

It has been held in the United States that a partner who, on retiring from the partnership, sets up no claim to an interest in the trade mark, and sees, without objection, the remaining partner continuing to use it, must be taken to have abandoned all interest in it (a). But it has also been held in America that the continued use of the mark by the retiring partner, even on a spurious article, is evidence that he does not intend to abandon his interest (b).

Abandonment by a retiring partner.

In *Browne v. Freeman* (c) it was held that the plaintiff, having previously commenced a suit against an infringer of his trade mark, and then having got his bill dismissed with costs, in consequence of being advised that his right was doubtful, had lost all rights in the trade mark. Under the registration system such a loss of trade mark can seldom occur except in the case of unregistered though certified marks, since the rights of a proprietor of a registered mark are such that it is impossible to suppose that in many cases such a proprietor would resign his claims without a struggle. With respect to marks unregistered, or even uncertified, there does not appear to be anything in the Act to prevent proof of the imitation of such marks being given in support of an action for unfair competition in trade carried on by means of actual intentional fraud, and not depending solely on the similarity of the marks.

Abandonment by dismissal of suit.

On the whole, it may be expected that, with respect to registered marks, there will be in the future but little discontinuance or abandonment, except where registration has been discontinued, in consequence of non-compliance on the part of the registered proprietor with the requirements of the Act with respect to prolonged registration.

Abandonment of registered marks not to be anticipated.

(a) *Kidd & Co. v. Mills, Johnson & Co.*, 5 U. S. Pat. Gaz. 337; but see *Kidd v. Johnson*, 100 U. S. Rep. 617. See also *Swift v. Peters*, 11 U. S. Pat. Gaz. 1110; *Simpson v. Wright* (1), 15 *ib.* 248; *Holt v.*

Menendez, 128 U. S. Rep. 182.

(b) *Wright v. Simpson*, 15 U. S. Pat. Gaz. 968.

(c) 12 W. R. 305; and see W. N. 1873, p. 178. See *Massam v. Thorley's Cattle Food Co.*, 14 Ch. D. 748.

Infringement
of disused
mark.

In *Lemoine v. Ganton* (a), a plaintiff was allowed to recover nominal damages for the infringement by the defendant of a trade mark which the plaintiff had formerly used, but had ceased to use for a year. And it has also been held by the United States Commissioner of Patents that a person who, after having acquired certain rights in a trade mark, has discontinued his business for several years, recovers, on again commencing business, superior rights in the trade mark to those possessed by another person who has used the mark during the period of discontinuance (b).

Effect of
removed
mark.

By § 79 (5), as amended by the Act of 1888, a registered trade mark removed from the register is, for the purpose of any application for registration during one year next after the date of such removal, to be deemed to be a trade mark already registered.

Cancellation.

By § 91 power is given to the comptroller upon a proper application to cancel the whole or a part of the entry of a trade mark on the register. In this case a statutory declaration by the registered proprietor is necessary (c).

(a) 2 E. D. Smith, 343; R. Cox, 142.

(b) *Armistead v. Blacknell*, 1 U. S. Pat. Gaz. 603.

(c) See notes to § 91, *infra*, and Forms O. and P

CHAPTER IV.

INFRINGEMENT.

WHEN an action has been commenced, having for its object the restraint of an unfair competition in trade, carried on by means of an employment by the defendant of a trade mark identical, or nearly identical, with the plaintiff's, there must be established, in order for the action to be successful, the existence of the trade mark, the plaintiff's exclusive right therein (a), the fact of an imitation, and the absence of licence or acquiescence on the part of the plaintiff (b). Requisites for infringement.

Assuming, then, the validity of the trade mark and the rights of the plaintiff therein to be established, the next and most important point for the plaintiff to prove is the fact of infringement. The plaintiff has no right to say that the defendant shall not sell exactly the same article, better or worse, or an article looking exactly like his own unpatented article; but he has a right to say that the defendant shall not sell such article in such a way as to steal (so to call it) the plaintiff's trade mark, and make purchasers believe that it is the manufacture to which that trade mark was originally applied (c). In the language of the Common Law, the defendant has no right to sell his goods "as and for" those of the plaintiff (d); and "where Fact of infringement.

(a) As to this, see *Witthaus v. Braun*, 44 Md. 303; *Popham v. Wilcox*, 38 N. Y. Super. Ct. 274; *Weston v. Ketcham* (1) and (2), 39 *ib.* 54; 51 How. Pr. 455; and *Compagnie Laferme v. Hendrickx*, Dig. 512.

(b) See *Kinahan v. Bolton*, 15 Ir. Ch. 75; and *Leather Cloth*

Co. v. American Leather Cloth Co., 4 De G. J. & S. 137.

(c) See per Lord Cranworth, C., in *Farina v. Silverlock*, 6 De G. M. & G. 214; and per Lord Langdale, M.R., in *Franks v. Weaver*, 10 Beav. 297.

(d) *Sykes v. Sykes*, 3 B. & Cr. 541; *Morison v. Salmon*, 2 Man. & G. 385; *Crawshay v. Thompson*, 4 *ib.* 357.

it is shown that a dealer has the imitated article in his store, and offers it for sale as genuine, even though but a single sale is proved (a), that is sufficient to sustain an injunction against a continuance of the wrong, and an action for such injunction will not be defeated solely on the ground that on the day it is brought the dealer happens not to have any of the article on hand" (b).

Fraudulent intention.

The question of how far a fraudulent intention in the mind of the defendant was necessary to entitle the plaintiff to obtain redress from him long remained a subject of discussion in connection with trade marks. The doctrine of the Common Law was that, inasmuch as the only manner in which the Common Law could be set in motion to repair the wrongful proceedings of an infringer was by the institution of an action on the case (c), an allegation of intentional fraud (d), supported by evidence, was necessary to enable the plaintiff to bring his action to a successful conclusion (e).

First purchaser not deceived.

While, however, it was necessary at Common Law for a fraudulent intention to be proved, it was not required that the defendant should have represented to his immediate purchaser that the goods marked were of the plaintiff's manufacture; it was sufficient to bring the case within the reach of the law if he had sold the goods for the purpose of their being resold as and for goods of the plaintiff's manufacture, which object the mark attached to them by the defendant would be calculated to facilitate (f).

Early doctrine in Chancery.

When plaintiffs in trade-mark cases began to seek

(a) See *Bondier v. Depatie*, 3 Dorion 233.

(b) Per the New York Court of Appeals in *Low v. Hart*, 90 N. Y. 457.

(c) See *Crawshay v. Thompson*, 4 Man. & G. 357.

(d) I.e., that the defendant had acted knowingly—*scienter*.

(e) *Singleton v. Bolton*, 3 Dong. 293; *Morison v. Salmon*, 2 Man. & G. 385; *Crawshay v. Thompson*, 4

ib. 357; *Rodgers v. Nowill*, 5 C. B. 109; and *Myers v. Baker*, 3 H. & N. 802. See, too, per Parke, B., in *Taylor v. Ashton*, 11 M. & W. 415.

(f) *Sykes v. Sykes*, 3 B. & Cr. 541; and see *Chappell v. Davidson*, 2 K. & J. 123; *Rose v. Loftus*, 47 L. J. Ch. 576; *Orr-Ewing & Co. v. Johnston & Co.*, 7 App. Cas. 219; *Balfour & Co. v. Kilburn & Co.*, 1 Hyde, 270.

redress in the Court of Chancery, desirous of obtaining the more convenient remedy by way of injunction and account, which was superior to the damages to be gained at Common Law alike in the compensation for the past and in the security for the future, the Chancery judges held that the Courts in which they presided could act only in aid of and as ancillary to the legal right (a). And acting upon this same principle, they held that the rules by which they had to judge of infringement must be identical with those of the Common Law, the plaintiff's right to his remedy being considered to be based, not on any right of property in him, but on the fraudulent proceedings of the defendant (b). The cases which were frequently sent by Chancery judges to be tried at Common Law by a jury were, of course, tried in accordance with Common Law principles (c).

It is, however, apparent that the seriousness of the injury inflicted on the manufacturer who has acquired a reputation for excellence in a particular class of goods, denoted by a special trade mark, by the offering for sale in the market of other goods, side by side with his, bearing the same mark, is not affected by the question whether such rival goods are made and marked by a person who is aware of the reputation of the original goods and desirous of attracting to himself some of the profits of that reputation, or by one who is actuated by no such motives, and is even ignorant of the prior use of the mark. As Lord Cairns, C., said, in a well-known case (d):—"A man may take the trade mark of another ignorantly, not knowing it

Same injury caused, whether actual fraud or not.

(a) See per Lord Cottenham, C., in *Motley v. Downman*, 3 My. & Cr. 1.

(b) *Blanchard v. Hill*, 2 Atk. 484; *Canham v. Jones*, 2 V. & B. 218; *Perry v. Truefitt*, 6 Beav. 66; *Croft v. Day*, 7 Beav. 84. And see the observations of V.-C. Wood in *Edelsten v. Vick*, 11 Hare, 78; *Collins Co. v. Coven*, 3 K. & J. 428;

Leather Cloth Co. v. American Leather Cloth Co., 1 H. & M. 271; *Hall v. Barrows*, 32 L. J. Ch. 548; and *McAndrew v. Bassett*, 33 L. J. Ch. 561.

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

(d) *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 391.

was the trade mark of the other; or he may take it in the belief, mistaken but sincerely entertained, that in the manner in which he is taking it he is within the law, and doing nothing which the law forbids; or he may take it knowing it is the trade mark of his neighbour, and intending and desiring to injure his neighbour by so doing. But in all these cases it is the same act that is done, and in all these cases the injury to the plaintiff is just the same." "If a man has acquired legitimately a right to the property in an exclusive use of a name, it is of small account to him, should it be invaded, whether the invasion comes from a purpose to deceive, or from ignorance, or inadvertence, or an honest misconception of the relative rights of the parties; and the law ought not to permit, and will not permit, the continuance of the invasion, whatever may have been its origin" (a). The first maker is defrauded, even though his rival's conduct be not intentionally fraudulent.

Later
doctrine in
Chancery.

In 1838, Lord Cottenham, C., awarded a perpetual injunction in a case in which he rejected any imputation of intentional fraud (b), and this is not now necessary to obtain redress in equity. The principles in accordance with which relief will be given in equity were summed up as follows by Lord Westbury, C.:—"At Law the proper remedy is by action on the case for deceit, and proof of fraud on the part of the defendant is of the essence of the action; but this Court will act on the principle of protecting property alone, and it is not necessary for the injunction to prove fraud in the defendant, or that the credit of the plaintiff is injured by the sale of an inferior article. The injury done to the plaintiff in his trade by loss of custom is sufficient to support his title to relief. Neither will the plaintiff be deprived of remedy in Equity,

(a) Per Lord O'Hagan, *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 396; and see per Cotton, L. J., in *Singer Manufacturing Co.*

v. Loog (3), 18 Ch. D. 412; and *Blackwell v. Wright*, 73 N. Car. 310.

(b) *Millington v. Fox*, 3 My. & Cr. 338.

even if it be shown by the defendant that all the persons who bought from him goods bearing the plaintiff's trade mark were well aware that they were not of the plaintiff's manufacture. If the goods were so supplied by the defendant for the purpose of being sold again in the market the injury to the plaintiff is sufficient. Again, it is not necessary for relief in Equity that proof should be given of persons having been actually deceived, and having bought goods with the defendant's mark, under the belief that they were of the manufacture of the plaintiff, provided that the Court be satisfied that the resemblance is such as would be likely to cause the one mark to be mistaken for the other" (a). It is not necessary for the plaintiff to show that the defendant knew whose trade mark his resembled (b), nor, in fact, to show that the defendant knew that his trade mark resembled any existing mark (c). "The action of the Court must depend upon the right of the plaintiff, and the injury done to that right. What the motive of the defendant may be, the Court has very imperfect means of knowing. If he was ignorant of the plaintiff's rights in the first instance, he is, as soon as he becomes acquainted with them and perseveres in infringing upon them, as culpable as if he had originally known them" (d). In short, "the absence of fraudulent intention is no defence against an application to the Court for an injunction by the person whose property has been injured" (e); and

(a) *Edelsten v. Edelsten*, 1 De G. J. & S. 185. That the rule of the Court of Chancery was as here stated, was recognised by the Court of Queen's Bench in *Dixon v. Fawcus*, 3 Ell. & Ell. 537.

(b) *Cartier v. Carlile*, 31 Beav. 292.

(c) *Kinahan v. Bolton*, 15 Ir. Ch. 75; *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Burgess v. Hills*, 26 Beav. 244; *Harrison v. Taylor*, 11 Jur. N. S. 408; *Orr-Ewing & Co.*

v. Grant, Smith & Co., 2 Hyde, 185; and see per Cotton, L. J., in *Singer Manufacturing Co. v. Loog* (3), 18 Ch. D. 412.

(d) Per Lord Cairns, C., in *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 376-91.

(e) Per Stuart, V.-C., in *Clement v. Maddick*, 1 Giff. 98; *Orr-Ewing & Co. v. Johnston & Co.*, 13 Ch. D. 434; *Rose v. Loftus*, 47 L. J. Ch. 576; *Upmann v. Forester*, 24 Ch. D. 231; *Coven v. Hulton*,

even if a person who has in his possession a quantity of goods bearing a spurious trade mark, is not intending to sell them or part with them, but to use them for his own consumption, relief will be granted against him (a).

Indulgence to innocent offender.

It was, however, suggested by Lord Romilly, M. R., that the Court would not require a person to completely change a trade mark which he had taken *bonâ fide*, and without any intention of deception, but which did in point of fact resemble the trade mark of another person, since the complete change of trade mark might be of so serious consequence to the unintentional offender (b); and it has been held in America that a plaintiff may lose by delay his right to an injunction against an innocent vendor of goods spuriously marked, whatever might be the case with regard to the guilty manufacturer (c).

Fraudulent intention, as affecting account, or damages.

It is also important to prove the fact of fraudulent intention, having regard to the account to be obtained, which may not be given in respect of sales by the defendant during such time as he continued in ignorance that he was infringing the plaintiff's rights (d), or with a view to the question of damages (e).

Fraudulent intention in case of delay.

Again, in *Rodgers v. Rodgers* (f), Mellish, L. J., 46 L. T. N. S. 897. The same principle holds good in Ireland: *Bodega Co., Ltd. v. Owens*, 23 L. R. Ir. 371; in the United States: *McLean v. Fleming*, 96 U. S. Rep. 245; *Stonebraker v. Stonebraker*, 33 Md. 252; *Amoskeag Manufacturing Co. v. Garner* (2), 54 How. Pr. 298; *Colman v. Crump*, 70 N. Y. 573; *Blackwell v. Wright*, 73 N. Car. 310; *McCann v. Anthony*, 21 Mo. App. 83; *Williams v. Brooks*, 50 Conn. 278; *Pratt's Appeal*, 117 Penn. St. 401; in India: *Balfour & Co. v. Kilburn & Co.*, 1 Hyde, 270; *Orr-Ewing & Co. v. Grant, Smith & Co.*, 2 Hyde, 185; *Graham & Co. v. Kerr, Dods & Co.*, 3 Beng. L. R. App. 4; and in Australia: *Hennessy v. White*, 6 W. W. & A'B. Eq. 216; *Hennessy v. Hogan*, 6 W. W. & A'B. Eq. 225.

(a) *Upmann v. Forester*, 24 Ch. D. 231. But see *Upmann v. Currey*, 29 Sol. J. 735.

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

(c) *Rodgers v. Philp*, 1 U. S. Pat. Gaz. 29.

(d) *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Moet v. Couston*, 33 Beav. 578. See *Rose v. Loftus*, 47 L. J. Ch. 576.

(e) See *Faber v. D'Utassey*, 11 Abb. Pr. N. S. 399; *Weed v. Peterson*, 12 Abb. Pr. N. S. 178.

(f) 31 L. T. N. S. 285. And see *McLean v. Fleming*, 96 U. S. Rep. 245, where an injunction which had been granted was confirmed by the U. S. Supreme Court, notwithstanding a delay of many years.

expressed an opinion that, in a case in which the application for an injunction would, in the absence of proof of actual fraud, have to be rejected on the ground of long user by the defendants without assertion by the plaintiffs of their right, yet if it were clearly made out that the use of the trade mark by the defendants was fraudulent, and that it had the practical effect of deceiving the public, then in such a case the intentional fraud would operate to prevent the application for the injunction from being defeated on the ground of lapse of time.

Further, in *Radde v. Norman* (a), it was held by Wickens, V.-C., to be quite obvious that much less absolute proof of the plaintiff's title would be required where there was reason to doubt the defendant's good faith; and in *Cope v. Evans* (b), Hall, V.-C., said that where fraudulent intention was proved, the Court would restrain the defendants without further inquiry.

In default of direct proof of fraudulent intention, there are various circumstances which may serve to point to the conclusion that such intention has existed: thus, the continuing to use a mark after objections raised (c); the exact imitation of peculiar characteristics (d); the addition

In other respects.

Circumstances pointing to fraudulent intention.

(a) L. R. 14 Eq. 348.

(b) L. R. 18 Eq. 138. And see *Condy v. Mitchell*, 37 L. T. N. S. 268, 766; *Wilson v. Maxfield*, L. J. N. of C. 1875, p. 51; *McLean v. Fleming*, 96 U. S. Rep. 245; *Mowie Nerve Food Co. v. —*, 43 U. S. Pat. Gaz. 888; *Miller Tobacco Manufactory v. Commerce*, 45 N. J. Law 123.

(c) See per Lord Cairns in *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 376; and per Cotton, L. J., and Lord Blackburn in *Singer Manufacturing Co. v. Loog* (3), 18 Ch. D. 395; 8 App. Cas. 15. Also *Williams v. Osborne*, 13 L. T. N. S. 498; *McAndrew v. Bassett*, 4 De G. J. & S. 380; *Orr-Ewing & Co. v.*

Johnston & Co., 13 Ch. D. 434; *Walker v. Alley*, 13 Grant Up. Can. Ch. 366; *Bodega Co., Ltd. v. Owens*, 23 L. R. Ir. 371; *Holt v. Menendez*, 128 U. S. Rep. 182.

(d) *Hine v. Lart*, 10 Jur. 106; *McLean v. Fleming*, 96 U. S. Rep. 245; *Frese v. Baehof* (2), 14 Bl. C. C. 432; *Davis v. Reid*, 17 Grant Up. Can. Ch. 69; *Rodgers v. Philp*, 1 U. S. Pat. Gaz. 29; *Landreth & Sons v. Landreth*, 22 Fed. Rep. 41; *Glen Cove Manufacturing Co. v. Ludeman*, 23 Bl. C. C. 46; *Southern White Lead Co. v. Carey*, 25 Fed. Rep. 125; *Anheuser Busch Brewing Association v. Clarke*, 26 Fed. Rep. 410; *Pierce v. Guittard*, 68 Cal. 68.

to an existing mark of a feature taken from the plaintiff's mark (*a*); the imitating changes introduced by the plaintiff (*b*); the removal, one by one, of points of difference, which originally served to distinguish the defendant's mark from the plaintiff's (*c*); the marking goods in obedience to an order to imitate the plaintiff's mark (*d*); the giving orders for that to be done (*e*); the adoption of an essential part of the plaintiff's mark, with a trifling and colourable alteration (*f*); the placing of a word resembling the plaintiff's word on the same spot on an article of the same shape (*g*); the statement that the sources from which both plaintiff and defendant derive their raw material, and after which the plaintiff's works are named, are the defendant's sole property (*h*); the use on the goods of the name of a town where the defendant does not carry on business but the plaintiff does (*i*); the copying directions for use (*k*); the giving thanks to the plaintiff's customers for past favours (*l*); the adoption of similar type to the plain-

(*a*) *Dixon v. Jackson*, Ct. of Sess. Cas., 3rd Ser., V. 326 (a star added); *Ralli v. Fleming*, Ind. L. R. 3 Calc. 417.

(*b*) *Braham v. Beacham* (1), 7 Ch. D. 848; *Siegert v. Findlater*, *ib.* 801.

(*c*) *Farina v. Cathery*, L. J. N. of C., 1867, p. 134; *Brown v. Mercer*, 37 N. Y. Super. Ct. 265; *Bell, Black & Co. v. Bell & Co.*, Dig. 514; *Reynolds & Son v. Walker*, 87 L. T. (Journal) 93; *Celluloid Manufacturing Co. v. Cellonite Manufacturing Co.*, 32 Fed. Rep. 94; *Pratt's Appeal*, 117 Penn. St. 401.

(*d*) *Woollam v. Ratcliff*, 1 H. & M. 259.

(*e*) *Godillot v. Hazard*, 81 N. Y. 263; *Twentsche Stoom Bleekery Goor v. Ellinger & Co.*, 26 W. R. 70.

(*f*) *Radde v. Norman*, L. R. 14 Eq. 348 ("Leopoldsalt" for "Leopoldshall"); *Derby Photographic Dry Plate Co. v. Pollard, Graham*

& Co., 2 Times L. R. 276 ("Derwent" for "Derby"); *Thompson v. Montgomery*, 41 Ch. D. 35 (a T for a cross); *Avery & Sons v. Meikle & Co.*, 27 U. S. Pat. Gaz. 1027; *Davis v. Reid*, 17 Grant Up. Can. Ch. 69; *Orr-Ewing & Co. v. Johnston & Co.*, 13 Ch. D. 431; *Balfour & Co. v. Kilburn & Co.*, 1 Hyde, 270.

(*g*) *Slazenger & Sons v. Feltham & Co.*, 6 P. R. 531.

(*h*) *Wheeler v. Johnston*, 3 L. R. Ir. 284.

(*i*) *Anheuser Busch Brewing Association v. Piza*, 23 Bl. O. C. 245; *Southern White Lead Co. v. Carey*, 25 Fed. Rep. 125.

(*k*) *Franks v. Weaver*, 10 Beav. 297; *Sedon v. Senate*, Dig. 18; *Youatt v. Winyard*, 1 Jac. & W. 394; *Blofeld v. Payne*, 4 B. & Ad. 410; *Day v. Walls*, 12 Phila. 274; and many other cases.

(*l*) *Mogford v. Courtenay*, 45 L. T. N. S. 303; *Walker v. Alley*, 13 Grant Up. Can. Ch. 366.

tiff's (a); the use of large type for a catchword (b); or of small type for a word showing the article not to be the original (c); the imitation of numbers used by the plaintiff (d); the imitation of the barrels (e), or bottles (f), containing the plaintiff's article; the buying up and using the plaintiff's old bottles (g); the use by the defendant of a name not his own (h), possibly under the authority of some person who bore the same name as the plaintiff (i); the formation of a partnership with another person, whose name or initial was such as to enable the defendant to imitate the plaintiff's mark with some specious pretence of legality (k); the addition of "and Co." after the name (l); the alteration of a name acquired by purchase with the

(a) *India Rubber Comb Co. v. Rubber Comb and Jewelry Co.*, 45 N. Y. Super. Ct. 258; *Potter v. McPherson*, 28 N. Y. Sup. Ct. 559.

(b) *Wotherspoon v. Currie*, L. R. 5 H. L. 508; *Metzler v. Wood*, 8 Ch. D. 606; *Dence v. Mason* (1), Dig. 534; *Foot v. Lea*, 13 Ir. Eq. 484.

(c) *Day v. Binning*, C. P. Coop. 489; *Glenny v. Smith*, 2 Dr. & Sm. 476; *Hookham v. Pottage*, L. R. 8 Ch. 91; *Robinson v. Charbonnel*, W. N., 1876, p. 160; *Dence v. Mason* (1), Dig. 534; 41 L. T. N. S. 573; *Colton v. Thomas*, 7 Phila. 257; *Chubb v. Priest*, 1 L. T. 142; *Hennessy v. White*, 6 W. W. & A'B. Eq. 216; *Morgan v. Schuyler*, 79 N. Y. 490.

(d) *Humphreys' Specific Homœopathic Medicine Co. v. Wenz*, 14 Fed. Rep. 250.

(e) *Moorman v. Hoge*, 2 Sawy. 78; *Cook v. Starkweather*, 13 Abb. Pr. N. S. 392.

(f) *Henry v. Price*, 1 Leg. Obs. 364; *Siegert v. Findlater*, 7 Ch. D. 801; *Wolfe v. Goulard*, 18 How. Pr. 64; *Laird v. Wilder*, 9 Bush 131; *Congress Co. v. High Rock Co.*, 45 N. Y. 291; *Wilder v. Wilder*, Dig. 372; *Wolfe v. Hart*, 4 Vict. L. R. Eq. 125; *Fullwood v. Fullwood* (1), W. N. 1873, p. 93, 185; *Hostetter v. Adams*, 20 Bl.

O. C. 326; *Carbolic Soap Co. v. Thompson*, 25 Fed. Rep. 625; *Moxie Nerve Co. v. Baumbach*, 32 Fed. Rep. 205.

(g) *Rose v. Henley*, Dig. 551; *Allen v. Richards*, 26 Sol. J. 658; *Hostetter v. Anderson*, 1 V. R. Eq. 7.

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

(i) *Moriden Britannia Co. v. Parker*, 39 Conn. 450; 12 Amer. Rep. 401; *Perks v. Hall & Co.*, W. N. 1881, p. 111; *Melachrino v. Melachrino Egyptian Cigarette Co.*, 4 P. R. 215; *Sawyer v. Kollogg*, 7 Fed. Rep. 721; 9 *ib.* 601; *Rogers Manufacturing Co. v. Rogers & Spurr Manufacturing Co.*, 11 Fed. Rep. 495.

(k) *Croft v. Day*, 7 Beav. 84 (Day & Martin); *Moët v. Clybourn*, Dig. 533 (M. & C.). And see *Schweitzer v. Atkins*, 37 L. J. Ch. 847; *Hallett v. Cumston*, 110 Mass. 29; *M. Melachrino & Co. v. R. Melachrino & Co.*, Chitty, J., May 27th, 1888.

(l) *Churton v. Douglas*, Johns. 174; *Fullwood v. Fullwood* (1) W. N. 1873, pp. 93, 185; *Holt v. Smith*, 4 Times L. R. 329; *M. Melachrino & Co. v. R. Melachrino & Co.*, Chitty, J., May 27th, 1888; *Devlin v. Devlin*, 69 N. Y. 212; *Brooklyn White Lead Co. v. Masury*, 25 Barb. 416.

goodwill of a business, so as to assimilate it to the name of another firm carrying on a similar business (a); the removal into the plaintiff's neighbourhood (b); the adoption of a name for a manufactory similar to that used by another, and placing it on goods, but keeping it out of the Directory (c); the making an improper use of the defendant's relationship to the plaintiff (d); the claiming untruly to be the sole proprietor (e); the making an unfair reference to a former partnership (e); the making an intentional misstatement as to the date of the commencement of a business (f), or as to prizes gained at an exhibition (g); the false pretence of an appointment as purveyor to a royal personage (g); have all been held to afford ground for reasonable suspicion of the presence of an *animus fraudandi*.

Circumstances pointing to absence of fraud.

On the other hand, if the defendant uses, on the goods which he is alleged to be endeavouring to pass off as the plaintiff's, a distinct and obvious trade mark of his own, or if he states plainly and in fair-sized and clear type that such goods are in fact manufactured by himself, there is a strong indication that the defendant has no intention of attempting deception (h). So, again, if the defendant has

(a) *Holt v. Smith*, 4 Times L. R. 329.

(b) *Lee v. Haley*, L. R. 5 Ch. 155; *Fullwood v. Fullwood* (1), *ubi sup.*

(c) *Rodgers v. Rodgers*, 31 L. T. N. S. 285.

(d) *Gouraud v. Trust*, 10 N. Y. Sup. Ct. 627.

(e) *Wolfe v. Alsop*, 10 Vict. L. R. (E.) 41.

(f) *Fullwood v. Fullwood* (2), 9 Ch. D. 176; *Blackwell v. Armistead*, 5 Amer. L. T. 85.

(g) *Cave v. Myers*, Dig. 304.

(h) *Singer Manufacturing Co. v. Wilson*, 2 Ch. D. 434-44; so, too, in *Cheavin v. Walker*, 5 Ch. D. 850, where the goods were stated to be manufactured by the defendants. And see *Beard v. Turner*, 13 L. T.

N. S. 746; *Raggett v. Findlater*, L. R. 17 Eq. 29; *Singer Manufacturing Co. v. Loog* (3), 18 Ch. D. 395; *Magee Furnace Co. v. Le Barron*, 127 Mass. 115; *Wolfe v. Goulard*, 18 How. Pr. 64; *McCartney v. Garnhart*, 45 Mo. 593; *Gilman v. Hunnewell*, 122 Mass. 139; *Ayer v. Rushton*, 7 Daly, 9. But compare *Wotherspoon v. Currie*, L. R. 5 H. L. 508; *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 376; *Perry v. Truefitt*, 6 Beav. 66; *Braham v. Bustard*, 1 H. & M. 447; *Ford v. Foster*, L. R. 7 Ch. 611; *Siegert v. Findlater*, 7 Ch. D. 801; *Reinhardt v. Spalding*, 49 L. J. Ch. 57; *Henderson v. Jores*, Dig. 198; *Singer Manufacturing Co. v. Kimball & Morton*, Ct. Sess. Cas., 3rd Ser. XI. 267;

ventured to display at a public exhibition goods bearing the mark to which exception is afterwards taken (a); or if he has truly stated the connection between himself and the original adopter of the trade mark (b); or if, when using bottles moulded with the plaintiff's name, which have come into his possession without fraud, he places his own labels on the bottles in place of the plaintiff's (c).

A registered trade mark is property, and evidence of fraudulent intention is unnecessary in a case of alleged infringement of such a mark, as appears from the Patents Act, 1883, § 76 (d), in accordance with which the registration of a person as proprietor of a trade mark is *prima facie* evidence of his right to the *exclusive use* of such trade mark, and, after the expiration of five years from the date of such registration, conclusive evidence of his right to the exclusive use of such trade mark, subject to the provisions of the Act.

But when infringement of a registered trade mark is in question, the point is, not whether there has been infringement of the mark which the plaintiff has used in his business, but whether there has been infringement of the mark which he has actually registered. Thus, Jessel, M. R., said, in *Ellis & Sons v. Ruthin Soda Water Co.* (e), "As I understand the Trade Marks Act, if you come for trade

Fraud unnecessary where mark registered.

Where mark registered, infringement must be of mark as registered.

Lea v. Wolff, 46 How. Pr. 157; *Field v. Lewis*, Dig. 280; *Rose v. Loftus*, 47 L. J. Ch. 576; *Eno v. Stephens*, Dig. 609; *Kinahan v. Bolton*, 15 Ir. Ch. 75; *Williams v. Johnson*, 2 Bos. 1; *Phalon v. Wright*, 5 Phila. 464; *Boardman v. Meriden Britannia Co.*, 35 Conn. 402; *Whitney v. Hickling*, 5 Grant Up. Can. Ch. 605; *Hier v. Abrahams*, 82 N. Y. 519; *Thornton v. Crowley*, 47 N. Y. Super. Ct. 527; *Hegeman & Co. v. O'Byrne*, 9 Daly, 264; *Frese v. Bachof* (2), 14 Bl. C. C. 432; *Carroll v. Ertheiler*, 1 Fed. Rep. 688; *Kleischmann v. Schuckmann*, 62 How. Pr. 92; *Lewis v. Klapproth*, 11 Vict. L. R. 214.

(a) *Beard v. Turner*, 13 L. T. N. S. 746.

(b) *Emerson v. Badger*, 101 Mass. 82; *Gilman v. Hunnewell*, 122 *ib.* 139.

(c) *Rose v. Loftus*, 47 L. J. Ch. 576; *Barrett v. Gomm*, 74 L. T. (Journal) 388; *Barrett v. White*, North, J., May 12th, 1883.

(d) This re-enacts § 3 of the Trade Marks Registration Act, 1875.

(e) M. R., Nov. 21st, 1879. And see *Nuthall v. Vining*, C. A., Jan. 21st, 1880; *Lamplough v. Beedzler*, C. A., Nov. 12th, 1880; *Russell & Sons, Ltd. v. Smith*, M. R., June 18th, 1880; *In re Lyndon*, 32 Ch. D. 109.

mark and not for actual fraud, you can only sue in respect of what you had registered as a trade mark." And in considering whether there has been infringement of the registered mark, it is necessary to see whether the essential particular in that registered mark has been imitated. Thus it was held by Jessel, M. R., in *In re Horsburgh (a)*, that there was no conflict between two marks which combined substantially the same descriptive word with different devices, since the essential particulars, the devices, being different, it was immaterial that the marks resembled each other in a non-essential feature.

Burden of proof.

When a defendant has taken the material and essential part of the plaintiff's trade mark, the burden is upon the defendant to disprove the probability of deception, not upon the plaintiff to prove it (*b*).

Infringement of names as old marks.

With respect to trade marks used before the passing of the Trade Marks Registration Act, 1875, and consisting of a name printed or stamped in ordinary characters, which might be the case independently of the Act, it has been held that it is not necessary, in order to obtain an injunction, to prove the *scienter* where the infringer does not bear the name he has assumed (*c*), but that, on the other hand, where he does bear that name, such evidence must be produced (*d*); and, in the same way, where two firms have become entitled to use the same trade mark or firm name, it is only in a case of fraud that an injunction will be granted; and an allegation that the defendants use the mark on inferior goods is not sufficient, since, if they have the right to use it, they can use it as they please (*e*).

Infringement of names as new marks.

With respect to names first used as trade marks after

(a) 53 L. J. Ch. 237. And see *Lucke v. Webster*, M. R., April 4th, 1879.

(b) *Ford v. Foster*, L. R. 7 Ch. 611; *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 376; *Orr-Ewing & Co. v. Johnston & Co.*, 13 Ch. D. 434.

(c) *Ainsworth v. Walmsley*, L. R.

1 Eq. 518; *McLean v. Fleming*, 96 U. S. Rep. 245.

(d) *Burgess v. Burgess*, 3 De G. M. & G. 896; *Turton & Sons, Ltd. v. Turton*, 42 Ch. D. 128; *McLean v. Fleming*, 96 U. S. Rep. 245.

(e) *Rogers v. Taintor*, 97 Mass. 291; *Emerson v. Badger*, 101 *ib.* 82.

the passing of the Act of 1875, the requirement that they shall be "~~printed, impressed, or woven, in some particular and distinctive manner~~" (a), renders the mere use of the same name no infringement, unless the particular and distinctive manner is also copied, in which case evidence of actual intentional fraud will be unnecessary, whatever may be the name of the infringer.

In the same way, where a trade mark consisting of the coloured threads which form the heading to a piece of stuff (b), or of the representation of a coin (c), or of any other mark in which colour is essential, and which would lose its distinctiveness by being registered in the ordinary way, has been registered by deposit, it will not be infringed unless the colour and arrangement have been imitated. But, where the trade mark does not substantially consist in colour, and has been registered in the ordinary way, then, though the mark has been registered in colour, the exclusive right to use the mark in any colour is now given to the registered proprietor (d).

When it is alleged that a trade mark registered without colour has been infringed, it has been said that the proper manner of comparing the two trade marks is to compare their designs in the same size and free from colour, and that similarities in respect of colour in actual use should only be regarded in order either to prove fraud or to turn the scale when the question of infringement, leaving colour out of sight, is very difficult to decide (e). Where the plaintiffs had used a label for coffee, coloured red,

(a) Patents Act, 1883, § 64, amended by Act of 1888. And see *In re Gianacis*, 58 L. J. Ch. 782.

(b) *Mitchell v. Henry*, 15 Ch. D. 181.

(c) *In re Robinson*, 29 W. R. 31. And see *In re Horsburgh*, 53 L. J. Ch. 237. In America it has been held that where the identical form, size, colour, and style of a numeral

registered as a trade mark had been copied, an infringement had been committed, although it would have been no infringement to have used the numeral without copying those peculiarities: *Kinney v. Allen*, 1 Hughes, 106.

(d) Patents Act, 1883, § 67.

(e) Per Ct. of App. in *Nuthall v. Vining*, C. A., Jan. 21st, 1880.

Mode of comparing uncoloured marks.

white and blue, and containing the words "red, white and blue label," and had registered it without colour, the use by others of labels similarly coloured and containing the words was restrained (a). Another mode of comparing two trade marks is to compare the designs in the same colour (b), but this is more appropriate to cases of opposed registration.

What is infringement.

The real question which the Court has to try in a case of alleged infringement of trade mark, is whether what the defendant has done is calculated to deceive, whether there is so much imitation that goods bearing the one mark may be readily mistaken for goods bearing the other, and whether a careful inspection is necessary to distinguish the mark and appearance of the former goods from those of the latter (c).

Croft v. Day. In *Croft v. Day* (d), it was remarked by Lord Langdale, M. R., that two things were necessary for the accomplishment of a fraud such as was there contemplated: "First, there must be such a general resemblance of the forms, words, symbols, and accompaniments as to mislead the public; and, secondly, a sufficient distinctive individuality must be preserved, so as to procure for the person himself the benefit of that deception which the general resemblance was calculated to produce. To have a copy of the thing would not do, for, though it might mislead the public in one respect, it would lead them back to the place where they were to get the genuine article, an imitation of which was improperly sought to be sold. For the accomplishment of such a fraud it was necessary in the first instance to mislead the public, and in the next place to secure a benefit to the party practising the de-

(a) *Hanson v. British Tea and Trading Association (Ld.)*, Bacon, V.-C., April 9th, 1884; C. A. June 19th, 1884. The same trade mark was afterwards refused registration under P. A. 1883; *In re Hanson*, 37 Ch. D. 112.

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

(c) See per Bynum, J., in *Blackwell v. Wright*, 73 N. Car. 310.

(d) 7 Beav. 84.

ception by preserving his own individuality" (a). In that case, however, a deliberate attempt was made to represent the defendant's establishment as the plaintiff's, and the injury done to the plaintiff by the sale of goods bearing the spurious marks instead of his genuine goods is ordinarily sufficient to entitle him to his remedy, independently of any habit induced in the customer to resort to the defendant instead of to the plaintiff.

By what test, then, has it to be determined whether there is such a degree of similarity as to require the interference of the Court? Tests of infringement.

In the first place, where one person has adopted the trade mark of another, or a mark nearly resembling it, and there is evidence of actual deception—that is to say, "that any one has in fact been thereby induced to buy the defendant's goods as being the goods of the plaintiff—the question of resemblance has been decided by the test of facts, and the Court will restrain the defendant without further inquiry (b), unless it is clearly of opinion that the resemblance is so slight that no rational person ought to have been deceived (c). It is not, indeed, necessary that there shall have been actual deception (d), or damage sustained (e); but since, unless that can be proved, the case which the Court has to try is a hypothetical case, in which honest evidence as to the likelihood of deception can in all probability be procured on both sides (f), it is always Actual deception.

(a) And see *Edelsten v. Vick*, 11 Hare, 78; *Rowley v. Houghton*, 2 Brews. 303; R. Cox, 486; *Enoch Morgan's Sons' Co. v. Schwachhofer*, 55 How. Pr. 37.

(b) *Cope v. Evans*, L. R. 18 Eq. 138; and see *Woollam v. Ratcliff*, 1 H. & M. 259; *McLean v. Fleming*, 96 U. S. Rep. 245; *Cook v. Starkweather*, 13 Abb. Pr. N. S. 392; *Kinney v. Basch*, Dig. 542.

(c) *Civil Service Supply Association v. Dean*, 13 Ch. D. 512.

(d) *Abbott v. Bakers & Confectioners' Tea Association*, W. N. 1871,

p. 207; *Field v. Lewis*, Dig. 280; and see *Filley v. Hassett*, 44 Mo. 173; R. Cox, 530; *Dixon Crucible Co. v. Guggenheim*, 2 Brews. 321; R. Cox, 559; and *India Rubber Comb Co. v. Rubber Comb & Jewelry Co.*, 45 N. Y. Super. Ct. 258.

(e) *Braham v. Beashim* (1), 7 Ch. D. 848.

(f) As a rule, not much weight is given to expert evidence on questions of similarity. See *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *Cook v. Starkweather*, 13 Abb. Pr. N. S. 392; *Popham v. Wilcox*,

safer for a plaintiff to obtain proof of actual deception if possible, and a certain degree of delay to enable him to obtain such proof will be excused (a).

Probable
deception.

In most cases, however, there is not produced any evidence of actual deception, and the plaintiff then has to satisfy the Court or jury that the defendant has used a mark either identical with, or only colourably differing from, his own (b). It is not sufficient for the plaintiff to produce evidence tending to show that in the opinion of the witnesses deception may occur: he has to convince the Court or jury that there is such reasonable probability of deception as to justify interference with the defendant (c);

66 N. Y. 69; but there may be circumstances in which much weight will be given to it: *Mitchell v. Henry*, 15 Ch. D. 181; *In re Worthington*, 14 Ch. D. 8; *In re Christiansen*, 3 P. R. 54; *Williams v. Brooks*, 50 Conn. 278. In *Wallace & Co. v. King & Co.*, Bomb. High Ct., April 30th, 1879, it was held in the High Court of Bombay that evidence given by European witnesses in Bombay and Manchester as to the probability of deception, was not admissible under the Indian Evidence Act, the witnesses not being experts, and the question not being one of science or art.

(a) *Lee v. Haley*, L. R. 5 Ch. 155; *Cave v. Myers*, Dig. 304.

(b) See *Cartier v. Carlile*, 31 Beav. 292; and *Cope v. Evans*, L. R. 18 Eq. 138.

(c) *Blackwell v. Crabb*, 36 L. J. Ch. 504; *Bass v. Dawber*, 19 L. T. N. S. 626; *Cope v. Evans*, L. R. 18 Eq. 138; *Snowden v. Noah*, Hopk. 347; R. Cox, 1; *Colladay v. Baird*, 4 Phila. 139; R. Cox, 257; *Colton v. Thomas*, 2 Brews. 308; R. Cox, 507; *Falkinburg v. Inoy*, 35 Cal. 52; R. Cox, 448; *Bell v. Locke*, 8 Paige, 75; R. Cox, 11; *Ledger v. Ray*, Dig. 550; *Stephens v. DeConto*, 30 N. Y. Sup. Ct. 343; R. Cox, 442; *Wylam v. Clarke*, W. N. 1876, p. 68; *Condy v. Mitchell*, 37 L. T. N. S. 268, 766; *Wilson v. Maxfield*, L. J.

N. of C. 1875, p. 51; *Ellis v. Zeilen & Co.*, 42 Ga. 91; *Blackwell v. Wright*, 73 N. Car. 310; *Cook v. Starkweather*, 13 Abb. Pr. N. S. 392; *Degraves v. Whiteman*, 5 Vict. L. R. Eq. 304; *Lamplough v. Beedzler*, C. A., Nov. 12th, 1880; *Enoch Morgan's Sons' Co. v. Trowell*, 89 N. Y. 292; *American Grocer Publishing Association v. Grocer Publishing Co.*, 51 How. Pr. 402; *Massam v. Thorley's Cattle Food Co.*, 14 Ch. D. 748; *In re Imbs*, 10 U. S. Pat. Gaz. 463; *Daves v. Davies*, Dig. 426; *Prince Metallic Paint Co. v. Carbon Metallic Paint Co.*, Dig. 573; *Wheeler v. Johnston*, 3 L. R. Ir. 284; *Chinn v. Thomas*, 5 Vict. L. R. Eq. 188; *Goodwin v. Venning*, 24 Sol. J. 690; *Amoskeag Manufacturing Co. v. Trainer*, 101 U. S. Rep. 51; *Hurricane Patent Lantern Co. v. Miller & Co.*, 56 How. Pr. 234; *Talbot v. Webley*, 3 P. R. 276; *Beddow & Sons v. Boyd*, 4 P. R. 310; *Vogeler Co. v. Middleton*, 84 L. T. (Journal) 45 (where the plaintiffs sold "St. Jacob's Oil," and the defendants sold "St. Joseph's Oil"); *Waterman v. Ayres*, 39 Ch. D. 29; *Great Tower St. Tea Co. v. Smith*, 6 P. R. 165; *Gail v. Wackerbart*, 28 Fed. Rep. 286; *Liggett & Myers Tobacco Co. v. Finzer*, 128 U. S. Rep. 182; *New Haven Patent Rolling Spring Bed Co. v. Farren*, 51 Conn. 324; *Rogers v. Rogers*, 53 Conn. 121;

and if he "cannot allege and prove that the public are deceived, or that there is a reasonable probability of deception, he has no right to interfere with the use of the mark by others" (a). But where this burden is discharged, the defendant's conduct "cannot be justified by showing that the device or inscription upon the imitated mark is ambiguous, and capable of being understood by different persons in different ways" (b).

It is obvious that in these cases questions of considerable nicety may arise; and, in the language of Lord Cranworth, C., in *Seixo v. Provezende* (c), "it is hardly necessary to say that, in order to entitle a party to relief, it is by no means necessary that there should be absolute identity (d). What degree of resemblance is necessary, is, from the nature of things, a matter incapable of definition *à priori* (e). All that Courts of Justice can do is to say that no trader can adopt a trade mark so resembling that of a rival as that ordinary purchasers, purchasing with ordinary caution, are likely to be misled (f)."

When is deception probable.

Morse v. Martin, Can. Sup. Ct. Cas. Dig. 509; *Marshall v. Hawkins*, 4 N. Z. L. R. Sup. Ct. 59; *Desmond's Appeal*, 103 Penn. St. 126; *Singer Manufacturing Co. v. Riley*, 11 Fed. Rep. 706; *Adams v. Heisel*, 31 Fed. Rep. 279; *Evans v. Von Laer*, 32 Fed. Rep. 153.

(a) Per Lord Watson in *Singer Manufacturing Co. v. Loog* (3), 8 App. Cas. 39.

(b) Per Lord Selborne, C., in *Singer Manufacturing Co. v. Loog*, 8 App. Cas. 18. So in *M. Melachrino & Co. v. R. Melachrino & Co.*, Chitty, J., May 27th, 1888.

(c) L. R. 1 Ch. 192.

(d) As to this, see per Lord Chelmsford in *Wotherspoon v. Currie*, L. R. 5 H. L. 508; and per Malins, V.-C., in *Anglo-Swiss Condensed Milk Co. v. Swiss Condensed Milk Co.*, W. N. 1871, p. 163. Also *McCann v. Anthony*, 21 Mo. App. 83. And see *post*, p. 150-1.

(e) What will constitute in-

fringement is not to be defined. See per Stawell, C. J., in the Sup. Ct. of Victoria in *Hennessy v. White*, 6 W. W. & A'B. Eq. 216.

(f) As to this criterion, see *Archbold v. Sweet*, 1 Mo. & Rob. 162; *Shrimpton v. Laight*, 18 Beav. 164; *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. C. 523 (per Lord Cranworth); *Barnard v. Pillow*, W. N. 1868, p. 94; *Anglo-Swiss Condensed Milk Co. v. Swiss Condensed Milk Co.*, W. N. 1871, p. 163; *Wotherspoon v. Currie*, L. R. 5 H. L. 508; *Condy v. Mitchell*, 37 L. T. N. S. 268, 766; *Abbott v. Bakers & Confectioners' Tea Association, Ltd.*, W. N. 1872, p. 31; L. J. N. of C. 1871, p. 199; *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 376, 392, 394; *London & County Banking Co. v. Hampshire & North Wilts Bank*, Dig. 618; *Moses v. Sargood*, Dig. 636; *In re Worthington*, 14 Ch. D. 8; *Liebig's Extract of Meat Co. v. Anderson*,

“It would be a mistake, however, to suppose that the resemblance must be such as would deceive persons who should see the two marks placed side by side (a). The rule so restricted would be of no practical use. If a purchaser looking at the article offered to him would naturally be led, from the mark impressed on it, to suppose it to be the production of the rival manufacturer, and would purchase it in that belief, the Court considers the use of such a mark to be fraudulent. But I go farther. I do not consider the actual physical resemblance of the two marks to be the sole question for consideration. If the goods of a manufacturer have, from the mark or device he has used, become known in the market by a particular

W. N. 1883, p. 185; *In re Christiansen*, 3 P. R. 54; *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 Ch. D. 454; *Lever v. Goodwin*, 36 Ch. D. 1; *Steinway & Sons v. Henshaw*, 5 P. R. 77; *Hennessey v. White*, 6 W. W. & A'B. Eq. 216; *Hennessey v. Hogan*, *ib.* 225; *Partridge v. Menck*, 1 How. App. Cas. 558; R. Cox, 72; *Walton v. Crowley*, 3 Bl. C. C. 440; R. Cox, 166; *Clark v. Clark*, 25 Barb. 76; R. Cox, 206; *Brooklyn White Lead Co. v. Masury*, 25 Barb. 416; R. Cox, 210; *Swift v. Dey*, 27 N. Y. Sup. Ct. 611; R. Cox, 319; *Rowley v. Houghton*, 2 Brews. 303; R. Cox, 486; *Colton v. Thomas*, 2 Brews. 308; R. Cox, 507; *Lockwood v. Bostwick*, 2 Daly, 521; R. Cox, 555; *Dixon Crucible Co. v. Guggenheim*, 2 Brews. 321; R. Cox, 559; *Blackwell v. Wright*, 73 N. Car. 310; *Gilman v. Hunnewell*, 122 Mass. 139; *Popham v. Wilcox*, 66 N. Y. 69; *Talcott v. Moore*, 13 N. Y. Sup. Ct. 106; *Brown v. Mercer*, 37 N. Y. Super. Ct. 265; *McLean v. Fleming*, 96 U. S. Rep. 245; *Daves v. Davies*, Dig. 426; *Colman v. Crump*, 70 N. Y. 573; *Manhattan Medicine Co. v. Wood*, 108 U. S. Rep. 218; *Wolfe v. Hart*, 4 Vict. L. R. Eq. 125; *Ex parte Caire*, 15 U. S. Pat. Gaz. 248; *Robertson v. Berry*, 50 Md. 591; *Glen Cove Manufacturing*

Co. v. Ludeman, 23 Bl. C. C. 46; *McCann v. Anthony*, 21 Mo. App. 83; *Avery & Sons v. Meikle & Co.*, 27 U. S. Pat. Gaz. 1027; *Liggett & Myers Tobacco Co. v. Hynes*, 20 Fed. Rep. 883; *Ralli v. Fleming*, Ind. L. R. 3 Cal. 417; *Ex parte Kennedy*, 9 Vict. L. R. (L.) 335; *Brill v. Singer Manufacturing Co.*, 41 Ohio St. 127; *Sawyer v. Kellogg*, 7 Fed. Rep. 721; 9 *ib.* 601. In *Singer Manufacturing Co. v. Loog* (3) (8 App. Cas. 18), Lord Selborne, C., says, “The imitation of a man’s trade mark, in a manner liable to mislead the unwary, cannot be justified by showing either that the device or inscription upon the imitated mark is ambiguous, and capable of being understood by different persons in different ways, or that a person who carefully and intelligently examined and studied it might not be misled.”

(a) See *Moses v. Sargood*, Dig. 636; *Read v. Richardson*, 45 L. T. N. S. 54; *Ascough v. Johnson & Co.*, 3 Times L. R. 735; *Sohl v. Geisendorf*, 1 Wils. (Ind.) 60; *Alleghany Fertiliser Co. v. Woodside*, 1 Hughes, 115; *Manhattan Medicine Co. v. Wood*, 108 U. S. Rep. 218; *Sawyer v. Kellogg*, 7 Fed. Rep. 721; 9 *ib.* 601; *Liggett & Myers Tobacco Co. v. Hynes*, 20 Fed. Rep. 883.

name, I think that the adoption by a rival trader of *any mark which will cause his goods to bear the same name in the market* (a), may be as much a violation of the rights of that rival as the actual copy of his device."

The natural consequence of marking goods so as to cause them to bear the same name in the market as those of a well-known firm is to deceive the ultimate purchaser, and such deception will be restrained, even though the original purchaser is not deceived (b). "No

Deception of ultimate purchaser.

(a) Thus, where the plaintiff's yarn had become known as "Bhe Hathi," or "two elephant" yarn, from the representation of two elephants on the trade mark, the defendants were restrained from using two different elephants (*Orr-Ewing & Co. v. Johnston & Co.*, 7 App. Cas. 219); where the plaintiff's beer was known as "Dog's Head Beer," the defendants were restrained from using on their beer the head of a different kind of dog from that used by the plaintiffs (*Read v. Richardson*, 45 L. T. N. S. 54); where the plaintiff's clothing was known as "Crown Clothing," from the use of a royal crown, the defendants were restrained from using an imperial crown between two standards (*Moses v. Sargood*, Dig. 636). So, if in *Edelsten v. Edelsten*, 1 De G. J. & S. 185, the defendant had called his wire "Anchor Wire," without using the figure of an anchor, the plaintiff's wire having acquired the name of "Anchor Wire" because of the trade mark being an anchor. See *Cartier v. Carlile*, 31 Beav. 292; *Cartier v. Westhead*, Dig. 199; *Cartier v. May*, Dig. 200 ("Cross Cotton"); *In re Jelley, Son & Jones*, 51 L. J. Ch. 639 ("Dog-brand Files"); *In re Whiteley*, 43 L. T. N. S. 627 ("Globe Steel"); *In re Rabone*, Dig. 643 ("Lion" edge tools); *In re Worthington*, 14 Ch. D. 8 ("Triangle Beer"); *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 Ch. D. 454 ("Milkmaid" or "Dairymaid Brand");

In re Baschiera & Co., 33 Sol. J. 469 ("Lion" matches); *Taylor v. Virasami*, Ind. L. R. 6 Mad. 108 ("Talwar" shirtings); *Smith v. Fair*, 14 Ont. Rep. 729 ("Red Seal" cigars). In the U. S. Patent Office there was held to be a fatal conflict between two trade marks for hams, of which the one consisted of the word "Bouquet," the other of a bouquet of flowers: *Schrauder v. Beresford & Co.*, U. S. Patent Office, June 27th, 1872; and in *In re American Lubricating Oil Co.*, 9 U. S. Pat. Gaz. 687, registration was refused to the word "Star" for oil, the device of a star having already been registered for that article. But in *Curtis, Harvey & Co. v. Kraft, Meyer & Co.*, Chitty, J., June 16th, 1882, it was thought that the German words "Diamant Pulver" were not likely to be mistaken for the English words "Diamond Powder." See *McLean v. Fleming*, 96 U. S. Rep. 245; *Morrison v. Case*, 9 Bl. C. C. 548; *In re Weaver*, 10 U. S. Pat. Gaz. 1; *In re Pratt v. Farmer*, *ib.* 866; *In re Park*, 12 *ib.* 2; *Barsalon v. Darling*, 9 Can. Sup. Ct. 677.

