

**Conclusion.** In the result, while letters used as a trade mark for the first time since the Act of 1875 must, if sought to be registered under the Acts prior to that of 1905, have been combined with some distinctive feature (*a*), it seems clear that, if used as such before the Act of 1875, they would, even standing alone, have been entitled to protection, though probably not as against persons having them for their initials and using them without fraud (*b*). Now letters can be registered, if distinctive, without any special application to the Board of Trade or the Court, under § 9 (5) of the Act of 1905 (*c*). But this does not apply to cotton marks (*d*).

**Single letters.** The Trade Marks Registration Act of 1875, § 10, only authorised the registration of letters by the use of the term "any special and distinctive combination of figures or letters"; and in *In re Mitchell* (1) (*e*), Hall, V.-C., felt himself compelled to hold that a single letter, however long and exclusively used by an applicant for registration, was not within the section, and was incapable of registration. Now, however, the wording of the present Act, as did that of the Patents Acts, 1883-8, permits in express terms the registration of a "letter" as an old mark, so that the difficulty is removed. And, further, the present Act permits its registration as a new mark. But in either case the letter will, of course, have to be proved to be special or distinctive. In America, the single letter "D" in a lozenge has been admitted to registration (*f*), notwithstanding the decision in *Ferguson v. Davol Mills* (*g*) with respect to the letter "K" enclosed in circular lines—a decision which appears to have been founded on the mistaken interpretation of the expressions used in *Amoskeag Manufacturing Co. v. Spear* (*h*), previously referred to. So in

*Small Arms Co., Ltd. v. Webb & Co.*, 24 P. R. 27 ("B. S. A."); *In re Birmingham Small Arms Co., Ltd.*, 24 P. R. 563; *A. Boake, Roberts & Co., Ltd. v. Wayland* ("K. M. S."), 26 P. R. 251; *Provident Chemical Works v. Canada Chemical Co.*, 4 Ont. L. R. 545; *Doran v. Hogadore*, 11 Ont. L. R. 321; *Bondier v. Depatie*, 3 Dorion, 233 ("G. B. D."). See also *In re Brook*, 26 W. R. 791; *Candee v. Deere*, 54 Ill. 439; *Amoskeag Manufacturing Co. v. Trainer*, 101 U. S. 51; *Frank v. Sleeper*, 150 Mass. 583; *Frankau v. Pope*, 11 Cape Good Hope, 209.

(*a*) See *Chas. Bayer & Co. v. Strauss*,

*Adler & Co.*, Cape Good Hope, 24 S. C. R. 27, a decision under a corresponding section in the Colonial Act.

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

(*c*) E.g., "B. S. A.": *In re Birmingham Small Arms Co.*, 24 P. R. 563.

(*d*) See T. M. A. 1905, § 64 (10) (*c*).

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

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

(*g*) 2 Brews. 314.

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

New South Wales a single letter may be registered as a trade mark (a).

In *Rosenthal v. Reynolds* (b), where a trader registered as a new mark a device with initial letters added, but disclaimed the right to the exclusive use of the added matter, it was held by North, J., that a rival trader could not be restrained on motion from using the same initials in a similar position upon similar goods as being calculated to deceive, but this case has been questioned in Scotland by the Lord President in *Bayer v. Baird* (c), and the latter view is now expressly recognised by the Trade Marks Act, 1905, s. 15, which provides that no disclaimer upon the register shall affect any rights of the proprietor of the trade mark other than such as arise out of the registration of the mark.

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

(a) *Hornsby v. Hudson*, 11 N. S. W. L. R. Eq. 148.

(b) (1892) 2 Ch. 301. Cf. *In re Loftus*, (1894) 1 Ch. 193; *Packham & Co., Ltd. v. Sturgess & Co.*, 15 P. R. 669. See Chapter 8, and *Reddaway v. Banham*, (1896) A. C. 199.

(c) 15 P. R. 615, 634.

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

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

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

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

(h) Dig. 542.

(i) 12 Fed. Rep. 696.

England (*a*), America (*b*) and India (*c*), in which the imitation of numbers has been restrained. In such cases, however, either the numerals have been parts of combination marks (*d*), or they have been printed in a special and distinctive colour and configuration (*e*), or they have been selected in so arbitrary a manner that they conveyed no idea of number (*f*), or there has been an evident intention to commit a fraud (*g*); and it is apprehended that if a case were to occur in which the plaintiff's numeral was printed in an ordinary style, and the defendant could show any reason for desiring to use the number in the course of his business, which was not necessarily attributable to a wish to appropriate the plaintiff's custom, no relief would be granted against him (*h*). Now a numeral, if proved to be distinctive, can be registered under the present Act as an old or new mark, and the registrar has allowed such registration to be effected (*i*). For cotton marks, however, no registration is to give any exclusive right to the use of a numeral (*k*). Apart from registration it is apprehended that the use of any number so as to pass off A.'s goods for B.'s will be restrained.

Combinations  
of letters and  
figures.

A special and distinctive combination of letters or numerals may also be recognised as an old mark (*l*), and though the con-

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

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

(*c*) *Ralli v. Fleming*, Ind. L. R. 3 Cal. 417. Cf. *Barlow v. Gobindram*, Ind. L. R. 24 Cal. 364.

(*d*) *Carrer v. Pinto Leite*, L. R. 7 Ch. 90; *Carrer v. Bowker*, Dig. 581; *Broadhurst v. Barlow*, W. N. 1872, p. 212; *Robinson v. Finlay*, 9 Ch. D. 487; *Boardman v. Meriden Britannia Co.*, 35 Conn. 402; *Lawrence Manufacturing Co. v. Lowell*, 129 Mass. 325; *Ralli v. Fleming*, Ind. L. R. 3 Cal. 417; *Humphreys'*

*Specific Homœopathic Medicine Co. v. Wenz*, 14 Fed. Rep. 250.

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

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

(*g*) *Gillott v. Kettle*, 3 Duer, 624; *Gillott v. Esterbrook*, 48 N. Y. 374; *Boardman v. Meriden Britannia Co.*, 35 Conn. 402; *Kinney v. Basch*, Dig. 542.

(*h*) See *Barlow v. Gobindram*, Ind. L. R. 24 Cal. 364.

(*i*) *E.g.*, the No. "40" has been registered by the Chillington Co. for hoes.

(*k*) T. M. A. 1905, § 64 (10) (c).

(*l*) Patents Acts, 1883-8, § 64; the words are not repeated, but may be implied in T. M. A. 1905, § 9 (5).

tention might possibly have been raised that this did not include a combination of one letter and one figure, as "A 1," or of several letters with one figure (*a*), or of one letter with several figures, the intention of the words is so obviously comprehensive that it does not appear likely that the contention could succeed. Under the present Act such a combination, if distinctive, can be registered even as a new mark.

This completes the list of trade marks specifically embraced within § 64 of the Patents Acts, 1883—1888 (*b*); but it is desirable to refer here to § 91 of the Patents and Designs Act, 1907, replacing §§ 103 and 104 of the Act of 1883, by which subjects or citizens of foreign states or British possessions to which those sections have been made applicable by Order in Council are entitled to certain privileges in the registration of trade marks; and it is provided that "any trade mark the registration of which has been duly applied for in the country of origin may be registered" under the Act. This provision contains no reference to the definition section, but that section says explicitly that "a registrable trade mark must contain or consist of at least one" of the specified essential particulars, so that it would appear that a foreign trade mark, whether actually registered or tendered for registration in the foreign country or not, ought not to be registered here unless the requirements of § 9 are satisfied, and this is, in effect, the result of the decisions under the former Acts (*c*). The contrary view would inflict great hardship on British subjects, seeing that in many foreign countries registration is regarded as a mere record of claim, conferring no rights, with the result that almost anything tendered for registration is registered there, so that to admit such marks to the British register would often confer a monopoly in the most ordinary English words.

In some cases protection has been granted to a combination of marks, taken as a whole, notwithstanding that some of the component marks were *publici juris* (*d*); but it has been held in

Trade marks under § 91 of the P. & D. Act, 1907.

Combination marks.

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

(*b*) For the special provisions of the T. M. A. 1905, see *infra*.

(*c*) *In re Carter Medicine Co.*, (1892) 3 Ch. 472. And see *In re Californian Fig Syrup Co.*, 40 Ch. D. 620.

(*d*) *Carrer v. Bowker*, Dig. 581; *Robinson v. Finlay*, 9 Ch. D. 487; *Pinto v. Badman*, 8 P. R. 181, 191; *In re Bradley*, 9 P. R. 205; and see *In re Smokeless Powder Co.*, (1892) 1 Ch. 590; *In re Clement & Cie.*, (1900) 1 Ch. 114. Cf. *In re Bryant & May, Ltd.*, 8 P. R. 69; *Pirie v. Goodall*, (1892) 1 Ch. 35.

America (*a*) and Victoria (*b*) that a combination of marks, none of which was capable in itself of forming a valid trade mark, could not be claimed. On the other hand, it has been held in Canada that words which separately are *publici juris* may in combination constitute a valid trade mark (*c*).

Certification marks.

An official stamp or brand can never become an ordinary private trade mark (*d*). But certification marks are now capable of registration under sect. 62 of the Act of 1905.

Colour.

It has been said in many cases that there can be no right of trade mark in the colour of wrappers, labels, &c.; but in the case of trade marks consisting of coloured threads in the border of a piece of stuff (*e*), or in the wick of a candle (*f*), or of the representation of a coin (*g*), the colour may form a material part of the mark, and such marks have been registered by deposit. Now colour may make a mark distinctive and qualify it for registration (*h*).

Price.

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

Shape of barrel, &c.

In America a particular shape of barrel, bottle, box, parcel, &c., containing goods is no trade mark for the goods contained in it (*k*); nor is the representation of such barrel, bottle, box, or parcel a trade mark for such goods (*l*), though the fraudulent imitation of it will be restrained (*m*). Nor is a mechanical convenience not used for purposes of identification, such as a strip of tobacco rolled round the mouthpiece of cigarettes (*n*),

(*a*) *In re Tolle*, 2 U. S. Pat. Gaz. 415. See *Corbin v. Gould*, 133 U. S. 308.

(*b*) *Wolfe v. Alsop*, 10 V. L. R. (Eq.) 41.

(*c*) *Smith v. Fair*, 14 Ont. Rep. 729 ("Red Seal" cigars); cf. *Pirie v. Goodall*, (1892) 1 Ch. 35.

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

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

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

(*g*) *In re Rolison*, 29 W. R. 31.

(*h*) T. M. A. 1905, § 10.

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

(*k*) *Moorman v. Hoge*, 2 Sawy. 78 (a barrel); *Harrington v. Libby*, 14 Bl. C. C. 128 (a collar box); *Sawyer v. Horn*, 4 Hughes, 239; *Ball v. Siegel*, 116 Ill.

137. See *In re Kane & Co.*, 9 U. S. Pat. Gaz. 105; *Manhattan Medicine Co. v. Wood*, 108 U. S. 218; *Hoyt v. Hoyt*, 143 Penn. St. 623; 24 Am. St. Rep. 575; *Babbit v. Brown*, 75 N. Y. Sup. Ct. 515; *Fischer v. Blank*, 138 N. Y. 244; *N. K. Fairbank Co. v. R. W. Bell Manufacturing Co.*, 77 Fed. Rep. 869; *Lafean v. Weeks*, 177 Pa. 412. Compare the English cases of *Ripley v. Griffith*, 19 P. R. 550; *J. B. Williams Co. v. H. Bronnley & Co.*, 26 P. R. 481; *J. B. Williams Co. v. J. B. Newbery & Son, Ltd.*, 26 P. R. 489.

(*l*) *Ex parte Halliday Brothers*, 16 U. S. Pat. Gaz. 500. Compare *James v. Parry*, L. R. 33 Ch. D. 392.

(*m*) *Cook v. Starkweather*, 13 Abb. Pr. N. S. 392, *et passim*. See cases collected *et passim* p. 155.

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

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

If a mark is in other respects a good trade mark, the fact that it is consumed with the article to which it is attached is no objection to its validity (l). Thus, a mark impressed on a cake of soap.

Mark may be consumed with the article.

Attention must lastly be directed to the special provisions of sect. 9 (5) of the Act of 1905, by which *any* distinctive mark can be registered, provided that if the mark consists of a name, signature, or word or words, other than such as are included in sect. 9 (1—4), the Board of Trade or the Court can be induced to make an order permitting the application to proceed. Under this provision many names and words have been permitted to proceed to registration on proof of their practical distinctiveness, notwithstanding that registration could not possibly have been allowed under any previous Act. In order for an application for the registration of a word to be brought within sub-sect. (5) of sect. 9 at all, the word must be one which is *primâ facie* descriptive in some degree, as otherwise it would come within sect. 9 (4) (m).

Any distinctive mark can be registered under T. M. A. 1905, § 9 (5).

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

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

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

(d) *Adams v. Heisel*, 31 Fed. Rep. 279.

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

(f) *Lorillard v. Pride*, 28 *ib.* 434.

(g) *Lorillard v. Wight*, 15 *ib.* 383.

(h) *Per Johnson, J.*, in *Fairbanks v. Jacobus*, 14 Bl. C. C. 337.

(i) *Lowell Manufacturing Co. v. Larned*, Dig. 428.

(k) *Ex parte Straiton & Storm*, 18 U. S. Pat. Gaz. 923.

(l) *In re Gordon*, 12 *ib.* 517. And see *Singer Manufacturing Co. v. Wilson*, 2 Ch. D. 441.

(m) See notes to § 9 (5) of the Act in Appendix A.

## CHAPTER III.

## ACQUISITION, TRANSFER, AND DISCONTINUANCE OF TRADE MARKS.

1. *Acquisition.*

Who may  
acquire.

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

Aliens.

A question has, however, been raised as to whether an alien was capable of acquiring a right to a trade mark, but when raised was at once finally decided by Wood, V.-C., in accordance alike with justice and expediency. The plaintiffs in *Collins Co. v. Cowen* (*b*), were an American firm of edge-tool manufacturers, whose trade marks appear to have been systematically infringed by English rivals. In the case in question the defendants, who had copied the plaintiffs' stamp of "Collins Co., Hartford, cast steel, warranted," demurred. The Vice-Chancellor overruled the demurrer, and observed in the course of his judgment, "I apprehend that every subject of every country, not being an alien enemy—and even to an alien enemy the Court has extended relief in cases of fraud—has a right to apply to this Court to have a fraudulent injury to his property arrested. And here the plaintiffs have the right—a right recognised, I imagine, everywhere in the world, or at least in every civilised community—of saying, 'We, being the manufacturers of certain goods, claim that another man shall not manufacture goods and put upon them our trade mark, and then pass them off as manufactured by us.' It would be most grievous if any Court should hold that there was an incapacity of affording relief in a case where a fraud has been com-

(*a*) See Interpretation Act, 1889, § 19, for definition of person, also § 1.

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

mitted upon a subject of any country. I speak, of course, of a fraud so far connected with property as to be not a shadowy but a substantial injury. If you use the name of another for the purpose of securing to yourself, in the disposition of property, advantages which belong to him, the fraud is complete, and the remedy ought to be complete, as in the case of a libel, where the action is allowed to a foreigner. I cannot in my own mind entertain the slightest misgiving in this case, whether it be new or not" (a).

When no goods bearing the foreign trade mark have been sold in this country, the trade mark can have acquired here no reputation for its foreign owner, so that it would appear doubtful whether the protection extended to foreign trade mark owners should be afforded in cases where there has been no user in this country, and the mark does not expressly state a foreign origin. In such a case the first person to use the mark in the United Kingdom is the first person to gain a reputation for it here (b). But foreign or colonial marks can be registered in England, and special provisions with regard to them are contained in § 91 of the Patents and Designs Act, 1907.

Where no user in England.

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

Sovereigns.

