THE

LAW OF TRADE MARKS

AND THEIR REGISTRATION,

AND MATTERS CONNECTED THEREWITH;

INCLUDING

A CHAPTER ON GOODWILL.

TOGETHER WITH

THE PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883-8,

AND THE TRADE MARKS RULES AND INSTRUCTIONS THEREUNDER;

FORMS AND PRECEDENTS;

THE MERCHANDISE MARKS ACT, 1887,

AND OTHER STATUTORY ENACTMENTS;

THE UNITED STATES STATUTES, 1870-81,

AND THE RULES AND FORMS THEREUNDER;

AND THE TREATY WITH THE UNITED STATES, 1877.

BY

LEWIS BOYD SEBASTIAN, B.C.L., M.A.,

OF LINCOLN'S INN, ESQ., BARRISTER-AT-LAW;

AUTHOR OF "A DIGEST OF CASES OF TRADE MARK, TRADE NAME, TRADE SECRET, GOODWILL," &c.

THIRD EDITION.

LONDON:

STEVENS AND SONS, LIMITED,

119 & 120, CHANCERY LANE,

Law Publishers and Booksellers.

1890.

PRINTED BY

HAZELL, WATSON, AND VINEY, LD.,

LONDON AND AYLESBURY.

TO

The Memory of

THE RIGHT HON. SIR GEORGE JESSEL,

MASTER OF THE ROLLS,

TO WHOM,

BY HIS KIND PERMISSION,

THE

FIRST EDITION OF

This Work

WAS MOST RESPECTFULLY DEDICATED.

PREFACE

TO

THE THIRD EDITION.

DURING the six years which have passed since the second edition of this book was submitted to the profession, many new cases have been decided with respect to the registration and the infringement of trade marks, various amendments have been made in the Act of 1883, and the important Merchandise Marks Act, 1887, has become law. These additions to, and alterations in, the law, together with other new matter, account for the expansion of the book from 500 pages to 650. The cases cited have increased in number by nearly one-half.

The Trade Marks Registration Acts, 1875-7, are reprinted; since, though they are repealed, the validity of trade marks registered under them still depends upon the terms of the Acts in force at the date of registration, and a reference to those Acts is frequently necessary in order to correctly appreciate the bearing of the earlier decisions.

In this edition, as in former editions, a large number of American and colonial decisions are cited, both because of the sale which this book has obtained in the United States and the Colonies, and also because of the increasing extent to which such decisions are cited in this country. "Although," as Cockburn, C.J., said (*a*), "the decisions of the American Courts are, of

(*a*) *Scaramanga* v. *Stamp*, 5 C. P. D. 295—303.

course, not binding on us, yet the sound and enlightened views of American lawyers in the administration and development of the law—a law, except so far as altered by statutory enactment, derived from a common source with our own—entitle their decisions to the utmost respect and confidence on our part." These decisions are, it is admitted, "intrinsically entitled to the highest respect" (*a*), having been delivered by acute and practised judges, after full consideration of English as well as American authorities; and it may reasonably be anticipated that English judges will in similar circumstances arrive at similar conclusions.

The author's thanks are due to various friends at the Bar and at the Patent Office, for useful hints and assistance, in particular to Mr. C. C. HENSLEY, of Lincoln's Inn, and Mr. ARNOLD GLOVER, of the Inner Temple, who have given much valuable help.

The English cases are brought down to the present month. It should be observed that the decision in *In re Dunn*, 41 Ch. D. 439, has been reversed by a majority in the House of Lords (*Eno* v. *Dunn*, June 19th, 1890).

L. B. S.

13, NEW SQUARE, LINCOLN'S INN,
June, 1890.

(*a*) See per Patteson, J., in *Beverley v. Lincoln Gas Light and Coke Co.*, 6 Ad. & Ell. 829-37, and Bacon, V.C., in *Dawson v. Bank of Whitehaven*, 4 Ch. D. 639-48.

TABLE OF CONTENTS.

TABLE OF CASES.

A.

B.

Bla—Bri

Bri—Bur

C.

Cas—Cla PAGE

D.

Del—Dun

F.

Ful—Goo

G.

Goo–Gui

H.

Hit—Hub PAGE

I.

J.

L.

Llo—McC

M.

Mau—Moe

Moe—Mun

P.

Ree—R. v. R

Roc—Roy

S.

Sin—Soc

Soc—Ste

Sti—Tho

T.

TABLE OF DEFENDANTS.

TABLE OF ABBREVIATIONS.

A. J.	Australian Jurist.
Abb. N. C.	Abbott's New Cases (New York).
Abb. Pr.	Abbott's Practice Reports (New York).
Act. Comm.	Acting Commissioner.
Ad. & E.	Adolphus and Ellis.
Alb. L. J.	Albany (New York) Law Journal.
Allen	Allen (Massachusetts).
Am. L. Reg.	American Law Register.
Am. L. Rev.	American Law Review.
Am. L. T.	American Law Times.
Amer. Dec.	American Decisions.
Amer. Rep.	American Reports.
Amer. St. Rep.	American State Reports.
App. Cas.	Appeal Cases.
Asst. Comm.	Assistant Commissioner.
Atk.	Atkins.
B. & Ad.	Barnewall and Adolphus.
B. & Cr.	Barnewall and Cresswell.
Barb. Ch.	Barbour's Chancery Reports (New York).
Barb. S. C. or Barb.	Barbour's Supreme Court Reports (New York).
Barnard.	Barnardiston.
Beav.	Beavan.
Bell	Bell's Crown Cases.
Beng. L. R. App.	Bengal Law Reports, Appendix.
Biss.	Bissell (U. S. Circuit Court).
Bl. C. C.	Blatchford (U. S. Circuit Court).
Bomb.	Bombay.
Bond	Bond (U. S. Circuit Court).
Bos.	Bosworth (New York).
Bos. & P. N. R.	Bosanquet and Puller New Reports.
Brews.	Brewster (Pennsylvania).
Browne	Browne (Massachusetts).
Bush	Bush (Kentucky).
C. A.	Court of Appeal.
C. B.	Common Bench.
C. C. C.	Central Criminal Court.
C. C. C. Sess. Pap.	Central Criminal Court Sessions Papers.

C. C. R.	Court of Crown Cases Reserved.
C. & M.	Carrington and Marshman.
C. &. P.	Carrington and Payne.
C. P.	Common Pleas.
C. P. Div.	Common Pleas Division.
Cab. & Ell.	Cababé and Ellis (Nisi Prius.)
Cal.	California.
Calc.	Calcutta.
Can.	Canada.
Cass. Dig.	Cassell's Canadian Digest.
Ch. D.	Chancery Division.
Chitty Gen. Pr.	Chitty's General Practice.
Cinc.	Cincinnati.
Cinc. L. B.	Cincinnati Legal Bulletin.
Codd. Dig.	Coddington's American Digest of Trade Mark Cases.
Comm.	Commissioner.
Comm. of App.	Commission of Appeals (New York).
Conn.	Connecticut.
Coop.	Cooper.
C. P. Coop.	C. P. Cooper.
Cor.	Coryton (Bengal).
Cox	Cox's Criminal Cases.
R. Cox	R. Cox's American Trade Mark Cases.
Cro.	Croke.
Ct. of App.	Court of Appeal.
Ct. of Cl.	Court of Claims (U. S.).
Ct. of Sess. Cass.	Court of Session Cases (Scotch).
Curtis	Curtis (U. S. Circuit Court).
Cush.	Cushing (Massachusetts).
D. & B.	Dearsley and Bell.
D. & R.	Dowling and Rylands.
Daly	Daly (New York).
Deady	Deady (U. S. Circuit Court).
De G. F. & J.	De Gex, Fisher and Jones.
De G. & J.	De Gex and Jones.
De G. J. & S.	De Gex, Jones and Smith.
De G. M. & G.	De Gex, Macnaghten and Gordon.
De G. & Sm.	De Gex and Smale.
Den.	Denison, Crown Cases
Dig.	Sebastian's Digest of Cases of Trade Mark, &c.
Dill.	Dillon (U. S. Circuit Court).
Dorion	Quebec Q.B. Reports.
Doug.	Douglas.
Dr.	Drewry.
Dr. & Sm.	Drewry and Smale.
Duer	Duer (New York).
E. & B.	Ellis and Blackburn.
East P. C.	East's Pleas of the Crown.
Ell. & Ell.	Ellis and Ellis.
Eq. Rep.	Equity Reports.
Esp. N. P. C.	Espinasse, Nisi Prius Cases.

Ex.	Exchequer.
F. & F.	Foster and Finlason.
Fed. Rep.	Federal Reporter (U. S.).
Foster Cr. Cas.	Foster, Crown Cases.
Ga.	Georgia.
Giff.	Giffard.
Grant, Up. Can. Ch.	Grant, Upper Canada, Chancery.
Green	Green, New Jersey.
H. & M.	Hemming and Miller.
H. & N.	Hurlstone and Norman.
H. & Tw.	Hall and Twells.
H. & W.	Harrison and Wollaston.
H. L.	House of Lords.
H. L. C.	House of Lords Cases.
Hand	Hand (New York).
Hilt.	Hilton (New York).
Hoff.	Hoffman (New York).
Holmes	Holmes (U. S. Circuit Court).
Hopk.	Hopkins (New York).
How. App. Cas.	Howard's Appeal Cases (New York).
How. Pr.	Howard's Practice Cases (New York).
Hughes	Hughes (U. S. Circuit Court).
Hun	Hun (New York).
Hyde	Hyde (Bengal).
Ill.	Illinois.
Ind.	Indiana.
Ind. L. R.	Indian Law Reports.
Iowa	Iowa State Reports.
Ir. Ch.	Irish Chancery.
Ir. Eq.	Irish Equity.
Ir. Jur.	Irish Jurist.
J. & H.	Johnson and Hemming.
J. & S.	Jones and Spencer (New York).
J. P.	Justice of the Peace.
Jac.	Jacob.
Jac. & W.	Jacob and Walker.
Johns.	Johnson.
Journ. of Jurisp.	Journal of Jurisprudence (Scotch).
Jur.	Jurist.
K. & J.	Kay and Johnson.
Keyes	Keyes (New York).
Ky.	Kentucky.
Kyshe	Straits Settlements Reports.
L. C.	Lord Chancellor.
L. JJ.	Lords Justices.
L. J. Bkptcy.	Law Journal, Bankruptcy.
L. J. Ch.	Law Journal, Chancery.
L. J. C. P.	Law Journal, Common Pleas.
L. J. Ex.	Law Journal, Exchequer.
L. J. K. B.	Law Journal, King's Bench.
L. J. M. C.	Law Journal, Magistrate's Cases.
L. J. N. of C.	Law Journal, Notes of Cases.

L. J P. C.	Law Journal, Privy Council.
L. J. Q. B.	Law Journal, Queen's Bench.
L. R. Ch.	Law Reports, Chancery Appeals.
L. R. C. P.	Law Reports, Common Pleas.
L. R. Eq.	Law Reports, Equity.
L. R. Ex.	Law Reports, Exchequer.
L. R. H. L.	Law Reports, House of Lords (English and Irish).
L. R. I. R.	Irish Law Reports.
L. R. P. C.	Law Reports, Privy Council.
L. R. Q. B.	Law Reports, Queen's Bench.
L. T.	Law Times Reports.
L. T. (Journal)	Law Times Notes of Unreported Cases .
L. & C.	Leigh and Cave, Crown Cases.
La. Ann.	Louisiana Annual Reports.
Lans.	Lansing (New York).
Lath.	Lathrop (Massachusetts).
Leach	Leach, Crown Cases.
Leg. Obs.	Legal Observer.
M. M. A.	Merchandise Marks Act, 1887.
M. & Rob.	Moody and Robinson.
Mac. & G.	Macnaghten and Gordon.
McCrary	McCrary (U. S. Circuit Court).
McLean	McLean (U. S. Circuit Court).
Mad.	Madras.
Madd.	Maddock.
Man & G.	Manning and Granger.
Mass.	Massachusetts.
Md.	Maryland.
Me.	Maine.
Mer.	Merivale.
Mich. C. C.	Michigan Circuit Court.
Mich. N. P.	Michigan Nisi Prius.
Minn.	Minnesota.
Mo.	Missouri.
Mo. App.	Missouri Appeals.
Mod.	Modern Reports.
Mont. D. & De G.	Montague, Deacon and De Gex.
Monthly L. R.	Monthly Law Reports.
Moo. P. C.	Moore's Privy Council Cases.
My. & Cr.	Mylne and Craig.
N. Car.	North Carolina.
N. J. (Eq.)	New Jersey (Equity).
N. P.	Nisi Prius.
N. R.	New Reports.
N. S.	New Series.
N. S. W. Rep. (E.).	New South Wales Reports, Equity.
N. Y.	New York.
N. Z.	New Zealand.
N. & M.	Neville and Manning.
N. & P.	Neville and Perry.
Neb.	Nebraska.

O. S.	Old Series.
Ohio St.	Ohio State Reports.
Ont.	Ontario.
Oreg.	Oregon.
P. R.	Patent Office Reports.
Pac. C. L. J.	Pacific Coast Law Journal.
Paige	Paige (New York).
Peake	Peake, Nisi Prius Cases.
Pemb.	Pemberton on Judgments.
Penn. St.	Pennsylvania State Reports.
Penn. L. J.	Pennsylvania Law Journal.
Ph.	Phillips.
Phila.	Philadelphia.
Pick.	Pickering (Massachusetts).
Post	Post (Missouri).
Q. B.	Queen's Bench.
R. I.	Rhode Island.
Robertson	Robertson (New York).
Russ.	Russell.
Ry. Cass.	Railway Cases.
S. & S.	Simons & Stuart.
Sandf. Ch.	Sandford's Chancery Reports (New York).
Sandf. S. C.	Sandford's Supreme Court Reports (New York).
Sawy.	Sawyer (U. S. Circuit Court).
Scot. L. Rep.	Scottish Law Reporter.
Scott, N. R.	Scott's New Reports.
Seton	Seton on Decrees.
Sickels	Sickels (New York).
Sim.	Simons.
E. D. Smith.	E. D. Smith (New York).
Sol. J.	Solicitor's Journal.
St. Dig.	Stephens' Digest of Canadian Cases.
Story	Story (U. S. Circuit Court).
Sup. Ct.	Supreme Court.
Super. Ct.	Superior Court.
Swanst.	Swanston.
T. M. A.	Trade Marks Registration Act.
T. R.	Term Reports.
Thomp. & C.	Thompson and Cook (New York).
Trade Marks	British and Foreign Journal of Commerce, Trade Marks, and International Exhibitions.
Trans. App.	Transcript Appeals (New York).
U. S. C. C., Dt. of —	United States Circuit Court, District of —.
U. S. Pat. Comm. Decis.	Decisions of the U. S. Commissioner of Patents.
U. S. Pat. Gaz.	United States Official Patent Gazette.
U. S. Rep.	United States Supreme Court Reports.
U. S. Sup. Rep.	United States Supreme Court.
V. & B.	Vesey and Beames.
V.-C.	Vice-Chancellor.

V. R. Eq.	Victoria Reports (First Series Equity.
Va.	Virginia.
Ves.	Vesey.
Vict. L. R. Eq.	Victoria Law Reports (New Series) Equity.
Vt.	Vermont.
W. N.	Weekly Notes.
W. R.	Weekly Reporter.
W. Va.	West Virginia.
W. & W. (I. E. & M.)	Wyatt and Webb's Victoria Reports (Insolvency, Ecclesiastical and Matrimonial).
W. W. & A'B. Eq.	Wyatt, Webb and A'Beckett's Victoria Reports (Equity).
W. A'B. & W. Eq.	Webb, A'Beckett and Williams' Victoria Reports (Equity).
Wallace	Wallace (U. S. Supreme Court).
Wall., Jr.	Wallace, Junior (U. S. Circuit Court).
Washb.	Washburn (Vermont).
Webs. P. C.	Webster, Patent Cases.
Wend.	Wendell (New York).
West. L. J.	Western Law Journal.
Wils.	Wilson.
Wils. (Ind.)	Wilson's Indianapolis Reports.
Wisc.	Wisconsin.
Wood. & M.	Woodbury and Minot (U. S. Circuit Court).
Y. & C. Ch.	Younge and Collyer's Chancery Reports.

THE LAW OF TRADE MARKS.

CHAPTER I.

GENERAL INTRODUCTION.

General principle of trade-mark law.

THE general principle upon which the Courts exercise jurisdiction in the case of trade marks is, that "a manufacturer who produces an article of merchandise which he announces as one of public utility, and who places upon it a mark by which it is distinguished from all other articles of a similar kind, with the intention that it may be known to be of his manufacture, becomes the exclusive owner of that which is henceforth called his trade mark. By the law of this country—and the like law prevails in most other civilised countries—he obtains a property in the mark which he so affixes to his goods. The property thus acquired by the manufacturer, like all other property, is under the protection of the law, and for the invasion of the right of the owner of such property the law affords a remedy similar in all respects to that by which the possession and enjoyment of all property is secured to the owners" (*a*). "A man is not to sell his own goods under the pretence that they are the goods of another man; he cannot be permitted to practise such a deception, nor to use the means which contribute to that end. He cannot, therefore, be allowed to use names, marks, letters, or other *indicia* by which he may induce purchasers to believe that the goods which

(*a*) Per Bacon, V.-C., in *Ransome* v. *Graham*, 51 L. J. Ch. 897.

he is selling are the manufacture of another person" (*a*). "Supposing the rival trader to have obtained celebrity in his manufacture, he is entitled to all the advantages of that celebrity, whether resulting from the greater demand for his goods, or from the higher price which the public are willing to give for them, rather than for the goods of other manufacturers whose reputation is not so high. Where, therefore, a manufacturer has been in the habit of stamping the goods which he has manufactured with a particular mark or brand, so that thereby persons purchasing goods of that description know them to be of his manufacture, no other manufacturer has a right to adopt the same stamp. By doing so he would be substantially representing the goods to be of the manufacture of the manufacturer who had previously adopted the stamp or mark in question, and so would or might be depriving him of the profit he might have made by the sale of the goods which, *ex hypothesi*, the purchaser intended to buy. The law considers this to be wrong towards the person whose mark is thus assumed, for which wrong he has a right of action, or, which is the more effectual remedy, a right to restrain by injunction the wrongful use of the mark thus pirated" (*b*).

Function of trade mark.

The function of the trade mark is to give the purchaser a satisfactory assurance of the make and quality of the article he is buying. Thus, it was said by Lord Cottenham, C. (*c*), "take a piece of steel: the mark of the manufacturer from whom it comes is the only indication to the eye of the customer of the quality of the article; so it is of

(*a*) Per Lord Langdale, M. R., in *Perry* v. *Truefitt*, 6 Beav. 66.

(*b*) Per Lord Cranworth, C., in *Seixo* v. *Provezende*, L. R. 1 Ch. 192. And see per the United States Supreme Court in *Canal Co.* v. *Clark*, 13 Wall. 311; *McLean* v. *Fleming*, 96 U. S. Rep. 245, and *Amoskeag Manufacturing Co.* v. *Trainer*, 101 U. S. Rep. 51; and per Molesworth, J., in the Supreme Court of Victoria in *In re Brebner*, 2 W. & W. 12; and per Levinge, J., in the High Court of Bengal, in *Orr-Ewing & Co.* v. *Grant, Smith & Co.*, 2 Hyde 185.

(*c*) In *Spottiswoode* v. *Clarke*, 2 Ph. 154; and see *Sohl* v. *Geisendorf*, 1 Wils. (Ind.) 60; *Kidd* v. *Johnson*, 100 U. S. Rep. 617.

blacking, or any other article of manufacture the particular quality of which is not discernible by the eye." It is on the faith of the mark being genuine, and representing a quality equal to that which he has previously found a similar mark to indicate, that the purchaser makes his purchase. "That, in truth," said James, L. J. (*a*), "is the meaning and object of a trade mark. It indicates this—that you may take this as a warranty that it has come from the particular manufacturer of the goods with which you have been hitherto pleased." So again, it was said by Kay, J. (*b*) —"What does a trade mark mean? It means the mark under which a particular individual trades, and which indicates the goods to be his goods—either goods manufactured by him, or goods selected by him, or goods which in some way or other pass through his hands in the course of trade. That is the meaning of a trade mark. It is a mode of designating goods as being the goods which have been, in some way or other, dealt with by the person who owns the trade mark."

Mere statement of quality, no trade mark.

Yet, while the object of the trade mark is to indicate quality, a mere English adjective, or word in common use (*c*), which indicates quality and nothing more, not serving to connect the goods with any particular manufacturer or seller, cannot be appropriated as a trade mark; for no person can be permitted to exclude others from the use of words common to all, even in their application to goods; and without such exclusive appropriation, the mark is a mere statement, offering no guarantee, and making no one responsible for its correctness. And in the same way the use of a mark which has for its object the enabling purchasers

(*a*) *Massam* v. *J. W. Thorley's Cattle Food Co.*, (2) 14 Ch. D. 748; and see *Amoskeag Manufacturing Co.* v. *Trainer*, 101 U. S. Rep. 51; *Liggett and Myers Tobacco Co.* v. *Hynes*, 20 Fed. Rep. 883; *Holt* v. *Menendez*, 128 U. S. Rep. 182.

(*b*) *In re Australian Wine Importers, Ld.*, 41 Ch. D. 278.

(*c*) *Braham* v. *Bustard*, 1 H. & M. 447; *Raggett* v. *Findlater*, L. R. 17 Eq. 29; *In re Barrows*, 5 Ch. D. 353; *Spottiswoode* v. *Clarke*, 1 Coop. 264; *Gillott* v. *Esterbrook*, R. Cox, 353; *Osgood* v. *Allen*, 1 Holmes 185; *In re Eagle Pencil Co.*, 10 U. S. Pat. Gaz. 981.

to divide into equal pieces the substance to which it is applied, cannot deprive other makers of the right to use other somewhat similar marks with the same object (*a*).

Exception.

Marks, however, which do serve to indicate the production of a certain manufacturer, though at the same time subject to variation for the purpose of denoting different qualities, are entitled to protection (*b*). And it may be observed that a symbol or word indicating quality in one class of goods need not necessarily do so in another (*c*).

Trade mark not always indicative of actual manufacturer.

The use of the trade mark is not in all cases to designate the maker of the substance to which it is attached (*d*), though that is usually so; it may indicate some other person who has expended labour on the article, so that, as finished, it owes some portion of its value to him. Thus, in a case in the Supreme Court of New York (*e*) it was held that, where one person manufactured cotton cloths, and another printed them, the mark was indicative of the printer and not of the original manufacturer. So a trade mark has been recognised as indicating the bleacher who finished the goods which another person had manufactured (*f*); and in the same way, one may serve to denote the importer (*g*) or exporter (*h*) of manufactured goods.

(*a*) *Dausman and Drummond Tobacco Co.* v. *Ruffner*, 15 U. S. Pat. Gaz. 559.

(*b*) *Hirst* v. *Denham*, L. R. 14 Eq. 542; *Ransome* v. *Graham*, 51 L. J. Ch. 897; *Moses* v. *Sargood*, Dig. 636; *Sohl* v. *Geisendorf*, 1 Wils. (Ind.) 60; *Godillot* v. *Harris* (per Danforth, J.), 81 N. Y. 263. See *Stokes* v. *Landgraff*, 17 Barb. 608; R. Cox, 137; *Gillott* v. *Kettle*, 3 Duer, 624; R. Cox, 148; *Gillott* v. *Esterbrook*, 47 Barb. 455; R. Cox, 340; 48 N. Y. 374; *Amoskeag Manufacturing Co.* v. *Trainer*, 101 U. S. Rep. 51; *Morry* v. *Hoopes*, 111 N. Y. 415; *Ralli* v. *Fleming*, Ind. L. R. 3 Calc. 417. And see *Wood* v. *Lambert*, 32 Ch. D. 247.

(*c*) *In re English*, U.S. Pat. Comm. Decis. 1870, 142; *In re Dick & Co.*, 9 U. S. Pat. Gaz. 538.

(*d*) See per Bacon, V.-C., in *Ford* v. *Foster*, L. R. 7 Ch. 611.

(*e*) *Amoskeag Manufacturing Co.* v. *Garner*, 55 Barb. 151; R. Cox, 541. See *Amoskeag Manufacturing Co.* v. *Garner* (2), 54 How. Pr. 298, and *Wamsutta Mills* v. *Allen*, 12 Phila. 535.

(*f*) *In re Sykes*, 43 L. T. N. S. 626.

(*g*) *Godillot* v. *Hazard*, 44 N. Y. Super. Ct. 427; *Ralli* v. *Fleming*, Ind. L. R. 3 Calc. 417; *Taylor* v. *Virasami*, Ind. L. R. 6 Mad. 108.

(*h*) *Robinson* v. *Finlay*, 9 Ch. D 487, though it was held on appeal that in that particular instance this was not the case.

May be indicative of selector.

Again, a trade mark may be so composed as to indicate that the goods have been examined and selected by a person of known ability, so that they have attributed to them such value as his approval can give, and his reputation depends upon their corresponding to their alleged quality. In such a case, therefore, the trade mark belongs to the selector and not to the manufacturer (*a*).

May indicate natural products.

To go farther, it is not necessary that the goods to which the mark is affixed should be manufactured goods at all; it is sufficient if the vendors, whose property the trade mark is, have alone the opportunity of procuring the article in question, so that the trade mark indicates accurately the source from which the article is derived. This is particularly the case with mineral waters and similar productions (*b*). A mere name, however, for a natural product which is available by all the world, cannot be exclusively appropriated by an individual, who possesses no exclusive access to its source (*c*).

Advantages of use of trade marks.

The benefits derivable from the recognition of the exclusive right of a trader to his trade mark are apparent from the consideration that the "trade mark is both a sign of the quality of the article and an assurance to the public that it is the genuine product of his manufacture. It thus often becomes of great value to him, and in its exclusive use the Court will protect him against attempts of others

(*a*) *Hirsch* v. *Jonas*, 3 Ch. D. 584; *Re Australian Wine Importers, Ld.*, 41 Ch. D. 278; *Thomson & Co.* v. *Robertson*, Ct. Sess. Cas. 4th Ser. XV. 880; *Yale Cigar Manufacturing Co.* v. *Yale*, 30 U. S. Pat. Gaz. 1183; *Holt* v. *Menendez*, 128 U. S. Rep. 182. And see *Wood* v. *Lambert*, 32 Ch. D. 247.

(*b*) *Apollinaris Co.* v. *Norrish*, 33 L. T. N. S. 242; *Apollinaris Co.* v. *Edwards*, Seton, 4th ed. 237 (Apollinaris Water); *Radde* v. *Norman*, L. R. 14 Eq. 348 (Leopoldshall Kainit); *Congress and Empire Spring Co.* v. *High Rock Congress Spring Co.*, 57 Barb. 526; R. Cox, 599 (Congress Spring Water); *Wheeler* v. *Johnston*, 3 L. R. Ir. 284 (Cromac Springs Water); *Dunbar* v. *Glenn*, 42 Wisc. 118 (Bethesda Mineral Water); and see the coal cases—*Braham* v. *Beachim*, 7 Ch. D. 848; *Davis* v. *Tylor*, M. R., April 24th, 1879; *Lochgelly Co. Ld.* v. *Lumphinnans Iron Co.*, Ct. Sess. Cas., 4th Ser. VI. 482.

(*c*) *Young* v. *Macrae*, 9 Jur. N. S. 322 (Paraffin Oil); *Canal Co.* v. *Clark*, 13 Wall. 311 (Lackawanna Coal); *Montgomerie* v. *Donald & Co.*, Ct. Sess. Cas. 4th Ser. XI. 506 (Water of Ayr Stone).

to pass off their products upon the public as his. This protection is afforded, not only as a matter of justice to him, but to prevent imposition upon the public" (*a*).

The protection of trade marks is, therefore, beneficial to the public, since it enables them to buy with confidence that they are getting what they require; while at the same time it is beneficial to the manufacturer, since it affords him the means of securing the benefit of the custom which he deserves and which is intended for him. When the owner of a trade mark is asserting his exclusive rights, "monopoly is not the thing for which the one party struggles and which the other resists. On the contrary, fair trading is all for the protection of which the law is invoked; and the public, as well as the manufacturer or merchant, are concerned that infringement of trade marks and trade designations should be prevented. For there is a double wrong: the public are or may be deceived, and the trader whose trade mark or trade designation is infringed is or may be injured" (*b*). So advantageous did the adoption of a trade mark speedily prove to be that, in 1742, Lord Hardwicke, C., said that "every particular trader had some particular mark or stamp" (*c*).

Southern v. *How.*

In the earliest case on record (*d*) damages were given for the infringement of a mark on cloth, though it is not clear from the reports whether the plaintiff was a clothmaker whose mark had been pirated, or a purchaser who had been deceived into buying the wrong goods.

Blanchard v. *Hill.*

In *Blanchard* v. *Hill* (*e*), however, in 1742, Lord Hardwicke refused to protect the "Great Mogul" stamp on cards, deciding, in effect, that there was no right of

(*a*) *Per* U. S. Sup. Ct. in *Manhattan Medicine Co.* v. *Wood*, 108 U. S. Rep. 218; and see *Amoskeag Manufacturing Co.* v. *Spear*, 2 Sandf. S. C. 599.

(*b*) Per Lord Craighill in *Dunnachie* v. *Young & Sons*, Ct. Sess. Cas. 4th Ser. X. 874; and see *State of Missouri* v. *Gibbs*, 56 Mo. 133; and *Blackwell* v. *Wright*, 73 N. Car. 310.

(*c*) *Blanchard* v. *Hill*, 2 Atk. 484, 485.

(*d*) *Southern* v. *How*, Poph. 144; 3 Cro. 471; 2 Rolle 28.

(*e*) 2 Atk. 484.

property in a trade mark, though actual fraud might be restrained or punished, as in *Southern* v. *How* (*a*). The decision seems in great measure to have been founded upon a dread of setting up a monopoly, the distinction between a trade mark and a patent not being clearly present to his lordship's mind.

Singleton v. Bolton.

In *Singleton* v. *Bolton* (*b*), in the Court of King's Bench (1783), Lord Mansfield, C. J., said that if the defendant had sold a medicine of his own under the plaintiff's name or mark, that would be a fraud for which an action would lie; but the name of an original inventor being the trade mark in question, evidence was necessary of the medicine having been sold as if prepared by the plaintiff, a distinction being thus drawn between the transmissibility of a name and that of other trade marks, which has since been removed (*c*).

Sykes v. Sykes.

In Scotland an interdict was granted in 1823 to restrain the infringement of a trade mark (*d*), but in England it was for the first time perceived, in 1824, that goods sold with a pirated mark attached, though they might not deceive an immediate purchaser, yet might deceive an ultimate purchaser, who might have no notice of the fraud (*e*).

Requisites to entitle to damages at CommonLaw.

This case marks the last stage of development in the law of trade marks as recognised at Common Law (*f*); and the requisites necessary to entitle a plaintiff to recover damages were, in accordance with the judgment of Sir T. Wilde, C. J., in *Rodgers* v. *Nowill* (*g*), that he should have been accustomed to use a certain mark upon goods of his manufacture to denote that that was so, that that mark

(*a*) Poph. 144.

(*b*) 3 Doug. 293.

(*c*) See *Leather Cloth Co.* v. *American Leather Cloth Co.*, 1 H. & M. 271; 4 De G. J. & S. 137; 11 H. L. C. 523, and other cases.

(*d*) *Wilkie* v. *McCulloch*, Ct. Sess. Cas., 1st Ser. II. 413.

(*e*) *Sykes* v. *Sykes*, 3 B. & Cr. 541.

(*f*) See per Sir G. Mellish, L. J., in *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434—454.

(*g*) 5 C. B. 109.

was known in the trade (*a*), and that the defendant had imitated the mark and sold goods bearing it, as and for the plaintiff's goods, with intent to defraud (*b*).

Lord Blackburn in *Singer Manufacturing Co.* v. *Loog*.

Lord Blackburn, discussing the history of trade-mark law in *Singer Manufacturing Co.* v. *Loog* (*c*), said: "The original foundation of the whole law is this—that when one, knowing that goods are not made by a particular trader, sells them as and for the goods of that trader, he does that which injures that trader. At first it was put upon the ground that he did so when he sold inferior goods as and for the trader's; but it is established, alike at law and in equity, that it is an actionable injury to pass off goods known not to be the plaintiff's as and for the plaintiff's, even though not inferior. The modes in which goods may be passed off as and for the plaintiff's vary. The most usual is where a particular mark on the goods, or on the packages in which they are sold, has been used to denote that they are made by a particular firm to such an extent that it is understood in the market to bear that meaning. The law as to those trade marks is now regulated by statutes, but before there was any legislation on the subject it was well settled that when any one adopted a mark so closely resembling the trade mark of the plaintiff that it would be likely to be mistaken for it, and put it on his goods and sold them, knowing that though the persons to whom he sold them were well aware that they were not the plaintiff's make, yet that they were meant to be sold to others who would see only the trade mark, and were likely to be deceived by its resemblance to that of the plaintiff, he might be properly found to have knowingly and fraudulently sold the goods

(*a*) Application for registration, provided the connection with the goodwill of the business is observed, is now equivalent to public use of a mark: Patents Act, 1883, § 75, as amended by the Act of 1888; and see Trade Marks Act, 1875, § 2. This was held to be so also in America under the U. S. Statute of 1870: *In re The Dutcher Temple Co.*, U. S. Pat. Comm. Decis. 1871, 248. And see § 7 of the U. S. Act of 1881.

(*b*) See, however, the Judicature Act of 1873, § 25, by which the rules of equity prevail.

(*c*) 8 App Cas. 29.

as and for the plaintiff's goods. And, so far, there was no difference between law and equity.

"But at law it was necessary to prove that an injury had been actually done; in equity it was enough to show that the defendant threatened to do, and would, if not prevented, do that injury. But there is a further question on which there may be a difference between law and equity." The difference to which allusion is here made arises from the fact that in equity the protection to the manufacturer and the public was carried a stage farther in 1833 by the decision of Lord Cottenham, C., in *Millington* v. *Fox* (*a*), since which time it has not been necessary to prove an actual fraudulent intention, the remedy being obtainable if the defendant's conduct has been such as to produce the effects of fraud, though he may, in fact, have acted in perfect innocence.

Equity—*Millington* v. *Fox*.

It is, however, "no part of the duty of the Court to enforce the observance of the dictates of morality" (*b*), and therefore, if a defendant "has an abstract right to do what he has done, the Court must permit it, however opposed to one's moral sense" (*c*). The Court will not interfere, simply on the ground that there is a misrepresentation, unless some right belonging to the plaintiff has been interfered with (*d*).

Limits to Court's interposition.

The mode of acquiring a right to a trade mark was, from 1875 to 1883, regulated by the Trade Marks Registration Acts, 1875-7 (*e*). The trade mark was required to accord with the definition contained in section 10 of the Act of

Acquisition of trade marks.

(*a*) 3 My. & Cr. 338. In *Gout* v. *Aleploglu*, 5 Leg. Obs. 496, the Vice-Chancellor of England held that "the plaintiff had acquired by long previous usage *the exclusive right*" to his trade marks, but the report is too brief to show whether that expression was employed in its full meaning. *Lugg* v. *Kirby*, 8 Ves. 215 (1803); and *Day* v. *Binning*, C. P. Cooper, 489, and 1 Leg. Obs. 205 (1831), were cases of fraudulent competition; and in *Henry* v. *Price*, 1 Leg. Obs. 364 (1831), there were circumstances of fraud.

(*b*) Per Wood, V.-C., in *Batty* v. *Hill*, 1 H. & M. 264. And see *Roper's, &c., Co.* v. *Copeman's, &c., Association, Limited*, 28 Sol. J. 218; *Schneider* v. *Williams*, 44 N. J. (Eq.) 391.

(*c*) *Braham* v. *Bustard*, 1 H. & M. 447.

(*d*) See *Batty* v. *Hill*, *ubi suprà*.

(*e*) 38 & 39 Vict. c. 91; 39 & 40 Vict. c. 33; 40 & 41 Vict. c. 37.

1875 (*a*), and not to be obnoxious to the restrictions of section 6; and it had to be registered, or, if it had been used before the passing of the Act, application must have been made for registration, and have been refused, in which case a certificate of refusal could be obtained from the registrar (*b*), unsuccessful applicants thus retaining whatever rights might have been theirs before the Act. For a mark to have been used before the Act, it was sufficient for a vendible article to have been actually in the market, bearing the mark in question; it was not necessary for this to have been the case for any length of time, so long as there was some user (*c*).

The Trade Marks Acts, 1875-7, are now repealed, and replaced by the Patents Acts, 1883-8 (*d*), which contain a wider and more comprehensive definition of a trade mark (*e*), but are in other respects substantially identical, so far as concerns the acquisition of trade marks, with the repealed Acts (*f*).

Appropriation to special classes of goods.

A trade mark must, under the present Acts, as under the repealed Acts, be registered as belonging to particular goods or classes of goods (*g*), according to the classification of goods contained in the Rules; and trade marks used before the Act of 1875 can only be protected in respect of the same classes of goods as those to which they have been habitually applied, for no man could be so deceived as to suppose that he was buying A's linen because he saw the same mark as A's on B's iron (*h*).

(*a*) Which was so restricted as to exclude from registration some marks previously recognised: *Ex parte Stephens*, 3 Ch. D. 659; *In re Mitchell* (1), 7 Ch. D. 36. See *Rose* v. *Evans*, 48 L. J. Ch. 618.

(*b*) § 2 of Amendment Act, 1876.

(*c*) Per Lord Westbury, C., in *McAndrew* v. *Bassett*, 4 De G. J. & S. 380; *Wheeler* v. *Johnston*, 3 L. R. Ir. 284; *In re Simpson, Davies & Sons*, M. R., Jan. 12, 1881; *Somerville* v. *Schembri*, 12 App. Cas, 453; and other cases.

(*d*) 46 & 47 Vict. c. 57; 48 & 49 Vict. c. 63; 51 & 52 Vict. c. 50.

(*e*) See § 64 of the Act of 1883 as amended by § 10 of the Act of 1888.

(*f*) See §§ 62—74.

(*g*) Trade Marks Act, 1875, § 2; Patents Act, 1883, § 65.

(*h*) *Hall* v. *Barrows*, 4 De G. J. & S. 150; *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518; *Merchant Banking Co.* v. *Merchants' Bank*, 9 Ch. D. 560; *Société Anonyme* v. *Baxter*, 14 Bl. C. C. 261; *Colman* v. *Crump*, 70 N. Y. 573; *Hart* v. *Colley*, 44 Ch. D. 193.

