THE

LAW OF TRADE MARKS

AND THEIR

REGISTRATION AND MATTERS CONNECTED THEREWITH,

INCLUDING PASSING OFF AND GOODWILL.

BY

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FIFTH EDITION

BY

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A DIGEST OF CASES

OF

TRADE MARKS, TRADE NAME, TRADE SECRET, GOODWILL, &c.

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TO

The Memory of

THE RIGHT HON. SIR GEORGE JESSEL,

LATE

MASTER OF THE ROLLS,

TO WHOM,

BY HIS KIND PERMISSION,

THE FIRST EDITION OF

This Work

WAS MOST RESPECTFULLY DEDICATED,

IN THE YEAR 1878.

PREFACE TO THE FIFTH EDITION.

The history of the Acts for regulating the registration of trade marks is the history of a continued struggle on the part of the mercantile community to bring about a state of the law suited to their practical requirements, of repeated attempts on the part of the Legislature to comply with those requirements, and of a succession of discoveries of the failure of the language employed, when submitted to judicial decision, to carry out the objects arrived at.

The most familiar example of this is in connection with the provisions relating to the registration of words as trade marks. When the original Act of 1875 was passed it was thought that the difficulties affecting this subject were insurmountable, and the registration of words was simply dismissed from consideration, except in cases of old user, to which a concession was made by permitting the registration of any "special and distinctive word" used as a trade mark before the passing of the Act. This did not meet the needs of commerce, so in the Act of 1883 provision was made for the registration of words as new marks; but unfortunately, instead of allowing the registration of a "special and distinctive word" as a trade mark, the phrase "fancy word not in common use," which had previously been in fairly general use with much the same meaning as that attached to the phrase "special and distinctive word," was introduced, and before long it was discovered that the true signification of the term employed was so restricted that practically every word which came into question was ruled out for one reason or another. Then

came Lord Herschell's Committee and the Act of 1888, which introduced two alternatives, the one being "an invented word" and the other "a word having no reference to the character or quality of the goods." Here, again, the Courts at first considered it necessary to examine the words submitted to them with the same rigidity as before; but the decision of the House of Lords in the "Solio" case did much to relax the tension in the case of "invented words," while remote allusions to character or quality continued to exclude large classes of words. Unfortunately, too, the decision in the "Solio" case was accompanied by *dicta* of a somewhat ambiguous kind, which gradually led to the whole weary round being begun anew.

The new Act deals with the difficulty by slightly relaxing the stringency of the definition of registrable marks, and adding to this the provision that any distinctive mark may be registered, but that a name, signature, or word or words, other than such as are expressly permitted, shall not be deemed a distinctive mark except by order of the Board of Trade or the Court, and the tribunal is authorized to take into consideration the extent to which actual user has rendered the mark in fact distinctive, so that for the first time regard may be had to facts as well as to theories. Unfortunately the framers of the Act, in their desire to meet the possible contention that a mark which had not been used could not be distinctive, defined the word "distinctive" as meaning "adapted to distinguish," and it has become evident that if the Act fails to meet the expectations of its promoters, this will most likely be the cause. In the strictest sense, no word which is not registrable under the earlier portions of the section can be "adapted to distinguish," as words which have no reference, or only an indirect reference, to the character or quality of the goods, can be registered without any special sanction, and unless the words "adapted to distinguish" are interpreted with some liberality, and in the light of the facts proved in evidence, the special form of application might as well have been omitted from the Act altogether. It would be difficult, however, to say that any word has been refused under this provision without reasonable grounds, and it is to be hoped that words which have come to identify the goods of particular traders will not be rejected for mere *à priori* reasons.

Another matter which may be mentioned has reference to the necessity felt by traders for the use and registration of a number of marks substantially identical, while differing in minor respects. Such registrations have frequently been permitted, but in other instances the Courts have objected to the registration of a mark very similar to one already standing in the same name, on the ground that the existing registration afforded sufficient protection for such variations, and that to allow what was considered to be in substance a re-registration of the same mark would be to cumber the register unnecessarily. Now that the number of marks brought under the Act exceeds three hundred thousand, this objection is hardly one of substance, and it makes no allowance for trading requirements or foreign registrations. The point is successfully dealt with by the new Act.

Since the last edition of this book was published a very large number of decisions have been given, not only in trade mark cases properly so-called, but also in cases of passing-off, and these have thrown much additional light on the operation of the law, though without affecting its fundamental principles to any material extent.

In this edition, as in former editions, a large number of American and colonial decisions are cited, both because of the sale which this book has obtained in the United States and the Colonies, and also because of the increasing extent to which such decisions are cited in this country. "Although," as Cockburn, C.J., said (*a*), "the decisions of the American Courts are, of course, not binding on us, yet the sound and enlightened views of American lawyers in the administration and development of the law—a law, except so far as altered by statutory enactment, derived from a common source with our own—entitle their decisions to the utmost respect and confidence on our part." These decisions are, it is admitted, "intrinsically entitled to the highest respect" (*b*), having been delivered by acute and practised judges,

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

(*b*) See *per* Patteson, J., in *Beverley* v. *Lincoln Gas Light and Coke Co.*, 6 Ad. & Ell. 829, 837, and Bacon, V.-C., in *Dawson* v. *Bank of Whitehaven*, 4 Ch. D. 639, 648.

after full consideration of English as well as American authorities; and it may reasonably be anticipated that English judges will in similar circumstances arrive at similar conclusions. It has been found necessary, however, to curtail to some extent the references to the American authorities, as otherwise, in view of the great growth of British and colonial case-law, room could not have been found for matter which could hardly have been omitted.

It has been thought best to retain the decisions under the Acts of 1883--1902 in the notes to those Acts in Appendix F., as to have inserted them in the notes to the Act of 1905 in Appendix A. might easily have led to mistakes, the language of the Acts being varied in very many respects. It is hoped that the copious cross-references will render them still easily available, when required, without the risk of their being supposed to be decisions under the Act now in force.

The author desires to offer his grateful thanks to his coadjutors, Mr. Hemming and Mr. S. Raymond Sebastian, who have devoted great pains and attention to the preparation of this edition; also to the officials of the Trade Marks Registry, the Board of Trade, and the Board of Customs, and others, for kind assistance.

L. B. S.

13, New Square, Lincoln's Inn,
February, 1911.

TABLE OF CONTENTS.

APPENDIX A.

APPENDIX B.

APPENDIX C.

APPENDIX D.

APPENDIX E.

APPENDIX F.

APPENDIX G.

APPENDIX H.

APPENDIX I.

APPENDIX K.

APPENDIX L.

TABLE OF CASES

A.

Alb—Apl PAGE

Bil—Bon

Cla—Col PAGE

Eas—Eme

F.

G.

Jam—Jon PAGE

K.

L.

Luc—Mac

M.

N.

Pop—Pri PAGE

Ran—R.

R—R

R—R

Rey—Rob

Rob—Ros PAGE

S.

Sax—Sha

Sin—Soc

Soc—Sta

Sta—Swi

Tho—Tud

U.

V.

W.

Wal—Wed

Wol—Wri

TABLE OF DEFENDANTS.

TABLE OF ABBREVIATIONS.

A. C. (preceded by 1891, or as the year may be).	Law Reports, Appeal Cases (current series).
A. J.	Australian Jurist.
A. L. T.	Albany (Australia) Law Times.
Abb. N. C.	Abbott's New Cases (New York).
Abb. Pr.....	Abbott's Practice Reports (New York).
Act. Comm.	Acting Commissioner.
Ad. & E.....	Adolphus and Ellis.
Alb. L. J.	Albany (New York) Law Journal.
Allen	Allen (Massachusetts).
Am. L. Reg.	American Law Register.
Am. L. Rev.	American Law Review.
Am. L. T.	American Law Times.
Am. St. Rep.	American State Reports.
Amer. Dec.	American Decisions.
Amer. Rep.	American Reports.
Ann. Pr.....	Annual Practice.
App. Cas.	Appeal Cases.
App. Div. N. Y.	Appeal Division (New York) Reports.
Asst. Comm.	Assistant Commissioner.
Atk.	Atkins.
B. & Ad.....	Barnewall and Adolphus.
B. & Cr.	Barnewall and Cresswell.
Barb. Ch.	Barbour's Chancery Reports (New York).
Barb. S. C. or Barb.....	Barbour's Supreme Court Reports (New York).
Barnard.....	Barnardiston.
Beav.	Beavan.
Bell.....	Bell's Crown Cases.
Beng. L. R. App.	Bengal Law Reports, Appendix.
Bing.	Bingham.
Biss.	Bissell (U. S. Circuit Court).
Bl. C. C.....	Blatchford (U. S. Circuit Court).
Bomb...	Bombay.
Bond	Bond (U. S. Circuit Court).
Bos.....	Bosworth (New York).
Bos. & P. N. R.	Bosanquet and Puller New Reports.
Brews.	Brewster (Pennsylvania).
Browne	Browne (Massachusetts).
Bush	Bush (Kentucky).
C. A.	Court of Appeal.
C. B.	Common Bench.
C. C. C.	Central Criminal Court.
C. C. C. Sess. Pap.	Central Criminal Court Sessions Papers.
C. C. R.	Court of Crown Cases Reserved.
C. & M.	Carrington and Marshman.

C. & P.	Carrington and Payne.
C. L. R.	Commonwealth Law Reports.
C. L. Rep.	Common Law Reports.
C. P.	Common Pleas.
C. P. Coop.	C. P. Cooper.
C. P. D.	Common Pleas Division.
Cab. & Ell.	Cababé and Ellis (Nisi Prius).
Cal.	California Reports.
Calc.	Calcutta.
Camp.	Campbell.
Can.	Canada.
Can. Leg. News	Canada Legal News.
Can. Sup. Ct.	Canada Supreme Court.
Cass. Dig.	Cassell's Canadian Digest.
Ch. (preceded by 1891, or as the year may be).	Law Reports, Chancery Division (current series).
Ch. D.	Chancery Division.
Chitty Gen. Pr.	Chitty's General Practice.
Cinc.	Cincinnati Reports.
Cinc. L. B.	Cincinnati Legal Bulletin.
Cl. & Fin.	Clark and Finnelly.
Codd. Dig.	Coddington's American Digest of Trade Mark Cases.
Col.	Colorado Reports.
Comm.	Commissioner.
Comm. of App.	Commission of Appeals (New York).
Conn.	Connecticut Reports.
Coop.	Cooper.
Cor.	Coryton (Bengal).
Cox	Cox's Criminal Cases.
R. Cox	R. Cox's American Trade Mark Cases.
Cro.	Croke.
Cro. Jac.	Croke's King's Bench Reports temp. James I.
Ct. of App.	Court of Appeal.
Ct. of Cl.	Court of Claims (U. S.).
Ct. Sess. Cas.	Court of Session Cases (Scotch).
Curtis	Curtis (U. S. Circuit Court).
Cush.	Cushing (Massachusetts).
D. & B.	Dearsley and Bell.
D. & R.	Dowling and Rylands.
Daly	Daly (New York).
Deady	Deady (U. S. Circuit Court).
De G. F. & J.	De Gex, Fisher and Jones.
De G. & J.	De Gex and Jones.
De G. J. & S.	De Gex, Jones and Smith.
De G. M. & G.	De Gex, Macnaghten and Gordon.
De G. & Sm.	De Gex and Smale.
Den.	Denison, Crown Cases.
Dig.	Sebastian's Digest of Cases of Trade Mark, &c.
Dill.	Dillon (U. S. Circuit Court).
Dorion	Quebec Q. B. Reports.
Doug.	Douglas.
Dr.	Drewry.
Dr. & Sm.	Drewry and Smale.
Duer	Duer (New York).
E. & B.	Ellis and Blackburn.
East P. C.	East's Pleas of the Crown.
Ell. & Ell.	Ellis and Ellis.

Eq. Rep.	Equity Reports.
Esp. N. P. C.	Espinasse, Nisi Prius Cases.
Ex.	Exchequer.
F. & F.	Foster and Finlason.
Fed. Rep.	Federal Reporter (U. S.).
Fla.	Florida Reports.
Foster Cr. Cas.	Foster, Crown Cases.
Ga.	Georgia Reports.
Giff.	Giffard.
Grant, Up. Can. Ch.	Grant, Upper Canada, Chancery.
Green	Green, New Jersey.
H. & M.	Hemming and Miller.
H. & N.	Hurlstone and Norman.
H. & Tw.	Hall and Twells.
H. & W.	Harrison and Wollaston.
H. L.	House of Lords.
H. L. C.	House of Lords Cases.
Hand	Hand (New York).
Hilt.	Hilton (New York).
Hoff.	Hoffman (New York).
Holmes	Holmes (U. S. Circuit Court).
Hopk.	Hopkins (New York).
How. App. Cas.	Howard's Appeal Cases (New York).
How. Pr.	Howard's Practice Cases (New York).
Hughes	Hughes (U. S. Circuit Court).
Hun	Hun (New York).
Hyde	Hyde (Bengal).
Ill.	Illinois.
Ind.	Indiana Reports.
Ind. L. R.	Indian Law Reports.
Iowa	Iowa State Reports.
I. R. (preceded by 1894, or as the year may be).	Irish Reports (current series).
Ir. Ch.	Irish Chancery.
Ir. Eq.	Irish Equity.
Ir. Jur.	Irish Jurist.
J. & H.	Johnson and Hemming.
J. & S.	Jones and Spencer (New York).
J. P.	Justice of the Peace.
Jac.	Jacob.
Jac. & W.	Jacob and Walker.
Johns.	Johnson.
Journ. of Jurisp.	Journal of Jurisprudence (Scotch).
Jur.	Jurist.
K. & J.	Kay and Johnson.
Keyes	Keyes (New York).
Ky.	Kentucky Reports.
Kyshe	Straits Settlements Reports.
L. C.	Lord Chancellor.
L. G. R.	Local Government Reports.
L. JJ.	Lords Justices.
L. J. Bkptcy.	Law Journal, Bankruptcy.
L. J. Ch.	Law Journal, Chancery.
L. J. C. P.	Law Journal, Common Pleas.
L. J. Ex.	Law Journal, Exchequer.
L. J. K. B.	Law Journal, King's Bench.
L. J. M. C.	Law Journal, Magistrate's Cases.
L. J. N. of C.	Law Journal, Notes of Cases.

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

N. & P.	Neville and Perry.
Neb.	Nebraska Reports.
O. S.	Old Series.
Ohio St.	Ohio State Reports.
Ont.	Ontario Reports.
Oreg.	Oregon Reports.
P. R.	Patent Office Reports.
Pa. *or* Penn. St.	Pennsylvania State Reports.
Pac. C. L. J.	Pacific Coast Law Journal.
Paige	Paige (New York).
Peake	Peake, Nisi Prius Cases.
Pemb.	Pemberton on Judgments.
Penn. L. J.	Pennsylvania Law Journal.
Ph.	Phillips.
Phila.	Philadelphia Reports
Pick.	Pickering (Massachusetts).
Post.	Post (Missouri).
Q. B.	Queen's Bench.
Q. B. (preceded by 1891, or as the year may be).	Law Reports, Queen's Bench Division (current series).
Q. B. D.	Queen's Bench Division.
Queens. L. J. Rep.	Queensland Law Journal Reports.
Q. O. R. K. B.	Quebec Official Reports, King's Bench.
R. I.	Rhode Island Reports.
R. & M.	Russell and Mylne.
Robertson	Robertson (New York).
Russ.	Russell.
Ry. Cas.	Railway Cases.
S. & S.	Simons and Stuart.
Sandf. Ch.	Sandford's Chancery Reports (New York).
Sandf. S. C.	Sandford's Supreme Court Reports (New York).
Sawy.	Sawyer (U. S. Circuit Court).
S. C. (preceded by 1908, or as the year may be).	Scottish Cases.
S. C. R.	Supreme Court Reports.
Scot. L. T.	Scottish Law Times.
Scot. L. Rep.	Scottish Law Reporter.
Scott, N. R.	Scott's New Reports.
Seton	Seton on Decrees.
Sickels	Sickels (New York).
Sim.	Simons.
E. D. Smith	E. D. Smith (New York).
Sol. J.	Solicitors' Journal.
St. Dig.	Stephen's Digest of Canadian Cases.
Story	Story (U. S. Circuit Court).
Sup. Ct.	Supreme Court.
Super. Ct.	Superior Court.
Swanst.	Swanston.
T. M. A.	Trade Marks Registration Act.
T. R.	Term Reports.
Tex.	Texas Reports.
Thomp. & C.	Thompson and Cook (New York).
Trade Marks	British and Foreign Journal of Commerce, Trade Marks, and International Exhibitions.
Trans. App.	Transcript Appeals (New York).
U. S.	United States Supreme Court Reports.
U. S. C. C., Dt. of —	United States Circuit Court, District of —.
U. S. Pat. Comm. Decis.	Decisions of the U. S. Commissioner of Patents.

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

THE

LAW OF TRADE MARKS.

CHAPTER I.

GENERAL INTRODUCTION.

General principle of trade mark law.

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

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

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

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

Function of trade mark.

The function of the trade mark is to give the purchaser a satisfactory assurance of the make and quality of the article he is buying. Thus, it was said by Lord Cottenham, C. (*b*), "take a piece of steel: the mark of the manufacturer from whom it comes is the only indication to the eye of the customer of the quality of the article; so it is of blacking, or any other article of manufacture the particular quality of which is not discernible by the eye." It is on the faith of the mark being genuine, and representing a quality equal to that which he has previously found a similar mark to indicate, that the purchaser makes his purchase. "That, in truth," said James, L. J. (*c*), "is the meaning and object of a trade mark. It indicates this—that you may take this as a warranty that it has come from the particular manufacturer of the goods with which you have been hitherto pleased." So, again, it was said by Kay, J. (*d*)—"What does a trade mark mean? It

(*a*) *Per* Lord Cranworth, C., in *Seixo* v. *Provezende*, L. R. 1 Ch. 192. And see *per* the United States Supreme Court in *Canal Co.* v. *Clark*, 80 U. S. 311; *McLean* v. *Fleming*, 96 U. S. 245; and *Amoskeag Manufacturing Co.* v. *Trainer*, 101 U. S. 51; and *per* Molesworth, J., in the Supreme Court of Victoria, in *In re Brebner*, 2 W. & W. 12; and *per* Levinge, J., in the High Court of Bengal, in *Orr-Ewing & Co.* v. *Grant, Smith & Co.*, 2 Hyde, 185.

(*b*) In *Spottiswoode* v. *Clarke*, 2 Ph. 154. And see *Kidd* v. *Johnson*, 100 U. S. 617.

(*c*) *Massam* v. *J. W. Thorley's Cattle Food Co.* (2), 14 Ch. D. 748. And see *Amoskeag Manufacturing Co.* v. *Trainer*, 101 U. S. 51; *Holt* v. *Menendez*, 128 U. S. 182.

(*d*) *In re Australian Wine Importers, Ld.*, 41 Ch. D. 278. And see *In re Kinahan*, 10 P. R. 393.

means the mark under which a particular individual trades, and which indicates the goods to be his goods—either goods manufactured by him, or goods selected by him, or goods which in some way or other pass through his hands in the course of trade. That is the meaning of a trade mark. It is a mode of designating goods as being the goods which have been, in some way or other, dealt with by the person who owns the trade mark." Similarly, Bowen, L. J. (*a*), has described the function of a trade mark as being "to give an indication to the purchaser or possible purchaser as to the manufacture or quality of the goods—to give an indication to his eye of the trade source from which the goods come, or the trade hands through which they pass on their way to the market."

Mere statement of quality, no trade mark.

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

Exception.

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

(*a*) *In re Powell* (2), (1893) 2 Ch. 388.

(*b*) *Braham* v. *Bustard*, 1 H. & M. 447; *Raggett* v. *Findlater*, L. R. 17 Eq. 29; *In re Barrows*, 5 Ch. D. 353; *Spottiswoode* v. *Clarke*, 1 Coop. 264; *Lawrence Mfg. Co.* v. *Tennessee Mfg. Co.*, 138 U. S. 537; *Columbia Mill Co.* v. *Alcorn*, 150 U. S. 460.

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

(*d*) *Hirst* v. *Denham*, L. R. 14 Eq. 542; *Ransome* v. *Graham*, 51 L. J. Ch. 897; *Moses* v. *Sargood*, Dig. 636; *Amoskeag Manufacturing Co.* v. *Trainer*, 101 U. S. 51; *Ralli* v. *Fleming*, Ind. L. R. 3 Calc. 417. And see *Wood* v. *Lambert*, 32 Ch. D. 247.

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

Trade mark not always indicative of actual manufacturer.

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

May be indicative of selector.

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

May indicate natural products.

To go farther, it is not necessary that the goods to which the mark is affixed should be manufactured goods at all; it is sufficient if the vendors, whose property the trade mark is, have alone the opportunity of procuring the article in question, so that the trade mark indicates accurately the source from which the article is derived. This is particularly the case with mineral waters and similar productions (*g*). A mere name, however, for a natural

(*a*) See *per* Bacon, V.-C., in *Ford* v. *Foster*, L. R. 7 Ch. 611. See also *Knott* v. *Marshall*, W. N. 1894, 214.

(*b*) *Amoskeag Manufacturing Co.* v. *Garner* (1), 55 Barb. 151; R. Cox, 541. See *Amoskeag Manufacturing Co.* v. *Garner* (2), 54 How. Pr. 298.

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

(*d*) *Godillot* v. *Hazard*, 44 N. Y. Super. Ct. 427; *Ralli* v. *Fleming*, Ind. L. R. 3 Calc. 417; *Taylor* v. *Virasami*, Ind. L. R. 6 Mad. 108; *In re Apollinaris Co.*, (1891) 2 Ch. 186, 226, 230.

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

(*f*) *Hirsch* v. *Jonas*, 3 Ch. D. 584; *In re Australian Wine Importers, Ld.*, 41 Ch. D. 278; *In re Apollinaris Co.*, (1891) 2 Ch. 186, 226, 230; *Leahy* v. *Glover*, 10 P. R. 141; *Benedictus* v. *Sullivan, Powell & Co.*, 12 P. R. 25; *Major Brothers* v. *Franklin & Son*, 25 P. R. 406; *Thomson & Co.* v. *Robertson*, Ct. Sess. Cas. 4th Ser. XV. 880; *Holt* v. *Menendez*, 128 U. S. 182. And see *Wood* v. *Lambert*, 32 Ch. D. 247; and *In re Wills* (2), (1893) 2 Ch. 262.

(*g*) *Apollinaris Co.* v. *Norrish*, 33 L. T. N. S. 242; *Apollinaris Co.* v. *Edwards*, Seton, 5th ed. 537 (Apollinaris Water); *Radde* v. *Norman*, L. R. 14 Eq. 348 (Leopoldshall Kainit); *Wheeler* v. *Johnston*, 3 L. R. Ir. 284 (Cromac Springs Water). And see the coal cases—*Braham* v. *Beachim*, 7 Ch. D. 848; *Davis* v. *Tylor*, Jessel, M. R., April 24th, 1879; *Lochgelly Co., Ld.* v. *Lumphinnans Iron Co.*, Ct. Sess. Cas. 4th Ser. VI. 482. See also *Major Brothers* v. *Franklin & Son*, 25 P. R. 406 (fruit and vegetables).

product which is available by all the world, cannot be exclusively appropriated by an individual, who possesses no exclusive access to its source (*a*).

Present definition.

For the purposes of trade mark registration, the previous law on this point is now summed up in express statutory form in sect. 3 of the Trade Marks Act, 1905—"A trade mark shall mean a mark used or proposed to be used upon or in connection with goods for the purpose of indicating that they are the goods of the proprietor of such trade mark by virtue of manufacture, selection, certification, dealing with, or offering for sale."

Advantages of use of trade marks.

The benefits derivable from the recognition of the exclusive right of a trader to his trade mark are apparent from the consideration that the "trade mark is both a sign of the quality of the article and an assurance to the public that it is the genuine product of his manufacture. It thus often becomes of great value to him, and in its exclusive use the Court will protect him against attempts of others to pass off their products upon the public as his. This protection is afforded, not only as a matter of justice to him, but to prevent imposition upon the public" (*b*).

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

(*a*) *Young* v. *Macrae*, 9 Jur. N. S. 322 (Paraffin Oil); *Canal Co.* v. *Clark*, 80 U. S. 311 (Lackawanna Coal); *Montgomerie* v. *Donald & Co.*, Ct. Sess. Cas. 4th Ser. XI. 506 (Water of Ayr Stone). And see *Grand Hotel Co. of Caledonia Springs, Ld.* v. *Wilson*, (1904) A. C. 103.

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

(*c*) *Per* Lord Craighill in *Dunnachie* v. *Young & Sons*, Ct. Sess. Cas. 4th Ser. X. 874.

adoption of a trade mark speedily prove to be that, in 1742, Lord Hardwicke, C., said that "every particular trader had some particular mark or stamp" (*a*).

Southern v. *How.*

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

Blanchard v. *Hill.*

In *Blanchard* v. *Hill* (*c*), however, in 1742, Lord Hardwicke refused to protect the "Great Mogul" stamp on cards, deciding, in effect, that there was no right of property in a trade mark, though actual fraud might be restrained or punished, as in *Southern* v. *How* (*d*). The decision seems in great measure to have been founded upon a dread of setting up a monopoly, the distinction between a trade mark and a patent not being clearly present to his lordship's mind.

Singleton v. *Bolton.*

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

Sykes v. *Sykes.*

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

Requisites to entitle to damages at Common Law.

This case marks the last stage of development in the law of trade marks as recognised at Common Law (*i*); and the requisites

(*a*) *Blanchard* v. *Hill*, 2 Atk. 484, 485.
(*b*) *Southern* v. *How*, Poph. 144; 3 Cro. 471; 2 Rolle, 28.
(*c*) 2 Atk. 484.
(*d*) Poph. 144.
(*e*) 3 Doug. 293.
(*f*) See *Leather Cloth Co.* v. *American Leather Cloth Co.*, 1 H. & M. 271; 4 De G. J. & S. 137; 11 H. L. C. 523, and cases collected at p. 118, note (*d*).
(*g*) *Wilkie* v. *McCulloch*, Ct. Sess. Cas. 1st Ser. II. 413.
(*h*) *Sykes* v. *Sykes*, 3 B. & Cr. 541.
(*i*) See *per* Sir G. Mellish, L. J., in *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434, 454.

necessary to entitle a plaintiff to recover damages were, in accordance with the judgment of Sir T. Wilde, C. J., in *Rodgers* v. *Nowill* (*a*), that he should have been accustomed to use a certain mark upon goods of his manufacture to denote that that was so, that that mark was known in the trade, and that the defendant had imitated the mark and sold goods bearing it, as and for the plaintiff's goods, with intent to defraud (*b*).