(a) See also *Collins Co. v. Brown*, 3 K. & J. 423; *Collins Co. v. Walker*, 7 W. R. 222; *Collins Co. v. Reeves*, 28 L. J. Ch. 56; *Howe v. McKernan*, 30 Beav. 547; *National Folding Box & Paper Co. v. National Folding Box Co.*, 43 W. R. 156; *La Société Anonyme des Anciens Etablissements v. Panhard et Levassor Motor Co., Ltd.*, (1901) 2 Ch. 513; *Grant v. Levitt*, 18 P. R. 361; *Rey v. Lecouturier*, 25 P. R. 265; 27 *ib.* 268. See also *Ebrahim Currim v. Fessa Abba Sait*, 24 Madr. 163. So in Scotland the trade marks or names of American manufacturers have been protected: *Singer Manufacturing Co. v. Kimball & Morton*, Ct. Sess. Cas. 3rd Ser. XI. 267. The same rule obtains in America: *Taylor v. Carpenter*, 3 Story, 458; *R. Cox*, 14; *Same v. Same*, 2 Wood. & M. 1; *R. Cox*, 32; *Same v. Same*, 11 Paige, 292; *R. Cox*, 45; *Coats v. Holbrook*, 2 Sandf. Ch. 586; *R. Cox*, 20; *Lemoine v. Ganton*, 2 E. D. Smith, 343; *R. Cox*, 142; *Lacroix v. May*, 15 Fed. Rep. 226. And the in-

fringement of a British trade mark has been criminally punished in Missouri: *State of Missouri v. Gibbs*, 56 Mo. 133. In India protection is afforded to British trade marks: *Orr-Ewing v. Chooneeloll Mullick*, Cor. 150; *Orr-Ewing v. Grant, Smith & Co.*, 2 Hyde, 185; and in Canada also the trade marks of aliens are protected: *Davis v. Kennedy*, 13 Grant, Up. Can. Ch. 523.

(b) See *In re Münch*, 50 L. T. N. S. 12; *In re Riviere & Co.*, 26 Ch. D. 48; *In re Leonard & Ellis*, *ib.* 288, *per* Fry, L. J.; *Berliner, &c. Tiroli v. Knight, Stocks & Co.*, W. N. 1883, p. 70; *Jackson & Co. v. Napper*, 35 Ch. D. 162; *Newman v. Pinto*, 4 P. R. 508, *per* Kekewich, J.; *Smith v. Fair*, 14 Ont. Rep. 729. See *In re Meus*, (1891) 1 Ch. 41.

(c) See *Ex parte King of Saxony*, Dig. 598; *Republic of Peru v. Reeves*, 40 N. Y. Super. Ct. 316; *La République Française v. Schultz*, 57 Fed. Rep. 37; *Ex parte South Carolina*, 64 U. S. Pat. Gaz. 1395.



Officials.

Agents.

A person in an official position, using an official stamp in his official capacity, cannot thereby acquire any private right therein (a). Nor can an agent acquire any interest in his principal's mark from the fact that he has used it (b); nor a printer in the trade mark of a mercantile firm from the fact that he has been employed to print it (c).

Certification marks.

But an association or person who undertakes the examination of any goods in respect of origin, material, mode of manufacture, quality, accuracy, or other characteristic, and uses a mark upon or in connection with the goods to certify the result of such examination, can now register such certification mark, with the permission of the Board of Trade (d).

Artisans.

In America the question has been much discussed whether the members of an artisans' trade society were entitled to claim an exclusive right in a label supplied by the society to its members, and affixed by them to goods manufactured by them, for the purpose of showing that such goods had been manufactured by members of the society. The objection which was raised to the claim was, that the members of the society did not manufacture or deal in the goods on their own account, but were merely workmen in the employment of various firms, whose product the goods were, and not that of the workmen, and that consequently the label was not distinctive of origin or ownership, and in some cases this objection has prevailed (e), but in other cases the decision has been in favour of the society, on the ground that its members were entitled to protection for the insignia which secured to them the benefit of their skilled labour (f); and although such labels may not be technically trade marks, they may be, and frequently are, protected in a similar manner by special legislation (g).

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

(b) *Hirsch v. Jonas*, 3 Ch. D. 584; *Heiniger v. Droz*, 25 Bom. 433; *Vadilal v. Burditt & Co.*, 30 Bom. 61; *Swift v. Peters*, 11 U. S. Pat. Gaz. 1110.

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

(d) T. M. A. 1905, § 62.

(e) *Ex parte Cigar Makers' Association*, 16 U. S. Pat. Gaz. 958; *Schneider v. Williams*, 44 N. J. Eq. 391; *Cigar Makers' Protective Union v. Conhaim*, 40 Minn. 243; 12 Am. St. Rep. 726; *McVey v. Brendel*, 144 Penn. St. 235; 27 Am. St. Rep. 625; *Weener v. Brayton*, 152 Mass. 101. And see *Ex parte Kuppen-*

*heimer*, 60 U. S. Pat. Gaz. 439; *State v. Bishop*, 128 Mo. 373; 49 Am. St. Rep. 569.

(f) *Strasser v. Moonelis*, 108 N. Y. 611; *Allen v. Macarthy*, 37 Minn. 347; *People v. Fisher*, 57 N. Y. Sup. Ct. 552; *Blaete v. Simon*, 19 Abb. N. C. 88; *Carson v. Ury*, 49 U. S. Pat. Gaz. 411; *Gravel Roofers' Exchange v. Turnbull*, 64 U. S. Pat. Gaz. 441. And see *Cohn v. People*, 149 Ill. 486; 41 Am. St. Rep. 304.

(g) *Cohn v. People*, 149 Ill. 486; 41 Am. St. Rep. 304; *State v. Bishop*, 128 Mo. 373; 49 Am. St. Rep. 569.

Such marks would probably now be treated in this country as certification marks, and be registrable under sect. 62 of the Act.

Where there were three bodies of professional accountants, incorporated respectively by Royal Charter as the Society of Accountants in Edinburgh, the Institute of Accountants in Glasgow, and the Society of Accountants in Aberdeen, and the members of these bodies habitually used the initials "C.A." (for "chartered accountant"), the members of another body of accountants, incorporated under the Companies Acts, and not by Royal Charter, as the Corporation of Accountants, Limited, were restrained by the Court of Session from using the same initials "C.A." (for "corporate accountant") (a). So in this country, where a society called the Society of Accountants and Auditors was incorporated in 1885 to provide a central organisation for accountants and auditors, and to elevate the status of the profession by establishing a system of examinations, and the members of the society had become known in business circles as incorporated accountants, and in 1905 a company called the London Association of Accountants, Limited, was incorporated with similar objects, an injunction was granted (1) against a member of the London association to restrain him from calling himself "incorporated accountant," either with or without the addition of the words "London Association of Accountants, Limited," and (2) against the association to restrain them from holding out that their members were entitled to use any such designation in such a way as to lead to the belief that their members were members of the older society (b).

Chartered accountants.

There was at one time a doubt as to the circumstances under which one person could acquire a sufficient right in a trade mark to be entitled to restrain another from infringing it. The right to redress being treated as founded on the defendant's fraud, it was thought that a plaintiff who claimed an injunction against a defendant ought to show that he (the plaintiff) had acquired for the mark indicating his manufacture such a reputation (c) as

Length of user formerly required.

(a) *Society of Accountants in Edinburgh v. Corporation of Accountants, Limited*, Ct. Sess. Cas., 4th Ser. XK. 750.

(b) *Society of Accountants and Auditors v. Goodway*, 24 P. R. 159. But in *Society of Architects v. Kendrick*, W. N. 1910, p. 113, the defendant was not restrained from using the letters "M.S.A.,"

which were used by members of the plaintiff society.

(c) In *Hine v. Lart*, 10 Jur. 106, Shadwell, V.-C. of England, thought that the imitation by a defendant of a plaintiff's trade mark afforded a presumption of that mark having acquired a reputation. And see *Dixon v. Jackson*,

would raise a presumption that the defendant in adopting a similar mark had done so with the intention of availing himself of that reputation to divert to himself the plaintiff's custom, or at all events that the plaintiff ought to show that he had used the mark long enough to render it probable that such a reputation had been acquired (a).

Latterly  
considered  
unnecessary.

But when it came to be recognised that there was a right of property in a trade mark, intentional fraud being unnecessary to justify restraint, it was at once seen that, as was stated by Romilly, M. R., "the interference of a Court of Equity could not depend on the length of time the manufacturers had used it" (b), but that "from the time of their commencing the user of their trade mark they became entitled to the protection of the Court against any other persons using the same, so that purchasers might be induced to purchase the goods of other persons as theirs" (c). "As soon as a trade mark has been so applied in the market as to indicate to purchasers that the goods to which it is attached are the manufacture of a particular firm, it becomes, to that extent, the exclusive property of the firm, and no one else has a right to copy it, or even to appropriate any part of it, if by such appropriation unwary purchasers may be induced to believe that they are getting goods which were made by the firm to whom the trade mark belongs" (d). There must, however, have been a real user (e).

Wrongful  
user gives no  
title.

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

Ct. Sess. Cas., 3rd Ser. V. 326, per the Lord Justice Clerk.

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

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

(c) Per Hall, V.-C., in *Cope v. Evans*,

L. R. 18 Eq. 138. And see *Orr-Ewing & Co. v. Grant, Smith & Co.*, 2 Hyde, 185. Compare the observations of Romer, L. J., in *Payton v. Snelling*, 17 P. R. 48, at pp. 54—5, with respect to get-up.

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

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

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

B.'s discontinuance, on account of the wrongful inception of his user (a).

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

Acquisition by common repute.

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

How property in a trade mark acquired.

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

The mark must be on a vendible article.

(a) *O'Rourke v. Central City Soap Co.*, 26 Fed. Rep. 576; *Parlett v. Guggenheimer*, 67 Md. 542. And see *In re Johnson*, 26 P. R. 195.

(b) 7 Ch. D. 801. And see *In re Barker & Son*, 53 L. T. N. S. 23; *Smith v. Woodruff*, 48 Barb. 438; *Rowley v. Houghton*, 2 Brews. 303; *Degraves v. Whiteman*, 5 V. L. R. Eq. 304; *Levy v. Waitt*, 61 Fed. Rep. 1008.

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

(d) 4 De G. J. & S. 380.

(e) Compare T. M. A. 1905, §§ 11, 19,

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

(f) Compare remarks of Lord Kingsdown in *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. C. 523.

(g) See chapter on "Infringement."

(h) L. R. 2 Ch. 307. And see *In re Verity*, 19 P. R. 56.

(i) And see per Willes, J., in *Lawson v. Bank of London*, 18 C. B. 84; also *Civil Service Supply Association v. Dean*, 13

expenditure during the course of manufacture in advertisements or other announcements to the public of the article so in course of manufacture could give any right in the mark or name by which it was intended that the article should be known when completed and in the market (a). Moreover, user must be as of a trade mark, and not as of a mere descriptive term (b).

Acquisition  
by registra-  
tion.

By the Trade Marks Registration Act, 1875, now repealed, a new manner of acquiring a right to a trade mark was introduced, and with respect to new marks substituted for the earlier method. By the Patents Acts, 1883—1888 (c), which took the place of the Act of 1875, no infringement of a registrable trade mark could be restrained or civilly punished, unless the mark had been registered. For five years after registration the fact of registration was to be *primâ facie* evidence of the right of the registered proprietor to the exclusive use of the trade mark (d), or, in other words, it qualified him for taking proceedings against infringers (e); after five years had expired from the date of registration, the fact of registration became conclusive evidence of his right to the mark (f) in any action brought by him (g), though the mark was still liable to removal from the register in proceedings taken for

Ch. D. 512; *In re Simpson, Davies & Sons*, Jessel, M. R., Jan. 12th, 1881; *Wheeler v. Johnston*, 3 L. R. Ir. 284; *Rowley v. Houghton*, 2 Brews. 303; R. Cox, 486; *Bowman v. Floyd*, 85 Mass. 76; *McLean v. Fleming*, 96 U. S. 245; *St. Louis Piano Manufacturing Co. v. Merkel*, 1 Mo. App. 305; *Avery & Sons v. Meikle & Co.*, 27 U. S. Pat. Gaz. 1027; *Yale Cigar Manufacturing Co. v. Yale*, 30 U. S. Pat. Gaz. 1183; *Schneider v. Williams*, 44 N. J. (Eq.) 391; *Jaeger's, &c. Co. v. Le Boutillière*, 54 N. Y. Sup. Ct. 521; *McCall v. Theal*, 28 Grant, Up. Can. Ch. 48; *William Rogers Manufacturing Co. v. Rogers & Spurr Manufacturing Co.*, 11 Fed. Rep. 495; *Sheppard & Co. v. Stuart & Peterson*, 13 Phila. 117. As to the difficulty of acquiring a right of trade mark in a name applied to a patented article, see p. 72, *ante*.

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

(b) *In re Leonard & Ellis*, 26 Ch. D. 288; *In re Harrison, McGregor & Co.*, 42 Ch. D. 691; *Richards v. Butcher*, (1891) 2 Ch. 522; *In re Powell*, (1893) 2 Ch. 398; (1894) A. C. 8.

(c) § 77. And see *Goodfellow v. Prince*, 35 Ch. D. 9; *Barlow & Jones, Id. v. Johnson & Co.*, 7 P. R. 395, 405, 411, which shows that the section merely enacts a condition precedent to suing, and does not prevent a plaintiff from recovering damages for infringements before registration: *Hargreaves v. Freeman*, (1891) 3 Ch. 39, 43; *Magnolia Metal Co. v. Atlas Metal Co.*, 14 P. R. 389.

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

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

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

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

that purpose, if it was registered wrongfully (*a*). Registration protected the trade mark in all sizes and in all colours, whether registered in colour (*b*) or not (*c*). In the case of trade marks in use before August 13th, 1875, application had to be made for registration, and if that was refused, a certificate of refusal could be obtained, which preserved to the applicant whatever rights he would have had independently of the Act (*d*).

Under the Trade Marks Act, 1905, the distinction between marks which have been on the register for five years and those which have been registered for a shorter period is removed, and, subject to the provisions of § 41 and to any limitations and conditions entered on the register, registration gives an exclusive right (*e*). But this does not operate as against persons who have used the mark from an earlier date than the registered proprietor (*f*). After seven years from the date of registration, the original registration has to be taken as valid, unless it was obtained by fraud or unless the mark offends against § 11 of the Act (*f*). In order for a certificate of refusal to be obtained, it has now to be proved, not only that the mark is an old mark, but also that an application for registration has been made under the present Act and refused (*g*). Registration does not interfere with any *bonâ fide* user of a name, address, or description of goods (*h*). But a "passing off" action may still be brought in any suitable case (*i*).

Under  
T. M. A.,  
1905.

In several cases under the earlier Acts (*k*) doubts were expressed whether a trade mark could be registered before it had been used, the doubt being founded on the old principle that a right in a trade mark could only be acquired by its being attached to vendible goods in the market, until which was the case user by others could lead to no deception; but these doubts were set at rest by

Registration  
before user.

(*a*) *In re Palmer* (1), 21 Ch. D. 47; S. C. (3), 24 *ib.* 504; *In re Leonard & Ellis*, 26 Ch. D. 288; *In re Lloyd & Sons*, 27 Ch. D. 646; *In re Wragg*, 29 Ch. D. 551; *Edwards v. Dennis*, 30 Ch. D. 454; *Wood v. Lambert*, 32 Ch. D. 247; *In re Spencer*, 54 L. T. N. S. 659; 3 P. R. 73; *In re Apollinaris Co.*, (1891) 2 Ch. 186; *In re Verity*, 19 P. R. 58. And so in Victoria: *Lewis v. Klapproth*, 11 V. L. R. 214; *Wolfe v. Alsop* (2), 12 V. L. R. (E.) 421; *Wolfe v. Lang & Co.*, 13

V. L. R. 752.

(*b*) See § 67.

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

(*d*) § 77.

(*e*) § 39.

(*f*) § 41.

(*g*) § 42.

(*h*) § 44.

(*i*) § 45.

(*k*) *In re Anderson*, 54 L. J. Ch. 1084; *Edwards v. Dennis*, 30 Ch. D. 354; *In re Lyndon*, 32 Ch. D. 109.

*In re Hudson* (a), where the Court of Appeal came to a clear decision that registration before user was allowable. It is now expressly provided that "a 'trade mark' shall mean a mark used or proposed to be used" (b). Where, however, it is proved that a mark which it is sought to register without prior user is not intended to be used by the applicant, but that the proposed registration is directed to a different end, registration will be refused (c). And if a mark has been registered, it can be removed from the register for non-user (d).

Goods  
classified.

