also *Adams' Tm.*, 9 R. P. C. 174; 66 L. T. N. S. 610 (1892), where Kekewich, J., refused to allow "patent" to be struck out of an old mark for furniture polish.

⁶ "Patent medicines" are excepted from the prohibition upon the sale of poisons in the Pharmacy Act, 1868. The exception relates to medicines manufactured under letters patent only: *Pharmaceutical Society v. Piper*, [1898] 1 Q. B. 686; *Same v. Armson*, [1894] 2 Q. B. 720.

had any patent for White Zinc Paint, and that although they had had a patent, long since expired, relating to the manufacture of oxide of zinc, they had ceased to confine their mark to paint made with oxide of zinc manufactured under the patent. Rigby, L.J., said that, if necessary, he should have held that the plaintiffs were disentitled to sue.¹

Secondly, where the plaintiff's action was not barred; SYKES' PATENT, patent invalid, no plea having reference to the misrepresentation, *Sykes v. Sykes*, 3 B. & C. 541;² TAYLOR'S PATENT SOLID-HEADED PINS, expired patent, labels printed from the old blocks in use while the patent existed, *Edelsten v. Vick*, 11 Hare, 78; PATENT THREAD, no patent, evidence that patent was understood in the market to denote the character of the goods, *Marshall v. Ross*, L. R. 8 Eq. 651; CLUB SODA, MANUFACTURED IN IRELAND BY H.M. ROYAL LETTERS PATENT, *Cochrane v. Macnish*, above, p. 477. The case of *Ransome v. Graham*, 51 L. J. Ch. 897, must probably be explained as one of collateral misrepresentation, if it can be supported at all. There the trade mark consisted of letters and numbers stamped upon the working parts of the plaintiff's ploughs, and "patent" was stamped also, although the only patent which had ever existed related to the ploughshares merely, and had expired in 1817. The plaintiff's advertisements and catalogues stated that the patent had expired, but this could hardly be an answer to the objection, as the notice would not, or might not, reach all the persons who saw the stamp. In *Perry v. Hessin*, 29 R. P. C. 101, where the defendants raised a defence founded on improper use of the word "Patent" on pens and in circulars relating to them, Eve, J., in dismissing the action on other grounds, said that that defence would not have succeeded, as the use did not amount to more than a collateral misrepresentation.³ And, where on an application

Action not barred.

¹ See also *The Triticumina* case, *Meaby & Co. v. Triticine*, 15 R. P. C. 1 (1898), where North, J., held that that word was the name of a patented article (above, p. 48), and expressed the opinion, without deciding the point, that as the plaintiffs had represented the article as patented, they would be in no better position if the representation were untrue. And see the copyright case, *Slingsby v. Bradford Patent Truck and Trolley Co.*, [1906] W. N. 50, in which it appeared that many of

the articles described in the plaintiffs' catalogue as "patent" had not been patented in England, and the action was dismissed on the ground that by reason of this and other misrepresentations the catalogue was not entitled to the protection of the Court.

² See *Hubbuck v. Brown*, cited above, p. 478.

³ At pages 127 and 128; on an appeal by the plaintiffs, which failed, the point was not dealt with (29 R. P. C. 509).

to register the words LAWSON Tait for bedsteads, there had been some slight user of the words "Patent Lawson Tait" and of the word "Patent" in other ways, but the applicants had not claimed or in fact enjoyed a monopoly of selling the bedsteads, they obtained an order under section 9 (5) of the Trade Marks Act, 1905.¹

"Patent,"
&c., not to be
registered.

The Registrar may refuse to accept any application upon which any of the following appear, namely, "Patent," "Patented," "By Royal Letters Patent," or words to like effect.²

"Trade
mark."

It is a misrepresentation which disentitles a label or other trade mark to protection or to registration, to include in it anything which is calculated to mislead the public as to what is the mark of which the proprietor claims the exclusive use. The matter was first brought forward in *The Apollinaris* case,³ where some of the labels in question had the word *trade mark* printed immediately under the red triangle or disc, which was their most prominent feature, although other parts of the labels, and, in particular, the words *Apollinaris* and *Friedrichshall*, were claimed as essential features of the trade marks. The application before the Court was to remove the marks from the Register on several grounds; and Fry, L.J., who delivered the judgment of the Court of Appeal, dealt with the present objection in the following passage⁴:—

The Apolli-
naris case.

"One (objection) was, that the mark was calculated to mislead, inasmuch as the whole label is registered as a trade mark, and yet contains the assertion that the red disc, which is the most conspicuous part of the whole label, is 'trade mark'—not saying 'a trade mark,' not saying part of 'the trade mark'—but an assertion pointing to the conclusion that it, and it alone, is 'the trade mark,' and therefore that the label, as a whole, is not the trade mark. Such would have been the impression produced (I am speaking for myself) on my own mind, had I approached the reading of the label unbiassed by what I have learned while sitting in this seat, and such, we think, is the true result of this case. An owner of a registered trade mark may put it on a

¹ *Application of Whitfield's Bedsteads, Ltd.*, [1909] 2 Ch. 378; 26 R. P. C. 657.

² Rule 11, p. 721.

³ [1891] 2 Ch. 186; 8 R. P. C. 137, C. A. In *Bass, Ratcliffe and Gretton, Ltd.'s Tms.*, [1902] 2 Ch. 579; 19 R. P. C.

129, 529, C. A., cited p. 482, Romer, L.J., said that he should not have come to the same conclusion on the facts as the Court of Appeal did in the *Apollinaris* case.

⁴ [1891] 2 Ch. p. 283.

registered label, but not so as to mislead a reader of that label, and induce him to believe the only thing registered is the distinctive mark." It is true, the learned Lord Justice added, that the objection might, apparently, have been taken in *Hudson's* case, where the mark there in question was upheld by the Court of Appeal,¹ but it was, in fact, neither discussed in argument nor considered by the Court.

The judgment caused a number of applications, under sec. 92 of the Act of 1883,² for leave to remove "trade mark" from registered marks, to be made to the Court. The results of these are stated in Chapter X.³

It is to be observed that Fry, L.J., does not say that the use of the words "trade mark" within a label is necessarily misleading; it may be, but it is a question of fact whether it is or not.

In *Hammond v. Brunker*,⁴ the registered label of the plaintiffs comprised a number of devices, and among them a small blank shield in the middle of the upper half. In use, the plaintiffs printed within the blank shield a hand and forearm holding a dart, and having the words "trade mark" beneath it. Chitty, J., in rejecting an objection founded upon this, said:⁵ "It is a question of fact in every case where a man puts the term 'trade mark' on his device, or some part of it, whether he does or does not so place the words as to indicate to the public that he is claiming a particular part of the trade mark only. In *The Apollinaris* case, the Lord Justice's observations were addressed to a label which had been registered, and had the term *Friedrichshall* above a disc, with a quantity of printed matter; the disc was coloured red, and underneath the disc were the words 'trade mark.' Without expressing a final opinion on the matter,⁶ the Lord Justice thought that there were grounds for saying, on that label, that the trade mark referred to the disc, and if I may say so myself, with great respect, it seems to me that there were grounds. But, as I say, this is a question of fact, and I am satisfied that these words 'trade mark' in the middle of this label do not indicate to the public that the shield only is the

*Hammond v.
Brunker.*

¹ 32 C. D. 311; 3 R. P. C. 155 (1886).

² Corresponding to sec. 34 of the Act of 1907.

³ Page 304.

⁴ 9 R. P. C. 301 (1892). Chitty, J., came to a similar conclusion of fact in *Benedictus v. Sullivan*, 12 R. P. C. 25

(1894), cited below, p. 484, where the registered trade mark was the words "La Flor de Margareta," see at p. 32.

⁵ 9 R. P. C. 307.

⁶ This is hardly borne out by the report of the judgment of Fry, L.J.

trade mark. In *The Apollinaris* case there was no other device except the disc, which was coloured red, in use.¹ That being so, I think that these two grounds of objection to the plaintiff's suing, namely, the addition of the arrow and the forearm, and the addition of the words 'trade mark,' do not disentitle the plaintiff to ask for an injunction with regard to his trade mark."

In a later case,² Wright, J., held the objection to be fatal to one of the respondent's marks, a label, and ordered it to be removed from the Register. There the main portion of the label was occupied by a picture of the head of a negro, inclosed by a circular band containing the words *W. D. & H. O. Wills, Bristol*. Underneath this picture was printed in very large letters the word *Star*. At the side of the label, on the right, was a representation of an eight-pointed star; and in immediate proximity to the star the words "trade mark" occurred.

Bass' case.

A similar question came again before the Court of Appeal in *Bass' Tms.*,³ in which, Kekewich, J., had ordered the removal from the Register of a label, having in its centre a diamond (in black as registered) with the words "trade mark" on it; one of the grounds of removal was that the words were deceptive, as leading to the inference that the rest of the label was unregistered. A diamond coloured red on the Register was in fact separately registered and owned by the respondents. They successfully appealed, the Court of Appeal holding that no one could be misled or injured by the words as they appeared on the label. Romer, L.J., delivering the principal judgment, said that it could not be laid down as a general rule that, whenever the word "trade mark" appeared on a label, it must be intended to denote only that particular part of the label on which it was placed; and he continued as follows: "In the present case the word 'trade mark' is placed in the centre of the label upon the diamond, and I do not know why I should be bound to assume that the word is intended to apply only to the diamond. But it may so apply, and I will assume that it does. What then? In every case in which the word 'trade mark' is placed upon a particular portion of a label to denote that that portion is a trade mark, is

¹ But there were the important words *Apollinaris* and *Friedrichshall*.

² *Dexter's Tm. and Wills' Tm.*, [1898] 2 Ch. 262; 10 R. P. C. 269. See also *Day v. Riley and Whittaker*, 17 R. P. C.

517 (1900), Buckley, J., as to the mark No. 70,347.

³ [1902] 2 Ch. 579; 19 R. P. C. 129, 529.

the Court bound of necessity to hold that the label is calculated to deceive? In my opinion it is not. It may, no doubt, in some circumstances be calculated to deceive. If, for example, the part of the label to which alone the word is intended to refer is not in fact the subject of a separate trade mark, I think the label would be calculated to deceive, because it would lead an ordinary person reading it to suppose that the owner of the label as a whole had a specially greater right as against the public than he really had. But if there were a separate trade mark for that part of the label which is designated by the word 'trade mark,' why should it be assumed in every case that the word is calculated to deceive? As I have pointed out in the course of the argument, it is not sufficient to say that the label is 'calculated to deceive.' It must be shown that it is reasonably calculated to injure some one—to lead him to do or to abstain from doing some act the doing or the abstaining from doing which may possibly injure him. Now, there may be a perfectly innocent deception, which would injure no one. If there were such an innocent deception, it ought not to be a ground for removing a trade mark from the Register. The truth is the Court ought in each case to see in the first place whether, assuming that the word 'trade mark' refers to a particular portion only of the label, there would be a natural inference that the rest of the label, or the label as a whole, was not a trade mark. Speaking for myself, I refuse to take it as a natural or necessary inference in every case, from the fact that a particular portion of a label is designated as a 'trade mark,' that the whole of the label is not a trade mark. In my opinion such a conclusion ought not to be drawn in every case. You ought to go further, and to ask in each case, can it be supposed from the particular facts of the case that there is any substantial probability of injury."

A combination trade mark and a part of it can be each registered, but, if registered under the Act of 1905, they must be registered as associated trade marks.¹

It is a penal offence to describe a trade mark as registered when it is not.² Such a misrepresentation is, it seems, sufficient to deprive the proprietor of the mark of his right to protection against infringers, or against persons who pass off

False assertion of registration.

¹ Sec. 25, above, p. 117.

² Sec. 67, below, p. 649, replacing as to trade marks sec. 105 of the Act of

1888, below, p. 708, Merchandise Marks Act, s. 3 (1) (e); see Appendix, p. 888.

their goods as his under cover of the mark.¹ In *The Melachrino* case,² however, Chitty, J., held that the use of the word "registered" with a mark in which blanks appearing on the registered form were filled up by coats of arms in use, was not a bar to the plaintiff's case; and it has been held by the Court of Appeal that the use of the words "special registered trade mark," before registration had been obtained, was not a sufficient objection to prevent the Court granting an interlocutory injunction.³ And the Court of Appeal has allowed a mark to be registered which had been used with the words "registered shape." In this case both the mark (a dome-topped cylinder) and the words had been impressed on the blocks of blacklead, which were the goods in question, although the registration of the shape as a design had expired in 1864; but the case was not argued on behalf of the respondents.⁴

In *Benedictus v. Sullivan*,⁵ the plaintiff had printed at the bottom of one of the labels used upon his cigar boxes "Regd. by H. B. 6458." The label comprised a number of devices and also the words *La Flor de Margareta*. The words alone had been registered in the trade mark registry, and they were so registered under Number 6458. It was, however, held upon a consideration of the whole box and its other labels that there was no representation that anything besides the words of the label was registered.

The description of an unregistered trade mark as a "trade mark" is no offence within sec. 67, and if the mark is, in fact, as it may be, a trade mark acquired by user, such description is not by itself a misrepresentation.⁶ But a person is to be deemed

"Trade
Mark."

¹ In *Sen Sen Co. v. Britten*, [1899] 1 Ch. 692; 16 R. P. C. 137, Stirling, J., said, "Of course, if the plaintiffs are brought within the terms of that section they must be denied relief."

² 4 R. P. C. 215 (1887).

³ *Read v. Richardson*, 45 L. T. 54 (1881), C. A. In *Lewis v. Goodbody*, 67 L. T. 194 (1892), Kekewich, J., refused an interlocutory injunction in a passing-off case, because the plaintiffs had represented that their mark was a registered trade mark. See note (6).

⁴ *James' Tm.*, 33 C. D. 392; 3 R. P. C. 340 (1886). And see p. 485, note (4).

⁵ 12 R. P. C. 25 (1895), Chitty, J. The label is printed in the report. The label was, in fact, registered at

Stationers' Hall, but not under No. 6458.

⁶ *Sen Sen Co. v. Britten*, note (1). The mark there was registered in the United States. An interlocutory injunction was granted. Stirling, J., held that the use of the words "trade mark" was not a pretence of registration. Kekewich, J., who was reported in *Lewis v. Goodbody*, note (3), as having decided the contrary, has adopted this ruling: *Hubbuck v. Brown*, 17 R. P. C. 148; (1899), W. N. 250. See also *Kenrick and Jefferson's Application*, 26 R. P. C. 641, where Neville, J., held that a trade mark might exist apart from registration.

for the purposes of sec. 67 to represent that a trade mark is registered, if he uses in connection with the trade mark the word "registered" or any words expressing or implying that registration has been obtained for the trade mark.¹ The use of the words "Trade Mark—Registered," or "Registered," is a representation of registration in this country, and, in the absence of words qualifying that meaning, the use of either expression referring to an unregistered mark is an offence under the section.²

It was further suggested in *The Apollinaris* case, and the Court of Appeal were inclined to hold, that the statement upon one of the labels used for natural mineral waters, and claimed as a trade mark, "imitations of this water will be prosecuted," meant all imitations, whether fraudulent or not, of the water, and was addressed, therefore, to artificial waters which might lawfully be made and sold as imitations of the natural water, and that, if it bore this meaning, it was calculated to deceive.³

The Registrar may refuse to accept any application upon which any of the following appear, namely the words "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To counterfeit this is forgery," or words to like effect, and accordingly such words should not appear upon the representations of trade marks forming part of an application.⁴

The operation of a deceptive misstatement as to the origin of the goods in destroying the distinctive character of the mark, has been referred to in an earlier chapter.⁵ In *The Eton Cigarette* case,⁶ it was held that an English tobacconist, who put a Russian name, as that of the maker, upon his goods

Other misleading statements

¹ Sub-sec. 2.

² *Wright, Crossley & Co. v. Dobbin*, 15 R. P. C. 21 (Q. B. D. Ireland); *MacSymons Stores, Ltd. v. Shuttleworth*, 15 R. P. C. 748 (Day and Channell, JJ.), both 1898, and decided therefore under the Act of 1883. See also *Winser & Co., Ltd. v. Armstrong*, 16 R. P. C. 167, as to use of "registered" after expiration of protection of design.

³ [1891] 2 Ch. p. 226. As to the refusal of costs to a defendant on the ground of his misrepresentations, see below, p. 511.

⁴ Rule 11, Appendix, p. 721. Cf. *Altman's Application*, 21 R. P. C. 753

(1904), *Kekewich, J., and Lyle and Kinahan's Application*, 24 R. P. C. 87 and 249 (1907), *Kekewich, J., and C. A.*, where representations before registration as to the marks being registered made by *bonâ fide* mistake or slip were not held sufficient ground for refusing registration.

⁵ Chap. VIII., p. 224.

⁶ *Wood v. Lambert*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A.; *Wolff v. Nopitsch*, 17 R. P. C. 321 (1900), *Cozens-Hardy, J., (Spanish Graphite)*; on appeal this point was not specially dealt with, 18 R. P. C. 27.

could not protect the mark which they also bore as his trade mark against infringements.

Fraudulent trade.

(ii.) Where the plaintiff uses the trade mark in aid of a fraudulent trade, the rule which bars his action is so clear that it will be sufficient to summarise the few cases reported on the subject.

Summary of cases.

A plea that the plaintiff made a practice of selling by short weight failed because it was not supported by the evidence, *The Guinea Coal* case, *Lee v. Haley*, L. R. 5 Ch. 155. A Pianoforte Tutor, described as "600th edition, specially revised by Hemy," although the musician referred to had not revised the work for ten years, was held not to be misleading, evidence being given that in the trade an issue of 250 was called an edition, *Metzler v. Wood*, 8 C. D. 606. A trade in German cigars sold in boxes bearing a label with the words LA PUREZA (an old Havana brand), HABANA, RAMON, ROMEDO, and additional labels with other words and a sham address in Spanish was held to be fraudulent, the whole get-up being described by Bowen, L.J., as "an elaborate concatenation of pictorial lies" intended to pass off the cigars as made in Havana, although evidence was given that the name *Havana* in the cigar trade indicates the shape of the cigars only, *Newman v. Pinto*, 4 R. P. C. 508; 57 L. T. 31;¹ but the sale of English cigars under a label bearing the word HABANA, in boxes marked BRITISH MANUFACTURE, was held not to be fraudulent in the absence of evidence that the plaintiffs represented that their cigars were made in Havana, *Hargreaves v. Freeman*, [1891] 3 Ch. 39; 8 R. P. C. 237.² The application of the name CALIFORNIAN SYRUP OF FIGS to an aperient drug in which fig syrup was used as a flavouring only was held not to be a misrepresentation: *Californian Fig Syrup Co. v. Taylor's Drug Co.*³ In *Bile Bean Manufacturing Co. v. Davidson*, 22 R. P. C. 553; 23 R. P. C. 725 (1905), a case of alleged passing-off by means of the words "Bile Beans," the plaintiffs' advertisement falsely stated that the basis of their Bile Beans was an Australian herb discovered

Havana cigars.

The Bile Bean case.

¹ Cf. *Fuente's Tms.*, [1891] 2 Ch. 156; 8 R. P. C. 214; and *Dexter's Application*, [1893] 2 Ch. 262; 10 R. P. C. 269.

² Cf. *Benedictus v. Sullivan*, above, p. 484, where a Spanish look about the box, and the words "Fabrica de Tabacos de la Vuelta Abago," was held not to be a representation of foreign manufacture in the face of the words "Re-

galia Britannica," "Londini"; and see *Robinson and Barnsdale, Ltd.'s* case, Times, April 2nd, 1901; and *R. v. Butcher*, 99 L. T. 622; 24 T. L. R. 797 (1909); and *Van der Leeuw's Application*, [1912] 1 Ch. 40; 28 R. P. C. 708.

³ 14 R. P. C. 341 (1897), Kekewich, J., reversed on appeal on another point; 14 R. P. C. 564.

by an eminent scientist, whose name was given. There was no such person, and the story of the discovery given in the advertisements was an invention. These advertisements were not, however, on the pill boxes themselves. It was held by the Lord Ordinary that the plaintiffs' trade was a fraudulent one, and that the plaintiffs were disentitled to protection for it, and the action was dismissed on this as well as on other grounds, and the decision was upheld on appeal, it being held that the misrepresentation was not a collateral one, but affected the very essence of the article offered for sale.

A misrepresentation which has been corrected and abandoned before the action is no bar.¹ The same rule is said to apply to one adopted after the commencement of the action. So Fry, J., stated in *Siegert v. Findlater*,² for, he said, applying the test laid down by Mellish, L.J., in *Ford v. Foster*,³ its adoption could not, before Sir John Rolt's Act, have warranted the Court of Chancery in restraining the action had it been commenced in a common law Court. The learned Judge held, however, that in the case before him there was in fact no fraudulent misrepresentation which ought, in any case, to debar the plaintiffs. It is submitted, with great deference, that on principle it can make no difference, supposing the plaintiff is seeking the aid of the Court for a fraudulent trade, or for a trade conducted by fraudulent means, that the frauds commenced after the action was begun. The objection is not that the plaintiff's case is incomplete, or that the defendant has any answer as of right to oppose to it, but that the plaintiff and his business are, when the Court takes cognizance of the matter, unworthy of its protection or assistance.

It may here be noticed that in a firm name case the defendants set up that the use of the name by the plaintiffs, a limited company, had been in contravention of sec. 41 of the Companies Act, 1862, but Farwell, J., held that this was no defence,⁴ and

Misrepresentation abandoned before, or commencing after action brought.

Alleged offences against Companies Act.

¹ *Benedictus v. Sullivan*, p. 484. See also the American case, *Siegert v. Abbott* (2) (1891), Cox, p. 486.

² 7 O. D. 801 (1878) (*Angostura Bitters*).

³ L. R. 7 Ch. 611, cited p. 478; and *Faulder & Co., Ltd. v. Rushton*, 20 R. P. O. 477, at p. 489 (1903), Hall, V.-C., where the plaintiffs' trade mark had been removed from the Register after the commencement of the action, but the plaintiffs succeeded on passing-

off. It was contended that the use by the plaintiffs of the words "trade mark" was a misrepresentation, and it was held that, if after the judgment removing the mark the continued use of the words was a misrepresentation, it was an honest and natural mistake and not such a mistake as disentitled them to relief. See p. 484, "Trade Mark."

⁴ *Pearks, Gunston and Tee, Ltd. v. Thompson, Talmev & Co.*, 18 R. P. O.

his decision has been followed in a later case.¹ But if a limited company sets up a claim to a trade name which they have used in association with their statutory name, they may find it difficult to establish that the trade name by itself indicates them or their goods; and if they omit all reference to their statutory name they may render themselves liable to penalties under sec. 63 of the Companies (Consolidation) Act, 1908.² A trade mark is not necessarily an advertisement within the meaning of that section.³

6. The Relief granted.

If the plaintiff succeeds in an action for infringement, he may obtain an order for—(i.) an injunction restraining further infringements of his rights; (ii.) the delivery up for destruction, or for the erasure of the marks, of any goods already marked with the spurious mark and in the possession or under the control of the defendant; (iii.) and damages in respect of the past infringement, or, in lieu of damages, an account of the profits made by the defendant by the sale of the spuriously marked goods, or for some one or more of these.

(i.) Injunction.

This was the characteristic remedy by which the Court of Chancery protected trade marks, either after the plaintiff had recovered damages for past infringements at law, or where it had been appealed to in the first instance and no action had been brought. It is generally the most beneficial relief for the plaintiff, because it summarily stops the particular infringement which the defendant has practised, and makes it highly dangerous for him to commence any other, and it is operative against impecunious infringers who might care little for repeated

185 (1901) (*Talmey & Co.*). On appeal the case was settled. Cf. *Ld. Robertson's judgment in Royal Baking Powder Co. v. Wright, Crossley & Co.*, 18 R. P. C. at p. 103.

¹ *H. E. Randall, Ltd. v. British and American Shoe Co.*, [1902] 2 Ch. 354; 19 R. P. C. 393, Swinfen Eady, J.; and see *Application of Albert Baker & Co. (1898), Ltd.*, [1908] 2 Ch. 86; 25 R. P. C. 513, Eve, J., where it was held that the fact that the company had not affixed their name to all their shops was not a ground of opposition to the registration for which they were apply-

ing. See also *Application of Holbrooks, Ltd.*, 26 R. P. C. 791, where the Registrar refused the trade mark partly on the ground of the words "Swann & Co." on it, which he thought would lead the public to think that the applicants were a firm; but Joyce, J., did not agree with this, and ordered the registration to proceed.

² See the judgments of Cozens-Hardy, M.R., and Farwell, L.J., in *H. E. Randall, Ltd. v. Bradley*, 24 R. P. C. 773 (1907).

³ *Application of Albert Baker & Co. (1898), Ltd.*, cited above. note (1).

judgments for damages against them. The Merchandise Marks Act of 1862¹ empowered a court of law, in any action for fraudulent infringement, to grant an injunction to the successful plaintiff; and, since the Judicature Acts, both divisions of the High Court have the same power as that formerly exercised by the Court of Chancery.

The grant of an injunction in trade mark cases is governed by the general rules governing it where other rights are concerned. There must be some threat or probability that the infringement will be commenced, continued, or repeated, or the Court will not interfere;² but if an actual infringement is shown to have occurred that is usually sufficient, and the plaintiff is not bound to wait until it has been frequently repeated, or until warning has been given and been disregarded,³ for "the life of a trade mark depends upon the promptitude with which it is vindicated."⁴ So an injunction has been granted where the defendant had altered the device and discontinued the use of the labels complained of, and offered to undertake not to use any more of them,⁵ although, in some instances, the undertaking of an innocent infringer has been accepted by the Court.⁶ Nor is it necessary that any actual infringement should have occurred if it is proved that the defendant contemplates committing or has threatened to commit one,⁷ and it is sufficient evidence of this that he is in possession of a considerable quantity of spuriously marked goods,⁸ even though it is only as a forwarding agent.⁹

Further infringement must be threatened or be likely to occur.

¹ 25 & 26 Vict. c. 88, s. 21, now repealed; see Chap. I., p. 6.

² See the cases in which isolated instances of infringement or passing-off only have been proved, above, p. 432. Also the patent case, *Hudson v. Chatteris Engineering Co.*, 15 R. P. C. 438 (1898), Stirling, J. An act having a continuing effect, e.g. the issue of a large number of circulars, is not sufficiently met by the offer of an undertaking not to repeat it, without anything to neutralise the effect of what has been done: *Yeatman v. Homberger & Co.*, 29 R. P. C. 561 and 645 (1912), Eve, J., and C. A. The Court will presume that a trader will use his mark so as not to be deceptive, if it is capable of being used without the probability of being deceptive, unless some reason to the contrary is shown:

Kutnow's Tm., 10 R. P. C. 401 (1893), cited p. 302.

³ See *Upmann v. Forester*, 24 C. D. 231 (1883), Chitty, J., see above, p. 424.

⁴ *Johnston v. Orr-Ewing*, 7 App. Ca. 219.

⁵ By Malins, V.-C., in *Guinness v. Heap*, Seb. Dig. p. 377 (1878); cf. *Tonge v. Ward*, 21 L. T. N. S. 480 (1869), Romilly, M.R.

⁶ *Rose v. Loftus*, 47 L. J. Ch. 576 (1878), Malins, V.-C.

⁷ See *The Emperor of Austria v. Day and Kossuth*, 3 De G. F. & J. 217; 30 L. J. Ch. 690 (1861), Campbell, C. and L.JJ.

⁸ See above, note (3).

⁹ *Upmann v. Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. 130 (1871), Romilly, M.R., and Hatherley, C. And in *Caterson & Sons, Ltd. v. Anglo-Foreign*

Proof of fraud
not necessary.

It has already been shown that the fact that the infringement was not fraudulent,¹ or even that it was made in ignorance of the plaintiff's right,² is no defence to the claim for an injunction.

Form of
injunction.³

The injunction is sometimes directed generally to restrain the infringement of the plaintiff's trade marks to which his title is established in the case,³ but it is usually expressed with more particularity, to restrain the use by the defendant of such trade marks, or of marks only colourably differing from them, in connection with goods of the kind for which they are registered, by selling or otherwise disposing of the goods marked with such marks. Sometimes the particular colourable infringement of which the defendant has been proved to have been guilty is expressly referred to in the order, a general restraint being added. And, in some cases, the form of injunction which seems more appropriate to the unspecialised action for "passing-off" is made use of also, the defendants being restrained from "in any other way passing off their goods as those of the plaintiff."⁴ To avoid a discussion upon a motion to commit for an alleged breach of the injunction, it is obviously advantageous for the plaintiff to combine in the order a particular reference to the form of the infringement which has actually been committed or threatened, with general words, as wide as are obtainable, directed to prevent a colourable evasion of the decree.⁵

As it is not an infringement to use the plaintiff's mark upon his own goods, that is, goods which possess the attribute connoted by the mark,⁷ the injunction is commonly expressed so as to prevent this being a breach of its terms.⁸

Manufacturing Co., Ltd., 28 R. P. C. 74 (1911), Joyce, J., an injunction was granted against commission agents, importers of goods made abroad, who alleged that they had acted innocently, they not having met the plaintiffs' complaint in a proper manner.

¹ *Millington v. Fox*, 3 My. & Cr. 338 (1838), Cottenham, C.

² *Moet v. Couston*, 33 Beav. 578 (1864), Romilly, M.R.; *Edelsten v. Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, C.

³ *The Bodega Co., Ltd. v. Riviere*, 6 R. P. C. 243 (1888), Chatterton, V.-C.; *Montgomery v. Thompson*, [1891] A. C. p. 218; 8 R. P. C. 361.

⁴ *Slazenger & Sons v. Feltham & Co.*, 6 R. P. C. 531 (1889), C. A.

⁵ See, for instance, the question

which arose in *Ripley v. Arthur*, 19 R. P. C. 443 (1902), where on a division of opinion between V. Williams and Stirling, L.JJ., the judgment of Farwell, J., dismissing a motion to commit was affirmed.

⁶ See the forms of injunction collected in the Appendix, p. 798, and in Seton, 7th ed., Vol. I., 618. The Court will not in anticipation lay down a course of conduct for the defendant, *Kerfoot v. R. A. Cooper, Ltd.*, 25 R. P. C. 508 (1908), Eve, J., *Sweet Lips Cachous*.

⁷ Chap. II., p. 34. And see *Condy v. Taylor*, 56 L. T. 891 (1887), Kekewich, J.

⁸ Cf. the "passing-off" cases; *Siebert v. Findlater*, 7 C. D. 801; and

And in cases where the infringement has been effected by the employment of a word, to the exclusive use of which the plaintiff has no title, the injunction should, it seems, be directed to restrain the defendant from using the word without clearly distinguishing his goods from those of the plaintiff, not to forbid his using it altogether.¹

In a case where the plaintiffs refrained from taking proceedings on learning that the defendants had received a small quantity of the infringing goods, but waited until they had got a larger consignment, Malins, V.-C., ordered the injunction to be directed to stop the sale of future consignments only.² It is submitted, however, with great deference, that the calculated conduct of the plaintiffs was not a sufficient reason for allowing the goods already received to be sold under the deceptive labels, although it might have been an answer to a claim for damages for past infringements. It has certainly been held that acquiescence, not sufficient to bar the plaintiff's right, may, in some classes of actions, cause the Court to refuse relief by injunction, and to grant the plaintiff damages only,³ but the case last referred to did not involve any continuing fraud or deception.⁴

The injunction may also be limited with reference to the use of the mark in a particular country or market,⁵ for instance, if it

Injunction directed to future consignments of goods only.

Injunction refused because of acquiescence.

Injunction limited to a particular market.

Braham v. Beachim, 7 C. D. 848, both (1878), Fry, J. In *Palestine Wine and Trading Co., Ltd. v. Cohen*, 23 R. P. C. 568 (1906), Warrington, J., the defendants contended that the goods in question were goods sold by the plaintiffs, but it was held that there was a trick to sell as the plaintiffs' brandy something which was not in substance the plaintiffs' brandy, the defendant having diluted the same.

¹ *Seixo v. Provezende*, L. R. 1 Ch. 192 (1865), Wood, V.-C., and Cranworth, L.C.; *Johnston v. Orr-Ewing*, 13 C. D. 434; 7 App. Ca. 219 (1880), Fry, J., O. A. and H. L.; and see *Montgomery v. Thompson*, [1891] A. C. 217; 8 R. P. C. 361; and *Reddaway v. Banham*, [1896] A. C. 199; 13 R. P. C. 218; and also the special proviso to the injunction in *Bewlay v. Hughes*, 15 R. P. C. 290 (1898), North, J.

² *The Anglo-Swiss Condensed Milk Co. v. The Swiss Condensed Milk Co.*, W. N. (1871), 163.

³ *Sayers v. Collyer*, 28 C. D. 103, per Fry, L.J. A case relating to a restrictive covenant in regard to buildings. In a passing-off action a delay of three and a half years was under the circumstances of the case held not to disentitle the plaintiffs to an injunction: *Reddaway v. Stevenson*, 20 R. P. C. 276 (1903). Cf. *McCaw, Stevenson and Orr, Ltd. v. Lee*, 23 R. P. C. 1 (1906), Swinfen Eady, J. And below, p. 503.

⁴ The action for infringement may wholly fail, because the defendant has used the plaintiff's mark so long that there is no longer any deception, as in *The Marquis of Londonderry v. Russel*, 2 Times L. R. 843; 3 Times L. R. 360 (1886), Bacon, V.-C. and C. A. Above, p. 471.

⁵ *Carver v. Bowker*, Seb. Dig. p. 350. (1877), Little, V.-C.; *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L.J.; see *Société, &c., de l'Etoile's Tm.*, 10 R. P. C. 436; [1894] 1 Ch. 61, Stirling, J., and above, pp. 258 and 434.

is calculated to deceive there only,¹ or in a particular manner, as by sending goods marked with it to English ports for shipment to the colonies.²

Interlocutory application for an interim injunction.

The plaintiff in an infringement or "passing-off" action usually moves, as soon as the action is commenced, for an interim injunction to restrain the defendant, until the hearing of the action or further order, from continuing or committing the infringement or deceptive conduct of which he complains, either getting leave to serve notice of motion with the writ,³ or serving it after the defendant has appeared. In a plain case the motion is, in the first instance, sometimes made *ex parte* for an injunction until the day for which the notice of motion is given; and in a case where the defendant is committing a deliberate fraud, it is important, if possible, to obtain an *ex parte* order before giving him a notice which may lead to the disposal of any spurious goods which he is about to put on the market.

Balance of convenience.

Where the plaintiff's title is disputed, or the fact of infringement is doubtful, or misrepresentation amounting to a bar to the action, or some other defence is plausibly alleged upon the interlocutory motion, the Court, in granting or refusing the interim injunction, is guided principally by the balance of convenience, that is, by the relative amounts of damage which seem likely to result if the injunction is granted and the plaintiff ultimately fails, or if it is refused and he ultimately succeeds. Thus, in *Read v. Richardson*,⁴ on the defendants undertaking to keep an account, Jessel, M.R., refused an interlocutory injunction; but the Court of Appeal granted it because, while the defendants had only recently commenced to use their mark, and their trade was admittedly not dependent on it, the plaintiffs had a large trade in connection with which they used the label alleged to be infringed, and their rights would have been irremediably and incalculably injured unless the injunction were granted, if their case should be established at the trial. In this action the

¹ See *Wilkinson v. Griffith*, 8 R. P. C. 370 (1891), Romer, J., and above, p. 434. Cf. *Cowie v. Herbert*, 14 R. P. C. 436 (1897), Court of Sess.

² *Rodgers v. Rottgen*, 5 Times L. R. 678 (1889), Kay, J.

³ Ord. 52, r. 9.

⁴ 45 L. T. 54 (1881) (*Dog's Head Beer*). In *Evans v. Smith*, 3 Times L. R. 390 (1887), Kay, J., refused an

interlocutory injunction because it was a serious question whether the plaintiff's registered trade mark *Montserrat* was a "special and distinctive word." But *quære* whether sufficient weight was given to sec. 76 of the Act of 1883 in this case; see *Hommel v. Bauer*, 20 R. P. C. 801 (1903), Byrne, J., and above, p. 430, note (2).

defendants' mark had been registered as well as the plaintiffs', and the defendants asserted that the plaintiffs' action was barred because the plaintiffs had, before registration, printed the words "specially registered trade mark" upon their labels.¹

As appears by the cases just cited, it is not necessary for the plaintiff, upon the interlocutory application, to give conclusive evidence as to his title to the mark. It is sufficient if he makes it appear probable that he will succeed at the hearing, at least in order to bring the question of balance of convenience before the Court, and where there is reason to doubt the good faith of the defendant, the Court is more easily induced to interfere.² If the defendant showed a *prima facie* case of concurrent right, the Court would not interfere by interlocutory injunction.³

The interim injunction will not be granted if the plaintiff has delayed interfering until the defendant has built up a large trade in which he has notoriously used the mark,⁴ or if the plaintiff has delayed for a considerable time after he knew of the matters complained of, unless the delay is explained.⁵ And in a case in which the acts complained of had been going on for five years, and the plaintiffs failed to satisfy the Court that they did not know of them, an interlocutory injunction was refused.⁶ But a

Interim
injunction
refused on
account of
delay.

¹ As to this plea, see above, p. 483. Jessel, M.R., had refused the injunction on the ground of no apparent infringement. See also *Parker and Smith v. Satchwell*, 17 R. P. C. 713 (1900), where the Court of Appeal in a passing-off case granted an interlocutory injunction, which had been refused by Cozens-Hardy, J., on the ground of no probability of deception; a perpetual injunction was granted at the trial, 18 R. P. C. 299 (1901), Farwell, J. In *Alaska Packers' Association v. Crooks*, 16 R. P. C. 503, an interlocutory injunction granted on the balance of convenience by Kekewich, J., was discharged on special (arranged) terms. The plaintiffs failed at the trial, 18 R. P. C. 129 (1901).

² *Radde v. Norman*, L. R. 14 Eq. 348 (1872), Wickens, V.-C.

³ *Hayward Bros., Ltd. v. Peakall*, 26 R. P. C. 1 (1909), Eve, J., where, however, the defendant had not made out such a *prima facie* case.

⁴ Above, pp. 466 and 470.

⁵ *North British Rubber Co. v. Gor-*

mully Co., 12 R. P. C. 17 (1894), Chitty, J., a patent case. In *Army and Navy Co-operative Society, Ltd. v. Army, Navy, and Civil Service Co-operative Society of South Africa, Ltd.*, 19 R. P. C. 574 (1902), Buckley, J., a trade name case, a delay of three months after the plaintiffs became aware of the incorporation of the defendant company was held to be sufficiently explained. And in *Hayward Bros., Ltd. v. Peakall*, note (3), a delay of about five months was held to have been explained.

⁶ *Yost Typewriter Co., Ltd. v. Typewriter Exchange Co.*, 19 R. P. C. 422 (1902), Buckley, J. In *Van Oppen & Co., Ltd. v. L. Van Oppen*, 20 R. P. C. 617 (1903), Swinfen Eady, J., the plaintiffs failed to get an interlocutory injunction as to part of the relief claimed, there having been a protest on their part some two years before, without result. See also *Royal Warrant Holders' Association v. Slade & Co., Ltd.*, 25 R. P. C. 245 (1908), Swinfen Eady, J.

slight use of the defendant's mark, chiefly upon sales to a few purchasers for their private use, will not prevent the Court from interfering in a case where the plaintiff's trade is considerable.¹

If the plaintiff intends to ask for an interim injunction he ought to apply for it as soon as possible after commencing proceedings.²

Application
adjourned to
the trial.

And if no actual infringement is in progress, and no harm is likely to be done, and the motion is seriously contested, it is usually referred to the trial.

Interim
injunction
limited as
closely as
possible;

The interim injunction, being intended only to preserve the plaintiff's rights from serious detriment until the hearing, is, at any rate in cases which appear to be doubtful or honestly disputed, limited as closely as possible to what is sufficient to attain that end.³ It is only granted upon the plaintiff undertaking to be responsible in damages for the loss (if any) occasioned by it to the defendant, should it turn out at the hearing that it ought not to have been granted.⁴

only granted
on under-
taking as to
damages.

A common form of interlocutory injunction is to restrain a wharfinger or consignee from passing into the market goods alleged to bear spurious marks until the trial or further order.⁵

Cross motions
for injunction
and to
expunge.

A large proportion of the seriously contested trade mark cases commence with cross motions for an interim injunction, and to expunge or vary the plaintiff's registered mark. The question in what cases it is open to a defendant, without such a motion to

¹ *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478; 4 T. L. R. 9 (1887), Chitty, J., and C. A. *Apollinis*, used in Germany from 1876, and in England from 1881. *Derby Photographic Dry Plate Co., Ltd. v. Pollard*, 2 Times L. R. 276 (1886), Bacon, V.-C.; *Isaacson v. Thompson*, 41 L. J. Ch. 101 (1871), Bacon, V.-C.

² *Knowles v. Bennett*, 12 R. P. C. 137 (1894), Robinson, V.-C., a design case.

³ See *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478; 4 T. L. R. 9 (1887), Chitty, J., and C. A.; and *Alaska Packers' Association v. Crooks*, above, p. 493, note (1).

⁴ Whenever an undertaking to the Court is given in lieu of an interlocutory injunction there is inserted in the order a cross-undertaking in damages by the applicant unless the contrary is agreed and expressed at the time, Resolution of Chancery Judges (1904), W. N. pp. 203, 208, and see *Oberrheinische*

Metallwerke v. Cocks (1906), W. N. 127. The Court of Appeal had previously held that there was no general practice under which such a cross-undertaking was implied, *Howard v. Press Printers, Ltd.* (1904), W. N. 198. As to the calculation of the damages covered by the undertaking, see *Mansell v. The British Linen Co. Bank*, [1892] 3 Ch. 159. Under special circumstances the defendant may be left to move specially to enforce the undertaking: *J. & J. Cash, Ltd. v. Cash*, 18 R. P. C. 213 (1901), Kekewich, J., where the final order was narrower than the interlocutory order, the terms of the perpetual injunction being modified on appeal, 19 R. P. C. 181 (1902).

⁵ *Rivero v. Norris* (1868), Seb. Dig. p. 178; Seton, 6th ed., p. 625, Giffard, V.-C.; *Del Valle v. Mayer* (1870), Seb. Dig. p. 195; Seton, *ibid.*, James, V.-C.

expunge or vary, to dispute the validity of the plaintiff's registration has been discussed elsewhere,¹ but it would seem that on an application for an interlocutory injunction, the validity cannot as a rule be so disputed.²

In a case where the defendant claimed a right to the mark in question, and had applied to register it himself, an interlocutory motion for an injunction by the plaintiff was ordered to stand over pending the result of the application.³

And sometimes, where there is a substantial case to be tried, the application for an interim injunction is ordered to stand over to the hearing upon the defendant undertaking to keep an account of his sales under the mark objected to.⁴

Breaches of the injunction are contempts of Court, which may be punished by the committal or attachment⁵ of the guilty person, or by ordering him to pay a fine or costs. "Committal was the proper remedy for doing a prohibited act, and attachment the proper remedy for neglecting to do some act ordered to be done," but, though they are distinct remedies, there is now no substantial difference between the two,⁶ except in procedure.⁷ The course usually adopted is to move to commit, the notice of motion being personally served upon the respondent, or if this is impracticable, leave for substituted service being obtained.⁸

The order granting the injunction should be forthwith drawn up and served upon the defendant, but no formal service or notice of it is necessary to enable the Court to enforce it. It is sufficient to subject him to the risk of committal, if he infringes it, that the defendant or other respondent is shown to have been in fact aware of the order for the injunction having been granted or made,⁹ although, as a general rule, a person intending to ask the

Undertaking
to keep an
account.

Enforcement
of the injunc-
tion.

¹ Above, pp. 363 and 431. *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478; 4 T. L. R. 9 (1887), Chitty, J., and C. A.; *Read v. Richardson*, 45 L. T. 54, cited p. 492.

² *Hommel v. Bauer*, 20 R. P. C. 801 (1903), Byrne, J., but see *Evans v. Smith*, 8 T. L. R. 390 (1887), Kay, J.

³ *Edwards v. Elkan*, 5 R. P. C. 70 (1887), Stirling, J.

⁴ *Mitchell v. Henry*, 15 C. D. 181 (1880), C. A.; *Apollinaris Co. v. Snook*, 7 R. P. C. 474 (1890), North, J.

⁵ Ord. 42, r. 7, or in the case of a corporation, by sequestration of its property or attachment of its officers. Ord. 42, r. 31.

⁶ *Callow v. Young*, 56 L. T. 147; *Harvey v. Harvey*, 26 C. D. p. 654; *Evans v. Noton*, [1893] 1 Ch. 252. The proper remedy for the breach of an undertaking is committal: *D. v. A. & Co.* (1900), W. N. 30.

⁷ For instance, Order LII., r. 4, does not apply to a motion to commit, *Taylor, Plinston Bros. & Co. v. Plinston*, [1911] 2 Ch. 605.

⁸ See the notes to Ord. 44, r. 1, in the Annual Practice.

⁹ *Marcovitch v. Bramble, Wilkins & Co.*, Seb. Dig. p. 363 (1878), Malins, V.-C. Annual Practice note to Ord. 42, r. 7; and see *United Telephone Co. v. Dale*, 25 C. D. 778.

Court to enforce an order by committal or attachment should proceed strictly.¹

Where an injunction is granted in general terms, and the defendant is not doing the specific thing on which the judgment was founded, or the injunction having been obtained on default, no specific thing has been admitted or found to be an infringement, the plaintiff may, when moving to commit, be in some difficulty, for in a case in which a mere comparison of the two marks or things does not show that the defendant is committing a breach of the injunction, it is necessary for the plaintiff to prove by evidence that there is probability of deception.²

Unintentional breach of the injunction.

The principal question upon an application to commit for breach of an injunction restraining the infringement of a trade mark is, generally: Does the new mark of the defendant constitute an infringement or not? And it may be assumed that if the Court is satisfied that the defendant has honestly tried to select a mark which is not objectionable, having regard to its order, it will be unwilling to send him to prison because he has failed in his endeavour. But the Court has jurisdiction to commit for disobedience to an order which is not shown to have been wilful.³ If the defendant is in the wrong, even though by mistake or misfortune, he is usually ordered to pay the costs of the motion.⁴ A mere servant of the defendant should not be joined as respondent to a motion to commit.⁴

Choice of a new mark by the defendant.

It may be safely assumed also that in the case suggested above the Court will be careful not to compel an honest trader to alter his mark more than is necessary to protect the plaintiff's rights. But the following passage from Lord Romilly's judgment in *Bass v. Dawber*,⁵ goes, perhaps, too far, for the plaintiff is entitled to have the full extent of his right secured to him, without reference to the loss which it occasions to the defendant. "If a person has *bonâ fide* taken a label or trade mark which does resemble

¹ *Incandescent Gas Light Co. v. Riemer*, 17 R. P. C. 378 (1900), O.

² *Ripley v. Arthur*, 19 R. P. C. 448 (1902), Farwell, J., and C. A., a passing-off case. "An admission by default in pleading never admits anything beyond what is necessary to carry the judgment." Per Vaughan Williams, L.J., at p. 448.

³ *Hewitt v. Mansell*, 29 Sol. J. 66. In *Parker Manufacturing Co. v. Cooper*, 18

R. P. C. 319 (1901), Cozens-Hardy, J., refused to commit the defendant for an isolated instance of passing-off by the defendant's son without the defendant's knowledge; no order was made as to costs.

⁴ *Daniel and Arter v. Whitehouse*, 16 R. P. C. 71 (1889), North, J. See note (3).

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

the label of another person, and this is not done with the intention to deceive, the Court will not require him to change it completely, because the change of a trade mark is a serious thing. . . . It is like beginning a new firm."

In a case where the plaintiff refused to take any notice of a label which the defendant suggested and proposed to adopt in lieu of the label, against the use of which the injunction was granted, Langdale, M.R., himself undertook to determine whether the distinction between the labels was sufficient.¹

If the plaintiff delays taking steps to enforce the injunction for a considerable time after he knows of the fresh infringement, the delay may cause the Court to refuse to commit; but if the infringement is continuing, it has been said that "there must—in order to deprive the party who has obtained the injunction of the right to move for committal upon the breach of it—be a case made out almost amounting to such a licence to the party enjoined, to do the act enjoined against, as would enable him to maintain a bill against others for doing the act. The party enjoined must, I think, show such acquiescence as would be sufficient to create a new right in him."² In the case just quoted, the injunction was granted in 1847, the new infringement began in 1848, and was continued until the motion to commit in 1853. The Lords Justices, however, were not satisfied that the plaintiffs were aware of it. Stuart, V.-C., refused the motion on the ground of the delay, but the Lords Justices directed that the defendant should be committed unless, within a week, he suggested, and undertook to use for the future, a mark which the Court should consider satisfactory, and they ordered that he should pay the costs of the motion.

Delay in application to commit.

In *Cartier v. May*,³ where the plaintiff delayed moving for fifteen months after the defendant had commenced a new infringement not expressly covered by the injunction, Wood, V.-C., refused to commit the defendant, but ordered him to pay the costs of the application, and enlarged the injunction so as to make it extend to the new fraud.

¹ *Croft v. Day*, 23 Leg. Obs. 378; Seb. Dig. p. 39 (1844), on a motion to commit. The French Courts, apparently, will order affirmatively what the defendant is to do: see *Grezier v. Autran*, 13 R. P. C. at p. 10; see also

Rodgers v. Nowill, note (2); and p. 490, note (6).

² Per Turner, L.J., in *Rodgers v. Nowill*, 3 De G. M. & G. 614; 22 L. J. Ch. 404 (1853).

³ Seb. Dig. p. 111 (1861).

(ii.) Delivery up of the marked articles.

Erasure of
the spurious
marks.

The Court not only forbids further infringement by its injunction, but, where the defendant is proved to have spuriously marked articles in his possession or under his control, it also orders the erasure of the marks,¹ or the delivery up of the marked articles for that purpose, or, if erasure is impracticable, for destruction.² Thus, in *Slazenger v. Feltham*,³ where the word *Demotic*, an infringement of the plaintiffs' mark *Demon*, was stamped upon the defendant's tennis racquets, the order of Kekewich, J., for the destruction of the racquets, was varied by the Court of Appeal, upon it being pointed out that the spurious mark could be planed off; and it was ordered that the defendants should make an affidavit verifying the number of the racquets, and that they should either deliver up the racquets to the plaintiffs, to be destroyed, or satisfactorily erase from them the name *Demotic*, in the presence of the plaintiffs or their agent.