A trade mark is assignable and transmissible, but only in connection with the goodwill of the business concerned with the goods or classes of goods to which it relates (*a*). A trade mark cannot exist in gross and unattached to specific articles (*b*), for, if that could be so, the mark might come to be an instrument of deception, instead of a guarantee of genuineness (*c*). In an assignment of the business and goodwill, the trade mark passes as a matter of course (*d*), or, if specially excepted, must cease to be available by the vendor. On the death of a registered proprietor, his legal personal representative acquires the title to the mark. Subsequent registered proprietors stood in the same position, under § 4 of the Trade Marks Act of 1875, as if their title were a continuation of the title of the first registered proprietor (*e*). And this will still be so, though the section has not been re-enacted in the new Acts.

Assignment and transmission.

It has been held in bankruptcy that a trade mark passes to a trustee in bankruptcy, as being "goods and chattels" within § 15, subs. 5, of the Bankruptcy Act, 1869 (*f*).

Bankruptcy.

Apart from the special provisions of the Patents Act, 1883, a trade mark may be lost, as by its coming to be

Trade mark lost.

(*a*) Patents Act, 1883, § 70, and see Trade Marks Act, 1875, § 2; *Hall* v. *Barrows*, 4 De G. J. & S. 150; *Dixon Crucible Co.* v. *Guggenheim*, 2 Brews., 321; R. Cox, 159; *In re Wellcome*, 32 Ch. D. 213; *Smith* v. *Fair*, 14 Ont. Rep. 729; *McVeagh* v. *Valencia Cigar Factory*, 32 U. S. Pat. Gaz. 1124.

(*b*) *McAndrew* v. *Bassett*, 4 De G. J. & S. 380; *Leather Cloth Co.* v. *American Leather Cloth Co.*, *ib.* 137; 11 H. L. C. 523; *Dixon* v. *Guggenheim*, *ubi suprà*; *Wheeler* v. *Johnston*, 3 L. R. Ir. 284; *Kidd* v. *Johnson*, 100 U. S. Rep. 617; *Weston* v. *Ketcham*, (1) 39 N. Y. Super. Ct. 51; *S. C.* (2) 51 How. Pr. 455.

(*c*) *Cotton* v. *Gillard*, 44 L. J. Ch. 90; see *Witthaus* v. *Braun*, 44 Md. 303.

(*d*) *Shipwright* v. *Clements*, 19 W. R. 599.

(*e*) And see *Walton* v. *Crowley*, 3 Bl. C. C. 440; R. Cox, 166.

(*f*) *Ex parte Young*; *Re Lemon Hart & Son*, Dig. 537; and see *Kelly* v. *Hutton*, L. R. 3 Ch. 703; *Hudson* v. *Osborne*, 39 L. J. Ch. 79; and cases at p. 115, note (*a*); also the Bankruptcy Act, 1883, § 44 (iii). In America it has been considered a disputable question whether property in a trade mark is the subject of attachment or levy under execution (*Hegeman & Co.* v. *Hegeman*, 8 Daly 6), or whether it will pass under a general assignment (*Milliken* v. *Dart*, 33 N. Y. Sup. Ct. 24).

commonly applied to a special article, in which case it becomes *publici juris*; thus "Worcestershire sauce," which might at one time have been protected, could no longer be so when it had come into common use (*a*). But for general user to render a mark of common right, it must be user on the same goods as those for which an exclusive right to it is claimed (*b*). It was also held, before the passing of the Registration Acts, that if a person abandons a suit which he has undertaken to restrain infringement, he abandons his exclusive right (*c*).

Infringement.

When once a person has acquired a right in the trade mark, any infringement of that right will form a ground for the interference of the Court. For the Court to interfere there must be fraud, for where there is no fraud there is no wrong to be redressed and no remedy applicable. But it is not necessary that there should be fraud in the sense that the infringer knowingly and wilfully makes a fraudulent attempt to appropriate to himself the fruits of another's reputation: if he acts so that custom intended for another is diverted to himself, and that the public buy and pay for one thing while intending to buy and pay for another, so that both vendor and purchaser are injured, there is fraud, and the animus of the infringer is unimportant (*d*). Even if the purchaser is told that the goods are the goods of the actual seller, but the imitated mark is upon them, there is ground for interference, since the goods may be resold bearing the mark, but without the information necessary to correct the statement thereby made (*e*). There is infringement if ordinary purchasers

(*a*) *Lea* v. *Millar*, Dig. 513. And so 'Kaiser' spring water—*Luties* v. *Hollender*, (2) 24 Bl. C. C. 353; "Gold Leaf" Tobacco—*Partlo* v. *Todd*, 12 Ont. Rep. 171; "Imperial Cough Drops"—*Watson* v. *Westlake*, 12 Ont. Rep. 449; and see per Sir G. Mellish, L. J., in *Ford* v. *Foster*, L. R. 7 Ch. 611. Also *Neva Stearine Co.* v. *Mowling*, 9 Vict. L. R. Eq. 98; *Portuondo* v. *Monne*, 28 Fed. Rep. 16; *Lawrence Manufacturing Co.* v. *Tennessee Manufacturing Co.*, 31 Fed. Rep. 776.

(*b*) *Somerville* v. *Schembri*, 12 App. Cas. 453.

(*c*) *Browne* v. *Freeman*, 12 W. R. 305.

(*d*) See cases collected at p. 183, note (*c*).

(*e*) *Sykes* v. *Sykes*, 3 B. & Cr. 541; and cases at pp. 175, 176.

purchasing with ordinary caution, are likely to be misled (*a*): on the one hand, the Court will not strain its jurisdiction to protect fools and idiots (*b*); on the other hand, it will not require such minuteness of imitation as to deceive persons of unusual sagacity and information.

Remedies for infringement.

Infringement is criminally punishable under an indictment for obtaining money by false pretences (*c*), or in accordance with the special provisions of the Merchandise Marks Act, 1887 (*d*), expressly enacted to prevent such practices. The Common Law remedy is by an action on the case for damages caused by the offender's fraud (*e*). The equitable remedy is by injunction, together with an account, or damages, if preferred. The greater suitability of this form of remedy has occasioned the adjudication in Chancery of the great majority of trade-mark cases, and the carrying into operation of the Trade Marks Registration Acts was specially entrusted to the Chancery Division (*f*).

Fraudulent intention.

At Common Law, at all events until the Judicature Acts, it was necessary to prove knowledge of the plaintiff's rights and intentional deception on the part of the defendant (*g*); to obtain an injunction in Chancery this has not been required since *Millington* v. *Fox* (*h*), in 1833. It may, however, be material with reference to the extent of the relief to be granted, since a plaintiff is only entitled to an account in respect of such user of his trade mark by the defendant as has been subsequent to the latter becoming aware of the prior ownership, or at least of the prior existence as a trade mark of the mark used by him (*i*).

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

(*b*) *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434-47; *Blackwell* v. *Wright*, 73 N. Car. 310.

(*c*) See Ch. 5.

(*d*) 50 & 51 Vict. c. 28.

(*e*) An injunction may now form part of the relief.

(*f*) Trade-marks Rule 42 of 1876.

(*g*) *Rodgers* v. *Nowill*, 5 C. B. 109.

(*h*) 3 My. & Cr. 338.

(*i*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; *Cartier* v. *Carlile*, 31 Beav. 292; *Moet* v. *Couston*, 33 Beav. 578.

Plaintiff disentitled to relief.

A plaintiff who in other respects would be entitled to obtain a remedy against an infringer may yet be deprived of his right by reason of some fraudulent statement contained in his own trade mark (*a*), for "*ex turpi causâ non oritur actio*, and if the trade mark contains a false representation calculated to deceive the public, a man cannot by using that which is in itself a fraud obtain any right at all in the mark" (*b*).

When not disentitled.

A mere collateral misrepresentation, not contained in the trade mark itself, and therefore not repeated at every transfer of the article, is not sufficient to disentitle the trade mark to protection (*c*).

Unauthorised use of word "patent," &c.

A particular form of misstatement which has proved fatal in several cases has been the insertion or retention in a trade mark of the words "patent" or "patented," so as to indicate the protection of an existing patent, to which the article bearing the trade mark is not in fact entitled (*d*).

Distinction between trade mark and patent.

"Trade marks have sometimes been likened to letters patent and sometimes to copyrights, from both of which they differ in many respects" (*e*). "There is this difference between the case of a trade mark and that of a patent: in the former case the article sold is open to the whole world to manufacture, and the only right the plaintiff seeks is that of being able to say—'Don't sell any goods under my mark.' He may find his customers fall off in consequence of the defendant's manufacture; but it does not necessarily follow that the plaintiff can claim damages for every article manufactured by the defendant, even though it be under that mark. On the other hand, every sale without licence of a patented article must be a damage to the patentee" (*f*). In the case of a trade mark, "the property and right to protection is in the device or symbol which is invented and

(*a*) See *Pidding* v. *How*, 8 Sim. 477; *Perry* v. *Truefitt*, 6 Beav. 66; and other cases in Ch. 7.

(*b*) Per Sir G. Mellish, L. J., in *Ford* v. *Foster*, L. R. 7 Ch. 611.

(*c*) *Ford* v. *Foster*, *ubi suprà*.

(*d*) See the cases in Ch. 7.

(*e*) Per Lord Blackburn, in *Johnston* v. *Orr-Ewing*, 7 App. Cas. 219—228.

(*f*) Per Wood, V.-C., in *Davenport* v. *Rylands*, L. R. 1 Eq. 302.

adopted to designate the goods to be sold, and not in the article which is manufactured and sold" (*a*). The broad difference between a patent and a trade mark is, therefore, that the public are prohibited and restrained from manufacturing any article protected by the former, so long as the protection exists, whereas the public are at full liberty to manufacture an unpatented article (*b*), and that according to the identical original process, and to say that they are so doing, and this is so whether the original makers use, or do not use, a trade mark upon their goods. What the subsequent manufacturers may not do is to put upon their goods the mark used by the original makers, so as to represent that such goods are the actual goods of the original makers, and not merely equivalent goods made by others. The benefit conferred upon the public by the communication of a new invention, which after a limited period all can use, is the consideration in respect of which a monopoly of the invention is granted to the inventor for that limited period (*c*). Any attempt, therefore, to prolong the term of the patent by means of a trade mark will be discouraged (*d*).

Trade mark distinguished from copyright.

As a trade mark is not the same thing as a patent, so it is not the same as a copyright (*e*). The difference between

(*a*) Per Monell, C. J., in *Godillot* v. *Hazard*, 49 How. Pr. 5; and see *McLean* v. *Fleming*, 96 U. S. Rep. 245; and *Swift* v. *Peters*, 11 U. S. Pat. Gaz. 1110.

(*b*) This is quite clear in America as well as in this country. See *Thomson* v. *Winchester*, 19 Pick. 214; R. Cox, 7; *Coffeen* v. *Brunton*, 4 McLean, 516; R. Cox, 82; *Davis* v. *Kendall*, 2 R. I. 566; R. Cox, 112; *Comstock* v. *White*, 18 How. Pr. 421; R. Cox, 232; *Phalon* v. *Wright*, 5 Phila. 464; R. Cox, 307; *Falkinburg* v. *Lucy*, 35 Cal. 52; R. Cox, 448; *Cook* v. *Starkweather*, 13 Abb. Pr. N. S. 392; *Godillot* v. *Hazard*, 44 N. Y. Super. Ct. 427; *Hardy* v. *Cutter*, 3 U. S. Pat. Gaz. 468; *Frese* v. *Bachof* (2), 14 Bl. C. C. 432; *Manhattan Medicine Co.* v. *Wood*, 4 Cliff. 461. So also in Scotland, *Singer Manufacturing Co.* v. *Kimball and Morton*, Ct. Sess. Cas., 3rd Ser. XI. 267.

(*c*) *Cheavin* v. *Walker*, 5 Ch. D. 850-63.

(*d*) See per Sir G. Mellish, L. J., in *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434-56.

(*e*) *Farina* v. *Silverlock*, 6 De G. M. & G. 214; *Collins Co.* v. *Cowen*, 3 K. & J. 428; *Correspondent Newspaper Co.* v. *Saunders*, 11 Jur. N. S. 540; *Kelly* v. *Hutton*, L. R. 3 Ch. 703: *Dicks* v. *Yates*, 18 Ch. D. 76; *Taylor* v. *Carpenter*, 11 Paige, 292; 2 Sandf. 603; R. Cox, 45; *Wolfe* v. *Barnett*, 24 La. Ann. 97; 13 Amer. Rep. 111.

them is in fact so wide that the United States statute of 1870, by which the registration of trade marks was authorised and regulated, was held to be unconstitutional and invalid on the express ground that the clause in the Constitution empowering the Legislature to regulate patents and copyrights conferred upon it no authority to make a statute for the regulation of trade marks. A copyright, like a patent, relates to the substance of an article, but differs in that it has reference to a literary instead of a material production. A trade mark does not protect the substance of the article to which it is attached from being imitated, but it identifies an article and indicates the source to which that article is to be attributed. Trade mark not being copyright, registration of a trade mark, or, what comes to be much the same thing, a title of a book or paper, under the Copyright Acts, is unnecessary and useless (*a*).

Trade marks of aliens protected.

Since trade marks are recognised throughout the world, and not merely in the manufacturer's own country, as indicative of his goods, so that the subjects of any country are liable to be defrauded by goods bearing an imitation of a foreign trade mark, and any manufacturer is liable to suffer by the forgery of his marks abroad, the right of property in a trade mark is not limited by territorial bounds (*b*), though a limitation may be imposed by means of an exception of specified places by the assignor of a trade mark on assignment (*c*), and aliens' marks are protected in the English Courts in precisely the same manner as if they belonged to British subjects (*d*). The same is the case in the United States (*e*), in India (*f*), Canada (*g*), and elsewhere.

(*a*) *Maxwell* v. *Hogg*, L. R. 2 Ch. 307; *Kelly* v. *Hutton*, L. R. 3 Ch. 703; *Hirsch* v. *Jonas*, 3 Ch. D. 584; *Scoville* v. *Toland*, 6 West. L. J. 84.

(*b*) *Derringer* v. *Plate*, 29 Cal. 292; R. Cox, 325.

(*c*) *Manhattan Medicine Co.* v. *Wood*, 108 U. S. Rep. 218.

(*d*) *Collins Co.* v. *Cowen*, 3 K. & J. 428; and cases at p. 92, note (*a*).

(*e*) *Taylor* v. *Carpenter*, 3 Story, 458; R. Cox, 14; and cases at p. 92, note (*a*).

(*f*) *Orr-Ewing* v. *Chooneeloll Mullick*, Cor. 150.

(*g*) *Davis* v. *Kennedy*, 13 Grant Up. Can. Ch. 523.

Conflict of laws.

No direct conflict of laws has as yet arisen in the English Courts with respect to trade marks, though on some occasions such has appeared likely to be the case. In *Farina* v. *Cathery* (*a*) the question was raised whether a Prussian manufacturer could be restrained in this country from using a trade mark which he was entitled to use under Prussian law. It was held, however, that the mark was not identical with that to which a right had been acquired in Prussia. In *Compagnie Laferme* v. *Hendrickx* (*b*) there was a question whether a German manufacturer could acquire a right in England to the exclusive use of a trade mark consisting of the word "Laferme," a mere word not being allowed in Germany to constitute a trade mark; but as the plaintiff failed to satisfy the Court that he had been the first to use the word in Germany, no decision was given on the point. In *In re Farina* (2) (*c*), registration was refused to a German mark on the ground of too great a similarity existing between it and a previously registered German mark, notwithstanding that the German Court of Appeal, reversing the decision of the Court of First Instance, had held that there was no such similarity as to prevent the registration in that country of the second mark. And in *Rodgers & Sons, Ld.* v. *Rottgen* (*d*), a German defendant was restrained from using a trade mark which he had registered in Germany, but which resembled the plaintiff's mark. It has also been held that user abroad is not such user as will bring the person using within the three-mark rule (*e*), and that a person who has not even an intention of using a trade mark in England cannot be a person aggrieved by a wrongful entry on the register (*f*); but the latter decision was

(*a*) L. J. N. of C., 1867, p. 134.
(*b*) Dig. 512.
(*c*) 27 W. R. 456.
(*d*) 5 Times L. R. 678.
(*e*) *In re Münch*, 50 L. T. N. S. 12. And see *Berliner Brauerei Gesellschaft Tivoli* v. *Knight, Stocks & Co.*, W. N. 1883, p. 70; *Jackson & Co.* v. *Napper*, 35 Ch. D. 162; *Newman* v. *Pinto*, 57 L. T. N. S. 31 (per Kekewich, J.), and the Canadian case of *Smith* v. *Fair*, 14 Ont. Rep. 729.
(*f*) *In re Riviere & Co.*, 53 L. J. Ch. 455.

reversed (*a*). Sections 103 and 104 of the Patents Act provide for the grant of privileges to foreigners and colonists in cases in which their governments give protection to British subjects.

Cases analogous to trade-mark cases.

Besides cases of infringement of trade marks proper, there are some other classes of cases nearly akin to the former, but differing from them in some important particulars, which yet require notice in connection with the subject of trade marks, as where there is an unfair competition in trade contrived, not by imitation of trade marks, but by other forms of representation that one man's goods are another's. Such cases are governed by substantially identical principles with those which regulate the law of trade marks, the decision of the Court of Appeal to the contrary (*b*) having been overruled by the House of Lords (*c*).

Trade names.

In imitations of trade names, again, used as such and not as trade marks on goods, there is a difference from trade-mark cases proper: there is a false representation, but it is a representation, not that certain goods are certain other goods, but that a certain establishment is a certain other establishment, the object being that the one establishment should obtain custom intended for the other. Such cases are not cases of trade mark, not being concerned with marks placed on vendible articles in the market (*d*), but still the Court has to proceed on much the same lines.

Goodwill.

All such cases, whether of trade mark, or trade name, or other unfair use of another's reputation, are concerned with an injurious attack upon the goodwill of a rival business; customers are diverted from one trader to another, and orders intended for one find their way to the other. Trade marks are really a branch of the goodwill of the

(*a*) 26 Ch. D. 48.
(*b*) *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434.
(*c*) S. C. 3 App. Cas. 376.
(*d*) *M'Andrew* v. *Bassett*, 4 De G. J. & S. 380.

business with which they are connected, representing it in the market, while the trade name over the shop represents it to the passer-by. It is by the devolution of the goodwill that that of the trade marks is regulated (*a*); they are in fact included in, and valued as part of, the goodwill (*b*); severed from it they cannot exist.

(*a*) § 70 of Patents Act, 1883; and see Rule 38, also § 2 of Trade Marks Act, 1875, and Rule 27 of the Trade Marks Rules, 1876.

(*b*) *Hall* v. *Barrows*, 4 De G. J. & S. 150.

CHAPTER II.

WHAT IS A TRADE MARK?

What is a trade mark?

THE first point which has to be considered in regard to the law of trade marks is, "What is a trade mark?" With what class of objects is this branch of law concerned? On the answer to this question must necessarily depend the principles to be applied in any given case.

A true trade mark must be affixed to the article.

The most important criterion by which a case of trade mark may be distinguished from a case of false representation not amounting to an infringement of trade mark, was thus described by Sir G. Jessel, M. R. (*a*): "The cases which have come before the Courts may, I think, be conveniently divided into two classes. The first class, which is the more numerous, consists of cases where the goods manufactured are distinguished by some description or device in some way or other affixed to the article sold. It may be descriptive—that is, it may consist of a name or names or a lengthy description consisting of names with superadded words—and that description may be either affixed to, or impressed upon, the goods themselves by means of a stamp or an adhesive label, or it may be made to accompany the goods by being impressed or made to adhere to an envelope or case containing the goods (*b*).

"An illustration of the first class would be the common trade mark, which is either the name or the image of some known or unknown thing, actually impressed upon, or worked into, the material, or made to adhere to the surface

(*a*) *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434-40.

(*b*) See the definition by the V.-C. of Ireland in *Wheeler* v. *Johnston*, 3 L. R. Ir. 284; also *Jay* v. *Ladler*, 40 Ch. D. 649; *St. Louis Piano Manufacturing Co.* v. *Merkel*, 1 Mo. App. 305.

of the material; or it may be not what is commonly known as a trade mark, a distinguishing mark which, perhaps, to a legal mind would be a trade mark, but some form of the material itself." His lordship then instanced a case recently before him in which the trade mark consisted of certain lines woven into the fringe of a certain make of cloth, and continued:—

"Sometimes you do not find anything put on the goods themselves, the reason often being that the goods are not capable of it: for instance, when these are liquids, upon which, of course, you cannot put a mark, and therefore a mark is put on the bottle containing the liquid, or on the cork which is in the bottle and helps to retain the liquid. These are again true trade marks, whether affixed in the shape of a label on a bottle of liquid, or in the shape of a device on the cork, or in the case of other goods, such as cigars, affixed to the box which contains the cigars, or the string which encircles them,—they are in some way or other attached to the goods, and go along with the goods on sale. That I call the first class."

As to the second class, his lordship said that "they are cases where the defendant, without putting any trade mark at all on his goods, or putting a trade mark which is admittedly different in substance from the trade mark, if any, of the plaintiff on the goods, has represented the goods as being goods manufactured by the plaintiff. Here, again, the Court has to try the question of representation. What the defendant has said or has done must amount to a representation that the goods to be sold are the goods of the plaintiff, or that they are manufactured by the plaintiff. What amount of representation will be sufficient for that purpose must again depend, of course, on the facts of each particular case."

Registration equivalent to public use.

For a trade mark to be entitled to protection, it must therefore not only be applicable, but be actually applied to

a "vendible article" (*a*) in the market; the registration, however, of a trade mark under the Patents Acts, 1883–8, as under the Trade Marks Acts of 1875–7, is equivalent to public use of the same (*b*).

Not every mark applied can be a trade mark.

But it is not everything that can be marked on goods that will constitute a valid trade mark: a mere descriptive adjective, for instance, cannot be appropriated from the rest of the world (*c*). It is necessary, therefore, to distinguish true trade marks from other marks, which, though affixed to goods, yet cannot be claimed as the exclusive trade marks of any individual.

Name and address of proprietor need not be stated.

In some American cases (*d*) a difficulty has been raised with regard to a supposed requirement for a trade mark to contain an indication of the name and address of its proprietor. This requirement, however, which appears to have been based on a misconstruction of the language of Duer, J., in *Amoskeag Manufacturing Co.* v. *Spear* (*e*),

(*a*) See per Lord Westbury, C., in *McAndrew* v. *Bassett*, 4 De G. J. & S. 380; also *Maxwell* v. *Hogg*, L. R. 2 Ch. 307; *Civil Service Supply Association* v. *Dean*, 13 Ch. D. 512; *In re Simpson, Davies & Sons*, M. R., Jan. 12th, 1881; *Wheeler* v. *Johnston*, 3 L. R. Ir. 284; *Candee* v. *Deere*, 54 Ill. 439; *Avery & Sons* v *Meikle & Co.*, 27 U. S. Pat. Gaz. 1027.

(*b*) 38 & 39 Vict. c. 91, § 2; 46 & 47 Vict. c. 57, § 75. By 51 & 52 Vict. c. 50, § 17, application for registration is substituted for actual registration, but it would appear that this must be followed by registration. See § 77 of the Act of 1883. See also *Edwards* v. *Dennis*, 30 Ch. D. 454. And this is so also in the United States: see *In re Dutcher Temple Co.*, U. S. Pat. Comm. Decis. 1871, 248.

(*c*) Cf. *Raggett* v. *Findlater*, L. R. 17 Eq. 29; *Braham* v. *Bustard*, 1 H. & M. 447; *In re Brandreth*, Dig. 626; *Fulton* v. *Sellers*, 4 Brews. 42, and other cases. As to trade marks composed of an essential particular with an addition varied to indicate different qualities or other matters, and how such marks should be registered, see *infrà*.

(*d*) *E.g.*, *Ferguson* v. *Davol Mills*, 2 Brews. 314; *Dixon Crucible Co.* v. *Guggenheim*, 7 Phila. 408; *White* v. *Schlect*, 14 Phila. 88.

(*e*) 2 Sandf. S. C. 599; R. Cox, 87. The passage alluded to runs thus:—"The owner of an original trade mark has an undoubted right to be protected in the exclusive use of all the marks, forms, or symbols that were appropriated as designating the true origin or ownership of the article or fabric to which they are affixed; but he has no right to an exclusive use of any words, letters, figures, or symbols which have no relation to the origin or ownership of the goods, but are only meant to indicate their name or quality. He has no right to appropriate a sign or symbol which, from the nature of the fact which it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose."

has in practice been disregarded, and the reasoning of the U. S. Commissioner of Patents, when admitting the number "140" to registration as a trade mark for umbrellas (*a*), seems to be conclusive. "A trade mark," he says, "must be of such a character as, when attached to the applicant's goods in the market, will distinguish t' em as to origin from other goods of the same class. To do this, it need not necessarily give the name of the person owning the said mark, nor the place where the goods are made or sold. It is enough if the mark is of such a character as to indicate to the purchaser that all articles bearing it come from one and the same source. The object a man has in view in adopting a trade mark is to secure to himself the benefits arising from the superior merits of his goods over others of the same class. To do this he puts upon them a peculiar mark, that purchasers may be able to distinguish them in the market. It matters not to him nor to others whether the purchasers know either his name or place of business, provided that his goods have some mark by which they may be designated and inquired for." Again, "If a trade mark possesses the evidence upon its face that it is put forth or given out as a distinguishing mark of the goods to which it is attached—that is, distinguishing as to origin, and not as to kind or quality—it may have all the requisites of a valid trade mark without naming the person or place whence it came" (*b*). In short, if a trade mark is properly distinctive—a condition which is indispensable (*c*) —no further particularity can be required, unless under the provisions of some statutory enactment.

Non-restraint of mark, no presumption in favour of mark.

The fact that an action to restrain the use of a particular trade mark has been successfully defended raises no presumption that the defendant's mark is a valid trade mark or capable of registration, for the action may have failed

(*a*) *Ex parte Daves & Fanning*, 1 U. S. Pat. Gaz. 27.

(*b*) Per U. S. Commissioner in *In re Dutcher Temple Co.*, U. S. Pat. Comm. Decis. 1871, 248.

(*c*) See *Lavergne* v. *Hooper*, Ind. L. R. 8 Mad. 149, and many other cases.

on such grounds as, *e.g.*, that the plaintiff's and defendant's marks were alike descriptive (*a*).

Definition of trade mark in Merchandise Marks Act, 1862.

For the purposes of the Merchandise Marks Act, 1862 (*b*), a very wide definition was adopted for the words "trade mark," a definition too little precise to be of much practical use outside of that Act, although it was adopted by the V.-C. of Ireland in *Wheeler* v. *Johnston* (*c*). The Merchandise Marks Act, 1887 (*d*), extends to all trade marks registered under the Patents Act, 1883.

Definition in Patents Acts, 1883-8.

The Trade Marks Registration Act of 1875 (*e*), however, contained a definition, which was not only valuable in itself, but was of great practical importance, qualifying, as it did, for registration and the accompanying advantages, all marks which satisfied its requirements. This definition was repeated, in a somewhat amplified form, in the Patents Act, 1883 (*f*), and has been still further enlarged by the Patents Act, 1888 (*g*).

The definition in question, as it now stands, is as follows:—

"(1) For the purposes of this Act a trade mark must consist of or contain at least one of the following essential particulars:—

(*a*) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

(*b*) A written signature, or copy of a written signature, of the individual or firm applying for registration thereof as a trade mark; or

(*c*) A distinctive device, mark, brand, heading, label, or ticket; or

(*d*) An invented word or invented words; or

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

(*a*) *In re Anderson*, 26 Ch. D. 409; 54 L. J. Ch. 1084 (App.).
(*b*) 25 & 26 Vict. c. 88, § 1.
(*c*) 3 L. R. Ir. 284.
(*d*) 50 & 51 Vict. c. 28.
(*e*) § 10. (*f*) § 64. (*g*) § 10.

(2) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them; but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

(3) Provided as follows:—

(i.) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business; but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof;

(ii.) Any special and distinctive word or words, letter, figure, or combination of letters or figures (*a*), or of letters and figures, used as a trade mark before the 13th day of August, 1875, may be registered as a trade mark under this part of this Act" (*b*).

And by § 74 further provision is made for the registration of additions to registered trade marks.

Effect of this definition.

The effect of this definition is to restrict the variety of marks now capable of adoption for the first time by a manufacturer, for he cannot register or obtain protection under the Act for a new mark which does not comply with this definition by containing some one of the five first-mentioned essential particulars, although previously to the Act it would have been perfectly good. "There was considered that it was the essential elements that constituted the trade mark, not the whole label with all the minor and immaterial additions: *Orr-Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 479.

(*a*) "Figures" means "numerals." *Ex parte Stephens*, 3 Ch. D. 659.

(*b*) And see the definitions in *McLean* v. *Fleming*, 96 U. S. Rep. 245, and *Avery & Sons* v. *Meikle & Co.*, 27 U. S. Pat. Gaz. 1027. The House of Lords appears to have

obviously much more difficulty," said Lord Blackburn (*a*), referring to the Act of 1875, "in dealing with existing trade marks, in which there was a vested right of property, than in dealing with new trade marks, as to which no one as yet had a vested right. According to the usual course of legislation in this country, vested rights of property are to be respected, and not interfered with farther than is necessary; but as to rights to be acquired hereafter, it is merely a question of expediency what conditions the Legislature may think fit to attach to the acquiring of those rights." The Act of 1883 went beyond the Act of 1875 in admitting to registration as a new trade mark "a fancy word or fancy words,"—an expression for which sub-clauses (*d*) and (*e*) of the amended § 64 (1) have now been substituted,—but there are still some marks incapable of registration as new ones which would have been protected before the Act of 1875. However, a manufacturer is entitled under § 64 to register any distinctive mark used as such *before* the passing of the Act of 1875, and which is within the wording of § 64 (*b*), so obtaining for it the benefits of the Act, or, in case of registration being refused, to demand a certificate of such refusal (*c*), the possession of which will place him in a position to exercise whatever rights he may have had before and independently of the Acts.

First class of trade marks. —A name.

In accordance with the above definition, the first species of trade marks consists of a name of an individual or firm, printed, impressed, or woven in some particular and distinctive manner, to which essential particular may be added any letters, words, or figures, or combination of letters, words, or figures, or of any of them.

How names differ from

There is between a name of an individual or firm used

(*a*) *Orr-Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 495.

(*b*) This is wider than the wording of § 10 of the Act of 1875, and a single distinctive letter or figure may now be registered as an old trade mark, though this was not so under the Act of 1875: *In re Mitchell* (1), 7 Ch. D. 36.

(*c*) Patents Act, 1883, § 77.

as a trade mark, and a fancy name or arbitrary symbol used for the same purpose, a broad distinction, which was early perceived, and which caused some difficulty in the universal acceptance of a name as an efficacious trade mark. This difference is that a name is in its very nature generic, and is properly applied to designate, not one individual in the world, but, it may be, many thousands, to all of whom it is equally appropriate. The addition of the Christian to the surname does, indeed, diminish the number of persons to whom the appellation belongs; but the Christian name is commonly abbreviated to an initial letter, and, in any case, the surname is the important part of the name, beyond which many persons do not care to investigate.

other trade marks.

The impossibility of a single manufacturer being allowed to arrogate to himself the exclusive use of a name which he shares in common with many other persons is apparent; and from this circumstance the rule was deduced that while, as against persons bearing a different name, a manufacturer's right in his name trade mark is absolute and exclusive, as against persons bearing the same name no such exclusive right can be set up (*a*). Thus in *Dence* v. *Mason* (*b*), Malins, V.-C., held that during the continuance of the partnership between two persons named Mason and Brand they could not be prevented from using the

Consequently the right in a name used as a trade mark is less complete.

(*a*) *Burgess* v. *Burgess*, 3 De G. M. & G. 896, and *infrà*, p. 29; *Faber* v. *Faber*, 49 Barb. 357; R. Cox, 401; *Meneely* v. *Meneely*, 62 N. Y. 427. See *Howe* v. *Howe Machine Co.*, 50 Barb. 236; R. Cox, 421; *Kazenby* v. *White* (1), 41 L. J. Ch. 354; *Massam* v. *Thorley's Cattle Food Co.* (1), 6 Ch. D. 574; *Turton* v. *Turton*, 42 Ch. D. 128; *Tussaud* v. *Tussaud*, 38 W. R. 503; *McLean* v. *Fleming*, 96 U. S. Rep. 245; *Binninger* v. *Wattles*, 28 How. Pr. 206; *Gilman* v. *Hunnewell*, 122 Mass. 139; *Prince Metallic Paint Co.* v. *Carbon Metallic Paint Co.*, Dig. 573; *Helmbold* v. *Helmbold Manufacturing Co.*, 53 How. Pr. 453; *Aikins* v. *Piper*, 15 Grant Up. Can. Ch. 581; *Decker* v. *Decker*, 52 How. Pr. 218; *Hardy* v. *Cutter*, 3 U. S. Pat. Gaz. 468; *In re Consolidated Fruit Jar Co.*, 14 U. S. Pat. Gaz. 269; *Marshall* v. *Pinkham*, 52 Wisc. 572; *Frazer* v. *Frazer Lubricator Co.*, 121 Ill. 147; *Brown Chemical Co.* v. *Myer*, 31 Fed. Rep. 453; *Pratt's Appeal*, 117 Penn. St. 401. And in the same way it seems that a manufacturer may put his address, the name of his mill, on his goods, though it may resemble the address on another man's goods: *Carmichel* v. *Latimer*, 11 R. I. 395.

(*b*) Dig. 534.

latter's name in their business, notwithstanding that it was well known in connection with a similar old-established business; and the Court of Appeal held (*a*) that the same would be the case if a new *bonâ-fide* partnership should be formed. This rule must, however, be qualified by the statement that where a person uses his own name for the purpose of fraud, and satisfactory evidence of fraudulent intention can be produced, such unfair conduct will be restrained, even though the free use of the man's own name may be thereby hindered (*b*). And the Criminal Law also admits of the punishment of such fraudulent user of a man's own name (*c*).

Statements on this point.

A valuable statement of the law was made by Lord Craighill in the Scottish Court of Session, in *Dunnachie* v. *Young & Sons* (*d*), in which he said:—"The name of a person may be a trade mark; there may be other manufacturers of goods of the same description, and the latter are not precluded from placing their own names on their goods by reason of the fact that this name has already become the trade mark of another manufacturer. The only condition they must fulfil is that the name as used by them shall be accompanied with something which shall be a distinction, if the bare name would lead to the deception of the public and the injury of the trader on whose goods the name first appeared as a trade mark." And in the New York case of *England* v. *The New York Publishing*

(*a*) 41 L. T. N. S. 573.

(*b*) *Holloway* v. *Holloway*, 13 Beav. 209, and *infrà*; *Rodgers* v. *Nowill*, 6 Hare, 325; 5 C. B. 109; *Taylor* v. *Taylor*, 23 L. J. Ch. 255; *James* v. *James*, L. R. 13 Eq. 421; *Fullwood* v. *Fullwood*, W. N. 1873, pp. 93-185; *Fullwood* v. *Fullwood* (2), 9 Ch. D. 176; *Massam* v. *Thorley's Cattle Food Co.* (2), 14 Ch. D. 748; *Pullar* v. *Pullar*, Fry, J., April 9th, 1883; *Warner* v. *Warner*, 5 Times L. R. 359; *Tussaud* v. *Tussaud*, 38 W. R. 503; *Gillis* v. *Hall*, R. Cox, 596; *Stonebraker* v. *Stonebraker*, 33 Md. 252; *McLean* v. *Fleming*, 96 U. S. Rep. 245; *Devlin* v. *Devlin*, 69 N. Y. 212; *Wilder* v. *Wilder*, Dig. 372; *Peltz* v. *Eichele*, 62 Mo. 171; *Rogers* v. *Taintor*, 97 Mass. 291; *In re Consolidated Fruit Jar Co.*, 14 U. S. Pat. Gaz. 269; *Shaver* v. *Shaver*, 52 Iowa, 208; *India Rubber Comb Co.* v. *Rubber Comb & Jewelry Co.*, 45 N. Y. Super. Ct. 258.

(*c*) *R.* v. *Dundas*, 6 Cox, 380.

(*d*) Ct. Sess. Cas. 4th Ser. X. 874.

Co. (*a*), Daly, C. J., said:—"The fact that a man has used his own name to designate the article he produces, and that the name has become valuable to him through the article becoming extensively known, gives him no right to exclude any other man of the same name from affixing his name upon the same kind of article, if he manufactures it. The test is whether he uses the name honestly and fairly in the ordinary prosecution of his business, or dishonestly, to palm off his own commodity as the production of another."

Holloway v. *Holloway*.

In *Holloway* v. *Holloway* (*b*), the defendant, Henry Holloway, sold pills and ointment in packets and pots, similar to those in which his brother, the plaintiff, Thos. Holloway, sold his, and the defendant also affixed to his packets and pots similar labels and wrappers, but with "H. Holloway," instead of simply "Holloway." Thomas Holloway having filed a bill for an injunction, Lord Langdale, M. R., granted the injunction, saying, on the evidence, that it was as clear and as plainly avowed a fraud as he ever knew. He, however, expressly stated that, "the defendant's name being Holloway, he had a right to constitute himself a vendor of Holloway's pills and ointment," and that he, the M. R., "did not intend to say anything tending to abridge such right"; the defendant had, nevertheless, no right to do so with such additions to his own name as to deceive the public and make them believe that he was selling the plaintiff's pills and ointment.

Burgess v. *Burgess*.

The case of *Burgess* v. *Burgess* (*c*) was somewhat similar. There the plaintiff's father, to whose business the plaintiff had succeeded, had invented "Burgess' Essence of Anchovies." He employed his two sons as his assistants, and the business was conducted by him and them at 107, Strand. After a time one of the sons, W. H.

(*a*) 8 Daly, 375.
(*b*) 13 Beav. 209.
(*c*) 3 De G. M. & G. 896.

Burgess, took a house in King William Street, and setting up for himself, put on his shop front, "W. H. Burgess, late of 107, Strand." He also headed his labels, "36, King William Street, City, London (Royal Arms), late of 107, Strand, Burgess' Essence of Anchovies"; plaintiff's labels being headed, "107 (Royal Arms), Strand, corner of the Savoy Steps, John Burgess and Son, Original and Superior Essence of Anchovies." Sir R. T. Kindersley, V.-C., granted an injunction as to "late of 107, Strand," and the continuance on the sides of the defendant's shop door of a plate with the words "Burgess' Fish Sauce Warehouse, late of 107, Strand"; but the part of the motion which referred to the use of the words "Burgess' Essence of Anchovies" being refused, the plaintiff appealed, and the Lords Justices then distinctly refused to deny a man the use of his own name. Sir J. L. Knight-Bruce, L. J., said, "All the Queen's subjects have a right to sell their articles in their own names, and not the less so that they bear the same name as their fathers (*a*). The defendant carries on business in his own name, and sells his essence of anchovies as 'Burgess' Essence of Anchovies,' which, in truth, it is;" and Sir G. Turner, L. J., added that, "where a person was selling goods under a particular name, and another person, not having that name, was using it, it might be presumed that he so used it to represent the goods sold by himself as the goods of the person whose name he used (*b*); but that where the defendant sold goods under his own name, and it did happen that the plaintiff had the same name, it did not follow that the defendant was selling his goods as

(*a*) And see *Hardy* v. *Cutter*, 3 U. S. Pat. Gaz. 468. However, a son has no right to deceive the public by using his father's new name, after the father has assumed a different name from that to which the son is entitled: *Gouraud* v. *Trust*, 10 N. Y. Sup. Ct. 627; but if the son has assumed the same fictitious name with the father, by the father's desire, the latter cannot afterwards interfere with the honest use of the fictitious name by the son: *England* v. *New York Publishing Co*, 8 Daly, 375.