A trade mark must be registered as belonging to particular goods or classes of goods (e), as arranged in the Third Schedule to the Rules; the class to which the goods belong being determined, in case of doubt, by the registrar (f). This requirement is no alteration of the rules of the pre-existing law, but is merely a statement of one of those rules as bearing upon registration under the Act. It had been already fully recognised that a particular trade mark could be protected as such only in connection with particular goods or classes of goods. Thus Lord Westbury, C., says, "Property in a trade mark is the right to the exclusive use of some mark, name, or symbol in connection with a particular manufacture or vendible commodity; consequently the use of the same mark in connection with a different article is not an infringement of such a right of property" (g). And again, "An iron-founder who uses a particular mark for his manufactures in iron could not restrain the use of the same mark when impressed upon cotton or woollen goods; for the property in a trade mark consists in the exclusive right to the use of that mark as applied to some particular manufacture" (h). And V.-C. Wood similarly says that "this Court has taken upon itself to protect a man in the use of a certain trade mark as applied to a particular description of article. He has no property in that mark, *per se*, any more than in any other fanciful denomination he may assume for his own private use, otherwise than with reference to his trade. If he does not carry on a trade in iron, but carries on a trade in linen,

(a) 32 Ch. D. 311.  
 (b) T. M. A., 1905, § 3.  
 (c) *In re Apollinaris Co.*, (1891) 2 Ch. 186, 234; *In re Batt & Co.*, (1898) 2 Ch. 432.  
 (d) § 37.

(e) § 8.  
 (f) Rule 5.  
 (g) *Leather Cloth Co. v. American Leather Cloth Co.*, 4 De G. J. & S. 137.  
 (h) *Hull v. Barrows*, 4 De G. J. & S. 150.

and stamps a lion on his linen, another person may stamp a lion on iron; but when he has appropriated a mark to a particular species of goods, and caused his goods to circulate with this mark upon them," his right to the mark so applied will be protected (a).

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

Limit of rights acquired by user.

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

New user of old mark may be infringement.

(a) *Ainsworth v. Walmsley*, L. R. 1 Eq. 518. And see *Singer Manufacturing Co. v. Wilson*, 2 Ch. D. 434, 443; *Merchant Banking Co. of London v. Merchants' Joint Stock Bank, Ltd.*, 9 ib. 560; *In re Lake & Elliott*, 20 P. R. 605.

(b) *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *Edwards v. Dennis*, 30 Ch. D. 451. And see *In re Braby & Co.*, 21 Ch. D. 223; also *In re Lyndon*, 32

Ch. D. 109, per Pearson, J.

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

(d) *In re English*, U. S. Pat. Comm. Decis. 1870, 142; *In re Dick & Co.*, 9 U. S. Pat. Gaz. 538; *George v. Smith*, 52 Fed. Rep. 830.

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



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

Wide registration, but limited user.

Again, though by § 75 of Patents Act, 1883, registration (c) of a trade mark was to be deemed to be equivalent to public use of the trade mark, it was held by the Court of Appeal that if a trader had registered a mark for a variety of goods, and had only used it in connection with some of them, he was not entitled to restrain the use by another trader of a somewhat similar mark in connection with the goods for which his mark had not been used (d). So also where a trade mark has been registered for a variety of goods, though it contains indications that it is only applicable to some of such goods, and it has only been used as registered in respect of such limited description of goods, it will not be protected in respect of other goods for which it is registered, even though the essential parts of it may have been used in respect of such other goods (e). Upon the same principle, where a mark registered for tobacco generally was used for cigars only, the consent of the owner to the registration of a similar mark by a rival trader for packet tobacco was held not to estop him from restraining an infringement of his mark in respect of cigars (f). In *Batt's case* (g) it was laid down by the Court of

(a) Dig. 636.

(b) 7 P. R. 183.

(c) Afterwards "application for registration," § 17 of the Patents Act, 1888.

(d) *Edwards v. Dennis*, 30 Ch. D. 454. Cf. *Phillips v. Ogden*, 12 P. R. 325.

(e) *Hargreave v. Freeman*, (1891) 3 Ch. 39.

(f) *Benedictus v. Sullivan, Powell & Co.*, 12 P. R. 25. See *Phillips v. Ogden*, 12 P. R. 325; *In re Banks & James*, 12 P. R. 333; *Freeman Bros. v. Sharpe Bros. & Co., Ltd.*, 16 P. R. 205.

(g) (1898) 2 Ch. 432.

Appeal that a man could not properly register a trade mark for goods in which he did not deal or intend to deal, meaning by intending to deal, having at the time of registration some definite and present intention to deal in certain goods, or descriptions of goods, and not a mere general intention of extending his business at some future time to anything which he might think desirable. This decision was affirmed by the House of Lords (a), and it is now provided by sect. 3 of the Trade Marks Act, 1905, that a trade mark must be "used or proposed to be used." Numerous marks have been removed from the register, or limited to certain goods, for non-user (b), and a special provision with respect to this is now to be found in sect. 37 of the Act.

Another question which has been raised, bearing on this point, is whether a mark which has been registered for some of the goods in a class can be protected for other goods in the class, as having been used in respect of them; and it appears that, having regard to § 8, by which a trade mark must be registered for particular goods or classes of goods, a trade mark which is registered only for particular goods in a class cannot be regarded as registered for other goods, whether in the same or a different class (c), or entitled to protection *quâ* trade mark in respect of such other goods; and in *Hart v. Colley* (d), North, J., decided in favour of the view here suggested. Passing off by means of imitation of an unregistered mark can, however, be restrained (e).

Mark only protected for goods for which registered.

By § 19 the registration of a mark identical with, or nearly similar to a mark already registered, is prohibited, not generally, but in connection with such goods or description of goods as those in respect of which the mark already on the register is registered. And, with a view to the protection of the public, this prohibition is extended over a period of one year after the removal of the mark once registered from the register for non-payment of a

Provisions in the Act of 1905.

(a) (1899) A. C. 428.  
 (b) *Edwards v. Dennis*, 30 Ch. D. 454;  
*In re Apollinaris Co.*, (1891) 2 Ch. 186;  
*In re Valentine Extract Co., Ltd.*, 18 P. R.  
 175; *In re Hart*, 19 P. R. 569; *In re Suter Hartmann & Rahtjen's Composition Co.*, 19 P. R. 42; *Anglo-Swiss Condensed Milk Co. v. Pearks, Gunston & Tee*, 20 P. R. 509; 21 P. R. 261; *In re Ralph*,

25 Ch. D. 194; *In re Ashton*, 48 W. R. 389; *In re Paine & Co., Ltd.*, 25 P. R. 329.

(c) See *Goodfellow v. Prince*, 35 Ch. D. 9; and *Richards v. Butcher* (1), 7 P. R. 288.

(d) 44 Ch. D. 193.

(e) § 45. And see *Jay v. Ladler*, 40 Ch. D. 649.

renewal fee, during which period of one year the removed mark in question is to be still deemed to be registered, unless disuser for two years is proved (*a*).

Steps necessary to obtain registration:  
The application.

A person desirous of having his trade mark registered must send an application to the registrar in the prescribed form (*b*), together with the prescribed number (*c*) of representatives (*d*) of the trade mark. When a representation cannot be given in the usual manner, a specimen or copy of the trade mark may be supplied instead (*e*). The application must state the particular goods or classes of goods in connection with which the applicant desires the trade mark to be registered (*f*). Words in other than Roman characters must have a translation supplied, and a translation may be required by the registrar in all cases of foreign words (*g*). Applications for registration in classes 23, 24, or 25, are to be sent to the Manchester Branch Office (*h*).

When mark is an old mark.

When the mark is claimed as an old mark—*i.e.*, a mark used before the passing of the Trade Marks Registration Act, 1875 (August 13th, 1875)—the facts as to such prior user are to be stated (*i*), and it is essential that the mark should be claimed and registered precisely in the form in which it has been used (*k*). In such cases a statutory declaration verifying the old user is not prescribed by rule, but the registrar is entitled (*l*) to require, and frequently does require, such a declaration to be made by some one acquainted with the facts, and the existence of such a declaration on the files of the office is rather advantageous to the proprietor of the trade mark. If such a declaration is called for, the facts which it must verify are that the mark applied for (which it is well to exhibit to the declaration) has, in the exact form shown, and by itself, been used as a trade mark by the applicant (and his predecessor in business, if so) within the United

(*a*) § 31.

(*b*) Form T. M. No. 2 in the Second Schedule to the Rules; or Form T. M. No. 5 if the application is a special one under § 9 (*h*); or Form T. M. No. 6 if the mark is a certification mark under § 62. See § 12 (1) and Rules 17—28, 35, 42, 43. The Rules now in force are the Rules of 1906.

(*c*) See Rules 21, 22. Applications for the registration of a series of marks under § 26 are governed by Rule 27.

(*d*) For form of Additional Represen-

tation, see Form T. M. No. 3.

(*e*) See Rule 26.

(*f*) § 8.

(*g*) Rule 28.

(*h*) § 64 (3).

(*i*) Rule 20.

(*k*) See p. 62, *supra*, and note (*g*) to § 64 of the Patents Act, 1883. Immaterial additions or alterations do not affect the claim to old user: T. M. A. 1905, § 9 (*h*).

(*l*) Rule 20.

Kingdom, in respect of the exact goods for which registration is sought, continuously since a specified date before the 13th day of August, 1875, and that save the said mark there did not appear upon the said goods, or upon the packages, &c. containing them, any device, words, numerals, letters, or other particulars whatsoever.

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

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

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

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

At the expiration of one month from the date of the advertisement, and subject to any proceedings which may have been taken, the registrar is, if satisfied of the applicant's title, to register the trade mark (*g*) as from the date of the application for registration (*h*), and upon registration is to issue a certificate thereof to the applicant with a reference to the advertisement (*i*). Registration.

If an applicant dies between application and registration the registration may be completed in the name of the successor to the goodwill of his business (*k*). In case of applicant's death.

In case of special applications under sect. 9 (5), the course of procedure is laid down by rules 42-6. The application is made Special applications.

- (*a*) Rule 17.
- (*b*) Rules 10, 17.
- (*c*) Rule 7.
- (*d*) Rule 9.
- (*e*) Rule 19.

- (*f*) Rules 47—50.
- (*g*) Rules 63, 64.
- (*h*) § 16.
- (*i*) Rule 67. See Form O. No. 2.
- (*k*) Rule 66.

to the registrar, who transmits it to the Board of Trade, with a report made by him thereon, a copy of which report is also sent to the applicant. Then a statement of case, setting out the grounds on which the application is supported, is submitted by the applicant to the Board of Trade, which usually calls for evidence in the form of statutory declarations. When this has been supplied the Board either passes the mark for registration at once, or gives the applicant an opportunity of being heard in support of it, or refers the application to the Court. If the application is allowed to proceed, by the Board of Trade or by the Court, as the case may be, the mark is advertised and the application proceeds in the usual way, and is open to opposition by any party interested (a).

Sheffield and  
Cotton  
marks.

Trade marks applied for in respect of goods within the Cutlers' Company's Acts (b) are governed by special rules (c); and so are marks on cotton goods, known as "cotton marks," which are dealt with at Manchester (d).

Series of  
marks.

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

Disclaimers.

Under the Patents Acts, additions which were common to the trade might be registered together with trade marks, but such common elements had to be disclaimed by the appellant (g). Disclaimers may still be called for, when needful (h), but under the present practice these are seldom required.

Alternative  
marks.

No provision is made in the British Acts for registering alternative marks, as has sometimes been done in America, e.g., where

(a) *E.g.*, *In re Crosfield*, 26 P. R. 561, 837.

(b) See Appendix K., *infra*.

(c) § 63 and Rules 107—112.

(d) § 64 and Rules 113—120.

(e) See § 9 as to essential particulars.

(f) § 26 and Rule 27. This practice is not new. See note (a) to § 66 of the Patents Acts, and note (c) to § 72 of the same Acts, *infra*.

(g) § 74 of Patents Acts. The prac-

tice of requiring common parts of marks or additions to marks to be disclaimed was not new. See *per* Jessel, M. R., in *In re Kuhn & Co.*, 53 L. J. Ch. 238; and *per* Kay, J., in *In re Hayward & Sons*, 54 L. J. Ch. 1003; and *In re Davies*, before Chitty, J., March 9th, 1885. Also notes to § 74 of the Patents Acts, and note (e) to § 72, *infra*. And it exists in America also: *Harris Drug Store v. Stucky*, 46 Fed. Rep. 624.

(h) § 15.

a trade mark was registered as consisting either of the figure of a lion, or the word "lion," or both (*a*). But the registration of a series of marks has to some extent the same effect, and in any case there is seldom any difficulty in registering alternative marks separately. If the mark is used for various goods, and the description of the goods appears in the mark in differing words, it may be registered with the name of one variety of goods inserted, but with a statement that the description varies (*b*).

Trade marks may now be registered in colour, and the effect of such registration is no longer to limit the protection conferred by registration to the one colour in which the registration has been effected, unless the applicant elects to limit his registration to one or more specified colours (*c*). Colour.

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

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

When, as frequently happens, a mark tendered for registration is objected to by the registrar, *e.g.*, on the ground that it does not

(*a*) *In re Weaver*, 10 U. S. Pat. Gaz. 1. And see *Ex parte Roth Grocery Co.*, 62 *ib.* 315; *Ex parte Kinney*, 72 *ib.* 1349; *Ex parte Lazarus, Schwarz & Lipper*, 64 *ib.* 1396.

(*b*) Rule 16.

(*c*) § 10 of the T. M. A. 1905; also § 67 of the Patents Acts.

(*d*) See Rule 26.

(*e*) § 12 (2).

(*f*) § 11.

(*g*) § 19.

(*h*) § 11.

(*i*) § 53, and Rules 31, 32.

(*k*) § 12 (3). See Rules 121—127.

(*l*) § 59. "The Court" is the High

come within the definition of registrable marks in § 9, or on the ground that it too closely resembles some other mark or marks already on the register (*a*), the proper course for the applicant to take, if he desires to persevere with the application, is to apply for a hearing before the registrar, who may, and frequently does, waive all or some of the objections raised to the registration. The application for a hearing must be made within one month after the objection is notified (*b*). If an appeal against an adverse decision is contemplated, it is imperative on the applicant to take a hearing before the registrar, in order that the case may be fully considered before it goes further (*c*).

Opposition to application.

Even if the registrar is willing to treat the application as unobjectionable, any person (*d*) may give notice of opposition at the Patent Office within one month or such further time as the registrar may allow, after the advertisement, and the applicant is then allowed one month for sending in a counter-statement, or the registrar may extend the time. If no such counter-statement is sent, the application is deemed to be withdrawn; if it is sent, the person giving notice of opposition will be furnished with a copy of it, and the registrar will then hear the case (*e*); but his decision is to be subject to an appeal to the Court or, with the consent of the parties, to the Board of Trade (*f*), who may, if it appears expedient, refer the appeal to the Court (*g*).

Limited registration.

In deciding whether registration is to be allowed or not, the Court has frequently granted the application in such a limited

Court of Justice (§ 3), the Chancery Division being no longer specified; but recourse is still had to that Division. In the case of applications at the Manchester Office "the Court" is the Lancaster Palatine Chancery (§ 71). When the registration is objected to on the ground that the mark tendered for registration is not qualified for registration, "the first duty cast upon the Court is to ascertain whether some one or more than one of the essential particulars of a trade mark, as defined by the Act, is found to exist, so that the mark may be described with the one or more than one essential particular or particulars which distinguish it." *Per* Lord Cairns, C., in *Orr-Ewing v. Registrar of Trade Marks*, 4 App. Cas. 484.

(*a*) § 19.

(*b*) Rule 31.

(*c*) Rule 122.

(*d*) It need not be the proprietor of a registered mark. In *In re Simpson, Davies & Sons* (2), Jessel, M.R., Jan. 12th. 1881, the proprietors of a trade mark registered for coal in Class 4 successfully opposed the registration of a similar mark for railway waggons in Class 22, the opponents' coal being carried in and sold out of waggons.

(*e*) The practice in such cases is prescribed by § 14, and Rules 51—61.

(*f*) § 14 (5).

(*g*) § 59. As to the old practice, see *Ex parte Stephens*, 24 W. R. 819; *In re Salamon*, Dig. 569; *In re Johnston*, 43 L. T. N. S. 672; *In re Simpson, Davies & Sons*, 15 Ch. D. 525. As to costs, see *In re Brandreth*, 9 Ch. D. 618; *In re Australian Wine Importers, Ltd.*, 41 Ch. D. 278.

form as to obviate the risk of its clashing with the mark which is considered to be resembled (*a*). Thus registration has been granted in such a form as to be partial in respect of the mark itself which is registered (*b*), or of the goods for which it is registered (*c*), or of the manner of user in respect of colour (*d*), or otherwise (*e*), or of the locality within which it is to be used (*f*), or of the persons against whom it is to be protected (*g*). In case of honest concurrent user the Court has now power to permit registration, subject to such conditions and limitations, if any, as to mode or place of user or otherwise, as it may think it right to impose (*h*).