Delay.

A plaintiff may lose his right to delivery up if he unduly delays the commencement of his action.⁴

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

The lien of a wharfinger for his charges in regard to goods deposited with him, including the costs he is put to by being made a defendant in a trade mark action, is not destroyed if the goods turn out to be spuriously marked;⁵ and although, in some earlier cases,⁶ the plaintiff was adjudged to have a lien upon the goods, subject to that of any wharfinger or mortgagee who had an earlier charge, and who was innocent in regard to the infringement, the Court of Appeal, in the case last cited,⁵

¹ *Dent v. Turpin*, 2 J. & H. 189; 30 L. J. Ch. 495 (1861), Wood, V.-C.; *Upmann v. Elkan*, L. R. 12 Eq. 140; 7 Ch. 180, Romilly, M.R., and Hatherley, L.C., note (6) below.

² *Farina v. Silverlock*, 4 K. & J. 650 (1858), Wood, V.-C. The repealed Merchandise Marks Act of 1862, s. 21, empowered the Court to direct any chattel to which any trade mark had been fraudulently applied, or which had been exposed for sale with a forged or counterfeited trade mark applied to it, to be destroyed or otherwise disposed of. The Act of 1887 empowers it to forfeit every chattel by means of, or in relation to which, an offence under the Act has been committed, to her Majesty, and it contains a power for the Court to order

the destruction of the forfeited articles; sec. 2 (3), (4); Appendix, p. 887. In *Maréchal and Ruchon v. M'Colgan*, 18 R. P. C. 262 (1901), Chatterton, V.-C., Ireland, the stamp was ordered to be delivered up.

³ 6 R. P. C. 531; 5 T. L. R. 365 (1899), Kekewich, J., and C. A.

⁴ *County Chemical Co., Ltd. v. Frankenburg*, 21 R. P. C. 722 (1904), Ld. Alverstone, L.C.J., five months' delay before complaint, the boxes complained of being capable of being used in ways not a breach of the injunction.

⁵ *Moet v. Pickering*, 6 C. D. 770; 8 C. D. 372 (1877), C. A., reversing Fry, J.

⁶ *Ponsardin v. Peto*, 33 Beav. 642; 33 L. J. Ch. 371 (1863), Romilly, M.R.;

expressed considerable doubt whether such a lien could be supported. Of course, neither the wharfinger nor any other persons interested in the goods would be allowed to sell or dispose of the goods until the spurious marks were removed.

A wharfinger, transport agent, or other bailee who finds that goods committed to his charge are spuriously marked, therefore, is justified in refusing to deliver them up until the objectionable marks have been erased.¹ And, further, he is entitled to an indemnity from the bailor against the damages and costs incurred by him by reason of his dealing with the goods at the latter's request.² His proper course, on being informed by the owner of the trade mark infringed, or his agents, that goods in his possession are spuriously marked, is to give all necessary information to enable them to stop the infringement, to undertake that the goods shall not be removed or dealt with until the spurious marks have been obliterated, and to give the persons injured all requisite facilities for that purpose.³ If he takes this course, the costs of any proceedings subsequently taken against him by the plaintiff will be ordered to be paid to him;⁴ but he must pay the costs of proceedings previously taken, even though the action commenced without notice to him,⁵ unless the value of the infringing goods in his possession is trifling.⁶

The duty of the bailee of infringing goods.

(iii.) Damages or Profits.

It was long ago decided at common law, that the mere proof of an infringement entitles the plaintiff to nominal damages,⁷ and that, consequently, no allegation of special damage is a necessary part of his case.⁸ And the natural consequence of an

Nominal damages.

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

6 C. D. 770 · 8 C. D. 372 (1877), Fry, J., and C. A.

⁵ See last cases, and *Upmann v. Forester*, 24 C. D. 231 (1883), Chitty, J.

⁶ *American Tobacco Co. v. Guest*, [1892] 1 Ch. 630; 9 R. P. C. 218, Stirling, J.

⁷ *Blofeld v. Payne*, 4 B. & Ad. 410; 2 L. J. K. B. (N. S.) 68 (1833). In *Daniel v. Whitehouse*, 15 R. P. C. 134 (1898), Gorell Barnes, J., 40s. damages were given.

⁸ *Rodgers v. Nowill*, 5 C. B. 163; 17 L. J. C. P. 52 (1847). See also *Reddaway v. Bentham Hemp Spinning Co.*, [1892] 2 Q. B. 639; 9 R. P. C. 503.

¹ *Hunt v. Maniere*, 34 Beav. 157; 34 L. J. Ch. 142 (1864), Romilly, M.R., and L.J.J. Action by indorsee of dock warrants against wharfingers restrained.

In *Knowles v. Bennett*, 12 R. P. C. 137 (1894), Robinson, V.-C., shipowners were restrained from parting with the goods except to the plaintiffs.

² *Dixon v. Fawcus*, 3 E. & E. 537; 30 L. J. Q. B. 137 (1861).

³ *Upmann v. Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. 130 (1871), Romilly, M.R., and Hatherley, C.

⁴ Last case, and *Moet v. Pickering*,

Indemnity
to agent or
purchaser.

Onus of show-
ing substan-
tial damage
lies on the
plaintiff.

infringement, even though it be made in complete ignorance of the plaintiff's rights, is that the infringer must pay at least nominal damages,¹ and the costs of action, so that, if he acted under the direction of a third person, he may reasonably compound with the proprietor of the trade mark on these terms, and claim an indemnity from his employer.²

But, if the plaintiff claims substantial damages, the onus of showing what loss he has actually sustained by reason of the defendant's conduct, lies upon him; and it will not be presumed, in the absence of evidence, that the amount of goods sold by the defendant under the infringing trade mark would, but for the defendant's unlawful use of the plaintiff's mark, have been sold by the plaintiff.³ The proper form of an order for an inquiry as to damages occasioned by the infringement of a trade mark is, therefore, what damage (if any) has the plaintiff sustained.⁴

In general, the only injury which is done by an infringement is that the defendant's goods are sold instead of those of the plaintiff, and the sale of the latter is, in some degree, diminished in consequence. But it may, under exceptional circumstances,

¹ See, however, below, pp. 502 and 503.

² *Dixon v. Fawcus*, 3 E. & E. 537; 30 L. J. Q. B. 137 (1861). As to implied warranty by the use of a trade mark, see below, Chap. XVII., p. 615. As to third party notice claiming an indemnity, see *Hennessey v. Dompé*, 19 R. P. C. 333 (1902).

³ *Leather Cloth Co. v. Hirschfeld*, L. R. 1 Eq. 299 (1865), Wood, V.-C.; *Magnolia Metal Co. v. Atlas Metal Co.*, 14 R. P. C. 389 (1896), Collins, J., and C. A. (a passing-off case). If there is a demand which remains unsatisfied after the infringing goods have been sold, it may be inferred that genuine goods would have been sold in place of all the latter: *Alexander v. Henry*, 12 R. P. C. 360 (1895), Kekewich, J. In the United States there appears to be a question whether any recognised rule of law exists on the point or not. Mr. Cox says (p. 198): "There is a conflict between the cases as to the proper measure of damage for the infringement of a trade mark. It has been held in many instances that the profits of the defendant is the true measure, and in others that it is the profits which would have been

realised by the plaintiff had he sold the quantity of goods shown to have been sold by the defendant. Perhaps the most authoritative decision on the subject is *Faber v. Hovey* (Codd. Dig. 79, 249 (1875)), decided by the General Term of the Supreme Court of New York, and affirmed on appeal by a divided Court, in which the latter rule was applied, although the mark involved was of a strictly technical nature." As is stated in the text, the plaintiff in England has usually the option of taking the defendant's profits in lieu of damages. In a recent passing-off case in Scotland, where the judge at the trial had awarded the plaintiffs £50 damages, the Court of Session varied the order below, disallowing the damages, on the ground that there was no proof of actual deception, and that it could not be inferred that a falling-off in the plaintiff's sales had been due to a set of undetected deceptions: *Kinnell & Co., Ltd. v. Ballantine*, 27 R. P. C. 185.

⁴ *Davenport v. Rylands*, L. R. 1 Eq. p. 308, per Wood, V.-C.

appear that further damage has been done, for instance, where the spurious goods are so inferior to the genuine as to injure the trade reputation of the plaintiff,¹ or where the stress of the competition compels the plaintiff to lower his prices in order to avoid being driven from the market, and the reduction does not, as it may, bring him a sufficient increase of business to make up for the loss of profit on each article sold.²

The case of *Alexander v. Henry*² is an example of such exceptional circumstances as are referred to above. There the plaintiffs had had complete command of the Mexican market for their thread until it was taken from them by the fraudulent imitations of their marks in respect of which the damages were awarded. The result of the imitations was (1) to enable the defendants to make sales which would otherwise have been made by the plaintiffs; (2) to compel the plaintiffs to reduce their prices; and (3) so to injure the plaintiffs' reputation that the defendants were able to sell goods, without disguise,³ in competition with them. The action was not defended, and the assessment of damages was referred to an Official Referee who awarded £772 under head (1), and £2,295 under head (2) against one set of defendants (the Henrys), and a lump sum of £5,000 (apparently) under head (3) against the other set of defendants (the Wallers). On an appeal to Kekewich, J., this award was supported.

If the infringement is a continuing one, the damages ought to be assessed down to the time of the assessment.⁴

The plaintiff may, in general, make his choice of either an account and payment to him of the profits which the defendant has gained by his wrongful conduct, or an inquiry as to, and payment of, the damages occasioned to the plaintiff by reason of it,⁵

¹ *Sykes v. Sykes*, 3 B. & Cr. 541; 3 L. J. K. B. (O. S.) 46 (1824).

² See the patent cases: *American Wire Co. v. Thomson*, 44 C. D. 274; 7 R. P. C. 152 (1890), C. A.; and *United Horseshoe Co. v. Stewart*, 13 App. Ca. 401; 5 R. P. C. 260 (1888), both discussed in *Alexander v. Henry*, 12 R. P. C. 360 (1895), Kekewich, J.; *British Motor Syndicate v. Taylor*, 17 R. P. C. 189, 723 (1900); *Leeds Forge Co., Ltd. v. Deighton's Patent Flue and Tube Co., Ltd.*, 25 R. P. C. 209 (1908), Swinfen Eady, J.; and *Wellman, Seaver and Head, Ltd. v. Burstinghaus & Co., Ltd.*, 28 R. P. C. 326 (1911), Swinfen Eady, J.

³ This appears to be the meaning of paragraph 3 of the referee's report.

⁴ Ord. 36, r. 58.

⁵ *Weingarten v. Bayer*, 22 R. P. C. 341 (1905), H. of L., a passing-off case, in which Vaughan Williams and Cozens-Hardy, L.JJ., had intimated that if they had considered the plaintiff entitled to any relief, damages and not an account of profits ought to be given. In the House of Lords the plaintiff partially succeeded, and an account of profits was ordered. See also *Edelsten v. Edelsten*, 1 De G. J. & S. 185 (1863); *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A.;

Damages or profits.

that is, unless the case is tried before a jury and damages are assessed by the jury at once, or assessed by the judge sitting alone, acting as a jury.

Account of profits and damages are alternative.

The account and inquiry are alternative remedies,¹ for though in some of the earlier cases they were both allowed, they are now considered to be inconsistent. "If you take an account of profits, you condone the infringement," Lord Westbury said, in a patent case,² and the same rule applies in trade mark cases also.

Account or inquiry only granted if substantial damage is shown.

But neither an account nor an inquiry as to damages will be granted if the evidence of sales under the objectionable mark is not sufficient to make it worth while,³ or if it appears that the defendant has only used his mark for a short time.⁴ For instance, no account or damages was allowed or given in a case where the only infringement proved was by the defendant, at the request of a customer, filling with lime-juice of his own make, a bottle embossed with the plaintiff's mark, removing the plaintiff's label, and replacing it by his own.⁵

They only go back for six years;

Damages can only be recovered, and the profits to be included in the account can only be reckoned, in respect of infringements occurring within six years from the issue of the writ,⁶ subject to the exception in the case of concealed fraud, which is part of the general law.

and, as against innocent infringers, only to notice of infringement.

It has been shown that it is no answer to the claim for an injunction that the infringement was effected innocently, in ignorance of the existence of trade mark rights; but an inquiry as to damages or an account of profits will only be granted against an infringer, if he has infringed after he has knowledge of the existence of the plaintiff's trade mark; and if any such inquiry or account is ordered, the damages or profits are only calculated in respect of sales, dealings, or other infringements, if any, of which the infringer is guilty after becoming aware of

Saxlehner v. Apollinaris Co., 14 R. P. C. 645; cf. *Hodgson v. Kynoch*, 15 R. P. C. 465 (1898), Romer, J.; and *Van Zeller v. Mason, Cattley & Co.*, 25 R. P. C. 37 (1908), Joyce, J.

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

² *Neilson v. Betts*, L. R. 5 H. L. 1 (1871); followed in *De Vitre v. Betts*, L. R. 6 H. L. 319 (1872).

³ *Sanitas Co., Ltd. v. Condy*, 4 R. P. C. 530 (1887), Kekewich, J.; neither was

granted in *Magnolia Co. v. Atlas Co.*, 14 R. P. C. 389 (1896), Collins, J., and C. A., although the plaintiffs obtained an injunction; and see *Crosfield & Sons, Ltd. v. Caton*, 29 R. P. C. 47 (1912), Joyce, J.

⁴ *McAndrew v. Bassett*, 10 Jur. (N. S.) 495 (1864), Westbury, C.

⁵ *Rose v. Loftus*, 47 L. J. Ch. 576 (1878), Malins, V.-C.

⁶ Per Mellish, L.J., in *Ford v. Foster*, L. R. 7 Ch. p. 633 (1872).

the plaintiff's rights.¹ In a case in which at the most there were only proved one or two inadvertent sales by servants of goods under the plaintiff's special trade name for his goods, and this contrary to the defendant's orders, the Inner House in Scotland held the plaintiff to be entitled to no relief, reversing the Lord Ordinary, who had granted an interdict with a small sum for damages.²

The case of a manufacturer who copies a mark he finds on goods which he knows are not his own may be distinguishable. He may not know whose mark it is, and may possibly be in doubt whether it is a trade mark or not, but he knows that he has no right to the mark if it be a trade mark, and the damages or account have been ordered to be calculated as against him from the first infringement, within six years of the writ.³

The Court has refused, in some cases, to order an account of profits where the plaintiff has neglected to take proceedings after becoming aware of the infringement;⁴ and it may be assumed that it certainly would not assist the plaintiff to recover profits which he had deliberately allowed the defendant to earn in the expectation of obtaining them from him.⁵ And damages have also been refused on the ground of delay.⁶ But delay in order to obtain evidence necessary to establish his case would not bar the plaintiff of his ordinary remedy,⁷ nor, it is submitted, would any

Refused
because of
delay or
acquiescence.

¹ *Edelsten v. Edelsten*, 1 De G. J. & S. 185; 10 L. T. (N. S.) 780 (1868), Westbury, L.C.; *Moet v. Couston*, 33 Beav. 578; 10 L. T. (N. S.) 995 (1864), Romilly, M.R.; *Ellen v. Slack*, 24 Sol. J. 290 (1880), Jessel, M.R.; and *Slazenger v. Spalding*, [1910] 1 Ch. 257; 27 R. P. C. 20, Neville, J., who expressed the opinion that the plaintiffs were not entitled even to nominal damages, but the defendants had offered £10 damages and judgment was given for that sum. The defendants were manufacturers. The principle was applied in *Horsfield v. J. Walkden & Co., Ltd.*, 28 R. P. C. 175 (1911), Leigh Clare, V.-C. Cf. Patents and Designs Act, 1907, sections 33 and 60.

² *Montgomerie v. Young*, 21 R. P. C. 285 (1904).

³ *Cartier v. Carlile*, 31 Beav. 292; 8 Jur. (N. S.) 183 (1262), Romilly, M.R. See also the cases cited in note (1).

⁴ *Harrison v. Taylor*, 11 Jur. (N. S.)

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

⁵ Cf. *Anglo-Swiss Condensed Milk Co. v. Swiss Condensed Milk Co.* (1871), W. N. 163, Malins, V.-C., cited above, p. 491; *Beard v. Turner*, above, and see *Crossley v. Derby Gas Light Co.*, 1 Webster's P. C. 119, a patent case.

⁶ *Reddaway v. Stevenson*, 20 R. P. C. 276 (1903), Hall, V.-C., three years' delay before action. In *Gledhill & Sons, Ltd. v. British Perforated Toilet Paper Co.*, 28 R. P. C. 429 (1911), Eve, J., in dismissing the action intimated that, even if the plaintiffs had been entitled to an injunction, their delay of over two years would have debarred them from obtaining damages.

⁷ See *Cave v. Myers*, (1868), Seb. Dig. p. 181, Giffard, V.-C.; *Lee v. Haley*, 21 L. T. (N. S.) 546; L. R. 5 Ch. 155 (1869), Malins, V.-C., and Giffard, L.J., and *Crossley v. Derby Gas Light Co.*, note (5).

reasonable delay in the hope of avoiding litigation after a definite warning to the defendant.

Limited because of misrepresentation.

In a case where there had been some delay, and some amount of misrepresentation in his business on the plaintiff's part, and the defendant's proper trade was larger than that of the plaintiff's, the account was limited to profits earned since the commencement of the suit, and Mellish, L.J., said that it was a case where a jury would have given forty shillings damages only.¹

Form of order for account.

The ordinary form of the order for an account directs an account of the profits made by the defendant in selling or otherwise disposing of the goods bearing the spurious mark or marks to be taken by the master or the official referee, and orders payment of the amount found to be made by the defendant to the plaintiff within a time fixed from the date of the certificate or report.²

In the case of *Lever v. Goodwin*,³ it was objected that the account should be limited to sales made to persons who bought the goods as and for the goods of the plaintiff, by reason of the use of the infringing mark upon them. The Court overruled this objection.³ They said that the mischief done by the spurious marking of the goods is not merely that it is calculated to deceive immediate purchasers from the infringers, but that it puts "a weapon calculated to be fraudulently used by the middlemen"⁴ into their hands, by which they may intentionally, or not, deceive the ultimate purchasers. In a subsequent case Kekewich, J., made an order in the same form notwithstanding that he did not believe that there had been a single sale of the defendant's goods as those of the plaintiff, and notwithstanding that the goods had been fairly competing.⁵

Costs of inquiry or account.

The costs of the inquiry as to damages or the account of profits, should generally be reserved until the result of the inquiry or account is known,⁶ at any rate, unless it is clear that it will be of substantial value to the plaintiff; for if no damages or profits are found to have been incurred or made,⁷ or if the proceedings

¹ *Ford v. Foster*, L. R. 7 Ch. p. 633 (1872), L.JJ.

² *Weingarten v. Bayer*, 22 R. P. C. 341 (1905), H. of L.; *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A.; Appendix, p. 801.

³ See also *Edelsten v. Edelsten*, 1 De G. J. & S. 185; 10 L. T. (N. S.) 780 (1869), Westbury, L.C.

⁴ Per Cotton, L.J., in *Lever v.*

Goodwin; and see *Price's Patent Candle Co. v. Ogston and Tennant, Ltd.*, 26 R. P. C. 797, at p. 814 (1909).

⁵ *Saxlehner v. Apollinaris Co.*, [1897] 1 Ch. 898; 14 R. P. C. 645.

⁶ Per Fry, J., in *Stark v. Midland Rail. Co.*, 16 C. D. 81 (1880), a case of nuisance.

⁷ *Tonge v. Ward*, 21 L. T. (N. S.) 480 (1869), Romilly, M.R.

subsequent to the judgment are oppressively conducted by the plaintiff, or if the defendant has made a sufficient offer,¹ the plaintiff ought to pay the costs. But where the defendant had filed a false affidavit greatly understating the number of goods sold, although the account showed that he had made no profit, Chitty, J., said it was a case for investigation, and allowed the plaintiff the costs.²

Where at the trial the defendant offers a sum as damages, but the plaintiff elects to take an inquiry, the offer will, at the defendant's request, be recited in the order.¹

Recital in
order of offer.

The plaintiff is entitled to the ordinary inquiry as to damages, or account of profits made by the defendant by the use of the infringing mark, although the plaintiff is not the sole owner of the mark. If he elects to have an account of profits, however, he can only claim payment of such proportionate share of the profits as may be found to be appropriable to his interest in the mark.³ It is submitted that this is so, notwithstanding the language of the proviso to sec. 39, which (*inter alia*) 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 each of such persons shall otherwise (*i.e.* except as against one another) have the same rights as if he were the sole registered proprietor thereof. The defendant is, it seems, entitled to have all the co-owners of the mark made parties, before the account is taken, in order that they may be bound by it, and that it may be taken once for all.⁴

Account
where plain-
tiff not sole
owner.

¹ *Iron-Ox Remedy Co., Ltd. v. Leeds Industrial Co-operative Society, Ltd.*, 24 R. P. C. 434 (1907), Parker, J.; and *Fettes v. Williams (Birmingham), Ltd.*, 25 R. P. C. 511 (1908), Warrington, J., a design case, in which the damages were assessed at less than the amount of the offer, and the plaintiffs were ordered to pay the costs of the inquiry and of the further consideration. Possibly the rule might not be strictly applied in a case of fraudulent infringement.

² *Dicks v. Jackson*, March 31st, 1884, cited Sebastian, 5th ed., p. 251.

³ In *Dent v. Turpin*, 2 J. & H. 139 (1861), Wood, V.-C., which is substantially the only authority on the matter, both of the two owners of the mark had filed bills asking, in each case,

for payment of so much of the profits made by the defendant as the plaintiff was entitled to. The Vice-Chancellor said the fact that both owners were suing avoided the difficulty in regard to the account. In *Southorn v. Reynolds*, 12 L. T. (N. S.) 75 (1865), the same Vice-Chancellor followed his previous decision, but the order as to payment (if any) is not reported. In the latter case, contrary to the modern rule, the inquiry and the account were both ordered.

⁴ See the patent cases, *Bergmann v. Macmillan*, 17 C. D. 423 (1881), Fry, J.; and *Van Gelder v. Sowerby Society*, 44 C. D. 374; 7 R. P. C. 208 (1890), C. A., see per Cotton, L.J., 44 C. D. p. 392. The defendant cannot, as appears from the last case, object to judgment

7. Costs.

Costs in the discretion of the judge.

Subject to sec. 46 of the Act, which is referred to below, the costs of and incident to an action for the infringement of a trade mark, as the costs in any other action, are in the discretion of the Court or judge, and the Court or judge has full power to determine by whom and to what extent such costs shall be paid.¹ Provided that where the action is tried with a jury, the costs follow the event, unless the judge by whom it is tried, or the Court, for good cause, otherwise orders.²

Unsuccessful party usually ordered to pay costs.

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

Infringer must offer complete redress before action,

An unsuccessful defendant must usually pay costs, although he has only defended a mark which he honestly adopted without being aware of its too great resemblance to the plaintiff's mark,³ and though he has acted without fraud and in ignorance of the plaintiff's rights,⁴ and the action has been commenced against him without notice.⁵ But by offering the plaintiff all that he is entitled to,—that is, in the case of the innocent holder⁶ of spuriously marked goods, an undertaking⁷ not to part with them

on the ground of want of parties, but can apply to have the owners who are not plaintiffs added (as plaintiffs or defendants) for the purposes of the account after judgment. See Ord. 16, r. 11, in the Annual Practice.

¹ Supreme Court of Judicature Act, 1890, s. 5.

² Ord. 65, r. 1.

³ *Blair v. Stock*, 52 L. T. 123 (1884), Kay, J.; cf. the registration cases, *Hyde & Co.'s Tm.*, 7 O. D. 724; *Kuhn & Co.'s Tm.*, 53 L. J. Ch. 288, n., both (1878), Jessel, M.R.

⁴ *Edelsten v. Edelsten*, 1 De G. J. & S. 185; 10 L. T. (N. S.) 780 (1869), Westbury, L.C.; *Tonge v. Ward*, 21 L. T. (N. S.) 480 (1869), Romilly, M.R.

⁵ *Field v. Lewis*, Seb. Dig. p. 167 (1867), Wood, V.-C.; *Upmann v. Forester*, 24 C. D. 231 (1883), Chitty, J.

See *Weingarten v. Bayer*, 22 R. P. C. 341, at p. 350 (1905), Ld. Macnaghten.

⁶ In a case of fraud, the plaintiff may, notwithstanding that the defendant has made a full offer to submit, be allowed the whole costs although he proceeds to trial. *Jameson & Son, Ltd. v. Clarke*, 19 R. P. C. 255 (1902), Chatterton, V.-C., Ireland.

⁷ The plaintiff is not bound to accept an undertaking in the case of an infringer with notice, or where there is reasonable risk that it will be necessary to take steps to enforce it. In such a case the plaintiff will usually be allowed the costs of a motion for judgment, *Gandy Belt Manufacturing Co., Ltd. v. Fleming, Birkby and Goodall, Ltd.*, 18 R. P. C. 276 (1901), Byrne, J.; but at all events the defendant must pay the costs of the plaintiff obtaining an in-

until the spurious marks have been removed,¹ and all requisite information to enable the plaintiff to stop the infringement² and the payment of the taxed costs³ (if any) already incurred by him in the action, if an action has been commenced—the defendant may escape liability for subsequent costs.⁴ If the plaintiff, after such an offer has been made, commences or continues proceedings against the defendant making it, he will be ordered to pay him his costs subsequently incurred.⁵ In a case where, as it turned out, the plaintiff was entitled to an injunction only, and his right to this was admitted on the second day of the trial, he was given costs up to that time, and was ordered to pay the subsequent costs.⁶ In a passing-off case, in which the defendants offered an undertaking at an early stage of the trial, and the plaintiffs refused the offer, and pressed for an injunction, and it was held that there had been no fraud, and that if any wrongful acts had been done, they had been done accidentally or by inadvertence, and an injunction was refused, no order was made as to costs; and an appeal by the plaintiffs was dismissed with costs.⁷

and will then get subsequent costs.

junction by consent in chambers; *Slazenger v. Pigott*, 12 R. P. C. 439 (1895), North, J. Of the patent case, *Jenkins v. Hope*, [1896] 1 Ch. 278; 13 R. P. C. 57, North, J.

¹ An innocent consignee or bailee may become liable for damages if he sends the spurious goods out of the country, or otherwise puts them beyond the control of the Court. *Upmann v. Elkan*, note (5), and cf. the patent case, *British Motor Syndicate, Ltd. v. Taylor*, [1901] 1 Ch. 122; 17 R. P. C. 723, C. A.

² Above, pp. 489, 502. The plaintiff is not entitled to the publication of an apology: *Hudson v. Bennett*, 14 L. T. (N. S.) 698 (1866), Stuart, V.-C.; *Hudson v. Chatteris Co.*, p. 508, n. (2); or to receive a list of the defendant's customers, if not entitled to an enquiry or account: *Hipkins v. Plant*, 15 R. P. C. 294 (1898).

³ *Burgess v. Hills*, 26 Beav. 244; 28 L. J. Ch. 356 (1858), Romilly, M.R.; *McAndrew v. Bassett*, 33 L. J. Ch. 561; 4 De G. J. & S. 380 (1864), Wood, V.-C., and Westbury, C.; *Fennessy v. Day and Martin*, 55 L. T. 161 (1886), Bacon, V.-C.

⁴ But the defendant must not ask for

a term which he is not legally entitled to, as, for instance, that the plaintiff should not advertise the undertaking: *Hipkins v. Plant*, above, note (2); and *Henry Clay and Bock Co., Ltd. v. Godfrey Phillips, Ltd.*, 27 R. P. C. 508 (1910), Eve, J.

⁵ *Millington v. Fox*, 3 My. & Cr. 338 (1838), Cottenham, C.; *Moet v. Couston*, 33 Beav. 578 (1864), Romilly, M.R.; *Upmann v. Elkan*, L. R. 12 Eq. 140; 7 Ch. 130 (1871), Romilly, M.R., and Hatherley, C.; *Moet v. Pickering*, 6 C. D. 770; 8 C. D. 372 (1877), Fry, J., and C. A.; *Slazenger v. Spalding Bros.*, 27 R. P. C. 20 (1910), Neville, J. In *Catterson & Sons, Ltd. v. Anglo-Foreign Manufacturing Co.*, 23 R. P. C. 74 (1911), the defendants, who were commission agents and alleged that they were innocent importers from abroad, were held not to have met the plaintiffs' complaint in a proper manner, and an injunction was granted to the plaintiffs with costs.

⁶ *Magnolia Metal Co. v. Atlas Metal Co.*, 14 R. P. C. 389, at p. 400 (1896), Collins, J., a passing-off case.

⁷ *Lever Bros., Ltd. v. Masbro'*

Where an action was brought for infringement of trade mark by the use of a label and to restrain passing-off, the act complained of being the use of the same label, and the defendants offered to submit to an injunction as regards trade mark, and, after accepting such offer, the plaintiffs continued the action as regards passing-off, the plaintiffs were ordered to pay the costs from the date of the offer.¹

If the plaintiff moves for an interlocutory injunction after being offered all that he can obtain on such a motion, unless there is ground to believe that the offer will not be carried out, the motion should be refused with costs.²

In *Moet v. Pickering*,³ where wharfingers with whom the spuriously marked goods had been warehoused in the ordinary course of trade, and who were entitled to a lien for their charges, were added as defendants, and the plaintiffs proceeded to trial against them, the Court of Appeal, reversing Fry, J., ordered that their costs of action should be paid by the plaintiffs. The wharfingers had pleaded that they had no knowledge of the infringement, and that they submitted to act as the Court should direct, upon payment of their charges and costs; but the Court of Appeal regarded this as meaning only that they claimed nothing adversely to the plaintiffs or the infringer. The case does not conflict with the rules stated above, for the plaintiffs had claimed to override the wharfinger's lien by a lien of their own for costs, and this was held to be wrong; and besides, it was clearly unnecessary to have added the wharfingers as defendants or to have proceeded to trial against them, since not only had they made no threat to part with the goods, but after

Equitable Pioneers Society, Ltd., 29 R. P. C. 33 and 225 (1912), Joyce, J., and C. A.

¹ *Vernon & Sons v. Buchanan's Flour Mills, Ltd.*, 23 R. P. C. 17 (1906), Farwell, J.; cf. *Hat Manufacturers Supply Co., Ltd. v. Tomlin Bros.*, 23 R. P. C. 413 (1906), Swinfen Eady, J. Where on a motion for an injunction which was treated as the trial, the plaintiff failed as to the relief claimed in the writ, and the motion and evidence were also directed to another complaint, as to which the defendants had made a reasonable offer, including costs to that date, the action was dismissed, the

plaintiffs being ordered to pay the subsequent costs, *Clarke v. Hudson*, 18 R. P. C. 310 (1901), Farwell, J.

² *Snuggs v. Seyd and Kelly's Credit Index Co.*, (1894), W. N. 95, Chitty, J. In *Hudson v. Chatteris Co.*, 15 R. P. C. 438 (1898), Stirling, J., a patent case, where the defendant had paid sufficient money into Court to cover damages and an injunction was refused at the trial, costs subsequent to the acceptance of the money were given to the plaintiff. See also p. 506, note (7).

³ A similar order was made in *Upmann v. Elkan*, p. 507, note (5).

notice of the injunction obtained against the infringer it would have been a contempt of Court for them to do so.

Where the plaintiff has obtained, or is offered, all that he is entitled to, the Court will stay further proceedings in the action, at the defendant's instance.¹ Stay of proceedings.

And in a trivial case, where an action had been commenced without notice against the innocent purchaser of an inconsiderable quantity of spuriously marked goods, and he at once submitted to do as the Court directed, Stirling, J., refused to give any costs.² In some cases of isolated instances of infringement or passing-off, the plaintiff has been refused relief at the trial, and been ordered to pay the costs of the action.³ Trivial cases.

It is no reason for not giving costs that the defendant is an infant.⁴

Costs have been refused to a successful plaintiff because he claimed, besides the injunction to which he was entitled, an account to which he was not, against an innocent purchaser of the spuriously marked goods;⁵ and in a similar case, where the Costs refused because plaintiff claimed too much.

¹ *Rudd v. Rowe*, L. R. 10 Eq. 610 (1870), James, V.-C.; *Curtis and Harvey v. Pape*, 5 R. P. C. 146 (1888), North, J. (*Diamond Gunpowder*).

² *American Tobacco Co. v. Guest*, [1892] 1 Ch. 630; 9 R. P. C. 218; cf. *Rose v. Loftus*, 47 L. J. Ch. 576 (1878), Malins, V.-C.

³ *Leahy v. Glover*, 10 R. P. C. 141 (1893), H. of L., and *Rutter v. Smith*, 18 R. P. C. 49 (1901), Kekewich, J., where only a single act of passing-off by a servant, since discharged, was proved, and costs were given against the plaintiffs; and see the other similar cases cited above, p. 432, note (3). In *Burberry v. Watkinson*, 23 R. P. C. 141 (1906), Warrington, J., an isolated case of a wrongful act, the defendant acting unwittingly, the action was dismissed without costs. In *Bass, Ratcliff and Gretton, Ltd. v. Laidlaw*, 26 R. P. C. 211 (1909), Lord Ordinary Scotland, although there were several instances of sales of beer not of the plaintiffs' manufacture as their beer, these were proved to have all originated in a single mistake relating to one barrel, and there being no fraud and no reasonable apprehension of repetition, interdict was

refused with costs; the plaintiffs had not asked for an explanation before action. In *Armstrong Oiler Co., Ltd. v. Patent Axlebox & Co., Ltd.*, 27 R. P. C. 362 (1910), Joyce, J., where a mistake having been made in an isolated instance, the defendants gave an undertaking on an interlocutory motion, and the plaintiffs failed to show at the trial that the defendants had done what they were not entitled to do, except in this instance, judgment was given for the defendants with costs, except so far as down to and including the hearing of the motion the costs had been increased by the complaint as to the one isolated mistake. In a trivial case of passing-off, where the defendant submitted on an interlocutory motion to a perpetual injunction, the plaintiff was awarded only County Court costs: *Joseph Crosfield & Sons, Ltd. v. Cuton*, 29 R. P. C. 47 (1912), Joyce, J. See also *Kokal, Ltd. v. Grenville*, 25 R. P. C. 416 (1908).

⁴ *Chubb v. Griffiths*, 35 Beav. 127 (1865), Romilly, M.R.

⁵ *Moet v. Couston*, 33 Beav. 578; 10 L. T. (N. S.) 325 (1864), Romilly, M.R. In *Hiphins v. Plant*, p. 507, note (2), the

plaintiffs set up claims to a copyright in a music tutor, as well as an exclusive right to its title, and failed as to the copyright, they were allowed only half their taxed costs of action.¹ On similar grounds, plaintiffs have been ordered to pay,² or have been deprived of,³ the costs occasioned by allegations which they have failed to prove, although they have succeeded and obtained the general costs of their actions. Thus, in a Scotch case, the plaintiffs were deprived of costs because they had alleged personal fraud without proving it, had claimed substantial damages and offered no proof thereof, and had had to make indispensable amendment in their pleadings.⁴ But where the plaintiff, in an action for infringing his trade mark and also for "passing-off," failed as regards the infringement in respect of some of the goods for which he used, but had not registered, the trade mark, and succeeded as to the rest of the action, and the defendant was held to have been guilty of deliberate infringement in breach of an undertaking previously given by him, Kekewich, J., refused to deprive the plaintiff of any part of his costs.⁵ If the plaintiffs' case has been overlaid with unnecessary evidence, he may be deprived of the costs of such evidence.⁶

The usual rule is to apportion the costs, each party getting costs of the substantial issues upon which he has succeeded, the plaintiff getting the costs of the action except so far as these are increased by the issues upon which costs are given against him,⁷

defendants were given the costs of the action so far as it asked for damages or an account.

¹ *Metzler v. Wood*, 8 C. D. 606 (1877), Malins, V.-C., and C. A.

² *Pierce v. Franks*, 15 L. J. Ch. 122 (1846), Knight Bruce, V.-C.

³ *Standish v. Whitwell*, 14 W. R. 512 (1866), Wood, V.-C., an affidavit charging fraud. So *Saxlehner v. Apollinaris Co.*, note (7), Kekewich, J., where a charge of fraud failed in part.

⁴ *Montgomerie & Co., Ltd. v. Young Bros.*, 20 R. P. C. 781 (1903), Ld. Kyllachy. On appeal the defendants wholly succeeded, 21 R. P. C. 285 (1904), Inner House.

⁵ *Jay v. Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888). So *Rowland v. Mitchell*, 13 R. P. C. 457 (1896), Romer,

J. In *Hodgson v. Kynoch*, 15 R. P. C. 465 (1898), Romer, J., there was no fraud, and the claim as to infringement had not substantially increased the costs, consequently no order as to them was made.

⁶ In *Daimler Motor Co., Ltd. v. London Daimler Co., Ltd.*, 24 R. P. C. 379 (1907), C. A., the plaintiffs were given only one half the costs of the evidence.

⁷ *Saxlehner v. Apollinaris Co.*, [1897] 1 Ch. 898; 14 R. P. C. 645; *Lever v. Bedingfield*, 15 R. P. C. 453 (1898), both Kekewich, J.; *Hipkins v. Plant*, 15 R. P. C. 294 (1898), Byrne, J. *Worthington Pumping Engine Co. v. Moore*, 20 R. P. C. 41 (1902), Byrne, J., a claim that the defendant was trustee for the plaintiffs of three patents, no evidence being offered as to one of them.

unless there is one main issue upon which he has failed.¹

In a case, where an action for infringement and two motions by the defendants, one to expunge the plaintiff's registration, and the other for an order to the Comptroller to register a mark propounded by the defendants, were tried together, and the action and the second motion failed, but the first motion succeeded, and both parties made unfounded allegations of fraud, North, J., refused to give any costs to either, principally on the ground that it was absolutely impossible for any taxing master to do justice between the parties by distinguishing the costs of one part of the case from another.²

The judge at the trial has jurisdiction to decide what proportion of costs a party is to pay, thus, where the plaintiffs and defendants each succeeded partially, the defendants were directed to pay one-third of the plaintiffs' costs, and no order was made as to their own.³ And where the defendants in an infringement action succeeded in their defence, and in a motion by them for rectification succeeded partially as to one mark, but failed as to another, the plaintiffs were ordered to pay to the defendants two-fifths of the costs of the action and motion, treating them as a whole, and including the costs of an interlocutory motion which were made costs in the action.⁴ And in a passing-off action in Scotland where on appeal the defendants were successful in obtaining a variation of the order made in the Court below, the Inner House ordered that the plaintiffs should have two-thirds only of their expenses in the Outer House, and no expenses of the appeal were awarded to either party.⁵

Apportionment of costs.

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

Successful defendant deprived of costs.

¹ *Pneumatic Stamp Co. v. Lindner*, 15 R. P. C. 525 (1898), Byrne, J.

² *Baker v. Rawson*, 45 C. D. 519; 8 R. P. C. 89 (1890); *Jackson v. Napper*, 35 C. D. 162; 4 R. P. C. 45 (1886), Stirling, J.

³ *Findlater, Mackie, Todd & Co. v. Newman & Co.*, 19 R. P. C. 235 (1902), Kekewich, J.

⁴ *Bourne v. Swan and Edgar, Ltd.*, 20 R. P. C. 105 (1903), Farwell, J. And see *In re Pollard* (1902), W. N. 49, Kekewich, J. See also the patent case, *Gawthorp v. Mason*, 23 R. P. C. 401 (1906), Kekewich, J.

⁵ *Kinnell & Co., Ltd. v. Ballantine & Sons*, 27 R. P. C. 185 (1910).

Where, for example, the plaintiff failed because of misrepresentations contained in his trade mark,¹ but the defendant had closely imitated the mark, the action was dismissed without costs; and the same course was followed where there was no sufficient proof that the defendant's mark was calculated to deceive, having regard to the long delay of the plaintiff to take proceedings, and the absence of evidence of actual deception;² and in cases where the action was dismissed, but the Court thought that the defendant's conduct had been uncandid and unfair;³ and North, J., dismissed an action without costs because he thought that the defendants had kept back information;⁴ and where the defendants had by their conduct brought the action on themselves, they were given no costs.⁵ So, where features of the defendants' wrapper had been taken from the plaintiffs', but not so as to infringe the plaintiffs' rights, the Court of Appeal, whilst dismissing the action and giving the defendants the costs of their successful appeal, refused to give them the costs of the action.⁶

So, too, no costs were given where it was proved that the defendant had represented the goods he sold as being those of the plaintiff, although the proof of the plaintiff's title failed.⁷

¹ *The Leather Cloth Co., Ltd. v. The American Leather Cloth Co., Ltd.*, 4 De G. J. & S. 137; 33 L. J. Ch. 199; 11 H. L. C. 523; 35 L. J. Ch. 53 (1863), Westbury, L.C., and H. L. The House of Lords held that there was no infringement.

² *Rodgers v. Rodgers*, 31 L. T. (N. S.) 285 (1874), L.JJ.

³ *Estcourt v. The Estcourt Hop Essence Co.*, 31 L. T. (N. S.) 567; L. R. 10 Ch. 276 (1874), Malins, V.C., Cairns, C., and L.JJ.; *Maxwell v. Hogg*, 15 L. T. (N. S.) 204; L. R. 2 Ch. 310 (1866), Stuart, V.-C., and L.JJ.; but see *King v. Gillard*, cited p. 513, note (4).

⁴ *Meaby & Co., Ltd. v. Triticine, Ltd.*, 15 R. P. C. 1 (1898).

⁵ *Lambert and Butler v. Goodbody*, 19 R. P. C. 377 (1902), Farwell, J. In a case in which Leigh Clare, V.-C., thought that the defendants had sailed as near the wind as possible with regard to their label, but held that there had

been no infringement, he intimated that their conduct might have deprived them of costs, but for the offer they had made before action, which rendered the action unnecessary, and he dismissed it with costs: *Jewsbury and Brown v. Atkinson*, 28 R. P. C. 293.

⁶ *Lever v. Bedingsfield*, 16 R. P. C. 3 (1899). The same course was taken where the Court of Appeal found misconduct on the part of the defendant; before and during the course of action. *Claudius Ash, Sons & Co., Ltd. v. Invicta Manufacturing Co., Ltd.*, 28 R.P.C. 252 and 597 (1911). The plaintiffs' appeal to the House of Lords was dismissed with costs, 29 R. P. C. 465 (1912).

⁷ *Ainsworth v. Walmsley*, L. R. 1 Eq. 518 (1866), Wood, V.-C.; and see *Browne v. Freeman* (1), 12 W. R. 305 (1864), Wood, V.-C., where the defendant misdescribed his goods as *The Original Chlorodyne*.

In *The Patent Plumbago* case,¹ however, where the plaintiffs failed on the ground of misrepresentation, but the imitation of their trade name was clearly made out, the action was dismissed with costs, the plaintiffs having continued to misdescribe their goods as "patent" after a summons taken out at their instance had been dismissed by the magistrate because of such misdescription.

So in cases in which the plaintiff fails because he is carrying on a fraudulent trade, and the defendant stands *in pari delicto*, the practice is to dismiss the action without costs.² Defendant *in pari delicto*.

And a successful defendant has also been deprived of costs because he has made an unfounded charge of fraud.³ Unfounded charges of fraud.

In a case in which the judge at the trial dismissed the action, but without costs, on the ground of what he found to be untrue statements on the defendants' goods as to prize medals and awards, the Court of Appeal found that there had been no dishonesty on the part of the defendants, but held that even if the statements had been misrepresentations to the public, yet if that was unconnected with a wrong done to the plaintiffs, the judge could not in his discretion on that ground deprive the defendants of costs.⁴

In an earlier case the same judge refused a successful defendant his costs because he put the word "registered" on his goods although his device was not registered; in this case, however, the plaintiffs might have been to some extent affected as they used the word "registered," their mark being registered.⁵

In a trade name case, where the plaintiffs' action was dismissed by the Court of Appeal on the ground that they were not satisfied that the name adopted by the defendants would cause any deception likely to occasion damage to the plaintiffs, costs, both of the appeal and in the Court below, were refused because the Costs of appeal.

¹ *Morgan v. McAdam*, 36 L. J. Ch. 223 (1866), Wood, V.-C.

² *Newman v. Pinto*, 4 R. P. C. 508; 57 L. T. 31 (1887), C. A.; *Thorneloe v. Hill*, 11 R. P. C. 61 (1894), Romer, J.; cf. *Baschet v. London Standard Co.*, [1900] 1 Ch. 73, Kekewich, J., a copyright case.

³ *Humphries v. The Taylor Drug Co.*, 59 L. T. 820 (1888), Kekewich, J.; *Hargreaves v. Freeman*, [1891] 3 Ch. 39; 8 R. P. C. 237, Chitty, J. As to unfounded charges of fraud by the

plaintiff, see p. 510.

⁴ *King v. Gillard*, [1905] 2 Ch. 7; 21 R. P. C. 589; 22 R. P. C. 327, Kekewich, J., and C. A. *Estcourt v. The Estcourt Hop Essence Co.*, cited p. 512, note (3), was not cited to the Court in this case.

⁵ *Warsop & Sons, Ltd. v. Warsop*, 21 R. P. C. 481 (1904), Kekewich, J. Cf. the cases cited above, in which a false representation of registration was held to constitute an element in infringement, above, p. 442.

Lords Justices believed that the defendants had chosen the name in dispute with the hope of obtaining some illicit advantage from the plaintiffs' reputation.¹

But, in general, the reasons for depriving the defendant of costs do not apply to the costs of an unsuccessful appeal brought by the plaintiff against the dismissal of his action. Thus, the appeal to the House of Lords in *The Leather Cloth* case² and the appeal to the Court of Appeal in *Newman v. Pinto*³ were both dismissed with costs. In the former case the plaintiff obtained judgment in the first instance, and when this was reversed on appeal by Lord Westbury no costs were given.⁴

Interest on costs repaid.

A party who succeeds on appeal and recovers the costs paid under the judgment below is not entitled to interest.⁵ But where the defendants succeeded at the trial, and received their costs from the plaintiffs, but failed on appeal and repaid the amount so received with interest to date, and on appeal to the House of Lords the defendants succeeded, they were held to be entitled not only to the return of the costs and interest repaid by them, but to interest on the costs from the date of such repayment by them to the date of the return after the House of Lords' decision.⁶

Higher scale.

The Court or judge may order the costs adjudged to be paid to be taxed upon the higher scale, if special grounds arising out of the nature and importance, or the difficulty or urgency, of the case appear to exist.⁷ Such an order was made by North, J., in *The Great Tower Street Tea Co. v. Smith*,⁸ where the hearing occupied a long time, and the facts were complicated, and a great number of witnesses were called. But some special reason for the order must be shown, for, although the application is almost always made in heavy trade mark or patent actions, it is not granted as of course;⁹ and it is not granted as a

¹ *Borthwick v. The Evening Post*, 37 C. D. 449 (1888), C. A.

² 11 H. L. C. 523; 35 L. J. Ch. 53.

³ See note (2), ante, p. 513. See also the cases cited above, p. 512, note (6).

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

⁵ *Edge v. Gallon*, 16 R. P. C. 509, at p. 520 (1899), C. A.

⁶ *Ashworth v. English Card Clothing Co., Ltd.*, 21 R. P. C. 355 (1904), Joyce, J.

⁷ Ord. 65, r. 9. See the note in the

Annual Practice.

⁸ 6 R. P. C. 165 (1889).

⁹ *Sanitas Co., Ltd. v. Condy*, 4 R. P. C. 530 (1887), Kekewich, J. In *Rodgers v. Rottgen*, 5 Times L. R. 678 (1889), Kay, J., said he gave costs on the higher scale very charily. In *Leonhardt v. Kalle*, 12 R. P. C. 103, at p. 120 (1895), Romer, J., said he had never done it except by consent. Collins, J., gave such costs in *Reddaway v. Banham*, 12 R. P. C. 86, and his judgment was restored by the H. of L., [1896] A. C. at p. 222.

punishment,¹ or merely because a case of gross fraud is found out.² The order ought only to be made in cases of very unusual difficulty requiring skill, antiquarian research and things of that kind.³ That scientific witnesses are necessarily called has been held to be a special reason.⁴ An appeal lies on the question whether there are "special grounds" or not.⁵

It is provided by sec. 46⁶ that—

"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."

Costs as between solicitor and client.

This section corresponds to the statutory provisions with regard to actions for the infringement of a patent.⁷

A certificate cannot be granted unless the right to the exclusive use of the trade mark has, in fact, come in question, and, therefore, it was refused in a case under the repealed Acts where the defendant's counsel admitted that, upon the failure of the defendant's application to remove the plaintiff's mark from the Register, he had no defence to the action.⁸ Under sec. 77A of the Act of 1883, introduced into that Act by sec. 18 of the Act of 1888, a certificate

Certificate that title to trade mark came in question.

¹ *Hudson v. Osgerby*, 32 W. R. 566; 50 L. T. 923 (1884), Pearson, J.; and see *Pooley's Trustee v. Whetham*, 33 C. D. p. 120; and *Paine v. Chisholm*, [1891] 1 Q. B. 531, and the cases there cited.

² See note (9), p. 514.

³ *Gadd v. Mayor of Manchester*, 9 R. P. C. 516, at p. 535, Lindley, L.J. See also *Dunlop Co. v. Wapshare Co.*, 17 R. P. C. 493 (1900), Buckley, J., *Chamberlain and Hookham v. Mayor of Bradford*, 17 R. P. C. 493 (1900), Farwell, J., and *Vidal Dyes Syndicate, Ltd. v. Levinstein, Ltd.*, 28 R. P. C. 541; 29 R. P. C. 245 (1912), Parker, J., and C. A., where the order was made; *Consolidated Pneumatic Tool Co. v. Clark*, 23 R. P. C. 718 (1906), Warrington, J.; *British Liquid Air Co., Ltd. v. British Oxygen Co., Ltd.*, 25 R. P. C. 218 and 577 (1908); Warrington, J., and C. A.; *Flour Oxidis-*

ing Co. v. Hutchinson, 26 R. P. C. 597 (1909), Warrington, J.; *Donnersmarkhutte, &c., Gesellschaft v. Electric Construction Co., Ltd.*, 27 R. P. C., 321 (1910), Parker, J., and *Marconi v. British Radio Telegraph and Telephone Co., Ltd.*, 28 R. P. C. 181 (1911), Parker, J., where it was refused. These are all patent cases.