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

Lord Blackburn, discussing the history of trade mark law in *Singer Manufacturing Co.* v. *Loog* (*c*), said: "The original foundation of the whole law is this—that when one, knowing that goods are not made by a particular trader, sells them as and for the goods of that trader, he does that which injures that trader. At first it was put upon the ground that he did so when he sold inferior goods as and for the trader's; but it is established, alike at law and in equity, that it is an actionable injury to pass off goods known not to be the plaintiff's as and for the plaintiff's, even though not inferior. The modes in which goods may be passed off as and for the plaintiff's vary. The most usual is where a particular mark on the goods, or on the packages in which they are sold, has been used to denote that they are made by a particular firm to such an extent that it is understood in the market to bear that meaning. The law as to those trade marks is now regulated by statutes, but before there was any legislation on the subject it was well settled that when any one adopted a mark so closely resembling the trade mark of the plaintiff that it would be likely to be mistaken for it, and put it on his goods and sold them, knowing that, though the persons to whom he sold them were well aware that they were not the plaintiff's make, yet that they were meant to be sold to others who would see only the trade mark, and were likely to be deceived by its resemblance to that of the plaintiff, he might be properly found to have knowingly and fraudulently sold the goods as and for the plaintiff's goods. And, so far, there was no difference between law and equity.

"But at law it was necessary to prove that an injury had been actually done; in equity it was enough to show that the defendant threatened to do, and would, if not prevented, do that injury.

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

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

(*c*) 8 App. Cas. 29.

Equity—*Millington* v. *Fox*.

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

Limits to Court's interposition.

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

Acquisition of trade marks.

The mode of acquiring a right to a trade mark by registration was, from 1875 to 1883, regulated by the Trade Marks Registration Acts, 1875—1877 (*e*). The trade mark was required to accord with the definition contained in section 10 of the Act of 1875 (*f*), and not to be obnoxious to the restrictions of section 6; and it had to be registered, or, if it had been used before the passing of the Act, application must have been made for registration, and have been refused, in which case a certificate of refusal could be obtained from the registrar (*g*), unsuccessful applicants thus retaining whatever rights might have been theirs before the Act. For a mark to have been used before the Act, it was sufficient for a vendible article to have been actually in

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

(*b*) *Per* Wood, V.-C., in *Batty* v. *Hill*, 1 H. & M. 264. And see *Roper's, &c. Co.* v. *Copeman's, &c. Association, Limited*, 28 Sol. J. 218; *Native Guano Co.* v. *Sewage Manure Co.*, 8 P. R. 125; *Tallerman* v. *Dowsing Radiant Heat Co.*, (1900) 1 Ch. 1.

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

(*d*) See *Batty* v. *Hill*, 1 H. & M. 264.

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

(*f*) Which was so restricted as to exclude from registration some marks previously recognized: *Ex parte Stephens* (2), 3 Ch. D. 659; *In re Mitchell* (1), 7 Ch. D. 36. See *Rose* v. *Evans*, 48 L. J. Ch. 618.

(*g*) § 2 of Amendment Act, 1876.

the market, bearing the mark in question; it was not necessary for this to have been the case for any length of time, so long as there was some user (*a*).

The Trade Marks Acts, 1875-7, were repealed, and replaced by the Patents Acts, 1883-1902 (*b*), which contained a wider and more comprehensive definition of a trade mark (*c*), but were in other respects substantially identical, so far as concerned the acquisition of trade marks, with the previous Acts (*d*). Since April 1st, 1906, the Act regulating the registration of trade marks has been the Trade Marks Act, 1905 (*e*).

Appropriation to special classes of goods.

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

Assignment and transmission.

A trade mark is assignable and transmissible, but only in connection with the goodwill of the business concerned with the goods or classes of goods to which it relates (*h*). A trade mark cannot exist in gross and unattached to specific articles (*i*), for, if that could be so, the mark might come to be an instrument of decep-

(*a*) *Per* Lord Westbury, C., in *McAndrew* v. *Bassett*, 4 De G. J. & S. 380; *In re Simpson, Davies & Sons* (2), Jessel, M. R., Jan. 12, 1881; *Somerville* v. *Schembri*, 12 App. Cas. 453; *Wheeler* v. *Johnston*, 3 L. R. Ir. 284; and other cases.

(*b*) 46 & 47 Vict. c. 57; 48 & 49 Vict. c. 63; 51 & 52 Vict. c. 50; 2 Edw. 7, c. 34.

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

(*d*) See §§ 62–74.

(*e*) 5 Edw. 7, c. 15. See the summary of this Act beginning at p. 17.

(*f*) Trade Marks Act, 1875, § 2: Patents Act, 1883, § 65; Trade Marks Act, 1905, § 8.

(*g*) *Hall* v. *Barrows*, 4 De G. J. & S. 150; *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518; *Merchant Banking Co.* v. *Merchants' Bank*, 9 Ch. D. 560; *Hart* v. *Colley*, 44 Ch. D. 193.

(*h*) Trade Marks Act, 1905, § 22. And see Patents Act, 1883, § 70; Trade Marks Act, 1875, § 2; *Rey* v. *Lecouturier*, 25 P. R. 265; 27 *ib.* 268; *Hall* v. *Barrows*, 4 De G. J. & S. 150; *Edwards* v. *Dennis*, 30 Ch. D. 454; *In re Wellcome*, 32 Ch. D. 213; *In re Bolanachi's Empire Chocolate Co.*, 89 L. T. Jo. 273; *Thorneloe* v. *Hill*, (1894) 1 Ch. 569; *In re Harness*, 17 P. R. 40; *In re Johnson*, 26 P. R. 195; *Smith* v. *Fair*, 14 Ont. Rep. 729. And see *Hammond* v. *Malcolm, Brunker & Co.*, 9 P. R. 301, where an assignment of a trade mark with such portion of the goodwill as related to the goods to which the trade mark applied was held valid; and *In re Magnolia Metal Co.*, (1897) 2 Ch. 371, where the goodwill was only indirectly connected with the goods for which the trade mark was registered.

(*i*) *McAndrew* v. *Bassett*, 4 De G. J. & S. 380; *Leather Cloth Co.* v. *American Leather Cloth Co.*, *ib.* 137; 11 H. L. C. 523; *Dixon* v. *Guggenheim*, 7 Phila. 408; R. Cox, 559; *Wheeler* v. *Johnston*, 3 L. R. Ir. 284; *Kidd* v. *Johnson*, 100 U. S. 617.

tion, instead of a guarantee of genuineness (*a*). In an assignment of the business and goodwill, the trade mark, in the absence of any indication to the contrary (*b*), passes as a matter of course (*c*), or, if specially excepted, must cease to be available by the vendor. On the death of a registered proprietor, his legal personal representative acquires the title to the mark. Subsequent registered proprietors stood in the same position, under § 4 of the Trade Marks Act of 1875, as if their title were a continuation of the title of the first registered proprietor (*d*). And this will still be so, though the section has not been re-enacted in the later Acts.

Bankruptcy.

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

Trade mark lost.

Apart from the special provisions of the Trade Marks Act, 1905, a trade mark may be lost, as by its coming to be commonly applied to a special article, in which case it becomes *publici juris*; thus "Worcestershire sauce," which might at one time have been protected, could no longer be so when it had come into common use (*f*). But for general user to render a mark of common right, it must be used on the same goods as those for which an exclusive right to it is claimed (*g*). It was also held, before the passing of the Registration Acts, that if a person abandons a suit which he has undertaken to restrain infringement, he abandons his exclusive right (*h*).

Infringement.

When once a person has acquired a right in the trade mark, any

(*a*) *Cotton* v. *Gillard*, 44 L. J. Ch. 90: *Pinto* v. *Badman*, 8 P. R. 181; *Hammond* v. *Malcolm, Brunker & Co.*, 9 P. R. 301.

(*b*) *In re Roger* (2), 12 P. R. 149; *Currie* v. *Currie*, 15 P. R. 339.

(*c*) *Shipwright* v. *Clements*, 19 W. R. 599. And see cases collected at p. 117, note (*b*).

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

(*e*) *Ex parte Young; Re Lemon, Hart & Son*, Dig. 537. And see *Kelly* v. *Hutton*, L. R. 3 Ch. 703; *Hudson* v. *Osborne*, 39 L. J. Ch. 79; and cases at p. 121, note (*f*); also the Bankruptcy Act, 1883, § 44 (iii). In America it has been considered a disputable question whether property in a trade mark is the subject of attachment or levy under execution (*Hegeman & Co.* v. *Hegeman*, 8 Daly, 6), or whether it will pass under a general assignment (*Milliken* v. *Dart*, 33 N. Y. Sup. Ct. 24).

(*f*) *Lea* v. *Millar*, Dig. 513. And so "Maizena"—*National Starch Manufacturing Co.* v. *Munn's Patent Maizena and Starch Co.*, (1894) A. C. 275; "Kaiser" spring water—*Luylies* v. *Hollender* (2), 24 Bl. C. C. 353; "Gold Leaf" Flour—*Partlo* v. *Todd*, 17 Can. Sup. Ct. 196; "Imperial Cough Drops"—*Watson* v. *Westlake*, 12 Ont. Rep. 449. And see *per* Sir G. Mellish, L. J., in *Ford* v. *Foster*, L. R. 7 Ch. 611; adopted by Lord Macnaghten in *Leahy* v. *Glover*, 10 P. R. 141. Also *Neva Stearine Co.* v. *Moulding*, 9 V. L. R. Eq. 98; *Laurence Manufacturing Co.* v. *Tennessee Manufacturing Co.*, 138 U. S. 537.

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

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

infringement of that right will form a ground for the interference of the Court. For the Court to interfere there must be fraud, for where there is no fraud there is no wrong to be redressed and no remedy applicable. But it is not necessary that there should be fraud in the sense that the infringer knowingly and wilfully makes a fraudulent attempt to appropriate to himself the fruits of another's reputation; if he acts so that custom intended for another is diverted to himself, and that the public buy and pay for one thing while intending to buy and pay for another, so that both vendor and purchaser are injured, there is fraud, and the animus of the infringer is unimportant (*a*). Even if the purchaser is told that the goods are the goods of the actual seller, but the imitated mark is upon them, there is ground for interference, since the goods may be resold bearing the mark, but without the information necessary to correct the statement thereby made (*b*). There is infringement if ordinary purchasers purchasing with ordinary caution are likely to be misled (*c*): on the one hand, the Court will not strain its jurisdiction to protect fools and idiots (*d*); on the other hand, it will not require such minuteness of imitation as to deceive persons of unusual sagacity and information.

Remedies for infringement.

Infringement is criminally punishable under an indictment for obtaining money by false pretences (*e*), or in accordance with the special provisions of the Merchandise Marks Act, 1887 (*f*), expressly enacted to prevent such practices. The Common Law remedy is by an action on the case for damages caused by the offender's fraud (*g*). The equitable remedy is by injunction, together with an account, or damages, if preferred. The greater suitability of this form of remedy has occasioned the adjudication in Chancery of the great majority of trade mark cases, and the carrying into operation of the Trade Marks Registration Acts, 1875-7, was specially entrusted to the Chancery Division (*h*). This provision is not now repeated, but the great majority of such cases are still dealt with by the Chancery judges.

(*a*) See cases collected at p. 183, note (*b*).

(*b*) *Sykes* v. *Sykes*, 3 B. & Cr. 541; and cases at p. 175.

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

(*d*) *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434, 447; *Payton* v. *Snelling*, 17 P. R. 48, 57 (*per* Romer, L. J.).

(*e*) See Ch. 5.

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

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

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

Fraudulent intention.

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

Plaintiff disentitled to relief.

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

When not disentitled.

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

Unauthorised use of word "patent," &c.

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

Distinction between trade mark and patent.

"Trade marks have sometimes been likened to letters patent and sometimes to copyrights, from both of which they differ in many respects" (*h*). "There is this difference between the case of a trade mark and that of a patent: in the former case the article sold is open to the whole world to manufacture, and the only right the plaintiff seeks is that of being able to say—'Don't sell any goods under my mark.' He may find his customers fall off in consequence of the defendant's manufacture; but it does

(*a*) *Rodgers* v. *Nowill*, 5 C. B. 109.
(*b*) 3 My. & Cr. 338.
(*c*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185; *Cartier* v. *Carlile*, 31 Beav. 292; *Moet* v. *Couston*, 33 Beav. 578.
(*d*) See *Pidding* v. *How*, 8 Sim. 477; *Perry* v. *Truefitt*, 6 Beav. 66; and other cases in Ch. 7.
(*e*) *Per* Sir G. Mellish, L. J., in *Ford* v. *Foster*, L. R. 7 Ch. 611.
(*f*) *Ford* v. *Foster*, *ubi supra*.
(*g*) See the cases in Ch. 7.
(*h*) *Per* Lord Blackburn, in *Johnston* v. *Orr-Ewing*, 7 App. Cas. 219, 228.

not necessarily follow that the plaintiff can claim damages for every article manufactured by the defendant, even though it be under that mark. On the other hand, every sale without licence of a patented article must be a damage to the patentee" (*a*). In the case of a trade mark, "the property and right to protection is in the device or symbol which is invented and adopted to designate the goods to be sold, and not in the article which is manufactured and sold" (*b*). The broad difference between a patent and a trade mark is, therefore, that the public are prohibited and restrained from manufacturing any article protected by the former, so long as the protection exists, whereas the public are at full liberty to manufacture an unpatented article (*c*), and that according to the identical original process, and to say that they are so doing, and this is so whether the original makers use, or do not use, a trade mark upon their goods. What the subsequent manufacturers may not do is to put upon their goods the mark used by the original makers, so as to represent that such goods are the actual goods of the original makers, and not merely equivalent goods made by others. The benefit conferred upon the public by the communication of a new invention, which after a limited period all can use, is the consideration in respect of which a monopoly of the invention is granted to the inventor for that limited period (*d*). Any attempt, therefore, to prolong the term of the patent by means of a trade mark will be discouraged (*e*).

Trade mark distinguished from copyright.

As a trade mark is not the same thing as a patent, so it is not the same as a copyright (*f*). The difference between them is in fact so wide that the United States statute of 1870, by which the registration of trade marks was authorised and regulated, was held to be unconstitutional and invalid on the express ground that the clause in the Constitution empowering the Legislature to regulate

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

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

(*c*) This is quite clear in America as well as in this country. See *Thomson* v. *Winchester*; 36 Mass. 214; R. Cox, 7; *Coffeen* v. *Brunton* (1), 4 McLean, 516; R. Cox, 82; *Manhattan Medicine Co.* v. *Wood*, 4 Cliff. 461, and many other cases. So also in Scotland, *Singer Manufacturing Co.* v. *Kimball and Morton*, Ct. Sess. Cas. 3rd Ser. XI. 267.

(*d*) *Cheavin* v. *Walker*, 5 Ch. D. 850, 863.

(*e*) See *per* Sir G. Mellish, L. J., in *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434, 456.

(*f*) *Farina* v. *Silverlock*, 6 De G. M. & G. 214; *Collins Co.* v. *Cowen*, 3 K. & J. 428: *Correspondent Newspaper Co.* v. *Saunders*, 11 Jur. N. S. 540; *Kelly* v. *Hutton*, L. R. 3 Ch. 703; *Dicks* v. *Yates*, 18 Ch. D. 76.

patents and copyrights conferred upon it no authority to make a statute for the regulation of trade marks. A copyright, like a patent, relates to the substance of an article, but differs in that it has reference to a literary instead of a material production. A trade mark does not protect the substance of the article to which it is attached from being imitated, but it identifies an article and indicates the source to which that article is to be attributed. Trade mark not being copyright, registration of a trade mark, or, what comes to be much the same thing, a title of a book or paper, under the Copyright Acts, is unnecessary and useless (*a*).

The difference between trade mark and copyright is well illustrated by *Schauer* v. *Field* (*b*), where the defendants registered as a trade mark a photograph of a German picture in which there was copyright in Germany but not in England. After the English copyright had been acquired by the plaintiff under the International Copyright Act, 1886, the defendants reproduced their trade mark in various sizes and colours on show cards and price lists for purposes of advertisement. Chitty, J., refused to grant an injunction on the ground that the interest which, by the saving clause of the International Copyright Act, 1886 (*c*), was reserved to the defendants as proprietors of the trade mark extended to advertising their trade mark as well as to using it. "This interest in the defendants," said the learned judge, "is wholly unconnected with any copyright in the defendants; they have none and claim none; it arises from or in connection with their trade mark alone"; he therefore thought it immaterial to consider when any particular show card or advertisement of the trade mark was first produced. But, of course, the fact that a picture is used by a trader to advertise his goods does not of itself prevent such use from being an infringement of copyright (*d*).

Trade marks of aliens protected.

Since trade marks are recognised throughout the world, and not merely in the manufacturer's own country, as indicative of his goods, so that the subjects of any country are liable to be defrauded by goods bearing an imitation of a foreign trade mark, and any manufacturer is liable to suffer by the forgery of his

(*a*) *Maxwell* v. *Hogg*, L. R. 2 Ch. 307; *Kelly* v. *Hutton*, L. R. 3 Ch. 703; *Hirsch* v. *Jonas*, 3 Ch. D. 584; *Barlow & Jones, Ld.* v. *Johnson & Co.*, 7 P. R. 395, 399.

(*b*) (1893) 1 Ch. 35.

(*c*) § 6.

(*d*) See *Hanfstaengl* v. *American Tobacco Co.*, (1895) 1 Q. B. 347.

marks abroad, the right of property in a trade mark is not limited by territorial bounds (*a*), though a limitation may be imposed by means of an exception of specified places by the assignor of a trade mark on assignment (*b*), and aliens' marks are protected in the English Courts in precisely the same manner as if they belonged to British subjects (*c*). The same is the case in the United States (*d*), in India (*e*), Canada (*f*), and elsewhere.

Conflict of laws.

No direct conflict of laws has as yet arisen in the English Courts with respect to trade marks (*g*), though on some occasions such has appeared likely to be the case. In *Farina* v. *Cathery* (*h*) the question was raised whether a Prussian manufacturer could be restrained in this country from using a trade mark which he was entitled to use under Prussian law. It was held, however, that the mark was not identical with that to which a right had been acquired in Prussia. In *Compagnie Laferme* v. *Hendrickx* (*i*) there was a question whether a German manufacturer could acquire a right in England to the exclusive use of a trade mark consisting of the word "Laferme," a mere word not being allowed in Germany to constitute a trade mark; but as the plaintiff failed to satisfy the Court that he had been the first to use the word in Germany, no decision was given on the point. In *In re Farina* (2) (*k*), registration was refused to a German mark on the ground of too great a similarity existing between it and a previously registered German mark, notwithstanding that the German Court of Appeal, reversing the decision of the Court of First Instance, had held that there was no such similarity as to prevent the registration in that country of the second mark (*l*).

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

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

(*c*) *Collins Co.* v. *Coven*, 3 K. & J. 428; *Rey* v. *Lecouturier*, 25 P. R. 265; 27 *ib.* 268; and cases at p. 99, note (*a*).

(*d*) *Taylor* v. *Carpenter* (1), 3 Story, 458; R. Cox, 14: and cases at p. 99, note (*a*).

(*e*) *Orr-Ewing* v. *Chomeeloll Mullick*, Cor. 150.

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

(*g*) Unless the refusal to register in England trade marks already registered in the United States is to be considered as such. See *In re Californian Fig Syrup Co.*, 40 Ch. D. 620; *In re Carter Medicine Co.*, (1892) 3 Ch. 472.

(*h*) L. J. N. of C. 1857, p. 134.

(*i*) Dig. 512. In the United States registration of a single word has been granted to a German, though he could not obtain registration in his own country, it being shown that registration of a single word had been granted in Germany to citizens of the United States. *Ex pte. Portland Cement Fabrik, &c.*, 64 U. S. Pat. Gaz. 858.

(*k*) 27 W. R. 456.

(*l*) With regard to the effect of a decision in a trade mark case in one country upon the jurisdiction of another country to entertain a similar action, it has been held in America that it is not an answer to an action in that country to restrain an infringement of a trade

In *Rodgers & Sons, Ld.* v. *Rottgen* (*a*), a German defendant was restrained from using a trade mark which he had registered in Germany, but which resembled the plaintiff's mark. In *Rey* v. *Lecouturier* (*b*), the Court of Appeal and House of Lords, while protecting in this country the rights of the original proprietors of a goodwill and trade marks which in France, the country of origin, had been held to have passed to other owners, were careful to point out that the French decisions did not affect, or purport to affect, the rights in this country. For registration in this country a title good in English law must be shown (*c*). It has also been held that user abroad is not such user as will bring the person using within the three-mark rule (*d*), and that a person who has not even an intention of using a trade mark in England cannot be a person aggrieved by a wrongful entry on the register (*e*); but the latter decision was reversed (*f*). Section 91 of the Patents and Designs Act, 1907, replacing sections 103 and 104 of the Patents Act, provides for the grant of privileges to foreigners and colonists in cases in which their governments give protection to British subjects.

Passing off.

Besides cases of infringement of trade marks proper, there are some other classes of cases nearly akin to the former, but differing from them in some important particulars, which yet require notice in connection with the subject of trade marks, as where there is an unfair competition in trade contrived, not by imitation of trade marks, but by other forms of representation that one man's goods are another's. This is what is known as "passing off." The term "substitution" is also sometimes employed where an order has been given for one article and another has been supplied. Such cases are governed by substantially identical principles with

mark by the sale in America of the article alleged to be an infringement that an injunction had been refused against the defendant's principal in Germany, first, because the question whether the alleged infringement was likely to impose upon the public depended upon the circumstances of the place, and, secondly, because the particular subject-matter of the two actions was not identically the same: *Hohner* v. *Gratz*, 50 Fed. Rep. 3.

(*a*) 5 Times L. R. 678.

(*b*) 25 P. R. 265; 27 *ib.* 268.

(*c*) *Pinto* v. *Badman*, 8 P. R. 181, 192, 193; *In re Californian Fig Syrup Co.*, 40 Ch. D. 620; *In re Carter Medicine Co.*, (1892) 3 Ch. 472.

(*d*) *In re Münch*, 50 L. T. N. S. 12. And see *Berliner Brauerei Gesellschaft Tivoli* v. *Knight, Stocks & Co.*, W. N. 1883, p. 70; *Jackson & Co.* v. *Napper*, 35 Ch. D. 162; *Neuman* v. *Pinto*, 4 P. R. 508 (*per* Kekewich, J.); *In re Meus*, (1891) 1 Ch. 41; *Smith* v. *Fair*, 14 Ont. Rep. 729; *Ebrahim Currim* v. *Essa Abba Sait*, Ind. L. R. 24 Mad. 163.

(*e*) *In re Riviere & Co.*, 53 L. J. Ch. 455.

(*f*) 26 Ch. D. 48.

those which regulate the law of trade marks, the decision of the Court of Appeal to the contrary (*a*) having been overruled by the House of Lords (*b*). But the injunction granted may differ in form, even though the modification may be productive of little or no practical benefit to the defendant (*c*).

Trade names.

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

Goodwill.

All such cases, whether of trade mark, or trade name, or other unfair use of another's reputation, are concerned with an injurious attack upon the goodwill of a rival business; customers are diverted from one trader to another, and orders intended for one find their way to the other. Trade marks are really a branch of the goodwill of the business with which they are connected, representing it in the market, while the trade name over the shop represents it to the passer-by. It is by the devolution of the goodwill that that of the trade marks is regulated (*e*); they are in fact included in, and valued as part of, the goodwill (*f*); severed from it they cannot exist (*g*).

The registration system.

The above general outline of the law of trade marks naturally leads to a consideration of the system of registration which now prevails. And first it is to be remembered that the law of trade mark registration is not equivalent to the law of trade marks. That which is used as a trade mark is still a trade mark, registered or unregistered. But unless that which is used as a trade mark is registered as a trade mark it cannot be pro-

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

(*b*) S. C. 3 App. Cas. 376.

(*c*) *E.g.*, the "Yorkshire Relish" case —*Powell* v. *Birmingham Vinegar Brewery Co.*, (1896) 2 Ch. 54; (1897) A. C. 710. See *per* Lindley, L. J., at p. 79 of the report in C. A.

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

(*e*) § 22 of the Trade Marks Act, 1905; Rules 76—81 of the Trade Marks Rules, 1906. See also § 70 of the Patents Act, 1883, and § 2 of the Trade Marks Act, 1875.

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

(*g*) *Thorneloe* v. *Hill*, (1894) 1 Ch. 569.

tected as a trade mark, except in one case only, which will be explained presently. The difference is, that a trade mark which is entitled to protection as a trade mark cannot be imitated without infringement, whereas a trade mark which is not entitled to protection as a trade mark can only be protected in a passing-off action, in which the plaintiff has to prove, not merely that the mark has been copied, but that the mark in fact identifies his goods. Further than this, he must satisfy the Court that the defendant's conduct is calculated to deceive. It is no doubt true that even in an action for infringement of a trade mark this must be made out; but if the identical trade mark has been taken, and not merely a mark having a resemblance to it, infringement requires no further proof (*a*). Sect. 45 of the present Act expressly lays down that the passing-off action is unaffected by the provisions as to registration; but this has been already recognized by the Courts, *e.g.*, in the "Stone Ales" case (*b*), in which the words were removed from the register but protected by injunction simultaneously, and the "Yorkshire Relish" case, in which the words were similarly expunged (*c*), but were nevertheless protected in a passing-off action (*d*). Now for a trade mark to be protected as a trade mark it must be registered (sect. 42), with the one exception, that if the mark was in use before the 13th August, 1875 (the date of the first Trade Marks Registration Act), the proprietor can place himself in a position to have it protected as a trade mark if he applies for registration under the present Act and, failing to obtain registration, obtains a certificate of refusal. (Sect. 42.) It must be noticed that for this purpose it is not sufficient to have applied unsuccessfully for registration under one of the repealed Acts. The latitude provided by the present Act is greater than previously prevailed, and it is made an express condition of protection that an application shall have been made under the more generous conditions. Trade marks may therefore be summed up under three heads: (a) registrable trade marks, which must be registered if they are to be protected as trade marks; (b) non-registrable trade marks used before the 13th August, 1875, which can be protected as trade marks if tendered for registration

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

(*b*) *Thompson* v. *Montgomery*, 41 Ch. D. 35; (1891) A. C. 217.

(*c*) *In re Powell*, (1893) 2 Ch. 388; (1894) A. C. 8.

(*d*) *Powell* v. *Birmingham Vinegar Brewery Co., Ltd.*, (1896) 2 Ch. 54; (1897) A. C. 710.

and refused; (c) non-registrable trade marks not used before the 13th August, 1875, which can only be protected in a passing-off action, this mode of protection being also open to marks falling within classes (a) or (b), but which have not been registered or tendered for registration.

What can be registered.

The advantage of being able to rely on registration, without the necessity of having to prove a case of common law fraud, is so obvious that all marks should be tendered for registration and, if possible, registered. Moreover, it is plainly of the first importance that any trader who is desirous of adopting a trade mark for his goods should adopt one which is capable of registration, and that he should put this to the test by applying for and obtaining registration before he risks his capital in building up a business in reliance on his right to protection for the mark on which it is to depend. For this purpose the first section of the Act which has to be considered is sect. 3, which contains the definitions of the expressions "mark," "trade mark," "registrable trade mark," and "registered trade mark." These definitions are as follows:—

"A 'mark' shall include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof."

"A 'trade mark' shall mean a mark used or proposed to be used upon or in connection with goods, for the purpose of indicating that they are the goods of the proprietor of such trade mark by virtue of manufacture, selection, certification, dealing with, or offering for sale."

"A 'registrable trade mark' shall mean a trade mark which is capable of registration under the provisions of this Act."