Again, where each of several persons claims the same trade mark the registrar may refuse to register any of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by him or (on appeal) by the Board of Trade (*i*). Conflicting claims.

Subsequently to registration, the registrar has power to amend the registration in specified respects, on request, but not so as to extend the rights given by the existing registration (*k*). If he refuses, an appeal may be brought (*l*). Alteration of registered trade mark.

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

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

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

(*c*) See note to § 65 of the Patents Acts, *infra*. The registration should always be so limited: See *Edwards v. Dennis*, 30 Ch. D. 454; *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 Ch. D. 454; *In re Butt & Co.*, (1898) 2 Ch. 432; (1899) A. C. 428; *In re Suter, Hartmann & Rahtjen's Composition Co., Ltd.*, 19 P. R. 42; *In re Hart*, 19 P. R. 569; *In re Paine & Co., Ltd.*, 25 P. R. 329.

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

(*e*) See note (*e*) to § 72 of the Patents

Acts, *infra*; and *In re Whiteley*, 43 L. T. N. S. 627; *In re Sykes*, *ib.* 626; *In re Farina* (3), Dig. 654.

(*f*) *In re Rabone*, Dig. 643; *In re Keep Bros.*, 26 Ch. D. 187; *In re Mitchell & Co.*, 28 Ch. D. 666; *In re Johnson, Philpott & Co.*, North, J., Feb. 21st, 1888; *In re Steel*, Chitty, J., Jan. 12th, 1893. But registration with such limitations was later not regarded with favour: *In re Dechurst & Sons, Ltd.*, (1896) 2 Ch. 137.

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

(*h*) § 21.

(*i*) § 20.

(*k*) § 32. And see *In re Dechurst*, Jessel, M. R., June 11th, 1880, and cases collected in the note to sect. 92 of the Patents Acts.

(*l*) *E.g.*, *In re Carron Co.*, 27 P. R. 412.

(*m*) § 5. See *In re Mitchell & Co.* 28 Ch. D. 666; *In re De Otaduy*, L. J. N. of C. 1885, p. 155.



2. *Transfer.*

Assignment  
and transmis-  
sion.

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

Trade mark  
cannot be  
severed from  
goodwill.

Even apart from the Act, there is no doubt that the trade mark cannot be severed from and used independently of the goodwill. If that could be done, the *indicium* of genuineness might only serve to mislead. This view was clearly put by Lord Westbury, C., in the *Leather Cloth Companies' case* (d), when he suggested the case of a firm of clothiers in Wiltshire, trading as A. B. & Co. for fifty years, and acquiring a great reputation for their broad cloth marked "A. B. & Co. Wilts"; then, he asked, supposing A. B. & Co. to discontinue their business, and to sell the right to use the mark to C. D. & Co., clothiers in Yorkshire, would the latter be protected in equity in their claim to the exclusive use of the mark? and he answered the question in the negative. So in *Pinto v. Badman* (e), Fry, L. J., said: "By the English law, can a trader, who has used a brand upon a particular article, and who continues to manufacture that article, alienate that brand to another person, so as to give the alienee any right whatever? It appears to me that upon first principles he can have no such right. The brand is an indication of origin, and if you transfer the indication of origin, without transferring the origin itself, you are transferring a right, if any right at all, to commit a

(a) § 22. See *Massam v. Thorley's Cattle Food Co.*, 14 Ch. D. 748; *Ex parte Lawrence Bros.*, 44 L. T. N. S. 98; *In re Wellcome*, 32 Ch. D. 213; *In re Harness*, 17 P. R. 40; *In re Johnson*, 26 P. R. 195.

(b) *Per* Fry, L. J., in *Edwards v. Dennis*, 30 Ch. D. 454. If a trade mark registered in respect of an extensive class of goods is assigned together with the goodwill of a business concerned in some only of such goods, the assignment of the trade mark would

apparently be valid *pro tanto*.

(c) § 27.

(d) 4 De G. J. & S. 137. And see *Cotton v. Gillard*, 44 L. J. Ch. 90; *In re Harness*, 17 P. R. 40; *Ullmann v. Leuba*, 25 P. R. 673; *In re Johnson*, 26 P. R. 195; *Smith v. Fair*, 14 Ont. Rep. 729; *Gegy v. Bassett*, 3 Ont. L. R. 263; *In re Rowley & Pyne*, 9 V. L. R. (L.) 307.

(e) 8 P. R. 181, 194. And see *Thorneloe v. Hill*, (1894) 1 Ch. 569.

fraud upon the public, and such right is not recognised by the law of England."

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

In a case before the New York Court of Appeals (c), the expression was adopted that "a property in trade mark might be obtained by transfer from him who had made the primary acquisition, though it was essential that the transferee should be possessed of the right either to manufacture or sell the merchandise to which the trade mark had been attached." In another American case (d), the statement that the "property or right to a trade mark might pass by an assignment or by operation of law," was followed by this limitation, "to any one who took at the same time the right to manufacture or sell the particular merchandise to which the trade mark had been attached." And in the case of *Kidd v. Johnson* (e), the Supreme Court of the United States laid down that "as distinct property, separate from the article created by the original producer or manufacturer, a trade mark may not be the subject of sale. But when it is affixed to articles manufactured at a particular establishment, and acquires a special reputation in connection with the place of manufacture, and that establishment is transferred, either by contract or operation of law, to others, the right to the use of the trade mark may be lawfully transferred with it. Its subsequent use by the person to whom the establishment is transferred is considered as only indicating that the goods to which it is affixed are manufactured at the same place, and are of the same character, as those to which the mark was attached by its original designer." Same principle adopted in America.

It is possible that occasionally, though rarely, a trade mark may be so framed as not to be merely a simple indication of quality, or a guide to the place of manufacture, but to have the effect of ascribing the article to which it is attached to the personal skill or supervision of an individual. In such a case the question arises Personal trade mark.

(a) 19 W. R. 599.

(b) And see *Churton v. Douglas*, Johns. 174; *In re Roger* (2), 12 P. R. 149; *Currie v. Currie*, 15 P. R. 339; *Mitchell v. Joshua Bros.*, 17 V. L. R. 736.

(c) *Congress & Empire Spring Co. v.*

*High Rock Congress Spring Co.*, 45 N. Y. 291; R. Cox, 599.

(d) *Dixon Crucible Co. v. Guggenheim*, 2 Brews. 321; R. Cox, 559.

(e) 100 U. S. 617.

whether the trade mark, which when originally adopted contained no assertion which was incorrect, is capable of transfer to another person so as to enable him to apply it to his own goods and to prevent a similar use of it by others, the personal skill and supervision of its former proprietor having ceased to be applied. A striking example of a case of this kind is that relating to the "Chartreuse" liqueur, which was manufactured by the monks of the Order under a jealously-guarded secret (*a*).

Not assign-  
able.

The considerations which occur in cases where such a contention is set up are well stated by the Supreme Court of Massachusetts (*b*) in the following terms:—"There may, no doubt, be cases where the personal skill of an artist or artisan may so far enter into the value of a product that a trade mark bearing his name would, or at least might, imply that his personal work or supervision was employed in the manufacture; and in such cases it would be a fraud upon the public if the trade mark should be used by other persons, and for this reason such a trade mark would be held to be unassignable. . . . But, on the other hand, the usages of trade may be such that no such inference would naturally be drawn from the use of a trade mark which contains a person's name, and that all that purchasers would reasonably understand is that goods bearing the trade mark are of a certain standard, kind, or quality, or are made in a certain manner, or after a certain formula, by persons who are carrying on the same business that formerly was carried on by the person whose name is in the trade mark."

Name of  
former  
proprietor.

It is, indeed, settled law in England, though there is some American authority (*c*) to the contrary, that the mere fact of the trade mark consisting of or containing the name of its former proprietor, who originally conducted the business with which the trade mark is connected, is not of itself sufficient to disentitle the transmittee or assignee of the business to continue to use the mark, since the mere name of the maker will be deemed to be indicative rather of a business, in whosoever hands it may be, than of an individual proprietor of it (*d*).

(*a*) *Rey v. Lecouturier*, 25 P. R. 265; 27 *ib.* 268.

(*b*) *Hoxie v. Chaney*, 143 Mass. 592.

(*c*) *Sherwood v. Andrews*, 3 Amer. L. Reg. N. S. 588. And see *Partridge v. Menck*, 2 Sandf. Ch. 622; *Carmichel v.*

*Latimer*, 11 R. I. 395; *Manhattan Medicine Co. v. Wood*, 108 U. S. 218; *Horton Manufacturing Co. v. Horton Manufacturing Co.*, 18 Fed. Rep. 816.

(*d*) *Bury v. Bedford*, 4 De G. J. & S. 352; *Churton v. Douglas*, Johns. 174;

It is, however, conceivable that a trade mark may be "so completely personal as of necessity to import that the goods sold under it have been manufactured by a particular individual" (*a*), as if it contains not only the name of the proprietor, but also some reference to his personal qualifications or supervision (*b*), or an allusion to particular workmen in his employ (*c*), in which case the mark will already become deceptive even while the business remains in the same hands, if the proprietor should cease to give his personal attention or to employ the same workmen. And in *Manhattan Medicine Co. v. Wood* (*d*), the Supreme Court of the United States said that "if one affix to goods of his own manufacture signs or marks which indicate that they are the manufacture of others, he is deceiving the public and attempting to pass upon them goods as possessing a quality and merit which another's skill has given to similar articles, and which his own manufacture does not possess in the estimation of purchasers. To put forth a statement, therefore, in the form of a circular or label attached to an article, that it is manufactured in a particular place by a person whose manufacture there had acquired a great reputation, when in fact it is manufactured by a different person at a different place, is a fraud upon the public which no Court of Equity will countenance (*e*).

When trade mark is personal.

In such a case, independently of statute, it is clear that no protection will be given to a mark become deceptive. Thus, Lord Westbury, C., was of opinion that the Court would not sell and transfer the right to use a mark of a personal character simply and without alteration (*f*).

No protection of deceptive marks.

The objection to the use of a trade mark become deceptive,

*Hall v. Barrows*, 4 De G. J. & S. 150; *Leather Cloth Co. v. American Leather Cloth Co.*, 1 H. & M. 271; 4 De G. J. & S. 137; 11 H. L. C. 523; *Massam v. J. W. Thorley's Cattle Food Co.* (2), 14 Ch. D. 748; *Tussaud v. Tussaud*, 44 Ch. D. 678; and the American cases of *McLean v. Fleming*, 96 U. S. 245; *Filkins v. Blackman*, 13 Bl. C. C. 440; and many others; and the Canadian case of *Gage v. Canada Publishing Co.*, 11 Can. Sup. Ct. 306.

(*a*) Per Turner, L. J., in *Bury v. Bedford*, 4 De G. J. & S. 352.

(*b*) *Helmholtz v. Helmholtz Manufacturing Co.*, 53 How. Pr. 453; *Pinto v. Badman*, 8 P. R. 181, 187.

(*c*) And compare the reference by Lord Kingsdown to an artist's special skill, in *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. C. 523.

(*d*) 108 U. S. 218. See also *In re Hill*, 10 P. R. 113.

(*e*) See *Rey v. Lecouturier*, 25 P. R. 265; 27 *ib.* 268.

(*f*) *Hall v. Barrows*, 4 De G. J. & S. 150. See, too, the Clothiers' case, suggested by him in the *Leather Cloth Co.'s case*, 4 De G. J. & S. 137; and the remarks of Lord Cranworth in that case in the House of Lords, 11 H. L. C. 523; and those of the L. JJ. in *Bury v. Bedford*, 4 De G. J. & S. 352. And see *Pinto v. Badman*, 8 P. R. 181, 187.

which, independently of statute, applied rather to the use of the mark assigned than to the power of assigning it (*a*), should now, as it appears, more properly apply to the registration of the assignee or transmittor, by which the latter acquires, at least, a *prima facie* right to practise deceit. The Act, indeed, contains no provision expressly directed to meet a case of this kind, the 11th section being only aimed at an attempted registration of a mark disintituled from the beginning to protection, by reason of being calculated to deceive, and not to a registration of a subsequent proprietor of a mark which has lost its right to protection through a change of circumstances. The spirit of the Act is, however, to favour the general assignability of trade marks together with the goodwill to which they are attached, and it may be expected that such elements in a trade mark as would impede this assignability will very rarely survive the original process of registration now necessary. An example of such survival may, however, be found in the "Chartreuse" case (*b*), in which the marks contained the emblems of the monastic order by which the liqueur was manufactured. It was, however, held in this case that the goodwill had not passed.

Trade marks generally transferable.

Subject only to the provision prohibiting the severance of a trade mark from the goodwill of the business with which it is connected, the trade mark is freely assignable. "The right to a trade mark may, in general, treating it as property, or an accessory of property, be sold and transferred upon a sale and transfer of the manufactory of the goods on which the mark has been used to be affixed, and may be lawfully used by the purchaser" (*c*). If this were not so, the value of a very valuable and important part of the goodwill of the business carried on by a person (*d*) would

(*a*) *Per* Turner, L. J., in *Bury v. Bedford*, 4 De G. J. & S. 352.

(*b*) *Rey v. Lecouturier*, 25 P. R. 265; 27 *ib.* 268.

(*c*) *Per* Lord Cranworth in *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. C. 523. And see *per* V.-C. Wood in *Ainsworth v. Walmsley*, L. R. 1 Eq. 518; also *Hall v. Barrows*, 4 De G. J. & S. 150; *Hudson v. Osborne*, 39 L. J. Ch. 79; *Gage v. Canada Publishing Co.*, 11 Can. Sup. Ct. 306; and the clear and full statement by Daly, C. J., in *Hegeman & Co. v. Hegeman*, 8 Daly, 1. It was said by Shipman, J., in the American case of *Filkins v. Blackman*,

13 Bl. C. C. 440, that "the right to the use of a trade mark cannot be so enjoyed by an assignee that he shall have the right to affix the mark to goods differing in character or species from the article to which it was originally attached;" and this agrees with the view taken in *Rey v. Lecouturier*, 25 P. R. 265; 27 *ib.* 268, where the secret of manufacture had not been disclosed.

(*d*) Compare the observations of Wood, V.-C., as to the sale of a trade name, involving the same considerations, in *Churton v. Douglas*, Johns. 174; also *Shipwright v. Clements*, 19 W. R. 599.

be seriously diminished. And for a similar reason, and in the interest alike of the owner of a trade mark himself and of his assignee, the original owner will, subsequently to assignment, be restrained from the use of his former trade mark, equally with persons who have never had an interest in it (*a*). Nor after that event does he retain any power of conferring on another a right to use it (*b*). The same will be the case if the sale has been made, not by the owner himself, but by his trustee in bankruptcy (*c*). In the sale of a business a trade mark will pass to the purchaser without special mention (*d*).

When a person becomes entitled to a registered trade mark by assignment or transmission, or other operation of law, the way in which he has to obtain the registration of himself as the proprietor is by sending to the registrar a request to that effect, which may either be made by himself and his predecessor in title jointly, or by himself alone. In the former case a declaration in support of the application need only be furnished if required; in the latter case a statement of the particulars relating to the title must be supplied and, if this is satisfactory, the statement must be verified by declaration (*e*).

Registration  
of subsequent  
proprietor.

On the owner of a trade mark becoming bankrupt, his trade mark is transmitted with his business to his representative in bankruptcy, and will, together with the business and goodwill, be dealt with by him (*f*); and it cannot be objected to an assignment of a trade mark by the trustee in bankruptcy of the owner that the goodwill has ceased because the trustee does not himself carry on the business (*g*). Similarly on the winding up of a company the trade mark will pass with the goodwill of the business to the liquidator (*h*). But, apart from the statutory provisions regu-

Transmission  
on bank-  
ruptcy.

(*a*) *Bury v. Bedford*, 4 De G. J. & S. 352. And see *Churton v. Douglas*, Johns. 174.

(*b*) *Sohl v. Geisendorf*, 1 Wils. (Ind.) 60; *Filkins v. Blackman*, 13 Bl. C. C. 440.