⁴ *Ellington v. Clark*, 5 R. P. C. 328; 58 L. T. 818 (1888), C. A.; *The Robin*, [1892] P. 95, Jeune, J.; *Dunlop Co. v. Wapshare Co.*, supra.

⁵ *Paine v. Chisholm*, [1891] 1 Q. B. 531, C. A.

⁶ Replacing sec. 18 of the Act of 1888.

⁷ Patents and Designs Act, 1907, sec. 35.

⁸ *Benjamin Edgington, Ltd. v. John Edgington & Co.*, 6 R. P. C. 513; 61 L. T. 323 (1899), Kay, J.

could only be given in an action for infringement; but it was held that it could under some circumstances be granted upon a motion for rectification where the mark had been registered for five years, since the mark could then only be attacked by proceedings for rectification. Thus where, under an order of the Court, a motion for rectification and an action for infringement were heard together and on the same evidence, it was held that there was jurisdiction to grant a certificate, and the grant was made.¹

In a case where the Court of Appeal refused an application by the defendant to expunge the plaintiffs' marks, partly on the ground that the defendant was a deliberate infringer, they declined to give the plaintiffs a certificate under the section.²

The order granting a certificate is not appealable.³

In a passing-off action in which the defendants were alleged to have passed-off other tobacco as the plaintiffs' "Grand Cut" tobacco, and it was held that in fact neither the defendant nor his assistants had supplied other tobacco when asked for the plaintiffs' "Grand Cut" tobacco, the defendant asked for solicitor and client costs, but these were refused.⁴

Costs of motion to rectify in aid of defence.

Considerations similar to those above stated govern the grant or refusal of costs in respect of the application to rectify the Register by expunging or varying the registration of the plaintiff's mark, which is an ordinary incident of the defence in an action for infringement. The usual practice is to give the applicant costs, if he succeeds;⁵ but if the application is made by the defendant for the purposes of the action, and it is doubtful whether he is not acting fraudulently, the costs may be reserved till the trial,⁶ or may be refused.⁷

Three counsel.

The costs of three counsel have sometimes been expressly

¹ *Field & Co. v. Wagel Syndicate*, [1900] 1 Ch. 651; 17 R. P. C. 266, Buckley, J. A certificate was, however, refused in *Kodak, Ltd. v. London Stereoscopic, &c., Co.*, 20 R. P. C. 337 (1903), Swifen Eady, J., where passing-off was the chief issue; and on special grounds in *Bourne v. Swan and Edgar, Ltd.*, 20 R. P. C. 105 (1903), Farwell, J. A certificate was given in *Barlow v. Johnson*, 7 R. P. C. 395, at p. 411 (1890), Chitty, J.; there was a motion to rectify, but the mark had been registered less than five years.

² *Paine & Co. v. Daniells & Sons'*

Breweries, [1893] 2 Ch. 567; 10 R. P. C. 217, cited p. 398.

³ *Haslam & Co. v. Hall*, 5 R. P. C. 144 (1888), C. A.

⁴ *Godfrey Phillips, Ltd. v. Russell*, 26 R. P. C. 834 (1909), Warrington, J.

⁵ *Richards v. Butcher*, [1891] 2 Ch. 522; 8 R. P. C. 37, Kay, J.

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

⁷ *Perry-Davis' Tm.*, 5 R. P. C. 333; 58 L. T. 695 (1888), Kay, J.; *Bradley's Tm.*, 9 R. P. C. 205 (1892), Chitty, J. See further Chap. XI., p. 348.

allowed by the Court in trade mark and similar cases,¹ but the present practice of the taxing masters is to exercise their discretion as to allowing such costs without an order of the Court.²

8. Appeal.

In a case where the defendant desired to appeal against an interim injunction which the plaintiff had obtained, the Court, on his application, and on the ground that the continuance of the injunction would do irreparable damage to his business, advanced the case to the head of the list.³ Appeal advanced.

A stay of an injunction pending appeal will only be granted on special grounds, and generally on terms.⁴ But a stay as to delivery up is more readily granted.⁵ An inquiry as to damages or an account of profits is not often stayed, but sometimes liberty to apply when the inquiry has been answered has been given.⁶ Stay pending appeal.

¹ For instance, in *Weingarten v. Rosenthal*, 21 R. P. C. 212 (1904), Farwell, J.

² See *Andrews' Patent*, 24 R. P. C. 349, at p. 378 (1907), C. A.; and *Burroughs, Wellcome & Co.'s Tms.*, 22 R. P. C. 164 (1905), where such costs at the trial and in the Court of Appeal were allowed by the taxing master, and Warrington, J., refused to overrule his discretion. In *Crosfield & Sons, Ltd.'s Application*, 27 R. P. C. 433 (1910), an opposition to registration, in which the evidence was very heavy, Swinfen Eady, J., allowed the successful opponents the costs of three counsel at the hearing and in the Court of Appeal, overruling the decision of the Taxing Master in this respect. The costs at the attendance of the country solicitor at the trial were also allowed; and see *Perry v. Hessin*, 30 R. P. C. 199 (1913), Eve, J.

³ *Lazenby v. White*, L. R. 6 Ch. 89 (1870), James, L.J.

⁴ See the patent cases, *Leeds Forge Co., Ltd. v. Deighton's Patent Flue and Tube Co., Ltd.*, 18 R. P. C. 233 (1901), stay arranged in C. A.; *Pilkington v. Massey*, 21 R. P. C. 421 (1904), Kekewich, J.; *Jandus Arc Lamp, &c. Co. v. Arc Lamp Co.*, 22 R. P. C. 277 (1905), C. A., stay granted on terms; *Osrarn Lamp Works, Ltd. v. "Z" Electric Lamp Manufac-*

turing Co., Ltd., 29 R. P. C. 401 (1912), Warrington, J., stay granted on terms; and *Worcester Royal Porcelain Co., Ltd. v. Locke*, 19 R. P. C. 479, at p. 491 (1902), Byrne, J., passing-off, stay on terms including an undertaking to keep an account and to pay over profits if the appeal failed; *Mouchel v. Coignet*, 23 R. P. C. 649 (1906), Warrington, J. See generally as to stay pending appeal, Annual Practice, notes to Ord. 58, r. 16.

⁵ *E.g.*, granted in *Parker and Smith v. Satchwell*, 18 R. P. C. 299 (1901), Farwell, J., where the delivery up was stayed, although a stay of the injunction was refused. Also *Presto Gear Case, &c. Co., Ltd. v. Orme, Evans & Co., Ltd.*, 17 R. P. C. 218 at p. 227 (1900), Farwell, J.; *Mouchel v. Coignet*, note (4); and *Gillette Safety Razor Co. v. Anglo-American Trading Co., Ltd.*, 29 R. P. C. 341 (1912), Parker, J.

⁶ See the *Presto Gear* case cited note (5), and *British United Shoe Machinery Co., Ltd. v. A. Fussell & Sons, Ltd.*, 25 R. P. C. 368 (1908), Swinfen Eady, J. In *Coleman & Co., Ltd. v. Stephen Smith & Co., Ltd.*, [1911] 2 Ch. 572, Swinfen Eady, J., refused to stay an account of profits, stating that it was not the practice of the Court to do so, unless irreparable injury would be caused.

A stay of the injunction pending an appeal from the Court of Appeal to the House of Lords, the defendants undertaking to keep an account, was granted in a patent case on the ground of difference of opinion in the Court, coupled with the fact that there was no possible doubt as to the plaintiffs getting their damages if an appeal failed.¹

Stay of order. An application to stay a new trial ordered to take place by the Court of Appeal, pending an appeal against the order to the House of Lords, was refused in *Edge v. Johnson*.²

Interlocutory appeal barred by delay. In *Burgess v. Burgess*,³ delay for five months in appealing against an order for an interim injunction, where the plaintiff was appellant, seeking to have the scope of the order enlarged, was held to be a bar to the appeal.

Appeal in case of fraud. Where the judge of first instance has found, or has refused to find, fraud it is difficult, and usually impossible, for the Court of Appeal to reverse his finding. In a trade name case a finding of fraud was reversed, the Court being able to act without relying on the evidence of the defendant, which the judge below had not believed.⁴ In a recent case in which the judge below found that the get-up of the defendants' goods was calculated to deceive, and expressed his dissatisfaction with the defendants' principal witness, and said that he could not exonerate the defendants from intention to deceive, the Court of Appeal held that these reflections were unjustified, and that the get-up was in fact not calculated to deceive.⁵

Non-suit. If an appeal is brought, and the defendant succeeds, judgment is entered in his favour, not a non-suit;⁶ but the Court of Appeal,

¹ *Consolidated Pneumatic Tool Co., Ltd. v. Clark*, 24 R. P. C. 593, at p. 640 (1907).

² 9 R. P. C. 184 (1892).

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

⁴ *Jamieson & Co. v. Jamieson*, 15 R. P. C. 169 (1897). In *Valentine Meat Juice Co. v. Valentine Extract Co., Ltd.*, the Court of Appeal found fraud, where Stirling, J., had failed to do so, 17 R.

P. C. 1 and 678; 83 L. T. 259 (1900).

⁵ *Coleman & Co., Ltd. v. Stephen Smith & Co.* (1911), 2 Ch. 572; 28 R. P. C., 645, 29 R. P. C. 81, Swinfen Eady, J., and C. A. And see *Claudius Ash, Sons & Co., Ltd. v. Invicta Manufacturing Co., Ltd.*, 28 R. P. C. 252 and 597, where Warrington, J., found that there must have been a fraudulent inception to the user of the name "Stent," by the defendants' predecessors; but the Court of Appeal held that this issue had not been pleaded, and allowed the defendants' appeal. An appeal to the House of Lords was dismissed, 29 R. P. C. 465.

⁶ *Pinto v. Badman*, 8 R. P. C. 181

in dismissing the plaintiff's action, may reserve to him liberty to sue again in respect of any part of his claim. This course was adopted in an action where the plaintiff sought to raise a new case of "passing-off," not set up by the pleadings, at the trial, and was not allowed to proceed with it.¹

9. Practice.

There are no rules as to pleadings which are peculiar to actions for the infringement of trade marks; ² all that is necessary, therefore, is that the statement of claim, defence, and reply, if any, in any such action, shall respectively contain statements, in a summary form, of the material facts upon which the party pleading relies for his claim or defence, ³ giving particulars of the frauds, if fraud is alleged.⁴ What are material facts, having regard to the circumstances of the case, may be gathered from the statement of substantive law, given in the earlier part of the present chapter. Pleadings.

The forms provided by the appendices to the Supreme Court Rules are set out below. They, when applicable, and when they are not applicable forms of a like character, and as near as may be to them, are to be used for all pleadings; and, where they are applicable and sufficient, any longer forms are to be deemed prolix, and the costs occasioned by such prolixity are to be disallowed, or to be borne by the party so using the same, as the case may be.⁵ Forms in the Rules of the Supreme Court.

INDORSEMENT OF THE WRIT.

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

STATEMENT OF CLAIM.

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

(1891), C. A. No plaintiff can, under the modern practice, claim to be non-suited: *Fox v. Star Newspaper Co.*, [1900] A. C. 19.

¹ *Native Guano Co. v. Sewage Manure Co.*, 8 R. P. C. 125 (1888), C. A. and H. L.

² Sec. 9 of the Merchandise Marks Act, 1887, provides that in any pleading, proceeding, or document in which any

trade mark or forged trade mark is intended to be mentioned, it shall be sufficient, without further description and without any copy or facsimile, to state that trade mark or forged trade mark to be a trade mark or forged trade mark. Appendix, p. 891.

³ Ord. 19, r. 4.

⁴ Ord. 19, r. 6.

⁵ Ord. 19, r. 5.

(2.) The trade mark is (*describe it*). (*If the plaintiff is not the original proprietor of the trade mark, show shortly how his title is derived.*)

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

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

The plaintiff also claims an account or damages.¹

DEFENCE.

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

It will be observed that the form of statement of claim here given does not comprise an allegation that the plaintiff's trade mark has been registered, or that sec. 42 of the Act has been otherwise complied with; but such an allegation is certainly proper, and, it is submitted, necessary.

Some more elaborate and detailed forms are given in the Appendix.²

Particulars.

The ordinary rule³ that the parties must state the facts upon which they rely and which they plead in their pleadings, or in particulars separately delivered, with sufficient particularity to prevent their opponents being taken by surprise at the trial, applies to trade mark cases.

So if the plaintiff alleges that actual deception has occurred, he will be ordered to give particulars of the persons deceived.⁴ And if the defendant pleads that the plaintiff's trade mark is invalid, he must give particulars of the invalidity alleged.⁵

In a passing-off case in which the plaintiffs alleged that their cigars had come to be known by a name consequent on the use of red bands, they were ordered to give particulars of the dates

¹ Rules of the Supreme Court, Appendix C., sec. 6, Form 8.

² Page 792 *et seq.*

³ See the notes to Ord. 19, rr. 6 and 7, in the Annual Practice.

⁴ *Humphries v. Taylor Drug Co.*, 39 C. D. 693; 5 R. P. C. 687 (1888), Kekewich, J.; *Whitstable Oyster Fishery Co.*

v. Hayling Fisheries, Ltd., 17 R. P. C. 461 (1900) (the decision at the trial was affirmed on appeal, 18 R. P. C. 434 (1901)).

⁵ *Rowland v. Mitchell*, 13 R. P. C. 457 (1896), Romer, J.; *Grosvenor Chemical Co. v. Greenfield*, [1909] I. R. 82, M.R. Ireland.

when the cigars in question first became known by the name, as well as certain particulars as to the alleged passing-off.¹

If a motion to expunge the plaintiff's mark is made by way of reply to the usual interlocutory application on behalf of the plaintiff for an interim injunction, and both the motion and application stand over to the trial, unless there are affidavits sufficiently showing what the defendant's case is upon his motion to expunge, he is frequently directed to deliver particulars of it. Where a defendant alleges common use of the mark in question, he may be ordered to give particulars of such user, for instance, the date of first user in the trade, and the names and addresses of a certain number of persons alleged to have used the mark.² So also where a defendant alleges user by himself he may be ordered to give particulars of the user alleged.³

Discovery.

The ordinary rules⁴ governing discovery also apply to trade mark actions.⁵

But a process which enables a rival trader to extract from his opponent information concerning his customers, his trade, and his mode of doing business, is extremely likely to be abused, and in cases where a large trade mark business is affected, even the ordinary order for discovery of documents upon oath may be very oppressive.⁶ The Court, therefore, will, upon a proper case being shown, modify the common orders so that they shall occasion no more inconvenience to the party to whom they are directed than is necessary to ascertain the rights of his opponent.

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

Thus, in *Carver v. Pinto Leite*,⁷ it was held that the defendants

¹ *Imperial Tobacco Co., Ltd. v. Purnell & Co.*, 20 R. P. C. 719 (1903), Kekewich, J.

² *Aquascutum, Ltd. v. Moore*, 20 R. P. C. 640 (1903), Kekewich, J.; *Schweppes v. Gibbens*, 22 R. P. C. 113, at p. 116 (1905). But if a defendant pleads that the article in question is generally known by the name which the plaintiff alleges is distinctive, and does not rely on particular users, he will not be ordered to give particulars of the general knowledge or of general use: *Roake Roberts & Co. v. Wayland*, 26 R. P. C. 249 (1909), Neville, J.

³ *Macmillan v. Ehrmann Bros., Ltd.*,

21 R. P. C. 357 (1904).

⁴ Ord. 31. The Merchandise Marks Act, 1887, provides that nothing in that Act shall entitle any person to refuse to make a complete discovery, or to answer any question or interrogatory in any action: sec. 19. Appendix, p. 894.

⁵ *Orr v. Diaper*, 4 C. D. 92 (1876) Hall, V.-C., demurrer to an action for discovery against shippers, brought in aid of an intended action against the consignors, dismissed.

⁶ *Wills' Tms.*, [1892] 3 Ch. 201; 9 R. P. C. 346, C. A.

⁷ L. R. 7 Ch. 90 (1871), C. A. See also *Benbow v. Low*, 16 C. D. 93 (1880),

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

And in a later case, where the defence was that the plaintiff was carrying on a fraudulent trade by selling as foreign cigars goods made in England, the plaintiff, who admitted the fact that his goods were in fact made in England, was allowed to refuse to say who was the manufacturer because, under the circumstances, the question was irrelevant.¹

But, where plaintiffs alleged that they had used certain trade marks for a great many years, and on an order for discovery, exhibited three orders for goods and three invoices as typical, stating that they had in their possession numerous other similar orders and invoices and refused a request for inspection, they were ordered to file a further and better affidavit of documents.²

Interrogatories as to common matter.

In a recent case, in which the defendants alleged that the type, shape, and pattern of pens and of the boxes containing them were common to the trade, interrogatories were allowed asking whether such matters were common to the trade.³

Disclosure of sales.

Discovery in regard to the sales effected by the defendant under the disputed mark is not, in general, where the infringement is denied, material, until the fact that the mark is an infringement of the plaintiff's rights has been decided;⁴ but where the giving of an account would occasion little trouble to the defendant, and may enable the plaintiff to get final judgment at the trial, without further inquiry, the judge, in his discretion, may order it to be given.⁴ In a case where the questions of fact had been

Discovery in aid of inquiry or account.

C. A.; and *The Attorney-General v. The North Metropolitan Tramways Co.*, [1892] 3 Ch. 70, North, J. Full discovery was ordered in *Howe v. McKernan*, 30 Beav. 547 (1862), Romilly, M.R., where the defendant was charged with advertising himself as the plaintiff's agent after the agency was determined.

¹ *Benedictus v. Sullivan, Powell & Co.*, 12 R. P. C. 25 (1895), Chitty, J. If the question had been relevant, the

plaintiff must have answered it.

² *Andrew & Co., Ltd. v. Kuehnrich*, 29 R. P. C. 698 (1912), C. A.

³ *Perry & Co., Ltd. v. Hessin & Co.*, 23 R. P. C. 108 (1911), Eve, J.; an interrogatory asking whether the labels on the boxes of certain of the plaintiffs' pens bore certain trade marks separately registered by the plaintiffs was disallowed.

⁴ *Benbow v. Low*, 16 C. D. 93 (1880), C. A. See also Ord. 31, r. 20, and the

ordered to be tried by a jury, such discovery was refused, before the trial, on the ground that the plaintiff had not elected whether to claim damages or an account of profits if he succeeded.¹ After an account of profits or an inquiry as to damages has been directed, discovery of the names and addresses of the persons to whom the marked goods were sold, or, if this cannot be had, of persons to whom goods—as to which the accounting party cannot swear that they were *not* marked with the objectionable mark—were sold, may be ordered.²

Inspection, &c.

The Court or a judge has wide powers, under Ord. 50, r. 3, to make any order for the detention, preservation, or inspection³ of any property or thing, being the subject of litigation, and to authorise any persons to enter upon or into any land or building in the possession of any party to the litigation, and, for all or any of the purposes aforesaid, to authorise any samples to be taken, or any observation to be made, or experiment to be tried, which may be necessary or expedient for the purpose of obtaining full information or evidence.

Under this power the Court could, for instance, authorise the plaintiff to inspect goods upon which he showed reasonable grounds for suspecting that a mark infringing his mark had been placed.⁴

The application is made in the Chancery Division by motion or summons; in the King's Bench Division by summons.⁵

note in the Annual Practice thereon. And for the decisions in patent cases, see Frost on Patents, 4th ed., p. 450, and *De la Rue v. Dickinson*, 3 K. & J. 388 (1857).

¹ *Fennessy v. Clark*, 37 C. D. 184 (1887), Kay, J., and C. A.

² *Leather Cloth Co., Ltd. v. Hirschfeld*, 1 H. & M. 295 (1863), Wood, V.-C.; *Powell v. Birmingham Brewery Co.*, 14 R. P. C. 1 (1897), Stirling, J., and C. A.; *Saccharin Corporation v. Chemicals and Drugs Co.*, [1900] 2 Ch. 556; 17 R. P. C. 612, C. A.

³ Sec. 21 of the repealed Merchandise Marks Act of 1869 gave jurisdiction to order inspection. As to the powers of justices to issue *search warrants* for goods by means of or in relation to

which an offence has been committed under the Merchandise Marks Act, 1887, see sec. 12 of that Act, p. 891. A person charged with an offence under the Act may find it necessary to show that "on demand made by or on behalf of the prosecutor he gave all the information in his power with respect to the persons from whom he obtained such goods or things": sec. 2 (2), and sec. 6. See Appendix, pp. 887 and 889.

⁴ Such inspection is frequently authorised in patent cases. See Frost on Patents, 4th ed. pp. 460 and 512; and *Neilson v. Betts*, L. R. 5 H. L. p. 11, per Ld. Westbury.

⁵ See the Annual Practice notes to Ord. 50, rr. 3 and 6.

Documents referred to in the pleadings, &c.

Production and inspection of copies of the trade marks, or of other documents which are referred to in any of the pleadings or affidavits of any of the parties in a case, may be obtained by giving notice in writing to such party to produce them, unless some cause or excuse for not complying with the notice is shown, which the Court or judge deems sufficient.¹

Evidence.

The Registrar's certificate, and sealed copies of the Register.

The registration of the plaintiff's mark, or the refusal to register it, is proved by the production of a certificate under the hand of the Registrar, and the actual terms of the registration, and proof of the mark itself as it is registered, are shown and given by the production of an extract or copy from the Register certified by the Registrar and sealed with the seal of the Patent Office.²

The request for the certificate should be made to the Registrar in writing, stating for what purpose it is required, in the form given in the second schedule to the Rules.³ It may be sent by post.⁴ The fee for a certificate for use in legal proceedings is one pound.

By sect. 50—

Copies of the Register.

“Printed or written copies or extracts of or from the Register, purporting to be certified by the Registrar, and sealed with the seal of the Patent Office, shall be admitted in evidence in all Courts in his Majesty's dominions, and in all proceedings, without further proof or production of the originals.”

And by sect. 51—

Registrar's certificates.

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

These sections correspond to secs. 89 and 96 of the Act of 1883.

¹ Ord. 31, r. 15. *Smith v. Harris*, 48 L. T. 869 (1889), Chitty, J. The learned judge refused to order barrels branded with the mark to be produced. See also *Wills' Tms.*, above, p. 521, note (6).

² Sec. 7, Chap. III., p. 67, and sec. 50, *infra*.

³ Rule 102, Form TM No. 34, Appendix, p. 761.

⁴ Rule 7.

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

Where the mark is registered, and the plaintiff is the registered proprietor, proof of the registration, and of the identity (if any question as to this is raised) of the registered proprietor with the plaintiff is *prima facie* evidence of the plaintiff's exclusive right to the use of the mark.¹ After seven years from the date of the original registration, or from the passing of the Act of 1905,² whichever shall last happen, the original registration is to be taken to be valid in all respects, subject to certain exceptions.³

Proof of title of registered proprietor ;

Registration is *prima facie* evidence of the validity of all assignments and transmissions of the trade mark,⁴ but if the plaintiff claims, by devolution or assignment, through the registered proprietor, he must prove the devolution or assignment by giving the proper evidence of the facts which effect it, and must prove in the same way that the goodwill of the business concerned has also devolved upon or been assigned to him.⁵

of title by assignment, &c. ;

The infringement must be proved by showing that the defendant, his servants, or agents, have dealt in, or threaten, or are about to deal in goods of the kind to which the plaintiff's trade mark rights extend, in such a manner as to infringe his trade mark.⁶

of infringement ;

The nature of the evidence which should be adduced to satisfy the Court that the defendant's mark has such a resemblance to the plaintiff's as to be calculated to deceive has already been discussed.⁷ It has been shown that the Court, in general, refuses to admit the mere statements of opinion by persons who are called as witnesses, to say that they think there is or there is not probability of deception.⁸ But a witness may be asked whether

of probability of deception.

¹ This is the combined effect of secs. 39 and 40, and is subject to certain limitations; see Chap. XII., Effect of Registration, above, p. 363 *et seq.*

² August 11th, 1905.

³ Sec. 41. See above, p. 368.

⁴ Sec. 39, above, p. 363.

⁵ Sec. 22, Chap. XIII., p. 385. As to registration of the assignment, see p. 398.

⁶ Above, p. 481.

⁷ Above, p. 444, and Chap. X., p. 260. In many of the reports in the

R. P. C. the nature of the evidence is very fully indicated; see, for instance, *Liebig's Co. v. Chemists' Society*, 13 R. P. C. 635, and the *Valentine and Payton* cases cited in the next chapter.

⁸ *Turton v. Turton*, 42 C. D. 149 (1889), C. A., "Compurgators," Fry, L.J. See also *Cope v. Evans*, L. R. 18 Eq. 138 (1874), Hall, V.-C.; and per Jessel, M.R., in *Thorn v. Worthing Skating Rink Co.*, 6 C. D. 415, n.; and *ante*, p. 281.

he would be deceived, and in an action to restrain the use of the Royal Arms, a question to a witness as to the conclusion in his mind arising from the Royal Arms being exhibited on the defendants' premises was held to be admissible.¹

The Registrar's books are not evidence that a mark is *publici juris*.

In *Orr-Ewing v. Johnston*,² Fry, J., held that the books kept by the Registrar of Trade Marks were not evidence, in an action for infringement, to show that marks like the plaintiff's mark were in common use and had been refused registration, and that the plaintiff's mark was consequently *publici juris*. The books were only evidence, the learned judge held, that other persons had made claims. Certified copies of entries actually made on the Register are, however, evidence of such entries, and if they show that three or more marks other than, but similar to, the plaintiff's have been registered for the same goods, that would, it is submitted, be evidence that the mark is a common mark.³

A commission to America to take evidence as to goods ordered from an American firm, who were joined as plaintiffs, in consequence of their advertisements in this country and as to the extent of advertisements sent to this country was refused by the Court of Appeal on the ground of expense, and as not being really necessary for the plaintiffs.⁴

¹ *Royal Warrant Holders' Association v. Deane and Beal, Ltd.* (1912), 1 Ch. 10, 28 R. P. C. 721.

² 13 C. D. at p. 442 (1879).

³ See the "Three Marks Rule,"

Chap. X., p. 249.

⁴ *Christy & Co. v. Tipper & Sons*, 21 R. P. C. 97 (1904), C. A., reversing Kekewich, J.

CHAPTER XVI.

THE ACTION FOR "PASSING-OFF."

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It is an actionable wrong for the defendant to represent, for trading purposes, that his goods are those or that his business is that of the plaintiff, and it makes no difference whether the representation is effected by direct statements, or by using some of the badges by which the goods of the plaintiff are known to be his, or any badges colourably resembling these, in connection with goods of the same kind, not being the goods of the plaintiff, in such manner as to be calculated to cause the goods to be taken by ordinary purchasers for the goods of the plaintiff. But this rule does not extend to prevent the defendant honestly trading under his own name,¹ or under the names of the members of his firm, or honestly describing his goods, and their place of origin, manner of manufacture, and other characteristics, in the ordinary terms current in his trade.

The question whether the use of particular words or badges is calculated to pass off the defendant's goods as those of the plaintiff, or is merely honestly descriptive, is often one of difficulty, but it is, in substance, a question of fact.

"The principle of law may be very plainly stated, that nobody has any right to represent his goods as the goods of somebody else. How far the use of particular words, signs, or pictures, does or does not come up to the proposition enunciated in each particular case must always be a question of evidence, and the more simple the phraseology, the more like it is to a mere description of the article sold, the greater becomes the difficulty of proof; but if the proof establishes the fact, the legal consequence appears to follow."²

The action to restrain the defendant from passing off his goods as the goods of the plaintiff is obviously the generalised form of the action to restrain the infringement of a trade mark;³ and the old principles from which the latter action grew up are still recognised and put into force by the Courts.⁴ The action for

Comparison with the action for the infringement of a trade mark.

¹ Below, p. 598. Can the use be said to be honest, after it is shown that the result is to lead to the belief that the defendant's goods are the plaintiff's?

² Per Halsbury, L.C., in *Reddaway v. Banham*, [1896] A. C. at p. 204; 13 R. P. C. at p. 224. See generally on the subject of this Chapter the summaries of the law by Kay and Lindley, LL.J., in *Powell v. Birmingham Vinegar Brewery Co.*, [1896] 2 Ch. 54; 13 R. P. C. 235; and *Ld. Davey in Cellular Clothing Co.*

T.M.

v. Maxton, [1899] A. C. at p. 343; 16 R. P. C. at p. 408, the first of which is printed in a note at the end of this Chapter. Leading American authorities are the *Amsteag Co. v. Spear*, 2 Sandf. S. C. 599 (1849); and *Lawrence Co. v. Tennessee Co.*, 138 U.S. 537 (1891).

³ See Chap. I., pp. 1 and 13, and Chap. XV., p. 421.

⁴ See Chapters I. and II., and the judgments of the C. A. in *Powell v. Birmingham Brewery Co.*, [1896] 2 Ch. 54;

infringement has been specialised, and the proof of the plaintiff's case in it greatly facilitated and simplified by the registration of trade marks and the provisions of the Acts; but the plaintiff's trade mark, although the most important, is only one of the badges by which his trade or his goods are, or may be, identified with him; and it is equally a wrong, according to the principles laid down in the judgments quoted in the Introduction, and in the cases last cited, to imitate or copy any of the others,¹—his trade name or the get-up of his goods, for instance,—so as to damage his trade by passing off other goods as his, or by leading his customers to suppose that there is a connection between such other goods and his business, which does not in fact exist.²

In a trade mark action the plaintiff must prove his title to the mark he claims, that it is registered as his mark or as the mark of his predecessor in business (unless the trade mark was in use before August 13th, 1875, and has been refused registration under the Act),³ and that the defendant has infringed the mark.⁴ And proof of the registration is, at least *primâ facie*, proof of title also. Further, if the mark has been actually or substantially copied, that constitutes an infringement, although it is not shown that the copy is calculated to deceive.⁵ In a passing-off action the plaintiff's case is very similar to this, but registration forms no part of it, and the plaintiff must prove by direct evidence that the conduct of the defendant is calculated to pass off the defendant's goods as his. To do so, he must show either that the defendant has actually represented that his goods or business are those of the plaintiff, or,—and this is the common case,—that he has used certain symbols or badges in connection with his goods or business, which are reputed in the market to import that the goods or business in connection with which they are used are the plaintiff's goods or business.

13 R. P. C. 235; *Lee v. Haley*, L. R. 5 Ch. 155 (1869), Malins, V.-C., and Giffard, L.J.; *Somerville v. Schembri*, 12 App. Ca. 453; 4 R. P. C. 179 (1887), P. C.; *Montgomery v. Thompson*, 41 C. D. 35; [1891] A. C. 217; 8 R. P. C. 361 (*Stone Ales*).

¹ "By the course of trade, by the existence and technology of trade, and by the mode in which things are sold, a man may utter that same proposition" (*i.e.*, that his goods are those of the plaintiff) "but in different words and

without using the name of the rival tradesman at all." Per Halsbury, L.C., in *Birmingham Brewery Co. v. Powell*, [1897] A. C. at p. 711; 14 R. P. C. at p. 728.

² See *Borthwick v. The Evening Post*, 37 C. D. 449 (1888), Kay, J., and C. A., cited below, p. 561, and sec. 45, above, p. 377.

³ Sec. 42, above, p. 373.

⁴ See the last Chapter, p. 431

⁵ See p. 441.

A plaintiff may, therefore, fail to make out a case of infringement of trade mark rights because he cannot prove his title to the trade mark, or its registration, or that its registration extends to the goods,¹ or to all of the goods,² in question, or because the registration is ordered to be annulled,³ and may yet show that by imitating the mark claimed as a trade mark, or otherwise, the defendant has done what is calculated to pass off his goods as those of the plaintiff. It follows that a case of "passing-off" is generally added as a second string to an action for infringement, and is frequently successful where the trade mark action proper breaks down.⁴

Nothing in the Trade Marks Act affects a trader's right against another in an action for passing-off. This is now expressly declared by sec. 45, but the law was the same under the earlier Acts.⁵ It is therefore no bar to an action for passing-off that the trade name, get-up, or any other of the badges identified with the plaintiff's business, which are alleged to have been copied or imitated by the defendant, might have been, but are not, registered under the Acts as trade marks,⁶ even though the evidence is wholly addressed to what may be a mark capable of registration.⁷ Such unregistered marks are frequently referred to as "common law trade marks."⁷

But a plaintiff who has raised no issue upon his pleadings

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

The two actions are frequently combined.

The Act affords no bar to a passing-off action.

Common law trade marks.

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

¹ *Hart v. Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J.

² *Jay v. Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.

³ *Lever v. Goodwin*, 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A.; *Montgomery v. Thompson*, 41 C. D. 35; 6 R. P. C. 404; [1891] A. C. 217; 8 R. P. C. 361, C. A. and H. L.; *Powell v. Birmingham Co.*, [1896] 2 Ch. 54; 13 R. P. C. 295; [1897] A. C. 710; 14 R. P. C. 720. The fact that a word which is *prima facie* descriptive has been removed from the Register is an element to be considered when it is alleged in a case for passing-off to be distinctive. The Court may infer that the registration (alone) has prevented other traders from using the name: *Hommel v. Bauer*, 21 R. P. C. 576; 22 *ib.* 43 (1904), Warrington, J., and C. A.

⁴ See the cases cited in the last three notes. *Barber v. Manico*, 10 R. P. C.

93 (1893), A. L. Smith, L.J.; and the judgment of Lindley, L.J., in *Reddaway & Co. v. Bentham Hemp Spinning Co.*, [1892] 2 Q. B. 639; 9 R. P. C. 503, C. A. (*Camel Hair Belting*). See also *Compania General de Tabacos v. Rehder*, 5 R. P. C. 61 (1887), Kay, J., and *Curtis and Harvey v. Pape*, 5 R. P. C. 146 (1887), North, J., where the trade mark questions were left undecided.

⁵ See pp. 450 and 451 of the 2nd ed., and *Faulder v. Rushton*, 20 R. P. C. 477 (1902), C. A. The question was argued in *Weingarten v. Bayer*, 20 R. P. C. 289, 649; 22 R. P. C. 341 (1905).

⁶ See above, Chap. XII., p. 377, and *Great Tower Street Tea Co. v. Langford & Co.*, 5 R. P. C. 65 (1887), Stirling, J.

⁷ *Reddaway & Co. v. Bentham Hemp Spinning Co.*, [1892] 2 Q. B. 639; 9 R. P. C. 503, Lindley, L.J.; *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L.J.

except in regard to the infringement of his trade mark has been refused leave to amend his claim at the trial so as to start a fresh case of "passing-off" in order to save his action.¹ In the case first cited in the note, however, leave was reserved to the plaintiffs to bring a fresh action to restrain the defendants from passing off their goods as the plaintiffs'. If a charge of fraud is to be made at the trial, it is essential that it should be put forward clearly and prominently on the pleadings.²

Thus, in a case in which the plaintiffs, whose dental impression composition was known as "Stents," complained of the get-up of the defendants' goods, including the use of the name "G. Stent," and it appeared that the defendants and their predecessors had used that name for many years, but Warrington, J., found that in the absence of any explanation of the origin of that user, it was to be presumed to be fraudulent in its inception, and he granted an injunction, the Court of Appeal held that the issue of fraudulent inception had not been raised by the plaintiffs on the pleadings, and that the defendants were therefore not challenged to give an explanation of the origin of the name, and that on the evidence the use by the defendants of the name "G. Stent" and of their get-up was not calculated to deceive, and the appeal was allowed; and this decision was affirmed by the House of Lords.³

Proof of
fraudulent
intention is
not essential.

Passing-off cases are often cases of deliberate and intentional misrepresentation, and they have been treated in many reported judgments, even in recent cases, in which the attention of the Court was not directed to the point, as though fraud were a necessary element of the right of action; but it is well settled that this is not the case.⁴ In an action to restrain passing-off,

¹ *Native Guano Co. v. Sewage Manure Co.*, 4 R. P. C. 478; 8 R. P. C. 125 (1887), Kay, J., C. A. and H. L. Leave was granted, the defendants not objecting, in *Jay v. Ladler*, 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.; and also in *Barber v. Manico*, supra, where the defendants raised the objection. But see *Andrew & Co. v. Kuehnrich*, 30 R. P. C. 93 (1913), where at the trial the plaintiffs were given leave to amend so as to claim clearly for infringement as well as passing-off; see also Addenda.

² *Leahy, Kelly and Leahy v. Glover*, 10 R. P. C. 141 (1893), H. L.

³ *Claudius Ash, Sons & Co., Ltd. v.*

Invicta Manufacturing Co., Ltd., 28 R. P. C. 252 and 597; 29 R. P. C. 465 (1912).

⁴ *Singer Manufacturing Co. v. Wilson*, 3 App. Ca. 376 (1877), Cairns, L.C., cited above, p. 13; *Johnston v. Orr-Ewing*, 7 App. Ca. 219 (1882); *Singer Manufacturing Co. v. Loog*, 8 App. Ca. 15 (1882); *Reddaway v. Bentham*, [1892] 2 Q. B. 639; 9 R. P. C. 503, C. A.; *Saxlehner v. Apollinaris Co.*, [1897] 1 Ch. 893; 14 R. P. C. 645, Kekewich, J.; and see the judgments of Cotton, L.J., in *Borthwick v. The Evening Post*, 37 C. D. 449 (1888); and *Turton v. Turton*, 42 C. D. 128 (1889), cited below, p. 603.

proof that the defendant intended to deceive, if his conduct is shown to be calculated to pass off his goods as those of the plaintiff, or to cause them to be so passed off, is no more necessary than in an action for infringement.¹ And if it were necessary, it would be sufficient evidence of fraud to show that the defendant continued, or sought to continue, to use the deceptive badges or descriptions, after the danger of mistake arising from their use had been brought to his notice.² For it has never been held that innocent inception is a defence.³ Proof of fraudulent intention may, however, materially assist a plaintiff in establishing probability of deception.⁴

It is obvious, therefore, that a trader has much the same right in respect of his trade name, the get-up of his goods, and all the other distinctive badges and descriptions by which goods are known to be his, as he has in respect of his trade marks, although the latter right is called a right of property, and the former is commonly, but not invariably,⁵ denied that title.⁶ There are,

Property
in trade
names and
get-up.

and Halsbury, L.C., in *Cellular Clothing Co. v. Maxton*, [1899] A. C. at p. 334; 16 R. P. C. at p. 404; *Chivers & Sons v. Chivers & Co., Ltd.*, 17 R. P. C. 420 (1900), Farwell, J.

¹ Chap. XV., p. 446. *Carr & Sons v. Crisp*, 19 R. P. C. 497 (1902), Byrne, J.; *Birmingham Small Arms Co. v. Webb*, 24 R. P. C. 27 (1907). This rule was too well settled to be disturbed by the judgments in *Derry v. Peek*, 14 App. Ca. 337 (1889), although it originally rested upon the extension of the action of deceit to cases where there was no intentional deception, which was reprobated in that case. Although in some judgments actions for passing-off have been referred to as actions for deceit, e.g., as by Vaughan Williams, L.J., in *Jamieson v. Jamieson*, 15 R. P. C. at p. 191, and by the C. A. in *London General Omnibus Co. v. Lavell*, [1901] 1 Ch. 135, they are not actions for deceit in the ordinary sense, i.e. actions brought to recover damages for a fraudulent misrepresentation made to the plaintiff. See also the judgment of Farwell, J., in *Bourne v. Swan and Edgar, Ltd.*, [1903] 1 Ch. 211, and 20 R. P. C. 105.

² See p. 447, above; and *Chivers v. Chivers*, p. 532, note (4).

³ *Paine & Co. v. Daniells & Sons' Breweries*, [1893] 2 Ch. 567; 10 R. P. C. 217, C. A.

⁴ Below, p. 583.

⁵ *Clements v. Maddick*, 1 Giff. 98 (1859), Stuart, V.-C.; *Borthwick v. The Evening Post*, 37 C. D. 449 (1887), Kay, J., property in the name of a newspaper. But see *Outram & Co., Ltd. v. London Evening Newspapers Co., Ltd.*, 28 R. P. C. 308 (1911). "There is no property in a name," per Warrington, J. Cf. p. 542, note (1), below.

⁶ See per Ld. Blackburn in *Singer Manufacturing Co. v. Wilson*, 3 App. Ca. p. 400. In *Reddaway v. Banham*, [1896] A. C. at p. 209; 13 R. P. C. 228, Ld. Herschell said that he doubted whether it was accurate to speak of there being property in such a trade mark (i.e., a common law trade mark), though no doubt some of the incidents which are incident to property might attach to it, especially if it was such as to be capable of no conceivable legitimate use except by the proprietor. In *Jamieson & Co. v. Jamieson*, 15 R. P. C. at p. 191, Vaughan Williams, L.J., said it was wrong to assume that a trader acquired some sort of property in his trade name or its use, and that the action is one of deceit.

however, important practical differences between the two rights. A trade mark being deliberately assumed or invented as a distinctive mark to identify the goods of its proprietor because of its supposed fitness for the purpose, could hardly be adopted by any other trader in the same market for similar goods without its use by him being calculated to deceive. But the other badges and descriptions referred to, although by use they may become more or less identified with the trader who used them first or most extensively, may have been adopted merely for purposes of convenience or of ornament, and may have been suggested by the circumstances of the trade in question, or of the trader himself; and the same considerations or circumstances may suggest the use of the same badges and descriptions to others also,¹ and their use of them will not necessarily be calculated to deceive. The cases in which a defendant can plead an independent right to the use of badges or descriptions which are not trade marks,—for instance, to the use of the same trade name as the plaintiff,—are much more important than the rare cases in which he can claim a right to use the trade mark of the plaintiff or a trade mark closely resembling it.²

Inferiority of the spurious goods need not be shown.

It is immaterial to the existence of the plaintiff's right of action that the goods passed off as his are as good as or better than his own;³ but it would seem that if they are not inferior no case of damage by injury to the plaintiff's trade reputation could be made out.

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

It will be seen from the definition placed at the beginning of the chapter, and the comparison of the two actions in the preceding pages, that the rules and principles relating to the action of infringement which are collected in the last chapter, in general apply also to the action for "passing-off," substituting proof of repute for evidence of title and registration. The defences available, the relief granted, and the practice and procedure in both actions are substantially the same.

¹ Or to customers of other traders, as for instance in the *Dolly Blue* case, *Edge v. Gallon*, 17 R. P. C. 557 (1901), H. of L.

² See per Cotton, L.J., in *Turton v. Turton*, 42 C. D. p. 142, and Chap. XV., p. 456; and the last note.

³ *Blofield v. Payne*, 4 B. & Ad. 410; 2 L. J. K. B. (N. S.) 68 (1839); *Edelsten v. Edelsten*, 1 De G. J. & S. 185 (1863), Westbury, L.C.; per Ld. Blackburn, in *Singer Manufacturing Co. v. Loog*, 8 App. Ca. p. 29. See last Chapter, p. 432.

1. Direct Misrepresentation as to Business or Goods.

Where there is a direct misrepresentation by the defendant that the goods he sells are the goods of the plaintiff, the case presents no difficulty.

Thus, in *Ainsworth v. Walmsley*,¹ it was shown that the defendant had sold certain spools of thread wound and marked like the plaintiff's thread, with a representation that it was of the plaintiff's make. The defendant asserted that he had himself bought it on a like representation, which he believed, and that he had disclosed the source through which he himself obtained the goods, and his assertion was not disproved. The Vice-Chancellor accordingly dismissed the suit, for if the defendant in fact believed that the thread was the plaintiff's thread, he had committed no act of which the plaintiff could complain. Had he known it was not, or threatened to repeat the representation when he knew that it was untrue, there would have been a clear case for an injunction. "The use (by one manufacturer) of the name of another manufacturer," the Vice-Chancellor said, "whether *scienter* or not, is an interference with his business which this Court will interpose to prevent, on the ground that the defendant is endeavouring to pass off the goods of his own, or somebody else's, manufacture, as the manufacture of the plaintiff." But he added, "Taking the case most strongly against the defendant, it merely amounts to this, that Walmsley stated to the purchaser, 'I sell you thread which I have bought of Wreford, but which I know to be Ainsworth's.'"

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

But no action lies for passing off the defendant's goods as "similar to" those of the plaintiff,² or with a representation that they are better than his,³ even though the statements complained of are untrue and injurious to the plaintiff.⁴

"Similar to."

Cases in which the defendant directly represents that his business is the plaintiff's business, or a branch of it, or connected

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

¹ L. R. 1 Eq. 518 (1866), Wood, V.-C. Upon the facts proved the plaintiff would probably succeed at the present day. The Vice-Chancellor treated the representation as practically equivalent to a warranty to the purchaser and no more. Cf. the defence of "acting innocently" under the Merchandise Marks Act, 1887, sec. 2 (2) (c), *Christie v. Cooper*, [1900] 2 Q. B. 522; *Thwaites v. M'Evilly*, 21 R. P. C. 397 (1904), C. A.,

Ireland; and *Stone v. Burns*, 108 L. T. 540; 74 J. P. 456 (1910), Div. Ct.

² *Magnolia Metal Co. v. Tandem Smelting Syndicate*, 15 R. P. C. 701; 17 R. P. C. 477 (1900), C. A. and H. L. Cf. *Burberrys v. Raper*, 23 R. P. C. 170 (1906), Warrington, J., "identical with."

³ *White v. Mellin*, [1895] A. C. 154.

⁴ *Hubbuck v. Wilkinson*, [1899] 1 Q. B. 86, C. A., and see cases last cited.

with it¹ are equally clear as soon as the false representation is made out.

False pre-
tence of a
business
connection.

A partner or servant who has left a well-known firm and set up a similar business of his own, is entitled to advertise his former connection,² unless restrained from doing so by contract with his late partners or employers;³ but he must take care to do it so as not to suggest that the connection is still existing between them and him,⁴ or that they have ceased to carry on business and he is their successor.⁵

And the same rule holds good of a trader who,⁶ or whose trustee in bankruptcy,⁷ has sold the goodwill of his business.

False repre-
sentation of
succession to
business.

"Late."

Thus, where the son of the plaintiff quitted his father's employment, and described himself as "late of 107, Strand,"⁴ an injunction was granted to restrain him from continuing to do so. So, in *Scott v. Scott*,⁸ a doorplate, bearing the words "Scott and Nixon, late Robert and Walter Scott," was held to be a representation that Walter Scott had retired, and that Scott and Nixon were carrying on the business of his old firm.

And in a case where no such connection as those above referred to had ever existed between the defendants and the plaintiffs, but the defendants, having obtained a lease of clay mines formerly leased to the plaintiffs, described themselves in advertisements, referring not only to the mines, but to certain works also, where they carried on a trade similar to that of the plaintiffs, as *E. and J. Pearson (late Harpers and Moore)*, the description was held to be a representation calculated to lead the public to believe that the plaintiffs, Harpers and Moore, had retired from business.⁹

¹ *Walter v. Ashton*, [1902] 2 Ch. 282.

² *Clark v. Leach*, 32 Beav. 14; 1 De G. J. & S. 409; 32 L. J. Ch. 290 (1862), Romilly, M.R., and Westbury, L.C.

³ As in *Wolmershausen v. O'Connor*, 36 L. T. (N. S.) 921 (1877); and *Selby v. The Anchor Tube Co.*, W. N. (1877), 191, both Bacon, V.-C., where the style and goodwill passed, under the articles, to one partner on a dissolution. A servant must not use information acquired in his employment to enable him to solicit his master's customers to deal with him after he has left the employment: *Robb v. Green*, [1895] 2 Q. B. 1, 315, Hawkins, J., and C. A. As to sales of goodwill, see below, p. 589.

⁴ *Burgess v. Burgess*, 3 De G. M. &

G. 896; 22 L. J. Ch. 675 (1853), Kindersley, V.-C., and L.JJ.; *Van Oppen v. L. Van Oppen*, 20 R. P. C. 617 (1903), Eady, J., and see p. 409.

⁵ See the cases next cited, and *La-bouchere v. Dawson*, L. R. 18 Eq. 322 (1872), Romilly, M.R.

⁶ *Churton v. Douglas*, Johns. 174; 23 L. J. Ch. 841 (1859), Wood, V.-C.; *Fullwood v. Fullwood*, W. N. (1873), 93 and 185, Malins, V.-C., and L.JJ. See this further discussed below, p. 590.

⁷ *Hudson v. Osborne*, 39 L. J. Ch. 79 (1869), James, V.-C. See further, as to this, below, p. 591.

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

⁹ *Harpers v. Pearson*, 3 L. T. (N. S.)

So where the plaintiff and defendant were carrying on business as rival dentists in the same street, and, on the expiration of his tenancy, the plaintiff was compelled to remove, and the defendant put up a board describing himself as the "old-established dentist," this was held to be a representation that the plaintiff had removed to the defendant's place of business. An interim injunction would have been granted had the defendant not undertaken to put his name very conspicuously upon the board.¹

Description of new-comer as "the old-established."

Another description of false representation of a business connection which sometimes comes before the Courts, is where the defendant has pretended to be agent for the sale of the plaintiff's goods.²

Pretence of agency.

The fraud is commonly effected by issuing misleading circulars or advertisements,³ or by placing the deceptive name or title on the fascia over the defendant's shop,⁴ and by opening and replying to letters addressed to, or intended for, the plaintiff, and executing the orders contained in them;⁵ or some one or more of these devices.

Deceptive circulars.

Names over shops.

Executing orders intended for the plaintiff.

As further examples of misrepresentation, not included in the classes considered below, may be mentioned claims to medals, prizes, &c., which, in fact, have been gained by the plaintiff,⁶ or

Claim to the prizes, medals or patents of another.

547 (1860), cited above, p. 426; *Stevens v. Paine*, 18 L. T. (N. S.) 600 (1868), Giffard, V.-C., and cf. *Townsend v. Jarman*, 17 R. P. C. at 657 (1900), Farwell, J.

¹ *Mallam v. Davis*, 3 Times L. R. 221 (1887), Stirling, J.

² *Howe v. McKernan*, 30 Beav. 547 (1862), Romilly, M.R. (discovery ordered); *Wheeler and Wilson Co. v. Shakespear*, 39 L. J. Ch. 36 (1869), James, V.-C. (injunction granted).