"A 'registered trade mark' shall mean a trade mark which is actually upon the register."

The effect of this is that for the purposes of the Act a "mark" may be any of the various matters specified, and that to constitute such a mark a "trade mark" it must be used or intended to be used in trade in one or more of the modes specified, which include not merely marks indicative of manufacture, but also marks indicative of trading, wholesale or retail, and, further, marks indicative of certification, as provided by sect. 62. The definitions of "registrable" and "registered" trade marks call for no comment.

The next point is as to the conditions which entitle a mark to be regarded as a "registrable trade mark." These conditions are

laid down by sect. 9, by which such a mark "must contain or consist of at least one of the following essential particulars:—

"(1.) The name of a company, individual, or firm represented in a special or particular manner;

"(2.) The signature of the applicant for registration or some predecessor in his business;

"(3.) An invented word or invented words." As to this reference should be made to the "Solio" case (*a*) and the "Tachytype" case (*b*).

"(4.) A word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;

"(5.) Any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the above paragraphs (1), (2), (3) and (4), shall not, except by order of the Board of Trade or the Court, be deemed a distinctive mark;

"Provided always that any special or distinctive word or words, letter, numeral, or combination of letters or numerals, used as a trade mark by the applicant or his predecessors in business before the thirteenth day of August, one thousand eight hundred and seventy-five, which has continued to be used (either in its original form or with additions or alterations not substantially affecting the identity of the same) down to the date of the application for registration, shall be registrable as a trade mark under this Act.

"For the purposes of this section 'distinctive' shall mean adapted to distinguish the goods of the proprietor of the trade mark from those of other persons.

"In determining whether a trade mark is so adapted, the tribunal may, in the case of a trade mark in actual use, take into consideration the extent to which such user has rendered such trade mark in fact distinctive for the goods with respect to which it is registered or proposed to be registered."

The effect of this section is that a mark which falls within any of the first four sub-sections, or any other distinctive mark, not being a name, signature, or word or words, can be registered without more, as can an old mark which falls within the proviso

(*a*) *In re Eastman Photographic Materials Co., Ltd.*, (1898) A. C. 571.

(*b*) *In re Linotype Co., Ltd.*, (1900) 2 Ch. 258.

which follows sub-sect. (5), but other marks consisting of a name, signature, or word or words, can only be registered by utilizing the special provisions of sub-sect. (5).

Names and words.

The first sub-section is not of much importance, as it only protects a particular manner of representation of a particular name, and not the name itself; and the same remark applies to sub-sect. (2). Sub-sects. (3) and (4) applying to words, and sub-sect. (5) so far as it relates to devices, labels, tickets and the like, are of greatly more consequence. But the really new provision is that contained in the latter part of sub-sect. (5), by which a name, signature, or word or words, which do not fall within any of the earlier sub-sections, can still be registered if an order can be obtained from the Board of Trade or the Court on what is termed a "special application." The applicant has the advantage of being able to select which tribunal he prefers (though if he selects the Board of Trade there is always the possibility that the case may be referred to the Court under sect. 59), but if he selects the Board of Trade, and they hear the case, their decision will be final; whereas if he selects the Court, and the decision is unfavourable, he will be able to appeal up to the House of Lords, if he thinks fit so to do. He will further have the very great advantage, whichever tribunal he selects, of being able to produce evidence of the extent to which actual user has rendered his mark in fact distinctive for the particular goods, although the mark must be "adapted to distinguish" them, a phrase to which somewhat excessive regard has been paid, seeing that it was put into the Act to meet the case of previously unused marks which could not be actually distinctive in fact before they had become known. In this respect the new Act is greatly to be preferred to those which went before it, which, except in case of marks used before the 13th August, 1875, paid no attention whatever to actual user or its result. As matters have hitherto stood, words which did not fall within a strict construction of the words of the Acts, even though they were absolutely distinctive of the products of particular traders, could not obtain registration unless they had been used alone as trade marks on the goods before the 13th August, 1875 (*e.g.*, "Stone Ales," "Yorkshire Relish"). Now such words can be and have been registered by leave of the Board of Trade or the Court (*a*).

(*a*) Many such trade marks, numbering hundreds, have been passed for registration by the Board. The cases which have come before the Court so

Cotton marks.

It should here be noted that the provisions which apply to trade marks generally are somewhat modified in the case of cotton marks, which will henceforth be governed by sect. 64, by sub-sect. (10) of which section no words, standing alone, are to be registered for cotton piece goods or cotton yarn; no line heading, standing alone, is to be registered for cotton piece goods; and no registration of a cotton mark is to give any exclusive right to the use of any word, letter, numeral, line heading, or any combination thereof.

Colour.

Reverting to trade marks generally, sect. 10 enables trade marks to be limited in whole or in part to one or more specified colours. This has been desired by traders, but except in rare cases not much use is likely to be made of it, seeing that it does not apply to word-marks, and that ordinary devices would be of little value if the same devices could be adopted by other traders if coloured differently.

Restrictions on registration.

Certain restrictions upon registration are imposed by sect. 11, which prohibits the registration as a trade mark, or part of a trade mark, of matter which is open to objection for the reasons therein stated, and Rules 11—16 authorize the registrar to refuse registration for various further reasons. In certain cases there defined the registrar may require consents to be furnished. Further objections arise where marks tendered for registration contain matter which invades the rights of other traders, but it will be more convenient to deal with this topic later on.

Classification of goods.

Under the new Act, as under all that have preceded it, a trade mark must be registered in respect of particular goods or classes of goods (sect. 8), but there is nothing to prevent the registration of the same mark for a variety of goods, or classes of goods, in which the applicant is trading or intending to trade. For the purpose of registration, goods are classified in fifty classes (Rule 5). The third schedule to the Rules sets out these classes, and the Guide to the classification (p. 463, *post*) serves as an index to them. Rule 16 contains special provision for cases in which the name or a description of any goods appears on a trade mark, in which cases the registrar may refuse to register the mark for any other goods unless the application states that the name or description varies.

Application for registration.

When a person claiming to be the proprietor of a trade mark is

far have not been numerous, but in several instances the applications have been successful. See notes to sect. 9 (5) of the Act in App. A.

desirous of obtaining registration, he must make an application under sect. 12 (1). Such applications (except in the case of Sheffield marks and cotton marks, under sects. 63 and 64) have to be made to the registrar at the Trade Marks Office, and the manner of application is laid down by Rules 17—28.

Procedure on application.

The procedure on receipt of the application is laid down by Rules 29—34. The registrar may refuse the application, or may accept it absolutely, or subject to conditions, amendments, or modifications. (Sect. 12 (2).) Such conditions may include the entry of disclaimers (sect. 15, Rule 34), but such disclaimers are now expressly limited, so as not to affect any rights of the proprietor of the mark except such as arise from the registration. (Sect. 15.) If the applicant desires to appeal against such refusal, or against the imposition of such conditions, amendments, or modifications, he may require the registrar to state in writing the grounds of his decision and the materials used by him. (Sect. 12 (3), Rule 33.) He may appeal either to the Board of Trade or to the Court at his option (sect. 12 (3)), but if he appeals to the Board of Trade the appeal may be referred to the Court. (Sect. 59.) If the Board of Trade hears the appeal, the decision will be final (sect. 59), but if the appeal is heard by the Court the usual opportunities for further appeals will be available. The appellate tribunal has the same power as the registrar to impose conditions, amendments, or modifications (sect. 12 (4)), and the appeal is to be heard on the materials stated by the registrar. (Sect. 12 (5).) If special leave is given to take further grounds of objection the applicant may withdraw his application without payment of costs. (Sect. 12 (5), Rule 128.) Sect. 12 (6) provides for the correction of errors in applications or amendments thereof at any time. Appeals to the Court are brought by way of motion. (Rule 121.) Appeals to the Board of Trade are in the manner provided for by Rules 122–7. All appeals must be brought within one month.

Special provision is made by Rules 35—41 for applications for the registration of a name, signature, or word or words, under sect. 9 (5).

Special provision is also made by Rules 42—46 for applications for the registration of certification marks under sect. 62.

Advertisement.

When an application has been accepted the registrar is required to cause it to be advertised, together with all the conditions to which it is subject. (Sect. 13.) Such advertisement is in the

Trade Marks Journal, and the manner of advertisement is defined by Rules 47—50. If no representation of the mark is inserted in the Journal, as, *e.g.*, in the case of colour marks or cotton marks, a reference is to be given to the place where a specimen is deposited for exhibition. (Rule 47.)

Opposition. So far the only cases which have been dealt with have been cases in which the applicant has simply had to satisfy the registrar or the appellate tribunal that his proposed mark complied with the conditions of the Act. But the rights of third parties also have to be considered, and provision for opposition by such third parties is made by sect. 14 and Rules 51—61. Any person may give notice of opposition within one month from the date of advertisement. (Rule 51.) Such notice is to be in writing, in the prescribed form, and is to state the grounds of opposition. There is no limitation of persons who may oppose, or of grounds of opposition (except in sect. 41). If it is intended to rely on registered marks, the numbers of such marks and the numbers of the Journals containing the advertisements are to be set out. (Sect. 14 (2), Rule 52.) The registrar sends a duplicate of the notice of opposition (furnished by the opponent) to the applicant, who is to send to the registrar within one month a written counter-statement of the grounds on which he relies. (Sect. 14 (3), Rule 53.) The registrar then sends a duplicate of the counter-statement (furnished by the applicant) to the opponent (sect. 14 (4)), who is to put in his evidence in chief by way of statutory declaration within one month. (Rule 54.) The applicant is to put in his evidence in answer by way of statutory declaration within one month (Rule 55), and the opponent then has fourteen days within which to put in his evidence in reply. (Rule 56.) The registrar has power at any time to give leave to file evidence upon terms (Rule 57), and he has, by Rule 99, general power to enlarge any time prescribed by the Rules. (See also Rule 60.) When the evidence is completed a date is fixed for the hearing. (Rule 59.) The hearing then takes place and the decision is given. (Sect. 14 (4).) The decision is subject to appeal to the Court or, with the consent of the parties, to the Board of Trade. (Sect. 14 (5).) The Board of Trade may hear the appeal or may refer it to the Court. (Sect. 59.) If it hears the appeal its decision is final. (Sect. 59.) If the appeal is heard by the Court further appeals are possible. The appellate tribunal has the same power as the

registrar to impose conditions on registration. (Sect. 14 (6).) Further material may be introduced on appeal by special leave (sect. 14 (7)), but if further grounds of objection are introduced by special leave of the appellate tribunal the applicant may withdraw his application without payment of costs. (Sect. 14 (8), Rule 128.) In any appeal the appellate tribunal may permit the mark to be modified in any manner not substantially affecting its identity. (Sect. 14 (9).) Power is now given to the registrar or the Board of Trade to make an order for costs. (Sect. 14 (10).) If an opponent or appellant, as the case may be, neither resides nor carries on business in the United Kingdom, the registrar or the appellate tribunal, as the case may be, may require him to give security for costs. (Sect. 14 (11), Rule 61.)

Registration.

When an application for registration has been accepted and has not been opposed, and the time for opposition has expired, or when there has been an opposition which has been decided in favour of the applicant, the registrar is (upon payment of the prescribed fee) to register the mark, and such registration is to date as of the date of the application. (Sect. 16, Rule 64.) But if a mark has been accepted in error, the acceptance may be withdrawn. (Rule 63.) On registration a certificate is to be issued. (Sect. 17, Rule 67.) If the applicant dies before registration, the successor to his business may be substituted for him. (Rule 66.)

Abandonment.

If registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, notice is to be given to the applicant and his agent, if he has one, and if, after fourteen days or such longer time as the registrar may allow, the registration is still not completed, the application is to be deemed to be abandoned. (Sect. 18, Rules 62, 99.)

Conflicting marks.

The registration of a trade mark which is identical with one already on the register in respect of the same goods, or which so nearly resembles such trade mark as to be calculated to deceive, is prohibited (sect. 19, but see sect. 41), and in such cases the mark ought to be rejected in the office without putting the previously registered proprietor to the trouble and expense of an opposition. It is of course impossible for the registrar to be fully informed as to the details of all trades, so that in many cases marks will be passed for advertisement which ought to have been stopped, but there will then be an opportunity for opposition in the usual way.

Where there is any serious doubt as to the two marks conflicting, it is thought that the applicant ought to have the benefit of the doubt, leaving it to the owner of the other mark to oppose if he thinks fit In any case the Court can direct registration of identical or similar marks if it thinks fit to do so. The new law differs from the old in one important respect, viz., that for a mark to be stopped because of the presence of a similar mark on the register, it is now expressly provided that such stoppage is only to take place when the earlier mark belongs to a different proprietor. Consequently there is now nothing to prevent the same proprietor from registering any number of marks with the same essential particular, and in fact it is often convenient that this should be so. Another point to be noted is that in the case of an old mark, claimed as having been in use before the 13th August, 1875, there is no prohibition of registration on the ground of an identical or similar mark being on the register. Hitherto, similar old marks have been allowed to be registered up to three, after which the mark became common. It remains to be seen whether any such limit will be imposed in future, but it seems unlikely that many marks will be tendered for registration in the future with a claim of user for more than thirty-five years. The Court has now power (sect. 21) to provide for cases of honest concurrent user, *e.g.*, in different localities, by allowing registration of similar marks by different proprietors, subject to limitations in respect of mode or place of user or otherwise. This power was exercised by the Court in the early years of trade mark registration, without any precise legislative authority, but only in the case of old marks. Now it has become general. The case of each of several persons claiming to be the proprietor of the same mark, or similar marks, is provided for by sect. 20; but such cases can seldom arise, as the claims would have to be made practically simultaneously, otherwise one mark would be on the register and the later applications would in ordinary cases be refused.

Associated trade marks.

A group of sections which is substantially new consists of sects. 24—27, dealing with what the Act describes as "associated trade marks." The central idea is that while it is possible for the same proprietor to own a number of different registered marks, unlike one another, round each of which a distinct goodwill may quite possibly have grown up, it is also possible, and even probable, that the same proprietor may own a number of registered

marks which, while differing in various respects, may yet contain the same distinctive elements, so that any goodwill which attaches to one of them must necessarily attach, in some degree at all events, to all, so that it would be contrary to the whole spirit of the law of trade marks for such marks to change ownership except as a group. Suppose, for example, that a brewer had a number of different labels each containing the representation of a tiger and the words "Tiger Brand," but with different accompaniments, and also a number of other labels each containing the representation of a unicorn and the words "Unicorn Brand," there would be no harm in the "Tiger Brand" labels passing to A. and the "Unicorn Brand" labels to B., but it would never do to allow some of the tiger labels to go to A. and the rest to B. If that were to be so no one would be able to tell whose beer was indicated by the "Tiger Brand." The sections of the Act now under consideration provide that where marks are applied for which are so similar to one another that if used by different persons for the same goods deception would arise, such marks shall be treated as associated marks, and shall be assignable or transmissible only as a whole. (Sect. 27.) This same principle is applied whether the same person registers one mark first and applies afterwards to register another which is essentially the same (sect. 24), or if he registers a particular trade mark and also a more extended trade mark in which the first is included (sect. 25), or if he registers a series of trade marks which agree in the material particulars, while differing in other matters which do not substantially affect the identity of the mark. (Sect. 26.) This last provision appeared in a slightly different form in the Act of 1883, but in other respects this group of sections is new. Rule 65 gives practical effect to the principle laid down by requiring the registrar to note the number of each associated mark against the registration of each mark associated with it.

Sheffield marks.

The special provisions with regard to Sheffield marks for metal goods which were contained in the earlier Acts are repeated, with slight alterations, in sect. 63 of the new Act, and worked out by Rules 107—112. The general effect of the section and Rules is that for persons carrying on business in metal goods in Hallamshire, or within six miles thereof, the Cutlers' Company of Sheffield is substituted for the Registrar of Trade Marks, and provision is made for an interchange of information with regard to applica-

tions in respect of metal goods between the company and the registrar.

Cotton marks.

Somewhat similar provisions with regard to cotton marks are made by sect. 64 of the Act and Rules 113—120. In this case applications with respect to cotton marks are to be made to the Manchester Branch Office, superintended by the Keeper of Cotton Marks, who is to give all necessary information to the registrar. Cotton marks are defined by sect. 64 (1), (2) as trade marks for cotton goods, which have hitherto constituted classes 23, 24 and 25, "except such as may be prescribed." The Rules do not prescribe any exceptions, so that it may be taken that marks for any goods in any of the three classes named are cotton marks. It may be noted that sect. 64 (9) contains a provision to the effect that where a cotton mark tendered for registration has been used, the length of such user shall be stated in the application. No reason has been assigned why this useful stipulation has not been made to apply generally.

Certification marks.

A new and useful provision is made by sect. 62 for the admission to registration, by leave of the Board of Trade, of what are called in the heading to the section "Special Trade Marks," in the side-note to the section "Standardization, &c. Trade Marks," but better in sect. 3, "Certification Trade Marks." Such a mark is a mark used for the purpose of conveying to those who see it, not that the goods marked therewith are goods made or sold by the owner of the mark, but that the owner of the mark has examined the goods, and has affixed the mark for the purpose of certifying the result of such examination, in respect of the origin, material, mode of manufacture, quality, accuracy, or any other characteristic of the goods. Such marks would be the standard hall marks on plate. In such cases the marks may be registered, though there may be no goodwill attached to them, but they cannot be assigned or transmitted without the leave of the Board of Trade.

This concludes all that it seems necessary to say with respect to getting trade marks on the register. What remains is to consider what may be done in respect of them while they are there, how they are to be kept there, and how they are to be removed.

Assignment and devolution.

The new Act repeats the provision which has appeared in all Acts relating to trade mark registration, that a registered trade mark can be assigned and transmitted only in connection with the goodwill. (Sect. 22.) But express authority is given for the first

time for the goodwill for different countries to be split up, and for the right of user in any British possession or protectorate, or foreign country, to be assigned together with the goodwill of the business therein. Assignments and devolutions are to be entered in the register. (Sect. 33, Rules 76—81.) An assignor and assignee may apply jointly, or the assignee may apply alone. (Rules 76, 77.) On a goodwill becoming divided, by dissolution of partnership or otherwise, an apportionment of the registered trade marks may be sanctioned by the registrar, subject to the provisions of the Act as to associated trade marks. (Sect. 23, Rules 87—89.) The registrar's decision is subject to appeal to the Board of Trade (sect. 23), who may, if they think fit, refer it to the Court. (Sect. 59.)

Rights of registered proprietor.

The registered proprietor of a trade mark has the exclusive right to the use of the mark for the specified goods. (Sect. 39.) But where the same, or substantially the same, trade mark is registered for the same goods by different persons, neither of them is to have any exclusive rights against the other or others, except so far as their respective rights may have been defined by the Court (sect. 39), and no registration is to interfere with the *bonâ fide* use by any person of his own name or place of business, or of that of any of his predecessors in business, or of any *bonâ fide* description of the character or quality of his goods. (Sect. 44.)

Duration of registration.

The registration of a trade mark lasts for fourteen years, at the end of which time it comes to an end, unless it is duly renewed for another period of fourteen years. The procedure for obtaining renewal is set out in sects. 28—30 and Rules 68—75. If a registration is not renewed, and the mark is consequently removed from the register, marks similar to it are still not allowed to be registered for a year unless it is made out that the *bonâ fide* user of the removed mark had ceased for the two years immediately preceding the removal. (Sect. 31.)

Alteration by registrar.

The registrar has power, on application by the registered proprietor, to alter the registration of a trade mark in various respects, *i.e.*, by correcting an error in the name or address of the registered proprietor, by entering any change in the name or address of the registered proprietor (this meets the difficulty raised in *In re New Ormonde Cycle Co., Ltd.* (*a*)), by cancelling the registration, by

(*a*) (1896) 2 Ch. 520.

narrowing the goods for which the registration exists, by entering any disclaimer or memorandum which does not extend the registration rights. (Sect. 32, Rules 90—92, 82.) He may also allow the alteration of the mark itself in any respect which does not substantially affect its identity (sect. 34, Rules 93, 94)—a power which has hitherto been reserved for the Court. Any decision under either of these sections is subject to appeal to the Board of Trade, who may refer the appeal to the Court. (Sect. 59.)

Rectification by Court.

The Court may, under sect. 35, correct the register on the application of any person aggrieved in any of the following respects:—(a) by the non-insertion in or omission from the register of any entry (this does not extend to directing the registration of a mark, which must be obtained by means of the procedure provided for application and, if necessary, appeal) (*a*); (b) by any entry made in the register without sufficient cause; (c) by any entry wrongly remaining on the register; (d) by any error or defect in any entry in the register. The question who is a "person aggrieved" has been repeatedly considered by the Court, and reference may be made to *In re Riviere & Co.* (*b*), *In re Apollinaris Co.* (*c*), *In re Powell* (*d*), *In re Wright, Crossley & Co.* (*e*). The effect of these decisions is that a common informer is not a person aggrieved, but that any one is so who may possibly be injured by the continuance of the mark on the register. One way in which a mark is wrongly registered is where a mark is registered for goods on which there is no present intention of using it, such absence of intention being proved by failure for a substantial time to use it. This case was held to fall within sect. 90 of the Act of 1883, in *In re Batt & Co.* (*f*), *In re Suter Hartmann and Rahtjen's Composition Co.* (*g*), and *In re Hart* (*h*), and it is now expressly provided for by the introduction into sect. 35 of the words "any entry wrongly remaining on the register," and also by sect. 37, which is specially directed to this case. A new provision is that the registrar himself may apply for rectification in case of fraud in the registration or transmission of a registered trade mark. (Sect. 35 (3).) What is to be considered as "fraud" remains to be decided. An order

(*a*) See *In re Normal Co., Ltd.*, 35 Ch. D. 231.
(*b*) 26 Ch. D. 48; and on further hearing, 53 L. T. N. S. 237.
(*c*) (1891) 2 Ch. 186.
(*d*) (1893) 2 Ch. 388; (1894) A. C. 8.
(*e*) 15 P. R. 131, 377.
(*f*) (1898) 2 Ch. 432; (1899) A. C. 428.
(*g*) 19 P. R. 42.
(*h*) (1902) 2 Ch. 621.

for rectification is to be served upon the registrar, who is thereupon to rectify the register and, if he thinks the order should be made public, is to publish it in the *Trade Marks Journal*. (Sect. 35 (4), Rules 129, 130.) Another new provision is that a mark registered under an earlier Act is not to be removed from the register on the ground that it was not registrable under that Act if it would be registrable under the new Act. (Sect. 36.) This overrules one of the points decided in *In re Apollinaris Co.* (*a*). Again, it is provided (and in this respect the policy of the new Act is open to very grave question) that the original registration of a trade mark is, after the expiration of seven years from the date of such original registration (or seven years from the passing of the new Act, whichever shall last happen), to be taken to be valid in all respects unless the original registration was obtained by fraud, or unless the mark is objectionable for special grounds under sect. 11. (Sect. 41.) It will be observed that this provision only applies to the "original registration," so that it would still appear to be possible to obtain rectification on the ground that the entry is wrongly remaining on the register (sect. 35 (1)), as in the case of non-user for five years. (Sect. 37.) There is the further proviso that registration is not to entitle the registered proprietor to interfere with the use of a trade mark which was in use by others before his own registration. (Sect. 41.)

Remaining provisions.

The remaining provisions of the new Act and Rules deal chiefly with matters of practice and procedure, and need not be specially noticed here. It is, however, to be observed that in proceedings before the Court the registrar is no longer entitled as a matter of course to an order for his costs, which are in the discretion of the Court, though he is not liable to have to pay costs. (Sect. 48.) In practice the old rule will usually be followed.

International arrangements.

The sections of the Patents Acts, 1883—1902, relating to international and colonial arrangements (secs. 103, 104) were left standing by the Trade Marks Act, 1905, but those sections have since been replaced by secs. 88 and 91 of the Patents and Designs Act, 1907 (7 Edw. VII. c. 29).

Royal Arms.

The use of the Royal Arms is dealt with by sect. 68 of the new Act, which enables the improper use of such arms to be restrained by injunction. This is in addition to the provisions of sect. 90 of the Patents and Designs Act, 1907, which is now substituted for sect. 106 of the Patents Acts, previously unrepealed.

(*a*) (1891) 2 Ch. 186, 213.

CHAPTER II.

WHAT IS A TRADE MARK?

What is a trade mark?

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

A true trade mark must be affixed to the article.

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

"An illustration of the first class would be the common trade mark, which is either the name or the image of some known or unknown thing, actually impressed upon, or worked into, the material, or made to adhere to the surface of the material; or it may be, not what is commonly known as a trade mark, a distinguishing mark which, perhaps, to a legal mind would be a trade mark, but some form of the material itself." His lordship then

(*a*) *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434, 440.

(*b*) See the definition by the V.-C. of Ireland in *Wheeler* v. *Johnston*, 3 L. R. Ir. 284; also *Jay* v. *Ladler*, 40 Ch. D. 649.

instanced a case recently before him in which the trade mark consisted of certain lines woven into the fringe of a certain make of cloth, and continued:—

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

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

Registration gives exclusive right.

For a trade mark to be entitled to protection, it must therefore, apart from registration, not only be applicable, but be actually applied to a "vendible article" (*a*) in the market; the registration, however, of a trade mark gives an exclusive right to the use of the same, subject only to a few rare exceptions (*b*).

(*a*) See *per* Lord Westbury, C., in *McAndrew* v. *Bassett*, 4 De G. J. & S. 380; also *Marsell* v. *Hogg*, L. R. 2 Ch. 307; *Civil Service Supply Association* v. *Dean*, 13 Ch. D. 512; *In re Simpson, Davies & Sons*, Jessel, M. R., Jan. 12th, 1881; *Wheeler* v. *Johnston*, 3 L. R. Ir. 284; *Candee* v. *Deere*, 54 Ill. 439; *Avery & Sons* v. *Meikle & Co.*, 27 U. S. Pat. Gaz. 1027; *Ex parte Roy & Nourse*, 54 U. S. Pat. Gaz. 1267, where an unsuccessful attempt was made to register a trade-mark for land.

(*b*) T. M. A. 1905, § 39. See also 38 & 39 Vict. c. 91, § 9; 46 & 47 Vict. c. 57, § 75; 51 & 52 Vict. c. 50, §§ 17, 77. See also *Edwards* v. *Dennis*, 30 Ch. D. 454; *In re Batt & Co.*, (1898) 2 Ch. 432; (1899) A. C. 428. And this is so also in the United States. See *In re Dutcher Temple Co.*, U. S. Pat. Comm. Decis. 1871, 248.

Not every mark applied can be a trade mark.

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

Name and address of proprietor need not be stated.