(*b*) See *Perks* v. *Hall & Co.*, W.N. 1881, p. 111.

the goods of the plaintiff" (*a*); if, however, a fraudulent intention had been proved, both judges agreed that the case would have been different.

Ainsworth v. *Walmsley.*

The fact that according to these cases a man might with impunity, in the absence of proof of actual fraud, sell the same goods as another, under the same name, provided that his own name was the same as that of the rival manufacturer, who had been in the habit of using his name as his trade mark, not unnaturally produced doubts whether a trade mark which was not capable of protection against infringement in all cases could rightly be termed a trade mark at all; and in *Ainsworth* v. *Walmsley* (*b*), where the defendant had affixed to thread not of the plaintiff's make labels with the words "Ainsworth's Thread," it was argued that such a case was no case of trade mark, and that, this being so, it became necessary for the plaintiff to prove the *scienter* on the part of the defendant. Sir W. P. Wood, V.-C., however, declined to adopt that argument, and intimated that in his opinion a man's name was "as strong an instance of trade mark as could be suggested," adding that it was subject "only to this inconvenience—that if a Mr. Jones or a Mr. Brown relied on his name, he might find it a very inadequate security, because there might be several other manufacturers of the same name."

A name may be a true trade mark.

The decision in this case finally established the principle that the name of an individual or firm duly appended to the vendible article is a valid trade mark (*c*), subject to the inconvenience mentioned above.

A name now first used as a

That inconvenience has now been removed as to new

(*a*) In *Massam* v. *J. W. Thorley's Cattle Food Co.* (2), 14 Ch. D. 748, James, L. J., expressed the opinion that the language of Turner, L. J., was to be preferred to that of Knight-Bruce, L. J., the terms used by the latter being somewhat calculated to mislead; but see the judgments of the Court of Appeal in *Turton* v. *Turton*, 42 Ch. D. 128.

(*b*) L. R. 1 Eq. 518.

(*c*) See per Lord Kingsdown, in *Leather Cloth Co.* v. *American Leather Cloth Co.*, 11 H. L. C. 523, where he treats a name as a good trade mark.

trade mark must be in a distinctive form.

marks by the requirement for the name claimed as a trade mark to be "printed, impressed, or woven in some particular and distinctive manner" (*a*). For the future, a new trade mark consisting of a name will be available against all the world, without exception, for with the mere collocation of letters there is to be combined some further element, in respect of colour, pattern, or some other such differentia, which shall effectually distinguish the trade mark from even a similar succession of letters from which that further characteristic shall be absent (*b*). The effect of this provision is to render necessary for the future a precaution which many manufacturers have already voluntarily adopted; and the employment of a mode of printing, the imitation of which would furnish an almost irrefutable presumption of fraud, may be instanced from *Stephens* v. *Peel* (*c*), in which case the labels on the bottles containing the plaintiff's ink were printed in letters which are described as being in part white on a red ground, in part white on a blue ground, and in part blue on a white ground.

The name need not be that of the actual manufacturer.

There is no provision in the Act which requires that the name selected as the trade mark shall be the name of the individual or firm by whom the goods to which the trade mark is to be attached are actually manufactured. Neither was this the case before the passing of the Act. In many instances, it is true, the name was that of the actual

(*a*) Patents Acts, 1883-8, § 64; Trade Marks Act, 1875, § 10; and see *In re Gianaclis*, 58 L. J. Ch. 782; *In re Hannay*, 7 P. R. 46. Also *In re Price's Patent Candle Co.*, 27 Ch. D. 681.

(*b*) See per Jessel, M.R., in *In re Horsburgh & Co.*, 53 L. J. Ch. 237. In the same way, the United States Statute of 1870, § 79, provided that the Commissioner of Patents should not receive and record any proposed trade mark which was merely the name of a person, firm, or corporation only, unaccompanied by a mark sufficient to distinguish it from the same name where used by other persons. And the Statute of 1881, now in force, provides by § 3, that "no alleged trade mark shall be registered which is merely the name of the applicant." See the decisions in *In re India Rubber Comb Co.*, 8 U. S. Pat. Gaz. 905, and *In re Roue & Post*, 9 U. S. Pat. Gaz. 496, under the Act of 1870, and other cases noted against the Act.

(*c*) 16 L. T. N. S. 145. See *Royal Baking Powder Co.* v. *Davis*, 26 Fed. Rep. 293.

manufacturer: thus, the words "Ainsworth's Thread" (*a*) and "Taylor's Persian Thread" (*b*) were used as trade marks on thread produced by those makers, "Ramsay' was used on bricks by G. H. Ramsay (*c*), Thomas Holloway placed "Holloway's Pills" and "Holloway's Ointment" on his boxes and pots (*d*), and so in many cases more (*e*).

A name become a trade mark may pass with the business.

But where a name has once become a trade mark by registration, or, if used before the passing of the Trade Marks Registration Act of 1875, by actual user on a vendible article (*f*), since followed by registration or the procurement of a certificate of refusal to register, it is assignable (*g*), subject to a connection with the goodwill of the business (*h*), and may easily pass to and become the property of a person or firm whose own name is widely different. Thus, the trade mark "William Ash" in *Bury* v. *Bedford* (*i*), "1847, Rogers Bros. A. 1," in *Meriden Britannia Co.* v. *Parker* (*k*), "Thorley's Cattle Food" in *Massam* v. *J. W. Thorley's Cattle Food Co.* (2) (*l*), "D. Simmons" in *Weed* v. *Peterson* (*m*), "Pepper's Signal Oil" in *Weston* v. *Ketcham* (1), (2) (*n*), "Dr. C. McLane's Pills" in *McLean* v. *Fleming* (*o*), "Smith, Snyder & Co." in *Young* v. *Jones Bros. & Co.* (*p*), "Oakes' Candies" in *Probasco* v. *Bouyon* (*q*). But it is a fraudulent act to purchase the right to use the name of a small maker

(*a*) *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518.

(*b*) *Taylor* v. *Taylor*, 23 L. J. Ch. 255.

(*c*) *Dixon* v. *Fawcus*, 3 Ell. & Ell. 537.

(*d*) *Holloway* v. *Holloway*, 13 Beav. 209.

(*e*) *Burgess* v. *Burgess*, 3 De G. M. & G. 896; *Wedgwood* v. *Smith*, Dig. 96; *Collins Co.* v. *Brown*, 3 K. & J. 423; *Stephens* v. *Peel*, 16 L. T. N. S. 145, &c.

(*f*) *McAndrew* v. *Bassett*, 4 De G. J. & S. 380.

(*g*) *Hall* v. *Barrows*, 4 De G. J. & S. 150; *The Leather Cloth Companies' case*, 1 H. & M. 271 (V.-C. Wood), and 11 H. L. C. 523 (Lords Cranworth and Kingsdown); *Rogers* v. *Taintor*, 97 Mass. 291; *Emerson* v. *Badger*, 101 Mass. 82.

(*h*) Trade Marks Registration Act, 1875, § 2. Patents Act, 1883, § 70.

(*i*) 32 L. J. Ch. 741, and 4 De G. J. & S. 352.

(*k*) 39 Conn. 450; 12 Amer. Rep. 401.

(*l*) 14 Ch. D. 748.

(*m*) 12 Abb. Pr. N. S. 178.

(*n*) 39 N. Y. Super. Ct. 54; 51 How. Pr. 455.

(*o*) 96 U. S. Rep. 245.

(*p*) 3 Hughes, 274.

(*q*) 1 Mo. App. 241.

because it happens to be identical with that of a maker of reputation (*a*).

Names of fancy personages.

Among trade marks used before the passing of the Trade Marks Act of 1875, instances are not unusual of marks consisting of a name which neither is nor ever has been borne by the present or any past manufacturer, but which either belongs to some person who actually exists or has existed, or to some imaginary or symbolical personage, or character from a book. Thus, the names "Victoria," "Albert," &c., are very commonly used on a great variety of articles; thus "Bismarck" denoted paper collars (*b*), and "Roger Williams" long cloth (*c*), "Dave Jones" whisky (*d*), "Lone Jack" tobacco (*e*); so too "Britannia," "Dolly Varden," &c. All such names, whether of real or fictitious characters, will properly be classed under sub-clause (*e*) of the amended § 64 (1 .

Name sometimes used alone.

In some cases the name constituting the trade mark is used alone, as "Wilkie" in *Wilkie* v. *McCulloch* (*f*), "Dent" in *Dent* v. *Turpin* (*g*), "Ramsay" in *Dixon* v. *Fawcus* (*h*), "Howe" in *Howe* v. *Howe Machine Co.* (*i*), "Wedgwood" in *Wedgwood* v. *Smith* (*k*), "Derringer" in *Derringer* v. *Plate* (*l*), "Jules Jurgensen" in *Jurgensen* v. *Alexander* (*m*), "A. W. Faber" in *Faber* v. *Faber* (*n*).

(*a*) *Perks* v. *Hall & Co.*, W. N. 1881, p. 111.

(*b*) *Messerole* v. *Tynberg*, 4 Abb. Pr. N. S. 410; R. Cox, 479. In the U. S. Patent Office it has been held that one man may register as his trade mark another man's name with the latter's written consent: *Ex parte Sullivan & Burke*, 16 U. S. Pat. Gaz. 765; *Ex parte Puce, Talbott & Co.*, *ib.* 909.

(*c*) *Barrows* v. *Knight*, 6 R. I. 434; R. Cox, 238.

(*d*) *Kidd & Co.* v. *Mills, Johnson & Co.*, 5 U. S. Pat. Gaz. 337.

(*e*) *Carroll* v. *Ertheiler*, 1 Fed. Rep. 688.

(*f*) Ct. Sess. Cas., 1st Ser. II. 413.

(*g*) 2 J. & H. 139.

(*h*) 3 Ell. & Ell. 537.

(*i*) 50 Barb. 236; R. Cox, 421.

(*k*) Dig. 96.

(*l*) 29 Cal. 292; R. Cox, 324.

(*m*) 24 How. Pr. 269; R. Cox, 298.

(*n*) 49 Barb. 357; R. Cox, 401. And see *Richards* v. *Williamson*, 30 L. T. N. S. 746; *Fullwood* v. *Fullwood*, W. N. 1873, pp. 93-185; *Tonge* v. *Ward*, 21 L. T. N. S. 480; *Fullwood* v. *Fullwood* (2), 9 Ch. D. 176; *Bowman* v. *Floyd*, 85 Mass. 76; *Rogers* v. *Taintor*, 97 Mass. 291; *Emerson* v. *Badger*, 101 Mass. 82; *Sohier* v. *Johnson*, 111 Mass. 238; *Sherwood* v. *Andrews*, 3 Am. L. Reg. N. S. 588; *In re India Rubber Comb Co.*, 8 U. S. Pat. Gaz. 905; *India Rubber Comb Co.* v. *Meyer*, *ib.* 905; *India Rubber Comb*

In other cases the name is used in combination with other letters, words, or figures, or combinations of letters, words, or figures; and the name of an inventor, discoverer, manufacturer, &c., "may make words distinctive which, without the name, would not be so" (*a*). Thus "Chubb's Patent-Lock Fire-proof Safe" (*b*), "Collins & Co. Hartford Cast Steel, Warranted" (*c*), "Taylor's Persian Thread" (*d*), "Stephens' Blue Black Writing Fluid" (*e*), "Thorley's Cattle Food" (*f*), "Coe's Super-phosphate of Lime" (*g*), "Wolfe's Aromatic Schiedam Schnapps" (*h*), "Mrs. Winslow's Soothing Syrup" (*i*), "1847, Rogers Bros., A 1" (*k*), "Meneely's West Troy, N.Y." (*l*). Again, "J. Rodgers & Sons" was coupled with a crown between the initials of the sovereign (*m*), and "Ransomes & Co." was followed by "H. H. 6" (*n*). Sometimes in combinations.

Co. v. Rubber Comb & Jewelry Co., 45 N.Y. Super. Ct. 258; *In re Rubber Clothing Co.*, 10 U. S. Pat. Gaz. 111; *In re Coggin, Kidder & Co.*, 11 U. S. Pat. Gaz. 1109; *In re Hall & Co.*, 13 U. S. Pat. Gaz. 229; *Carmichel* v. *Latimer*, 11 R. I. 395.

(*a*) *Fulton* v. *Sellers*, 4 Brews. 42.

(*b*) *Chubb* v. *Priest*, 1 L. T. 142.

(*c*) *Collins Co.* v. *Brown*, 3 K. & J. 423; *Collins Co.* v. *Coven*, *ib.* 428.

(*d*) *Taylor* v. *Taylor*, 23 L. J. Ch. 255.

(*e*) *Stephens* v. *Peel*, 16 L.T. N.S. 145.

(*f*) *Massam* v. *J. W. Thorley's Cattle Food Co.* (2), 14 Ch. D. 748.

(*g*) *Bradley* v. *Norton*, 33 Conn. 157; R. Cox, 331.

(*h*) *Burke* v. *Cassin*, 45 Cal. 467; 13 Amer. Rep. 204.

(*i*) *Curtis* v. *Bryan*, 2 Daly, 212; R. Cox, 434.

(*k*) *Meriden Britannia Co.* v. *Parker*, 39 Conn. 450; 12 Amer. Rep. 401.

(*l*) *Meneely* v. *Meneely*, 62 N. Y. 427.

(*m*) *Rodgers* v. *Nowill*, 6 Hare, 325; 5 C. B. 109; 3 De G. M. & G. 614.

(*n*) *Ransome* v. *Bentall*, 3 L. J. Ch. 161. And see *Green* v. *Folgham*, 1 S. & S. 398; *James* v. *James*, L. R. 13 Eq. 421; *Lazenby* v. *Lazenby*, Dig. 160; *Gillis* v. *Hall*, R. Cox, 596. Also *Wilder* v. *Wilder*, Dig. 372 ("J. B. Wilder & Co.'s Stomach Bitters"); *Weston* v. *Hemmons*, 2 Vict. L. R. Eq. 121 ("Weston's Wizard Oil"); *Filkins* v. *Blackman*, 13 Bl. C. C. 440 ("Dr. J. Blackman's Genuine Healing Balsam"); *Gouraud* v. *Trust*, 10 N. Y. Sup. Ct. 627 ("Gouraud's Oriental Cream, or Magical Beautifier"); *Weston* v. *Ketcham* (1) and (2), 39 N. Y. Super. Ct. 54; 51 How. Pr. 455 ("Capt. S. Pepper's Extra Signal Oil"); *In re Rohland*, 10 U. S. Pat. Gaz. 980 ("Dr. Lobenthal's Essentia Antiphthisica"); *Swift* v. *Peters*, 11 U. S. Pat. Gaz. 1110 ("The John C. RagsdaleAmmoniated Dissolved Bone"); *McLean* v. *Fleming*, 96 U. S. Rep. 245 ("Dr. C. McLane's Liver Pills"); *Davis* v. *Kennedy*, 13 Grant Up. Can. Ch. 523 ("Perry Davis' Vegetable Pain-Killer"); *Fulton* v. *Sellers*, 4 Brews. 42 ("Dr. J. M. Lindsey's Improved Blood Searcher"); *Manhattan Medicine Co.* v. *Wood*, 4 Cliff. 461 ("Atwood's Physical

Second class of trade marks.—A signature.

The second class of trade marks to which the Act allows registration is really little else than a subdivision of the first class, consisting, as it does, of "a written signature, or copy of a written signature of the individual or firm applying for registration thereof as a trade mark," to which there may be added, as before, "any letters, words, or figures, or combination of letters, words, or figures, or of any of them." The signature of an individual or firm is in fact the name of the individual or firm printed or written in a "particular and distinctive manner," and as such, even before the Registration Acts, necessarily exhibited characteristics which could hardly be copied without the presumption being irresistible that the imitation was fraudulent and intended to invade the rights of the person whose signature was in question. In the cases of *Farina* v. *Silverlock* (*a*) and *Welch* v. *Knott* (*b*) the signature formed an important part of the trade mark concerned, and in America the signatures of individuals and firms have been admitted to registration on the same principle. Under the Act of 1875, § 10, there was no necessity for the signature to be that "of the individual or firm applying for registration thereof as a trade mark," but that is now required by § 64, both as originally contained in the Act of 1883, and as amended by the Act of 1888; so that an individual or firm will not in the future be able to register the signature of the person or firm to whose business he or they succeeded,

Vegetable Jaundice Bitters"); *Hostetter* v. *Vowinkle*, 1 Dill. 329, and *Hostetter* v. *Anderson*, 1 V. R. Eq. 7 ("Hostetter's Celebrated Stomach Bitters"); *Radway* v. *Coleman*, 15 Grant Up. Can. Ch. 50 ("Radway's Ready Relief"); *Chinn* v. *Thomas*, 5 Vict. L. R. Eq. 188 ("Hood & Co.'s Soluble Sheep Dip"); *Hanford* v. *Westcott*, 16 U. S. Pat. Gaz. 1181 ("Hanford's Chestnut Grove Whiskey"); *Morgan* v. *Rogers*, 26 *ib.* 1113 ("Dr. Haynes' Arabian Balsam"); *Funke* v. *Dreyfus*, 34 La. Ann. 80 ("Boker's Stomach Bitters"); *Hoxie* v. *Chaney*, 143 Mass. 592 ("A. N. Hoxie's Mineral Soap"), ("A. N. Hoxie's Pumice Soap").

(*a*) 1 K. & J. 509; 6 De G. M. & G. 214; 4 K. & J. 650.

(*b*) 4 K. & J. 747. See *Massam* v. *Thorley's Cattle Food Co.* (1), 6 Ch. D. 574; *In re Farina* (2), 27 W. R. 456; *In re Farina* (3), Dig. 654; *In re Maignen*, 28 W. R. 759.

unless that is an old mark, having been used as such before the passing of the Act of 1875. However, when the signature is once registered as a trade mark, whether with or without additions, it will descend and be assignable just as any other trade mark, without its new owner being liable to any imputation of representing the person whose signature is employed to be still in charge of the business, although formerly the use of a mark of this description might not improbably have been held to convey some such representation to the public. To a case of this description Lord Cranworth's observations very directly apply, when, speaking of a buyer of a business using the name of a former maker, he said (*a*), "the question in every such case must be whether the purchaser in continuing the use of the original trade mark would, according to the ordinary usages of trade, be understood as saying more than that he was carrying on the same business as had been formerly carried on by the person whose name constituted the trade mark. In such a case I see nothing to make it improper for the purchaser to use the old trade mark, as the mark would in such a case indicate only that the goods so marked were made at the manufactory which he had purchased." The provision in the Acts of 1875 (*b*) and 1883 (*c*) that a trade mark "shall be assigned and transmitted only in connexion with the goodwill of the business" will enable the purchaser to use the trade mark so acquired by him without his motives being open to question, and will at the same time insure that marked goods purchased by the public shall, except in cases of punishable infringement, be produced at the works from which they purport to have come.

Third class of trade marks.—A distinc-

The third class of marks comprises "a distinctive device, mark, brand, heading, label, or ticket," to which again

(*a*) *Leather Cloth Co.* v. *American Leather Cloth Co.*, 11 H. L. C. 523.

(*b*) § 2.

(*c*) § 70.

tive device, &c.

may be added "any letters, words, or figures, or combination of letters, words, or figures, or of any of them."

Distinctiveness required.

The important feature which is absolutely necessary in all the varieties of trade marks included in this class is that of distinctiveness (*a*): each mark must be such that, if a question of infringement arises, it shall be perfectly clear what it is that is being infringed, and that this something is quite different from all other marks used upon the same class of goods.

Composition of trade mark, and manner of use alluded to.

Of the words "device, mark, brand, heading, label, or ticket," some point more directly to the matter of which the trade mark is composed, others to the manner in which it is affixed to the vendible article.

"Device" and "mark."

"Device" and "mark" seem, at first sight, wide enough to include any of the symbols or combinations of which a trade mark could consist. It has, however, been held, under the Act of 1875, that they do not include a mere word, or collocation of letters or figures, however strangely combined, or singular in their application (*b*), and the decision seems to be equally applicable to the Acts of 1883-8.

Mode of application indicated by them.

When used as indicative of the mode of application of the trade mark, these words will include such cases as where the mark is stamped on shirts (*c*) or other cotton goods (*d*), or imprinted on sticks of liquorice (*e*) or sealing-wax (*f*), and, generally, any cases which do not come within the remaining and more exact terms.

"Brand."

"Brand" refers to cases in which the trade mark is

(*a*) See per Cotton, L. J., in *Waterman* v. *Ayres*, 39 Ch. D. 33, and per Chitty, J., in *Burland & Co.* v. *Broxburn Oil Co. Ld.* (2), 42 Ch. D. 274.

(*b*) *Ex parte Stephens*, 3 Ch. D. 659.

(*c*) *Ford* v. *Foster*, L. R. 7 Ch. 611.

(*d*) *Henderson* v. *Jorss*, Dig. 198; *Carver* v. *Pinto Leite*, L. R. 7 Ch. 90; *Broadhurst* v. *Barlow*, W. N. 1872, p. 212; *Carver* v. *Bowker*, Dig. 581.

(*e*) *McAndrew* v. *Bassett*, 4 De G. J. & S. 380.

(*f*) *In re Hyde & Co.*, 7 Ch. D. 724.

branded on metal goods (*a*), or on wine-casks (*b*), or corks (*c*).

"Heading" possibly applies to cases where, in addition to the ordinary label on the goods, there is a separate label affixed above it, on which the special mark is exhibited (*d*). But it more especially applies to the kind of marks applicable to the case of textile fabrics, in which a heading of special pattern is inwoven into the edge of the goods (*e*). "Heading."

"Label" indicates an impression of a trade mark upon a piece of paper, or some other thin substance, which is made to adhere to the goods to which it is applied, or to the vessel containing them. Thus, in *Wotherspoon* v. *Currie* (*f*), the label was affixed to packets of starch; in *Bass* v. *Dawber* (*g*) to bottles of beer; in *Blackwell* v. *Crabb* (*h*), *Cocks* v. *Chandler* (*i*), *Cotton* v. *Gillard* (*j*), and other cases, to bottles of pickle. "Label."

"Ticket" points to a mark also impressed upon a separate material, but only loosely attached to the goods the make of which it indicates. Thus the trade mark of a wire manufacturer consisted of an anchor stamped on the tallies, or metal labels, attached to the bundles of his wire (*k*); the trade mark of a clothier was imprinted on a ticket pinned on to his wares (*l*). Mere words do not constitute a distinctive heading (*m*), or label, or ticket (*n*). "Ticket."

(*a*) *Motley* v. *Downman*, 3 My. & Cr. 1; *Millington* v. *Fox*, *ib.* 338; *Crawshay* v. *Thompson*, 4 M. & G. 357; *Hall* v. *Barrows*, 32 L. J. Ch. 548; and 4 De G. J. & S. 150, &c.

(*b*) *Seixo* v. *Provezende*, L. R. 1 Ch. 192; *Moet* v. *Couston*, 33 Beav. 578; *Ponsardin* v. *Peto*, 33 Beav. 642, &c.

(*c*) *Moet* v. *Clybourn*, Dig. 533; *Moet* v. *Pickering*, 8 Ch. D. 372.

(*d*) *Ex parte Stephens*, 24 W. R. 963.

(*e*) *Harter* v. *Souvazoglu*, W. N. 1875, pp. 11-101; *Carver* v. *Bowker*, Dig. 581; *Robinson* v. *Finlay*, 9 Ch. D. 487; and see per Sir G. Jessel, M. R., in *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434.

(*f*) L. R. 5 H. L. 508. See *Gilman* v. *Hunnewell*, 122 Mass. 139.

(*g*) 19 L. T. N. S. 626.

(*h*) 36 L. J. Ch. 504.

(*i*) L. R. 11 Eq. 446.

(*j*) 44 L. J. Ch. 90.

(*k*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185.

(*l*) *Hirst* v. *Denham*, L. R. 14 Eq. 542.

(*m*) *Leonard and Ellis* v. *Wells & Co.*, 26 Ch. D. 288.

(*n*) *Great Tower St. Tea Co.* v. *Smith*, 6 P. R. 165.

Composition of trade mark.

The question, "What is a trade mark?" is, however, less directed to the manner in which the trader's symbol is attached to his goods than to its composition, and the varieties of mark which will merit and receive protection.

"Device."

The original form of trade mark was probably the representation of some animal, or other natural object, or mathematical figure, as the Hall mark of the lion or leopard's head, the Freemasons' square and compasses (*a*), or the Government broad arrow. Such a mark would be independent of language, and would serve to distinguish goods of a certain make, even for the illiterate.

Examples.

Such marks are still frequently employed, and this clause specially includes them. To this class belong the marks of an anchor (*b*), an eagle (*c*), a lion (*d*), an elephant (*d*), a cross (*e*), a pyramid (*f*), a bell (*g*), a hand (*h*), a cock (*i*), a rising sun (*k*), or a triangle (*l*).

A crest.

A crest is just as capable of becoming a trade mark as any other arbitrary device (*m*). In *Beard* v. *Turner* (*n*)

(*a*) As to this Freemasons' emblem, it has been held in the United States that it is so generally appropriated to a special purpose as not to be registrable by a private firm, even in combination: *In re Tolle*, 2 U. S. Pat. Gaz. 415. But this decision was not followed in *In re Thomas*, 14 U. S. Pat. Gaz. 821, or *Ex parte King* (2), 46 U. S. Pat. Gaz. 119, though in *Ex parte Smith* (3), 16 U. S. Pat. Gaz. 764, registration was refused to the word "Masonic."

(*b*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185.

(*c*) *Standish* v. *Whitwell*, 14 W. R. 512.

(*d*) *Henderson* v. *Jorss*, Dig. 198.

(*e*) *Cartier* v. *Carlile*, 31 Beav. 292; *Cartier* v. *Westhead*, Dig. 199; *Cartier* v. *May*, Dig. 200.

(*f*) *Bass* v. *Dawber*, 19 L. T. N. S. 626.

(*g*) *Bell* v. *Bell*, Dig. 514.

(*h*) *Allsopp* v. *Walker*, Dig. 545.

(*i*) *In re Walkden Aërated Waters Co.*, 54 L. J. Ch. 384.

(*k*) *Morse* v. *Worrell*, 10 Phila. 168.

(*l*) *In re Worthington*, 14 Ch. D. 8.

(*m*) In *Steinthal* v. *Samson*, Dig. 546, the trade mark consisted of the crest, arms, and motto of the plaintiff's family. See *Robinson* v. *Finlay*, 9 Ch. D. 487; *Hargreaves* v. *Smith*, Dig. 338; *In re Rosing*, 54 L.J. Ch. 975; *In re Farina* (1), 26 W. R. 261; *In re Farina* (3), Dig. 654; *Godillot* v. *Hazard*, 81 N. Y. 263; *Mackinnon* v. *Thompson*, 5 Can. Leg. News 396, also Instructions, as to royal, national, municipal, &c., arms.

(*n*) 13 L. T. N. S. 746. In *Standish* v. *Whitwell*, 14 W. R. 512, the defendant was restrained from using what he alleged to be his own crest as his trade mark. So in *Mackinnon* v. *Thompson*, 5 Can. Leg. News 396, where the trade mark, consisting of the defendant's name and arms, had been sold to the plaintiff.

Sir W. P. Wood, V.-C., said, "I am not prepared to say or hold that a man putting his crest should not so put it as to establish his right to say, 'Nobody shall use my crest.' It is incumbent on him, as on every plaintiff, to show that the crest is an essential part of his trade mark." The readiest way of proving this is now by reference to the Register of Trade Marks.

Portrait. The portrait of a person whose name has become descriptive of the goods, is not sufficiently distinctive to be registered as a good trade mark (*a*); but the portrait of a public character has been allowed to be registered in America (*b*).

Initials. Before the Trade Marks Act of 1875 a trade mark might consist of initials, either alone or in combination with other ingredients (*c*). Now, however, it would be difficult to assert that initials alone, printed in the usual manner, and without any distinguishing peculiarities of shape, colour, &c., could be described as "a distinctive device, mark, brand, heading, label, or ticket." Where the letters are combined together into the form of a monogram, or enclosed within a distinctive border, or are in any other way used in such a combination as to be distinguishable from the same letters used in the plain ordinary way, it might have been supposed that a device or mark would be constituted capable of registration; but in *Lucke* v. *Webster* (*d*), the late Master of the Rolls, while admitting to registration as an old mark a monogram on a shield, suggested that he could not have done so if it had been a new mark. In the American case of *United States* v. *Marble* (*e*), the Commissioner of Patents considered that the letters "W. G." in a monogram were registrable as a trade mark.

Marks with a Marks which have a mechanical purpose, *e.g.*, to serve

(*a*) *In re Anderson*, 26 Ch. D. 409; 54 L. J. Ch. 1084 (App.).

(*b*) *Ex parte Sullivan & Burke*, 16 U. S. Pat. Gaz. 765; *Ex parte Pace, Talbott & Co.*, *ib.* 909.

(*c*) See p. 83 *infrà*.

(*d*) M. R., April 4th, 1879.

(*e*) 22 U. S. Pat. Gaz. 1366.

mechanical purpose.

as guides for the equal division of the article to which they are applied, cannot deprive other manufacturers of the right to use somewhat similar marks for the same purpose (*a*).

Marks representing the article.

In some American cases it has been held or suggested that a device which represents the article to which it is intended to be applied must be treated as descriptive and incapable of appropriation, in the same way as words which are descriptive of the article to which they are applied are refused recognition as distinctive names. Thus the representation of a pig, attached to packages of lard (*b*), the representation of a fish, for fishing-lines (*c*); the representation of a bed made under a special patent, for beds so made (*d*); the representation of a barrel composed of alternate light and dark staves, for barrels of flour so made up (*e*); the representation of a twig with three leaves and a plum, for medicated prunes (*f*). But there is no English authority in favour of such devices being incapable of appropriation, and it is very doubtful whether the principle would be recognised in this country. In the case of the descriptive name, the right to use it could hardly be separated from the right to make and sell the article; but there is no imperative necessity that every one who has the latter right should also be entitled to sell the article under a mark containing a representation of it. If the trade are entitled to sell the article, and to sell it by its appropriate name, their requirements appear to be satisfied. However, the question would probably be treated as being, to some extent at least, one of degree. In *In re James* (*g*) an application was made for the removal from the register of a trade mark for black lead, which consisted of the representation of a dome-shaped cylinder of black lead, on the

(*a*) *Dausman and Drummond Tobacco Co.* v. *Ruffner*, 15 U. S. Pat. Gaz. 559.

(*b*) *Popham* v. *Wilcox*, 66 N. Y. 69.

(*c*) *In re Pratt & Farmer*, 10 U. S. Pat. Gaz. 866.

(*d*) *Tucker Manufacturing Co.* v. *Boyington*, 9 U. S. Pat. Gaz. 455.

(*e*) *Ex parte Halliday Brothers*, 16 U. S. Pat. Gaz. 500.

(*f*) *Ex parte Smith* (2), 16 U. S. Pat. Gaz. 679.

(*g*) 33 Ch. D. 392.

ground that the trade mark was simply a pictorial description of the goods in the form in which they were usually sold; but the decision of Pearson, J., allowing the application, was reversed by the Court of Appeal. This was principally on the ground that the black lead was not necessarily sold in that shape, and that the mark had sometimes been applied and might properly be applicable to blocks of black lead in any shape; and the Court did not actually decide what would be done if the trade mark had consisted of a pictorial representation of the goods in the only shape in which they could be made, but the inclination of the Court of Appeal would appear to have been rather in the direction above suggested. The Comptroller-General has now signified his intention not to accept as trade marks pictorial representations of the goods to which they are to be applied.

"Heading." *Harter* v. *Souvazoglu.*

In *Harter* v. *Souvazoglu* (*a*) the trade mark consisted of a certain combination of purple, pink, and green threads, nine stripes in three gradations, which were woven as a heading into cotton goods, which were forwarded to the markets of Turkey and the Levant. The owners of this mark having filed a bill for an injunction against a rival trader who had copied the mark, Sir C. Hall, V.-C., held "that a heading could be the subject of a trade mark, that the evidence in the case showed that this heading was distinguished from others in Turkey, and that it had become a trade mark, although it was sometimes associated with stamps on the goods, of the lion and the sun, and other devices. Customers had bought goods because of this particular heading, and he therefore considered that the plaintiffs who had adopted it were entitled to the protection they asked, and that no other persons could use it" (*b*).

(*a*) W. N., 1875, pp. 11-101.

(*b*) And see per Sir G. Jessel, M. R., in *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434. Also *Carver* v. *Bowker*, Dig. 581, and *Robinson* v. *Finlay*, 9 Ch. D. 487, where a heading of coloured threads formed a part of the combination mark, though not mentioned in the report.

Fancy words.

Besides the varieties of marks to which reference has already been made, the third class of registrable trade marks under § 64 of the Patents Act, 1883, before its amendment by the Act of 1888, also included "a fancy word or words not in common use." This was not so under the Trade Marks Registration Act, 1875-7, which entirely excluded fancy words from registration as new marks, and only admitted such as had been used before the Act of 1875. This exclusion was, however, found to cause great annoyance and inconvenience, since a fancy name is of all trade marks the most useful, seeing that it affords so easy a mode of inquiring for and obtaining goods produced by the precise manufacturer whose production is desired. For this reason the use of such words as trade marks has been more general than that of any other description of mark, and during the period of exclusion from registration recourse was had to all kinds of contrivances for obtaining the registration and at least partial protection of fancy names.

Requirements.

For words to be capable of exclusive appropriation under this provision of the Act of 1883, they had to comply with three requirements. First, they had to be fancy words; secondly, they had to be distinctive; and, thirdly, they had to be not in common use. Each of these requirements has been the subject of decision under the Act.

Fancy words defined.

As to what is meant by "a fancy word or fancy words," it was at first very generally supposed, and was so held by Chitty, J. (*a*), and Bacon, V.-C. (*b*), that the term would include any word fancifully applied, such as would have been protected by the Courts irrespective of any registration Act. The Court of Appeal, however, took a more stringent view of the meaning of the phrase, and the

(*a*) *In re Stapley & Smith*, 29 Ch. D. 877.
(*b*) *In re Van Duzer*, 34 Ch. D. 623; *In re Leaf, Sons & Co.*, 34 Ch. D. 632.

effect to be given to it is now ascertained with reasonable clearness. Thus, in the leading case on the subject (*a*), Cotton, L. J., said, "To be registered, the word must be a 'fancy word'; and in order to come within that description it must be a word which obviously cannot have reference to any description or designation of where the article is made, or of what its character is"; and Lindley, L. J., said, "To be a 'fancy word' the word must either have to ordinary English people, to whom the Act is addressed, no meaning, like the word 'Eureka,' or the word 'Aeilyton,' or, if it has any meaning at all, it must be obviously [non-descriptive] (*b*) when used as a trade mark." And Lopes, L. J., added, "A word to be a 'fancy word' must be obviously meaningless as applied to the article in question. It must be a word fanciful in its application to the article to which it is applied, in the sense of being so obviously and notoriously inappropriate as neither to be deceptive nor descriptive, nor calculated to suggest deception or description. Further than that, the word must have an innate and inherent character of fancifulness, which must not depend on evidence, and cannot be supported by evidence, to show that in fact it is neither deceptive nor descriptive, nor calculated to be deceptive or descriptive. A fancy word must speak for itself: it must be a fancy word of its own inherent strength." Again, in *Waterman* v. *Ayres* (*c*), Fry, L. J., after expressing his concurrence in the definitions given above, added further, "That which is the only name of a thing cannot, it seems to me, be a fancy word with regard to it. The word 'spade' describes the thing. You can never take the word 'spade' and call it a fancy word for the thing." And in another case (*d*) Chitty, J., said that, "in reference to an article

(*a*) *In re Van Duzer*, 34 Ch. D. 623.
(*b*) See 34 Ch. D. 645.
(*c*) 39 Ch. D. 29.
(*d*) *In re Davis & Co.*, 59 L. T. N. S. 854.

produced in a foreign country and imported into England, where it was previously unknown and without a name, the word used in that foreign country as the common term to describe or denote the article is not a fancy word within the meaning of the Act."

The effect of these statements has been so to narrow and restrict the meaning of the phrase that in nearly all the cases in which the question of "fancy word" has been brought before the Court the decision has been adverse to the claimant. In fact, in only three cases (*a*), one of which has since been disapproved (*b*), has the word been upheld; whereas in many cases it has been disallowed on the ground of descriptiveness or suggestion of descriptiveness (*c*).

"Distinctive."

As to the requirement that a fancy word shall be distinctive, it seems that the meaning to be placed

(*a*) *In re Stapley & Smith*, 29 Ch. D. 877 ("Alpine" cotton); *Slazenger* v. *Malings*, W. N. 1885, p. 124 ("The Lawford" racquet); *In re Burgoyne*, 61 L. T. N. S. 39 ("Oomoo" wine).

(*b*) *In re Stapley & Smith* in *In re Van Duzer*, 34 Ch. D. 623.