(b) See *Singer Manufacturing Co. v. Loog*, 8 App. Cas. 15; *Orr-Ewing & Co. v. Johnston & Co.*, 7 App. Cas. 219; *In re Christiansen*, 3 P. R. 54; *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 Ch. D. 454; *Ralli v. Fleming*, Ind. L. R. 3 Calc. 417; *Manookji Petit Manufacturing Co., Ltd. v. Mahalaxmi Spinning & Weaving Co., Ltd.*, Ind. L. R. 10 Bomb. 617.

man is entitled to represent his goods as being the goods of another man, and no man is permitted to use any mark, sign or symbol, device, or other means, whereby, without making a direct false representation himself to a purchaser who purchases from him, he enables such purchaser to tell a lie or to make a false representation to somebody else who is the ultimate customer" (a). "If a man does that, the natural consequence of which (although it does not deceive the person with whom he deals, and is therefore no misrepresentation to him) is to enable that other person to deceive and pass off his goods as somebody else's, for that he is answerable. But this is confined to those things which in their necessary or natural uses accompany the things sold. For instance, the corks of champagne bottles marked "Moet and Chandon" must be in the bottles sold, and must accompany the bottles. They must necessarily accompany the thing to the retail buyer, and so must labels to be put on the bottles. The very reason for their existence is that they must be put on the bottles, and if they are deceptive and fraudulent, then the person who prepares them is answerable for it. Such things must not be used if their natural and legitimate consequence is, not to deceive the person to whom they are sold, but to enable the purchaser to pass off the goods as being the goods of other persons" (b).

Deception by
get-up of
goods.

And the same principle of preventing that which would deceive the ultimate purchaser is observed where the probability of deception arises, not from the imitation of a trade mark proper, but from copying the peculiar get-up of the plaintiff's goods or from some similar act. In *Lever v. Goodwin* (c) the plaintiffs' soap was got up in a special manner, which had been copied somewhat nearly by the

(a) Per James, L. J., in *Singer Manufacturing Co. v. Loog* (3), 18 Ch. D. 412.

(b) Per Cotton, L. J., in S. C., 18 Ch. D. 422.

(c) 4 P. R. 492 (Chitty J.), 36 Ch. D. 1 (C. A.).

defendants; and Chitty, J., said, "The law applicable to the case is plain: it is founded on fraud. The simplest case is where the seller misrepresents to the buyer that the goods which are being offered for sale are the goods, not of the person who made them, but of some other manufacturer. That is a case merely between the buyer and the seller. Then comes the case where the manufacturer, by devices which are to accompany the goods on their sale in the market, gets them up in such a form as to be calculated to deceive the ultimate buyer into the belief that the goods which he, the manufacturer, is putting on the market are the goods of some other maker. Here, generally speaking, a double fraud is committed: first, there is the fraud which is perpetrated on the ultimate buyer; and, secondly, there is a fraud perpetrated on the other manufacturer, who loses part of his trade. In this class of cases the trade is seldom deceived; the retail dealers know from whom they are buying, and if there is a fraudulent device, they are rarely taken in by it. But in such a case the manufacturer puts an instrument of fraud into their hands. Now, it has been said more than once in this case, that the manufacturer ought not to be held liable for the fraud of the ultimate seller—that is, the shopkeeper or the shopkeeper's assistant; but that is not the true view of the case. The question is whether the defendants have or have not knowingly put into the hands of the retail dealers the means of deceiving the ultimate purchasers." So, in another case (*a*), Kekewich, J., said "The plaintiffs are entitled to have their trade mark protected; and, further than that, they are entitled to have their business protected to this extent, that if any person has used the words which they employ, so as to pass off, or so as to tend to pass off, the goods of that other person as the goods of the plaintiffs, then the

(*a*) *Sanitas Co., Ltd. v. Condy*, 4 P. R. 530. And see, per Kay, J., in *In re Sanitus Co., Ltd.*, 58 L. T. N. S. 166.

plaintiffs are entitled, apart from their trade mark, to insist that that should be restrained."

Infringement of essential part, or of combination.

The infringement of a trade mark may consist in the adoption of the essential part of the plaintiff's trade mark by the defendant, as the word "Eureka" (a), or "Glenfield" (b), or "Apollinaris" (c). And where there is no imitation of the essential part, a resemblance in particulars common to the trade does not constitute an infringement (d). But, on the other hand, the infringement may consist in the imitation of the general appearance of the plaintiff's mark, and where both trade marks are of a composite character, it is possible that, though no one particular mark has been exactly imitated, or the principal mark which has been reproduced cannot, for some reason or other, be protected as a trade mark, the combination may be very similar and likely to

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

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

(c) *Apollinaris Co. v. Norrish*, 33 L. T. N. S. 242; and see *Filley v. Fassett*, 44 Mo. 173; *R. Cox*, 530 ("Charter Oak" stoves); *Siegert v. Ehlers*, Dig. 432, and *Siegert v. Findlater*, 7 Ch. D. 801 ("Angostura Bitters"); *Eno v. Stephens*, Dig. 609 ("Fruit Salt"); *Reinhardt v. Spalding*, 49 L. J. Ch. 57 ("Family Salve"); *Berliner Brauerei Gesellschaft Tivoli v. Knight, Stocks & Co.*, W. N. 1883, p. 70 ("Tivoli" beer); *Slazenger v. Malings*, W. N. 1885, p. 124 ("The Lawford" racquet); *Compania General de Tabacos v. Rehder*, 5 P. R. 61 ("Cavite" cigars); *Lawrie v. Baker*, 2 P. R. 213 ("Patent cups"); *Dunbar v. Glenn*, 42 Wisc. 118 ("Bethesda" water); *Blackwell v. Armistead*, 5 Am. L. T. 85 ("Durham" tobacco); *In re Coggin, Kidder & Co.*, 11 U. S. Pat. Gaz. 1109 ("Haxall"); *Rillet v. Carlier*, 61 Barb. S. C. 435 ("Grenade Syrup"); *Davis v. Kennedy*,

13 Grant Up. Can. Ch. 523 ("Pain-Killer"); *Crawford v. Shuttock*, *ib.* 149 ("Imperial" soap); *Carroll v. Ertheiler*, 1 Fed. Rep. 688 ("Lone Jack" tobacco); *Meischmann v. Schuckmann*, 62 How. Pr. 92 ("Vienna Bread"); *Lauferty v. Wheeler*, 63 *ib.* 488; 11 Daly, 194 ("Alderney" oleo-margarine). See also, per Cotton, L. J., in *In re Leonard & Ellis*, 26 Ch. D. 288; *Vulcan Match Co. v. Jebson & Co.*, 1 Kyshe 650; *Humphreys' Specific Homœopathic Medicine Co. v. Wenz*, 14 Fed. Rep. 250.

(d) *Lucke v. Webster*, M. R., April 4th, 1879; *In re Horsburgh*, 53 L. J. Ch. 237; *Wallace & Co. v. King & Co.*, Bomb. High Ct., April 30th, 1879; *Tucker Manufacturing Co. v. Boyington*, 9 U. S. Pat. Gaz. 455; *Thornton v. Crowley*, 47 N. Y. Super. Ct. 527; *Coats v. Merriok Thread Co.*, 45 U. S. Pat. Gaz. 347; *Stachelberg v. Ponce*, 128 U. S. Rep. 686; *Marshall v. Hawkins*, 4 N. Z. L. R. Sup. Ct. 59; *Ball v. Siegel*, 116 Ill. 137; *Portuondo v. Monne*, 28 Fed. Rep. 16.

deceive, and will therefore be restrained by injunction (a).

“For the purpose of establishing a case of infringement it is not necessary to show that there has been the use of a mark in all respects corresponding with that which another person has acquired an exclusive right to use, if the resemblance is such as, not only to show an intention to deceive, but also such as to be likely to make unwary purchasers suppose that they are purchasing the article sold by the party to whom the right to use the trade mark belongs” (b). It is seldom that the mark employed by

Infringer's mark need not be identical with mark infringed. Colourable differences.

(a) *Abbott v. Bakers' & Confectioners' Tea Association*, W. N. 1871, p. 207; *ib.* 1872, p. 31; *Hargreaves v. Smith*, Dig. 338; *Lazenby v. Lazenby*, Dig. 160; *In re Barker & Son*, 53 L. T. N. S. 23; *Compania General de Tabacos v. Rehder*, 5 P. R. 61; *Great Tower St. Tea Co. v. Langford & Co.*, 5 P. R. 66; *Ascough v. Johnson & Co.*, 3 Times L. R. 735; *Ralli v. Fleming*, Ind. L. R. 3 Calc. 417; *Brown v. Mercer*, 37 N. Y. Super. Ct. 265; *Godillot v. Hazard*, 81 N. Y. 263; *Lea v. Wolff* (S. T.), 13 Abb. Pr. N. S. 389; *Whitney v. Hickling*, 5 Grant Up. Can. Ch. 605; *Davis v. Reid*, 17 *ib.* 69; *Day v. Walls*, 12 Phila. 274; *Sawyer v. Kellogg*, 7 Fed. Rep. 721; 9 *ib.* 601; *Hostetter v. Adams*, 20 Bl. C. C. 326; *Conrad v. Joseph Uhrig Brewing Co.*, 8 Mo. App. 277; *Electro-Silicon Co. v. Levy*, 59 How. Pr. 469; *Royal Baking Powder Co. v. Davis*, 26 Fed. Rep. 293; *McCann v. Anthony*, 21 Mo. App. 83; *Green v. Woodhouse*, 38 U. S. Pat. Gaz. 1491; *Williams v. Brooks*, 50 Conn. 278; *Hop Bitters Manufacturing Co. v. Wharton*, 10 Vict. L. R. (L.) 377; *Pierce v. Guittard*, 68 Cal. 68; *Leolanohe Battery Co. v. Western Electric Co.*, 21 Fed. Rep. 538; *Carboliv Soap Co. v. Thompson*, 25 Fed. Rep. 625; *Foster v. Blood Balm Co.*, 77 Ga. 216; but see *Blackwell v. Crabb*, 36 L. J. Ch.

504; and *Blackwell v. Wright*, 73 N. Car. 310.

(b) Per Lord Chelmsford, in *Wotherspoon v. Currie*, L. R. 5 H. L. 508. And see *Moses v. Sargood*, Dig. 636; *In re Farina* (2), 27 W. R. 456; *Hennessy v. White*, 6 W. W. & A'B. Eq. 216; *Hennessy v. Hogan*, *ib.* 225; *McLean v. Fleming*, 96 U. S. Rep. 245; *Alleghany Fertiliser Co. v. Woodside*, 1 Hughes 115; *Barrows v. Knight*, 6 R. L. 434; *Cook v. Starkweather*, 13 Abb. Pr. N. S. 392; *Brown v. Mercer*, 37 N. Y. Super. Ct. 265; *Shaver v. Shaver*, 54 Iowa, 208; *Godillot v. Hazard*, 81 N. Y. 263; *Rodgers v. Philp*, 1 U. S. Pat. Gaz. 29; *Colman v. Crump*, 70 N. Y. 573; *Amosheag Manufacturing Co. v. Garner*, (2), 54 How. Pr. 298; *Wolfe v. Hart*, 4 Vict. L. R. Eq. 125; *Actien Gesellschaft Apollinaris Brunnen v. Somborn*, 14 Bl. C. C. 380; *Hegeman & Co. v. O'Byrne*, 2 Daly, 264; *Leidersdorf v. Flint* (2), 50 Wisc. 401; *Atlantic Milling Co. v. Robinson*, 20 Fed. Rep. 217; *Avery & Sons v. Meikle & Co.*, 27 U. S. Pat. Gaz. 1027; *Liggett & Myers Tobacco Co. v. Hynes*, 20 Fed. Rep. 883; *Heyde v. Wittkowski*, 5 N. S. W. Rep. (E.) 74; *Bryant & May v. Heyde*, 7 N. S. W. Rep. (E.) 72; *Pierce v. Guittard*, 68 Cal. 68; *Ball v. Siegel*, 116 Ill. 137; *Lorillard v. Wight*, 15 Fed. Rep. 383; *Dreydoppel v. Young*, 14 Phila. 226.

the infringer does correspond in all respects with that of the person whose rights he is attacking; the usual practice is to introduce some colourable variation, which may supply the infringer with a plausible excuse for his fraud. "In every case," however, "the Court must ascertain whether the differences are made *bonâ fide* in order to distinguish the one article from the other; whether the resemblances and the differences are such as naturally arise from the necessity of the case, or whether, on the other hand, the differences are simply colourable, and the resemblances are such as are obviously intended to deceive the purchaser of the one article into the belief of its being the manufacture of another person. Resemblance is a circumstance which is of primary importance for the Court to consider, because if the Court finds, as it almost invariably does find in such cases as this, that there is no reason for the resemblance, excepting for the purpose of misleading, it will infer that the resemblance is adopted for the purpose of misleading" (a).

Examples.

Thus, it was held that "Cacaotine" was a colourable imitation of "Cocoatina" (b), "Steel pens" of "Stephens" (c), "Tung's" of "Tonge's" (d), "Leopoldsalt" of "Leopoldshall" (e), "Lactopepsine" of "Lactopeptine" (f), "Cocaine" of "Cocoaine" (g), "Bovina" of "Bovilene" (h).

(a) Per Wood, V.-C., *Taylor v. Taylor*, 23 L. J. Ch. 255; and in the case of a prosecution for obtaining money by false pretences, see per Erle, J., in *R. v. Dundas*, 6 Cox, 380.

(b) *Schweitzer v. Atkins*, 37 L. J. Ch. 847.

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

(d) *Tonge v. Ward*, 21 L. T. N. S. 480.

(e) *Radde v. Norman*, L. R. 14 Eq. 348.

(f) *Carrick v. Morson*, L. J. N. of C., 1877, p. 71.

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

(h) *Lockwood v. Bostwick*, 2 Daly, 521; R. Cox, 555. Other instances are:—"Schrewsbury-Marchal Patent Thread" put for "Shrewsbury, Marshall & Co. Patent Thread," *Marshall v. Ross*, L. R. 8 Eq. 651; "Burgiss" for "Burgess," *Burgess v. Hills*, 26 Beav. 244; "Genuine" for "Guinness," *Guinness v. Heap*, Dig. 617; "Derwent" for "Derby," *Derby Photographic Dry Plate Co. v. Pollard, Graham & Co.*, 2 Times L. R. 276; "Condisanitas" for "Sanitas," *Sanitas Co., Ltd. v.*

Again, a beehive was held to be a colourable imitation of a bell of a similar shape, similarly printed on a label (c).

Condy, 4 P. R. 195, 530; "Apol-linis" for "Apollinaris," *Apollinaris Co., Ltd. v. Herrfeldt*, 4 P. R. 478; "Steinberg" for "Steinway," *Steinway & Sons v. Henshaw*, 5 P. R. 77; "Demotic" for "Demon," *Slazenger & Sons v. Feltham & Co.*, 6 P. R. 531; "Holsteter & Smyte" for "Hostetter & Smith," *Hostetter v. Voninkle*, 1 Dill. 329; "Rogers & Son" for "J. Rodgers & Sons," *Rodgers v. Philp*, 1 U. S. Pat. Gaz. 29; "Andrew Coe's Superphosphate of Lime" for "Coe's Superphosphate of Lime" *Coe v. Bradley*, 9 *ib.* 541; "Star" for "Stark," *Gardner v. Bailey*, Dig. 365; "Wamyesta" for "Wamsutta," *Wamsutta Mills v. Allen*, 12 Phila. 535; "Electric-Silicon" for "Electro-Silicon," *Electro-Silicon Co. v. Trask*, 59 How. Pr. 189; "Pride of Syracuse" for "Pride" *Hier v. Abrahams*, 82 N. Y. 519; "South-western, St. Louis" for "Southern Company, St. Louis," *Southern White Lead Co. v. Carey*, 25 Fed. Rep. 125; "Cellonite" for "Celluloid," *Celluloid Manufacturing Co. v. Cellonite Manufacturing Co.*, 32 Fed. Rep. 94; "Willoughby Ridge" for "Willoughby Lake," *Pike Manufacturing Co. v. Cleveland Stone Co.*, 35 Fed. Rep. 896; "Diamond Gem" for "Black Diamond," *ib.*; "Seamless," with a flourish, for "Shawknit," with a flourish, *Shaw Stocking Co. v. Mack*, 21 Bl. C. C. 1; "Dr. Morse's Improved Yellow Dock and Sarsaparilla Compound" for "Morse's Compound Syrup of Yellow Dock Root," *Alexander v. Morse*, 14 R. I. 153; "Chatterbook" for "Chatterbox," *Estes v. Leslie* (2), 29 Fed. Rep. 91; "Sawin's Soluble Blue and Pepper Box" for "Sawyer's Crystal Blue and Safety Box," *Sawyer v. Kellogg*, 7 Fed. Rep. 721; 9 *ib.* 601; "Maizharina" with a device for "Maizena" with a device, *Glen Cove Manufacturing Co. v. Ludeman*, 23 Bl. C. C. 46.

(a) *Bell, Black & Co. v. Bell & Co.*, Dig. 514. Other instances are:— A crown with "B. B. S." in italics put for a crown with "B. B. H." in Roman characters, *Barrows v. Pelsall Coal & Iron Co.*, Dig. 530; a volcano with a man coming out of it and the words "Volcanic Paraffin Matches," for a volcano with the words "The Vulcan Paraffin Matches," *Vulcan Match Manufacturing Co. v. Knos & Co.*, Pearson, J., June 22nd, 1883; a device of a diamond with a K in the centre for a device of a plain diamond, *Curtis & Harvey v. Pape*, 5 P. R. 146; "Rottgen" with two crosses for "Rodgers" with a star and a cross, *Rodgers & Sons, Ltd. v. Rottgen*, 5 Times L. R. 678; a pelican, with an inscription in gold on a green ground, for a crane with an inscription in gold on a green ground, *Balfour & Co. v. Kilburn & Co.*, 1 Hyde, 270; an orb rising over a piece of water, with the words "Rising Moon Stove Polish," for an orb with rays rising over a piece of water, with the words "Rising Sun Stove Polish": *Morse v. Worell*, 10 Phila. 168; a sprig of grape vine for a sprig of hop vine, *Hop Bitters Manufacturing Co. v. Wharton*, 10 Vict. L. R. (L.) 371; a unicorn's head for a horse's head similarly arranged, *Barsalon v. Darling*, 9 Can. Sup. Ct. 677. But in *McCartney v. Garnhart*, 45 Mo. 593, it was held that two picks with a pair of scales, and the words "J. H. Garnhart's Old Bourbon," were not too similar to two anchors and the initials "S. McC." Where the infringement consisted in a general resemblance between labels on "Old Bachelor" tobacco and "Old Coon" tobacco, it was held that the wrong was not remedied by printing across the former the words "Not Old Coon," *McCann v. Anthony*, 21 Mo. App. 83.

*Seixo v.
Provezende.*

In *Seixo v. Provezende* (a) the plaintiff, a Portuguese nobleman and wine grower, sold his wine in casks branded on the head with a crown and eagle, and the letters "B. S.," and also at the bung-hole with a crown, the word "Seixo," and the year of vintage. This wine had acquired a reputation as "Crown Seixo Wine," when the defendant began to sell wine which he called "Seixo de Cima," and placed in casks branded in a somewhat similar manner to the plaintiff's. The injunction was granted and affirmed, although the defendants contended that parts of their own vineyards were called "Seixo," and that the name was an ordinary Portuguese adjective, signifying "stony."

*Wotherspoon
v. Currie.*

In *Wotherspoon v. Currie* (b) the plaintiffs manufactured starch, which, under the name of "Glenfield Starch"—a name derived from a small place near Paisley, where it was made—acquired a great reputation. They subsequently removed their works to Paisley, and there continued to make "Glenfield Starch." The defendants, also starch manufacturers at Paisley, bought a small plot of land at Glenfield, and began selling "Glenfield Starch." It was held by V.-C. Malins and the House of Lords that the use of the word "Glenfield" in connection with starch had the effect of inducing people to buy the defendants' manufacture, under the impression that it was the plaintiffs', and that there was a colourable imitation of the mark to which the plaintiffs were entitled (c).

Similarity of
packing or
get-up.

Where the goods of one manufacturer are so packed or arranged as externally to resemble those of others engaged

(a) L. R. 1 Ch. 192.

(b) L. R. 5 H. L. 508.

(c) See also *Thompson v. Montgomery*, 41 Ch. D. 35, and the American cases, *Coffeen v. Brunton*, 4 McLean, 516, R. Cox, 82; *Amoskeag Manufacturing Co. v. Spear*, 2 Sand. S. C. 599, R. Cox, 87; *Davis v. Kendall*, 2 R. I. 566, R. Cox, 112; *Williams v. Johnson*,

2 Bos. 1; R. Cox, 214; *Bradley v. Norton*, 33 Conn. 157, R. Cox, 331; *Boardman v. Meriden Britannia Co.*, 35 Conn. 402, R. Cox, 490; *Gillis v. Hall*, R. Cox, 596; *Meriden Britannia Co. v. Parker*, 39 Conn. 450, 12 Amer. Rep. 401; *Burke v. Cassin*, 45 Cal. 467, 13 Amer. Rep. 204.

in the same trade, as where starch was put up commonly in the trade in packets of a certain colour and appearance, the similarity common to all does not of itself expose the manufacturer to an action, but it makes it incumbent upon him to take care that his distinguishing mark is really distinguishing (a). And where a plaintiff has been in the habit of packing or getting up his goods in a peculiar and distinctive manner, he will be entitled to restrain another from imitating his packages (b), even though his actual trade mark is bad (c); and the imitation of bottles (d) or barrels (e) of a peculiar design, such as is used only by the plaintiff, will afford a strong presumption that fraud is intended. As Cotton, L. J., said, in *Lever v. Goodwin* (f), "there may be no monopoly at all in the individual things, but if they are so combined by the defendants as to pass off the defendants' goods as the plaintiffs', then the defendants have brought themselves within the old Common Law doctrine, in respect of which Equity will give to the aggrieved party an injunction, in order to restrain the defendants from

(a) See per Lord Hatherley, C., *Wotherspoon v. Currie*, 5 H. L. 508; also *Enoch Morgan's Sons' Co. v. Troxell*, 89 N. Y. 292; *Gail v. Wackerbarth*, 28 Fed. Rep. 286.

(b) *Frese v. Bachof* (2), 14 Bl. C. C. 432; *Enoch Morgan's Sons' Co. v. Schwachhofer*, 55 How. Pr. 37; *Great Tower St. Tea Co. v. Langford & Co.*, 5 P. R. 66; *Ascough v. Johnson & Co.*, 3 Times L. R. 735; *Landreth & Sons v. Landreth*, 22 Fed. Rep. 41; *Southern White Lead Co. v. Carey*, 25 Fed. Rep. 125; *Anheuser Busch Brewing Association v. Clarke*, 26 Fed. Rep. 410; *Pierce v. Guittard*, 68 Cal. 68; *Moxie Nerve Food Co. v. Baumbach*, 32 Fed. Rep. 205; *Miller Tobacco Manufactory v. Commerce*, 45 N. J. Law 123; *Trask Fish Co. v. Wooster*, 28 Mo. App. 408.

(c) *Lever v. Goodwin*, 36 Ch. D. 1;

Sawyer v. Horn, 4 Hughes, 239; *McCall v. Theal*, 28 Grant Up. Can. Ch. 48; *Carbolic Soap Co. v. Thompson*, 25 Fed. Rep. 625; *Smith v. Fair*, 14 Ont. Rep. 729.

(d) *Henry v. Price*, 1 Leg. Obs. 364; *Sieger v. Findlater*, 7 Ch. D. 801; *Fullwood v. Fullwood* (1), W. N. 1873, 185; *Wolfe v. Goulard*, 18 How. Pr. 64; *Laird v. Wilder*, 9 Bush 131; *Congress Co. v. High Rock Co.*, 45 N. Y. 291; *Wilder v. Wilder*, Dig. 372; *Hostetter v. Adams*, 20 Bl. C. C. 326; *Carbolic Soap Co. v. Thompson*, 25 Fed. Rep. 625; *Moxie Nerve Food Co. v. Baumbach*, 32 Fed. Rep. 205; *Moxie Nerve Food Co. v. Beach*, 33 Fed. Rep. 248.

(e) *Cook v. Starkweather*, 13 Abb. Pr. N. S. 392. See *Moorman v. Hoge*, 2 Sawy. 78.

(f) 36 Ch. D. 1.

passing off their goods as those of the plaintiffs." It has been held in America (a) that a label, on which is a representation of a box filled with cakes of soap, wrapped in variously coloured paper wrappers and arranged in a particular way, is not infringed by offering for sale boxes containing cakes of soap so wrapped and arranged.

Not conclusive.

However, where a defendant had, in obedience to express directions, put up his silk in imitation of the plaintiff's bundles, his execution of the order was held not to be conclusive against him (b). So, too, where a defendant packed inferior brandy in the plaintiff's cases at the express request of an agent of the plaintiff, who was seeking to entrap him, Malins, V.-C., refused the injunction with costs (c).

Sale over counter.

Where a manufacturer, e.g. of beer or whiskey, sets up a case against a retail dealer of having sold the product of another manufacturer over the counter in response to a request for the plaintiff's goods, and the defendant shows that he took reasonable precautions to avoid mistakes, it has been held in Scotland that it is not sufficient to prove that one or two mistakes have occurred, but that a course of fraudulent dealing must be made out (d).

User in circulars.

It has also been held in Scotland that a word registered as a trade mark is not infringed by its being used in circulars and advertisements in a properly descriptive sense (e).

Infringement must be by

The use by one manufacturer of a trade mark resem-

(a) *Davis v. Davis*, 27 Fed. Rep. 490.

(b) *Woollam v. Ratcliff*, 1 H. & M. 259. And see *Prise v. Bachof* (1), 13 Bl. C. C. 234; *Sanyer v. Kellogg*, 7 Fed. Rep. 721; 9 *ib.* 601.

(c) *Hennessy v. Kennett*, Dig. 556. But in the Indian case of *Orr-Ewing v. Chooneeloll Mullick*, Cor. 150, the defendant was restrained, though there was no

evidence of his having sold the spurious goods (which he had bought ready marked) to any one but the plaintiff's agent.

(d) *Bass, Ratcliff & Gretton, Ltd. v. Laidlaw*, Ct. Sess. Cas., 4th Ser. XIII. 898; *Thomson & Co. v. Robertson*, Ct. Sess. Cas., 4th Ser. XV. 880.

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

bling or even identical with that used by another, is not an infringement of that other's rights, unless the class of goods on which the two marks are used is the same (a) or, at least, of so similar a description that they may fairly be supposed to be of the same manufacture as the goods to which the mark is properly applied (b). use on same class of goods.

And where a trader has registered a trade mark for an extensive class of goods, but has only used it for a small part of the goods in the class, another person does not infringe his rights by using a somewhat similar mark on goods also in the class, but substantially different from the goods on which the registered proprietor has used it. This was so laid down by the Court of Appeal in *Edwards v. Dennis* (c), in which Cotton, L. J., said "no doubt the intention of the Trade Marks Act of 1875 is to give a right to what is on the register so as to enable a person who has been registered for five years as the proprietor of a trade mark to maintain an action against any other person taking or infringing that trade mark; but when the alleged infringement consists in using, not the exact thing upon the register, but something similar to it, the Court must, in considering whether there has been an infringement or not, proceed upon the old principle, which prevailed both at law and in equity before the Act, that a man is not to pass off his goods as the goods of another. At common law the man thus injured might obtain damages, and in equity the more effectual protection of an injunction." No infringement where registration wider than user.

(a) *Hall v. Barrons*, 4 De G. J. & S. 150; *Ainsworth v. Walmsley*, L. R. 1 Eq. 518; *Moses v. Sargood*, Dig. 636; *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *In re Whiteley*, 43 L. T. N. S. 627; *In re Rabone*, Dig. 643; *In re Ashton*, V.-C. H. Feb. 26th, 1881; *Colman v. Crump*, 70 N. Y. 573; *Société Anonyme v. Baxter*, 14 Bl. C. C. 261. In *Hecht v. Porter*, 9 Pac. C. L. J. 569, it was held that leather

boots and indiarubber boots were so far distinct that a trade mark for the former was not infringed by user in respect of the latter.

(b) *Wamsutta Mills v. Allen*, 12 Phila. 535; *Carroll v. Ertheiler*, 1 Fed. Rep. 688; *Collins Co. v. Ames & Sons*, 20 Bl. C. C. 542.

(c) 30 Ch. D. 454. And compare *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 Ch. D. 454.

Rights of
agent of
foreign firm.

In the case of *Apollinaris Co., Ltd. v. Scherer* (a) the plaintiffs, an English company had obtained from one Saxlehner, the proprietor of a spring in Hungary, called the "Hunyadi Janos" spring, the exclusive right to export the water to the United States, and to use the name there. Saxlehner sold the water in Europe under a label which stated that it was not meant for export to America, and the plaintiffs sold the water in the United States under a label which stated that they were the sole exporters. The defendant bought genuine water in Europe under labels bearing Saxlehner's caution, and sold it in the United States as "Hunyadi Janos" water; and it was held that the Apollinaris Co. was entitled to no relief against him, the Court being of opinion that genuine water, rightfully bought, might be sold under its proper name anywhere, and that the arrangement between the Apollinaris Co. and Saxlehner was not binding on persons who were no parties to it.

Rights of
lessee of
spring.

On the other hand, it has been held (b) that the concessionnaire of a spring for a term is not entitled, at all events during the term, to open another spring in the same neighbourhood, and sell the water derived therefrom under the same name as the water derived from the first spring, and in competition with that water.

Sale of
materials
under name.

Where the plaintiffs' article was known as "Hostetter's Stomach Bitters," and the defendants sold materials which they alleged could be used in the production of that article, no relief was granted, there being no allegation that the defendants had done more than this, or that they were engaged with others in a scheme of fraud (c).

Infringement
of disused
mark.

It has been held in America that the use by a manufacturer of a mark previously used by another manufacturer, but discontinued by him for a year, is an infringement of the rights of the latter (d); but it is no infringement to use

(a) 23 Bl. C. C. 459.

(b) *Hill v. Lockwood*, 32 Fed. Rep. 389.

(c) *Hostetter v. Fries*, 21 Bl. C. C. 339.

(d) *Lemoine v. Ganton*, 2 E. D. Smith, 343, R. Cox, 142. But see *Symonds v. Greene*, 28 Fed. Rep. 834.

in an honest way a mark which has failed to obtain protection in the hands of another trader by reason of that trader's misstatements; and an infringer of the mark as subsequently used by the honest trader cannot escape by setting up the prior user of the dishonest trader (a).

Registration of a trade mark which resembles a prior trade mark, which is registered so nearly as to be calculated to deceive, does not, at all events for five years from the date of registration, prevent the owner of the prior mark from obtaining an injunction to restrain its use (b); and since registration is, for the first five years, only a qualification for bringing an action (c), it would seem that if the second of two registered marks had been used first, the owner of that mark would, by virtue of his prior user, be entitled to restrain the owner of the mark which was used later, but registered first, from using that mark. Where the plaintiff's mark had been registered for an extensive class of goods, and the defendant's mark had been registered for a class which overlapped the plaintiff's, but had been used only for goods distinct from theirs, on the defendant beginning to use his mark on goods included in his registration, but similar to those for which the plaintiff's mark had been registered and used, his registration was rectified by limiting it to the distinct goods, and an injunction was granted as to the goods on which he was newly using it (d). Again, where the proprietors of a mark registered for coffee in 1876 began, in 1889, to apply it to tea, they were restrained from so doing on motion by the proprietor of a similar mark registered for tea in 1878 (e).

Infringement
by use of a
registered
mark.

(a) *Parlett v. Guggenheimer*, 67 Md. 542, with which compare *O'Rourke v. Central City Soap Co.*, 26 Fed. Rep. 576.

(b) *Read v. Richardson*, 45 L. T. N. S. 54; *Goodwin v. Venning*, 24 Sol. J. 690. And in New South Wales the use of a registered mark has been restrained: *Harris v. Ogg*, 5 N. S. W. Rep. (E.) 114;

Bryant & May v. Heyde, 7 N. S. W. Rep. (E.) 72.

(c) *Nuthall v. Vining*, C. A. Jan. 21st, 1880; *Mouson & Co. v. Boehm*, 26 Ch. D. 398; *Hart v. Colley*, 44 Ch. D. 193.

(d) *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 Ch. D. 454.

(e) *Upper Assam Tea Co. v. Herbert & Co.*, C. A., July 3rd, 1889.

Infringement
by improper
use of genuine
mark.

It is an infringement to use a genuine trade mark of a manufacturer upon goods not of his production (a); and it is no less an infringement to use it upon goods of a quality to which he did not intend it to be applied, even though the goods upon which the infringer uses it are of the make of the owner of the mark (b). But where goods have been purchased in bulk, the purchaser is entitled to resell them retail under the name given to them by the manufacturer (c).

Moulded
bottles.

In some cases a rather difficult question has arisen with respect to the use of bottles moulded with the plaintiff's name or trade mark. Where such bottles have been systematically bought up and refilled with spurious waters, &c., so as to pass them off as being of the plaintiff's manufacture, an injunction will be granted to restrain the continuance of the fraud (d); but where the bottles have been bought by the defendant in the ordinary course of his business they have become his property, though they bear the plaintiff's trade mark (e), and it does not appear that he will be restrained from using what he has bought, merely because the bottles are moulded, so long as he uses them in a fair manner, and places on them his own adhesive labels (f). There does not, indeed, seem to be a clear decision on the point, as the question has not been raised free from complications. Thus, in *Barrett v. Gomm* (g), the Court of Appeal held that no injunction could be

(a) *Barnett v. Leuchars*, 13 L. T. N. S. 495 (boxes for "Pharaoh's Serpents"); *Richards v. Williamson*, 30 L. T. N. S. 746 (gun stamps); *Hennessy v. Rohmann*, 36 L. T. N. S. 51; *Hennessy v. Cooper*, Dig. 549 (cases for brandy).

(b) *Hennessy v. Kennett*, Dig. 556; *Hennessy v. White*, 6 W. W. & A'B. Eq. 216; *Hennessy v. Hogan*, *ib.* 225 (cases intended for brandy of superior quality used for brandy of inferior quality); *Gillott v. Kettle*, 3 Duer, 624, R. Cox, 148 (labels indicating superior pens placed on boxes of inferior ones).

(c) *Condy & Mitchell v. Taylor & Co.*, 56 L. T. N. S. 891.

(d) *Rose v. Henley*, Dig. 551; *Allen v. Richards*, 26 Sol. J. 658; *Hostetter v. Anderson*, 1 V. R. Eq. 7; *Sawyer Crystal Blue Co. v. Hubbard*, 32 Fed. Rep. 388; *Evans v. Von Laer*, 32 Fed. Rep. 153.

(e) *Idris & Co. v. Ward*, C. A. Feb. 4th, 1889.

(f) *Welch v. Knott*, 4 K. & J. 747; *Rose v. Loftus*, 47 L. J. Ch. 576. See, however, *Wood v. Burgess*, 24 Q. B. D. 162, a case under the Merchandise Marks Act, 1887.

(g) 74 L. T. (Journal) 388.

granted against soda-water manufacturers whose labels were found to be placed on two bottles of soda-water moulded with the plaintiff's name and trade mark, but in this case there was no evidence to show that the soda-water in the bottles was of the defendant's manufacture, or that the defendants had filled or sold them. The Master of the Rolls (Sir G. Jessel), however, stated that if some of the plaintiff's engraved bottles had come fairly into the defendants' possession, they would have been entitled to refill and sell them, at all events if they had placed on them their own adhesive labels, so as to cover the plaintiff's name and trade mark. And this opinion appears to have been adopted by North, J., in *Barrett v. White* (a).

It is an infringement for an engraver to prepare and supply to one person printing-blocks engraved with the trade mark, or an important part of the trade mark of another, inasmuch as the piracy would be impossible without the blocks; and Shadwell, V.-C. of E., went so far as to say that if a thing contained twenty-five parts, and one only was taken, such an imitation would be sufficient to contribute to a deception, and the law would hold those responsible who had contributed to the fraud (b). The principle is the same where the engraver, though retaining the blocks in his own possession, yet facilitates fraud by the dissemination of labels bearing pirated trade marks (c). Lord Cranworth, C., thought, however, that a man who had A's goods, but none of his labels, might rightfully employ a printer or engraver to supply him with imitated labels, and that A could have no ground of complaint against the sale of his goods with something on them to represent his trade mark, though not his genuine mark (d).

Infringement
by engraver.

(a) North, J., May 12th, 1883.

(b) *Guinness v. Ullmer*, 10 L. T. (Old Series) 127.

(c) *Farina v. Silverlock*, 1 K. & J. 509; 6 De G. M. & G. 214; 4 K. & J. 650; *De Kuypcr v. Witte-*

man, 23 Fed. Rep. 871; *Yale Cigar Manufacturing Co. v. Yale*, 30 U. S. Pat. Gaz. 1183; *Holt v. Menendez*, 128 U. S. Rep. 182.

(d) *Farina v. Silverlock*, 6 De G. M. & G. 214.

Untrue allegation of registration.

It does not appear that the position of a defendant in an action for infringement is altered for the worse by the fact of his having alleged his trade mark to be registered, before it in fact was so (a); but by so doing he will expose himself to penalties under § 105 of the Patents Act, 1883 (b).

Use by a trade-mark owner of his mark upon another's goods.

It seems that a manufacturer is entitled to place his trade mark on articles not of his own make, unless there is some trade custom or contract that he shall not do so, and to remove the maker's mark for the purpose of substituting his own, and that such a course would not be actionable (c). Nor is there any reason why it should be so. The maker's mark has already performed its function when the goods are sold, and when it is removed from the goods the maker ceases to be responsible for the guarantee implied by its presence on them. The purchaser, by substituting his own mark, undertakes the responsibility for the quality of the goods, which are, in effect, selected and guaranteed by him (d).

(a) *Ellis & Sons v. Ruthin Soda Water Co.*, M. R., Nov. 21st, 1879.

(b) See also § 3 (1) (c) of the Merchandise Marks Act, 1887.

(c) See *Johnson v. Raylton*, 7 Q. B. D. 438. Compare *Starey v.*

Chilworth Gunpowder Co., 24 Q. B. D. 80.

(d) See *Hirsch v. Jonas*, 3 Ch. D. 584; *Wood v. Lambert*, 32 Ch. D. 247; *Yale Cigar Manufacturing Co. v. Yale*, 30 U. S. Pat. Gaz. 1183.

CHAPTER V.

THE CRIMINAL PROSECUTION.

“In cases like the present” (*i.e.*, in cases of imitation of Remedies for a wrapper imprinted with a trade mark), “the remedy,” fraudulent imitations. said Willes, J., “is well known. The prosecutor may, if he pleases, file a bill in equity to restrain the defendant from using the wrappers, or he may bring an action at law for damages, or he may indict him for obtaining money under false pretences” (*a*).

At Common Law the imitation of a trade mark or of a trade wrapper is not a forgery. “A forgery must be of some document or writing” (*b*); “it is the forging of a false document to represent a genuine document” (*c*). Infringement of trade mark not forgery at Common Law. In a case in which the prisoner had imitated the label used on Borwick’s baking powder, and was indicted for forgery (*d*), the Court of Crown Cases Reserved, consisting of Pollock, C. B., Willes and Byles, JJ., and Bramwell and Channell, BB., decided that the conviction for forgery was not sustainable, though an indictment for false pretences would have been good. The grounds of the decision are thus stated by Bramwell, B.: “I think that this was not a forgery. Forgery supposes the possibility of a genuine document, and that the false document is not so good as the genuine document, and that the one is not so efficacious for all purposes as the other. In the

(*a*) *R. v. John Smith*, D. & B. 566; 8 Cox, 32. This was in 1858, before the Merchandise Marks Act of 1862.

(*b*) Per Cockburn, C. J., *R. v.*

Closs, D. & B. 460; 7 Cox, 494.

(*c*) Per Willes, J., *R. v. John Smith*, *ubi supra*.

(*d*) *R. v. John Smith*, *ubi supra*.

present case, one of these documents is as good as the other: the one asserts what the other does; the one is as true as the other; but one gets improperly used. But the question is whether the document itself is a false document. It is said that the wrapper is so like one used by somebody else, that it may mislead; but that is not material to the question we have to decide. The prisoner may have committed a gross fraud in using the wrappers for that which was not the genuine powder, and may possibly be indicted for obtaining money by false pretences, but I think he cannot be convicted of forgery" (a).

Not even if the mark consists of a signature.

It might be thought that where the trade mark consisted of a signature, an imitation of this would amount to forgery; but this has been decided not to be so, in the case of *R. v. Closs* (b), in which the prisoner imitated the signature of the artist, J. Linnell, in the corner of a spurious picture. Cockburn, C. J., in delivering the judgment of the Court of Crown Cases Reserved, said that the stamp was merely in the nature of a mark put upon the painting with a view to identifying it, and was no more than if the painter put any other arbitrary mark as a recognition of the painting being his; and in the course of the argument he expressed a similar opinion with respect to the imitation of a signature stamped on a gun.

The Merchandise Marks Act, 1862.

Under the Merchandise Marks Act, 1862 (c), the forgery of trade marks was made a misdemeanour, and the Criminal Law made to cover such offences as those committed in *R. v. John Smith* (d) and *R. v. Closs* (e).

(a) Taking the same view, Pollock, C. B., said that the real offence was the enclosing the false powder in the false wrappers; that the issuing of the wrappers without the stuff within them would be no offence; but that the real offence was the issuing them with the fraudulent matter in them.

(b) D. & B. 460; 7 Cox, 494. 25

& 26 Vict. c. 68, § 7, now provides for spurious pictures with a forged signature.

(c) 25 & 26 Vict. c. 88.

(d) D. & B. 566; 8 Cox, 32.

(e) D. & B. 460; 7 Cox, 494. See *R. v. Lloyd* (Recorder of Birmingham, Oct. 13th, 1881), in which the infringement of a gunmaker's trade mark was punished under the

And this is so now under the new Merchandise Marks Act, 1887 (a).

By that Act (b) the following offences are made punishable:—

What offences are punishable under the Merchandise Marks Act, 1887.

1. Forging a trade mark registered in the United Kingdom or protected in any British possession or foreign state to which § 103 or 104 of the Patents Act, 1883, has been made applicable (c).
2. Falsely applying to goods any trade mark as above, or any mark so nearly resembling such a trade mark as to be calculated to deceive (d).
3. Making any die, block, machine, or other instrument for the purpose of forging or of being used for forging a trade mark as above (e).
4. Applying to goods any false trade description—*i.e.*, any description, statement, or other indication, direct or indirect—

(a) As to the number, quantity, measure, gauge or weight of any goods; or

(b) As to the place or country in which any goods were made or produced; or

(c) As to the mode of manufacturing or producing any goods; or

(d) As to the material of which any goods are composed; or

Merchandise Marks Act, 1862, with six months' imprisonment. In *R. v. Willis*, C.C.C., September 21st, 1885, Hawkins, J., inflicted six years' penal servitude on a person who had offered for sale watches of base metal thinly coated with gold and bearing a forged Goldsmiths' Hall mark. In *R. v. Boyes*, C. C. C., April 6th, 1886, the Recorder of London inflicted four months' imprisonment without hard labour for imitation of the prosecutor's perfumes, bottles and labels. In *R. v. Pemberton*, 20 Iron, 110, the defendant had forged the "Low Moor" trade mark on iron tubes not of the Low Moor

Co.'s material or manufacture, and Day, J., inflicted three months' imprisonment without hard labour. See *Cooper v. Hamilton*, 6 N. Z. L. R. 598, as to the practice in New Zealand.

(a) 50 & 51 Vict. c. 28.

(b) As to this Act generally, see *Gridley v. Swinborne*, 5 Times L. R. 71; *Wood v. Burgess*, 24 Q. B. D. 162; and *Starey v. Chilworth Gunpowder Co.*, 24 Q. B. D. 90; and the notes to the Act in Appendix E.

(c) §§ 2 (1) (a), 3 (1) and 4.

(d) §§ 2 (1) (b), 3 (1), 5 and 6.

(e) §§ 2 (1) (c), 4 and 6.

- (e) As to any goods being the subject of an existing patent, privilege, or copyright ;
- (f) As to the person or firm who manufactured any goods,
- which is false in a material respect as regards the goods to which it is applied (a).
5. Disposing of or having in possession any die, block, machine, or other instrument for the purpose of forging a trade mark as above (b).
 6. Causing any of the above things to be done (c).
 7. Selling, or exposing for or having in possession for sale, or any purpose of trade or manufacture, any goods or things to which any forged trade mark as above or false trade description is applied, or to which any trade mark as above or mark so nearly resembling such a trade mark as to be calculated to deceive, is falsely applied (d).
 8. Procuring, counselling, aiding, abetting, or being accessory to, from within the United Kingdom, the commission without the United Kingdom of any such act as above (e).
 9. Falsely representing that any goods are made by a person holding a Royal warrant, or for the service of Her Majesty, or of any of the Royal Family, or any Government department (f).

Additions to and alterations of trade marks.

Forgery at Common Law.

By § 4 (b) it is made forgery of a trade mark to falsify a genuine trade mark, whether by alteration, addition, effacement, or otherwise. At Common Law "it is forgery to alter a material part of a true instrument" (g). Thus, where in a bill of exchange "0" was added to "8" and

(a) §§ 2 (1) (d), 3, 5, and 6. Compare § 18. As to 4 (a) see *R. v. Sherwood*, 7 Cox, 270; *R. v. Ragg*, 8 Cox, 265; *R. v. Lee*, 9 Cox, 460. As to 4 (b) see § 7, with respect to watches. As to 4 (e) see § 105 of the Patents Act, 1883, and *R. v. Wallis*, 3 P. R. 1, *R. v. Crampton*, 3 P. R. 367, and *R. v.*

Morris, Great Marlborough Street Police Court, December 16th, 1886.

(b) §§ 2 (1) (e), 3 (1) and 4.

(c) §§ 2 (1) (f) and 6.

(d) § 2 (2). (e) § 11.

(f) § 20. And see § 106 of the Patents Act, 1883, as to wrongful assumption of the Royal Arms.

(g) 2 East, P. C., 978.

“y” to “eight,” so as to make it appear to be for £80 (a). And “the making of any false instrument which is the subject of forgery, with a fraudulent intent, although in the name of a non-existing person, is as much a forgery as if it had been made in the name of one who was known to exist, and to whom it was due” (b). “An exact resemblance, or facsimile, is not required to constitute the crime of forgery, for if there be a sufficient resemblance to show that a false making was intended, and that the false stamp is so made as to have an aptitude to deceive, that is sufficient” (c).

The defences to a charge of one of the above offences are set out, as to Nos. 1 to 6, in § 2 (1); as to No. 7, in § 2 (2). A special defence is also provided by § 6 for persons who are charged with having committed offences 2, 3, 4 or 6, when they were in fact employed in the ordinary course of their business. Defences.

The penalties for offences Nos. 1 to 8 are set out in § 2 (3); as to No. 9, in § 20. Penalties.

It is not an offence for persons to use any trade description lawfully and generally applied, at the passing of the Act, to goods of a particular class, or manufactured by a particular method, to indicate the particular class or method of manufacture of such goods (d), when the description is so applied. Thus, patent leather, patent thread (e), patent pins (f), patent isinglass (g). But there is a special requirement, when the name of a place or country is stated in a misleading way, that the place of origin shall be stated (h). Expressions generally understood may be employed.

A conviction under this Act does not relieve the defendant from any civil proceedings (i). Civil remedy not affected by conviction.

(a) *R. v. Elsworth*, 2 East P. C. 986.

(b) *Ib.* 957; and see *R. v. Lewis*, Foster Cr. Cas. 116; *R. v. Avery*, 8 C. & P. 596; *R. v. White*, 72 C. C. C. Sessions Papers, 222.

(c) Per Grose, J., in *R. v. Colli-*

cott, 2 Leach, 1048, a Stamp case.

(d) § 18.

(e) *Marshall v. Ross*, L. R. 8 Eq. 651.

(f) *Edelsten v. Vick*, 11 Hare, 78.

(g) *Gridley v. Swinborne*, 5 Times L. R. 71.

(h) § 18. (i) § 19.

Where decep-
tion succeeds,
indictment
for false pre-
tences will lie.

While, apart from the Merchandise Marks Act, the fraudulent imitation of a trade mark is not forgery, such an imitation, when it has been intended to be and has been the means of inducing persons to part with their money, in the belief that they were buying one thing, when in fact they were buying another, is sufficient to support a conviction on an indictment for obtaining money by false pretences. This affords sufficient protection to the innocent purchaser of goods falsely marked; the Act gives protection to the manufacturer who has suffered in his custom and in his reputation by piracies.

Convictions.

“There is no difference in principle between a misrepresentation of a mark, and one that an acceptance was the acceptance of John Jones or any other person” (a); and it is established that the fraudulent imitation of a trade mark will be punished in the same way, where the necessary circumstances exist. Thus, in *R. v. Dundas* (b), the prisoner, who asserted his own name to be Everett, sold blacking in bottles labelled “Everett’s Premier,” in a similar manner, with only trifling variations, to the bottles of a well-known manufacturer of that name. Erle, J., told the jury that “with respect to the difference between the labels, the jury should consider whether it was a small and colourable difference only, and intended to deceive. It was of little consequence whether the man’s name was Everett, as he had stated, or not; for even if it were, and he went about the country and offered blacking for sale as ‘Everett’s Premier,’ representing it to be the well-known article of that name, knowing that it was not so, and intending to cheat the prosecutor by passing upon him a spurious article as the true one, his conduct was equally fraudulent” (c). The prisoner was convicted.

(a) Per Kelly, C. B., in *R. v. Suter & Coulson*, 10 Cox, 577.

(b) 6 Cox, 380.

(c) It was also held that an

offer to sell on sale or return was immaterial, the actual bargain being for cash.

In *R. v. Smith* (a), the conviction for forgery being quashed, the prisoner afterwards pleaded guilty to an indictment for false pretences (b). In *R. v. Suter & Coulson* (c), it was held by the Court of Crown Cases Reserved that a representation that a mark of "18" on a watch was a genuine hall-mark of the Goldsmiths' Company was clearly a false pretence within the statute (d).

The case of *R. v. Bryan* (e) gave rise to some differences of opinion in respect to the Law of False Pretences. The prisoner in that case was found by the jury to have obtained money from pawnbrokers on spoons which he had fraudulently represented to have as much silver on them as Elkington's "A" spoons. They also found that he had represented the foundations to be of the best material, knowing that to be untrue, and that in consequence of this he obtained the moneys mentioned in the indictment. The Recorder of London reserved the case for the consideration of the Court of Crown Cases Reserved. Twelve judges heard the case, and of these ten held that the conviction must be quashed, Willes, J., and Bramwell, B., dissenting. The language employed by some of the judges on that occasion, and in particular by Lord Campbell, C. J. (f), led to an impression that in the opinion of the judges it was impossible to convict under the Statute of False Pretences, when the misrepresentation had reference only to quality and not to substance: that is to say, that where, for instance, an

R. v. Bryan.
Question as to
misrepresentation
of
quality.

(a) D. & B. 566; 8 Cox, 32.

(b) 8 Cox, 37; and 48 C. C. C. Sessions Papers, 8.

(c) 10 Cox, 577.

(d) And in *R. v. Gray & Gosling*, Dig. 183, the imitation of Messrs. Allsopp's labels was punished; and in *R. v. S. Jones*, Dig. 182, the imitation of Mr. Borwick's wrappers. See, too, *R. v. Closs*, D. & B. 460; 7 Cox, 494.

(e) D. & B. 265; 7 Cox, 312.

(f) He said, for instance, that

the conviction proceeded upon "a mere misrepresentation, during the bargaining for the purchase of a commodity, of the quality of that commodity." "If the seller were criminally liable for unduly exaggerating the value of the article, the buyer would be for unduly depreciating." He "found no case in which a mere misrepresentation at the time of sale of the quality of the goods had been held to be an indictable offence."

infinitesimal quantity of gold was found in a ring represented to be of eighteen-carat gold, the presence of that infinitesimal quantity of gold prevented the false representations from supporting a criminal charge (a). Where the jewellery contained no metal of the kind specified, the prisoner was convicted (b). Anticipating such a result, Bramwell, B., said (c) that the result of the decision would be that the prisoner would be indictable if Elkington's spoons had half an ounce and his none, but not if Elkington's had one ounce and his a quarter of an ounce.