In some American cases (*b*) a difficulty has been raised with regard to a supposed requirement for a trade mark to contain an indication of the name and address of its proprietor. This requirement, however, which appears to have been based on a misconstruction of the language of Duer, J., in *Amoskeag Manufacturing Co.* v. *Spear* (*c*), has in practice been disregarded, and the reasoning of the U. S. Commissioner of Patents, when admitting the number "140" to registration as a trade mark for umbrellas (*d*), seems to be conclusive. "A trade mark," he says, "must be of such a character as, when attached to the applicant's goods in the market, will distinguish them as to origin from other goods of the same class. To do this, it need not necessarily give the name of the person owning the said mark, nor the place where the goods are made or sold. It is enough if the mark is of such a character as to indicate to the purchaser that all articles bearing it come from one and the same source. The object a man has in view in adopting a trade mark is to secure to himself the benefits arising from the superior merits of his goods over others of the same class. To do this he puts upon them a peculiar mark, that purchasers may be able to distinguish them in the market. It matters not to him nor to others whether the purchasers know either his name or place of business, provided that his goods have some mark by which they may be designated and inquired for." Again, "If a trade mark

(*a*) Cf. *Raggett* v. *Findlater*, L. R. 17 Eq. 29; *Braham* v. *Bustard*, 1 H. & M. 447; *In re Brandreth*, Dig. 626; *In re Crosfield*, 23 P. R. 837, and other cases.

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

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

(*d*) *Ex parte Daves and Fanning*, 1 U. S. Pat. Gaz. 27.

possosses the evidence upon its face that it is put forth or given out as a distinguishing mark of the goods to which it is attached—that is, distinguishing as to origin, and not as to kind or quality—it may have all the requisites of a valid trade mark without naming the person or place whence it came" (*a*). In short, if a trade mark is properly distinctive—a condition which is indispensable (*b*)—no further particularity can be required, unless under the provisions of some statutory enactment.

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

The fact that an action to restrain the use of a particular trade mark has been successfully defended raises no presumption that the defendant's mark is a valid trade mark or capable of registration, for the action may have failed on such grounds as, *e.g.*, that the plaintiff's and defendant's marks were alike descriptive (*c*).

Definition of trade mark in Merchandise Marks Act, 1862.

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

Definition in Patents Acts, 1883—1888.

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

Under the last mentioned Act the definition was as follows:—

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

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

(*a*) *Per* U. S. Commissioner in *In re Dutcher Temple Co.*, U. S. Pat. Comm. Decis. 1871, 248. And see *per* Lord Herschell in *Powell* v. *Birmingham Vinegar Brewery Co.*, (1897) A. C. 710.

(*b*) See *Lavergne* v. *Hooper*, Ind. L. R. 8 Mad. 118, and many other cases.

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

(*d*) 25 & 26 Vict. c. 88, § 1.

(*e*) 3 L. R. Ir. 284.

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

(*g*) § 10.

(*h*) § 64.

(*i*) § 10.

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

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

(d) An invented word or invented words; or

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

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

(3) Provided as follows:—

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

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

And by § 74 of the Act of 1883 further provision was made for the registration of additions to registered trade marks.

Effect of this definition.

The effect of this definition was to restrict the variety of marks capable of adoption for the first time by a manufacturer, for he could not register or obtain protection under the Act for a new mark which did not comply with this definition by containing

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

(*b*) And see the definitions in *McLean* v. *Fleming*, 96 U. S. 245 and *Avery & Sons* v. *Meikle & Co.*, 27 U. S. Pat. Gaz. 1027. The House of Lords appears to have considered that it was the essential elements that constituted the trade mark, not the whole label with all the minor and immaterial additions: *Orr-Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 479.

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

Definition in Trade Marks Act, 1905.

Under the Act of 1905 the definition was very broadly recast, all in favour of applicants. It is now to be found in sections 3 and 9 of the Act, and is as follows:

"3. In and for the purposes of this Act (unless the context otherwise requires):—

A 'mark' shall include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof:

A 'trade mark' shall mean a mark used or proposed to be used upon or in connexion with goods for the purpose of indicating that they are the goods of the proprietor

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

(*b*) Since this enactment a single distinctive letter or figure has been capable of being registered as an old trade mark, though this was not so under the Act of 1875: *In re Mitchell* (1), 7 Ch. D. 36.

(*c*) Patents Act, 1883, § 77.

of such trade mark by virtue of manufacture, selection, certification, dealing with, or offering for sale:

A. 'registrable trade mark' shall mean a trade mark which is capable of registration under the provisions of this Act.

9. A registrable trade mark must contain or consist of at least one of the following essential particulars:—

(1) The name of a company, individual or firm represented in a special or particular manner;

(2) The signature of the applicant for registration or some predecessor in his business;

(3) An invented word or invented words;

(4) A word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;

(5) Any other distinctive mark, but a name, signature, or word or words, other than such as fall within the description in the above paragraphs (1), (2), (3) and (4), shall not, except by order of the Board of Trade or the Court, be deemed a distinctive mark:

Provided always that any special or distinctive word or words, letter, numeral, or combination of letters or numerals used as a trade mark by the applicant or his predecessors in business before the thirteenth day of August, one thousand eight hundred and seventy-five, which has continued to be used (either in its original form or with additions or alterations not substantially affecting the identity of the same) down to the date of the application for registration shall be registrable as a trade mark under this Act.

For the purposes of this section 'distinctive' shall mean adapted to distinguish the goods of the proprietor of the trade mark from those of other persons.

In determining whether a trade mark is so adapted, the tribunal may, in the case of a trade mark in actual use, take into consideration the extent to which such user has rendered such trade mark in fact distinctive for the goods with respect to which it is registered or proposed to be registered."

The distinctions between this definition and that which preceded it are numerous, and will quickly appear upon a comparison of the two. Attention may, however, be specially directed to

the fact that any distinctive mark, of whatever nature, may now be registered, if, in the case of words or names, the leave of the Board of Trade or the Court can be obtained. Also that the requirement of disclaimers has now disappeared, except when specially required under the provisions of section 15.

First class of trade marks. —A name.

In accordance with the above definition, the first species of trade marks consists of a name of a company, individual, or firm, represented in a special or particular manner.

How names differ from other trade marks.

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

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

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

(*a*) *Burgess* v. *Burgess*, 3 De G. M. & G. 896, and *infra*, pp. 41, 42. See *Lazenby* v. *White* (1), 41 L. J. Ch. 354; *Massam* v. *Thorley's Cattle Food Co.* (1), 6 Ch. D. 574; *Turton* v. *Turton*, 42 Ch. D. 128; *Tussaud* v. *Tussaud*, 44 Ch. D. 678; *Jamieson & Co.* v. *Jamieson*, 15 P. R. 169; *Valentine* v. *Valentine*, 31 L. R. Ir. 488; *McLean* v. *Fleming*, 96 U. S. 245; *Prince Metallic Paint Co.* v. *Carbon Metallic Paint Co.*, Dig. 573; *Aikins* v. *Piper*, 15 Grant Up. Can. Ch. 581; *Brown Chemical Co.* v. *Meyer*, 139 U. S. 540. And in the same way it seems that a manufacturer may put his address, the name of his mill, on his goods, though it may resemble the address on another man's goods: *Carmichael* v. *Latimer*, 11 R. I. 395.

(*b*) Dig. 531.

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

Statements on this point.

A valuable statement of the law was made by Lord Craighill in the Scottish Court of Session, in *Dunnachie* v. *Young & Sons* (*d*), in which he said:—"The name of a person may be a trade mark; there may be other manufacturers of goods of the same description, and the latter are not precluded from placing their own names on their goods by reason of the fact that this name has already become the trade mark of another manufacturer. The only condition they must fulfil is that the name as used by them shall be accompanied with something which shall be a distinction, if the bare name would lead to the deception of the public and the injury of the trader on whose goods the name first appeared as a trade mark." And in the New York case of *England* v. *New York Publishing Co.* (*e*), Daly, C. J., said: "The fact that a man has used his own name to designate the article he produces, and that the name has become valuable to him through the article becoming extensively known, gives him no right to exclude any other man of the same name from affixing his name upon the same kind of article, if he manufactures it. The test is whether he uses the name honestly and fairly in the ordinary prosecution of his business, or dishonestly, to palm off his own commodity as the production of another."

Holloway v. *Holloway.*

In *Holloway* v. *Holloway* (*f*), the defendant, Henry Holloway, sold pills and ointment in packets and pots, similar to those in

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

(*b*) *Holloway* v. *Holloway*, 13 Beav. 209, and *infra*; *Rodgers* v. *Nowill*, 6 Hare, 325; 5 C. B. 109; *Taylor* v. *Taylor*, 23 L. J. Ch. 255; *James* v. *James*, L. R. 13 Eq. 421; *Fullwood* v. *Fullwood*, W. N. 1873, pp. 93, 185; *Fullwood* v. *Fullwood* (2), 9 Ch. D. 176; *Massam* v. *Thorley's Cattle Food Co.* (2), 14 Ch. D. 748; *Pullar* v. *Pullar*, Fry, J., April 9th, 1883; *Warner* v. *Warner*, 5 Times L. R. 359; *Tussaud* v. *Tussaud*, 44 Ch. D. 678; *In re Hopkinson*, (1892) 2 Ch. 116; *Valentine Meat Juice Co* v. *Valentine Extract Co., Ld.*, 17 P. R. 673; *Wilder* v. *Wilder*, Dig. 372; *McLean* v. *Fleming*, 96 U. S. 245. And see cases collected at p. 291.

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

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

(*e*) 8 Daly, 375.

(*f*) 13 Beav. 209.

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

Burgess v. *Burgess*.

The case of *Burgess* v. *Burgess* (*a*) was somewhat similar. There the plaintiff's father, to whose business the plaintiff had succeeded, had invented "Burgess' Essence of Anchovies." He employed his two sons as his assistants, and the business was conducted by him and them at 107, Strand. After a time one of the sons, W. H. Burgess, took a house in King William Street, and setting up for himself, put on his shop front, "W. H. Burgess, late of 107, Strand." He also headed his labels, "36. King William Street, City, London (Royal Arms), late of 107, Strand, Burgess' Essence of Anchovies"; plaintiff's labels being headed, "107 (Royal Arms), Strand, corner of the Savoy Steps, John Burgess and Son. Original and Superior Essence of Anchovies." Sir R. T. Kindersley, V.-C., granted an injunction as to "late of 107, Strand," and the continuance on the sides of the defendant's shop door of a plate with the words "Burgess' Fish Sauce Warehouse, late of 107, Strand"; but the part of the motion which referred to the use of the words "Burgess' Essence of Anchovies," being refused, the plaintiff appealed, and the Lords Justices then distinctly refused to deny a man the use of his own name. Sir J. L. Knight-Bruce, L. J., said, "All the Queen's subjects have a right to sell their articles in their own names, and not the less so that they bear the same name as their fathers (*b*). The defendant

(*a*) 3 De G. M. & G. 896.

(*b*) And see *Hardy* v. *Cutler*, 3 U. S. Pat Gaz. 468. However, a son has no right to deceive the public by using his father's new name, after the father has assumed a different name from that to which the son is entitled: *Gouraud* v. *Trust*, 10 N. Y. Sup. Ct. 627; but if the son has assumed the same fictitious name with the father, by the father's

carries on business in his own name, and sells his essence of anchovies as 'Burgess' Essence of Anchovies,' which, in truth, it is"; and Sir G. Turner, L. J., added that, "where a person was selling goods under a particular name, and another person, not having this name, was using it, it might be presumed that he so used it to represent the goods sold by himself as the goods of the person whose name he used (*a*); but that where the defendant sold goods under his own name, and it did happen that the plaintiff had the same name, it did not follow that the defendant was selling his goods as the goods of the plaintiff" (*b*); if, however, a fraudulent intention had been proved, both judges agreed that the case would have been different.

Ainsworth v. *Walmsley.*

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

desire, the latter cannot afterwards interfere with the honest use of the fictitious name by the son: *England* v. *New York Publishing Co.*, 8 Daly, 375.

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

(*b*) In *Massam* v. *J. W. Thorley's Cattle Food Co.* (2), 14 Ch. D. 748, James, L. J., expressed the opinion that the language of Turner, L. J., was to be preferred to that of Knight-Bruce, L. J., the terms used by the latter being somewhat calculated to mislead; and this view has since been adopted by Lord Herschell in *Reddaway* v. *Banham*, (1896) A. C. 199. See also *Richards* v. *Butcher*, (1891) 2 Ch. 522; and *In re Hopkinson*, (1892) 2 Ch. 116. Compare *Turton* v. *Turton*, 42 Ch. D. 128.

(*c*) L. R. 1 Eq. 518. See *In re Hopkinson*, (1892) 2 Ch. 116: *Monro* v. *Hunter*, 21 P. R. 296.

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

A name may be a true trade mark.

That inconvenience has now been removed as to new marks capable of being allowed by the registrar without the sanction of the Board of Trade or the Court by the requirement for the name claimed as a trade mark to be "represented in a special or particular manner" (*b*). For the future, a new trade mark consisting of a name and registered under section 9 (1) will be available against all the world, without exception, for with the mere collocation of letters there is to be combined some further element, in respect of colour, pattern, or some other such differentia, which shall effectually distinguish the trade mark from even a similar succession of letters from which that further characteristic shall be absent (*c*). The effect of this provision is to render necessary for the future a precaution which many manufacturers have already voluntarily adopted; and the employment of a mode of printing, the imitation of which would furnish an almost irrefutable presumption of fraud, may be instanced from *Stephens* v. *Peel* (*d*), in which case the labels on the bottles containing the plaintiff's ink were printed in letters which are described as being in part white on a red ground, in part white on a blue ground, and in part blue on a white ground. This requirement, however, does not apply to old marks (*e*), and a manufacturer may still obtain protection for his name as an old mark though not printed in any particular or distinctive manner (*f*).

A name now first used as a trade mark must be in a distinctive form.

(*a*) See *per* Lord Kingsdown in *Leather Cloth Co.* v. *American Leather Cloth Co.*, 11 H. L. C. 523, where he treats a name as a good trade mark. Cf. *Brown Chemical Co.* v. *Meyer*, 139 U. S. 540.

(*b*) Trade Marks Act, 1905, § 9; Patents Acts, 1883—8, § 64; Trade Marks Act, 1875, § 10. And see *In re Gimaelis*, 6 P. R. 467; *In re Hannay*, 7 P. R. 46; also *In re Price's Patent Candle Co.*, 27 Ch. D. 681; *In re Edge*, 8 P. R. 207; *In re Bradley*, 9 P. R. 205; *In re Carroll*, 16 P. R. 82.

(*c*) See *per* Jessel, M. R., in *In re Horsburgh & Co.*, 53 L. J. Ch. 237. In the same way, the United States Statute of 1870, § 79, provided that the Commissioner of Patents should not receive and record any proposed trade mark which was merely the name of a person, firm, or corporation only, unaccompanied by a mark sufficient to distinguish it from the same name where used by other persons. And the Statute of 1881 provided by § 3, that "no alleged trade mark shall be registered which is merely the name of the applicant."

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

(*e*) Trade Marks Act, 1905, § 9; Patents Acts, 1883—1888, § 64; Trade Marks Act, 1875, § 10.

(*f*) *In re Hopkinson*, (1892) 2 Ch. 116; and see *In re Wright, Crossley & Co.*, 15 P. R. 131, 377.

Special registration under Trade Marks Act, 1905, s. 9 (5).

Further, where the Board of Trade or the Court is satisfied that a name in plain type is, in fact, a distinctive mark by virtue of long and exclusive user, the name can be registered without distinguishing additions, the right of other persons of the same name to make a *bonâ fide* use of it being preserved by section 44. A number of such names have been registered in this way by leave of the Board of Trade.

The name need not be that of the actual manufacturer.

There is no provision which requires that the name selected as the trade mark shall be the name of the individual or firm by whom the goods to which the trade mark is to be attached are actually manufactured. Neither was this the case before the introduction of registration. In many instances, it is true, the name was that of the actual manufacturer: thus, the words "Ainsworth's Thread" (*a*) and "Taylor's Persian Thread" (*b*) were used as trade marks on thread produced by those makers, "Ramsay" was used on bricks by G. H. Ramsay (*c*), Thomas Holloway placed "Holloway's Pills" and "Holloway's Ointment" on his boxes and pots (*d*), and so in many cases more (*e*).

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

But where a name has once become a trade mark by registration, or, if used before the passing of the Trade Marks Registration Act of 1875, by actual user on a vendible article (*f*), since followed by registration or the procurement of a certificate of refusal to register, it is assignable (*g*), subject to a connection with the goodwill of the business (*h*), and may easily pass to and become the property of a person or firm whose own name is widely different. Thus the trade mark "William Ash" in *Bury* v. *Bedford* (*i*), "1847, Rogers Bros. A. 1," in *Meriden Britannia Co.* v. *Parker* (*k*), "Thorley's Cattle Food" in *Massam* v. *J. W. Thorley's Cattle Food Co.* (2) (*l*), "Dr. C. McLane's Pills" in *McLean* v. *Fleming* (*m*). But it is a fraudulent act

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

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

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

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

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

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

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

(*h*) Trade Marks Act, 1905, § 22; and see Patents Act, 1883, § 70; and Trade Marks Registration Act, 1875, § 2.

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

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

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

(*m*) 96 U. S. 245.

to purchase the right to use the name of a small maker because it happens to be identical with that of a maker of reputation (*a*).

Names of fancy personages.

Among trade marks used before the passing of the Trade Marks Act of 1875, instances are not unusual of marks consisting of a name which neither is nor ever has been borne by the present or any past manufacturer, but which either belongs to some person who actually exists or has existed, or to some imaginary or symbolical personage, or character from a book. Thus, the names "Victoria," "Albert," &c., are very commonly used on a great variety of articles; so too "Britannia," "Dolly Varden," &c. All such names, when of fictitious characters, were properly classed under sub-clause (e) of the amended § 64 (1) of the Act of 1888 (*b*), and can be registered under the present Act.

Name sometimes used alone.

In some cases the name constituting the trade mark is used alone, as "Wilkie" in *Wilkie* v. *McCulloch* (*c*), "Dent" in *Dent* v. *Turpin* (*d*), "Ramsay" in *Dixon* v. *Fawcus* (*e*), "Howe" in *Howe* v. *Howe Machine Co.* (*f*), "Wedgwood" in *Wedgwood* v. *Smith* (*g*), "Hopkinson" and "J. J. Hopkinson" in *In re Hopkinson* (*h*).

Sometimes in combinations.

In other cases the name is used in combination with other letters, words, or figures, or combinations of letters, words, or figures; and the name of an inventor, discoverer, manufacturer, &c., "may make words distinctive which, without the name, would not be so" (*i*). Thus "Chubb's Patent-Lock Fire-proof Safe" (*k*). "Collins & Co. Hartford Cast Steel, Warranted" (*l*). "Taylor's Persian Thread" (*m*), "Stephens' Blue Black Writing Fluid" (*n*), "Thorley's Cattle Food" (*o*). Again, "J. Rodgers & Sons" was coupled with a crown between the initials of the sovereign (*p*), and "Ransomes & Co." was followed by "H. H. 6" (*q*).

(*a*) *Perks* v. *Hall & Co.*, W. N. 1881, p. 111; *Morrall, Ld.* v. *Hessin & Co.*, 19 P. R. 557; 20 *ib.* 429.

(*b*) See *In re Holt & Co.*, (1896) 1 Ch. 711 ("Trilby"); contrast *In re Harris*, 9 P. R. 492 ("Beatrice"); *In re Banks & James*, 12 P. R. 333 ("Shakespere"); *In re Carroll*, 16 P. R. 82 ("Princess Christian").

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

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

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

(*f*) 50 Barb. 236; R. Cox. 421.

(*g*) Dig. 96.

(*h*) (1892) 2 Ch. 116. And see *Richards* v. *Williamson*, 30 L. T. N. S. 746; *Fullwood* v. *Fullwood*, W. N. 1873, pp. 93, 185; *Tonge* v. *Ward*, 21 L. T. N. S. 480; *Fullwood* v. *Fullwood* (2), 9 Ch. D. 176.

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

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

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

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

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

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

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

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

But the mere combination of a name in the genitive case and in ordinary type with ordinary descriptive words does not constitute a registrable new trade mark. Thus "Giannelis' Cigarettes" (*a*), "Edge's Filtered Blue" (*b*). But such marks may be allowed by the Board of Trade or the Court on a special application under sect. 9 (5) of the Act of 1905.

Second class of trade marks.—A signature.

The second class of trade marks to which the Act allows registration is really little else than a subdivision of the first class, consisting as it does, of "the signature of the applicant for registration or some predecessor in his business." The signature of an individual or firm is in fact the name of the individual or firm printed or written in a "particular and distinctive manner," and as such, even before the Registration Acts, necessarily exhibited characteristics which could hardly be copied without the presumption being irresistible that the imitation was fraudulent and intended to invade the rights of the person whose signature was in question (*c*). In the cases of *Farina* v. *Silverlock* (*d*) and *Welch* v. *Knoll* (*e*) the signature formed an important part of the trade mark concerned, and in America the signatures of individuals and firms have been admitted to registration on the same principle. Under the Act of 1875, § 10, there was no necessity for the signature to be that "of the individual or firm applying for registration thereof as a trade mark," but that was required by § 64, both as originally contained in the Act of 1883, and as amended by the Act of 1888; so that an individual or firm could not, under those Acts, register the signature of the person or firm to whose business he or they succeeded, unless that was an old mark, having been used as such before the passing of the Act of

161. And see *Green* v. *Folgham*, 1 S. & S. 398; *James* v. *James*, L. R. 13 Eq. 121; *Lazenby* v. *Lazenby*, Dig 160; *Gillis* v. *Hall*, R. Cox, 596; also *Wilder* v. *Wilder*, Dig. 372 ("J. B. Wilder & Co.'s Stomach Bitters"); *Weston* v. *Hemmons*, 2 V. L. R. Eq. 121 ("Weston's Wizard Oil"); *McLean* v. *Fleming*, 96 U. S. 245 ("Dr. C. McLane's Liver Pills"); *Davis* v. *Kennedy*, 13 Grant Up. Can. Ch. 523 ("Perry Davis' Vegetable Pain-Killer"); *Hostetter* v. *Vowinkle*, 1 Dill. 329; and *Hostetter* v. *Anderson*, 1 V. R. Eq. 7 ("Hostetter's Celebrated Stomach Bitters"); *Radway* v. *Coleman*, 15 Grant Up. Can. Ch. 50 ("Radway's Ready Relief"); *Chinn* v. *Thomas*, 5 V. L. R. Eq. 188 ("Hood & Co.'s Soluble Sheep Dip").

(*a*) *In re Giannelis*, 6 P. R. 467.

(*b*) *In re Edge*, 8 P. R. 207. And see *Pirie* v. *Goodall*, (1892) 1 Ch. 35; cf. *In re Colman*, (1891) 2 Ch. 115.

(*c*) Compare *Weingarten* v. *Bayer*, 22 P. R. 341, where the mark protected consisted of the descriptive words ("Erect Form Corset"), printed in a peculiar and distinctive scroll.

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

(*e*) 4 K. & J. 747. See *Massam* v. *Thorley's Cattle Food Co.* (1), 6 Ch. D. 574; *In re Farina* (2), 27 W. R. 156; *In re Farina* (3), Dig. 654; *In re Maignen*, 28 W. R. 759.

1875. This limitation is now removed by the Act of 1905, and the signature of a predecessor in business is again registrable. However, when the signature is once registered as a trade mark, whether with or without additions, it will descend and be assignable just as any other trade mark, without its new owner being liable to any imputation of representing the person whose signature is employed to be still in charge of the business, although formerly the use of a mark of this description might not improbably have been held to convey some such representation to the public. To a case of this description Lord Cranworth's observations very directly apply, when, speaking of a buyer of a business using the name of a former maker, he said (*a*), "the question in every such case must be whether the purchaser in continuing the use of the original trade mark would, according to the ordinary usages of trade, be understood as saying more than that he was carrying on the same business as had been formerly carried on by the person whose name constituted the trade mark. In such a case I see nothing to make it improper for the purchaser to use the old trade mark, as the mark would in such a case indicate only that the goods so marked were made at the manufactory which he had purchased." The provision in the Acts of 1875 (*b*), 1883 (*c*) and 1905 (*d*), that a trade mark "shall be assigned and transmitted only in connexion with the goodwill of the business" will enable the purchaser to use the trade mark so acquired by him without his motives being open to question, and will at the same time insure that marked goods purchased by the public shall, except in cases of punishable infringement, be produced at the works from which they purport to have come.

Third class of trade marks.—A distinctive device, &c.

Before proceeding to deal with trade marks consisting of words, letters or numerals, it will be convenient to refer to the very large group of marks which formed the third class under the Acts of 1883-8, and which were described as comprising "a distinctive device, mark (*e.g.*, brand, heading, label, or ticket." These varieties (except "mark") are all included in section 3 of the Act of 1905, and authorised by section 9 (5) to be registered, if distinctive.

(*a*) *Leather Cloth Co.* v. *American Leather Cloth Co.*, 11 H. L. C. 523.
(*b*) § 2.
(*c*) § 70.
(*d*) § 22.
(*e*) The word "mark" is omitted from § 3 of the Act of 1905 as being unnecessary.

Distinctiveness required.

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

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

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

"Device."

"Device" ordinarily means a picture, and includes such cases as where the mark was stamped on shirts (*b*) or other cotton goods (*c*), or imprinted on sticks of liquorice (*d*) or sealing wax (*e*), and, generally, any cases which did not come within the remaining and more exact terms.

"Brand."

"Brand" refers to the name-brand of the goods, and includes cases in which the trade mark is branded on metal goods (*f*), or on wine casks (*g*), or corks (*h*), and it may include a water mark woven into the texture of paper (*i*).

"Heading."

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

"Label."

"Label" indicates an impression of a trade mark upon a piece of paper or some other thin substance, which is made to adhere to the goods to which it is applied, or to the vessel containing them. Thus, in *Wotherspoon* v. *Currie* (*m*), the label was affixed

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

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

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

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

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

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

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

(*h*) *Moet* v. *Clyhouse*, Dig. 533; *Moet* v. *Pickering*, 8 Ch. D. 372.

(*i*) *Pirie* v. *Goodall*, (1892) 1 Ch. 35.

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

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

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

to packets of starch; in *Bass* v. *Dawber* (*a*) to bottles of beer; in *Blackwell* v. *Crabb* (*b*), *Cocks* v. *Chandler* (*c*), *Cotton* v. *Gillard* (*d*) and other cases, to bottles of pickle.

"Ticket" points to a mark also impressed upon a separate "Ticket." material, but only loosely attached to the goods the make of which it indicates. Thus the trade mark of a wire manufacturer consisted of an anchor stamped on the tallies, or metal labels, attached to the bundles of his wire (*e*); the trade mark of a clothier was imprinted on a ticket pinned on to his wares (*f*). In the case of textiles the "ticket" is gummed on to the fabric. Mere words do not constitute a distinctive device (*g*), or heading (*h*), or label, or ticket (*i*).

Composition of trade mark.

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

"Device."

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

Examples.

Such marks are still frequently employed, and this clause specially includes them. To this class belong the marks of an anchor (*l*), an eagle (*m*), a lion (*n*), an elephant (*n*), a cross (*o*), a pyramid (*p*), a bell (*q*), a hand (*r*), a cock (*s*), a rising sun (*t*), or a triangle (*u*).