(*c*) Words which have been held not to be "fancy words": *In re Price's Patent Candle Co.*, 27 Ch. D. 681 ("National Sperm" candles); *In re Friedlander*, W. N. 1885, p. 85 ("Zephyr Asiatic Walnut Pipe"); *In re Harden Star &c. Co., Ld.*, 55 L. J. Ch. 596 ("Hand Grenade Fire Extinguisher"); *In re Van Duzer*, 34 Ch. D. 623 ("Melrose Favourite Hair Restorer"); *In re Leaf, Sons & Co.*, 34 Ch. D. 632 ("Electric Velveteen"); *In re Arbenz*, 35 Ch. D. 248 ("Gem" air-guns); *Lever* v. *Goodwin*, 36 Ch. D. 1 ("The Self-Washer"); *Towgood Bros.* v. *Pirie & Sons, Ld.*, 56 L. T. N. S. 394 ("The Jubilee Note" paper); *In re Ainslie & Co.*, 4 P. R. 212 ("Ben Ledi" whiskey); *In re Laing*, L. J. N. of C., 1887, p. 102 ("Glengowrie Blend of Fine Old Highland Whiskey"); *In re Hanson*, 37 Ch. D. 112 ("Red, White, and Blue" label tea); *In re Sanitas Co., Ld.*, 58 L. T. N. S. 166 ("Sanitas" medicines); *In re Waterman*, 39 Ch. D. 29 ("Reversi" game); *In re Davis & Co.*, 59 L. T. N. S. 854 ("Boköl" beer); *Humphries* v. *Taylor Drug Co.* (2), 59 L. T. N. S. 820 ("Herbalin" medicine); *In re Californian Fig Syrup Co.*, 40 Ch. D. 620 ("Syrup of Figs"); *In re Jackson & Co.*, 60 L. T. N. S. 93 ("Kokoko" cotton piece goods); *In re Thompson & Co.*, 6 P. R. 213 ("Manor" tin plates); *In re Grossmith*, 60 L. T. N. S. 612 ("Emollio" toilet cream); *Great Tower Street Tea Co.* v. *Smith*, 6 P. R. 165 ("Tower Tea"); *Burland & Co.* v. *Broxburn Oil Co., Ld.* (2), 42 Ch. D. 274 ("Washerine" soap); *In re Vignier*, 6 P. R. 490 ("Monobrut" champagne); *In re Batt & Co.*, 6 P. R. 493 ("The Brymbo Special" iron); *In re Hannay*, 7 P. R. 46 ("Electroid" anti-fouling composition"); *Stuart & Co.* v. *Scottish Val de Travers Paving Co., Ld.*, Ct. Sess. Cas., 4th Ser XIII., 1 ("Granolithic" artificial stone).

upon this is that the word must be one which serves to distinguish the goods of one maker or dealer from the goods of all others (*a*), and that it cannot be distinctive if a word of similar sound, though different in spelling, is in use in the trade (*b*).

"Not in common use."

The further requirement that fancy words shall be "not in common use" has been interpreted by Chitty, J. (*c*), to mean that they must not be in common use in the trade with respect to which it is sought to appropriate them; and though other judges have rather avoided expressing an opinion as to the meaning of the phrase, it would appear that this is the true meaning to be attached to it. The fact that a word may have been generally used and have acquired a descriptive signification in one trade may well leave it "obviously meaningless" in another. In Scotland, Lord Craighill (*d*) seems to have taken substantially the same view as Chitty, J., for he says that the term "'common use,' as employed in the statute, does not necessarily import that the word must have been used commonly by all members of the community, or by people in all parts of the country. What is enough, in my opinion, to establish common use, in the sense of the statute, is this: if it shall be shown that the word has been commonly used by persons who had occasion to use it, and who are connected more or less directly with the use of the commodity to which the word has been applied."

Fourth class of trade marks.—Invented words.

The fourth class of marks comprises "an invented word or invented words," to which, as in other cases, additions may be made. The introduction of this expression into

(*a*) See *Wood* v. *Lambert*, 32 Ch. D. 257; *Waterman* v. *Ayres*, 39 Ch. D. 29; *In re Jackson & Co.*, 60 L. T. N. S. 93.

(*b*) Per Kay, J., in *In re Jackson & Co.*, 60 L. T. N. S. 93.

(*c*) *In re Stapley & Smith*, 29 Ch. D. 877; *In re Burgoyne*, 61 L. T. N. S. 39. Compare *Great Tower Street Tea Co.* v. *Smith*, 6 P. R. 165.

(*d*) In *Stuart & Co.* v. *Scottish Val de Travers Paving Co., Ld.*, Ct. Sess. Cas., 4th Ser. XIII. 1.

the Act appears to be intended to bring within its scope, and to render registrable as new marks, such words as "Washerine" (*a*) and "Monobrut" (*b*), which were rejected as fancy words, or as "Pectorine" (*c*), "Lacto-peptine" (*d*), "Valvoline" (*e*), which were not submitted to that test. It has, however, been held that "Satinine" was not registrable for starch, soap, blue, and similar goods, as being descriptive of the effect produced (*f*).

Fifth class of trade marks.—Non-descriptive words.

The fifth class of marks comprises "a word or words having no reference to the character or quality of the goods, and not being a geographical name, with or without additions." This seems designed to include such terms as "Pharaoh's Serpents" toys (*g*), "United Service" soap (*h*), and "Charter Oak" stoves (*i*). Geographical words remain excluded, as they had already been under the meaning given by the Courts to the term "fancy words."

Sixth class of trade marks.—Old marks.

Marks which come within any of the above five classes are capable of registration, whether they were used before the passing of the Trade Marks Registration Act, 1875, or not; but many valuable trade marks adopted and used before any precise definition was provided are not included in any of these five classes, and would consequently be deprived of the benefits of the Act, unless some special provision were made for their protection. To meet this case it is provided, by § 64 (3) (ii), that "any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures, used as a trade mark before the 13th day of August, 1875, may be registered as a trade mark under this part of this Act."

(*a*) *Burland & Co.* v. *Broxburn Oil Co., Ld.* (2), 42 Ch. D. 274.
(*b*) *In re Vignier*, 6 P. R. 490.
(*c*) *Smith* v. *Mason*, W. N. 1875, p. 62.
(*d*) *Carnrick* v. *Morson*, L. J. N. of C. 1877, p. 71.
(*e*) *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288.
(*f*) *In re Meyerstein & Co.*, 43 Ch. D. 604.
(*g*) *Barnett* v. *Leuchars*, 13 L. T. N. S. 495.
(*h*) *Field* v. *Lewis*, Seton, 4th Ed. 237.
(*i*) *Filley* v. *Fassett*, 44 Mo. 173.

Old word-marks.

By far the most important description of marks included in this class is that defined as "any special and distinctive word or words used as a trade mark before the 13th day of August, 1875," which brings within the scope of the Act the numerous varieties of words which were used as old marks, whether they come within the definitions applicable to new marks or not. With respect to them, two conditions are prescribed. First, the word or words must be "special and distinctive"; and, secondly, they must have been used as a trade mark before the passing of the Act of 1875.

"Used as a trade mark."

Passing over for the moment the question what words can be properly regarded as special and distinctive, it seems convenient first to consider here the further requirement that the word or words shall have been "used as a trade mark before the 13th day of August, 1875," a requirement which, it will be observed, applies also to the other varieties of old marks comprised in § 64 (3) (ii). There must, then, have been user of the word or other mark before August 13th, 1875, and such user must have been user as a trade mark, and not as a descriptive term relating to the character or pattern of the goods or the like (*a*). The word or other mark must have been used *per se*, and not as part of a mark which included other elements (*b*); and if it has always been used with such other elements, it cannot, apart from them, be claimed as an old mark, even though in some cases some of the elements comprising the entire trade mark have been used on one side of the article and the remainder on the other side (*c*). Moreover, it is not sufficient that there has been user on price lists, bill heads, or other trade documents; for user as a trade mark there must have

(*a*) *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288; *In re Harrison, M'Gregor & Co.*, 42 Ch. D. 691.

(*b*) *In re Palmer* (3), 24 Ch. D. 504; *In re Royal Baking Powder Co.*, W. N. 1880, p. 49; *In re Hayward & Sons*, 54 L. J. Ch. 1003; *In re Chorlton & Dugdale*, 53 L. T. N. S. 337; *In re Perry Davis & Son*, 58 L. T. N. S. 695; *In re Grossmith*, 60 L. T. N. S. 612; *In re Dunn*, 41 Ch. D. 439.

(*c*) *In re Spencer*, 54 L. T. N. S. 659.

been user on the goods themselves (*a*), or on the boxes or wrappers containing them (*b*),—though slight user is sufficient (*c*), unless the claim is for registration under the three-mark rule (*d*),—and the user before August 13th, 1875, must have been within the United Kingdom; for foreign user is immaterial (*e*), and the mere passage through England of marked goods, without any sale or exposure for sale, is not user of the mark (*f*). And even if all these conditions have been complied with, the old user only gives a right to registration in respect of the goods with relation to which the old user existed, and not to registration as an old mark in respect of any other goods (*g*).

"Special and distinctive."

As to the requirement that the word or words shall be "special and distinctive," it has been said by an Irish judge (*h*) that "special" means that the words must not ordinarily be applied to goods of the class in respect of which they are used, and that "distinctive" means that they must be suitable for distinguishing the particular goods as to which they are used from other goods of the same class. And in *Wood* v. *Lambert* (*i*), Fry, L. J., said, "It appears to me that to satisfy the requirements of the definition (*k*), the word or words must be distinctive

(*a*) *In re Palmer* (3), 24 Ch. D. 504; *In re Chorlton* v. *Dugdale*, 53 L. T. N. S. 337; *In re Perry Davis & Son*, 58 L. T. N. S. 695; *Thompson* v. *Montgomery*, 41 Ch. D. 35.

(*b*) *Jay* v. *Ladler*, 40 Ch. D. 649.

(*c*) *In re Chorlton & Dugdale*, 53 L. T. N. S. 337.

(*d*) *In re Hodson & Co.*, 26 Sol. J. 43.

(*e*) *In re Münch*, 50 L. T. N. S. 12; *In re Riviere & Co.*, 26 Ch. D. 48; *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288 (per Fry, L. J.); *Berliner Brauerei Gesellschaft Tivoli* v. *Knight, Stocks & Co.*, W. N. 1883, p. 70; *Jackson & Co.* v. *Napper*, 35 Ch. D. 162; *Smith* v. *Fair*, 14 Ont. Rep. 729. But see *In re Eastman*, W. N. 1880, p. 128.

(*f*) *Jackson & Co.* v. *Napper*, 35 Ch. D. 162; *Newman* v. *Pinto*, 57 L. T. N. S. 31 (per Kekewich, J.).

(*g*) *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *Edwards* v. *Dennis*, 30 Ch. D. 454, and see per Pearson, J., in *In re Lyndon*, 32 Ch. D. 109.

(*h*) Chatterton, V.-C. of I., in *Bodega Co., Ld.* v. *Owens*, 23 L. R. Ir. 371.

(*i*) 32 Ch. D. 247.

(*k*) The definition there referred to is that contained in T. M. A. 1875, § 10 (3), with which, for this purpose, the present words are identical.

in this sense, that they distinguish the manufacture of the person who has registered the trade mark from the manufacture of all other persons. I say 'manufacture,' but of course there may be cases in which they distinguish, not the manufacture, but the selection, or some other operation upon the goods. But in all cases the word or words must distinguish the product of the person claiming the trade mark from the product of all other persons, and it appears to me that it must have that distinctive character at the time of the registration" (*a*). And in the same case Lindley, L. J., said, "What is meant by a 'distinctive' trade mark? It must mean some mark which distinguishes the goods to which it is attached as those made or sold by the person who uses the mark." So in *In re Perry Davis & Son* (*b*) Lopes, L. J., stated that "the authorities are clear to show that it" (*i.e.*, a word claimed as an old mark) "must be a word distinguishing the article manufactured by one person from a similar article manufactured by another person, and not a word that is merely descriptive of the article itself" (*c*).

Wood v. *Lambert.*

In *Wood* v. *Lambert* (*d*) the word "Eton," which was registered as a trade mark by the plaintiffs, had been habitually used by them in conjunction with names of imaginary firms; and the Court of Appeal held that such user had destroyed whatever distinctiveness the word might otherwise have possessed. Fry, L. J., in whose views the other Lords Justices concurred, laid down that "when a person uses a name and represents that name to be applicable to the product of a manufacturer or manufacturers other than himself, so as to induce the belief that the goods are the manufacture of that third person or persons, he cannot say that the word is distinctive

(*a*) This definition Fry, L. J., repeated in substance in *In re Perry Davis & Son*, 58 L. T. N. S. 695.

(*b*) 58 L. T. N. S. 695.

(*c*) And see per Fry, L. J., in *Waterman* v. *Ayres*, 39 Ch. D. 29.

(*d*) 32 Ch. D. 247.

of his own manufacture. Nor do I think that that principle applies the less because the plaintiff may be false in the assertion that there is any such firm or firms as the manufacturer represents. He who has made the goods has taken upon himself to represent two things: in the first place, that they are not his manufacture, but somebody else's; in the second place, that a firm exists which does not exist at all."

Leniency of courts.

In the majority of the cases in which the validity and right to registration of a word claimed as an old mark has been considered, the question has turned on the user or non-user as a trade mark before the 13th August, 1875; but when the question has turned on the words being distinctive or otherwise, the Courts have shown themselves far more leniently disposed than in the case of "fancy words," and words which must have been refused registration as "fancy words" have been recognised as registrable in the character of "special and distinctive words" (*a*). In fact, in some of these cases the words have been so far descriptive as to cause a reasonable doubt whether the leniency shown was not excessive.

Descriptiveness fatal.

Although there may be questions as to the application of the principle in particular cases, there can be no doubt that, as was clearly laid down in *Wood* v. *Lambert* (*b*), descriptiveness is fatal to a word claimed as an old trade

(*a*) The following words have been recognised as special and distinctive words: *Reinhardt* v. *Spalding*, 49 L. J. Ch. 57 ("Family Salve"); *Talbot* v. *Webley*, 3 P. R. 276 ("Baffle" stoves); *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288 ("Valvoline" oil); (but compare *In re Horsburgh*, 53 L. J. Ch. 237); *In re Eastman*, W. N. 1880, p. 128 ("Kitchen Crystal Soap"); *Blair* v. *Stock*, 52 L. T. N. S. 123 ("Strathmore" whiskey); *Compania General de Tabacos* v. *Rehder & Co.*, 5 P. R. 61 ("Cavite" cigars); *Free Fishers and Dredgers of Whitstable* v. *Elliott*, W. N. 1888, p. 27 ("Whitstable native oysters"); *B. Edgington, Ld.* v. *J. Edgington & Co.*, 6 P. R. 513 ("Frigi Domo" canvas); and see *Evans* v. *Smith*, 3 Times L. R. 390 ("Montserrat" lime-juice); *In re Grossmith*, 60 L. T. N. S. 612 ("Emollio" toilet cream); *Thompson* v. *Montgomery*, 41 Ch. D. 35 ("Stone Ales"). In *In re Perry Davis & Son*, 58 L. T. N. S. 695, the term "Pain-Killer" medicines seems to have been thought too descriptive, though there were other reasons for invalidating the trade mark.

(*b*) 32 Ch. D. 247.

mark, though it will not be invalidated for such a mere suggestion or suspicion of descriptiveness as has in some instances proved fatal to words claimed as "fancy words" (*a*) The intention of the proviso admitting old word marks to registration is evidently to give protection to words used as trade marks, and which would have been protected as such before the first Trade Marks Registration Act; and it may probably be said that words which would have been recognised as trade marks before 1875 will now be recognised as coming within the statutory proviso in favour of old marks.

Descriptive words.

It appears, then, that a word may be purely descriptive, that is to say, it may express accurately and appropriately the material or mode of composition of the goods to which it is affixed, and unless the exclusive manufacture of such goods is protected by a patent, and the same result cannot be attained without infringement of the patent, all the world has the right to make and sell such goods; and further, when the goods are manufactured and in course of sale, not only has the right, but is in duty bound to describe them, for the proper information and protection of the public, in such manner as will convey the most correct idea. Hence the original maker can claim no exclusive right in the properly descriptive name; nor would it be in accordance with the principles of equity that he should be able to do so, for, as was well said by Mr. Justice Strong, in the Supreme Court of the United States (*b*), "Equity will not enjoin against telling the truth."

Young v. *Macrae*.

The reasoning of Wood, V.-C., in *Young* v. *Macrae* (*c*), affords a good example of the just way of considering cases of this description. In that case the plaintiffs,

(*a*) *E.g.*, in *Waterman* v. *Ayres*, 39 Ch. D. 29; *In re Sanitas Co., Ld.*, 58 L. T. N. S. 166; *Burland & Co.* v. *Broxburn Oil Co., Ld.* (2), 42 Ch D. 274; *In re Vignier*, 61 L. T. N. S. 495; *Stuart & Co.* v. *Scottish Val de Travers Paving Co., Ld.*, Ct. Sess. Cas., 4th Ser. XIII. 1.

(*b*) *Canal Co.* v. *Clark*, 13 Wall. 311

(*c*) 9 Jur. N. S. 322.

who held a patent for manufacturing a kind of oil which they called "Paraffin oil," filed a bill against the defendant, who sold a substance which he styled "Kerosene oil," or "American Paraffin oil." The case coming on on motion for injunction, the Vice-Chancellor said, "In the patent the process is described as 'a distillation of coal so as to obtain oil containing paraffin, and from this oil I obtain paraffin.' So he calls it paraffin oil because it contains paraffin. Here is a well-known substance called 'paraffin.' A chemist discovers that by the same process by which paraffin is produced, an oil containing paraffin, and from which paraffin can again be produced, is obtainable. Therefore, it being an oil containing paraffin, and producing paraffin, he calls it 'paraffin oil.' It is not a fanciful or whimsical name, but it describes the thing which he has produced. A man cannot take out a patent for a natural substance, but he can take out a patent for arriving at that natural substance, and he may christen it, putting aside all other people, having called it by that name." The Vice-Chancellor then put the case of a man extracting sugar from beet-root by a patented process, and calling the extract "beet-root sugar" for a period of ten years. In such a case, when beet-root sugar was asked for, it would be known that his was meant, because he was the only man who made it. "The name," the Vice-Chancellor said, "does not become a trade mark, but it gets fixed to his sugar simply because nobody else could make it. Then, suppose that another man found out another method of making sugar from beet-root, and so extracted it, not wanting to patent it, and described it as 'beet-root sugar,' may he not call it 'beet-root sugar' because the other gentleman for ten years has been the manufacturer of it, and sold it as such? I think the question of the fancifulness of the name is a question whether it is taken by way of trade mark or not. All he (*i.e.* the plaintiff) has done here is this: he has found out an article which is

a natural product, and he has given that natural product a name." "This is not like the case of the 'Medicated Mexican Balm,' which is a name extravagantly ridiculous. I therefore should not assume *mala fides* against a person who calls the thing what it is. It is paraffin and it is oil, therefore paraffin oil. There is paraffin in it, and paraffin to be obtained from it, and it is American." Injunction refused.

In a later case (*a*) the same Vice-Chancellor referred to the above case of *Young* v. *Macrae* (*b*), and remarked that "if the evidence had gone to show that the plaintiff had been the first to apply the name 'paraffin' to the oil, he would have granted an injunction (*c*); but that he had there had it proved that the name 'paraffin oil' had long been known as the scientific name of the article, and that the defendant could not well have called it anything else."

Name become *publici juris.*

Again, a word which was first applied to, or was even invented for the sole and express purpose of designating a substance or composition may prove, on investigation, to have ceased to retain the characteristic, which it once possessed, of conveying the idea of the goods being of a particular manufacture; in which case the person who first used the word, though its inventor, will cease to have any exclusive rights in it, since it will have become purely descriptive of an article which all may freely make (*d*). The name thus becomes *publici juris*, and

(*a*) *Braham* v. *Bustard*, 1 H. & M. 447.

(*b*) 9 Jur. N. S. 322.

(*c*) So in *Eno* v. *Stephens*, Dig. 609, the term "Fruit Salt" was protected at the instance of the person who was the first to use it; but compare *In re Eno*, 41 Ch. D. 439, and see *Siegert* v. *Findlater*, 7 Ch. D. 801; *Linoleum Manufacturing Co.* v. *Nairn*, 7 Ch. D. 834; and *Canal Co.* v. *Clark*, 13 Wall. 311, as to a name which is appropriated to an article.

(*d*) *E.g.*, "Worcestershire Sauce" —*Lea* v. *Millar*, Dig. 513; *Lea* v. *Deakin*, 11 Biss. 23; "Gem" airguns, *In re Arbenz*, 35 Ch. D. 248; "Neva Stearine" candles, *Neva Stearine Co.* v. *Mowling*, 9 Vict. L. R. 98; "Calhoun Plough," *In re Hall & Co.*, 13 U. S. Pat. Gaz. 229; "Holbrook's School Appuratus," *Sherwood* v. *Andrews*, 3 Am. L. Reg. N. S. 538.

not only can be, but ought to be, employed by all who manufacture and sell an article which they are at perfect liberty to manufacture and sell, and of which the name in question is generally recognised as the appropriate designation. This point is well stated by Lord Selborne, C., in *Singer Manufacturing Co.* v. *Loog* (3) (*a*), where he says, "The reputation acquired by machines of a particular form or construction is one thing; the reputation of the plaintiffs, as manufacturers, is another. If the defendant has no right under colour of the former to invade the latter, neither have the plaintiffs any right under colour of the latter to claim (in effect) a monopoly of the former. If the defendant has a right to make and sell, in competition with the plaintiffs, articles similar in form and construction to those made and sold by the plaintiffs, he must also have a right to say that he does so, and to employ for that purpose the terminology common in his trade, provided always that he does this in a fair, distinct and unequivocal way."

Effect of registration.

The registration as a trade mark of a name of this description will somewhat complicate the question, as registration of a trade mark is *primâ-facie* evidence, and, after five years' registration, conclusive evidence of the right of the registered owner to the exclusive use of such trade mark (*b*); but the wording of the Act is entirely directed to the registration of "a trade mark," the exclusive use of "a trade mark," &c., and since a name which has become *publici juris*, whether registered or not, cannot be a "trade mark" within the definition section of the Act, because it contains nothing distinctive, it seems that, at all events within the five years, this enactment does not preclude a defence on the ground that the name so registered is in fact no trade mark, and was registered, or is continued on the register, by error. However,

(*a*) 8 App. Cas. 27; and see per Mellish, L. J., in *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434-56,

(*b*) Patents Act, 1883, § 76.

whether that be so or not, it has been repeatedly decided that five years' registration cannot protect a mark which has been registered as a trade mark, but is invalid by reason of its being descriptive or otherwise, from being removed from the register (*a*); and the remarks of Mellish, L. J., in *Ford* v. *Foster* (*b*), appear to be equally applicable since the Act as before it. "There is no doubt, I think, that a word which was originally a trade mark, to the exclusive use of which a particular trader, or his successor in trade, may have been entitled, may subsequently become *publici juris*, as in the case which has been instanced of Harvey's Sauce (*c*). Then, what is the test by which a decision is to be arrived at whether a word which was originally a trade mark has become *publici juris*? I think the test must be, whether the use of it by other persons is still calculated to deceive the public, whether it may still have the effect of inducing the public to buy goods not made by the original owner of the trade mark as if they were his goods. If the mark has come to be so public and in such universal use that nobody can be deceived by the use of it, or can be induced from the use of it to believe that he is buying the goods of the original trader, it appears to me, however hard to some extent it may appear on the trader, yet practically, as the right to a trade mark is simply a right to prevent a trader from being cheated by other persons' goods being sold as his

(*a*) *In re Palmer* (1) and (3), 21 Ch. D. 47; 24 *ib.* 504; *In re Lloyd & Sons*, 27 Ch. D. 646; *Edwards* v. *Dennis*, 30 Ch. D. 454; *In re Wragg*, 29 Ch. D. 551; *Wood* v. *Lambert*, 32 Ch. D. 247; *In re Spencer*, 54 L. T. N. S. 659. And it has been so held also in Victoria: *Lewis* v. *Klapproth*, 11 Vict. L. R. 214; *Wolfe* v. *Alsop* (2), 12 Vict. L. R. 421; *Wolfe* v. *Lang & Co.*, 13 Vict. L. R. 752. The wisest course to take in such a case is no doubt to apply to rectify the register by the removal of the offending mark—*e.g.*, *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288.

(*b*) L. R. 7 Ch. 611.

(*c*) With respect to this example, an injunction was granted by Sir J. Romilly, M. R., in 1858, to restrain a representation that the defendant's sauce was that of the inventor's successor in business. See *Lazenby* v. *Lazenby*, Dig. 160. But in *Lazenby* v. *White*, 41 L. J. Ch. 354, it was admitted that the name was common to the trade.

goods through the fraudulent use of the trade mark, the right to the trade mark must be gone" (*a*).

The three-mark rule.

When the Trade Marks Registration Act, 1875, first came into operation, it was found that in many trades application was made by two or more traders for the registration of substantially identical marks—the fact being that the marks had not previously come into collision on account of their being used in different parts of the country—without any suspicion of want of *bona fides* on the part of any of the rival applicants. If the strict letter of the Act and Rules had been adhered to, much injustice would have been done to the later applicants, whose applications must have been refused; and the Commissioners of Patents therefore framed the rule that identical or similar *old* marks—*i.e.*, marks used before the 13th August, 1875—might be registered by different persons in the same trade up to the number of three, but not more; the rule providing that if the mark had been used *bonâ fide* by more than three persons it must be treated as common to the trade, and no registration at all be allowed. This rule was recognised by Courts of First Instance in numerous cases (*b*); and in one case (*c*) three substantially identical marks, of which two were old and one was new, and in another case (*d*) three substantially identical *new* marks, were allowed to be registered for the same goods by different traders with consent of all the parties concerned. A provision derived from this rule is now to be found in § 74 of the Patents Act, 1883, by which it is enacted that any device which

(*a*) For instances of marks proved to be common to particular trades see Note (*c*) to § 74 of the Patents Act, 1883, *infra*.

(*b*) *In re Walkden Co.*, 54 L. J. Ch. 394; *In re Powell*, Dig. 589; *In re Hyde & Co.*, 54 L. J. Ch. 395; *In re Leonardt*, Dig. 610; *In re Mitchell* (2), Dig. 611; *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *Ex parte Sales, Pollard & Co.*, Dig. 620; *In re Kuhn & Co.*, 53 L. J. Ch. 238; *In re Brook*, 26 W. R. 791; *In re Hudson & Co.*, 26 Sol. J. 43; *Benbow* v. *Low* (4), 44 L. T. N. S. 875; *In re Sove & Fleming Manufacturing Co.*, 30 Ch. D. 505; *Jackson & Co.* v. *Napper*, 35 Ch. D. 162; *In re Bancroft & Co.*, 5 P. R. 209.

(*c*) *In re Walkden Co.*, 54 L. J. Ch. 394.

(*d*) *In re Vergaraz*, V.-C. H., June 3rd, 1881.

was before August 13th, 1875, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of the section (*i.e.*, for the purpose of registration as an addition to a trade mark, exclusive rights therein being disclaimed) be deemed common to the trade in such goods (*a*).

Name indicative of a principle of construction.

In the majority of cases in which the question has been raised whether a word was descriptive of the article to which it was applied, or distinctive of the maker by whom that article was made, the question has been whether the word, according to the ordinary usage of the English language, indicated correctly the nature or origin of the article. Thus, "Porous Plasters" (*b*), "Croup Tincture" (*c*), and so on. But in a considerable number of instances the question has been whether a word, which had no descriptive signification to persons unacquainted with the particular trade, did or did not indicate to persons versed in the trade an article prepared according to a definite process, or a machine constructed on a definite principle, the rule being that if the word indicates such a process or principle it is descriptive and incapable of exclusive appropriation.

Articles made according to a patented process.

This difficulty has especially arisen with respect to articles made under a patent, which can only be made by the patentee during the existence of the patent, and to which, consequently, his name or some other special name usually becomes attached. "Where a patented article is known in the market by any specific designation, whether of the name of the patentee or otherwise, every person at the expiration of the patent has a right to manufacture and vend the same under the designation thereof by which it was known to the public. . . . . The original patentee or his assignees have no right to the exclusive

(*a*) Common user is not proved by the books containing applications for registration: *Orr-Ewing & Co.* v. *Johnston & Co.*, 13 Ch. D. 434.

(*b*) *In re Brandreth*, Dig. 626.

(*c*) *In re Roach*, 10 U. S. Pat. Gaz. 333.

use of the designation as a trade mark. Their rights were under the patent, and expired with it" (*a*).

The sewing-machine cases.

Thus, in the case of *The Wheeler & Wilson Manufacturing Co.* v. *Shakespeare* (*b*), James, V.-C., and in that of *The Singer Manufacturing Co.* v. *Wilson* (*c*), Jessel, M. R. (affirmed by the Court of Appeal), refused to assist an attempt at continuing the monopoly in sewing machines which had been patented, after the expiration of the patent, by a claim to the exclusive use, by way of trade mark, of the name by which the peculiar principle of construction had come to be generally known. In the latter case the House of Lords declined to decide whether the name "Singer" was indicative of a maker or of a principle of construction, the defendant's evidence being incomplete; but it was assumed that if the latter had been proved, the defendant would have succeeded (*d*), and that result actually took place in *Singer Manufacturing Co.* v. *Loog* (3) (*e*). So in America, in *Singer Manufacturing Co.* v. *Larsen* (*f*), *Singer Manufacturing Co.* v. *Stanage* (*g*),

(*a*) Per Treat, J., in *Singer Manufacturing Co.* v. *Stanage*, 2 McCrary 512; and see *Edelsten* v. *Vick*, 11 Hare, 78; *Young* v. *Macrae*, 9 Jur. N. S. 322; *Green* v. *Rooke*, W. N., 1872, p. 49; *Liebig's Extract of Meat Co.* v. *Hanbury*, 17 L. T. N. S. 298; *Same* v. *Anderson*, W. N., 1883, p. 185; *Lazenby* v. *White*, 41 L. J. Ch. 354; *Condy* v. *Mitchell*, 37 L. T. N. S. 766; *James* v. *James*, L. R. 13 Eq. 421; *Cheavin* v. *Walker*, 5 Ch. D. 850; *Massam* v. *Thorley's Cattle Food Co.* (1), 6 Ch. D. 574; *Siegert* v. *Findlater*, 7 Ch. D. 801; *Linoleum Manufacturing Co.* v. *Nairn*, 7 Ch. D. 834; *In re Ralph*, 25 Ch. D. 194; *In re Leonard & Ellis*, 26 Ch. D. 288; per Cotton, L. J.; *Native Guano Co., Ld.* v. *Sewage Manure Co.*, 4 Times L. R. 372; *In re Richardson*, 3 U. S. Pat. Gaz. 120; *Tucker Manufacturing Co.* v. *Boyington*, 9 U. S. Pat. Gaz. 455; *Canal Co.* v. *Clark*, 13 Wall. 323, per Strong, J.; *In re Kane & Co.*, 9 U. S. Pat. Gaz. 105; *In re Consolidated Fruit Jar Co.*, 14 U. S. Pat. Gaz. 269; *Ex parte Consolidated Fruit Jar Co.*, 16 *ib.* 679; *Fairbanks* v. *Jacobus*, 14 Bl. C. C. 337; *Burton* v. *Stratton*, 12 Fed. Rep. 696; *Green* v. *Woodhouse*, 38 U. S. Pat. Gaz. 1491; *Galley* v. *Colt's Patent Fire Arms Manufacturing Co.*, 30 Fed. Rep. 118; *Goodyear Rubber Co.* v. *Goodyear India Rubber Glove Manufacturing Co.*, 128 U. S. Rep. 598; *Adee* v. *Peck Bros. & Co.*, 48 U. S. Pat. Gaz. 823; *Leclanche Battery Co.* v. *Western Electric Co.*, 21 Fed. Rep. 538; *Goodyear Rubber Co.* v. *Day*, 22 Fed. Rep. 44. See *In re Eastman*, W. N. 1880, p. 128, in which registration was granted to a name which had been used for soap made under a patent.

(*b*) 39 L. J. Ch. 36.
(*c*) 2 Ch. D. 434.
(*d*) 3 App. Cas. 376.
(*e*) 8 *ib.* 15.
(*f*) 8 Biss. 181.
(*g*) 2 McCrary, 512.

Singer Manufacturing Co. v. *Riley* (*a*), and *Brill* v. *Singer Manufacturing Co.* (*b*), though in the earlier Scotch case of *Singer Manufacturing Co.* v. *Kimball & Morton* (*c*), the decision was in favour of the company. Where, during the continuance of a patent granted to one Foley the defendants had made articles in accordance with the patent and called them "Foley's Patent Valves," it was held in America that they had infringed the patent, but not any trade-mark rights (*d*).

And it has further been decided in America that a patented instrument for distinguishing a manufacturer's goods—*e.g.*, a special tin tag or ticket—cannot be recognised as a trade mark during the continuance of the patent (*e*), and that the special shape of an article made under a patent is similarly incapable of individual appropriation (*f*).

New name for new article.

And even where no patent is obtained, "it is to be observed that the person who produces a new article, and is the sole maker of it, has the greatest difficulty (if it is not an impossibility) in claiming the name of that article as his own, because, until somebody else produces the same article, there is nothing to distinguish it from" (*g*). Thus it was held by the Court of Appeal that a firm who invented a new description of oil, and called it "Valvoline," had no right of trade mark in the word (*h*); and so where the word "Albion" had been used to indicate metal goods of a particular pattern, and not to indicate a particular manufacturer (*i*). But where the article is not

(*a*) 11 Fed. Rep. 706.

(*b*) 41 Ohio St. 127.

(*c*) Ct. Sess. Cas., 3rd Ser. XI., 267.

(*d*) *Adee* v. *Peck Bros. & Co.*, 48 U. S. Pat. Gaz. 823.

(*e*) *Lorillard* v. *Pride*, 28 Fed. Rep. 434.

(*f*) *Wilcox & Gibbs Sewing Machine Co.* v. *Gibbon's Frame*, 21 Bl. C. C. 431; *Brill* v. *Singer Manufacturing Co.*, 41 Ohio St. 127.

(*g*) Per Fry, J., in *Siegert* v. *Findlater*, 7 Ch. D. 801; and see *Linoleum Manufacturing Co.* v. *Nairn*, *ib.* 834; and *Waterman* v. *Ayres*, 39 Ch. D. 29. So also in United States: *Leclanche Battery Co.* v. *Western Electric Co.*, 21 Fed. Rep. 538; and New Zealand: *Marshall* v. *Hawkins*, 4 N. Z. L. R. Sup. Ct. 59.

(*h*) *In re Leonard & Ellis*, 26 Ch. D. 288. See *Leonard & Ellis* v. *White's Golden Lubricator Co.*, 48 U. S. Pat. Gaz. 1401.

(*i*) *In re Harrison, M'Gregor & Co.*, 42 Ch. D. 691.

a new article, but only an improved form of an old article, the same considerations do not apply (*a*).

Actual fraud.

Of course, in any case which arises, any element of actual intentional fraud will be taken into consideration, and the Court will, in the exercise of its general jurisdiction for the repression of fraud, award an injunction or damages in a case in which, but for the fraud, no remedy would have been given. Thus, for instance, in a case in which the infringer might have taken with impunity the name of an article invented by another, but, not content with so doing, described his own manufacture as "the original" article, he was restrained by injunction from the use of that misleading epithet (*b*).

Name merely descriptive cannot be protected.

The general principle, however, is that where a name used by way of a trade mark either was originally, or has since come to be, merely descriptive of the article to which it is attached, so that while serving to indicate what the article is, it does not serve to connect it with any particular manufacturer or manufacturing establishment, that name cannot be protected as a trade mark (*c*) or registered as special and distinctive. The Act establishing registration "takes nothing away from

(*a*) *Barlow & Jones, Ld.* v. *Johnson & Co.*; 34 Sol. J. 298; affirmed by C. A., W. N. 1890, p. 110.

(*b*) *Cocks* v. *Chandler*, L. R. 11 Eq. 446. The presumption of fraud may, however, be refuted, as by a fair statement of the maker's own name: *Browne* v. *Freeman*, 12 W. R. 305.

Descriptive words.