The interpretation thus put upon the decision in *R. v. Bryan* was unfortunate, tending, as it did, to encourage an idea of fraud being possible with impunity; and some of the judges who had decided *R. v. Bryan* (c) took opportunities of explaining what the real principle of the judgment was (d). It was also difficult to reconcile such a conclusion with such cases as those in which the prisoner sold a cheese by means of the representation that a taster taken from a cheese of superior quality was in fact taken from the one in question (e). There was, indeed, in those cases, a certain misrepresentation as to substance, but the real grievance was that a cheese was sold as being of one quality, when it was in fact of another (f).

R. v. Ardley. The whole question is now fully explained and set at rest by the judgment in *R. v. Ardley* (g). There the

(a) *R. v. Suter & Coulson*, 10 Cox, 577; and see *R. v. Lee*, 8 Cox, 233; *R. v. Levine & Wood*, 10 Cox, 374. Previously to *R. v. Bryan*, D. & B. 265, 7 Cox, 312, in *R. v. Hall*, 45 C. C. Sessions Papers, 451, the prisoner was convicted, though there was a minute quantity of gold.

(b) *R. v. Roebuck*, 7 Cox, 126; D. & B. 24; and see *R. v. Ball*, C. & M. 249; *R. v. Stevens*, 1 Cox, 83; and *R. v. Priestley*, 63 C. C. Sessions Papers, 541.

(c) *R. v. Bryan*, D. & B. 265; 7 Cox, 312.

(d) See, for instance, per Erle, C. J., in *R. v. Goss*, Bell, 208; 8 Cox, 262; and per Willes, J., in *R. v. Suter & Coulson*, 10 Cox, 577.

(e) *R. v. Abbott*, 1 Den. 273; *R. v. Dark*, 1 Den. 276; *R. v. Garlick*, 1 Den. 276; *R. v. Goss*, Bell, 208; 8 Cox, 262.

(f) And on this ground Lord Campbell, C. J., in *R. v. Roebuck*, 7 Cox, 126, D. & B. 24, dissented from *R. v. Abbott*.

(g) L. R. 1 C. C. R. 301, 12 Cox, 23. Compare *R. v. Foster*, 13 Cox, 393.

prisoner obtained money for a watch chain which he represented to be of fifteen-carat gold, stamped on every link, but which representation was untrue. In giving judgment, Bovill, C. J., said: "The case which has been most pressed upon us is *R. v. Bryan* (a). The representation in that case was that certain plated spoons were 'equal to Elkington's A.' *Primâ facie* that representation would seem to be a mere matter of opinion, and the Court held that it was not sufficient to support the conviction. But many of the judges expressed the opinion that there might well be cases in which misrepresentations, though as to quality, would be within the statute. Cockburn, C. J., says, 'If the prisoner had represented these articles as being of Elkington's manufacture, when in point of fact they were not, and he knew it, that would be an entirely different thing.' Pollock, C. B., says, 'I think if a tradesman or a merchant were to concoct an article of merchandise expressly for the purpose of deceit, and were to sell it as and for something very different even in quality from what it was, the statute would apply.' It is plain that these learned judges considered that a specific representation of quality, if known to be false, would be within the statute. Coleridge, J., expressly concurs in the observations of Pollock, C. B. Erle, J., at the close of his judgment, says: 'No doubt it is difficult to draw the line between the substance of the contract and the praise of an article in respect of a matter of opinion; still it must be done, and the present case appears to me not to support a conviction, upon the ground that there is no affirmation of a definite triable fact in saying the goods were equal to Elkington's "A," but the affirmation is of what is mere matter of opinion, and falls within the category of untrue praise in the course of a contract of sale, where the vendor has in substance the article contracted for, namely, plated spoons.' Crompton, J., also considered that the statute

(a) D. & B. 265; 7 Cox, 312.

applies 'where the thing sold is of an entirely different description from what it is represented to be.' Willes, J., who dissented from the judgment of the Court, goes the whole length of saying that a representation as to quality, if known to be false, is enough to support a conviction. And Bramwell, B., leans to the same opinion.

"Applying these observations to the present case, the statement here made is not in form an expression of opinion or mere praise. It is a distinct statement, accompanied by other circumstances, that the chain was fifteen-carat gold. That statement was untrue, was known to be untrue, and was made with intent to defraud. How does that differ from the case of a man who makes a chain of one material and fraudulently represents it to be of another? Therefore, whether we look at the whole of the evidence, or only at that which goes to the quality of the chain, the conviction is good. The case differs from *R. v. Bryan* (a), because here there was a statement as to a specific fact within the actual knowledge of the prisoner, namely, the proportion of pure gold in the chain."

Intentional
misstate-
ment as to
fact punish-
able.

From this case it follows that where a person has made a false statement in regard to a specific question of fact, knowing that statement to be false, with intent to defraud, and he does defraud by means of that statement, then, even though the statement have reference to the quality of the article, he will be liable to be convicted (b).

Wrongful user
of trade
marks.

Placing a forged trade mark on goods not the make of the manufacturer whom the trade mark denotes will amount to such a statement; and it seems that the shifting a genuine label from goods of superior quality to goods of inferior quality, though of the same maker, will also come within the principle of *R. v. Ardley* (c).

(a) D. & B. 265; 7 Cox, 312.

(b) On this principle, in New South Wales, a prosecution was directed against a person who had sold German cigars as Havannahs.

Heyde v. Wittkowski, 5 N. S. W. Rep. (E.) 74.

(c) L. R. 1 C. C. R. 301; 12 Cox, 23.

In the sale of goods by weight, if money is obtained by representing the weight sold to be greater than it really is, an indictment for false pretences will be good, and it will make no difference that the goods were sold as a whole—for instance, by the load—if the price was calculated on the assumption that the load was of the weight represented by the prisoner (*a*).

False pretences as to weight.

By § 105 of the Patents Act, 1883, penalties are now imposed on persons untruly representing that a trade mark is registered (*b*).

False pretences as to registration of trade marks.

Words are not necessary to constitute the false representation. Thus, where hewers at a colliery placed in their tubs of coal tokens to represent a greater weight of coal than they had in fact worked, it was held that they were properly convicted (*c*).

False pretences with out words.

(*a*) *R. v. Sherwood*, 7 Cox, 270; *R. v. Ridgway*, 3 F. & F. 838; *R. v. Ragg*, 8 Cox, 265; *R. v. Lee*, 9 Cox, 460.

(*b*) See § 3 (1) of the Merchan-

dise Marks Act, also *R. v. Morris*, Great Marlborough Street Police Court, December 16th, 1886.

(*c*) *R. v. Hunter*, 10 Cox, 642; *R. v. Carter*, *ib.*

CHAPTER VI.

THE CIVIL REMEDY. I.

Common Law. THE proper remedy at Common Law for a fraud committed by means of the infringement of a trade mark belonging to a rival trader is by an action on the case for deceit. The manner in which that form of action was made applicable to cases of trade mark and developed to meet the necessities of such cases, which in some respects differ from other cases of fraudulent misrepresentation, may be well stated in the language employed by Mellish, L. J., who says (a) : "In my opinion, all actions of this nature must be founded upon false representations. Originally, I apprehend, the right to bring an action in respect of the improper use of a trade mark arose out of the Common Law right to bring an action for a false representation, which, of course, must be a false representation made fraudulently. It differed from an ordinary action for false representation in this respect, that an action for false representation is generally brought by the person to whom the false representation is made ; but in the case of the improper use of a trade mark, the Common Law Courts noticed that the false representation which is made by putting another man's trade mark, or the trade name of another manufacturer, on the goods which the wrongdoer sells, is calculated to do an injury, not only to the person to whom the false or fraudulent representation is made, but to the manufacturer whose trade mark is imitated ; and, therefore, the Common Law Courts held that such a manufacturer had a

(a) *Singer Manufacturing Co. v. Wilson*, 2 Ch. D. 434-53.

right of action for the improper use of his trade mark. Then the Common Law Courts extended that doctrine one step farther; first, if I recollect rightly, in the case of *Sykes v. Sykes* (a). There it was held that, although the representation was perfectly true as between the original vendor and the original purchaser, in this sense, that the original purchaser knew perfectly well who was the real manufacturer of the goods, and therefore was not deceived into believing that he had bought goods manufactured by another person; yet if the trade mark was put on the goods for the purpose of enabling that purchaser, when he came to resell the goods, to deceive any one of the public into thinking that he was purchasing the goods of the manufacturer to whom the trade mark properly belonged, then that was equally a deception, a selling of goods with a false representation, which would give the original user of the trade mark a right of action. That was the Common Law right."

An action on the case for deceit at Common Law may then be brought, not only by the person who has been induced to purchase goods manufactured by one maker in the faith that they have been manufactured by another, but also by the maker of whose manufacture the goods in question have falsely been represented to be. It seems at least probable that this principle was recognised as early as the reign of Queen Elizabeth. In *Southern v. How* (b) a case was quoted by Doderidge, J., in which, in that reign, a clothier of Gloucester, who manufactured better cloth than any other person in the trade, had invented and applied to his cloth a special mark to denote his manufacture. Another clothier then pirated this mark and applied it to his own inferior cloth; and it was held in the Court of Common Pleas that an action on the case for deceit would lie against the fraudulent clothier.

Action may be brought by manufacturer defrauded.

(a) 3 B. & Cr. 541. And see per Lord Blackburn, in *Singer Manufacturing Co. v. Loog* (3), 8 App. Cas. 15.

(b) Cro. Jac. 471; Poph. 144; 2 Rolle, 28.

Whether the action was brought by the buyer of the cloth or by the rival clothier cannot be determined, since the reporters differ on this point; but this much is clear, that Chief Justice Popham (*a*) reported the case as establishing the right of the defrauded clothier to compensation for the injury done him.

Right to redress.

Whatever the circumstances in that particular case may have been, the principle that a person who has suffered by reason of his trade mark being intentionally imitated by another has a right at Common Law to redress from the infringer has been repeatedly acted on, and is thus clearly stated by Coltman, J., in *Rodgers v. Nowill* (*b*), where, after expressing his agreement with the law laid down by Williams, J., that no man had a right to sell goods of his own manufacture upon a false and deceitful representation that they were of the manufacture of another, he says: "To this I would add that an action is clearly maintainable by the party whose name is so fraudulently used, if any damage results to him from the false representation."

At Common Law, fraudulent intention must be proved.

According to the strict principles of the Common Law, for an action in respect of a trade mark to be successful, it must be proved that the defendant acted with fraudulent intention. "Proof of fraud on the part of the defendant," says Lord Westbury, C., "is of the essence of the action" (*c*). The general law on the subject of false representations is

(*a*) The great weight to be given to any statement by Popham, C. J., appears from the terms applied to him in 6 Co. Rep. 75, where he is described as "the venerable and honourable Chief Justice of England, and Councillor of State to Queen Elizabeth and to our Lord the King that now is. . . . Who was a most reverent judge, of a ready apprehension, profound judgment, most excellent understanding in the true reason of the law, and of universal and admirable experience and knowledge of all business which concerned the

commonwealth; accompanied with a rare memory, with perpetual industry and labour for the maintenance of the tranquillity and public good of the realm, and in all things behaving with great constancy, integrity and patience." Eyre, C. J. (1 B. & P. 610), speaks of him as "a very able judge," and Lord Fitzgerald (14 App. Cas. 357) says "he had the reputation of being a consummate lawyer."

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

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

summed up by Parke, B., in *Taylor v. Ashton* (a), as being that, independently of any contract between the parties, no one can be made responsible for a representation of such a kind as there was in that case (*i.e.*, a false representation of the flourishing state of a bank, which had induced the plaintiff to take shares), unless it be fraudulently made. The law so enunciated was applied in a succession of trade-mark cases at Common Law (b), the effect of which was stated by Lord Westbury as above.

It has been held that intentional fraud cannot be inferred from the fact alone that the plaintiff has informed the defendant that in his opinion the defendant was using a trade mark calculated to deceive, nor even from the fact being that the trade mark so used is really calculated to deceive: there must be evidence that the defendant believed such deception to be probable (c); in other words, that the defendant has sold his goods "as and for" the plaintiff's goods (d). "But," said Lord Blackburn, in *Singer Manufacturing Co. v. Loog* (3) (e), "it is to my mind obvious that, though the defendants might have committed no

Defendant
must have
expected
deception.

(a) 11 M. & W. 415.

(b) See, among other cases, *Singleton v. Bolton*, 3 Doug. 293; *Crawshay v. Thompson*, 4 Man. & G. 357; *Rodgers v. Nowill*, 5 C. B. 109; *Myers v. Baker*, 3 H. & N. 802. In *Crawshay v. Thompson*, Coltman, J., expressed himself thus: "It appears to me that an intention to deceive is a necessary ingredient in this case. The intention is for the jury; and fraud must be made out by proof of an intention existing in the mind of the party that the iron should pass as the iron of the plaintiff." And in *Hargreaves v. Smith*, Dig. 338, Lush, J., told the jury that an intention to divert customers from the plaintiffs to the defendant must be proved. See per Lord Blackburn in *Singer Manufacturing Co. v. Loog* (3), 8 App. Cas. 15, in the House of Lords, and *Lavrio v. Baker*, 2 P. R. 213.

(c) *Crawshay v. Thompson*, 4 Man. & G. 357.

(d) *Sykes v. Sykes*, 3 B. & Cr. 541; *Morison v. Salmon*, 2 Scott, N. R. 449, 2 Man. & G. 385; *Crawshay v. Thompson*, *ubi supra*. In equity, it is not necessary to prove fraudulent intention otherwise than by proving that the defendant has used a mark which is, in fact, calculated to deceive; and this was recognised by the Court of Queen's Bench in *Dixon v. Fawcus*, 3 Ell. & Ell. 537. Since by the Judicature Act of 1873, § 25, the rules of Equity are to prevail where they conflict with those of the Common Law, it appears that at least nominal damages should now be recoverable in the Queen's Bench Division on proof of such facts as would be satisfactory to a Court of Equity.

(e) 8 App. Cas. 15

actionable wrong whilst using the plaintiff's trade mark innocently, yet, if they persevered with the use of it after they had knowledge of the facts, they would do wrong, and there would be evidence to support a claim at law for damages for knowingly selling the defendants' goods as and for the plaintiff's." And in a recent Canadian case at law (a), it was held that the plaintiff was entitled to damages, though the defendant denied any fraudulent intention, since the mark had been registered for a year as the plaintiff's, and the defendant must be taken to have known it.

Deception of first purchaser not necessary.

It is not necessary, in order for the plaintiffs to recover, for them to show that the defendants made fraudulent representations directly to the persons to whom they sold the goods; "although they did not themselves sell them as goods of the plaintiffs' manufacture, yet if they sold them to retail dealers for the express purpose of being resold as goods of the plaintiffs' manufacture" (b), thus "scattering over the world the means of enabling parties to commit frauds upon the plaintiffs" (c), proof of that would be sufficient for the plaintiffs' case (d).

Questions for jury.

The question of fraudulent intention is for the jury, with whom it rests to say whether or not such intention is proved by the evidence before them (e). And it was held under the old practice that the plaintiff's pleadings must allege with sufficient distinctness a false representation on the part of the defendant (f), when it was left to the jury to say whether the defendant had adopted the particular mode of deceit charged (g).

(a) *Bondier v. Depatie*, 3 Dorion 233.

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

(c) Per Wood, V.-C., in *Farina v. Silverlock*, 1 K. & J. 509.

(d) Compare the language of the Court of King's Bench in *Polhill v. Walter*, 3 B. & Ad. 114; and see *Singer Manufacturing Co. v.*

Wilson, 2 Ch. D. 434-42-51-53, and *Singer Manufacturing Co. v. Loog* (3), 8 App. Cas. 15.

(e) *Crawshay v. Thompson*, 4 Man. & G. 357; *Rodgers v. Nowill*, 5 C. B. 109.

(f) *Morison v. Salmon*, 2 Scott, N. R. 449; 2 Man. & G. 385.

(g) *Rodgers v. Nowill*, 5 C. B. 109. In *Hargreaves v. Smith*, Dig.

In order to entitle the plaintiff to recover, it must be shown that the defendant's conduct has injuriously affected the plaintiff, and the plaintiff's pleadings must be so framed as to disclose a sufficient cause of action; so that where a banking business was established in London under the same name as a previously existing bank, it was held that the proprietor of the earlier bank could not recover, since he had not averred that he was a banker or had ever carried on a banking business (a). This case was decided on the same principle on which it was held, in the Court of Chancery, that there was no infringement of trade mark unless there was actually in the market a vendible article to which the mark was in some way attached, and that no right to an injunction existed before the article had in fact been produced, even though it had been repeatedly advertised, and considerable outlay so incurred (b).

Plaintiff must be injured.

Where A ordered from B a quantity of fire-bricks, marked with the name of C, who used it as his own trade mark, and the order was being executed by B in ignorance of C's rights, C filed a bill in Chancery to restrain B, who compromised the matter on paying a sum amounting in all, including costs, to over £200. On B bringing an action against A to recover the sum which he had so been compelled to pay, it was held by the Court of Queen's Bench that he was entitled to recover that sum, C being entitled to an injunction in Equity on mere proof of the imitation, though at Common Law he would have had to prove fraud on the part of B (c).

Costs incurred by defendant's fraud recovered from him.

It has been held in America that an innocent vendor of goods falsely marked, the genuineness of which he has not

Innocent vendor of goods falsely marked.

338, Lush, J., left it to the jury to say (1) whether the plaintiffs' mark was a good one; (2) whether it had been imitated; (3) whether, if there was imitation, it was with intent to deceive. And see *Gillespie & Co. v. Marshall*, Dig. 648.

(a) *Lawson v. Bank of London*,

18 C. B. 84. And see per Lord Blackburn in *Singer Manufacturing Co. v. Loog* (3), 8 App. Cas. 15.

(b) *McAndrew v. Bassett*, 4 De G. J. & S. 380; *Maxwell v. Hogg*, L. R. 2 Ch. 307.

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

warranted, is entitled to maintain an action to recover the price of the goods from a person to whom he has sold them (*a*).

Damages.

Although it cannot be assumed by the Court, in default of evidence, that the same quantity of goods which a defendant has sold under a trade mark imitated from that of the plaintiff would have been sold by the plaintiff but for the defendant's unfair competition (*b*), yet, where the whole profit made by an infringer upon the sale of the goods wrongfully marked was awarded by the jury as damages, the American Court held that this was not excessive, and said that the fact that it was impossible to apportion the profit rendered it just that the infringer should lose the whole (*c*). And in *Taylor v. Carpenter* (*d*), when the defendant, against whom a verdict had been found with substantial damages, moved for a new trial, urging, among other arguments, that the jury should have been told that if the defendant's goods were not inferior to the plaintiffs', the latter could not recover, or at all events could recover only nominal damages, it was held that the plaintiffs were not only not debarred from recovering at all, but that they could recover substantial damages, "since the actual damage suffered by loss of sales by the plaintiffs, which was the ground of recovery, was just as great as if the thread had been inferior, though the credit of their mark and thread might not suffer as much thereby, if it did at all."

Nominal
damages
where right
infringed.

That a plaintiff is entitled to recover some damages where his trade mark has been infringed, appears clearly from *Blofeld v. Payne* (*e*), in which Lord Denman, C. J., told the jury that even if the defendants' hones were not

(*a*) *Rudderow v. Huntington*, 3 Sand. S. C. 252, R. Cox, 106.

(*b*) *Leather Cloth Co. v. Hirschfeld*, L. R. 1 Eq. 299. As to damages see cap. 7 *infra*.

(*c*) *Graham v. Plate*, 40 Cal.

593, 6 Amer. Rep. 639. And see *Hostetter v. Vowinkle*, 1 Dill. 329.

(*d*) 2 Wood. & M. 1; 9 L. T. (Old Series) 514, R. Cox, 32-42.

(*e*) 4 B. & Ad. 410.

inferior, the plaintiff was still entitled to some damages, inasmuch as his right had been evaded by the fraudulent act of the defendants. The jury found a verdict for the plaintiff, with a farthing damages, and also found that the defendants' hones were not inferior to the plaintiff's. The verdict was upheld by the Court of King's Bench, Little-dale, J., saying that "the act of the defendants was a fraud against the plaintiff, and that even if it occasioned him no specific damage, it was still, to a certain extent, an injury to his right." It is evident that in this case, although the plaintiff did not suffer in reputation by the sale of inferior hones as his, yet he suffered in another way, his custom being diminished to an undetermined extent by goods being sold as his, so as to compete with those really of his make (a).

The first recorded case of trade mark brought before the judicial notice of the Court of Chancery was that of *Blanchard v. Hill* (b), in 1742, which, however, resulted in a statement by Lord Hardwicke, C., that he did not know "any instance of granting an injunction in Chancery to restrain one trader from using the same mark with another," and that he thought "it would be of mischievous consequence to do it."

In *Day v. Day* (1816) (c), *Henry v. Price* (1831) (d), and *Gout v. Aleploglu* (1833) (e), however, injunctions were granted to restrain the infringement of the plaintiffs' trade marks, and from this time the steadily increasing number of such cases coming before the Court of Chancery shows the growing favour with which that Court was regarded by suitors, the chief incentive no doubt being

(a) See per Erskine, J., in *Morison v. Salmon*, 2 Scott, N. R. 449; 2 Man. & G. 385; and per Wilde, C. J., in *Rodgers v. Nowill*, 5 C. B. 109; also *Coffeen v. Brunton*, 4 McLean, 516, R. Cox, 82; *Lemoine v. Ganton*, 2 E. D. Smith, 343, R. Cox, 142; *Chappell v. Davidson*, 2 K. & J. 123; *Singer Manufacturing Co. v.*

Wilson, 2 Ch. D. 434-42-51-54; *Lawrie v. Baker*, 2 P. R. 213; and *Bondier v. Depatie*; 3 Dorion 233.

(b) 2 Atk. 484.

(c) Dig. 21.

(d) 1 Leg. Obs. 364.

(e) 5 *ib.* 495, and 6 Beav. 69; and see *Day v. Binning*, C. P. Cooper, 489, 1 Leg. Obs. 205.

the more beneficial character of the remedy awarded, by injunction and account, as compared with the Common Law remedy of damages. By degrees the Court of Chancery absorbed the jurisdiction in trade-mark cases, until such cases were rarely if ever tried in the Common Law Courts, except when they were remitted by a Chancery judge for trial of the Common Law right. That practice was discontinued in consequence of Sir John Rolt's Act (*a*), and the effect was, notwithstanding the extended power given to the Common Law Courts by the Merchandise Marks Act of the same year (*b*), to confine the consideration of this class of cases more strictly, if possible, than before to the Court of Chancery.

Registration Acts administered by Chancery Division.

This fact was recognised by the Chancery Division being appointed to administer the Trade Marks Registration Acts (*c*), and although the High Court of Justice generally is now substituted for the Chancery Division (*d*), trade-mark cases are still usually brought before that Division.

Board of Trade.

The comptroller appointed under the Patents Act is, however, subject to the superintendence of the Board of Trade, who will, it may be assumed, refer all cases of difficulty, whether arising from questionable applications or from oppositions persisted in, to the Court (*e*).

Principles adopted in Equity with respect to trade marks.

The principles on which the Courts of Equity have long acted in cases where a valid trade mark has been affixed to the goods or to wrappers or vessels containing them—principles by which those cases must, as it seems, be governed for the future, before whichever branch of the

(*a*) 25 & 26 Vict. c. 27. But in some of the American Courts cases of doubtful right are still sent for trial at law; *e.g.*, *Seltzer v. Powell*, 8 Phila. 296.

(*b*) 25 & 26 Vict. c. 88, § 21.

(*c*) 38 & 39 Vict. c. 91; 39 & 40 Vict. c. 33; and 40 & 41 Vict. c. 37. See the old Rule 42, and *In re Orr-Ewing* (2), 28 W. R. 412.

(*d*) § 117 of Patents Act, 1883.

(*e*) *In re Normal Co., Ltd.*, 35 Ch. D. 231. And see Patents Acts, 1883-8, §§ 62, 69. As to the position of the late Commissioners of Patents, whose functions are now transferred to the Board of Trade, see *In re Meikle*, 24 W. R. 1067; *In re Barrows*, 5 Ch. D. 353; *In re Rotherham*, 14 *ib.* 585.

High Court of Justice they may come (a)—are thus explained by Sir G. Jessel, M. R., in *Singer Manufacturing Co. v. Wilson* (b).

“ It is quite immaterial that the maker of the goods to which what I will call, for the sake of shortness, the trade mark is affixed, did not know that it was a trade mark, and had not the slightest intention of defrauding anybody. He must not put as a mark on goods, even though he intends to establish it as his own trade mark, that which is the known trade mark of other people, and he would be restrained by injunction, though he thought he himself had invented the trade mark, and *bonâ fide* intended it to designate goods of his own manufacture. And the reason is obvious: because the goods pass from hand to hand, and though he may act with the utmost *bona fides*, yet the ultimate purchasers might believe that they were the real goods, that is to say, that they were manufactured by the person entitled to the original trade mark. Therefore, in that case, knowledge that he is doing anything wrong is immaterial, even in the maker.

“ Another element which is sometimes imported into these cases has also no material bearing: that is, that if the maker knows that they are not the goods of the person entitled to use the trade mark, and communicates that knowledge to the immediate purchaser, it makes, as I have said, no difference; and even if he does not know it, and tells the immediate purchaser that the goods are of his own manufacture, it will still not save him from an injunction, because, although the immediate purchaser from him is aware that the goods in question are not manufactured by any other person than the vendor, yet, as he passes them on, the representation does not necessarily pass on with them, and therefore the next purchaser, or the following or some other purchaser, or the public at large, who are the ultimate purchasers, would be as much deceived as if

(a) See Judicature Act of 1873, § 25. (b) 2 Ch. D. 434.

no such communication took place. Consequently, you have nothing more to do than to show that the trade mark has been taken" (a).

At first
Equity fol-
lowed the
Common Law.

When trade-mark cases were first brought into the Court of Chancery, they were treated on the same principle as they were at Common Law, and redress was refused where actual intentional fraud was not alleged and substantiated. The existence of anything that could be called a right of property in a trade mark was denied, and a fear expressed that, if that should be admitted, a stronger monopoly than even a patent-right would be created (b).

*Millington v.
Fox.*

In the year 1838, however, when the case of *Millington v. Fox* (c) came before Lord Cottenham, C., the Lord Chancellor perceived that when goods made by one man were put upon the market bearing the trade mark of another, the same evil effects were produced, whether the mark was so affixed for fraudulent purposes or with innocent intentions, since purchasers would buy A's goods in the belief that they were B's, and B would be deprived of the custom intended for him; so that A, whether by his own contrivance or not, would profit at the expense of B and the public. In that case it was accordingly held by the Lord Chancellor that the plaintiffs were entitled to an injunction, although he stated in express terms that

(a) And see per Lord Cairns, C., *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 391, and Lord O'Hagan, *ib.* 396; *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 Ch. D. 454. So, in Scotland, "on an application for an interdict it is not only not necessary to prove any pecuniary damage, but it is not necessary to prove that any injury has been actually inflicted. A threat of injury is a sufficient ground for an application for an interdict; and in like manner a reasonable apprehension of injury from the proceedings of the parties complained against is also in many

circumstances a very good ground for such an application." (Per the Lord President, in *Singer Manufacturing Co. v. Kimball & Morton*, Ct. Sess. Cas. 3rd Ser. XI., 267.) And in India "it is not enough to say that there was no fraudulent intention. That is no reason why an injunction should not be granted." (Per Phear, J., *Graham & Co. v. Kerr, Dods & Co.*, 3 Beng. L. R. App. 4.)

(b) *Blanchard v. Hill*, 2 Atk. 484; *Canham v. Jones*, 2 V. & B. 218.

(c) 3 My. & Cr. 338; and see the earlier case of *Gout v. Aleploglu*, 5 Leg. Obs. 495.

he saw no reason for thinking that there had been any fraudulent user by the defendant of the plaintiffs' mark (a).

The decision in this case gave rise to some difference of opinion among the judges, some holding that the jurisdiction of the Court of Chancery in these cases, like that of the Common Law Courts, was founded on intentional fraud, and denying any exclusive right in trade marks (b), while others held that, intentional fraud not being necessary for the injunction, the jurisdiction must be held to be founded on the protection of a right of property in the trade mark (c).

Question as to foundation of jurisdiction.

(a) See per Lord Blackburn in *Singer Manufacturing Co. v. Loog* (3), 8 App. Cas. 15.

(b) *Perry v. Truefitt*, 6 Beav. 66; *Croft v. Day*, 7 Beav. 84; *Foot v. Lea*, 13 Ir. Eq. 484; *Edelsten v. Vick*, 11 Hare, 78; *Collins Co. v. Brown*, 3 K. & J. 423; *Collins Co. v. Cowen*, 3 K. & J. 428; *Leather Cloth Co. v. American Leather Cloth Co.*, 1 H. & M. 271; *McAndrew v. Bassett*, 33 L. J. Ch. 561; *Walton v. Crowley*, 3 Bl. C. C. 440, R. Cox, 166.

(c) *Farina v. Silverlock*, 6 De G. M. & G. 214; *Burgess v. Hills*, 26 Beav. 244; *Clement v. Maddick*, 1 Giff. 98; *Emperor of Austria v. Day*, 3 De G. F. & J. 217; *Welch v. Knott*, 4 K. & J. 747; *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Hall v. Barrows*, 4 *ib.* 150; *McAndrew v. Bassett*, 4 *ib.* 380; *Leather Cloth Co.'s case*, 4 *ib.* 137; 11 H. L. C. 523; *Cartier v. Carlile*, 31 Beav. 292; *Moet v. Couston*, 33 *ib.* 578; *Barnett v. Leuchars*, 13 L. T. N. S. 495; *Maxwell v. Hogg*, L. R. 2 Ch. 307; *Collins Co. v. Reeves*, 28 L. J. Ch. 56; *Bradbury v. Becton*, 39 *ib.* 57; *Radde v. Norman*, L. R. 14 Eq. 348; *Hirst v. Denham*, *ib.* 542; *Smith v. Mason*, W. N. 1875, p. 62; *Apollinaris Co. v. Norrish*, 33 L. T. N. S. 242; *Cheavin v. Walker*, 5 Ch. D. 850; *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 376;

Same v. Loog (3), 8 *ib.* 15; *Grillon v. Guénin*, W. N. 1877, p. 14; *Ransome v. Graham*, 51 L. J. Ch. 897; *Cowen v. Hulton*, 46 L. T. N. S. 897; *Hatchard v. Mège*, 18 Q. B. D. 771; *Oakey & Sons v. Dalton*, 35 Ch. D. 700. So in Scotland—*Singer Manufacturing Co. v. Kimball & Morton*, Ct. Sess. Cas. 3rd Ser. XI., 267; in Ireland—*Kinahan v. Bolton*, 10 Ir. Ch. 75; *Wheeler v. Johnston*, 3 L. R. Ir. 284; in India—*Orr-Ewing & Co. v. Grant, Smith & Co.*, 2 Hyde, 185; in Canada—*Walker v. Alley*, 13 Grant, Up. Can. Ch. 366; in the United States—*Davis v. Kendall*, 2 R. I. 566, R. Cox, 112; *Clark v. Clark*, 25 Barb. 76, R. Cox, 206; *Dale v. Smithson*, 12 Abb. Pr. 237, R. Cox, 282; *Woodward v. Lazar*, 21 Cal. 448, R. Cox, 300; *Derringer v. Plate*, 29 Cal. 292, R. Cox, 324; *Bradley v. Norton*, 33 Conn. 157, R. Cox, 331; *Gillott v. Esterbrook*, 47 Barb. 455, R. Cox, 340; 48 N. Y. 374; *Burnett v. Phalon*, 9 Bos. 192, R. Cox, 376; *Filley v. Fassett*, 44 Mo. 173, R. Cox, 530; *Dixon Crucible Co. v. Guggenheim*, 2 Brews. 321, R. Cox, 559; *Stonebraker v. Stonebraker*, 33 Md. 252; *State of Missouri v. Gibbs*, 56 Mo. 133; *Winsor v. Clyde*, 9 Phila. 513; *Blackwell v. Armistead*, 5 Am. L. T. 85; *Colman v. Crump*, 70 N. Y.

Deference to
Common Law.

In *Molloy v. Downman* (a) it was laid down broadly that the jurisdiction of the Court of Chancery was merely ancillary to that of the Common Law, and that the right to redress must be determined by the rules of the Common Law; and accordingly cases were frequently referred to the Common Law Courts for the determination of the right, before the equitable remedy was awarded (b). That practice, however, gradually died out as the principle of interference in the absence of intentional fraud came to be recognised, and Sir John Rolt's Act (c) finally put an end to it.

Principle of
Millington v. Fox
explained
by V.-C. Wood.

The explanation given by Wood, V.-C., of the decision in *Millington v. Fox* (d) and other cases in which relief was given without proof of fraudulent user, was, that it was on the principle "that although a person had used another man's trade mark perfectly innocently, yet if he continued for one moment after he had been told of it to use another man's trade mark, he did so fraudulently, and if he sought to keep in his pocket profits which he had made by representing, however innocently, that his goods were another person's, after he had been told of the fact, it was fraud" (e).

By Lord
Westbury.

From this view Lord Westbury, C., dissented (f), and the view now generally accepted as to the principles governing the action of the Courts of Equity was thus stated by him, in the *Leather Cloth Co.s' case* (g): "The representation

573; *Rillet v. Carlier*, 61 Barb. S. C. 435; *Gilman v. Hunnerell*, 122 Mass. 139; *McLean v. Fleming*, 96 U. S. Rep. 245; *Kidd v. Johnson*, 100 *ib.* 617; *Robertson v. Berry*, 50 Md. 591.

(a) 3 My. & Cr. 1.

(b) *Perry v. Truefitt*, 6 Beav. 66; *Rodgers v. Nowill*, 6 Hare, 325; *Foot v. Lea*, 13 Ir. Eq. 484; *Farina v. Silverlock*, 1 K. & J. 509; and others. In some of the American States, e.g., in Pennsylvania, the same practice is still followed: *Seltzer v. Powell*, 8 Phila. 256.

(c) 25 & 26 Vict. c. 27.

(d) 3 My. & Cr. 338.

(e) *McAndrew v. Bassett*, 33 L. J. Ch. 561. See per Lord Cairns, in *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 376-91, and per Lord Blackburn in that case (*ib.* 400), and in *Singer Manufacturing Co. v. Loog* (3), 8 App. Cas. 15.

(f) *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Leather Cloth Co.s' case*, 4 *ib.* 137; *Hall v. Barrows*, *ib.* 150; *McAndrew v. Bassett*, *ib.* 380.

(g) 4 De G. J. & S. 137.

which the defendant is supposed to make, that his goods are the goods of another person, is not actually made otherwise than by his appropriating and using the trade mark which such other person has an exclusive right to use in connection with the sale of some commodity; and if the plaintiff has an exclusive right to use any particular mark or symbol, it becomes his property for the purposes of such application, and the act of the defendant is a violation of such right of property, corresponding with the piracy of copyright or the infringement of a patent. I cannot therefore assent to the dictum that there is no property in a trade mark. It is correct to say that there is no exclusive ownership of the symbols which constitute a trade mark, apart from the use or application of them; but the word 'trade-mark' is the designation of marks or symbols when applied to a vendible commodity, and the exclusive right to make such user or application is rightly called 'property.'—The true principle, therefore, seems to be that the jurisdiction of the Court in the protection given to trade marks rests upon property; and that the Court interferes by injunction, because that is the only mode by which such property can be effectually protected. The same things are necessary to constitute a title to relief in Equity in the case of the infringement of the right to a trade mark as in the case of the violation of any other kind of property. First, the plaintiff must prove that he has an exclusive right to use some particular mark or symbol in connection with some manufacture or vendible commodity; and, secondly, that this mark or symbol has been adopted or is used by the defendant so as to prejudice the plaintiff's custom and injure him in his trade or business" (a).

(a) In *Walker v. Alley*, 13 Grant, Up. Can. Ch. 366, Van Koughnet, Chancellor of Upper Canada, said: "Some difficulty may be created by the use of the word 'property'

in trade marks. It may be said, 'What is property, unless it be something tangible?' I take property, when used in this connection and sense, to be a means by which

In what sense fraud is required in Equity.

Still, even though it be admitted that the Law of Trade Marks is based upon a right of property, fraud also is necessary to entitle the owner of the trade mark to redress (a). But the fraud does not consist in an intention to deceive on the part of the defendant, but in an actual deception, or in the creation of a probability of deception (b), independently of any fraudulent intention. "Imposition on the public," says Lord Westbury (c), "is indeed necessary for the plaintiff's title; but in this way only, that it is the test of the invasion by the defendant of the plaintiff's right of property; for there is no injury done to the plaintiff if the mark used by the defendant be not such as may be mistaken, or is not likely to be mistaken, by the public for the mark of the plaintiff. But the true ground of the Court's jurisdiction is property."

Intention immaterial in Equity.

The exact language in which the principle on which the Court of Chancery has acted is to be described is really immaterial, and in fact "merely a question of nomenclature" (d), since the important and substantial point is completely established, that in cases of trade mark nothing more has to be done "than to show that the trade mark has been taken" (e).

Right of property in registered mark.

The right in a trade mark registered under the Trade Marks Acts or the present Patents Acts is strictly a right of property (f); the person entitled to it is the proprietor (g);

money or money's worth, in the shape of profit or otherwise, is created or obtained."

(a) See per Mellish, L. J., in *Singer Manufacturing Co. v. Wilson*, 2 Ch. D. 434-53.

(b) Compare per Hall, V.-C., in *Cope v. Evans*, L. R. 18 Eq. 138. And see *Kinney v. Basch*, Dig. 542; *Bodega Co., Ltd. v. Owens*, 23 L. R. Ir. 371.

(c) *Hall v. Barrows*, 4 De G. J. & S. 150; and see per Lord Cranworth, C., in *Farina v. Silverlock*, 6 De G. M. & G. 214, and per Jessel, M. R., in *Cheavin v. Walker*

5 Ch. D. 850. So in the Supreme Court of Pennsylvania, *Pratt's Appeal*, 117 Penn. St. 401.

(d) Per Wood, V.-C., *McAndrew v. Bassett*, 33 L. J. Ch. 561.

(e) Jessel, M. R., in *Singer Manufacturing Co. v. Wilson*, 2 Ch. D. 434; and see *Orr-Ewing & Co. v. Johnston & Co.*, 13 Ch. D. 434, and the cases collected at note (c) on p. 183, *suprà*.

(f) See *Eno v. Stephens*, Dig. 609.

(g) §§ 3, 4, 5 of the Act of 1875; §§ 62, 66, 71, 72, 76 of the Act of 1883.

he is entitled to the exclusive use of it (*a*); and though his rights in regard to it are in some respects less unlimited than those of owners of other kinds of property—*e.g.*, the inability to transfer it except in connection with the goodwill of the business (*b*)—still, subject to the provisions of the Patents Acts, he is entitled to deal with it as he chooses.

In trade-mark cases, “in order to found the jurisdiction of the Court,” says the Lord Chancellor of Ireland (*c*), “there must be established, first, the existence of the trade mark; next, the fact of an imitation, whether a direct imitation, or one with such variations that the Court must regard them as merely colourable; and, thirdly, the fact that the imitations were made without licence (*d*) or anything that the Court could regard as acquiescence in their use.” The law is the same in the three kingdoms, for, said Bacon, V.-C., in *Singer Manufacturing Co. v. Loog* (3) (*e*), “the law of Scotland does not in this respect (*i.e.*, with respect to trade marks) differ from the law of England.” The principles which govern the one govern the other.

Elements
necessary to
found juris-
diction.

In order to ensure a full disclosure of the facts bearing upon these points, the Court will grant, if necessary, discovery and inspection (*f*), and upon the satisfactory establishment of the plaintiff's case will award its appro-

Proceedings
in Equity.

(*a*) § 3 of the Act of 1875; § 76 of the Act of 1883.

(*b*) § 2 of the Act of 1875; § 70 of the Act of 1883.

(*c*) *Kinahan v. Bolton*, 15 Ir. Ch. 75. See *Linde v. Benschel*, 29 N. Y. Sup. Ct. 601.

(*d*) It has been held in America that if the defendant is the holder of a licence from the plaintiff, he cannot contest the validity of the plaintiff's mark, but that he may set up that he was induced to enter into the agreement by fraudulent representations: *Hilsen v. Libby*,

44 N. Y. Super. Ct. 12. And see the observations in that case with respect to pleading.

(*e*) 18 Ch. D. 395.

(*f*) It has been held in America that a defendant is not entitled, by alleging that the plaintiff's goods possess injurious properties, to compel the plaintiff to disclose in cross-examination the ingredients of which his goods are composed, though it seems that such questions may be allowed if the plaintiff has himself led up to them. *Tetlow v. Savournin*, 15 Phila. 170.

priate remedy of an injunction (*a*), framed in such terms as best to counteract the illicit designs of the infringer. And the injunction will be granted, even though the defendant has ceased to use the pirated trade mark (*b*), and has offered to undertake not to use any of the old labels in stock (*c*), or has actually retired from the business in which the pirated marks were used (*d*). But if a plaintiff continues the litigation after having received an offer of all he is entitled to get, he may fail to obtain his costs (*e*). The liability to account for profits is usually, as Romilly, M. R., said in *Cartier v. Carlile* (*f*), incident to the injunction (*g*), or the plaintiff may, at his option, have an inquiry as to damages in lieu of the account, but not both (*h*). The Court will further, where necessary, order the delivery up and destruction of the spurious labels, cards, or tickets (*i*), or the production of the goods wrongfully marked, for the purpose of the erasure and cancellation of the spurious marks (*k*). Destruction of the goods will not be ordered if it is possible without destruction to satisfactorily erase the spurious marks (*l*). In a case in the Supreme Court of

(*a*) In *Glen & Hall Manufacturing Co. v. Hall*, 61 N. Y. 226, a case of the class analogous to trade-mark cases, an injunction was granted against the original plaintiffs, on counter-claim. The injunction will be granted, notwithstanding an offer of submission by the defendants: *Geary v. Norton*, 1 De G. & Sm. 9; *Tonge v. Ward*, 21 L. T. N. S. 480.

(*b*) *Guinness v. Heap*, Dig. 617; *McLean v. Fleming*, 96 U. S. Rep. 245; *Frese v. Bachof* (1), 13 Bl. C. C. 234; and see *Reid v. Sibbald*, 18 Journ. of Jurisp. 392.

(*c*) *Guinness v. Heap*, Dig. 617.

(*d*) *Weed v. Peterson*, 12 Abb. Pr. N. S. 178.

(*e*) See *infra*, p. 264.

(*f*) 31 Beav. 292.

(*g*) Unless the defendant can prove that he has bought and re-sold the improperly marked goods without being aware of the true

ownership of the trade mark which he is shown to have infringed: *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Moet v. Couston*, 33 Beav. 578.

(*h*) *Neilson v. Betts*, L. R. 5 H. L. 1. See *Leidersdorf v. Flint* (2), 50 Wisc. 401.

(*i*) *Furina v. Silverlock*, 1 K. & J. 509, 6 De G. M. & G. 214, 4 K. & J. 650; *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Apollinaris Co. v. Edwards*, Seton, 4th ed. 237; *Graveley v. Winchester*, *ib.* 257.

(*k*) *Dent v. Turpin*, 2 J. & H. 139; *Upmann v. Elkan*, L. R. 12 Eq. 140, L. R. 7 Ch. 130; *Jurgensen v. Alexander*, 24 How. Pr. 269; R. Cox, 298. In *Meriden Britannia Co. v. Parker*, 39 Conn. 450, 12 Amer. Rep. 401, it was held that goods already stamped might be sold, subject to the remedy at law.

(*l*) *Slazenger & Sons v. Feltham & Co.*, 6 P. R. 531.

Victoria (a) it was held that an agent, who had received from a foreign principal goods marked in imitation of the plaintiff's trade mark, could not be allowed to send back to his principal the goods as they were, since it was the plaintiff's right to have the fraudulent labels removed and destroyed.

While, however, the Court will give protection where it is required, "it must not be forgotten that such protection by injunction when granted is, or may be, attended with loss to the defendant in rendering useless or depreciating in value articles to which the trade mark has already been affixed, and in compelling him otherwise to vary the mode in which he has been carrying on business" (b). And it has been thought that where it is proved that a defendant has adopted a trade mark in *bonâ-fide* ignorance of its infringing the plaintiff's rights, the Court will be satisfied with the least amount of alteration of the defendant's mark which will effectually distinguish it from the plaintiff's (c).

Sufficient distinction must, however, be made; and in the even harder case, where a man has not affixed the spurious mark to his own goods at all, but has bought goods already stamped with a mark which he did not know to belong to any one, he must submit to an injunction, though he may not have to account for profits if he does not delay his submission (d). Where, however, A has, without notice of fraud, advanced money on goods fraudulently marked, he will not be prevented from asserting his rights by reason of the illicit mark (e).

Although there is no jurisdiction in the English Courts

(a) *Siebert v. Lawrence*, 11 Vict. L. R. 47. And in New South Wales it was said that matches packed in boxes fraudulently labelled should be repacked before exposure for sale: *Bryant & May v. Heyde*, 7 N. S. W. Rep. (E.) 72. See *Upmann v. Elkan*, L. R. 7 Ch. 130.

(b) *Cope v. Evans*, L. R. 18 Eq. 138; and see *Liebig's Extract of Meat Co. v. Hanbury*, 17 L. T.

N. S. 298; *Bass v. Dawber*, 19 *ib.* 626; *Ransome v. Graham*, 51 L. J. Ch. 897.

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

(d) *Moet v. Couston*, 33 Beav. 578; *Orr-Ewing v. Choonecloll Mullick*, Cor. 150.

(e) *Ponsardin v. Peto*, 33 Beav. 642. See *Rudderow v. Huntington*, 3 Sand. S. C. 252, R. Cox, 106.

Consideration shown for innocent infringer.

But innocent infringement checked.

Foreign fraudulent samples.

to try a case in which a foreign subject has sent direct to another foreign country, or to a British colony or dependency, goods bearing an infringement of a trade mark used by a British firm in their trade with such country, colony or dependency, yet, if the spurious goods or samples of them have been sold in the United Kingdom, an action will lie (a).

Issue of writ
for service
in Scotland
or Ireland.

In *Marshall v. Marshall* (b) there was an application by a person carrying on business in Scotland for leave to issue and serve out of the jurisdiction (viz. in Scotland) a writ in an action intended to be brought by him against another person carrying on business in Scotland, for selling his goods in England under a trade mark calculated to deceive, the object being that the action might be heard together with an application for registration of the trade mark by the defendant, which was opposed by the plaintiff; but leave was refused, on the ground that it was expedient that proceedings should be taken in Scotland, where the order of the Court could be enforced against the defendant personally, rather than in England, where it could only be enforced against his servants and agents. And similarly in *Kiahaan v. Kinahan* (c), where both parties were Irish. However, in *Burland & Co. v. Broxburn Oil Co., Ltd.* (d), where a similar application was made by an English firm, who were desirous of taking proceedings against a Scotch company, who had their registered office in Glasgow, but had branch offices also in London, Manchester and Hull, and whom the plaintiffs alleged to have been infringing their trade mark by sending out marked goods from their English branches, and the defendants were applying in England to rectify the plaintiffs' registration, it was held that it was possible to effectually enforce in England against the property of the defendants any injunction that might be granted, and that, on the balance of convenience, leave should be given.

(a) *Rodgers & Sons, Ltd. v. Rottgen*, 5 Times L. R. 678.

(b) 38 Ch. D. 330.

(c) 34 Sol. J. 473.

(d) 41 Ch. D. 542.

In asking for his remedy a plaintiff must not make scandalous and impertinent charges against the defendant. Scandal and impertinence. Where such charges were made exceptions for scandal and impertinence were allowed (a), and under the present practice the defendant would succeed on a motion to strike out such statements, under Order XIX., Rule 27.

The appropriate mode of trial of cases in which, as in most trade-mark cases, law and fact are closely united, is by a judge without a jury; and therefore, where a defendant gave notice of trial of a trade-mark case before a judge and special jury, it was held that, notwithstanding the notice, the case must be heard without a jury (b). If the defendant allows the action to proceed to trial without applying for the questions at issue to be submitted to a jury, it will be too late for him to make such an application when the case comes on for trial (c). But where the defendants submitted to a perpetual injunction, leaving only the question of damages to be tried, the action was, on the plaintiffs' application, transferred to the Queen's Bench Division for trial with a jury (d). Trial without a jury appropriate.

It is usual for the plaintiff in trade-mark cases to apply for an interlocutory injunction at an early period. When such an application is to be made, it is the duty of the plaintiff to make it speedily (e), and delay on his part in coming to the Court is liable to be construed as signifying that the case is one which he does not consider to be of an urgent nature, and which therefore does not deserve the special favour of the Court (f). The plaintiff is, however, entitled to delay long enough to secure the necessary Interlocutory injunction.

(a) *Christie v. Christie*, L. R. 8 Ch. 499.

(b) *Spratt's Patent v. Ward & Co.*, 11 Ch. D. 240; *Singer Manufacturing Co. v. Loog* (2), *ib.* 656.

(c) *Thomas v. Williams*, 14 Ch. D. 864.

(d) *Fennessy v. Rabbits & Sons*, 56 L. T. N. S. 138.

(e) Per Romilly, M. R., in *Chubb v. Griffiths*, 35 Beav. 127.

(f) *Pickford v. Grand Junction Railway Co.*, 3 Railway Cas. 538; *Flavel v. Harrison*, 10 Hare, 467; *Isaacson v. Thompson*, 20 W. R. 196; *Mallan v. Davis*, 3 Times L. R. 221; *Evans v. Smith*, *ib.* 390.

evidence to establish his case (*a*); and although no interlocutory injunction is asked for—as, for instance, where it is rendered unnecessary by reason of the defendant having discontinued the acts of which the plaintiff is complaining—the plaintiff is not precluded from his right to a perpetual injunction, if in other respects he has such a right (*b*), nor from his right to state, if true, that the defendant is acting without authority in what he is doing (*c*).

When
granted.

In the older cases (*d*), the tendency of the Court was to refuse to grant an injunction on an interlocutory application, unless the clearest evidence of the plaintiff's right was producible, but rather to send that right to be tested at Common Law. That course of proceeding being now extinct (*e*), some relaxation has taken place, and, in particular, where there is reason to suspect intentional deceit on the part of the defendant, much less absolute proof of the plaintiff's title is required (*f*); and it occasionally happens that after an interlocutory injunction has been granted, it is held at the hearing that the evidence is insufficient to justify any relief being given (*g*). The interlocutory injunction will, however, not be granted where the defendant has innocently infringed, and has withdrawn the offending articles from sale and offered an undertaking

(*a*) *Lee v. Haley*, L. R. 5 Ch. 155; *Cave v. Myers*, Dig. 304.

(*b*) *Collins Co. v. Walker*, 7 W. R. 222.

(*c*) *Anderson v. Liebig's Extract of Meat Co., Ltd.*, 45 L. T. N. S. 757.

(*d*) *E.g.*, *Spottiswoode v. Clarke*, 2 Ph. 154; *Stevens v. Keating*, 2 Ph. 333; *Motley v. Downman*, 3 My. & Cr. 1; *Merrimack Manufacturing Co. v. Garner*, 2 Abb. Pr. 318.

(*e*) Since Sir John Rolt's Act, 25 & 26 Vict. c. 27.

(*f*) *Radde v. Norman*, L. R. 14 Eq. 348. It has been held in America that a defendant, who demurs on the ground that the

two marks are so different as to negative the probability of deception, will be held to admit for the purposes of the demurrer any charges of fraud in the plaintiff's pleadings, and that an injunction will therefore be granted against him: *Enock Morgan's Sons' Co. v. Hunkele*, 16 U. S. Pat. Gaz. 1092. And if a defendant's defence and counter-claim contain any allegations of fact which the plaintiff does not desire to admit, he must deal specially with them: *Benbow v. Low* (2), 13 Ch. D. 553.

(*g*) *E.g.*, in *Degraves v. Whitman*, 5 Vict. L. R. Eq. 304.

immediately on being served with the writ (*a*), nor where there is any considerable conflict (*b*), nor where the plaintiff has been guilty of delay (*c*); and if it is granted the plaintiff will be required to give an undertaking as to damages (*d*).

Where, on the plaintiff moving for an injunction to restrain an alleged infringement of a trade mark registered in 1886, it appeared that the defendant had used the mark since 1884, and was himself then applying for registration thereof, the motion was ordered to stand over generally in order that the question of the defendant's right to registration might be first decided (*e*).

Where an injunction was granted on motion, but the defendant alleged that he had not had sufficient time to answer the affidavits on the other side, Lord Langdale, M. R., directed that the order should be prefaced by a statement to that effect, and giving the defendant leave to move to dissolve the injunction (*f*).

(*a*) *Caruncho v. Highmoor*, 27 Sol. J. 199.