(*c*) *Hudson v. Osborne*, 39 L. J. Ch. 79; *Melrose Drover v. Heddle*, Ct. Sess. Cas. 5th Ser. IV. 1120; *Hegeman & Co. v. Hegeman*, 8 Daly, 1.

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

(*e*) See Rules 76—81, and Forms T. M. Nos. 16—19.

(*f*) *Hudson v. Osborne*, 39 L. J. Ch. 79; *Cotton v. Gillard*, 44 L. J. Ch. 90; *Bury v. Bedford*, 4 De G. J. & S. 352; *Ex parte Young*, Dig. 537; *Rogers v. Taintor*, 97 Mass. 291; *Hegeman & Co. v. Hegeman*, 8 Daly, 1; *Warren v. Warren Thread Co.*, 134 Mass. 247. And see *Longman v. Tripp*, 2 Bos. & P. N. R. 67; and *Ex parte Foss*, 2 De G. & J. 230.

(*g*) *Hammond v. Malcolm Brunker & Co.*, 9 P. R. 301.

(*h*) *In re Bolanuchi's Empire Chocolate Co.*, 89 L. T. (J.) 273.

lating registration, it seems that a trade mark which owes its value to its owner's personal skill will not pass; and in the American case of *In re Swezey and Dart* (a) an insolvent trader was directed to be examined for the purpose of ascertaining whether the value of the mark was owing to such skill or to the general working of the factory. And it has been held in America that an assignee in bankruptcy cannot sell a trade secret or a trade mark of which the main feature is the bankrupt's name, so as to restrict the bankrupt's right to use it (b); and also that where one of the partners in a solvent firm becomes bankrupt, his interest in the name or trade mark of the firm cannot be sold, on the ground that his right is only to an undivided part of the mark, and that this is of no value apart from its connection with the goodwill (c).

Formation of  
partnership  
or joint-  
adventure.

Upon the formation of a partnership, one member of which is the proprietor of a trade mark, the trade mark will, in the absence of express provisions, or tacit acquiescence by the other partners in the previous owner's retention of his trade mark (d), pass into and become part of the partnership assets, for the trade mark is but an element of the trade (e). In that case it seems that the partner who has newly acquired an interest in the trade mark will be entitled to registration as joint proprietor with his partner who is already on the register. And where, without the actual formation of a partnership, three persons agreed to carry on business in common, one manufacturing, another acting as exporting agent, and the third as consignee and merchant at Rangoon, it was held on appeal that neither had an exclusive right to the combination of marks used on the goods which had passed through this course, though some of the marks in the combination had been used separately by one of the three before the arrangement between them was made; the decision being based on the fact that the combination as a whole had come to denote goods which had passed through the hands of all three (f). In the same way, where an Italian firm of fruit exporters and an English firm of merchants

(a) 62 How. Pr. 215.

(b) *Helmhold v. Helmhold Manufacturing Co.*, 53 How. Pr. 453; *Iowa Seed Co. v. Dorr*, 70 Iowa, 481.

(c) *Taylor v. Bemis*, 4 Biss. 406.

(d) *Kidd v. Johnson*, 100 U. S. 617, practically reversing *Kidd & Co. v. Mills, Johnson & Co.*, 5 U. S. Pat. Gaz.

337. Cf. *Sanche v. Electrolibation Co.*, 60 *ib.* 1189.

(e) *Bury v. Bulford*, 4 De G. J. & S. 352, per Turner, L. J. And see *Condy v. Mitchell*, 37 L. T. N. S. 268; *ib.* 766.

(f) *Robinson v. Finlay*, 9 Ch. D. 487. Compare *In re Jones*, 53 L. T. N. S. 1.

entered into a joint adventure consisting in the export from Italy and the importation into and sale in England of Italian produce, and certain marks were used upon the fruits which had passed through this course of trade, the marks were ordered to be placed in the joint names (*a*).

Upon the dissolution of a partnership among whose property a trade mark is included, whether that dissolution be brought about by the mutual agreement of the partners or by the death of one of them, the trade mark, as forming part of the partnership assets, and also on account of its close connection with the goodwill of the business, must be treated in the same way as the business and goodwill are treated, unless there is an express agreement for its discontinuance. If the business and goodwill are sold, the trade mark will be included in the sale (*b*); if the share of the retiring or deceased partner is, by arrangement, taken over by the continuing or surviving partner or partners, the retiring or deceased partner's interest in the trade mark passes with his share in the business, and must be included in the valuation of that share (*c*); if the partners merely agree to divide the partnership assets, so that each in effect carries on the same business, though they carry it on severally instead of jointly, then each is at liberty to use the mark as he did before (*d*). Thus, where H. B. Condy had brought into a partnership formed between himself and one Mitchell certain trade marks, which consisted in part of the former's name, it was held that after the dissolution, on which the goodwill became divisible in equal shares between the partners, Mitchell was equally entitled with Condy to continue to use the trade mark (*e*). And where certain partners sold to their co-partner their interest in the business premises and in certain personal

Dissolution of partnership.

(*a*) *In re "Tarantella" Marks*, 27 P. R. 573.

(*b*) *Bradbury v. Dickens*, 27 Beav. 53; *Hall v. Barrows*, 4 De G. J. & S. 150; *Banks v. Gibson*, 34 Beav. 566.

(*c*) *Banks v. Gibson*, 34 Beav. 566; *Hall v. Barrows*, 4 De G. J. & S. 150; *Hazard v. Caswell*, 93 N. Y. 259; *Gage v. Canada Publishing Co.*, 11 Can. Sup. Ct. 306.

(*d*) *Banks v. Gibson*, 34 Beav. 566. And see *Bond v. Milbourn*, 20 W. R. 197; *Tadilal v. Burditt & Co.*, 30 Bom. 61; *Robinson v. Finlay*, 9 Ch. D. 487.

In *In re Jones*, 53 L. T. N. S. 1, it was held that neither of the parties to a joint adventure was entitled, after this had come to an end, to use or register the joint trade marks as against the others.

(*e*) *Condy v. Mitchell*, 37 L. T. N. S. 268, 766. And see *Caswell v. Hazard*, 121 N. Y. 484; 18 Am. St. Rep. 333, which shows that in such cases neither partner may use his own name in such a way as to interfere with the use of the firm name by the other.



property connected with the business, but not their interest in the goodwill or trade mark, it was held in America that they retained their right to use the trade mark concurrently with their former co-partner (a).

Transmission  
on death.

Where a trade mark has been transmitted by the death of the registered proprietor, his legal personal representative will be recognised as having the title to the mark. So long since as the reign of King Geo. II., Lord Hardwicke, C., decided (b) that shares in the goodwill of a newspaper, entitled *The St. James's Evening Post*, were to be considered as part of the personal property of the proprietor; and that, on the death of the proprietor, his trade mark passes to his personal representative with the remainder of his personal property has never been questioned (c). Where letters of administration to a person who had adopted a trade mark for an article of his invention had not been taken out, it was held that his son could not, by merely continuing to make the article and use the trade mark after his father's death, acquire a right in the trade mark so as to be entitled to prevent another person from using it; still less could a purchaser of the son's business do so (d). But a rather different view of the results of such a proceeding has been taken in America (e).

Bequest of  
trade mark.

The proprietor of a trade mark may bequeath it according to pleasure (f), but this is subject to the provisions prohibiting its transmission otherwise than in connection with the goodwill of his business (g), and associated trade marks can only be transmitted as a whole (h).

Several  
proprietors.

By means of bequest, dissolution of partnership, &c., it is possible for more than one person to become severally entitled to the same trade mark at the same time (i), and concurrent rights may similarly arise by reason of concurrent substantial user by

(a) *Huwer v. Dannenhoffer*, 82 N. Y. 499; *Hazard v. Caswell*, 93 N. Y. 259.

(b) *Giblett v. Read*, 9 Mod. 459.

(c) Thus, in *Croft v. Day*, 7 Beav. 84; 28 Leg. Obs. 378, the successful plaintiffs were the executors of the former proprietor of the business and trade mark. See *In re Farina* (4), 44 L. T. N. S. 99; *Rey v. Lecouturier*, 25 P. R. 265; 27 *ib.* 268.

(d) *Horenden v. Lloyd*, 18 W. R. 1132. And see *Singleton v. Bolton*, 3 Doug. 293.

(e) *Pratt's Appeal*, 117 Penn. St. 401.

(f) *Dent v. Turpin*, 2 J. & H. 139; *M'Lean v. Fleming*, 96 U. S. 245.

(g) § 22.

(h) § 27.

(i) *Hine v. Lart*, 10 Jur. 106; *Dent v. Turpin*, 2 J. & H. 139; *Banks v. Gibson*, 34 Beav. 566. And see *Southorn v. Reynolds*, 12 L. T. N. S. 75; *In re Roger*, 12 P. R. 149; *Pratt's Appeal*, 117 Penn. St. 401; *Waukesha Hygeia Springs Co. v. Hygeia Sparkling Distilled Water Co.*, 63 Fed. Rep. 438, 443; *Batchelor v. Thomson*, 86 Fed. Rep. 630.

more firms than one (*a*). In such a case Stirling, J., held that the registrar ought not to register each of the claimants (*b*), but the present Act provides that the registrar *may* refuse to register any of them until their rights have been determined by the Court or have been settled by agreement in a manner approved by him, or (on appeal) by the Board of Trade (*c*). Where one of the claimants has got on to the register, the registrar cannot register the other without the leave of the Court (*d*); neither can he do so where either application is opposed (*e*), until the opposition has been disposed of.

By the 4th section of the Act of 1875, it was provided that every proprietor registered in respect of a trade mark subsequently to the first registered proprietor was, as respected his title to that trade mark, to stand in the same position as if his title were a continuation of the title of the first registered proprietor (*f*). This section is not re-enacted, but there appears to be no doubt that in ordinary cases the result will be the same as if it had been.

Position of subsequent proprietors.

### 3. *Discontinuance.*

In order for a trade mark to be entitled to protection as such, and apart from passing off, it is now necessary either that the trade mark shall be registered, or, if an old mark incapable of registration is in question, that registration under the present Act shall have been refused (*g*). The protection of a mark once registered terminates, therefore, with the cessation of registration.

When trade mark protected.

The original registration of a trade mark is for a period of fourteen years, at the end of which time it may be renewed for a further period of fourteen years on payment of the prescribed fee, and in the same way from time to time for further periods of fourteen years. In default of renewal the mark is removed from the register (*h*). No difficulty need in ordinary cases be

Duration of registration.

(*a*) *In re Powell*, Dig. 589; *In re Jelley, Son, & Jones*, 51 L. J. Ch. 639; *Benbow v. Low* (4), 44 L. T. N. S. 875; *Day v. Neale*, Bacon. V.-C., May 24th, 1881; *In re Hodson, Tessier & Co.*, 86 L. T. N. S. 188; *Edge & Sons, Ltd. v. Gallon*, 17 P. R. 557; *Goodwin v. Ivory Soap Co.*, 17 P. R. 689; 18 P. R. 389; *In re Lyle & Kinahan, Ltd.*, 24 P. R. 249; and other cases on the Three Mark Rule.

See note (*e*) to § 72 of Patents Acts, *infra*.

(*b*) *In re Ehrmann*, (1897) 2 Ch. 495.

(*c*) § 20.

(*d*) § 19.

(*e*) § 14.

(*f*) Compare *Horenden v. Lloyd*, 18 W. R. 1132.

(*g*) §§ 42, 45.

(*h*) §§ 28—31, Rules 68—75.

apprehended from the prolongation of registration, for the exclusive use of a trade mark is no injury or deprivation to the public, but a protection against fraud.

Restoration to register.

Even after the removal from the register for non-payment of the fee, the mark may be restored to the register by the registrar, if he is satisfied that it is just so to do, on payment of an additional fee (a).

Must be a vendible article with trade mark attached.

Independently of registration no trade mark can exist as such unless there is actually existent in the market a vendible article to which the mark is in some way affixed or attached (b), though it is not necessary for the mark to be externally visible—e.g., where it is placed on the bottom of a wine cork, which is not seen until the bottle is bought and opened (c).

Effect of registration.

The necessity of proving the existence of such an article so marked, in the case of registered marks, now no longer exists, since registration, if valid, gives an exclusive right (d). If, however, a mark somewhat similar to, but not identical with, the registered mark has been used on goods on which the registered mark has never been used, though they are covered by the registration, the Court may decline to recognise the probability of deception (e). But in the case of old marks, it seems that a certificate of refusal will not entitle the unsuccessful applicant to his remedy, if discontinuance can be established. The 34th Rule under the Act of 1875 contained provisions intended to prevent the continuance of restrictions which no longer served any useful purpose, and this was put into practice in the case of *In re Ralph* (f). It has not been re-enacted; but since, by § 22, a trade mark is determinable with the goodwill, the Court has jurisdiction under § 35 to remove from the register, on the

(a) § 30, Rule 73.

(b) *McAndrew v. Bassett*, 4 De G. J. & S. 380; *Maxwell v. Hogg*, L. R. 2 Ch. 307; *Edwards v. Dennis*, 30 Ch. D. 454; *Wheeler v. Johnston*, 3 L. R. Ir. 284. And see *Singer Manufacturing Co. v. Wilson*, 2 Ch. D. 434. In *Cotton v. Gillard*, 44 L. J. Ch. 90, the plaintiffs had bought from the trustee in bankruptcy the interest of the bankrupt in a certain sauce and in his trade mark, but the sauce being compounded according to a secret which the trustee could not communicate, Sir G. Jessel, M. R., held that the plaintiffs could not use or protect the trade mark. In *Rey v. Lecouturier*, 25 P. R. 265; 27 *ib.* 268, the

defendants had in France obtained possession of the plaintiffs' business, but not of their trade secret, and it was held by the C. A. and H. L. that the defendants were not entitled to use the plaintiffs' trade marks or trade name in England.

(c) *Moët v. Pickering*, 8 Ch. D. 372; *Moët v. Clybourn*, Dig. 533. But see *In re Kinahan*, 10 P. R. 393.

(d) § 39.

(e) *Edwards v. Dennis*, 30 Ch. D. 454; *Hargreave v. Freeman*, (1891) 3 Ch. 39. Cf. *Phillips v. Ogden*, 12 P. R. 325; *Boord & Son v. Huddart*, 21 P. R. 149; *Finlay v. Shamrock Co.*, 22 P. R. 301.

(f) 25 Ch. D. 194.

application of any person aggrieved, a trade mark which has lost its right to existence by the discontinuance of its proprietor's business (a). The continued registration of such a mark would be an "entry wrongly remaining on the register," and in many cases the provisions of § 37 would be directly applicable in addition.

"That the right to use a trade mark may be lost by abandonment or disuse is too clear to need argument or the support of authority" (b), and the neglect on the part of the owner which is fatal to his exclusive right may either take the shape of cessation of user on his own part, or of the growth of a concurrent right in others. Each of these depends upon intention. "To constitute abandonment" (i.e., by cessation of user) "an intention to abandon must be shown. Mere non-user of a trade mark can no more be said to constitute abandonment than the mere non-user of a right to foul a stream belonging to a mill as an easement can be said to constitute an abandonment of the easement" (c). But when the word claimed as a trade mark had not been used during a period of eleven years, and the sale of the article on which it had been used had been discontinued, and the labels on which it had appeared had been destroyed, it was held that there had been abandonment (d).

"The question of abandonment" (i.e., by non-interference with infringers) "is one of intention, and the burden of establishing it lies upon the party who affirms it," said an American judge (e); and in the same way it was said in the High Court of Bengal (f) that the right of property in a trade mark acquired by user "would continue until it had been proved by evidence that the proprietor had abandoned it." In particular, where the trade mark owner is ignorant of infringements taking place, it will not be held that he has abandoned his rights because of his failure to enforce them,

Abandonment  
by disuse.

Abandonment  
by permitting  
infringe-  
ments.

(a) See *In re Batt*, (1898) 2 Ch. 432.

(b) Per Hughes, J., in *Blackwell v. Dibrell*, 14 U. S. Pat. Gaz. 633. See *Laverque v. Hooper*, Ind. L. R. 8 Mad. 149.