(*a*) 19 L. T. N. S. 626.
(*b*) 36 L. J. Ch. 504.
(*c*) L. R. 11 Eq. 446.
(*d*) 14 L. J. Ch. 90.
(*e*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185.
(*f*) *Hirst* v. *Denham*, L. R. 14 Eq. 542.
(*g*) *Ex parte Stephens*, 3 Ch. D. 659.
(*h*) *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288.
(*i*) *Great Tower St. Tea Co.* v. *Smith*, 6 P. R. 165.
(*k*) As to this Freemasons' emblem, it has been held in the United States that it is so generally appropriated to a special purpose as not to be registrable by a private firm, even in combination: *In re Tolle*, 2 U. S. Pat. Gaz. 415. But this decision was not followed in *In re Thomas*, 14 U. S. Pat. Gaz. 821, or *Ex parte King* (2), 46 U. S. Pat. Gaz. 119, though in *Ex parte Smith* (3), 16 U. S. Pat. Gaz. 764, registration was refused to the word "Masonic."
(*l*) *Edelsten* v. *Edelsten*, 1 De G. J. & S. 185.
(*m*) *Standish* v. *Whitwell*, 14 W. R. 512.
(*n*) *Henderson* v. *Jorss*, Dig. 198.
(*o*) *Cartier* v. *Carlile*, 31 Beav. 292; *Cartier* v. *Westhead*, Dig. 199; *Cartier* v. *May*, Dig. 200.
(*p*) *Bass* v. *Dawber*, 19 L. T. N. S. 626.
(*q*) *Bell, Black & Co.* v. *Bell & Co.*, Dig. 514.
(*r*) *Allsopp* v. *Walker*, Dig. 515.
(*s*) *In re Walkden Aërated Waters Co.*, 54 L. J. Ch. 394.
(*t*) *Morse* v. *Worrell*, 10 Phila. 168.
(*u*) *In re Worthington*, 14 Ch. D. 8.

A crest

A crest is just as capable of becoming a trade mark as any other arbitrary device (*a*). In *Beard* v. *Turner* (*b*). Sir W. P. Wood, V.-C., said, "I am not prepared to say or hold that a man putting his crest should not so put it as to establish his right to say, 'Nobody shall use my crest.' It is incumbent on him, as on every plaintiff, to show that the crest is an essential part of his trade mark." The readiest way of proving this is now by reference to the Register of Trade Marks.

Portrait.

The portrait of a person whose name has become descriptive of the goods, is not sufficiently distinctive to be registered as a good trade mark (*c*). The portrait of a public character has, however, been allowed to be registered in America (*d*), and even in this country in ordinary cases a trader may obtain registration of his own portrait as a trade mark (*e*).

Initials.

Before the Trade Marks Act of 1875 a trade mark might consist of initials, either alone or in combination with other ingredients (*f*). Under that Act and the Acts of 1883-8 it was difficult to assert that initials alone, printed in the usual manner, and without any distinguishing peculiarities of shape, colour, &c., could be described as "a distinctive device, mark, brand, heading, label, or ticket." Where the letters were combined together into the form of a monogram, or enclosed within a distinctive border, or were in any other way used in such a combination as to be distinguishable from the same letters used in the plain ordinary way, it might have been supposed that a device or mark would be constituted capable of registration; but in *Lucke* v. *Webster* (*g*), Sir G. Jessel, M. R., while admitting to registration as an old mark a monogram on a shield, suggested that he could not have done so if it had been a new mark. Under the Act of 1905 the

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

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

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

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

(*e*) *Rouland* v. *Michell*, (1897, 1 Ch. 71; and see *Richmond Nervine Co.* v. *Richmond*, 159 U. S. 293.

(*f*) See pp. 90, 91, *infra*.

(*g*) Jessel, M. R., April 4th, 1879.

case is otherwise, and initials can be registered, if distinctive (*a*). In the American case of *United States* v. *Marble* (*b*), the Commissioner of Patents considered that the letters "W. G." in a monogram were registrable as a trade mark.

Marks with a mechanical purpose.

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

Marks representing the article.

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

(*a*) See *In re Birmingham Small Arms Co., Ld.*, 24 P. R. 563; *Bouke, Roberts, & Co.* v. *W. A. Wayland & Co.*, 26 P. R. 251, 691.

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

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

(*d*) *Popham* v. *Wilcox*, 66 N. Y. 59.

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

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

(*g*) *Ex parte Halliday Brothers*, 16 U. S. Pat. Gaz. 560.

(*h*) *Ex parte Smith* (2), 16 U. S. Pat. Gaz. 679; and see *Merriam* v. *Famous Shoe and Clothing Co.*, 47 Fed. Rep. 411; *Merriam* v. *Texas Siftings Publishing Co.*, 49 Fed. Rep. 944. But this rule does not appear to be of universal application. See *Frost* v. *Rindskopf*, 42 Fed. Rep. 408: *Harris Drug Co.* v. *Stucky*, 46 Fed. Rep. 624. Cf. *Fish Brothers Wagon Co.* v. *La Belle Wagon Works*, 82 Wisc. 546; 33 Am. St. Rep. 72.

In *In re James* (*a*) an application was made for the removal from the register of a trade mark for black lead, which consisted of the representation of a dome-shaped cylinder of black lead, on the ground that the trade mark was simply a pictorial description of the goods in the form in which they were usually sold; but the decision of Pearson, J., allowing the application, was reversed by the Court of Appeal. This was principally on the ground that the black lead was not necessarily sold in that shape, and that the mark had sometimes been applied and might properly be applicable to blocks of black lead in any shape; and the Court did not actually decide what would be done if the trade mark had consisted of a pictorial representation of the goods in the only shape in which they could be made, but the inclination of the Court of Appeal would appear to have been rather in the direction above suggested. In 1889 the Comptroller-General signified his intention not to accept as trade marks from that date pictorial representations of the goods to which they were to be applied (*b*). No prohibition of this kind, however, appears in the present rules or instructions.

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

In *Harter* v. *Souvazoglu* (*c*) the trade mark consisted of a certain combination of purple, pink, and green threads, nine stripes in three gradations, which were woven as a heading into cotton goods, which were forwarded to the markets of Turkey and the Levant. The owners of this mark having filed a bill for an injunction against a rival trader who had copied the mark, Sir C. Hall, V.-C., held "that a heading could be the subject of a trade mark, that the evidence in the case showed that this heading was distinguished from others in Turkey, and that it had become a trade mark, although it was sometimes associated with stamps on the goods, of the lion and the sun, and other devices. Customers had bought goods because of this particular heading, and he therefore considered that the plaintiffs who had adopted it were entitled to the protection they asked, and that no other persons could use it" (*d*). Line-headings cannot now be registered for cotton piece goods (*e*).

(*a*) 33 Ch. D. 392. And see *Ripley* v. *Bawley*, 14 P. R. 591, compromised on appeal, *ib.* 914.

(*b*) See *In re Sphincter Grip Armoured Hose Co.*, 10 P. R 84.

(*c*) W. N. 1875, pp. 11, 101.

(*d*) And see *per* Sir G. Jessel, M. R., in *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434. Also *Carver* v. *Bowker*, Dig. 581, and *Robinson* v. *Finlay*, 9 Ch. D. 487, where a heading of coloured threads formed a part of the combination mark, though not mentioned in the report. The heading is practically always an element in the combination of markings on cotton piece goods.

(*e*) Act of 1905, s. 64 (10).

Fancy words.

Coming now to word marks, the first point to be noticed is that under the Act of 1875 no such mark could be registered at all unless used before Aug. 13th, 1875. This prohibition was regarded by traders as intolerable, and to meet their demands the words "fancy word or words not in common use" were introduced into § 64 of the Act of 1883.

Requirements.

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

Fancy words defined.

As to what is meant by "a fancy word or fancy words," it was at first very generally supposed, and was so held by Chitty, J. (*a*), and Bacon, V.-C. (*b*), that the term would include any word fancifully applied, such as would have been protected by the Courts irrespective of any Registration Act. The Court of Appeal, however, took a more stringent view of the meaning of the phrase, and the effect to be given to it was defined with reasonable clearness. Thus, in the leading case on the subject (*c*), Cotton, L. J., said, "To be registered, the word must be a 'fancy word'; and in order to come within that description it must be a word which obviously cannot have reference to any description or designation of where the article is made, or of what its character is"; and Lindley, L. J., said, "To be a 'fancy word' the word must either have to ordinary English people, to whom the Act is addressed, no meaning, like the word 'Eureka,' or the word 'Acilyton,' or, if it has any meaning at all, it must be obviously non-descriptive (*d*) when used as a trade mark." And Lopes, L. J., added, "A word to be a 'fancy word' must be obviously meaningless as applied to the article in question. It must be a word fanciful in its application to the article to which it is applied, in the sense of being so obviously and notoriously inappropriate as neither to be deceptive nor descriptive, nor calculated to suggest deception or description. Further than that, the word must have

(*a*) *In re Stapley & Smith*, 29 Ch. D. 877.

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

(*c*) *In re Van Duzer*, 34 Ch. D. 623.

(*d*) See 34 Ch. D. 645. See also *In re Borril Trade Mark*, (1896) 2 Ch. 600, 605, 607.

an innate and inherent character of fancifulness, which must not depend on evidence (*a*), and cannot be supported by evidence, to show that in fact it is neither deceptive nor descriptive, nor calculated to be deceptive or descriptive. A fancy word must speak for itself: it must be a fancy word of its own inherent strength." Again, in *Waterman* v. *Ayres* (*b*), Fry, L. J., after expressing his concurrence in the definitions given above, added further, "That which is the only name of a thing cannot, it seems to me, be a fancy word with regard to it. The word 'spade' describes the thing. You can never take the word 'spade' and call it a fancy word for the thing." And in another case (*c*) Chitty, J., said that, "in reference to an article produced in a foreign country and imported into England, where it was previously unknown and without a name, the word used in that foreign country as the common term to describe or denote the article is not a fancy word within the meaning of the Act."

Only six "fancy words" upheld.

The effect of these statements was so to narrow and restrict the meaning of the phrase that in nearly all the cases in which the question of "fancy word" was brought before the Court the decision was adverse to the claimant. In fact, in only six cases (*d*), one of which was afterwards disapproved (*e*), was the word upheld; whereas in many cases it was disallowed on the ground of descriptiveness or suggestion of descriptiveness (*f*).

(*a*) And see *Hodgson* v. *Sinclair*, 9 P. R. 22.

(*b*) 39 Ch. D. 29.

(*c*) *In re Davis & Co.*, 6 P. R. 207.

(*d*) **Words held to be "fancy words":** *In re Stapley & Smith*, 29 Ch. D. 877 ("Alpine" cotton); *Slazenger* v. *Malings*, W. N. 1885, p. 124 ("The Lawford" racquet); *In re Burgoyne*, 6 P. R. 227 ("Oomoo" wine); *In re Densham*, (1895) 2 Ch. 176 ("Mazawattee" tea); *In re Bovril Trade Mark*, (1896) 2 Ch. 600 ("Bovril"); *In re Burroughs, Wellcome & Co.*, (1901) 1 Ch. 736 ("Tabloid").

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

(*f*) **Words which have been held not to be "fancy words":** *In re Price's Patent Candle Co.*, 27 Ch. D. 681 ("National Sperm" candles); *In re Friedlander*, W. N. 1885, p. 85 ("Zephyr Asiatic Walnut Pipe"); *In re Harden Star, &c. Co., Ld.*, 3 P. R. 132 ("Hand Grenade Fire Extinguisher"); *In re Van Duzer*, 34 Ch. D. 623 ("Melrose Favourite Hair Restorer"); *In re Leaf, Sons & Co.*, 31 Ch. D. 632 ("Electric Velveteen"); *In re Arbenz*, 35 Ch. D. 248 ("Gem" air-guns); *Lever* v *Goodwin*, 36 Ch. D. 1 ("The Self-Washer"); *Tourgood Bros.* v. *Pirie & Sons, Ld.*, 4 P. R. 67 ("The Jubilee Note" paper); *In re Ainslie & Co.*, 4 P. R. 212 ("Ben Ledi" whiskey); *In re Laing*, L. J. N. of C. 1887, p. 102 ("Glengowrie Blend of Fine Old Highland Whiskey"); *In re Hanson*, 37 Ch. D. 112 ("Red, White, and Blue" label tea); *In re Sanitas Co., Ld.*, 4 P. R. 533 ("Sanitas" medicines); *In re Waterman*, 39 Ch. D. 29 ("Reversi" game); *In re Davis & Co.*, 6 P. R. 207 ("Bokö" beer); *Humphries* v. *Taylor Drug Co.* (2), 59 L. T. N. S. 820 ("Herbalin" medicine); *In re Californian Fig Syrup Co.*, 40 Ch. D. 620 ("Syrup of Figs"); *In re Jackson & Co.*, 6 P. R. 80 ("Kokoko" cotton piece goods); *In re Thompson & Co.*, 6 P. R. 213 ("Manor" tin plates); *In re Grossmith*, 6 P. R. 180 ("Emollio" toilet cream); *Great Tower Street Tea Co.*

It is, however, to be observed that the 'Mazawattee,' 'Bovril' and 'Tabloid' decisions might well have been adverse to the trade mark owners if the Courts had, at those later dates, been disposed to show as great severity as in some of the previous cases.

"Distinctive."

As to the requirement that a fancy word should be distinctive, it seems that the meaning to be placed upon this is that the word must be one which serves to distinguish the goods of one maker or dealer from the goods of all others (*a*), and that it cannot be distinctive if a word of similar sound, though different in spelling, is in use in the trade (*b*). The language of the present Act is that "distinctive" means "adapted to distinguish" (*c*).

"Not in common use."

The further requirement that fancy words must be "not in common use" was interpreted by Chitty, J. (*d*), to mean that they must not be in common use in the trade with respect to which it is sought to appropriate them; and though other judges have rather avoided expressing an opinion as to the meaning of the phrase, it would appear that this is the true meaning to be attached to it. The fact that a word may have been generally used and have acquired a descriptive signification in one trade may well leave it "obviously meaningless" in another. In Scotland, Lord Craighill (*e*) seems to have taken substantially the same view as Chitty, J., for he says that the term "'common use,' as

v. *Smith*, 6 P. R. 165 ("Tower Tea"); *Burland & Co.* v. *Broxburn Oil Co., Ld.* (2), 42 Ch. D. 274 ("Washerine" soap); *In re Vignier*, 6 P. R. 490 ("Monobrut" champagne); *In re Batt & Co.*, 6 P. R. 493 ("The Brymbo Special" iron); *In re Hannay*, 7 P. R. 46 ("Electroid" anti-fouling composition); *Stuart & Co.* v. *Scottish Val de Travers Paving Co., Ld.*, Ct. Sess. Cas. 4th Ser. XIII. 1 ("Granolithic" artificial stone); *In re Apollonaris Co.*, (1891) 2 Ch. 186, 221 ("Apollinaris," "Friedrichshall," and "Hunyadi Janos" mineral waters and products); *In re Edge*, 8 P. R. 207 ("Filtered Blue"); *Pirie* v. *Goodall*, (1892) 1 Ch. 35 ("Parchment Bank" paper); *Hodgson* v. *Sinclair*, 9 P. R. 22 ("Britannia" soap); *In re Paine* (1), 9 P. R. 130 ("John Bull Brand" beer); but see *Paine* v. *Daniells*, (1893) 2 Ch. 567; *In re Harris*, 9 P. R. 492 ("Beatrice" shoes); *In re Lloyd*, 10 P. R. 281 ("Carnival" cigarettes); *In re Talbot*, 11 P. R. 77 ("Emolliolorum" saddle paste); *In re Banks & James*, 12 P. R. 333 ("Shakspere" cigars); *In re Thompson*, 13 P. R. 35 ("Roadster" boots); *In re Davis*, 14 P. R. 903 ("Compactum" umbrellas); *Meaby & Co.* v. *Triticine, Ld.*, 15 P. R. 1 ("Triticumina" food); *In re Gestetner*, (1907) 2 Ch. 478; (1908) 1 Ch. 513 ("Cyclostyle" stationery).

(*a*) See *Wood* v. *Lambert*, 32 Ch. D. 257; *Waterman* v. *Ayres*, 39 Ch. D. 29; *In re Jackson & Co.*, 6 P. R. 80; *In re Apollinaris Co.*, (1891) 2 Ch. 186; *In re Magnolia Metal Co.*, (1897) 2 Ch. 371. See *In re Philippart*, 25 P. R. 565.

(*b*) *Per* Kay, J., in *In re Jackson & Co.*, 6 P. R. 80. And see *In re Ripley*, 15 P. R. 151.

(*c*) As to the great importance of this expression, see *In re Crosfield*, 26 P. R. 561, 837; *In re Cassella*, 27 P. R. 453.

(*d*) *In re Stapley & Smith*, 29 Ch. D. 877; *In re Burgoyne*, 6 P. R. 272. Compare *Great Tower Street Tea Co.* v. *Smith*, 6 P. R. 165; and *In re Banks & James*, 12 P. R. 333.

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

employed in the statute, does not necessarily import that the word must have been used commonly by all members of the community, or by people in all parts of the country. What is enough, in my opinion, to establish common use, in the sense of the statute, is this: if it shall be shown that the word has been commonly used by persons who had occasion to use it, and who are connected more or less directly with the use of the commodity to which the word has been applied." Conversely it was laid down by Kekewich, J., that if words were in common use generally, they were in common use within the meaning of the Statute (*a*).

Invented words.

The stringent interpretation placed by the Courts upon the phrase "fancy words" rendered the concession to commercial requirements intended to be made by the Act of 1883 practically valueless, and accordingly a departmental committee was appointed by the Board of Trade, over which Lord Herschell presided, and, following upon their report (*b*), the phrase "fancy word or words not in common use" was replaced in the Act of 1888 by the following terms:—

"(d) an invented word or invented words; or
(e) a word or words having no reference to the character or quality of the goods, and not being a geographical name."

In the Act of 1905 the phrase "an invented word or invented words" appears again without alteration, and these marks constitute the next class. The introduction of this expression into the Act of 1888 was generally considered to have been intended to bring within its scope, and to render registrable as new marks, such words as "Washerine" (*c*) and "Monobrut" (*d*), which were rejected as fancy words, or as "Pectorine" (*e*), "Lactopeptine" (*f*), "Valvoline" (*g*), which were not submitted to that test. The judges were, however, unable to remove from their minds the impression produced upon them by the rigidity with which the term "fancy word" had been construed, and which had been carried so far as to exclude from registration, not merely words which contained direct statements as to the

(*a*) *In re Paine* (1), 9 P. R. 130.
(*b*) See Appendix G.
(*c*) *Borland & Co.* v. *Broxburn Oil Co.* (2), 42 Ch. D. 274.
(*d*) *In re Vignier*, 6 P. R. 490.
(*e*) *Smith* v. *Mason*, W. N. 1875, p. 62.
(*f*) *Carnrick* v. *Morson*, L. J. N. of C. 1877, p. 71.
(*g*) *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288.

character or quality of the goods, but even invented words which had never been heard of before, but which were supposed to contain some remote suggestion of descriptiveness. Under the influence of this impression, they applied to this class of "invented words" the same prohibition of any reference to the character or quality of the goods which was contained in the succeeding clause of the Act relating to existing words, and having so introduced this prohibition they construed it with no less strictness than had previously been adopted in the case of "fancy words." In this way "Satinine" was rejected as a trade mark for starch, soap, blue, and similar goods (*a*). "Emolliolorum" for saddle paste (*b*). "Somatose" for an extract of meat (*c*). On the other hand "Mazawattee" was approved for tea (*d*), and "Kynite" for explosives (*e*). Finally the refusal of the Courts to register the invented word "Solio" for photographic paper (*f*) led to the question being submitted to the House of Lords, with the result that a decision was obtained from the highest tribunal that the term "invented word" in the later Act is to be construed without reference to the decisions on "fancy word" in the earlier Act, and that the prohibition of descriptiveness is not to be extended from the clause of the statutory definition relating to known words, where it was placed by the Legislature, to the clause relating to "invented words," where the Legislature omitted it. In fact in such cases the only question which has to be determined is, as stated by Lord Herschell in the "Solio" case, "whether the word sought to be registered is an 'invented word.' In one of the cases on this subject, Lord Justice Kay said: 'There is extremely little invention in the matter.' It may be that the word 'Satinine,' which was there in question, was objectionable on other grounds; but if the word be an 'invented' one, I do not think the *quantum* of invention is at all material. An invented word is allowed to be registered as a trade mark, not as a reward of merit, but because its registration deprives no member of the community of the rights which he possesses to use the existing vocabulary as he pleases. It may no doubt sometimes be difficult to determine whether a word is an invented word or not. I do not think the combination of two English words is an invented

(*a*) *In re Meyerstein*, 43 Ch. D. 604.
(*b*) *In re Talbot*, 11 P. R. 77.
(*c*) *In re Farbenfabriken*, (1894) 1 Ch. 645.
(*d*) *In re Densham*, (1895) 2 Ch. 176.
(*e*) *In re Kynoch*, 14 P. R. 905.
(*f*) *In re Eastman Photographic Materials Co., Ld.*, (1898) A. C. 571.

word, even although the combination may not have been in use before, nor do I think that a mere variation of the orthography or termination of a word would be sufficient to constitute an invented word, if to the eye or ear the same idea would be conveyed as by the word in its ordinary form (*a*). Again, I do not think that a foreign word is an invented word, simply because it has not been current in our language. At the same time, I am not prepared to go so far as to say that a combination of words from foreign languages so little known in this country that it would suggest no meaning except to a few scholars might not be regarded as an invented word."

This decision, however, does not affect such decisions as that in *In re British Electrozone Co.* (*b*), where it was held that a word known in an English-speaking country (the United States) could not be an invented word, or that in *In re Ripley* (*c*), where it was held that a new word "Pirle," identical in sound with a common and well-known word "Pearl," though differently spelt, could not be registered as an invented word.

To entitle a word to registration as an invented word it has been laid down by Cozens-Hardy, J., that it is not necessary that the applicant should be the true and first inventor—in the case in question the applicants had acquired the word from an American company—or that there should have been no prior publication within the jurisdiction, if substantially there has been no user in this country (*d*); and by Swinfen Eady, J., that, if a word is really an invented word when adopted as a trade mark, the mark does not become invalidated merely because of an interval between its first user and its registration (*e*). But it has been

(*a*) Thus "Bioscope" (*Warwick Trading Co.* v. *Urban*, 21 P. R. 240), "Haematogen" (*Hommel* v. *Gebrüder Bauer & Co.*, 21 P. R. 576), and "Gramophone"—27 P. R. 689, were held not to be invented words, as being known. On the other hand, "Savonol" (*J. C. & J. Field & Co.* v. *Wagel Syndicate*, 17 P. R. 266), and "Kodak" (*In re Kodak, Ld.*, 20 P. R. 337), have been held to be invented words.

(*b*) 13 P. R. 447.

(*c*) 15 P. R. 151. On this principle, "Uneeda" (*In re "Uneeda" T. M.*, (1902) 1 Ch. 783; "Absorbine" (*Christy & Co.* v. *Tipper & Son*, (1903) 1 Ch. 1; "Panoram" (*In re Kodak, Ld.*, 20 P. R. 337); "Diabolo" (*In re Philippart*, 25 P. R. 565); "Orlwoola" (*In re Orlwoola, Ld.*, 26 P. R. 850), have been held not entitled to registration. And see *Kirstein, Sons & Co.* v. *Cohen Bros.*, 39 Can. Sup. Ct. 286; *Ruffell* v. *Registrar of Deeds*, Cape Good Hope, 16 S. C. R. 141. Compare *In re Verschure and Zoon*, 22 P. R. 568, where "Vezet," which was said to be the Dutch way of pronouncing the letters VZ, was admitted to registration, the applicants undertaking not to claim any exclusive right to the letters.

(*d*) *In re Linotype Co.*, (1900) 2 Ch. 238.

(*e*) *In re Kodak, Ld.*, 20 P. R. 337.

said by Warrington, J., that a word to be invented must be newly coined, as was said by Lord Herschell and Lord Macnaghten in the "Solio" case; that it must not be an old word which is used for the first time in a new sense or an adjective which is used for the first time as a substantive; and that it must be coined for the first time for the purpose of its use as a trade mark in this country; and, while accepting the general observations of Cozens-Hardy, J., in *In re Linotype Co.*, he expressed a doubt whether the word must not be newly coined substantially at the date at which the application for registration is made, since otherwise it might get into common use between the time when it was first used and the time when the application was made for registration, and in this way the applicant might establish a legally enforceable monopoly in a word which had become part of the common stock of the English language (*a*). It may, however, be expected that words which have not become known in this country except in connection with the applicant's goods will seldom be rejected.

Non-descriptive words.

The next class of marks, as described in § 9 (4) of the Act of 1905, comprises "a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname." This definition is enlarged from the Act of 1888 by the introduction of the word "direct" and the reference to the ordinary signification of the word, and modified by the additional exclusion of surnames, which are left to be dealt with by the Board of Trade or the Court under sub-s. (5). This includes such terms as "Pharaoh's Serpents" toys (*b*), "United Service" soap (*c*), and "Charter Oak" stoves (*d*). Accordingly under this heading the words "Brownie" and "Bullseye" have been held good as applied to photographic films (though "Panoram" as so applied was held bad as descriptive) (*e*), "Quaker" as applied to spirits (*f*), "Motorine" for lubricating oil for motors (*g*). Geographical words remain excluded (*h*), as they had already been under the meaning given by the Courts to the term "fancy words."

(*a*) *Hommel* v. *Gebrüder Bauer & Co.*, 21 P. R. 576.

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

(*c*) *Feild* v. *Lewis*, Seton, 6th ed.

(*d*) *Fitley* v. *Fassett*, 44 Mo. 173.

(*e*) *In re Kodak, Ld.*, 20 P. R. 337.

(*f*) *In re Ellis & Co.*, 21 P. R. 617.

(*g*) *In re Compagnie Industrielle des Pétroles*, (1907) 2 Ch. 435.

(*h*) See *In re Apollinaris Co.*, (1891) 2 Ch. 186, 221 ("Apollinaris," "Friedrichshall," and "Hunyadi Janos" mineral waters and products).

Geographical words.

The question what is a geographical word is, however, not always easy of solution. Thus, in *In re Salt* (*a*), the word "Eboline" was held to be geographical, as being the name of the Italian town of "Eboli" with an ordinary suffix, though the word had been composed in ignorance of the existence of the town. Again, many words are used as names of places, while their original signification has no geographical reference at all. Such a case was that of "Magnolia" (*b*), which was the name of many small American towns and villages, yet was considered to be registrable, the geographical allusion not being generally understood in this country. The effect of this decision appears to be that a word is not to be regarded as geographical unless its primary signification is geographical, or unless it has become recognised in this country as a geographical word, and the reference in the new section to the "ordinary signification" has now made this distinction statutory.

Non-geographical words.

With reference to existing words free from any geographical meaning, the question still remains whether they have or have not any reference to the character or quality of the goods. That this question will be looked into very closely may be assumed from the cases cited above with respect to "invented words." And this seems very reasonable, for the right of the public to use descriptive words in a descriptive sense ought to be strictly maintained, as was pointed out by Lord Herschell in the "Solio" case (*c*), and their right to do so is now preserved, notwithstanding registration, by sect. 44 of the Act of 1905. Whether it was necessary to discover a descriptive allusion in all the cases in which the Court discovered it may perhaps be doubted, but it is clear from the decision of the House of Lords that no non-invented word which really is descriptive will be allowed to be registered as a new trade mark since August, 1875 (*d*), unless the sanction of the Board of Trade or the Court is obtained under sect. 9 (5). Where, however, a name which is not naturally descriptive, such

(*a*) (1894) 3 Ch. 166.