(*b*) *Green v. Rooke*, W. N. 1872, p. 49, L. J. N. of C., 1872, p. 54; *Farina v. Cathery*, L. J. N. of C., 1867, p. 134; *Hennesy v. Rohmann*, 36 L. T. N. S. 51; *Mitchell v. Henry*, 15 Ch. D. 181; *American Grocer Publishing Association v. Grocer Publishing Co.*, 51 How. Pr. 402; *Witthaus v. Braun*, 44 Md. 303; *Leclanche Battery Co. v. Western Electric Co.*, 21 Fed. Rep. 538; *Goodyear Rubber Co. v. Day*, 22 Fed. Rep. 44; and other cases. If an interlocutory injunction is asked for on the ground that the defendant claims a right to use the plaintiff's trade mark, but there is evidence that he is not in fact using the mark or threatening an immediate exercise of his alleged right of user, the motion will be ordered to stand to the hearing, as in *Linoleum Manufacturing Co. v. Nairn*, Dig. 536, or refused, with

costs, as in *Davis v. Tylor*, M. R., July 27th, 1877 ("*Ferndale*" coal).

(*c*) *Isaacson v. Thompson*, 41 L. J. Ch. 101; *Chinn v. Thomas*, 5 Vict. L. R. Eq. 188. In the Scotch case of *Green v. Shepherd*, Ct. of Sess. Cas., 3rd Ser., IV. 1028, the plaintiff having by his summons asked for damages and an interdict, the Court refused a motion for an interim interdict, on the ground that the summons was framed on the footing that there was no case for an interim interdict, and that the plaintiff must first establish his right by recovering damages.

(*d*) In *Actien Gesellschaft Apollinaris Brunnen v. Somborn*, 14 Bl. C. C. 380, an American case, a bond was given to secure the possible damages.

(*e*) *Edwards v. Elkan*, 5 P. R. 70.

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

Submission
not relieved
against.

In *Elsas v. Williams* (a) the defendant having consented, on the hearing of a motion for injunction, to submit to a perpetual injunction to restrain him from infringing a trade mark for buttons, a subsequent application by him, before the order was drawn up, to be relieved from his consent, on the ground that his German manufacturers had sold buttons bearing the mark in England before the plaintiff had done so, was refused, on the ground that there had not been such a mistake as to entitle the defendant to be relieved.

Stay of pro-
ceedings after
submission.

Where an action was brought to restrain the use of the word "Diamond" and a diamond-shaped device, and the defendant consented, on motion, to a perpetual injunction as to the word, and subsequently, after the plaintiff had delivered his statement of claim, to a perpetual injunction as to the device, and the plaintiff waived damages or an account, it was ordered, on the defendant's motion, that, the defendant submitting and paying costs, further proceedings should be stayed, except for the purpose of enforcing the order (b).

Form of
injunction.

The injunction may be granted in such a form as to restrain the imitation of the general style of the plaintiff's mark, while not interfering with the use of particular features (c), or, if granted so as to restrain the use of particular features, it may be limited so as not to interfere with the use of them absolutely and in all events (d); or, again, it may be granted in such terms as to restrain any imitation of a composite mark as a whole, or of any of the elements of which it is composed (e).

(a) 54 L. J. Ch. 336.

(b) *Curtis & Harvey v. Pape*, 5 P. R. 146.

(c) *Compagnie Laferme v. Hendrickx*, Dig. 512; *Wolfe v. Hart*, 4 Vict. L. R. Eq. 125; *Wolfe v. Alsop* (2), 12 Vict. L. R. (E.) 421.

(d) *Ford v. Foster*, L. R. 7 Ch. 611; *Braham v. Beachim* (1), 7 Ch. D. 848; *Siegert v. Findlater*,

7 Ch. D. 801; *Massam v. Thorley's Cattle Food Co.*, 14 Ch. D. 748; *Dence v. Mason* (1), Dig. 534; *Wheeler v. Johnston*, 3 L. R. Ir. 284; *Whitstable (Free Fishers & Dredgers of) v. Elliott*, W. N. 1888, p. 27; *Hill v. Lockwood*, 32 Fed. Rep. 389.

(e) See *India Rubber Comb Co. v. Rubber Comb and Jewelry Co.*, 45 N. Y. Super. Ct. 258.

In the case of an appeal delay is no less fatal than in Appeal. the proceedings in the Court below (*a*); but no appeal ought to be brought from a refusal to grant an interlocutory injunction if the defendant, while refusing to submit to an injunction or to give an undertaking, removes the cause of complaint (*b*). Where an injunction had been granted to restrain the sale by the defendant of "The Original Lazenby's Harvey's Sauce," an appeal against the decision was ordered to be advanced, on the ground of the irreparable damage the continuance of the injunction would occasion (*c*). It seems that when the Court of Appeal has overruled a demurrer or objection on a point of law, it will not stay the further hearing of the case with the evidence until after an appeal to the House of Lords from this decision on the point of law is decided (*d*).

Where a defendant in a trade-mark action continues to use the prohibited mark, or a mark insufficiently altered from it (*e*), after an injunction has been issued against him, he renders himself liable to committal (*f*). In order to support the motion to commit, "it should appear clearly that the ordinary mass of customers, paying that attention which persons usually do in buying the article in question,

(*a*) See per Knight-Bruce, L. J., in *Burgess v. Burgess*, 3 De G. M. & G. 896.

(*b*) *Dale v. Smith*, W. N. 1882, p. 145.

(*c*) *Lazenby v. White*, L. R. 6 Ch. 89.

(*d*) See *In re Palmer* (2), 22 Ch. D. 88. In that case the question was with reference to an application to strike a mark off the register.

(*e*) *Devlin v. Devlin*, 69 N. Y. 212.

(*f*) *Rodgers v. Nowill*, 3 De G. M. & G. 614; *Gillis v. Hall*, R. Cox, 596. On August 8th, 1877, V.-C. Malins made an order to commit the defendant in *Dence v. Mason* (Dig. 534), who had, notwithstanding the injunction, continued

to sell goods and issue labels using the name "Brand" thus—"Frank Mason & Co.'s ('Brand's') Essence of Beef," and so on. He was discharged on December 18th, on undertaking not to use the name "Brand" until the hearing of the action (Dig. 570). In *Devlin v. Devlin*, 69 N. Y. 212, the Supreme Court of New York imposed a fine. In *U. S. v. Roche*, 1 M'Crary, 385, it was held that the declaration that the U. S. Statute of 1870 was invalid did not affect the validity of an injunction granted independently of the Act, and that an attachment must issue against a defendant who had committed breaches of the injunction.

would be easily deceived" (a). It was said by Lord Langdale, M. R., in *Croft v. Day* (b), that "if the defendants were willing to make a proper distinction, and the plaintiffs refused to attend to their proposal, the Court would itself determine whether the proposed distinction was sufficient." If the defendant sets up acquiescence on the part of the plaintiff, he must make out a case amounting almost to such a licence as to entitle him to proceed against other infringers—such acquiescence, in fact, as to create a new right in him; and in default of such a licence, the order for committal will be made, unless the defendant satisfies the Court of his intention to use a trade mark which will not interfere with the plaintiff's rights (c). Where the contempt committed has not been gross, it is usual not to make an actual order for committal, but only to order the person in contempt to pay the costs of the motion for committal: e.g., where an auctioneer, in contempt of an injunction, offered for sale "Vanity Fair" cigarettes, supposing the notice of motion served on him not to be properly authenticated, but did not actually effect any sale, V.-C. Malins made no order for committal, on his apologising, submitting to the injunction, and paying all the costs (d). But a defendant can only be ordered to pay the costs of a motion for committal, if his conduct has been such that a committal might

(a) *Swift v. Dey*, 27 N. Y. Super. Ct. 611, R. Cox, 319-24; and see per Lord Langdale, M. R., in *Croft v. Day*, 28 Leg. Obs. 378. In *Braham v. Brachim* (1), 7 Ch. D. 848, an injunction was granted to restrain the defendants from calling themselves "The Radstock Colliery Proprietors," or saying that they were the proprietors of collieries at Radstock; and it was afterwards held (*Braham v. Beachim* (2), Dig. 633) that the defendants had committed no breach of the injunction by styling themselves "The Radstock Coal and Waggon Co., Colliery

Proprietors, Radstock, Somerset." In *Dence v. Brand*, W. N. 1881, p. 31, it was held that the defendant had not committed a breach of an injunction restraining him from representing that he was the original inventor of essence of beef by stating that he was the original manufacturer of that article.

(b) 28 Leg. Obs. 378.

(c) *Rodgers v. Nowill*, 3 De G. M. & G. 614.

(d) *Marcovitch v. Bramble, Wilkins & Co.*, Dig. 595.

have been ordered (a). Where an injunction had been granted to restrain the infringement of a mark on cotton, in which a conspicuous feature consisted of a cross, from which the cotton had become known as "Cross Cotton," and the defendant adopted an altered label, containing the words "Cross Cotton," and otherwise calculated to deceive, Wood, V.-C., refused to order a committal, on the ground that the defendant had ingeniously avoided committing a breach of the injunction, and that the plaintiff had delayed to enforce his right for fifteen months; but he enlarged the terms of the injunction so as to effectually put a stop to the new fraud, and ordered the defendant to pay all the costs (b). Sometimes an application is made to commit the editor or publisher of a newspaper on the ground that he has published something prejudicial to the fair trial of a pending action for infringement; but such a motion in *Singer Manufacturing Co. v. Loog* (c), based on a newspaper paragraph stating that further proceedings would be taken on the conclusion of the action, was refused, on the ground that the paragraph would have no influence on the trial of the action.

An action to restrain the infringement of a trade mark Revivor. is an action to protect property, and if the plaintiff dies, his representatives are entitled to continue it (d). On the other hand, when an injunction had been granted, without opposition by the defendant, the Superior Court of New York refused a motion by the defendant's administratrix to have the action continued against her, on the ground that it was not shown that the defendant had acquired any rights in the litigation, or that his estate would be prejudiced by the action not being continued (e).

It has sometimes happened that more marks than one Where two marks used. have been used by a person on his goods, the infringe-

(a) *Dence v. Brand*, W. N. 1881, p. 31.

(b) *Cartier v. May*, Dig. 200.

(c) Dig. 635.

(d) *Oakey & Sons v. Dalton*, 35 Ch. D. 700.

(e) *Republic of Peru v. Reeves*, 40 N. Y. Super. Ct. 316.

ment of either of which would be visited by the Court with the penalties at its command. Thus, where A's soft soap was denoted, not only by a specific device, but also by the name "Excelsior," it was held that the infringement of the latter alone was punishable by the Court, the Vice-Chancellor remarking that he could not hold it to be any justification for a defendant to say that the plaintiff had two ways of identifying the goods, and he (the defendant) had only stolen one (a). And so in *Wheeler v. Johnston* (b), the V.-C. of Ireland said that "a man may have two, or three, or more trade marks, which he may put on his goods as he likes." But where it was shown that the goods to which a certain mark was affixed were known by a distinct name, and not by the mark, and the mark was not commonly used by the plaintiff before bill filed, the injunction was refused (c).

Name used
with trade
mark.

Moreover, the habitual use of his own name in combination with his verbal trade mark by the manufacturer of the "Eureka" shirts was held not to disentitle him to relief against defendants who had made use of the word "Eureka," though in combination with the name of their own firm (d). But where the name is the only distinctive part of the mark, and that is not taken, no injunction will be granted in respect of the use by the defendant of a non-distinctive part of the mark. There has, in fact, been no infringement (e).

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

(b) 3 L. R. Ir. 284.

(c) *Wilson v. Marfield*, L. J. N. of C. 1875, p. 51. This was before the Trade Marks Registration Act, 1875, was passed.

(d) *Ford v. Foster*, L. R. 7 Ch. 611. So in *Reinhardt v. Spalding*, 49 L. J. Ch. 57; and *Hoby v. Grosvenor Library Co.*, 28 W. R. 386.

(e) *E.g.*, it was held in Scotland that the fact that one firm called their goods "Wotherspoon's Victoria Lozenges," could not pre-

vent another firm from styling theirs "Gray's Victoria Lozenges": *Wotherspoon v. Gray*, Ct. Sess. Cas., 3rd Ser., II. 38. So in the United States Patent Office, it was held that the use of the words "Pfeiffer's Egg Macaroni," before the United States Act of 1870, did not entitle the applicants to sever the mark and register the descriptive words "Egg Macaroni" alone, without the name, as having been a lawful trade mark at that time: *In re Dole Brothers*, 12 U. S. Pat. Gaz. 939.

Where, however, a manufacturing company affixed their special device to their machines, and also their name, the Master of the Rolls and Court of Appeal declined to restrain another company who manufactured similar goods bearing their own mark and name, but did not affix to them the plaintiffs' name, from using the plaintiffs' name as descriptive of the principle on which the machines were constructed (a); and this part of the decision was not disapproved by the House of Lords when they remitted to the Court below the question whether the name was in fact descriptive of the principle of the machines, which was afterwards decided against the plaintiffs in *Singer Manufacturing Co. v. Loog* (b). *Singer Manufacturing Co. v. Wilson.*

Courts of Equity have sometimes had to decide somewhat nice questions as to who should be recognised as having a right to protection in equity in respect of a trade mark, such questions being usually raised by the right of the plaintiff in an action to restrain infringement being contested. Questions of title to trade marks.

In *Motley v. Downman* (c), Lord Cottenham, C., was of opinion that a trade mark habitually applied to the iron manufactured at certain works could not be sold with the business by the tenants of the works, so as to give the purchasers an exclusive right as against the landlord of the works, or as against tenants of the works who had leased them after the purchasers of the business and trade mark had removed from those works and gone elsewhere. Between landlord and tenant of iron works.

In another case (d) A, having for some time leased certain brick works, and also certain mines, from which fire-clay was taken for manufacture at the works, removed his business elsewhere, whereupon B commenced business Successive lessees of brick works.

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

(b) 8 App. Cas. 15.

(c) 3 My. & Cr. 1. See *Dickson v. McMaster & Co.*, 18 Ir. Jur. 202; *Atlantic Milling Co. v. Robinson*, 20 Fed. Rep. 217.

(d) *Harper v. Pearson*, 3 L. T. N. S. 547. And see *Carmichel v. Latimer*, 11 R. I. 395, and *Armstrong v. Kleinhaus*, 1 Ky. L. Rep. 112; 82 Ky. 303.

at the brick works in question, but did not lease the same mines. A having filed a bill against B, as fraudulently representing (in effect) that the latter had succeeded to his business, Vice-Chancellor Wood, in the course of his judgment in favour of the plaintiff, took occasion to intimate that it would have been almost a matter of course to have granted an injunction to the owner of the mines of fire-clay used by A but not by B, if he had made application for it. This was, indeed, rather a case of fraudulent misrepresentation than of trade mark.

Owner and lessee of a spring.

If A is the owner of a natural spring, and B is the concessionnaire for a term of years, it seems that the name of the spring is the property of A, even though it was given to the spring by B, and that B is not entitled to sell water from another spring under the same name (*a*), nor, if his concession is limited to sales in specified countries, to interfere with the sale in those countries, under the name of the spring, of genuine water from the spring, though not imported by him (*b*).

Manufacturer and printer of cotton goods.

Where manufacturers of cotton cloths, which were afterwards printed elsewhere, sought to restrain other manufacturers who made and printed similar cloths, and marked them similarly to the goods made by the plaintiffs, it was held that the marks on the plaintiffs' goods were indicative of the printer and not of the manufacturer (*c*). And in *Wamsutta Mills v. Allen* (*d*) it was held that muslin manufacturers were entitled to restrain the use of a colourable imitation of their mark on shirts made from inferior muslin, which might, from the mark, have been identified with their manufacture.

Principal and agent.

Where a London tradesman, who dealt in goods supplied

(*a*) *Hill v. Lockwood*, 32 Fed. Rep. 389.

(*b*) *Apollinaris Co., Ltd. v. Scherer*, 23 Bl. C. C. 459.

(*c*) *Amoskeag Manufacturing Co. v. Garner*, 55 Barb. 151, R. Cox, 541; and see *In re Sykes*, 43 L. T.

N. S. 626. But see *Amoskeag Manufacturing Co. v. Garner* (2), 54 How. Pr. 298. And compare *Goodfellow v. Prince*, 35 Ch. D. 9, as to the difference between manufacturer and importer.

(*d*) 12 Phila. 535.

to him by a foreign manufacturer, had invented a trade mark for those goods which stated the name of the foreign manufacturer, but made no reference to the London vendor, it was held by the Master of the Rolls that the latter could not restrain the use of the mark by a subsequent consignee of the same goods, though if the trade mark had referred to the goods having been of his selection, the case might have been different (*a*).

In another case (*b*), a combination mark, which was used on cotton goods manufactured by Ward, and consigned through Robinson, the exporting agent, to Galbraith, the merchant, at Rangoon, consisted of five separate stamps or labels, of which three had been used separately by Robinson, one (in a slightly different form) by Robinson and Galbraith, and the remaining one was used for the first time by the three on the goods which passed through the course of dealing above stated; and it was held on appeal that neither Ward nor Robinson had such an exclusive right to the combination as to be entitled to restrain the other from using it. And there are other cases in which both parties have been held to be entitled by long user to use the same mark (*c*); but for this to be so the user must have been substantial (*d*).

A question of a somewhat similar character arose in *In re Jones* (*e*). In that case cotton goods were habitually exported by Jones of Manchester to Manilla, for sale there on commission, through Andrews & Co., of Manchester and Manilla, one of the partners in which firm, named Rotschke, was resident at Manilla; and two trade marks

(*a*) *Hirsch v. Jonas*, 3 Ch. D. 584. See *Dence v. Mason* (1), Dig. 534; *Swift v. Peters*, 11 U. S. Pat. Gaz. 1110; *McLean v. Fleming*, 96 U. S. Rep. 245; *Thomson & Co. v. Robertson*, Ct. Sess. Cas, 4th Ser. XV. 880.

(*b*) *Robinson v. Finlay*, 9 Ch. D. 487. In this case, Bacon, V.-C., had held that the mark belonged to the exporter, and it seems that this may be so in a proper case.

In *Godillot v. Hazard*, 81 N. Y. 263, the importer was recognised as the proprietor of the mark.

(*c*) *Day v. Neale*, V. C. B., May 24th, 1881; *Benbow v. Low* (4), 44 L. T. N. S. 875; and other cases cited at p. 188, note (*h*).

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

(*e*) 53 L. T. N. S. 1.

were designed and used for the goods which passed through this course of trade. Each of the marks contained a representation of Andrews & Co.'s house of business in Manilla, and, besides this, one of the marks had the name "Andrews & Co.," and the other had that name and also the name "Robert Jones of Manchester" and Rotschke's crest, with a statement that it was Rotschke's trade mark. It was held by Chitty, J., and the Court of Appeal that there was no contract that, after the joint adventure came to an end, either party was to be entitled, as against the other, to use or register the trade marks, and that if there had been such a contract it could not have been enforced, since, having regard to the composition of the marks, the result would be to deceive the public.

Manufacturer
and mer-
chant.

The construction of an agreement between two parties with respect to a mark on brandy had to be determined by the Court in *In re Rivière (a)*, in which it was held by Pearson, J., and the Court of Appeal that the true purport of the arrangement was that the mark in question, which had been used and registered by Rivière & Co., the French manufacturers, in France, before it was adopted by McDowell & Co., wine and spirit merchants, in Madras, was to be used exclusively by McDowell & Co. so long only as they took their brandy from Rivière & Co., and was only to be used by them on such brandy; and that on McDowell & Co. ceasing to take their brandy from Rivière & Co. the original right of the latter to the mark was to revive.

Shipper and
shipowner.

In *Winsor v. Clyde (b)*, it was held that a firm who had carried on business as shippers of merchandise by ships which they did not own, but of which they had the entire management while loading and unloading, &c., and who had denominated each line of vessels used by them and plying in a particular direction by the name

(a) 53 L. T. N. S. 237. See
Lavergne v. Hooper, Ind. L. R. 8
Mad. 149.

(b) 9 Phila. 513.

of "The Keystone Line for ———," had acquired a right of property in the name, and were entitled to restrain the use of the name by another firm who owned the ships employed by the former firm for a certain period on one of their lines, after the termination of the connection, the latter firm having had at best a revocable licence to use the name.

A different point occurred in another case (a), in which, after the plaintiff company had for some two years been selling cigars of their own manufacture marked with the name "Grand Master," and paying all the expenses of the manufacture and marking, a member of the company, who was also their superintendent, registered the mark as his own, and sought to justify himself by alleging that he had invented the name, selected the tobacco for the brand of cigars, devised the shape for them, made the first ones himself, and personally affixed the first labels to the boxes; but it was held that in all these matters he had been simply acting as the servant of the company, and that the mark belonged to them.

Master and
servant.

Again, in *Cotton v. Gillard* (b), it was decided by the Master of the Rolls that a man had no right to use a trade mark applied to a sauce with the composition of which he was unacquainted, even though he had, as he believed, bought that right from the person entitled to the same; it followed that he could not prevent its use by the person acquainted with the secret, of which he had in fact been the inventor. But it has been held in America (c) that a person who has been accustomed to manufacture for another, in accordance with the latter's instructions, may receive an assignment of the trade mark which has been habitually used on the goods so

(a) *Yale Cigar Manufacturing Co. v. Yale*, 30 U. S. Pat. Gaz. 1183.

(b) 44 L. J. Ch. 90. Compare *Coffeen v. Brunton*, 5 McLean, 256,

R. Cox, 132; *Taylor v. Bemis*, 4 Biss. 406.

(c) *Witthaus v. Braun*, 44 Md. 303. See *Helmbold v. Helmbold Manufacturing Co.*, 53 How. Pr. 453.

manufactured. And it seems that where an article known by a particular name or mark has been manufactured by partners, of whom one has been acquainted with the secret of the process and the other not, the former cannot, after the dissolution of the partnership, restrain the other from using the name or mark, for the right therein of the one partner is equal to that of the other (a).

Registered
trade marks.

With respect to registered trade marks, such difficulties can seldom arise in the future, since it is the registered proprietor who has, *primâ facie*, the exclusive right to the mark, and after five years has that right conclusively (b), subject only to the possibility of a rectification of the register (c). It is, therefore, of great importance that the registration should be effected in a form which will recognise all existing rights. Thus, in *Ex parte Hemming & Son* (d), in which recent occupiers of a needle mill were registering the name of the mill as their trade mark, a note was appended to the entry on the register, stating that the registered proprietors did not claim the exclusive right to the use of the name so as to prevent the owner or occupier for the time being from using the name for any legitimate purpose.

More than one
proprietor.

It occasionally happens that a trade mark becomes vested in more than one person. The question then arises whether either of these is entitled to succeed in a suit against an infringer, to which the other person entitled is not a

(a) *Weston v. Ketcham* (1) and (2), 39 N. Y. Super. Ct. 54; 51 How. Pr. 455; and see *Manhattan Medicine Co. v. Wood*, 108 U. S. Rep. 218.

(b) Patents Act, 1883, § 76. In the Scotch case of *Dunnachie v. Young & Sons*, Ct. Sess. Cas. 4th ser. X. 874, the name "Glenboig" was used and registered by two companies trading as brickmakers on the Glenboig estate for the bricks made there, and a third firm carrying on the same business in the neighbourhood of the Glenboig

estate began to use the name, alleging that it was descriptive of all bricks made of the seam of clay which ran through the Glenboig estate, and which they alleged that they were working. The Court of Session, however, decided against this contention, and granted an interdict at the suit of the two companies. See also *Montgomerie v. Donald & Co.*, Ct. Sess. Cas., 4th Ser., XI. 506.

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

(d) M. R., April 27th, 1881.

party. In a case of this description, Shadwell, V.-C., gave it as his opinion, that whether the plaintiff had the right in himself, or jointly with some other persons, he still had sufficient right to bring forward the case (a). In *Dent v. Turpin* (b), Wood, V.-C., decided in accordance with this view, saying that the plaintiff had a clear right to an injunction and the erasure of the spurious marks, without making the other person interested a party, while as to the account, only the plaintiff's share having been prayed for, that, though it might be difficult to ascertain, was yet ascertainable. In any case, the wrong-doer had no right to complain of any technical difficulty arising from his own wrongful act, though the result was to involve him in two suits instead of one. In *Southorn v. Reynolds* (c) he decided in the same way, saying that his previous decision had not been interfered with (d). So, in the Scotch case of *Dunnachie v. Young & Sons* (e), the name "Glenboig" was used and registered as the trade mark of one company, and as part of the trade mark of another company, and an interdict was granted in an action in which the two companies were co-plaintiffs, to restrain the use of the name by a third company.

It seems that where the use of a trade mark is improperly secured for himself by one member of a partnership, he being bound to obtain it for the partnership, he will be held to be a trustee of it for the benefit of the partnership (f).

Partnership
trade mark.

In *Delondre v. Shaw* (g) it was held that, inasmuch as

Delondre v. Shaw.

(a) *Hine v. Lart*, 10 Jur. 106. See *Pratt's Appeal*, 117 Penn. St. 401.

(b) 2 J. & H. 139.

(c) 12 L. T. N. S. 75.

(d) And see *Leather Cloth Co. v. American Leather Cloth Co.*, 1 H. & M. 271; and *Newman v. Alvord*, 49 Barb. 588; *R. Cox*, 404; 51 Y. N. 189; and consider *Robinson v. Finlay*, 9 Ch. D. 487.

(e) Ct. Sess. Cas., 4th ser. X. 874.

(f) *Weston v. Ketcham* (1), 39 N. Y. Super. Ct. 54; and see *Ex parte Lawrence Bros.*, 44 L. T. N. S. 98; *In re Rust & Co.*, *ib.* 98; and *In re Farina* (4), *ib.* 99.

(g) 2 Sim. 237; and see *Page v. Townsend*, 5 Sim. 395.

one of the plaintiffs had no interest in the account (a), he was improperly joined as a co-plaintiff, the Court thus treating the injunction as ancillary to the account. In *Farina v. Silverlock* (b) the same question was raised, but without success, and no such objection would prevail at the present day (c).

Prize
medallist.

In *Batty v. Hill* (d), an attempt was made by a prize medallist at the Exhibition of 1862 to restrain the use by the defendant, who had not been awarded a medal, of a label which had been prepared before the award, bearing the words "Prize Medal, 1862." The Vice-Chancellor was, however, of opinion that he could not interfere merely on the ground of a misrepresentation, and that the plaintiff was not entitled to claim the label as a trade mark for various reasons, among which was the fact that whatever rights the plaintiff could have must be shared with all those who had been awarded medals (e).

Infringement
by servants.

The person sought to be enjoined in a trade-mark case is commonly a rival manufacturer, who is using the spurious mark to promote the sale of his own commodities. The

(a) It should be observed that the reason given by Mr. Bickersteth (afterwards Lord Langdale and M. R.), who argued the case, for the joinder of Pelletier as a co-plaintiff, was that, though having no interest in the medicine, he yet was entitled to prevent his name being used. It is further to be observed, that the subsequent decision of Lord Langdale, in *Clark v. Freeman*, 11 Beav. 112, does not conflict with the position taken up by him in *Delondre v. Sham*, since Pelletier not only manufactured the medicine, but supplied it to Delondre, so that he had a pecuniary interest in the maintenance of his reputation. *Clark v. Freeman* was decided on the point that the plaintiff did not manufacture or sell pills.

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

(c) In *Millington v. Fox*, 3 My. & Cr. 338, the account was waived; and see *McAndrew v. Bassett*, 4 De G. J. & S. 380; *Leather Cloth Co. v. American Leather Cloth Co.*, *ib.* 137; *Barnett v. Leuchars*, 13 L. T. N. S. 495; *Symonds v. Greene*, 28 Fed. Rep. 834; and many other cases. In fact, this is a common incident.

(d) 1 H. & M. 264.

(e) See Exhibition Medals Act, 1863 (26 & 27 Vict. c. 119); also *Taylor v. Gillies*, 59 N. Y. 331; and *Roper's, &c., Co. v. Copeman's, &c., Association, Ltd.*, 28 Sol. J. 218. But representations of prize medals have been registered as parts of old combination marks, both in England (see *In re Brook*, 26 W. R. 791, and *In re Farina* (2), 27 W. R. 456) and in America (see *In re Bush & Co.*, 10 U. S. Pat. Gaz. 164).

fact that the fraud has been committed by a servant of the trader makes no difference, for principals "are bound to know what their agents do, and if they do not know, they are responsible exactly as if they did know." Hence, where a defendant's manager had affixed to his master's goods, without the knowledge of the latter, as he alleged, a ticket infringing the rights of the plaintiff, an injunction was granted against the master, with costs (a). And, similarly, where a clerk had sold goods in a spurious wrapper, with a verbal representation that the goods and wrapper were genuine (b). But this does not relieve servants or agents from their personal responsibility (c).

And English agents of foreign traders will be restrained Agents. from selling goods received from their principals falsely marked, to the injury of other manufacturers (d). And similarly in America with American agents of foreign manufacturers (e), and in the colonies (f). So, too, commission merchants, selling with the knowledge that the goods they sell are so marked as to deceive (g).

The remedy will, however, not only be awarded against Engravers such persons as are to profit directly by the perpetration of a fraud, but also against all who connect themselves with and assist in the same. Thus, persons who engrave or print a trade mark for one not entitled to use it may be restrained.

In *Guinness v. Ullmer* (h), where the defendants had Guinness v. Ullmer. supplied to one Taylor blocks engraved with the main part of the plaintiffs' trade mark, including their names, from which blocks Taylor had printed labels similar to the

(a) *Tonge v. Ward*, 21 L. T. N. S. 480; and see *Tweentsche Stoom Bleekery Goor v. Ellinger & Co.*, 26 W. R. 70; *Atkinson v. Atkinson*, 85 L. T. (Journal) 229.

(b) *Low v. Hart*, 90 N. Y. 457.

(c) *Sawyer v. Kellogg*, 7 Fed. Rep. 721; 9 *ib.* 601; *Estes v. Worthington* (2), 30 Fed. Rep. 465.

(d) *Farina v. Cathery*, L. J. N.

of C., 1867, p. 134; *Siegert v. Findlater*, 7 Ch. D. 801; and see *Siegert v. Ehlers*, Dig. 432.

(e) *Roberts v. Sheldon*, 8 Biss. 398; *Carbolic Soap Co. v. Thompson*, 25 Fed. Rep. 625.

(f) *Siegert v. Lawrence*, 11 Vict. L. R. 47.

(g) *Coats v. Holbrook*, 2 Sandf. 586, R. Cox, 20.

(h) 10 L. T. (Old Series), 127.

plaintiffs', the Vice-Chancellor of England, Sir L. Shadwell, was of opinion that, as the matter complained of could not have happened without the prints which had been made from the blocks, the defendants had made themselves ancillary to the piracy, and he accordingly granted the injunction. It had been contended for the defendants that it was with a part only of the plaintiffs' mark that they had been concerned; but the Vice-Chancellor thought that if a thing contained twenty-five parts, and one only was taken, such an imitation would be sufficient to contribute to a deception, and that the law would hold those responsible who had contributed to the fraud. In *Farina v. Shaw* (a), and *Farina v. Silverlock* (b), injunctions were granted to restrain the printing of labels similar to those used by the plaintiff. In the latter case, on appeal (c), Lord Cranworth, C., dissolved the injunction, and sent the right to be tried at law (d); but this can no longer be done (e).

Spurious goods in innocent hands.

A different combination of circumstances arises when the goods improperly marked are in the charge of an innocent third party, for purposes of conveyance, storage, or the like. In such a case, although that person be merely a carrier receiving goods, which, though fraudulently marked, are not for his own use, nor to be sold by him for his own benefit, but have been received by him merely for the purposes of transmission to the persons to whom they are consigned, yet an injunction will issue to restrain him from parting with the goods spuriously marked (f). "It is the duty of the person in charge of the marked goods at once to give all the information required, and to undertake that the goods shall

(a) Decided by V.-C. Parker, and referred to in *Farina v. Silverlock*, 1 K. & J. 509-12. See 3 Eq. Rep. 886-90.

(b) 1 K. & J. 509.

(c) 6 De G. M. & G. 214.

(d) Where the plaintiff obtained

a verdict. See 4 K. & J. 650.

(e) 25 & 26 Vict. c. 27.

(f) *Upmann v. Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. 130; and see *Rivero v. Norris*, Seton, 4th ed. 236; *Del Valle v. Mayer*, *ib.*; *Moet v. Pickering*, 8 Ch. D. 372.

not be removed or dealt with, unless the spurious brand has been removed, and to offer to give all facilities to the person injured for that purpose." He should also, on discovering the fraud, at once inform his correspondent abroad (a). If, on the other hand, the carrier declines to give information required by the injured party for the purpose of an action against the author of the fraud, even after the marked goods have passed out of his control, the person injured is entitled to succeed in an action brought against him to compel discovery (b). Supposing the carrier, &c., to give the required information and undertaking, and to seek to facilitate the proceedings, then, "if after that the person injured files a bill, though he will be entitled to all that he seeks in the shape of relief, as he might have got it all without suit, he will not get from the defendants the costs of the suit, and he may have to pay them (c). On the fact of the fraudulent mark being discovered, it is no redress for the carrier, &c., to send back the goods, or to offer to do so, for that would only put it in the power of the consignor to repeat his fraud; but if the carrier, &c., offers as an alternative to erase the mark, he has done all he can be reasonably required to do" (d).

Where wines bearing a spurious trade mark were in the custody of a dock company, and an innocent third party had advanced money on the security of the wines, it was ordered by Romilly, M. R., that the wines should be delivered to the mortgagee, on the spurious brands being removed and destroyed (e). Innocent mortgagee.

(a) Per Romilly, M. R., and Lord Hatherley, C., in *Upmann v. Elkan*, L. R. 12 Eq. 140, and L. R. 7 Ch. 130.

(b) *Orr v. Diaper*, 4 Ch. D. 92.

(c) *Upmann v. Elkan*, L. R. 12 Eq. 140. See *Moet v. Pickering*, 8 Ch. D. 372; *Upmann v. Forester*, 24 Ch. D. 231; *Upmann v. Currey*, 29 Sol. J. 735.

(d) Per Lord Hatherley, C., in *Upmann v. Elkan*, L. R. 7 Ch. 130. See also *Siegert v. Lawrence*, 11 Vict. L. R. 47, in Victoria, and *Bryant & May v. Heyde*, 7 N. S. W. Rep. (E.) 72, in New South Wales.

(e) *Ponsardin v. Peto*, 33 Beav. 642.

Wharfingers' lien.

In *Moet v. Pickering* (a) wharfingers were in possession of wines spuriously branded, but they had no knowledge that the brand was spurious, and they offered to act with respect to the wine as the Court should direct, upon having their charges and costs paid or provided for. The Court of Appeal held that they were entitled to a lien on the wine for their charges, and that, even if the plaintiffs in the action for infringement were entitled to any lien on the wine for their costs, which was doubted, that lien must at all events be postponed to that of the wharfingers; and the Court also held that the latter had not done anything to disentitle them to their costs, which must be paid in both Courts by the plaintiffs.

Warehousemen.

In *Hunt v. Maniere* (b), where warehousemen, at the request of the owners of a certain brand on wines, refused to deliver (c) to the indorsee of the dock warrants wines improperly marked with that brand, Romilly, M. R., restrained the indorsee from proceeding with an action at law against the warehousemen for their refusal. The jurisdiction of the old Court of Chancery to restrain actions at law is now gone, but the warehousemen would have a good defence in the Common Law Divisions to an action there commenced (d).

Questions of contract.

In exercising its jurisdiction to restrain breach and enforce specific performance of contract, the Court has sometimes had to deal with questions of trade mark, or akin thereto. Thus, where an injunction was granted to restrain the use of a man's name (e) otherwise than in accordance with a contract into which he had entered, or of

(a) 6 Ch. D. 770; 8 *ib.* 372.

(b) 34 Beav. 157.

(c) On the same day, but subsequently, an injunction was granted to restrain them from doing so.

(d) Judicature Act, 1873, § 24.

(e) *Ainsworth v. Bentley*, 14 W. R. 630; *Ward v. Beeton*, L. R. 19 Eq. 207; *Probasco v. Bouyon*, 1 Mo. App. 241; *Gage v. Canada Publishing Co.*, 11 Can. Sup. Ct. 306; *Frazer v. Frazer Lubricator*

Co., 121 Ill. 147; *Brewer v. Lamar*, 69 Ga. 656, where, in the sale of the goodwill of the business of "Brewer's Lung Restorer," the vendor agreed not to use his name on any preparation for the same purpose, and he was restrained from selling a preparation as "Brewer's Sarsaparilla Syrup," and it was held that such a contract did not involve any restraint of trade.

an initial (a), or of the name of a business (b), or of a singer's voice (c), or of a publication (d).

Where, among other symbols, the arms, crest, and motto (the latter being the word "Excelsior") of one of the partners were used as trade marks of a partnership, and on dissolution of the partnership it was agreed that the other partner might use all the trade marks of the firm's except such private arms, crest, and motto, it was held that no breach of the agreement had been committed by the continuing partner in using the word "Excelsior," apart from the arms and crest, on some of his goods, since it had been so used alone previously as a trade mark, and it was not then used as a motto, but as a trade mark (e). *Steinthal v. Samson.*

Where, on a dissolution of partnership, it was agreed that neither partners should continue to use the firm's trade mark, which consisted of the letters "P. & O." within a scroll bearing an inscription, one of the members of the late firm was restrained from using a mark very similar to the old mark, the only practical difference being that the letters "P. S. & Co." were substituted for "P. & O." (f). And in a case of the same character, where, on a dissolution of partnership, one of the partners had assigned to the other his interest in the firm's stock of labels, which contained his name, and the other had covenanted not to print any more, except in a form expressive of the change in the firm, the latter was not allowed to register the old labels in Victoria, without alteration (g). *Other cases.*

Where a tobacco manufacturer agreed to pay a royalty *Name of cigarettes.*

(a) *Tudor v. Tudor*, W. N. 1873, p. 72; *Fullwood v. Fullwood*, 9 Ch. D. 176.

(b) *Hagg v. Darley*, 47 L. J. Ch. 567 ("Old Government Sanitary Company"); and see *McGowan Brothers' Pump & Machine Co. v. McGowan*, 2 Cinc. 313.

(c) *Lumley v. Wagner*, 5 De G. & Sm. 485; 1 De G. M. & G. 604;

and see *Ainsworth v. Walmesley*, L. R. 1 Eq. 518, as to a singer's voice.

(d) *Clowes v. Hogg*, W. N. 1870, p. 268.

(e) *Steinthal v. Samson*, Dig. 546.

(f) *Osborne, Garrett & Co. v. Parton, Son & Co.*, V. C. B., July 25th, 1884.

(g) *Ex parte Grist & Bowring*, 11 Vict. L. R. 630.

for the use of a patent for improvements in the manufacture, and he proposed and the patentee assented to his using as the name for the cigarettes to be made from the tobacco the words "Sweet Caporal," "Caporal" alone having been previously used by the manufacturer on other cigarettes, it was held that after the manufacturer had discontinued the use of the patent he was under no contract not to use the name "Sweet Caporal" on other cigarettes (a).

*Barrows v.
Pelsall Coal
& Iron Co.*

In *Barrows v. Pelsall Coal & Iron Co.* (b), the plaintiffs used a trade mark consisting of the letters "B. B. H." in Roman type, with a crown, and the defendants, who had compromised a suit commenced for the purpose of restraining them from using the letters "B. B. S.," also in Roman type, with a crown, by undertaking to discontinue the use of the mark, were restrained by injunction from committing a breach of the contract by applying to register the letters "B. B. S." in italics, with a crown.

Fraudulent
agreement.

The Court will not specifically enforce an agreement the object of which is to defraud the public by putting goods spuriously marked on the market (c), nor will it protect a person who has used his trade mark on spurious as well as on genuine goods (d), or has intended to commit fraud by buying the right to stamp on his own goods the name of another person who has acquired a reputation in the trade (e). And where an action for damages was brought against a person who had filled with inferior seed seed-bags which he had bought from the plaintiffs, marked with their labels, it was held on demurrer that the plaintiffs, having knowingly been parties to a fraud upon the public, were not entitled to recover (f).

(a) *Hornbostol v. Kinney*, 52 N. Y. Super. Ct. 41.

(b) Dig. 530.

(c) *Oldham v. James*, 13 Ir. Ch. 393; 14 *ib.* 81.

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

(e) *Samuel v. Berger*, 24 Barb. 163; R. Cox, 178. See *Roagers v. Philp*, 1 U. S. Pat. Gaz. 29; *In re Tolle*, 2 *ib.* 415.

(f) *Bloss v. Bloomer*, 23 Barb. 604; R. Cox, 200.

“Where the manufacture of a person or firm,” said Cotton, L. J., in *Johnson v. Raylton* (a), “has acquired with the public a name or reputation, as Broadwood’s or Erard’s pianos, Purday’s or Lancaster’s guns, a purchaser from them of articles of which they are the makers is entitled to refuse any not made by the firm with whom he contracts. In such a case the purchaser relies on reputation or public opinion that the maker to whom he goes supplies good articles. In other cases, where a man contracts with a particular firm of makers for goods such as they make, in the absence of evidence that in the particular trade, or as regards particular goods, there is a known practice that a maker of whom the goods are ordered is at liberty, in the absence of such a stipulation, to supply goods of the kind, though made by other firms, I should come to the conclusion that the purchaser is induced to go to the particular firm of manufacturers by his reliance, in part at least, on the opinion which he forms, either on his own experience or from information of others, as to the average or general excellence of the goods which are manufactured by them. He is trusting to his own experience, or to that of his friends, as a purchaser who goes to a firm which has acquired a public reputation trusts to the opinion of the public.” So that where a manufacturer has contracted to sell goods of his own manufacture and bearing his trade mark, the purchaser is justified in refusing to accept other goods, though of the same quality. But it seems that if what is wanted is the particular manufacturer’s trade mark on the goods as a guarantee of quality, the proprietor of the mark is justified in placing that mark on goods not of his own make, since by so doing he makes himself responsible for the quality of them, just as if he had made them himself (b).

Contract with
trade-mark
owner for
purchase of
goods.

(a) 7 Q. B. D. 438.

(b) See per Brett, L. J., in S. C.

But compare Merchandise Marks Act, 1887, § 3 (2).

Contract for purchase of goods with a specified mark.

Where a contract has been entered into for the purchase of goods of a particular stamp, the question arises whether the stamp was specified as indicative of a particular quality, or as possessing some value in itself, so that the goods would be of less value if stamped differently. Thus, in *Hopkins v. Hitchcock* (a), where iron stamped with "S. & H." and a crown had been contracted for, and iron stamped with "H. & Co." and a crown was supplied, the firm having become differently constituted, and having consequently marked their iron of the quality originally denoted by the former brand with the latter stamp in substitution for the former, it was decided that the contract turned upon the quality of the iron, and not upon the brand (b); if, however, the brand had possessed a special value, and the object of the purchase had been to resell the iron at a price which would have had to be lowered in the absence of the special mark, or even if it had been clear that the defendant had contracted for the brand for its own sake, and not as indicative of quality, it seems that the decision would have been the other way. Such questions must, however, depend in each case upon the terms in which the intention of the contracting parties is expressed; and it seems that a contract to supply goods bearing a particular trade mark may be implied from that trade mark being printed at the head of the order form (c).

Painter's name on paintings.

In the case of paintings, described in a catalogue as being the work of Claude Lorraine and Teniers, it was held by Lord Kenyon, C. J., that the description was merely an expression of the vendor's opinion, and not a warranty of the authenticity of the paintings (d); in a

(a) 14 C. B. N. S. 65.

(b) Compare *Nichol v. Godts*, 10 Ex. 191. Similarly, in *Gillespie & Co. v. Marshall*, Dig. 648, the question was discussed whether a contract to supply "Marshall's Canada Plates" was performed by the delivery of plates such as were usually

supplied by Marshall, but which were not "Canada Plates" in the strict commercial sense.

(c) *Johnson v. Raylton*, 7 Q. B. D. 438.

(d) *Jewdine v. Slade*, 2 Esp. N. P. C. 572.

similar case, however, where the painter was said to be Canaletto, it was held by the Court of King's Bench to be for the jury to say whether or not the description amounted to a warranty (a). The paintings being so much more modern, it was more reasonable in this case to suppose that the vendor intended to make an assertion as to the fact of their authenticity, as within his own knowledge.

By the Merchandise Marks Act, 1887, any person selling or contracting to sell any goods bearing a trade mark, or trade description, is to be deemed to warrant the genuineness of the trade mark, or the correctness of the trade description, unless he expresses the contrary in signed writing, delivered to and accepted by the vendee (b). Merchandise
Marks Act.

By § 19 the punishment of an offender under that Act does not take away the civil remedy to which any person aggrieved by his conduct is entitled.

That under some circumstances an infringement of another person's trade mark may expose the infringer to liabilities even beyond those involved in an action brought to restrain the wrong, appears from the Victorian case of *In re Brebner* (c), in which an insolvent, who had wasted his means in litigation occasioned by his having infringed a trade mark, had his certificate suspended for a year. Risks in-
curred by
infringement.

(a) *Power v. Barham*, 4 Ad. & E. 473.

(b) 50 & 51 Vict. c. 28, § 17.

(c) 2 W. & W. (I. E. & M.) 12.

CHAPTER VII.

THE CIVIL REMEDY. II.

DEFENCES; DISCOVERY AND INSPECTION, ACCOUNT, DAMAGES, COSTS.

Defences.

Defences. THE possible defences to an action to restrain an infringement of trade mark are numerous, some being of a somewhat special character. The following are some of the more important.

1. *Non-infringement.*

1. Non-infringement. The first and usual defence is that the conduct on the part of the defendant, of which the plaintiff complains, has not been, in fact, such as to have for its object or its result the appropriation by the defendant of what was the plaintiff's due, the fruits of his enterprise and reputation: shortly, that the defendant has not infringed (a).

2. *No Registration or Certificate of Non-registration.*

2. No registration or certificate. The trade mark, so called, may present some one or more of the essential particulars required by the Acts, and may not be objectionable in itself; but yet the fact of non-registration under the Acts will, if it is a mark capable of registration, whether it was or was not used before the 13th August, 1875, effectually debar the person who has

(a) *E.g., Crawshay v. Thompson*, 4 Man. & G. 357; *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Blackwell v. Crabb*, 36 L. J. Ch. 504; *Wotherspoon v. Currie*, L. R. 5 H. L. 508; *Blackwell v. Wright*, 73 N. Car. 310.

used it from obtaining the injunction, which would otherwise be awarded as a matter of course (a). And this is so, even though the trade-mark owner has taken all steps in his power to protect his rights, and the Patent Office is responsible for the delay (b). If, being incapable of registration, it is an old mark, a certificate of refusal to register will preserve the existing right to protection (c). If, being incapable of registration, it is a new mark, the Acts of 1883-8 do not appear to deprive the mark of protection for want of registration (d); but the definition is now wider than it was in the Act of 1875, and there can be but few, if any, marks which would be capable of protection at Common Law, and yet be incapable of registration. However, it does not at all appear that, when a case of actual intentional fraud can be proved, there is anything in the Acts to prevent proof of imitation of marks, though unregistered, &c., being given as corroborative evidence of the fraud (e). In such a case the state of things would be similar to that in which it is a mode of packing that has been imitated (f). The injunction which would not be granted to restrain the infringement of the unregistered and uncertified trade mark would, as it seems, be granted to restrain the intentional fraud, in which the imitation of marks was a mere incident.

(a) See Patents Act of 1883, § 77; also *Goodfellow v. Prince*, 35 Ch. D. 9, and *Hart v. Colley*, 44 Ch. D. 193. Registration is a "condition precedent to suing." Per Chitty, J., in *Mouson & Co. v. Boehm*, 26 Ch. D. 398. It does not appear that in America it is equally essential to have obtained registration. See *Rodgers v. Philp*, 1 U. S. Pat. Gaz. 29.

(b) *Hazzopulo v. Kaufmann*, 23 Sol. J. 819.

(c) Patents Act 1883, § 77. See per Lord Blackburn in *Orr-Ewing v. Registrar of Trade Marks*, 4 App. Cas. 498. In *Orr-Ewing & Co. v. Johnston & Co.*, 13 Ch. D.

434, a certificate of registration or of refusal to register does not appear to have been called for.

(d) Patents Act, 1883, § 77.

(e) The late Master of the Rolls has intimated from the bench that this view is correct; and see per Pearson, J., in *In re Riviere & Co.*, W. N. 1884, p. 75, and per Kay, J., in *In re Sanitas Co., Ltd.*, 58 L. T. N. S. 166. Also *Hart v. Colley*, *ubi. sup.*, and the Canadian case of *Smith v. Fair*, 14 Ont. Rep. 729.

(f) *Woollam v. Ratcliff*, 1 H. & M. 259; *Edelsten v. Vick*, 11 Hare, 78; *Frese v. Bachof* (2), 14 Bl. C. C. 432; *Orr v. Diaper*, 4 Ch. D. 92; *Lever v. Goodwin*, 36 Ch. D. 1.

3. *The Plaintiff not the Registered Proprietor.*

3. Plaintiff
not the
registered
proprietor.

The provision contained in § 77 of the Act of 1883 disabling trade-mark owners from obtaining protection for their marks, unless they have been registered in pursuance of the Acts, does not appear to prevent such owners from suing, so long as the mark is registered, whether it stands in their name or not; and this has in effect been so held in a case where a trade mark had been registered in the name of a firm, and a new firm took over the business and goodwill, and commenced an action for infringement before the trade mark had been transferred into their names (a). It is, however, provided by § 76 that "the registration of a person as proprietor of a trade mark shall be *primâ-facie* evidence of his right to the exclusive use of the trade mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade mark, subject to the provisions of this Act." So that, at all events after a trade mark has been registered for five years, and the registration has become conclusive evidence of the exclusive title of the registered proprietor, it would seem very difficult for a person who, though really entitled to the mark, was not the registered proprietor, to sue in respect of an infringement, without his first getting his name placed on the register as the proprietor, for which purpose it may be necessary first to rectify the register by the removal of the name already there.

The trade mark being duly registered, the objection which formerly prevailed, by which a trade mark was excluded from protection when there were no vendible goods in the market stamped therewith (b), will apparently

(a) *Thlee v. Henshaw*, 31 Ch. D. 323. G. J. & S. 380; *Maxwell v. Hogg*,
(b) *MoAndrew v. Bassett*, 4 De L. R. 2 Ch. 307.

be avoided, for application for registration is to be deemed to be equivalent to public use of the mark (a).

4. Plaintiff's Trade Mark bad in itself.

This defence must for the future be founded mainly on the definition of a trade mark in the Act under which the mark was registered. Thus, marks registered or tendered for registration between August 13th, 1875, and December 31st, 1883, must comply with the definition in § 10 of the Trade Marks Registration Act, 1875; marks registered or tendered for registration between January 1st, 1884, and December 31st, 1888, must comply with the definition in § 64 of the Patents Act, 1883; marks registered or tendered for registration on or after January 1st, 1889, must comply with the last-mentioned definition as modified by § 10 of the Patents Act, 1888. If the mark sued on is a new mark and incapable of registration, so that § 77 of the Act of 1883 leaves its owner free to sue for an infringement without registration, the validity of the mark will be determined by the general law as to distinctiveness, &c. (b). But such cases cannot be numerous, and in the great majority of cases the point will be whether a mark which has been registered was rightly registered (c). Then the question arises whether the contention, that the mark does not comply with the conditions imposed upon marks tendered for registration, can be set up by way of defence, or whether a motion to rectify the register is necessary. That such a contention may be set up by way of defence when the mark has been registered for less than five years seems clear, since by § 76 registration is only *primâ-facie* evidence

4. Plaintiff's trade mark bad.

(a) § 17 of Act of 1888, substituted for § 75 of Act of 1883. This is so also in the United States: *In re The Dutcher Temple Co.*, U. S. Pat. Comm. Decis. 1871, p. 248. See, however, *Edwards v. Dennis*, 30 Ch. D. 454.

(b) See Chap. II., *supra*.

(c) If the registered mark, being a new mark, is held to be incapable of registration and to have been wrongly registered, the question of validity at Common Law may arise.

during the first five years, and to disallow the setting up of such a contention by way of defence within the five years would be to make the registration conclusive evidence from the outset.

When the case relates to a trade mark which has been registered for upwards of five years, the question seems much more difficult. The Court of Appeal seems to have suggested in one case (a) that registration is conclusive after five years, in the absence of a motion to rectify, and there is no doubt that the more prudent course is to apply for rectification. If this is granted, the plaintiff's action will fail, as his previous wrongful registration will afford no foundation for it (b). But it appears to be very doubtful whether, on the wording of the Acts of Parliament, a motion to rectify is required, where the defence is that the mark claimed is not within the definition section in the Act under which it was registered. Both in § 3 of the Act of 1875, and in § 76 of the Act of 1883, the exclusive right for which provision is made relates to the use of "a trade mark," and it can hardly be that that which the Act, by excluding it from the definition of "a trade mark," declares not to be a trade mark for the purposes of the Act, can yet participate in the privileges which are conferred on trade marks which the Act recognises. The process of registration, whether for five years or for any shorter period, can hardly make that "a trade mark" which does not contain at least one of the elements declared by the definition section to be essential, unless that section is to be entirely disregarded. This view was upheld by the Court of Appeal in *In re Palmer* (1) (c), in which the late Master of the Rolls fully discussed the point, and Lindley, L. J., said that "after careful examination of §§ 3, 5, and 10 of the Trade Marks

(a) *Apollinaris Co., Ltd. v. Herrfeldt*, 4 P. R. 478.

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

(c) 21 Ch. D. 47.