³ As in *Purser v. Brain*, 17 L. J. Ch. 141 (1848), Shadwell, V.-C.; *Burrows v. Foster*, 32 Beav. 18 (1862), L.JJ.; *Graveley v. Winchester*, Seton, 7th ed. 682; Sob. Dig. p. 162 (1867), Wood, V.-C. (circulars ordered to be given up); *Stevens v. Paine*, 18 L. T. (N. S.) 600 (1868), Giffard, V.-C.; *Scoby v. Anchor Tube Co.*, W. N. (1877), 191, Bacon, V.-C. (defendants restrained from soliciting or executing orders obtained by the misrepresentations); *Mogford v. Courtenay*, 45 L. T. (N. S.) 303; *Vernon v. Hallam*, 34 C. D. 748

(1886), Stirling, J.; and see *Townsend v. Jarman*, [1900] 2 Ch. 698; 17 R. P. C. 649.

⁴ *Fool v. Lea*, 13 Ir. Eq. 484 (1850), Smith, M.R.; *Burgess v. Burgess*, 3 De G. M. & G. 896; 22 L. J. Ch. 675 (1853), Kindersley, V.-C., and L.JJ.; *Scott v. Scott*, 16 L. T. (N. S.) 143 (1866), Wood, V.-C. (door plate); *Hookham v. Pottage*, L. R. 8 Ch. 91 (1872), Malins, V.-C., and L.JJ. As to the purchase of a building with the vendor's name built into it, see *Townsend v. Jarman*, note (3), and *Boussod, Valadon & Co. v. Marchant*, 25 R. P. C. 42 (1908), C. A. As to names of places of business, see p. 559.

⁵ *Schiele v. Brackell*, 11 W. R. 796 (1863); Seton, 7th ed. 673, Stuart, V.-C.; *Edgington v. Edgington*, 10 L. T. (N. S.) 299 (1864), Wood, V.-C. (a single instance proved, injunction refused); *Witt v. Concoran*, 2 C. D. 69 (1873), Bacon, V.-C.; *Townsend v. Jarman*, note (3).

⁶ *National Starch Co. v. Munn's Patent Maizena Co.*, [1894] A. C. at

to patents under which he, and not the defendant, is working.¹ Such claims may enable a rival to pass his goods or business off as those of the person who is really entitled to the medals, prizes, or patents. Where they are not calculated to produce such a result, no case can be made.²

Unauthorised
use of the
name of a
non-trader.

In the old case of *Clark v. Freeman*,³ Lord Langdale, M.R., refused to restrain the defendant from selling a quack medicine as "Sir J. Clarke's Consumption Pills," at the instance of the Sir J. Clark referred to, who was an eminent physician, on the ground that the plaintiff carried on no business in pill-making, and that the wrong done to him was a libel only, which the Court of Chancery had no jurisdiction to restrain.⁴ It has always been considered⁵ that a narrow view was taken of the facts of this case, as the sale of pills under a well-known doctor's name is eminently calculated to suggest that the pills are prepared according to his directions, and to injure his practice if they do not meet with a favourable reception by purchasers who are, or who might become, his patients; but, in a similar case, *Kay, J.*, refused to treat the older authority as no longer law, at least, upon an interlocutory application.⁶

System of
advertising.

The mere adoption by one person of a system of advertising

p. 281, P. C.; 11 R. P. C. 294; *Franks v. Weaver*, 10 Beav. 297; 8 L. T. (O. S.) 510 (1847), Ld. Langdale; see note (2), and below, p. 586. In *King v. Gillard*, 22 R. P. C. 327 (1905), C. A., the defendant's representations as to medals, &c., were held at the trial to be untrue, and they were for that reason deprived of costs. In the Court of Appeal, however, the decision on this point was reversed. The medals, &c., had been awarded to the defendants, but not for the goods in question.

¹ *Lawrie v. Baker*, 2 R. P. C. 218 (1885), Day, J.; *Pneumatic Rubber Stamp Co. v. Lindner*, 15 R. P. C. 525 (1898); see also *Paine & Co. v. Daniells & Sons' Breweries*, cited above, p. 442.

² *Tallerman v. Dowsing Radiant Heat Co.*, [1900] 1 Ch. 1, Stirling, J. A medicine vendor published as his own testimonials sent to another. There was no probability of deception. Interlocutory injunction refused. An appeal in this case was compromised. See also *Batty v. Hill*, 1 H. & M. 264;

8 L. T. (N. S.) 791. As to medals and certificates at the Exhibitions of 1851 and 1862, see 26 & 27 Vict. c. 119, below, p. 900. Cf. also *Ajello v. Worsley*, [1898] 1 Ch. 274.

³ 11 Beav. 112; 17 L. J. Ch. 142 (1848).

⁴ As to this, see *Bonnard v. Perryman*, [1891] 2 Ch. 269; *Collard v. Marshall*, [1892] 1 Ch. 571; and *Monson v. Tussaud*, 10 Times L. R. 227 (1894).

⁵ Lord Selborne said the case had seldom been cited except to be disapproved: *Re Rivière's Tm.*, 26 C. D. 48 (1884). See also *Maxwell v. Hogg*, L. R. 2 Ch. 307 (1867), Ld. Cairns; *Springhead Spinning Co. v. Riley*, L. R. 6 Eq. 551 (1868), Malins, V.-C. Cf. the case of the name of a private house, below, p. 560. As to authors' names, see p. 577, below.

⁶ *Williams v. Hodge*, 4 Times L. R. 175 (1887). Kekewich, J., did so in *Lee v. Gibbings*, 67 L. T. 263 (1892). But see *Dockrell v. Dougall*, 80 L. T. 556 (1899), C. A.

similar to that used by a rival trader will not support a passing-off action;¹ nor will the adoption of a similar system of window-dressing or decoration of a shop, if only used to attract custom and not to divert customers from the plaintiff's shop.²

Passing off one class of a manufacturer's goods for a superior class of his goods will be restrained by injunction.³ But in order to establish such a case, there must be a definite superior class of article for which the goods of the other class are passed off.⁴

Passing off one quality of goods for another.

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

Actions based upon direct misrepresentation are comparatively rare. The plaintiff's case more commonly is that the defendant has copied or imitated the trade name, the unregistered trade mark, or the get-up, or some other badge or description by which the plaintiff's business and goods are known to be his. Where the charge is one of indirect misrepresentation of this sort, the onus is cast upon the plaintiff, in the first place, to show that the things copied or imitated are reputed in the market to denote a connection between himself or his predecessors in business, and the business or goods in, upon, or in reference to which they are used. And this is precisely the proof which the plaintiff had to adduce in trade mark actions before the Acts. So far as regards marks applied or attached to the goods themselves, it has been considered, and the authorities relevant to it have been collected in a previous chapter.⁵ In a label or get-up in which there is common matter, the plaintiff must show that the defendant has taken something that is distinctive of the plaintiff's goods.⁶

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

It is not, however, necessary to show that the customers who knew the goods of the plaintiff's firm by a particular name or get-up knew anything whatever about the plaintiff. It is

The plaintiff himself may be unknown.

¹ *Wertheimer v. Stewart, Cooper & Co.*, 23 R. P. C. 481 (1906), Kekewich, J.

² *Plotzker v. Lucas*, 24 R. P. C. 551 (1907), Mackenzie, L. O., Scotland.

³ *Jameson & Son, Ltd. v. Clarke*, 19 R. P. C. 255 (1902), Ireland, Chatterton, V.-O.; *Teacher v. Levy*, 23 R. P. C. 117 (1906), Swinfen Eady, J.; also *Spalding v. Gamage*, 30 R. P. C. 388 (1913), Sargant, J. (not yet reported).

⁴ *Hunt, Roope, Teage & Co. v. Ehrmann Bros.*, [1910] 2 Ch. 198; 27 R. P. C. 512; and see *Burgoyne & Co., Ltd. v. Godfree*, 22 R. P. C. 168 (1908), C. A., judgment of Romer, L.J., at p. 173.

⁵ Definition of a trade mark, Chap. II., p. 24; *Lawson v. The Bank of London*, 18 C. B. 84; 25 L. J. C. P. 188 (1856).

⁶ See below, p. 578.

immaterial that they did not even know his name;¹ for it is sufficient to prove that purchasers of his goods recognised, by the use of the marks in question in connection with them, that they were goods of a particular class, and to show that such class is, in fact, constituted by his goods.

Thus, in the much contested *Yorkshire Relish* case,² the plaintiff's sauce was made according to a secret recipe, and was always bought and sold by the name alone. The defendants made a sauce described as a "wonderful match" of the plaintiff's, and their contention was that the public knew and cared nothing about the actual manufacturer, but wanted only the sauce known as *Yorkshire Relish*. The contention failed. Lord Herschell said of it in the House of Lords: "I think that the fallacy of the appellant's argument rests on this: that it is assumed that one trader cannot be passing off his goods as the manufacture of another unless it be shown that the persons purchasing the goods know of the manufacture by name, and have in their mind when they purchase the goods that they are made by a particular individual. It seems to me that one man may quite well pass off his goods as the goods of another, if he passes them off to people who will accept them as the manufacture of another, though they do not know that other by name at all. In the present case it seems to me that *Yorkshire Relish* meant the manufacture of a particular person."³

And in *Edge v. Niccolls*,⁴ where the plaintiff succeeded on get up, the plaintiff's name did not appear on their blue, but it was shown that to many purchasers their name was not known, and that purchasers of the poorer classes distinguished the plaintiff's goods by their general appearance.

Evidence of
repute
essential.

Where the existence of such repute is not shown, the action cannot succeed.⁵ Thus, in a case where the plaintiff claimed only as the mortgagee of a business and its trade name, and had never used, and did not intend to use, the trade name,⁶ and in a case in which the plaintiffs were carrying on no business in

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

² *Powell v. The Birmingham Brewery Co.*, [1896] 2 Ch. 54; 12 R. P. C. 720, and p. 37, above.

³ [1897] A. C. at p. 715

⁴ [1911] A. C. 693; 28 R. P. C. 582.

⁵ *Goodfellow v. Prince*, 35 C. D. 9 (1887), C. A.; *Fels v. Christopher Thomas*, 21 R. P. C. 85 (1903), C. A. (*Naphtha Soap*).

⁶ *Beazley v. Soares*, 23 C. D. 660 (1882), Pearson, J.; cf. *Clark v. Freeman*, above, p. 538.

England,¹ the actions were dismissed. But where the plaintiffs had no place of business in England, but their goods were imported by purchasers with the consent of the owners of the English patents, it was held that they had a reputation and market in England which the Court would protect.² No length of time during which the use of the badges in question by the plaintiff or his predecessors must have extended can be laid down,³ although it seems safe to assume that an actual and practical knowledge of the connection between them and him by a number, apparently considerable, of probable dealers in, or purchasers of, the goods must be shown, and, accordingly, that a name, get-up, or other badge just adopted and brought into use would not now be protected, as a newly adopted trade mark would have been before the Registration Acts,⁴ and would be now, if registered. On the other hand, it is not necessary that the association of the plaintiff's mark with his goods should be known all over the kingdom, or to every person in the area where it is known best.⁵

It has been held that three days' use of the name of a new weekly newspaper, of which fifteen copies had been sold (before the defendant's publication began), was not sufficient to give the owners any right to stop other persons using the same name for a rival paper.⁶

The reputed connection must be a connection of the trade or the goods, in or with which the name, get-up, or other badges are used, with the plaintiff himself, or else with his predecessors

¹ *Robineau v. Charbonnel*, W. N. (1876), 160, Malins, V.-C. The plaintiffs were confectioners (*querc* dress-makers) in Paris, having no agency in England. Held, no probability of injury.

² *Société Anonyme Panhard et Levassor v. Panhard Levassor Motor Co., Ltd.*, [1901] 2 Ch. 513; 18 R. P. C. 405, Farwell, J.

³ This was stated to be a question for a jury in the old case of *Purser v. Brain*, 17 L. J. Ch. 141 (1848), Shadwell, V.-C. (*The London Manure Co.*).

⁴ *Maxwell v. Hogg*, L. R. 2 Ch. 307 (1867), L.J.J.; *Hall v. Barrows*, 32 L. J. Ch. 548 (1863), Romilly, M.R.; *McAndrew v. Bassett*, 33 L. J. Ch. 561 (1864), Wood, V.-C., ante, p. 54.

⁵ *Faulder v. Rushton*, 20 R. P. C.

477 (1902), C. A. (*Silverpan Jam*); *Weingarten v. Bayer*, 20 R. P. C. 289, 649; 22 *ib.* 341 (1905), H. of L.; *Wurm v. Webster*, 21 R. P. C. 373 (1903), Kekewich, J. (*White Viennese Band*). And below, p. 567, area, and p. 565, secondary distinctive meaning. The question of the extent and area of user necessary to enable a mark to be registered as a distinctive trade mark has been considered above, p. 190.

⁶ *Licensed Victuallers' Newspaper Co. v. Bingham*, 38 C. D. 139 (1888), North, J., and C. A.; Cotton, L.J., said that the larger sale of the plaintiff's paper subsequently to the adoption of the defendant's name was immaterial; cf. *Maxwell v. Hogg*, supra, and p. 35, above.

Assignment and devolution of trade name, &c.

as owners of the business in which he is at the time of action using, or intending to use them. And trade names may be assigned and may devolve in connection with the goodwill of the business.¹ The rules in regard to assignment already discussed in relation to trade marks² apply, therefore, to trade names and similar matters, for if the things which the defendant has copied or imitated denote a connection, not with the plaintiff, but with some one else, he can have no claim to sue in respect of the deception which, as he alleges, the defendant's use of them is calculated to occasion. Thus, in *Pinto v. Badman*, the jury at the trial found, upon the same facts, that the defendant had both infringed the plaintiff's trade mark, and had passed off his goods as those of the plaintiff. On the appeal it appeared that the label and brand copied by the defendant had, not long before the commencement of the action, been assigned, without the business with which they were connected, by certain third parties to the plaintiff. Upon this ground the Court of Appeal set aside the verdict and entered judgment for the defendants, notwithstanding the finding as to "passing-off."³ And neither a licence to use, nor an absolute assignment of a trade name without the goodwill of the business to which it was attached, entitles the licensee or assignee to sue in respect of the use of the name by another trader.⁴

The question as to repute is not generally considered separately.

The question of repute is, however, rarely considered separately,⁵ for, as a right of property in respect of the exclusive use of marks or badges other than registered trade marks (and, to some extent, the trade name of the plaintiff) is not recognised, it is generally more convenient to deal directly with the general

¹ "I think it is settled by a series of cases, of which *Hall v. Barrows*" (p. 541, note (4)) "is, I think, the leading one, that both trade marks and trade names are, in a certain sense, property, and that the right to use them passes with the goodwill of the business to the successors of the firm which originally established them, even though the name of that firm be changed, so that they are no longer strictly correct": per Ld. Blackburn, in *Singer Manufacturing Co. v. Loog*, 8 App. Ca. p. 38 (1882). See above, p. 533, n. (6).

² Chap. XIII., p. 384.

³ 8 R. P. C. 181 (1891). The case,

so far as regards passing-off, was not expressly referred to in the judgments, but the principles stated were as applicable to that as to the case for infringement.

⁴ *Thorneloc v. Hill*, [1894] 1 Ch. 569; 11 R. P. C. 61, Romer, J. (*John Forrest*). It follows that the mere right to use a name cannot be sold; see below, p. 556.

⁵ It arose in *Dental Manufacturing Co. v. De Trey*, [1912] 3 K. B. 76; 29 R. P. C. 617, where it was held on the facts that the get-up was not associated with the sole importer of the goods, but with the manufacturer.

question: Is the defendant's conduct calculated to pass off his goods as those of the plaintiff? ¹

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

A. The Plaintiff's Trade or Firm Name.

A man's own name, or the name under which he trades, may be an ordinary trade mark, if used as such, that is, applied or attached to the goods in which he deals.² If it is represented in a special or particular manner, or in the form of the signature of the applicant or some predecessor in his business, it may be entered upon the Register.³ But, although it is not so used or registered, and therefore does not become a trade mark, its use by the defendant for trading purposes in connection with goods which are not the plaintiff's is obviously calculated to mislead, unless it happens to be the name of the defendant also, or a name under which he is entitled to trade.⁴

The ground upon which the Court acts in protecting a trade name was stated by James, L.J., in *Levy v. Walker*⁵ in the following passage: "It should never be forgotten that in these cases the sole right to restrain anybody from using any name he likes in the course of any business he chooses to carry on is a right in the nature of a trade mark, that is to say, a man has a right to say, 'You must not use a name, whether fictitious or real—you must not use a description, whether true or not, which is to represent, or calculated to represent, to the world that your business is my business, and so, by a fraudulent⁶ misstatement, deprive me of the profits of the business which would otherwise come to me.' An individual plaintiff can only proceed on the ground that, having established a business reputation under a particular name, he has a right to restrain anyone else from injuring his business by using that name."⁷

Principle on which a trade name is protected.

¹ See *Jamieson & Co. v. Jamieson*, 15 R. P. C. 169 (1898), in the C. A. p. 593, below.

² See Chap. II., p. 24.

³ Sec. 9 (1) and (2), Chap. VIII., pp. 145 and 149.

⁴ See per Wood, V.-C., *Ainsworth v. Walmsley*, L. R. 1 Eq. 518 (1866), and

⁵ 10 C. D. p. 447 (1879). And see *Mrs. Pomeroy, Ltd. v. Scalé*, 24 R. P. C. 177 (1907).

⁶ See above, pp. 14 and 532.

⁷ Cf. *Ld. Chelmsford's* statement in *Du Boulay v. Du Boulay*, L. R. 2 P. C.

In the case of *Society of Accountants and Auditors v. Goodway*,¹ the question arose whether the plaintiff society could sue to restrain non-members from using a name which was calculated to represent them as being members of it, and it was held that it suffered a legal injury thereby, inasmuch that it was a matter of pecuniary value to the society to have as many members as possible, and that the acts complained of by reducing its status might affect the number of its members.

It may belong to others beside the plaintiff.

The name taken or copied by the defendant need not be that under which the plaintiff alone, and no other person, is properly trading. Thus, in *Dent v. Turpin*,² Wood, V.-C., held that each of two firms carrying on business separately as watchmakers under the name *Dent* might sue a third person, who had set up a similar business under the same name, for an injunction, delivery up of the marked articles, and an account of profits.³ But if the name in question is properly used by more than one person the difficulty of showing that its use by the defendant is calculated to cause his goods to be taken for those of the plaintiff may be greatly increased.⁴

p. 441 (1869): "The right to the exclusive use of a name in connection with a trade or business is familiar to our law; and any person using that name after a relative right of this description has been acquired by another is considered to have been guilty of a fraud, or, at least, of an invasion of another's right, and renders himself liable to an action, or he may be restrained from the use of the name by injunction"; and *Clark v. Freeman*, cited ante, p. 538; see also the judgments of James, L.J., and Jessel, M.R., quoted above, pp. 1 and 13.

¹ [1907] 1 Ch. 489; 24 R. P. C. 159, a similar decision was given in Scotland in *Society of Accountants in Edinburgh v. Corporation of Accountants, Ltd.*, 20 R. 750. See also *Tones and Moore v. Merchant Service Guild, Ltd.*, 25 R. P. C. 474 (1908), Neville, J., an action brought on behalf of the members of the *Imperial Merchant Service Guild* (usually known as the *Merchant Guild*) to restrain the use of the name "Merchant Service Guild," or the initials M.S.G., in which an interlocutory in-

junction was granted. In *Society of Architects v. Kendrick* (1910), W. N. 113; 102 L. T. 526; 26 T. L. R. 433, Joyce, J., refused, in an undefended case, to grant an injunction to restrain the defendant from using the letters "M.S.A.," meaning, as was alleged, a member of the plaintiff society. He said that the principle was not one which ought to be extended.

² 2 J. & H. 139; 30 L. J. Ch. 495 (1861); *Southorn v. Reynolds*, 12 L. T. (N. S.) 75 (1865), Wood, V.-C. See also per Ld. Watson during the argument in *Powell v. The Birmingham Brewery Co.*, 14 R. P. C. at p. 726. The action in *Jamieson & Co. v. Jamieson*, 15 R. P. C. 169 (1898), failed because the defendant had not used anything identified with the plaintiffs (p. 182), not because there were other Jamiesons in the trade at Aberdeen. See the *Whitstable Oyster* case, note (4). Cf. *Worcester Royal Porcelain Co., Ltd. v. Locke*, 19 R. P. C. 479 (1902), Byrne, J.

³ As to the relief granted in such a case, see the last Chapter, p. 505.

⁴ See *Jamieson & Co. v. Jamieson*,

And as stated by James, L.J., in the judgment quoted above, the name need not be the personal name of the plaintiff.¹ It need not even be that of a predecessor in business, for a trader may lawfully adopt and trade under any name which is unappropriated for businesses of the same kind, and when the name has become his by repute he is as well entitled to protection for it as if it were his own.² A modern case before North, J., is an illustration of this rule. There the plaintiffs made and sold a sauce which they called by the name of one of their servants, "Holbrook's Worcester Sauce." The servant left them and joined the defendants, who thereupon advertised that they had acquired the right to make "Holbrook's Worcester Sauce." It was shown that the sauce sold by the plaintiffs was well known as theirs by the name, and the learned judge held that they had a right to the name in question, and that Holbrook could not sell it to the defendants.³ In that case the sauce was identified by the name with the plaintiffs, and not with Holbrook; an opposite result would have been reached if the name had been understood to indicate that the latter person was the actual maker of the goods, and that they were his goods of which plaintiffs happened

It need not be the plaintiff's family name.

note (2), in which Vaughan Williams, L.J., said (at p. 193): "The moment it is admitted that the goods of more traders than one are denoted by the same name you have gone a long way towards disposing of the assertion that the particular name is understood in the trade to denote the goods of the plaintiff." See also *Whitstable Oyster Co. v. Hayling Fisheries, Ltd.*, 17 R. P. C. 461 and 18 R. P. C. 434 (1901), Buckley, J., and C. A., and the judgments of Kekewich, J., in *Paine v. Daniells*, 10 R. P. C. at p. 80; and in *Findlater, Mackie, Todd & Co. v. Newman*, 19 R. P. C. 235, at p. 242; and *Mappin and Webb, Ltd. v. Leapman*, 22 R. P. C. 398 (1905), Farwell, J. See also *Claudius Ash, Son & Co. v. Invicta Manufacturing Co.*, 28 R. P. C. 597; 29 R. P. C. 465 (1912), C. A. and H. of L., where the plaintiffs complained chiefly of the use of the name "Stent" by the defendants in connection with dental composition, and a third person had for many years been selling under the name H. G. Stent. The plaintiffs, however, failed to establish that the de-

fendants' use of the name "G. Stent's," which they had used for many years, was wrongful.

¹ P. 543; also *Mrs. Pomeroy, Ltd. v. Scale*, 24 R. P. C. 177 (1907). In *Macmillan v. Ehrmann*, 21 R. P. C. 357, 647 (1904), Buckley, J., and C. A., the name in question, *Macfarlane Whiskey*, was adopted by both parties. The action failed because there was no probability of deception. In *Wurm v. Webster*, 21 R. P. C. 373 (1904), Kekewich, J., the plaintiff failed to prove that "White Viennese Band" without the addition of his name meant his band exclusively. Cf. "Defences," below, p. 606.

² In *Isaacson v. Thompson*, 41 L. J. Ch. 101 (1871), Bacon, V.-C., for instance, the plaintiff traded as *Mme. Elise*. See also *Mrs. Pomeroy, Ltd. v. Scale*, note (1).

³ *Birmingham Vinegar Brewery Co. v. Liverpool Vinegar Co.*, W. N. (1888), 139, an interlocutory injunction was granted; cf. *Dence v. Mason*, W. N. (1877), 23; (1878), 42, Malins, V.-C. (*Brand's Essence of Beef*).

to be vendors.¹ Thus, in *Franke v. Chappell*,² although the plaintiff had organised a series of concerts known as "Richter Concerts" for many years, when Herr Richter made arrangements to conduct the rival concerts of the defendants, it was held that the defendants might rightly advertise their series under the name, since it was understood to mean, not concerts got up by the plaintiff, but anybody's concerts conducted by Richter.

And a manufacturer has no right to use a name under which goods made by him for a trader have become known and identified with the trader alone, or to prevent him from using it for goods made for him by others.³

In the case of a company registered under the Companies (Consolidation) Act, 1908, it is enacted that⁴—

"A company may not be registered under a name identical with that by which a company in existence is already registered, or so nearly resembling that name as to be calculated to deceive, except where the company in existence is in the course of being dissolved,⁵ and signifies its consent in such manner as the Registrar requires."

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

As Buckley, L.J., pointed out in his note to the section,⁶ it is to be observed (1) that it only applies to the case of taking the name of a subsisting company already registered, and not to a case like *Hendriks v. Montagu*,⁷ where a new company proposes to register in a name resembling the name of an old-established company, which is not registered; ⁸ (2) that so soon

¹ As to joint trade marks, see p. 425, above.

² 57 L. T. (N. S.) 141 (1887), Chitty, J.

³ *Defries v. Electric and Ordnance Accessories Co.*, 23 R. P. C. 341 (1906), Joyce, J. On the other hand, a merchant cannot continue to use a name identified with the place of origin of the goods, e.g., a vineyard, after he has ceased to obtain his goods from it: *Van Zeller v. Mason, Catley & Co.*, 25 R. P. C. 37 (1907), Joyce, J.

⁴ 8 Edw. VII., c. 69, s. 8, replacing s.

20 of the Companies Act, 1862, which was in almost identical terms.

⁵ For example, upon a reconstruction.

⁶ Buckley on the Companies Acts, see 9th ed. p. 14; see also Palmer's Company Precedents, 11th ed., Pt. 1, p. 450.

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

⁸ *Hoby v. Grosvenor Library Co., Ltd.*, 28 W. R. 386.

The trade name of a company.

Sec. 8 of the Companies (Consolidation) Act, 1908.

as the new company is registered, the section has, except as to change of name, ceased to be applicable; the old registered company cannot upon the section claim an injunction to restrain the newly registered company from trading under the name;¹ (3) that the Act forbids registration in the same or a similar name, irrespective of whether the business to be carried on is the same or not.² A greater protection is therefore given by the section to companies than is given by common law to individuals.³

But the provision of the section is merely in supplement of the ordinary rule upon which the Court acts in protecting trade names, and that rule is in no way limited by the registration of the name objected to as the name of the defendant company.⁴ An injunction will therefore be granted to restrain the defendant from carrying on the same trade as that of the plaintiff under a name so nearly resembling his as to be calculated to deceive, whether it has been registered as the name of the defendant company or not, and, in the latter event, to restrain the defendants also from applying for registration of the name. In *Hendriks v. Montagu*,⁵ the leading case on the point, the plaintiff, on behalf of the *Universal Life Assurance Society*, sued certain persons who were the promoters of an intended new company, to be called the *Universe Life Assurance Association*, and an injunction in the following form was granted:—

“To restrain the defendants from applying to the Registrar of joint stock companies in England, for registration under the Companies Acts, of any company to be incorporated under the name of the *Universe Life Assurance Association*, or any other

The section is supplementary to the common law.

Hendriks v. Montagu.

The injunction granted.

¹ But the section lays down the principle which ought to govern the Court in dealing with two companies, one of which is an old-established company, the other of which is an infant company. Per Cozens-Hardy, M.R., in *Daimler Motor Co. (1904), Ltd. v. London Daimler Co., Ltd.*, 24 R. P. C. 379, at p. 385; and also to the same effect in the case cited in note (3).

² In considering similar names, however, a difference in the nature of the businesses may be material: *Aerators, Ltd. v. Tollit*, [1902] 2 Ch. 319; 18 R. P. C. 418, Farwell, J.; and *Scottish Union and National Insurance Co. v.*

Scottish National Insurance Co., Ltd., 25 R. P. C. 560; 26 R. P. C. 105 (1909), Scotland. See also the *Dunlop* case, cited below, p. 601.

³ See the judgment of Cozens-Hardy, M.R., in *Ouvah Ceylon Estates, Ltd. v. Uva Ceylon Rubber Estates, Ltd.*, 27 R. P. C. 753 (1910).

⁴ *Merchant Banking Co. of London v. Merchants Joint Stock Bank*, 9 C. D. 560 (1878), Jessel, M.R.; *Manchester Brewery Co., Ltd. v. North Cheshire and Manchester Brewery Co., Ltd.*, [1898] 1 Ch. 539; [1899] A. C. 83.

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

name likely to mislead or deceive the public into the belief that the company, being incorporated as aforesaid, is the same as the *Universal Life Assurance Society*, from issuing or publishing advertisements, circulars, or prospectuses representing that a company is to be incorporated pursuant to the Companies Act, 1862, under the name of the *Universe Life Assurance Association, Limited*, or any such other name as aforesaid; and from carrying on or commencing any business under the name of the *Universe Life Assurance Association, Limited*, or any such other name as aforesaid."

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

Injunction
against
signatories
of Memo-
randum of
Association.

In *Panhard et Levassor v. Panhard-Levassor Motor Co., Ltd.*,¹ the injunction was granted against the defendant company and also against the seven signatories of the Memorandum of Association forbidding them to use the names Panhard and Levassor, and also forbidding the signatories to allow the company to remain registered under its then present name.

Ground of
interference
by the Court.

The ground of the interference of the Court is, that the use of the defendant company's name, or its intended name, is calculated to deceive, and so to divert business from the plaintiff to the defendant, or to occasion a confusion between the two businesses. If this is not made out there is no case.² But

¹ [1901] 2 Ch. 513; 18 R. P. C. 405, Farwell, J., and Appendix, p. 807.

² See *Daimler Motor Co. (1904), Ltd. v. London Daimler Co., Ltd.*, 24 R. P. C.

“calculated to deceive” is not to be limited to the date of the proceedings, the Court will have regard to the way in which the business may be carried on in the future, and to its not being carried on precisely as carried on at the date of the proceedings.¹

And the mere employment of a term which is descriptive of the business of both the parties will not of itself be accepted as sufficient to make out the plaintiff's case.² If it were, it would give the first user a monopoly in the term. “If a company which does colonial business cannot call itself colonial, it is obvious that, under a species of assertion that the word colonial is symbolical, the plaintiffs might prevent every other person using it as descriptive of his trade.”³

In *The Guardian Fire and Life Assurance Co. v. The Guardian and General Insurance Co.*,⁴ the plaintiff company were a very old-established institution, and were commonly known as *The*

No monopoly allowed in names merely descriptive.

Cases of company trade names.

379 (1907), C. A.; and *Electromobile Co., Ltd. v. British Electromobile Co., Ltd.*, 25 R. P. C. 149 (1908), C. A.; and the other cases collected below. And the principles to be applied are, at any rate, extremely analogous to those which are applicable in ordinary passing-off cases in which the Court has to consider whether a trade name, or trade description, or a description of a particular class of goods, or the get-up of a particular class of goods, is or is not likely to deceive: *British Vacuum Cleaner Co., Ltd. v. New Vacuum Cleaner Co., Ltd.*, [1907] 2 Ch. 312; 24 R. P. C. 641, Parker, J.

¹ See *Ouvah Ceylon Estates, Ltd. v. Uva Ceylon Rubber Estates, Ltd.*, 27 R. P. C. 753 (1910). Cf. *Scottish Union and National Insurance Co. v. Scottish National Insurance Co., Ltd.*, 25 R. P. C. 560; 26 R. P. C. 105 (1909), L. O. and Inner House, Scotland. The Court was satisfied that the defendant company did not intend to carry on any other business than marine insurance, whereas the plaintiffs were a fire and life insurance company.

² Cf. the rule against descriptive trade marks, Chap. II., p. 39; Chap. VIII., p. 205; and as to infringement in similar cases, Chap. X., p. 281, and

below, p. 563.

³ Per Ld. Romilly, in *The Colonial Life Insurance Co. v. The Home and Colonial Assurance Co., Ltd.*, 33 Beav. 548; 33 L. J. Ch. 741 (1864); see also *India and China Tea Co. v. Teede*, W. N. (1871), 241, Jessel, M.R.; and *The Australian Mortgage, Land, and Finance Co. v. The Australian and New Zealand Mortgage Co.*, W. N. (1880), 6 C. A., cited p. 553; *Daimler Motor Car Co. v. British Motor Traction Co.*, 18 R. P. C. 465 (1901), Buckley, J. (*Daimler Wagon Co.*). The application, which failed in the last case, succeeded six years later when *Daimler* was no longer merely descriptive: *Daimler, &c. Co. v. London Daimler Co.*, 24 R. P. C. 379, C. A. Also *Aerators, Ltd. v. Tollit*, [1902] 2 Ch. 319; 19 R. P. C. 418, Farwell, J.; *British Vacuum Cleaner Co., Ltd. v. New Vacuum Cleaner Co., Ltd.* (1907), 2 Ch. 312; 24 R. P. C. 641, Parker, J.; *H. E. Randall, Ltd. v. Bradley & Son, Ltd.*, 24 R. P. C. 657, 773 (1907), Warrington, J., and C. A.; *Electromobile Co., Ltd. v. British Electromobile Co., Ltd.*, 24 R. P. C. 688; 25 R. P. C. 149 (1908), Warrington, J., and C. A.

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

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

Taking an existing name as a whole.

If a new company take the whole name of a subsisting company, even though that name is of a descriptive character, there is a high probability of deception.¹ Thus, where the Manchester Brewery Co., Ltd., had a brewery and a large business at Manchester, a new company which had acquired a brewery at Macclesfield with a business extending to Manchester, as well as other towns, attached to it, was restrained by the Court of Appeal from trading as the "North Cheshire and Manchester Brewery Co., Ltd." The decision was affirmed by the House of Lords on the ground that the use of the name would amount to a representation that the new company was an amalgamation comprising the business of the complainants.¹ But there is no rule of law that the use of a descriptive word in the name of a new company is deceptive and therefore unlawful, if it forms part or even the whole of the name of a previously existing company engaged in a similar trade.²

Name suggesting an amalgamation.

Name suggesting a branch or agency.

If the name of the defendant company is one which is calculated to lead to the belief that it is an agency, branch or

¹ *Manchester Brewery Co., Ltd. v. North Cheshire, &c. Co., Ltd.*, [1898] 1 Ch. 539; [1899] A. C. 83. Cf. *Scottish Union and National Insurance Co. v. Scottish National Insurance Co., Ltd.*, 25 R. P. C. 560; 26 R. P. C. (105) (1909), Scotland. In 1878 the plaintiffs had taken over the business of a company called the *Scottish National Insurance Co.*, and had kept alive that name in their office to some extent. The defendant and plaintiff companies carried on, however, businesses of a different nature.

² In *Aerators, Ltd. v. Tollit*, 19 R. P. C. 418 (1902), Farwell, J., a claim to stop *Automatic Aerator Patents, Ltd.*, failed; *British Vacuum Cleaner Co., Ltd. v. New Vacuum Co., Ltd.*, [1907] 2 Ch. 312; 24 R. P. C. 641, Parker, J.; *Randall v. Bradley*, 24 R. P. C. 657, 773 (1907), Warrington, J., and C. A. (*Anglo-American Shoe Co.*); (*Electromobile Co., Ltd. v. British Electromobile Co., Ltd.*, 24 R. P. C. 688; R. P. C. 149 (1908), Warrington, J., and C. A.

department of the plaintiff company, an injunction will be granted, thus, where a limited company was incorporated under the name of Lloyd's (Southampton), Ltd., no person of the name of Lloyd being connected therewith, and was carrying on the business of shipbroking and the sale and purchase of vessels, and were, as was held, attempting to obtain by the use of the name some benefit from the reputation attaching in the shipping world to the name Lloyd's, an injunction was granted to restrain the defendants carrying on business under their name or any other name calculated to induce the belief that the defendants' business was the business of, or an agency, branch or department of the business of the plaintiffs Lloyd's.¹

In the *Eastman Co. v. The John Griffiths Cycle Corporation, Ltd.*, and the *Kodak Cycle Co., Ltd.*, the first-named defendants had promoted the Kodak Cycle Co., Ltd., to which they gave a name comprising as its distinctive element the trade name of the plaintiffs' goods, *Kodak*. Both defendants were restrained from carrying on business under the name Kodak Cycle Co., Ltd., or under any name comprising the word *Kodak*.²

A limited company, by the purchase of a business, often becomes entitled to a trade name which is different from its registered name, and, provided that sec. 63 of the Companies (Consolidation) Act, 1908, is not violated, there seems to be no objection to its continuing the use of such a name in connection with its own business, and it could, whether it had so used the name or not, if it had not abandoned it, prevent a person so using it as to represent that he was carrying on the business formerly carried on under the name; and, moreover, the company could sell the name with, of course, the goodwill.³

Name comprising plaintiffs' trade name.

Assignments of trade name to or by a limited company.

¹ *Lloyd's v. Lloyd's (Southampton), Ltd.*, 29 R. P. C. 493 (1912), C. A.

² 15 R. P. C. 105 (1898), Romer, J. See the order below, p. 806. See also *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Lubricant Co.*, 16 R. P. C. 12 (1899), Romer, J., and cf. the later *Dunlop* case cited p. 554, note (14).

³ *Townsend v. Jarman*, 17 R. P. C. 649 (1900), Farwell, J.; *Macmillan v. Ehrmann*, 21 R. P. C. 357, 647 (1904), Buckley, J., and C. A. Past contraventions of the section above referred to do not bar the plaintiffs: *Pearks, Gunston and Tee, Ltd. v. Thompson, Talmey &*

Co., 18 R. P. C. 185 (1901), Farwell, J.; *Randall, Ltd. v. British and American Shoe Co.*, 19 R. P. C. 893 (1902), Swinfen Eady, J., and see *Application of Albert Baker & Co.* (1898), *Ltd.* (1908), 2 Ch. 86; 25 R. P. C. 513. But where a plaintiff company in order to comply with the section has always used the special name in conjunction with its own registered name, it may be in a difficulty in showing that the name by itself indicates the company or its goods: see *Randall, Ltd. v. Bradley*, 24 R. P. C. 773 (1907), C. A.

Although a limited company could not, it is presumed, sell to a purchaser of its goodwill the whole of its registered name, yet a third person would not be permitted after the dissolution of the company to adopt its name (except the word "limited") so as to lead to the belief that his business was that formerly carried on by the company to the injury of the purchaser.¹

Injunctions
granted.

Injunctions have been granted in the following cases:—*Hoby* (carrying on *The Grosvenor Library*) v. *The Grosvenor Library Co., Ltd.*; ² *Hendriks* (on behalf of the *Universal Life Assurance Society*) v. *Montagu* (promoter of the *Universal Life Assurance Association*); ³ *The Accident Insurance Co., Ltd.* v. *The Accident Disease and General Insurance Co., Ltd.*; ⁴ *Madame Tussaud and Son, Ltd.* v. *Louis Tussaud, Ltd.*; ⁵ *Wolmershausen* v. *G. S. Wolmershausen & Co., Ltd.*; ⁶ *Saunders* (on behalf of the *Sun Life Insurance*) v. *The Sun Life Assurance Co. of Canada*; ⁷ *Premier Cycle Co., Ltd.* v. *Premier Tube Co., Ltd.*; ⁸ *John Brinsmead & Co.* v. *Thomas Edward Brinsmead & Sons, Ltd.*; ⁹ *Pinet et Cie* v. *Maison Pinet, Ltd.*; ¹⁰ *Pinet et Cie* v. *Maison Louis Pinet, Ltd.*; ¹¹ *Eastman Co.* (whose trade name was *Kodak*) v. *John Griffiths Cycle Corporation, Ltd.* (promoters of the *Kodak Cycle Co., Ltd.*); ¹² *Manchester Brewery Co., Ltd.* v. *North Cheshire and Manchester Brewery Co., Ltd.*; ¹³ *Valentine Meat Juice Co.* v. *Valentine Extract Co., Ltd.*; ¹⁴ *Pearks, Gunston Tee, Ltd.* (carrying on business as *Talmey & Co.*) v. *Thompson, Talmey & Co.*; ¹⁵ *Panhard et Levassor* v. *Panhard-Levassor Motor Co., Ltd.*; ¹⁶ *H. E. Randall, Ltd.* (trading as *American Shoe Co.*) v. *British and*

¹ *Montreal Lithographing Company* v. *Sabiston*, [1899] A. C. 610, J. C., really supports this proposition, although the actual decision, which turned on the special facts of the case (see *Townsend v. Jarman*, 17 R. P. C. 649), was there in favour of the defendant, it being held that the mere use of the name was not, under the circumstances, calculated to deceive.

² 28 W. R. 386.

³ 17 C. D. 688 (1881), Jessel, M.R., and C. A.

⁴ 54 L. J. Ch. 104 (1884).

⁵ 44 C. D. 678 (1890), Stirling, J.

⁶ [1892] W. N. 87.

⁷ [1894] 1 Ch. 537, Stirling, J.

⁸ 12 T. L. R. 481 (1896), Chitty, J., interlocutory injunction granted, the defendant company's works had for six years been known as Premier Mills.

⁹ 12 T. L. R. 631; 13 T. L. R. 3 (1896), North, J., and C. A. Cf. the second *Brinsmead* case, cited, p. 603.

¹⁰ 14 R. P. C. 933 (1897), C. A.

¹¹ 15 R. P. C. 65 (1898), North, J.

¹² 15 R. P. C. 105 (1898), Romer, J.

¹³ [1898] 1 Ch. 539 (1899), A. C. 83.

¹⁴ 17 R. P. C. 673 (1900), C. A.

¹⁵ 18 R. P. C. 185 (1901), Farwell, J., and C. A.

¹⁶ [1901] 2 Ch. 513; 18 R. P. C. 405, Farewell, J.

American Shoe Co.; ¹ *Fine Cotton Spinners, etc., Ltd.*, and *John Cash & Sons, Ltd. v. Harwood Cash & Co., Ltd.*; ² *International Plasmon, Ltd. v. Plasmonade, Ltd.*; ³ *Standard Bank of South Africa, Ltd. v. Standard Bank, Ltd.*; ⁴ *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Lubricant Co.*; ⁵ *Ouvah Ceylon Estates, Ltd. v. Uva Ceylon Rubber Estates, Ltd.*; ⁶ *Muratti & Sons, Ltd. v. Murad, Ltd.*; ⁷ *Kingston, Miller & Co., Ltd. v. Thomas Kingston & Co., Ltd.*; ⁸ *Lloyd's v. Lloyd's (Southampton), Ltd.*; ⁹ *Lloyd's Bank v. Lloyd's Investment Trust Co., Ltd.*; ¹⁰ *Facsimile Letter Printing Co., Ltd. v. Facsimile Typewriting Co.*; ¹¹ and *Daimler Motor Co. (1904), Ltd. v. London Daimler Co., Ltd.*¹²

In the following cases injunctions were refused: *London and Provincial Law Assurance Society v. London and Provincial Joint Stock Life Assurance Co.*,¹³ although there was evidence that the former company was usually called the *London and Provincial Insurance Co.*; *London Assurance v. London and Westminster Assurance Corporation*; ¹⁴ *Colonial Life Assurance Co. v. Home and Colonial Assurance Co., Ltd.*; ¹⁵ *London and County Banking Co. v. Capital and Counties Bank* (cited in the next case); *Merchant Banking Co. of London v. Merchants Joint Stock Bank*; ¹⁶ *The Army and Navy Co-operative Society, Ltd. v. The Junior Army and Navy Stores, Ltd.*; ¹⁷ *Australian Mortgage Land and Finance Co. v. Australian and New Zealand Mortgage Co.*; ¹⁸ *National Cash*

Injunctions refused.

¹ 19 R. P. C. 393 (1902), Swinfen Eady, J.

² [1907] 2 Ch. 184; 24 R. P. C. 533, Joyce, J.

³ 22 R. P. C. 543 (1905), Warrington, J., interlocutory injunction granted.

⁴ 26 R. P. C. 310 (1909), Eve, J.

⁵ 16 R. P. C. 12 (1899), Romer, J.

⁶ 27 R. P. C. 753 (1910), Joyce, J., and C. A. Ouvah and Uva were alternative spellings of the name of the same province in Ceylon, and both companies were rubber companies.

⁷ 28 R. P. C. 497 (1911), Swinfen Eady, J.

⁸ [1912] 1 Ch. 575; 25 R. P. C. 289, Warrington, J.

⁹ 29 R. P. C. 433 (1912), C. A.

¹⁰ 29 R. P. C. 545 (1912), Neville, J.

¹¹ 29 R. P. C. 557 (1912), Swinfen Eady, J.

¹² See above, p. 549, note (3). In *Army and Navy Co-operative Society,*

Ltd. v. Army, Navy and Civil Service Co-operative Society of South Africa, Ltd., 19 R. P. C. 575 (1902), on appeal from an interlocutory injunction granted by Buckley, J., the defendants agreed to change their name to *Naval, Military and Civil Service Co-operative Society of South Africa, Ltd.* In *Hopton Wood Stone Firms, Ltd. v. Gelling* (trading as *Hopton Stone and Marble Quarrying Co.*), 27 R. P. C. 605 (1910), Parker, J., the defendant undertook to prefix the word "New" to that style.

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

¹⁴ 32 L. J. Ch. 664 (1863), Stuart, V.-C.

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

¹⁶ 9 C. D. 560 (1878), Jessel, M.R.

¹⁷ Seb. Dig. p. 393 (1879), Jessel, M.R.

¹⁸ W. N. (1880), G, C. A. James, L.J.,

Register Co., Ltd. v. Theeman (who was trading as the *Cash Register Co.*);¹ *Scottish Union and National Insurance Co. v. Scottish National Insurance Co., Ltd.*;² *Daimler Motor Car Co., Ltd. v. British Motor Traction Co.* (who were about to register the *Daimler Wagon Co., Ltd.*);³ *Aerators, Ltd. v. Tollit* (the defendants being about to register *Automatic Aerator Patents, Ltd.*);⁴ *Electromobile Co., Ltd. v. British Electromobile Co., Ltd.*;⁵ *British Vacuum Cleaner Co., Ltd., v. New Vacuum Cleaner Co., Ltd.*; ⁶ *H. E. Randall, Ltd.* (trading as *American Shoe Co.*) *v. Bradley* (trading as *Anglo-American Shoe Co.*);⁷ *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Motor Co., Ltd.*; ⁸ *Meikle* (trading as *Kelvindale Chemical Co.*) *v. Williamson* (trading as *Kelvinside Chemical Co.*);⁹ *Royal Insurance Co., Ltd. v. Midland Insurance Co.*; ¹⁰ *Elliott* (trading as the *Trade Extension Co.*) *v. Expansion of Trade, Ltd.*; ¹¹ *Standard Ideal Co. v. Standard Sanitary Manufacturing Co.*¹² In *Bumstead v. The General Reversionary Co., Ltd.*, an interlocutory injunction was refused, because, although the defendant company had adopted a name resembling that of the company of which the plaintiff was secretary, the General Reversionary and Investment Co., yet there was no probability of deception because the former was a small Liverpool concern, and the latter a very large London one.¹³

The company may continue established name.

A limited company formed to take over a business may adopt and use a name embodying a name under which the business has already been lawfully and properly carried on.¹⁴ This was

said: "The difficulty in these cases was, that while the business name of another could not be appropriated, a man could not, on the other hand, give himself any monopoly in a name which, as in this case, merely described the nature of the business or the locality of its operations"; see above, p. 549.

¹ 24 R. P. C. 211 (1907), Kekewich, J.

² 25 R. P. C. 560 (1908), Scotland.

The classes of business were quite distinct.

³ 18 R. P. C. 465 (1901), Buckley, J. Cf. *Daimler Motor Co. (1904), Ltd. v. London Daimler Co., Ltd.*, 24 R. P. C. 379 (1907), C. A.

⁴ [1902] 2 Ch. 319; 19 R. P. C. 418, Farwell, J.

⁵ 25 R. P. C. 149 (1908), C. A.

⁶ [1907] 2 Ch. 312; 24 R. P. C. 611, Parker, J.

⁷ 24 R. P. C. 657, 773 (1907), Warrington, J., and C. A.

⁸ [1907] A. C. 430; 24 R. P. C. 572.

⁹ 26 R. P. C. 775 (1909), Ct. of Sess., Scotland.

¹⁰ 25 R. P. C. 728; 26 R. P. C. 95 (1909), Warrington, J., and C. A. The plaintiffs became successors in business, in the year 1892, of the Midland Counties Insurance Co.

¹¹ 27 R. P. C. 54, Eve, J. (1909).

¹² 27 R. P. C. 789 (1910), P. C.

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

¹⁴ *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Motor Co., Ltd.*, 23 R. P. C. 761 (Sc.); aff. in H. L. 24 R. P. C. 572.

fully recognised by Stirling, J., in the case of *Tussaud v. Tussaud*,¹ where, however, the condition did not obtain. In that case an unsuccessful attempt was made by the defendant to shelter himself under the general exception from the principle stated at the head of this chapter, that anyone may honestly trade under his own name, which is discussed more fully below.² The plaintiffs, Madame Tussaud & Sons, Ltd., were the owners of a waxwork exhibition originally founded by a Madame Tussaud, and subsequently carried on by the father and uncles of the defendant. Their business was often referred to as *Madame Tussaud's*, and not infrequently as *Tussaud's* only. The defendant, who was a wax modeller by trade, was promoting a company to be called *Louis Tussaud, Ltd.*, to open and carry on a waxwork exhibition under that name in Shaftesbury Avenue, the plaintiff's exhibition being situated in the Marylebone Road. He was to be engaged as manager of the exhibition and modeller of the exhibited figures. He had never carried on, and did not possess the goodwill of, any business in any such exhibition.

Tussaud v. Tussaud.

It follows, said the learned judge, "from the decisions in *Burgess v. Burgess*³ and *Turton v. Turton*,⁴ that the defendant is at perfect liberty to open on his own account, and to carry on in his own name, an exhibition of waxworks. Further, he might take partners into his business, and carry it on under the name *Louis Tussaud & Co.* That seems to me to have been expressly decided in *Turton v. Turton*. Having commenced business on his own account, I apprehend that he might sell it with the benefit of the goodwill to third parties, and that the third parties might, if they thought fit, continue to carry on the business under the same name—that of the defendant; that is to say, they would be entitled to the full benefit of the goodwill which they had honestly and legitimately purchased from the defendant.

The judgment of Stirling, J.

In *S. Chivers & Sons v. S. Chivers & Co., Ltd.*, 17 R. P. C. 420 (1900), Farwell, J., said, at p. 426: "To my mind, no element of suspicion of fraud attaches to a man who has established a business under his own name if he turns that business into a limited company, and applies to that limited company his own name with the word "limited," because the reason for doing so is obvious, that he desires to retain the goodwill which he has gained for that name."