(*c*) The following are cases in which words have been held to be descriptive:—*Thomson* v. *Winchester*, 19 Pick. 214 ("Thomsonian Medicines"); *Fetridge* v. *Wells*, R. Cox, 180 ("Balm of Thousand Flowers"); *Wolfe* v. *Goulard*, 18 How. Pr. 64 ("Schiedam Schnapps"); *Burke* v. *Cassin*, 45 Cal. 467 (do.); *Wolfe* v. *Hart*, 4 Vict. L. R. Eq. 125 (do.); *Wolfe* v. *Alsop* (1), 10 Vict. L. R. Eq. 41 (do.); (2) 12 Vict. L. R. 421 (do.); *Wolfe* v. *Lang & Co.*, 13 Vict. L. R. 752 (do.); *Corwin* v. *Daly*, 7 Bos. 222 ("Club House Gin"); *Young* v. *Macrae*, 9 Jur. N. S. 322 ("Paraffin Oil"); *Phalon* v. *Wright*, 5 Phila. 464 ("Extract of Night-Blooming Cereus"); *Binninger* v. *Wattles*, 28 How. Pr. 206 ("Old London Dock Gin"); *Liebig's Extract of Meat Co.* v. *Hanbury*, 17 L. T. N. S. 298 ("Liebig's Extract of Meat"); *Same* v. *Anderson*, W. N. 1883, p. 185 (do.); *Caswell* v. *Davis*, 58 N. Y. 223 ("Ferrophosphorated Elixir of Calisaya Bark"); *Town* v. *Stetson*, 4 Abb. Pr. N. S. 218 ("Desiccated Codfish"); *Canal Co.* v. *Clark*, 13 Wall. 311 ("Lackawanna" coal); *Choynski* v. *Cohen*, 39 Cal. 501 ("Antiquarian Book Store"); *Gray* v. *Koch*, 2 Mich. N. P. 119 ("Mammoth Wardrobe"); *In re Hauthaway* (1 and

anybody. It confers, upon certain conditions and under particular circumstances, rights which, but for the Act of Parliament, would not be as clearly asserted, but it takes

2), U. S. Pat. Comm. Decis. 1871, 97, 284 ("Beeswax Oil"); *In re Roberts* (4), *ib.* 100 ("Razor Steel"); *In re Blakeslee & Co.*, *ib.* 284 ("Cundurango Ointment. C. O."); *Ex parte Palmer*, *ib.* 289 ("Invisible Face Powder"); *Rowland* v. *Breidenbach*, Dig. 386 ("Macassar" oil); *James* v. *James*, L. R. 13 Eq. 421 ("Lieut. James' Horse Blister"); *Green* v. *Rooke*, W. N. 1872, p. 49 ("Golden Ointment"); *In re Johnson & Co.*, 2 U. S. Pat. Gaz. 315 ("Parsons' Purgative Pills, P. P. P." and "Johnson's American Anodyne Liniment, Established A.D. 1810"); *In re Graham*, 2 *ib.* 618 ("New Manny Harvester"); *In re Richardson*, 3 *ib.* 120 ("Richardson's Patent Union Leather-splitting Machine"); *In re The American Sardine Co.*, 3 *ib.* 495 ("American Sardines"); *Hardy* v. *Cutter*, 3 *ib.* 468 ("Old Bourbon" whiskey); *Tucker Manufacturing Co.* v. *Boyington*, 9 *ib.* 455 ("Tucker Spring Bed"); *Browne* v. *Freeman*, 12 W. R. 305 ("Chlorodyne"); *Bulloch, Lade & Co.* v. *Gray*, 19 Journ. of Jurisp. 218 ("Loch Katrine" whiskey); *Godillot* v. *Hazard*, 81 N. Y. 263 ("Julienne" soup); *In re Dick & Co.*, 9 U. S. Pat. Gaz. 538 ("Tasteless" drugs); *In re Lawrence & Co.*, 10 *ib.* 163 ("Für Familien Gebrauch," and "Lawrence Feiner Familien Flannel"); *In re Roach*, 10 *ib.* 333 ("Croup Tincture"); *Gilman* v. *Hunnewell*, 122 Mass. 139 ("Cough Remedy"); *In re Goodyear Rubber Co.*, 11 U. S. Pat. Gaz. 1062 ("Crack-proof" indiarubber); *In re Warburg & Co.*, 13 *ib.* 44 ("Cachemire Milano"); *Ayer* v. *Rushton*, 7 Daly, 9 ("Cherry Pectoral"); *Helmbold* v. *Helmbold Manufacturing Co.*, 53 How. Pr. 453 ("Highly Concentrated Compound Fluid Extract of Buchu"); *In re Dole Brothers*, 12 U. S. Pat. Gaz. 939 ("Egg Macaroni"); *Siegert* v. *Findlater*, 7 Ch. D. 801 ("Angostura Bitters"); *In re Horsburgh*, 53 L. J. Ch. 237 ("Valvoline" oil); but see *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288; *In re Rader & Co.*, 13 U. S. Pat. Gaz. 596 ("Ironstone" water-pipes); *In re Saunion & Co.*, Dig. 625 ("Anglo-Portugo" oysters); *In re Brandreth*, Dig. 626 ("Porous" plasters); *Ex parte Safety Powder Co.*, 16 U. S. Pat. Gaz. 136 ("Safety" powder); *Fairbanks* v. *Jacobus*, 14 Bl. C. C. 337 ("Fairbanks' Patent"); *Linoleum Manufacturing Co.* v. *Nairn*, 7 Ch. D. 834 ("Linoleum"); *Lazenby* v. *White*, 41 L. J. Ch. 354 ("Harvey's Sauce"); *Wotherspoon & Co.* v. *Gray & Co.*, Ct. Sess. Cas., 3rd Ser. II. 38 ("Victoria" lozenges); *Popham* v. *Wilcox*, 66 N. Y. 69 ("Prime Leaf" lard); *Sherwood* v. *Andrews*, 3 Amer. L. Reg. N. S. 588 ("Holbrook's School Apparatus"); *Alleghany Fertiliser Co.* v. *Woodside*, 1 Hughes, 115 ("Ammoniated Bone Superphosphate of Lime"); *Frese* v. *Bachof* (2), 14 Bl. C. C. 432 ("Hamburg" tea); *Ex parte Alden*, 15 U. S. Pat. Gaz. 389 ("Evaporated" articles of food); *Ex parte Marsching & Co.*, 15 *ib.* 294 ("French'' paints); *Ex parte Cohn* (1), 16 *ib.* 680 ("Standard A" cigars); *Ex parte Cohn* (2), 16 *ib.* 680 ("Druggists' Sundries" cigars); *Ex parte Smith* (2), 16 *ib.* 679 ("Medicated Prunes"); *Ex parte Thompson, Derby & Co.*, 16 *ib.* 137 ("Swing" scythe-sockets); *Ex parte Smith* (3), 16 *ib.* 764 ("Masonic" cigars); *Ex parte Waeferling*, 16 *ib.* 764 ("Granulated Dirt-killer Soap"); *Lamplough* v. *Beedzler*, C. A., Nov. 12th, 1880 ("Pyretic Saline"); *Day* v. *Neale*, V. C. B., May 24th, 1881 ("White Chemical Extract," "Brown Chemical Extract," "Red Paste," "Red Drench," "Gaseous Fluid," etc.); *In re Price's Patent Candle*

nothing away. Any man who has a right to a trade mark has his trade mark just the same after the passing of the Trade Marks Registration Act as he had before. Only, if

Co., 27 Ch. D. 681 ("National Sperm" candles); *In re Hudson*, 32 Ch. D. 311 ("Carbolic Acid Soap Powder"); *In re Atkins Filter & Engineering Co., Ld.*, 3 P. R. 164 ("The Sanitary Filter, easily cleaned"); *Native Guano Co., Ld.* v. *Sewage Manure Co.*, 4 Times L. R. 372 ("Native Guano"); *Schove* v. *Schmincke*, 33 Ch. D. 546 ("Castle Album"); *Watt* v. *O'Hanlon*, 4 P. R. 1 ("Old Innishowen" whiskey); *Symington & Co.* v. *Footman, Pretty & Co.*, 56 L. T. N. S. 696 ("Guaranteed Corset"); *In re Perry Davis & Son*, 58 L. T. N. S. 695 ("Pain-Killer" medicines); *In re Dunn*, 41 Ch. D. 439 ("Fruit Salt"); *In re Ralph*, 25 Ch. D. 194 ("The Homewasher"); *Roberts* v. *Sheldon*, 8 Biss. 398 ("Parabola"—eye needles); *Van Beil* v. *Prescott*, 82 N. Y. 630 ("Rye and Rock" liquor); *Marshall* v. *Pinkham*, 52 Wisc. 572 ("Old Dr. S. Marshall's Celebrated Liniment"); *Hostetter* v. *Adams*, 20 Bl. C. C. 326 ("Celebrated Stomach Bitters"); *Ex parte Brigham*, 20 *ib.* 891 ("Satin Polish" boots and shoes); *Ex parte Ams*, 23 *ib.* 344 ("Albany Beef"); *Ex parte Strasburger & Co.*, 20 *ib.* 155 ("Time-keeper" watches); *Ex parte Kipling*, 24 *ib.* 899 ("Cristalline" brilliants); *Electro Silicon Co.* v. *Levy*, 59 How. Pr. 469 ("Silicon" polishing powder); *Hegeman & Co.* v. *Hegeman*, 8 Daly, 1 ("Hegeman's Ferrated Elixir of Bark, or Elixir of Calisaya Bark with Iron," "Hegeman's Compound Fluid Extract of Buchu," "Hegeman's, formerly Velpeau's, Celebrated Remedy for Diarrhœa"); *Goodyear Rubber Co.* v. *Goodyear India-rubber Glove Manufacturing Co.*, 128 U. S. Rep. 598 ("Goodyear Rubber"); *Moxie Nerve Food Co.* v. ——, 43 U. S. Pat. Gaz. 888 ("Nerve Food"); *Kerry* v. *Les Sœurs de l'Asile de la Providence*, 2 St. Dig. 726 ("Syrup of Red Spruce Gum"); *McCall* v. *Theal*, 28 Grant Up. Can. Ch. 48 ("Bazaar Patterns" for clothing); *Montgomerie* v. *Donald & Co.*, Ct. Sess. Cas. 4th Ser. XI. 506 ("Water of Ayr" stone); *Stuart & Co.* v. *Scottish Val de Travers Paving Co., Ld.*, Ct. Sess. Cas., 4th Ser. XIII. 1 ("Granolithic" artificial stone); *Lewis* v. *Klapproth*, 11 Vict. L. R. 214 ("Borax Soap"); *Dreydoppel* v. *Young*, 14 Phila. 226 (do.); *Hop Bitters Manufacturing Co.* v. *Luke*, 10 Vict. L. R. (Eq.) 234 ("Hop Bitters," said to be no more distinguishing than "Olive Oil" or "Buttermilk"); *Hop Bitters Manufacturing Co.* v. *Wharton*, 10 Vict. L. R. (L.) 377 (do.); *Larrabee* v. *Lewis*, 67 Ga. 561 ("Snowflake" biscuits); *Eggers* v. *Hink*, 63 Cal. 445 ("Philadelphia Beer"); *Ball* v. *Siegel*, 116 Ill. 137 ("Health Preserving" corset); *Humphreys' Specific, &c., Co.* v. *Wenz*, 14 Fed. Rep. 250 ("Homœopathic Specifics"); *Brown Chemical Co.* v. *Myer*, 31 Fed. Rep. 453 ("Iron Bitters"); *Carbolic Soap Co.* v. *Thompson*, 25 Fed. Rep. 625 ("Cresylic Ointment"); *Pratt Manufacturing Co.* v. *Astral Refining Co., Ld.*, 27 Fed. Rep. 493 ("Astral Oil"); *Alden* v. *Gross*, 25 Mo. App. 123 ("Fruit" vinegar); *Trask Fish Co.* v. *Wooster*, 28 Mo. App. 408 ("Selected Shore Mackerel"); *Rumford Chemical Works* v. *Muth*, 35 Fed. Rep. 524 ("Acid Phosphate"); *Colgan* v. *Danheim*, 35 Fed. Rep. 150 ("Toffy Tolu"). And see cases as to "fancy words," *supra*, p. 46.

Distinctive words.

In the following cases descriptiveness has either not been alleged or has been held not to be established, and the words have been treated as distinctive words:—*Pidding* v. *How*, 6 Sim. 477 ("Howqua's Mixture"); *Perry* v. *Truefitt*, 6 Beav. 66 ("Medicated Mexican

the persons enjoying the trade mark have been so numerous that it is impossible to say that any of them, or all of them together, had an exclusive right to it, then they

Balm"); *Taylor* v. *Carpenter* (1), 3 Story, 458 ("Persian Thread"); S. C. (2) 2 Wood. & M. 1 (do.); S. C. (3) 2 Sandf. Ch. 603 (do.); *Taylor* v. *Taylor*, 2 Eq. Rep. 290 (do.); *Hine* v. *Lart*, 10 Jur. 106 ("Ethiopian" stockings); *Fowle* v. *Spear*, 7 Penn. L. J. 176 ("Wistar's Balsam of Wild Cherry"); *Coffeen* v. *Brunton* (1), (2), 4 McLean, 516; 5 *ib.* 256 ("Chinese Liniment"); *Davis* v. *Kendall*, 2 R. I. 566; ("Pain-Killer" medicine); *Davis* v. *Kennedy*, 13 Grant Up. Can. Ch. 523 (do.), (but see *In re Perry Davis & Son*, 58 L. T. N. S. 695); *R.* v. *Dundas*, 6 Cox, 380 ("Everett's Premier" blacking); *Heath* v. *Wright*, R. Cox, 154 ("Kathairon"); *Fetridge* v. *Merchant*, 4 Abb. Pr. 156 ("Balm of Thousand Flowers"); *Williams* v. *Johnson*, 2 Bos. 1 ("Yankee Soap"); *Williams* v. *Spence*, 25 How. Pr. 366 (do.); *Williams* v. *Adams*, 8 Biss. 452 (do.); *Comstock* v. *White*, 18 How. Pr. 421 ("Dr. Morse's Indian Root Pills"); *Braham* v. *Bustard*, 1 H. & M. 447 ("Excelsior" soap); *McAndrew* v. *Bassett*, 4 De G. J. & S. 380 ("Anatolia" liquorice); *Faber* v. *Hovey*, Dig. 481 ("Star" pencils); *Rillet* v. *Carlier*, 61 Barb. S. C. 435 ("Grenade" syrup); *Smith* v. *Woodruff*, 48 Barb. 438 ("Sweet Opoponax of Mexico" perfume); *Burnett* v. *Phalon*,, 3 Keyes, 594 ("Cocoaine" hair oil); *Messerole* v. *Tynberg*, 4 Abb. Pr. N. S. 410 ("Bismarck" collars); *Rowley* v. *Houghton*, 2 Brews. 303 ("Hero" jars); *Palmer* v. *Harris*, 60 Penn. St. 156 ("Golden Crown" cigars); *Filley* v. *Fassett*, 44 Mo. 173 ("Charter Oak" stoves); *Filley* v. *Child*, 16 Bl. C. C. 376 (do.); *Lockwood* v. *Bostwick*, 2 Daly, 521 ("Bovilene" pomado); *Congress & Empire Spring Co.* v. *High Rock Congress Spring Co.*, 45 N. Y. 291 ("Congress Spring" water); *Alleghany Fertiliser Co.* v. *Woodside*, 1 Hughes, 115 ("Eureka" manure); *Ford* v. *Foster*, L. R. 7 Ch. 611 ("Eureka" shirts); *Seltzer* v. *Powell*, 8 Phila. 296 ("Silver Grove" whiskey); *In re Francis & Mallon*, U. S. Pat. Comm. Decis. 1871, 283 ("Beaverine" boots); *Blackwell* v. *Armistead*, 5 Am. L. T. 85 ("Durham" tobacco); *Armistead* v. *Blackwell*, 1 U. S. Pat. Gaz. 603 (do.); *Blackwell* v. *Wright*, 73 N. Car. 310 (do.); *Blackwell* v. *Dibrell*, 14 U. S. Pat. Gaz. 633 (do.); *Hirst* v. *Denham*, L. R. 14 Eq. 542 ("Turin," "Sefton," "Leopold," "Liverpool," cloth); *Sternberger* v. *Thalheimer*, 3 U. S. Pat. Gaz. 120 ("Centennial" clothing); *In re Bush & Co.*, 10 *ib.* 164 ("Centennial" wines); *Kidd & Co.* v. *Mills, Johnson & Co.*, 5 *ib.* 337 ("Magnolia," "Dave Jones" whiskey); *Morse* v. *Worrell*, 10 Phila. 168 ("Rising Sun" stove polish); *Cotton* v. *Gillard*, 44 L. J. Ch. 90 ("Licensed Victuallers' Relish"); *Smith* v. *Mason*, W. N. 1875, p. 62 ("Pectorine" medicine); *Gouraud* v. *Trust*, 10 N. Y. Sup. Ct. 627 ("Gouraud's Oriental Cream"); *In re Glines*, 8 U. S. Pat. Gaz. 435 ("Slate Roofing Paint"); *In re Green*, 8 *ib.* 729 ("German Sirup"); *In re Weaver*, 10 *ib.* 1 ("Lion" goods); *Grillon* v. *Guénin*, W. N. 1877, p. 14 ("Tamar Indien" lozenges); *Carnrick* v. *Morson*, Dig. 543 ("Lactopeptine" medicine); *In re Cornwall* (2), 12 U. S. Pat. Gaz. 312 ("Dublin" soap); *Eno* v. *Stephens*, Dig. 609 ("Fruit Salt"), but see *In re Dunn*, 41 Ch. D. 439; *Reinhardt* v. *Spalding*, 49 L. J. Ch. 57 ("Family Salve"); *Rosing* v. *Atkinson*, 27 Sol. J. 534 ("Edelweiss" perfume); *Berliner Brauerei Gesellschaft Tivoli* v. *Knight, Stocks & Co.*, W. N. 1883, p. 70 ("Tivoli" lager beer); *In re Porter Blanchard's Sons*, U. S. Pat. Comm. Decis. 1871, 97 ("Blanchard Churn"); *In re Rohland*, 10 U. S. Pat. Gaz. 980 ("Dr. Lobenthal's Essentia Anti-

shall not have the benefit of the registration, which would give an exclusive right" (*a*). Common marks may, however, now be registered as additions to good trade marks, if an exclusive right in them is disclaimed (*b*). If the name is descriptive, the addition of "new" or "improved" does not better the case (*c*), nor that of initials representing the name of the goods (*d*), or of a mere oval border (*e*).

Name not distinctive.

Again, where a mark, though not descriptive, yet does not serve to distinguish the person using it from a number of other persons who use or are entitled to use it, it cannot be a valid trade mark, since it is common, if not to the whole world, at all events to a class of persons. Thus "prize medal" (*f*), "gold

phthisica"); *Scrg* v. *Welsh*, 16 U. S. Pat. Gaz. 910 ("Tidal Wave" tobacco); *In re Eastman*, W. N. 1880, p. 128 ("Kitchen Crystal Soap"); *Burton* v. *Stratton*, 12 Fed. Rep. 696 ("Twin Brothers" yeast); *Hier* v. *Abrahams*, 82 N. Y. 519 ("Pride" cigars); *Insurance Oil-tank Co.* v. *Scott*, 33 La. Ann. 946 ("Insurance" oil); *Smith* v. *Sixbury*, 32 N. Y. Sup. Ct. 232 ("Magnetic Balm"); *Ex parte Heyman*, 18 U. S. Pat. Gaz. 922 ("Invigorator" spring bed-bottoms); *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288 ("Valvoline" oil); *Leonard & Ellis* v. *White's Golden Lubricator Co.*, 48 U. S. Pat. Gaz. 1401 (do.), (but see *In re Horsburgh*, 53 L. J. Ch. 237); *Atlantic Milling Co.* v. *Robinson*, 20 Fed. Rep. 217 ("Champion" flour); *Ex parte Wiesel*, 36 U. S. Pat. Gaz. 689 ("Kollerina"); *Yale Cigar Manufacturing Co.* v. *Yale*, 30 U. S. Pat. Gaz. 1183 ("Grand Master" cigars); *Holt* v. *Menendez*, 128 U. S. Rep. 182 ("La Favorita" flour); *Lyman* v. *Burns*, 47 U. S. Pat. Gaz. 660 ("Pigs in Clover" game); *Selchow* v. *Baker*, 93 N. Y. 59 ("Sliced Animals" toys); *Electro-Silicon Co.* v. *Hazard*, 36 N. Y. Sup. Ct. 369 ("Electro-Silicon" polishing powder); *O'Rourke* v. *Central City Soap Co.*, 26 Fed. Rep. 576 ("Anti-Washboard" soap); *Funke* v. *Dreyfus*, 34 La. Ann. 80 ("Boker's Stomach Bitters"); *Hoxie* v. *Chaney*, 143 Mass. 592 ("A. N. Hoxie's Mineral Soap," "A. N. Hoxie's Pumice Soap"); *Hecht* v. *Porter*, 9 Pac. C. L. J. 569 ("Ironclad" boots); *Sheppard & Co.* v. *Stuart & Peterson*, 13 Phila. 117 ("Excelsior" stoves); *Lauferty* v. *Wheeler*, 63 How. Pr. 488; 11 Daly, 194 ("Alderney" oleo-margarine).

(*a*) Per Bacon, V.-C., in *Benbow* v. *Low* (4), 44 L. T. N. S. 875.

(*b*) Patents Act, 1883, § 74.

(*c*) *In re Graham*, 2 U. S. Pat. Gaz. 618. See *Gage* v. *Canada Publishing Co.*, 11 Can. Sup. Ct. 306; *Russia Cement Co.* v. *Le Page*, 147 Mass. 206; *Alexander* v. *Morse*, 14 R. I. 153; *Humphreys' Specific, &c., Co.* v. *Wenz*, 14 Fed. Rep. 250.

(*d*) *In re Blakeslee & Co.*, U. S. Pat. Comm. Decis. 1871, 284; *In re Dick & Co.*, 9 U. S. Pat. Gaz. 538.

(*e*) *In re Rader & Co.*, 13 U. S. Pat. Gaz. 596.

(*f*) *Batty v. Hill*, 1 H. & M. 264. See *Roper's, &c., Co.* v. *Copeman's, &c., Association, Ld.*, 28 Sol. J. 218. And see *Schneider* v. *Williams*, 44 N. J. (Eq.) 391, and *Ex parte Cigar Makers' Association*, 16 U. S. Pat. Gaz. 958, with which compare *Strasser* v. *Moonelis*, 108 N. Y. 611;

medal" (*a*). The objection, however, will not prevail where the class is very limited (*b*).

"Terms which designate merely the name, quality, kind, size, number, or elements of an article, or have become its proper appellation, or that merely describe it, or direct the mode of its use, purely generic and geographical terms, and the necessary and common uses in which the English language and arabic numerals are employed by people to express their ideas and feelings and to tell the truth, are common property which all may use, but which none may exclusively appropriate as a trade mark, or acquire as absolute individual property" (*c*). Consequently, an ordinary adjective in the common language of the country, descriptive of the quality of the article, and not designating it to be of the manufacture of a certain individual or establishment, as "superior" (*d*), "superfine" (*d*), "nourishing" (*e*), cannot be exclusively appropriated as a trade mark. And the same is the case with a word or symbol which is understood generally, or in the trade, to indicate quality and not a special manufacturer. Thus "A, No. 1," "A X, No. 1" (*f*), "A 1" (*g*), "Best six-cord"—"200 yds." (*h*).

Adjective denoting quality only, no trade mark.

Allen v. *Macarthy*, 37 Minn. 347, and *People* v. *Fisher*, 57 N. Y. Sup. Ct. 552.

(*a*) *Taylor* v. *Gillies*, 59 N. Y. 331.

(*b*) *Dent* v. *Turpin*, 2 J. & H. 139. And see p. 118, note (*g*).

(*c*) Per Kentucky Court of Appeal in *Avery & Sons* v. *Meikle & Co.*, 27 U. S. Pat. Gaz. 1027.

(*d*) *Braham* v. *Bustard*, 1 H. & M. 447.

(*e*) *Raggett* v. *Findlater*, L. R. 17 Eq. 29; and see *Spottiswoode* v. *Clarke*, 1 Coop. 254; *Gillott* v. *Esterbrook*, R. Cox, 353; *Ex parte Palmer*, U. S. Pat. Comm. Decis. 1871, 289; *In re Dick & Co.*, 9 U. S. Pat. Gaz. 538; *In re Goodyear Rubber Co.*, 11 *ib.* 1062; *Fulton* v. *Sellers*, 4 Brews. 42; *Ex parte Cohn* (1), 16 U. S. Pat. Gaz. 680; *Royal Baking Powder Co.* v. *Sherrill*, 93 N. Y. 331; *Smith* v. *Imus*, 32 Alb. L. J. 455; *Smith* v. *Walker*, 37 Mich. 456.

(*f*) *Candee, Swan & Co.* v. *Deere & Co.*, 54 Ill. 439; 5 Amer. Rep. 125; and see *Amoskeag Manufacturing Co.* v. *Spear*, 2 Sand. S. C. 599; R. Cox, 87; *Same* v. *Trainer*, 101 U. S. Rep. 51; *Burke* v. *Cassin*, 45 Cal. 467; 13 Amer. Rep. 204; *Stokes* v. *Landgraff*, 17 Barb. 608; R. Cox, 137; *Kinney* v. *Allen*, 1 Hughes, 106; *In re Eagle Pencil Co.*, 10 U. S. Pat. Gaz. 981; *Osgood* v. *Allen*, 1 Holmes, 185; *Carver* v. *Bowker*, Dig. 581; *Avery* v. *Meikle*, 27 U. S. Pat. Gaz. 1027; *Lawrence Manufacturing Co.* v. *Tennessee Manufacturing Co.*, 31 Fed. Rep. 776.

(*g*) *Rogers* v. *Rogers*, 53 Conn. 121.

(*h*) *Coats* v. *Merrick Thread Co.*, 45 U. S. Pat. Gaz. 347.

Marks denoting maker as well as quality.

But in some of the American cases this principle appears to have been carried to an extent which is unreasonable, and which has not been and would not be recognised in this country, the rule having been laid down too generally that every word or symbol which serves to indicate quality is incapable of appropriation as a trade mark, the qualification being omitted that, if such word or symbol also serves to indicate a particular manufacturer, the mark may be a good trade mark. In *Amoskeag Manufacturing Co.* v. *Trainer* (*a*) the Supreme Court of the United States itself appears to have decided in favour of the wider rule. There the plaintiff company manufactured cotton tickings, and sold the different qualities under different labels, of which the one affixed to the best quality of the goods bore a combination device, in which the prominent and conspicuous feature consisted of the letters "A. C. A." Those letters had for many years been recognised as indicating that the goods to which they were attached were of the plaintiff company's manufacture, and also of the best quality of the goods so manufactured, and the plaintiffs' user of the letters had been substantially exclusive. In an action, however, brought against defendants who had sold similar goods of their own make under a label containing the same letters in a conspicuous place, the Supreme Court held that, the letters being indicative of quality, no protection could be given. All trade marks, however, which are of any value at all, denote that the goods to which they are attached are of good quality, and by far the greater number of large manufacturing firms use a variety of trade marks, which they apply to goods of different descriptions or qualities, or intended for different markets; and possibly the explanation of the decision may be that the Court really considered that the letters, though

(*a*) 101 U. S. Rep. 51. And see *Royal Baking Powder Co.* v. *Sherrill*, 93. N. Y. 331.

only used by the plaintiffs, indicated nothing beyond quality (*a*).

Such marks valid.

It seems clear that the English rule that combinations of letters, or words, or symbols, which indicate that the goods to which they are applied have been manufactured by a particular person or firm, may constitute valid and registrable trade marks, notwithstanding that they also indicate the quality or pattern of the goods as compared with other goods of the same makers (*b*), is preferable to that which appears to have been formulated in some of the American Courts. Thus, in *Hirst* v. *Denham* (*c*), different fancy patterns of the plaintiff's cloth were marked with different names, each of which was protected; in *Moses* v. *Sargood, Ewen & Co.* (*d*), the plaintiff's clothing was marked with a number of crowns, varying from one to six, according to quality; in *Ransome* v. *Graham* (*e*) the plaintiff's ploughs were marked with the letters "R. N." and an additional letter or numeral, varied according to pattern and quality (*f*). In the Indian case of *Taylor* v. *Virasami* (*g*) the plaintiffs' shirtings were marked with scimitars, varying in number from two to five, according to quality. Even in some of the American Courts the English rule has been recognised, and it was well stated by the Supreme Court of Rhode Island (*h*) as follows:—"Undoubtedly, if it be assumed that a given mark indicates quality only, and not origin, it will follow that purchasers of goods so marked have not been misled thereby into the supposition that they were

(*a*) See *American Solid Leather Button Co.* v. *Anthony*, 15 R. I. 338.

(*b*) *Ransome* v. *Graham*, 51 L. J. Ch. 897.

(*c*) L. R. 14 Eq. 542.

(*d*) Dig. 636.

(*e*) 51 L. J. Ch. 897.

(*f*) And see *In re Brook*, 26 W. R. 791; *Mitchell* v. *Henry*, 15 Ch. D. 181; *Ralli* v. *Fleming*, Ind. L. R. 3 Calc. 417; *Barlow & Jones, Ld.* v. *Johnson & Co.*, 34 Sol. J. 298; affirmed by C. A., W. N., 1890, p 110; and per Pearson, J., in *Wood* v. *Lambert*, 32 Ch. D. 247; and the American cases of *Lawrence Manufacturing Co.* v. *Lowell*, 129 Mass. 325; *Godillot* v. *Hazard*, 81 N. Y. 263, per Danforth, J.; *Sohl* v. *Geisendorf*, 1 Wils. (Ind.) 60; *Merry* v. *Hoopes*, 111 N. Y. 415.

(*g*) Ind. L. R. 6 Mad. 108.

(*h*) In *American Solid Leather Button Co.* v. *Anthony*, 15 R. I. 338.

buying a plaintiff's goods, and hence he would show no cause for relief. . . . But it by no means follows as a rule of law that marks indicating style or quality may not also indicate origin, and thus be a subject of trade mark. . . . A person may have different symbols for different grades of goods, which will indicate both quality and origin with respect to the goods so marked. A manufacturer may adopt such symbols, not simply to mark a style or quality, but *his* style and *his* quality as well. He is entitled to have his style and his quality protected from misrepresentation, and to have the benefit of any favourable reputation they may have gained."

Marks denoting quality in only one trade.

If a word or symbol is only indicative of quality in a particular trade, it seems that it may be used as a trade mark in a different trade (*a*).

Deceptive marks.

Again, a trade mark which contains false representations, so as to deceive the public, will not be protected in equity as a valid trade mark (*b*), and cannot be registered as such under the Patents Acts, 1883-8 (*c*). In short, as was said by Wallace, J., in *Ginter* v. *Kinney Tobacco Co.* (*d*), "no principles are better settled in the law of trade marks than that a generic name, or a name merely descriptive of the ingredients, quality, or characteristics of an article of trade, cannot be the subject of a trade mark; and that the use of a name or term which is likely to deceive the public in reference to the components or nature of the article to which it is applied will not be tolerated." But mere collateral misrepresentations do not disqualify (*e*).

Marks which are either descriptive or deceptive.

An attempt has occasionally been made to meet the contention that a word claimed as a trade mark is incapable of appropriation by reason of its descriptiveness,

(*a*) *In re English*, U. S. Pat. Comm. Decis. 1870, 142.

(*b*) *Pidding* v. *How*, 8 Sim. 477; *Perry* v. *Truefitt*, 6 Beav. 66; *Flavel* v. *Harrison*, 10 Hare, 467; *Leather Cloth Co.* v. *American Leather Cloth Co.*, 4 De G. J. & S. 137; *Morgan* v. *McAdam*, 36 L. J. Ch. 228; *Connell* v. *Reed*, 128 Mass. 477; and see c. 7, *infrà*.

(*c*) See § 73.

(*d*) 12 Fed. Rep. 782.

(*e*) *Ford* v. *Foster*, L. R. 7 Ch. 611.

by the allegation that the goods to which it is applied do not answer the description imported by the word, and therefore that the word is not, in fact, descriptive of the goods. But in cases where a word is used which is descriptive of qualities which the goods might reasonably be supposed to possess, if the goods do not possess those qualities the use of the word is deceptive, so that *quâcunque viâ* the claim fails. Thus, in *In re Saunion & Co.* (*a*), the late Master of the Rolls refused registration to the words "Anglo-Portugo Oysters," on the ground that if the oysters were Anglo-Portuguese the use of the term was descriptive, while, if they were not, it was deceptive. And the same view was adopted by Lopes, L. J., in *In re Van Duzer* (*b*). There are many American authorities to the same effect (*c*). But if the term claimed is one which is notoriously inappropriate to the article, it will not be treated as deceptive. Thus the name "Edelweiss" was allowed to be appropriated to scent not derived from that flower, it being well known that the edelweiss yields no perfume (*d*).

Extravagance an advantage in word trade marks.

It may be stated as a general rule that the more extraordinary and extravagant the name that is adopted by way of trade mark, the better will the object be attained, and the protection of the Courts and of the Registration Office secured; for the more uncommon the designation is, the less obnoxious is the exclusive claim of the manufacturer, and the more conclusive the evidence of fraud supplied by an infringement. Thus, Wood, V.-C., said, "I have

(*a*) Dig. 625.

(*b*) 34 Ch. D. 631. Compare *Free Fishers & Dredgers of Whitstable* v. *Elliott*, W. N. 1888, p. 27.

(*c*) *Fairbanks* v. *Jacobus*, 14 Bl. C. C. 337 ("Fairbanks' Patent"); *In re American Sardine Co.*, 3 U. S. Pat. Gaz. 495 ("American Sardines"); *In re Dole Brothers*, 12 *ib.* 939 ("Egg Macaroni"); *In re Warburg & Co.*, 13 *ib.* 44 ("Cachemire Milano" silks); *Ex parte Marsching & Co.*, 15 *ib.* 294 ("French" paints); *Ex parte Knapp*, 16 *ib.* 318 ("London" animal foods); *Ex parte Farnum & Co.*, 18 *ib.* 412; ("Lancaster" tickings); *Ginter* v. *Kinney Tobacco Co.*, 12 Fed. Rep. 782 ("Straight-cut" cigarettes). With which compare *In re Green*, 8 U. S. Pat. Gaz. 729 ("German Sirup"); *In re Cornwall* (2), 12 *ib.* 312 ("Dublin" soap).

(*d*) *Rosing* v. *Atkinson*, 27 Sol. J. 534.

not the least doubt that if the plaintiff (if I doubted I should be going quite contrary to the Mexican Balm case and other cases in which ridiculous names have been used) had invented a fanciful and ridiculous name—and the more ridiculous, the better it is for his purpose—and had used it for eight or ten years in his trade, the Court would take care that nobody else should use that absurd name; for such user could only be a user for the express purpose of imitating the plaintiff's, and so defrauding the plaintiff, by representing goods manufactured by one person to be goods manufactured by another" (*a*).

Words specially invented.

In many cases the word used as a trade mark is an entirely new word, invented for the occasion by the manufacturer of the material or composition to which it is applied, and such a name may be registered and otherwise treated as a valid trade mark (*b*). Thus "Pectorine" (*c*) and "Lactopeptine" (*d*) were protected as names for medical compounds; "Cocoaine" (*e*) and "Bovilene" (*f*) for pomades. "Chlorodyne" (*g*) was only not protected because the proprietor, on a mistaken view of his rights, consented to have his bill for an injunction dismissed with costs. Invented words (*h*) were, however, occasionally refused registration as "fancy words" under § 64 of the Act of 1883, where they were considered to suggest a description of the article—*e.g.*, "Washerine"

(*a*) *Young* v. *Macrae*, 9 Jur. N. S. 322; and see *Ketridge* v. *Merchant*, 4 Abb. Pr. 156; R. Cox, 194.

(*b*) See Patents Act, 1883, § 64, as amended by the Act of 1888.

(*c*) *Smith* v. *Mason*, W. N. 1875, p. 62.

(*d*) *Carnrick* v. *Morson*, L. J. N. of C. 1877, p. 71.

(*e*) *Burnett* v. *Phalon*, 9 Bos. 192; R. Cox, 376.

(*f*) *Lockwood* v. *Bostwick*, 2 Daly, 521; R. Cox, 555.

(*g*) *Browne* v. *Freeman*, 12 W. R. 305.

(*h*) *In re Francis & Mallon*, U. S. Pat. Comm. Decis. 1871, 283 ("Beaverine" boots and shoes); *Enoch Morgan's Sons' Co.* v. *Schwachhofer*, 55 How. Pr. 37, and *same* v. *Hunkele*, 16 U. S. Pat. Gaz. 1092 ("Sapolio" soap); *Electro-Silicon Co.* v. *Trask*, 59 How. Pr. 189 ("Electro-silicon"); *Electro-Silicon Co.* v. *Hazard*, 36 N. Y. Sup. Ct. 369 (do.) And see *Young* v. *Macrae*, 9 Jur. N. S. 322, in which "Paraffin Oil," *Lamplough* v. *Balmer*, W. N. 1867, p. 293, in which "Pyretic Saline," and *Wolfe* v. *Goulard*, 18 How. Pr. 64, R. Cox, 226, in which "Schiedam Schnapps," was not protected for special reasons only.

soap (*a*), "Monobrut" champagne (*b*); and Jessel, M. R., treated "Valvoline" oil as descriptive (*c*), though Lord Selborne (*d*) and a United States circuit judge (*e*) have thought differently.

Existing words composing a word trade mark.

In many other cases the trade mark consists, not of a newly coined word, but of a word, or a combination of words, already in common use, but which for the purpose of the trade mark is or are used and applied in a manner quite different from the ordinary use and application, so different that it is seen at the first glance that the word or combination of words is or are being used quite out of the common signification, and in the nature of a fancy name designatory of the goods (*f*). Thus, "Pharaoh's Serpents" (*g*), applied to a toy; "The Licensed Victuallers' Relish" (*h*), to a sauce; "Turin," "Sefton," "Leopold," and "Liverpool" (*i*), to cloth; "United Service" (*k*) and "Genuine Yankee" (*l*), to soap; "Sweet Opoponax of

(*a*) *Burland & Co.* v. *Broxburn Oil Co., Ld.* (2), 42 Ch. D. 274.

(*b*) *In re Vignier*, 61 L. T. N. S. 495.

(*c*) *In re Horsburgh*, 53 L. J. Ch. 237.

(*d*) *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288.

(*e*) *Leonard & Ellis* v. *White's Golden Lubricator Co.*, 48 U. S. Pat. Gaz. 1401.

(*f*) See *Newman* v. *Alvord*, R. Cox, 413, in which Daniels, J., said that "any member of the community, whose interests and business may be promoted by doing so, should be at liberty to apply even names and words in common use to the products of his industry, in such a manner as to indicate their origin or particular manufacture, where such application will not intrench upon and will be in no way included in their use by the public. By doing so, the rights of no member of the community can be in any manner infringed, and no public inconvenience whatever can be occasioned by it. The public will still be left at full liberty to use such words or terms as they were used before; while for a special purpose a new office or purpose may be imposed upon them;" *Osgood* v. *Allen*, 1 Holmes, 185, in which Shepley, J., said that "words or devices may be adopted as trade marks, which are not original inventions of the one who adopts and uses them. Words in common use may be adopted, if at the time of adoption they were not used to designate the same or similar articles of production;" and *Lea* v. *Wolff*, 15 Abb. Pr. N. S. 1; *Ex parte Palmer*, U. S. Pat. Comm. Decis. 1871, 289; *M'Lean* v. *Fleming*, 96 U. S. Rep. 245; *Smith* v. *Woodruff*, 48 Barb. 438; and *Ex parte Halliday Brothers*, 16 U. S. Pat. Gaz. 500.

(*g*) *Barnett* v. *Leuchars*, 13 L. T. N. S. 495.

(*h*) *Cotton* v. *Gillard*, 44 L. J. Ch. 90.

(*i*) *Hirst* v. *Denham*, L. R. 14 Eq. 542.

(*k*) *Field* v. *Lewis*, Dig. 280.

(*l*) *Williams* v. *Johnson*, 2 Bos. 1; R. Cox, 214; *Williams* v. *Spence*, 25 How. Pr. 366; R. Cox, 305.

Mexico" (*a*) and "Balm of Thousand Flowers" (*b*), to perfume; and "Charter Oak" to stoves (*c*).

Inscriptions or advertisements.

Occasionally it has been sought to protect as a trade mark, and to claim exclusive rights in, an inscription or advertisement composed of ordinary English words, used in their ordinary sense, and only peculiar from the length of the sequence. Usually, indeed, there is in such cases some feature which might be really distinctive, but of which the plaintiff, for some reason or other, is unable to avail himself; this failing, the whole inscription is claimed. Such cases, however, are in fact "advertisements of the character and quality of the goods" (*d*), in which advertisements no exclusive rights can be claimed, as was expressly decided by the Court of Appeal in *Cheavin* v. *Walker* (*e*),

(*a*) *Smith* v. *Woodruff*, 48 Barb. 438; R. Cox, 373.

(*b*) *Fetridge* v. *Merchant*, 4 Abb. Pr. 156; R. Cox, 194; but see *Fetridge* v. *Wells*, 13 How. Pr. 385; R. Cox, 180.

(*c*) *Filley* v. *Fassett*, 44 Mo. 173; R. Cox, 530; *Filley* v. *Child*, 16 Bl. C. C. 376. And see *Weston* v. *Hemmons*, 2 Vict. L. R. Eq. 121 ("Wizard" oil); *Sternberger* v. *Thalheimer*, 3 U. S. Pat. Gaz. 120 ("Centennial" clothing); *Kidd & Co.* v. *Mills, Johnson & Co.*, 5 *ib.* 337 ("Magnolia" whiskey); *Kidd* v. *Johnson*, 100 U. S. Rep. 617 (do.); *In re Glines*, 8 U. S. Pat. Gaz. 435 ("Slate Roofing Paint"); *In re Kimball*, 11 *ib.* 1109 ("Vanity Fair" cigarettes); *Marcovitch* v. *Bramble, Wilkins & Co.*, Dig. 595 (do.); *Davis* v. *Kennedy*, 13 Grant Up. Can. Ch. 523 ("Pain-Killer" medicine); *Faber* v. *Hovey*, Dig. 481 ("Star" pencils); *Ex parte Peper*, 16 U. S. Pat. Gaz. 678 ("Corn" tobacco); *Wright* v. *Simpson*, 15 *ib.* 968 ("Pond Lily Wash"); *Crawford* v. *Shuttock*, 13 Grant Up. Can. Ch. 149 ("Imperial" soap); *Degraves* v. *Whiteman*, 5 Vict. L. R. Eq. 304 ("Cascade" ale); *Yale Cigar Manufacturing Co.* v. *Yale*, 30 U. S. Pat. Gaz. 1183 ("Grand Master" cigars); *Hecht* v. *Porter*, 9 Pac. C. L. J. 569 ("Ironclad" boots). But where the name "Astral Lamp" had been long in use for a particular kind of oil lamp, it was held that no exclusive right could be acquired in the word "Astral" as applied to oil. *Pratt Manufacturing Co.* v. *Astral Refining Co., Ld.*, 27 Fed. Rep. 493.