Registration Act, 1875, I am satisfied that a mark which is not a trade mark, and which therefore ought never to have been registered, does not become a trade mark by being on the register for five years." The Vice-Chancellor of Ireland has taken the same view (a), and the same principle has been followed in Victoria (b). In America also the same conclusion has been arrived at, under the United States Statute (c).

5. Trade Mark severed from Goodwill.

It is a good defence to an action for infringement of trade mark, to prove that the plaintiff is not the owner of the business and goodwill concerned in the particular goods or classes of goods in respect of which the trade mark is registered (d).

5. Trade mark severed from goodwill.

6. Licence.

The defendant may plead a licence from the plaintiff (e), or from a co-proprietor of the mark (f). In one American case (g) it was held that the plaintiffs, who had received an exclusive licence from the owner of a trade mark, were entitled to an injunction against the successors in business of persons who had been partners in business with the licensor, but had tacitly acquiesced in his retaining the sole right in the mark. However, the Court would not

6. Licence.

(a) *Bodega Co., Ltd. v. Owens*, 23 L. R. Ir. 371.

(b) *Lewis v. Klapproth*, 11 Vict. L. R. (E.) 214; *Wolfe v. Alsop* (2), 12 Vict. L. R. (E.) 421; *Wolfe v. Lang & Co.*, 13 Vict. L. R. 752.

(c) *Moorman v. Hoge*, 2 Sawy. 78.

(d) See §§ 65 and 70 of Act of 1883. There can be no trade mark in gross: *Cotton v. Gillard*, 44 L. J. Ch. 90. See *In re Wellcome*, 32 Ch. D. 213; *Witthaus v. Braun*, 44 Md. 303; *Taylor v. Bemis*, 4 Biss. 406; *Weston v. Ketcham* (1), (2), 39 N. Y. Super. Ct. 54; 51 How. Pr. 555; *Skinner v. Oakes*, 10 Mo. App. 45; *Morgan v. Rogers*,

19 Fed. Rep. 596; *Smith v. Fair*, 14 Ont. Rep. 729.

(e) See Patents Act, 1883, § 87. It does not appear that this section can be intended to authorise the user of a trade mark on goods not being the goods of the trade-mark owner, or, at least, equivalent to them. See *Lawrence Manufacturing Co. v. Tennessee Manufacturing Co.*, 31 Fed. Rep. 776.

(f) *Marshall v. Pinkham*, 52 Wisc. 572.

(g) *Kidd v. Johnson*, 100 U. S. Rep. 617. See *Kidd & Co. v. Mills, Johnson & Co.*, 5 U. S. Pat. Gaz. 337.

allow a licensee to defraud the public by the sale of goods under a mark which was similar to that on the licensor's own goods, while the goods themselves were not the goods or goods equivalent to the goods of the licensor (a).

It has been held in India (b) that plaintiffs, who had led the defendant to believe that they did not claim a certain trade mark, and that he was at liberty to use it, and had allowed him to build up a trade under it, were estopped by their own conduct from denying the defendant's right to use it.

7. Delay and Acquiescence.

7. Delay and acquiescence.

A man may by his own *laches* lose his right to that protection which he would have obtained at once, had he come to the Court with reasonable promptitude (c). In fact, that which has originally been a valid trade mark, the property of an individual or firm, entitled to protection, may become *publici juris*—that is to say, the use of it may be thrown open to the public—by its proprietor allowing his right to be so habitually infringed that the trade mark no longer conveys to those who see it the impression that the goods to which it is attached are of his manufacture (d). That this must necessarily be so, the reasoning of the Supreme Court of Victoria, in *Neva*

(a) *Oldham v. James*, 13 Ir. Ch. 393; 14 *ib.* 81; *Bloss v. Bloomer*, 23 Barb. 604, R. Cox, 200; *Samuel v. Berger*, 24 Barb. 163, R. Cox, 178; *Rodgers v. Philp*, 1 U. S. Pat. Gaz. 29; *In re Tolle*, 2 *ib.* 415.

(b) *Lavergne v. Hooper*, Ind. L. R. 8 Mad. 149.

(c) *Motley v. Downman*, 3 My. & Cr. 1; *Morison v. Moat*, 9 Hare, 241; *Flavel v. Harrison*, 10 Hare, 467; *Wason v. Waring*, 15 Beav. 151; *Attorney-General v. Sheffield Gas Consumers' Co.*, 3 De G. M. & G. 327; *Burgess v. Burgess*, *ib.* 896; *Farina v. Gebhardt*, 3 Eq. Rep. 891; *Chappell v. Sheard*, 2 K. & J. 117; *Coles v. Sims*, 5 De G. M.

& G. 1; *Kinahan v. Bolton*, 15 Ir. Ch. 75; *Hovenden v. Lloyd*, 18 W. R. 1132; *Isaacson v. Thompson*, 41 L. J. Ch. 101; *Estcourt v. Estcourt Hop Essence Co.*, L. R. 10 Ch. 276; *Amoskeag Manufacturing Co. v. Garner*, 55 Barb. 151, R. Cox. 541; *Manhattan Medicine Co. v. Wood*, 108 U. S. Rep. 218; *Marshall v. Pinkham*, 52 Wisc. 572; and other cases cited below.

(d) *Ford v. Foster*, L. R. 7 Ch. 611; *Wheeler & Wilson v. Shakespeare*, 39 L. J. Ch. 36; *In re Kuhn & Co.*, 53 L. J. Ch. 238; *Rodgers v. Philp*, 1 U. S. Pat. Gaz. 29; *Filley v. Child*, 16 Bl. C. C. 376.

Stearine Co. v. Mowling (a), appears convincing. "Great stress," said Holroyd, J., "has been laid on this: that a person who is entitled to a distinctive trade name or mark is said to have acquired property in it, and that the property once acquired cannot be lost. But what is the nature of the property, if that be the right designation to give it? It is that, when an article has become known to the public generally by a particular name or mark, no other person has a right to simulate that name or mark so as to induce the public to believe that his goods are the goods of the inventor. If that be the reason, then the right, if it be acquired in that way, must be lost when the reason for it ceases. If the use of the name by another person will no longer induce that belief, then the right to the property must be gone." Thus, in *In re Hyde & Co.* (b), it was held that the words "Bank of England" had long ceased to be a trade mark in respect of sealing-wax, by reason of the user for six years of those words on sealing-wax by persons other than those who had originally adopted it, without interference by the latter, and the registration of the lapsed trade mark was accordingly rescinded.

The principle on which the Court allows the plaintiff's delay to be pleaded by way of defence is thus stated by Wood, V.-C., in *Beard v. Turner* (c): "By not complaining at the time when you might complain (I do not say that it is your intention, we must judge of the intention by the necessary result), you are lying by, the man continuing to use your property, with the hope (and such is the prayer of your bill filed two or three years afterwards) of obtaining those profits which you stood by allowing him to make under this designation, without apprising him of your intention to make any such use of

Principle of
this defence.

(a) 9 Vict. L. R. (E.) 98.

(b) 7 Ch. D. 724.

(c) 13 L. T. N. S. 746. And

see *Neva Stearine Co. v. Mowling*,
9 Vict. L. R. (E.) 98.

it. On that ground it falls within the principle enunciated by Lord St. Leonards in the Irish case referred to, in which it is stated that it is a fraud to allow a plaintiff to avail himself of delay to obtain benefit for himself. In that case you will not grant him relief."

On motion for injunction.

In the case of a motion for an injunction "the argument as to acquiescence is no doubt very important. A short acquiescence may properly induce the Court not to interfere *ex parte*. A longer acquiescence may, under the circumstances, throw serious doubt upon the right of the plaintiff, and induce the Court not to interfere by any interlocutory order, even when applied for on notice" (a). And it is not sufficient for the plaintiff to commence proceedings promptly: if he wishes for an interlocutory injunction he must bring on his motion at once, or the Court will hold that he has shown by his own conduct that he does not consider such interference to be imperative (b).

At the hearing.

Where, however, the case has arrived at the hearing, the degree of delay or acquiescence must be much greater; there must be such an acquiescence as to amount, not only to a positive licence, but to an implication of an actual grant, before the parties can be for ever deprived of their rights (c). In *Fullwood*

(a) Per Lord Langdale, M. R., in *Gorain v. Cheltenham Railway Co.*, 5 Beav. 233; and see *Isaacson v. Thompson*, 41 L. J. Ch. 101; *Flavel v. Harrison*, 10 Hare, 467; *Evans v. Smith*, 3 Times L. R. 390; *Mallan v. Davis*, 3 Times L. R. 221; *Chinn v. Thomas*, 5 Vict. L. R. Eq. 138; *Estes v. Worthington* (1), 23 Bl. C. C. 165. But compare the N. S. W. case of *Heyde v. Wittkowski*, 5 N. S. W. Rep. (E.) 74.

(b) *Pickford v. The Grand Junction Railway Co.*, 3 Railway Cas. 538.

(c) *Patching v. Dubbins*, Kay 11; *Gordon v. The Cheltenham Railway Co.*, 5 Beav. 233; *Rodgers v. Rodgers*, 31 L. T. N. S. 285; and

see *Lazenby v. White*, 41 L. J. Ch. 354; *Weaver v. Sanitary, &c., Co.*, L. J. N. of C. 1887, p. 144 (where the defendants had used the word for eleven years, to the plaintiff's knowledge); *Weaver v. Stiff*, L. J. N. of C. 1887, p. 144 (where the defendants had so used the mark for ten years); *Gillott v. Esterbrook*, 47 Barb. 455; R. Cox, 340; 48 N. Y. 374; *Filley v. Fassett*, 44 Mo. 173, R. Cox, 530; *McLean v. Fleming*, 96 U. S. Rep. 245; *Sawyer v. Kellogg*, 7 Fed. Rep. 721; 9 *ib.* 601; *Gamble v. Stephenson*, 10 Mo. App. 581; *Julian v. Hoosier Drill Co.*, 75 Ind. 408; *Holt v. Menendez*, 128 U. S. Rep.

v. Fullwood (2) (a), Fry, J., laid down that mere lapse of time, short of the statutory period fixed for the limitation of actions, would not deprive a plaintiff in an action for infringement of a trade mark, which is an action for the assertion of a legal right, of his right to the injunction. And in an American case (b), while it was held that a delay of twenty-five years effectually disentitled the plaintiffs to relief as against an innocent vendor of goods falsely marked, the question as to the rights of a trade-mark owner, after a similar delay, against a guilty manufacturer, was left open. In Victoria also it has been said that "in cases of fraud a much longer period of acquiescence would be necessary than where there was no fraud" (c). But a long delay may be regarded as rendering harmless that which might at an earlier period have been regarded as a misrepresentation (d).

It is not a sufficient answer to a plea of delay on the part of the plaintiff for the plaintiff to allege continual assertions of his right. He must take some more decided measures. "What the plaintiffs mainly relied on was the continual claim on their part," says Turner, L. J. (e), "and no doubt they have not ceased to assert their claim; but I cannot agree to a doctrine so dangerous as that the mere assertion of a claim, unaccompanied by any act to give effect to it, can avail to keep alive a right which would otherwise be precluded" (f).

Rights must be actively defended.

But where a trade mark has been infringed, and the

No delay where no knowledge.

182; *Lea v. Deakin*, 11 Biss. 23 (where the plaintiffs had previously failed in England in an action against the defendant's principal); *Collins Co. v. Ames & Sons*, 20 Bl. C. C. 542; *Funk v. Dreyfus*, 34 La. Ann. 80; *Blackwell v. McElwee*, 100 N. C. 150. The same was formerly the case on demurrer.

(a) 9 Ch. D. 176.

(b) *Rodgers v. Philp*, 1 U. S. Pat. Gaz. 29; and see *Wolfe v. Barnett*, 24 La. Ann. 97; *Sanders v. Jacob*, 20 Mo. App. 96.

(c) *Neva Stearine Co. v. Mowling*, 9 Vict. L. R. (E.) 98; but compare *In re Heaton*, 27 Ch. D. 570.

(d) *Marquis of Londonderry v. Russell*, 3 Times L. R. 360.

(e) *Clegg v. Edmonton*, 3 De G. M. & G. 810.

(f) This dictum was approved and followed by Wood and Selwyn, L. J.J., in *Lehmann v. McArthur*, L. R. 3 Ch. 496; but see *Attorney-General v. Sheffield Gas Consumers' Co.*, 3 De G. M. & G. 327; and *Kinahan v. Bolton*, 15 Ir. Ch. 75.

owner has not been aware that this has been the case, he has been guilty of no delay in taking no steps to put an end to the fraud, and he will, therefore, not be deprived of his rights by reason of his having taken no proceedings while he was ignorant of the infringement (a). Hence, where a defence of delay is set up, the evidence must go to show, not merely that the plaintiff might have been aware of the infringement which was going on, but that he actually was so, and that it was with such knowledge that he remained quiescent (b).

Delay by
retiring
partner.

It has been held in America that if a member of a partnership retires therefrom without setting up any claim to an interest in the trade mark, and makes no objection to its being used by the continuing partner, he must be taken to acquiesce in its being appropriated by the latter (c); but that if, on the other hand, a partner submits to the appropriation of the firm trade mark by his partner, at a time when he is, in a measure, in the latter's power, by reason of the latter being in sole possession of an important secret used in the business, he will be held not to have lost his right (d); and that a continued user of the mark by the retiring partner, even on a spurious article, is evidence that he does not intend to give up his rights therein (e).

Delay for
purpose of
securing
evidence.

Inasmuch as in a case where no proof of actual deception is produced, the Court has to try a hypothetical case, turning on the probabilities of deception, as to which witnesses could probably be brought forward by both sides,

(a) *Weldon v. Dicks*, 10 Ch. D. 247; *In re Farina* (2), 27 W. R. 456; *Mouson & Co. v. Boehm*, 26 Ch. D. 398; *Apollinaris Co. v. Herrfeldt*, 4 P. R. 478; *Williams v. Adams*, 8 Biss. 452; *Sawyer v. Kellogg*, 7 Fed. Rep. 721, 9 *ib.* 601; *Celluloid Manufacturing Co. v. Cellonite Manufacturing Co.* 32 Fed. Rep. 94. Compare *In re Hewton*, 27 Ch. D. 570.

(b) *Siegert v. Findlater*, 26 W. R. 462.

(c) *Kidd & Co. v. Mills, Johnson & Co.*, 5 U. S. Pat. Gaz. 337; *Simpson v. Wright* (1), 15 *ib.* 248; *Holt v. Menendez*, 128 U. S. Rep. 182.

(d) *Weston v. Ketoham* (1), 39 N. Y. Super. Ct. 54.

(e) *Wright v. Simpson*, 15 U. S. Pat. Gaz. 968.

a person who believes others to be infringing his trade mark is entitled to wait until he can collect a sufficient number of cases to prove to the Court that the proceedings of which he complains do actually deceive the public; and his right to protection is not gone by reason of such delay (a). It seems that in *Rodgers v. Rodgers* (b), and *Estcourt v. Estcourt Hop-Essence Co.* (c), the delay would have been condoned had it resulted in the production of satisfactory evidence of deception. On the other hand, where a plaintiff delayed his motion until December, having been in possession of sufficient evidence in May, the delay was fatal to the motion (d).

Where an injunction has been granted by the Court, there must, in order to deprive the party who has obtained the injunction of his right to move for committal upon the breach of it, be a case made out almost amounting to such a licence to the party enjoined to do the act enjoined against as would entitle him to maintain an action against others for doing that act (e).

Even if the delay has not been such as to disentitle the plaintiff to his injunction, it may yet obtain some indulgence for the defendant; as, for instance, the permission to dispose of the wares on which he expended money in consequence of the plaintiff's delay (f).

Or, the injunction may be granted and the account of profits or damages, by which it is usually accompanied, withheld (g).

(a) *Lee v. Haley*, L. R. 5 Ch. 155; *Cave v. Myers*, Dig. 304.

(b) 31 L. T. N. S. 285.

(c) L. R. 10 Ch. 276.

(d) *Isaacson v. Thompson*, 41 L. J. Ch. 101.

(e) Per Turner, L. J., in *Rodgers v. Nowill*, 3 De G. M. & G. 614. In *Cartier v. May*, Dig. 200, a delay of eighteen months was one of the grounds on which the motion to commit was refused.

(f) *Clowes v. Hogg*, W. N. 1870

p. 268; S. C. on appeal, W. N. 1871, p. 40; *Anglo-Swiss Condensed Milk Co. v. Swiss Condensed Milk Co.*, W. N. 1871, p. 163.

(g) *Harrison v. Taylor*, 11 Jur. N. S. 408; *Amoskeag Manufacturing Co. v. Garner* (2), 54 How. Pr. 298; *McLean v. Floming*, 96 U. S. Rep. 245; *Carver v. Bowker*, Dig. 581; *Holt v. Menendez*, 128 U. S. Rep. 182; *Low v. Fells*, 35 Fed. Rep. 361; and see *Beard v. Turner*, 13 L. T. N. S. 746.

Costs not given.

Lastly, the delay of the plaintiff may be punished by his being left to pay his own costs, though successful in his main contention (a). On the other hand, a defendant who has only defeated the plaintiff's claim by pleading the latter's delay, may fail to obtain thereby the costs of the proceedings occasioned by his own fraud (b).

8. Plaintiff's Misrepresentation.

8. Plaintiff's misrepresentation.

"The administration of Equity is founded on perfect truth" (c), and, "when the owner of a trade mark applies for an injunction to restrain the defendant from injuring his property by making false representations to the public, it is essential that the plaintiff should not, in his trade mark, or in the business connected with it, be himself guilty of any false or misleading representation; for if the plaintiff makes any material false statement in connection with the property which he seeks to protect, he loses, and very justly, his right to claim the assistance of a Court of Equity. He must come there with clean hands" (d).

It is impossible to define what misrepresentation will disentitle the plaintiff to relief; all that can be said is,

(a) See *Millington v. Fox*, 3 My. & Cr. 338; *Beard v. Turner*, 13 L. T. N. S. 746; *Day v. Neale*, V. C. B., May 24th, 1881; *Perks v. Hall & Co.*, W. N. 1881, p. 111; *In re Kuhn & Co.*, 53 L. J. Ch. 238; *Amoskeag Manufacturing Co. v. Garner* (2), 54 How. Pr. 298.

(b) *Rodgers v. Rodgers*, 31 L. T. N. S. 285.

(c) Per Lord Romilly, M. R., in *Cocks v. Chandler*, L. R. 11 Eq. 446.

(d) Per Lord Westbury, C., in *Leather Cloth Co. v. American Leather Cloth Co.*, 4 De G. J. & S. 137; and see *Edelsten v. Vick*, 11 Hare, 78; *Post v. Marsh*, 16 Ch. D. 395; *Talbot v. Judges*, 3 Times L. R. 398; *Petridgo v. Wells*, 13 How. Pr. 385, R. Cox, 180; *Palmer*

v. Harris, 60 Penn. 156, R. Cox, 523; *Laird v. Wilder*, 9 Bush, 131, 15 Amer. Rep. 707; *Wolfe v. Burke*, 56 N. Y. 115; *Consolidated Fruit Jar Co. v. Dorflinger*, 6 Am. L. T. N. S. 511; *Manhattan Medicine Co. v. Wood*, 108 U. S. Rep. 218; *Seabury v. Grosvenor*, 14 Bl. C. C. 262; *Helmbold v. Helmbold Manufacturing Co.*, 53 How. Pr. 453; *Connell v. Reed*, 128 Mass. 477; *Burton v. Stratton*, 12 Fed. Rep. 696; *McNair v. Cleave*, 10 Phila. 155; *Kochler v. Sanders*, 55 N. Y. Sup. Ct. 48; *Wolfe v. Lang & Co.*, 13 Vict. L. R. 752. Words which would be disentitled to protection in a court of justice by reason of their being calculated to deceive, are not to be registered under the Patents Act, 1883, § 73.

that "he that hath committed iniquity shall not have equity" (a).

According to the American decisions (b), if it is proved that a plaintiff adopted his trade mark while an identical or similar trade mark was in use by another firm, he will himself be held to have acted wrongfully, and the trade mark so adopted will be refused protection. Trade mark wrongfully adopted.

The trade marks, labels, &c., of the plaintiff, who is complaining of fraud on the part of another, may themselves contain statements calculated to mislead and defraud the public, who are induced by such statements to buy goods which otherwise they would not buy. Thus, in *Pidding v. How* (c), the plaintiff sold tea which he termed "Howqua's Mixture," and which he put up in packets labelled with extravagant and false statements as to its origin and quality. Shadwell, V.-C. of E., declined to protect the plaintiff until he had established his title in a Court of Law, saying that it was a clear rule laid down by Courts of Equity not to extend their protection to persons whose case was not founded in truth. Misstatements in plaintiff's marks.

In *Perry v. Truefitt* (d), the plaintiff sold "Perry's Medicated Mexican Balm," the secret of which he had bought from a Mr. Leathart. On his show-cards he falsely stated that the hair-mixture in question was made from a recipe of Von Blumenbach, and he also alleged in the same way that it was compounded from Mexican plants, which was not in the least borne out by evidence at the trial. Lord Langdale, M. R., agreeing with the observations of the Vice-Chancellor of England in *Pidding v. How* (c), did not think it a favourable case for the interposition of the Court, and ordered the matter to stand over, with liberty to bring an action. *Perry v. Truefitt.*

(a) *Palmer v. Harris*, 60 Penn. St. 156, R. Cox, 523. See *Blackwell v. Armistead*, 5 Am. L. T. 85.

(b) *O'Rourke v. Central City Soap Co.*, 26 Fed. Rep. 576; *Parlott*

v. Guggenheimer, 67 Md. 542; *Lawrence Manufacturing Co. v. Tennessee Manufacturing Co.*, 31 Fed. Rep. 776.

(c) 8 Sim. 477.

(d) 6 Beav. 66.

Leather Cloth Co.s' case.

In *Leather Cloth Co. v. American Leather Cloth Co.* (a), the House of Lords sustained the judgment of Lord Westbury, C. (b), and declined to protect the plaintiffs, who used a label or advertisement containing false statements as to the character and manufacture of their goods. Lord Westbury, C. (b), remarked, that he "could not receive it as a rule either of morality or of equity, that the plaintiffs were not answerable for a fraud because it might be so gross and palpable that no one was likely to be deceived by it. If there was a wilfully false statement, he would not stop to inquire whether it was too gross to mislead."

Cases in tobacco trade.

The tobacco trade has been fruitful in cases of this description. Thus, in *Wood v. Lambert* (c), John Wood & Son of London sold their English-made cigarettes sometimes in boxes labelled "cigarettes of the finest selected Turkish tobacco, manufactured by Jancal Tachta, Constantinople," sometimes in boxes labelled "St. Petersburg—P. Mavrogordato & Co.—cigarettes"; and it was held that the word "Eton," which had been used upon the boxes so labelled, was disentitled alike to registration and protection. So in *Newman v. Pinto* (d), where the plaintiff sold cigars in boxes branded with the Spanish words "La Pureza—Habana—Ramon Romnedo," and bearing labels on which appeared the words "La Pureza," the written signature of Ramon Romnedo (who was in fact a non-existent personage), and the arms of Spain and Havannah, and it was proved that the cigars, though made of Havannah tobacco, were imported from Bremen, and no evidence was given by the plaintiff as to the actual place of manufacture, it was held that the get-up of the goods was such as to represent that the cigars were manufactured in Havannah by Ramon Romnedo, and that the plaintiff, having failed to prove that this

(a) 11 H. L. C. 523.

(b) 4 De G. J. & S. 137.

(c) 32 Ch. D. 247.

(d) 57 L. T. N. S. 31.

representation was true, he was disentitled to sue in respect of his label, which was only used as part of the fraudulent get-up, which Bowen, L. J., described as "an elaborate concatenation of pictorial lies." In the United States also (a), and in Canada (b), labels used so as to represent that cigars not of Cuban manufacture were Cuban have been refused protection. And in a New South Wales case (c), where the defendant had been guilty of a similar misrepresentation, the judge not only granted an injunction at the instance of a trader whose mark had been pirated, but directed criminal proceedings for the fraud to be taken against the defendant.

In short, the Court will not protect a trade mark, label, Puffing. &c., which contains, or has attached to it, a serious misstatement calculated to deceive (d). Mere puffing, however, or exaggerated statements as to the value, &c., of patent medicines, and similar preparations, will not disentitle their owners, since every one knows how to estimate the value of such statements correctly (e). Thus, in *Holloway v. Holloway* (f), the assumption of the title of "Professor" was disregarded; in *Metzler v. Wood* (g) it was held that the plaintiffs were not disentitled either by a representation that the publication was the 600th edition of the work, it being shown to be a trade custom to call 250 copies an edition; or by a statement that the

(a) *Palmer v. Harris*, 60 Penn. St. 156; *Schumacher & Ettlinger v. Schwenke* (2), 36 U. S. Pat. Gaz. 457.

(b) *Labbatt v. Trester*, 2 St. Dig. 726.

(c) *Heyde v. Wittkowski*, 5 N. S. W. Rep. (E.) 74.

(d) In *Raggett v. Findlater*, L. R. 17 Eq. 29, costs were given against the plaintiff mainly on account of a misstatement by him.

(e) *Holloway v. Holloway*, 13 Beav. 209; *Comstock v. White*, 18 How. Pr. 421, R. Cox, 232; *Smith v. Woodruff*, 48 Barb. 438, R. Cox, 373. In America puffing has fre-

quently been treated somewhat more severely: *Fowlb v. Spear*, 7 Penn. L. J. 176, R. Cox, 67; *Heath v. Wright*, 3 Wall. Jr. 1, R. Cox, 154; *Petridge v. Weils*, 13 How. Pr. 385, R. Cox, 180; *Petridge v. Merchant*, 4 Abb. Pr. 156, R. Cox, 194; *Hobbs v. Français*, 19 How. Pr. 567, R. Cox, 287; *Phalon v. Wright*, 5 Phila. 464, R. Cox, 307; *Laird v. Wilder*, 9 Bush, 131; 15 Amer. Rep. 707; *Wolfe v. Burke*, 56 N. Y. 115. But see *Ellis v. Zeilen & Co.*, 42 Ga. 91.

(f) 13 Beav. 209.

(g) 8 Ch. D. 606.

work was specially revised by the author, the fact being that a previous edition which the present one followed had been so revised. In *Hogg v. Kirby* (a), the defendant, who had brought out what he intended to be taken for a continuation of the plaintiff's magazine, set up in his defence the fact that the plaintiff's magazine untruly professed to be by "William Granger, Esq." Lord Eldon granted the injunction; and it is certainly improbable that any one could be injured by the use of a name previously unknown (b).

Melachrino v. Melachrino.

Again, in *M. Melachrino & Co. v. R. Melachrino & Co.* (c), it was held that the plaintiffs were not disentitled, either because they placed the word "registered" on their trade mark as used, though it differed from the registered trade mark in having what were blank spaces in the latter filled in with coats-of-arms, nor because they sold their cigarettes as "Egyptian cigarettes," whereas on one occasion they had re-made in England with Egyptian tobacco a small quantity of cigarettes which had been damaged on the voyage from Egypt to England. And it has been held in America that the use of the word "imported" in connection with goods of home-manufacture does not disentitle the plaintiff, if the word is used without intention to deceive and does not produce that effect (d).

False statement in foreign language.

If the misrepresentation is in other respects such as to disentitle, the fact of its being made in a foreign language does not necessarily save the plaintiff from losing the rights which he would have had if no such statements had been made (e).

Use of predecessor's name.

The use of the name of his predecessor by one who has succeeded him in business, when such use will not lead to any other supposition than that the business is the

(a) 8 Ves. 215.

(b) And see *Dale v. Smithson*, 12 Abb. Pr. 237, R. Cox, 282; *Meriden Britannia Co. v. Parker*, 39 Conn. 450, 12 Amer. Rep. 401.

(c) Chitty, J., May 27th, 1888.

(d) *Funke v. Dreyfus*, 34 La. Ann. 80.

(e) *Palmer v. Harris*, 60 Penn. St. 156; R. Cox, 523.

same (a), or the use of his own name, without more, by one whose name happens to be the same as that of another manufacturer (b), is not such a misrepresentation as to disentitle such a person to relief against fraud. But where a trader has been in the habit of labelling his goods (e.g. a particular medicine) with statements which refer to himself personally, and his successor in business continues to use the same statements, "a Court of Equity will extend no aid to sustain a claim to a trade mark of an article which is put forth with a misrepresentation to the public as to the manufacturer of the article, and as to the place where it is manufactured, both of which particulars were originally circumstances to guide the purchaser of the medicine" (c).

Collateral misrepresentations made by the plaintiff, as, for instance, in an advertisement in the newspapers, do not necessarily disentitle him to protection (d). Nor do misstatements of so trifling a character as not to mislead purchasers (e), or statements not made till after the institution of the action (e).

It is not the province of the Court, however, to protect speculations which aim at inducing the public to buy

Collateral misrepresentations.

Fraudulent speculation.

(a) *Leather Cloth Co.'s case*, 1 H. & M. 271; 4 De G. J. & S. 137; 11 H. L. C. 523; *Churton v. Douglas*, Johns. 174; *Hudson v. Osborne*, 39 L. J. Ch. 79; *Massam v. Thorley's Cattle Food Co.*, 14 Ch. D. 748; *Fulton v. Sellers*, 4 Brews. 42; *Pepper v. Labrot*, 8 Fed. Rep. 29; *Société, &c., de la Benedictine v. Micalovitch*, 36 Alb. L. J. 364. But see *Sherwood v. Andrews*, 3 Am. L. Reg. N. S. 588; *Partridge v. Menck*, 2 Sandf. Ch. 622; *Carmichel v. Latimer*, 11 R. I. 395; *Horton Manufacturing Co. v. Horton Manufacturing Co.*, 18 Fed. Rep. 816.

(b) *Holloway v. Holloway*, 13 Beav. 209; *Burgess v. Burgess*, 3 De G. M. & G. 896; *Turton v. Turton*, 42 Ch. D. 128; *Tussaud v. Tussaud*, 38 W. R. 503.

(c) Per U. S. Supreme Court in *Manhattan Medicine Co. v. Wood*, 108 U. S. Rep. 218. And see *Hazard v. Caswell*, 93 N. Y. 259; *Siegert v. Abbott*, 61 Md. 276; *Stachelberg v. Ponce*, 23 Fed. Rep. 430.

(d) *Curtis v. Bryan*, 2 Daly, 212, R. Cox, 434; and see *Ford v. Foster*, L. R. 7 Ch. 611.

(e) *Siegert v. Findlater*, 7 Ch. D. 801. (But this case was questioned in *Siegert v. Abbott*, 61 Md. 276.) *Alexander v. Morse*, 14 R. I. 153; *Moxie Nerve Food Co. v. Baumbach*, 32 Fed. Rep. 205. Thus, in *Blackwell v. Armistead*, 5 Am. L. T. 85, a misstatement as to the date of commencement of the business, made in *bonâ-fide* error by a junior partner, was condoned.

one thing when they think they are buying another; and therefore, where both plaintiffs and defendant were engaged in speculations of that character, although the Court refused, on the ground of the plaintiffs' delay, to grant the injunction they prayed, it declined to give costs to the defendant, who was *in pari delicto* (a). And on similar grounds relief will be refused to a plaintiff who has used his trade mark on goods of inferior quality to those with which the mark has become associated (b), or who has used the mark beyond the limits to which he was confined on the assignment of it to him (b), or who adopted it in infringement of the rights of another (c).

*Hogg v.
Maxwell.*

In *Hogg v. Maxwell* (d) the plaintiff registered, under the Copyright Acts, the title of an intended magazine in 1863, but did not bring out the work. In June 1866 the defendant registered the same name. The plaintiff discovered this in August. He then hastened on his own publication, which was first announced on September 24th, and published next day. In the meantime the plaintiff had, on the 19th, undertaken to advertise the defendant's intended magazine, but retracted the undertaking, and gave the defendant notice of his claim to the title on the 25th. Proceedings were taken by both parties with a view to an injunction, which was refused in both cases, the Court being of opinion, in *Hogg v. Maxwell*, that the plaintiff had got beforehand by improper means, which disentitled him to relief.

(a) *Estcourt v. Estcourt Hop Essence Co.*, L. R. 10 Ch. 276; and see *In re Saunton & Co.*, Dig. 625; *Newman v. Pinto*, 57 L. T. N. S. 31; *Samuel v. Berger*, 24 Barb. 163, R. Cox, 178; *Bloss v. Bloomer*, 23 Barb. 604, R. Cox, 200; *In re American Sardine Co.*, 3 U. S. Pat. Gaz. 495; *In re Dole Bros.*, 12 *ib.* 939; *In re Warburg & Co.*, 13 *ib.* 44; *Ex parte Marsching & Co.*, 15 *ib.* 294; *Ex parte Knapp*, 16 *ib.* 318; *Fairbanks v. Jacobus*, 14 Bl.

C. C. 337, with which compare *In re Green*, 8 U. S. Pat. Gaz. 729.

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

(c) *O'Rourke v. Central City Soap Co.*, 26 Fed. Rep. 576; *Parlett v. Guggenheimer*, 67 Md. 542; *Lawrence Manufacturing Co. v. Tennessee Manufacturing Co.*, 31 Fed. Rep. 776. And see *In re Heaton*, 27 Ch. D. 570.

(d) L. R. 2 Ch. 316.

The Court will not protect persons in carrying on a Short weight trade in which short measure is given systematically and knowingly (a). And in *Hennessy v. Wheeler* (b), the New York Court of Common Pleas refused relief to brandy merchants who sold their brandy in bottles containing quarts and pints of nominal measure, but really considerably less. But this decision was reversed on appeal, on the ground that the bottles were not bought on the faith of their containing any particular quantity of brandy, and that no one was proved to have been deceived or was likely to be so. Similarly, where the plaintiff admitted that his medical preparation was "sold only in quart bottles," and the bottles, though such as were commonly known in the trade as quart bottles, really contained substantially less, it was held that the misstatement was not such as to deprive the plaintiff of his right to protection (c).

9. Word "Patent" improperly used by Plaintiff.

"It is impossible not to see," says Mellish, L. J., "that persons do try to use their right in trade marks for the purpose of getting a monopoly in particular articles, just as if they had a patent for the goods which they manufacture" (d). A special form of misrepresentation consists in the use by persons in their trade marks of words inducing the belief that they have a patent for the articles to which those trade marks are affixed; and the tendency which the use of such words has to procure for the persons using them an unfair monopoly, or to prolong a monopoly granted only for a limited time, causes it to be regarded with special disfavour. The importance of the point is forcibly pointed out by

9. Improper use of word "patent."

(a) See per Giffard, L. J., in *Lee v. Haley*, L. R. 5 Ch. 155.

(b) 51 How. Pr. 457; 69 N. Y. 271.

(c) *Alexander v. Morse*, 14 R. I. 153.

(d) *Singer Manufacturing Co. v. Wilson*, 2 Ch. D. 434-56.

Wood, V.-C., in *Morgan v. McAdam* (a). He says: "All those who are induced to buy these crucibles thus described as 'Patent Plumbago Crucibles,' are to a certain extent deceived, because they are led to believe that the article is protected by a patent, and thus may be induced to purchase it from the plaintiffs, under the belief that there is a patent, and that the plaintiffs, or at least some limited number of persons, are the only persons authorised to sell it; and further, they are led to believe that if they should be minded to set up any manufactory of the same kind for themselves, they would be unable to do so in consequence of the plaintiffs being the possessors, either by way of licence or ownership, of a patent preventing the world at large from imitating the article which is sold by them under this particular designation" (b).

Plaintiff
disentitled.

Where, therefore, the plaintiff has used in his trade mark the word "patent," or words to that effect, although, in point of fact, he has never had a patent for the goods to which the mark is applied, the Court will refuse to extend to him the protection which he has forfeited. Previously to Sir John Rolt's Act (c), liberty was given to the plaintiff to bring an action at law (d); but since then the action has been simply dismissed, with or without costs (e). And the course would be the same if the words were first inserted in the trade mark after the expiration of a patent which had existed (f). In *Sykes v.*

(a) 36 L. J. Ch. 228.

(b) And see per the same learned judge, in *Flavel v. Harrison*, 10 Hare, 467.

(c) 25 & 26 Vict. c. 27.

(d) *Flavel v. Harrison*, *ubi supra*, 467.

(e) *Morgan v. McAdam*, 36 L. J. Ch. 228; *Lamplough v. Balmer*, W. N. 1867, p. 293; *Leather Cloth Co. v. Lonsont*, L. R. 9 Eq. 352; *Nixey v. Roffey*, W. N. 1870, p. 227; and see *Ford v. Foster*, L. R. 7 Ch. 611. In *Stewart v. Smithson*, 1 Hilt.

119, R. Cox, 175, the Court of C. P. of New York refused to recognise this as a defence; but the word "patent" has been refused registration in America in connection with an article made under an expired patent (*In re Richardson*, 3 U. S. Pat. Gaz. 120), and in *In re Consolidated Fruit Jar Co.*, 14 *ib.* 269, the name of a patentee was refused registration. But see *Ex parte Consolidated Fruit Jar Co.*, 16 *ib.* 673.

(f) *Edelsten v. Vick*, 11 Hare, 78.

Sykes (a), a patent had been taken out by the plaintiff's father. That patent was held to be invalid, on account of a defect in the specification, but the use of the word "patent" was not held to disqualify the plaintiff from recovering at law. The question does not seem, however, to have been fairly raised in that early case, and it has been held in America that marks containing a reference to a patent declared to be invalid could not be protected by injunction (b).

There has been some apparent difference of opinion in regard to the case in which the word "patent" has been inserted in the trade mark while the article was still patented, and has been retained there after the patent has run out. In such a case (c), *Wood*, V.-C., held that the plaintiffs were entitled to recover, the blocks for the labels having been made during the existence of the patent, when the representation was perfectly true. Lord Kingsdown, in discussing this judgment (d), said that he agreed with it if the word "patent" were only used as part of the designation of an article, but that he could not do so if the trade mark represented the article as protected by an existing patent. In a subsequent case (e), the Vice-Chancellor explained his meaning as being in harmony with that of Lord Kingsdown. "If originally you have a patent, and the article is in the market as a patent article, and you stamp all your goods which are sent out with these words 'patent pins,' or patent wire,' or whatever the particular article might be, at the end or the expiration of the patent it is not necessary, as I thought, to call in the whole of the previous stamps, and remodel the whole of your stamps, and have a new form of packing your article, in order that you may

(a) 3 B. & Cr. 541.

(b) *Consolidated Fruit Jar Co. v. Dorflinger*, 6 Am. L. T. N. S. 511.

(c) *Edelsten v. Vick*, 11 Hare, 78. And see *Leather Cloth Co. v. Hirschfeld* (1), 1 N. R. 551.

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

(e) *Morgan v. McAdam*, 36 L. J. Ch. 228.

Retention of word after expiration of patent.

inform the world that the patent, which did exist, has expired. Of course it would be better, and those who are inclined to act with scrupulous honesty would take care, to put the date of their patent, which would obviate all difficulty (a), upon the articles which they designate as patented." In a later case (b), it was clearly established by the Court of Appeal that the principle enunciated by Lord Kingsdown is the rule of the Court, and that the use of the word "patent," so as to indicate an existing patent, is equally fatal, whether there has never been a patent for the article in question, or the patent which did exist has expired (c).

Word so used
as not to
deceive.

As has been seen, Lord Hatherley, when V.-C. (d), and Lord Kingsdown (e), were of opinion that when the word "patent" formed part of the name of an article, and did not operate so as to induce a belief in the existence of a patent, the trade mark in which the word appeared might be protected. A distinct decision to this effect was pronounced by James, V.-C., in *Marshall v. Ross* (f), where "patent thread" was compared by the learned judge to "patent leather boots" (g). And where the plaintiffs had described themselves as "patentees" of an article of which they had secured the exclusive manufacture by registration, though not by letters patent, it was held that they were not disentitled (h). In *Lauferty v. Wheeler* (i), it

(a) See *Consolidated Fruit Jar Co. v. Dorflinger*, 6 Am. L. T. N. S. 511; *Wilson v. Singer Manufacturing Co.*, 16 U. S. Pat. Gaz. 1091; *Fairbanks v. Jacobus*, 14 Bl. C. C. 337.

(b) *Cheavin v. Walker*, 5 Ch. D. 850. And see *Fairbanks v. Jacobus*, 14 Bl. C. C. 337; *New York Consolidated Card Co. v. Union Playing Card Co.*, 46 N. Y. Sup. Ct. 611.

(c) The penalties inflicted under § 105 of the Patents Act, 1883, for the improper use of the word "patent," are not, however, incurred by the continued use of the

word upon goods for which a patent has previously been possessed.

(d) *Morgan v. McAdam*, 36 L. J. Ch. 228.

(e) *Leather Cloth Co.'s case*, 1 H. L. C. 523.

(f) L. R. 8 Eq. 651.

(g) See the observations on this case, in *Leather Cloth Co. v. Lonsont*, L. R. 9 Eq. 345. And see, too, *Ransome v. Graham*, 51 L. J. Ch. 897.

(h) *Cave v. Myers*, Dig. 304.

(i) 63 How. Pr. 488; 11 Daly 194.

was held that the plaintiff was not disentitled by reason of having described his goods as "Patent, Sept.," after being officially informed that his application for a patent had been allowed, but before the actual issue of letters patent. Similarly, it seems that a statement that a trade mark is registered before it in fact is so, does not disentitle the proprietor to sue, after registration has been effected (*a*), though it exposes the proprietor to a penalty (*b*), and may affect the costs of the action (*c*). Nor is the proprietor of a registered trade mark disentitled by the fact that he places the word 'registered' on his trade mark when in use, though spaces left blank in the mark as registered are filled in when it is in use (*d*).

A patentee is not bound to decide a doubt as to the validity of his patent adversely to himself, and consequently the plaintiff, in an action for infringement of a trade mark for boot-tips, was held not to be disentitled to relief by the fact that the word "patentee" appeared in his trade mark, he being the owner of an existing patent, notwithstanding that it had been shown that questions might be raised as to the validity of the patent, and the plaintiff had himself admitted that he had some doubt as to the validity (*e*).

When
validity
of patent
doubtful.

The fact that the misrepresentation is so gross as hardly to be capable of deceiving will not exonerate the person making it from the consequences. Thus, the use on untanned leather cloth of the words "tanned patented" was a ground for refusing assistance (*f*).

Grossness of
misrepre-
sentation no
excuse.

Where a plaintiff described himself on his labels as "manufacturer and patentee," it was held that this was

"Manufac-
turer and
patentee."

(*a*) See per Brett, L. J., in *Read v. Richardson*, 45 L. T. N. S. 54.

(*b*) See Patents Act, 1883, § 105, *R. v. Morris*, Great Marlborough St. Police Court, Dec. 16th, 1886.

(*c*) *Harris v. Ogg*, 5 N. S. W. Rep. 114.

(*d*) *M. Melachrino & Co. v. R. Melachrino & Co.*, Chitty, J., May 27th, 1888.

(*e*) *Blakey v. Latham*, 85 L. T. (Journal) 47.

(*f*) *Leather Cloth Co.s' case*, 4 De G. J. & S. 137; 11 H. L. C. 523.

equivalent to describing the article as "patent," and the bill was dismissed, without costs (a). And in *Consolidated Fruit Jar Co. v. Dorflinger* (b), it was held that certain trade marks consisting of the words "Mason's Patent, November 30th, 1858," "Mason's Improved," and "The Mason Jar of 1858," were bad, the patent of 1858 being invalid by judicial decision.

Lamplough v. Balmer.

When a plaintiff used on his stopper labels with the words "Royal Letters Patent," the explanation that he had for twenty-five years paid the stamp duty on "patent medicines," and that he was only continuing to use the labels he had had on hand when he discovered his medicines did not belong to that class, was not accepted as satisfactory, and his motion for an injunction to restrain an imitator was refused (c).

Collateral use of word.

If, however, the plaintiff's trade is a perfectly honest trade, and the trade mark is a perfectly honest trade mark, the fact that the plaintiff has committed a purely collateral misrepresentation, by describing himself, though not in the trade mark itself, as "patentee," will not disentitle him to his remedy (d).

Patents Act, 1883.

By § 105 of the Patents Act, 1883 (e), it is provided

(a) *Nixey v. Roffey*, W. N. 1870, p. 227. And see Patents Act, 1883, § 105.

(b) 6 Am. L. T. N. S. 511.

(c) *Lamplough v. Balmer*, W. N. 1867, p. 293.

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

(e) This replaces § 7 of 5 & 6 Will. IV. c. 83. See *Myers v. Baker*, 3 H. & N. 802. In America a penalty is similarly assigned for the use of the word "Patented" on an unpatented article (U. S. Rev. St. § 4901. See *Wilson v. Singer Manufacturing Co.*, 16 U. S. Pat. Gaz. 1091; *Stimpson v. Pond*, 2 Curtis, 502). And an article which, together with patented elements, contains new and valuable unpatented elements, ought not,

as a rule, to be termed "patented" (*Deverall v. Banker*, 45 U. S. Pat. Gaz. 591). But the penalty is only incurred if there is an intent to defraud (*Tompkins v. Butterfield*, 25 Fed. Rep. 556), and that question is for the jury (*Walker v. Hawhurst*, 5 Bl. C. C. 494; *Deverall v. Banker*, 45 U. S. Pat. Gaz. 591); who are justified in convicting if they are reasonably satisfied upon the evidence as to the material facts, and proof beyond a reasonable doubt is not required; *Hawloetz v. Kass*, 25 Fed. Rep. 765; a corporation is responsible for the act of its superintendent in wrongfully describing an unpatented article as "patented," and will be liable to a penalty if he knew or should

that "any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade mark applied to any article sold by him as registered, which is not so, shall be liable for every offence on summary conviction to a fine not exceeding £5." And it is also provided that "a person shall be deemed, for the purposes of this enactment, to represent that an article is patented, or a design or a trade mark is registered, if he sells the article with the word 'patent,' 'patented,' 'registered,' or any word or words expressing or implying that a patent or registration has been obtained for the article, stamped, engraved or impressed on, or otherwise applied to the article." It has been held under this section that a person is subject to a penalty who represents an article to be patented, after he has applied for a patent and obtained provisional protection, but before the actual grant (a); and, similarly, where a person represents a trade mark to be registered, after he has applied for registration, and the application has been advertised in the "Trade Marks Journal," but before the actual registration (b).

By the Merchandise Marks Act, 1887, § 3 (1), a statement "as to any goods being the subject of an existing patent, privilege, or copyright," is, if untrue, a "false trade description" punishable under the Act. Under § 18, however, the provisions of the Act with respect to false trade descriptions are not to apply to the use of a trade description which "is lawfully and generally applied to goods of a particular class, or manufactured by a particular

Merchandise
Marks Act.

have known that the article was not patented, but not if he *bonâ fide* believed it was so: *Tompkins v. Butterfield*, 25 Fed. Rep. 556. In *U. S. v. Morris* (2 Bond, 23), Leavitt, J., held that the statute did not apply unless the goods were patentable; but in *Oliphant v. Salem Flouring*

Mills (5 Sawy. 128), Deady, J., held that it applied whether the goods were patentable or not.

(a) *R. v. Wallis*, 3 P. R. 1; *R. v. Crampton*, 3 P. R. 367.

(b) *R. v. Morris*, Great Marlborough St. Police Court, Dec. 16th, 1886.

method, to indicate the particular class or method of manufacture of such goods." This will protect such combinations as "patent thread," in *Marshall v. Ross* (a), or "patent leather boots."

INOPERATIVE DEFENCES.

Among the defences which have occasionally been set up in actions for infringement of trade mark, but without success, are the following:

Ignorance

Ignorance of the plaintiff's rights. This will not suffice to prevent the issue of the injunction (b); although it may have the effect of relieving the defendant from the necessity of accounting (c).

No intention to sell.

Absence of intention to sell the goods bearing the spurious mark is no defence (d).

No actual deception or fraud.

Absence of proof of actual deception or fraudulent intention is no defence, if in the opinion of the Court or jury there is such imitation as to be calculated to deceive (e).

Immediate purchasers not deceived.

It is no defence to prove that all the persons who bought from the defendant goods bearing the plaintiff's mark were well aware that they were not of the plaintiff's manufacture (f).

(a) L. R. 8 Eq. 651.

(b) *Burgess v. Hills*, 26 Beav. 244; *Geary v. Norton*, 1 De G. & S. 9; *Cartier v. Carlile*, 31 Beav. 292; *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Moët v. Couston*, 33 Beav. 578; *Orr-Ewing & Co. v. Grant, Smith & Co.*, 2 Hyde, 185; *Weed v. Peterson*, 12 Abb. Pr. N. S. 178; *Upmann v. Forester*, 24 Ch. D. 231; and other cases.

(c) *Edelsten v. Edelsten*, *ubi supra*; *Moët v. Couston*, *ubi supra*; *Rose v. Loftus*, 47 L. J. Ch. 576.

(d) *Upmann v. Forester*, 24 Ch. D. 231. See *Upmann v. Currey*, 29 Sol. J. 735.

(e) *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Cope v. Evans*, L. R.

18 Eq. 138; *Bodega Co., Ltd. v. Owens*, 23 L. R. Ir. 371; *Orr-Ewing & Co. v. Grant, Smith & Co.*, 2 Hyde, 185; *Coats v. Holbrook*, 2 Sandf. Ch. 586, R. Cox, 20; *Taylor v. Carpenter*, 11 Paige, 292; 2 Sandf. Ch. 603, R. Cox, 45; *Coffeen v. Brunton*, 4 McLean, 516, 5 *ib.* 256; R. Cox, 82, 132; *Davis v. Kendall*, 2 R. I. 566, R. Cox, 112; *McLean v. Fleming*, 96 U. S. Rep. 245; *Shaver v. Shaver*, 54 Iowa, 208; *Williams v. Brooks*, 50 Conn. 278; and see Ch. IV., on Infringement.

(f) *Sykes v. Sykes*, 3 B. & Cr. 541; *Edelsten v. Edelsten*, *ubi supra*; *Rose v. Loftus*, 47 L. J. Ch. 576; *Singer Manufacturing Co. v. Loog*

Nor to say that the marks used indicate quality or pattern, if they also indicate a particular manufacturer or merchant (a). Indication of quality as well as manufacturer.

Nor to show that the words, of the use of which the plaintiff complains, are ambiguous and capable of being understood by different persons in different ways (b). Words ambiguous.

Nor to say that the plaintiff's entire mark has not been copied (c). Only part of mark taken.

Nor to say that the name, to the use of which by the defendant the plaintiff objects, is the defendant's own, if he has used it so as to deceive (d). Name used is defendant's own.

Nor to produce a colourable authority to use the name of a person having the same name as that used by the plaintiff in his business (e). Colourable authority.

Nor to say that the goods which the defendant is selling under the mark in question are goods manufactured by the plaintiff or of different quality. Goods plaintiff's own of different quality.

(3), 8 App. Cas. 15; *Balfour & Co. v. Kilburn & Co.*, 1 Hyde, 270; *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 Ch. D. 454; and cases at p. 145 *suprà*.

(a) See cases at p. 69 *suprà*.

(b) *Singer Manufacturing Co. v. Loog* (3), 8 App. Cas. 15, per Lord Selborne, C.; *M. Melachrino & Co. v. R. Melachrino & Co.*, Chitty, J., March 27th, 1888.

(c) *Ford v. Foster*, L. R. 7 Ch. 611; *Wotherspoon v. Currie*, L. R. 5 H. L. 508; *Shaver v. Shaver*, 54 Iowa, 208; and see cases at pp. 150-1 *suprà*.

(d) *Churton v. Douglas*, Johns. 174; *Burgess v. Burgess*, 3 De G. M. & G. 896; *Pullar v. Pullar*, Fry, J., April 9th, 1883; *Nicholls v. Kimpton*, 3 Times L. R. 674; *M. Melachrino & Co. v. R. Melachrino & Co.*, Chitty, J., May 27th, 1888; *Warnerv. Warner*, 5 Times L. R. 359; *Shaver v. Shaver*, 54 Iowa, 208; *India-Rubber Comb Co. v. Rubber Comb and Jewelry Co.*, 45 N. Y. Super. Ct. 258; *Rogers Manufacturing Co. v. Rogers & Spurr Manufacturing Co.*, 11 Fed. Rep. 495;

Russia Cement Co. v. Le Page, 147 Mass. 206; *Gage v. Canada Publishing Co.*, 11 Can. Sup. Ct. 306; and see cases at p. 138.

(e) *Perry v. Truefitt*, 6 Beav. 66; *Croft v. Day*, 7 Beav. 84; *Moct v. Clybourn*, Dig. 533; *Dence v. Mason* (1), Dig. 534; 41 L. T. N. S. 573; *Williams v. Johnson*, 2 Bos. 1; *Phalon v. Wright*, 5 Phila. 464; *Perks v. Hall & Co.*, W. N. 1881, p. 111; *Sawyer v. Kellogg*, 7 Fed. Rep. 721, 9 *ib.* 601; *Meriden Britannia Co. v. Parker*, 39 Conn. 450, 12 Amer. Rep. 401; *Wolfe v. Barnett*, 24 La. Ann. 97, 13 Amer. Rep. 111; *Melachrino & Co. v. Melachrino Egyptian Cigarette Co.*, 4 P. R. 215; *Birmingham Vinegar Brewery Co., Ltd. v. Liverpool Vinegar Co., Ltd.*, W. N. 1888, p. 139; *Williams v. Brooks*, 50 Conn. 278; *Rogers Manufacturing Co. v. Rogers & Spurr Manufacturing Co.*, 11 Fed. Rep. 495. But see *Beard v. Turner*, 13 L. T. N. S. 746; *Hallett v. Cumston*, 110 Mass. 29; *Ayer v. Rushton*, 7 Daly, 9; *Dence v. Brand*, W. N. 1881, p. 31.

factured by the plaintiff, if they are of a different quality from that of which the defendant represents them to be (a).