¹ 44 C. D. 678 (1890), Stirling, J.; followed and approved in *Fine Cotton Spinners, &c. Association, Ltd. v. Harwood, Cash & Co., Ltd.*, [1907] 2 Ch. 184; 24 R. P. C. 533, Joyce, J.; *Rendle v. Rendle & Co.*, 63 L. T. 94 (1890), Kay, J., is a somewhat similar case.

² Page 593.

³ 3 D. M. & G. 896; 22 L. J. Ch. 675 (1853), Knight Bruce and Turner, L.JJ., cited p. 593.

⁴ 42 C. D. 128 (1889), C. A., reversing North, J., cited p. 603.

Again, the third parties might transfer the business and the goodwill to a joint stock company, and (without expressing a final opinion on the point) I am not prepared at present to say that that company might not be registered under the same name as had previously been used in connection with the business."¹

Right to use a name not attached to any goodwill cannot be sold.

But the defendant could not, it was held, sell the right to use his name in connection with a business which he had never carried on, and in which he had no interest whatever, or in which he stood simply in the position of a paid servant.² And the proper inference to be drawn from the facts of the case *prima facie* was, the learned judge concluded, that the object of the defendant in promoting the proposed company was to induce the world to believe that the business intended to be carried on was that of the plaintiff company or a branch of it, notwithstanding that the prospectus issued by the defendant plainly stated on the face of it that the new exhibition had no connection with the plaintiff company. An interim injunction in the terms of that in *Hendriks v. Montagu*,³ set out above, was accordingly granted.

In three cases which subsequently came before the Courts attempts appear to have been made to carry through the series of operations indicated in the judgment just cited, but in each instance the defence which might have been founded upon them was displaced by evidence of deliberate fraud.

Brinsmead & Co. v. T. E. Brinsmead, Ltd.

In *The Brinsmead* case,⁴ the plaintiffs were the well-known firm of pianoforte makers. T. E. Brinsmead and his sons, who were relatives of the partners, and had been in their employment, started a small independent business as "T. Brinsmead & Sons." They were restrained from trading under the name Brinsmead without using their full names, and they then promoted the

¹ 44 C. D. p. 687. See p. 554, note (14).

² See also *Fine Cotton Spinners v. Harwood, Cash & Co., Ltd.*, p. 555, note (1); and *Kingston, Miller & Co., Ltd. v. Thomas Kingston & Co., Ltd.*, [1912] 1 Ch. 575; 29 R. P. C. 289, cited below, p. 558. Cf. *The Birmingham Vinegar Brewery Co. v. The Liverpool Vinegar Co.*, supra, p. 545; and *Warner v. Warner*, 5 Times L. R. 327, 359 (1889), Stirling, J., and C. A. (*Warner's*

Cure); and see below, p. 606.

³ Above, p. 547.

⁴ *John Brinsmead & Co. v. Thomas Edward Brinsmead & Sons, Ltd.*, 12 Times L. R. 681; 13 *ibid.* 3 (1896), North, J., and C. A. The facts appear in *Re T. E. Brinsmead & Sons, Ltd.*, [1897] 1 Ch. 45, 406. Cf. *John Brinsmead & Sons, Ltd. v. Stanley Brinsmead*, 30 R. P. C. 187 (1918), Warrington, J., cited below, p. 603.

defendant company under the name of "Thomas Edward Brinsmead & Sons, Ltd.," with the fraudulent intention of getting some of the plaintiff's business. By the use of this name they induced the public to subscribe for shares in the belief that the company possessed the plaintiffs' business. The defendants were restrained from using the name Brinsmead in connection with pianos without an express statement that they had no connection with the plaintiffs' firm. No connection.

In *Pinet's* case,¹ a man who had carried on business in special boots for lame persons as "Maison Pinet," assigned his business to a company called "Maison Pinet, Ltd." The French firm of Pinet et Cie complained of this, but the defendants contended that they intended only to trade in the special boots, and on that ground Kekewich, J., refused an interlocutory injunction. The Court of Appeal did not believe the defendants' story, and granted the injunction restraining them from carrying on their business in boots under the name Pinet without clearly distinguishing their boots from those of the plaintiffs. Subsequently it was discovered that the vendor to the defendant company had assumed the name Pinet for the purpose of defrauding the plaintiffs, and an injunction was then granted forbidding the use of the name by the defendants, and forbidding the liquidator of the company from selling the right to use the name in connection with boots.² *Pinet et Cie v. Maison Pinet, Ltd.*

And in *Valentine's* case,³ the Court of Appeal came to the conclusion that there had been an attempt to get the benefit of the plaintiffs' reputation, and in addition to relief in respect of passing-off, they restrained the defendant company from carrying on the business of manufacturers of extract of meat under any name of which *Valentine* formed part.

The rule that a person who has not any goodwill of a business, cannot transfer to a new company the right to use his name in a manner which would be calculated to deceive by reason of confusion between the name of the new business and that of an old-established business is, however, independent of the presence or absence of fraudulent intention. The law on this point has

¹ *Pinet et Cie v. Maison Pinet, Ltd.*, 14 R. P. C. 938 (1897), C. A.

² *Pinet et Cie v. Maison Louis Pinet, Ltd.*, 15 R. P. C. 65 (1898), North, J.

³ *Valentine Meat Juice Co. v. Valen-*

tine Extract Co., Ltd., 17 R. P. C. 678; 83 L. T. 259 (1900), C. A. The facts will be found more fully set out below, p. 598.

been stated by Joyce, J., in the following passage: "I consider, as the law stands at present, that a new company with a title of which the name 'A,' for instance, forms part has not the natural rights that an individual born with the name of 'A' would have. I think, also, that such a company merely by registration does not acquire and incorporate the individual rights which its promoters may respectively have had to carry on business in their own names; and, further, I think that a person of the name of 'A' without transferring a business and goodwill cannot, by merely authorising the promoters of a company to use his name as part of their title, confer upon such company a right to do so as against other people who would be damaged thereby."¹ In the subsequent case of *Kingston, Miller & Co., Ltd. v. Thomas Kingston & Co., Ltd.*,² it was contended that Thomas Kingston, who had been in the employ of the plaintiff company and was managing director of the defendant company, had something in the nature of goodwill attached to his name of which he could give the benefit to the defendant company, namely, qualifications such as personal skill and experience in the business. But Warrington, J., held that he had nothing in the nature of goodwill to transfer, and that, although he could make use of his personal qualifications, the name was not incident to that qualification in the sense that it could be transferred to a third person and give to that third person the right to use it regardless of the fact that it may mislead the public.

Purchase of
a name.

In some cases of trade name, the defendant has sought to justify the use of the name by setting up the purchase of a business carried on under a name identical with or similar to that of the plaintiff, but the business so purchased has been one dealing in different goods. Whatever may be the legitimate rights of a *bond fide* purchaser of a business to extend it beyond its original scope, the use of the name to defraud the plaintiff by such means will not be allowed by the Courts.³

¹ *Fine Cotton Spinners v. Harwood, Cash & Co., Ltd.*, [1907] 2 Ch. at p. 190; 24 R. P. C. at p. 538. See also *Warwick Tyre Co., Ltd. v. New Motor and General Rubber Co., Ltd.*, [1910] 1 Ch. 248; 27 R. P. C. 161.

² [1912] 1 Ch. 575; 29 R. P. C. 289.

³ *Holloway v. Clent*, 20 R. P. C. 525

(1903), Swinfen Eady, J.; *Rodgers v. Hearnshaw*, 23 R. P. C. 349 (1906), Buckley, J.; *Morrall v. Hessin*, 19 R. P. C. 557; 20 R. P. C. 429 (1903), Swinfen Eady, J., and O. A. Cf. *Map-pin and Webb v. Leapman*, 22 R. P. C. 398 (1905), Farwell, J.

On the other hand, in *The Dunlop* case,¹ a company formed under the name Dunlop Motor Co., Ltd., by R. and J. F. Dunlop to purchase and carry on the motor branch of a motor and cycle repairing business in Edinburgh, which they had previously carried on in partnership, maintained its right to use the name against the well-known Dunlop Pneumatic Tyre Company. There was no proof of fraud and there was no great similarity in the objects of the companies, and, in the view of the Court, there was no probability of deception.

Where an injunction is granted against a limited company carrying on business under its registered name, the injunction is usually suspended for a short time to allow of the company changing its name.²

A trader has the same rights in respect of the name of the house, shop,³ or factory,⁴ where he carries on his trade or business, as he has in respect of his trade name. He can, therefore, support an action for passing-off, and obtain an injunction by showing that the name of the house, &c., has a reputed connection with his trade or business or goods, and that the defendant, without having any independent right to do so,⁵ is using for

Name of
business,
house, or
factory

¹ *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Motor Co., Ltd.*, 23 R. P. C. 761 (Sc.); aff. 24 R. P. C. 572 (1907), H. L. Cf. *Same v. Dunlop Lubricant Co.*, 16 R. P. C. 12 (1899), Romer, J.

² See for instance *Lloyd's v. Lloyd's (Southampton), Ltd.*, 29 R. P. C. 433.

³ *Boussod, Valadon & Co. v. Marchant*, 24 R. P. C. 665; 25 *ib.* 42 (1907), Parker, J., and C. A. (*Goupil Gallery*); *Hudson v. Osborne*, 99 L. J. Ch. 79 (1869), James, V.-C. (*Osborne House*); *Boulnois v. Peake*, 13 C. D. 512, n. (1868), Giffard, V.-C. (*The Carriage Bazaar*); *Bodega Co. v. Owens*, 6 R. P. C. 236; 7 *ib.* 31; 23 L. R. Ir. 371 (1889), Chatterton, V.-C. (*Bodega Wine Shop*). *Great North of Scotland Rail. Co. v. Mann*, 19 R. 10, 35 (*Palace Hotel*); *Cowan v. Miller*, 22 R. 833 (*Sun Foundry*); both Scotch cases. In *Charleston v. Campbell*, 4 Sess. Cas. 4th ser. 149 (1876), an injunction to restrain the use of the "Royal Station Hotel," at the instance of the proprietor of the "Station Hotel," was refused, because

the title was merely descriptive.

⁴ *Braham v. Beachin*, 7 C. D. 848 (1878), Fry, J. (*Radstock Colliery*); *Montgomery v. Thompson*, 41 C. D. 35; [1891] A. C. 217; 8 R. P. C. 361, Chitty, J., C. A., and H. L. (*Stone Brewery*).

⁵ In *Mason v. Queen*, 23 Scot. L. R. 641 (1886), the Lord Ordinary held that the goodwill and trade name of an hotel could not be transferred so as to entitle the transferee to stop a new occupier of the building from using the old name. The "Waverley Hotel," Glasgow, was taken by a railway company under compulsory powers in May, 1884, compensation being paid for loss of business. The proprietor, who had other "Waverley Hotels" in London and Edinburgh, transferred the goodwill and the right to use the name to the plaintiff, who thereupon changed the name of her own house to "Waverley," and put up a notice of removal upon the old building. In January, 1885, the railway company let the old building to the defendant, who opened it as the "Old Waverley."

business purposes a name which is calculated to cause his trade, business, or goods to be taken for, or to be confounded with, the plaintiff's.¹ There is no right to the exclusive use of the name of a mere private house,² and no cause of action arises where, although the defendant has adopted, for business purposes, an address likely to be confused with that of the plaintiff, yet the businesses of the parties are so different that no damage can result to the plaintiff's trade.³

If the goodwill of a business, including the right to a name derived from the house where the business is carried on, be sold, the purchaser is generally entitled to continue to use the name even though he does not acquire, or ceases to possess, the house itself.⁴

If the name in question is taken from a building where a firm carries on business, it may be that on the removal of the firm the name still attaches to the building and may properly be used by the next tenant. The question appears to be one of fact.⁵

Held: (1) the plaintiff had no exclusive right to the name, and (2) (but *quære* on the special facts) there was no case of passing-off. See also *Nicholson v. Buchanan*, 19 R. P. C. 321 (1900), Stirling, J., where a firm who were the owners of a business and distillery, sometimes known as "the Black Swan Distillery," which had had a figure of a black swan outside, and who also had a black swan for a trade mark, sold first the premises to the defendants, and subsequently the goodwill and trade mark to the plaintiffs. The vendors had been known chiefly for gin, whereas the defendants carried on business on the premises in Scotch whisky, no distilling being done there. On the evidence it was held that there was no probability of deception, and the action in which the plaintiffs complained of the use of the words "Black Swan" and the device was dismissed. In *Cooper and M'Leod v. Maclachlan*, 18 R. P. C. 380; 19 R. P. C. 27 (1902), the defendant was held entitled to use "Castle Brewery" which the plaintiffs

also used, there being no probability of deception. Cf. *Findlater, Mackie, Todd & Co. v. Newman*, 19 R. P. C. 235 (1902), Kekewich, J., where "Findlater's Corner" was held to be associated with the place where the defendant carried on business. As to the assignment of marks having a local connotation, see above, pp. 388 and 389.

¹ See note (3), p. 559, above.

² *Day v. Brownrigg*, 10 C. D. 294 (1878), C. A.

³ *Street v. Union Bank of Spain and England*, 30 C. D. 156 (1885), Pearson, J.; the plaintiffs were advertising agents (telegraphic cypher).

⁴ *Rickerby v. Reay*, 20 R. P. C. 380 (1903), Byrne, J. See also the *Goupil Gallery* case, above, p. 559, note (3).

⁵ See *Mason v. Queen*, *Nicholson v. Buchanan*, supra, note (5), p. 559, *Charleston v. Campbell*, supra, p. 559, note (3), and *Rickerby v. Reay*, note (4); *Booth v. Jarrett*, 52 How. Pr. 169 (1876), New York ("Booth's Theatre"); and *Sebastian*, 5th ed., p. 304.

B. The Trade Name of the Plaintiff's Goods.

A name which is used upon or in connection with goods for the purpose of indicating that they are the goods of a trader by virtue of manufacture, selection, certification dealing with or offering for sale, is a trade mark.¹ And if it is within any of the classes enumerated in sec. 9, it may be registered as a trade mark. But whether or not the name is used upon or in connection with the goods, so as to conform to the definition just stated, or registered as a trade mark, if it is in fact known in the market as the distinctive name of the goods of a particular trader, no one else may use it for dealings in other goods of the same description as those in connection with which it has acquired its distinctive signification.

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

The qualified right in the trade name,—a right to prevent a defendant from passing off his goods as those of the plaintiff by the use of it,—exists only with regard to goods of the kind for which the plaintiff uses it, and to which the connection with his business suggested by the use of the name extends.² So, where the proprietors of *The Morning Post* sought to restrain the publishers of a new evening newspaper from calling their paper *The Evening Post*, the Court of Appeal, holding, as an inference of fact, that there was no probability of the defendant's paper being taken for the plaintiff's, or being taken to have any connection with it so as to cause damage to the plaintiffs, dismissed the action.³ But if the name, although not actually used by the

Right restricted to particular goods or business.

The Evening Post case.

¹ Trade Marks Act, 1905, sec. 3, Chap. II., p. 25.

² Page 92; and cf. the rule in respect of the infringement of trade marks, Chap. XV., p. 435.

³ *Borthwick v. The Evening Post*, 37 C. D. 449 (1888), C. A., overruling Kay, J. So in *Outram & Co. v. London Evening Newspapers Co.*, 128 R. P. C. 308 (1911), Warrington, J., the owners of the *Evening Times* published in Glasgow were held not entitled to

restrain the publication of a paper of the same name published in London, there being no competition and no resemblance between the papers. Similarly the American proprietors of a shilling monthly magazine called "Everybody's Magazine" failed to obtain an injunction against the proprietors of a penny weekly paper known as "Everybody's Weekly," there being no competition and no resemblance except in the word "Everybody's,"

plaintiff for the particular kind of goods to which the defendant has applied it, is so identified with the plaintiff that the defendant's use of it will induce the belief that his goods are those of the plaintiff,¹ or that his business is an extension of,² or an amalgamation with,³ or is otherwise connected with¹ the plaintiff's business, and will thereby cause substantial damage to the plaintiff, an injunction may be granted,⁴ and possibly a prospective interference with the natural and probable extension of the plaintiff's business would be sufficient⁵ ground to entitle the plaintiff to relief.

The name may be used on the right goods.

It must be distinctive of the plaintiff's goods;

Anyone may use the name in connection with goods which are in fact the goods of the plaintiff.⁶

It is the essence of the plaintiff's case that the use of the name should be understood in the market to imply that the goods sold or dealt in under it are his goods.⁷

Ridgeway Co. v. Amalgamated Press, Ltd., 29 R. P. C. 130 (1912), Warrington, J. See also *Stevens v. Cassell*, 30 R. P. C. 199, Neville, J. (1913), (*Magazine of Fiction*). Injunctions were granted in *Walter v. Emmott*, 54 L. J. Ch. 1059 (1885), C. A. (*The Morning Mail*), and in *Reed v. O'Meara*, 21 L. R. Ir. 216, V.-C. (*The Grocer*). Cf. *Re The Australian Wine Importers, Ltd.*, 41 C. D. 278; 6 R. P. C. 311 (1889), Kay, J., and C. A., where a mark for wine was refused registration, as too closely resembling a mark for spirits, and the Court left open the question whether its use would amount to infringement or passing-off; and other cases, cited above, in connection with secs. 19, 20, and 21, pp. 252 *et seq.*

¹ In *Warwick Tyre Co., Ltd. v. New Motor, &c. Co., Ltd.*, 27 R. P. C. 161 (1910), Neville, J., the plaintiffs had an interest in the name *Warwick* in connection with cycle tyres, although they neither manufactured nor sold such tyres, and the defendants were selling their motor tyres as *Warwick* motor tyres; an injunction was granted.

² *Eastman, &c. Materials Co. v. John Griffiths' Cycle Corp., Ltd.*, 15 R. P. C. 105 (1898), Romer, J. The plaintiff company dealt in photographic materials, and sold *Bicycle Kodak* cameras. *Kodak* was their trade name. The defendants were restrained from

selling *Kodak Cycles*. Romer, J., said it would lead to confusion and to deception, and would be injurious to the plaintiff company. See further as to this case, above, pp. 253, 300, and 551. Cf. *Joseph Lucas, Ltd. v. Fabry Automobile Co., Ltd.*, 23 R. P. C. 33 (1906), Warrington, J., where the plaintiffs had a reputation in cycle accessories, principally metal, under the name "Lucas," and the defendants commenced to sell "Lucas" motor tyres, which were well known on the Continent, it was found that the tyre trade was a distinct branch of the motor industry, and the action for passing-off was dismissed.

³ See *Manchester Brewery Co. v. North Cheshire, &c. Co.*, above, p. 550.

⁴ See note (2).

⁵ See the cases last cited, per Ld. Watson in *Eno v. Dunn*, 15 App. Ca. at p. 258, and per Cotton, L.J., in *The Morning Mail* case, p. 561, note (3). In an American case, *Celluloid Co. v. Reed*, 47 Fed. Rep. 712; Cox, p. 509, the judge said the prospect that the complainant will in future want to manufacture starch, is too shadowy to base an injunction upon. But the suggested extension was there improbable in fact.

⁶ Pages 84 and 487; and *Ainsworth v. Walmsley*, L. R. 1 Eq. 518 (1886), Wood, V.-C., cited p. 535.

⁷ Page 36. *Fels v. Christopher*

In *The Two D.* case,¹ Herschell, L.C., said, the foundation of a passing-off case "is that the party alleging it should prove, in the first instance, that any name which he claims as his trade name has been so extensively used in connection with his manufacture or with the goods which he sells, that his goods have come to be known in the market by that name; that anyone using that name would intend to refer to his goods; and that anyone to whom the name was used would understand that his goods were referred to."

Hence the critical question of fact in cases under this head is often whether a word or term is the distinctive name of the plaintiff's goods, or is the name of anybody's goods of the kind,² like *Liebig's Extract*,³ *Chlorodyne*,⁴ *Linoleum*,⁵ *Wellington Boots*, *Gladstone Bag*, and *Hansom Cab*, or a mere description of the goods, denoting only their pattern,⁶ mode of manufacture,⁷ or sale,⁸

not the mere name of the goods.

Thomas Brothers, Ltd., 21 R. P. C. 85 (1903), C. A. (*Naphtha soap*).

¹ *Leahy, Kelly and Leahy v. Glover*, 10 R. P. C., p. 155 (1893), H. L.

² See pp. 39 and 280 *et seq.*

³ *Liebig's Extract of Meat Co., Ltd. v. Hanbury*, 17 L. T. (N. S.) 298 (1867), Wood, V.-O.; *Liebig Co. v. Anderson*, 55 L. T. 206 (1887), Chitty, J.; and cf. *Same v. Chemists' Co-operative Society, Ltd.*, 13 R. P. C. 736.

⁴ *Browne v. Freeman*, (1) 12 W. R. 305 (1864), Wood, V.-O.; (2) W. N. (1873), 178, L.JJ.

⁵ *Linoleum Manufacturing Co. v. Nairn*, 7 C. D. 834 (1878), Fry, J. Cf. *Chesebrough Co.'s Tms.*, 18 R. P. C. 191; 19 *ib.* 342 (1901), C. A., reversing Buckley, J. (*Vaseline* not descriptive.)

⁶ *Ford v. Foster*, L. R. 7 Ch. 616 (1872), L.JJ. (*Eureka Shirts*); *Hirst v. Denham*, L. R. 14 Eq. 542 (1872), Bacon, V.-O.; *Harrison, McGregor & Co.'s Tm.*, 42 C. D. 691; 7 R. P. C. 25 (1889), Kekewich, J. (*Albion Mowers*); *Winser v. Armstrong*, 16 R. P. C. 167 (1899), Byrne, J. (*Winser Interceptors*). In *Burberry v. Raper and Pulleyn*, 23 R. P. C. 170 (1906), Warrington, J., the defence, that the name "Burberry" meant a coat of a particular shape made of a particular cloth, failed. Cf. *Burberrys v. Cording & Co., Ltd.*, 62 R. P. C. 693 (1909), Parker, J. (slip-on

coats). A word may be shown by evidence to indicate a particular pattern of goods when made by a particular manufacturer, and thus to be distinctive: *Application by Whitfield's Bedsteads, Ltd.*, [1909] 2 Ch. 373; 26 R. P. C. 657 (*Lawson Tait Bedsteads*).

⁷ *Singer Manufacturing Co. v. Wilson*, 2 C. D. 434; 3 App. Ca. 376 (1875); *Ib. v. Loog*, 18 C. D. 395; 8 App. Ca. 15 (1877); *Ib. v. Spence & Co.*, 10 R. P. C. 297 (1893), Romer, J.; *Ib. v. British Empire Co.*, 20 R. P. C. 313 (1903), Kekewich, J. (*Singer System, Singer Sewing Machines*), cited *ante*, p. 40. In the last two cases and in *Daimler Motor Co. (1904), Ltd. v. London Daimler Co., Ltd.*, 24 R. P. C. 379 (1907), C. A. (*Daimler*), the plaintiffs after failing in previous actions established that the name had become distinctive. See also *Bowden Wire, Ltd. v. Bowden Brake Co., Ltd.*, No. 2, Times, June 25th, 1913 (*Bowden Control* held to be descriptive, Warrington, J.). In *Bechstein v. Barker*, 27 R. P. C. 484 (1910), Eve, J., the plaintiffs obtained an injunction against passing-off by the use of the word "Bechstein," the defendants having sold pianos not of the plaintiffs' manufacture as "Bechstein Model Pianos."

⁸ *Symington v. Footman*, 56 L. T. 696 (1885), Kay, J. (*Guaranteed Corset*).

type,¹ ingredients,² quality,³ or place of origin,⁴ or the use for which they are intended.⁵ In *The Kodak* case it was alleged for the defendants that certain names were descriptive of photographic films suitable for use in cameras of the same names; but it was held, in fact, that they indicated the plaintiff's goods only.⁶

A word may have a different meaning to the public from that which it has to the trade: thus a "Eureka" shirt was held to be distinctive to the public, but descriptive of pattern to the trade;⁷ whilst, on the other hand, the word "gramophone" was held to indicate to the public a talking machine with disc records, but to the trade it connoted also the manufacturers.⁸

¹ In *Armstrong Oiler Co. v. Patent Axlebox, &c. Co., Ltd.*, 27 R. P. C. 362, the plaintiffs, who were makers of oilers for the axles of railway carriages, claimed that *Armstrong Oilers* meant their oilers, and sought to restrain the defendants from supplying their own goods as *Armstrong Type Oilers*; the customers to whom the defendants' goods were supplied knew that the goods were not the goods of the plaintiffs, and it was held that there was no passing-off.

² *Massam v. Thorley's Cattle Food Co.*, 14 C. D. 748 (1880), C. A. In *Boake, Roberts & Co. v. Wayland*, 26 R. P. C. 251 (1909), Neville, J., the plaintiffs established that K. M. S. (the initial letters of Kalium Meta Sulphite) meant their goods.

³ But where *Vacuum Oil* meant the plaintiffs' oil, the defendants, who described their oil as "Vacuum Motor Oil A Quality," were restrained: *Vacuum Oil Co. v. Gooch*, 27 R. P. C. 76 (1910), Neville, J.

⁴ *McAndrew v. Bassett*, 4 De G. J. & S. 380; 33 L. J. Ch. 561 (*Anatolia Liquorice*); *Seixo v. Provezende*, L. R. 1 Ch. 192 (*Seixo Wine*); *Wotherspoon v. Currie*, 5 L. R. H. L. 508 (*Glenfield Starch*), all cited pp. 54 and 55; see also *The Reading Biscuit* case, *Huntley and Palmer v. The Reading Biscuit Co., Ltd.*, 10 R. P. C. 277 (1893), Chitty, J.; and *The Rugby Portland Cement* case, *Rugby Portland Cement Co., Ltd. v. The Rugby and Newbold Portland*

Cement Co., 8 R. P. C. 241; 9 R. P. C. 46 (1891), V. Williams, J., and C. A., and *Bewlay v. Hughes*, 15 R. P. C. 290 (1898), North, J. (*Dindigul Cigars*); *Whitstable Oyster Co. v. Hayling Fisheries, Ltd.*, 17 R. P. C. 461; 18 *ib.* 434, Buckley, J., and C. A. (*Whitstable Oysters*); *Hopton Wood Stone Firms, Ltd. v. Gethings*, 27 R. P. C. 605 (1910), Parker, J. (*Hopton Wood Stone*), and *London Candles*, below, p. 565, n. (2).

⁵ *Talbot v. Webley*, 3 R. P. C. 276 (1886), Bacon, V.-O. (*Baffle Safes*); *Christy v. Tipper*, 21 R. P. C. 97, 755 (1903), Kekewich, J., and C. A. (*Absorbine Lotion*).

⁶ *Kodak, Ltd. v. London Stereoscopic, &c. Co.*, 20 R. P. C. 337 (1903), Swinfen Eady, J. Cf. *Neostyle Manufacturing Co., Ltd. v. Ellam's Duplicator Co.*, 21 R. P. C., 185, 569 (1904), Byrno, J., and C. A., where it was held on the facts that, although "Neostyle" in England denoted the name of the plaintiffs' duplicating machine, the plaintiffs had no exclusive right to it for accessories. See also *Gledhill & Sons, Ltd. v. British Perforated Toilet Paper Co.*, 28 R. P. C. 429, 714 (1911), Eve, J., and C. A., where it was found that Gledhill's coils had come to mean coils for use in Gledhill's cash tills, and that the defendants had only used a fair description of the coil as suitable for that purpose.

⁷ *Ford v. Foster*, cited, p. 563, note (6).

⁸ *Gramophone Co.'s Application*, [1910] 2 Ch. 428; 27 R. P. C. 689, 785, Parker, J.

Words and terms which *prima facie* are merely descriptive in the sense just explained may, however, acquire by use and reputation a secondary distinctive meaning,¹ so that they may be practically monopolised for use in connection with certain classes of goods by a particular trader, since their employment by anyone else would be calculated to deceive.² "I take it to be clear from the evidence," Lord Westbury said, in *The Glenfield Starch* case,³ "that long antecedently to the operations of the respondent, the word *Glenfield* had acquired a secondary signification or meaning in connection with a particular manufacture—in short, it had become the trade denomination of the starch made by the appellants. It was wholly taken out of its ordinary meaning, and in connection with starch had acquired that peculiar secondary signification to which I have referred. The word *Glenfield*, therefore, as a denomination of starch, had become the property of the appellants."

Descriptive names may have a secondary distinctive meaning.

And in *The Camel Hair Belting* case,⁴ Lord Herschell said: "The name of a person, or words forming part of the common stock of language, may become so far associated with the goods of a particular maker that it is capable of proof that the use of them by themselves without explanation or qualification by another manufacturer would deceive a purchaser into the belief that he was getting the goods of A. when he was really getting the goods of B. In a case of this description the mere proof by the plaintiff that the defendant was using a name, word, or device which he had adopted to distinguish his goods would not entitle him to any relief. He could only obtain it by proving further that the defendant was using it under such circumstances or in such manner as to put off his goods as the goods of the plaintiff."⁵

¹ Chap. II., p. 39.

² See the cases cited in note (4), p. 564, and *Montgomery v. Thompson*, 41 C. D. 35; [1891] A. C. 217; 8 R. P. C. 361 (*Stone Ales*); followed in *Worcester Royal Porcelain Co., Ltd. v. Locke*, 19 R. P. C. 479 (1902), Byrne, J. (*Worcester China*). In *Price's Patent Candle Co. v. Ogston and Tennant, Ltd.*, 26 R. P. C. 797 (1909), Ld. Johnston, Scotland, it was found that in Morocco *London Candles* meant the plaintiffs' candles.

³ See above, p. 564, note (4).

⁴ *Reddaway v. Banham*, [1896] A. C. 199, at p. 210; 13 R. P. C. at p. 228.

⁵ Cf. the decisions on the expression "fancy word not in common use" in the Act of 1883, above, p. 153. The current use of the term "fancy word" is as an antithesis to "descriptive," or *prima facie* descriptive, word. See *Faulder v. Rushton*, 20 R. P. C. 477 (1902), C. A. (*Silverpan Jam*), and the judgments in the *Cellular Clothing* case cited below; and in *Kinnell v. Ballantine*, 26 R. P. C. 12; 27 R. P. C. 185 (1910), Ct. of Sess., "Horse shoe"

And in a recent case in which the plaintiffs were claiming that the words "Slip-On" were distinctive of their goods,¹ Parker, J., summarised the principles of law applicable to the case in the following passage:—

Judgment of
Parker, J., in
Burberrys v.
Cording.

"The principles of law applicable to a case of this sort are well known. On the one hand, apart from the law as to trade marks, no one can claim monopoly rights in the use of a word or name. On the other hand, no one is entitled by the use of any word or name, or indeed in any other way, to represent his goods as being the goods of another to that other's injury. If an injunction be granted restraining the use of a word or name, it is no doubt granted to protect property, but the property, to protect which it is granted, is not property in the word or name, but property in the trade or goodwill which will be injured by its use. If the use of a word or name be restrained, it can only be on the ground that such use involves a misrepresentation, and that such misrepresentation has injured, or is calculated to injure, another in his trade or business. If no case of deception by means of such misrepresentation can be proved, it is sufficient to prove the probability of such deception, and the Court will readily infer such probability if it be shown that the word or name has been adopted with any intention to deceive. In the absence of such intention, the degree of readiness with which the Court will infer the probability of deception must depend on the circumstances of each particular case, including the nature of the word or name, the use of which is sought to be restrained. It is important for this purpose to consider whether the word or name is *primâ facie* in the nature of a fancy word or name, or whether it is *primâ facie* descriptive of the article in respect of which it is used. It is also important for the same purpose to consider its history, the nature of its use by the person who seeks the injunction, and the extent to which it is or has been used by others. If the word or name is *primâ facie* descriptive or be in general use, the difficulty of establishing the probability

for boilers was found to have been adopted by the plaintiffs as a fancy title associated with good luck. *Yorkshire Relish* was referred to as a "fancy word," although it could not have been registered under the Act: see [1896], 2 Ch. p. 92: 13 R. P. C. 235. The expression is also made use of in regard to trading names, see the judg-

ment of Kennedy, L.J., in *Daimler Motor Co. (1904), Ltd. v. London Daimler Co., Ltd.*, 24 R. P. C. 879 (1907), and the judgment of Parker, J., in *British Vacuum Cleaner Co., Ltd. v. New Vacuum Cleaner Co., Ltd.*, 24 R. P. C. 641 (1907).

¹ *Burberrys v. Cording*, 26 R. P. C. 693, at p. 701 (1909).

of deception is greatly increased. Again, if the person who seeks the injunction has not used the word or name simply for the purpose of distinguishing his own goods from the goods of others, but primarily for the purpose of denoting or describing the particular kind of article to which he has applied it, and only secondarily, if at all, for the purposes of distinguishing his own goods, it will be more difficult for him to establish the probability of deception. But whatever be the nature or history of the word or name, in whatever way it has been used, either by the person seeking the injunction or by others, it is necessary where there has been no actual deception, to establish at least a reasonable probability of deception."

It has sometimes been said that a descriptive word cannot be distinctive of the goods of a particular person until it has lost its descriptive meaning, but it may be doubted whether at the present time that proposition could be maintained. In the case just cited, relating to the words "Slip-On" for coats, Parker, J., said: "The word has never been used by the plaintiffs primarily as a word distinctive of goods of their own manufacture. If it has come to distinguish their goods from those of others, it has done so by acquiring a secondary meaning without losing its descriptive character. Though I do not agree with the argument that a word cannot be at the same time both descriptive and distinctive, I think the fact that it retains its *prima facie* descriptive signification increases the difficulty of proving that it is distinctive of the goods of any particular manufacturer."¹

Descriptive meaning need not be wholly lost.

Where a word, which is not a "fancy word,"² but is *prima facie* descriptive, is claimed as his trade name by the plaintiff, he must show that it has acquired a distinctive meaning "amongst those who are purchasers of the goods" in question³ within a definite area. Such area must extend to a large part of England and Wales and include the district in which the defendant trades or proposes to trade.⁴ If the word still

Area.

¹ *Burberrys v. Cording*, 26 R. P. C., at p. 704; see also the judgment of Moulton, L.J., in *Crosfield's Application*, [1910] 1 Ch. 118; 26 R. P. C. 837, quoted above, p. 187.

² See note (5), p. 565.

³ This was Ld. Herschell's phrase in *Reddaway v. Banham*, [1896] A. C. at p. 208; 18 R. P. C. at p. 227.

⁴ In *S. Chivers & Sons v. S. Chivers*

& Co., Ltd., 17 R. P. C. 420 (1909), Farwell, J., expressed the rule by saying that the secondary meaning must be "locally universal." He did not think that the area need necessarily comprise Scotland in order to establish a case in the English Courts. This goes too far. *Faulder v. Rushton*, p. 565, note (5), and the judgment of Moulton, L.J., in *Star Cycle Co. v. Frankenburgs*, 24 R. P. C.

continues to be used and understood with its original descriptive meaning by any considerable section of such persons, it cannot be monopolised.¹ And the more appropriate the words claimed are as a description of the goods or of some characteristic of the goods, the greater is the burden of proof required from the plaintiff.² If the plaintiff has had a monopoly in fact of the goods his difficulty is increased.³

405 at p. 414 (1907), where the learned Lord Justice said that small local *bona fide* users, which had been proved, did not affect his mind much with regard to the issue (the general reputation of the plaintiffs under the name *Star Cycle*). See also the judgment of Ld. Shand in the *Cellular Clothing* case cited below, note (1). In *Henry Thorne & Co., Ltd. v. Sandow*, 29 R. P. C. 440 (1912), Neville, J., found that the evidence did not suffice to prove that throughout the country "Health Cocoa" had acquired a secondary meaning, and at all events had not acquired that meaning in London, where it was almost unknown, and the action failed. See also cases as to registration, in which distinctiveness can only be established in particular districts, above, p. 190.

¹ *Parsons v. Gillespie*, [1898] A. C. 299; 15 R. P. C. 57, P. C. (*Flaked Oatmeal*); *Cellular Clothing Co., Ltd. v. Maxton*, [1899] A. C. 326; 16 R. P. C. 397, H. L. See also the judgments in the Court of Session in the last case, 15 R. P. C. 581.

² "I desire to say, speaking for myself, at all events, that where a person for his own purposes, for his own business, adopts such a title" (*American Shoe Co.*), "a title descriptive of the goods which he is selling, and another person is minded to adopt a title descriptive of the goods which he is going to sell, the very heavy burden lies upon the plaintiffs of proving that the adoption of this new title will cause deception, and, again, speaking for myself at all events, I think the Courts ought to be extremely careful to prevent the acquisition by persons who adopt a descriptive name, of a monopoly not only in that name, but in a name

descriptive of another class of goods": per Warrington, J., in *H. E. Randall, Ltd. v. E. Bradley & Son*, 24 R. P. C. 657, affirmed p. 773. The action of the plaintiffs (*The American Shoe Co.*) to restrain the defendants trading as *The Anglo-American Shoe Co.* was dismissed. "In all these cases if the primary meaning of a word is a simple and easy primary meaning, known to everybody, it is extremely difficult to establish that in any particular trade this word has lost its well-known and original meaning, and in that trade acquired a secondary meaning to the exclusion of the natural and original meaning of the word": per Vaughan Williams, L.J., in *Hommel v. Bauer & Co.*, 22 R. P. C. 43 (1905); *Hæmatogen* for a medicine held not to be distinctive. "The *Camel Hair Belting* case may be an example of what, under ordinary circumstances, it would be very difficult to establish": per Halsbury, L.C., in the *Cellular Clothing* case, [1899] A. C. at p. 336; 16 R. P. C. at p. 405. See also the judgment of Parker, J., in *Burberrys v. Cording*, 26 R. P. C. 693 (1909), at pp. 701, 704, and 709 (slip-on coats), cited above, pp. 566 and 567.

³ See Ld. Davey's judgment in the *Cellular Clothing* case, note (1), and Farwell, J., in *Ripley v. Griffiths*, 19 R. P. C. 590 (1902), where the plaintiffs had been the only manufacturers of laundry blue in an oval shape, but they failed to establish a secondary meaning of the words "Oval Blue"; also the *Naphtha Soap* cases, *Fels v. Christopher Thomas*, *Fels v. Stephenson*, *Fels v. Hedley*, 21 R. P. C. 85, 89 and 91, C. A.; and *Burberrys v. Cording*, note (2). And see *Bowden Wire, Ltd. v. Bowden Brake Co., Ltd.*, No. 2, Times, June 25th, 1913 (*Bowden Control*).

The question of fact which has to be answered in the cases under consideration has, accordingly, a negative as well as an affirmative part.¹

The question for the jury.

The possibility of proving that a word which is *primâ facie* descriptive is in reality a trade name is not an exception to the well-settled rule that no case of passing-off can be made out merely by showing that the defendant has adopted and used a descriptive or other "open" word previously used by the plaintiff.² Any trader is entitled to affix a true description to his goods in ordinary language; but if words are used which have lost their ordinary descriptive meaning and have acquired a new meaning which is not descriptive, they no longer constitute a true description.³

Literally true description may mislead.

¹ In his direction to the jury in *A. W. Gamage, Ltd. v. H. E. Randall, Ltd.*, 16 R. P. C. 185 (1899), at p. 196, Russell, L.C.J., said: "The first point is, have Gamages made out to your satisfaction that *Shorland* means a buckle and strap shoe sold by Gamage & Co. *exclusively*, so that the person who sold the shoe under the name of *Shorland* would be passing off as Gamages' what was not Gamages', but his own, and so that a person buying it would believe that he was getting Gamages' and not the shoe of the man who sold it to him." This was approved by the C. A. In *Reddaway v. Banham*, [1895] 1 Q. B. 286; [1896] A. C. 199; 12 R. P. C. 83; 13 R. P. C. 218, the questions put to the jury were:—1. Does *Camel Hair Belting* mean belting made by the plaintiffs as distinguished from belting made by other manufacturers? (*Answer, Yes.*) 2. Or does it mean belting of a particular kind without reference to any particular maker. (*Answer, No.*) 3. Do the defendants so describe their belting (*i.e.*, by using the term) as to be likely to mislead purchasers, and to lead them to buy the defendants' belting as and for the belting of the plaintiffs? (*Answer, Yes.*) 4. Did the defendants endeavour to pass off their goods as and for the goods of the plaintiffs, so as to be likely to deceive purchasers? (*Answer, Yes.*) Upon these findings, Collins, J., gave judgment for the plaintiffs; the

Court of Appeal reversed the judgment on the ground that the term was descriptive; but the House of Lords restored it. It appears from all the judgments that the fourth question was superfluous.

² *Kelly v. Byles*, 13 C. D. 682 (1880), Bacon, V.-C., and C. A. (*Post Office Directory*); *Schove v. Schmincke*, 33 C. D. 546 (1886), Chitty, J. (*Castle Album*); *Great Tower Tea Co. v. Smith*, 6 R. P. C. 165; 5 T. L. R. 232 (1889), North, J. (*Tower Tea*); *Burland v. Broxburn Oil Co.*, 42 C. D. 274; 6 R. P. C. 482 (1889), Chitty, J. (*Washerine*); *Rugby Portland Cement Co., Ltd. v. Rugby and Newbold Portland Cement Co., Ltd.*, 8 R. P. C. 241; 9 R. P. C. 46 (1891), Vaughan Williams, J., and C. A. (*Rugby Portland Cement*); *The Colonial Life Assurance Co. v. The Home and Colonial Assurance Co., Ltd.*, above p. 553; *Magnolia Metal Co. v. Atlas Metal Co.*, 14 R. P. C. 389, Collins, J., and C. A. (1897), (*Magnolia Metal*); *Parsons v. Gillespie and Cellular Clothing Co., Ltd. v. Maxton*, above, p. 568, note (1).

³ "Even a description of goods which is literally true may be so framed as to deceive": per Ld. Davoy in *Grand Hotel Co. of Caledonia Springs, Ltd. v. Wilson*, 21 R. P. C. at p. 134. In *Reddaway v. Banham*, [1896] A. C. at p. 212; 13 R. P. C. at p. 229, Ld. Herschell said: "I rather demur, however, to the

A descriptive word must not, moreover, be used as a mere blind. Where an ingredient, oxide of iron, was used in making medicinal tablets merely to justify the use of the name "Compound Iron Oxide Tablets," and the name was chosen because it would lead to confusion with the plaintiffs' "Iron-Ox Tablets," and not because it could be said to correctly describe the article, an injunction was granted against the use of the term iron oxide without better distinguishing the defendants' goods from those of the plaintiffs. The plaintiffs' goods did not contain oxide of iron, which was practically useless as a drug, and the name "Iron-Ox Tablets" was held to indicate their tablets and was not associated by the public with any particular drug.¹

Evidence.

It will be useful to contrast the evidence in some of the modern cases in which the plaintiffs succeeded with that in others in which they failed. In *Reddaway v. Banham*,² although it was admitted that the yarn of which the belting was made consisted for the most part of camel hair,³ it was shown that the name camel-hair belting had never been current as a description in the trade, a number of other names being used, and there was evidence that the defendant had adopted the name in order to deceive purchasers, and that he was likely to succeed in deceiving them by its use. In *Powell v. The Birmingham Vinegar Brewery Co.*,⁴ numerous wholesale and retail grocers, export agents,

statement of James, L.J., that the defendant in *Wotherspoon v. Currie* (above, p. 55) was not telling a lie in calling his starch *Glenfield Starch*, as I do to the view that the defendants in this case were telling the simple truth when they sold their belting as camel-hair belting. I think the fallacy lies in overlooking the fact that a word may acquire in a trade a secondary meaning differing from its primary one, and that if it is used to persons in the trade who will understand it in its secondary sense, it will be none the less a falsehood that in its primary sense it may be true." Ld. Macnaghten said (at p. 219; 13 R. P. C. at p. 233): "At Banham's works, where it cannot mean Reddaway's belting, it may be construed to mean belting made of camel's hair; abroad, to the German manufacturer, to the Bombay mill-owner, to

the up-country native, it must mean Reddaway's; it can mean nothing else. I venture to think that a statement which is literally true, but which is intended to convey a false impression, has something of a faulty ring about it; it is not sterling coin; it has no right to the genuine stamp and impress of truth."

¹ *Iron-Ox Remedy Co., Ltd. v. Co-operative Wholesale Society, Ltd.*, 24 R. P. C. 425 (1907), Parker, J.

² Above, p. 565. See the findings of the jury, p. 569, note (1). And other "camel hair" cases below, p. 612, note (2).

³ Cf. the earlier case, *Reddaway v. Bentham Hemp Co.*, [1892] 2 Q. B. 639; 9 R. P. C. 503, C. A., where there was no such admission.

⁴ [1894] 3 Ch. 449; 11 R. P. C. 563, interlocutory injunction; [1896] 2 Ch.

travellers, saucemakers and purchasers, and scientific witnesses were called, and the effect of their evidence, stated shortly, was that if a purchaser asked for Yorkshire Relish he would expect to get the plaintiffs' sauce. There was also evidence of actual deception.¹ In this case, as there was no other maker of the sauce but the plaintiffs themselves, the defendants' ² sauce being a clever imitation, but not the same thing, it was inevitable that the name should indicate the plaintiffs' goods. This circumstance might have gone some way to displace the plaintiffs' evidence, as in the cases next cited, if the defendants had been prepared to sell the goods which, according to their own contention, were described by the name.

On the other hand, in *Parsons v. Gillespie*,³ a number of grocers proved that when asked by their customers for "Flaked Oatmeal" they supplied the plaintiff's goods; but there was no evidence of actual deception or confusion, and the value of the evidence first mentioned was discounted by the fact that it wholly or chiefly referred to a period when there were no other goods of the kind in question in the market besides the plaintiff's goods. In *The Cellular Clothing Co., Ltd. v. Maxton*,⁴ the plaintiffs' evidence consisted of (a) their own advertisements, in which they used the word "cellular" to describe their cloth, but did not suggest that its use distinguished their cloth from cloth of a similar description made by others; ⁵ (b) statements of witnesses who said that they understood "cellular goods" to mean the goods of the plaintiffs, but who did not say that they knew of any other manufacturers making similar classes of goods; and (c) consent orders for injunctions obtained against other persons who had used the name. In both of these cases the plaintiffs failed.

Secondary meaning not acquired while no competition.

In *A. W. Gamage, Ltd. v. H. E. Randall, Ltd.*,⁶ where the

54; [1897] A. C. 710; 13 R. P. C. 295; 14 R. P. C. 710, Stirling, J., C. A. and H. L.

¹ [1896] 2 Ch. p. 57.

² Above, p. 540.

³ See [1898] A. C., p. 254; 15 R. P. C., p. 62.

⁴ See [1899] A. C. at p. 345; 16 R. P. C. at p. 410. The cases are reviewed in *British Vacuum Cleaner Co. v. New Vacuum Cleaner Co.*, 24 R. P. C. 641 (1907), Parker, J.

⁵ It is not sufficient to show exten-

sive advertising apart from the effect of the advertisement. "To make an advertisement relevant you must show that it had an effect." Per Vaughan Williams, L.J., in *Christy v. Tipper*, 21 R. P. C. 97 (1904), at p. 101. See also *Chivers & Sons v. Chivers & Co. Ltd.*, 17 R. P. C. 420 (1900), Farwell, J., at p. 431.

⁶ 16 R. P. C. 185 (1899), Russell, L.C.J., and C. A. (*The Shorland Cycling Shoe*). See above, p. 569, note (1).

Word
qualified by
plaintiff's
name.

plaintiffs were retail shopkeepers, a mass of evidence was called on both sides. The plaintiffs relied principally on the evidence of purchasers, of retail dealers, and of writers in trade newspapers; the defendants principally on that of wholesale dealers. It was admitted that there were in the market shoes of the same pattern as the shoes in question made by other makers, but it was proved that the plaintiffs invariably used, besides their alleged trade name, a stamp bearing the name of the company. Some of the plaintiffs' witnesses admitted that if they saw the name without the stamp they would not think the goods were the plaintiffs'. The jury found for the defendants, being possibly influenced by the admission just mentioned, and the Court of Appeal refused to disturb their verdict.¹

Name of
introducer or
patentee.

The name of the inventor or first introducer of goods which are new to the market, or the name which he gives to those he manufactures or sells, is very readily adopted as the name of goods by whomsoever they are made; and in the case of goods made under a patent, the Court is careful not to extend the patentee's monopoly by forbidding other manufacturers, after the patent has expired, to sell goods lawfully made by them according to its specification under the only name by which they are known.²

In *James v. James*,³ Romilly, M.R., said that anyone who was possessed of the secret of an invention might make the goods according to it, and might sell them under the name of the inventor after his death, but might not sell them in his lifetime, so as to suggest that they were made by him. But the distinction here suggested was questioned by James, L.J.,⁴ in a later case, for the death of the inventor would not necessarily prevent the use of his name being calculated to pass off the goods of others as goods manufactured in the business lately carried on by him, if his successors were continuing the business; and, on the other hand, during his lifetime, if there was no monopoly in the manufacture, anyone might state that the goods were made according to his system. It is material also to remember that

¹ So in *Hommel v. Bauer*, 22 R. P. C. 43 (1905), the plaintiff had called his goods "Dr. Hommel's Hæmatogen." See the judgment of Vaughan Williams, L.J., and *Actiengesellschaft Hommel's Hæmatogen v. Hommel*, 29 R. P. C. 378 (1909). Further illustrations will be

found under the heading, "Right to trade under one's own name," below, p. 593.

² See Chap. II., p. 45.

³ L. R. 13 Eq. 421 (1872) (*Lieutenant James' Horse Blister*).

⁴ *Massam v. Thorley's Cattle Food Co.*, 14 Q. D. p. 754 (1880).

the name of the first maker or inventor is often understood to imply the good quality of work or materials which has brought the new goods into favour rather than the mode of manufacture or the nature of the ingredients employed.¹ Where this is the case the use of the name by traders who have no connection with him must almost always be calculated to deceive.

On the other hand, names which once carried a distinctive reference to a particular trader may, in consequence of successful piracies, or of their use by the trader himself for goods which are the goods of others, or are put forward as such,² or for other reasons, lose it and fall into common use and become *publici juris*,³ in the same way as trade marks may be lost or abandoned. Accordingly, evidence is admissible to show that a word which was once distinctive of a particular trader's goods has become common in the trade. But, where the distinctive meaning alleged is proved to hold generally for the trade and public, cases of small local user for the goods of other traders will not have much effect to displace the evidence.⁴

Names may become *publici juris*,

The question is, What is the meaning of the name for the time being? it is possible therefore for a word which has at one time been the trade name of one trader to become so identified with the goods of a rival trader as afterwards to become the trade name of the latter,⁵ who may thereby acquire an exclusive right to its use,⁵ or, if its association with the original owner has continued, a right concurrent with his right.⁶

or become associated with another trader.