(*d*) Per Lord Westbury, C., in *Leather Cloth Co.* v. *American Leather Cloth Co.*, 11 H. L. C. 523, which see.

(*e*) 5 Ch. D. 850. And see *Blackwell* v. *Crabb*, 36 L. J. Ch. 504; *Alleghany Fertiliser Co.* v. *Woodside*, 1 Hughes, 115 ("Ammoniated Bone Superphosphate of Lime"); *Helmbold* v. *Helmbold Manufacturing Co.*, 53 How. Pr. 453 ("Highly Concentrated Compound Fluid Extract of Buchu"); *In re Johnson & Co.*, 2 U. S. Pat. Gaz. 315 ("Johnson's American Anodyne Liniment, Established A.D. 1810"); *Gilman* v. *Hunnewell*, 122 Mass. 139 ("A sure remedy for chronic or common cough, sore throat, and other minor throat complaints, so often by neglect the forerunner of consumption").

where the inscription was "G. Cheavin's improved patent, gold-medal, self-cleaning, rapid water filter, Boston, England," the name Cheavin having become indicative of a principle of construction. In *Shrimpton* v. *Laight* (*a*), the use of the words "graduated, grooveless, drill-eyed, ground-down" needles was also accompanied by that of the maker's name, and this being obviously imitated by the defendant, the injunction was granted.

Words taken from the dead languages.

Sometimes a word taken from a dead language has been applied to goods and protected as a valid trade mark, as the Latin word "Excelsior" in respect of soap (*b*), or stoves (*c*); or the Greek word "Eureka" on shirts (*d*), or on an agricultural compost (*e*).

Or from modern foreign languages.

In some instances words taken from modern foreign languages have been protected, though the precise extent to which trade marks so composed will be acknowledged has not yet been authoritatively decided. Where the name employed is a fancy name which happens to be in a foreign language, or framed in imitation of the forms of a foreign language, there is no doubt that there is just as good a trade mark as if it had been in English or framed on English forms; thus, "Flor Fina Prairie Superior Tabac" (*f*) was allowed to be a good trade mark, though the defendant was held not to have infringed; and "Tamar

(*a*) 18 Beav. 164. And see *Boardman* v. *Meriden Britannia Co.*, 35 Conn. 402; R. Cox, 490, where an injunction was given. In *Roberts* v. *Sheldon*, 8 Biss. 398, the plaintiffs used the words "Roberts' Parabola Gold-Burnished Sharps" on his needles, and the defendant was restrained from using the words "William Clark & Sons' Parabola Gold-Burnished Sharps." In *In re Roberts* (1), (2), (3), U. S. Pat. Comm. Decis. 1871, 113, 100, 101, the following were registered as trade marks:—"A luxury—R. J. Roberts' Razor-Steel Scissors. The best in the world. The best is the cheapest. For sale here;" "An exquisite pleasure to shave with R. J. Roberts' Diamond-Edged Razors;" "R. J. Roberts' Diamond-Edge Razor. Every razor warranted."

(*b*) *Braham* v. *Bustard*, 1 H. & M. 447.

(*c*) *Sheppard & Co.* v. *Stuart & Peterson*, 13 Phila. 117.

(*d*) *Ford* v. *Foster*, L. R. 7 Ch. 611.

(*e*) *Alleghany Fertiliser Co.* v. *Woodside*, 1 Hughes, 115. See *Raggett* v. *Findlater*, L. R. 17 Eq. 29.

(*f*) *Cope* v. *Evans*, L. R. 18 Eq. 138.

Indien" (*a*) was actually protected. In *In re Rotherham* (*b*), an Arabic word, used by way of a pun, was held to be entitled to registration as a good trade mark, though the Commissioners of Patents had directed the registrar to the contrary.

Foreign words in their ordinary signification. *Gout* v. *Aleploglu*.

When, however, the foreign words are used in their ordinary sense, or in a sense not widely remote therefrom, the case is different. In *Gout* v. *Aleploglu* (*c*), the plaintiff was a maker of watches for the Turkish market. These watches he marked in Turkish with his own name (Ralph Gout) with the word "Pessendede," "warranted"), with his initials "R. G." and a crescent, and also with a sprig and crescent. The defendant procured watches to be made, in which the minor features of the marks used by the plaintiff were omitted, but in which the main characteristics, the name ("Ralph Gout") and the word "Pessendede," in Turkish characters, were reproduced, the style of engraving being copied. Such watches were then sent by the defendant to Constantinople, and there sold, to the prejudice of the plaintiff's business. This was a clear case of fraud, and so it was held to be by the Vice-Chancellor of England, Sir L. Shadwell, who, however, did express an opinion that the plaintiff had acquired an exclusive right in the word "Pessendede" (*d*). But the point that had to be decided was not simply whether the word "warranted," in Turkish, could be protected; and indeed, when it is considered that the watches were to be sold in Turkey, the case does seem to be just the same as if the word had been engraved in English on watches to be sold in this country, when such a proposition would be clearly untenable. But not only the word, but the manner of engraving it was copied, and not only that word,

(*a*) *Grillon* v. *Guénin*, W. N. 1877, p. 14; and see *Caruncho* v. *Stephenson*, 25 Sol. J. 929 ("Intimidad" cigars); *Holt* v. *Menendez*, 128 U. S. Rep. 182 ("La Favorita" flour).

(*b*) 14 Ch. D. 585.

(*c*) 6 Beav. 69; 5 Leg. Obs. 496.

(*d*) 5 Leg. Obs. 496.

but the name of the maker; and what the Vice-Chancellor actually decided was that here there was a clear case of attempted fraud, which was quite sufficient ground for the issue of an injunction, without its being necessary to consider whether the imitation of one single feature would have been sufficient to entitle the plaintiff to that remedy. The use of the name "Ralph Gout" alone by the defendant, whose own name was entirely different, would indeed have been sufficient to entitle the plaintiff to an injunction (*a*), but the case with respect to "Pessendede" was different.

Broadhurst v. *Barlow*.

In *Broadhurst* v. *Barlow* (*b*), the case was again a far more complicated one than that of a single foreign word, or even a succession of words taken from the same foreign language. Here the plaintiffs were spinners and manufacturers at Manchester and Bolton, who exported to the East large quantities of pieces of Spanish shirting, which they marked with their proper trade mark, a lion in a border, and with the words "Spanish shirting" in a scroll, and "No. 120." To this they had added "exactly 12 yards," in Turkish, Armenian, and Greek, the same statement being repeated in the three languages, placed one below the other (*c*). The defendants were discovered to be preparing Spanish shirting for export, similarly marked, except that there were five lines instead of four, and that an elephant was used in place of the lion. Wickens, V.-C., held that "though an elephant was used by the defendants, the three sentences in the same languages in the same order was an infringement of the plaintiffs' rights," and he therefore granted the injunction to restrain the use of the words in the three languages in the order used by the plaintiffs.

(*a*) See per Sir G. Turner, L. J., in *Burgess* v. *Burgess*, 3 De G. M. & G. 896; *Perks* v. *Hall & Co.*, W. N. 1881, p. 111.

(*b*) W. N. 1872, p. 212; and L. J. N. of C., 1872, p. 183.

(*c*) In *Curtis* v. *Bryan*, 2 Daly, 212; R. Cox, 434, a label was used, with an inscription in English, French, German, and Spanish; and see *Siegert* v. *Findlater*, 7 Ch. D. 801, and *Siegert* v. *Ehlers*, Dig. 432.

Conclusion.

The true principle appears to be that, while foreign words employed in their ordinary signification may, even when used on goods intended for consumption in the country where that foreign language is spoken, form a part of a combination trade mark, the infringement of which will be restrained, the exclusive use of such words themselves, apart from fraud, will not be protected in this country, any more than that of an ordinary English adjective (*a*). In an American registration case (*b*) it was sought to register the German words "Für Familien Gebrauch," and "Lawrence Feiner Familien Flannel," meaning respectively "For Family Use" and "Lawrence Fine Family Flannel"; but the application was refused, on the ground of descriptiveness. In *Rillet* v. *Carlier* (*c*) it was indeed held that an American maker of pomegranate syrup had acquired an exclusive right in America to the term "Grenade Syrup," though "Grenade" was the ordinary French word for pomegranate, and the term "Grenade Syrup" was in common use in France. In this case, however, there were elements of fraud, and actual fraud will always be restrained.

Geographical names.

Under the head of "distinctive words" should be included trade marks consisting of geographical names. For registration, it is indispensable to prove user as a trade mark before August 13th, 1875, for such words have never been allowed to be registered as new marks. This was so under the Act of 1875, because that Act did not allow any mere words to be registered as new marks (*d*); under the Act of 1883, because the construction placed on the term "fancy word" was such as to exclude geographical names (*e*); and under the Act of 1888, because such names

(*a*) This was so laid down with respect to words claimed as fancy words under P. A. 1883, § 64, by Chitty, J., in *In re Davis & Co.*, 59 L. T. N. S. 854.

(*b*) *In re Lawrence & Co.*, 10 U. S. Pat. Gaz. 163.

(*c*) 61 Barb. S. C. 435.

(*d*) T. M. A. 1875, § 10.

(*e*) *In re Van Duzer*, 34 Ch. D. 623 ("Melrose Favourite Hair Restorer"); *In re Ainslie & Co.*, 4 P. R. 212 ("Ben Ledi" whiskey); *In re Laing*, L. J. N. of C. 1887, p

are expressly excluded from registration as new marks (*a*). But it seems that where a geographical name has been used *per se* as a trade mark before August 13th, 1875, and is not in common use, it will be recognised as a "special and distinctive" word (*b*). When geographical names are used as trade marks they are in that application to be understood, not as ascribing the goods to which they are affixed to any special section of the earth's surface, but as expressing the works at which, or the manufacturer by whom, those goods have been produced. So Wood, V.-C., in the "Anatolia" liquorice case (*c*), said that "the plaintiffs had established beyond all doubt the connection of their name with that mark, that was beyond dispute," and that "he could not treat the word as being otherwise than a designation mark, which the plaintiffs had caused to be attached to that particular article of liquorice which they so manufactured, and which they had a right to consider, in that qualified sense, property." Lord Westbury, C., in that case strongly confirmed the opinion of the Vice-Chancellor; and in the later case of *Wotherspoon* v. *Currie* (*d*), where the subject of dispute was the word "Glenfield" applied to starch, he stated that that word had acquired a secondary signification or meaning in connection with a particular manufacture: in short, it had become the trade designation 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

102 ("Glengowrie Blend of Fine Old Highland Whiskey"); *In re Thompson & Co.*, 6 P. R. 213 ("Manor" tin plates); *Great Tower Street Tea Co.* v. *Smith*, 6 P. R. 165 ("Tower Tea"); *In re Batt & Co.*, 6 P. R. 493 ("The Brymbo Special" iron goods).

(*a*) P. A. 1888, § 64 (1) (e).

(*b*) *In re Van Duzer*, 34 Ch. D. 623 (per Cotton, L. J.); *Compania General de Tabacos* v. *Rehder*, 5 P. R. 61 ("Cavite" cigars); *Evans* v. *Smith*, 3 Times L. R. 390 ("Montserrat" lime juice). See *Thompson* v. *Montgomery*, 41 Ch. D. 35.

(*c*) *McAndrew* v. *Bassett*, 33 L. J. Ch. 561; 4 De G. J. & S. 380 (App.).

(*d*) L. R. 5 H. L. 508. See also the very recent case of *Thompson* v. *Montgomery*, 41 Ch. D. 35 ("Stone Ales").

he had referred. The word "Glenfield," therefore, as a denomination of starch, had become the property of the appellants. It was their right and title in connection with the starch.

Rules as to geographical names.

In some cases there is no pretence for saying that the name is used in its ordinary geographical sense. Thus no one could affirm that the use of the names "Persian thread" (*a*) or "Ethiopian stockings" (*b*) had induced him to suppose that the articles in question were imported from those countries. In other cases, however, the name is less purely arbitrary, and was originally, at least, indicative of local origin. For instance, the pipes marked with "E. Southorn, Broseley" (*c*), were manufactured at a village of that name; Glenfield starch (*d*), in the same manner, came from Glenfield; Anatolia liquorice (*e*), and Leopoldshall Kainit (*f*), from those respective places. This fact, however, does not deprive the trade mark of the right to protection. It is true that the name of an existent place cannot for all purposes be appropriated (*g*),

(*a*) *Taylor* v. *Taylor*, 23 L. J. Ch. 255.

(*b*) *Hine* v. *Lart*, 10 Jur. 106; and see *In re Cornwall* (2), 12 U. S. Pat. Gaz. 312 ("Dublin" soap); *Fleischmann* v. *Schuckmann*, 62 How. Pr. 92 ("Vienna" bread); *Lauferty* v. *Wheeler*, 63 *ib.* 488; 11 Daly, 194 ("Alderney" oleo-margarine).

(*c*) *Southorn* v. *Reynolds*, 12 L. T. N. S. 75.

(*d*) *Wotherspoon* v. *Currie*, L. R. 5 H. L. 508.

(*e*) *McAndrew* v. *Bassett*, 4 De G. J. & S. 380.

(*f*) *Radde* v. *Norman*, L. R. 14 Eq. 348; and see *Apollinaris Co.* v. *Edwards*, Seton, 4th ed. 237; and *Apollinaris Co.* v. *Norrish*, 33 L. T. N. S. 242 ("Apollinaris Water"); *Congress and Empire Spring Co.* v. *High Rock Congress Spring Co.*, 57 Barb. 526, R. Cox, 599 ("Congress Spring Water"); *Amoskeag Manufacturing Co.* v. *Garner* (1), 55 Barb. 151; R. Cox, 541, and S.C. (2), 54 How. Pr. 298 ("Amoskeag" cloths); *Newman* v. *Alvord*, 51 N. Y. 189 ("Akron"); *Lea* v. *Millar*, Dig. 513 ("Worcestershire Sauce"); *Powell* v. *McNulty*, Dig. 526 ("Yorkshire Relish"); *Siegert* v. *Findlater*, 7 Ch. D. 801 ("Angostura Bitters"); *Kinney* v. *Basch*, Dig. 542 ("St. James' Cigarettes"); *Wheeler* v. *Johnston*, 3 L. R. Ir. 284 ("Cromac Springs"); *Davis* v. *Tylor*, M. R., April 24th, 1879 ("Ferndale" coal); *Lochgelly Co., Ld.* v. *Lamphinnans Iron Co.*, Ct. Sess. Cas., 4th Ser. VI., 482 ("Lochgelly" coal); *Blair* v. *Stock*, 52 L. T. N. S. 123 ("Strathmore" whiskey).

(*g*) "Property in the word for all purposes cannot exist:" per Lord Westbury, C., *McAndrew* v. *Bassett*, 4 De G. J. & S. 380. In *Watt* v. *O'Hanlon*, 4 P. R. 1, the words "Old Innishowen" were held to be descriptive of a particular quality of whiskey, and an injunction was refused.

and that any one who manufactures at a place the name of which has become another's trade mark, indicative of that other's productions, may still describe his goods as made on that spot (*a*). But by English law he cannot stamp that name on his goods in the character of a trade mark of his own. In *Seixo* v. *Provezende* (*b*), where it was urged by the defendants that parts of their vineyards were known by the name of Seixo, the Lord Chancellor (Lord Cranworth) said that even assuming that to be true, "that did not justify the defendants in adopting a device or brand, the probable effect of which was to mislead the public, when purchasing their wine, to suppose that they were purchasing wine produced from the vineyards, not of the defendants, but of the plaintiff. Cases might be imagined, though very unlikely to arise, in which a person bringing into the market for the first time the produce of a newly established manufacture, to come into competition with one already established, might really be embarrassed as to the mode in which he should describe it, so as not to interfere with the description adopted by a manufacturer who had been before him." And he added that if such a case should arise, it would have to be dealt with on its own merits.

McAndrew v. *Bassett*.

Again, in *McAndrew* v. *Bassett* (*c*), Lord Westbury, C., said, "I am told that the word 'Anatolia,' being a general geographical expression—being, in point of fact, the geographical designation of a whole country—is a word common to all, and that in it, therefore, there can be no property. That is nothing in the world more than a

(*a*) Thus in *Braham* v. *Beachim* (1), 7 Ch. D. 848, an injunction was only granted to restrain the defendants from describing their coal as "Radstock" until they had some justification for so describing it, and when that justification could be produced, no relief was granted against them. And so in *Free Fishers & Dredgers of Whitstable* v. *Elliott*, W. N. 1888, p. 27. But this course was not taken in *Thompson* v. *Montgomery*, 41 Ch. D. 35, *q.v.* See *Braham* v. *Beachim* (2), Dig. 633, and *Siegert* v. *Findlater*, 7 Ch. D. 801.

(*b*) L. R. 1 Ch. 192.

(*c*) 4 De G. J. & S. 380; See *Wheeler* v. *Johnston*, 3 L. R. Ir. 284.

repetition of the fallacy which I have frequently had occasion to expose. Property in the word for all purposes cannot exist; but property in that word, as applied by way of stamp upon a stick of liquorice, does exist the moment the liquorice goes into the market so stamped, and obtains acceptance and reputation in the market, whereby the stamp gets currency as an indication of superior quality, or of some other circumstances that render the article so stamped acceptable to the public."

Geographical names in America.

In America, the rule prohibiting the appropriation of geographical names as trade marks appears to be more stringent than in England, as the Courts there deny that such names can constitute trade marks (*a*), and registration is, as a rule, refused to them (*b*); and the Scotch Courts appear inclined to take the same course (*c*). Where, however, the use of a geographical name is clearly fraudulent (*d*), or where it is used by a defendant whose residence

(*a*) Thus, in *Canal Co.* v. *Clark*, 13 Wall. 311, the Supreme Court of the United States allowed the defendants to use the name "Lackawanna" on coal produced in that district, though the defendants had previously so used it; and see *Candee, Swan & Co.* v. *Deere & Co.*, 54 Ill. 439; 5 Amer. Rep. 125 ("Moline" ploughs); *Glendon Iron Co.* v. *Uhler*, 75 Penn. St. 467; 15 Amer. Rep. 599 ("Glendon" iron); *Carmichel* v. *Latimer*, 11 R. I. 395 ("Stillman Mill"); *Eggers* v. *Hink*, 63 Cal. 445 ("Philadelphia Beer"); *Evans* v. *Van Laer*, 32 Fed. Rep. 153 ("Montserrat" lime juice); *Osgood* v. *Allen*, 1 Holmes, 185; *Dunbar* v. *Glenn*, 42 Wisc. 118; *Burton* v. *Stratton*, 12 Fed. Rep. 696; *Anheuser Busch Brewing Association* v. *Piza*, 23 Bl. C. C. 245; *Lea* v. *Deakin*, 11 Biss. 23; *Pratt's appeal*, 117 Penn. St. 401; *Smith* v. *Imus*, 32 Alb. L. J. 455; *Smith* v. *Walker*, 37 Mich. 456. But see Mr. R. Cox's note to *Glendon Iron Co.* v. *Uhler*, at 13 Am. L. Reg. N. S. 543, in which he disputes the decision that a geographical name cannot be a trade mark.

(*b*) *Armistead* v. *Blackwell*, 1 U.S. Pat. Gaz. 603 ("Durham" tobacco); *Blackwell* v. *Dibrell*, 14 *ib.* 633 (do.); *In re Tolle*, 2 *ib.* 415 ("Cherry St. Mills," "Market St. Mills"); *In re American Sardine Co.*, 3 *ib.* 495 ("American Sardines"); *In re Warburg & Co.*, 13 *ib.* 44 ("Cachemire Milano"); *Ex parte Marsching & Co.*, 15 *ib.* 294 ("French" paints); *Ex parte Knapp*, 16 *ib.* 318 ("London" animal foods); *Ex parte Farnum & Co.*, 18 *ib.* 412 ("Lancaster" tickings); *Ex parte Oliver*, 18 *ib.* 923 ("Raleigh" tobacco).

(*c*) *Montgomerie* v. *Donald & Co.*, Ct. Sess. Cas., 4th ser. XI., 506 ("Water of Ayr" stone).

(*d*) *Kinney* v. *Basch*, Dig. 542 ("St. James' Parish" cigarettes); *Dunbar* v. *Glenn*, 42 Wisc. 118 ("Bethesda" mineral water); *Anheuser Busch Brewing Association* v. *Piza*, 23 Bl. C. C. 245; *Southern White Lead Co.* v. *Carey*, 25 Fed. Rep. 125; *Pike Manufacturing Co.* v. *Cleveland Stone Co.*, 25 Fed. Rep. 896.

and works are not situate in the locality the name of which he seeks to employ (*a*), relief may be obtained; and registration has also been effected in cases where there was a plausible ground for the assertion that the name was selected and used in a purely arbitrary way (*b*).

Words disentitled to protection.

In addition to deceptive words, no other words, the use of which would be deemed disentitled to protection in a court of justice, can be registered (*c*).

Letters and figures.

The provision inserted in favour of old marks in § 64 of the Patent Acts, 1883-8, also includes "any special and distinctive letter, figure (*d*), or combination of letters or figures, or of letters and figures, used as a trade mark before August 13th, 1875." It will be observed that the wording of this part of the section differs considerably from that of the corresponding part of § 10 of the Registration Act, 1875, the object being to bring all old trade marks composed of letters, figures, or combinations within the scope of the provisions for registration, an object which the old section had failed to achieve (*e*).

Letters.

Letters, generally in the form of initials, have, with or without additions, frequently been treated as trade marks. Among the earliest of these cases are *Motley* v. *Downman* (*f*) and *Millington* v. *Fox* (*g*); in the first of which cases "M. C.," and in the second "J. H.," was branded on iron. Still earlier than these cases, in the year 1834, "H. H. 6" formed part of a trade mark protected by injunction (*h*).

(*a*) *Lea* v. *Wolff*, 15 Abb. Pr. N. S. 1 ("Worcestershire Sauce"); *Anheuser Busch Brewing Association* v. *Piza*, 23 Bl. C. C. 245; *Southern White Lead Co.* v. *Carey*, 25 Fed. Rep. 125; *Pike Manufacturing Co.* v. *Cleveland Stone Co.*, 35 Fed. Rep. 896.

(*b*) *In re Green*, 8 U. S. Pat. Gaz. 729 ("German Sirup"); *In re Cornwall* (2), 12 *ib.* 312 ("Dublin" soap); and see *Ex parte Barnum & Co.*, 18 *ib.* 412, in which it was said that a geographical name would not be registered in the U. S. Patent Office unless it was clearly shown that it would be understood to be primarily fanciful, and that manufacturers residing at the place denoted by the name could be excluded from the use of it.

(*c*) See Patents Acts 1883-8, § 73.

(*d*) *I.e.*, numeral. See *Ex parte Stephens*, 3 Ch. D. 659.

(*e*) See *In re Mitchell* (1), 7 Ch. D. 36.

(*f*) 3 My. & Cr. 1.

(*g*) 3 My. & Cr. 338.

(*h*) *Ransome* v. *Bentall*, 3 L. J. Ch. 161.

In *Crawshay* v. *Thompson* (*a*), "W. C." in an oval was employed, and infringement being alleged through the use of "W. O." in a similar oval, a verdict was given by the jury for the defendants. The question whether initial letters could form a trade mark, alone or in conjunction with other symbols, was definitively raised before the Lord Chancellor of Ireland, in *Kinahan* v. *Bolton* (*b*). In that case the alleged trade mark consisted of the letters "L L" (standing for "Lord Lieutenant"), with a ducal coronet, which mark, it was alleged, had been adopted at a time when there was a ducal Lord Lieutenant of Ireland. The case of the defendants was that "L L" could no more compose a trade mark than "X X," but was a mere mark of quality. The Lord Chancellor, saying that there was no doubt as to this mark being a trade mark "in the strictest sense," went on to observe: "A most competent witness says that this whiskey, under the name of 'L L,' is a well-known article of commerce, that it has no other name than 'L L,' that under this name it has acquired a special reputation, and that for the long period of forty years this name has been applied to it. What is a trade mark more than that? It is proved that these two letters designate this whiskey. The letters of themselves mean nothing; no one *à priori* could know the meaning of such a trade mark: it is merely like a diamond, an anchor, or a crown, stamped on any article, the mark by which the vendor enables the public to recognise his wares."—"There can be no doubt, and indeed it is not disputed, that two letters may constitute a trade mark." Reference was then made to the cases of *Motley* v. *Downman* (*c*) and *Millington* v. *Fox* (*d*), and the injunction was granted. Since that time "S. and H." with a crown (*e*), "B. B. H." with a crown (*f*), or in any

(*a*) 4 M. & G. 357.
(*b*) 15 Ir. Ch. 75.
(*c*) 3 My. & Cr. 1.
(*d*) 3 My. & Cr. 338.
(*e*) *Hopkins* v. *Hitchcock*, 14 C. B. N. S. 65.
(*f*) *Hall* v. *Barrows*, 4 De G. J. & S. 150; *Barrows* v. *Pelsall Coal & Iron Co.*, Dig. 530.

other combination (*a*), "C. B." with a cross (*b*), "M. and C." in a circle (*c*), and other letters (*d*), have been treated as undoubted trade marks.

Conclusion.

In the result, while letters used as a trade mark for the first time since the Act of 1875 must be combined with some distinctive feature, it seems clear that, if used as such before the Act, they will, even standing alone, be entitled to protection, though probably not as against persons having them for their initials and using them without fraud (*e*).

Single letters.

The Trade Marks Registration Act of 1875, § 10, only authorised the registration of letters by the use of the term "any special and distinctive combination of figures or letters;" and in *In re Mitchell* (1) (*f*), Hall, V.-C., felt himself compelled to hold that a single letter, however long and exclusively used by an applicant for registration, was not within the section, and was incapable of registration. Now, however, the wording of the present Act permits in express terms the registration of a "letter" as an old mark, so that the difficulty is removed. The letter will, of course, have to be proved to be special and distinctive. In America, the single letter "D" in a lozenge has been admitted to registration (*g*), notwithstanding the decision in *Ferguson* v. *Davol Mills* (*h*) with respect to the letter "K" enclosed in circular lines —a decision which appears to have been founded on

(*a*) *In re Barrows*, 5 Ch. D. 353.

(*b*) *Cartier* v. *Carlile*, 31 Beav. 292; *Cartier* v. *Westhead*, Dig. 199; *Cartier* v. *May*, Dig. 200.

(*c*) *Moet* v. *Clybouw*, Dig. 533; *Moet* v. *Pickering*, 8 Ch. D. 372.

(*d*) See *Ex parte Young*, Dig. 537 ("L. H. & S."); *Carver* v. *Bowker*, Dig. 581 ("R. H."); *Ransome* v. *Graham*, 51 L. J. Ch. 897 ("R. N."); *Bondier* v. *Depatie*, 3 Dorion, 233 ("G. B. D."). See also *In re Brook*, 26 W. R. 791; *Candee* v. *Deere*, 54 Ill. 439; *Amoskeag Manufacturing Co.* v. *Trainer*, 101 U. S. Rep. 51; *Avery & Sons* v. *Meikle & Co.*, 27 U. S. Pat. Gaz. 1027; *Burton* v. *Stratton*, 12 Fed. Rep. 696; *Smith* v. *Imus*, 32 Alb. L. J. 455.

(*e*) The case is much the same as that of a maker's name. See *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518.

(*f*) 7 Ch. D. 36.

(*g*) *In re The Dutcher Temple Co.*, U. S. Pat. Comm. Decis. 1871, 248; and see *In re Imbs*, 10 U. S. Pat. Gaz. 463.

(*h*) 2 Brews. 314.

the mistaken interpretation of the expressions used in *Amoskeag Manufacturing Co.* v. *Spear* (*a*), previously referred to.

Numerical figures.

Numerals can only be registered as part of a new mark when combined with some essential particular (*b*); but provision is made for the registration of a single numeral or a combination of numerals, when it was used as an old mark and is special and distinctive, and in America a numeral may be registered as a trade mark (*c*). There does not, however, appear to be any case in which the English Courts have recognised a mere numeral or combination of numerals, standing alone, as sufficiently special and distinctive to constitute a trade mark (*d*); and in *Carver* v. *Bowker* (*e*), Little, V.-C. of Lancaster, held that that could not be; and in *Kinney* v. *Basch* (*f*) and *Burton* v. *Stratton* (*g*) the American Courts seem to have been of the same opinion. The use of numerals is, however, common in some trades, especially in the cotton trade, in which the usual combination marks generally include some arbitrary number or numbers; and there have been cases, in England (*h*), America (*i*) and India (*k*), in which the imitation of numbers has been restrained. In such cases, however, either the numerals have been parts

(*a*) 2 Sandf. S. C. 599.

(*b*) See Patents Act, 1883, § 64, as amended by the Act of 1888.

(*c*) *Ex parte Dawes & Fanning*, 1 U. S. Pat. Gaz. 27; and see *Dawes* v. *Davies*, Dig. 426.

(*d*) In *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518, the imitation of a series of numbers was held to be an important *indicium* of fraud, but the V.-C. did not treat the numbers as a trade mark; on the contrary, he distinguished them from one. See L. R. 1 Eq. 527.

(*e*) Dig. 581. The decision of the V.-C. was affirmed by the Court of Appeal in general terms.

(*f*) Dig. 542.

(*g*) 12 Fed. Rep. 696.

(*h*) *Carver* v. *Pinto Leite*, L. R. 7 Ch. 90; *Carver* v. *Bowker*, Dig. 581; *Broadhurst* v. *Barlow*, W. N. 1872, p. 212; *Robinson* v. *Finlay*, 9 Ch. D. 487.

(*i*) *Gillott* v. *Kettle*, 3 Duer, 624; *Gillott* v. *Esterbrook*, 48 N. Y. 374; *Boardman* v. *Meriden Britannia Co.*, 35 Conn. 402; *Kinney* v. *Basch*, Dig. 542; *Kinney* v. *Allen*, 1 Hughes, 106; *Lawrence Manufacturing Co.* v. *Lowell*, 129 Mass. 325; *India Rubber Comb Co.* v. *Rubber Comb and Jewelry Co.*, 45 N. Y. Super. Ct. 258; *Shaw Stocking Co.* v. *Mack*, 21 Bl. C. C. 1; *American Solid Leather Button Co.* v. *Anthony*, 15 R. I. 338.

(*k*) *Ralli* v. *Fleming*, Ind. L. R. 3 Calc. 417.

of combination marks (*a*), or they have been printed in a special and distinctive colour and configuration (*b*), or they have been selected in so arbitrary a manner that they conveyed no idea of number (*c*), or there has been an evident intention to commit a fraud (*d*); and it is apprehended that if a case were to occur in which the plaintiff's numeral was printed in an ordinary style, and the defendant could show any reason for desiring to use the number in the course of his business, which was not necessarily attributable to a wish to appropriate the plaintiff's custom, no relief would be granted against him.

Combinations of letters and figures.

A special and distinctive combination of letters and figures may also be registered as an old mark, and though the contention may possibly be raised that this does not include a combination of one letter and one figure, as "A 1," or of several letters with one figure (*e*), or of one letter with several figures, the intention of the words is so obviously comprehensive that it does not appear likely that the contention could succeed.

Trade marks under §§ 103 and 104 of Patents Act 1883.

This completes the list of trade marks specifically embraced within § 64 of the Patents Acts, 1883-8; but another possible class should be mentioned. By §§ 103 and 104 of the Act of 1883 subjects or citizens of foreign states or British possessions to which those sections have been made applicable by order in Council are entitled

(*a*) *Carver* v. *Pinto Leite*, L. R. 7 Ch. 90; *Carver* v. *Barker*, Dig. 581; *Broadhurst* v. *Barlow*, W. N. 1872, p. 212; *Robinson* v. *Finlay*, 9 Ch. D. 487; *Boardman* v. *Meriden Britannia Co.*, 35 Conn. 402; *Lawrence Manufacturing Co.* v. *Lowell*, 129 Mass. 325; *Ralli* v. *Fleming*, Ind. L. R. 3 Calc. 417; *Humphreys' Specific Homœopathic Medicine Co.* v. *Wenz*, 14 Fed. Rep. 250.

(*b*) *Kinney* v. *Basch*, Dig. 542; *Kinney* v. *Allen*, 1 Hughes, 106.

(*c*) See *Kinney* v. *Allen*, 1 Hughes, 106; *Shaw Stocking Co.* v. *Mack*, 21 Bl. C. C. 1; *American Solid Leather Button Co.* v. *Anthony*, 15 R. I. 338; and compare *Burton* v. *Stratton*, 12 Fed. Rep. 696, and *In re Eagle Pencil Co.*, 10 U. S. Pat. Gaz. 981, in which registration was refused to numerals which had not been selected with sufficient arbitrariness.

(*d*) *Gillott* v. *Kettle*, 3 Duer, 624; *Gillott* v. *Esterbrook*, 48 N. Y. 374; *Boardman* v. *Meriden Britannia Co.*, 35 Conn. 412; *Kinney* v. *Basch*, Dig. 542.

(*e*) *E.g.*, "H. H. 6," in *Ransome* v. *Bentall*, 3 L. J. Ch. 161; "R. N. 1," in *Ransome* v. *Graham*, 51 *ib.* 897.

to certain privileges in the registration of trade marks; and it is provided that "any trade mark the registration of which has been duly applied for in the country of origin may be registered" under the Act. The wording of this provision appears to leave the comptroller at liberty, so long as the requirements of § 103 or 104 are complied with, to register any mark registered abroad (*a*), whether within § 64 or not; though this cannot be said to be clear, as § 64 says explicitly that "for the purposes of the Act a trade mark *must* consist of or contain at least one" of the specified essential particulars. It will be noticed that the comptroller is not in terms compelled, but only allowed, to register such marks. If the construction placed upon the section should be such as to allow of the registration of such descriptive words as "Syrup of Figs," which were claimed in *In re Californian Fig Syrup Co.* (*b*), a new class of marks may be formed, and the freedom of British subjects to use the English language in its ordinary signification may be materially restricted. The hardship on British subjects who cannot claim the like privileges is likely to be all the greater, that in many foreign countries registration is merely regarded as a record of claim, conferring no rights, so that anything tendered for registration is registered there.

Combination marks.

In some cases protection has been granted to a combination of marks, taken as a whole, notwithstanding that some of the component marks were *publici juris* (*c*); but it has been held in America (*d*) and Victoria (*e*) that a combination of marks, none of which was capable in itself of forming a valid trade mark, could not be claimed. On the other hand, it has been held in Canada

(*a*) See *In re Californian Fig Syrup Co.*, 40 Ch. D. 620.
(*b*) 40 Ch. D. 620.
(*c*) *Carver* v. *Bowker*, Dig. 581; *Robinson* v. *Finlay*, 9 Ch. D. 487, &c.
(*d*) *In re Tolle*, 2 U. S. Pat. Gaz. 415.
(*e*) *Wolfe* v. *Alsop*, 10 Vict. L. R. (Eq.) 41.

that words which separately are *publici juris* may in combination constitute a valid trade mark (*a*).

Official stamps.

An official stamp or brand can never become a private trade mark (*b*).

Colour.

It has been said in many cases that there can be no right of trade mark in the colour of wrappers, labels, &c.; but in the case of trade marks consisting of coloured threads in the Lo er of a piece of stuff (*c*), or in the wick of a candle (*d*), or of the representation of a coin (*e*), the colour may form a material part of the mark, and such marks have been registered by deposit.

Price.

The price of the article to which the trade mark is attached is no part of the trade mark (*f*).

Shape of barrel, &c.

A particular shape of barrel, bottle, box, parcel, &c., containing goods is no trade mark for the goods contained in it (*g*); nor is the representation of such barrel, bottle, box, or parcel a trade mark for such goods (*h*), though the fraudulent imitation of it will be restrained (*i*). Nor is a mechanical convenience not used for purposes of identification, such as a strip of tobacco rolled round the mouthpiece of cigarettes (*k*), nor the general configuration and appearance of a machine (*l*), nor a sampler-pattern (*m*), nor the shape of a plug of tobacco (*n*), or of a stick of

(*a*) *Smith* v. *Fair*, 14 Ont. Rep. 729 ("Red Seal" cigars).

(*b*) *Chase* v. *Mayo*, 121 Mass. 343.

(*c*) *Harter* v. *Souvazoglu*, W. N. 1875, pp. 11, 101; *Carver* v. *Bowker*, Dig. 581; *Mitchell* v. *Henry*, 15 Ch. D. 181; *Robinson* v. *Finlay*, 9 Ch. D. 487.

(*d*) See the Public Stores Act, 1875.

(*e*) *In re Robinson*, 29 W. R. 31. See Patents Act, 1883, § 67.

(*f*) *In re Steedman*, L. J. N. of C. 1883, p. 83.

(*g*) *Moorman* v. *Hoge*, 2 Sawy. 78 (a barrel); *Harrington* v. *Libby*, 14 Bl. C. C. 128 (a collar box); *Sawyer* v. *Horn*, 4 Hughes, 239; *Ball* v. *Siegel*, 116 Ill. 137. See *In re Kane & Co.*, 9 U. S. Pat. Gaz. 105, and *Manhattan Medicine Co.* v. *Wood*, 108 U. S. Rep. 218.

(*h*) *Ex parte Halliday Brothers*, 16 U. S. Pat. Gaz. 500.

(*i*) *Cook* v. *Starkweather*, 13 Abb. Pr. N. S. 392.

(*k*) *In re Gordon*, 12 U. S. Pat. Gaz. 517.

(*l*) *Fairbanks* v. *Jacobus*, 14 Bl. C. C. 337; *Wilcox & Gibbs Sewing Machine Co.* v. *Gibbon's Frame*, 21 Bl. C. C. 431; *Brill* v. *Singer Manufacturing Co.*, 41 Ohio St. 127.

(*m*) *In re Parker*, 13 U. S. Pat. Gaz. 323.

(*n*) *Liggett & Myers Tobacco Co.* v. *Hynes*, 20 Fed. Rep. 883.

chewing-gum (*a*), nor a manner of packing, in boxes, cakes of soap wrapped in differently coloured paper wrappers (*b*), nor the use of a tin tag or ticket, irrespective of its shape and contents (*c*), a trade mark; though a tin tag of a special shape, size and colour may be (*d*). But where the mark is "something different from the article itself which the mark designates" (*e*), such as a stick placed in a roll of carpet, showing an octagonal ring at each end (*f*), or a band attached to cigar-boxes (*g*), and is special and distinctive, and not in common use, then it may be recognised as a good trade mark, notwithstanding that it is not attached to the goods in the usual way.