Equality in quality.

Nor to say that the spurious goods are equal in quality to the genuine ones, for the plaintiff's right is equally invaded (b).

Addition of defendant's name.

The defendant will not escape by showing that he has used his own name in conjunction with the mark or word which is alleged to be used in infringement of the plaintiff's rights (c).

Addition of address.

Nor by showing that he has always placed his own address on the goods (d).

(a) *Hennessy v. Kennett*, Dig. 556; *Hennessy v. White*, 6 W. W. & A'B. Eq. 216; *Hennessy v. Hogan*, *ib.* 225; *Gillott v. Kettle*, 3 Duer, 624.

(b) *Blofeld v. Payne*, 4 B. & Ad. 410; *Edelsten v. Edelsten*, 1 De G. J. & S. 185 (per Lord Westbury, C., "It is not necessary, for the injunction, to prove . . . that the credit of the plaintiff is injured by the sale of an inferior article. The injury done to the plaintiff in his trade by loss of custom is sufficient to support his title to relief"); *Singer Manufacturing Co. v. Loog* (3), 8 App. Cas. 15, per Lord Blackburn; *Coats v. Holbrook*, 2 Sandf. Ch. 586, R. Cox, 20; *Taylor v. Carpenter*, 11 Paige, 292; 2 Sandf. Ch. 603, R. Cox, 45; *Partridge v. Menck*, 2 Barb. Ch. 101, 1 How. App. Cas. 558, R. Cox, 72; *Cook v. Starkweather*, 13 Abb. Pr. N. S. 392; *Shaver v. Shaver*, 54 Iowa, 208; *Coffeen v. Brunton*, 5 McLean, 256, R. Cox, 132.

(c) *Wotherspoon v. Currie*, L. R. 5 H. L. 508; *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 376; *Siegert v. Findlater*, 7 Ch. D. 801; *Braham v. Bustard*, 1 H. & M. 447; *Ford v. Foster*, L. R. 7 Ch. 611; *Kinahan v. Bolton*, 15 Ir. Ch. 75; *Eno v. Stephens*, Dig. 609; *Rose v.*

Loftus, 47 L. J. Ch. 576; *Field v. Lewis*, Dig. 280; *Reinhardt v. Spalding*, 49 L. J. Ch. 57; *Berliner Brauerei Gesellschaft Tivoli v. Knight, Stocks & Co.*, W. N. 1883, p. 70; *Lea v. Wolff*, 15 Abb. Pr. N. S. 1; *Frese v. Bachof* (2), 14 Bl. C. C. 432; *Boardman v. Meriden Britannia Co.*, 35 Conn. 402; *Siegert v. Ehlers*, Dig. 432; *Davis v. Kennedy*, 13 Grant Up. Can. Ch. 523; *Roberts v. Sheldon*, 8 Biss. 398; *Hier v. Abrahams*, 82 N. Y. 519; *Hegeman & Co. v. O'Byrne*, 9 Daly, 264; *Carroll v. Ertheiler*, 1 Fed. Rep. 688; *Fleischmann v. Schuckmann*, 62 How. Pr. 92. But compare *Cheavin v. Walker*, 5 Ch. D. 850; *Barrett v. Gomm*, 74 L. T. (Journal) 388; *Barrett v. White*, North, J., May 12th, 1883; *Mages Furnace Co. v. Le Barron*, 127 Mass. 115; *Thornton v. Crowley*, 47 N. Y. Super. Ct. 527; *Somerville v. Schembri*, 12 App. Cas. 453; *McCall v. Theal*, 28 Grant Up. Can. Ch. 48; *Pratt's Appeal*, 117 Penn. St. 401; *Moxie Nerve Food Co. v. Baumbach*, 32 Fed. Rep. 205; *Leonard & Ellis v. White's Golden Lubricator Co.*, 48 U. S. Pat. Gaz. 1401; *Bryant & May v. Heyde*, 7 N. S. W. Rep. (E.) 72.

(d) *Gray v. Taper Sleeve Pulley Works*, 16 Fed. Rep. 436.

Nor by showing that he has used the word "Improved" in connection with his goods (a). Addition of word "Improved."

Nor by showing that the same mark has been used by other persons on goods of another class (b), or by less than three firms besides the plaintiff on goods of the same class (c), or by different firms abroad, if not in England (d). User by others.

Nor by showing that another trader used the mark before the plaintiff, if that other trader's right to the mark has been adjudged to be gone by reason of misrepresentations contained in it (e). Fraudulent anticipation.

Nor by showing that the plaintiff's trade mark has been infringed by others without his knowledge or acquiescence (f). Infringement by others.

It is no defence to say that the plaintiff uses more than one trade mark on the same goods (g), nor that his goods have been known by a variety of names (h). A plurality of marks or names.

Nor that the plaintiff in practice uses devices, &c., on his trade marks which are not registered as part of them—e.g., filling in blank spaces with coats-of-arms (i). Additions in practice to marks as registered.

Nor that the infringement has been committed in a district in which the plaintiff has appointed a licensee (k). Infringement in district of a licensee.

(a) *Russia Cement Co. v. Le Page*, 147 Mass. 206; *Alexander v. Morse*, 14 R. I. 153; *Humphreys' Specific, & Co. v. Wenz*, 14 Fed. Rep. 250; *Gage v. Canada Publishing Co.*, 11 Can. Sup. Ct. 306.

(b) *Hall v. Barrows*, 4 De G. J. & S. 150; *Ainsworth v. Walmsley*, L. R. 1 Eq. 518; *Somerville v. Schembri*, 12 App. Cas. 453; *Colman v. Crump*, 70 N. Y. 573; *Hegeman & Co. v. O'Byrne*, 9 Daly, 264; *Celluloid Manufacturing Co. v. Cellonite Manufacturing Co.*, 32 Fed. Rep. 94.

(c) *Deat v. Turpin*, 2 J. & H. 139; *Dunnachie v. Young & Sons*, Ct. Sess. Cas., 4th Ser. X. 874; and cases at p. 118.

(d) *Berliner Brauerei Gesellschaft Tivoli v. Knight, Stocks & Co.*, W. N. 1883, p. 70; *Jackson v. Napper*, 35 Ch. D. 162; *Newman*

v. Pinto, 57 L. T. N. S. 31 (per Kekewich, J.). So in Canada: *Smith v. Fair*, 14 Ont. Rep. 729.

(e) *Parlett v. Guggenheimer*, 67 Md. 542.

(f) *Ford v. Foster*, L. R. 7 Ch. 611; *Taylor v. Carpenter*, 3 Story, 458, R. Cox, 14; *Filley v. Fassett*, 44 Mo. 173, R. Cox, 530.

(g) *Braham v. Bustard*, 1 H. & M. 447; *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 376; *Wheeler v. Johnston*, 3 L. R. Ir. 284.

(h) *Orr-Ewing & Co. v. Johnston & Co.* 13 Ch. D. 434.

(i) *Newman v. Pinto*, 57 L. T. N. S. 31 (per Kekewich, J.); *Melachrino v. Melachrino Egyptian Cigarette Co.*, 4 P. R. 215; *M. Melachrino & Co. v. R. Melachrino & Co.*, Chitty, J., May 27th, 1888.

(k) *Moxie Nerve Food Co. v. Baumbach*, 32 Fed. Rep. 205.

Puffing.

Mere exaggerated statements of the merits of medical or other compounds on the part of the plaintiff, which do not amount to fraud, will not exonerate the defendant from the consequences of his own fraud (*a*). Nor will other statements by the plaintiff, which, though not absolutely correct, cannot mislead in any important respect (*b*)—*e.g.*, an allegation that the plaintiff's mark was registered before registration had actually been effected (*c*); or the putting the word "registered" on the mark as used, though spaces left blank in the mark as registered are filled in (*d*).

Slight delay.

The defendant will not escape by alleging laches on the part of the plaintiff in prosecuting his action, if no greater delay has taken place than was requisite to enable necessary evidence to be obtained (*e*).

Infancy.

Infancy is no defence, for "if an infant practises a fraud, he is liable for the consequences" (*f*), and he will be in the same position as an adult with respect to the payment of costs (*g*). And so with a married woman having separate estate (*h*).

Defendant's mark registered.

Registration of the defendant's mark at Stationers' Hall, or in the trade marks register (*c*), is no defence (*i*).

Interference with defendant's business.

Nor is it any defence to say that an injunction, if granted, would interfere with the defendant's business, or with that of other manufacturers, since they will be able to trade as they please, with the sole exception of using the plaintiff's trade mark (*k*).

(*a*) *Holloway v. Holloway*, 13 Beav. 209; *Metzler v. Wood*, 8 Ch. D. 606; *Comstock v. White*, 18 How. Pr. 421. See cases at p. 231.

(*b*) *Siegert v. Findlater*, 7 Ch. D. 801.

(*c*) *Read v. Richardson*, 45 L. T. N. S. 54.

(*d*) *M. Melachrino & Co. v. R. Melachrino & Co.*, Chitty, J., May 27th, 1888.

(*e*) *Lee v. Haley*, L. R. 5 Ch. 155; *Cave v. Myers*, Dig. 304. See

McLean v. Fleming, 96 U. S. Rep. 245.

(*f*) Per Plumer, V.-C., in *Cory v. Gertoken*, 2 Madd. 49.

(*g*) *Chubb v. Griffiths*, 35 Beav. 127.

(*h*) *Nicholls v. Kimpton*, 3 Times L. R. 674.

(*i*) *Reinhardt v. Spalding*, 49 L. J. Ch. 57. And see cases at p. 157.

(*k*) *Ransome v. Graham*, 51 L. J. Ch. 897. See *Cope v. Evans*, L. R. 18 Eq. 138; *Bass v. Dawber*, 19 L. T. N. S. 626.

Discovery and Inspection.

The plaintiff in a trade-mark case sometimes thinks it advisable, for the purposes of his action, to obtain from the defendant a disclosure of certain particulars of his business—as, for instance, of the names of customers to whom the goods alleged to be marked with the plaintiff's trade mark have been sold, or on whose account such goods have been conveyed.

The principles on which this advantage is given or withheld are thus stated by Lord Hatherley, C. (a): “The Court does not, when discovery is a matter of indifference to the defendant, weigh in golden scales the question of materiality or immateriality; but where the nature of the discovery required is such that the giving of it may be prejudicial to the defendant, the Court takes into consideration the special circumstances of the case, and whilst, on the one hand, it takes care that the plaintiff obtains all the discovery which can be of use to him, on the other, it is bound to protect the defendant against undue inquisition into his affairs. The question of materiality must be tested by reference to the case made by the plaintiff's pleadings, and to what will be in issue at the hearing.”

“The more strict the Court is in compelling a full answer, the more necessary it is that the Court should be vigilant in seeing that the process of the Court is not made use of in an oppressive manner” (b). Where, therefore, the L.JJ. were of opinion that the discovery asked was such as the plaintiff, even if he failed at the hearing, might yet afterwards use in a manner prejudicial to the defendant, and were not satisfied that there was any real prospect of its being of material service to the plaintiff at the hearing, they reversed the order of the

(a) *Moore v. Craven*, L. R. 7 Ch. 94. v. *Lockett*, L. R. 4 Ch. 341. And see *Piggott v. Anglo-American Telegraph Co.*, 19 L. T. N. S. 46.

(b) Per Selwyn, L. J., in *Lockett*

Principles on which given.

Not given where oppressive.

Vice-Chancellor of Lancaster, by whom such discovery had been granted (a).

*Benbow v.
Low.*

So in *Benbow v. Low* (b) the defendants exhibited interrogatories requiring the plaintiffs to state (*inter alia*) what quantities of soap had been sold by them bearing the name in dispute, between the dissolution of the original partnership and the date of the action, distinguishing between the quantities sold in each year, and between the quantities sold in England and in the United States and in the continent of Europe; and Bacon, V.-C., and the Court of Appeal held that the plaintiffs were justified in refusing to answer, as the question was framed, not for the ordinary purposes of discovery, but in order to get at the details of a part of the plaintiff's evidence.

Given when
necessary.

On the other hand, "the Court, while it takes care that no oppressive use is made of its forms of procedure, must take care that parties are not allowed to refuse discovery which they ought to make" (c). Where, therefore, a defendant who, having been the agent in London of the plaintiff, an American sewing-machine maker, continued, after dismissal, to advertise himself as the plaintiff's agent, and to sell as "the Howe Sewing Machine" machines not made by the plaintiff, and refused to give discovery of all the machines sold by him, with the prices, profits, names of purchasers, and other particulars, on the ground that he would thereby disclose the names of his customers and the secrets of his trade, Romilly, M. R., held that the discovery might be extremely material to the plaintiff, and ordered it to be given (d). Again,

(a) *Carver v. Pinto Leite*, L. R. 7 Ch. 90. "If the Court sees that all fair and legitimate purposes will be answered by a restricted discovery, it will so restrict it;" per Hall, V.-C., in *Orr v. Diaper*, 4 Ch. D. 92, commenting on this case.

(b) 16 Ch. D. 93.

(c) Per Giffard, L. J., in *Thomp-*

son v. Dunn, L. R. 5 Ch. 576. And see *Renard v. Levinstein*, 10 L. T. N. S. 94; *Russell v. Crichton*, Ct. Sess. Cas., 1st Ser. XV., 1270; *Union Paper Collar Co. v. Metropolitan Collar Co., Ltd.*, 3 Daly, 171; *Byass v. Sullivan*, 21 How. Pr. 50.

(d) *Howe v. McKernan*, 30 Beav. 547.

where the plaintiff obtained an injunction against the defendants, and the defendants offered to submit to an injunction and pay costs, and then moved to stay proceedings, the answer to the plaintiff's interrogatories not having yet been given, Wood, V.-C., said that the plaintiff had a right to ascertain the facts in his own way, by the answer of the defendants to his interrogatories, and that until the defendants had put in their answer, it was impossible for the Court to say whether or not he had done rightly in rejecting the terms offered by the defendants. The motion was dismissed, with costs (a).

In *Leather Cloth Co. v. Hirschfeld* (b), a decree having been made directing the defendant to account for all goods sold by him with a particular stamp, it was decided by the same learned judge that the defendant was compellable to disclose the names of all persons to whom he had sold any such goods, and that if he could not say to which of his customers the stamped goods were sold, he was then (but not otherwise) compellable to disclose the names of all customers to whom he had sold goods which he would not swear positively were unstamped. *Leather Cloth Co. v. Hirschfeld.*

In *Fennessy v. Clark* (c), an action for an injunction to restrain an infringement of trade mark, and for damages on an account, after an order had been made for the trial of issues of fact before a judge and jury, and before the plaintiff had elected between damages and an account, the plaintiff took out a summons for a fuller statement by the defendant of the number of his sales and for inspection of his books; but the application was refused as being premature. *Fennessy v. Clark.*

In *Orr v. Diaper* (d) the plaintiffs discovered that the defendants, who were shippers, had exported large quantities *Action for discovery.*

(a) *Stephens v. Brett*, 10 L. T. N. S. 231.

(b) 1 H. & M. 295.

(c) 37 Ch. D. 184.

(d) 4 Ch. D. 92.

of goods packed and marked in imitation of theirs for certain persons unknown. Being unable to discover the infringers, they applied to the defendants for discovery, and this being refused, instituted an action against them, in which discovery was prayed. The defendants having demurred, on the ground that no relief was prayed or intended to be prayed against them, Hall, V.-C., held that the fact that the plaintiffs required the information for the purposes of an action against the infringers was sufficient, without their intending to bring an action against the shippers, and granted the discovery.

Discovery
under Mer-
chandise
Marks Acts.

By the Merchandise Marks Act, 1862 (a), any person who had sold, &c., any goods marked with a spurious trade mark, was bound, within forty-eight hours after delivery of a demand in writing, to give full information in writing of the name and address of the person from whom he obtained the goods, and of the time when he obtained them. In case of refusal, a justice of the peace might summon and fine the person refusing, and such refusal was *prima-facie* evidence that the person refusing was acquainted with the illegal circumstances.

This provision is not repeated in the Act of 1887, but by § 2 (2) (b) a person who sells or exposes for sale goods having a forged trade mark or false trade description applied thereto is guilty of an offence against the Act, unless he proves, among other things, "that, on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons from whom he obtained" the goods; and § 12 authorises the issue of a search-warrant.

Inspection
under Judica-
ture Acts.

In *Hennessy v. Rohmann* (b), Malins, V.-C., granted inspection of cases and bottles used by the defendants. In *Smith v. Harris* (c), the plaintiff in a trade-mark case

(a) 25 & 26 Vict. c. 88, § 6.
(b) 36 L. T. N. S. 51. This was
under Order LII., r. 3, of the

Rules of Court then in force, now
Order L., r. 3.

(c) 48 L. T. N. S. 869.

alleged by his statement of claim that he had for many years used the word "Glenlivet" on his invoices, letters, billheads, and whiskey casks, and, on the defendant's application, he was ordered to produce for inspection the invoices, letters and billheads in his possession so marked, but not the casks.

In the last-mentioned case the defendant alleged by his statement of defence that the plaintiff had for many years been well aware of the word "Glenlivet" being widely used in the trade in connection with other makes of whiskey; and the Court of Appeal ordered (a) the defendant within an appointed time to deliver particulars of the names of the persons alleged to have used the word with the plaintiff's knowledge, and the times when and places where they had done so, and ordered that, if the defendant should not do so, the paragraph in the defence should be struck out. Again, in *Humphries v. Taylor Drug Co.* (1) (b) the plaintiff in a trade-mark action having alleged by his statement of claim that persons had been deceived, he was ordered to deliver particulars of the names and addresses of the persons alleged to have been deceived.

Account.

A most important part of the remedy given in Equity for the infringement of the rights of the owner of a trade mark is the account of the profits, by which such profits as have been dishonestly acquired by a defendant by means of the reputation of another are restored to the plaintiff, whose they ought to have been at first. The principle is the same as where a man is made to account for the profits which he has improperly received, arising from the fraudulent manufacture of a secret medicine (c), or the publication of a newspaper (d).

(a) Feb. 6th, 1884.
(b) 39 Ch. D. 693.

(c) *Green v. Folgham*, 1 S. & S. 398.
(d) *Giblett v. Read*, 9 Mod. 459.

Incident to
injunction.

“The liability to account for the profits is incident to the injunction” (a), and “on authority and principle it is clear that if a man manufactures goods and knowingly marks them with the trade mark of another person, he is accountable for the profits so made” (b), and that, whether he manufactures on his own account, or only puts up goods for others (c).

Wherever
another's
mark is
placed on the
goods by the
defendant.

So long as the defendant is aware that he is using a trade mark, which is not his, the fact that he does not know to whom the trade mark belongs which is on the goods he is selling does not in the slightest degree affect the right of the owner to an injunction and an account of profits. And since the defendant cannot himself have placed on the goods another's trade mark without being aware that he was infringing some one's trade-mark rights, though he may not have known exactly whose it was, he will be accountable in all cases in which he has himself placed the mark on the goods (d).

Not always
so, where he
bought goods
ready
marked.

But where the defendant has bought marked goods and resold them in ignorance that the trade mark on them was forged, although the plaintiff will be entitled to his injunction, he will not necessarily be entitled to an account, except in respect of any user by the defendant after he became aware of the prior ownership (e). On this principle, in *Ellin v. Slack* (f), a defendant who had bought and resold goods bearing a mark which infringed the plaintiff's trade mark, but without knowledge of the infringement, and who, on hearing of the infringement, had at once desisted from any further sales and offered to submit to

(a) Per Romilly, M. R., in *Cartier v. Carlile*, 31 Beav. 292.

(b) Per Romilly, M. R., in *Moet v. Couston*, 33 Beav. 578. See *Carver v. Bowker*, Dig. 581. The account only extends to goods actually sold under the spurious mark, not to goods manufactured but not sold. See *Stonebraker v. Stonebraker*, 33 Md. 252.

(c) *Sawyer v. Kellogg*, 7 Fed. Rep. 721, 9 *ib.* 601.

(d) *Cartier v. Carlile*, *ubi supra*; *Moet v. Couston*, *ubi supra*. And see S. C. 10 L. T. N. S. 395.

(e) *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Moet v. Couston*, 33 Beav. 578.

(f) 24 Sol. J. 290.

a perpetual injunction with costs, was relieved from accounting.

In many cases the main object of the action is to obtain the injunction, the account being of very secondary importance (*a*); and occasionally the injury suffered by the plaintiff, and the profits received by the defendant, have been so small that the account has not formed part of the relief awarded, so that the old rule that the injunction was subordinate to the account (*b*) no longer holds good.

Account sometimes useless.

As a plaintiff may be disentitled to his injunction by reason of his own laches, so he may be disentitled by the same reason to the account of profits. If he permits the defendant to continue his infringement for a prolonged period, he will not then be allowed to treat him as his salesman, and claim an account (*c*). But if the plaintiff has not been aware of the fact of the defendant's user, the length of that user will not deprive him of his right to an account (*d*).

No account where laches.

Where a defendant offered, among other things, to account for profits, but the plaintiff, declining the offer of submission, insisted upon his own terms, including an account, the Court granted the account, but only upon the plaintiff's request, and at his peril in respect of costs, in case it should turn out that the account furnished by the defendant of his own accord was accurate (*e*).

Offer of submission.

In *Dent v. Turpin* (*f*), where a defendant had infringed a trade mark, which had become by bequest the property of two different persons, and those persons brought distinct actions against the defendant, the prayer in each case

Subdivided account.

(*a*) *Pierce v. Franks*, 15 L. J. Ch. 122; *Burgess v. Hately*, 26 Beav. 249; *Leather Cloth Co. v. American Leather Cloth Co.*, 4 De G. J. & S. 137; *McAndrew v. Bassett*, *ib.* 380; *Barnett v. Leuchars*, 13 L. T. N. S. 495; *Shipwright v. Clements*, 19 W. R. 599, &c.

(*b*) *Delondre v. Shaw*, 2 Sim. 237.

(*c*) *Beard v. Turner*, 13 L. T. N. S. 746; *Harrison v. Taylor*, 11

Jur. N. S. 408; *McLean v. Fleming*, 96 U. S. Rep. 245; *Amoskeag Manufacturing Co. v. Garner* (2), 54 How. Pr. 298; *Holt v. Menendez*, 128 U. S. Rep. 182; *Low v. Fells*, 35 Fed. Rep. 361.

(*d*) *Sawyer v. Kellogg*, 7 Fed. Rep. 721, 9 *ib.* 601.

(*e*) *Nunn v. D'Albuquerque*, 34 Beav. 595.

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

including an account and payment of such share of the profits as should be shown to be attributable to the individual plaintiff's share, it was held that such an account and payment could be granted.

Extent of
account.

As to the extent of the account, it will not be given for a period of more than six years before the commencement of the action, and it will not include every species of profit made by the defendant during that period, but only so much as is properly attributable to the use of the plaintiff's trade mark (*a*). But the defendant must account for the whole of the profits so made without any limitation to the extra profits made by the wrongful use of the trade mark (*b*), even though he may have sustained a loss on his business as a whole (*c*). And the plaintiff is entitled to those profits, and those profits only, and it is immaterial whether he himself would, if the defendant had not infringed, have made profits either greater or less than those (*c*). The account must extend to the whole of the goods sold under the particular mark or in the particular get-up (*d*), and, at all events in case of fraud, to sales prior to the plaintiff's registration, as well as to sales since then (*e*). If the defendant was at first ignorant that he was using a trade mark, the account may be made to commence from the date when he became aware of that fact (*f*); and where the defendant had himself been guilty of misrepresentation, and the defendant's business was carried on upon so much larger a scale than the plaintiff's as to render it impossible to suppose that the use of the plaintiff's mark had alone brought the defendant his customers, the account was only given from the date of filing the bill, and not earlier (*g*).

(*a*) *Cartier v. Carl e*, 31 Beav. 292.

(*b*) *Benkert v. Feder*, 34 Fed. Rep. 534.

(*c*) *Atlantic Milling Co. v. Rowland*, 27 Fed. Rep. 24.

(*d*) *Lever v. Goodwin*, 36 Ch. D. 1.

(*e*) *Smith v. Fair*, 14 Ont. Rep. 729.

(*f*) *Moet v. Couston*, 33 Beav. 578; *Edelsten v. Edelsten*, 1 De G. J. & S. 185.

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

An account of profits is frequently directed at the plaintiff's risk (a). Where an account had been directed of the sale and profits of a book published in infringement of the plaintiff's rights, notwithstanding an affidavit by the defendant that about half of 11,000 copies printed had been sold, and the account showed that 9000 copies had been sold, but that instead of a profit there had been a small loss, it was held that the affidavit had been shown to be untrustworthy, and that the plaintiff was justified in requiring the account to be taken, and was entitled to the costs thereby occasioned (b).

Account directed at plaintiff's risk.

The acceptance of an account of profits by the plaintiff operates as a condonation of the infringement; so that a plaintiff must elect between the account and an inquiry as to damages, but cannot insist on both (c), though he may at the outset claim both, reserving his election till a later stage (d).

Election between account and damages.

Damages.

It is in the option of a successful plaintiff in a trade-mark action to elect between an account of profits and an inquiry as to damages, although, as before stated, he cannot have both (e). Damages being the appropriate remedy at Common Law, while the account of profits was peculiar to Equity, the result, and probably the cause of the great majority of trade-mark cases being brought into Equity, has been that an account has been commonly awarded, and not damages. This has been the case notwithstanding that the Courts of Equity have had the power of giving relief in the shape of damages (f), since

Damages.

(a) As an inquiry as to damages may be. See *Tonge v. Ward*, 21 L. T. N. S. 480.

(b) *Dicks v. Jackson*, Chitty, J., March 31st, 1884.

(c) *Neilson v. Betts*, L. R. 5 H. L. 1.

(d) See *Leidersdorf v. Flint* (2), 50 Wisc. 401.

(e) *Neilson v. Betts*, L. R. 5 H. L. 1. See *Leidersdorf v. Flint* (2), 50 Wisc. 401.

(f) Thus, inquiries as to damages were given in *Cheavin v. Walker*, 5 Ch. D. 850-61; and *Graveley v. Winchester*, Seton, 4th ed. 257.

in most cases the account forms the most convenient remedy.

When given.

Some of the remarks made in reference to the account apply in respect of damages: thus, the defendant is liable in damages for the user of what he has reason to know, or suppose to be, a forged trade mark, though he may be ignorant of the owner; but not necessarily for user of a mark which he did not at all know to be forged (a); while, on the other hand, the plaintiff may be held to be disentitled to damages by reason of his own delay (b).

Special damage need not be proved.

For damages to be recovered it is not necessary that special damage should be proved; it is sufficient to show that the plaintiff's right has been invaded, in which case some damages, even if only nominal, will be given (c). And it has been held in New Zealand that more than nominal damages may be awarded for a fraudulent imitation, even without proof of special damage (d).

Measure of damages.

The measure of damages which can be recovered when special damage is proved is not yet clearly settled by authority; but in *Leather Cloth Co. v. Hirschfeld* (e), it was held by Wood, V.-C., that it would not be assumed in the absence of evidence that the amount of goods sold by the defendant under the fraudulent trade mark would have been sold by the plaintiff but for the defendant's unlawful use of the plaintiff's trade mark; for how could the Court assume that the persons who bought what the plaintiff averred were inferior articles, at an inferior price, would necessarily, if they had not done so,

(a) *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Cartier v. Carlile*, 31 Beav. 292; *Moct v. Couston*, 33 Beav. 578; 10 L. T. N. S. 395. Thus, in *Weed v. Peterson*, 12 Abb. Pr. N. S. 178, it was held that, though an injunction must be granted with costs, yet, as the defendants had acted perfectly *bonâ fide*, no damages could be given.

(b) *Amoskeag Manufacturing Co.*

v. Garner (2), 54 How. Pr. 298; *Holt v. Menendez*, 128 U. S. Rep. 182.

(c) *Blofeld v. Payne*, 4 B. & Ad. 410; and see *Sykes v. Sykes*, 3 B. & Cr. 541; *Morison v. Salmon*, 2 Scott, N. R. 449; 2 Man. & G. 385; and cases at p. 179, n. (a).

(d) *Littlejohn & Son v. Mulligan*, 3 N. Z. L. R. (Sup. Ct.) 446.

(e) L. R. 1 Eq. 229. See *Davenport v. Rylands*, L. R. 1 Eq. 302.

have bought the superior articles at the higher prices? In America, however, it has been said that "every consideration of reason, justice, and sound policy demands that one who fraudulently uses the trade mark of another should not be allowed to shield himself from liability for the profit he has made by the use of the trade mark on the plea that it is impossible to determine how much of the profit is due to the trade mark and how much to the intrinsic value of the commodity. The fact that it is impossible to apportion the profit renders it just that he should lose the whole" (a); and the usual practice in America appears to be to assess damages at the amount of the profits which the plaintiffs would have made if they had sold the same quantity of the genuine goods as the defendants had sold of the spurious ones (b), or, at all events, at the amount of the actual profits reaped by the defendants from the infringement (c). The observation, however, seems just, that the measure of damages is really the injury done to the plaintiffs, and not the profits made by the defendants (who in the case referred to were selling at lower prices than the plaintiffs) (d); and in an Indian case (e), where it was shown that the price of the plaintiff's goods had been necessarily lowered in consequence of the defendants' fraudulent competition, it was held that the amount of the reduction in price gave the measure of damages. So it was said in *Atlantic Milling Co. v. Robinson* (f) that the extent to which the defendants' infringement had interfered with the plaintiff's sales was the measure of damages.

Where a defendant offered submission in terms which Offer of submission.

(a) Per Crockett, J., in *Graham v. Plate*, 40 Cal. 593, 6 Amer. Rep. 639.

(b) *Hostetter v. Vowinkle*, 1 Dill. 329; *Faber v. Hovey*, Dig. 481.

(c) *Graham v. Plate*, *ubi supra*; *Peltz v. Eichele*, 62 Mo. 171.

(d) *Vulcan Match Co. v. Jebson & Co.*, 1 Kyshe, 650. See *Addington v. Cullinane*, 28 Mo. App. 238.

(e) *Manockji Petit Manufacturing Co. v. Mahalaxmi Spinning & Weaving Co., Ltd.*, Ind. L. R. 10 Bomb. 617.

(f) 20 Fed. Rep. 217.

were rejected by the plaintiff, the latter was allowed an inquiry as to damages at his own risk (*a*).

Costs—(i.) in Actions.

General rule as to costs—follow event.

The same general principles on which costs are given in other cases prevail in those in which a question of trade mark is at issue. Thus, the primary rule is that costs follow the event: that is to say, that where a plaintiff succeeds, he will get his costs (*b*); where he is unsuccessful, he will have to pay costs (*c*). The fact that merely nominal damages have been awarded will not deprive a successful plaintiff of his right to his costs, since a question of his right has been involved (*d*). And where a plaintiff had registered a label containing common words, without a disclaimer, it was held that this was not such a wrongful act as to disentitle him to costs as against the defendants, who had used an identically similar label (*e*).

Relief sometimes granted without costs.

Costs, however, being in the discretion of the Court, the Court will, under some circumstances, grant the injunction, but without costs, as where the plaintiff has persisted in litigation which had become unnecessary (*f*), or where the successful plaintiff has been guilty of delay (*g*). So, again, where forwarding agents, who had been made the medium for importing spuriously marked cigars, had not participated in the fraud, had offered to give what

(*a*) *Tonge v. Ward*, 21 L. T. N. S. 480. See *Dicks v. Jackson*, Chitty, J., March 31st, 1884.

(*b*) *Chappell v. Davidson*, 2 K. & J. 123; *Farina v. Silverlock*, 1 K. & J. 509; 6 De G. M. & G. 214; 4 K. & J. 650; *Collins Co. v. Walker*, 7 W. R. 222; *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *McAndrew v. Bassett*, 4 *ib.* 380.

(*c*) *Woollam v. Ratcliff*, 1 H. & M. 259; *Williams v. Osborne*, 13 L. T. N. S. 498; *Morgan v. McAdam*, 36 L. J. Ch. 228; *Bass v. Dawber*, 19 L. T. N. S. 626; *Lucke v. Webster*, M. R., April 4th, 1879; *Watt v. O'Hanlon*, 4 P. R. 1.

(*d*) *Morison v. Salmon*, 2 Scott, N. R. 449; 2 Man. & G. 385. But in a similar case the Canadian Court gave no costs: *Bondier v. Depatie*, 3 Dorion 233.

(*e*) Per Kekewich, J., in *Newman v. Pinto*, 57 L. T. N. S. 31.

(*f*) *Millington v. Fox*, 3 My. & Cr. 338; *Moet v. Couston*, 33 Beav. 578; *Hudson v. Bennett*, 12 Jur. N. S. 519.

(*g*) *Millington v. Fox*, 3 My. & Cr. 338; *Beard v. Turner*, 13 L. T. N. S. 746; *Perks v. Hall & Co.*, W. N. 1881, p. 111; *Amoskeag Manufacturing Co. v. Garner* (2), 54 How. Pr. 298.

information they could, and had submitted to act as the Court should direct (a).

Under some circumstances the plaintiff may obtain his Relief injunction and yet have to pay the costs of some defendants, ^{granted,} ^{plaintiff to} as where a dock company was innocently in possession of ^{pay costs.} spuriously marked goods (b). And again, where wine bearing a spurious brand was in the possession of wharfingers, it was held by the Court of Appeal that they were entitled to their costs of being made defendants to an action for infringement, notwithstanding that they had submitted to act as the Court should direct only upon having their charges and costs paid or provided for (c).

On the other hand, while the relief claimed by the plaintiff is refused, the defendant may still be left to pay his own costs, as where the plaintiff has lost his remedy by lapse of time (d), or improper use of the word "patentee" (e), or other similar reasons (f), the defendant's fraudulent intention being evident; or, more commonly, where the defendant's conduct, though not so clearly fraudulent as to entitle the plaintiff to an injunction, has yet been so suspicious and uncandid as to call for some punishment (g). Thus, where the Vice-Chancellor considered that the defendant had acted fraudulently, but thought himself bound by a decision of the Court of

(a) *Upmann v. Elkan*, L. R. 7 Ch. 130. See *Moet v. Pickering*, 8 Ch. D. 372.

(b) *Upmann v. Elkan*, *ubi supra*.

(c) *Moet v. Pickering*, *ubi supra*.

(d) *Rodgers v. Rodgers*, 31 L. T. N. S. 285.

(e) *Nixey v. Rossy*, W. N. 1870, p. 227. And where a plaintiff company was held to be disentitled to an injunction by reason of the wrongful use of the word "patent," and the defendant, as having been the company's manager, was in some sense responsible for this, he was deprived of the costs which would otherwise have been given

him: *Leather Cloth Co. v. Lorsoni*, L. R. 9 Eq. 345.

(f) *E.g., Fetridge v. Wells*, 13 How. Pr. 385, R. Cox, 180.

(g) *Edgington v. Edgington*, 11 L. T. N. S. 299; *Bass v. Dawber*, 19 L. T. N. S. 626; *Ainsworth v. Walmsley*, L. R. 1 Eq. 518; *Wylam v. Clarke*, W. N. 1876, p. 68; *Robineau v. Charbonnel*, W. N. 1876, p. 160; *Borthwick v. Evening Post, Ltd.*, 37 Ch. D. 449. See *Humphries v. Taylor Drug Co.* (2), 59 L. T. N. S. 820; also *Fallcot v. Moore*, 13 N. Y. Sup. Ct. 106; *Degraves v. Whiteman*, 5 Vict. L. R. Eq. 304; *Hop Bitters Manufacturing Co. v. Luke*, 10 Vict. L. R. (E.) 234.

Appeal on the motion to dismiss the bill, he did so without costs (a). Where the defendant had filled with his own lime-juice bottles brought to him for the purpose, though they were stamped with the plaintiff's name, and the plaintiff brought an action, making charges which amounted to fraud, but which the Court did not consider to be justified, though the defendant had done that which he was not entitled to do, and the defendant gave an undertaking not to repeat the offence, no order was made, and each party was left to pay his own costs (b). Frequently the costs of interlocutory proceedings will be made costs in the cause, as where, on motion for injunction, the plaintiff failed on the score of delay (c).

Apportionment of costs.

In some cases a portion only of the relief asked for has been granted, and the costs have either been apportioned in a manner corresponding to the amount of success achieved, or each party has been left to pay his own costs. Thus, where a plaintiff company succeeded on the question of imitation of labels and wrappers, but failed as to trade mark, the plaintiffs were given their costs up to the motion for injunction, each party having to bear his own after that (d). In *Day v. Neale* (e) no costs were given on either side, the plaintiffs having asked for an injunction in respect of several trade marks, in only two of which they had an exclusive right, and having delayed to take proceedings for more than two years, while the defendants were in the wrong as to the two marks. In *Metzler v. Wood* (f) the plaintiffs, who succeeded on the main question of imitation of the title of their publication, were deprived of half their costs, on

(a) *Wotherspoon v. Currie*. See L. R. 5 H. L. 510.

(b) *Rose v. Loftus*, 47 L. J. Ch. 576; and see *Perks v. Hall & Co.*, W. N. 1881, p. 111. So in N. S. W., where the successful party had untruly marked his goods as if the mark were registered: *Harris v. Ogg*, 5 N. S. W. Rep. (E.). 114.

(c) *Isaacson v. Thompson*, 41 L. J. Ch. 101. And see *Brook v. Evans*, 2 L. T. N. S. 740; *Wallis v. Wallis*, 4 Dr. 458.

(d) *Compagnie Laferme v. Hendrickx*, Dig. 512. And see *Jackson & Co. v. Napper*, 35 Ch. D. 162.

(e) V. C. B. May 24th, 1881.

(f) 8 Ch. D. 606.

the ground of their having made claims as to copyright which failed. Where a plaintiff succeeded in establishing a limited right in a word, and also that the defendant had acted fraudulently, but he failed to show a general right in the word, and that certain labels used by the defendant were deceptive, the defendant was ordered by the Irish Court to pay the general costs of the suit, but the plaintiff was ordered to pay and set off against his own costs the costs of all the affidavits of the defendant's witnesses (except that of the defendant himself), since they had been addressed to the part of the case on which the plaintiff failed (a). In a Bombay case (b), in which six marks were in question, and the defendants succeeded as to all but one, which they had offered to give up within six days after the commencement of the suit, it was held that the defendants must only pay their own costs with regard to that mark, and one-sixth of the plaintiffs' costs up to and including the day on which the offer was made, and that all the remaining costs of both parties must be paid by the plaintiffs. Where a defendant had untruly alleged that he was the first to use a word in dispute, and that the plaintiff had copied from him, no costs were given, though the action was dismissed (c).

If a plaintiff makes charges which he is unable to substantiate, he may obtain an injunction with costs, and yet have to pay all costs occasioned by the making of that charge (d). In the same way, if a plaintiff insists upon having an account taken, after the defendant has given full information, the plaintiff will have to pay the costs of that account if it turn out to have been unnecessary (e).

When a defendant in a trade-mark action submits to a perpetual injunction with costs, the mere fact of his

Costs of unfounded charges, &c.

Scale of costs when defendant submits.

(a) *Wheeler v. Johnston*, 3 L. R. Ir. 284.

(b) *Wallace & Co. v. King & Co.*, Bombay High Ct., April 30th, 1879.

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

(d) *Pierce v. Franks*, 15 L. J. Ch. 122; *Standish v. Whitwell*, 14 W. R. 512; *Wylam v. Clarke*, W. N. 1876, p. 68.

(e) *Nunn v. D'Albuquerque*, 34 Beav. 595.

having submitted constitutes no special ground, under R. S. C., 1883, Order LXV., r. 9, for directing the costs to be taxed on the higher scale, but in such a case the Court will refuse to punish him for submitting at once, and will leave the costs to be taxed on the lower scale (*a*). But there may be cases in which costs will be given on the higher scale—*e.g.*, where the action has been fought out at great length (*b*).

Costs of
motion to
commit.

A motion to commit for breach of an injunction is not unfrequently made without any intention of obtaining an order for actual committal, but the defendant can only be ordered to pay the costs of such a motion if the facts would have warranted a committal (*c*). But where an order for committal was rescinded by the Court of Appeal, no costs were given the defendant, on account of the equivocal conduct of some of his agents (*c*). Where a motion to commit was dismissed on the ground of delay, as well as that the actual terms of the injunction had not been disobeyed, though its spirit had been, the Vice-Chancellor, while refusing the motion, enlarged the injunction and made the defendant pay the costs (*d*). In a case in which the Supreme Court of New York had fined a defendant for contempt, the Court of Appeals, while considering itself bound by the decision of the Supreme Court as to the fact of the breach, yet thought the decision so doubtful that it gave no costs of the appeal (*e*).

Costs of
appeals.

The costs of appeals are usually governed by the same principle as those in the Courts of First Instance, and follow the event. Thus, in *McLean v. Fleming* (*f*), in which the U. S. Circuit Court considered the plaintiff to be entitled to an injunction and an account, but the Supreme Court reversed the decision with respect to the

(*a*) *Hudson v. Osgerby*, 50 L. T. N. S. 323.

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

(*c*) *E.g., Dence v. Brand*, W. N. 1881, p. 31.

(*d*) *Cartier v. May*, Dig. 200.

(*e*) *Derlin v. Derlin*, 69 N. Y.

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

account, on the ground of the plaintiff's own laches, it was held that the plaintiff must have his costs in the Court below, but the defendant (appellant) his costs of the appeal. The costs of an unnecessary appeal must be paid by the appellant. Thus, where a respondent appeared at the hearing of an appeal, after having received notice from the appellant that no alteration would be asked in the order in the Court below with respect to his costs, which the appellant had been ordered to pay, that respondent was left to pay the costs of such appearance (a). And where, in an action for imitation of the name of the plaintiffs' journal, the plaintiffs brought on an appeal from the decision of the judge directing the motion for an injunction to stand to the hearing, after the defendants had changed the name of their publication, the plaintiffs were ordered to pay the costs of the appeal, notwithstanding that the defendants had refused to submit to an injunction, or to give an undertaking as to their original title (b). In *Newman v. Pinto* (c) the plaintiff, who had succeeded in the Court of First Instance, was held by the Court of Appeal to be disentitled to relief on the ground of misrepresentations contained in his trade mark; but the defendants, who had used the same trade mark, containing the same misrepresentations, were not allowed the general costs of the action, but only the costs of the appeal.

One of the main objects which the Court has in view in the exercise of its jurisdiction is "to repress unnecessary litigation, and to keep litigation within those bounds which are essential to enable the parties to vindicate and establish their rights" (d). Although, therefore, a plaintiff whose rights have been attacked is not bound to rely on the assurance of his assailant that the act will

Costs in case of compromise.

(a) *Upmann v. Elkan*, L. R. 7 Ch. 130.

(b) *Dale v. Smith*, W. N. 1892, p. 145.

(c) 57 L. T. N. S. 31.

(d) Per Lord Cottenham, C., in *Millington v. Fox*, 3 My. & Cr. 338.

not be repeated, but is entitled to the protection of an injunction (a), yet if he, immediately after the suit is commenced, is offered and may obtain all he seeks, and still thinks proper to go on with the suit, the Court may give him his decree, but will not give him the costs of the suit so unnecessarily prosecuted (b). The defendant is, however, the aggressor, since the litigation has been first occasioned by his unwarrantable interference with the plaintiff's rights in respect of his trade mark, and this is equally the case whether the aggression was made with knowledge or in ignorance of those rights of the plaintiff. The defendant must therefore offer all the plaintiff has a right to obtain, and the offer must include all the costs which have been occasioned by his improper conduct (c). Thus, where in a patent case an injunction was granted, the defendants having previously promised to commit no further infringement and to pay the costs of preparing the bill, Knight Bruce, V.-C., gave the plaintiffs their costs at the hearing, since the defendants ought to have offered, on the injunction being obtained, to pay all costs up to that time (d). The same result followed where a defendant, who had offered to pay the taxed costs as between party and party, but refused to pay them as between solicitor and client, put in his answer,

(a) *Geary v. Norton*, 1 De G. & S. 9; *Routh v. Webster*, 10 Beav. 561; *Tonge v. Ward*, 21 L. T. N. S. 480; *Coats v. Holbrook*, 2 Sandf. Ch. 586, R. Cox, 20; *Radway v. Coleman*, 15 Grant Up. Can. Ch. 50; *Guardian Fire and Life Assurance Co. v. Guardian and General Insurance Co., Ltd.*, 50 L. J. Ch. 252.

(b) Per Wigram, V.-C., in *Colburn v. Simms*, 2 Hare, 560, commenting on *Millington v. Fox*; and see *McAndrew v. Bassett*, 4 De G. J. & S. 380; *Hudson v. Bennett*, 12 Jur. N. S. 519; *Upmann v. Elkan*, L. R. 12 Eq. 140, 7 Ch. 130; *Williams v. Osborne*, 13 L. T. N. S. 498.

(c) *Fradella v. Weller*, 2 R. & M. 247; *Kelly v. Hooper*, 1 Y. & C. Ch. 197; *Geary v. Norton*, 1 De G. & S. 9; *Burgess v. Hills*, 26 Beav. 244; *Burgess v. Hately*, 26 Beav. 249; *Wallis v. Wallis*, 4 Dr. 458; *Collins Co. v. Walker*, 7 W. R. 222; *Moet v. Couston*, 33 Beav. 578; *Num v. D'Albuquerque*, 34 Beav. 595; *Coats v. Holbrook*, 2 Sandf. 586, R. Cox, 20; *Weed v. Peterson*, 12 Abb. Pr. N. S. 178.

(d) *Geary v. Norton*, *ubi supra*. See *Lochgelly Co. (Limited) v. Lumphinnans Iron Co.*, Ct. Sess. Cas., 4th Ser. VI. 482.

and then, the plaintiff offering to accept the costs as between party and party, declined to pay the costs of the answer (a). But if an innocent infringer withdraws all marked articles from sale, and offers an undertaking immediately upon being served with the writ, and the plaintiff afterwards moves for an injunction, the motion will be refused with all costs, less the costs of the writ, which will have been incurred before the defendant's offer (b).

It has been thought that a person whose trade mark ^{Notice to infringer.} has been infringed should give notice to the infringer of his intention to take proceedings, so as to give him an opportunity of explaining his conduct or submitting (c); and if he does so, and a fair offer is made, he should not hasten to incur needless expense (d), or he may be punished in respect of costs. Lord Romilly, M. R., was, however, of opinion (e) that, the defendant having been the aggressor, the plaintiff would be justified in filing his bill without making any application to the defendant; and in *Upmann v. Elkan* (f) he indicated his adherence to the same view, saying that he did not mean to lay down that the person whose trade mark had been imitated might not file a bill without making any inquiry at all. In the later case of *Upmann v. Forester* (g), Chitty, J., decided in accordance with this opinion, giving costs to a plaintiff who had moved for an injunction without giving any previous notice, though the defendant had acted perfectly innocently, and would have submitted if

(a) *Kelly v. Hooper*, 1 Y. & C. Ch. 197.

(b) *Caruncho v. Highmoor*, 27 Sol. J. 199.

(c) *Chappell v. Davidson*, 2 K. & J. 123; *Wallis v. Wallis*, 4 Dr. 458; *Twentsche Stoom Bleekery Goor v. Ellinger & Co.*, 26 W. R. 70.

(d) *Williams v. Osborne*, 13 L. T. N. S. 498. And see the opinion of Jessel, M. R., cited in *Upmann v. Forester*, 24 Ch. D. 231, and *In re Kuhn & Co.*, 53 L. J. Ch. 238.

(e) In *Burgess v. Hately*, 26 Beav. 249. In *Field v. Lewis*, Dig. 280, Wood, V.-C., granted an injunction with costs, though no notice had been given before bill filed. And see *Coats v. Holbrook*, 2 Sandf. Ch. 586, R. Cox, 20; and *Sawyer v. Kellogg*, 7 Fed. Rep. 721, 9 *ib.* 601.

(f) L. R. 12 Eq. 140; L. R. 7 Ch. 130.

(g) 24 Ch. D. 231.

notice had been given him. And he stated that this was also the opinion of Jessel, M. R. (a). The reason assigned by Chitty, J., for this decision appears to be that, if the plaintiff were to give notice to the defendant, and the defendant were to submit, the plaintiff would lose his costs; but it might be thought that the plaintiff would be sufficiently secured in this respect by the rule above stated, that an offer of submission must, to be effectual, include an offer of all costs occasioned to the plaintiff, and that no injustice would be done to the plaintiff, but a very possible injustice to an innocent defendant might be minimised, by requiring notice to be given. And in *Upmann v. Currey* (b), a case very similar to *Upmann v. Forester* (c), the innocent defendant offered in court to empty and deliver up or destroy the boxes in which the cigars had been sold to him, and which were labelled (but without his knowledge) in imitation of the plaintiff's boxes, and Smith, J., refused an injunction, and gave no costs on either side.

Infancy does not excuse from costs.

A plea of infancy will not excuse an infant infringer from paying the costs which his conduct has occasioned (d). And so with a married woman having separate estate (e).

Costs occasioned to a third party by defendant's fraud.

A person who has induced another person to manufacture for him goods marked with the trade mark of a third person is liable to repay to the person he has made the instrument of his fraud the costs of legal proceedings brought about by the infringement, including any sum which that person may have reasonably paid to compromise the matter (f).

(a) See per Jessel, M. R., in *In re Kuhn & Co.*, 53 L. J. Ch. 238, and *Barrett v. Gomm*, 74 L. T. (Journal) 388. Also *Fennessy v. Day*, 55 L. T. N. S. 161. So *Siebert v. Lawrence*, 11 Vict. L. R. 47, in Victoria.

(b) 29 Sol. J. 735.

(c) 24 Ch. D. 231.

(d) *Cory v. Gertchen*, 2 Madd. 49; *Chubb v. Griffiths*, 35 Beav. 127.

(e) *Nicholls v. Kimpton*, 3 Times L. R. 674.

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

Costs—(ii.) in Registration Cases.

When an application for the registration of a trade mark is opposed and brought before the Court, the costs are usually ordered to be paid by the unsuccessful party, as having been occasioned by his wrongful claim or opposition. Thus, where a claim was made to register and use a trade mark, which would have been an infringement of an existing mark, the persons who wrongly claimed the mark were ordered to pay the costs of cross-adjourned summonses, as well as of an action for an injunction which had been rendered necessary by the claim (a). And in *In re Rosing* (b), the Cutlers' Co. of Sheffield, who had opposed an application in what they believed to be the interest of the public (and whose opposition succeeded in the Court of Appeal), were ordered by V.-C. Bacon to pay the costs of their opposition, which failed before him. Costs in registration cases.

If, on the other hand, each party is partially successful, no costs will be given on either side (c). And where application was made for the registration of a label containing descriptive words, and the applicants disclaimed some of the descriptive words, but not all, and conducted their case on the footing that registration would give them an exclusive right to such words, the Court of Appeal held that though the registration must be granted, and would not have the effect of giving any such right, the litigation had nevertheless been caused by the applicants, and no costs could be given them (d). And in *In re Dunn* (e), in which the Court of Appeal reversed the refusal of the Court below to allow registration, they No costs.

(a) *Davis v. Tylor*, M. R., April 24th, 1879. See *Jackson & Co. v. Napper*, 35 Ch. D. 162; *In re Grossmith*, 60 L. T. N. S. 612; *In re Burgoyne*, 61 L. T. N. S. 39.

(b) 54 L. J. Ch. 975.

(c) *In re Jelley, Son & Jones*, 51

L. J. Ch. 639; *In re Rosing*, 54 L. J. Ch. 975; *Mouson & Co. v. Boehm*, 26 Ch. D. 398.

(d) *In re Hudson*, 32 Ch. D. 311. And see *In re Swift Specific Co.*, P. R. 352.

(e) 41 Ch. D. 444.

only gave costs of the appeal, and none of the hearing below.

Costs paid by successful applicant.

Where an applicant took advantage of the precise wording of the Act of 1875 to obtain registration as a part of his trade mark of words to the exclusive use of which he was not entitled, and the application was unsuccessfully opposed, Jessel, M. R., held that, notwithstanding the success of the applicant, he must still pay the costs of the application, as he was taking advantage of the Act to do that which the Act did not intend him to do (a).

Costs of comptroller.

Where the comptroller (formerly the registrar) is served with notice of an application to the Court, he is entitled to appear on the hearing of the application, and to receive his costs of so doing, since it is proper that he should know what order is made (b).

When he opposes.

Where the comptroller opposes an application, and his opposition fails, he will not usually be required to pay the costs of the successful applicant (c); and the rule has in fact been established that the comptroller will generally receive his costs, whether successful or unsuccessful (d), but where the case is a test case, each party may be left to pay his own costs (d). Formerly it seems that costs might be given against him if he opposed in a case in which the Court pronounced the applicant's mark, not only to be distinct from the mark which the comptroller supposed it to resemble, but to be so distinct that the comptroller was acting wrongly in objecting (e). And in one case (f) in which the comptroller's objection succeeded no costs were given him, because he had not merely submitted the claim to the Court, but had

(a) *In re Maignen*, 28 W. R. 759.

(b) This has been repeatedly so laid down: e.g., *In re Orr-Ewing* (2), 28 W. R. 412.