(c) Per Chitty, J., in *Mouson & Co. v. Boehm*, 26 Ch. D. 398. It would be evidence of intention to abandon if a trade mark owner were to break up his moulds and erase the mark from his books and lists: *Ib.* See *In re Hart*, 19 P. R. 569; *Louise & Co., Id. v. Gainsborough*,

20 P. R. 61; *Blogg v. Anderson*, N. S. W. 21 L. R. Eq. 238; *Sarlehner v. Eisner*, 179 U. S. 19.

(d) *In re Grossmith*, 6 P. R. 180; *Daniel v. Whitehouse*, (1898) 1 Ch. 685, 689. And see *In re Ashton*, 48 W. R. 389.

(e) Morris, Comm., in *Julian v. Hoosier Drill Co.*, 75 Ind. 408, in which a delay of three years was held not to amount to abandonment.

(f) *In Orr-Ewing & Co. v. Grant, Smith & Co.*, 2 Hyde, 185, per Levinge, J.

that failure being due to his ignorance of what was going on (a); but it may be assumed that there must be reasonable diligence shown in the defence of his rights. In *Barlow & Jones, Limited v. Johnson & Co. (b)*, it was held that the owners of a name and trade mark were not debarred from enforcing their rights because, after detecting a former infringement and obtaining the undertaking of the infringer to discontinue the infringement, they had allowed a small quantity of the infringing goods to be sold in the market under the imitated name and trade mark and had themselves purchased some of such goods.

Distinctive words become descriptive.

With respect to trade marks consisting of words which originally were distinctive, it has occasionally happened that they have ceased to denote the manufacture of any particular person, and have become simply descriptive of a certain article or a certain principle of manufacture. When that has become the case, such words have ceased to be capable of protection as trade marks, having become *publici juris*, open to the use of all (c). But a composite mark is not abandoned by isolated words or symbols contained in it being used by others (d); and it has been held in America that where a word has been properly appropriated as a trade mark, and has not been formally abandoned, use in a descriptive sense by persons other than the proprietor does not make it open to the public (e). Where a name, which it has been attempted to appropriate as a trade mark, has been in fact descriptive throughout, the case can hardly be said to have arisen of a discontinuance of a trade mark, inasmuch as it was invalid originally (f).

(a) *Weldon v. Dicks*, 10 Ch. D. 247; *In re Farina (2)*, 27 W. R. 456; *Mouson & Co. v. Boehm*, 26 Ch. D. 398; *Barlow & Jones, Ltd. v. Johnson & Co.*, 7 P. R. 395, 408; *Blagg v. Anderson*, N. S. W. 21 L. R. Eq. 238; *Saxlehner v. Eisner*, 179 U. S. 19.

(b) 7 P. R. 395, 408. And see *Ripley v. Bandy*, 14 P. R. 591, 944.

(c) *Per Mellish*, L. J., in *Ford v. Foster*, L. R. 7 Ch. 611. And see *Wheeler & Wilson Manufacturing Co. v. Shakespeare*, 39 L. J. Ch. 36; *Liebig's Extract of Meat Co. v. Hanbury*, 17 L. T. N. S. 298; *Same v. Anderson*, W. N. 1883, p. 185; *Lazenby v. White*, 41 L. J. Ch. 354; *In re Hyde & Co.*, 7 Ch. D. 724; *Browne v. Freeman*, W. N. 1873, p. 178; *Barlow & Jones, Ltd. v. Johnson*

*& Co.*, 7 P. R. 395; *In re Wills*, (1893) 2 Ch. 262; *National Starch Manufacturing Co. v. Munn's Patent Maizena & Starch Co.*, (1894) A. C. 275; *In re Magnolia Metal Co.*, (1897) 2 Ch. 371; *Lea v. Millar*, Dig. 513; *Neva Stearine Co. v. Mowling*, 9 V. L. R. (E.) 98; *Wilson v. Lyman*, 25 Ont. App. R. 303; *Lawrence Manufacturing Co. v. Tennessee Manufacturing Co.*, 138 U. S. 537.

(d) *Sohl v. Geisendorf*, 1 Wils. (Ind.) 60; *Filley v. Child*, 16 Bl. C. C. 376.

(e) *Celluloid Manufacturing Co. v. Cellonite Manufacturing Co.*, 32 Fed. Rep. 94; *Saxlehner v. Eisner*, 179 U. S. 19.

(f) *Young v. Macrae*, 9 Jur. N. S. 322; *Raggett v. Findlater*, L. R. 17 Eq. 29; *In re Horsburgh*, 53 L. J. Ch. 237; *Row-*

In this connection the "three-mark rule," as it is called, becomes of importance. This rule originated in the discovery—soon after the Act of 1875 came into operation—that the same or substantially the same trade mark was in many instances in use by more firms than one, generally carrying on business in different parts of the country; and in order to avoid injustice being done in such cases the rule was laid down by the Commissioners of Patents, and acted on in various decisions of the Courts, that where two or three firms could prove that they had used the same or substantially the same mark on the same or substantially the same goods, to a substantial extent, before the passing of the Act of 1875, each should be allowed to register; but that where the mark had been used by more than three firms it was common to the trade (*a*); and on this principle it has been held that various marks were common in different trades (*b*).

The three-mark rule.

In *Braham v. Bustard* (*c*) and *Ford v. Foster* (*d*) it was held that the habitual use of the manufacturer's name (which was alone a sufficient trade mark), before the special and distinctive appellation of "Excelsior" in the one case and "Eureka" in the other, did not amount to an abandonment of the manufacturer's right in those appellations when used without the name, but that the manufacturer remained entitled to his essential mark (*e*). In *Lea v. Millar* (*f*) it was held that, in addition to the evidence as to the common use of the alleged trade mark by persons other than the plaintiff, the fact that the plaintiff had recently adopted a new label upon his goods, on the ground that his existing label did not afford sufficient protection, was a public abandonment of the latter. And in *Manhattan Medicine Co. v. Wood* (*g*), it was held that a trade mark had been lost by abandonment, a new form of bottle and label having been adopted in place of the old ones. An exclusive right to a mark may be lost by its owner using it habitually and exclusively upon goods which pass through other persons' hands so that they acquire a right in it (*h*); and it would appear that notwithstanding certain American decisions (*i*) to the effect

Trade mark not abandoned by habitual user in combination with name.

*land v. Breidenbach*, Dig. 386; *In re Leonard & Ellis*, 26 Ch. D. 288; *Bulloch, Lade & Co. v. Gray*, 19 Journ. of Jurisp. 218. And see p. 76, note (*b*), *supra*.

(*a*) See note (*c*) to § 72 of Patents Acts, *infra*.

(*b*) See notes to § 74 of Patents Acts, *infra*.

(*c*) 1 H. & M. 447.

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

(*e*) And see *Worcester Royal Porcelain Co. v. Locke & Co.*, 19 P. R. 479; *Hornsby v. Hudson*, N. S. W. 11 L. R. Eq. 148.

(*f*) Dig. 513. (*g*) 108 U. S. 218.

(*h*) *Robinson v. Finlay*, 9 Ch. D. 487.

(*i*) *Pike Manufacturing Co. v. Cleveland Stone Co.*, 35 Fed. Rep. 896; *Sheppard & Co. v. Stuart & Peterson*, 13 Phila. 117.

that the habitual addition to a label of the name of the merchant to whom the goods are supplied does not deprive the owners of the label of their right to it, yet such a practice would cause the label to lose its distinctive character as indicating its proprietor's goods (*a*).

Abandonment  
by dismissal  
of suit.

In *Browne v. Freeman* (*b*) it was held that the plaintiff, having previously commenced a suit against an infringer of his trade mark, and then having got his bill dismissed with costs in consequence of being advised that his right was doubtful, had lost all rights in the trade mark. Under the registration system such a loss of trade mark can seldom occur, except in the case of unregistered though certified marks, since the rights of a proprietor of a registered mark are such that it is impossible to suppose that in many cases such a proprietor would resign his claims without a struggle. With respect to marks unregistered, or even uncertified, there is nothing in the Act to prevent proof of the imitation of such marks being given in support of an action for passing off.

Infringement  
of disused  
mark.

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

Effect of re-  
moved mark.

By § 31, a registered trade mark removed from the register for non-renewal is, for the purpose of any application for registration during one year next after the date of such removal, to be deemed to be a trade mark already registered, unless it is shown to the satisfaction of the registrar that there had been no *bonâ fide* trade user of such trade mark during the two years immediately preceding such removal.

Cancellation.

By § 32, power is given to the registrar, upon a proper application, to cancel the entry of a trade mark on the register, and to strike out any goods or classes of goods (*e*).

*a*) *Wood v. Lambert*, 32 Ch. D. 247.

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

*c*) 2 E. D. Smith, 343; *R. Cox*, 142.

*d*) *Armistead v. Blackwell*, 1 U. S. Pat. Gaz. 603.

*e*) See notes to § 91 of Patents Act; also Rules 90—92.

## CHAPTER IV.

## INFRINGEMENT.

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

Requisites for infringement.

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

Fact of infringement.

(*a*) As to this, see *Witthaus v. Braun*, 41 Md. 303; *Popham v. Wilcox*, 38 N. Y. Super. Ct. 274; *Weston v. Ketchum* (1), 39 *ib.* 51; and (2), 51 How. Pr. 455; and *Compagnie Lafarge v. Hendricks*, Dig. 512.

(*b*) See *Kinahan v. Bolton*, 15 Ir. Ch. 75; and *Leather Cloth Co. v. American Leather Cloth Co.*, 4 De G. J. & S. 137.

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

(*d*) *Sykes v. Sykes*, 3 B. & Cr. 541; *Marison v. Salmon*, 2 Mau. & Gr. 385; *Crawshaw v. Thompson*, 4 *ib.* 357.

(*e*) See *Bondier v. Depatie*, 3 Dorion, 233. Cf. *Leahy v. Glover*, 10 P. R. 141, where it was held that an isolated case of misrepresentation by an employee who had acted without the employer's sanction and had since left his service, was not of itself enough to support an injunction against the employer. See *infra*, p. 209.



injunction against a continuance of the wrong, and an action for such injunction will not be defeated solely on the ground that on the day it is brought the dealer happens not to have any of the article on hand" (a).

Fraudulent intention.

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

First purchaser not deceived.

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

Early doctrine in Chancery.

When plaintiffs in trade-mark cases began to seek redress in the Court of Chancery, desirous of obtaining the more convenient remedy by way of injunction and account, which was superior to the damages to be gained at Common Law alike in the compensation for the past and in the security for the future, the Chancery judges held that the Courts in which they presided could act only in aid of and as ancillary to the legal right (f). And acting upon this same principle, they held that the rules by which they had to judge of infringement must be identical with those of the Common Law, the plaintiff's right to his remedy being considered to be

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

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

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

(d) *Singleton v. Bolton*, 3 Doug. 293; *Morison v. Salmon*, 2 Man. & G. 385; *Crawshay v. Thompson*, 4 *ib.* 357; *Rudgers v. Nowill*, 5 C. B. 109; and *Myers v. Baker*, 3 H. & N. 802. See, too, *per*

Parke, B., in *Taylor v. Ashton*, 11 M. & W. 415.

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

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

based, not on any right of property in him, but on the fraudulent proceedings of the defendant (*a*). The cases which were frequently sent by Chancery judges to be tried at Common Law by a jury were, of course, tried in accordance with Common Law principles (*b*).

It is, however, apparent that the seriousness of the injury inflicted on the manufacturer who has acquired a reputation for excellence in a particular class of goods, denoted by a special trade mark, by the offering for sale in the market of other goods, side by side with his, bearing the same mark, is not affected by the question whether such rival goods are made and marked by a person who is aware of the reputation of the original goods and desirous of attracting to himself some of the profits of that reputation, or by one who is actuated by no such motives, and is even ignorant of the prior use of the mark. As Lord Cairns, C., said, in a well-known case (*c*):—"A man may take the trade mark of another ignorantly, not knowing it was the trade mark of the other; or he may take it in the belief, mistaken but sincerely entertained, that in the manner in which he is taking it he is within the law, and doing nothing which the law forbids; or he may take it knowing it is the trade mark of his neighbour, and intending and desiring to injure his neighbour by so doing. But in all these cases it is the same act that is done, and in all these cases the injury to the plaintiff is just the same." "If a man has acquired legitimately a right to the property in an exclusive use of a name, it is of small account to him, should it be invaded, whether the invasion comes from a purpose to deceive, or from ignorance, or inadvertence, or an honest misconception of the relative rights of the parties; and the law ought not to permit, and will not permit, the continuance of the invasion, whatever may have been its origin" (*d*). The first maker is defrauded, even though his rival's conduct be not intentionally fraudulent.

Same injury caused, whether actual fraud or not.

(*a*) *Blanchard v. Hill*, 2 Atk. 484; *Canham v. Jones*, 2 V. & B. 218; *Perry v. Truefitt*, 6 Beav. 66; *Croft v. Day*, 7 Beav. 84. And see the observations of V.-C. Wood in *Edelsten v. Vick*, 11 Hare, 78; *Collins Co. v. Cowen*, 3 K. & J. 428; *Leather Cloth Co. v. American Leather Cloth Co.*, 1 H. & M. 271; *Hall v. Barrows*, 32 L. J. Ch. 548; and *McAndrew v. Bassett*, 33 L. J. Ch. 561.

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

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

(*d*) *Per* Lord O'Hagan, *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 396; and see *per* Cotton, L.J., in *Singer Manufacturing Co. v. Loog* (3), 18 Ch. D. 412; *Bourne v. Swan & Edgar*, (1903) 1 Ch. 211.

Later doctrine  
in Chancery.

In 1838, Lord Cottenham, C., awarded a perpetual injunction in a case in which he rejected any imputation of intentional fraud (*a*), and this is not now necessary to obtain redress in equity. The principles in accordance with which relief will be given in equity were summed up as follows by Lord Westbury, C.:—"At Law the proper remedy is by action on the case for deceit, and proof of fraud on the part of the defendant is of the essence of the action; but this Court will act on the principle of protecting property alone, and it is not necessary for the injunction to prove fraud in the defendant, or that the credit of the plaintiff is injured by the sale of an inferior article. The injury done to the plaintiff in his trade by loss of custom is sufficient to support his title to relief. Neither will the plaintiff be deprived of remedy in Equity, even if it be shown by the defendant that all the persons who bought from him goods bearing the plaintiff's trade mark were well aware that they were not of the plaintiff's manufacture. If the goods were so supplied by the defendant for the purpose of being sold again in the market the injury to the plaintiff is sufficient. Again, it is not necessary for relief in Equity that proof should be given of persons having been actually deceived, and having bought goods with the defendant's mark, under the belief that they were of the manufacture of the plaintiff, provided that the Court be satisfied that the resemblance is such as would be likely to cause the one mark to be mistaken for the other" (*b*). It is not necessary for the plaintiff to show that the defendant knew whose trade mark his resembled (*c*), nor, in fact, to show that the defendant knew that his trade mark resembled any existing mark (*d*). "The action of the Court must depend upon the right of the plaintiff, and the injury done to that right. What the motive of the defendant may be, the Court has very imperfect means of knowing. If he was ignorant of the plaintiff's rights in the first instance, he is, as soon as he becomes acquainted with them and perseveres in infringing upon them, as

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

(*b*) *Edelsten v. Edelsten*, 1 De G. J. & S. 185. That the rule of the Court of Chancery was as here stated, was recognised by the Court of Queen's Bench in *Dixon v. Faucus*, 3 Ell. & Ell. 537. And see *Reddaway v. Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639.

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

(*d*) *Kinahan v. Bolton*, 15 Ir. Ch. 75; *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Burgess v. Hills*, 26 Beav. 244; *Harrison v. Taylor*, 11 Jur. N. S. 408; *Orr-Ewing & Co. v. Grant, Smith & Co.*, 2 Hyde, 185. And see *per Cotton, L. J.*, in *Singer Manufacturing Co. v. Looy* (3), 18 Ch. D. 412.

culpable as if he had originally known them" (a). In short, "the absence of fraudulent intention is no defence against an application to the Court for an injunction by the person whose property has been injured" (b); and even if a person who has in his possession a quantity of goods bearing a spurious trade mark, is not intending to sell them or part with them, but to use them for his own consumption, relief may be granted against him (c).

It was, however, suggested by Lord Romilly, M. R., that the Court would not require a person to completely change a trade mark which he had taken *bonâ fide*, and without any intention of deception, but which did in point of fact resemble the trade mark of another person, since the complete change of trade mark might be of serious consequence to the unintentional offender (d); and it seems that an innocent licensee from a registered proprietor who was deemed from his conduct to have previously made over his rights in his trade mark to another person in whose employment he was, is entitled to some consideration upon an interlocutory application (e). Again, it has been held in America that a plaintiff may lose by delay his right to an injunction against an innocent vendor of goods spuriously marked, whatever might be the case with regard to the guilty manufacturer (f).