Mark may be consumed with the article.

If a mark is in other respects a good trade mark, the fact that it is consumed with the article to which it is attached is no objection to its validity (*h*).

(*a*) *Adams* v. *Heisel*, 31 Fed. Rep. 279.
(*b*) *Davis* v. *Davis*, 27 *ib.* 490.
(*c*) *Lorillard* v. *Pride*, 28 *ib.* 434.
(*d*) *Lorillard* v. *Wight*, 15 *ib.* 383.
(*e*) Per Johnson, J., in *Fairbanks* v. *Jacobus*, 14 Bl. C. C. 337.
(*f*) *Lowell Manufacturing Co.* v. *Larned*, Dig. 428.
(*g*) *Ex parte Straiton & Storm*, 18 U. S. Pat. Gaz. 923.
(*h*) *In re Gordon*, 12 U. S. Pat. Gaz. 517; and see *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 441.

CHAPTER III.

ACQUISITION, TRANSFER, AND DISCONTINUANCE OF TRADE MARKS.

1. *Acquisition.*

Who may acquire.

As a general rule, any person capable of acquiring any other species of property is capable of acquiring a right to a trade mark, and this is equally the case with artificial persons, as corporations (*a*), as with physical persons, or individuals.

Aliens.

A question has, however, been raised as to whether an alien was capable of acquiring a right to a trade mark, but when raised was at once finally decided by Wood, V.-C., in accordance alike with justice and expediency. The plaintiffs in *Collins Co.* v. *Cowen* (*b*), were an American firm of edge-tool manufacturers, whose trade marks appear to have been systematically infringed by English rivals. In the case in question the defendants, who had copied the plaintiffs' stamp of "Collins Co., Hartford, cast steel, warranted," demurred. The Vice-Chancellor overruled the demurrer, and observed in the course of his judgment, "I apprehend that every subject of every country, not being an alien enemy—and even to an alien enemy the Court has extended relief in cases of fraud—has a right to apply to this Court to have a fraudulent injury to his property arrested. And here the plaintiffs have the right—a right recognised, I imagine, everywhere in the world, or at least in every civilised community—of

(*a*) See Patents Act, 1883, § 117, for definition of "person."

(*b*) 3 K. & J. 428.

saying, 'We, being the manufacturers of certain goods, claim that another man shall not manufacture goods and put upon them our trade mark, and then pass them off as manufactured by us.' It would be most grievous if any Court should hold that there was an incapacity of affording relief in a case where a fraud has been committed upon a subject of any country. I speak, of course, of a fraud so far connected with property as to be not a shadowy but a substantial injury. If you use the name of another for the purpose of securing to yourself, in the disposition of property, advantages which belong to him, the fraud is complete, and the remedy ought to be complete, as in the case of a libel, where the action is allowed to a foreigner. I cannot in my own mind entertain the slightest misgiving in this case, whether it be new or not" (*a*).

Where no user in England.

When no goods bearing the foreign trade mark have been sold in this country, the trade mark can have acquired here no reputation for its foreign owner, so that it would appear doubtful whether the protection extended to foreign trade mark owners should be afforded in cases where there has been no user in this country, and the mark does not expressly state a foreign origin. In such a case the first person to use the mark in the United Kingdom is the first person to gain a reputation for it here (*b*). But foreign

(*a*) See also *Collins Co.* v. *Brown*, 3 K. & J. 423; *Collins Co.* v. *Walker*, 7 W. R. 222; *Collins Co.* v. *Reeves*, 28 L. J. Ch. 56; *Howe* v. *McKernan*, 30 Beav. 547. So in Scotland the trade marks or names of American manufacturers have been protected: *Singer Manufacturing Co.* v. *Kimball & Morton*, Ct. Sess. Cas., 3rd Ser. XI. 267. The same rule obtains in America: *Taylor* v. *Carpenter*, 3 Story, 458; R. Cox, 14; Same *v.* Same, 2 Wood. & M. 1; R. Cox, 32; Saine *v.* Same, 11 Paige, 292; R. Cox, 45; *Coats* v. *Holbrook*, 2 Sandf. Ch. 586; R. Cox, 20; *Lemoine* v. *Ganton*, 2 E. D. Smith, 343; R. Cox, 142; *Lacroix* v. *May*, 15 Fed. Rep. 236. And the infringement of a British trade mark has been criminally punished in Missouri: *State of Missouri* v. *Gibbs*, 56 Mo. 133. In India protection is afforded to British trade marks: *Orr-Ewing* v. *Chooneeloll Mullick*, Cor. 150; *Orr-Ewing* v. *Grant, Smith & Co.*, 2 Hyde, 185; and in Canada also the trade marks of aliens are protected: *Davis* v. *Kennedy*, 13 Grant, Up. Can. Ch. 523.

(*b*) See *In re Münch*, 50 L. T. N. S. 12; *In re Riviere & Co.*, 26 Ch. D. 48; *In re Leonard & Ellis*, *ib.* 288, per

or colonial marks can be registered in England under § 103 or 104 of the Patents Act, 1883, and registration is equivalent to public use (*a*).

Sovereigns.

It seems that there is nothing to prevent sovereign princes or states from being the proprietors of trade marks in respect of goods manufactured or produced on their account (*b*).

Officials.

A person in an official position, using an official stamp in his official capacity, cannot thereby acquire any private right therein (*c*).

Agents.

Nor can an agent acquire any interest in his principal's mark from the fact that he has used it (*d*); nor a printer in the trade mark of a mercantile firm from the fact that he has been employed to print it (*e*).

Artisans.

In America the question has been much discussed whether the members of an artisans' trade society were entitled to claim an exclusive right in a label supplied by the society to its members, and affixed by them to goods manufactured by them, for the purpose of showing that such goods had been manufactured by members of the society. The objection which was raised to the claim was, that the members of the society did not manufacture or deal in the goods on their own account, but were merely workmen in the employment of various firms, whose product the goods were, and not that of the workmen, and in some cases this objection has prevailed (*f*), but in the majority of the cases the decision has been in favour of the society, on the ground that its members

Fry, L. J.; *Berliner, &c., Tivoli* v. *Knight Stocks & Co.*, W. N. 1883, p. 70; *Jackson & Co.* v. *Napper*, 35 Ch. D. 162; *Newman* v. *Pinto*, 57 L. T. N. S. 31, per Kekewich, J.; *Smith* v. *Fair*, 14 Ont. Rep. 729.

(*a*) Patents Act, 1883, § 75.

(*b*) See *Ex parte King of Saxony*, Dig. 598; *Republic of Peru* v. *Reeves*, 40 N. Y. Super. Ct. 316.

(*c*) *Chase* v. *Mayo*, 121 Mass. 343.

(*d*) *Hirsch* v. *Jonas*, 3 Ch. D. 584; *Swift* v. *Peters*, 11 U. S. Pat. Gaz. 1110.

(*e*) *Schumacher & Ettlinger* v. *Schwenke* (2), 36 U. S. Pat. Gaz. 457.

(*f*) *Ex parte Cigar Makers' Association*, 16 U. S. Pat. Gaz. 958; *Schneider* v. *Williams*, 44 N. J. Eq. 391.

were entitled to protection for the insignia which secured to them the benefit of their skilled labour (*a*).

Length of user formerly required.

There was for some time a doubt as to the circumstances under which one person could acquire a sufficient right in a trade mark to be entitled to restrain another from infringing it. The right to redress being treated as founded on the defendant's fraud, it was thought that a plaintiff who claimed an injunction against a defendant ought to show that he (the plaintiff) had acquired for the mark indicating his manufacture such a reputation (*b*) as would raise a presumption that the defendant in adopting a similar mark had done so with the intention of availing himself of that reputation to divert to himself the plaintiff's custom, or at all events that the plaintiff ought to show that he had used the mark long enough to render it probable that such a reputation had been acquired (*c*).

Latterly considered unnecessary.

But when it came to be recognised that there was a right of property in a trade mark, intentional fraud being unnecessary to justify restraint, it was at once seen that, as was stated by Romilly, M. R., "the interference of a Court of Equity could not depend on the length of time the manufacturers had used it" (*d*), but that, "from the time of their commencing the user of their trade mark they became entitled to the protection of the Court against any other persons using the same, so that purchasers might be induced to purchase the goods of other persons

(*a*) *Strasser* v. *Moonelis*, 108 N. Y. 611; *Allen* v. *Macarthy*, 37 Minn. 347; *People* v. *Fisher*, 57 N. Y. Sup. Ct. 552; *Bloete* v. *Simon*, 19 Abb. N. C. 88.

(*b*) In *Hine* v. *Lart*, 10 Jur. 106, Shadwell, V.-C. of England, thought that the imitation by a defendant of a plaintiff's trade mark afforded a presumption of that mark having acquired a reputation. And see *Dixon* v. *Jackson*, Ct. Sess. Cas., 3rd Ser. V. 326, per the Lord Justice Clerk: *Alleghany Fertiliser Co.* v. *Woodside*, 1 Hughes, 115, and *Avery & Sons* v. *Meikle & Co.*, 27 U. S. Pat. Gaz. 1027.

(*c*) See *Purser* v. *Brain*, 17 L. J. Ch. 141; *Edelsten* v. *Vick*, 11 Hare, 78; *Collins Co.* v. *Brown*, 3 K. & J. 423; and compare *Spottiswoode* v. *Clarke*, 2 Ph. 154.

(*d*) *Hall* v. *Barrows*, 32 L. J. Ch. 548.

as theirs" (*a*). "As soon as a trade mark has been so applied in the market as to indicate to purchasers that the goods to which it is attached are the manufacture of a particular firm, it becomes, to that extent, the exclusive property of the firm, and no one else has a right to copy it, or even to appropriate any part of it, if by such appropriation unwary purchasers may be induced to believe that they are getting goods which were made by the firm to whom the trade mark belongs" (*b*). There must, however, have been a real user (*c*).

Wrongful user gives no title.

Even, however, if user be established, extending over a considerable period, it does not follow that a title to the trade mark is made out; for if the user was fraudulent in its inception, and is still calculated to deceive, the user gives no right (*d*); and it has been held in America that if A has been using a trade mark which was really the property of B, and then B ceases to use it, A cannot acquire any title to the mark by continuing to use it after B's discontinuance, on account of the wrongful inception of his user (*e*).

Acquisition by common repute.

In *Siegert* v. *Findlater* (*f*), it was even held that the

(*a*) Per Hall, V.-C., in *Cope* v. *Evans*, L. R. 18 Eq. 138; and see *Orr-Ewing & Co.* v. *Grant, Smith & Co.*, 2 Hyde, 185; *Yale Cigar Manufacturing Co.* v. *Yale*, 30 U. S. Pat. Gaz. 1183. This principle does not appear to be universally recognised in America. See *Seltzer* v. *Powell*, 8 Phila. 296. In *Sternberger* v. *Thalheimer*, 3 U. S. Pat. Gaz. 120, it was held that prior registration and prior use of about six days, but only on a few articles by way of experiment, by one manufacturer, did not disentitle another to registration, he having systematically used the mark for some time before his rival had seriously adopted it. It is the adoption and use, not the invention, of the mark that gives a title to it: *Swift* v. *Peters*, 11 U. S. Pat. Gaz. 1110; *Hoosier Drill Co.* v. *Ingels*, 14 *ib.* 785; *Leidersdorf* v. *Flint* (1), 8 Biss. 327; *McLean* v. *Fleming*, 96 U. S. Rep. 245; *U. S.* v. *Steffens*, 100 *ib.* 82; and a trade mark may have been in part purchased and in part invented: *Sohl* v. *Geisendorf*, 1 Wils. (Ind.) 60.

(*b*) Per the Privy Council in *Somerville* v. *Schembri*, 12 App. Cas. 453.

(*c*) *Humphries* v. *Taylor Drug Co.* (2), 59 L. T. N. S. 820.

(*d*) *In re Heaton*, 27 Ch. D. 570.

(*e*) *O'Rourke* v. *Central City Soap Co.*, 26 Fed. Rep. 576; *Parlett* v. *Guggenheimer*, 67 Md. 542.

(*f*) 7 Ch. D. 801. And see *In re Barker & Son*, 53 L. T. N. S. 23; *Smith* v. *Woodruff*, 48 Barb. 438; *Rowley* v. *Houghton*, 2 Brews. 303; *Degraves* v. *Whiteman*, 5 Vict. L. R. Eq. 304.

plaintiffs were entitled to restrain the defendant from using the term "Angostura Bitters," although the defendant had used it on his labels before the plaintiffs had done so, on the ground that, before the plaintiffs had themselves used the term, it had become attached to their article in common parlance. But acquisition of a trade mark by common repute has not been universally recognised (*a*).

How property in a trade mark acquired.

Lord Westbury, C., said, in *McAndrew* v. *Bassett* (*b*), that the elements of the right to property in a trade mark might be represented as being the fact of the article being in the market as a vendible article with that stamp or trade mark at the time when the defendants imitated it; and he went on: "The essential qualities for constituting that property probably would be found to be no other than these: first, that the mark has been applied by the plaintiffs properly (that is to say, that they have not copied any other person's mark, and that the mark does not involve any false representation) (*c*); secondly, that the article so marked is actually a vendible article in the market; and, thirdly, that the defendants, knowing that to be so, have imitated the mark for the purpose of passing off in the market other articles of a similar description" (*d*).

The mark must be on a vendible article.

From this judgment it follows, and it was expressly recognised in *Maxwell* v. *Hogg* (*e*), that no property could be acquired in a trade mark, except through the process of sale, or offering for sale, in the market, of the article to which the trade mark was affixed (*f*). And in the last-

(*a*) See *Blackwell* v. *Armistead*, 5 Amer. L. T. 85; *Lorillard* v. *Pride*, 28 Fed. Rep. 434.

(*b*) 4 De G. J. & S. 380.

(*c*) Compare §§ 72, 73, 86 of the Patents Act, 1883. And see *In re Heaton*, 27 Ch. D. 570, and *O'Rourke* v. *Central City Soap Co.*, 26 Fed. Rep. 576; with which compare *Symonds* v. *Greene*, 28 Fed. Rep. 834.

(*d*) Compare remarks of Lord Kingsdown in the *Leather Cloth Companies' case*, 11 H. L. C. 523.

(*e*) L. R. 2 Ch. 307.

(*f*) And see per Willes, J., in *Lawson* v. *Bank of London*, 18 C. B. 84. Also *Civil Service Supply Association* v. *Dean*, 13 Ch. D. 512; *In re Simpson, Davies & Sons*, M. R., Jan. 12th, 1881; *Wheeler* v. *Johnston*, 3 L. R. Ir. 284; *Rowley* v. *Houghton*, 2 Brews. 303, R. Cox, 486; *Bowman* v. *Floyd*, 85 Mass. 76; *McLean*,

mentioned case it was held that no expenditure during the course of manufacture in advertisements or other announcements to the public of the article so in course of manufacture could give any right in the mark or name by which it was intended that the article should be known when completed and in the market (*a*). Moreover, user must be as of a trade mark, and not as of a mere descriptive term (*b*).

Acquisition by registration.

By the Trade Marks Registration Act, 1875, now repealed, a new manner of acquiring a right to a trade mark was introduced, and with respect to new marks substituted for the earlier method. By the Patents Acts, 1883-8 (*c*), which have now taken the place of the Act of 1875, no infringement of a registrable trade mark can be restrained or civilly punished, unless the mark has been registered. For five years after registration the fact of registration is *primâ facie* evidence of the right of the registered proprietor to the exclusive use of the trade mark (*d*), or, in other words, it qualifies him for taking proceedings against infringers (*e*); after five years have expired from the date of registration, the fact of registration becomes conclusive evidence of his right to the mark (*f*) in any

v. *Fleming*, 96 U. S. Rep. 245; *St. Louis Piano Manufacturing Co.* v. *Merkel*, 1 Mo. App. 305; *Avery & Sons* v. *Meikle & Co.*, 27 U. S. Pat. Gaz. 1027; *Yale Cigar Manufacturing Co.* v. *Yale*, 30 U. S. Pat. Gaz. 1183; *Schneider* v. *Williams*, 44 N. J. (Eq.) 391; *Jaeger's, &c., Co.* v. *Le Boutillière*, 54 N. Y. Sup. Ct. 521; *McCall* v. *Theal*, 28 Grant Up. Can. Ch. 48; *Rogers Manufacturing Co.* v. *Rogers & Spurr Manufacturing Co.*, 11 Fed. Rep. 495; *Sheppard & Co.* v. *Stuart & Peterson*, 13 Phila. 117. As to the difficulty of acquiring a right of trade mark in a name applied to a patented article, see p. 59, *ante*.

(*a*) And see *Civil Service Supply Association* v. *Dean*, 13 Ch. D. 512; and *Schneider* v. *Williams*, 44 N. J. (Eq.) 391.

(*b*) *In re Leonard & Ellis*, 26 Ch. D. 288; *In re Harrison, McGregor & Co.*, 42 Ch. D. 691.

(*c*) § 77; and see *Goodfellow* v. *Prince*, 35 Ch. D. 9.

(*d*) § 76; and see *Reinhardt* v. *Spalding*, 49 L. J. Ch. 57; *Wheeler* v. *Johnston*, 3 L. R. Ir. 284.

(*e*) *Nuthall* v. *Vining*, C. A. Jan. 21st, 1880; *Mouson & Co.* v. *Boehm*, 26 Ch. D. 398. In the case of *Morse* v. *Martin*, Quebec Super. Ct. Feb. 28th, 1882, it was held that the corresponding Canadian statute gave no right of action for anything done before registration. But the Quebec Court of Queen's Bench did not decide the point: 3 Dorion 353.

(*f*) § 76. This is, however, subject to the provisions of the Act, *e.g.*, as to the connection with the goodwill: § 70.

action brought by him (*a*), though the mark is still liable to removal from the register in proceedings taken for that purpose, if it was registered wrongfully (*b*). Registration protects the trade mark in all sizes and in all colours, whether registered in colour (*c*) or not (*d*). In the case of trade marks in use before August 13th, 1875, application must be made for registration, and if that is refused, a certificate of refusal will preserve to the applicant whatever rights he would have had independently of the Act (*e*).

Registration before user.

In several cases (*f*) doubts were expressed whether a trade mark could be registered before it had been used, the doubt being founded on the old principle that a right in a trade mark could only be acquired by its being attached to vendible goods in the market, until which was the case user by others could lead to no deception; but these doubts were set at rest in *In re Hudson* (*g*), where the Court of Appeal came to a clear decision that registration before user was allowable.

Goods classified.

A trade mark must be registered as belonging to particular goods or classes of goods (*h*), as arranged in the Third Schedule to the Rules; the class to which the goods belong being determined, in case of doubt, by the comptroller (*i*). This requirement is no alteration of the rules of the pre-existing law, but is merely a statement of one of those rules as bearing upon registration under the Act. It had been already fully recognised that a particular trade mark could be protected as such

(*a*) *Edwards* v. *Dennis*, 30 Ch. D. 454.

(*b*) *In re Palmer* (1), 21 Ch. D. 47; S. C. (3) 24 *ib.* 504; *In re Leonard & Ellis*, 26 Ch. D. 288; *In re Lloyd & Sons*, 27 Ch. D. 646; *In re Wragg*, 29 Ch. D. 551; *Edwards v. Dennis*, 30 Ch. D. 454; *Wood* v. *Lambert*, 32 Ch. D. 247; *In re Spencer*, 54 L. T. N. S. 659. And so in Victoria: *Lewis* v. *Klapproth*, 11 Vict. L. R. 214; *Wolfe* v. *Alsop* (2), 12 Vict. L. R. (E.) 421; *Wolfe* v. *Lang & Co.*, 13 Vict. L. R. 752.

(*c*) See § 67.

(*d*) *Nuthall* v. *Vining*, C. A. Jan. 21st, 1880.

(*e*) § 77.

(*f*) *In re Anderson*, 54 L. J. Ch. 1084; *Edwards* v. *Dennis*, 30 Ch. D. 454; *In re Lyndon*, 32 Ch. D. 109.

(*g*) 32 Ch. D. 311.

(*h*) § 65. (*i*) Rule 6.

only in connection with particular goods or classes of goods. Thus Lord Westbury, C., says, "Property in a trade mark is the right to the exclusive use of some mark, name, or symbol in connection with a particular manufacture or vendible commodity; consequently the use of the same mark in connection with a different article is not an infringement of such a right of property" (*a*). And again, "An ironfounder who uses a particular mark for his manufactures in iron could not restrain the use of the same mark when impressed upon cotton or woollen goods; for the property in a trade mark consists in the exclusive right to the use of that mark as applied to some particular manufacture" (*b*). And V.-C. Wood similarly says, that "this Court has taken upon itself to protect a man in the use of a certain trade mark as applied to a particular description of article. He has no property in that mark, *per se*, any more than in any other fanciful denomination he may assume for his own private use, otherwise than with reference to his trade. If he does not carry on a trade in iron, but carries on a trade in linen, and stamps a lion on his linen, another person may stamp a lion on iron; but when he has appropriated a mark to a particular species of goods, and caused his goods to circulate with this mark upon them," his right to the mark so applied will be protected (*c*).

Limit of rights acquired by user.

As a result of the rule that a trade mark can only be acquired by user in respect of the goods on which it has been used, it has been decided that the use of a mark

(*a*) *Leather Cloth Co.* v. *American Leather Cloth Co.*, 4 De G. J. & S. 137.

(*b*) *Hall* v. *Barrows*, 4 De G. J. & S. 150.

(*c*) *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518; and see *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434-43; *Merchants' Banking Co. of London* v. *Merchants' Joint Stock Bank, Limited*, 9 *ib.* 560; *Colladay* v. *Baird*, 4 Phila. 139; R. Cox, 257; *Rowley* v. *Houghton*, 2 Brews. 303; R. Cox, 486; *Amoskeag Manufacturing Co.* v. *Garner*, 55 Barb. 151; R. Cox, 541; *Colman* v. *Crump*, 70 N. Y. 573; *Société Anonyme, &c.*, v. *Baxter*, 14 Bl. C. C. 261.

before August 13th, 1875, on certain descriptions of goods gives no right to have it registered in respect of other descriptions of goods, except as a new mark; so that although the mark may have been long used in respect of some goods, it will be refused registration in respect of different goods or classes of goods (though of a somewhat similar character), if it conflicts with another mark already registered therein (*a*), or if for any reason it is not registrable as a new mark. If, however, it has been used for goods which, though not identical, were yet substantially the same as those for which it is claimed, registration may be allowed (*b*). And it has been held in America, with apparently good reason, that a mark which is descriptive, and therefore incapable of registration, when applied to one variety of goods, may be open to no such objection when applied to another variety of goods (*c*). Similarly, a mark may be in general use in connection with a variety of goods, and yet be perfectly good and distinctive in connection with particular goods on which there has been no such user. Thus it has been said in the Privy Council (*d*) that "the acquisition of an exclusive right to a mark or name in connection with a particular article of commerce cannot entitle the owner of that right to prohibit the use by others of such mark or name in connection with goods of a totally different character, and such use by others can as little interfere with his acquisition of the right."

New user of old mark may be infringement.

As a consequence of the rule that user only gives a right to the mark in respect of the goods for which it has been used, the user of a mark in connection with goods different from those in respect of which it has previously been

(*a*) *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *Edwards* v. *Dennis*, 30 Ch. D. 454; and see *In re Braby & Co.*, 21 Ch. D. 223; also *In re Lyndon*, 32 Ch. D. 109, per Pearson, J., and the American case of *Ex parte King* (2), 46 U. S. Pat. Gaz. 119.

(*b*) *Jackson & Co.* v. *Napper*, 35 Ch. D. 162; and compare *Collins Co.* v. *Ames & Sons*, 20 Bl. C. C. 542.

(*c*) *In re English*, U. S. Pat. Comm. Decis. 1870, 142; *In re Dick & Co.*, 9 U. S. Pat. Gaz. 538.

(*d*) *Somerville* v. *Schembri*, 12 App. Cas. 453.

used, though of a somewhat similar character, may amount to an infringement of the rights of another person who has had an earlier user in respect of those different goods. Thus in *Moses* v. *Sargood* (*a*) it was held to be an infringement of the plaintiffs' rights for the defendants, who had previously only exported goods unmade up, and used their trade mark upon such goods, to begin to export and to use their trade mark upon ready-made clothing, having regard to the fact that the plaintiffs had been in the habit of exporting and using a somewhat similar trade mark upon made-up goods. And in *Upper Assam Tea Co.* v. *Herbert & Co.* (*b*) the proprietors of a mark which had been used and registered for coffee were restrained from applying it to tea, though in the same class, having regard to the fact that a similar mark had been used and registered for tea by another firm.

Wide registration, but limited user.

Again, though by § 75 of Patents Act, 1883, registration (*c*) of a trade mark is to be deemed to be equivalent to public use of the trade mark, it has been held by the Court of Appeal that if a trader has registered a mark for a variety of goods, and has only used it in connection with some of them, he is not entitled to restrain the use by another trader of a somewhat similar mark in connection with the goods for which his mark has not been used (*d*).

Mark only protected for goods for which registered.

Another question which has been raised, bearing on this point, is whether a mark which has been registered for some of the goods in a class can be protected for other goods in the class, as having been used in respect of them; and it would seem that, having regard to § 65, by which a trade mark must be registered for particular goods or classes of goods, a trade mark which is registered only for particular goods in a class is not registered for other goods, whether in the same or a different class, and consequently

(*a*) Dig. 636.
(*b*) C. A., July 3rd, 1889.
(*c*) Now "application for registration," § 17 of P. A. 1888.
(*d*) *Edwards* v. *Dennis*, 30 Ch. D. 454.

that by § 77 (*a*) it is deprived of any right to protection in respect of such other goods; and in *Hart* v. *Colley* (*b*), North, J., decided in favour of the view here suggested. In *Jay* v. *Ladler* (*c*) it was held that the mark could be protected in respect of such other goods; but full effect does not appear to have been given to the sections above mentioned.

Provisions in the Patents, &c., Acts and Rules.

By § 72 the registration of a mark identical with, or nearly similar to a mark already registered, is prohibited, not generally, but in connection with such goods or description of goods as those in respect of which the mark already on the register is registered. And, with a view to the protection of the public, this prohibition is extended over a period of one year after the removal of the mark once registered from the register for non-payment of a continuance fee, during which period of one year the removed mark in question is to be still deemed to be registered for this purpose only (*d*).

Steps necessary to obtain registration: The application.

A person desirous of having his trade mark registered must send an application to the comptroller in the prescribed form (*e*), together with the prescribed number (*f*) of representations (*g*) of the trade mark. When a representation cannot be given in the usual manner, a specimen or copy of the trade mark may be supplied instead (*h*). The application must state the particular goods or classes of goods in connection with which the applicant desires the trade mark to be registered (*i*). Words in other than

(*a*) See *Goodfellow* v. *Prince*, 35 Ch. D. 9.

(*b*) 44 Ch. D. 193.

(*c*) 40 Ch. D. 649.

(*d*) § 79 (5), as amended by § 19 of the Act of 1888, *q.v.*

(*e*) Form F in the Second Schedule to the Rules. See § 62 (2) and Rules 4, 5, 11, 12.

(*f*) Three, except when the application is in respect of goods in classes 23 to 35, *i.e.*, the textile classes. In such a case four representations must be sent. In either case one of the representations is to be placed on the application form. See Rule 13. When the application is for the registration of a series of marks under § 66, the case will be governed by Rule 14.

(*g*) For form of Additional Representation, see Form G. See also § 62 (3).

(*h*) See Rule 13.

(*i*) § 62 (3).

Roman character must have a translation supplied (*a*). Applications for registration in classes 23, 24, or 25, are to be sent to the Manchester Branch Office (*b*).

When mark is an old mark

When the mark is claimed as an old mark—*i.e.*, a mark used before the passing of the Trade Marks Registration Act, 1875 (August 13th, 1875)—the facts as to such prior user are to be stated (*c*), but no statutory declaration is now required, as was formerly the case. In such cases it is essential that the mark should be claimed and registered precisely in the form in which it has been used (*d*).

When by firm.

When the application is made by a firm or partnership it may be signed by some one or more members of the firm or partnership, as the case may be (*e*).

When by a body corporate.

When the application is made by a body corporate, it may be signed by the secretary or other principal officer of such body corporate (*e*).

Manner of making application.

The application and all other communications between the applicant and the comptroller may be made by or through a duly authorised agent (*f*), and may be sent by a prepaid letter through the post (*g*). If the applicant is abroad at the time of his application, and is not claiming under an international convention, he must give an address for service within the United Kingdom (*h*).

Advertisement, &c.

All that remains to be done by the applicant for registration, after sending in his application, is to await an acknowledgment of its receipt by the comptroller (*i*), and then to furnish the comptroller with the means of inserting in the official paper the necessary advertisement of the application (*k*).

Registration.

At the expiration of one month from the date of the

(*a*) Rule 15.
(*b*) Rule 8.
(*c*) Rule 11.
(*d*) See p. 49, *suprà*, and note (*l*) to § 64 of P. A. 1883.
(*e*) Rule 7.
(*f*) Rule 9.
(*g*) § 97 and Rule 16.
(*h*) § 8 of Act of 1888.
(*i*) Rule 10.
(*k*) § 68 and Rules 27-30.

advertisement, and subject to any proceedings which may have been taken, the comptroller is, if satisfied of the applicant's title, to register the trade mark (*a*) as from the date of the receipt of the application for registration (*b*), and upon registration is to send notice thereof to the registered proprietor with a reference to the advertisement (*c*).

In case of applicant's death.

If an applicant dies between application and registration the registration may be completed in the name of the successor to the goodwill of his business (*d*).

Sheffield and cotton marks.

Trade marks applied for in respect of goods within the Cutlers' Company's Acts (*e*) are governed by special rules (*f*); but marks on cotton goods, even B list marks, are for the future to be dealt with on the same footing as other trade marks. The only special requirements in the case of cotton marks are for the name by which the mark would be referred to in invoices to be stated (*g*), and for three additional representations to be sent instead of two (*h*), and for applications to be made at Manchester (*i*).

Series of marks.

Where it is desired to register a number of trade marks which, while resembling each other in the material particulars thereof (*k*), yet differ in respect of statements of the goods for which they are to be used, or of numbers, or price, or quality, or names of places, they may be registered as a series in one registration, each of the marks being treated as separately registered, except for purposes of assignment and transmission (*l*).

Common marks.

Additions which are common to the trade may, in accordance with the provisions of § 74, as amended by

(*a*) Rule 32.
(*b*) § 17 of the Act of 1888.
(*c*) Rule 35.
(*d*) Rule 33.
(*e*) See Appendix G, *infrà*.
(*f*) § 81 as amended by § 20 of the Act of 1888, and Rules 56-59.
(*g*) Instructions, par. 14.
(*h*) Rule 13.
(*i*) Rule 8.
(*k*) See § 64 as to essential particulars.
(*l*) § 66 and Rules 14, 30. This is new as an enactment, but the practice is not new. See note (*a*) to § 66, and note (*c*) to § 72, *infrà*.

§ 16 of the Act of 1888, be registered together with trade marks, but such common elements must be disclaimed by the applicant (*a*).

Alternative marks.

No provision is made in the Patents Act, 1883, for registering alternative marks, as has sometimes been done in America, *e.g.*, where a trade mark was registered as consisting either of the figure of a lion, or the word "lion," or both (*b*).

Colour.

Trade marks may now be registered in colour, and the effect of such registration is no longer to limit the protection conferred by registration to the one colour in which the registration has been effected (*c*).

Registration by deposit.

Provision is made by the Rules for registration by deposit in cases where such a course is rendered necessary by the nature of the trade mark (*d*).

Refusal to register.

Registration is by no means a necessary consequence of application. The comptroller may refuse to grant registration if he thinks fit (*e*), or if he thinks the use of the mark would be contrary to law or morality (*f*), and he must refuse registration where the same or a similar mark is already registered for the same goods (*g*), or where words inherently calculated to deceive are offered for registration (*h*). Where the refusal is made in the exercise of a discretion vested in the comptroller, he is not to exercise that discretion adversely to the applicant until he has had an opportunity of being heard personally, or by his agent (*i*), and if he does, in his discretion, refuse to register, there is an appeal to the Board of Trade (*k*),

(*a*) The practice of requiring common parts of marks or additions to marks to be disclaimed is not new. See per Jessel, M. R., in *In re Kuhn & Co.*, 53 L. J. Ch. 238; and per Kay, J., in *In re Hayward & Sons*, 54 L. J. Ch. 1003; and *In re Davies*, before Chitty, J., March 9th, 1885. Also notes to § 74, and note (*c*) to § 72, *infrà*.

(*b*) *In re Weaver*, 10 U. S. Pat. Gaz. 1.

(*c*) See § 67 and note thereto, *infrà*.

(*d*) Rules 13, 27. And see note to § 67.

(*e*) § 62 (4).

(*f*) § 86.

(*g*) § 72. (*h*) § 73.

(*i*) § 94 and Rules 17-19.

(*k*) § 62 (4). See Rules 20-26.

who may, if they think fit, refer the appeal to the Court *a*).

Opposition to application.

Even if the comptroller is willing to treat the application as unobjectionable, any person (*b*) may give notice of opposition at the Patent Office within one month or such further time, not exceeding three months, as the comptroller may allow, after the advertisement, and the applicant is then allowed one month for sending in a counter-statement, or the registrar may extend the time. If no such counter-statement is sent, the application is deemed to be withdrawn; if it is sent, the person giving notice of opposition will be furnished with a copy of it, and the comptroller will then hear the case (*c*); but his decision is to be subject to an appeal to the Board of Trade (*d*), who may, if it appears expedient, refer the appeal to the Court (*e*).

Limited registration.

In deciding whether registration is to be allowed or not, the Court will frequently grant the application in such a limited form as to obviate the risk of its clashing with the

(*a*) § 62 (5). "The Court" is the High Court of Justice (§ 117), the Chancery Division being no longer specified; but recourse will, no doubt, still be had to that Division. In the case of applications at the Manchester Office "the Court" is the Lancaster Palatine Chancery (§ 26 of the Act of 1888). When the registration is objected to on the ground that the mark tendered for registration is not qualified for registration, "the first duty cast upon the Court is to ascertain whether some one or more than one of the essential particulars of a trade mark, as defined by the Act, is found to exist, so that the mark may be described with the one or more than one essential particular or particulars which distinguish it." Per Lord Cairns, C., in *Orr-Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 484.

(*b*) It need not be the proprietor of a registered mark. In *In re Simpson, Davies & Sons*, M. R., Jan. 12th, 1881, the proprietors of a trade mark registered for coal in class 4 successfully opposed the registration of a similar mark for railway waggons in class 22, the opponent's coal being carried in and sold out of waggons.

(*c*) The practice in such case is prescribed by Rule 31.

(*d*) See Rules 20-26.

(*e*) § 69 as amended by § 13 of the Act of 1888, which for the first time gave the comptroller jurisdiction in such cases. As to the old practice, see *Ex parte Stephens*, 24 W. R. 819; *In re Salamon*, Dig. 569; *In re Johnston*, 43 L. T. N. S. 672; *In re Simpson, Davies & Sons*, 15 Ch. D. 525. As to costs, see *In re Brandreth*, 9 Ch. D. 618; *In re Australian Wine Importers, Ld.*, 41 Ch. D. 278.

mark which it is considered to resemble (*a*). Thus registration has been granted in such a form as to be partial in respect of the mark itself which is registered (*b*), or of the goods for which it is registered (*c*), or of the manner of user in respect of colour (*d*), or otherwise (*e*), or of the locality within which it is to be used (*f*), or of the persons against whom it is to be protected (*g*).

Conflicting claims.

Again, where each of several persons claims the same trade mark the comptroller may refuse to register any of them until their rights have been determined according to law, and he may himself submit or require the claimants to submit their rights to the Court (*h*) in the form (unless the Court shall otherwise order) of a special case (*i*), agreed to by the parties, or, in case of difference, settled by the comptroller (*k*).

Issue may be directed.

In any proceeding for rectification of the register, the Court may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved (*l*).

Alteration of registered trade mark.

Subsequently to registration clerical errors may be corrected by the comptroller (*m*), who may also allow the application to be amended by omitting any of the goods for which the mark is claimed (*m*), and may, after registration, alter the address of the registered proprietor (*n*),

(*a*) See as to the growth of this form of registration, per Jessel, M.R., in *In re Kuhn & Co.*, 53 L. J. Ch. 238.

(*b*) See note (*c*) to § 72 and *In re Leonardt*, Dig. 610; *In re Mitchell* (2), Dig. 611; *In re Kuhn & Co.*, 53 L. J. Ch. 238; *In re Hoyle & Sons, Limited* (2), Chitty, J., Nov. 30th, 1883; *In re Hayward & Sons*, 54 L. J. Ch. 1003; *In re Davies*, Chitty, J., March 9th, 1885.

(*c*) See note to § 65, *infrà*. The registration should always be so limited. See *Edwards* v. *Dennis*, 30 Ch. D. 454; *Anglo-Swiss Condensed Milk Co.* v. *Metcalf*, 31 Ch. D. 454.

(*d*) *In re Johnson, Philpott & Co.*, North, J., Feb. 21st, 1888; *In re Jeffrey & Co.*, Stirling, J., May 18th, 1888.

(*e*) See note (*c*) to § 72, *infrà*, and *In re Whiteley*, 43 L. T. N. S. 627; *In re Sykes*, *ib.* 626; *In re Barina* (3), Dig. 654.

(*f*) *In re Rabone*, Dig. 643; *In re Keep Bros.*, 26 Ch. D. 187; *In re Mitchell & Co.*, 28 Ch. D. 666; *In re Johnson, Philpott & Co.*, North, J., Feb. 21st, 1888.

(*g*) *Ex parte Hemming & Son*, M. R., April 27th, 1881.

(*h*) § 71, and Rules 42, 43.

(*i*) Rule 44, and see note to § 71, *infrà*.

(*k*) Rule 45.

(*l*) § 90.

(*m*) § 91. (*n*) Rule 48.

and by leave of the Court the registered proprietor may alter his trade mark and procure an alteration of the register accordingly, but the alteration must not extend to any of the "essential particulars" of the trade mark (*a*).

No trust entered on register.

No notice of any trust, expressed, implied, or constructive, can be received by the comptroller, or entered in the register (*b*).

2. *Transfer.*

Assignment and transmission.

A trade mark is capable of being assigned during the life of its proprietor, and of being transmitted at his death; but it can be assigned and transmitted only in connection with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered (*c*), and "an assignee has no exclusive right to a trade mark unless the assignment is of a business co-extensive with the trade mark as registered" (*d*). Trade marks registered as a series can only be assigned and transmitted as a whole (*e*).