(c) *In re Rotherham*, 14 Ch. D. 585.

(d) *In re Van Duzer*, 34 Ch. D. 623; *In re Leaf, Sons & Co.*, 34 Ch. D. 632.

(e) *In re Patent Plumbago Crucible Co.*, M. R., August 1st, 1879.

(f) *In re Jones Bros.*, V.-C. H., July 10th, 1880.

actively disputed it and filed evidence. But no reliance can now be placed on these decisions.

Since, by the terms of the old Rule 16 (a), an opposed application did not stand for the determination of the Court until the comptroller informed the applicant that the opponent had given security, no costs incurred before that point in the proceedings, but only those incurred after it, could formerly be given by the Court or be included in an order to pay costs (b); and it has been held that the Court cannot even now give a successful opponent the costs of the proceedings in the Registry Office, under either § 69 or § 90 of the Patents Act, 1883 (c).

If a person registers as his property a trade mark to which he is not entitled, he will, as a rule, have to pay the costs of the necessary application to remove it from the register (d), though there may be exceptional cases in which this rule will not be followed: as if the mark was originally his property, but has become common through the common piracy of the trade, and they have delayed to apply for removal for some time after his registration, and have then done so without notice to him, he being a foreigner (e); or if the mark is removed from the register on the application of a person who has copied it, and who has only applied for rectification under stress of an action for infringement (f). Again, where a mark was removed from the register by the Court of Appeal on a ground which had not been raised in the Court below, and the applicant had acted in a fraudulent manner, no costs were given in either Court (g). As a rule, a person who fails in an

Extent of costs.

Costs of application to remove.

(a) Since repeated in § 69 of the Patents Act, 1883, as amended.

(b) *In re Brandreth*, 9 Ch. D. 618.

(c) *In re Australian Wine Importers, Ltd.*, 41 Ch. D. 278.

(d) *In re Hyde & Co.*, 7 Ch. D. 724; *In re Palmer* (3), 24 Ch. D. 504; *In re Kuhn & Co.*, 53 L. J. Ch. 238; *Burland & Co. v. Broxburn*

Oil Co., Ltd. (2), 42 Ch. D. 274; *In re Vignier*, 6 P. R. 490.

(e) *In re Kuhn & Co.*, 53 L. J. Ch. 238.

(f) *In re Perry, Davis & Son*, 58 L. T. N. S. 695; *Humphries v. Taylor Drug Co.* (2), 59 L. T. N. S. 820. See *In re Gianacelis*, 58 L. J. Ch. 782.

(g) *Thompson v. Montgomery*, 41 Ch. D. 35.

application to rectify will have to pay the costs of the application (a).

Security
for costs.

Where a firm of shipowners had been restrained, as carriers, from parting with cases of mineral waters containing bottles alleged to bear infringements of the plaintiffs' labels, and an American resident claimed to be the owner of the goods, and applied for leave to re-ship them to Hamburg, it was held that he must give security for the costs of his application (b). And where an application for the registration of a trade mark was made by a foreign resident and opposed, it was held that he must give security for costs, and that, unless he did so within seven days, his application must be refused without further order (c).

Costs of oppo-
sition leading
to abandon-
ment of appli-
cation.

When an application for registration is abandoned after notice of opposition, the comptroller has power to award costs to the opponent (d).

(a) *In re Atkins Filter & Engineering Co., Limited*, 3 P. R. 164.

(b) *Apollinaris Co. v. Wilson*, 31 Ch. D. 632.

(c) *In re Hurter*, W. N. 1887, p. 71.

(d) P. A. 1883-S, § 69 (5).

CHAPTER VIII.

CASES ANALOGOUS TO THOSE OF TRADE MARK.

IN addition to the cases in which there has been an infringement of trade mark properly so called, a variety of cases have been decided in which the Court has restrained the practice of fraud by one person at the expense of another, the means adopted to perpetrate the fraud resembling to some extent the infringement of a trade mark, but yet being distinguishable therefrom. Cases not strictly trade mark cases.

A trade mark is a technical matter, and for there to be an infringement of trade mark there must be a valid trade mark in existence—that is to say, there must not only be such a device in existence as is capable of forming a trade mark, but it must be actually attached to vendible articles in the market (*a*), or must (at least, if first used since the Trade Marks Act of 1375) be properly registered under the Patents Act, 1883 (*b*). Cases of true trade mark.

Where, however, there has been a representation that one thing is another, by means of which one person has secured custom intended for another, so that both the purchaser and the genuine trader have been defrauded, there the Court will interfere and protect the right of both parties to trade freely without fraudulent deceptions, although the fraud has taken another form than that of imitating a trade mark. Cases not of true trade mark.

An important class of cases of this description consists Trade name.

(*a*) *McAndrew v. Bassett*, 4 De G. J. & S. 380; *Maxwell v. Hogg*, L. R. 2 Ch. 307. See also *In re Leonard & Ellis*, 26 Ch. D. 288.

(*b*) See the Patents Act, 1883, § 77, as amended by the Act of 1888. Also *Edwards v. Dennis*, 30 Ch. D. 454.

of cases in which there has been a wrongful assumption by one person or firm of the trade or firm name under which a reputation has been gained by another person or firm, and which has therefore become a very important part of the goodwill of the business of such person or firm (*a*), although when used as a name, and not as a mark on vendible goods, it is not used as a trade mark. The imitation of such a name falsely represents not merely a certain class of goods, but the entire business, to be that of one not the true proprietor.

No exclusive right in name apart from business.

“In this country,” says Lord Chelmsford (*b*), “we do not recognise the absolute right of a person to a particular name, to the extent of entitling him to prevent the assumption of that name by a stranger. The right to the exclusive use of a name in connection with a trade or business is familiar to our law; and any person using that name, after a relative right of this description has been acquired by another, is considered to have been guilty of a fraud, or at least of an invasion of another’s right, and renders himself liable to an action, or he may be restrained from the use of the name by injunction.” But a man who has never carried on business under a particular name cannot, even though he has some kind of right to use that name, interfere with its being used by another. Thus, where the plaintiff was the mortgagee of the goodwill of a business, including the right to use the name under which the business was carried on, but had never exercised his right so to do (*c*).

Name by which goods identified.

There is another kind of trade name besides the trade name which is synonymous with firm name—viz., the trade name which is applied, not to the firm by whom the goods are manufactured and sold, but to the goods themselves; and it was with immediate reference to a trade

(*a*) Per Wood, V.-C., in *Churton v. Douglas*, Johns. 174.

(*b*) *Du Boulay v. Du Boulay*, L. R. 2 P. C. 441.

(*c*) *Beazley v. Soares*, 22 Ch. D. 660.

name of this description (a), though the principles laid down by him are equally applicable to both classes of trade names, that Lord Blackburn (b), after referring to frauds committed by the infringement of trade marks, went on to say: "There is another way in which goods not the plaintiff's may be sold as and for the plaintiff's. A name may be so appropriated by user as to come to mean the goods of the plaintiff, though it is not, and never was, impressed on the goods or on the packages in which they are contained, so as to be a trade mark, properly so called, or within the recent statutes. Where it is established that such a trade name bears that meaning, I think the use of that name, or one so nearly resembling it as to be likely to deceive, as applicable to goods not the plaintiff's, may be the means of passing off those goods as and for the plaintiff's, just as much as the use of a trade mark; and I think the law (so far as not altered by legislation) is the same. And I think it settled by a series of cases that both trade marks and trade names are in a certain sense property, and that the right to use them passes with the goodwill of the business to the successors of the firm which originally established them, even though the name of that firm be changed so that they are no longer strictly correct."

It cannot yet be said to be generally admitted that a right of property can be acquired in a trade name. The present Vice-Chancellor of Ireland said in a recent case (c) that "it has been repeatedly held that there is no property in the name of a firm, or of an individual, or of a place of business; and that the only right of an individual or firm to the sole use of a trade name, as distinguished from a trade mark, is this, that when a name has become identified, by adoption and user, with a particular trade

Property in trade name questioned

(a) "Singer" sewing machines. *Mowling*, 9 Vict. L. R. (E.)

(b) In *Singer Manufacturing Co. v. Loog* (3), 8 App. Cas. 15. And see *Neva Stearine Co. v.*

98.

(c) *Bodega Co., Ltd. v. Owens*, 23 L. R. Ir. 371.

or manufacture or business, the person who has so used or adopted it can obtain the aid of this Court to restrain the use of it by others in such a way as to lead customers or the public to think that the trade or business of the person so using it is his trade or business." And he went on to say that in a registered trade mark there is a larger right. The distinction, however, does not appear to be of much practical importance, as it is now admitted on all hands that if a trade name is so imitated as to render deception probable, relief will be granted, and the test of infringement of a trade mark, in which the right of property is undoubted, is the production of such a probability of deception (a).

Unregistered
trade name
protected.

The non-registration of trade names of the kind primarily referred to by Lord Blackburn is no bar to an action for the wrongful imitation of them (b); and where a trade mark consisting of the words "Stone ale" alone had been expunged from the register as not being registrable, an injunction to restrain the use of those words was nevertheless granted (c).

Fraud not
necessary to
be proved.

It was formerly sometimes supposed, and was held by the late Master of the Rolls and the Court of Appeal in *Singer Manufacturing Co. v. Wilson* (d), that for an action to restrain the use of a trade name to be successful fraud must be proved; on the ground that when a trade mark was once affixed to the goods it passed with the goods from hand to hand, thus silently repeating to each successive purchaser the original misrepresentation of the original infringer, while the improper use of a name not affixed to the goods was not the necessary consequence of being in possession of marked goods, but was the individual act of each person who used it in respect of the goods; so that there might be held to be an infringement of a trade

(a) Per Lord Westbury in *Hall v. Barrows*, 4 De G. J. & S. 150.

(b) *In re Sanitas Co., Ltd.*, 58 L. T. N. S. 166.

(c) *Thompson v. Montgomery*, 41 Ch. D. 35.

(d) 2 Ch. D. 434.

mark when, in analogous circumstances, there would be no infringement of a trade name. And when the case of *Singer Manufacturing Co. v. Wilson* was remitted by the House of Lords to the Court of First Instance (a), on the ground of insufficiency of evidence, some of the law peers seem to have thought that different principles of law might possibly be applicable to trade marks and trade names. But Lord Cairns, C. (b), said, "It may well be that if an imitated trade mark is attached to the article manufactured, there will, from that circumstance, be the certainty that it will pass into every hand into which the article passes, and be thus a continuing and ever present representation with regard to it; but a representation made by advertisements that the articles sold at a particular shop are articles manufactured by A B (if that is the legitimate effect of the advertisements, which is a separate question) must, in my opinion, be as injurious in principle, and may possibly be quite as injurious in operation, as the same representation made upon the articles themselves." And in *Singer Manufacturing Co. v. Loog* (c), Lord Blackburn took the view that the law of trade marks and trade names when not affected by legislation was the same.

Whether there is or is not property in a trade name, as Lord Blackburn suggested (d), it is a fraud on the part of one person to attract to himself the custom intended for another, by a false representation, direct or indirect, that the business carried on by himself is identical with that of the other person by whose ability and exertions the name has acquired the reputation it possesses (e). The question is not whether the defendants' business is represented as

False representation sufficient.

(a) 3 App. Cas. 376.

(b) *Ib.* 389. And see *Bodega Co., Ltd. v. Owens*, 23 L. R. Ir. 371.

(c) 8 App. Cas. 15. As to the differences between trade marks and trade names in Massachusetts, see *Bowman v. Floyd*, 85 Mass. 76.

(d) And see per the Court of Session in *Singer Manufacturing Co. v. Kimball & Morton*, Ct. of Sess. Cas. 3rd Ser. XI. 267; also *Boulnois v. Peake*, 13 Ch. D. 513.

(e) *Lee v. Haley*, L. R. 5 Ch. 155.

being similar to the plaintiffs', but whether it is represented as being that very identical business (a). If such a false representation has been made, whatever may have been the motive of the persons making it, when proceedings are taken in consequence of it, "all the Court requires is to be satisfied that the names are so similar as to be calculated to produce confusion between the two—so calculated to do it that, when it is drawn to the attention of those adopting the name complained of that that would be the result, it is not honest for them to persevere in their intention, though originally the intention might not have been otherwise than honest" (b).

Act originally innocent may become fraudulent.

"The question is this," said Cotton, L. J., in the Court of Appeal (c),—"whether the defendant has represented that the goods manufactured by him were manufactured by the plaintiffs, or whether he has done anything calculated so to represent. I quite agree that it is unnecessary that a fraudulent intention in issuing the circulars complained of should be established. If the natural consequence of those things, even in circumstances not known to him, is that they will represent the goods to be those of another person, it is wrongful, and, as this Court says, a fraud in him, to continue the user after those circumstances are brought to his knowledge. We must consider whether he has represented, or done that which is reasonably calculated to give that misrepresentation." In the same spirit, Wood, V.-C., had laid down long previously (d) that if the plaintiffs had represented to the defendants that the course which the latter had been taking was calculated to deceive the public, and, "after

(a) *Cruttwell v. Lye*, 17 Ves. 335; *Churton v. Douglas*, Johns. 174; *Civil Service Supply Association v. Dean*, 13 Ch. D. 512; *Hirsch v. Hirsch & Co.*, 80 L. T. (Journal) 283.

(b) Per James, L. J., in *Hendriks v. Montagu*, 17 Ch. D. 638.

(c) In *Singer Manufacturing Co. v. Loog* (3), 18 Ch. D. 417.

(d) In *Williams v. Osborne*, 13 L. T. N. S. 498. And see *McAndrew v. Bassett*, 4 De G. J. & S. 380; *Bodega Co., Ltd. v. Owens*, 23 L. R. Ir. 371; *Magee Furnace Co. v. Le Barron*, 127 Mass. 115, and *Holt v. Menendez*, 128 U. S. Rep. 182.

such representation, the defendants persisted in continuing the use of the name in the same manner, then, on the plaintiffs bringing the case before the Court, the Court would be justified in saying that that which was not fraudulent at first became so by the defendants' persisting in the same course, and that therefore the plaintiffs would be entitled to the relief they claimed."

The circumstances must, however, be such as to satisfy the Court that deception is probable, and where that is not adequately made out, relief will be refused. Thus, in *Goodfellow v. Prince (a)*, a London wine merchant agreed with a firm of French wine growers to import from them a particular growth of champagne under a label bearing the assumed name "Le Court et C^o, Reims," and sold considerable quantities of wine in England under the label, and another London wine merchant began to import champagne from a different French grower and to sell it in England under a label also bearing the assumed name of "Le Court et C^o"; and it was held by the Court of Appeal that, whether the use of the name by the defendant might or might not represent that his wine was manufactured by the same French grower who manufactured the plaintiff's wine, there was nothing to show that it represented that the wine was imported by the same importer. And in *Bodega Co., Ltd. v. Owens (b)*, the V.-C. of Ireland held on motion that, there being in Ireland only one establishment of the plaintiff company known as a Bodega, which was in Dublin, there was no such probability of deception, if the defendant were allowed to open a "Bodega" in Belfast, as to call for an injunction to prevent the latter from so doing. But at the hearing of the action, on further evidence, an injunction was granted.

But deception must be probable.

Lapse of time may be material in considering whether deception is probable. Thus, where the Marquis of Londonderry and his predecessors in title, owners of

This may be affected by lapse of time

(a) 35 Ch. D. 9.

(b) 23 L. R. Ir. 371.

the Londonderry collieries in the county of Durham, had for many years been in the habit of selling their coal in London, wholesale but not retail, and the defendant, a coal merchant, had, with the knowledge of the Marquis and his predecessors in title, been in the habit, since 1861, of selling retail a particular quality of coal, not obtained from the Londonderry collieries, under the name of "Londonderry Wallsend," or "Londonderry W. E.," and the Marquis had begun in February 1885 to sell retail in London coal got from a particular seam under the name of "Londonderry Wallsend," an injunction to restrain the defendant from selling his coal by the names which he had been accustomed to use was refused, on the ground that, having regard to the lapse of time, there was no misrepresentation, notwithstanding that the plaintiff's title formed part of the names, and that he was the owner of the Londonderry collieries (*a*).

Name of company.

When the name which is alleged to have been imitated is that of a company, and is composed of such words as are in ordinary use in the language, very clear evidence indeed of probability of deception will be required for an action for infringement to be successful. Thus, where a bill was filed by the London and Provincial Law Assurance Society against the London and Provincial Joint Stock Life Assurance Company (*b*), the injunction was refused, an action at law being directed; and in suits by the Colonial Life Assurance Company against the Home and Colonial Assurance

(*a*) *Marquis of Londonderry v. Russell*, 3 Times L. R. 360; and see *Ford v. Foster*, L. R. 7 Ch. 611-28, per Mellish, L. J.

(*b*) *London and Provincial Law Assurance Society v. London and Provincial Joint Stock Life Assurance Co.*, 17 L. J. Ch. 37. In *Purser v. Brain*, 17 L. J. Ch. 141, it was held that the circulars of "The London Patent Manure Co." were clearly fraudulent imitations of those of "The London Manure Co.," but the case was sent to a

jury for the purpose of deciding whether the plaintiffs' user of their title had been sufficiently long. And in *Lawson v. Bank of London*, 18 C. B. 84, a case at Common Law, the plaintiff was defeated on the ground of a want of averment in the declaration that he was a banker or had ever carried on that business; but Willes, J., remarked that he was not prepared to say that the defendant would not be liable if the cause of complaint were properly alleged."

Company, Limited (a), and by the London Assurance Company against The London and Westminster Assurance Corporation, Limited (b), the injunction was simply refused. In *Lee v. Haley* (c) the plaintiffs were coal merchants, trading under the name of The Guinea Coal Company, and having their business premises at No. 22, Pall Mall. The defendant had been in their service as manager, and on leaving them set up in business at Beaufort Buildings, Strand, under the name of the Pall Mall Guinea Coal Company. From Beaufort Buildings he removed to No. 48, Pall Mall. In that case fraud was held to be proved, and the injunction was granted; but the Court being of opinion that the only reasonable chance of successful deceit depended upon the residence of the defendant in Pall Mall, the injunction against the user by the defendant of his trade name as above was restricted to Pall Mall. In a case (d) where the plaintiff company sold white lead in kegs marked "Brooklyn White Lead Company," or "Co.," and the defendant, who had formerly marked his "Brooklyn White Lead, pure, 100 lbs.," changed the name to "Brooklyn White Lead and Zinc Company," it was held

(a) *Colonial Life Assurance Co. v. Home and Colonial Assurance Co.*, 33 Beav. 548.

(b) *London Assurance Co. v. London and Westminster Assurance Corporation*, 32 L. J. Ch. 664.

(c) L. R. 5 Ch. 155.

(d) *Brooklyn White Lead Co. v. Masury*, 25 Barb. 416, R. Cox, 210. And see *Churton v. Douglas*, Johns. 174. In *Hendriks v. Montagu*, 17 Ch. D. 638, an injunction was granted at the instance of "The Universal Life Assurance Society" to restrain the use of the name "The Universe Life Assurance Association, Ltd.," on the ground of similarity; in *Simpson v. Anglo-Indian Tea Co., Ltd.*, V. C. B., May 4th, 1883, the defendant company was not allowed to trade under the name which it had taken, which was the same as that under

which the plaintiff was trading; in *Guardian Fire & Life Assurance Co. v. Guardian & General Insurance Co., Ltd.*, 50 L. J. Ch. 252, it was held that the defendant company's name was likely to deceive, but that the name of "The Guardian Horse, Vehicle and General Insurance Co." might fairly be taken; in *Capital & Counties Bank, Ltd. v. Capital & County Deposit Bank*, Chitty, J., Feb. 9th, 1884, an injunction was granted to restrain the use of the latter name; in *Accident Insurance Co., Ltd. v. Accident, Disease & General Insurance Corporation, Ltd.*, W. N. 1884, p. 191, Pearson, J., granted an injunction, and on appeal an order was taken by consent, the defendants agreeing to place some other word than "accident" at the head of their title; in *Thompson v.*

that, though he was entitled to continue to mark his goods "Brooklyn White Lead and Zinc," he had no right to add "Company" or "Co."

Descriptive
name of
company.

In *Australian Mortgage, Land, & Finance Co. v. Improved French Dye-Cleaning & Dyeing Co., Ltd.*, 30 Sol. J. 753, the plaintiff was carrying on business at Brixton as "The French Dyeing & Cleaning Co.," and the defendants were carrying on business in Great Portland Street under the name above, and using the address "Brixton" on their trade papers, and an injunction was granted. So, also, in *Sanitas Co., Ltd. v. Condy*, 4 P. R. 195, 533, in which the plaintiffs were "The Sanitas Co., Ltd.," and the defendant began to trade as "The Condisanitas Co.,"; in *Holmes, Booth & Haydens v. Holmes, Booth & Attwood Manufacturing Co.*, 37 Conn. 278, the defendants were restrained from using the names of Holmes and Booth. In *Newby v. Oregon Central Railway Co.*, 1 Deady, 609, it was held that the original Oregon Central Railway Co. would be entitled to restrain the assumption of its name by a new company, though a single bondholder in the former company was not entitled to sue until the company had refused to do so. And see *Braham v. Beachim*, 7 Ch. D. 848 ("Radstock Colliery Proprietors"); *Campbell v. Hollins*, Dig. 548 ("Minton & Co."); *Batchellors v. Batchellor Manufacturing Co.*, 12 Amer. Rep. 414 n.; *Gray v. Taper Sleeve Pulley Works*, 16 Fed. Rep. 436, where the defendants were restrained from trading under the name they had assumed, which had been previously used by the plaintiffs, though they were entitled to make and sell "taper sleeve pulleys"; *McGowan Bros. Pump & Machine Co. v. McGowan*, 2 Cinc. 313; *Celluloid Manufacturing Co. v. Cellonite Manufacturing Co.*, 32 Fed. Rep. 94, where the names were as above; *Myers v. Kalamazoo Buggy Co.*, 54 Mich. 215 ("The Kalamazoo Waggon Co.," and "The Kalamazoo Buggy Co."). See *Plant Seed Co. v. Michel Plant Seed Co.*, 23 Mo. App. 519. In the following cases injunctions were refused:—*London & County Banking Co. v. Hampshire & North Wilts Bank*, Dig. 618, in which the defendant company was proposing to take the name of "The Capital & Counties Bank"; *Merchant Banking Co. of London v. Merchants' Joint Stock Bank, Ltd.*, 9 Ch. D. 560; *Army & Navy Co-operative Society, Ltd. v. Junior Army & Navy Stores, Ltd.*, Dig. 640; *Australian Mortgage, Land & Finance Co. v. Australian & New Zealand Mortgage Co.*, W. N. 1880, p. 6; *Midland Electric Light & Power Co. v. Brush Midland Electric Light & Power Co.*, 26 Sol. J. 465; *Provident Association of London, Ltd. v. London & Provincial Provident Association, Ltd.*, 30 Sol. J. 753; *Bumsted v. General Reversionary Co., Ltd.*, 4 Times L. R. 621, where the plaintiff sued on behalf of "The General Reversionary & Investment Co.," who carried on an extensive business in London, with country agents, and the defendants were setting up a small business at Liverpool; *Goodyear Rubber Co. v. Goodyear India-rubber Glove Manufacturing Co.*, 128 U. S. Rep. 598; and see *Condy v. Mitchell*, 37 L. T. N. S. 268, 766 ("Condy's Fluid Co."); *Massam v. Thorley's Cattle Food Co.*, 14 Ch. D. 748 ("Thorley's Cattle Food Co."); *Tussaud v. Tussaud*, 38 W. R. 440; *Ottoman Cakrey Co. v. Dane*, 95 Ill. 203, in which the plaintiff company was held not entitled to restrain the defendants from trading under the same name in Illinois, notwithstanding that the defendants were incorporated in Michigan and the plaintiffs in Illinois, the defendants having

Australian & New Zealand Mortgage Co. (a); the Court of Appeal pointed out the difficulty of monopolising the exclusive use of a name which correctly described the nature of a company's business, or the locality of its operations. And in *India & China Tea Co. v. Teede (b)*, it was held that a firm of tea merchants were entitled to assume the name of "The India & China Packet Tea Co." notwithstanding that the name of the plaintiff company was as above, the name assumed by the defendants being simply descriptive, and there being no evidence of deception.

By § 20 of the Companies Act, 1862 (c), it is enacted that "no company shall be registered under a name identical with that by which a subsisting company is already registered, or so nearly resembling the same as to be calculated to deceive, except in a case where such subsisting company is in the course of being dissolved, and testifies its consent in such manner as the registrar requires; and if any company, through inadvertence or otherwise, is, without such consent as aforesaid, registered by a name identical with that by which a subsisting company is registered, or so nearly resembling the same as to be calculated to deceive, such first-mentioned company may, with the sanction of the registrar, change its

The Companies Act, 1862.

been the first to trade under the name in Illinois; *Lehigh Valley Coal Co. v. Hamblen*, 23 Fed. Rep. 225, in which a Pennsylvania company, doing business in Illinois and other states, was held not entitled to restrain the formation of another company in Illinois under the same name; but it was intimated that the question would remain open whether relief would be granted if the new company should be formed and should improperly take away business from the plaintiffs. So in *Drummond Tobacco Co. v. Randle*, 114 Ill. 412, the plaintiff company failed to restrain the incorporation of another company as "The Drum-

mond-Randle Tobacco Co.;" in *McNair v. Cleave*, 10 Phila. 155, the plaintiffs, trading as the "Galaxy Publishing Co.," were held not to be entitled to the exclusive use of the name, because it represented, contrary to the fact, that they were incorporated as a company.

(a) W. N. 1880, p. 6. So also, per the Supreme Court of the U. S. in *Goodyear Rubber Co. v. Goodyear India-rubber Glove Manufacturing Co.*, 128 U. S. Rep. 598. And see *Keehler v. Sanders*, 55 N. Y. Sup. Ct. 48 ("International Banking Co.").

(b) W. N. 1871, p. 241.

(c) 25 & 26 Vict. c. 89.

name" (a). This section does not authorise a company to use or register a name so nearly resembling one previously used by another company as to be calculated to deceive, even though the name of the earlier company has not itself been registered (b); and, on the other hand, since the section only affects the registration of the name of a company, the rights of a company to a name which has been registered cannot be attacked *under the section*, whatever may be the rights outside the section of another company which has previously used the name (c).

Name of individual.

If the trade name which has been imitated is that of an individual, and this has been assumed by another person of different name, little is required to prove the fraud. In fact, the assumption of another's name is almost sufficient proof if taken alone (d). But in *Olin v. Bate* (e), the plaintiff Olin failed to succeed in restraining the defendant Bate from carrying on the same profession (the medical) in the same town as himself under the name of Olin, the defendant having so done before the plaintiff came to the town in question. And where "Liebig's Extract of Meat" had come to be the proper designation of an article first invented by Baron Von Liebig, Field, J., affirmed by the Court of Appeal and the House of Lords, declined to restrain a manufacturer of the article from styling his preparation "'Baron' Liebig's Extract of Meat," and placing on the pots a photograph of the Baron (f).

(a) As to the registration of names of companies under the U. S. Trade Marks Acts, see *In re Rowe & Post*, 9 U. S. Pat. Gaz. 496; *In re India Rubber Comb Co.*, 8 *ib.* 905; *India Rubber Comb Co. v. Meyer*, 8 *ib.* 905; *India Rubber Comb Co. v. Rubber Comb & Jewelry Co.*, 45 N. Y. Super. Ct. 258; *In re Rubber Clothing Co.*, 10 U. S. Pat. Gaz. 111, and Appendix —, *infra*.

(b) *Hendriks v. Montague*, 17 Ch. D. 638. See *Tussaud v. Tussaud*, 38 W. R. 440.

(c) *Merchant Banking Co. of London v. Merchants' Joint Stock Bank, Ltd.*, 9 Ch. D. 560.

(d) Per Turner, L. J., in *Burgess v. Burgess*, 3 De G. M. & G. 896. See *Binninger v. Wattles*, 28 How. Pr. 206, R. Cox, 318.

(e) 98 Ill. 55; 38 Amer. Rep. 78.

(f) *Liebig's Extract of Meat Co., Ltd. v. Anderson*, W. N. 1882, p. 147; *ib.* 1883, p. 185; H. L., July 16th, 1885.

Sometimes the plaintiff's name is itself an assumed or fanciful one: thus the use of the name "Christy's Minstrels" has been restrained (a); and that of the name "The Oldfield Lane Doctor" (b); and in *Isaacson v. Thompson* (c) the plaintiff kept a millinery establishment, as "Madame Elise," which name being imitated by the defendant, an injunction would have been awarded, had not the plaintiff's own delay disentitled her to relief.

Assumed name.

In some cases the use of a man's own name may be such as to deceive, and where this is so the person aggrieved is entitled to obtain an injunction against such use of the name (d); but he must prove clearly the fraudulent intent, and "it is a question of evidence in each case whether there is false representation or not" (e). It is not sufficient in such cases to show that the use of the name, though honest, may cause confusion. Thus, in *Turton & Sons, Ltd. v. Turton* (f) the plaintiffs carried on an old-established business in Sheffield as Thomas Turton & Sons, Ltd., and the defendant John Turton, who had for

Man's own name. Use not restrained unless fraudulent.

(a) *Christy v. Murphy*, 12 How. Pr. 77, R. Cox, 164; *Montague v. Moore*, Seton, 4th ed. 238.

(b) *Milner v. Reed*, Dig. 328.

(c) 41 L. J. Ch. 101.

(d) *Churton v. Douglas*, Johns. 174; *Burgess v. Burgess*, 3 De G. M. & G. 896; *Fullwood v. Fullwood*, W. N. 1873, pp. 93, 185; *Fullwood v. Fullwood* (2), 9 Ch. D. 176; *Holloway v. Holloway*, 13 Beav. 209; *Pullar v. Pullar*, Fry, J., April 9th, 1883; *Melachrino & Co. v. Melachrino Egyptian Cigarette Co.*, 4 P. R. 215; *M. Melachrino & Co. v. R. Melachrino & Co.*, Chitty, J., May 27th, 1888; *Nicholls v. Kimpton*, 3 Times L. R. 674; *Birmingham Vinegar Brewery Co., Ltd. v. Liverpool Vinegar Co., Ltd.*, W. N. 1888, p. 139; *Atkinson v. Atkinson*, 85 L. T. (Journal), 229; *Warner v. Warner*, 5 Times L. R. 359; *Tussaud v. Tussaud*, 38 W. R. 440; *Holmes v. Holmes*, 37 Conn. 278, 9 Amer. Rep. 324; *Gillis v.*

Hall, R. Cox, 596; *Devlin v. Devlin*, 69 N. Y. 212; *Shaver v. Shaver*, 54 Iowa, 208; *India Rubber Comb Co. v. Rubber Comb & Jewelry Co.*, 45 N. Y. Super. Ct. 258; *Landreth & Sons v. Landreth*, 22 Fed. Rep. 41; *Gage v. Canada Publishing Co.* 11 Can. Sup. Ct. 306; *Rogers Manufacturing Co. v. Rogers & Spurr Manufacturing Co.*, 11 Fed. Rep. 495; *Frazer v. Frazer Lubricator Co.*, 121 Ill. 147. See *Christie v. Christie*, L. R. 8 Ch. 499; *McGowan Bros. Pump & Machine Co. v. McGowan*, 2 Cinc. 313.

(e) Per Turner, L. J., in *Burgess v. Burgess*, *ubi supra*. And see *Turton & Sons, Ltd. v. Turton*, 42 Ch. D. 128; *Rogers v. Rogers*, 53 Conn. 121.

(f) 42 Ch. D. 128. And see *Rogers v. Rogers*, *ubi supra*; *Iowa Seed Co. v. Dorr*, 70 Iowa, 481; *Rogers Manufacturing Co. v. Simpson*, 54 Conn. 527; *Brown Chemical Co. v. Myer*, 31 Fed. Rep. 453.

some years carried on a similar business in the same town as John Turton & Co., took his two sons into partnership, and changed his trade name to John Turton & Sons; and although some confusion was proved, the Court of Appeal held that, the name adopted being a true statement of the composition of the firm, and there being no proof or even allegation of fraud, no injunction could be granted. Lord Esher, M. R., said, "If all that a man does is to carry on the same business (as another trader), and to state how he is carrying it on, that statement being the simple truth, and he does nothing more with regard to the respective names, he is doing no wrong. He is doing what he has an absolute right by the law of England to do; and you cannot restrain a man from doing that which he has an absolute right by the law of England to do." And Cotton, L. J., added: "The Court cannot stop a man from carrying on his own business in his own name, although it may be the name of a better known manufacturer, when he does nothing at all in any way to try and represent that he is that better known and successful manufacturer." But where a person has allowed another to use his name, and acquire a reputation under it, he will not afterwards be allowed himself to use his name so as to deceive, nor to empower others to use it so as to produce that result, nor will such others be permitted so to use it. Thus, where one Holbrook, an employé of the Birmingham Vinegar Brewery Co., Ltd., had allowed the company to use his name for twelve years as part of the title of their goods—*e.g.* "Holbrook's Worcestershire Sauce," "Holbrook's London Relish," "Holbrook's Pure Pickles"—he was not allowed, on leaving their service and entering that of the Liverpool Vinegar Co., Ltd., to give the latter a right to use his name as part of the same titles, nor were they allowed so to use it (a).

(a) *Birmingham Vinegar Brewery Co., Ltd. v. Liverpool Vinegar Co., Ltd.*, W. N. 1888, p. 139.

Evidence of fraudulent intention was supplied in one case (a) by a removal by the defendant into the neighbourhood in which the plaintiff was carrying on his business, and the addition of "and Co." to the name "H. Fullwood," the plaintiff's trade name being "R. J. Fullwood & Co"; and in another case (b), in which the same person was plaintiff, by a representation that the business of M. Fullwood and E. Fullwood, trading as "E. Fullwood & Co.," had been established in 1785, and was carried on at Hoxton, those facts being true of the business of R. J. Fullwood & Co., but not of that carried on by the defendants. In a third case (c), the defendant, who had sold his business and the goodwill, including the name, "John Douglas & Co.," recommenced business, and employing the three managing men of his former business, styled his new business "John Douglas & Co.," and sent round circulars informing the public that his firm was so well known that it was unnecessary to say anything about it; thus, in fact, "representing himself to be the owner of that which he had sold." So, too, it was held to be fraud for a person who had recently come into the neighbourhood of the "Carriage Bazaar" in Baker Street, and set up a "Carriage Repository," to

(a) *Fullwood v. Fullwood*, W. N. 1873, pp. 93, 185. So where the plaintiff carried on business as "Newman & Co." and the defendant bought a similar business carried on as "H. Newman," and changed the name to "Newman & Co.": *Holt v. Smith*, 4 Times L. R. 329. And where the plaintiff dealt in "Warner's Safe Cures," and the defendant, who was also named Warner, bought the goodwill of "Ashton's Gout and Rheumatic Cure," and changed the name to "Warner's Gout and Rheumatic Cure": *Warner v. Warner*, 5 Times L. R. 359.

(b) *Fullwood v. Fullwood* (2), 9 Ch. D. 176. And see *Glen & Hall Manufacturing Co. v. Hall*,

61 N. Y. 226. Where Robert Minton Taylor, formerly a member of the firm of Minton, Hollins & Co., set up for himself as Robert Minton Taylor & Co., and, on being threatened with legal proceedings, undertook to trade only as Robert Minton Taylor, it was held that a purchaser of R. M. Taylor's business could not carry it on under the style of "The Minton Brick and Tile Co.": *Campbell v. Hollins*, Dig. 548.

(c) *Churton v. Douglas*, Johns. 174. But see the American cases of *Hove v. Searing*, 10 Abb. Pr. 264, R. Cox, 244; *Reeves v. Denicke*, 12 Abb. Pr. N. S. 92; and *Booth v. Jarrett*, 52 How. Pr. 169.

change that name to the "New Carriage Bazaar," with some incorrect additions (a). But where the plaintiff had been for eight years in the habit of engaging Dr. Richter to conduct concerts in London, which the plaintiff advertised and made popular by the name of "Richter Concerts," and in 1887 Dr. Richter declined to continue to act with the plaintiff, and agreed to conduct concerts in London for the defendant, who began to advertise them as "Richter Concerts," it was held that the name "Richter Concerts" meant concerts conducted by Dr. Richter, and was properly applied to the proposed concerts, and that no injunction could be granted (b).

Change of
name copied.

Where the plaintiff had changed his name to Frank Leslie, and his son had, by his orders, assumed the same name, and the plaintiff had afterwards brought out "Frank Leslie's Illustrated News," and other publications of the titles of which his new name formed part, it was held that there was no ground for restraining the publication by the son of "Frank Leslie Junior's Sporting and Dramatic Times" (c). On the other hand, where Dr. Trust had changed his name to Gouraud, but his sons had not changed their name, the latter were restrained from selling a preparation with a statement that it was prepared by Dr. Gouraud's sons, there being a representation which, though not strictly false, was yet calculated to mislead (d).

Deceptive
circulars.

Again, a fraudulent intention may be shown to exist by the production of deceptive circulars so framed by the defendant as to represent his business to be identical with or a continuation of that carried on by the plaintiff; and such a fraud will be restrained (e). Thus, in *Mogford v.*

(a) *Boulnois v. Peake*, 13 Ch. D. 513. And see *Cave v. Myers*, Dig. 304; *Atkinson v. Atkinson*, 85 L. T. (Journal) 229; and *Glen & Hall Manufacturing Co. v. Hall*, 61 N. Y. 226.

(b) *Franke v. Chappell*, 57 L. T. N. S. 141.

(c) *England v. New York Publishing Co.*, 8 Daly, 375.

(d) *Gouraud v. Trust*, 10 N. Y. Sup. Ct. 627.

(e) *Churton v. Douglas*, Johns. 174; *Stevens v. Paine*, 18 L. T. N. S. 600; *Purser v. Brain*, 17 L. J. Ch. 141; *Christie v. Christie*,

Courtenay (a), the defendant issued a circular of which the effect was to represent that he was carrying on the business which he had previously carried on in partnership with the plaintiff, although under the partnership articles the entire goodwill vested in the plaintiff on dissolution.

So, too, one person will not be allowed to defraud another by opening letters addressed to him, and executing orders intended for him (*b*). Where, however, various acts of misrepresentation by the defendant were alleged, pointing to an intention to simulate the plaintiff, but only one case was made out, in which the defendant had opened a letter addressed to the plaintiff, answered it in his own name, and endeavoured to obtain the custom offered by that letter to the plaintiff, it was held that, though this raised grave suspicion of the defendant's motives, yet it was not sufficient ground for an injunction. The defendant, however, was refused his costs (*c*).

Opening letters.

Nor will fraud be permitted to be perpetrated under cover of a partnership got up for the purpose of fraud (*d*). Thus, in *Clayton v. Day (e)*, an ironmonger's assistant named Day, and a general shopkeeper named Martin, were not allowed to carry on the business of blacking manufacturers under the name of "Day and Martin,"

Fraudulent partnership.

L. R. 8 Ch. 499; *Burrows v. Foster*, 1 N. R. 156; *Graveley v. Winchester*, Seton, 4th ed. 257; *Selby v. Anchor Tube Co.*, W. N. 1877, p. 191.

(*a*) 45 L. T. N. S. 303.

(*b*) *Schoile v. Brakell*, 11 W. R. 796; Seton, 4th ed. 253; *Witt v. Corcoran*, *ib.* 257; *England v. Curling*, 8 Beav. 129; *Vernon v. Hallam*, 34 Ch. D. 748.

(*c*) *Edgington v. Edgington*, 11 L. T. N. S. 299.

(*d*) *Croft v. Day*, 7 Beav. 84; *Moet v. Clybourn*, Dig. 533; *Schweitzer v. Atkins*, 37 L. J. Ch. 847; *Dence v. Mason*, Dig. 534, 41 L. T. N. S. 573; *Dence v. Brand*, W. N. 1881, p. 31; *Holmes v. Holmes*, 37 Conn. 278; 9 Amer. Rep. 324.

(*e*) 26 Sol. J. 43, 76 L. T. (Journal) 79. But in America a fictitious partnership has been permitted to give to one of two partners, who had become the successor to the partnership business, a right to use the same trade name which had been formerly used by the partnership, and which consisted of the united names of the two former partners; although, apart from the fictitious partnership, he would have been prevented from so doing by the Massachusetts Gen. Stat. c. 56, which requires the consent of a former partner, or of his personal representative, to the continued use of his name in the business, and such consent was refused: *Hallett v. Cumston*, 110 Mass. 29.

though they were left free to trade as "Martin and Day." Similarly, in *Melachrino v. Melachrino Egyptian Cigarette Co. (a)*, the plaintiff's cigarettes being well known as "Melachrino cigarettes," a person named Poulides took a brother of the plaintiff into his service, under an agreement by which Poulides was to have the right to use his name, and Poulides then opened a business close to the plaintiffs, under the name of The Melachrino Egyptian Cigarette Co., and used the name "Melachrino" in various ways calculated to deceive, and an injunction was granted. Again, in *M. Melachrino & Co. v. R. Melachrino & Co. (b)*, Poulides, the defendant in the previous action, went to Egypt as soon as an interlocutory injunction had been granted in that action, and induced a person named Melachrino, who was not connected with the plaintiffs, but was a tobacconist in a small way of business in Alexandria, to enter into partnership with him and come to England to establish a business under the name of "R. Melachrino & Co.," the plaintiffs being "M. Melachrino & Co.," and they used various fraudulent devices. An injunction was again granted.

Vendor of
business may
recommence
business.

On the sale of the goodwill of a business, the vendor, in the absence of a special stipulation on the point, retains the right of recommencing business, even in his own name, however similar that may be to the trade name of the business the goodwill of which has been sold; provided that he scrupulously abstains from doing anything to induce the public to believe that his new business is in fact the old one which he has sold. If, however, he does anything calculated to induce the belief that his new business is not merely similar to, but is identical with, the old one, the purchaser of the old business is entitled to restrain him by injunction (c).

(a) 4 P. R. 215.
(b) Chitty, J., May 27th, 1888.
(c) *Cruttwell v. Laje*, 17 Ves. 335;
Churton v. Douglas, Johns. 174;
Johnson v. Helleley, 34 Beav. 63;

Hudson v. Osborne, 39 L. J. Ch. 79.
Tudor v. Tudor, W. N. 1873, p. 72,
depended on an express stipula-
tion in the deed under which the
plaintiff retired from the business.

On the dissolution of a partnership, if the whole concern and the goodwill are sold, the trade name is sold with them (*a*). But if the partners merely divide the partnership assets, and there are no express stipulations in the articles as to the disposal of the trade name, then each is at liberty to use the old name just as the partnership did before (*b*); at all events, if no injury will be thereby caused to a partner whose name the firm have used (*c*). Where there are express stipulations in a deed, the parties are of course bound. Thus, in *Day v. Finch* (*d*) a member of the dissolved firm of "Benjamin Finch & Co.," who had agreed to carry on business after the dissolution in his own name only, was restrained from continuing to use the words "and Co." after the name "Benjamin Finch." But where, on a dissolution of partnership, it was agreed that neither partner was to use the firm name, but that each was to be at liberty to manufacture the same articles as had been manufactured by the firm, and one of the partners set up in business on his own account and put up over his shop the name "Hodgson, late of Matthews & Hodgson," the words "late of" being in small type, it was held that no breach of the agreement had been committed (*e*); and where a business carried on as "Madame Élise" was purchased under an agreement which recited (inaccurately) that the business had been carried on as "Madame Élise & Co.," and gave the purchaser the right to use that name, it was held that the purchaser was not entitled to trade as "Madame Élise" simply (*f*).

(*a*) *Banks v. Gibson*, 34 Beav. 566. See *Hoffman v. Duncan*, Seton, 4th ed. 256; *Witt v. Corcoran*, *ib.* 257.

(*b*) *Ib.* See *Clark v. Leach*, 32 Beav. 14; *Dence v. Mason*, Dig. 534; *Condy v. Mitchell*, 37 L. T. N. S. 268, 766; *Levy v. Walker*, 10 Ch. D. 436; *Rogers v. Taintor*, 97 Mass. 291.

(*c*) *Scott v. Rowland*, 20 W. R. 508; *Levy v. Walker*, 10 Ch. D. 436; *Fenton v. Levy*, 29 Sol. J. 735;

Chappell v. Griffith, 53 L. T. N. S. 459. *Gray v. Smith*, 43 Ch. D. 208. See *Chatteris v. Isaacson*, 57 L. T. N. S. 177.

(*d*) 25 Sol. J. 354. And see *Tudor v. Tudor*, W. N. 1873, p. 72; *Vernon v. Hallam*, 34 Ch. D. 748; *Brewer v. Lamar*, 69 Ga. 656.

(*e*) *Matthews v. Hodgson*, 2 Times L. R. 899.

(*f*) *Chatteris v. Isaacson*, 57 L. T. N. S. 177.

Rights of
retiring
partner.

If, again, on the dissolution of partnership, one partner takes over the whole concern by arrangement, he must compensate the other partner for his interest in the trade name (*a*), and the retiring partner is at liberty to set up a similar business in his own name, even on adjoining premises (*b*).

Scott v. Scott. In *Scott v. Scott* (*c*), R. & W. Scott carried on business in partnership in Nithsdale, and in Glasshouse Street, Regent Street, as "R. & W. Scott." The partnership being dissolved, the agreement for the dissolution contained no stipulation by either party not to continue the business, but neither of the parties was to use the name of the firm, except so far as might be necessary for winding up the partnership affairs. W. Scott retiring from the business, and setting up for himself in the neighbourhood of Nithsdale, R. Scott retained the London premises of the late firm, and made them over with his business to the defendants Scott & Nixon. The inscription used by the late firm over their house at Glasshouse Street having been "R. & W. Scott of Nithsdale," the defendants replaced this by "Scott & Nixon, late R. & W. Scott of Nithsdale." Upon this W. Scott filed a bill against them, and on motion for injunction, the injunction was granted to restrain the defendants from permitting that inscription to remain, and from representing their business to be in continuance of that carried on by the late partnership of R. & W. Scott (*d*).

Representations that plaintiff has retired.

The injury caused by the defendants to the plaintiffs is even greater than in an ordinary case of misappropriation of a trade name, when the representations made by the defendants go to show that the plaintiffs have retired from business, and that the defendants have succeeded to the business formerly carried on by them. Thus, where

(*a*) *Banks v. Gibson*, 34 Beav. 566.
(*b*) *Bond v. Milbourn*, 20 W. R. 197; *Mogford v. Courtenay*, 45 L. T. N. S. 303.

(*c*) 16 L. T. N. S. 143.
(*d*) See *Selby v. Anchor Tube Co.*, W. N. 1877, p. 191.

the defendants had acquired a lease of works at which the plaintiffs had formerly manufactured bricks, but not of the mines from which the brick-clay used by the plaintiffs had been obtained, and then issued cards and circulars, styling themselves "E. J. & J. Pearson (late Harpers & Moore)," and otherwise representing themselves to have succeeded to the business of the plaintiffs, who were, as a matter of fact, carrying on their business on other works, the defendants were restrained by injunction from those misrepresentations (a); and Wood, V.-C., expressed an opinion that, on application by the owner of the mines of fire-clay used by the plaintiffs, but not by the defendants, the issue of an injunction would have been almost a matter of course.

A person who has been a member or employé of a firm of reputation, and who sets up in business on his own account, is entitled, unless he has contracted not to do so (b), to derive what benefit he may from a fair statement of the fact of his former employment (c), which is usually expressed by the addition after his own name of the name of his former firm or employer, with the words "late of," or "late with." But such statement must be made in an unambiguous way, and not in such a manner as to induce the belief that the tradesman in question is selling the goods of his former firm or employer. For the purposes of

Former firm or employer may be stated.

(a) *Harper v. Pearson*, 3 L. T. N. S. 547; also *Scott v. Scott*, 16 L. T. N. S. 143; *Stevens v. Paine*, 18 L. T. N. S. 600; *Reeves v. Denicke*, 12 Abb. Pr. N. S. 92; *Gouraud v. Trust*, 10 N. Y. Sup. Ct. 627. And as to a representation of one business being a continuation of another, see *Churton v. Douglas*, Johns. 174; *Burrows v. Foster*, 1 N. R. 156; *Witt v. Corcoran*, Seton, 4th ed. 257; *Graveley v. Winchester*, *ib.* 257; *Montague v. Moore*, *ib.* 238; *Selby v. Anchor Tube Co.*, W. N. 1877, p. 191; *England v. Curling*, 8 Beav. 129; *Vernon v. Hallam*,

34 Ch. D. 748; *Hoxie v. Chaney*, 143 Mass. 592.

(b) *Wolmershausen v. O'Connor*, 36 L. T. N. S. 921.

(c) See per Wood, V.-C., in *Leather Cloth Co. v. American Leather Cloth Co.*, 1 H. & M. 271; also *Clark v. Leach*, 32 Beav. 14; *Emerson v. Badger*, 101 Mass. 82; *Boswell v. Mathie*, Ct. Sess. Cas. 4th Ser. XI. 1072; *Van Wyck v. Horowitz*, 46 N. Y. Sup. Ct. 237; *Wolfe v. Alsop* (1), 10 Vict. L. R. (E.) 41; and cases *infra*. But see *Selby v. Anchor Tube Co.*, W. N. 1877, p. 191.

the plaintiff's right to relief it is a matter of indifference whether or not the defendant has acted with a fraudulent intention; if what he has done is, though unintentionally, calculated to deceive "the unwary, the heedless, the incautious portion of the public" (a), the plaintiff is entitled to protection just as much as if there were intentional fraud.

Glenny v. Smith.

In *Glenny v. Smith* (b) the defendant, who had been in the plaintiff's service, opened a shop in Oxford Street, where he placed his own name over the door, but on the brass plates and on the awning the words, "from Thresher & Glenny," "from" being in much smaller letters than the plaintiff's name. It further appeared that the defendant's own name over the door was quite hidden when the awning was let down. Kindersley, V.-C., granted an injunction (c).

Hookham v. Pottage.

In *Hookham v. Pottage* (d), the parties had been tailors in partnership at Oxford, the defendant having been formerly the plaintiff's manager, and afterwards taken into partnership by him. On the dissolution of the partnership it was arranged that the plaintiff was to continue the business, the defendant receiving from the plaintiff such an amount as should be found to be due to him. The plaintiff, in continuing the business, styled himself "Hookham & Co.," and the defendant setting up close to him, put over his shop, "S. Pottage, from Hookham & Pottage." There was some evidence of deception, and Malins, V.-C., granted an injunction, which decision was upheld by the Court of Appeal.

Other cases.

In *Foot v. Lea* (e), an older case, the Master of the Rolls

(a) V.-C. Kindersley, in *Glenny v. Smith*, 2 Dr. & Sm. 476.

(b) *Ubi supra*.

(c) See, too, *Burgess v. Burgess*, 3 De G. M. & G. 896; *Dence v. Mason* (1), Dig. 534; *Colton v. Thomas*, 2 Brews. 308, R. Cox, 507; *Boswell v. Mathie*, Ct. Sess.

Cas. 4th Ser. XI. 1072; *Wolfe v. Alsop*, 12 Vict. L. R. (E.) 421.

(d) L. R. 8 Ch. 91. And see *Selby v. Anchor Tube Co.*, W. N. 1877, p. 191.

(e) 13 Ir. Eq. 490. And see *Matthews v. Hodgson*, 2 Times L. R. 899.

in Ireland was of opinion that there was no attempt to deceive on the part of the defendant, who had used show-boards and labels on which his own name was followed by "late of Lundy, Foot & Co.," the latter name being of equal size with the defendant's, and he accordingly refused the injunction, with leave to bring an action at law. In *Williams v. Osborne* (a), Wood, V.-C., was of a similar opinion, and dismissed the bill, and, on account of the extreme haste with which it had been filed, with costs. In a more recent case (b), the defendants, who had been forewomen in the plaintiff's shop in Paris, used on their window blinds in Bond Street, the words "Ex 1^{ères} de la," in small letters, followed by "Maison Boissier de Paris," in large letters, to signify their former employment; and although V.-C. Malins declined to restrain the use of those words, notwithstanding that they were not generally understood in London as equivalent to "from," he left the defendants to pay their own costs.

Deception of the same kind will be restrained when what is imitated is not a name of an individual or firm, but a designation of the place at which the business of an individual or firm is carried on, and by which it is known and recognised. Thus, "Osborne House" (c), "The Carriage Bazaar" (d), "The Bodega" (e), "The New York Dental Rooms" (f). But in such cases the plaintiff must prove that there is something distinctive in the appellation which he has given to his establishment, since no relief can be given him if that appellation is merely descriptive, as "The Antiquarian Book Store" (g), "The

Name of
establishment.