Indulgence to innocent offender.

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

Fraudulent intention, as affecting account, or damages.

(a) *Per* Lord Cairns, C., in *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 376, 391. And see *In re Paine* (2), (1893) 2 Ch. 567.

(b) *Per* Stuart, V.-C., in *Clement v. Maddick*, 1 Giff. 98; *Orr-Ewing & Co. v. Johnston & Co.*, 13 Ch. D. 434; *Rose v. Loftus*, 47 L. J. Ch. 576; *Upmann v. Forester*, 24 Ch. D. 231; *Cowen v. Hulton*, 46 L. T. N. S. 897; *Lewis's v. Goodbody*, 67 L. T. N. S. 194; *Powell v. Birmingham Vinegar Brewery Co.*, (1896) 2 Ch. 51, (1897) A. C. 710; *Saxlehner v. Apollinaris Co.*, (1897) 1 Ch. 893. The same principle holds good in Ireland: *Bodegu Co., Ltd. v. Owens*, 6 P. R. 236; in Scotland: *Crawford v. Bernard*, 11 P. R. 580; in the United States: *McLean v. Fleming*, 96 U. S. 245; and other cases; in India: *Balfour & Co. v. Kilburn & Co.*, 1 Hyde,

270; *Orr-Ewing & Co. v. Grant, Smith & Co.*, 2 Hyde, 185; *Graham & Co. v. Kerr, Dods & Co.*, 3 Beng. L. R. App. 4; and in Australia: *Hennessy v. White*, 6 W. W. & A'B. Eq. 216; *Hennessy v. Hogan*, 6 W. W. & A'B. Eq. 225.

(c) *Upmann v. Forester*, 24 Ch. D. 231. But see *Upmann v. Currey*, 29 Sol. J. 735; and *American Tobacco Co. v. Guest*, (1892) 1 Ch. 630.

(d) *Bass v. Dauber*, 19 L. T. N. S. 626.

(e) *Lewis's v. Goodbody*, 67 L. T. N. S. 194.

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

(g) *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Moet v. Couston*, 33 Beav. 578;

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Note (h), see next page.

Fraudulent  
intention in  
case of delay.

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

In other  
respects.

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

Circum-  
stances point-  
ing to  
fraudulent  
intention.

In default of direct proof of fraudulent intention, there are various circumstances which may serve to point to the conclusion that such intention has existed; thus, the continuing to use a mark after objections raised (*d*); the exact imitation of peculiar characteristics (*e*); the addition to an existing mark of a feature taken from the plaintiff's mark (*f*); the imitating changes intro-

*Slazenger v. Spalding*, 27 P. R. 20. See *Rose v. Loftus*, 47 L. J. Ch. 576. As to the practice in the United States, see *Oakes v. Tonsmierre*, 49 Fed. Rep. 447.

(*h*) See *Reddaway v. Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639, where the principles applicable to an action for damages and an action for an injunction are discussed at length by Lopes, L. J.: *Faber v. D'Utassey*, 11 Abb. P. R. N. S. 399; *Weed v. Peterson*, 11 Abb. P. R. N. S. 178.

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

(*b*) L. R. 14 Eq. 348. And see *Payton v. Snelling*, 17 P. R. 48, 56: affirmed, (1901) A. C. 308; *Chivers v. Chivers & Co.*, 17 P. R. 420, 427.

(*c*) L. R. 18 Eq. 138. And see *Condy v. Mitchell*, 37 L. T. N. S. 268, 766; *Goodall v. Wilkinson*, 90 L. T. (Journal)

357; 91 *ib.* 29; *Wilson v. Masfield*, L. J. N. of C. 1875, p. 51; *McLean v. Fleming*, 96 U. S. 245.

(*d*) See *per* Lord Cairns in *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 376; and *per* Cotton, L. J., and Lord Blackburn in *Singer Manufacturing Co. v. Loog* (3), 18 Ch. D. 395; 8 App. Cas. 15. Also *Williams v. Osborne*, 13 L. T. N. S. 498; *McAndrew v. Bassett*, 4 De G. J. & S. 380; *Orr-Ewing & Co. v. Johnston & Co.*, 13 Ch. D. 434; *In re Paine* (2), (1893) 2 Ch. 567; *Bodega Co., Ltd. v. Owens*, 6 P. R. 236; *Walker v. Alley*, 13 Grant, Up. Can. Ch. 366; *Holt v. Menendez*, 128 U. S. 182, and many other cases.

(*e*) *Hine v. Lart*, 10 Jur. 106; *County Chemical Co., Ltd. v. Frankenburg*, 21 P. R. 722; *McLean v. Fleming*, 96 U. S. 245; *Davis v. Reid*, 17 Grant, Up. Can. Ch. 69.

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

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

(*a*) *Braham v. Beachin* (1), 7 Ch. D. 818; *Siegert v. Findlater*, *ib.* 801.

(*b*) *Hubbuck v. Brown*, 17 P. R. 638, 648.

(*c*) *Farina v. Cathery*, L. J. N. of C. 1867, p. 134; *Brown v. Mercer*, 37 N. Y. Super. Ct. 265; *Bell, Black & Co. v. Bell & Co.*, Dig. 514; *Reynolds & Son v. Walker*, 87 L. T. (Journal) 93.

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

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

(*f*) *Radde v. Norman*, L. R. 14 Eq. 348 ("Leopoldsalt" for "Leopoldshalt"); *Derby Photographic Dry Plate Co. v. Pollard, Graham & Co.*, 2 Times L. R. 276 ("Derwent" for "Derby"); *Orr-Ewing & Co. v. Johnston & Co.*, 13 Ch. D. 434; *Thompson v. Montgomery*, 41 Ch. D. 35; (1891) A. C. 217 (a T for a cross); *Davis v. Reid*, 17 Grant, Up. Can. Ch. 69; *Balfour & Co. v. Kilburn & Co.*, 1 Hyde, 270; and many other cases.

(*g*) *Stuzenger & Sins v. Feltham & Co.*, 6 P. R. 531; *Munday v. Carey*, 22 P. R. 273; *Doren v. Hogadore*, 11 Ont. L. R. 318; *R. v. Antier*, 6 Q. O. R. (Q. B.) 146; *Boston Rubber Shoe Co. v. Boston Rubber Co. of Montreal*, 32 Can. Sup. Ct. 315.

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

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

(*k*) *Franks v. Weaver*, 10 Beauv. 297; *Sedon v. Scaute*, Dig. 18; *Fouult v. Wingard*, 1 Jac. & W. 394; *Blufeld v. Payne*, 4 B. & Ad. 410. And see *Van Oppen & Co., Ltd. v. Van Oppen*, 20 P. R. 617.

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

(*m*) *Weingarten v. Bayer*, 22 P. R. 341; *India Rubber Comb Co. v. Rubber Comb & Jewellery Co.*, 45 N. Y. Super. Ct. 258; *Potter v. McPherson*, 28 N. Y. Sup. Ct. 559.

(*n*) *Wotherspoon v. Carrie*, L. R. 5 H. L. 508; *Metzler v. Wood*, 8 Ch. D. 606; *Dence v. Mason* (1), Dig. 534; *Otard, Dupuy & Co. v. Otard de Montebello Cognac Co.*, 9 Times L. R. 295; 10 *ib.* 67; *Bayer v. Baird*, 15 P. R. 615; *Worcester Royal Porcelain Co., Ltd. v. Locke & Co.*, 19 P. R. 479; *Reddaway v. Frictionless Engine Packing Co., Ltd.*, 19 P. R. 505; *Singer Mfg. Co. v. British Empire Mfg. Co., Ltd.*, 20 P. R. 313; *Foot v. Leu*, 13 Ir. Eq. 484.

original (*a*); the imitation of numbers (*b*) or initials (*c*) used by the plaintiff; the imitation of the barrels (*d*), or bottles (*e*), containing the plaintiff's article; the use of emblems specially indicative of the plaintiff (*f*); the buying up and using the plaintiff's old bottles (*g*); the pasting of a slip containing the plaintiff's name on the defendant's bottles (*h*); the use by the defendant of a name not his own (*i*), possibly under the authority of some person who bore the same name as the plaintiff (*k*); the formation of a partnership with another person, whose name or initial was such as to enable the defendant to imitate the plaintiff's mark with some specious pretence of legality (*l*); the addition of "and Co." after the name (*m*); the alteration of a name acquired by purchase with the goodwill of a business, so as to assimilate it to the name of another firm carrying on a similar business (*n*); the removal into the plaintiff's neighbourhood (*o*); the adoption of a name of a manufactory similar to that used by

(*a*) *Day v. Binning*, C. P. Coop. 489; *Glenny v. Smith*, 2 Dr. & Sm. 476; *Hookham v. Pottage*, L. R. 8 Ch. 91; *Robineau v. Charbonnel*, W. N. 1876, p. 160; *Dence v. Mason* (1), Dig. 534; 41 L. T. N. S. 573; *Singer Manufacturing Co. v. Spence*, 10 P. R. 293, 306; *Reddaway v. Frictionless Engine Packing Co., Ltd.*, 19 P. R. 505; *Barberry's v. Raper & Pulleyn*, 23 P. R. 122; *Chubb v. Priest*, 1 L. T. 142; *Hennessy v. White*, 6 W. W. & A'B. Eq. 216.

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

(*c*) *Bayer v. Baird*, 15 P. R. 615; *Bayer v. Connell* (2), 15 *ib.* 157.

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

(*e*) *Henry v. Price*, 1 Leg. Obs. 364; *Sugert v. Findlater*, 7 Ch. D. 801; *Day v. Riley*, 17 P. R. 517; *Rey v. Lecouturier*, 25 P. R. 265; 27 *ib.* 268; *Congress Co. v. High Rock Co.*, 45 N. Y. 291; *Wilder v. Wilder*, Dig. 372; *Wolfe v. Hart*, 4 V. L. R. Eq. 125; *Fullwood v. Fullwood* (1), W. N. 1873, pp. 93, 185; *Grezier v. Antran*, 13 P. R. 1.

(*f*) *Rey v. Lecouturier*, 25 P. R. 265; 27 *ib.* 268.

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

(*h*) *Cusnier v. Gaiety Bars and Restaurant Co., Ltd.*, 19 P. R. 357.

(*i*) *Ainsworth v. Walmsley*, L. R. 1

Eq. 518; *Barber v. Manico*, 10 P. R. 93; *Holloway v. Cleat*, 20 P. R. 525.

(*k*) *Morrall v. Hessin*, 19 P. R. 557; 20 P. R. 429; *Holloway v. Cleat*, 20 P. R. 525; *Meriden Britannia Co. v. Parker*, 39 Conn. 450; 12 Amer. Rep. 401; *Perks v. Hall & Co.*, W. N. 1881, p. 111; *Melachrino v. Melachrino Egyptian Cigarette Co.*, 4 P. R. 215; *Edge v. Harrison*, 8 P. R. 74; and see cases at p. 291, note (*d*).

(*l*) *Croft v. Day*, 7 Beav. 84 (*Day & Martin*); *Moët v. Clybourn*, Dig. 533 (*M. & C.*). And see *Schweitzer v. Atkins*, 37 L. J. Ch. 817; *Hallett v. Cumston*, 110 Mass. 29; *M. Melachrino & Co. v. R. Melachrino & Co.*, Chitty, J., May 29th, 1888; *Rendle v. Rendle & Co.*, 63 L. T. N. S. 94; *Edge v. Harrison*, 8 P. R. 740.

(*m*) *Churton v. Douglas*, Johns. 174; *Fullwood v. Fullwood* (1), W. N. 1873, pp. 93, 185; *Holt v. Smith*, 4 Times L. R. 329; *M. Melachrino & Co. v. R. Melachrino & Co.*, Chitty, J., May 29th, 1888; *Van Oppen & Co., Ltd. v. Van Oppen*, 20 P. R. 617; see *Joseph Rodgers & Sons, Ltd. v. Simpson*, 23 P. R. 297.

(*n*) *Holt v. Smith*, 4 Times L. R. 329. And see *National Folding Box and Paper Co. v. National Folding Box Co.*, 43 W. R. 156.

(*o*) *Lee v. Haley*, L. R. 5 Ch. 155; *Fullwood v. Fullwood* (1), W. N. 1873, pp. 93, 185.

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

On the other hand, if the defendant uses, on the goods which he is alleged to be endeavouring to pass off as the plaintiff's, a distinct and obvious trade mark of his own, or if he states plainly and in fair-sized and clear type that such goods are in fact manufactured by himself, there is a strong indication that the defendant has no intention of attempting deception (*f*). So, again, if the defendant has ventured to display at a public exhibition goods bearing the mark to which exception is afterwards taken (*g*); or if he has truly stated the connection between himself and the original adopter of the trade mark (*h*); or if, when using bottles moulded with the plaintiff's name, which have come into his possession without fraud, he places his own labels on the bottles in place of the plaintiff's (*i*):

Circumstances pointing to absence of fraud.

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

(*b*) *Gouraud v. Trust*, 10 N. Y. Sup. Ct. 627. And see *Otard Dupuy & Co. v. Otard de Montebello Cognac Co.*, 9 Times, L. R. 295; 10 *ib.* 67.

(*c*) *Wolfe v. Alsop*, 10 V. L. R. (E.) 41.

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

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

(*f*) *Singer Manufacturing Co. v. Wilson*, 2 Ch. D. 434, 444; so, too, in *Cheavin v. Walker*, 5 Ch. D. 850, where the goods were stated to be manufactured by the defendants. And see *Beard v. Turner*, 13 L. T. N. S. 746; *Raggett v. Findlater*, L. R. 17 Eq. 29; *Singer Manufacturing Co. v. Loog* (3), 18 Ch. D. 395; *Packham & Co. v. Sturgess & Co.*, 15 P. R. 669; *Parsons v. Gillespie*, 17 N. S. W. Rep. (Eq.) 227; (1898) A. C. 239. But compare *Wotherspoon v. Currie*, L. R. 5 H. L. 508; *Singer Manufacturing Co. v.*

*Wilson*, 3 App. Cas. 376; *Perry v. Truitt*, 6 Beav. 66; *Braham v. Bustard*, 1 H. & M. 447; *Ford v. Foster*, L. R. 7 Ch. 611; *Sigert v. Findlater*, 7 Ch. D. 801; *Reinhardt v. Spabling*, 49 L. J. Ch. 57; *Henderson v. Jorss*, Dig. 198; *Hubbuck v. Brown*, 17 P. R. 148, 638; *Cooper v. Macaughlan*, 18 P. R. 380; 19 P. R. 27; *Schweppes, Ltd. v. Gibbens*, 22 P. R. 113, 601; *King v. Gillard*, 22 P. R. 327; *Singer Manufacturing Co. v. Kimball & Morton*, Ct. Sess. Cas., 3rd ser. XI. 267; *Lea v. Wolff*, 46 How. Pr. 157; *Field v. Lewis*, Dig. 280; *Rose v. Loftus*, 47 L. J. Ch. 576; *Euo v. Stephens*, Dig. 609; *Kimahan v. Bolton*, 15 Ir. Ch. 75; *Whitney v. Hekling*, 5 Grant, Up. Can. Ch. 605; *Lewis v. Klapproth*, 11 Viet. L. R. 214; *Wilson v. Lyman*, 25 Ont. App. R. 303.

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

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

(*i*) *Rose v. Loftus*, 47 L. J. Ch. 576;



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

When infringement of a registered trade mark is in question, the point is, not whether there has been infringement of the mark which the plaintiff has used in his business, but whether there has been infringement of the mark which he has actually registered. Thus, Jessel, M. R., said, in *Ellis & Sons v. Ruthin Soda Water Co. (a)*, "As I understand the Trade Marks Act, if you come for trade mark and not for actual fraud, you can only sue in respect of what you had registered as a trade mark." And in considering whether there has been infringement of the registered mark, it is necessary to see whether the essential particular in that registered mark has been imitated. Thus it was held by Jessel, M. R., in *In re Horsburgh (b)*, that there was no conflict between two marks which combined substantially the same descriptive word with different devices, since the essential particulars, the devices, being different, it was immaterial that the marks resembled each other in a non-essential feature. If the registered trade mark has not been infringed, a passing-off action may still succeed on grounds apart from the registration.