Trade mark cannot be severed from goodwill.

Even apart from the Act, there is no doubt that the trade mark cannot be severed from and used independently of the goodwill. If that could be done, the *indicium* of genuineness might only serve to mislead. This view was clearly put by Lord Westbury, C., in the *Leather Cloth Companies' case* (*f*), when he suggested the case of a firm

(*a*) § 92; and see *In re Dewhurst*, M. R., June 11th, 1880. Notice of the application must be given to the comptroller: Rule 48.

(*b*) § 85. See *In re Mitchell & Co.*, 28 Ch. D. 666; *In re De Otaduy*, L. J. N. of C. 1885, p. 155.

(*c*) § 70. See *Massam* v. *Thorley's Cattle Food Co.*, 14 Ch. D. 748; *Ex parte Lawrence & Co.*, 44 L. T. N. S. 98; *In re Wellcome*, 32 Ch. D. 213.

(*d*) Per Fry, L. J., in *Edwards* v. *Dennis*, 30 Ch. D. 454.

(*e*) § 66.

(*f*) 4 De G. J. & S. 137; and see *Cotton* v. *Gillard*, 44 L. J. Ch. 90; *Taylor* v. *Bemis*, 4 Biss. 406; *Witthaus* v. *Braun*, 44 Md. 303; *Skinner* v. *Oakes*, 10 Mo. App. 45; *Morgan* v. *Rogers*, 19 Fed. Rep. 596; *McVeagh* v. *Valencia Cigar Factory*, 32 U. S. Pat. Gaz. 1124; *Oakes* v. *Tonsmierre*, 4 Woods 547; *Smith* v. *Fair*, 14 Ont. Rep. 729; *Smith* v. *Imus*, 32 Alb. L. J. 455; *In re Rowley & Pyne*, 9 Vict. L. R. (L.) 307. See *Goodman* v. *Meriden Britannia Co.*, 50 Conn. 139, as to the construction of a contract entered into on the sale of a trade mark.

of clothiers in Wiltshire, trading as A. B. & Co. for fifty years, and acquiring a great reputation for their broad cloth marked "A. B. & Co. Wilts"; then, he asked, supposing A. B. & Co. to discontinue their business, and to sell the right to use the mark to C. D. & Co., clothiers in Yorkshire, would the latter be protected in equity in their claim to the exclusive use of the mark? and he answered the question in the negative.

Trade mark passes with goodwill.

To such an extent is a trade mark an accessory of the goodwill, that in *Shipwright* v. *Clements* (*a*), Malins, V.-C., held that in the sale of the latter the trade mark would pass, whether specially mentioned or not (*b*).

Same principle adopted in America.

In a case before the New York Court of Appeals (*c*), the expression was adopted that "a property in trade mark might be obtained by transfer from him who had made the primary acquisition, though it was essential that the transferee should be possessed of the right either to manufacture or sell the merchandise to which the trade mark had been attached." In another American case (*d*), the statement that the "property or right to a trade mark might pass by an assignment or by operation of law," was followed by this limitation, "to any one who took at the same time the right to manufacture or sell the particular merchandise to which the trade mark had been attached." And in the case of *Kidd* v. *Johnson* (*e*), the Supreme Court of the United States laid down that "as distinct property, separate from the article created by the original producer or manufacturer, a trade mark may not be the subject of sale. But when it is affixed

(*a*) 19 W. R. 599.

(*b*) And see *Churton* v. *Douglas*, Johns. 174; *Fulton* v. *Sellers*, 4 Brews. 42; *Thompson* v. *Mackinnon*, 2 Steph. Dig. 726; *Merry* v. *Hoopes*, 111 N. Y. 415. But an assignment can give no exclusive right in a word used as a mere indication of quality: *Ib.*

(*c*) *Congress & Empire Spring Co.* v. *High Rock Congress Spring Co.*, 45 N. Y. 291; R. Cox, 599.

(*d*) *Dixon Crucible Co.* v. *Guggenheim*, 2 Brews. 321; R. Cox, 559; and see *Walton* v. *Crowley*, 3 Bl. C. C. 440; R. Cox, 166; and *Derringer* v. *Plate*, 29 Cal. 292; R. Cox, 324.

(*e*) 100 U. S. Rep. 617.

to articles manufactured at a particular establishment, and acquires a special reputation in connection with the place of manufacture, and that establishment is transferred, either by contract or operation of law, to others, the right to the use of the trade mark may be lawfully transferred with it. Its subsequent use by the person to whom the establishment is transferred is considered as only indicating that the goods to which it is affixed are manufactured at the same place, and are of the same character, as those to which the mark was attached by its original designer."

Personal trade mark.

It is possible that occasionally, though rarely, a trade mark may be so framed as not to be merely a simple indication of quality, or a guide to the place of manufacture, but to have the effect of ascribing the article to which it is attached to the personal skill or supervision of an individual. In such a case the question arises whether the trade mark which, when originally adopted, contained no assertion which was incorrect, is capable of transfer to another person so as to enable him to apply it to his own goods and to prevent a similar use of it by others, the personal skill and supervision of its former proprietor having ceased to be applied.

Not assignable.

The considerations which occur in cases where such a contention is set up are well stated by the Supreme Court of Massachusetts (*a*) in the following terms:—"There may, no doubt, be cases where the personal skill of an artist or artisan may so far enter into the value of a product that a trade mark bearing his name would, or at least might, imply that his personal work or supervision was employed in the manufacture; and in such cases it would be a fraud upon the public if the trade mark should be used by other persons, and for this reason such a trade mark would be held to be unassignable. . . . But, on the other hand, the usages of trade may be such that no such

(*a*) *Hoxie* v. *Chaney*, 143 Mass. 592.

inference would naturally be drawn from the use of a trade mark which contains a person's name, and that all that purchasers would reasonably understand is that goods bearing the trade mark are of a certain standard, kind, or quality, or are made in a certain manner, or after a certain formula, by persons who are carrying on the same business that formerly was carried on by the person whose name is in the trade mark."

Name of former proprietor.

It is, indeed, settled law in England, though there is some American authority (*a*) to the contrary, that the mere fact of the trade mark consisting of or containing the name of its former proprietor, who originally conducted the business with which the trade mark is connected, is not of itself sufficient to disentitle the transmittee or assignee of the business to continue to use the mark, since the mere name of the maker will be deemed to be indicative rather of a business, in whosesoever hands it may be, than of an individual proprietor of it (*b*).

When trade mark is personal.

It is, however, conceivable that a trade mark may be "so completely personal as of necessity to import that the goods sold under it have been manufactured by a particular individual" (*c*), as if it contains not only the name of the

(*a*) *Sherwood* v. *Andrews*, 3 Amer. L. Reg. N. S. 588; and see *Partridge* v. *Menck*, 2 Sandf. Ch. 622; *Carmichel* v. *Latimer*, 11 R. I. 395; *Manhattan Medicine Co.* v. *Wood*, 108 U. S. Rep. 218; *Horton Manufacturing Co.* v. *Horton Manufacturing Co.*, 18 Fed. Rep. 816.

(*b*) *Bury* v. *Bedford*, 4 De G. J. & S. 352, *Churton* v. *Douglas*, Johns. 174; *Hall* v. *Barrows*, 4 De G. J. & S. 150; *Leather Cloth Co.* v. *American Leather Cloth Co.*, 1 H. & M. 271; 4 De G. J. & S. 137; 11 H. L. C. 523; *Massam* v. *J. W. Thorley's Cattle Food Co.* (2), 14 Ch. D. 748; *Tussaud* v. *Tussaud*, 38 W. R. 503; and the American cases of *McLean* v. *Fleming*, 96 U. S. Rep. 245; *Filkins* v. *Blackman*, 13 Bl. C. C. 440; *Weed* v. *Peterson*, 12 Abb. Pr. N. S. 178; *Booth* v. *Jarrett*, 52 How. Pr. 169; *Weston* v. *Ketcham* (1), 39 N. Y. Super. Ct. 54; S. C. (2) 51 How. Pr. 455; *Woods* v. *Sands*, Dig. 467; *Fulton* v. *Sellers*, 4 Brews. 42; *Young* v. *Jones Bros. & Co.*, 3 Hughes, 274. Compare *Clark* v. *German Mutual Fire Insurance Co.*, 7 Mo. App. 77; *Russia Cement Co.* v. *Le Page*, 147 Mass. 206; *Hoxie* v. *Chaney*, 143 Mass. 592; *Pepper* v. *Labrot*, 8 Fed. Rep. 29; *Société, etc., de la Bénédictine* v. *Micalovitch*, 36 Alb. L. J. 364; and the Canadian case of *Gage* v. *Canada Publishing Co.*, 11 Can. Sup. Ct. 306.

(*c*) Per Turner, L. J., in *Bury* v. *Bedford*, 4 De G. J. & S. 352; so in *Carmichel* v. *Latimer*, 11 R. I. 395; *Oakes* v. *Tonsmierre*, 4 Woods 547; *Hoxie* v. *Chaney*, 143 Mass. 592.

proprietor, but also some reference to his personal qualifications or supervision (*a*), or an allusion to particular workmen in his employ (*b*), in which case the mark will already become deceptive even while the business remains in the same hands, if the proprietor should cease to give his personal attention, or to employ the same workmen. And in *Manhattan Medicine Co.* v. *Wood* (*c*), the Supreme Court of the United States said that "if one affix to goods of his own manufacture signs or marks which indicate that they are the manufacture of others, he is deceiving the public and attempting to pass upon them goods as possessing a quality and merit which another's skill has given to similar articles, and which his own manufacture does not possess in the estimation of purchasers. To put forth a statement, therefore, in the form of a circular or label attached to an article, that it is manufactured in a particular place by a person whose manufacture there had acquired a great reputation, when in fact it is manufactured by a different person at a different place, is a fraud upon the public which no Court of Equity will countenance."

No protection of deceptive marks.

In such a case, independently of statute, it is clear that no protection will be given to a mark become deceptive. Thus, Lord Westbury, C., was of opinion that the Court would not sell and transfer the right to use a mark of a personal character simply and without alteration (*d*).

The Patents, &c., Act, 1883.

The objection to the use of a trade mark become deceptive, which, independently of statute, applied rather to the

(*a*) *Helmbold* v. *Helmbold Manufacturing Co.*, 53 How. Pr. 453.

(*b*) And compare the reference by Lord Kingsdown to an artist's special skill, in *Leather Cloth Co.* v. *American Leather Cloth Co.*, 11 H. L. C. 523.

(*c*) 108 U. S. Rep. 218, and see *In re Swezey & Dart*, 62 How. Pr. 215; and Daly, C. J.'s observations in *Hegeman & Co.* v. *Hegeman*, 8 Daly, 1.

(*d*) *Hall* v. *Barrows*, 4 De G. J. & S. 150. See, too, the Clothiers' case, suggested by him in the *Leather Cloth Co.'s case*, 4 De G. J. & S. 137; and the remarks of Lord Cranworth in that case in the House of Lords, 11 H. L. C. 523; and those of the L. JJ. in *Bury* v. *Bedford*, 4 De G. J. & S. 352. Compare *Sherwood* v. *Andrews*, 3 Am. L. Reg. N. S. 588, and *Partridge* v. *Menck*, 2 Sandf. Ch. 622.

use of the mark assigned than to the power of assigning it (*a*), should now, as it appears, more properly apply to the registration of the assignee or transmittee, by which the latter acquires, at least, a *primâ-facie* right to practise deceit. The Act, indeed, contains no provision expressly directed to meet a case of this kind, the 73rd section being only aimed at an attempted registration of a mark disentitled from the beginning to protection, by reason of being inherently calculated to deceive, and not to a registration of a subsequent proprietor of a mark which has lost its right to protection through a change of circumstances. The spirit of the Act is, however, to favour the general assignability of trade marks together with the goodwill to which they are attached, and it may be expected that such elements in a trade mark as would impede this assignability will very rarely, if ever, survive the original process of registration now necessary.

Trade marks generally transferable.

Subject only to the provision prohibiting the severance of a trade mark from the goodwill of the business with which it is connected, the trade mark is freely assignable. "The right to a trade mark may, in general, treating it as property, or an accessory of property, be sold and transferred upon a sale and transfer of the manufactory of the goods on which the mark has been used to be affixed, and may be lawfully used by the purchaser" (*b*). If this were not so, the value of a very valuable and important part of

(*a*) Per Turner, L. J., in *Bury* v. *Bedford*, 4 De G. J. & S. 352.

(*b*) Per Lord Cranworth in *Leather Cloth Co.* v. *American Leather Cloth Co.*, 11 H. L. C. 523; and see per V.-C. Wood in *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518; also *Hall* v. *Barrows*, 4 De G. J. & S. 150; *Hudson* v. *Osborne*, 39 L. J. Ch. 79; *Weed* v. *Peterson*, 12 Abb. Pr. N. S. 178; *Cook* v. *Starkweather*, 13 *ib.* 392; *Frese* v. *Bachof* (2), 14 Bl. C. C. 432; *In re Rohland*, 10 U. S. Pat. Gaz. 980; *Lockwood* v. *Bostwick*, 2 Daly, 521; *Gage* v. *Canada Publishing Co.*, 11 Can. Sup. Ct. 306; and the clear and full statement by Daly, C. J., in *Hegeman & Co.* v. *Hegeman*, 8 Daly, 1. It was said by Shipman, J., in the American case of *Filkins* v. *Blackman*, 13 Bl. C. C. 440, that "the right to the use of a trade mark cannot be so enjoyed by an assignee that he shall have the right to affix the mark to goods differing in character or species from the article to which it was originally attached."

the goodwill of the business carried on by a person (*a*) would be seriously diminished. And for a similar reason, and in the interest alike of the owner of a trade mark himself and of his assignee, the original owner will, subsequently to assignment, be restrained from the use of his former trade mark, equally with persons who have never had an interest in it (*b*). Nor after that event does he retain any power of conferring on another a right to use it (*c*). The same will be the case if the sale has been made, not by the owner himself, but by his trustee in bankruptcy (*d*). In the sale of a business a trade mark will pass to the purchaser without special mention (*e*).

Registration of subsequent proprietor.

When a person becomes entitled to a registered trade mark by assignment or transmission, or other operation of law, the way in which he has to obtain the registration of himself as the proprietor (*f*) is by sending a request to that effect to the comptroller (*g*), signed in the same way as is required in the case of an original application (*h*), stating the name, address, and description of the claimant, and the particulars of his title, showing that the trade mark has gone with the goodwill of the business (*i*), and accompanied by a statutory declaration verifying the several statements made (*k*). And further proof of title is to be furnished to the comptroller if he requires it (*l*).

Transmission on bankruptcy.

On the owner of a trade mark becoming bankrupt, his trade mark is transmitted with his business to his representative in bankruptcy, and will, together with

(*a*) Compare the observations of Wood, V.-C., as to the sale of a trade name, involving the same considerations, in *Churton* v. *Douglas*, Johns. 174; also *Shipwright* v. *Clements*, 19 W. R. 599.

(*b*) *Bury* v. *Bedford*, 4 De G. J. & S. 352; and see *Churton* v. *Douglas*, Johns. 174.

(*c*) *Sohl* v. *Geisendorf*, 1 Wils. (Ind.) 60; *Filkins* v. *Blackman*, 13 Bl. C. C. 440.

(*d*) *Hudson* v. *Osborne*, 39 L. J. Ch. 79; *Hegeman & Co.* v. *Hegeman*, 8 Daly, 1.

(*e*) *Shipwright* v. *Clements*, 19 W. R. 599.

(*f*) § 87.

(*g*) Rule 36.

(*h*) Rule 37.

(*i*) Rule 38, and see § 70.

(*k*) Rule 39. For form of application and declaration, see Form K in Second Schedule to Rules.

(*l*) Rule 40.

the business and goodwill, be dealt with by him (*a*). But, apart from the statutory provisions regulating registration, it seems that a trade mark which owes its value to its owner's personal skill will not pass; and in the American case of *In re Swezey and Dart* (*b*) an insolvent trader was directed to be examined for the purpose of ascertaining whether the value of the mark was owing to such skill or to the general working of the factory. And it has been held in America that an assignee in bankruptcy cannot sell a trade secret or a trade mark of which the main feature is the bankrupt's name, so as to restrict the bankrupt's right to use it (*c*); and also that where one of the partners in a solvent firm becomes bankrupt, his interest in the name or trade mark of the firm cannot be sold, on the ground that his right is only to an undivided part of the mark, and that this is of no value apart from its connection with the goodwill (*d*).

Formation of partnership.

Upon the formation of a partnership, one member of which is the proprietor of a trade mark, the trade mark will, in the absence of express provisions, or tacit acquiescence by the other partners in the previous owner's retention of his trade mark (*e*), pass into and become part of the partnership assets, for the trade mark is but an element of the trade (*f*). In that case it seems that the partner who has newly acquired an interest in the trade

(*a*) *Hudson* v. *Osborne*, 39 L. J. Ch. 79; *Cotton* v. *Gillard*, 44 L. J. Ch. 90; *Bury* v. *Bedford*, 4 De G. J. & S. 352; *Ex parte Young*, Dig. 537; *Rogers* v. *Taintor*, 97 Mass. 291; *Hegeman & Co.* v. *Hegeman*, 8 Daly, 1; *Warren* v. *Warren Thread Co.*, 134 Mass. 247. And see *Longman* v. *Tripp*, 2 Bos. & P. N. R. 67; and *Ex parte Foss*, 2 De G. & J. 230.

(*b*) 62 How. Pr. 215.

(*c*) *Helmbold* v. *Helmbold Manufacturing Co.*, 53 How. Pr. 453; *Iowa Seed Co.* v. *Dorr*, 70 Iowa, 481.

(*d*) *Taylor* v. *Bemis*, 4 Biss. 406.

(*e*) *Kidd* v. *Johnson*, 100 U. S. Rep. 617, practically reversing *Kidd & Co.* v. *Mills, Johnson & Co.*, 5 U. S. Pat. Gaz. 337.

(*f*) *Bury* v. *Bedford*, 4 De G. J. & S. 352, per Turner, L. J. And see *Condy* v. *Mitchell*, 37 L. T. N. S. 268, *ib.* 766; *Filkins* v. *Blackman*, 13 Bl. C. C. 440; *Swift* v. *Peters*, 11 U. S. Pat. Gaz. 1110; *Rogers* v. *Taintor*, 97 Mass. 291; *Solier* v. *Johnson*, 111 Mass. 238; *Weston* v. *Ketcham* (2), 51 How. Pr. 455; *Yale Cigar Manufacturing Co.* v. *Yale*, 30 U. S. Pat. Gaz. 1183.

mark will be entitled to registration as joint proprietor with his partner who is already on the register. And where, without the actual formation of a partnership, three persons agreed to carry on business in common, one manufacturing, another acting as exporting agent, and the third as consignee and merchant at Rangoon, it was held on appeal that neither had an exclusive right to the combination of marks used on the goods which had passed through this course, though some of the marks in the combination had been used separately by one of the three before the arrangement between them was made; the decision being based on the fact that the combination as a whole had come to denote goods which had passed through the hands of all three (*a*).

Dissolution of partnership.

Upon the dissolution of a partnership among whose property a trade mark is included, whether that dissolution be brought about by the mutual agreement of the partners or by the death of one of them, the trade mark, as forming part of the partnership assets, and also on account of its close connection with the goodwill of the business, must be treated in the same way as the business and goodwill are treated, unless there is an express agreement for its discontinuance. If the business and goodwill are sold, the trade mark will be included in the sale (*b*); if the share of the retiring or deceased partner is, by arrangement, taken over by the continuing or surviving partner or partners, the retiring or deceased partner's interest in the trade mark passes with his share in the business, and must be included in the valuation of that share (*c*); if the

(*a*) *Robinson* v. *Finlay*, 9 Ch. D. 487. Compare *In re Jones*, 53 L. T. N. S. 1.

(*b*) *Bradbury* v. *Dickens*, 27 Beav. 53; *Hall* v. *Barrows*, 4 De G. J. & S. 150; *Banks* v. *Gibson*, 34 Beav. 566; *Rogers* v. *Taintor*, 97 Mass. 291; *Armistead* v. *Blackwell*, 1 U.S. Pat. Gaz. 603.

(*c*) *Banks* v. *Gibson*, 34 Beav. 566; *Hall* v. *Barrows*, 4 De G. J. & S. 150; *Hazard* v. *Caswell*, 93 N. Y. 259; *Gage* v. *Canada Publishing Co.*, 11 Can. Sup. Ct. 306; *Hoxie* v. *Chaney*, 143 Mass. 592. But it seems that if a retiring partner sets up no claim to an interest in the trade mark, and the continuing partner continues to use it without objec-

partners merely agree to divide the partnership assets, so that each in effect carries on the same business, though they carry it on severally instead of jointly, then each is at liberty to use the mark as he did before (*a*). Thus, where H. B. Condy had brought into a partnership formed between himself and one Mitchell certain trade marks, which consisted in part of the former's name, it was held that after the dissolution, on which the goodwill became divisible in equal shares between the partners, Mitchell was equally entitled with Condy to continue to use the trade mark (*b*). And where certain partners sold to their co-partner their interest in the business premises and in certain personal property connected with the business, but not their interest in the goodwill or trade mark, it was held that they retained their right to use the trade mark concurrently with their former co-partner (*c*).

Transmission on death.

Where a trade mark has been transmitted by the death of the registered proprietor, his legal personal representative will be recognised as having the title to the mark. So long since as the reign of King George II., Lord Hardwicke, C., decided (*d*) that shares in the goodwill of a newspaper, entitled *The St. James's Evening Post*, were to be considered as part of the personal property of the proprietor; and that, on the death of the proprietor, his

tion, the former will be held to have given up his interest in favour of the latter: *Kidd & Co.* v. *Mills, Johnson & Co.*, 5 U. S. Pat. Gaz. 337. See *Kidd* v. *Johnson*, 100 U. S. Rep. 617; *Holt* v. *Menendez*, 128 U. S. Rep. 182; and *Simpson* v. *Wright* (1), 15 U. S. Pat. Gaz. 248. On the other hand, the continued use of the mark by the retiring partner, even on a spurious article, is evidence of his intention to preserve his interest in the mark: *Wright* v. *Simpson*, 15 *ib.* 968.

(*a*) *Banks* v. *Gibson*, 34 Beav. 566. And see *Bond* v. *Milbourn*, 20 W. R. 197; *Weston* v. *Ketcham*, (1), 39 N. Y. Super. Ct. 54; S. C. (2), 51 How. Pr. 455; *Young* v. *Jones Bros. & Co.*, 3 Hughes, 274; *Hazard* v. *Caswell*, 93 N. Y. 259; *Robinson* v. *Finlay*, 9 Ch. D. 487. In *In re Jones*, 53 L. T. N. S. 1, it was held that neither of the parties to a joint adventure was entitled, after this had come to an end, to use or register the joint trade marks as against the others.

(*b*) *Condy* v. *Mitchell*, 37 L. T. N. S. 268, 766.

(*c*) *Huver* v. *Dannenhoffer*, 82 N. Y. 499; *Hazard* v. *Caswell*, 93 N. Y. 259.

(*d*) *Giblett* v. *Read*, 9 Mod. 459.

trade mark passes to his personal representative with the remainder of his personal property has never been questioned (*a*). Where letters of administration to a person who had adopted a trade mark for an article of his invention had not been taken out, it was held that his son could not, by merely continuing to make the article and use the trade mark after his father's death, acquire a right in the trade mark so as to be entitled to prevent another person from using it; still less could a purchaser of the son's business do so (*b*). But a rather different view of the results of such a proceeding has been taken in America (*c*).

Bequest of trade mark.

The proprietor of a trade mark may bequeath it according to pleasure (*d*), but this is subject to the provisions prohibiting its transmission otherwise than in connection with the goodwill of his business (*e*), and a registered series of marks can only be transmitted as a whole (*f*).

Several proprietors.

By means of bequest, dissolution of partnership, &c., it is possible for more than one person to become severally entitled to the same trade mark at the same time (*g*), and concurrent rights may similarly arise by reason of concurrent substantial user by more firms than one (*h*). In such cases it was provided by the old rules, now repealed, that the several claimants might, by their common consent, be registered separately as separate proprietors of such trade mark; and although no such provision is contained

(*a*) Thus, in *Croft* v. *Day*, 7 Beav. 84, 28 Leg. Obs. 378, the successful plaintiffs were the executors of the former proprietor of the business and trade mark. See *In re Farina*, (4), 44 L. T. N. S. 99.

(*b*) *Hovenden* v. *Lloyd*, 18 W. R. 1132. And see *Singleton* v. *Bolton*, 3 Doug. 293.

(*c*) *Pratt's Appeal*, 117 Penn. St. 401.

(*d*) *Dent* v. *Turpin*, 2 J. & H. 139; *M'Lean* v. *Fleming*, 96 U. S. Rep. 245.

(*e*) § 70. And see Rules 38, 39, and Form K.

(*f*) § 66.

(*g*) *Hine* v. *Lart*, 10 Jur. 106; *Dent* v. *Turpin*, 2 J. & H. 139; *Banks* v. *Gibson*, 34 Beav. 566; and see *Southorn* v. *Reynolds*, 12 L. T. N. S. 75; and *Pratt's Appeal*, 117 Penn. St. 401.

(*h*) *In re Powell*, Dig. 589; *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *Benbow* v. *Low* (4), 44 L. T. N. S. 875; *Day* v. *Neale*, V.-C. B., May 24th, 1881; *In re Hodson & Co.*, 26 Sol. J. 43; and other cases on the Three Mark Rule. See note (*e*) to § 72, *infrà*.

in the new rules, it would appear that in such a case the comptroller would have a discretion to register each of the claimants (*a*). But where one of the claimants has got on to the register, the comptroller cannot register the other without the leave of the Court (*b*); neither can he do so where either application is opposed (*c*).

Position of subsequent proprietors.

By the 4th section of the Act of 1875, it was provided that every proprietor registered in respect of a trade mark subsequently to the first registered proprietor was, as respected his title to that trade mark, to stand in the same position as if his title were a continuation of the title of the first registered proprietor (*d*). This section is not re-enacted, but there appears to be no doubt that in ordinary cases the result will be the same as if it had been. It may be noticed that by § 76 the privileges conferred by § 3 of the Act of 1875 upon the *first* registered proprietor are now given to the registered proprietor.

3. *Discontinuance.*

When trade mark protected.

In order for a trade mark to be entitled to protection, it is now necessary either that the trade mark shall be registered, or, if an old mark incapable of registration is in question, that registration shall have been refused (*e*). The protection of a mark once registered terminates, therefore, with the cessation of registration.

Duration of registration.

The original registration of a trade mark is for a period of fourteen years; and unless previously to the expiration of that period the fee for continuance is paid, the comptroller may, after the end of three months from such expiration, remove the mark from the register, and in the same way from time to time at the expiration of every fresh period of fourteen years (*f*). No difficulty need in ordinary cases be apprehended from the prolongation of registration, for the exclusive use o a trade mark is no

(*a*) See § 71.
(*b*) § 72.
(*c*) § 69.
(*d*) Compare *Hovenden* v. *Lloyd*, 18 W. R. 1132.
(*e*) § 77.
(*f*) § 79 (1), (2).

injury or deprivation to the public, but a protection against fraud.

If subsequently to the expiration of the fourteen years, but before the expiration of the additional three months, the proprietor pays the increased fee, the comptroller may accept the fee as if paid before the expiration of the fourteen years, and allow the mark to remain on the register (*a*).

Restoration to register.

Even after the removal from the register for non-payment of the fee, the mark may be restored to the register by the comptroller, if he is satisfied that it is just so to do, on payment of an additional fee.

Must be a vendible article with trade mark attached.

Independently of registration no trade mark can exist as such unless there is actually existent in the market a vendible article to which the mark is in some way affixed or attached (*b*), though it is not necessary for the mark to be externally visible—*e.g.*, where it is placed on the bottom of a wine cork, which is not seen until the bottle is bought and opened (*c*).

Registration now equivalent to public use.

The necessity of proving the existence of such an article so marked, in the case of registered marks, now no longer exists, since, subject to the connection with the goodwill of the business, registration is to be deemed to be equivalent to public use (*d*); although, if a mark somewhat similar

(*a*) § 79 (3).

(*b*) *McAndrew* v. *Bassett*, 4 De G. J. & S. 380; *Maxwell* v. *Hogg*, L. R. 2 Ch. 307; *Edwards* v. *Dennis*, 30 Ch. D. 454; *Wheeler* v. *Johnston*, 3 L. R. Ir. 284; *Candee* v. *Deere*, 54 Ill. 439; *Blackwell* v. *Dibrell*, 14 U. S. Pat. Gaz. 633; *Avery & Sons* v. *Meikle & Co.*, 27 U. S. Pat. Gaz. 1027. And see *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434. In *Cotton* v. *Gillard*, 44 L. J. Ch. 90, the plaintiffs had bought from the trustee in bankruptcy the interest of the bankrupt in a certain sauce and in his trade mark, but the sauce being compounded according to a secret which the trustee could not communicate, Sir G. Jessel, M. R., held that the plaintiff could not use or protect the trade mark. See *Witthaus* v. *Braun*, 44 Md. 303; *Taylor* v. *Bemis*, 4 Biss. 406; *Helmbold* v. *Helmbold Manufacturing Co.*, 53 How. Pr. 453; *Weston* v. *Ketcham* (1), 39 N. Y. Super. Ct. 54; S. C. (2), 51 How. Pr. 455; *Manhattan Medicine Co.* v. *Wood*, 108 U. S. Rep. 218; *Morgan* v. *Rogers*, 19 Fed. Rep. 596.

(*c*) *Moët* v. *Pickering*, 8 Ch. D. 372; *Moët* v. *Clyboun*, Dig. 533.

(*d*) § 75. This is so also in the United States: *In re Dutcher Temple Co.*, U. S. Pat. Comm. Decis. 1871, 248. See *Sternberger* v. *Thalheimer*, 3 U. S. Pat. Gaz. 120.

to, but not identical with, the registered mark has been used on goods on which the registered mark has never been used, though they are covered by the registration, the Court may decline to recognise the probability of deception (*a*). But in the case of old marks, it seems that a certificate of refusal will not entitle the unsuccessful applicant to his remedy, if discontinuance can be established. The 34th Rule under the Act of 1875 contained provisions intended to prevent the continuance of restrictions which no longer served any useful purpose, and this was put into practice in the case of *In re Ralph* (*b*). It has not been re-enacted; but since, by § 70, a trade mark is determinable with the goodwill, it may be held, though it is not clear, that the Court has jurisdiction under § 90 to remove from the register, on the application of any person aggrieved, a trade mark which has lost its right to existence by the discontinuance of its proprietor's business. Whether this is so or not, it appears very improbable that in such a case an injunction would be granted to protect it.

Abandonment by disuse.

"That the right to use a trade mark may be lost by abandonment or disuse is too clear to need argument or the support of authority" (*c*), and the neglect on the part of the owner which is fatal to his exclusive right may either take the shape of cessation of user on his own part, or of the growth of a concurrent right in others. Each of these depends upon intention. "To constitute abandonment" (*i.e.* by cessation of user) "an intention to abandon must be shown. Mere non-user of a trade mark can no more be said to constitute abandonment than the mere non-user of a right to foul a stream belonging to a mill as an easement can be said to constitute an abandonment of the easement" (*d*). But when the word claimed as a trade

(*a*) *Edwards* v. *Dennis*, 30 Ch. D. 454.

(*b*) 25 Ch. D. 194.

(*c*) Per Hughes, J., in *Blacknell* v. *Dibrell*, 14 U. S. Pat. Gaz. 633. See *Lavergne* v. *Hooper*, Ind. L. R. 8 Mad. 149.

(*d*) Per Chitty, J., in *Mouson & Co.* v. *Boehm*, 26 Ch. D. 398. It would be evidence of intention to

mark had not been used during a period of eleven years, and the sale of the article on which it had been used had been discontinued, and the labels on which it had appeared had been destroyed, it was held that there had been abandonment (*a*).

Abandonment of permitting infringements.

"The question of abandonment" (*i.e.* by non-interference with infringers) "is one of intention, and the burden of establishing it lies upon the party who affirms it," said an American judge (*b*); and in the same way it was said in the High Court of Bengal (*c*) that the right of property in a trade mark acquired by user "would continue until it had been proved by evidence that the proprietor had abandoned it." In particular, where the trade mark owner is ignorant of infringements taking place, it will not be held that he has abandoned his rights because of his failure to enforce them, that failure being due to his ignorance of what was going on (*d*); but it may be assumed that there must be reasonable diligence shown in the defence of his rights.

Distinctive words become descriptive.

With respect to trade marks consisting of words which originally were distinctive, it has occasionally happened that they have ceased to denote the manufacture of any particular person, and have become simply descriptive of a certain article or a certain principle of manufacture. When that has become the case, such words have ceased to be capable of protection as trade marks, having become *publici juris*, open to the use of all (*e*). But a composite mark is

abandon if a trade mark owner were to break up his moulds and erase the mark from his books and lists: *Ib.*

(*a*) *In re Grossmith*, 60 L. T. N. S. 612.

(*b*) Morris, Comm., in *Julian* v. *Hoosier Drill Co.*, 75 Ind. 408, in which a delay of three years was held not to amount to abandonment.

(*c*) In *Orr-Ewing & Co.* v. *Grant, Smith & Co.*, 2 Hyde, 185, per Levinge, J.

(*d*) *Weldon* v. *Dicks*, 10 Ch. D. 247; *In re Farina* (2), 27 W. R. 456; *Mouson & Co.* v. *Boehm*, 26 Ch. D. 398; *Williams* v. *Adams*, 8 Biss. 452; *Sawyer* v. *Kellogg*, 7. Fed. Rep. 721; 9 *ib.* 601.

(*e*) Per Mellish, L. J., in *Ford* v. *Foster*, L. R. 7 Ch. 611. And see *Wheeler & Wilson Manufacturing Co.* v. *Shakespeare*, 39 L. J. Ch. 36; *Liebig's Extract of Meat Co.* v. *Hanbury*, 17 L. T. N. S. 298; *Same* v. *Anderson*, W. N. 1883, p. 185; *Lazenby* v. *White*, 41 L. J. Ch. 354; *In re Hyde & Co.*, 7 Ch. D. 724; *Brownie* v. *Freeman*, W. N.

not abandoned by isolated words or symbols contained in it being used by others (*a*); and it has been held in America that where a word has been properly appropriated as a trade mark, and has not been formally abandoned, use in a descriptive sense by persons other than the proprietor does not make it open to the public (*b*). Where a name, which it has been attempted to appropriate as a trade mark, has been in fact descriptive throughout, the case can hardly be said to have arisen of a discontinuance of a trade mark, inasmuch as it was invalid originally (*c*).

The Three Mark Rule.

In this connection the "three-mark rule," as it is called, becomes of importance. This rule originated in the discovery—soon after the Act of 1875 came into operation—that the same or substantially the same trade mark was in many instances in use by more firms than one, generally carrying on business in different parts of the country; and in order to avoid injustice being done in such cases the rule was laid down by the Commissioners of Patents, and acted on in various decisions of the Courts, that where two or three firms could prove that they had used the same or substantially the same mark on the same or substantially the same goods, to a substantial extent, before the passing of the Act of 1875, each should be allowed to register; but that where the mark had been used by more than three firms it was common to the trade (*d*); and on this principle it has been held that various

1873, p. 178; *Lea* v. *Millar*, Dig. 513; *Lea* v. *Deakin*, 11 Biss. 23; *Neva Stearine Co.* v. *Mowling*, 9 Vict. L. R. (E.) 98; *Lawrence Manufacturing Co.* v. *Tennessee Manufacturing Co.*, 31 Fed. Rep. 776; *Smith* v. *Imus*, 32 Alb. L. J. 455; *Wolfe* v. *Goulard*, 18 How. Pr. 64; R. Cox, 226; *Burke* v. *Cassin*, 45 Cal. 467; 13 Amer. Rep. 204.

(*a*) *Sohl* v. *Geisendorf*, 1 Wils. (Ind.) 60; *Filley* v. *Child*, 16 Bl. C. C. 376.

(*b*) *Celluloid Manufacturing Co.* v. *Cellonite Manufacturing Co.*, 32 Fed. Rep. 94; *Selchow* v. *Baker*, 93 N. Y. 59; *Société, &c., de la Bénédictine* v. *Micalovitch*, 36 Alb. L. J. 364.

(*c*) *Young* v. *Macrae*, 9 Jur. N. S. 322; *Raggett* v. *Findlater*, L. R. 17 Eq. 29; *In re Horsburgh*, 53 L. J. Ch. 237; *Rowland* v. *Breidenbach*, Dig. 386; *In re Leonard & Ellis*, 26 Ch. D. 288; *Bulloch, Lade & Co.* v. *Gray*, 19 Journ. of Jurisp. 218; and see p. 62, note (*c*), *suprà*.

(*d*) See note (*e*) to § 72, *infrà*.

marks were common in different trades (*a*). This rule is now incorporated in § 74, so far as is necessary for the purpose of determining what parts of a composite mark must be disclaimed as common.

Trade mark not abandoned by habitual user in combination with name.

In *Braham* v. *Bustard* (*b*) and *Ford* v. *Foster* (*c*) it was held that the habitual use of the manufacturer's name (which was alone a sufficient trade mark), before the special and distinctive appellation of "Excelsior" in the one case and "Eureka" in the other, did not amount to an abandonment of the manufacturer's right in those appellations when used without the name, but that the manufacturer remained entitled to his essential mark. In *Lea* v. *Millar* (*d*) it was held that, in addition to the evidence as to the common use of the alleged trade mark by persons other than the plaintiff, the fact that the plaintiff had recently adopted a new label upon his goods, on the ground that his existing label did not afford sufficient protection, was a public abandonment of the latter. And in *Manhattan Medicine Co.* v. *Wood* (*e*), it was held that a trade mark had been lost by abandonment, a new form of bottle and label having been adopted in place of the old ones. An exclusive right to a mark may be lost by its owner using it habitually and exclusively upon goods which pass through other persons' hands so that they acquire a right in it (*f*); and it would appear that, notwithstanding certain American decisions (*g*) to the effect that the habitual addition to a label of the name of the merchant to whom the goods are supplied does not deprive the owners of the label of their right to it, yet such a practice would cause the label to lose its distinctive character as indicating its proprietor's goods (*h*).

(*a*) See notes to § 74, *infrà*.
(*b*) 1 H. & M. 447.
(*c*) L. R. 7 Ch. 611.
(*d*) Dig. 513.
(*e*) 108 U. S. Rep. 218.
(*f*) *Robinson* v. *Finlay*, 9 Ch. D. 487.
(*g*) *Pike Manufacturing Co.* v. *Cleveland Stone Co.*, 35 Fed. Rep. 896; *Sheppard & Co.* v. *Stuart & Peterson*, 13 Phila. 117.
(*h*) *Wood* v. *Lambert*, 32 Ch. D. 247.