(a) 13 L. T. N. S. 498.	23 L. R. Ir. 371, at the hearing of
(b) <i>Robineau v. Charbonnel</i> , W. N. 1876, p. 160.	the action.
(c) <i>Hudson v. Osborne</i> , 39 L. J. Ch. 79.	(f) <i>Sanders v. Utt</i> , 16 Mo. App. 322 (the rooms were in St. Louis, Mo.). See <i>Sanders v. Jacob</i> , 20 Mo. App. 96.
(d) <i>Boulnois v. Peake</i> , 13 Ch. D. 513.	(g) <i>Choynski v. Cohen</i> , 39 Cal. 501, R. Cox, 593.
(e) <i>Bodega Co., Ltd. v. Owens</i> ,	

Mammoth Wardrobe" (a), "The Tower Palace" (b), "Misfits Parlours" (c); and he must also prove that the result of the defendant's acts is to represent that his business is identical with that carried on by the plaintiff, as in *Cave v. Myers* (d), where the defendant, whose shop was in a corner house close to the establishment of the plaintiffs, Messrs. Cave, adopted for his shop the name of "Cavendish House," and had it so painted up that "Cave" appeared on the side of the street in which was the plaintiff's shop, and the remainder round the corner, and *Genin v. Chadsey* (e), where the plaintiff was the proprietor of "The Captain's Live-and-Let-Live Oyster and Dining Saloon," and the defendant set up "G. W. Chadsey & Co.'s Great Eastern Live-and-Let-Live Dining Saloon." On the other hand, it was held (f) that "Great I X L Auction company" was not likely to be mistaken for "I X L General Merchandise Auction Store," and where the defendant had put up a sign with the words "Depôt of the Cherry Pectoral Company," and inside his premises a notice, "Ayer's Cherry Pectoral, One Dollar; Rushton's Cherry Pectoral, Fifty Cents. Which will you have?" it was held that the defendant had done no more than trade in fair competition with the plaintiff, as he was entitled to do (g); but when fraud is proved or admitted, it will be restrained (h).

Sign-board.

In *Walker v. Alley* (i) it was decided that the name and sign of "The Golden Lion" was so connected with the plaintiff's dry goods business that it could not be taken by another trader; and the Chancellor of Upper

(a) *Gray v. Koch*, 2 Mich. N. P. 119.
 (b) *Armstrong v. Kleinhaus*, 1 Ky. L. Rep. 112; 82 Ky. 303.
 (c) *Cohn v. Kahn*, 26 Alb. L. J. 342.
 (d) Dig. 304.
 (e) Cited in *Dixon Crucible Co. v. Guggenheim*, R. Cox, 567. And see *Hoby v. Grosvenor Library Co.*, 28 W. R. 386 ("Grosvenor Library"); *Wheeler v. Johnston*,

3 L. R. Ir. 284 ("Cromac Springs"); and *Glen & Hall Manufacturing Co. v. Hall*, 61 N. Y. 226, 19 Amer. Rep. 278 ("No. 10, South Water Street, Rochester, New York").

(f) *Lichtenstein v. Mellis*, 8 Oreg. 464.

(g) *Ayer v. Rushton*, 7 Daly, 9.

(h) *Cohn v. Kahn*, 26 Alb. L. J. 342.

(i) 13 Grant. Up. Can. Ch. 366.

Canada said that "where it is clear to the Court that the defendant himself intended an advantage by the use of a particular sign or mark in use by another, and believes he has obtained it, or, in other words, that the defendant himself thought the use of it was calculated to advertise him at the expense of the plaintiff, and this was his object in using it, and where such has been the effect of the user, I think the Court should say to him, 'Remove that sign; its use by you may, as you intend, damage the plaintiff. It cannot be necessary or valuable to you for any other purpose. You have your choice of many signs which, as a mere attraction, or to give your store a marked designation, must answer a fair business purpose equally well.'"

Apart from a business of some kind, no exclusive right can be acquired in the name of a house, any more than in the name of a person, and no right of action arises from the annoyance occasioned by a person renaming his residence after the neighbouring residence of another householder (a). And where an abbreviated telegraphic address ("Street, London") had been used for many years by a business firm, and another firm of a different character afterwards adopted the same telegraphic address, it was held that the confusion which ensued was *damnum absque injuriâ*, and that no injunction could be granted (b).

No right in name of private house or telegraphic address.

The same principle which governs the names of business establishments has been extended to hotels, and a proprietor of one already established has been held entitled to protection against the setting up of hotels in the same neighbourhood under a similar title. Thus, "The Irving House" (c), "The What Cheer House" (d), and "The McCardel House" (e), have been protected.

Hotel.

(a) *Day v. Brownrigg*, 10 Ch. D. 294.

(b) *Street v. Union Bank of Spain & England*, 30 Ch. D. 156.

(c) *Howard v. Henriques*, 3 Sand. S. C. 725, R. Cox, 129.

(d) *Woodward v. Lazar*, 21 Cal. 448, R. Cox, 300; *Gamble v. Stephenson*, 10 Mo. App. 581.

(e) *McCardel v. Peck*, 28 How. Pr. 120, R. Cox, 312.

Must be
distinctive.

On the other hand, the Scotch Court of Session has held that the proprietor of "The Station Hotel" was not entitled to interfere with the use of the name "The Royal Station Hotel" for another hotel in the same neighbourhood, the plaintiff's name not being distinctive, and the defendant's name being sufficiently distinguished by the insertion of the word "Royal" (a).

Name goes
with building.

But it seems that where a name has been attached to a building it passes with it, and cannot be retained or dealt with by the former owner apart from the building. Thus, in *Booth v. Jarrett* (b), the founder of "Booth's Theatre," who had gained a reputation for it by his skill in acting, and had named it after himself, attempted, without success, to prevent the continued use of the name by a person into whose possession the theatre had subsequently come, the name having passed to the defendant with the building and goodwill. Again, in *Mason v. Queen* (c) the proprietor of the "Waverley Hotel," Glasgow, sold his premises to a railway company, who compensated him for the removal. He afterwards assigned the goodwill of his business and trade name to the plaintiff, who was carrying on another hotel in a different part of Glasgow, the name of which was thereupon changed to the "Waverley." The railway company did not require the actual site of the old hotel for their purposes, and subsequently let it to the defendant, who reopened the hotel under the name of the "Old Waverley Hotel," and it was held that the plaintiff was not entitled to restrain the defendant from so doing. In *Woods v. Sands* (d) it was held that the founder of "Woods' Hotel," who had sold and afterwards repurchased his interest in it, had recovered by the reassignment his exclusive right in the name, and the use of it by another person was prohibited. So, in *Armstrong v. Kleinhaus* (e) the

(a) *Charleson v. Campbell*, Ct. of Sess. Cas., 4th Ser. IV. 149.
(b) 52 How. Pr. 169.

(c) 23 Scot. L. Rep. 641.
(d) Dig. 467.
(e) 1 Ky. L. Rep. 112; 82 Ky. 303.

tenant of a business house which he had called "The Tower Palace," was held to have no right in the name capable of being transferred to a different building elsewhere. And in *Pepper v. Labrot* (a) it was held that the name "Oscar Pepper's Old Crow Distillery" had become attached to the distillery, and that Oscar Pepper's son and successor in business, on whose bankruptcy the distillery was sold, was not entitled to interfere with the use by the purchaser of the name "Oscar Pepper" as part of the name of the distillery. But in one Canadian case (b) the purchasers of "The Western or Mason's Hotel" were protected in their exclusive right to the name, as against the vendor, who had reoccupied his former premises after the purchaser had been driven out by a fire.

In the same way, the proprietor of the "Prescott House" Hotel was held entitled to restrain the use of the name by a coach proprietor upon his coaches, an agreement between the latter and a former owner of the hotel being treated as having been in the nature of a revocable licence, which had been revoked upon the sale of the hotel to the plaintiff (c). And not only the proprietors of such establishments have been protected in respect of the names by which they have been known, but other persons who have contracted with such proprietors for the exclusive conveyance of visitors to and from their hotels, have been held entitled to restrain the use by others not so authorised upon their vehicles and servants' clothing of the name of the establishment with which they were connected (d).

Name of hotel on conveyances.

So, again, the name of a line of steamships (e), of Similar cases.

(a) 8 Fed. Rep. 29.	360, R. Cox, 115; <i>Marsh v. Billings</i> ,
(b) <i>Mossop v. Mason</i> , 18 Grant	7 Cush. 322, R. Cox, 118. And
Up. Can. Ch. 453.	compare <i>Knott v. Morgan</i> , 2 Keen,
(c) <i>Deiz v. Lamb</i> , 29 N. Y. Super.	213.
Ct. 537.	(e) <i>Winsor v. Clyde</i> , 9 Phila. 513
(d) <i>Stone v. Carlan</i> , 13 Mo. L. R.	("Keystone Line").

collieries (*a*), and of particular waggons (*b*), has been protected.

Name not used in ordinary business.

Closely connected with the cases which concern the rights of an individual or firm in the trade name under which his or their business is carried on, are the cases in which it has been sought by one person to restrain the unauthorised use of his name by another, though he does not himself use that name over a shop, or, in fact, as a trade name usually so called.

Where articles are produced under a certain name.

Where a person produces certain articles, and a representation is made by another that articles not the production of that person are in fact produced by him, there is an injury to the right of property in the name, which has in fact, though not used as a trade mark, yet come to be the producer's means of selling the articles produced.

Author.

Thus, an author is entitled to protection for the name which sells his works for him. In *Lord Byron v. Johnston* (*c*), the defendant, who had advertised for sale poems which he represented to be by the plaintiff, but as to which he declined to swear to his belief in their genuineness, was restrained by injunction. And in *Besant v. Moffatt & Paige* (*d*) a well-known writer was protected against the use of his name in connection with a book for which he was not responsible.

Humourist.

In *Clemens v. Such* (*e*), a humorous writer, whose works were published under the *nom de plume* of "Mark Twain," was held to be entitled to restrain the unauthorised use of that designation by another person. And in *Clemens v. Belford* (*f*) it was held that the name might not be connected with matter not written by the plaintiff, though it might be attached to a reprint of matter written by him and not copyrighted. But in *Munro v. Beadle* (*g*)

(*a*) *Braham v. Beacham*, 7 Ch. D. 848 ("Radstock Collieries").

(*b*) *Shaver v. Shaver*, 54 Iowa, 08 ("Shaver Waggons").

(*c*) 2 Mer. 29.

(*d*) 84 L. T. (Journal) 152.

(*e*) Dig. 429.

(*f*) 11 Biss. 459.

(*g*) 46 U. S. Pat. Gaz. 448.

it was thought that one writer of detective stories could not restrain another from using the descriptive name of "Sleuth."

So, again, a legal writer is entitled to prevent the issue Legal writer. as his of works or editions not of his production. In *Archbold v. Sweet* (a) the plaintiff was the author of a book on a legal subject, of which he had sold the copyright to the defendant. The plaintiff refusing to re-edit the book, the defendant had it edited by another, and the plaintiff thereupon came forward to complain of the inaccuracies which he alleged to be contained in the new edition. Lord Tenterden, C. J., after remarking on the close analogy between that case and those in which an inferior article was sold in the name of a well-known manufacturer, the injury being in the latter case to the sale of the goods, in the former to the character of the author, laid down to the jury that if the new edition, in the form in which it was put forth, would be understood by purchasers who paid reasonable attention to its contents to be by the plaintiff, their verdict must be in his favour.

So, again, a painter will be protected from having Painter. exhibited as his a picture which he has not painted (b), and a medical man who compounds medicines from having Medical man. spurious medicines sold as his (c).

In all such cases the plaintiff must, of course, show that Deception must be probable. deception is probable, or he cannot succeed in obtaining the relief he seeks. Thus, where an artist painted a picture, and another person exhibited a diorama imitated from it, it was held that there could be no deception or injury, though if the plaintiff's picture had been a diorama the case would have been different (d). So where a person who wrote songs under the name of Claribel sought to restrain the publication of a song described as "written by

(a) 1 M. & Rob. 162.

(b) *Martin v. Wright*, 6 Sim.

297.

(c) *Clark v. Freeman*, 11 Beav.

112.

(d) *Martin v. Wright*, 6 Sim. 297.

Claribel," no mention being made of the composer's name, though the music given was not that of Claribel, it was decided that the words "written by" did not imply that the music was also composed by Claribel, and the injunction was refused (a).

*Clark v.
Freeman.*

The decision in *Clark v. Freeman* (b) has been much discussed with respect to the right a man has in his name. In that case the plaintiff, Sir James Clark, was an eminent physician, who filed a bill to restrain the advertisement and sale by the defendant of certain pills termed by him "Sir J. Clarke's Consumption Pills," the advertisements being so framed as to be calculated to induce the public to buy the pills as being of the plaintiff's invention. Lord Langdale, M. R., refused to grant the injunction, on the ground that there was no injury to property; but apparently not without some doubt, since he gave leave for the case to be mentioned again to him if cases in support of the bill could be produced. He did not, however, think the cases mentioned to him (c) sufficient to warrant him in granting the injunction, but at the same time he remarked that if "Sir James Clark had been in the habit of manufacturing and selling pills, it would have been very like the other cases in which the Court had interfered for the protection of property." The principle on which Lord Langdale's decision was based was that the Court would not interfere where the name pirated by the defendant had not become known to the public in connection with a manufactured article, but was merely a name under which an individual had acquired a certain reputation (d). It is evident, however, that the sale of quack medicines under the name of an eminent physician would tend to destroy his reputation and the confidence

(a) *Barnard v. Pillow*, W. N. 1868, p. 94; and see *Seeley v. Fisher*, 11 Sim. 581; and *Archbold v. Sweet*, 1 M. & Rob. 162.

(b) 11 Beav. 112.

(c) *Lord Byron v. Johnston*, 2 Mer. 29; and *Routh v. Webster*, 10 Beav. 561.

(d) See *Delondre v. Shaw*, 2 Sim. 237.

of his patients in him, and thereby to cause him a far more severe pecuniary loss than would be incurred by the sale of a few boxes of pills or copies of a book being lost to him. Later judges have, therefore, been of opinion that the case in question "might have been decided in favour of the plaintiff, on the ground that he had a property in his own name" (a).

Whatever rights a man may, irrespective of contract, have in his own name, so as to be able to prevent the unauthorised use of it by another, it is always open to him to modify those rights by contract, whether by way of permitting others to use his name in a certain manner (b), or by way of restraining his own use of it to a certain extent (c). Thus, where a publisher had sold to the defendants the copyright of an annual, entitled "Beeton's Christmas Annual," he himself entering into their service, it was held that the defendants were entitled to continue the annual publication under that same name, even after the plaintiff had ceased to remain in their employ, and had become unwilling for his name to be used by them in connection with a work not of his production (d). But it seems that, although a contract by which a man binds

Contracts
in respect
of names.

(a) Per Cairns, L. J., in *Maxwell v. Hogg*, L. R. 2 Ch. 307. In *Springhead Spinning Co. v. Riley*, L. R. 6 Eq. 561, Malins, V.-C., went even farther. And in *In re Riviere*, 26 Ch. D. 48-53, Lord Selborne, C., observed "that case has seldom been cited but to be disapproved; could not a professional man be injured in his profession by having his name associated with a quack medicine?" In *Williams v. Hodge & Co.*, 84 L. T. (Journal) 134, a very similar case, Kay, J., said that the decision in *Clark v. Freeman* "was rather a surprising one, and one which he had always thought was not sufficiently considered"; but he did not feel himself at liberty to disregard it on an interlocutory application, in the absence of authority to the contrary. The

expressions of opinion of Lord Cairns, Lord Selborne and Malins, V.-C., had apparently not been brought to his notice. Lord Westbury, C., however, spoke of the decision at all events without disapprobation: *Leather Cloth Co.'s case*, 4 De G. J. & S. 137.

(b) *Ward v. Beeton*, L. R. 19 Eq. 207. See *Condy v. Mitchell*, 37 L. T. N. S. 268, 766; *Hallett v. Cumston*, 110 Mass. 29; *Weed v. Peterson*, 12 Abb. Pr. N. S. 178; *Coe v. Bradley*, 9 U. S. Pat. Gaz. 541.

(c) *Ainsworth v. Bentley*, 14 W. R. 630; *Ward v. Beeton*, *ubi supra*; *Peltz v. Eichele*, 62 Mo. 171; *Coe v. Bradley*, 9 U. S. Pat. Gaz. 541.

(d) *Ward v. Beeton*, *ubi supra*. See *Gage v. Canada Publishing Co.*, 11 Can. Sup. Ct. 306.

himself to limit in some way his use of his own name can be enforced, a contract so binding him cannot be made by the representative of his estate in bankruptcy, and if such a contract has been entered into, the bankrupt will be entitled to disregard it (a).

Name of editor.

The name of the editor of a publication, appearing upon the title page, forms no part of the title. Romilly, M. R., refused, therefore, to restrain the proprietors of a paper, who had agreed with their editor not to alter the title of their paper without mutual consent, from omitting the publication on the title page of the editor's name as such (b).

Where name is used so as to injure.

It is clear that a man has a right to prevent the unauthorised use of his name by another person, apart from any special manufacture, where such use of it might involve him in legal or other difficulties. Thus, in *Routh v. Webster* (c) a bill was filed to restrain the provisional directors of a joint-stock company, called "The Economic Conveyance Company," from using the plaintiff's name in their prospectuses as a trustee of the company without his authority. The defendants setting up by way of defence that what had been done had been done inadvertently, and stating their intention of discontinuing their misrepresentations, the Master of the Rolls granted the injunction, holding that the defendants were not entitled "to use the name of any person they pleased, representing him as responsible in their speculations, and to involve him in all sorts of liabilities, and then to be allowed to escape the consequences by saying they had done it by inadvertence," and also that the plaintiff was in nowise bound to surrender his right to the injunction, trusting to the assurances of the defendants as to their intentions for the future. This decision has been generally

(a) *Helmbold v. Helmbold Manufacturing Co.*, 53 How. Pr. 458; and see *Walker v. Mottram*, 19 Ch. D. 355.

(b) *Crookes v. Petter*, 6 Jur. N. S. 1181.

(c) 10 Beav. 561.

approved as an "authority for preventing the improper use of a man's name against his will; not for the restraint of a libel, for no libel was involved" (a).

Where, however, a man's name has been used against Trade libel. his will in such a manner as to be libellous, or where statements have been made disparaging the goods sold under his name or trade mark, or threatening persons dealing in his goods, a more difficult question is raised, and one which has not always been answered in the same way. With respect to libels, Lord Cottenham, C., said (b), that the Libel Act "appointed a jury as the proper tribunal for trial of injuries to the person by libel or defamation; and that the liberty of the press consisted in the unrestricted right of publishing, subject to the responsibilities attached to the publication of libels, public or private." The principle that the publication of a libel was a crime, and that the Court of Chancery had no jurisdiction to prevent the commission of crimes, except in such cases as those relating to the protection of infants, was laid down by Lord Eldon in 1818 (c), and after that time Equity judges frequently stated that it was not within the proper scope of their authority to restrain the publication of libels (d). There were, indeed, cases

(a) Per Lord Cairns, C., in *Prudential Assurance Co. v. Knott*, L. R. 10 Ch. 142. In *Webster v. Webster*, 3 Swanst. 490 n. the injunction was refused because there was no injury to be apprehended. In *Tudor v. Tudor*, W. N. 1873, p. 72, there was an express contract. See *Bullock v. Chapman*, 2 De G. & Sm. 211; *Dixon v. Holden*, L. R. 7 Eq. 488; *Reid v. Sibbald*, 18 Journ. of Juris. 392; and cases *infra*.

(b) *Fleming v. Newton*, 1 H. L. C. 376. This case was a Scotch one, and the Lord Chancellor was speaking with reference to the Scotch Libel Act, but his remarks are equally applicable to cases arising in England, and under Order XXXVI., rule 2 of the Rules of

1883, a defendant in a libel case can still insist upon a jury.

(c) *Geo v. Pritchard*, 2 Swanst. 413.

(d) *Martin v. Wright*, 6 Sim. 297; *Seelcy v. Fisher*, 11 Sim. 581; *Clark v. Freeman*, 11 Beav. 112; *Emperor of Austria v. Day*, 2 Giff. 628, 3 De G. F. & J. 217 (in particular per Turner, L. J.); *Mulkern v. Ward*, L. R. 13 Eq. 619; *Browne v. Freeman*, W. N. 1873, p. 178; *Prudential Assurance Co. v. Knott*, L. R. 10 Ch. 142; *Fisher v. Apollinaris Co.*, *ib.* 297. The same view has been taken in India: *Shepherd v. Trustees of the Port of Bombay*, Ind. L. R. 1 Bomb. 132; and in America: *Mauger v. Dick*, 55 How. Pr. 132.

in which it was thought that where an injury was occasioned or threatened to a right of property by a libellous statement, the Court had jurisdiction to interfere to protect that right of property (a), but, practically speaking, cases which involved the consideration of libellous statements were left to the Courts of Common Law (b).

Effect of the
Judicature
Act, 1873.

The Judicature Act, 1873, however, introduced a new element into the discussion by enacting (§ 25, subs. 8) that "an injunction may be granted by an interlocutory order of the Court in all cases in which it shall appear to the Court to be just or convenient that such order should be made"; and in *Thorley's Cattle Food Co. v. Massam* (c), Vice-Chancellor Malins suggested that this enactment had conferred upon the Court more extensive powers than those which it previously possessed, and that an injunction might have been granted by virtue of those powers to restrain an injurious and unjust statement. Numerous cases have since been decided with respect to the effect of the section, in some of which expressions were employed which were calculated to lead to the belief that the power to grant injunctions where it was thought to be "just or convenient" conferred a power to grant injunctions in cases in which no legal remedy previously existed (d). It is now, however, settled—and this is not opposed to the observations before referred to—that the right view is that the section has enlarged the powers of the Court, not by enabling the Court to grant relief in cases where none was obtainable before in

(a) This was especially the view of Malins, V.-C. See *Dixon v. Holden*, L. R. 7 Eq. 488; *Springhead Spinning Co. v. Riley*, L. R. 6 Eq. 561; *Rollins v. Hinks*, L. R. 13 Eq. 355; *Aarmann v. Lund*, L. R. 18 Eq. 330. And see also *Emperor of Austria v. Day*, 3 De G. F. & J. 217; *Maxwell v. Hogg*, L. R. 2 Ch. 307; *James v. James*, L. R. 13 Eq. 421.

(b) For the principles by which the Courts of Common Law were guided, see *Wren v. Weild*, L. R. 4 Q. B. 730; *Western Counties Manure Co. v. Lawes Chemical Manure Co.*, L. R. 9 Ex. 218.

(c) 6 Ch. D. 582.

(d) See *Beddow v. Beddow*, 9 Ch. D. 89; *Quartz Hill Consolidated Gold Mining Co. v. Beall*, 20 Ch. D. 501.

any of the Superior Courts, but by way of giving each branch of the High Court power to grant relief in cases which could previously be brought only in the same or a different form before some other branch of the Court (a); so that, as Cotton, L. J., said in the case of *North London Railway Co. v. Great Northern Railway Co.* (b), "where there is a legal right which was, independently of the Act, capable of being enforced either at law or in equity, there, whatever may have been the previous practice, the High Court may interfere by injunction in protection of that right."

The injunction may be granted to restrain the continued publication of a libel which has been found to be so by the verdict of a jury (c), or it may be granted to restrain the publication of statements which have not been submitted to a jury (d). But where the Court is asked to grant an injunction, especially on an interlocutory application, without the assistance of a jury, the jurisdiction which it possesses so to do is one which must be exercised very carefully (e), and it ought not to be exercised unless the statements of which complaint is made are proved to be untrue (f), unless they are injurious to the plaintiff (g),

Conditions
necessary for
injunction.

(a) *Day v. Brownrigg*, 10 Ch. D. 294; *Ward v. Drat*, L. J. N. of C. 1878, p. 67; *Gaskin v. Balls*, 13 Ch. D. 321; *Dicks v. Brooks*, 15 Ch. D. 22 (per Bacon, V.-C.).

(b) 11 Q. B. D. 30.

(c) *Saxby v. Easterbrook*, 3 C. P. D. 339; *Hinrichs v. Berudes*, W. N. 1873, p. 11.

(d) As in *Thomas v. Williams*, 14 Ch. D. 864.

(e) *Quartz Hill Consolidated Gold Mining Co. v. Beall*, 26 Ch. D. 501; *Armstrong v. Armit*, 2 Times L. R. 887; *Coulson & Sons v. Coulson & Co.*, 3 Times L. R. 846; *Liverpool Household Stores Association v. Smith*, 37 Ch. D. 170. See *Marks v. Conservative Newspaper Co., Ltd.*, 3 Times L. R. 244.

(f) *Halsey v. Brotherhood*, 15 Ch. D. 514; 19 *ib.* 386; *Burnett v. Tate*, 45 L. T. N. S. 743; *Anderson v. Liebig's Extract of Meat Co., Ltd.*, *ib.* 757; *Quartz Hill, &c., Co. v. Beall*, *ubi supra*; *Benbow v. Low* (1), 23 Sol. J. 819; *Roper's, &c., Co. v. Copeman's, &c., Association, Ltd.*, 28 *ib.* 218; *Armstrong v. Armit*, 2 Times L. R. 887; *Coulson & Sons v. Coulson & Co.*, 3 Times L. R. 846; *Liverpool Household Stores Association v. Smith*, 37 Ch. D. 170; *Poulett v. Chatto & Windus*, 32 Sol. J. 24. And see *Clover v. Royden*, L. R. 17 Eq. 190.

(g) *Dicks v. Brooks*, 15 Ch. D. 22; and see *Brook v. Evans*, 2 L. T. N. S. 740; *Bullock v. Chapman*, 2 De G. & Sm. 211.

with reference to his trade or property (a), and are so clearly libellous that a contrary verdict of a jury would be set aside as unreasonable (b), unless it is proved that the defendant intends to continue to make them (c), and that the injury will be irreparable, *i.e.* incapable of compensation by damages (d), and unless (in cases of privilege) express malice is also established (e). Thus, in *Halsey v. Brotherhood* (f) the defendant had threatened intending purchasers from the plaintiff, alleging that the plaintiff was manufacturing in infringement of his, the defendant's, patent rights; and Jessel, M. R., and the Court of Appeal held that an injunction could not be granted unless the defendant persisted in making the statements after they had been proved to be false. In *Colley v. Hart* (g) it was held by North, J., that there was no jurisdiction to restrain the defendant from issuing a circular to the plaintiff's customers, alleging that the plaintiff was infringing his trade marks, and threatening proceedings. And in *Anderson v. Liebig's Extract of Meat Co., Ltd.* (h), Chitty, J., refused to restrain the company (who were taking proceedings to stop the plaintiff from selling his goods as "Baron Liebig's Extract of Meat" and using on the pots a photograph of the Baron) from circulating letters among the plaintiff's customers, stating that he was using the name and photograph without authority, on the

(a) See per Lindley, L. J., in *Coulson & Sons v. Coulson & Co.*, 3 Times L. R. 846, with which compare the statement by North, J., in *Pollard v. Photographic Co.*, 40 Ch. D. 345.

(b) *Coulson & Sons v. Coulson & Co.*, *ubi supra*; *Liverpool Household Stores Association v. Smith*, 37 Ch. D. 170.

(c) *Quartz Hill, & Co., v. Beall*, 20 Ch. D. 501.

(d) *Armstrong v. Armit*, 2 Times L. R. 887.

(e) *Quartz Hill, & Co., v. Beall*, *ubi supra*; *Burnett v. Tate*, 45 L. T. N. S. 473; *Armstrong v.*

Armit, *ubi supra*; *Coulson & Sons v. Coulson & Co.*, 3 Times L. R. 846; *Liverpool Household Stores Association v. Smith*, 37 Ch. D. 170.

(f) 15 Ch. D. 514; 19 *ib.* 386. See the New York case of *Wolfe v. Burke*, 56 N. Y. 115. The precise question raised in *Halsey v. Brotherhood* is now settled by § 32 of the Patents Act, 1883, under which numerous cases have been decided, but the general question of injunctions to restrain trade libels remains.

(g) 6 F. R. 17.

(h) 45 L. T. N. S. 757.

ground that the company was not shown to be acting otherwise than *bonâ fide*, or to be stating that which was untrue.

On the other hand, where the necessary facts are present, an injunction will be granted, as in *Thorley's Cattle Food Co. v. Massam* (2) (a), where it was established that the plaintiffs and defendants were both in possession of and entitled to use the same secret recipe in their respective businesses, and Malins, V.-C., and the Court of Appeal granted an injunction to restrain the defendants from publicly advertising that they alone were acquainted with the secret. When granted.

Where the plaintiff in an action for slander of title to a trade mark and his property therein, dies, the cause of action survives to his legal personal representative (b). Survival of cause of action.

The same principle on which misrepresentations by an original manufacturer with respect to the goods and business of a subsequent manufacturer are restrained, applies with even greater force to similar misrepresentations by the latter, and while it is open to any one to manufacture an unpatented article with the process of manufacture of which he has become acquainted, and also to describe it by the name applied to it by the original inventor so soon as that name shall have become *publici juris*—that is to say, descriptive of a specific article, but not of a specific maker—yet at the same time such subsequent manufacturer is not entitled to carry on an unfair competition in trade with the original maker or his successors in business, by means of assertions or representations that his own article is the only genuine one, or that the article of the original maker or his successors is spurious (c). Misrepresentations by subsequent manufacturer.

(a) 14 Ch. D. 763; and see *Hill v. Hart-Davies*, 21 Ch. D. 798; *Hermann Loog, Ltd. v. Bean*, 26 Ch. D. 806; *Hayward & Co. v. Hayward & Sons*, 34 Ch. D. 198; *Punch v. Boyd*, 16 L. R. Ir. 476.

(b) *Hatchard v. Mège*, 18 Q. B. D. 771.

(c) *James v. James*, L. R. 13 Eq. 421; *Thomas v. Williams*, 14 Ch. D. 864; *Liebig's Extract of Meat Co., Ltd. v. Anderson* (2), 55 L. T. N. S. 206; *Hirsh v. Hirsh & Co.*, 80 L. T. (Journal) 283; *Briton Life Association, Ltd. v. Roberts*, 2 Times L. R. 319.

"Original."

And where such an assertion or representation is embodied in the title of the later manufacturer's article by its being styled the "original"—an appellation which would naturally suggest the idea of the article in question being the make of the original manufacturer—such fraudulent representation will usually be restrained (a). But in the entire absence of evidence as to deception, Wood, V.-C., refused to grant an injunction in a similar case (b), and from the result of later litigation between the same parties (c) it is clear that the presumption against a person who styles an article of his own manufacture, but not of his invention, "the original," may be rebutted. In *Dence v. Mason* (1) (d) the defendant was restrained from styling himself the original maker of the "essence of beef," Malins, V.-C., holding that even if he had been the first to actually compound the article, which was not satisfactorily proved, he was not entitled to make such statements as those complained of, since he was in the employ of the plaintiff's predecessor in business at the time when he said he made it for the first time. In *Fullwood v. Fullwood* (2) (e) the defendants attempted to represent their business to be the original one, by assuming for it the date of establishment of the business which was really the first.

False representation of agency.

A dealer may not represent, contrary to the fact, that he is agent for a manufacturer (f); neither may a

(a) *Cooks v. Chandler*, L. R. 11 Eq. 446; *Lazenby v. White*, 41 L. J. Ch. 354. So in *M. Melachrino v. R. Melachrino & Co.*, Chitty, J., May 27th, 1888, where the defendants had placed on their labels the words "R. Melachrino & Co. Original Egyptian cigarettes." And see *Hagg v. Darley*, 47 L. J. Ch. 567.

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

(c) *Browne v. Freeman*, W. N. 1873, p. 178. This was, however, before the cases under the Judi-

cature Act, 1873, which see *supra*.

(d) Dig. 534; 41 L. T. N. S. 573.

(e) 9 Ch. D. 276. And see *Green v. Rooke*, W. N. 1872, p. 49; *Wheeler v. Johnson*, 5 L. R. Ir. 284; *Whitney's Application*, 5 Grant Up. Can. Ch. 333; *Mowson v. Mason*, 18 ib. 456; *Blackwell v. Wright*, 73 N. Car. 333; *Woods v. Sands*, Dig. 467.

(f) *Hove v. McKernan*, 30 Beav. 547.

manufacturer represent, contrary to the fact, that a dealer is acting as agent for him (a).

In other cases the attempt to deceive has been made in different forms: thus, in an early case (b), the defendant attempted to attract to himself the custom intended for the plaintiffs by an ingenious variation of their labels, his own labels being facsimiles of those of the plaintiffs, with only the difference that, whereas theirs contained the sentence "Manufactured by Day and Martin," his bore the words "Equal to Day and Martin's," the "Equal to" being in very small type. So, in an American case (c), a dentist formerly employed by the Colton Dental Association, on setting up in business for himself, described himself in his notice as "formerly operator at the Colton Dental Rooms," "formerly operator at the" being printed very small. And in another American case (d) a former partner in a firm of dentists trading as "Morgan and Schuyler," continued to carry on business at the old premises as "B. F. Schuyler, successor to Morgan and Schuyler," the words preceding the old firm name being in such small letters as to be almost invisible. In *Mallan v. Davis* (e) a dentist, who had practised for several years in Praed St. with the words "Old-established Dentist" over the door, left that address; and the defendant, who practised as a dentist at another house in Praed St., put up a notice stating that the old-established dentist could be consulted there; and it was held that he had acted in a way calculated to deceive, but no injunction was granted, there having been a delay of three months, and the defendant giving an undertaking to combine his own name in a conspicuous way with the description.

Deceptive labels and notices.

(a) *Colman v. Flavel*, 12 Sawy. 220.

(b) *Day v. Binning*, C. P. Cooper, 489; 1 Leg. Obs. 205. See *Wolfe v. Alsop* (1) & (2), 10 Vict. L. R. (E.) 41, 12 *ib.* 421.

(c) *Colton v. Thomas*, 2 Brews. 308, R. Cox, 507.

(d) *Morgan v. Schuyler*, 79 N. Y. 490.

(e) 3 Times L. R. 221.

*Franks v.
Weaver.*

Again, in *Franks v. Weaver* (a), the plaintiff sold a medicine which he had invented, and which he termed "Franks' Specific Solution of Copaiba," in bottles enclosed in wrappers, on which were printed directions for use, and testimonials. The defendant, an agent of the plaintiff, sold a preparation of his own, labelled "Chemical Solution of Copaiba." The label went on to state that the plaintiff had invented the "Specific Solution," and then gave the testimonials printed by the plaintiff as commendatory of the plaintiff's medicine, and also the same directions for use as those given by the plaintiff. In *Sedon v. Senate* (b), a person who had sold a medicine to another, set up a new medicine under a similar description, and in his advertisement adopted verses which had been attached to the original medicine. In all these cases, except *Mallan v. Davis* (c), injunctions were granted.

Directions for
use.

With respect to directions for the use of the article, it seems that, as Malins, V.-C., said in *Massam v. Thorley's Cattle Food Co.* (1) (d), if the article produced by one person is the same as that produced by another, and the former is quite at liberty to produce the same article, then the directions used by the latter are the correct directions for the use of the former's article, and he can only repeat them. In fact, if he could not give the appropriate directions for using the article which he is entitled to make, his liberty to manufacture would be unduly interfered with. The decision in the above case was, however, reversed by the Court of Appeal (e) on the general question of representation, the imitation of the directions being referred to as an indication of fraudulent intention, and any trader who uses the same directions as another

(a) 10 Beav. 297. And see *Siegert v. Findlater*, 7 Ch. D. 801; *Siegert v. Ehlers*, Dig. 432; *Dunbar v. Glenn*, 42 Wisc. 118.

(b) 2 V. & B. 220. And see *Wotherspoon v. Gray*, Ct. Sess. Cas.

3rd Ser. II. 38, where the interdict was refused.

(c) 3 Times L. R. 221.

(d) 6 Ch. D. 574, 581. And see per Cotton, L. J., in *In re Leonard & Ellis*, 53 L. J. Ch. 611.

(e) 14 Ch. D. 748.

ought to take great care to prevent the possibility of deception.

To describe articles formerly patented by the name of Name of patentee. the former patentee is not necessarily fraudulent, since the name may be used as indicative of a principle of construction (a); but in an American case (b) an injunction was granted to restrain the defendant from marking goods of his own make as being made under the plaintiff's subsisting patent, notwithstanding an allegation by the defendant that the patent was invalid.

The imitation of a peculiar manner of making up Mode of packing. and packing goods may, in combination with other circumstances, be held to prove a fraudulent intention; and it seems that, even in the absence of other circumstances of fraud, if the imitation is very significant, and the evidence very conclusive, an injunction will be awarded (c).

The manner in which the Court interferes by way of Imitation of line of omnibuses. injunction to prevent unfair competition in trade is well illustrated by a case which has always attracted a good deal of attention—that of the omnibus companies (d). In that case the plaintiffs were the proprietors of a line of omnibuses painted in a particular manner, with the words "Conveyance Company" and "London Conveyance Company" upon them. The defendant ran omnibuses similarly painted, and dressed his servants in livery imitated from that of the plaintiffs' employés. On his being required to aiter this, he made some mere colourable

(a) *Whesler & Wilson Manufacturing Co. v. Shakespear*, 39 L. J. Ch. 35; *Singer Manufacturing Co. v. Loog* (3), 8 App. Cas. 15; and other cases in Ch. 4.

(b) *Washburn & Moen Manufacturing Co. v. Haish*, 9 Biss. 141.

(c) See *Edelsten v. Vick*, 11 Hare, 78; *Woollam v. Ratcliff*, 1 H. & M. 259; *Anglo-Swiss Condensed Milk Co. v. Swiss Condensed Milk Co.*, W. N. 1871, p. 163; *Lever v.*

Goodwin, 36 Ch. D. 1; *McLean v. Fleming*, 96 U. S. Rep. 245; *Frese v. Bachof* (1), 13 Bl. C. C. 234; S. C. (2), 14 *ib.* 432. See also *Orr v. Diaper*, L. R. 4 Ch. D. 92.

(d) *Knott v. Morgan*, 2 Keen, 213. See also *Stone v. Carlan*, 13 Mo. L. R. 360, R. Cox, 115; *Marsh v. Billings*, 7 Cush. 322, R. Cox, 118; *Deiz v. Lamb*, 29 N. Y. Sup. Ct. 537.

alterations, but really left the matter as it stood at first. Lord Langdale, M. R., on the case coming before him on motion to dissolve an interlocutory injunction, said that he had not the least doubt that the defendant intended to represent his omnibuses to the public as those of the plaintiffs. He said "it was not to be said that the plaintiffs had any exclusive right to the words 'Conveyance Company' or 'London Conveyance Company,' or any other words; but they had a right to call upon that Court to restrain the defendant from fraudulently using precisely the same words and devices which they had taken for the purpose of distinguishing their property, and thereby depriving them of the fair profits of their business by attracting custom on the false representation that carriages, really the defendant's, belonged to and were under the management of the plaintiffs." This case was not at all a case of trade mark, though reference has been made to it as such; the Master of the Rolls expressly denied any exclusive right in the words painted on the vehicles, and personally altered the terms of the injunction so as to avoid creating such a right. In the language of Wood, V.-C. (a), "the defendant might have had those words painted on a yellow omnibus without objection, and so of the other resemblances: the wrong lay in their accumulation, not in any one of them alone." The value of the case really consists in the example it affords of the way in which the aggregation of a number of circumstances, individually comparatively harmless, may produce a result injurious to an individual and obnoxious to the law; and also of the manner in which the law will interfere to protect the interests of honest trade.

Etchings.

Where A had surreptitiously obtained possession of some etchings by B, and had advertised them for exhibition, and a catalogue of them, Lord Cottenham, C., held that

(a) *Woollam v. Ratcliff*, 1 H. & M. 259.

there was a title to relief alike on the ground of injury to property and on that of breach of trust (a).

As to the cases which have been decided in respect of Trade secrets, trade secrets, the general rule may be stated as being that any person who has, without the use of unfair means, become acquainted with the mode of compounding a secret unpatented preparation, may make and sell the compound, provided he does not lead the public to suppose that his preparation is the manufacture of the original discoverer or of his successors in business; and he may even call the compound made by himself by the same name as that given by the original discoverer to his, so long as he does not sell his own goods as and for those of another (b). On the other hand, where the knowledge of the secret process has been acquired by means of a breach of trust, neither the person who has committed the breach of trust, nor any one to whom he has imparted his discovery, will be allowed to make use of the information so surreptitiously acquired (c).

Again, "there is no doubt whatever that where a party who has a secret in a trade employs persons under contract express or implied, or under duty express or implied, those persons cannot gain the knowledge of that secret and then set it up against their employer" (d); and, stating it generally, where one person has entered into a contract, express

Contract not to use or divulge another's secret.

(a) *Prince Albert v. Strange*, 1 Mac. & G. 25. See *Pollard v. Photographic Co.*, 40 Ch. D. 345.

(b) *James v. James*, L. R. 13 Eq. 421; *Liebig's Extract of Meat Co. v. Hambury*, 17 L. T. N. S. 298; *Condy v. Mitchell*, 37 L. T. N. S. 268, 766; *Carter v. Goetze*, 2 Keen, 581; *Singleton v. Bolton*, 3 Doug. 293; *Williams v. Williams*, 3 Mer. 157; *Canham v. Jones*, 2 V. & B. 218. And see the comments on that case in *Morison v. Moat*, 9 Hare, 241. But of course, when the name has become a trade mark, no one but the proprietor can use

it. The question is whether the name is descriptive of the article or distinctive of the manufactory. See *Massam v. Thorley's Cattle Food Co.* (2), 14 Ch. D. 748.

(c) *Williams v. Williams*, 3 Mer. 157; *Youatt v. Winyard*, 1 Jac. & W. 394; *Tipping v. Clarke*, 2 Hare, 383; *Morison v. Moat*, 9 Hare, 241, 21 L. J. Ch. 248; *Estcourt v. Estcourt Hop Essence Co.*, L. R. 10 Ch. 276; *Portal v. Hino*, 4 Times L. R. 330.

(d) Per Lord Cranworth, L. J., in *Morison v. Moat*, 21 L. J. Ch. 248.

or implied (a), with another person, to keep that other person's secret, and not to divulge it, nor to use it for his own advantage, he will be restrained by an injunction from so divulging or using the secret in question (b); and so will a person who is acting in collusion with him (c); and a contract by which, on the sale of a trade secret, the vendor has bound himself not to use that secret, is not invalid as being in restraint of trade (d). Where the defendant, who had become acquainted with a trade secret, stood by and allowed the plaintiff to purchase it, without disclosing that he was acquainted with it, it was held that he was estopped from setting up his previous knowledge against the plaintiff, and an injunction was granted to restrain him from using it (e).

Name of
secret manu-
facture.

Where the defendant is availing himself of a breach of faith or of contract by means of the use of a certain designation for his goods, in such a case the defendant will be restrained from the use of such designation, although the plaintiff may have no exclusive right in the same, apart from such special circumstances (f).

(a) See *Tipping v. Clarke*, 2 Hare, 383; *Weston v. Hemmons*, 2 Vict. L. R. Eq. 121.

(b) *Sedon v. Senate*, 2 V. & B. 220; *Bryson v. Whitehead*, 1 S. & S. 74; *Green v. Fulgham*, *ib.* 398; *Tipping v. Clarke*, 2 Hare, 383; *Morison v. Moat*, 9 Hare, 241, 21 L. J. Ch. 248; *Hagg v. Darley*, 47 *ib.* 567; *Portal v. Hine*, 4 Times L. R. 330; *Whitney v. Hickling*, 5 Grant Up. Can. Ch. 605; *Weston v. Hemmons*, 2 Vict. L. R. Eq. 121; *Peabody v. Norfolk*, 98 Mass. 452; *Salomon v. Hertz*, 40 N. J. Eq. 400. But in the last case it was held that the defendant ought not to be restrained from divulging where or from whom the plaintiff bought his materials, or to whom he sold his goods, or the prices at which he bought and sold. In *Newbery v. James*, 2 Mer. 446, Lord Eldon declined to issue an injunction, on the ground that the Court could

have no means of judging as to its infringement.

(c) *Portal v. Hine*, 4 Times L. R. 330; *Peabody v. Norfolk*, 98 Mass. 452; *Salomon v. Hertz*, 40 N. J. Eq. 400.

(d) *Bryson v. Whitehead*, 1 S. & S. 74; *Hagg v. Darley*, 47 L. J. Ch. 567; *Jarris v. Peak*, 10 Paige 118. And see *Leather Cloth Co. v. Loreont*, L. R. 9 Eq. 352; *Allsopp v. Wheatcroft*, L. R. 15 Eq. 59; *Brewer v. Lamar*, 69 Ga. 556. In *Vickery v. Welch*, 19 Pick. 523, the Sup. Ct. of Mass. held that a person who had agreed to sell a secret process ought to have covenanted to communicate the secret to the purchaser and to no one else.

(e) *Champlin v. Stoddart*, 37 N. Y. Sup. Ct. 300.

(f) *Morison v. Moat*, 9 Hare, 241. And see *Green v. Fulgham*, 1 S. & S. 398; *James v. James*,

No one will be allowed to use the name of a well-known article, with the secret recipe of which he is unacquainted, upon goods of his own make, so as to represent the spurious goods to be genuine (a); but it seems that if a person has an equal right to the use of the name with the person who is acquainted with the secret in accordance with which the goods are manufactured, the latter, at all events, cannot restrain him from the use of the mark, whatever remedy may be open to the public (b). If the person of whom complaint is made is acquainted with the secret process, and has been accustomed to use it, the objection to his use of the name does not arise (c), and such a person will not be restrained from using it at the suit of a person who has no right to use the recipe in the district in which the defendant trades (d).

Cannot be used in ignorance of true recipe.

After the death of an inventor of a secret process, his son, who had learnt the secret in his employ, continued to make the article, but did not take out administration to the father, and it was held that without becoming his father's personal representative, he could acquire no right to prevent the use of the secret by another (e).

Secret passes with owner's personal estate.

The manner in which the Court deals with a secret process is well exemplified by the case of *Green v. Folgham* (f). There the grandfather of the plaintiffs and defendant possessed the secret of a recipe for an ointment called "Dr. Johnson's Ointment for the Eyes." This secret he settled on his daughter at her marriage, and directed that at the death of the survivor of her and

Green v. Folgham.

L. R. 13 Eq. 421; *Estcourt v. Estcourt Hop Essence Co.*, L. R. 10 Ch. 276; *Weston v. Hemmons*, 2 Vict. L. R. Eq. 121. In *Cankam v. Jones*, 2 V. & B. 218, and *Green v. Rooks*, W. N. 1872, p. 49, L. J. N. of C., 1872, p. 54, no fraud was proved.

(a) *Cotton v. Gillard*, 44 L. J. Ch. 90; *Ansell v. Gaubert*, Dig. 163.

(b) *Weston v. Ketcham* (1), 29

N. Y. Super. Ct. 54; S. C. (2), 51 How. Pr. 455.

(c) *Witthaus v. Braun*, 44 Md. 303; and see *Helmbold v. Helmbold Manufacturing Co.*, 53 How. Pr. 453.

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

(e) *Hovenden v. Lloyd*, 18 W. R. 1132. And see *Singleton v. Bolton*, 3 Doug. 293.

(f) 1 S. & S. 398.

her husband it should be sold for the benefit of the children. The daughter communicated the secret to her eldest son and destroyed the recipe. On a bill being filed against the eldest son by the younger children, Leach, V.-C., decreed an account of the profits made by the defendant since his mother's death by the sale of the ointment, a reasonable allowance being made him for his time and trouble in preparing and vending the same. And the Vice-Chancellor went on to remark that if the secret could be made a subject of sale, the plaintiffs would be next entitled to ask from the Court that a sale should be directed accordingly. But inasmuch as the Court had no possible means either to communicate the secret to a purchaser with certainty, or to protect him in the enjoyment of it, a sale was, he said, impracticable (a). But, he continued, although the Court could not direct a sale, it had the power of taking a course which, in point of advantage, would be equivalent to the plaintiffs. It could inquire what would be the value of the secret to sell, provided it could be made the subject of sale; and the annual profits which had actually been made by the sale of the ointment from the death of the mother would be a fair criterion by which that value might be estimated; and the Vice-Chancellor accordingly decreed the value to be ascertained at law, as at the date of the decree.

Fraudulent
secret.

In connection with this subject it should be mentioned that when, as is frequently the case, the article manufactured by the secret process is a quack medicine, or an article intended to deceive the public, the Court will not struggle to protect the secret or to punish those who invade it (b).

Literary
production.

The rights which are possessed by the owner of a magazine, newspaper, or other literary publication, are of a very similar character to those which a person has in the

(a) See *Newbery v. James*, 2 Mer. 157; *Estcourt v. Estcourt* Mer. 446. *Hop Essence Co., L. R.* 10 Ch.

(b) *Williams v. Williams*, 3 276.

goodwill of a business carried on by him. Just as a name affixed to a shop conveys to customers the idea of a certain degree of excellence, with which the articles sold by the person using that name are associated in their minds; so the title prefixed to a periodical, or its general appearance, conveys to those who take it up the impression that the contents of that publication will be found to be up to the standard to which former editions of the simulated publication have attained. Like goods bearing a trade mark, literary publications carry with them wherever they go the guarantee for their quality, and the representations conveyed by their titles are made to all into whose hands they may come, not merely to the original purchaser. With the doctrine of trade marks that of the titles of literary works has also progressed, so that in this also it has been said that "a publisher or author has either in the title of his work, or in the application of his name to the work, or in the particular marks which designate it, a species of property similar to that which a trader has in his trade mark, and may, like a trader, claim the protection of a Court of Equity against such a use or imitation of the name, mark, or designations as is likely, in the opinion of the Court, to be a cause of damage to him in respect of that property" (a).

The earliest of the cases with respect to the titles of *Hogg v. Kirby*. publications was *Hogg v. Kirby* (b), before Lord Eldon, C., in 1803. The plaintiff was the proprietor of a monthly magazine, called "The Wonderful Magazine," which was in fact edited by the plaintiff, though the defendant's name was used as that of the publisher. At the completion of the fifth number, the defendant refused to allow the longer use of his name, and the arrangement was

(a) Per Miller, J., in *Robertson v. Berry*, 50 Md. 591. See, however, *Walter v. Emmott*, 54 L. J. Ch. 1059.

(b) 8 Ves. 215. And see the

early Scotch cases of *In re Edinburgh Correspondent Newspaper*, Ct. Sess. Cas., 1st Ser. I. 407 n., and *Constable & Co. v. Brewster*, *ib.* III. 215.

accordingly discontinued, and the accounts between the parties finally settled. The plaintiff then put out a notice stating that he would publish the sixth number, which he did; but on the following day a new magazine was published by the defendant, under the same title as the old one, but with the addition of "New Series Improved, printed for Kirby & Scott," and it was announced that it was intended to issue this monthly. The plaintiff then instituted a suit to check the piracy, and was able to point to several circumstances, in addition to the title, which indicated an intention of inducing the belief that the work was in fact a continuation of the plaintiff's. Lord Eldon, in his judgment, after alluding to the circumstance that the plaintiff's counsel had argued the case on the several grounds of copyright, fraud, and contract, said that he should state the question to be, "not whether the defendant's work was the same as the plaintiff's, but, in a question between those parties, whether the defendant had not represented it to be the same,"—in fact, resting the case upon fraud on the part of the defendant. His Lordship held that the defendant's intention did appear to be to represent his work as a continuation of the plaintiff's, "taking the credit which had been acquired by that to his own" (a), and the injunction was accordingly granted, but in such terms as to extend only to the pretence of the defendant's work being a continuation of the plaintiff's (b).

*Spottiswoode
v. Clarke.*

In *Spottiswoode v. Clarke* (c), where the plaintiff published "The Pictorial Almanack," and the defendant "Old

(a) See *Longman v. Winchester*, 16 Ves. 269, in which Lord Eldon explained his decision in the present case.

(b) In *Strahan v. King*, Dig. 539, the proprietors of the "Contemporary Review" sought to restrain their publishers and a former assistant editor from issuing the "Nineteenth Century," alleg-

ing among other things that the defendants were representing the latter to be the plaintiffs' Review; the Vice-Chancellor, however, held that the charges failed, and refused to grant an injunction. And see *Clowes v. Hogg*, W. N. 1870, p. 268; *ib.* 1871, p. 40.

(c) 2 Ph. 154.

Moore's Pictorial Almanack," there being certain similarities between the wrappers of the two works, Lord Cottenham, denying that trade marks had anything to do with the case, said that it was difficult to believe that no fraud was intended, but that if such were the case, the attempt was very clumsy. And he felt so much doubt as to the legal right that, on the balance of convenience, he dissolved the injunction which had been granted by the Vice-Chancellor of England, giving the plaintiff leave to bring an action, and ordering the defendant to keep an account.

In both of the above cases fraud was the *ratio decidendi*, the actions of the defendants being examined with a view to the discovery of their motives and intentions. But at the present date the rule is that even though one person may have adopted in ignorance and *bonâ fide* a name coincident or nearly coincident with that employed by another person, yet he is bound to discontinue the use of that name so assumed as soon as he is made acquainted with the fact of its earlier employment, and the previous employer of the name is entitled to obtain an injunction against him, unless by his own laches or other default he has lost the rights which he otherwise would have had. The principle enunciated by Wood, V.-C., in *McAndrew v. Bassett* (a), would be equally applicable to the case of a title of a periodical: that is to say, that although A may have innocently used the title employed by B, yet if he continues to trade upon B's reputation after being made aware of his error, he does so fraudulently.

The modern doctrine was thus stated by the L.JJ. in the "Sporting Life" case (b): "It appears to us that there is nothing analogous to copyright in the name of a newspaper, but that the proprietor has a right to prevent

Fraudulent intention need not be proved.

(a) 33 L. J. Ch. 561. And see *Williams v. Osborne*, 13 L. T. N. S. 498; and *Singer Manufacturing*

Co. v. Loog (3), 8 App. Cas. 15 (per Lord Blackburn).

(b) *Kelly v. Hutton*, L. R. 3 Ch. 708.