(*b*) *In re Magnolia Metal Co.*, (1897) 2 Ch. 371. See also *In re Apollinaris Co., Ld.*, (1891) 2 Ch. 186.

(*c*) *In re Eastman Photographic Materials Co., Ld.*, (1898) A. C. 571.

(*d*) See *In re Linotype Co.*, 14 P. R. 900 ("Typograph"); *In re Harrison & Crosfield*, 18 P. R. 34 ("Nectar" for tea); *In re Kodak, Ld.*, 20 P. R. 337 ("Panoram" for photographic films); *Christy & Co.* v. *Tipper & Son*, (1904) 1 Ch. 696; (1905) 1 Ch. 1 ("Absorbine"); *In re Printing Machinery Co., Ld.*, 23 P. R. 38 ("Century" for machinery); *In re Philippart*, 25 P. R. 365 ("Diabolo").

as "Magnolia," has been given to a new article, that application of the word does not necessarily cause it to have reference to the character or quality of the goods, though if the word has come to be known as the name of the article, irrespective of the manufacturer, it may become open to objection on the ground that it has ceased to be distinctive (*a*).

The names of imaginary persons, such as the characters in books, *e.g.*, "Trilby," fall within this class of words (*b*).

Old marks.

Marks which come within any of the above classes are capable of registration, whether they were used before the passing of the Trade Marks Registration Act, 1875, or not; but many valuable trade marks adopted and used before any precise definition was provided are not included in any of these classes, and would consequently be deprived of the benefits of the Act, unless some special provision were made for their protection. To meet this case it was provided, by § 64 (3) (ii) of the Acts of 1883-88 (*c*), that "any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures, used as a trade mark before the 13th day of August, 1875, may be registered as a trade mark under this part of this Act." And this provision in favour of old marks is repeated in sect. 9 (5) of the Act of 1905, with some revision of language. The words now run—"any special or distinctive word or words, letter, numeral, or combination of letters or numerals used by the applicant or his predecessors in business before the 13th day of August, 1875, which has continued to be used (either in its original form or with additions or alterations not substantially affecting the identity of the same) down to the date of the application for registration." It is thus now sufficient for the mark to be either special *or* distinctive, and immaterial alterations will not affect its registrability, but the user must have continued down to the date of application.

Old word-marks.

By far the most important description of marks included in this class is that defined as "any special or distinctive word or words used as a trade mark before the 13th day of August, 1875," which brings within the scope of the Act the numerous varieties of words which were used as old marks, whether they come within the defi-

(*a*) *In re Magnolia Metal Co.*, (1897) 2 Ch. 371.
(*b*) *In re Holt*, (1896) 1 Ch. 711.
(*c*) And see Trade Marks Registration Act, 1875, § 10.

nitions applicable to new marks or not. With respect to them, three conditions are prescribed. First, the word or words must be "special or distinctive"; secondly, they must have been used as a trade mark before the passing of the Act of 1875; and, thirdly, that user must have continued down to application.

"Used as a trade mark."

Passing over for the moment the question what words can be properly regarded as special or distinctive, it seems convenient first to consider here the further requirement that the word or words shall have been "used as a trade mark before the 13th day of August, 1875."

The expression "used as a trade mark" was much considered in the case of *Richards* v. *Butcher* (2) (*a*), where Kay, J., said that "'user as a trade mark' means, not what the person who uses has in his own mind about it, not what he has registered in a foreign country, but what the public would understand, when the trade mark or so called trade mark is impressed upon the goods, or upon some wrapper or case containing the goods, to be the trade mark. That is the trade mark proper; and 'user as a trade mark' means, and must necessarily mean, the impressing of those words either upon the goods, or upon some wrapper or case containing the goods, in such a way that the public would necessarily understand those words to be, and alone to be, the trade mark of the person who uses them." Again in *In re Powell* (2) (*b*), where the question was as to the use of the words "Yorkshire Relish" on packing cases containing bottles of the sauce of that name, Bowen, L. J., said, "although it is perfectly possible that a mark on a packing case may be intended to be used as a trade mark, it can only, as a rule, be so when the packing case is intended to sell the goods, and the packing case is intended to be the thing shown to the purchaser."

There must, then, have been user of the word or other mark before August 13th, 1875, and such user must have been user as a trade mark, and not as a descriptive term relating to the character or pattern of the goods or the like (*c*). The word or other mark

(*a*) (1891) 2 Ch. 522, 532.

(*b*) (1893) 2 Ch. 388; affirmed (1894) A. C. 8. And see *Day* v. *Riley*, 17 P. R. 59.

(*c*) *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288; *In re Harrison, McGregor & Co.*, 42 Ch. D. 691; *Richards* v. *Butcher* (2), (1891) 2 Ch. 522; *In re Powell* (2), (1893) 2 Ch. 388; (1894) A. C. 8; *John Dewar & Sons, Ld.* v. *Dewar*, 17 P. R. 341; *Day* v. *Riley*, 17 P. R. 517.

must have been used *per se*, and not as part of a mark which included other elements (*a*); and if it has always been used with such other elements, it cannot, apart from them, be claimed as an old mark, even though in some cases some of the elements comprising the entire trade mark have been used on one side of the article and the remainder on the other side (*b*). Moreover, it is not sufficient that there has been user on price lists, bill heads, or other trade documents; for user as a trade mark there must have been user on the goods themselves (*c*), or on the boxes or wrappers containing them (*d*),—though slight user is sufficient (*e*), unless the claim is for registration under the three-mark rule (*f*),—and the user before August 13th, 1875, must have been within the United Kingdom; for foreign user (*g*) or registration (*h*) is immaterial, and the mere passage through England of marked goods, without any sale or exposure for sale, is not user of the mark (*i*). And even if all these conditions have been complied with, the old user only gives a right to registration in respect of the goods with relation to which the old user existed, and not to registration as an old mark in respect of any other goods (*k*). Further, the user must have been by the applicant or his predecessors in business, and must have continued down to application.

(*a*) *In re Palmer* (3), 24 Ch. D. 504; *In re Royal Baking Powder Co.*, W. N. 1880, p. 49; *In re Hayward & Sons*, 54 L. J. Ch. 1003; *In re Charlton & Dugdale*, 53 L. T. N. S. 337; *In re Perry Davis & Son*, 15 App. Cas. 316; *In re Grossmith*, 6 P. R. 180; *In re Dunn*, 41 Ch. D. 439; *In re Apollinaris Co.*, (1891) 2 Ch. 186; *In re Kinahan*, 10 P. R. 393; *In re Powell* (2), (1893) 2 Ch. 388; (1894) A. C. 8. The same rule applies to a device claimed as an old mark: *Baker* v. *Rawson*, 45 Ch. D. 519, 528, 532; *In re Fuente*, (1891) 2 Ch. 166; *In re Heddle*, 20 P. R. 599.

(*b*) *In re Spencer*, 54 L. T. N. S. 659; *Richards* v. *Butcher* (2), (1891) 2 Ch. 522.

(*c*) *In re Palmer* (3), 24 Ch. D. 504; *In re Charlton & Dugdale*, 53 L. T. N. S. 337; *In re Perry Davis & Son*, 5 P. R. 333; 15 App. Cas. 316; *Thompson* v. *Montgomery*, 41 Ch. D. 35; (1891) A. C. 217. And see *Louise & Co., Ld.* v. *Gainsborough*, 20 P. R. 61, 67.

(*d*) *Jay* v. *Ladler*, 40 Ch. D. 649. And see *Richards* v. *Butcher* (2), (1891) 2 Ch. 522.

(*e*) *In re Charlton & Dugdale*, 53 L. T. N. S. 337.

(*f*) *In re Hodson, Tessier & Co.*, 86 L. T. N. S. 188.

(*g*) *In re Münch*, 50 L. T. N. S. 12; *In re Riviere & Co.*, 26 Ch. D. 48; *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288 (*per* Fry, L. J.); *Berliner Brauerei Gesellschaft Tivoli* v. *Knight, Stocks & Co.*, W. N. 1883, p. 70; *Jackson & Co.* v. *Napper*, 35 Ch. D. 162; *Smith* v. *Fair*, 14 Ont. Rep. 729; *Chas. Beyer & Co.* v. *Strauss, Adler & Co.*, Cape Good Hope, 24 S. C. R. 27. But see *In re Eastman*, W. N. 1880, p. 128.

(*h*) *Richards* v. *Butcher* (2), (1891) 2 Ch. 522, 532.

(*i*) *Jackson & Co.* v. *Napper*, 35 Ch. D. 162; *Newman* v. *Pinto*, 4 P. R. 508 (*per* Kekewich, J.); *In re Meens*, (1891) 1 Ch. 41.

(*k*) *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *Edwards* v. *Dennis*, 30 Ch. D. 454. And see *per* Pearson, J., in *In re Lyndon*, 32 Ch. D. 109; and *Phillips* v. *Ogden*, 12 P. R. 325, 331.

"Special or distinctive."

As to the requirement that the word or words shall be "special or distinctive" (formerly "special and distinctive"), it has been said by an Irish judge (*a*) that "special" means that the words must not ordinarily be applied to goods of the class in respect of which they are used, and that "distinctive" means that they must be suitable for distinguishing the particular goods as to which they are used from other goods of the same class. And in *Wood* v. *Lambert* (*b*), Fry, L. J., said: "It appears to me that to satisfy the requirements of the definition (*c*), the word or words must be distinctive in this sense, that they distinguish the manufacture of the person who has registered the trade mark from the manufacture of all other persons. I say 'manufacture,' but of course there may be cases in which they distinguish, not the manufacture, but the selection, or some other operation upon the goods. But in all cases the word or words must distinguish the product of the person claiming the trade mark from the product of all other persons, and it appears to me that it must have that distinctive character at the time of the registration" (*d*). And in the same case Lindley, L. J., said, "What is meant by a 'distinctive' trade mark? It must mean some mark which distinguishes the goods to which it is attached as those made or sold by the person who uses the mark." So in *In re Perry Davis & Son* (*e*), Lopes, L. J., stated that "the authorities are clear to show that it" (*i.e.*, a word claimed as an old mark) "must be a word distinguishing the article manufactured by one person from a similar article manufactured by another person, and not a word that is merely descriptive of the article itself" (*f*); and in the same case Lord Halsbury said in the House of Lords (*g*), "The word 'distinctive' means distinguishing a particular person's goods from somebody else's goods - not a quality attributed to the particular article, but distinctive in that respect -that it means that it is a manufacture of his as distinguished from somebody

(*a*) Chatterton, V.-C. of I., in *Bodega Co., Ld.* v. *Owens*, 6 P. R. 236.

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

(*c*) The definition there referred to is that contained in the Trade Marks Act, 1875, § 10 (3).

(*d*) This definition, Fry, L. J., repeated in substance in *In re Perry Davis & Son*, 5 P. R. 333. And see *Barlow & Jones, Ld.* v. *Johnson & Co.*, 7 P. R. 395, 400.

(*e*) 5 P. R. 333.

(*f*) And see *per* Fry, L. J., in *Waterman* v. *Ayres*, 39 Ch. D. 29; *Richards* v. *Butcher* (2), (1891) 2 Ch. 522; *In re Hopkinson*, (1892) 2 Ch. 116; *In re Magnolia Metal Co.*, (1897) 2 Ch. 371; *Bourne* v. *Swan & Edgar*, (1903) 1 Ch. 211. And see *In re Philippart*, 25 P. R. 565.

(*g*) 15 App. Cas. 316, 320.

else's. The manufacture may or may not be new, but that is the sort of distinction contemplated by the statute." Now, for purposes of trade mark registration, the statutory definition of "distinctive" is "adapted to distinguish" (*a*).

Wood v. Lambert.

In *Wood* v. *Lambert* (*b*) the word "Eton," which was registered as a trade mark by the plaintiffs, had been habitually used by them in conjunction with names of imaginary firms; and the Court of Appeal held that such user had destroyed whatever distinctiveness the word might otherwise have possessed. Fry, L. J., in whose views the other Lords Justices concurred, laid down that "when a person uses a name and represents that name to be applicable to the product of a manufacturer or manufacturers other than himself, so as to induce the belief that the goods are the manufacture of that third person or persons, he cannot say that the word is distinctive of his own manufacture. Nor do I think that that principle applies the less because the plaintiff may be false in the assertion that there is any such firm or firms as the manufacturer represents. He who has made the goods has taken upon himself to represent two things: in the first place, that they are not his manufacture, but somebody else's; in the second place, that a firm exists which does not exist at all."

Leniency of Courts.

In the majority of the cases in which the validity and right to registration of a word claimed as an old mark have been considered, the question has turned on the user or non-user as a trade mark before the 13th of August, 1875; but when the question has turned on the words being distinctive or otherwise, the Courts have shown themselves far more leniently disposed than in the case of "fancy words," and words which must have been refused registration as "fancy words" have been recognised as registrable in the character of "special and distinctive words" (*c*). In fact,

(*a*) Act of 1905, § 9 (5). See *In re Crosfield*, 26 P. R. 561, 837; *In re Cassella*, 27 P. R. 453.

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

(*c*) The following words have been recognised as special and distinctive words: *Bonbarat* v. *Spalding*, 49 L. J. Ch. 57 ("Family Salve"); *Talbot* v. *Webley*, 3 P. R. 276 ("Baffle" stoves); *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288 ("Valvoline" oil); (but compare *In re Hasburgh*, 53 L. J. Ch. 237); *In re Eastman*, W. N. 1880, p. 128 ("Kitchen Crystal Soap"); *Blair* v. *Stock*, 52 L. T. N. S. 123 ("Strathmore" whiskey); *Compania General de Tabacos* v. *Rehder & Co.*, 5 P. R. 61 ("Cavite" cigars); *Free Fishers and Dredgers of Whitstable* v. *Elliott*, W. N. 1888, p. 27 ("Whitstable native oysters"); *B. Edgington, Ld.* v. *J. Edgington & Co.*, 6 P. R. 513 ("Frigi Domo" canvas). And see *Evans* v. *Smith*, 3 Times L. R. 390 ("Montserrat" lime-juice); *In re Grossmith*, 6 P. R. 180 ("Emollio" toilet cream); *Thompson* v. *Montgomery*, 41 Ch. D. 35 ("Stone Ales"). In *In re Perry Davis & Son*, 58 L. T. N. S. 695; 15 App. Cas. 315, the term "Pain-

in some of these cases the words have been so far descriptive as to cause a reasonable doubt whether the leniency shown was not excessive.

Descriptiveness fatal.

Although there may be questions as to the application of the principle in particular cases, there can be no doubt that, as was clearly laid down in *Wood* v. *Lambert* (*a*), descriptiveness is fatal to a word claimed as an old trade mark (*b*), though it will not be invalidated for such a mere suggestion or suspicion of descriptiveness as has in some instances proved fatal to words claimed as "fancy words" (*c*). The intention of the proviso admitting old word marks to registration is evidently to give protection to words used as trade marks, and which would have been protected as such before the first Trade Marks Registration Act; and it may probably be said that words which would have been recognised as trade marks before 1875 will now be recognised as coming within the statutory proviso in favour of old marks. "The Legislature in the Act of 1875 did no more than adopt the language of the cases, by reducing them into a compressed form, and say really that what the Court would have held to be a trade mark independently of the Act should now be capable of registration as a trade mark under the Act, provided only that the mark had been used as a trade mark before the passing of the Act" (*d*).

Descriptive words.

When, however, a word is purely descriptive, that is to say, when it expresses accurately and appropriately the material or mode of composition of the goods to which it is affixed, then, unless the exclusive manufacture of such goods is protected by a patent, and the same result cannot be attained without infringement of the patent, all the world has the right to make and sell such goods; and further, when the goods are manu-

Killer" medicines seems to have been thought too descriptive, though there were other reasons for invalidating the trade mark. And see *Wright, Crosby & Co.* v. *Royal Baking Powder Co.*, Cape of Good Hope, 15 S. C. R. 9, where "Royal" was held inadmissible for registration as an old mark.

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

(*b*) That is unless the matter is brought before the Board of Trade or the Court on a special application under § 9 (5) of the Act of 1905, in which case the tribunal has power to deal with the case as the facts require. (*In re Crosfield*, 26 P. R. 837.) See, in particular, *per* Moulton, L. J. As to protection of a descriptive word which has acquired a secondary signification, see *per* Lord Herschell in *Reddaway* v. *Banham*, 1896 A. C. 199 at pp. 212—13.

(*c*) *E.g.*, in *Waterman* v. *Ayres*, 39 Ch. D. 29; *In re Sanitas Co., Ld.*, 11 P. R. 533; *Burland & Co.* v. *Broxburn Oil Co., Ld.* (2), 42 Ch. D. 274; *In re Vigour*, 6 P. R. 490; *Stuart & Co.* v. *Scottish Vale de Travers Paving Co., Ld.*, Ct. Sess. Cas. 4th Ser. XIII. 1.

(*d*) *In re Hopkinson*, (1892) 2 Ch. 116, *per* Kekewich, J.

factured and in course of sale, the vendor not only has the right, but is in duty bound to describe them, for the proper information and protection of the public, in such manner as will convey the most correct idea. Hence the original maker can claim no exclusive right in the properly descriptive name; nor would it be in accordance with the principles of equity that he should be able to do so, for, as was well said by Mr. Justice Strong, in the Supreme Court of the United States (*a*), "Equity will not enjoin against telling the truth" (*b*).

Young v. *Macrae*.

The reasoning of Wood, V.-C., in *Young* v. *Macrae* (*c*), affords a good example of the just way of considering cases of this description. In that case the plaintiffs, who held a patent for manufacturing a kind of oil which they called "Paraffin oil," filed a bill against the defendant, who sold a substance which he styled "Kerosene oil," or "American Paraffin oil." The case coming on on motion for injunction, the Vice-Chancellor said, "In the patent the process is described as 'a distillation of coal so as to obtain oil containing paraffin, and from this oil I obtain paraffin.' So he calls it paraffin oil because it contains paraffin. Here is a well-known substance called 'paraffin.' A chemist discovers that by the same process by which paraffin is produced, an oil containing paraffin, and from which paraffin can again be produced, is obtainable. Therefore, it being an oil containing paraffin, and producing paraffin, he calls it 'paraffin oil.' It is not a fanciful or whimsical name, but it describes the thing which he has produced. A man cannot take out a patent for a natural substance, but he can take out a patent for arriving at that natural substance, and he may christen it, putting aside all other people having called it by that name." The Vice-Chancellor then put the case of a man extracting sugar from beet-root by a patented process, and calling the extract "beet-root sugar" for a period of ten years. In such a case, when beet-root sugar was asked for, it would be known that his was meant,

(*a*) *Canal Co.* v. *Clark*, 80 U. S. 311; *Poulton & Son* v. *Kelley & Son*, 21 P. R. 392; *Grand Hotel Co. of Caledonia Springs, Ld.* v. *Wilson*, (1904) A. C. 103. See *Cellular Clothing Co.* v. *Maxton & Murray*, (1899) A. C. 326.

(*b*) If, however, the effect of using a descriptive word is to cause the person to whom it is used to believe that the goods came from a source which is not the true one, it is fallacious to say that the person so using it with knowledge of the effect is telling the truth: *per* Lord Herschell in *Reddaway* v. *Banham*, (1896) A. C. 199.

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

because he was the only man who made it. "The name," the Vice-Chancellor said, "does not become a trade mark, but it gets fixed to his sugar simply because nobody else could make it. Then, suppose that another man found out another method of making sugar from beet-root, and so extracted it, not wanting to patent it, and described it as 'beet-root sugar,' may he not call it 'beet-root sugar' because the other gentleman for ten years has been the manufacturer of it, and sold it as such? I think the question of the fancifulness of the name is a question whether it is taken by way of trade mark or not. All he (*i.e.*, the plaintiff) has done here is this: he has found out an article which is a natural product, and he has given that natural product a name. . . . This is not like the case of the 'Medicated Mexican Balm,' which is a name extravagantly ridiculous. I therefore should not assume *mala fides* against a person who calls the thing what it is. It is paraffin and it is oil, therefore paraffin oil. There is paraffin in it, and paraffin to be obtained from it, and it is American." Injunction refused.

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

Name become *publici juris*.

Again, a word which was first applied to, or was even invented for the sole and express purpose of designating a sub-

(*a*) *Braham* v. *Bustard*, 1 H. & M. 447. See also the remarks on *Young* v. *Macrae*, in *Reddaway* v. *Banham*, (1896) A. C. 199, in the House of Lords. See also *Powell* v. *Birmingham Brewery Co.*, (1896) 2 Ch. 54; (1897) A. C. 710; *Rockingham Rail. Co.* v. *Allen*, 12 Times L. R. 345; *Parsons* v. *Gillespie*, 15 P. R. 57; *Daniel* v. *Whitehouse*, (1898) 1 Ch. 685.

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

(*c*) So in *Eno* v. *Stephens*, Dig. 609, the term "Fruit Salt" was protected at the instance of the person who was the first to use it. And see *In re Dunn*, 41 Ch. D. 439; 15 App. Cas. 252; also *Siegert* v. *Findlater*, 7 Ch. D. 801; *Linoleum Manufacturing Co.* v. *Nairn*, 7 Ch. D. 834; *Grezier* v. *Antran*, 13 P. R. 1; *In re Borril Trade Mark*, (1896) 2 Ch. 600; *Powell* v. *Birmingham Vinegar Brewery Co.*, (1896) 2 Ch. 54; (1897) A. C. 710; *Rockingham Rail. Co.* v. *Allen*, 12 Times L. R. 345; *Parsons* v. *Gillespie*, 15 P. R. 57; *Daniel* v. *Whitehouse*, (1898) 1 Ch. 685; *In re Cheseborough Mfg. Co.*, (1902) 2 Ch. 1; *In re Philippart*, 25 P. R. 565; *Rey* v. *Lecouturier*, (1908) 2 Ch. 715; *In re Gramophone Co., Ld.*, 27 P. R. 689; *Canal Co.* v. *Clark*, 80 U. S. 311; and *Schendel* v. *Silver*, 70 N. Y. Sup. Ct. 330, as to a name which is appropriated to an article.

stance or composition may prove, on investigation, to have ceased to retain the characteristic, which it once possessed, of conveying the idea of the goods being of a particular manufacture; in which case the person who first used the word, though its inventor, will cease to have any exclusive rights in it, since it will have become purely descriptive of an article which all may freely make (*a*). The name thus becomes *publici juris*, and not only can be, but ought to be, employed by all who manufacture and sell an article which they are at perfect liberty to manufacture and sell, and of which the name in question is generally recognized as the appropriate designation. This point is well stated by Lord Selborne, C., in *Singer Manufacturing Co.* v. *Loog* (3) (*b*), where he says, "The reputation acquired by machines of a particular form or construction is one thing; the reputation of the plaintiffs, as manufacturers, is another. If the defendant has no right under colour of the former to invade the latter, neither have the plaintiffs any right under colour of the latter to claim (in effect) a monopoly of the former. If the defendant has a right to make and sell, in competition with the plaintiffs, articles similar in form and construction to those made and sold by the plaintiffs, he must also have a right to say that he does so, and to employ for that purpose the terminology common in his trade, provided always that he does this in a fair, distinct and unequivocal way."

Effect of registration under the former Acts.

The registration as a trade mark of a name of this description somewhat complicated the question under the Acts prior to 1905, as registration of a trade mark was, under those Acts, *primâ facie* evidence, and, after five years' registration, conclusive evidence of the right of the registered owner to the exclusive use of such trade mark (*c*); but the wording of the Acts was entirely directed to the registration of "a trade mark," the exclusive use of "a trade mark," &c., and since a name which had become *publici juris*,

(*a*) *E.g.*, "Worcestershire Sauce"—*Lea* v. *Millar*, Dig. 513; *Lea* v. *Deakin*, 11 Biss. 23; "Gem" air-guns, *In re Arbenz*, 35 Ch. D. 248; "Maizena," *National Starch Manufacturing Co.* v. *Munn's Patent Maizena and Starch Co.*, (1894) A. C. 275; "Magnolia" Metal, *Magnolia Metal Co.* v. *Atlas Metal Co.*, 14 P. R. 389; "Winser" Sewer-trap interceptors, *Winser & Co., Ld.* v. *Armstrong & Co.*, 16 P. R. 167; "Neva Stearine" candles, *Neva Stearine Co.* v. *Moulding*, 9 V. L. R. Eq. 98; "Fly Poison Pads," *Wilson* v. *Lyman*, 25 Ont. App. Rep. 303.

(*b*) 8 App. Cas. 27; and see *per* Mellish, L. J., in *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. 434, 456. See also *Winser & Co., Ld.* v. *Armstrong & Co.*, 16 P. R. 167.

(*c*) Patents Act, 1883, § 76.

whether registered or not, could not be a "trade mark" within the definition section of the Acts, because it contained nothing distinctive, it seemed that, at all events within the five years, this enactment did not preclude a defence on the ground that the name so registered was in fact no trade mark, and had been registered, or was continued on the register, by error. However, whether that be so or not, it was repeatedly decided that five years' registration could not protect a mark which had been registered as a trade mark, but was invalid by reason of its being descriptive or otherwise, from being removed from the register (*a*): and the remarks of Mellish, L.J., in *Ford* v. *Foster* (*b*), appear to have remained applicable. "There is no doubt, I think, that a word which was originally a trade mark, to the exclusive use of which a particular trader, or his successor in trade, may have been entitled, may subsequently become *publici juris*, as in the case which has been instanced of Harvey's Sauce (*c*). Then, what is the test by which a decision is to be arrived at whether a word which was originally a trade mark has become *publici juris?* I think the test must be, whether the use of it by other persons is still calculated to deceive the public, whether it may still have the effect of inducing the public to buy goods not made by the original owner of the trade mark as if they were his goods. If the mark has come to be so public and in such universal use that nobody can be deceived by the use of it, or can be induced from the use of it to believe that he is buying the goods of the original trader, it appears to me, however hard to some extent it may appear on the trader, yet practically, as the right to a trade mark is simply a right to prevent a trader from being cheated by other persons' goods being sold as his goods through the fraudu-

(*a*) *In re Palmer* (1) and (3), 21 Ch. D. 47; 24 *ib.* 504; *In re Lloyd & Sons*, 27 Ch. D. 646; *Edwards* v. *Dennis*, 30 Ch. D. 454; *In re Wragg*, 29 Ch. D. 551; *Wood* v. *Lambert*, 32 Ch. D. 247; *In re Spencer*, 54 L. T. N. S. 659; *In re Apollinaris Co.*, (1891) 2 Ch. 186; *Richards* v. *Butcher* (2), (1891) 2 Ch. 522; *In re Hart*, 19 P. R. 569. And it has been so held also in Victoria: *Lewis* v. *Klauprotè*, 11 V. L. R. 214; *Wolfe* v. *Alsop*, 12 V. L. R. 421; *Wolfe* v. *Lang & Co.*, 13 V. L. R. 752. The wisest course to take in such a case was no doubt to apply to rectify the register by the removal of the offending mark - *e.g.*, *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288.