Similarly a word which has, at one time, been in common use in a trade with a mere descriptive meaning may subsequently come to have special reference to the goods of a particular

¹ See the last case; and cf. the use of "original," above, p. 53.

² *Wood v. Butler*, 32 C. D. 247; 3 R. P. C. 81 (1886), C. A. (*Eton Cigarettes*). See also *Wolff v. Nopitsch*, 17 R. P. C. 321 (1900), Cozens-Hardy, J.; 18 R. P. C. 57 (1901), C. A.; and above, p. 224, note (1).

³ Chap. II., p. 40; and Chap. XIV., p. 405. In *Gledhill & Sons, Ltd. v. British Perforated Toilet Paper Co.*, 28 R. P. C. 429, 714 (1909), Eve, J., and C. A., Eve, J., found that Gledhill coils were in 1902 distinctive of the plaintiffs', but in 1909 had come to mean merely

coils for Gledhill tills; the Court of Appeal only dealt with the position in 1909.

⁴ *Star Cycle Co. v. Frankenburgs*, 24 R. P. C. 405 (1907), see the judgment of Moulton, L.J.; *Boord v. Thom and Cameron, Ltd.*, 24 R. P. C. 697 (1907), Sc., and cf., "area," above, p. 567. For the converse, see p. 574, note (1).

⁵ *Daniel and Arter v. Whitehouse*, [1898] 1 Ch. 685; 15 R. P. C. 134, Gorell Barnes, J. (*Brazilian Silver*); cf. next case.

⁶ *Edge & Sons, Ltd. v. Gallon & Son*, 16 R. P. C. 509 (1899), C. A. (*Dolly Blue*).

trader, who will then be entitled to prevent others using it without sufficiently distinguishing their goods.¹

The fact that the plaintiff has for some of his goods a special name does not necessarily negative his right to a more general name; for instance, in *The Worcester China* case,² the plaintiffs had used the terms "Royal Worcester" and "Grainger's Worcester China" for some of their goods, and it was contended that by their conduct they had abandoned or lost their rights in "Worcester China" *simpliciter*, but this defence failed.

Disclaimed
word.

Under the old Act it was decided that a word, or other particular, forming part of a registered label or other trade mark, which the plaintiff had disclaimed as a condition of registration, was necessarily open, and that the plaintiff could not be heard to allege that by itself it formed a distinctive mark.³ It is now expressly provided that no disclaimer shall affect any rights of the proprietor of a trade mark except such as arise out of the registration.⁴ In the case of a word or mark which has been expunged from the Register, even though it was expunged without the plaintiff's assent, the removal of the mark does not and never did prevent the plaintiff from showing that the mark is, nevertheless, distinctive of his goods,⁵ but the Court may infer that other traders have refrained from using the word not because they knew it to mean the plaintiff's goods, but merely because of the registration.⁶ It has already been shown that a trade mark which has never been registered, or which has been removed from the Register, may be the basis of a passing-off case.⁷

Expunged
trade mark.

¹ *Daimler Motor Co. (1904), Ltd. v. London Daimler Co., Ltd.*, 23 R. P. C. 718; 24 *ib.* 379 (1906), Buckley, J., and C. A. A word which has denoted the goods of two or three separate firms may come to denote the goods of one only, *Worcester Royal Porcelain Co., Ltd. v. Locke*, 19 R. P. C. 479 (1902), Byrne, J., where, however, the plaintiffs were the successors of all the three firms who had previously used the term "Worcester" to denote their goods.

² See note (1). But the use of a special name is a matter to be considered, cf. *Whitstable Oyster Fishery Co. v. Hayling Fisheries, Ltd.*, 17 R. P. C. 461; 18 R. P. C. 484, Buckley, J., and C. A.

³ *Rosenthal v. Reynolds*, [1892] 2 Ch. 301; 9 R. P. C. 189, North, J. (*W. R. Corsets*), interim injunction refused. This was not followed by the Scotch Court in *Bayer v. Baird*, 15 R. P. C. 615 (1898) (*C. B. Corsets*). Might not the plaintiff show, at any rate, that the word has acquired a distinctive meaning after the registration?

⁴ Sec. 15.

⁵ See *The Yorkshire Relish* (above, pp. 540 and 570) and *Stone Ale* (above, p. 378) cases.

⁶ *Hommel v. Bauer*, 21 R. P. C. 576 (1904), Warrington, J., at p. 587; affirmed on appeal, 22 R. P. C. 48.

⁷ Above, p. 591; Chap. XII., p. 377. In *Paine & Co. v. Daniells & Sons'*

But an open word, that is to say, a non-distinctive word, or open words, may be an important element in the plaintiff's labels, and the use of the same word or words by the defendant in the same manner, especially if coupled with the use of other details of "get-up" which are similar to those which the plaintiff uses, may be strong evidence to support a passing-off case based upon imitation of get-up.¹

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

This was pointed out by Wood, V.-C., in *Woollam v. Ratcliff*,² where, in commenting upon *The Omnibus* case,³ he said: "The words *Conveyance Company*, the green omnibus, &c., were held sufficient together to entitle the plaintiffs to an injunction. The defendant might have had those words painted on a yellow omnibus without objection, and so of the other resemblances; the wrong lay in their accumulation, not in any one of them alone."

In the case of trade names which are *prima facie* geographically descriptive, a special order has sometimes been made in order to avoid any interference with the honest and proper use of them by persons other than the owner of the trade name. Thus, in *Braham v. Beachim*,⁴ the plaintiff, being owner of all the collieries in Radstock, except a very small one, traded as the "Radstock Coal Co.," and the defendants began to sell coal under the same name, and also as "The Radstock Colliery Proprietors." An injunction was granted, "to restrain the defendants, unless and until they shall acquire a colliery or coal mine within the parish of Radstock, from trading under, or using, the name or style of 'The Radstock Colliery Proprietors,' or any other name or style signifying that the defendants or

Geographical names.

Breweries Co., Ltd., [1893] 2 Ch. 567; 10 R. P. C. 217 (*John Bull Beer*), the C. A. assumed that the plaintiffs must fail if their trade mark were expunged from the Register, although the action was brought, not only in respect of infringement, but also in respect of passing-off. But the case was a peculiar one, for the only matter which led the Court to think the defendants' conduct was calculated to pass off their goods as those of the plaintiffs, was the use by the defendants of a label, bearing the words *Registered* and *John Bull*, whereas, in fact, the only *registered* John Bull mark was that of the plain-

tiffs. The use of the word "registered" in connection with the label complained of was an element also in *Boord & Son v. Huddart*, 21 R. P. C. 149 (1904), at p. 158, Swinfen Eady, J.

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

² 1 H. & M. 259 (1863).

³ *Knott v. Morgan*, 2 Keen, 213 (1836), Ld. Langdale, M.R., and Cottenham, L.C.

⁴ 7 C. D. 848 (1878), Fry, J.

either of them are proprietors of any colliery or collieries at Radstock." Subsequently the defendants acquired a colliery, but not in Radstock, and began to trade as "The Radstock Coal and Waggon Co., Colliery Proprietors, Radstock, Somerset," and a motion to commit for breach of the injunction was refused on the ground that the terms used by them did no more than imply that they were proprietors of collieries, and that their place of business was at Radstock, and this was true.¹ So, in *The Whitstable Oyster* case,² where it was held that the name "Whitstable Native Oysters" meant the plaintiffs' oysters, and could not be fairly used of French oysters relaid and brought to maturity at Whitstable; the learned judge said, the plaintiffs' right in respect of the name was subject to the inconvenience that the name might honestly be used by anyone to describe real Whitstable natives, whether the plaintiffs' oysters or not.³

It may be doubted whether the decision in *The Radstock Colliery* case, and the dicta just referred to, are consistent with the judgments delivered in the House of Lords, in *The Stone Ales* case,⁴ where, although the right of the appellant to state

¹ Seb. Dig. p. 633 (1878), Fry, J.

² *Free Fishers of Whitstable v. Elliot*, 4 Times L. R. 273; W. N. (1888), 27, Stirling, J., interlocutory injunction to restrain the use of *native*: no order as to *Whitstable*. In the later case of *The Whitstable Oyster Fisheries Co. v. The Hayling Fisheries, Ltd.*, 17 R. P. C. 461; 18 *ib.* 484 (1900), Buckley, J., and C. A., it was decided that "Whitstable," as applied to oysters, was descriptive of the place where the oysters reach maturity.

³ Cf. also *Bewlay v. Hughes and Wolff v. Nopitsch*, above, p. 55 note (5) and p. 56 note (1). In *Hopton Wood Stone Firms, Ltd. v. Gethings*, 27 R. P. C. 605 (1910), Parker, J., it was held that *Hopton* or *Hopton Wood* in connection with stone did not connote stone from the plaintiffs' quarries only or from a particular seam, and that the defendants had a right to sell their stone as *Hopton* or *Hopton Wood* stone. In *Grand Hotel of Caledonia Springs, Ltd. v. Wilson*, [1904] A. C. 103; 21 R. P. C. 117, P. C., it was held that the defendants were entitled to indicate that their mineral waters came from the Cale-

donia Springs. Cf. *Apollinaris Co., Ltd. v. Duckworth*, 23 R. P. C. 540 (*Apollinaris Salts*) (1906), Warrington, J., and C. A., and *Rey v. Lecouturier*, [1908] 2 Ch. 715; [1910] A. C. 262; 25 R. P. C. 265; 27 R. P. C. 268 (H. of L.) (*Chartreuse*). In *Price's Patent Candle Co., Ltd. v. Ogston and Tennant, Ltd.*, 26 R. P. C. 791 (1910), L. O. Scotland, the defendants were restrained from selling their candles as "London candles" without distinguishing them from the plaintiffs'. In *Brock & Co.'s Crystal Palace Fireworks, Ltd. v. Pain*, 28 R. P. C. 461 and 697 (1911), the plaintiffs established that Crystal Palace fireworks meant their fireworks, and that notwithstanding their contract to give displays at the Crystal Palace had determined; a contention that the name was geographical failed.

⁴ *Montgomery v. Thompson*, [1891] A. C. 217; 8 R. P. C. 361; *Worcester Royal Porcelain Co., Ltd. v. Locke & Co.*, 19 R. P. C. 479 (1902), Byrne, J. See also *The Yorkshire Relish* case, above, p. 540.

that his beer was brewed at Stone was recognised, it is held to be subject to an obligation not to do so in any manner calculated to cause the appellant's beer to be passed off as that of the respondents, which was commonly known as *Stone Ale*, and the learned Lords were clearly of opinion that the obligation would prevent the appellant from using the last-mentioned term at all. And if, as required by the rule laid down in the authorities, the plaintiff proves that an apparently descriptive word which he claims to appropriate has ceased to have a purely descriptive meaning, it is difficult to imagine how the defendant can be truthfully using the word with that meaning.¹

An author can restrain the publication under his name of books which are not written by him, on the same principles as a trader can obtain an injunction to protect his trade name or that of his goods.² And, further, it has been held that the writer of a work can maintain an action against the owner of the copyright for the damage occasioned to his reputation by the publication of a new edition of the book, purporting to be prepared by him, but in fact not so prepared.³ But in the case of a serial publication, the purchaser of the goodwill of the business of conducting it—sometimes, but erroneously, called the copyright in the publication—is at liberty to publish subsequent numbers under the old name after determining his business relations with the author or editor of earlier numbers, and notwithstanding that the name is that of the first editor or author.⁴

The author's right to prevent the work of another being passed off as his is, of course, quite distinct from the copyright which he may have in his own work. Upon the principle already stated,⁵ the right here under consideration will not enable him to stop the republication under his name of his own, non-copyright, work.⁶

¹ Above, p. 569.

² *Lord Byron v. Johnson*, 2 Mer. 29 (1816), Eldon, L.C.; cf. *Barnard v. Pillow*, W. N. (1868), 94, Romilly, M.R. (music); and *Martin v. Wright*, 6 Sim. 297 (1839), Shadwell, V.-C., copy of work of diorama painter.

³ *Archbold v. Sweet*, 1 M. & R. 162; 5 C. & P. 219 (1832), Ld. Tenterden, C.J. In *Lee v. Gibbins*, 66 L. T. 263 (1892), Kekewich, J., said the question was one of libel. He refused an interim injunction. See Chap. XVIII., p. 622.

⁴ *Ward v. Beeton*, L. R. 19 Eq. 207 (1874), Malins, V.-C. (*Beeton's Christmas Annual*); cf. *Condy v. Mitchell*, 37 L. T. N. S. 766 (1877), C. A. (*Condy's Fluid*). A late editor would be restrained from advertising that a serial is discontinued; *Bradbury v. Dickens*, 27 Beav. 53; 28 L. J. Ch. 667 (1859), Romilly, M.R. (*Household Words*).

⁵ Above, and pp. 528, 561.

⁶ *Clemens v. Belford*, 14 Fed. Rep. 728 (1883), Amer. (*Mark Twain*).

Title of book: Titles of books, newspapers, or other publications, are also protected on the same principles, that is, as trade names, and no cause of action arises, therefore, unless it is shown that the title is known to indicate the plaintiff's book or paper, so that its use by the defendant would be calculated to lead to deception.¹ There is no copyright in such titles.²

C. Imitation of Get-up.

Get-up common to the trade.

The general appearance of a trader's goods as they are presented to purchasers is often the most important of the signs by which the goods are recognised as his, and an imitation of it frequently affords the readiest means by which a fraudulent rival, and fraudulent retail dealers in collusion with him, can pass off his goods as the goods of the other. The cases falling under this head are almost necessarily cases of deliberate fraud, for such similarity of "get-up" as is calculated to deceive is, as a rule, the result of a resemblance, more or less close, in a number of corresponding details, and this can hardly happen by accident or coincidence. In effect, if the get-up of the defendant's goods appears, on first inspection, closely to resemble that of the plaintiff's, and it is shown that it has recently been adopted by him, the only explanation, consistent with honest conduct, that can ordinarily be given is, that the leading features of the get-up are common to the trade in question. A familiar example of such common features is the square tin box covered with yellow paper, bearing red and black letters, of the mustard trade.³

¹ *Schove v. Schmincke*, 33 C. D. 546 (1886), Chitty, J. (*Castle Album*); *Borthwick v. The Evening Post*, 37 C. D. 449 (1888), Kay, J., and C. A.; *Walter v. Emmott*, 54 L. J. Ch. 1059 (1885), C. A. (*The Morning Mail*); and cases in the next note. *Outram v. London Evening Newspapers Co.*, 28 R. P. C. 308 (1911), Warrington, J. (*Evening Times*), injunction refused; *Ridgeway, Ltd. v. Amalgamated Press, Ltd.*, 29 R. P. C. 190 (1912), Warrington, J. (*Everybody's Magazine and Everybody's Weekly*).

² *Dicks v. Yates*, 18 C. D. 76 (1880), Bacon, V.-C., and C. A. (*Splendid Misery*); *Licensed Victuallers' News-*

paper Co. v. Bingham, 38 C. D. 139 (1888), North, J., and C. A. (*Licensed Victuallers' Mirror*.)

³ See *Farrow's Tm.*, 7 R. P. C. 260; 63 L. T. 233 (1890), Stirling, J. Other examples will be found in *Jamieson & Co. v. Jamieson*, 15 R. P. C. 169 (1898), C. A., overruling Byrne, J.; *Packham & Co. v. Sturgess & Co.*, 15 R. P. C. 609 (1898), North, J., and C. A.; *Payton & Co. v. Snelling, Lampard & Co.*, 17 R. P. C. 48 and 628, C. A. and H. of L., enamelled tins for French coffee, reversing Byrne, J., 16 R. P. C. 283. *King v. Gillard*, 22 R. P. C. 327 (1905), C. A. (*desiccated soup in steel boxes*). J. B.

What is compendiously called the "get-up" of goods—the dress in which they are presented to the buyer¹—comprises, in particular, the size and shape of the packages,² where the goods have no definite outline, or none which is shown to the buyer, the material, colour, and decoration of their wrappers, and the lettering and arrangement of their labels.³ Thus, in *Lever v. Goodwin*,⁴ the plaintiffs sold their soap in packets wrapped up in a peculiar parchment paper, with *Sunlight Self-washer* printed in spaced type upon the wrapper; the defendants began to use similar packets and paper, with the words *Goodwin's Self-washing Soap* printed upon it in similar type. It was treated as an obvious case of fraud.⁵

"Looking at the two tablets," Cotton, L.J., said, "one cannot but see that there is a strong general resemblance between them, and especially in the eyes of people who cannot read. But (the defendants') contention was this: there is no trade mark in *Self-washer* or *Self-washing*;⁶ there is no monopoly in this

No monopoly
in the con-
stituent
elements.

Williams Co. v. Bronnley, 26 R. P. C. 481, 765 (1909), Neville, J., and C. A. (shaving soaps in maroon coloured tin boxes).

¹ In *Knott v. Morgan*, 2 Keen, 213 (1836), Langdale, M.R., and Cottenham, L.C., the fraud consisted in the imitation of the painting of the plaintiff's omnibuses, the uniforms of their servants, and the use of their descriptive title—the London Conveyance Co. The facts in *The London General Omnibus Co. v. Felton*, 12 T. L. R. 213, Chitty, J., and *London Road Car Co. v. Era Omnibus Assn.* (1898), *Times*, June 23; (1899) *Times*, April 28, were similar.

² In *Ripley v. Bandy*, 14 P. P. C. 591, Kekewich, J., the blue was done up in oval packets, and thence called *Oval Blue*; the case was settled on appeal, 14 R. P. C. 944. In *Jones v. Hallworth*, 14 R. P. C. 225 (1897), Kekewich, J., the colours, patterns, shape, and sizes of the plaintiff's *Selvyt* dusters were imitated. Cf. *Jones v. Anglo-American Optical Co.*, 29 R. P. C. 1 and 361 (1912), Swinfen Eady, J., and C. A., where the action failed. In *Elliott v. Hodgson*, 19 R. P. C. 518 (1902), Buckley, J., flat ended cigars were imitated.

³ A curiously shaped stick on which

the plaintiffs' carpets were rolled has been protected in America: *Lowell Manufacturing Co. v. Larned*, Cox, 2nd ed., p. 241. In *Parker and Smith v. Satchwell*, 18 R. P. C. 299 (1901), Farwell, J., the show cards on which the defendant's goods were sold closely resembled those used by the plaintiffs. In *Liquid Veneer Co. v. Scott*, 29 R. P. C. 639 (1912), Swinfen Eady, J., in addition to imitating the get-up of the plaintiffs' polish known as "Liquid Veneer," the defendants called their polish "Elve."

⁴ 36 C. D. 1; 4 R. P. C. 492 (1887), Chitty, J., and C. A. Cf. *Lever v. Bedingfield*, 16 R. P. C. 3 (1899), C. A.

⁵ Imitations of the descriptive and commendatory inscriptions, and of the directions for use printed on the covers of patent medicines and proprietary articles are very common: *Franks v. Wearer*, 10 Beav. 297 (1847), Langdale, M.R.; and *Massam v. Thorley's Cattle Food Co.*, 14 C. D. 748 (1880), C. A., are instances. As to prizes, medals, and testimonials, see above, p. 537, and below, p. 587, note (1).

⁶ It had been struck off the Register on the defendants' application.

parchment paper; there is no monopoly in the spaced printing; then why should we be restrained, in carrying on business, from using those things as to which the plaintiffs cannot claim any monopoly? That is an obvious fallacy. There may be no monopoly at all in the individual things, but, if they are so combined by the defendants as to pass off the defendants' goods as the plaintiffs', then the defendants have brought themselves within the old common law doctrine in respect of which equity will give to the aggrieved party an injunction to restrain the defendants from passing off their goods as those of the plaintiffs."¹

*Edge v.
Nicolls.*

In the recent case of *Edge v. Nicolls*,² the get-up of the plaintiffs' goods, laundry blue, consisted in the blue being put up in a porous bag, the neck of which was tied round, and a small stick with a knob on it protruded out of the neck, and by means of this stick, the article could be conveniently held and dipped into the water. The plaintiffs' blue had no label on it. The defendants took substantially the same get-up, but put a label round the bag, having their name on it prominently. Many of the plaintiffs' customers bought entirely by the appearance of the goods, and did not know the name of the makers. The Court of Appeal held that the stick was part of the article and not of the get-up, and decided against the plaintiffs. The House of Lords allowed the plaintiffs' appeal, holding that the get-up, including the particular form of stick, was associated with the plaintiffs, and that the defendants had not sufficiently distinguished. Lord Gorell, who delivered the principal judgment, said that if the plaintiffs had been claiming to prevent the use by the defendants of "a stick," he should have agreed with the Court of Appeal.³ The case therefore shows that a plaintiff cannot claim as get-up what is merely useful in the article itself,⁴ but a special design of a useful part may form part of the get-up.

¹ *Blofeld v. Payne*, 4 B. & Ad. 410; 2 L. J. K. B. (N. S.) 68 (1833), imitation of envelope; *Great Tower Street Tea Co. v. Langford & Co.*, 5 R. P. C. 66 (1887), Stirling, J., of packets; *Hammond v. Brunner*, 9 R. P. C. 301 (1892), Chitty, J., of label; *Stephens v. Peel*, 16 L. T. N. S. 145 (1867), Wood, V.-C., of bottle, and steel-pens for *Stephens*.

² (1911) 1 Ch. 5; (1911) A. C.; 29 R. P. C. 53 and 582.

³ The order for an injunction made by Swinfen Eady, J., was restored, but with a modification in the form of injunction.

⁴ The judgment of Fletcher Moulton, L.J., in the earlier case of *J. B. Williams & Co. v. Bronnley*, 26 R. P. C. 765, at p. 773, was to the same effect. "The

No case can be made merely by showing an imitation of the parts of the get-up of goods which are common to the trade.¹ And even where a trader introduces a new feature into the get-up of his goods he does not thereby acquire any proprietary interest in it, so as to be able to prevent its use by competitors without proving that it has become so identified with his goods that its use by others is calculated to deceive.² The fact that the peculiarities of get-up which are relied on by the plaintiff have become identified with and distinctive of his trade must be proved as in any other case of passing-off.³ But very little evidence of user may be sufficient where the get-up is not only novel but striking.⁴ The case is then analogous to that of a "fancy word."

Get-up common to the trade,

or newly introduced.

It is not, however, necessary that every part of the get-up should be imitated, for, though no exclusive right to the use of any single feature of it which is not a registered trade mark is recognised, yet a part of the get-up, a picture, for instance, which is used on the label or wrapper, may be shown to be so identified with the plaintiff's goods that its use for similar goods is calculated to pass them off as his. The picture, in effect, may become—as the trade name of the plaintiff's goods may—a "common law trade mark."⁵

Imitation of part of get-up.

get-up of an article means a capricious addition to the article itself, the colour, or shape, it may be, of the wrapper, or anything of that kind; but I strongly object to look at anything, that has a value in use, as part of the get-up of the article."

¹ Page 578, n. (3). *Imperial Tobacco Co. v. Purnell*, 21 R. P. C. 368, 598 (1904), Joyco, J., and C. A., narrow red bands for cigars. *Coleman & Co. v. Stephen Smith & Co.*, 28 R. P. C. 645; 29 R. P. C. 81 (1912), reversing Swinfen Eady, J., on the finding that the defendants' get-up was calculated to deceive.

² In *Payton v. Snelling, Lampard & Co.* (above, p. 578, n. (8)), the plaintiffs had been the first to put up coffee in tins enamelled in bright colours. The practice was soon followed, and it was held that the plaintiffs had no monopoly in such tins; and in *J. B. Williams & Co. v. Bronnley*, 26 R. P. C. 481, 765 (1909), Neville, J., and C. A., the plaintiffs had

been the first, and for years, the only persons to put on the market shaving sticks in tin-lined boxes with maroon covers, but at the date of the action these features were held to be common. In *De Long Hook and Eye Co. v. Newey*, 29 R. P. C. 49 (1912), Warrington, J., it was held that the get-up of the cartons in which the plaintiffs sold their hooks and eyes in bulk, even if novel, had not become associated with them. See also the remarks of Kekewich, J., in *Hubbuck v. Brown*, 17 R. P. C. at p. 154 (1900), and in *Alaska Packers' Association v. Crooks*, 18 R. P. C. 129 (1901), as to the fashion of the market.

³ See note (2); and *Jones Bros., Ltd. v. Anglo-American Optical Co.*, 29 R. P. C. 361 (1912), C. A.

⁴ *Weingarten v. Bayer*, 22 R. P. C. 841 (1905), H. L. (*Erect Form* with corsets written in a flourish of the E).

⁵ Above, p. 531, and *Weingarten v. Bayer*, supra.

Thus, in *Jay v. Ladler*,¹ the plaintiff used the device of a lady and a bear, in his trade as a furrier, by attaching it to the wrappers and boxes in which he sent out his goods, but he had registered it only as a trade mark for sealskin mantles and coats. The defendant began to issue a circular, bearing a similar mark, in connection with his trade, which was also that of a furrier. Two injunctions were granted, one, restricted to the mantles and coats, to restrain infringement of the trade mark, the other, not so restricted, to restrain the defendant from using the device so as to deceive the public.

And, on the other hand, the imitation of a number of things, each of which is in itself not distinctive of the plaintiff's goods, may make a strong case on account of the cumulative effect of the detailed resemblances.²

Only things which are put prominently forward so as to be likely to catch the eye of a purchaser and remain in his memory need generally be considered. Thus, the printing on the back or sides of a box may usually be disregarded in considering whether the get-up of goods is likely to deceive.³

It is no answer to a case founded on passing-off by "get-up" that the plaintiff's trade mark which appears on his goods or the special name of his goods is not taken or infringed. But if a plaintiff by his cautions and advertisements shows that he relies wholly or mainly on his trade mark or trade name, he makes his case on general get-up, apart from trade mark or trade name, more difficult to establish.⁴

¹ 40 C. D. 649; 6 R. P. C. 136 (1888), Kekewich, J.; see also *Hart v. Colley*, 44 C. D. 193; 7 R. P. C. 93 (1890), North, J.; and *Great Tower Street Tea Co. v. Langford & Co.*, 5 R. P. C. 66 (1887), Stirling, J.; and see p. 574, above.

² See the judgment, in *Lever v. Goodwin*, quoted above, p. 579, and compare it with those in *Lever v. Bedingfield*, 16 R. P. C. 3 (1899), C. A. See also per Wood, V.-C., in *Woollam v. Radcliff*, 1 H. & M. 259, cited ante, p. 575; and the judgment of Neville, J., in *J. B. Williams Co. v. Bronnley*, 26 R. P. C., at p. 486: "I am not prepared to say that there may not be cases in which a trader may acquire by user an exclusive right of monopoly in respect of a combination

of two or more matters, which by themselves are absolutely common to the trade." See also *Christiansen's Tm.*, 3 R. P. C. 54, cited above, p. 266.

³ "I attribute very little importance indeed in a case of this kind to the sides and back." Per Kekewich, J., in *Lever v. Bedingfield*, 15 R. P. C. at p. 462 (a box of tablets of soap).

⁴ See *Hennessy v. Keating*, 25 R. P. C. 125 and 361 (1903), H. of L.; *Imperial Tobacco Co. v. Purnell*, 21 R. P. C. 368, 598 (1904), Joyce, J., and C. A.; *Coleman & Co. v. Stephen Smith & Co.*, 29 R. P. C. 81, C. A.; *Perry v. Hessin*, 29 R. P. C. 101, and p. 509, Eve, J., and C. A. (see at p. 125); and *De Long Hook and Eye Co. v. Newey*, 29 R. P. C. 49, Warrington, J., all 1912.

In cases of alleged imitation of get-up it is generally material whether the plaintiff's and defendant's names appear distinctly on their respective goods.¹

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

The spurious badges must be used in connection with goods which are not the plaintiff's, but they need not be stamped or printed upon them or their envelopes. The fraudulent trade names, for instance, in most of the cases where injunctions have been granted, were used as descriptions of the defendants for general purposes, and in their advertisements and circulars,² or were placed over their shop doors.³ In *Jay v. Ladler*,⁴ the deceptive representation was effected by sending to the defendant's customers a circular enclosing a print of a design resembling the plaintiff's distinctive design. The action extends to every kind of representation which is calculated to pass off the defendant's goods as the plaintiff's.

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

4. Probability of Deception.

The Court must be satisfied that the defendant's conduct is calculated to pass off other goods as those of the plaintiff, or, at least, to produce such confusion in the minds of probable customers or purchasers as would be likely to lead to the other goods being bought and sold for his.⁵ This is the foundation of the action.

Where deception is intended.

If it is shown to have been intended by the defendant to deceive in this way, the Court will not generally push the inquiry further.⁶

¹ See, for instance, *Schweppes v. Gibbens*, 22 R. P. C. 113, 601 (1905), H. of L.; but cf. the cases cited on p. 451 and p. 612, notes (3) and (4).

² See the injunctions in *Hendriks v. Montagu*, 17 C. D. 638; *Massam v. Thorley*, 14 C. D. 748; and see *Saxlehner v. Apollinaris Co.*, [1897] 1 Ch. 898; 14 R. P. C. 645; Appendix, pp. 800, 805.

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

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

⁵ *Hendriks v. Montagu*, 17 C. D. 638 (1881); see per James, V.-C., p. 646,

and *Schweppes v. Gibbens*, note (1), per Romer, L.J.

⁶ "Why should we be astute to say that (the defendant) cannot succeed in doing what he is straining every nerve to do?" Lindley, L.J., asked, in *Slazenger v. Feltham*, 6 R. P. C. p. 538 (1889). Cf. per Ld. Macclesfield, in *Mitchell v. Reynolds*, 1 Smith, L.C., 10th ed., p. 391. "He only can suffer by his knavery, and surely Courts of Justice are not concerned lest a man should pay too dear for being a knave." "If you find a defendant who is a knave, you may presume he is not a fool," per Cozens-Hardy, M.R., in *Claudius Ash*,

But the intention is only evidence of the actual deception or probability of deception which may be inferred from it. And if the Court does not believe that there is any probability of deception, the action must fail.¹ "The law does not take notice of a fraudulent intention in a man's mind if he does nothing to carry out the fraud."²

"When once you establish the intent to deceive, it is only a short step to proving that the intent has been successful, but still it is a step, even though it be a short step."³

Deception by the deliberate fraud of a third party, *e.g.*, a retailer, where the defendant's mark when fairly used is not calculated to deceive, is not imputable to the defendant.⁴

Badges of fraud:
unexplained similarities;
colourable differences;

gradual approximation.

The existence of unexpected and unexplained similarities⁵ between the goods of the defendant and those of the plaintiff, or of similarities which have been modified by colourable differences⁶ or by differences and distinctions so arranged as to escape notice;⁷ the use by the defendant of descriptions, which, as applied to himself or his own trade, are inaccurate, and by reason of their inaccuracy approach more nearly to the proper description of the plaintiff,⁸ and the gradual approximation of the defendants' names, get-up, or description of those of the plaintiff,⁹ are all obvious badges of fraudulent intention

Sons & Co. v. Invicta Manufacturing Co., 28 R. P. C. at p. 603 (1912). See also *Royal Insurance Co., Ltd. v. Midland Insurance Co., Ltd.*, 26 R. P. C. at p. 97 (1909). And see *Lambert and Butler, Ltd. v. Goodbody*, 19 R. P. C. 377 (1902), Farwell, J., at p. 381; *Iron Ox Remedy Co. v. Co-operative Wholesale Society*, 24 R. P. C. 425 (1907), Parker, J., at p. 430; *Hennessy v. Keating*, 25 R. P. C. 125, Fitzgibbon, L.J., at p. 136.

¹ *Lever v. Bedingfield*, 16 R. P. C. 3 (1898), C. A., overruling 15 R. P. C. 453, Kekewich, J.

² Per Ld. Esher, M.R., in *Reddaway v. Banham*, 12 R. P. C. at p. 89.

³ Per Earl Loreburn in *Claudius Ash, Sons & Co. v. Invicta Manufacturing Co.*, 29 R. P. C. at p. 475; in that case neither fraud nor probability of deception was proved. See also the judgment of Kekewich, J., in *Saxlehner v. Apollinaris Co.*, 14 R. P. C. at

p. 654

⁴ *Payton v. Snelling*, [1901] A. C. 308; 17 R. P. C. 635; *Schweppes, Ltd. v. Gibbens*, 22 R. P. C. 113, 601 (1905), C. A. and H. of L.; *Hennessy v. Keating*, 25 R. P. C. 361 (1903), H. of L.

⁵ *Taylor v. Taylor*, 2 Eq. Rep. 290; 23 L. J. Ch. 255 (1854), Wood, V.-C.

⁶ *Slazenger & Sons v. Feltham & Co.*, 6 R. P. C. 531 (1889), C. A. (*Demon, Demotic*).

⁷ *E.g.*, "late of," &c., in small letters, Chap. XV., p. 454.

⁸ *Holloway v. Holloway*, 13 Beav. 209 (1850), Langdale, M.R.

⁹ *Boulnois v. Peake*, 13 C. D. 512, n. (1868), Giffard, V.-C., *Carriage Repository* changed to *New Carriage Bazaar*; *Apollinaris Co. v. Herrfeldt*, 4 R. P. C. 478 (1887), C. A. (*Apollinis*); *Sanitas Co., Ltd. v. Condy*, 4 R. P. C. 195, 530; 56 L. T. 621 (1886), Kay, J. (*Condi-Sanitas*). "When a manufacturer's

frequently recurring in the cases which come before the Court.¹

Obvious differences between the goods themselves are very material to the question of probability of deception.²

Instances of actual deception need not be proved if the Court is otherwise satisfied of the probability of deception;³ and on the other hand, they are not necessarily conclusive where they have occurred, in cases, for example, where their number is comparatively insignificant.⁴ And, of course, proof of deception is not sufficient to enable the plaintiff to succeed if the defendant has done nothing but what he was entitled to do, as where he has only used marks common to the trade.⁵

Proof of actual deception.

The question what resemblance is calculated to deceive, and the modes of comparison adopted, have been sufficiently considered in the preceding chapters.⁶

Proof of probability of deception.

goods are a drug on the market so long as they bear his own name or proclaim their true origin, and yet are saleable at once if marked with nothing but some common English words, and when that manufacturer holds himself out as ready and willing so to mark his goods, and does so mark them at the 'instigation,' as he says, of a purchaser, a Lancashire jury may perhaps be trusted to solve the riddle." Per Ld. Macnaghten in *The Camel Hair Belting* case, 13 R. P. C. at p. 233. See also *Colman v. Farrow*, 15 R. P. C. 198 (1898), Stirling, J.

¹ See further, p. 454.

² *Coleman v. Brown*, 16 R. P. C. 619 (1899), North, J., and C. A. on an interlocutory application (*Wincarnis, Vincalis*). *Fairbank Co. v. Cocos Butter Manufacturing Co.*, 21 R. P. C. 23 (1904), Swinfen Eady, J. (*Cottolene, Cocosoline*), an action for infringement; *Apollinaris Co., Ltd. v. Duckworth*, 23 R. P. C. 540 (1906), Warrington, J. (*Apollinaris Salts*); *Reddaway & Co., Ltd. v. Irwell and Eastern Rubber Co., Ltd.*, 23 R. P. C. 621; 24 R. P. C. 203 (1907), Neville, J., and C. A. (*Lancashire* for hair belting, *Lanco* for balata belting); *Pianotist Co.'s Application*, 23 R. P. C. 774 (1906), Parker, J., *Pianola* and *Neola* for different instruments; *Turner's Motor Manufacturing Co., Ltd. v. Miesse Petrol Car Syndicate, Ltd.*, 24

R. P. C. 531 (1907), Warrington, J., steam motor cars and petrol motor cars. *Nugget Polish Co., Ltd. v. Harboro' Rubber Co.*, 29 R. P. C. 133 (1912), Neville, J. (boot polish and rubber heels); *Re Tm. Herogen*, 30 R. P. C. 73, Eve, J. (1913). Cf. application of *Compagnie Industrielle des Petroles*, [1907] 2 Ch. 435; 24 R. P. C. 585, Warrington, J., *motorine* for lubricating oils, *motricine* for petrol; and the cases cited above, pp. 253, 254, and p. 436, note (4).

³ See the last Chapter, p. 446, and Parker, J., in *Iron Ox Remedy Co., Ltd. v. Co-operative Wholesale Society*, 24 R. P. C. 425, at p. 430 (1907).

⁴ *Civil Service Supply Association v. Deun*, 13 C. D. 512 (1879), Malins, V.-C.; *Borthwick v. The Evening Post*, 37 C. D. 449 (1888), C. A.; *Leahy, Kelly and Leahy v. Glover*, 10 R. P. C. 141 (1893), H. L.; *Rutter v. Smith*, 18 R. P. C. 49 (1901), Kekewich, J., and above, pp. 432, 509.

⁵ See below, *Defences*, and above, p. 578, note (3). In *Jamieson v. Jamieson*, 15 R. P. C. 169 (1898), the C. A. dismissed the action, although Byrne, J., had found both actual deception and intention to deceive. In *King v. Gillard*, 22 R. P. C. 327, the defendant copied some common elements from the plaintiff's box.

⁶ Chap. XV., p. 444; Chap. X.,

All the circumstances of the case must be considered. Thus where the mark in question is not attached to the goods themselves so as to reach the ultimate purchasers, it may be clear that the trade purchasers to whom the defendant's business is confined are not in danger of being deceived.¹

5. Proof of Damage.

Proof of damage² is not in every case essential to enable the plaintiff to maintain his action, for if he shows that the defendant is acting so as to pass off goods as those of the plaintiff which are not the plaintiff's, it will generally be assumed that the plaintiff is thereby prevented from selling as many of the goods as he otherwise would. But if this assumption is negatived by the circumstances of the case,³ proof of actual or probable damage is necessary.⁴ For the assumption of a name,⁵ or an address,⁶ similar to the name or address of the plaintiff, without malicious intent, although it may cause annoyance and inconvenience to him,—for instance, by delaying his letters,—is not actionable, unless it is shown to be calculated to injure him in his trade. And no action lies at the suit of any private person

Probability
or proof of
damage is
essential.

p. 260; see also *Goodfellow v. Prince*, 35 C. D. 9 (1887), C. A. (plaintiff and defendant both mere importers); *Bodega Co. v. Owens*, 6 R. P. C. 236; 7 R. P. C. 31; 23 L. R. Ir. 371 (1889), Chatterton, V.-C. (defendant called his wine shop in Belfast *Bodega*; plaintiff had no *Bodega* shop in Ireland outside Dublin).

¹ *Star Cycle Co. v. Frankenburgs*, 24 R. P. C. 46, 405 (1907), Eady, J., and C. A. (use in trade price lists); *Fairbank Co. v. Cocos Butter Co.*, 21 R. P. C. 23 (1903), Eady, J.

² See also last chapter, "Infringement," Damages or Profits, p. 499.

³ In *Warwick Tyre Co., Ltd. v. New Motor and General Rubber Co., Ltd.*, 27 R. P. C. 161 (1910), Neville, J., the plaintiffs, who sued to restrain the use of the name "Warwick" by the defendants in connection with motor tyres, neither manufactured nor sold tyres, having transferred the right to carry on their business to another company on terms of profit to themselves. The

defendants contended that there could be no damage to the plaintiffs for the loss of the sale of goods, and that the action would not lie; but Neville, J., held that, although practically the sole asset of the plaintiffs was the goodwill attaching to the name Warwick, it was of great value and they derived a substantial profit from it, and that it could not be said that no damage arose to the plaintiffs, and he granted an injunction.

⁴ So that a non-trader has no action, ante, pp. 435, 436; *Delondre v. Shaw*, 2 Sim. 237 (1828), Shadwell, V.-C.; *Levy v. Walker*, 10 C. D. 436 (1879). See also cases on p. 585, note (6).

⁵ *Borthwick v. The Evening Post*, above, p. 561; *Du Boulay v. Du Boulay*, L. R. 2 P. C. 430.

⁶ *Day v. Brownrigg*, 10 C. D. 294 (1878), C. A.; *Street v. Bank of Spain and England*, 30 C. D. 156 (1885), Pearson, J., adoption by the defendants (bankers) of the same cypher telegraphic address as that of the plaintiff.

for deception practised upon the public, unless it incidentally causes, or is calculated to cause, damage to him as an individual; if this is not the case, the wrongdoer can only be punished through the criminal law, or in a civil action on information brought in the name of the Attorney-General.¹

The questions how far the inconvenience caused to a trader by the use of his trade name, or the trade name of his goods, in a business which is not in competition with his own, and how far the interference with a possible extension of his existing business entitle him to sue, have already been considered.²

6. Defences.

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

- (1) The name, or other badge, which the plaintiff charges the defendant with having imitated, carries no distinctive reference to the plaintiff's goods.
- (2) The defendant has an independent or a concurrent right to use it.³
- (3) The name or other badge which the defendant is using, is not such, or is not so used, as to be calculated to pass off other goods for those of the plaintiff.⁴
- (4) The plaintiff is debarred from suing the defendant from all or part of the relief he seeks by (a) an agreement, or some personal estoppel⁵ (other than those next alluded to); (b) acquiescence;⁶ (c) delay;⁷ or (d) deceptive use of the name or badges he relies on, or because his trade is fraudulent.⁸

¹ Per Cotton, L.J., in *The Native Guano Co. v. The Sewage Manure Co.*, 8 R. P. C. p. 128 (1891); see also *Clark v. Freeman and Williams v. Hodge*, cited above, p. 538; *Batty v. Hill*, 1 H. & M. 264 (1863), Wood, V.-C., false pretence of award of gold medal. In *The Maizena* case (above, p. 406), the Privy Council thought that the defendants had made an objectionable reference to a medal really gained by the plaintiffs, but that it was a mere advertising trick. The defendants gave an undertaking to discontinue the reference, and the action was dismissed:

[1894] A. C. 275; 11 R. P. C. 281.

² Above, pp. 561 *et seq.*, and note (6), p. 586.

³ See, as to the right to trade under one's own name, p. 593; and as to the right to describe honestly the place of origin, &c. of his goods, p. 575; and further, the last Chapter, "Infringement," pp. 456 *et seq.*

⁴ Above, p. 583; and Chap. XV., p. 444.

⁵ Page 465.

⁶ Page 466.

⁷ Page 468.

⁸ Page 486.

Denial of
repute.

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

Concurrent
right.

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

Denial of
deception.

(3) This defence also is a mere traverse. It has been considered already.³

Estoppel.

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

Concurrent Right.

The defendant may have as good a title to use the name or other things in question as the plaintiff has to use the name or things with which it or they are, as he alleges, likely to be confused.⁵

Registered
trade mark.

The defence of concurrent right with regard to a registered trade mark is discussed in the last chapter.⁶ Registration of a mark which is deceptive confers no right to use it so as to pass off the defendant's goods as those of the plaintiff.⁷

Partners
after dissolution.

On the dissolution of a partnership, in the absence of special agreement, and unless the firm name is sold or assigned with the goodwill, as it may be,⁸ each partner has an equal right to

¹ Above, pp. 563 *et seq.*

² See note (3), p. 587.

³ Note (4), p. 587.

⁴ See *Read v. Richardson*, 45 L. T. N. S. 54 (1881), C. A. (*Dog's Head Beer*).

⁵ Thus, in a recent case, the plaintiffs alleged that the name Stents in connection with dental impression composition meant their composition, and complained of the get-up of the defendants' goods which included the name "G. Stents." The defendants, however, proved long user, and the plaintiff had not pleaded a case of fraudulent imitation, and the action failed.

Claudius Ash, Sons & Co., Ltd. v. Invicta Manufacturing Co., Ltd., 28 R. P. C. 597; 29 R. P. C. (1912), 465, C. A. and H. of L.

⁶ Above, p. 456. *Lyle and Kinnahan's Application*, 24 R. P. C. 249 (1907), C. A., see p. 256; *Van Zeller v. Mason*, 25 R. P. C. 37 (1907), Joyce, J.

⁷ See the judgment of Buckley, L.J., quoted above, p. 460.

⁸ *Hall v. Barrows*, 4 De G. J. & S. 150; 39 L. J. Ch. 204 (1863), Westbury, L. C.; and see Lindley on Partnership, 8th ed., pp. 514 and 516; and *In re David and Matthews*, below, p. 590.

use it, if he continues to carry on a similar business to that of the late firm,¹ provided that he does not by so doing expose his former partners to any risk of liability.¹ Whether there will be any such risk is a matter to be determined under the circumstances of the particular case.²

It is convenient to note here, in passing, that the purchaser of the goodwill of a business, or a partner succeeding to it under agreement upon dissolution of partnership, has a right to use the trade name and trade marks under which it was conducted.³ And this even though it comprise the personal name of a late partner,⁴ or of any other late owner of the goodwill, but not so as to cast any risk of liability upon the late partner or owner⁵ by using his personal name in such manner as to represent that he is still a member of the firm, or carrying on the business.⁶

Purchaser of goodwill.

¹ *Burchell v. Wilde*, [1900] 1 Ch. 551, Byrne, J., and C. A. (*Burchell & Co.*); *Banks v. Gibson*, 34 Beav. 566; 34 L. J. Ch. 591 (1865), Romilly, M.R.; *Levy v. Walker*, and *Chappell v. Griffiths*, *infra*.

² *Burchell v. Wilde*, *supra*; and see next paragraph.

³ *Levy v. Walker*, 10 C. D. 436 (1879), C. A.; *Currie v. Currie*, 15 R. P. C. 339 (1897), Ct. of Sess. (*Prince Charlie*). For a case where the purchase of goodwill and right to use a trade name was inferred upon a sale of stock-in-trade and patterns, see *Rickerby v. Reay*, 20 R. P. C. 380 (1903), Byrne, J. For cases of colourable purchase of a goodwill, see above, pp. 556 *et seq.*

⁴ *Condy v. Mitchell*, 37 L. T. N. S. 268, 766 (1887), Bacon, V.-C., and C. A. (*Condy's Fluid Co.*); *Chappell v. Griffiths*, 53 L. T. N. S. 459 (1885), Kay, J.

⁵ *Chatteris v. Isaacson*, 57 L. T. N. S. 177 (1887), Kekewich, J. The vendor of the business of "Mme. Elise" agreed that the purchaser should have the exclusive right to use the name "Mme. Elise & Co." Mme. Elise was his wife's name. Held, the purchaser must use the addition "& Co." In *Burchell v. Wilde*, [1900] 1 Ch. 521, it was held that, upon the division of a solicitor's business between the partners on dissolution, the partner whose name was

Burchell would run no risk by reason of the use by the other of the old name, *Burchell & Co.* Notice of the change had been given to all the clients. The defendant, in fact, undertook to carry on business under a different name, viz., *Burchell, Wilde & Co.* In *Townsend v. Jarman*, [1900] 2 Ch. 698; 17 R. P. C. 649, Farwell, J., the plaintiff bought the business of Jarman & Co., Ltd., seedsmen, from a company to whom he and the defendant had, on the dissolution of their partnership, transferred it. He carried on business as *Jarman & Co.*, and it was held that the defendant could not complain of this. The defendant had sold business premises on which his name, *E. J. Jarman*, was cut to the company, who had transferred them to the plaintiff. It was held that the defendant could not compel the plaintiff to remove the name. See also *Routh v. Webster*, 10 Beav. 561 (1847); and *Prudential Assurance Co. v. Knott*, L. R. 10 Ch. 142 (1875); also *Rosher v. Young*, Sol. Jo., Vol. 45, p. 344.

⁶ *Dickson v. McMaster & Co.*, 18 Ir. Jur. 202 (1866), Brady, C.; *Scott v. Rowland*, 26 L. T. N. S. 391 (1872), Wickens, V.-C.; *Gray v. Smith*, 43 C. D. 208 (1889), C. A.; *Thynne v. Shove*, 45 C. D. 577 (1890), Stirling, J. There can be no risk where the late

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

But where the goodwill of a business is sold, or is taken over on the dissolution of a partnership by agreement, without any restrictive condition being imposed upon the late owner or the retiring partner which restrains him from exercising his ordinary right, he is at liberty to start in the same trade again at once under his own name, so long as he uses it honestly, even though it be the same as, or be similar to, the name under which the old business was, and continues to be, carried on.¹

Vendor must not solicit his old customers.

In such a case the vendor or retiring partner could not trade under the old name if it differed from his own personal name.² And he would not be allowed to solicit his old customers in the business which he has sold, because to do so would be to derogate from his grant.³

In *Re David and Matthews*,⁴ there was a provision in a deed of partnership between two partners, that on the death of either a general account should be taken for the purpose of determining the value of the share of the deceased partner which was to be paid by the survivor, who, under other provisions, took over the assets of the firm. A question arose whether the goodwill should be included in the account or not, and, if it were, upon what basis it should be valued. Romer, J., after reviewing all the authorities on the subject, decided that the goodwill must be included as part of the assets, and must be valued as on a scale upon the footing that, if it were sold, the surviving partner would be at liberty to carry on a rival business, but not to solicit any person who was a customer of the firm before the death of the partner, or to carry on business under the firm name, which was made up of the names of both partners.

Questions between the purchaser of a business and its former

partner is dead, *Webster v. Webster*, 3 Swan. 490 (1791), Thurlow, L.C.; see Lindley on Partnership, 8th ed., pp. 515, 708.

¹ *Churton v. Douglas*, Johnson, 174; 28 L. J. Ch. 841 (1859), Wood, V.C.; see page 591; *Johnson v. Helleley*, 34 Beav. 63; 34 L. J. Ch. 32, 179; 2 De G. J. & S. 446 (1864), Romilly, M.R., and L.J.J.; *Labouchere v. Dawson*, L. R. 13 Eq. 322 (1872), Romilly, M.R.

² The grant would then pass the exclusive right to the name. *Mrs. Pomeroy, Ltd. v. Scalé*, 24 R. P. O. 177 (1907). See judgment of Parker, J.

See also cases cited in last note.

³ So finally decided in *Trego v. Hunt*, [1896] A. C. 7, overruling *Pearson v. Pearson*, 27 C. D. 145, on this point. See also *Gillingham v. Beddow*, [1900] 2 Ch. 242. The order made by the H. L. in the first case restrained the defendant from applying privately by letter, personally, or by a traveller, to any person who was, prior to the dissolution, a customer of the old firm, asking such customer to deal with him (the defendant) or not to deal with the plaintiffs.