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

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

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

Under the Act of 1905, registration, if valid, gives the registered proprietor the exclusive right to the use of the mark (*b*), and in all legal proceedings relating to the mark, the fact of registration is *primâ facie* evidence of the validity of the registration (*c*). This phraseology seems to preserve the right to question the validity of the mark without rectification, if the presumption in its favour can be set aside, but it is obvious that the only prudent course in such a case is for the party attacked to apply for the removal of the mark from the register, if not too late, having regard to the provisions of sect. 41, by which, after seven years from the 11th August, 1905, rectification will only be possible within seven years from the date of registration under the limited conditions therein specified.

Effect of registration under the Act of 1905.

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

The three-mark rule.

(*a*) For instances of marks proved to be common to particular trades, see note (*b*) to § 71 of the Patents Act, 1883, *infra*.

(*b*) T. M. A., 1905, § 39.

(*c*) T. M. A., 1905, § 40.

(*d*) *In re Walkden Co.*, 54 L. J. Ch. 394; *In re Powell* (1), Dig. 589; *In re Hyde & Co.*, 54 L. J. Ch. 395; *In re Leonardt*, Dig. 610; *In re Mitchell* (2), Dig. 611; *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *Ex parte Sales, Pollard & Co.*, Dig. 629; *In re Kuhn & Co.*, 53 L. J. Ch. 238; *In re Brook*, 26 W. R. 791; *In re Hudson, Tessier & Co.*, 86 L. T. 188; *Benbow* v. *Low* (4), 44 L. T. N. S. 875; *In re Sone & Fleming Manufacturing Co.*, 30 Ch. D. 505; *Jackson & Co.* v. *Napper*, 35 Ch. D. 162; *In re Bancraft & Co.*, 5 P. R. 209; and see *Board & Son* v.

case (*a*) three substantially identical marks, of which two were old and one was new, and in another case (*b*) three substantially identical *new* marks, were allowed to be registered for the same goods by different traders with consent of all the parties concerned. The provision in § 74 of the Patents Act, 1883, that any device which was before August 13th, 1875, publicly used by more than three persons on the same or a similar description of goods should, for the purposes of the section (*i.e.*, for the purpose of registration as an addition to a trade mark, exclusive rights therein being disclaimed) be deemed common to the trade in such goods (*c*), was derived from this rule. It is now possible, under sects. 19—21 of the Act of 1905, for concurrent registration of even identical new marks to be allowed under certain circumstances.

Name indicative of a principle of construction.

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

Articles made according to a patented process.

This difficulty has especially arisen with respect to articles made under a patent, which can only be made by the patentee during the existence of the patent, and to which, consequently, his name or some other special name usually becomes attached. "Where a patented article is known in the market by any specific designation, whether of the name of the patentee or otherwise, every

Thom & Cameron, 23 P. R. 509; 24 P. R. 697. The rule does not apply in New South Wales: *Blogg* v. *Anderson*, N. S. W. 21 L. R. Eq. 238.

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

(*b*) *In re Vergaras*, Hall, V.-C., June 3rd, 1881.

(*c*) Common user is not proved by the books containing applications for registration: *Orr-Ewing & Co.* v. *Johnston & Co.*, 13 Ch. D. 434; 7 App. Cas. 219.

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

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

person at the expiration of the patent has a right to manufacture and vend the same under the designation thereof by which it was known to the public. . . . . The original patentee or his assignees have no right to the exclusive use of the designation as a trade mark. Their rights were under the patent, and expired with it" (*a*).

The sewing-machine cases.

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

(*a*) *Per* Treat, J., in *Singer Manufacturing Co.* v. *Stumpe*, 2 McCrary, 512. And see *Edelsten* v. *Vick*, 11 Hare, 78; *Young* v. *Macrae*, 9 Jur. N. S. 322; *Green* v. *Rooke*, W. N. 1872, p. 49; *Liebig's Extract of Meat Co.* v. *Hanbury*, 17 L. T. N. S. 298; *Same* v. *Anderson*, W. N. 1883, p. 185; *Lazenby* v. *White*, 41 L. J. Ch. 354; *Condy* v. *Mitchell*, 37 L. T. N. S. 766; *James* v. *James*, L. R. 13 Eq. 421; *Chearin* v. *Walker*, 5 Ch. D. 850; *Massam* v. *Thorley's Cattle Food Co.* (1), 6 Ch. D. 574; *Siegert* v. *Findlater*, 7 Ch. D. 801; *Linoleum Manufacturing Co.* v. *Nairn*, 7 Ch. D. 834; *In re Ralph*, 25 Ch. D. 194; *In re Leonard & Ellis*, 26 Ch. D. 288, *per* Cotton, L. J.; *Native Guano Co., Ld.* v. *Sewage Manure Co.*, 8 P. R. 125; *Barlow & Jones, Ld.* v. *Johnson & Co.*, 7 P. R. 395, 400; *Magnolia Metal Co.* v. *Atlas Metal Co.*, 14 P. R. 289; *In re Davis*, 14 P. R. 903; *Mouby & Co.* v. *Triticine, Ld.*, 15 P. R. 1; *Magnolia Metal Co.* v. *Tandem Smelting Co.*, 17 P. R. 477; *In re Formalin Hygienic Co.*, 17 P. R. 486; *Cropper Minerva Machines Co.* v. *Cropper, Charlton & Co.*, 23 P. R. 388; *Dunlop Pneumatic Tyre Co.* v. *Dunlop Motor Co.*, 23 P. R. 761; 24 P. R. 572; *British Vacuum Cleaner Co.* v. *New Vacuum Cleaner Co.*, 24 P. R. 641; *In re Gestetner*, (1907) 2 Ch. 478; (1908) 1 Ch. 513; *In re E. M. Borden's Patent Syndicate, Ld.*, 26 P. R. 205; *Canal Co.* v. *Clark*, 80 U. S. 323, *per* Strong, J.; *Goodyear Rubber Co.* v. *Goodyear India Rubber Glove Manufacturing Co.*, 128 U. S. 598; *Coats* v. *Merrick Thread Co.*, 149 U. S. 562; *Singer Mfg. Co.* v. *June Mfg. Co.*, 163 U. S. 169. See *In re Eastman*, W. N. 1880, p. 128, in which registration was granted to a name which had been used for soap made under a patent.

(*b*) 39 L. J. Ch. 36.

(*c*) 2 Ch. D. 431.

(*d*) 3 App. Cas. 376.

(*e*) 8 *ib.* 15.

(*f*) 8 Biss. 181.

(*g*) 2 McCrary, 512.

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

turing Co. (*a*), though in the earlier Scotch case of *Singer Manufacturing Co.* v. *Kimball & Morton* (*b*), the decision was in favour of the company; and in the later case of *Singer Manufacturing Co.* v. *Spence* (*c*), it was held, distinguishing *Singer Manufacturing Co.* v. *Loog* (*d*), that in the absence of any context the word "Singer" or "Singer's," as applied to sewing machines, *primâ facie* denoted to the public a machine of the company's manufacture, and an injunction was granted (*e*).

Where, during the continuance of a patent granted to one Foley the defendants had made articles in accordance with the patent and called them "Foley's Patent Valves," it was held in America that they had infringed the patent, but not any trade mark rights (*f*).

And it has further been decided in America that a patented instrument for distinguishing a manufacturer's goods—*e.g.*, a special tin tag or ticket—cannot be recognised as a trade mark during the continuance of the patent (*g*), and that the special shape of an article made under a patent is similarly incapable of individual appropriation (*h*). But it has been held in this country that during the continuance of a patent an injunction may be granted in one action, where the evidence warrants it, not only for infringement of the patent but also for passing off by describing the spurious article as of the pattern of the patented article (*i*).

New name for new article.

And even where no patent is obtained, "it is to be observed that the person who produces a new article, and is the sole maker of it, has the greatest difficulty (if it is not an impossibility) in claiming the name of that article as his own, because, until somebody else produces the same article, there is nothing to distinguish it from" (*k*). Thus it was held by the Court of Appeal that a

(*a*) 41 Ohio St. 127.

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

(*c*) 10 P. R. 297. And see *Singer Manufacturing Co.* v. *June Manufacturing Co.*, 163 U. S. 169; and *Singer Manufacturing Co.* v. *Bent*, 163 U. S. 205.

(*d*) 8 App. Cas. 376.

(*e*) See *Singer Mfg. Co.* v. *British Empire Mfg. Co.*, 20 P. R. 313; *Daimler Motor Car Co.* v. *British Motor Traction Co.*, 18 P. R. 380; *Daimler Motor Co.* (1904), *Ld.* v. *London Daimler Co.*, 24 P. R. 379; *A. Boake Roberts & Co., Ld.* v. *Wayland*, 26 P. R. 251; *Hornsby* v. *Hudson*, N. S. W. L. R. 11 Eq. 148.

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

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

(*h*) *Wilcox & Gibbs Sewing Machine Co.* v. *Gibbon's France*, 21 Bl. C. C 431; *Brill* v. *Singer Manufacturing Co.*, 41 Ohio St. 127. So also in this country *Edge* v. *Niccolls*, C. A., Nov. 22, 1910.

(*i*) *Poulton & Son* v. *Kelley & Son*, 21 P. R. 392; cf. *Hill* v. *Thomas*, 23 P. R. 375.

(*k*) *Per* Fry, J., in *Siegert* v. *Findlater*, 7 Ch. D. 801. And see *Linoleum Manufacturing Co.* v. *Nairn*, *ib.* 834; *Waterman* v. *Ayres*, 39 Ch. D. 29; *Barlow*

firm who invented a new description of oil, and called it "Valvoline," had no right of trade mark in the word (*a*); and so where the word "Albion" had been used to indicate metal goods of a particular pattern, and not to indicate a particular manufacturer (*b*). But the word "Vaseline" was protected as an old mark for the well-known substance of that name, where the evidence showed that the word was used to denote not an article manufactured by a particular process, but an article manufactured by a particular manufacturer (*c*). So also where the article is not a new article, but only an improved form of an old article, the same considerations do not apply (*d*). The law has been thus summed up by Lord Justice Rigby, delivering the judgment of the Court of Appeal, in *In re Magnolia Metal Co.* (*e*): "When the article is made under a secret process or its manufacture is protected by a patent, no person who has not acquired the secret or obtained a licence from the patentee can manufacture it. Accordingly, it is established as a general rule that, when an article is made under a secret process, or when the manufacturer of it is protected by a patent, the manufacturer or patentee cannot, by any means, entitle himself to a monopoly in the use, after the secret process has been discovered or the term of the patent has expired, of the name by which the manufactured article is exclusively known whilst the secret is undiscovered, or the term of the patent is unexpired."

Actual fraud.

This rule, however, will of course not enable rival traders after the expiration of the patent, or the discovery of the secret, to represent their goods as the goods of the original manufacturer, and the Court will, in the exercise of its general jurisdiction for the repression of fraud, award an injunction or damages in a case of fraud in which, but for the fraud, no remedy would have been given. Thus, for instance, in a case in which the

& Jones, Ld. v. *Johnson & Co.*, 7 P. R. 395, 400; *Winser & Co., Ld.* v. *Armstrong & Co.*, 16 P. R. 167; *Cellular Clothing Co.* v. *Maxton & Murray*, (1899) A. C. 326, 344; *In re Formalin Hygienic Co.*, 17 P. R. 486; *Electromobile Co.* v. *British Electromobile Co.*, 24 P. R. 688; 25 P. R. 149; *Hommel* v. *Gebrüder Bauer & Co.*, 21 P. R. 576; *R.* v. *Cruttenden*, 10 Ont. L R 80; *In re Gramophone Co., Ld.*, 27 P. R. 689; *Marshall* v. *Hawkins*, 4 N. Z. L. R. Sup. Ct. 59.

(*a*) *In re Leonard & Ellis*, 26 Ch. D. 288.

(*b*) *In re Harrison, M'Gregor & Co.*, 42 Ch. D. 691. And see *Magnolia Metal Co.* v. *Atlas Metal Co.*, 14 P. R. 389.

(*c*) *In re Cheeseborough Mfg. Co.*, (1902) 2 Ch. 1; and see *Daimler Motor Co.* (1904), *Ld.* v. *London Daimler Co., Ld.*, 24 P. R. 379.

(*d*) *Barlow & Jones, Ld.* v. *Johnson & Co.*, 7 P. R. 395, 403.

(*e*) (1897) 2 Ch. 371, 391.

infringer might have taken with impunity the name of an article invented by another, but, not content with so doing, described his own manufacture as "the original" article, he was restrained by injunction from the use of that misleading epithet (*a*).

Name merely descriptive cannot be protected.

The general principle, however, is that where a name used by way of a trade mark either was originally, or has since come to be, merely descriptive of the article to which it is attached, so that while serving to indicate what the article is, it does not serve to connect it with any particular manufacturer or manufacturing establishment, that name cannot be protected as a trade mark (*b*)

(*a*) *Cocks* v. *Chandler*, L. R. 11 Eq. 446. And see *Reddaway* v. *Banham*, (1896) A. C. 199; *Powell* v. *Birmingham Vinegar Brewery Co.*, (1896) 2 Ch. 54; (1897) A. C. 710; *Singer Manufacturing Co.* v. *June Manufacturing Co.*, 163 U. S. 169; *Singer Manufacturing Co.* v. *Bent*, 163 U. S. 205. The presumption of fraud may, however, be refuted, as by a fair statement of the maker's own name; *Browne* v. *Freeman*, 12 W. R. 305.

Descriptive words.

(*b*) **The following are cases in which words have been held to be descriptive:**—*Thomson* v. *Winchester*, 36 Mass. 214 ("Thomsonian Medicines"); *Fetridge* v. *Wells*, R. Cox, 180 ("Balm of Thousand Flowers"); *Wolfe* v. *Goulard*, 18 How. Pr. 64 ("Schiedam Schnapps"); *Burke* v. *Cassin*, 45 Cal. 467 (do.); *Wolfe* v. *Hart*, 4 V. L. R. Eq. 125 (do.); *Wolfe* v. *Alsop* (1), 10 V. L. R. Eq. 41 (do.); (2) 12 V. L. R. 421 (do.); *Wolfe* v. *Lang & Co.*, 13 V. L. R. 752 (do.); *Young* v. *Macrae*, 9 Jur. N. S. 322 ("Paraffin Oil"); *Liebig's Extract of Meat Co.* v. *Hanbury*, 17 L. T. N. S. 298 ("Liebig's Extract of Meat"); *Same* v. *Anderson*, W. N. 1883, p. 185 (do.); *Canal Co.* v. *Clark*, 80 U. S. 311 ("Lackawanna" coal); *Rowland* v. *Breidenbach*, Dig. 386 ("Macassar" oil); *James* v. *James*, L. R. 13 Eq. 421 ("Lieut. James' Horse Blister"); *Green* v. *Rooke*, W. N. 1872, p. 49 ("Golden Ointment"); *Browne* v. *Freeman*, 12 W. R. 305 ("Chlorodyne"); *Bulloch, Lade & Co.* v. *Gray*, 19 Journ. of Jurisp. 218 ("Loch Katrine" whiskey); *Siegert* v. *Findlater*, 7 Ch. D. 801; and *Siegert* v. *Abbott*, 79 N. Y. Sup. Ct. 243 ("Angostura Bitters"); *In re Horsburgh*, 53 L. J. Ch. 237 ("Valvoline" oil); (but see *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288); *In re Saunion & Co.*, Dig. 625 ("Anglo-Portugo" oysters); *In re Brandreth*, Dig. 626 ("Porous" plasters); *Linoleum Manufacturing Co.* v. *Nairn*, 7 Ch. D. 834 ("Linoleum"); *Lazenby* v. *White*, 41 L. J. Ch. 354 ("Harvey's Sauce"); *Wotherspoon & Co.* v. *Gray & Co.*, Ct. Sess. Cas. 3rd Ser. II. 38 ("Victoria" lozenges); *Lamplough* v. *Beedzler*, C. A., Nov. 12th, 1880 ("Pyretic Saline"); *Day* v. *Neale*, Bacon, V.-C., May 24th, 1881 ("White Chemical Extract," "Brown Chemical Extract," "Red Paste," "Red Drench," "Gaseous Fluid," &c.); *In re Price's Patent Candle Co.*, 27 Ch. D. 681 ("National Sperm" candles); *In re Hudson*, 32 Ch. D. 311 ("Carbolic Acid Soap Powder"); *In re Atkins Filter & Engineering Co., Ld.*, 3 P. R. 164 ("The Sanitary Filter, easily cleaned"); *Native Guano Co., Ld.* v. *Sewage Manure Co.*, 8 P. R. 125 ("Native Guano"); *Schove* v. *Schmincke*, 33 Ch. D. 546 ("Castle Album"); *Watt* v. *O'Hanlon*, 4 P. R. 1 ("Old Innishowen" whiskey); *Symington & Co.* v. *Footman, Pretty & Co.*, 56 L. T. N. S. 696 ("Guaranteed Corset"); *In re Perry Davis & Son*, 5 P. R. 333; 15 App. Cas. 316 ("Pain-Killer" medicines); *In re Dunn*, 41 Ch. D. 439; 15 App. Cas. 252 ("Fruit Salt"); *In re Ralph*, 25 Ch. D. 194 ("The Home-washer"); *Goodyear Rubber Co.* v. *Goodyear India-rubber Glove Manufacturing Co.*, 128 U. S. 598 ("Goodyear Rubber"); *Kerry* v. *Les Sœurs de l'Asile de la Providence*, 2 St. Dig. 726 ("Syrup of Red Spruce Gum"); *McCall* v. *Theal*, 28 Grant Up. Can. Ch. 48 ("Bazaar Patterns" for clothing); *Montgomerie* v. *Donald & Co.*, Ct. Sess. Cas. 4th Ser. XI. 506 ("Water of Ayr" stone); *Stuart & Co.* v. *Scottish Val de Travers Paving Co., Ld.*, Ct. Sess. Cas. 4th Ser. XIII. 1 ("Granolithic" arti-

or registered as special and distinctive. The Act establishing registration "takes nothing away from anybody. It confers, upon certain conditions and under particular circumstances, rights which, but for the Act of Parliament, would not be as clearly asserted, but it takes nothing away. Any man who has a right to a trade mark has his trade mark just the same after the passing of the Trade Marks Registration Act as he had before. Only, if the persons enjoying the trade mark have been so numerous

ficial stone); *Lewis* v. *Klapproth*, 11 V. L. R. 214 ("Borax Soap"); *Hop Bitters Manufacturing Co.* v. *Luke*, 10 V. L. R. (Eq.) 234 ("Hop Bitters"); *Hop Bitters Manufacturing Co.* v. *Wharton*, 10 V. L. R. (L.) 337 (do.); *Brown Chemical Co.* v. *Meyer*, 139 U. S. 540 ("Iron Bitters"); *Parsons* v. *Gillespie*, 17 N. S. W. R. (Eq.) 227; (1898) App. Cas. 239 ("Flaked Oatmeal"); *Sparks* v. *Harper*, 3 Queensl. L. J. Rep. 158; *ib.* 201 ("French Coffee"); *Hommel* v. *Gebrüder Bauer & Co.*, 21 P. R. 576; 22 P. R. 43 ("Hæmatogen" drug); *In re Philippart*, 25 P. R. 565 ("Diabolo" tops); *Wright, Crossley & Co.* v. *Royal Baking Powder Co.*, Cape Good Hope, 15 S. C. R. 3 ("Royal" Baking Powder); *Peek, Frean & Co.* v. *Carr & Co.*, Cape Good Hope, 15 S. C R 172 ("Café Noir" biscuits); *Wordon & Pegram* v. *Cantrell & Cochrane*, Cape Good Hope, 18 S. C. R. 142 ("Club" soda-water); *Legg* v. *Finlay*, Cape Good Hope, 18 S. C. R. 107 ("Irish Crown" soap); *Southall & Co.* v. *Cuthbert & Co.*, Cape Good Hope, 18 S. C. R. 453 ("Lightfoot" boots); *Rex* v. *Cruttenden*, 10 Ont. L. R. 80 ("Glycothymoline" drug); *Asbestos & Asbestic Co.* v. *William Sclater Co.*, 10 Q. O. R. Q. B. 165 ("Asbestic" wall plaster); *In re Gramophone Co., Ld.*, 27 P. R. 689. And see cases as to "fancy words," *supra*, p. 54.

In the following cases descriptiveness has either not been alleged or has been held not to be established, and the words have been treated as distinctive words:—*Pidding* v. *How*, 6 Sim. 477 ("Howqua's Mixture"); *Perry* v. *Truefitt*, 6 Beav. 56 ("Medicated Mexican Balm"); *Taylor* v. *Carpenter* (1), 3 Story, 458 ("Persian Thread"); S. C. (2), 2 Wood. & M. 1 (do.); S. C. (3), 2 Sandf. Ch. 603 (do.); *Taylor* v. *Taylor*, 2 Eq. Rep. 290 (do.); *Hine* v. *Lart*, 10 Jur. 106 ("Ethiopian" stockings); *Davis* v. *Kendall*, 2 R. I. 566 ("Pain-Killer" medicine); *Davis* v. *Kennedy*, 13 Grant Up. Can. Ch. 523 (do.) (but see *In re Perry Davis & Son*, 5 P. R. 333; 15 App. Cas. 315); *R.* v. *Dundas*, 6 Cox, 380 ("Everett's Premier" blacking); *Braham* v. *Bustard*, 1 H. & M. 447 ("Excelsior" soap); *McAndrew* v. *Bassett*, 4 De G. J. & S. 380 ("Anatolia" liquorice); *Faber* v. *Hovey*, Dig. 481 ("Star" pencils); *Ford* v. *Foster*, L. R. 7 Ch. 611 ("Eureka" shirts); *Hirst* v. *Denham*, L. R. 14 Eq. 542 ("Turin," "Sefton," "Leopold," "Liverpool," cloth); *Sternberger* v. *Thalheimer*, 3 U. S. Pat. Gaz. 120 ("Centennial" clothing); *In re Bush & Co.*, 10 *ib.* 164 ("Centennial" wines); *Kidd & Co.* v. *Mills, Johnson & Co.*, 5 *ib.* 337 ("Magnolia," "Dave Jones" whiskey); *Morse* v. *Worrell*, 10 Phila. 168 ("Rising Sun" stove polish); *Cotton* v. *Gillard*, 44 L. J. Ch. 90 ("Licensed Victuallers' Relish"); *Smith* v. *Mason*, W. N. 1875, p. 62 ("Pectorine" medicine); *Rudam* v. *Shaw*, 28 Ont. R. 612 ("Microbe Killer"); *Grillon* v. *Guénin*, W. N. 1877, p. 14 ("Tamar Indien" lozenges); *Carnrick* v. *Morson*, Dig. 543 ("Lactopeptine" medicine); *Eno* v. *Stephens*, Dig. 609 ("Fruit Salt"), (but see *In re Dunn*, 41 Ch. D. 439; 15 App. Cas. 252); *Reinhardt* v. *Spalding*, 49 L. J. Ch. 57 ("Family Salve"); *Rosing* v. *Atkinson*, 27 Sol. J. 534 ("Edelweiss" perfume); *Berliner Brauerei Gesellschaft Tivoli* v. *Knight, Stocks & Co.*, W. N. 1883, p. 70 ("Tivoli" lager beer); *In re Eastman*, W. N. 1880, p. 128 "Kitchen Crystal Soap"); *Leonard & Ellis* v. *Wells & Co.*, 26 Ch. D. 288 ("Valvoline" oil) (but see *In re Horsburgh*, 53 L. J. Ch. 237); *Holt* v. *Menendez*, 128 U. S. 182 ("La Favorita" flour); *Barlow & Jones, Ld.* v. *Johnson & Co.*, 7 P. R. 395 ("Osman" towels). Cf. *In re Magnolia Metal Co.*, (1897) 2 Ch. 371, where a word not *per se* descriptive was held not distinctive on the ground that it had become descriptive.

Distinctive words.

that it is impossible to say that any of them, or all of them together, had an exclusive right to it, then they shall not have the benefit of the registration, which would give an exclusive right" (*a*).

Name not distinctive.

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

Adjective denoting quality only, no trade mark.

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

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

(*b*) *Batty* v. *Hill*, 1 H. & M. 264. See *Roper's, &c. Co.* v. *Copeman's, &c. Association, Ld.*, 28 Sol. J. 218; *In re Bryant & May, Ld.*, 8 P. R. 69; *Louise & Co.* v. *Gainsborough*, 20 P. R. 61; *In re Printing Machinery Co.*, 23 P. R. 38; *Wright, Crossley & Co.* v. *Royal Baking Powder Co.*, Cape Good Hope, 15 S. C. R. 9.

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

(*d*) *Dent* v. *Turpin*, 2 J. & H. 139. And see p. 124, note (*i*).

(*e*) *Per* Kentucky Court of Appeal in *Avery & Sons* v. *Meikle & Co.*, 27 U. S. Pat. Gaz. 1027. See *In re Crosfield*, 26 P. R. 561, 837.

(*f*) *Standard Co.* v. *Standard Co.*, P. C. Nov. 3, 1910.

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

(*h*) *Raggett* v. *Findlater*, L. R. 17 Eq. 29; and see *Spottiswoode* v. *Clarke*, 1 Coop. 254.

(*i*) *Candee, Swan & Co.* v. *Deere & Co.*, 54 Ill. 439; 5 Amer. Rep. 125; and see *Amoskeag Manufacturing Co.* v. *Spear*, 2 Sand. S. C. 599; R. Cox, 87; *Same* v. *Trainer*, 101 U. S. 51; *Burke* v. *Cassin*, 45 Cal. 467; 13 Amer. Rep. 204; *Stokes*

Notes (*k*) (*l*), see next page.

Marks denoting maker as well as quality.

But in some of the American cases the principle appears to have been carried to an extent which is unreasonable, and which has not been and would not be recognised in this country, the rule having been laid down too generally that every word or symbol which serves to indicate quality is incapable of appropriation as a trade mark, the qualification being omitted that, if such word or symbol also serves to indicate a particular manufacturer, the mark may be a good trade mark. In *Amoskeag Manufacturing Co.* v. *Trainer* (*a*) the Supreme Court of the United States itself appears to have decided in favour of the wider rule. There the plaintiff company manufactured cotton tickings, and sold the different qualities under different labels, of which the one affixed to the best quality of the goods bore a combination device, in which the prominent and conspicuous feature consisted of the letters "A. C. A." Those letters had for many years been recognised as indicating that the goods to which they were attached were of the plaintiff company's manufacture, and also of the best quality of the goods so manufactured, and the plaintiffs' user of the letters had been substantially exclusive. In an action, however, brought against defendants who had sold similar goods of their own manufacture under a label containing the same letters in a conspicuous place, the Supreme Court held that, the letters being indicative of quality, no protection could be given. All trade marks, however, which are of any value at all, denote that the goods to which they are attached are of good quality, and by far the greater number of large manufacturing firms use a variety of trade marks, which they apply to goods of different descriptions or qualities, or intended for different markets; and possibly the explanation of the decision may be that the Court really considered that the letters, though only used by the plaintiffs, indicated nothing beyond quality (*b*).

Such marks valid.