⁴ [1899] 1 Ch. 378.

owners, or some of them, respecting the use of the firm name seldom arise except upon a dissolution of partnership, or after the sale of the goodwill of a debtor's business by his trustee in bankruptcy; for no careful purchaser would agree to buy the goodwill of a business without stipulating for the exclusive use of the trade name, and probably stipulating also that the vendor should not carry on a new competitive business.¹

A trustee in bankruptcy has no power to contract on behalf of the bankrupt, and the bankrupt is not a grantor so as to be bound by the rule applied in *Trego v. Hunt*. The sale of the goodwill of his business in the bankruptcy, accordingly, throws no obligation upon the bankrupt trader other than the obligation of the general law, not to represent that the business is still carried on by him.² The purchaser can, however, restrain the bankrupt from using a firm name, but not from using his own name.³

But the late owner or partner must do nothing, other than make an honest use of his own name, which is calculated to suggest that he is carrying on the old business.⁴

"It has been settled," James, V.-C., said, in *Hudson v. Osborne*,⁵ "that there is no implied covenant of any kind in the sale by an individual himself of the goodwill of his business; but it seems to be settled that a trader, whose business, and the goodwill of whose business, have been sold by himself, or by any person deriving title under him, has no right to represent himself as carrying on that identical business; he has no right to use the trade marks which were the marks of that business, or, by the use of the name, or of a title of the firm, to represent himself as being the continuer of that identical business which has been sold."

And, in *Churton v. Douglas*,⁶ a partner, who, after he had sold

¹ As to the registered trade marks on a dissolution, see sec. 23, and above, pp. 392, 393.

² *Walker v. Mottram*, 19 C. D. 355 (1881), C. A. In *Trego v. Hunt*, above, p. 590, note (3), Ld. Macnaghten said: "There is all the difference in the world between the case of a man who sells what belongs to himself and receives the consideration, and a man whose property is sold without his consent by his trustee in bankruptcy,

and who comes under no obligation, express or implied, to the purchaser from the trustee."

³ *Melrose Driver, Ltd. v. Heddle*, 4 Fraser (Ct. of Sess., 5th series), 1120 (1902).

⁴ As to the use of the word "late," see above, pp. 454, 536.

⁵ 39 L. J. Ch. 79 (1869). This was, of course, before the decision in *Trego v. Hunt*.

⁶ Page 590, note (1); *Will v. Con-*

Sale in
bankruptcy.

The vendor
must not
represent
that his busi-
ness is the old
business, or
its successor.

his share in the business of "John Douglas & Co." to his co-partners, continued to trade as "Churton, Bankart, and Hirst, late John Douglas & Co.," was restrained from trading as "John Douglas & Co.," or representing that his new business was a continuation of the old business.

The question whether a late partner, or other late owner of a business which has passed into the hands of the plaintiff, is representing that he is still carrying it on, or that his present business is its successor, or is only fairly working and advertising the latter business as his own, is often one of great nicety. The case of *Mogford v. Courtenay*¹ is an illustration of this. There the partnership between the parties having expired by effluxion of time, and the goodwill passing under the partnership articles to the plaintiff, but without any restrictive covenant binding the defendant not to use the firm name or any similar name, the defendant was restrained from issuing a circular to the old customers stating the fact of dissolution, and that he had joined a new firm, and asking the customers for a "continuance" of their custom. This was held to be a suggestion that he was about to carry on, not merely a similar business, as he lawfully might, but the identical business which had passed to the plaintiff. It appears by the more recent authorities² that he ought to have been restrained from privately soliciting the old customers to deal with him in any terms whatsoever.

In a case in which a patentee of an article had granted a licence under the patent and had manufactured for the licensee, making up and packing the goods for him, and some years after the expiration of the patent the licensee brought an action against the patentee for selling goods with a similar get-up to that which the licensee used, the patentee set up in defence that he had some concurrent right in the get-up, alleging that he had invented it; but it was held that, even if he had done so, the circumstance did not justify him, and an injunction was granted.³

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

¹ 45 L. T. N. S. 303 (1881), Fry, J. The decision that the defendant might not solicit the old customers has since

been approved by the House of Lords, above, p. 590, note (3).

² *In re David and Matthews*, above, p. 590.

³ *Frankau & Co. v. Pflueger*, 26 R. P. C. 741; 28 R. P. C. 131 (1912), Joyce, J.

The right to Trade under one's own Name.

It has frequently been stated, as a general rule, that any man may, so long as he acts honestly, trade under or describe his goods by his own name, or the names of himself and his partners, even though the similarity of such name or names to the name under which another person has previously been trading, or to the trade name of that other's goods, may occasionally lead to confusion or lead to the business or goods of the new-comer being mistaken for the business or goods of the earlier trader.¹

The general rule.

Thus, Knight-Bruce, L.J., said, in a suit between father and son,² "all the Queen's subjects have a right to sell (their goods) in their own names, and not the less that they bear the same name as their father"; "but," he added, "if any circumstances of fraud had accompanied, and were continuing to accompany, the case, it would stand very differently." And in a recent Scotch case³ Lord Kyllachy said, "Far as the law may have gone in its justifiable anxiety to prevent imposition upon the unwary purchaser, and content as it has sometimes been to pursue that object at the expense of encouraging the acquisition of virtual monopolies by traders and companies prepared to spend largely in systematic advertising and litigation, it has never as yet, at least so far as I know, gone the length of debarring any merchant or manufacturer from selling his own goods under his own name, unless there has been, in addition to the use of that name, some overt act or course of conduct plainly indicative of fraud— to say, of dishonest effort to pass off his own goods as the goods of another."

In the present state of the authorities, however, no such general rule can now be laid down as an absolute rule of law.

Present state of authorities.

¹ Cf. s. 44 of the Trade Marks Act, 1905, above, p. 464. See the 5th and 6th rules stated by Kay, L.J., in *The Yorkshire Relish* case, printed in a note to this Chapter (p. 614), and the judgment of Lindley, L.J., in the same case: [1896] 2 Ch. at p. 70; 13 R. P. C. at p. 270; the judgments of the C. A. in *Turton v. Turton*, 42 C. D. 128 (1839), and *Warner v. Warner*, 5 T. L. R. 327, 359. In *Reddaway v. Banham* (below, p. 594), however, Ld. Macnaghten said he was at a loss to know why *Turton v. Turton* was ever reported, and that the plaintiff's case was ex-

travagant and absurd: [1896] A. C. at p. 220; 13 R. P. C. at p. 234.

² *Burgess v. Burgess*, 3 De G. M. & G. 896; 22 L. J. Ch. 675 (1853); see below, p. 594, note (4).

³ *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Motor Co., Ltd.*, 23 R. P. C. 761 (1907), aff. in the H. T., [1907] A. C. 430; 24 R. P. C. 672, where the question was dealt with merely as one of fact. In *Abel Morrall, Ltd. v. Hessin*, 20 R. P. C. at p. 493, Romer, L.J., said: "The law is settled and it is merely a question of fact. If fairly and honestly done, it cannot be stopped."

The inclination of the Courts is to treat the question whether the use of the name in question by a defendant is calculated to pass off his business or goods as that or those of the plaintiffs as one of fact in each particular case, as though there were no difference in principle between a man's own name and any other apparently descriptive word.¹ There is, as already stated, no reported instance, where, apart from fraud, a defendant has been absolutely restrained from using his own name, but in one case² an order was made restraining him from using it without taking reasonable precautions to distinguish his business and goods from those of the plaintiff, and orders have occasionally been made restraining the use of the name descriptively, *e.g.*, as *Cash's Frillings*³ or *Fowne's Gloves*.⁴ But such orders will only be made in the rare and highly exceptional cases where it can be proved that a personal name has become so identified by use in a wide-spread and well-known business with a particular trader as to be necessarily deceptive when used without qualification by anyone else in the same trade.

In the *Anchovy Sauce* case cited above,⁴ Turner, L.J., said that "it is a mere question of evidence in each case whether there is a false representation or not," and in the *Camel-hair Belting* case,⁵ in which the matter was placed upon its modern footing by the opinions of the learned Law Lords, this statement was adopted and approved. Lord Halsbury, L.C., said⁶ that no principle of law was laid down in the earlier cases which would

¹ *The Valentine Meat Juice Co. v. The Valentine Extract Co., Ltd.*, 17 R. P. C. 678; 83 L. T. 259 (1900), C. A. *Teofani v. Teofani*, cited p. 602, and the judgment of Buckley, L.J., in the *Brinsmead* case (cited p. 603) quoted in the Addenda. As to the conditions under which a descriptive word can be monopolised, see above, pp. 565 *et seq.*

² *J. & J. Cash, Ltd. v. Cash*, 18 R. P. C. 213 (1901); 19 R. P. C. 181, Kekewich, J., and C. A. An absolute injunction restraining the use of *Cash* was granted in the first instance. The C. A. altered this by adding "without taking reasonable precautions to distinguish, &c." It is said, as stated in the text, that the same rules are to apply to a personal name and any other *prima facie* descriptive word. If a name remains the only proper description of a person who is lawfully engaged in the

trade, can anyone have the right to prevent such descriptive use?

³ *Rigden v. Jones*, 22 R. P. C. 417 (1905), Eady, J.

⁴ *Burgess v. Burgess*, 8 D. M. & G. 896; 22 L. J. Ch. 675 (1853), Kindersley, V.-C., and Knight-Bruce and Turner, L.JJ., on an interlocutory application. The defendant, who had recently left the employment of his father, the plaintiff, and set up a rival business in King William Street, was restrained from describing his business as "late of 107, Strand," his father's address; but the Court refused to restrain him from trading under his own name or describing his goods as "Burgess' Essence of Anchovies."

⁵ *Reddaway v. Banham*, cited above, pp. 44 and 570.

⁶ [1896] A. C. at p. 204; 18 R. P. C. at p. 225.

have prevented an injunction, although the defendant's name was Burgess and although the article was described by a descriptive name, but that, in the view of the Lords Justices, the descriptive name there in question, *Burgess' Essence of Anchovies*, had not, as a matter of fact, acquired the technical signification of being only made by Burgess the father.

Lord Herschell said:¹ "the name of a person or words forming part of the common stock of language, may become so far associated with the goods of a particular maker that it is capable of proof that the use of them by themselves without explanation or qualification by another manufacturer would deceive a purchaser into the belief that he was getting the goods of A. when he was really getting the goods of B. In a case of this description the mere proof by the plaintiff that the defendant was using a name, word or device, which he had adopted to distinguish his goods, would not entitle him to any relief. He could only obtain it by proving further that the defendant was using it under such circumstances or in such manner as to put off his goods as the goods of the plaintiff."

These passages, and the passage from the judgment of Vaughan Williams, L.J., in *Jamieson v. Jamieson*, quoted below,² were cited by Lord Alverstone, M.R., in *The Valentine Meat Extract* case,³ as establishing that the supposed exception to the general rule stated at the head of this chapter in the case of a man's own name does not exist.

It follows that it is no more essential, in theory, to prove a fraudulent intent in a passing-off case which depends upon the use by the defendant of his own name than in any other case.⁴

While, however, the possibility of such a monopoly of a personal name being established as to prevent the honest use of his own name, without qualification, by the defendant is recognised, the degree of proof exacted is very high, and only one case has been

¹ [1896] A. C. at p. 210; 13 R. P. C. at p. 228.

² Page, 597.

³ Above, p. 594, note (1), and below, p. 598.

⁴ *S. Chivers & Sons v. S. Chivers & Co., Ltd.*, 17 R. P. C. 420 (1900), Farwell, J. The learned judge said that in order to make out that a personal name has acquired a secondary meaning, its use in the secondary sense must be shown to have become universal, and

that, if this were so, the defendant must necessarily have known that his use of it for his own goods was deceptive and dishonest. In the recent case of *John Brinsmead & Sons, Ltd. v. E. G. S. Brinsmead*, 30 R. P. C. 137 (1913), Warrington, J., said that, in the absence of fraud, the defendant could not be prevented from putting on his pianos his own name; the defendant, however, put his name "Stanley" in full, and see p. 594, note (1).

reported in which this has been done.¹ There are, no doubt, many instances in which the deliberately fraudulent attempt of a defendant to make use of his own name, or, more commonly, an assumed name, in order to pass off his goods as another's, has been restrained,² or where a company constituted for the purpose of competing with an established business under a name chosen because of its resemblance to the firm name of such business has been compelled to take steps to prevent deception or to change its name.³

Jamieson & Co. v. Jamieson.

In *Jamieson & Co. v. Jamieson*,⁴ the plaintiff failed because the Court of Appeal decided that the defendant was not bound to use extra precautions to avoid confusion between his goods and those of other persons in the trade, if such confusion arose solely from the similarity of his own name with theirs,⁵ and from the use of

¹ *J. J. Cash, Ltd. v. Cash*, cited above, p. 594, and more fully below, p. 600, and see App., p. 807. In *Dewar, Ltd. v. Dewar*, 17 R. P. C. 341 (1900), Ct. of Sess. at p. 358, Ld. Kyllachy said: "I do not myself know of any case in which the use by a man of his own name has been successfully challenged except in circumstances which plainly involved fraud on the part of the user." In the *Dunlop* case he dealt more fully with the matter, see below, p. 601. In *Cellular Clothing Co. v. Maxton*, cited above at p. 571, Ld. Shand ([1899] A. C. at p. 341; 16 R. P. C., at p. 407) said the same thing of descriptive names in general. *The Valentine* case was similar to the *Tussaud* and *Pinet* cases, cited below, where a company was formed with a deceptive name for the purposes of competition.

² As *Morrall v. Hessin*, 19 R. P. C. 557; 20 *ib.* 429 (1902), Swinfen Eady, J., and C. A. (*Morrall's needles*); and see *Van Oppen & Co., Ltd. v. Leonard Van Oppen*, 20 R. P. C. 617 (1903), Swinfen Eady, J., *Holloway v. Holloway*, 13 Beav. 209 (1850), Langdale, M.R., was a case of fraudulent imitation of "get-up." The M.R. said: "The defendant's name being Holloway, he has a right to constitute himself a vendor of Holloway's pills and ointment. I do not intend to say anything to abridge any such right."

³ Above, p. 546.

⁴ 15 R. P. C. 169 (1897), C. A., overruling Byrne, J. It should be noted that there were other Jamiesons engaged in the trade at Aberdeen besides the parties. It was a "get-up" case, but, in the view of the C. A., the only resemblance between the boxes of the plaintiff and defendant was due to the name and to features common to the trade.

⁵ In *J. H. Brooks & Co., Ltd. v. Norfolk Cycle Co. and John Brookes*, 16 R. P. C. 528 (1899), the plaintiffs were makers of the well-known "Brooks" saddle. The defendant Brookes was a saddle maker who had newly entered the trade, but his father had sold saddles under his own name, and had been restrained at the instance of the plaintiffs from doing so. Stirling, J., said that knowing the facts and the probability of confusion, it was the defendant's duty to mark his goods so as to avoid all possibility of mistake between them and those of the plaintiffs. Instead of doing this he had imitated the plaintiff's manner of marking. An injunction restraining him from marking saddles "J. Brookes" *without distinguishing, &c.* was granted. *Jamieson & Co. v. Jamieson* does not appear to have been cited, but the case was obviously one of fraud, and possibly also one in which the name had become

features common to the trade.¹ But the Court, as will be seen from the quotations following, carefully distinguished from the case before them the case where the name of a particular trader has come to denote his goods in the market.

Lindley, L.J., after referring to *The Holloway Pill* case,² said, "When we are asked to restrain a man from carrying on business in his own name, we must take very great care what we are about. The principle applicable to the case, I take it, is this: the Court ought not to restrain a man from carrying on business in his own name simply because there are other people who are doing the same and who will be injured by what he is doing. It would be intolerable if the Court were to interfere, and to prevent people from carrying on business in their own names in rivalry to others of the same name. There must be something far more than that, viz. (there must be), that the person who is carrying on business in his own name is doing it in such a way as to pass off his goods as the goods of somebody else."³ "It is said, because yours may be mistaken for ours you are bound to take extra precautions to prevent yours being mistaken for ours. I am not aware of any case that goes so far as that." "In all cases in which a person has been restrained from carrying on business in his own name he has done something more than use his name: he has copied something from somebody else in the trade, or he has gone out of his way to make his things look like those of a rival in the trade."⁴

Vaughan Williams, L.J., said: "I do not understand that there is any case, or ever has been any case, in which it has been laid down that a man who happens to bear a particular name is debarred from entering into any trade which he chooses to enter into merely because there is somebody else of the same name who has acquired a great reputation in the manufacture of the particular goods dealt with in the trade." Then, after referring to such well-known trade names as *Bass' Beer*,⁵

a trade name of the goods. See also the judgment of Cozens-Hardy, M.R., in *J. B. Williams & Co. v. Williams*, 26 R. P. C. 481, 765, at p. 773. In that case the plaintiffs' goods were known as *Williams' Shaving Stick*, and the action was in respect of get-up coupled with the use of the name Williams, it being held that even if there were a special obligation on the defendant to

distinguish by reason of his having the same name, he had done nothing of which the plaintiffs had any right to complain.

¹ Above, p. 267.

² Page 596, note (2).

³ 15 R. P. C. at p. 181.

⁴ At p. 183.

⁵ See below, p. 608.

Mere similarity of firm name does not impose duty to take precautions.

Colman's Mustard, and *Pears' Soap*, the Lord Justice continued: "A plaintiff never can complain of the user by the defendant of either the plaintiff's personal name, or of any other name that he chooses to use for the purpose of denoting his goods, unless he first establishes that in the market his goods have come to be known by that name. The right and duty of the Court always is to restrain a man from using a name that has come to be recognised as the name of a particular trader's goods for his, the defendant's, goods so as to suggest that the defendant's goods are the plaintiff's goods, and to pass them off as such."¹

The question has since come before the English Courts on several occasions.²

The Valentine case.

In *The Valentine Meat Juice Co. v. The Valentine Extract Co., Ltd.*,³ the plaintiffs in the Court of Appeal obtained an injunction⁴ to restrain the defendant company from carrying on business as manufacturers or vendors of extract of meat, and from selling any extract of meat, under a name of which *Valentine* formed part, and also an injunction to restrain the defendant, C. K. Valentine, from carrying on business, in such goods, under his name without distinguishing such business from that of the plaintiffs. The plaintiffs' business, although chiefly American, was well known in England, and their goods, a medicinal fluid extract of meat, were always described by a name comprising *Valentine*, and sometimes as *Valentine* simply. The defendant, C. K. Valentine, who had obtained a patent for putting up quite a different extract of meat, which was solid and was intended to be used as a food, promoted the defendant company as a purchaser of his invention, and became its managing director. He never had any business, although he purported to sell to the company "the goodwill of the business which is now being

¹ At pp. 192, 193. This passage was cited with approval by Ld. Alverstone, M.R., in *Valentine Meat Juice Co. v. Valentine Extract Co., Ltd.*, 17 R. P. C. at p. 680 (1900), as an exposition of the law on the point.

² It has also come before the Court of Session in Scotland in *Dewar, Ltd. v. Dewar*, above, p. 596, note (1), and in *The Dunlop Motor* case, below, p. 601, which went to the H. L.

³ 17 R. P. C. 1, Stirling, J.; 17 R. P. C. 673; 83 L. T. 259 (1901), C. A.

Stirling, J., refused the injunction partly because of the difference between the trades, but also on the ground that the defendant, C. K. Valentine, was entitled to promote a company to work his invention under his name, unless fraud were shown, and the learned judge did not find fraud.

⁴ Appendix, p. 806. The form of the injunction was followed in *International Plasmon, Ltd. v. Plasmonade, Ltd.*, 22 R. P. C. 543.

created by the vendor." There was evidence of actual deception, and the Court of Appeal came to the conclusion that C. K. Valentine adopted the name in dispute for his company for the purpose of getting the benefit of the plaintiffs' reputation.¹ The decision might therefore have been put upon the ground of fraud, and might have been arrived at without going beyond the earlier cases² cited below. The decision was, however, placed on the broad ground that the supposed distinction in law between personal names and other descriptive words does not exist.³

Chivers & Sons v. Chivers & Co., Ltd.,⁴ is an example of the difficulties which may occur where the extension of a large business brings it into competition with one which is already established in a particular locality. In that case the plaintiffs carried on the business of jam and jelly makers at Histon, Cambridgeshire, and by very extensive advertising⁵ for some years before the action they had developed a large trade in a particular class of their goods known as "table jellies," especially in the Eastern and Midland counties of England. It was not shown that they had any large or extensive trade in Wales. The goods in question were always described by the plaintiffs on the boxes in which all such goods were sold as *Chivers' Table Jellies*. The defendant company had been formed in the year 1895 by a firm of S. Chivers & Co., in which the senior partner, who became the principal managing director of the company, was Samuel Chivers. The firm, and after its incorporation the company, had carried on a substantial business at Cardiff and in South Wales as jam makers, and were locally well known. In the year 1898 the company commenced to make table jellies, the manufacture of which was, as the learned judge found, a bye-product of the jam trade. Their boxes were quite different in appearance⁶ from those of the plaintiffs, but they placed upon them their name, S. Chivers & Co., Ltd., and it was this of which

*Chivers v.
Chivers.*

¹ Per Ld. Alverstone, M.R.

² *E.g.*, *Tussaud's* case and *Pinet's* case, above, pp. 555, 557.

³ The defendants were also restrained from using the word *Valtine* which they had registered as a trade mark. It was subsequently removed from the Register, *Valentine's Tm.*, 18 R. P. O. 175 (1901), Farwell, J.

⁴ 17 R. P. C. 420 (1900), Farwell, J.

⁵ The learned judge said (at p. 431), "Advertising distinguished from trade is nothing."

⁶ They at first adopted a box which, in some particulars, closely resembled that of the plaintiffs. It had directions copied from the latter. In a previous action they had consented to an injunction in respect of this box.

complaint was made. They did not themselves use the phrase *Chivers' Table Jellies*, but a number of witnesses, most of whom had never heard of the defendant company, were called to prove that in different parts of the country that phrase or *Chivers' Jellies* was understood to mean the plaintiffs' goods, and that by the use of the defendant company's name their goods might and probably would be passed off as those of the plaintiffs. No case of fraud or of actual deception was made out. It was held that, as the plaintiffs had not established that the secondary meaning of the name *Chivers* for which they contended was universal in Wales as well as in England, or that its original meaning had been lost, they could not succeed. The learned judge said that if they could do so they could also prevent the use of the defendant's name for their old-established jam trade.

Cash v. Cash. The subject was next discussed in the case of *J. and J. Cash, Ltd. v. Cash*.¹ The plaintiffs and their predecessors in business had been for some years carrying on business under the name of Cash, in Coventry, and it was established that "Cash's Frillings," and "Cash's Woven Names," and "Cash's Initials" meant the plaintiffs' goods. The defendant, whose proper name was Joseph Cash, commenced to carry on business, also at Coventry, in goods which included frillings, woven names, and initials. He did not claim the right to describe these as "Cash's Frillings," etc., but to trade in such goods under the name of *Joseph Cash & Company* or *Joseph Cash*. Kekewich, J., said: "Is it possible for Joseph Cash to have a shop in Coventry, and there to sell frillings without those frillings being sold and known as 'Cash's Frillings'? It seems to me, speaking as a jury, and simply applying such knowledge of the world as I can to the subject, that it is impossible that that can be done." And the learned judge granted an injunction restraining the defendant from carrying on the business of manufacturer or seller of the three kinds of article under the name of Cash, or any other name so as to mislead. The defendant appealed against this order, asking that it might be varied so far as it absolutely restrained him from trading in the article in question in his own name, and he succeeded. The order, as modified by the Court of Appeal, restrained the defendant from carrying on business in the three kinds of articles under the name "Cash" without taking reasonable precautions

¹ 18 R. P. C. 213; 19 *ib.* 181 (1902), Kekewich, J., and C. A.

to clearly distinguish the business and articles of the defendant from those of the plaintiffs.¹

In *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop Motor Company, Ltd.*,² the plaintiffs, manufacturers of tyres and motor accessories, but not of motors, sought to restrain the defendants from carrying on business under their registered name. The defendants had purchased a small retail business carried on at Kilmarnock by R. Dunlop and F. D. Dunlop, who became directors of the defendant company. They had sold and repaired motors and cycles. The defendant company was formed to acquire it and to manufacture and sell motors. The main objects of the businesses were different, the defendant company being mainly a motor company and the plaintiffs a tyre company, although in minor articles there was or might be a common production. The plaintiffs succeeded at the trial, but on appeal the Court of Session dissolved the interdict granted, and the House of Lords upheld their decision, holding that on the facts there was no probability of confusion. In the Court of Session Lord Kyllachy, in his judgment in the passage quoted above, expressed the view that as a matter of law a person could not be restrained from the use of his own name except in a case of fraud,³ and said that if *The Valentine* case affirmed or implied any broader proposition, he did not agree with it.

The Dunlop case.

In *Actiengesellschaft Hommel's Hæmatogen v. Hommel*,⁴ the plaintiffs manufactured according to the formula of Dr. Adolf Hommel, and sold a tonic called "Hommel's Hæmatogen," but the latter was a word open to anyone to use. Two of the defendants were nephews of Dr. Adolf Hommel and manufactured hæmatogen abroad, and the defendant company, *A. Hommel & Co., Ltd.*, was formed to act as their agents in this country. The defendants sold their hæmatogen not as Hommel's hæmatogen, but as "H-Ring hæmatogen," but on the cartons

The Hommel case.

¹ The order is printed at length in the Appendix, p. 807. In *B. Warsop & Sons, Ltd. v. Warsop*, 21 R. P. C. 481 (1904), the defendant traded as "*A. Warsop*," and this was held to be sufficiently distinguished from the plaintiffs' name, and from the plaintiffs' use of "*B. Warsop*" on the goods (cricket bats); both the plaintiffs' and defendant's bats bore the word "Marylebone," but they bore different devices.

² 22 R. P. C. 533; 23 R. P. C. 761; [1907] A. C. 430; 24 R. P. C. 572, Lord Ordinary, Ct. of Sess. and H. of L.

³ See also Romer, L.J., in *Abel Morrall v. Hessin*, 20 R. P. C. at p. 533: "The law is settled, it is merely a question of fact. If fairly and honestly done, it cannot be stopped; and the judgment of Kennedy, L.J., in *The Daimler* case, 24 R. P. C. at p. 390.

⁴ 29 R. P. C. 378 (1912), Eve, J.

in which it was contained were the words, "A. Hommel & Co., Hanau, Germany," and "Depôt for Great Britain and Ireland, A. Hommel & Co., Ltd." The plaintiffs complained of the get-up of the defendants' goods, but mainly of the use of the name Hommel, alleging that the use of that name in connection with the sale of hæmatogen must lead to confusion. The case came before the Court on an interlocutory injunction, and it was held that no imitation of the plaintiffs' get-up was proved, and that the cases established that the Court would not intervene to prevent a man using his own name, unless he was so using it as to lead the Court to the conclusion that he was using it for the fraudulent and dishonest purpose of filching improperly the trade of the plaintiff,¹ and that no such case was established on the motion.

The Teofani case.

In *Teofani & Co., Ltd. v. Teofani*,² it was proved that "Teofani Cigarettes" meant the plaintiff company's cigarettes, and they had under sec. 9 (5) registered "Teofani" as a trade mark. The defendant Athanasius Teofani commenced to sell cigarettes as A. Teofani's non-soluk³ cigarettes, and with the words "A. Teofani, London, Non-Soluk" on the cigarettes. Warrington, J., after considering *Jamieson v. Jamieson*⁴ and the judgment of Lord Halsbury in *Reddaway v. Banham*⁵ said that it came to this, that it is possible that "a man may by the use of his own name represent that his goods are the goods of somebody else, and the question in each case which the Court has to determine, and it is a question of fact, is: Is he making that representation? Or, to put it another way, the mere fact that the name which the defendant is using is his own name is not conclusive evidence that he is not passing off his goods as the goods of somebody else." An injunction was granted against the defendant selling his cigarettes as "A. Teofani's cigarettes," or otherwise marking his goods with the name Teofani without clearly distinguishing such cigarettes from those of the plaintiffs,⁶ and also against infringement of trade mark, it being held that the defendant's use of his name had not been *bonâ fide*, and he was not therefore protected by sec. 44 of the Trade Marks

¹ But see the case of *Cash v. Cash*, cited above, p. 600, and the cases cited, p. 564, note (1).

² 30 R. P. O. 76 (1913), Warrington, J.

³ That is, "not containing a particular kind of tobacco."

⁴ Cited above, p. 596.

⁵ Cited above, pp. 594, 595.

⁶ Affirmed by C. A., as to trade name infringement and passing-off, 30 R. P. O. 446 (1913); as to the validity of the trade mark, see above, p. 197.

Act, 1905. The decision has been affirmed on appeal. Swinfen Eady, L.J., in his judgment stated the law thus, that "a man may not by the use of his name or otherwise pass off his goods as the goods of another."

In *John Brinsmead & Sons, Ltd. v. Brinsmead*,¹ the plaintiffs, the well-known piano manufacturers, complained in a passing-off action of the manner of the use by the defendant, *Edward George Stanley Brinsmead*, of the name *Brinsmead*. On the fall of the plaintiffs' pianos the words "John Brinsmead & Sons (Limited), London" appeared in Roman letters surrounded by a line; on the fall of the defendant's pianos appeared the words "Stanley Brinsmead," in script with a line returning underneath from the D. The names Edward and George were written within the curves of the S of Stanley, which was the Christian name by which the defendant was known. The pianos manufactured by the defendant were of a cheap class. There was no evidence of dishonesty on the part of the defendant, unless the use of his name was dishonest. Warrington, J., held that the form in which the defendant put his name on his pianos was quite different from that in which the plaintiffs put their name on their pianos; that the defendant derived some advantage from the fact that his name was the same as that of well-known manufacturers, and that he was aware of that advantage; but that did not entail that the user was dishonest, and that the action failed.²

The second *Brinsmead* case.

As the earlier cases on the subject are useful as illustrations of circumstances under which the Court has restrained or limited, or refused to restrain or limit, the use by a defendant of his own name, although they cannot now be relied on as laying down a general principle, the summary of them contained in the former editions of this book has been retained.

The earlier cases.

The subject had been previously discussed by the Court of Appeal in *Turton v. Turton*.³ In that case the plaintiffs, Thomas Turton and Sons, Limited, were carrying on a widely known and extensive business acquired by the company in 1886, but established many years previously, under the name of *Thomas Turton*

Turton v. Turton.

¹ 30 R. P. C. 137 (1913), Warrington, J.

² Affirmed by C. A. (Times, July 23rd, 1910); see Addenda.

³ 42 C. D. 128 (1889), C. A., reversing North, J. In *Reddaway v. Banham*, Ld. Macnaghten said he was at a loss to know why this case was ever

reported. The plaintiff's case was extravagant and absurd: [1906] A. C. at p. 220. But the doctrine laid down in it has been qualified by *Reddaway v. Banham*, per Buckley, L.J., in the *Brinsmead* case; see Addenda.

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

Mr. Justice North, at the trial, granted an injunction in the terms of that in *Hendriks v. Montagu*; ¹ but the Court of Appeal reversed this order, and dismissed the action.

Lord Esher's judgment.

In the view of the facts taken by the Court of Appeal, the defendant, John Turton, was not shown to have done anything to give to the name objected to any other meaning than that he was carrying on business in partnership with his sons; he had not done anything with the intent or for the purpose of making the use of his simple name look as if his name were the name of the plaintiffs. "In some cases," Lord Esher said, "besides using the names, parties have, to use what, I think, is a happy phrase of my brother Cotton's, 'garnished that use'—that is, they have done things besides using the name, in order that the use of that name might look as if it were being used by the old firm. There is nothing of that kind here."

Notwithstanding the possibility of mistakes between the two firms being made by careless people, therefore, the Court held that the defendants were justified in adopting the name complained of, and in continuing its use after the possibility of mistake had been brought to their knowledge, and the action was accordingly dismissed. One may venture to regret that the Court did not adopt the slight extension of the principles

¹ Ante, p. 547.

appealed to which would have been necessary to forbid the defendants from choosing out of several alternative styles, all equally accurate as descriptions, and equally convenient according to business usage, the only one which was calculated to lead to mistake. If *Turton & Co.* did not suit the defendants, they might have been satisfied with *Turton*, *Turton and Turton*, or *Turton* preceded by the initials of the partners.

The foundations of the judgments of all the Lords Justices was that the statement comprised in the defendant's name was nothing other than a statement of the actual fact that their business was the business of Joseph Turton and his sons, expressed in the "ordinary mercantile way,"¹ and made "truly, honestly, and in the usual manner in which such statements are made in the course of business."² The case is, therefore, readily distinguishable from cases where a "fancy name" which is not descriptive of actual facts in ordinary language is appropriated,³ such as, for instance, the name—the "Universal Life Assurance Association"—in *Hendriks v. Montagu*.³ There is no justification for the adoption and use of any such name if it is calculated to deceive.

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

not necessarily by any "fancy name."

Massam v. J. W. Thorley's Cattle Food Co., Ltd.,⁴ closely resembled the case of *Tussaud v. Tussaud* already referred to.⁵ There the plaintiffs, as executors of one Joseph Thorley, were carrying on a well-known business in a special food for cattle established by their testator. The defendant company had engaged as their manager J. W. Thorley, who was a brother of Joseph Thorley, and having been in his employment some ten years previously, had become possessed of the recipe according to which the cattle food was made by the plaintiff's testator. J. W. Thorley was also the holder of a one-shilling share in the company. The defendants endeavoured to defend their use of the name which they had adopted on the ground of their relations with J. W. Thorley, but unsuccessfully, and the Court of Appeal were further of opinion that the defendants had imitated the get-up of the plaintiff's goods, and had intentionally acted so as to induce buyers to take their goods for them.

Massam v. Thorley.

The injunction granted left the defendants at liberty to use their name, and to use the word *Thorley* in connection with their

¹ Cotton, L.J., p. 142.

² Fry, L.J., p. 147.

³ Ante, p. 547; and see the latter part of the judgment of Cotton, L.J., 42

C. D. 145.

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

⁵ Ante, p. 555.

goods (if they could) in any way not calculated to mislead the public.¹

The injunction in this case might, in the view which the Lords Justices took of the facts, have been granted on the fraudulent intention of the defendants alone, for, as appears from the judgments quoted above, it is only the honest use of a man's own name which is ever a defence.²

Name must be the defendant's own name;

not a bought name,

And the justification only extends, in any case where it applies, to the use of a man's own name,³ or that of his predecessor who founded his business and established it under the name which the defendant is using;⁴ not to the use of that of his servant,⁵ or of an alleged partner who has really no interest in his business, and has been brought into it only in aid of an attempt to cover the employment of a deceptive name.⁶ Still less to the use of the name of a stranger,⁷ even though it is alleged that he has authorised the defendant to use it,⁸ Where a name has been

¹ See the form of injunction, 14 C. D. 762; and Appendix, p. 800.

² See also *Warner v. Warner*, 5 Times L. R. 327, 359; *Huntley and Palmer v. The Reading Biscuit Co.*, 10 R. P. C. 277 (1893), Chitty, J.; and *Clayton v. Day*, where one Day joined one Martin in a fraudulent attempt to carry on business as "Day and Martin," in unfair competition with the well-known firm, 26 Sol. J. 43 (1881), Chitty, J.

³ In *Mrs. Pomeroy, Ltd. v. Scalè*, 24 R. P. C. 177 (1907), the defendant contended that the name "Mrs. Pomeroy," which had been adopted by her in her business had become for all practical purposes her own name, and that the plaintiffs who had purchased the business formerly carried on by her, could not restrain her from using it. It was held, however, that she had by express agreement precluded herself from using it in a similar business. In *Macmillan v. Ehrmann*, 21 R. P. C. 357, 647 (1904), Buckley, J., and C. A., the defendants were using a Scotch firm name, which they had adopted for their whisky business, it never having been the name of an actual firm; but, although disapproval was expressed of such a practice, it was held that nothing that the defendants had done had tended to

intercept the plaintiff's trade.

⁴ See *Pinet v. Maison Pinet, Ltd.*, ante, p. 557; *Turton v. Turton*, ante, p. 603; *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L.J.; *Truefitt v. Edney*, 20 R. P. C. 321 (1903), Byrne, J.

⁵ *Southorn v. Reynolds*, 12 L. T. N. S. 75 (1865), Wood, V.-C. (*Southorn's Broseley Pipes*); *Birmingham Vinegar Brewery Co. v. Liverpool Vinegar Co.*, W. N. (1888), 139, North, J., cited p. 545; *Tussaud v. Tussaud*, ante, p. 555.

⁶ See *Croft v. Day*, infra; *Schweitzer v. Atkins*, 37 L. J. Ch. 847 (1868); *Dence v. Mason*, W. N. (1877), 23; (1878) 42 (*Brand's Essence of Beef*), both Malins, V.-C.

⁷ *Isaacson v. Thompson*, 41 L. J. Ch. 101 (1871), Bacon, V.-C. (*Madame Elise*), defendant used his daughter's name, *E. Louise*; interim injunction refused on account of delay. *Pearks, Gunston and Tee, Ltd. v. Thompson, Talmeij & Co., Ltd.*, 18 R. P. C. 185 (1901), Farwell, J.

⁸ *Croft v. Day*, 7 Beav. 84 (1843), Langdale, M.R. (*Day and Martin*); *Shrimpton v. Laight*, 18 Beav. 164 (1854), Romilly, M.R.; *Melachrino & Co. v. The Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215 (1887), Chitty, J. See also *Tussaud v. Tussaud* and

acquired with a goodwill in one business, the purchaser will not be permitted to use it unfairly in another business, in which the use of it would be deceptive.¹

Such practices are badges of fraud rather than grounds of defence. So, where the defendant has altered his name in such a way as to make it more nearly resemble the plaintiff's, the inference is almost inevitable that fraud is intended,² and whether it is or not, the rule in question only applies to the use of the defendant's name in its ordinary form.

But it is submitted that the name need not be that which the defendant received from his parents. A name which he has adopted and used until it has come to be his name by repute is as much his name as that by which his parents were known.³ Of course, a new name adopted at the time of, or shortly before, the alleged deceptive user of it would generally be taken to have been adopted for fraudulent purposes, even if it could be shown by the date of the trial to have become the defendant's name by repute.

The name of a company formed by the addition of "limited" to the firm name of a business which the company takes over stands in the same position as the firm name itself.⁴

In most of the reported cases in which a defendant has been restrained from passing off his goods as those of the plaintiff under cover of a similar name, the defendant has added the "circumstances of fraud," to which Knight-Bruce, L.J., referred, in *Burgess v. Burgess*,⁵ or, in the phrase of Cotton, L.J., in

Rendle v. Rendle & Co., above, p. 555, note (1), and *The Talmey* case, p. 606, note (7).

¹ See the cases cited above, p. 558, note (3).

² *Taylor v. Taylor*, 23 L. J. Ch. 255 (1854), Wood, V.-C.; *James v. James*, L. R. 13 Eq. 421 (1872), Romilly, M.R. (*Robert Joseph James* called himself *Robert James*), and see *Slazenger v. Feltham*, 6 R. P. C. 531 (1889), C. A.

³ See per James, L.J., and Bramwell, L.J., in *Massam v. Thorley, &c.*, 14 C. D. 757, 760. See also per North, J., in *Pinet v. Pinet*, 15 R. P. C. at p. 72. It has already been shown that a name of repute is protected as a trade name; above, p. 545. See also p. 606, note (3).

⁴ *Chivers v. Chivers*, above, p. 599.

See also *Townsend v. Jarman*, above, p. 589, note (5). In *Fine Cotton Spinners &c. Association, Ltd. v. Harwood, Cash & Co., Ltd.*, 24 R. P. C. 533 (1907), Joyce, J., said that a company with a title of which the name "A" forms part has none of the natural rights that an individual born with the name "A" would have. In that case the defendant company had taken the name of a mere promoter. The decision was followed and applied in *Kingston, Miller & Co., Ltd. v. Thomas Kingston & Co., Ltd.*, [1912] 1 Ch. 575; 29 R. P. C. 289. Cf. in *The Daimler* case, 24 R. P. C. at p. 390, the judgment of Kennedy, L.J.

⁵ Ante, p. 593; e.g., by adding & Co.; *Graveley v. Winchester*, Seb. Dig. p. 162 (1867), Giffard, V.-C.; *Churton v.*

or a name altered to resemble the plaintiff's;

but may be the defendant's name of repute.

Addition of "limited" to a firm name.

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

Turton v. Turton,¹ has "garnished the use of his name" by imitating the get-up of the plaintiff's goods,² or his labels and show-cards,³ or has issued circulars or advertisements⁴ calculated to foster the error which the resemblance of his name and that of the plaintiff's was calculated to produce.⁵

Thus, in *Moët v. Clybourn*,⁶ the defendant claimed to be entitled to use the names *Meadows* and *Clybourn*, and, by virtue of such right, to brand upon the corks of his champagne bottles the letters *M. & C.* in a circle on the bottom, and the word *England* at the side, in obvious imitation of the plaintiff's practice. And in *Holt v. Smith*,⁷ the defendant bought the business of H. Newman and changed its name to Newman & Co., in imitation of the plaintiff's trade name. In *Joseph Rodgers & Sons, Ltd. v. Joseph Rodgers Simpson*,⁸ the defendant was trading as "Joseph Rodgers Simpson & Son," having in fact no son as partner, and he was held in this and other ways to have used his name in a manner calculated to pass off his cutlery as that of the plaintiffs, and an injunction was granted against such unfair use.

The proximity of the place where the defendant sets up his business to that where a well-known firm is already trading may be evidence to show that, although trading under his own name, the defendant is seeking to take fraudulent advantage of its similarity to the plaintiff's name. The case of somebody finding a man named *Bass* and setting up a brewery at Burton as *Bass & Co.*,⁹ and the case of a man starting business as a banker in the Strand under the name of *Coutts*,¹⁰ have been cited as

Proximity
may be a
badge of
fraud.

Douglas, Johnson, 174; 28 L. J. Ch. 841 (1859), *Wood, V.-C.*; *Witt v. Concoran*, 2 C. D. 69 (1873), *Bacon, V.-C.*

¹ Ante, p. 603.

² *Holloway v. Holloway*, 13 Beav. 209 (1850), *Langdale, M.R.*, above, p. 596, n. (2); *Taylor v. Taylor*, p. 607, n. (2); *Schweitzer v. Atkins*, p. 606, n. (6); *Fullwood v. Fullwood* (1), W. N. (1873), 93, 185, *Malins, V.-C.*, and *L.J.J.*; *J. H. Brooks & Co., Ltd. v. Norfolk Cycle Co. and John Brookes*, 16 R. P. C. 523, *Stirling, J.*, above, p. 596, n. (5).

³ *Croft v. Day*; *Melachrino v. The Melachrino Egyptian Cigarette Co.*, p. 606, n. (8).

⁴ *Massam v. J. W. Thorley's Cattle Food Co.*, above, p. 607, n. (8).

⁵ In *Rigden v. Jones*, 22 R. P. C. 417,

the defendant who had purchased a retail business of gloves carried on as "F. & A. Fownes" was restrained from using the words "Fownes, Manchester" without prefixing "F. & A.," the plaintiffs being known as manufacturers of "Fownes' Gloves."

⁶ *Seb. Dig.* p. 316 (1877), *Jessel, M.R. (Moët and Chandon)*.

⁷ 4 *Times L. R.* 329 (1888), *Kay, J.* Action stayed on the defendant undertaking to use *H. and drop Co.*; defendant to pay costs.

⁸ 23 R. P. C. 297 and 348 (1906).

⁹ *James, L.J.*, in *Massam v. Thorley, &c.*, 14 C. D. p. 757; see above, p. 597.

¹⁰ *Chitty, J.*, in *Melachrino v. The Melachrino, &c. Co.*, 4 R. P. C. p. 221.

instances in which it is scarcely conceivable that the use of the name could be honest.¹ In *Turton v. Turton*,² the defendants were trading in the same town, Sheffield, as the plaintiff, but their presence there was reasonably accounted for, because their business had been established in the town long before the circumstances which led them to adopt the name complained of arose.

7. The Relief Granted.

The relief granted to the plaintiff, if he succeeds in the passing-off action, corresponds to that granted in the action for infringement of a registered trade mark to which the first-mentioned action is so closely allied. It comprises, therefore—(i.) an injunction;³ (ii.) an order for the delivery up for destruction, or for the erasure of the names or other badges, of any goods already marked with the deceptive names or badges, and in the possession or under the control of the defendant;⁴ and (iii.) damages in respect of the past interferences with the plaintiff's rights;⁵ or (iv.) an account of the profits made by the defendant by the sale of goods under the deceptive names or badges,⁶ or some one or more of these.

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

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

Where he has imitated or adopted the plaintiff's trade name, the order may be an absolute injunction that he shall not carry on business under that name.⁷

A very full form of order was adopted in *Massam v. Thorley's Cattle Food Co.*⁸ It restrained the defendant company and Injunction in *Massam v. Thorley*.

¹ *Lee v. Haley* is another illustration. There the plaintiff's late manager set up in business as the "Pall Mall Guinea Coal Co.," in the Strand, and afterwards removed to 46, Pall Mall. The plaintiffs traded, at 22, Pall Mall, as "The Guinea Coal Co." An injunction was granted; 21 L. T. N. S. 546; 22 *ib.* 251; L. R. 5 Ch. 155, Malins, V.-C., and Giffard, L.J.

² Page 603.

³ Last chapter, p. 488. See below, and the orders collected in the Appendix, pp. 798 *et seq.*

⁴ Page 498.

⁵ Page 499.

⁶ Page 501, 502.

⁷ As in *Hendriks v. Montagu*, 17 C. D. 638, set out above, p. 547.

⁸ 14 C. D. p. 762, set out in the Appendix, p. 800.

their servants from selling, or procuring to be sold, and from in any manner representing any goods manufactured by them as the goods of the late Joseph Thorley or the plaintiffs, his successors; from in any manner representing, or doing anything which should lead to the belief that the defendant company were carrying on the business of the late Joseph Thorley; from affixing to their goods, or otherwise employing, any labels, wrappers, or marks used by him or the plaintiffs, or so contrived as to represent, or lead to the belief, that the goods manufactured or sold by the defendant company were his goods or those of the plaintiffs; and from using or circulating any circulars or advertisements, used or circulated by him or the plaintiffs, or which should in any manner represent or lead to the belief that the defendant company had been or were carrying on the business of the late Joseph Thorley, or were his successors.

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

But a device or name, which is not a trade mark or the trade name of the plaintiff, may always be used by the defendant in any way which is not calculated to deceive, if such way can be found; and the injunction in passing-off cases is usually drawn so as to preserve this right, the order not to use a particular device or word being qualified by the addition "so as to represent, or lead to the belief," that the defendant's goods are the plaintiff's.¹

Thus, in *Massam v. Thorley's Cattle Food Co.*, the Lords Justices refused to prohibit the defendants from using the word Thorley in connection with cattle food altogether.² And in *Slazenger v. Feltham*, the Court of Appeal modified the order of Kekewich, J., forbidding the defendants to stamp *Demotic* on their lawn-tennis bats, by adding the words "so as to represent that (they) are manufactured by the plaintiffs, or in any other way from passing off their lawn-tennis bats as the goods of the plaintiffs."

Where what is complained of is the deceptive use of an open word, which has come to be associated with the plaintiff's trade

¹ *Slazenger & Sons v. Feltham & Co.*, 6 R. P. C. 531 (1889); *Jay v. Ladler*, 40 C. D. p. 656; 6 R. P. C. 186 (1888), Kekewich, J.; *Magnolia Metal Co. v. Atlas Metal Co.*, 14 R. P. C. 389 (1897), Collins, J., and C. A. For a form of injunction in a trade name case in

which the plaintiffs had not an exclusive but only a qualified right in a particular word, see *Daimler Motor Co. (1904), Ltd. v. London Daimler Co., Ltd.*, 24 R. P. C. 379 (1907), C. A.

² 14 C. D. 763.

or goods, the form of injunction is now generally directed to prevent the defendant from using it "without clearly distinguishing his goods from the plaintiffs." This was the form adopted in the infringement cases *Seixo v. Provezende*,¹ and *Johnston v. Orr-Ewing*,² and in *The Yorkshire Relish*,³ and *The Stone Ales* cases. In the last-mentioned case several of the Lords of Appeal referred to it as the proper form to adopt unless the plaintiff had a claim to the exclusive use of the word, name, or other mark in question.⁴

"Without distinguishing, &c."

In the last-mentioned case, however, the injunction to restrain the defendant (*inter alia*) from selling beer not of the plaintiff's manufacture, under the term *Stone Ales* or *Stone Ale*, or in any way so as to induce the belief that such ale was of the plaintiff's manufacture, was, under the circumstances, maintained, the Lords of Appeal holding that the *Seixo v. Provezende* form of injunction would be more stringent, as it would, in effect, prevent the defendant using the term *Stone Ale* at all.⁵

The Stone Ales case.

And the defendant has, in some instances, been restrained from using a word or words which could not be used by him at all, except deceptively, so long as this should continue to be the case; for instance, from calling his bitters *Angostura Bitters* until he should find out how to make the real *Angostura Bitters*; ⁶ or from using the name *Radstock Colliery Proprietors* until he should be able to sell coal from Radstock.⁷

Temporary or contingent prohibition.

The *Pinet* cases⁸ illustrate the different cases to which the absolute and the limited forms of injunction are respectively applicable. In the first case it was supposed that the assignor

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

² 13 C. D. 494; 7 App. Ca. 219, Fry, J., C. A., and H. L.

³ Above, p. 540. *Bewlay & Co., Ltd. v. Hughes*, 15 R. P. C. 290 (1898), North, J. (*Dindigul Cigars*); and *Grezier and Doyle v. Autran*, 13 R. P. C. 1 (1895), Chitty, J., and C. A. and *Rey v. Lecouturier*, 25 R. P. C. 265, [1910] A. C. 262; 27 R. P. C. 268 C. A., and H. of L. (both *Chartreuse*), are other examples. See also Ld. Macnaghten's judgment in *Reddaway v. Banham*, [1896] A. C. at p. 221; 13 R. P. C. at p. 284.

⁴ Ld. Watson and Ld. Macnaghten :

Montgomery v. Thompson, [1891] A. C. 217; 8 R. P. C. 361; see also *Thompson v. Bent's Brewery Co., Ltd.*, 8 R. P. C. 479 (1891), Chitty, J. In *The Magnolia* case, p. 610, n. (1), Collins, J., granted an injunction in this form, and the plaintiffs unsuccessfully appealed, asking for an absolute prohibition.