It seems clear that the English rule that combinations of letters, or words, or symbols, which indicate that the goods to which they

v. *Landgraff*, 17 Barb. 308: R. Cox, 137; *Kinney* v. *Allen*, 1 Hughes, 106; *In re Eagle Pencil Co.*, 10 U. S. Pat. Gaz. 981; *Osgood* v. *Allen*, 1 Holmes, 185; *Carver* v. *Bowker*, Dig. 581; *Avery* v. *Meikle*, 27 U. S. Pat. Gaz. 1027; *Lawrence Manufacturing Co.* v. *Tennessee Manufacturing Co.*, 138 U. S. 537; *Barlow* v. *Gobindram*, Ind. L. R. 24 Calc. 364,

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

(*l*) *Coats* v. *Merrick Thread Co.*, 45 U. S. Pat. Gaz. 347; 149 U. S. 562.

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

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

are applied have been manufactured by a particular person or firm, may constitute valid and registrable trade marks, notwithstanding that they also indicate the quality or pattern of the goods as compared with other goods of the same makers (*a*), is preferable to that which appears to have been formulated in some of the American Courts. Thus, in *Hirst* v. *Denham* (*b*), different fancy patterns of the plaintiff's cloth were marked with different names, each of which was protected; in *Moses* v. *Sargood, Ewen & Co.* (*c*), the plaintiff's clothing was marked with a number of crowns, varying from one to six, according to quality; in *Ransome* v. *Graham* (*d*), the plaintiff's ploughs were marked with the letters "R. N." and an additional letter or numeral, varied according to pattern and quality (*e*). In the Indian case of *Taylor* v. *Virasami* (*f*) the plaintiff's shirtings were marked with scimitars, varying in number from two to five, according to quality. Even in some of the American Courts the English rule has been recognised, and it was well stated by the Supreme Court of Rhode Island (*g*) as follows:—"Undoubtedly, if it be assumed that a given mark indicates quality only, and not origin, it will follow that purchasers of goods so marked have not been misled thereby into the supposition that they were buying a plaintiff's goods, and hence he would show no cause for relief. . . . . But it by no means follows as a rule of law that marks indicating style or quality may not also indicate origin, and thus be a subject of trade mark. . . . . A person may have different symbols for different grades of goods, which will indicate both quality and origin with respect to the goods so marked. A manufacturer may adopt such symbols, not simply to mark a style or quality, but *his* style and *his* quality as well. He is entitled to have his style and his quality protected from misrepresentation, and to have the benefit of any favourable reputation they may have gained."

Marks denoting quality in only one trade.

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

(*a*) *Ransome* v. *Graham*, 51 L. J. Ch. 897.
(*b*) L. R. 14 Eq. 542.
(*c*) Dig. 636.
(*d*) 51 L. J. Ch. 897.
(*e*) And see *In re Brook*, 26 W. R. 791; *Mitchell* v. *Henry*, 15 Ch. D. 181; *Ralli* v. *Fleming*, Ind. L. R. 3 Calc. 417; *Barlow & Jones, Ld.* v. *Johnson & Co.*, 7 P. R. 395, 412, 415; and *per* Pearson, J., in *Wood* v. *Lambert*, 32 Ch. D. 247.
(*f*) Ind. L. R. 6 Mad. 108.
(*g*) In *American Solid Leather Button Co.* v. *Anthony*, 15 R. I. 338.
(*h*) *In re English*, U. S. Pat. Comm. Decis. 1870, 142.

Deceptive marks.

Again, a trade mark which contains false representations, so as to deceive the public, will not be protected in equity as a valid trade mark (*a*), and cannot be registered as such under the Trade Marks Act, 1905 (*b*). In short, as was said by Wallace, J., in *Ginter* v. *Kinney Tobacco Co.* (*c*), "no principles are better settled in the law of trade marks than that a generic name, or a name merely descriptive of the ingredients, quality, or characteristics of an article of trade, cannot be the subject of a trade mark; and that the use of a name or term which is likely to deceive the public in reference to the components or nature of the article to which it is applied will not be tolerated." But mere collateral misrepresentations do not disqualify (*d*).

Marks which are either descriptive or deceptive.

An attempt has occasionally been made to meet the contention that a word claimed as a trade mark is incapable of appropriation by reason of its descriptiveness, by the allegation that the goods to which it is applied do not answer the description imported by the word, and therefore that the word is not, in fact, descriptive of the goods. But in cases where a word is used which is descriptive of qualities which the goods might reasonably be supposed to possess, if the goods do not possess those qualities the use of the word is deceptive, so that *quâcunque viâ* the claim fails. Thus, in *In re Saunion & Co.* (*e*), Sir G. Jessel, M.R., refused registration to the words "Anglo-Portugo Oysters," on the ground that if the oysters were Anglo-Portuguese the use of the term was descriptive, while, if they were not, it was deceptive. And the same view was adopted by Lopes, L. J., in *In re Van Duzer* (*f*). There are many American authorities to the same effect (*g*). But if the term claimed is one which is notoriously inappropriate to the

(*a*) *Pidding* v. *How*, 8 Sim. 477; *Perry* v. *Truefitt*, 6 Beav. 66; *Flavel* v. *Harrison*, 10 Hare, 467: *Leather Cloth Co.* v. *American Leather Cloth Co.*, 4 De G. J. & S. 137; *Morgan* v. *McAdam*, 36 L. J. Ch. 228; *Lewis's* v. *Goodbody*, 67 L. T. N. S. 194; *In re Hill*, 10 P. R. 113.

(*b*) See § 11, and *In re Edge*, 8 P. R. 207.

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

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

(*e*) Dig. 625.

(*f*) 34 Ch. D. 631. See the observations of Moulton, L.J., in *In re Orlwoola, Ld.*, 26 P. R. 850, and compare *Free Fishers & Dredgers of Whitstable* v. *Elliott*, W.N. 1888, p. 27; and see *In re Hanmay*, 7 P. R. 46; *In re Edge*, 8 P. R. 207; *Parsons* v. *Gillespie*, 17 N. S. W. R. (Eq.) 227; (1898) A. C. 239; *Wolff* v. *Nopitsch*, 18 P. R. 27; *Peak, Frean & Co.* v. *Carr & Co.*, Cape Good Hope, 15 S. C. R. 172.

(*g*) *E.g.*, *In re American Sardine Co.*, 3 U. S. Pat. Gaz. 495 ("American Sardines"); *Ex parte Marsching & Co.*, 15 *ib.* 294 ("French" paints); *Ex parte Knapp*, 16 *ib.* 318 ("London" animal foods); *Ginter* v. *Kinney Tobacco Co.*, 12 Fed. Rep. 782 ("Straight-cut" cigarettes).

article, it will not be treated as deceptive. Thus the name "Edelweiss" was allowed to be appropriated to scent not derived from that flower, it being well known that the edelweiss yields no perfume (*a*).

Extravagance an advantage in word trade marks.

It may be stated as a general rule that the more extraordinary and extravagant the name that is adopted by way of trade mark, the better will the object be attained, and the protection of the Courts and of the Registration Office secured; for the more uncommon the designation is, the less obnoxious is the exclusive claim of the manufacturer; and the more conclusive the evidence of fraud supplied by an infringement. Thus, Wood, V.-C., said, "I have not the least doubt that if the plaintiff (if I doubted I should be going quite contrary to the Mexican Balm case and other cases in which ridiculous names have been used) had invented a fanciful and ridiculous name—and the more ridiculous, the better it is for his purpose—and had used it for eight or ten years in his trade, the Court would take care that nobody else should use that absurd name; for such user could only be a user for the express purpose of imitating the plaintiff's, and so defrauding the plaintiff, by representing goods manufactured by one person to be goods manufactured by another" (*b*).

Words specially invented.

In many cases the word used as a trade mark is an entirely new word, invented for the occasion by the manufacturer of the material or composition to which it is applied, and such a name may be registered and otherwise treated as a valid trade mark (*c*). Thus "Pectorine" (*d*) and "Lactopeptine" (*e*) have been protected as names for medical compounds; "Solio" for photographic paper (*f*); "Kodak" for cameras and accessories (*g*); "Tachytype" for typographical machines (*h*). "Chlorodyne" (*i*) was only not protected because the proprietor, on a mistaken view of his rights, consented to have his bill for an injunction dismissed with costs. Invented words were, however, occasionally refused registration as "fancy words" under § 64

(*a*) *Rosing* v. *Atkinson*, 27 Sol. J. 534. And see *In re Densham*, (1895) 2 Ch. 176.

(*b*) *Young* v. *Macrae*, 9 Jur. N. S. 322.

(*c*) See T. M. Act, 1905, § 9. replacing Patents Act, 1883, § 64, as amended by the Act of 1888.

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

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

(*f*) *In re Eastman Co., Ld.*, (1898) A. C. 571.

(*g*) *Eastman Co., Ld.* v. *Griffiths Corporation, Ld.*, 15 P. R. 105; *In re Kodak, Ld.*, 20 P. R. 337.

(*h*) *In re Linotype Co., Ld.*, 17 P. R. 380.

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

of the Act of 1883, where they were considered to suggest a description of the article—*e.g.*, "Washerine" soap (*a*), "Monobrut" champagne (*b*); and Jessel, M. R., treated "Valvoline" oil as descriptive (*c*), though Lord Selborne (*d*) and a United States circuit judge (*e*) have thought differently.

Existing words composing a word trade mark.

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

Inscriptions or advertisements.

Occasionally it has been sought to protect as a trade mark, and to claim exclusive rights in, an inscription or advertisement composed of ordinary English words, used in their ordinary sense, and only peculiar from the length of the sequence. Usually, indeed,

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

(*b*) *In re Vignier*, 6 P. R. 490. See also *Christy* v. *Tipper*, 21 P. R. 97, 755, ("Absorbine").

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

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

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

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

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

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

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

(*k*) *Field* v. *Lewis*, Dig. 280; *Marcovitch* v. *Bramble, Wilkins & Co.*, Dig. 595 ("Vanity Fair" cigarettes); *Davis* v. *Kennedy*, 13 Grant Up. Can. Ch. 523 ("Pain-Killer" medicine); *Crawford* v. *Shuttock*, 13 Grant Up. Can. Ch. 149 ("Imperial" soap); *Degraves* v. *Whiteman*, 5 V. L. R. Eq. 304 ("Cascade" ale); *Weston* v. *Hemmons*, 2 V. L. R. Eq. 121 ("Wizard" oil); *Kidd* v. *Johnson*, 100 U. S. 617 ("Magnolia" whiskey); *Faber* v. *Hovey*, Dig. 481 ("Star" pencils).

there is in such cases some feature which might be really distinctive but of which the plaintiff, for some reason or other, is unable to avail himself; this failing, the whole inscription is claimed. Such cases, however, are in fact "advertisements of the character and quality of the goods" (*a*), in which advertisements no exclusive rights can be claimed, as was expressly decided by the Court of Appeal in *Cheavin* v. *Walker* (*b*), where the inscription was "G. Cheavin's improved patent, gold-medal, self-cleaning, rapid water filter, Boston, England," the name Cheavin having become indicative of a principle of construction. In *Shrimpton* v. *Laight* (*c*), the use of the words "graduated, grooveless, drill-eyed, ground-down" needles was also accompanied by that of the maker's name, and this being obviously imitated by the defendant, the injunction was granted.

Words taken from the dead languages.

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

Or from modern foreign languages.

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

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

(*b*) 5 Ch. D. 850. And see *Blackwell* v. *Crabb*, 36 L. J. Ch. 504; *S. T. Midgley & Sons, Ld.* v. *Morris & Cowdery*, 21 P. R. 314 ("Fair-wear or a free pair," as applied to boots); *Wertheimer* v. *Stewart, Cooper & Co.*, 23 P. R. 481, where a novel and peculiar scheme of advertising was copied by the defendants. Compare *Walter* v. *Ashton*, (1902) 2 Ch. 282; also *Lever* v. *Goodwin*, 4 P. R. 492.

(*c*) 18 Beav. 164.

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

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

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

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

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

(*i*) *Grillon* v. *Guénin*, W. N. 1877, p. 14. And see *Caruncho* v. *Stephenson*, 25 Sol. J. 929 ("Intimidad" cigars); *Holt* v. *Menendez*, 128 U. S. 182 ("La Favorita" flour); *Rey* v. *Lecouturier*, 25 P. R. 265; 27 *ib.* 268 ("Chartreuse" liqueur).

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

of a pun, was held to be entitled to registration as a good trade mark, though the Commissioners of Patents had directed the registrar to the contrary.

Foreign words in their ordinary signification.

When, however, the foreign words are used in their ordinary sense, or in a sense not widely remote therefrom, the case is different. In *Gout* v. *Aleploglu* (*a*), the plaintiff was a maker of watches for the Turkish market. These watches he marked in Turkish with his own name (Ralph Gout) with the word "Pessendede" ("warranted"), with his initials "R. G." and a crescent, and also with a sprig and crescent. The defendant procured watches to be made, in which the minor features of the marks used by the plaintiff were omitted, but in which the main characteristics, the name ("Ralph Gout") and the word "Pessendede," in Turkish characters, were reproduced, the style of engraving being copied. Such watches were then sent by the defendant to Constantinople, and there sold, to the prejudice of the plaintiff's business. This was a clear case of fraud, and so it was held to be by the Vice-Chancellor of England, Sir L. Shadwell, who, however, did express an opinion that the plaintiff had acquired an exclusive right in the word "Pessendede" (*b*). But the point that had to be decided was not simply whether the word "warranted," in Turkish, could be protected; and, indeed, when it is considered that the watches were to be sold in Turkey, the case does seem to be just the same as if the word had been engraved in English on watches to be sold in this country, when such a proposition would be clearly untenable. But not only the word, but the manner of engraving it was copied, and not only that word, but the name of the maker; and what the Vice-Chancellor actually decided was that here there was a clear case of attempted fraud, which was quite sufficient ground for the issue of an injunction, without its being necessary to consider whether the imitation of one single feature would have been sufficient to entitle the plaintiff to that remedy. The use of the name "Ralph Gout" alone by the defendant, whose own name was entirely different, would indeed have been sufficient to entitle the plaintiff to an injunction (*c*), but the case with respect to "Pessendede" was different.

Gout v. *Aleploglu.*

Broadhurst v. *Barlow.*

In *Broadhurst* v. *Barlow* (*d*), the case was again a far more

(*a*) 6 Beav. 69; 5 Leg. Obs. 496.
(*b*) 5 Leg. Obs. 496.
(*c*) See *per* Sir G. Turner, L. J., in *Burgess* v. *Burgess*, 3 De G. M. & G. 896; *Perks* v. *Hall & Co.*, W. N. 1881, p. 111.
(*d*) W. N. 1872, p. 212; and L. J.

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

Conclusion.

The true principle appears to be that, while foreign words employed in their ordinary signification may, even when used on goods intended for consumption in the country where that foreign language is spoken, form a part of a combination trade mark, the infringement of which will be restrained, the exclusive use of such words themselves, apart from fraud, will not be protected in this country, any more than that of an ordinary English adjective (*b*).

Geographical names.

Under the head of "distinctive words" should be included trade marks consisting of geographical names. Prior to the Act of 1905 it was indispensable, if registration of such a name was desired, to prove user as a trade mark before August 13th, 1875, for such words were not allowed to be registered as new marks. This was so under the Act of 1875, because that Act did not allow any mere words to be registered as new marks (*c*); under

N. of C. 1872, p. 183. There have been numerous unreported cases with reference to cotton goods to the same effect.

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

(*b*) This was so laid down with respect to words claimed as fancy words under the Patents Act, 1883, § 64, by Chitty, J., in *In re Davis & Co.*, 6 P. R. 207 ("Bokol" beer).

(*c*) Trade Marks Act, 1875, § 10.

the Act of 1883, because the construction placed on the term "fancy word" was such as to exclude geographical names (*a*); under the Act of 1888, because such names were expressly excluded from registration as new marks (*b*). Under the Act of 1905 geographical names may be registered on a special application under sect. 9 (5) if the Board of Trade or the Court allows the application to proceed (*c*). But it seems that where a geographical name has been used *per se* as a trade mark before August 13th, 1875, and is not in common use, it may be recognised as a "special and distinctive" word (*d*). When geographical names are used as trade marks they are in that application to be understood, not as ascribing the goods to which they are affixed to any special section of the earth's surface, but as expressing the works at which, or the manufacturer by whom, those goods have been produced. So Wood, V.-C., in the "Anatolia" liquorice case (*e*), said that "the plaintiffs had established beyond all doubt the connection of their name with that mark, that was beyond dispute," and that "he could not treat the word as being otherwise than a designation mark, which the plaintiffs had caused to be attached to that particular article of liquorice which they so manufactured, and which they had a right to consider, in that qualified sense, property." Lord Westbury, C., in that case strongly confirmed the opinion of the Vice-Chancellor; and in the later case of *Wotherspoon* v. *Currie* (*f*), where

(*a*) *In re Van Duzer*, 34 Ch. D. 623 ("Melrose Favourite Hair Restorer"); *In re Ainslie & Co.*, 4 P. R. 212 ("Ben Ledi" whiskey); *In re Laing*, L. J. N. of C. 1887, p. 102 ("Glengowrie Blend of Fine Old Highland Whiskey"); *In re Thompson & Co.*, 6 P. R 213 ("Manor" tin plates) (as to which see *Pinto* v. *Badman*, 8 P. R. 181, 188, 191); *Great Tower Street Tea Co.* v. *Smith*, 6 P. R. 165 ("Tower Tea"); *In re Batt & Co.*, 6 P. R. 493 ("The Brymbo Special" iron goods); *Hodgson* v. *Sinclair*, 9 P. R. 22 ("Britannia" soap).

(*b*) Patents Act, 1888, § 10.

(*c*) *In re Apollinaris Brunnen*, (1907) 2 Ch. 178 ("Apollinaris"); *In re National Starch Co.*, (1908) 2 Ch. 698 ("Oswego"); *In re California Fig Syrup Co.*, 26 P. R. 846 ("California Syrup of Figs").

(*d*) See *In re Van Duzer*, 34 Ch. D. 623 (*per* Cotton, L. J.); *Compania General de Tabacos* v. *Rehder*, 5 P. R. 61 ("Cavite" cigars); *Evans* v. *Smith*, 3 Times L. R. 390 ("Montserrat" lime juice); *Thompson* v. *Montgomery*, 41 Ch. D. 35; (1891) A. C. 217.

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

(*f*) L. R. 5 H. L. 508. See also *Thompson* v. *Montgomery*, 41 Ch. D. 35; (1891) A. C. 217 ("Stone Ales"); *Huntley & Palmer* v. *Reading Biscuit Co.*, 10 P. R. 277 ("Reading" biscuits); *Powell* v. *Birmingham Vinegar Brewery Co.*, (1896) 2 Ch. 54; (1897) A. C. 710 ("Yorkshire Relish"); *Saxlehner* v. *Apollinaris Co.*, (1897) 1 Ch. 893 ("Hunyadi" water); *Bewlay & Co.* v. *Hughes*, 15 P. R. 290 ("Dindigul" cigars); *In re Clement & Cie.*, (1900) 1 Ch. 114 (Vin de "St. Raphael"); *Worcester Royal Porcelain Co., Ld.* v. *Locke & Co.*, 19 P. R. 479 ("Worcester" china). And see *Reddaway* v. *Banham*, (1896) A. C. 199;

the subject of dispute was the word "Glenfield" applied to starch, he stated that that word had acquired a secondary signification or meaning in connection with a particular manufacture: in short, it had become the trade designation of the starch made by the appellants. It was wholly taken out of its ordinary meaning, and in connection with starch had acquired that peculiar secondary signification to which he had referred. The word "Glenfield," therefore, as a denomination of starch, had become the property of the appellants. It was their right and title in connection with the starch.

Rules as to geographical names.

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

Rockingham Rail. Co. v. *Allen*, 12 Times L. R. 345; *Rose* v. *McLean Publishing Co.*, 24 Ont. App. R. 240.

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

(*b*) *Hine* v. *Lart*, 10 Jur. 106. And see *In re Clement & Cie.*, (1900) 1 Ch. 114 (Vin de "St. Raphael").

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

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

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

(*f*) *Radde* v. *Norman*, L. R. 14 Eq. 348. And see *Apollinaris Co.* v. *Edwards*, Seton, 6th ed., 626; and *Apollinaris Co.* v. *Norrish*, 33 L. T. N. S. 242 ("Apollinaris Water"); *Lea* v. *Millar*, Dig. 513 ("Worcestershire Sauce"); *Powell* v. *McNully*, Dig. 526, and *Powell* v. *Birmingham Vinegar Brewery Co.*, (1896) 2 Ch. 54: (1897) A. C. 710 ("Yorkshire Relish"); *Siegert* v. *Findlater*, 7 Ch. D. 801 ("Angostura Bitters"); *Kinney* v. *Basch*, Dig. 542 ("St. James's Cigarettes"); *Wheeler* v. *Johnston*, 3 L. R. Ir. 284 ("Cromac Springs"); *Davis* v. *Tylor*, Jessel, M. R., April 24th, 1879 ("Ferndale" coal); *Lochgelly Co., Ld.* v. *Lumphinnans Iron Co.*, Ct. Sess. Cas. 4th Ser. VI. 482 ("Lochgelly" coal); *Blair* v. *Stock*, 52 L. T. N. S. 123 ("Strathmore" whiskey); *Grezier* v. *Autran*, 13 P. R. 1 ("Chartreuse" liqueur); *Saxlehner* v. *Apollinaris Co.*, (1897) 1 Ch. 893 ("Hunyadi" water); see *Wolff* v. *Nopitsch*, 18 P. R. 27; *Rey* v. *Lecouturier*, (1908) 2 Ch. 715.

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

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

McAndrew v. *Bassett*.

Again, in *McAndrew* v. *Bassett* (*c*), Lord Westbury, C., said "I am told that the word 'Anatolia,' being a general geographical expression—being, in point of fact, the geographical designation of a whole country—is a word common to all, and that in it, therefore, there can be no property. That is nothing in the world more than a repetition of the fallacy which I have frequently had occasion to expose. Property in the word for all purposes cannot exist; but property in that word, as applied by way of stamp upon appropriated (*g*), and that anyone who manufactures at a place

Portland Cement Co. v. *Rugby & Newbold Portland Cement Co.*, 8 P. R. 241; 9 P. R. 46; *Whitstable Oyster Fishery Co.* v. *Hayling Fisheries, Ld.*, 17 P. R. 461; 18 P. R. 434; *Elgin National Watch Co.* v. *Illinois Watch Case Co.*, 179 U. S. 665.

(*a*) Thus, in *Braham* v. *Beachim* (1), 7 Ch. D. 848, an injunction was only granted to restrain the defendants from describing their coal as "Radstock" until they had some justification for so describing it, and when that justification could be produced, no relief was granted against them. And so in *Free Fishers & Dredgers of Whitstable* v. *Elliott*, W. N. 1888, p. 27. But this course was not taken in *Thompson* v. *Montgomery*, 41 Ch. D. 35; (1891) A. C. 217, *q. v.* See *Braham* v. *Beachim* (2), Dig. 633; *Siegert* v. *Findlater*, 7 Ch. D. 801; *Bewlay & Co.* v. *Hughes*, 15 P. R. 290; *Grand Hotel Co. of Caledonia Springs, Ld.* v. *Wilson*, (1904) A. C. 103; *Van Zeller* v. *Mason, Cattley & Co.*, 25 P. R. 37; *Helidon Spa Water Co.* v. *Hamlyn Spa Water Co.*, 29 V. L. R. 182.

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

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

the market so stamped, and obtains acceptance and reputation in the market, whereby the stamp gets currency as an indication of superior quality, or of some other circumstances that render the article so stamped acceptable to the public."

Words disentitled to protection.

In addition to deceptive words, no other words, the use of which would be deemed disentitled to protection in a court of justice, can be registered (*a*). This prohibition excludes three classes of words, the first consisting of such as ascribe to the goods some characteristic which they do not possess (*b*), the second of such as are objectionable on the ground of irreverence or immorality (*c*), and the third of such as would cause confusion with the goods of another firm (*d*).

Letters and figures.

The provision inserted in favour of old marks in § 9 of the Trade Marks Act, 1905, replacing § 64 of the Patents Acts, 1883—1888, also includes "any special or distinctive letter, numeral (*e*), or combination of letters or numerals, used as a trade mark before August 13th, 1875." It will be observed that the wording of this part of the section differs considerably from that of the corresponding part of § 10 of the Registration Act, 1875, the object being to bring all old trade marks composed of letters, numerals, or combinations within the scope of the provisions for registration, an object which the original section had failed to achieve (*f*).

Letters.

Letters, generally in the form of initials, have, with or without additions, frequently been treated as trade marks. Among the earliest of these cases are *Molley* v. *Downman* (*g*) and *Millington* v. *Fox* (*h*); in the first of which cases "M. C.," and in the second "J. H.," was branded on iron. Still earlier than these cases, in the year 1834, "H. H. 6" formed part of a trade mark protected by injunction (*i*). In *Crawshay* v. *Thompson* (*k*), "W. C." in an oval was employed, and infringement being alleged through the

(*a*) See T. M. Act, 1905, § 11, replacing Patents Acts, 1883—8, § 73.

(*b*) *E.g.*, the word "Worcester" as applied to American goods: *In re Royal Worcester Corset Co.*, 26 P. R. 185.

(*c*) *E.g.*, the words "Elijah's Manna" refused by the Board of Trade: *In re Postum Cereal Co.*, Nov. 12th, 1906.

(*d*) *E.g.*, "Fruit Salt" (*Eno* v. *Dunn*, 15 A. C. 252); "Motricine" (*In re Compagnie Industrielle des Petroles*, 24 P. R. 505); and see *In re Albert Baker & Co., Ld.*, 25 P. R. 513, at p. 525.

(*e*) In the earlier Acts the word was "figure." See *Ex parte Stephens*, 3 Ch. D. 659.

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

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

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

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

(*k*) 4 M. & G. 357.

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

(*a*) 15 Ir. Ch. 75.
(*b*) 3 My. & Cr. 1.
(*c*) 3 My. & Cr. 338.
(*d*) *Hopkins* v. *Hitchcock*, 14 C. B. N. S. 65.
(*e*) *Hall* v. *Barrows*, 4 De G. J. & S. 150; *Barrows* v. *Pelsall Coal & Iron Co.*, Dig. 530.
(*f*) *In re Barrows*, 5 Ch. D. 353.
(*g*) *Cartier* v. *Carlile*, 31 Beav. 292; *Cartier* v. *Westhead*, Dig. 199; *Cartier* v. *May*, Dig. 200.
(*h*) *Moet* v. *Clybouw*, Dig. 533; *Moet* v. *Pickering*, 8 Ch. D. 372.
(*i*) See *Ex parte Young*, Dig. 537 ("L. H. & S."); *Carver* v. *Bowker*, Dig. 581 ("R. H."); *Ransome* v. *Graham*, 51 L. J. Ch. 897 ("R. N."); *Bayer* v. *Connel* (2), 16 P. R. 157; *Aërated Bread Co*, *Ld.* v. *Aërated Bakeries* (*Manchester*), *Ld.* ("A. B. C."), Eady, J., Oct. 22nd, 1909; Neville, J., Nov. 20th, 1909; *Maréchal* v. *McColgan* ("G. B. D."), 18 P. R. 262; *Birmingham*