⁵ See above, p. 575; and *Braham v. Beachim*, there cited.

⁶ *Siegert v. Findlater*, 7 C. D. 801 (1878), Fry, J.

⁷ See ante, p. 575.

⁸ *Pinet v. Maison Pinet, Ltd.*, 14 R. P. C. 938 (1897), C. A.; *Same v. Maison Louis Pinet, Ltd.*, 15 R. P. C. 65, North, J.

to the defendant company had traded under his own name, "Pinet," and a limited injunction was granted. Subsequently it was discovered that this was not his own name, but a name adopted for the purpose of the fraud, and thereupon an absolute injunction was decreed.

No rule as to what distinction is sufficient.

No general rule can be laid down as to what additions to the objectionable matter will be sufficient to effect the requisite distinction.¹ It must depend upon the circumstances of each case.² Where the order is in respect of a word which has, in fact, become the trade name of the plaintiff's goods, the most careful differentiation of the get-up of the goods,³ and the greatest possible prominence of the defendant's own name⁴ upon his labels may not be enough. In such cases the limitation of the order is more likely to mislead the defendant than to protect him in his assumed right to use the word.

Limited to particular market.

The injunction may be limited with reference to the use of the mark in a particular country or market.⁵

¹ "No Court has ever said how the distinction is to be made": per Stirling, J., in *Powell v. Birmingham Vinegar Co.*, [1896] 2 Ch. at p. 64. Also *Kerfoot v. Cooper*, 25 R. P. C. 508 (1908). But see the last chapter, pp. 496, 497. In France the Court sometimes settles what may be used: see *Grezier and Doyle v. Autran*, 13 R. P. C. 1.

² Since the decision in *Reddaway v. Banham*, cited above, p. 570, there have been three cases as to "camel-hair" bolting in which the question has arisen whether the defendant sufficiently distinguished, namely, *Reddaway v. Ahlers*, 19 R. P. C. 14 (1902), *Reddaway v. Frictionless Engine Packing Co.*, 19 R. P. C. 505, and *Reddaway v. Stevenson*, 20 R. P. C. 276 (1903). In the second of these cases it was held that the prefixing of the defendants' name was sufficient, although they were not manufacturers, but the result was different in the last case, where it was pointed out that each case must rest on its own facts. It is no answer to say that the custom of the trade is not to distinguish, see the first of the three cases. In *Grand Hotel Co. of Caledonia Springs v. Wilson*, [1904] A. C. 103; 21 R. P. C. 117, P. C., the plaintiffs being the owners of natural

springs at Caledonia, Ontario, sold the water as "Caledonia Water" or "Caledonia Springs Water." They had, however, no exclusive right to the word "Caledonia," and the defendants, who owned springs in the same neighbourhood and sold "Natural Saline water from the New Springs at Caledonia," were held to have sufficiently distinguished. See also *Warsop v. Warsop*, cited supra, p. 601, n. (1), where A. Warsop was held to be sufficiently distinguished from *B. Warsop & Sons, Ltd.*

³ In *Powell v. Birmingham Vinegar Co.*, cited in note (1), the bottles and labels of the defendants' *Yorkshire Relish* were totally different from those of the plaintiffs. They are shown in 13 R. P. C. pp. 237, 238, and 240.

⁴ In *Daniel and Arter v. Whitehouse*, 16 R. P. C. 71 (1898), North, J., *F. Whitehouse's Brazilian Silver* was held to be an infringement of an order not to use *Brazilian Silver* without distinguishing, &c.

⁵ *Carver v. Bowker*, Seb. Dig. p. 350 (1877), Little, V.-C., a trade mark case before the Acts; *Barber v. Manico*, 10 R. P. C. 93 (1893), A. L. Smith, L.J.; the action succeeded only as to passing-

Interim injunctions are granted in passing-off actions on the same terms and according to the same principles as in infringement actions.¹ Interim injunctions.

In *Weingarten v. Bayer & Co.*,² Vaughan Williams and Cozens-Hardy, L.JJ., expressed the opinion that, had the plaintiffs succeeded, it would have been a case for damages and not profits, but in the House of Lords, where it was held that the defendant had sold his goods as and for the plaintiffs' by the use of the descriptive name "Erect Form Corsets" in a special type and with a special scroll used by the plaintiffs and an injunction was granted limited to the use of the special form, an account of profits derived from the sale of corsets so distinguished was ordered. Lord Macnaghten stated that ever since the case of *Edelsten v. Edelsten*,³ it had been the established rule that a plaintiff succeeding in a case of that sort might at his option take an inquiry as to damages or an account of profits.⁴ Damages or profits.

8. Costs, Appeals, and Practice.

And the rules and principles in regard to costs,⁵ appeals,⁶ and practice,⁷ are also the same in both actions, except in so far as they depend upon registration and the Registration Acts, which do not extend to or affect passing-off actions.

off; the injunction was limited to Ireland. In *Société, &c. de l'Etoile's Tm.*, [1894] 1 Ch. 61; 10 R. P. C. 436, a registered trade mark case, Stirling, J., said that he did not think limiting the registration would give the applicants, under the circumstances of the case, complete relief. See above, pp. 258 and 491. In *Weingarten v. Bayer*, 20 R. P. C. 289 (1903), Joyce, J., refused to limit the injunction which he granted to England or the account of profits to sales in England. The case went to the Court of Appeal, 20 R. P. C. 649, and the House of Lords, 22 R. P. C. 341 (see the text, *supra*). See also the judgment of Lord Johnston, L.O., in *Price's Patent Candle Co., Ltd. v. Ogston and Tennant*, 26 R. P. C. 797, at p. 813 (1909), Scotland, where the view was expressed that the interdict might be limited to a particular market

of such definite extent and character as the Morocco market. But as to limiting an injunction to a particular county, see *Royal Insurance Co., Ltd. v. Midland Insurance Co., Ltd.*, 26 R. P. C. 95 (1909), C. A.

¹ Chap. XV., p. 492.

² See note (5), p. 612.

³ 1 D. J. & S. 185.

⁴ See Chap. XV., p. 499, where the general principles as to damages are stated. In a trade name case in Scotland, where the L. O. awarded £50 damages, the Inner House varied the decree, disallowing damages, on the ground that no actual deception had been proved: *Kinnell & Co., Ltd. v. Ballantine & Sons*, 27 R. P. C. 185 (1910), (*Horse-shoe boilers*).

⁵ Page 506.

⁶ Page 517.

⁷ Page 519; forms of pleadings, p. 792.

NOTE.

In *Powell v. Birmingham Vinegar Brewery Co.*, [1896] 2 Ch. at p. 79; 13 R. P. C. at p. 256, Kay, L.J., said: "The law relating to this subject may be stated in a few propositions: (1) It is unlawful for a trader to pass off his goods as the goods of another. (2) Even if this is done innocently it will be restrained (*Millington v. Fox*, 3 My. & Cr. 338). (3) *A fortiori* if done designedly, for that is a fraud. (4) Although the first purchaser is not deceived, if the article is so delivered to him as to be calculated to deceive a purchaser from him, that is illegal (*Sykes v. Sykes*, 3 B. & C. 541). (5) One apparent exception is that where a man has been describing his goods by his own name, another man having the same name cannot be prevented from using it, though this may have the effect of deceiving purchasers (*Burgess v. Burgess*, 3 De G. M. & G. 896; *Turton v. Turton*, 42 C. D. 128). (6) But this exception does not go far. A man may so use his own name as to infringe the rule of law. 'It is a question of evidence in each case whether there is false representation or not' (per Turner, L.J., *Burgess v. Burgess*, 3 De G. M. & G. 905). So he may be restrained if he associates another man with him, so that under their joint names he may pass off goods as the goods of another person (*Croft v. Day*, 7 Beav. 84; *Clayton v. Day*, 26 Sol. Jour. 43; *Melachrino v. The Melachrino Egyptian Cigarette Co.*, 4 R. P. C. 215). (7) Another apparent exception is where a man trading under a patent had a monopoly for fourteen years, and has given the article a descriptive name, he cannot, when the patent has expired, prevent another from selling it under that name (*Young v. Macrae*, 9 Jur. N. S. 322; *Linoleum Co. v. Nairn*, L. R. 7 C. D. 834). (8) I am not sure that this would be so if the name so used were the name of the patentee, or even a purely fanciful name not descriptive. (9) Certainly where there has not been a patent, and an article has been made and sold under a fanciful name not descriptive, so that the article as made by one person has acquired reputation under that name, another trader will not be permitted to use the name for a similar article made by him (*Braham v. Bustard*, 1 H. & M. 447; *Cochrane v. MacNish*, 13 R. P. C. 100). (10) In this last proposition there is again a limitation. If the first maker has slept upon his rights or allowed the name to be used by others until it has become *publici juris*, this Court will not interfere."

Rule.

First exception.

Second exception.

Third exception.

CHAPTER XVII.

WARRANTY OF TRADE MARKS AND TRADE DESCRIPTIONS.¹

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

“On the sale or in the contract for the sale of any goods to which a trade mark,² or mark, or trade description³ has been applied,⁴ the vendor shall be deemed to warrant that the mark is a genuine⁵ trade mark and not forged⁶ or falsely applied,⁷ or that the trade description is not a false trade description⁸ within the meaning of this Act, unless the contrary is expressed in some writing signed by or on behalf of the vendor and delivered at the time of the sale or contract to and accepted by the vendee.”

This section corresponds to sec. 19 of the Merchandise Marks Act, 1862, but the older section applied only to trade marks which were applied to goods sold, and the implied warranty was that the trade marks were “genuine and true, and not forged or counterfeit, and not wrongfully used.”

Trade mark⁹ here means registered trade mark or trade mark Trade mark. protected by law in any British possession or foreign state to

¹ The references in this chapter are to the Merchandise Marks Act, 1887, which is set out in the Appendix, p. 886. It is fully dealt with and commented on in the 3rd ed. of Kerly on Merchandise Marks.

² “Trade mark,” sec. 3 (1), see the text, *infra*.

³ “Trade description,” sec. 3 (1).

⁴ “Applied,” sec. 3 (2), and sec. 5 (1).

⁵ “Genuine,” cf. sect. 2 (2) (a).

⁶ “Forged,” sec. 4.

⁷ “Falsely applied,” sec. 5 (3).

⁸ “False trade description,” sect. 3 (1).

⁹ “Trade mark,” sect. 3 (1).

which sec. 91 of the Patents and Designs Act, 1907, is applicable.¹ Section 17, however, imports a warranty of the genuineness of unregistered English trade marks, at any rate when the application of them to the goods is reasonably calculated to lead persons to believe that the goods are the manufacture or merchandise of the proprietor of the trade mark, and also of any trade mark, whether registered or not, which the mark applied to the goods purports to be, for in such cases the mark is a false trade description applied to the goods.² "Mark," where it first occurs in the section, can hardly include an unregistered trade mark, for the warranty implied is that the mark is a genuine trade mark, that is, a genuine registered trade mark, and that it does not purport to be. "Mark," where it occurs the second time, should be trade mark or mark.

The several terms occurring in the section have the meanings given to them respectively by the sections of the Merchandise Marks Act, 1887, which are referred to in the notes.³ The general effect of the implied warranty is that the trade marks, or marks purporting to be trade marks, applied to the goods, are used with the assent of the proprietor of the trade marks which they purport to be, and that the statements made or implied by the trade descriptions are true.

Statement in writing to the contrary.

The saving at the end of the section is, it will be observed, very carefully expressed. The statement required to prevent the implication of a warranty must be in writing, signed, delivered at the time of sale, and accepted by the vendee.⁴ What

¹ The reference is to sec. 103 of the Act of 1883, but by virtue of sec. 38 (1) of the Interpretation Act, 1889, see p. 718, the reference is now to the re-enactment. As to the trade marks so protected, see Chap. XX., p. 640, and the list in the Appendix, p. 811.

² Sec. 3 (2).

³ See notes on previous page; also Appendix, p. 886.

⁴ The Food and Drugs Act, 1875 (38 & 39 Vict. c. 63), s. 25, enables the vendor to set up as a defence that he purchased the adulterated goods under a written warranty and resold them unaltered. See *Laidlaw v. Wilson*, [1894] 1 Q. B. 74; *Robertson v. Harris*, [1900] 2 Q. B. 117; *Elliott v. Pilcher*, [1901] 2 K. B. 817; *Watts v. Stevens*, [1906]

2 K. B. 323; *Evans v. Weatheritt*, [1907] 2 K. B. 80, on the question, where the warranty is not given in express reference to a particular consignment, what evidence is necessary to connect any particular consignment with the warranty. Sec. 20 of the Sale of Food and Drugs Act, 1899 (62 & 63 Vict. c. 51), requires notices of the intention to rely on the warranty as a defence to be given to the purchaser and to the person who has given the warranty. Giving a false warranty is an offence, sec. 27 of the Act of 1875, unless the person giving it had reason to believe the statements or descriptions to be true, sect. 20 of the Act of 1899. Sec. 9 makes any alteration in the article without disclosure to the

“accepted by the vendee” means is not clear. It would probably be construed to import at least that the vendee understood that he was to get no warranty, and that he completed the purchase on that footing.

Apart from the statutory warranties implied by the Merchandise Marks Act, it is held, at common law,¹ that when a purchaser orders goods from a firm who are manufacturers only of such goods, and not dealers in them, then, unless it is shown that in the particular trade, or as regards the particular goods, there is a custom for the manufacturer to supply the goods of other makers, the purchaser must be assumed to have contracted with the particular manufacturers in reliance on the general excellence of the work of their firm, and he is entitled (in the absence of any express stipulation to the contrary) to have goods of the manufacturer’s own make delivered in performance of the contract.²

Implied warranty at common law.

It is a question of fact, or, if there is a written contract, of construction, whether a manufacturer or vendor has agreed to deliver the goods which are referred to by a trade mark in the contract, stamped with the mark, and being, therefore, goods of the kind properly denoted by it, or whether he has agreed only to deliver goods of the same quality as those which are denoted by the mark. Thus, in *Hopkins v. Hitchcock*,³ where the contract was for iron described as “S. and H. (crown) bars,” and the vendors were Hopkins & Co., the successors of Snowden and Hopkins, iron marked “H. & Co.” with a crown was delivered, and the jury found that the mark was not a material

Warranty where goods are described by a trade mark.

purchaser an offence. A notice exhibited in the shop may be such a disclosure: *Spiers and Pond v. Bennett*, [1896] 2 Q. B. 65. Cf. *Pearks, Gunston and Tee, Ltd. v. Houghton*, [1902] 1 K. B. 889, *Dawes v. Wilkinson*, [1907] 1 K. B. 279. Knowledge of the adulteration on the purchaser’s part is not a defence: *Heywood v. Whitehead*, 76 L. T. 781 (1897). Under sec. 17 of the Merchandise Marks Act, such questions can hardly arise. The statement in writing must, if the construction in the text is adopted, be a term of the contract. Disclosure that, for example, a trade mark is not genuine without the statement in writing would not prevent a warranty being implied. Under the

Food and Drugs Act proof of scienter is necessary to a conviction for giving a false warranty, *Derbyshire v. Houlston*, [1897] 1 Q. B. 772.

¹ Warranties of the genuineness of marks are implied, in respect of *anchors and chain cables*, by 37 & 38 Vict. c. 51, s. 4, and in respect of *hops*, by 29 & 30 Vict. c. 37, s. 8.

² Per Cotton, L.J., in *Johnson v. Raylton*, 7 Q. B. D. 438 (1881), Cotton and Brett, L.J.J., Bramwell, L.J., dissenting; *Starey v. Chilworth Gunpowder Co.*, 24 Q. B. D. 90 (1889), Div. Court.

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

part of the bargain. Judgment was given for the vendors in an action for the price of the iron, and the Court of Queen's Bench upheld the judgment, on the ground that the contract was for iron of a particular quality, not for iron bearing a particular mark.¹

Pictures ascribed to particular artists.

A somewhat similar question has arisen upon sales of pictures under the names of the supposed painters of them, and in such cases the matter to be decided is whether the use of the artist's name amounts to a warranty by the vendor that the picture in question is his, or merely to an expression of the vendor's opinion.

In the case where pictures had been sold as "Views in Venice, Canaletto," and they were not by Canaletto,² the question was left to the jury; but where the supposed artist was an old master, Lord Kenyon, at *Nisi Prius*, held that it was impossible to make the case one of warranty. The pictures, he said, were the work of artists of some centuries back, and there being no way of tracing the picture itself, it could only be matter of opinion whether the picture in question was the work of the artist whose name it bore or not; the catalogue only expressed the opinion of the vendor, but left the determination to the buyer's own judgment.³

Remedy for breach of the warranty.

The remedy for breach of warranty, whether implied under the section set out above, or at common law,⁴ or imported by express agreement in any contract in regard to goods sold or agreed to be sold, is an action for damages, reduction of the agreed price, or rescission of the contract. The rules determin-

¹ Section 14 of the Sale of Goods Act, 1893, which deals with the implied condition that goods sold for a particular purpose are reasonably fit for that purpose, does not come within the scope of this work, but it may be noticed that it has been held that the sale of an article under the descriptive name by which it is known in the trade is not a "contract for the sale of a specified article under its patent or other trade name" within the proviso of that section, *Gillespie v. Cheney, Eggar & Co.*, [1896] 2 Q. B. 59. On the sale of a patented article the implied warranty of title under sec. 12 of the Sale of Goods Act, 1893, does not ex-

tend to the validity of the patent, nor to a warranty that the purchaser will be able to use the article without infringing the rights of other patentees, *Monforts v. Marsden*, 12 R. P. C. 266 (1895), Russell, L.C.J.

² *Power v. Barham*, 7 C. & P. 356; 4 Ad. & E. 472; 5 L. J. K. B. (N. S.) 88 (1835) (Canaletto died in 1768). The jury found there was warranty.

³ *Jeuwine v. Slade*, 2 Esp. N. P. C. 573 (1797) (Teniers and Claud Lorraine, who died in 1694 and in 1682 respectively).

⁴ See Benjamin on Sale, Book IV., Part II., Chap. I.

ing the nature and extent of the remedy are now contained in the Sale of Goods Act, 1893,¹ from which the following sections are quoted:—

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

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

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

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

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

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

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

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

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

11.—(1) In England or Ireland—

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

Rescission of the contract for breach of warranty.

When condition is to be treated as warranty.

¹ 56 & 57 Vict. c. 71.

“(b.) Whether a stipulation in a contract of sale is a condition the breach of which may give rise to a right to treat the contract as repudiated, or a warranty the breach of which may give rise to a claim for damages, but not to a right to reject the goods and treat the contract as repudiated, depends in each case upon the construction of the contract. A stipulation may be a condition, though called a warranty in the contract.¹

“(c.) Where a contract is not severable, and the buyer has accepted the goods, or part thereof, or where the contract is for specific goods, the property in which has passed to the buyer, the breach of any condition to be fulfilled by the seller can only be treated as a breach of warranty, and not as a ground for rejecting the goods and treating the contract as repudiated,² unless there be a term of the contract, express or implied, to that effect.

The Scotch rule.

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

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

Damages for breach of warranty of trade mark.

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

¹ See *Behn v. Burness*, 3 B. & S. 756; 32 L. J. Q. B. 204 (1863), Blackburn on Sale, 2nd ed., p. 198. Also *Nadel v. Martin*, 20 R. P. C. 129 and 723; 23 R. P. C. 41 (1906), H. of L.; *Burchem v. Wren*, 21 R. P. C. 683 (1904), Darling, J.; *Henderson v. Shiels*, 24 R. P. C. 109 (1907), Parker, J.; in which questions arose whether on the construction

of agreements for sale and licence of patents a guarantee of validity was a condition or a mere warranty.

² *Street v. Blay*, 2 B. & Ad. 460 (1831); *Heyworth v. Hutchinson*, L. R. 2 Q. B. 447 (1867); *Hooper v. Balfour*, 62 L. T. 646 (1890); *Re Green and Balfour*, 63 L. T. 97, 325 (1890).

damages directly and naturally result in the ordinary course of events from the breach of warranty. It will also enable the purchaser to recover from the vendor any damages which may have been recovered from the purchaser by a sub-purchaser upon a resale by him, at any rate where the goods were known by the vendor to have been bought for the purpose of resale.¹

A manufacturer has at common law, and apart from any question of implied warranty, a right of indemnity by his customer, if, in compliance with the customer's orders, he innocently places a mark upon goods made for him, and the mark turns out to be an infringement of some third person's trade mark, so that the manufacturer is rendered liable to an action by the owner of the trade mark.²

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

In an action for infringement of trade mark the defendant served a third party notice on his vendor, claiming to be indemnified by him against liability on the ground that the goods were innocently purchased by him in good faith from the third party in the ordinary way of trade, and that the third party supplied the same to him without notification of any such infringement or wrong as in the claim alleged in the action; and an order was made that the third party notice should be tried immediately after the action, and that the third party should have liberty to take such part in the action as the judge at the trial should think fit.³

Third party notice.

¹ *Hammond v. Bussey*, 20 Q. B. D. 79 (1887), C. A.; *Agius v. Great Western Colliery Co.*, [1899] 1 Q. B. 413. See further, as to consequential damages, *The Argentino*, L. R. 13 P. D. 191 (1869), C. A.

² *Dixon v. Faucus*, 3 Ell. & Ell. 537; 30 L. J. Q. B. 137 (1861). As to the defence of the manufacturer in any such case upon proceedings under the Merchandise Marks Act, see sec. 2. (2), sec. 6, and sec. 19 (3) of that Act,

Appendix, pp. 887, 889, and 894, and Kerly on Merchandise Marks, 3rd ed., pp. 51, 52, 61.

³ *Hennessy v. Dompé*, 19 R. P. C. 338 (1903). At the trial, however, the third party was treated as a defendant, so that the action was tried as between the original plaintiff and both defendants, and, the plaintiff failing, he was ordered to pay the costs of both. On appeal, both defendants submitted to an order on terms, 20 R. P. C. 175 (1903).

CHAPTER XVIII.

TRADE LIBEL.

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

UNDER sec. 36 of the Patents and Designs Act, 1907,¹ an action for damages or an injunction lies against any person claiming to be a patentee, who by circulars, advertisements, or otherwise, threatens any other person with legal proceedings or liability, at the instance of anyone who is aggrieved by the threats.² The section does not extend to threats in respect of the use of a trade mark or trade name, and there is no precisely corresponding right apart from it. So that the publication in good faith of a statement that the plaintiff is infringing the defendant's trade mark, and that the defendant intends to take proceedings against all persons dealing in the infringing goods, is not actionable, and cannot be restrained by injunction.³ In

¹ Replacing sec. 32 of the Patents, &c. Act., 1883. The provisions are now extended to designs, Patents and Designs Act, 1907, sect. 61.

² Frost, 4th ed., Vol. I., p. 308, and Terrell, 5th ed., p. 268. *Challender v. Royle*, 36 C. D. 425; 4 R. P. C. 363 (1887), C. A.; *Johnson v. Edge*, [1892] 2 Ch. 1; 9 R. P. C. 142, C. A.; and

Skinner v. Shew, [1893] 1 Ch. 413; and as to damages, *S. C.*, [1894] 2 Ch. 581; and *Skinner v. Perry*, 11 R. P. C. 406 (1894).

³ *Colley v. Hart*, 44 C. D. 179; 6 R. P. C. 17 (1888), North, J. (interim injunction refused as to the trade mark). Also at the trial, 7 R. P. C. 108, at p. 113.

a passing-off case,¹ a counterclaim which alleged threats merely without malice was ordered to be struck out as disclosing no reasonable cause of action.

But disparaging statements calculated to injure the plaintiff's trade or to diminish the value of his goods, if they are not made in good faith, are actionable; and the continued publication of them after they have been shown, or have been held by the Court,² to be untrue may be restrained.³ For they amount to libels on the plaintiff in the way of his trade, or to slander of title.⁴

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

A fair warning to the public, or to probable purchasers of the goods, or to customers of the businesses concerned, by a trader that he regards the conduct of another as an infringement of his rights, if published in good faith, and in the belief that it is well founded, is not libellous,⁵ although it may turn out to be mistaken.⁵ So, anyone who thinks his trade name is likely to be confused with that of another business may publish a warning that there is no connection between his business and the other.⁶ And this, notwithstanding the pendency of proceedings in which the right of the proprietor of the other to use the name or marks

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

¹ *Ripley v. Arthur & Co.*, 18 R. P. C. 82 (1901), Farwell, J.

² *Burnett v. Tak*, 45 L. T. 743 (1882), Kay, J.

³ *Wren v. Weild*, L. R. 4 Q. B. 730 (1869), a patent threats action before the Act of 1883. In *Halsey v. Brotherhood*, 19 C. D. p. 392 (1831), a similar action, Lindley, L.J., said: "*Wren v. Weild* comes to this: that if I am a patentee, so long as I act honestly, I am entitled to say, without running the risk of having an action for damages brought against me, that somebody is infringing my patent, or that somebody else's manufacture is an infringement of my patent. . . . If I say it dishonestly, I am so liable; and if I know that what I say is untrue, it would not take much to persuade a jury that I was acting dishonestly."

⁴ A false and malicious statement in writing, printing, or by word of mouth, injurious to any person's title to property, and causing special damage, is an actionable slander of title. Tindal, C.J., in *Malachy v. Soper*, 3 Bing. N. C. 371 (1835).

⁵ In *Dicks v. Brooks*, 15 C. D. p. 40. (1880), Bramwell, L.J., said: "Although, according to our opinion, they would have been wrong in their law with respect to its being a piracy, I think their saying so would not have been actionable, because a man is not bound to be correct in his statement of law, though he is bound to be correct in his statement of facts." "To support such an action it is necessary for the plaintiffs to prove (1), that the statements complained of were untrue; (2), that they were made maliciously, *i.e.*, without just cause or excuse; (3), that the plaintiffs have suffered special damage thereby": per Ld. Davey, in *Royal Baking Powder Co. v. Wright, Crossley & Co.*, 18 R. P. C. 95 (1901), H. of L. See also the passage as to *bona fides*, below, p. 627.

⁶ *Thorley's Cattle Food Co. v. Masam*, 14 C. D. 763 (1880), C. A.; *William Coulson & Sons v. James Coulson & Sons*, 3 Times L. R. 740 (1887), Div. Court. In the last case the defendants added to their warning a statement that the plaintiff firm was lately bankrupt.

he has adopted comes into question.¹ But under pretence of the honest publication of a fair warning there is no excuse for an allegation that the goods of the other party are spurious,² or that he is foisting a fictitious article upon the public,³ or is fraudulently endeavouring to pass off his goods as those of the person who issues the advertisement or circular complained of.⁴

Suggestion that the plaintiff's goods are spurious.

Thus, in *Thorley's Cattle Food Co. v. Massam*,⁵ the defendants had published an advertisement warning the public that any goods purporting to be Thorley's Cattle Food, and not signed by their trade name "Joseph Thorley," were not of their manufacture, and alleging that they were the only persons possessed of the secret recipe according to which the food was compounded, and had published also a circular stating that the plaintiffs were seeking to "foist upon the public an article which they pretend is the same as that manufactured by the late Joseph Thorley." The defendants were the executors of the late Joseph Thorley, the inventor of the cattle food, and they were carrying on his business; but the statement that they alone possessed the secret recipe, and the suggestion that the goods of the plaintiffs were not prepared according to it, were both false, for one Josiah Thorley, a brother of Joseph Thorley, who had obtained the recipe from him, was manager of the plaintiff company.⁶ An injunction was granted at the trial to restrain the defendants from advertising, or representing, or suggesting in their advertisements or circulars, that they, or the proprietors of their testator's business, were alone possessed of the secret recipe, and from representing or suggesting, or doing anything calculated to represent or suggest, that the cattle food manufactured or sold by the plaintiffs was spurious or not genuine.

And in *Thomas v. Williams*,⁷ the publication of circulars suggesting that the goods of the plaintiff were not genuine, but were imitations of goods sold by the defendants, was restrained.

¹ *Coats v. Chadwick*, [1894] 1 Ch. 347, Chitty, J.; see p. 629, n. (1) below; *Anderson v. Liebig, &c. Co.*, 45 L. T. 757 (1881), Chitty, J.

² *Thorley's case*, supra, p. 623, n. (6).

³ See note (6), previous page.

⁴ *Coats v. Chadwick*, supra.

⁵ Supra; *Liebig, &c. Co. v. Anderson*, 55 L. T. 206 (1887), Chitty, J.

⁶ A suit for an injunction by the executors to restrain the use of the name *Thorley's Cattle Food* by the company

had been abandoned, after an application in it for an interim injunction had failed; 6 C. D. 583, Malins, V.-C. But, subsequently, the executors succeeded in a trade name and passing-off action against the company, ante, p. 605.

⁷ 14 C. D. 864 (1880), Fry, J.; *Liebig, &c. Co. v. Anderson*, note (5), "only genuine brand"; *Cars v. Bland Light Syndicate, Ltd.*, 28 R. P. O. 88 (1911), Warrington, J.

But a mere puff of the defendant's own goods, or a statement that they are superior to those of a rival trader, even if untrue and the cause of damage to the latter, is not actionable.¹ And it cannot be made actionable by proof of malice.¹

In an action for a trade libel, as distinguished from an ordinary personal libel, proof of damage—*i.e.*, that the publication of the libel has actually injured the business or property of the plaintiff—is essential.² If the libel is “in its very nature intended, or reasonably likely to produce,” and “in the ordinary course of business does produce, a general loss of business, as distinct from the loss of this or that known customer, evidence of such general decline of business is admissible” to prove damage.³

Damage must be proved.

¹ *Hubbuck v. Wilkinson*, [1899] 1 Q. B. 86, C. A., adopting the opinion expressed by Herschell, L.C., in *White v. Mellin*. In the latter case ([1894] 3 Ch. 276; [1895] A. C. 154), the defendant, a chemist, had placed upon the goods of the plaintiff, Mellin, which he sold, an advertisement of *Vance's Food*, a rival food for infants. The advertisement stated that *Vance's Food* was “far more nutritious and healthful” for infants and invalids “than any yet offered.” The plaintiff complained of this as a trade libel. Romer, J., dismissed the action at the close of his case. The C. A. ordered a new trial, but this order was reversed by the H. L. on the ground that neither the untruth of the statement complained of, nor that it had caused special damage to the plaintiff, had been proved. Both points were essential to the plaintiff's case. Ld. Watson also held that, notwithstanding the manner in which the statement had been affixed to and sold with the plaintiff's goods, it was not, in any legal sense, published of and concerning them. Ld. Herschell said (at p. 164): “I entertain very grave doubts whether any action can be maintained for an alleged disparagement of another's goods merely on the allegation that the goods sold by the party who is alleged to have disparaged his competitor's goods are better either generally or in this or that particular respect than his competitor's are.” His

lordship put aside the question of malice. The other learned lords concurred in this view. See also *Magnolia Metal Co. v. Tandem Smelting Syndicate*, 17 R. P. C. 477 (1900), H. of L.

² *White v. Mellin*, supra, approving *Evans v. Harlow*, 5 Q. B. 624 (1844); *British Empire Type Co. v. Linotype Co.*, 79 L. T. 8 (1898), C. A.; *Royal Baking Powder Co. v. Wright, Crossley & Co.*, 18 R. P. C. 95 (1901), H. of L. The contrary had formerly been held: see cases cited in *White v. Mellin* and *Hayward v. Hayward*, 34 C. D. 198 (1886). So, where the judge at the trial found that there was no actual damage proved, but that damage was highly probable, and granted an injunction, the defendants succeeded on the appeal: *Dunlop Pneumatic Tyre Co., Ltd. v. Maison Talbot*, 20 T. L. R. 579 (1904); the Court also held that there was no malice. But it is not necessary to prove special damage in the technical sense, only that actual damage has resulted, or is reasonably likely to result: *Edison-Bell Consolidated Phonograph Co., Ltd. v. National Phonograph Co., Ltd.*, March 25 and November 28, 1907, unreported, Neville, J., and C. A.

³ *Ratcliffe v. Evans*, [1892] 2 Q. B. 524, C. A. Cf. *Leatham v. Rank*, 57 S. J. 111, Dec. 7, 1912, C. A., where, following the judgment of Bowen, L.J., in the case last cited, to the effect that general loss of custom cannot be proved when repetition does not flow directly

If the injury is proved trifling and no threat to repeat the publication is proved, the action should be dismissed.¹

The interruption of an illegal trade cannot be legal damage.²

And in a case where the only evidence of damage to the plaintiff, by the publication of a libellous circular misstating the result of an action for passing off the plaintiff's goods as those of the defendant, was the plaintiff's own affidavit alleging that his business had fallen off, and the plaintiff had delayed bringing his action for three months after he first knew of the publication, North, J., assessed the damages at £5, but granted an injunction, and gave the plaintiff the costs of the action.³

Statement
may be a
personal libel.

But a disparaging statement with regard to a trader's goods may be an ordinary libel upon the trader personally and, accordingly, be actionable without proof of special damage. Such, for instance, would be the case if the goods were described as worthless⁴ or spurious.⁵ To write of a trader that he sells such goods is clearly defamatory.

Libel on
inventor.

In an action brought for falsely and maliciously publishing passages in a book depriving the plaintiff of the credit of being the first inventor of a machine, the statement of claim was struck out on the ground that the passages complained of were not libellous, and that no reasonable cause of action was shown. But Vaughan Williams, L.J., said that he must not be supposed in any way to be affirming such a proposition as that you cannot

and naturally from the circumstances under which the slander itself was uttered, it was held that evidence of general loss of business was not sufficient. Evidence by a plaintiff that he thought the effect of a circular complained of as suggesting that he had retired from business would be that his customers would not come, and that he had done less business with former customers, was held not to be sufficiently specific, and the action was dismissed, but without costs: *Concaris v. Duncan*, [1909] W. N. 51, Eve, J.

¹ *Dicks v. Brooks*, 15 C. D. 22 (1879), C. A. There the defendants, who owned the copyright in an engraving of Millais' "Huguenots," had threatened proceedings against persons who bought copies of the plaintiff's paper containing a wool-work pattern, wrongly alleged to be an infringement of the copyright. Only two or three numbers were shown

to have been returned or not sold in consequence of the threats.

² Per Ld. Robertson, in *Royal Baking Powder Co.'s case*, note (2), p. 625.

³ *Hayward & Co. v. Hayward & Sons*, 34 C. D. 198 (1886).

⁴ *British Empire Type Co. v. Linotype Co.*, 79 L. T. 8 (1898). The defendants published a statement that the plaintiffs' machines had been removed, after a very short time, from several newspaper offices. The plaintiffs got a verdict at the trial, and the C. A. refused a new trial on the ground stated in the text.

⁵ See *The Liebig case*, above, p. 624, n. (5). But an attack on a system worked under a patent does not necessarily involve an imputation upon the person who supplies the parts and licenses the use of the system: *Griffiths v. Benn*, 27 T. L. R. 346, C. A.

libel anyone by denying his title to a reputation which he may have obtained as an inventor or as a man of science.¹

It is essential, in order to entitle the plaintiff to redress in respect of the publication of a threat or warning, that he should make out that the statements complained of are not published in good faith. He must show that the defendant was not saying what he did in defence of his own right, or, as he believed, in defence of his own right—for the defendant might make a mistake.² Upon an application, therefore, for an interim injunction to restrain the publication of threats by the defendant, it is not sufficient proof, if it is any evidence at all, of want of good faith, to show that he has commenced an action for infringement of trade mark, or for passing off goods against the plaintiff, but has neglected to apply in it for an interlocutory injunction;³ nor to show even a long delay in bringing an action for infringement, if the delay is reasonably explained.⁴

A threat or warning may be made, if *bona fide*.

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

Misleading report of a trade mark action.

"By the judgment the defendant was ordered to undertake not to represent that his firm is, or that the plaintiff's firm is not, the original firm of Richard Hayward & Co.," and added that the plaintiffs, "finding that serious misrepresentations were in circulation to their prejudice, felt themselves compelled

¹ *Wilde v. Thompson*, 20 R. P. C. 361, 775 (1903), Buckley, J., and C. A.

² Per Lindley, M.R., in *Royal Baking Powder Co. v. Wright, Crossley & Co.*, 16 R. P. C. 217 (1899), C. A. In the House of Lords the decision was unanimously affirmed, the majority of the learned lords holding that special

damage was not proved, 18 R. P. C. 95.

³ *Anderson v. Liebig's Extract of Meat Co.*, 45 L. T. N. S. 757 (1881), Chitty, J.

⁴ *Incandescent Gas Light Co. v. Sunlight Incandescent Co.*, 14 R. P. C. 180 (1897), Stirling, J.

to bring the above action." In a subsequent action,¹ brought by the former defendants against the former plaintiffs, the circular was held to be untrue and libellous, and to have been published maliciously, and an injunction was granted to restrain its further publication.

True statements are not libellous.

So far as the case against an advertisement or other publication rests upon its being a libel, proof that the statements complained of in it are, in fact, true, is an answer to any action for damages, or an injunction in respect of its publication.² It makes no difference that ignorant readers might misunderstand it.³

Accordingly, an action for publishing a statement that certain persons, meaning the plaintiff company, had wrongfully used the word *Singer* to designate machines not manufactured by the *Singer* company, which came on for trial after the *Singer* company had established, in a passing-off action against the plaintiff company, that the use of the word by the latter was actually wrongful, was dismissed with costs.⁴

Evidence to construe the libel.

The meaning of the statements complained of is determined by the Court itself, and unless circumstances are proved tending to show that their actual meaning, in the particular case, is different from the natural meaning, evidence cannot be adduced to prove that they were not understood according to it.⁵

Solicitor.

A solicitor who has made the publication merely as agent for the real defendants should not be joined as a defendant.⁶ So the publication of an apology actually made by the plaintiffs to the defendants is justifiable, though it may have been extracted from the plaintiffs under duress of civil or criminal proceedings in respect of the false marking of their goods.⁷

Publication of an apology.

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

But the publication of a statement which turns out to be true may be improper pending legal proceedings in which the matters it refers to are in issue, not as being libellous, but as contempt of Court, if it tends to interfere with a fair trial of the action, or to embarrass one of the parties in the preparation or conduct of his case. And such contempt may be punished by imprisonment,⁸

¹ *Hayward & Co. v. Hayward & Sons*, 34 C. D. 198 (1886), North, J.; *Liebig's & Co. v. Anderson*, 55 L. T. 206 (1887), Chitty, J.

² *Nähmaschinen Fabrik, &c. v. Singer Manufacturing Co.*, 10 R. P. C. 310 (1893), Romer, J.; and the *Baking Powder* case, p. 627, note (2).

³ See note (4), p. 627.

⁴ Note (2), above.

⁵ Note (4), above, p. 626.

⁶ Note (4), above, p. 627.

⁷ *Fisher v. Apollinaris Co.*, L. R. 10 Ch. 297 (1875), L.JJ.

⁸ *Roach v. Hall*, 2 Atk. 469 (1742), Hardwicke, L.C. The respondents were imprisoned for publishing statements calling some of the witnesses "affidavit

fine, or sequestration of goods, or the publication may be restrained by injunction, upon a summary application by motion in the action.¹ The reluctance of the Court to interfere by interlocutory injunction to restrain the further publication of an alleged libel which the defendant justifies, does not extend to such cases as these. As already stated, the parties are at liberty to warn the trade as much as they like, notwithstanding the pendency of the action; but they are bound to refrain during its pendency from public discussion on the merits or demerits of the case.² "You can warn as much as you like," Kay, J., said, in *Goulard v. Lindsay*, "but can you advertise: 'I have brought an action against A. B. which is certain to succeed'?"³ And the learned judge added that to advertise a positive statement that the defendants had infringed the plaintiff's patent was wrong.

Moreover, a misrepresentation by one party to the prejudice of other parties of the result of proceedings is a contempt of Court, whether the actions or proceedings have come to an end or not. Where a motion for an interlocutory injunction had been refused on the ground of the plaintiff's delay, and the defendants thereupon put up a notice in their shop window which would in the opinion of the Court have led an ordinary customer to the conclusion that the defendants had been held to be entitled to do what was complained of, it was held that there had been an attempt to represent to the prejudice of the plaintiffs what had taken place in Court, and that therefore a contempt of Court had been committed.⁴

It is no answer to an application for an injunction in respect of a publication alleged to be a contempt of Court, to say that it was made in reply to a statement published by the applicant

Statement in reply to one published by the other side.

men." *Kitcat v. Sharp*, 31 W. R. 227 (1883), Fry, J. (defendant restrained from publishing the statement of claim and correspondence).

¹ *Coats v. Chadwick*, [1894] 1 Ch. 347, Chitty, J. The plaintiffs, in an action for passing-off, were restrained from publishing a circular charging the defendants with fraudulent imitation of their goods. In some subsequent cases the Court has expressed the opinion that the actual decision went too far, *R. v. Payne*, [1896] 1 Q. B. 577, Ld. Russell and Wright, J.; *In re New Gold Coast Exploration Co.*, [1901] 1

Ch. 860, Cozens-Hardy, J. See also *Goulard v. Lindsay*, 4 R. P. C. 189 (1887), Kay, J. (a patent case).

² Per Chitty, J., [1894] 1 Ch. 350.

³ 4 R. P. C. 189 (1887). But see *British Vacuum Cleaner Co., Ltd. v. Suction Cleaners, Ltd.*, 21 R. P. C. 300 (1904), Swinfen Eady, J.; *Haskell Golf Ball Co. v. Hutchison*, 21 R. P. C. 497 (1904), Buckley, J. These were all patent cases.

⁴ *Gillette Safety Razor Co. v. A. W. Gamage, Ltd.*, 24 R. P. C. 1 (1907), Warrington, J.

himself with reference to the same matter, although this circumstance may influence the Court in dealing with the costs of the application.¹

But every publication bearing upon the matters in question *pendente lite* is not a contempt. A fair and accurate report of interlocutory proceedings, for instance, is allowable.² And the Court may refuse to restrain a report which it thinks unfair or discreditable to the persons responsible for it, if not convinced that the report is calculated to obstruct the course of justice, or to prejudice the public mind.³

Undertaking
as to
damages.

Where the publication of a statement *pendente lite* is restrained as being a contempt of Court, the applicant is not required to give an undertaking to be answerable in damages to the respondent for any loss occasioned by the injunction if it turns out that the respondent was in the right,⁴ as is usual upon the grant of an interlocutory injunction, for the publication is wrong in any event, whether the statements are found in the end to be false or to be well-founded.

Contempts
by newspaper
editors.

The rule under which the publication of biassed comments reflecting on matters in issue in pending litigation and calculated to interfere with the fair trial of the action, is restrained, is of general application, and it is not confined to publications made by, or at the instance of, interested parties. Applications under it to commit the editors of newspapers were very frequent a few years ago, and, in spite of the constantly expressed reluctance of the judges to interfere where it is not necessary to protect the fair prosecution of the action,⁵ the applications generally

¹ *Coleman v. West Hartlepool Ry. Co.*, 8 W. R. 743 (1860), Wood, V.-C.

² A newspaper report published contemporaneously, if otherwise libellous, would be privileged under the Law of Libel Amendment Act, 1888.

³ *Brook v. Evans*, 29 L. J. Ch. 616 (1860), Stuart, V.C., and L.J.J. The plaintiffs advertised that they had established that they first used the word *Glacé*, but that the defendants relied on the lapse of time as an answer to the motion, although the plaintiffs had constantly protested against the defendants' use of the word. The defendants, in fact, had not been called upon on the motion.

⁴ *Fenner v. Wilson*, [1893] 2 Ch. 656,

Kekewich, J.

⁵ In *Re Clements*, 46 L. J. Ch. 383 (1877), Jessel, M.R., said: "I say that a judge should be most careful to see that the cause cannot be fairly prosecuted to a hearing unless this extreme mode of dealing with persons brought before him on accusations of contempt should be adopted." And see *R. v. Payne*, [1896] 1 Q. B. 577, Ld. Russell and Wright, J. In *The Plating Co. v. Farquharson*, 17 C. D. 49 (1881), the C. A. dismissed an application to commit the editor of a paper in respect of an advertisement asking for subscriptions and evidence to assist the appeal in a patent case. In *Re Martindale*, [1894] 8 Ch. 193, North, J., refused with

result in the costs incurred, or part of them,¹ and sometimes a substantial fine,² being thrown upon the respondents if they have ventured at all beyond a mere accurate report, or a colourless account of the proceeding.

Before the Judicature Act the Courts had no jurisdiction to restrain the publication of a libel, even though it affected the plaintiff's trade or property;³ but the jurisdiction is conferred by that Act upon all the divisions of the High Court, and it has been exercised in many cases.⁴

Injunction to restrain trade libels.

The Court also has jurisdiction to interfere by interlocutory injunction to restrain the further publication of an alleged trade libel, which is the subject of an action, until the hearing.⁵ But it will only do so if it is satisfied, upon the facts and evidence before it, that the statements complained of are false,⁶ however much the balance of convenience may be in favour of staying the publication,⁷ and only in the clearest cases⁸—where, as it has been put, the plaintiff's case is so strong that if the jury at the trial found for the defendant, their verdict would be set aside as unreasonable.⁹

Interlocutory injunction.

For the question, libel or no libel, is peculiarly a question for a jury; and in order to interfere before the hearing the Court must determine that question in advance, without the jury's assistance.⁹ The reluctance to interfere by interlocutory injunction is so strong, that the cases cited of *Bonnard v. Perryman*,¹⁰

costs motions to commit the editors of several papers who had innocently copied from another paper.

¹ See *Duncan v. Sparling*, *The Times*, 9th March, 1894.

² *Re The Crown Bank*, 44 C. D. 649 (1890) (a bad case of contempt).

³ *Prudential Assurance Association v. Knott*, L. R. 10 Ch. 142 (1875), Cairns, L.C. and L.JJ.

⁴ *Thorley's Cattle Food Co. v. Massam*, 6 C. D. 582 (1877), Malins, V.-C.; 14 C. D. 763 (1880), Malins, V.-C., and C. A.; *Thomas v. Williams*, 14 C. D. 864 (1880), Fry, J.; *Saxby v. Easterbrook*, 3 C. P. D. 339 (1878), Div. Court, and the cases cited below.

⁵ *Lee v. Gibbings*, 67 L. T. 263 (1892), Kekewich, J., and the cases next cited.

⁶ *Collard v. Marshall*, [1892] 1 Ch. 571, Chitty, J. The libel was that the

plaintiffs were "sweaters," and that their work was not properly executed. The defendants said the statements were, in substance, true, but did not suggest that they had any further evidence not before the Court. They were willing to treat the motion as the trial. An interim injunction was granted. *Punch v. Boyd*, 16 L. R. Ir. 476 (1885).

⁷ *Société des Manufactures des Glaces v. Tilghman's Patent Sand Blast Co.*, 25 C. D. 1 (1883), C. A.

⁸ *Monson v. Tussaud*, [1894] 1 Q. B. 671, C. A., per Davey, L. J. (case of a personal libel).

⁹ Per Ld. Esher, M.R., in *Coulson v. Coulson*, 3 Times L. R. 846, adopted in *Bonnard v. Perryman*, [1891] 2 Ch. 269, C. A.; *Lee v. Gibbings*, supra.

¹⁰ See note (9).

and *Monson v. Tussaud*,¹ seem to show that, where the defendant alleges justification and reserves the particulars of his case and the evidence in support of it, the injunction ought never to be granted. In any case, the probability of very serious injury to the plaintiff if the libellous statements are allowed to continue must be made out.²

Action
survives to
executors.

An action in respect of a trade mark for slander of title, unlike a mere personal libel, survives to the executors since it occasions an injury to the estate of the testator.³

¹ Note 8, p. 691. These were not, however, trade libels, but the rule was applied in *Champion & Co. v. The Birmingham Vinegar Brewery Co.*, 10 Times L. R. 163 (1893), Div. Court, which was a trade case.

² *Salomons v. Knight*, [1891] 2 Ch.

294, North, J., and C. A.; *Mogul Steamship Co. v. McGregor, Gow & Co.*, 15 Q. B. D. 476 (1885), Coleridge, L.C.J., and Fry, L.J.

³ *Hatchard v. Mege*, 18 Q. B. D. 771 (1887), Div. Court.

CHAPTER XIX.

TRADE SECRET AND TRADE NAME.

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It has been shown that anyone is entitled to use a name or mark for the goods to which that name or mark is properly applied.¹ Thus, anyone who is in possession of goods made or sold by the owner of a trade mark or trade name, may apply the proper trade name or trade mark to them,² and may, for instance, replace the old labels upon the goods by new ones.³ So, the name of a secret preparation may be used by anyone for goods actually prepared according to the recipe,⁴ for they are the goods

Use of the trade name of a secret preparation.

¹ See Chap. II., p. 34, and Chap. XV., p. 437.

² *Condy v. Taylor*, 56 L. T. 891 (1887), Kekewich, J. But he must not apply a mark denoting a superior quality of goods of the owner of the mark to an inferior quality, see above, p. 438.

³ *Farina v. Silverlock*, 6 De G. M. & G. 214; 26 L. J. Ch. 11 (1856), Cranworth, L.C., cited, p. 37. See also p. 437.

⁴ *Canham v. Jones*, 2 V. & B. 218; 13 R. R. 70 (1813), Plumer, V.-C. (*Velno's Vegetable Syrup*). The case was decided on demurrer, although the bill alleged facts which would now be held sufficient to support a passing-off case like that of *The Yorkshire Relish*, p. 634, note (1). *James v. James*, L. R. 13 Eq. 421 (1872), Romilly, M.R. (*Lieutenant James' Horse Blister*);

Condy v. Mitchell, 37 L. T. N. S. 268, 766 (1877), Bacon, V.C., and C. A. (*Condy's Fluid*); and see the injunction in *Siegert v. Findlater*, 4 C. D. 801 (1878), Fry, J., cited p. 437 (*Angostura Bitters*). In *Benbow v. Low*, 44 L. T. N. S. 875 (1881), Bacon, V.-C., held that an outgoing partner who retained the recipe could use the name of a secret preparation. The question whether the defendant could have used the name in *The Yorkshire Relish* case (next note), if he had discovered the secret, was left open by the H. L. Lord Davey ([1897] A. C. at p. 717; 14 R. P. C. at p. 732) said he saw no reason to differ from the opinion of Fry, J., in *The Angostura Bitters* case, and of Lindley, L.J., in the case in question, that he could have done so. See also *Rey v. Lecouturier*, [1910] A. C. 262;