Burden of proof.

When a defendant has not used the registered mark, but something considered to be similar to it, the plaintiff has to satisfy the Court that the use of this is calculated to deceive (c), but when the defendant has taken the material and essential part of the plaintiff's trade mark, the burden is upon the defendant to disprove the probability of deception, not upon the plaintiff to prove it (d).

Infringement of names as old marks.

With respect to trade marks used before the passing of the Trade Marks Registration Act, 1875, and consisting of a name printed or stamped in ordinary characters, which might be the case independently of the Act, and which may still be protected as trade marks if registered as old marks (e), or under the special provisions of § 9 (5) of the Trade Marks Act, 1905, it has been

*Barrett v. Gomm*, 74 L. T. (Journal) 388; *Barrett v. White*, North, J., May 12th, 1883; *Woolley & Son v. Morrison*, 21 P. R. 63; *Donohoe v. Cherry*, 26 P. R. 545.

(a) Jessel, M. R., Nov. 21st, 1879. And see *Nuthall v. Fining*, C. A., Jan. 21st, 1880; *Lamplough v. Beedler*, C. A., Nov. 12th, 1880; *Russell & Sons, Ltd. v. Smith*, Jessel, M. R., June 18th, 1880; *In re Lyndon*, 32 Ch. D. 109; *Crawford v. Bernard*, 11 P. R. 580.

(b) 53 L. J. Ch. 227. And see *Luche v. Webster*, Jessel, M. R., April 4th, 1879; *In re Loftus*, (1894) 1 Ch. 193.

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

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

(e) *In re Hopkinson*, (1892) 2 Ch. 116.

held that it is not necessary, in order to obtain an injunction, to prove the *scienter* where the infringer does not bear the name he has assumed (*a*), but that, on the other hand, where he does bear that name, such evidence must be produced (*b*); and, in the same way, where two firms have become entitled to use the same trade mark or firm name, it is only in a case of fraud that an injunction will be granted; and an allegation that the defendants use the mark on inferior goods is not sufficient, since, if they have the right to use it, they can use it as they please (*c*).

With respect to names first used as trade marks after the passing of the Act of 1875, and registered as being "represented in a special and particular manner" (*d*), the mere use of the same name is no infringement, unless the special and particular manner is also copied, in which case evidence of actual intentional fraud will be unnecessary, whatever may be the name of the infringer. Similarly, the registration by a trader of a facsimile of his own signature will not prevent another trader of the same name from using, as a trade mark, a facsimile of his signature (*e*).

Infringement of names as new marks.

In the same way, where a trade mark has been registered for specified colours under § 10, or where a trade mark consisting of the coloured threads which form the heading to a piece of stuff (*f*), or of the representation of a coin *g*, or of any other mark in which colour is essential, and which would lose its distinctiveness by being registered in the ordinary way, has been registered by deposit, it will not be infringed unless the colour and arrangement have been imitated. But, where the trade mark does not substantially consist in colour, and has been registered

Colour.

(*a*) *Ainsworth v. Walsley*, L. R. 1 Eq. 518; *McLean v. Fleming*, 96 U. S. 245.

(*b*) *Burgess v. Burgess*, 3 De G. M. & G. 896; *Turton & Sons, Ltd. v. Turton*, 42 Ch. D. 128; *Valentine v. Valentine*, 31 L. R. Ir. 488; *Jamieson & Co. v. Jamieson*, 15 P. R. 169; *McLean v. Fleming*, 96 U. S. 245. And see *Saunders v. Sun Life Assurance Company of Canada*, (1894) 1 Ch. 537; *Brown Chemical Co. v. Meyer*, 139 U. S. 546.

(*c*) *Rogers v. Tantor*, 97 Mass. 291; *Emerson v. Badger*, 101 *ib.* 82. See *Carlsbad v. Tibbets*, 51 Fed. Rep. 852.

(*d*) Trade Marks Act, 1905, § 9, replacing Patents Acts, 1883—1888, § 64.

And see *In re Giannetis*, 6 P. R. 467; *In re Humay*, 7 P. R. 16; *In re Edge*, 8 P. R. 207.

(*e*) *Crawford v. Becond*, 11 P. R. 580.

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

(*g*) *In re Robinson*, 29 W. R. 31. And see *In re Horshburgh*, 53 L. J. Ch. 237. In America it has been held that where the identical form, size, colour, and style of a numeral registered as a trade mark had been copied, an infringement had been committed, although it would have been no infringement to have used the numeral without copying those peculiarities: *Kinney v. Allen*, 1 Hughes, 106.

in the ordinary way, then, though the mark has been registered in colour, the exclusive right to use the mark in any colour is now given to the registered proprietor (a).

Mode of comparing uncoloured marks.

When it is alleged that a trade mark registered without colour has been infringed, it has been said that the proper manner of comparing the two trade marks is to compare their designs in the same size and free from colour, and that similarities in respect of colour in actual use should only be regarded in order either to prove fraud or to turn the scale when the question of infringement, leaving colour out of sight, is very difficult to decide (b). Where the plaintiffs had used a label for coffee, coloured red, white and blue, and containing the words "red, white and blue label," and had registered it without colour, the use by others of labels similarly coloured and containing the words was restrained (c). Another mode of comparing two trade marks is to compare the designs in the same colour (d), but this is more appropriate to cases of opposed registration. When the case is one of passing off, and not of trade mark proper, the colour is sometimes of much importance.

What is infringement.

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

*Croft v. Day.*

In *Croft v. Day* (f), it was remarked by Lord Langdale, M. R., that two things were necessary for the accomplishment of a fraud such as was there contemplated: "First, there must be such a general resemblance of the forms, words, symbols, and accompaniments as to mislead the public; and, secondly, a sufficient distinctive individuality must be preserved, so as to pro-

(a) T. M. Act, 1905, § 10, replacing Patents Act, 1883, § 67.

(b) *Per Ct. of App. in Nuthall v. Fining*, C. A., Jan. 21st, 1889. Cf. *In re La Société Anonyme des Verriers de l'Etoile*, (1894) 2 Ch. 26; *In re Turner*, 11 P. R. 37; *Jarrett v. British North Borneo Cigar Co.*, 37 Sol. J. 116.

(c) *Hanson v. British Tea and Trading*

*Association, Ltd.*, Bacon, V.-C., April 9th, 1884; C. A., June 19th, 1884. The same trade mark was afterwards refused registration under the Patents Act, 1883: *In re Hanson*, 37 Ch. D. 112.

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

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

(f) 7 Beau. 84.

cure for the person himself the benefit of that deception which the general resemblance was calculated to produce. To have a copy of the thing would not do, for, though it might mislead the public in one respect, it would lead them back to the place where they were to get the genuine article, an imitation of which was improperly sought to be sold. For the accomplishment of such a fraud it was necessary in the first instance to mislead the public, and in the next place to secure a benefit to the party practising the deception by preserving his own individuality" (a). In that case, however, a deliberate attempt was made to represent the defendant's establishment as the plaintiff's, and the injury done to the plaintiff by the sale of goods bearing the spurious marks instead of his genuine goods is ordinarily sufficient to entitle him to his remedy, independently of any habit induced in the customer to resort to the defendant instead of to the plaintiff.

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

Tests of infringement.

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

Actual deception.

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

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

(c) *Civil Service Supply Association v. Dean*, 13 Ch. D. 512. Cf. *St. Mungo Co. v. Piper Co.*, 27 P. R. 420.

(d) *Abbott v. Bakers & Confectioners' Tea Association*, W. N. 1871, p. 207; *Field v. Lewis*, Dig. 280. And see *Filley v. Fassett*, 14 Mo. 173; R. Cox, 530; *Dixon Crucible Co. v. Guggenheim*, 2 Brews. 321; R. Cox, 559; and many other cases both in the United Kingdom and the United States.

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

(f) *North Cheshire & Manchester Brewery Co. v. Manchester Brewery Co.*, (1899)

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

Probable  
deception.

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

A. C. 83; *Payton v. Snelling*, (1901) A. C. 308; *Alaska Packers' Association v. Crooks*, 18 P. R. 129; *Bourne v. Swan & Edgar*, (1903) 1 Ch. 211; *Cropper Minerva Machines Co. v. Cropper, Charlton & Co.*, 23 P. R. 388; *Apollinaris Co. v. Duckworth*, 23 P. R. 540; *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *R. v. Autier*, 6 Q. O. R. (Q. B.) 146. In *J. C. & J. Field, Ltd. v. Wügel Syndicate, Ltd.*, 16 P. R. 654, the Court viewed with approval an agreement to limit the number of expert witnesses to be called on each side, and this has sometimes been done. But there may be circumstances in which much weight will be given to expert evidence: *Mitchell v. Henry*, 15 Ch. D. 181; *In re Worthington*, 14 Ch. D. 8; *In re Christiansen*, 3 P. R. 51; *London General Omnibus Co. v. Larrell*, (1901) 1 Ch. 135. In *Wallace & Co. v. King & Co.*, Bomb. High Ct., April 30th, 1879, it was held in the High Court of Bombay that evidence given by European witnesses in Bombay and Manchester as to the probability of deception, was not admissible under the Indian Evidence Act, the witnesses not being experts, and the question not being one of science or art.

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

(b) See *Cartier v. Carlile*, 31 Beav. 292; *Cope v. Evans*, L. R. 18 Eq. 138; *Slater, Rodger & Co., Ltd. v. Stodart*, 26 P. R. 192.

(c) *Blackwell v. Crabb*, 36 L. J. Ch. 504; *Bass v. Hawber*, 19 L. T. N. S. 626; *Cope v. Evans*, L. R. 18 Eq. 138; *Wylam v. Clarke*, W. N. 1876, p. 68; *Condy v. Mitchell*, 37 L. T. N. S. 268, 766; *Wilson v. Maxfield*, L. J. N. of C. 1875, p. 51; *Degraves v. Whiteman*, 5 V. L. R. Eq. 304; *Lamplough v. Bedzler*, C. A., Nov. 12th, 1880; *Massam v.*

*Thorley's Cattle Food Co.*, 14 Ch. D. 748; *Daves v. Davies*, Dig. 426; *Prince Metallic Paint Co. v. Carbon Metallic Paint Co.*, Dig. 573; *Wheeler v. Johnston*, 3 L. R. Ir. 284; *Chinn v. Thomas*, 5 V. L. R. Eq. 188; *Goodwin v. Fenning*, 24 Sol. J. 690; *Amoskeag Manufacturing Co. v. Trainer*, 101 U. S. 51; *Talbot v. Webley*, 3 P. R. 276; *Beldow & Sons v. Boyd*, 4 P. R. 310; *Fogeler Co. v. Middleton*, 81 L. T. (Journal) 45 (where the plaintiffs sold "St. Jacob's Oil," and the defendants sold "St. Joseph's Oil"); *Waterman v. Ayres*, 39 Ch. D. 29; *Great Tower St. Tea Co. v. Smith*, 6 P. R. 165; *Goodall v. Wilkinson*, 90 L. T. (Journal) 357; 91 *ib.* 29; *Rugby Portland Cement Co. v. Rugby & Newbold Portland Cement Co.*, 8 P. R. 241; 9 P. R. 46; *Leahy v. Glover*, 10 P. R. 141; *Smith v. Carron*, 13 P. R. 108; *Cowie v. Herbert*, 14 P. R. 436; *California Fig Syrup Co. v. Taylor's Drug Co.*, 14 P. R. 564; *Parsons v. Gillespie*, (1898) A. C. 239; *Clark v. Sharp*, 15 P. R. 141; *Lever v. Beddingfield*, 16 P. R. 3; *Chameleon Co., Ltd. v. Marshall, Ltd.*, 17 P. R. 527; *Alaska Packers' Association v. Crooks*, 18 P. R. 129; *Goodwin v. Ivory Soap Co.*, 18 P. R. 387; *Bass, Ratcliff & Gretton, Ltd. v. John Davenport & Sons' Brewery, Ltd.*, 19 P. R. 129; *Lambert & Butler, Ltd. v. Goodbody*, 19 P. R. 377; *Bourne v. Swan & Edgar*, (1903) 1 Ch. 211; *N. K. Fairbank Co. v. Cocos Butter Manufacturing Co.*, 21 P. R. 23; *Dawson v. Stewart*, 22 P. R. 250; *Schweppes, Ltd. v. Gibbens*, 22 P. R. 113, 601; *Star Cycle Co. v. Frankenburg*, 23 P. R. 337; 24 P. R. 44; *Hennessy & Co. v. Keating*, 25 P. R. 125; *Aquascutum, Ltd. v. Cohen & Wilks*, 26 P. R. 651; *St. Mungo Co. v. Fiper Co.*, 27 P. R. 420; *Hopton Wood Stone Firms, Ltd. v. Gething*, 27 P. R. 605; *Gillett v. Lumsden Brothers*, 8 Ont.

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

If it is shown that both marks have been used for a number of years and no case of actual deception can be produced, it is strong to show that deception is not probable; and where this circumstance existed, and it was further proved to the satisfaction of the judge that the one mark was not copied from the other, but had an independent origin, and fraud on the part of the defendant was negatived, no injunction was granted, the defendant undertaking to discontinue a doubtful detail in his mark (d); and where the only probability of deception arose from the use of the words "guinea gold," which were contained in two labels registered by the plaintiff and defendant respectively in the same year, and both marks had been used for fourteen years before action brought, an injunction was refused (e).

It is obvious that in these cases questions of considerable nicety may arise; and in the language of Lord Cranworth, C., in *Seixo v. Provezende* (f). "it is hardly necessary to say that, in order to

When is deception probable.

L. R. 168; *Wilson v. Lyman*, 25 Ont. App. R. 303; *Jones v. Petersen & Co.*, Cape Good Hope, 20 S. C. R. 399; *Kirstein, Sons & Co. v. Cohen Brothers*, 39 Can. Sup. Ct. 286; *Liggett & Myers' Tobacco Co. v. Finzer*, 128 U. S. 182; *Morse v. Martin*, Can. Sup. Ct. Cas. Dig. 509; *Marshall v. Hawkins*, 4 N. Z. L. R. Sup. Ct. 59; *Griffiths v. Frankenburg*, 27 P. R. 733. And see *Martell v. Paul Berg Wine & Spirit Co.*, 12 Cape Good Hope, 326.

(a) Per Lord Watson in *Singer Manufacturing Co. v. Loog* (3), 8 App. Cas. 39. And see *Slater, Rodger & Co., Ltd. v. H. Stodart & Co.*, 26 P. R. 192. Thus, "Vincalis" as applied to a sherry was held not to come too near to "Wincarnis" as applied to a red wine: *Coleman v. Brown*, 16 P. R. 619; "Cocosoline" to "Cottoline": *N. K. Fairbank Co. v. Cocos Butter Manufacturing Co.*, 21 P. R.

23; "Colonial" to "Colonel" for golf balls: *St. Mungo Co. v. Viper Co.*, 27 P. R. 420.

(b) Per Lord Selborne, C., in *Singer Manufacturing Co. v. Loog* (3), 8 App. Cas. 18. So in *M. Melachrino & Co. v. R. Melachrino & Co.*, Chitty, J., May 29th, 1888.

(c) *Jarrett v. British North Borneo Cigar Co.*, 37 Sol. J. 116.

(d) *Baker v. Rawson*, 45 Ch. D. 519; see 60 L. J. Ch. 49. And see *Phillips v. Ogden*, 12 P. R. 325; *In re Talbot*, 11 P. R. 77, per Stirling, J.; *Hennessy & Co. v. Keating*, 25 P. R. 125, 361.

(e) *Phillips v. Ogden*, 12 P. R. 325. And see *In re Phillips*, 26 P. R. 121; *Jones v. Petersen & Co.*, Cape Good Hope, 20 S. C. R. 399; *Exshaw & Co. v. Van Ryn Wine & Spirit Co.*, Cape Good Hope, 21 S. C. R. 267.

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

entitle a party to relief, it is by no means necessary that there should be absolute identity (a). What degree of resemblance is necessary, is, from the nature of things, a matter incapable of definition *à priori* (b). All that Courts of Justice can do is to say that no trader can adopt a trade mark so resembling that of a rival as that ordinary purchasers, purchasing with ordinary caution, are likely to be misled (c).

“It would be a mistake, however, to suppose that the resemblance must be such as would deceive persons who should see the two marks placed side by side (d). The rule so restricted would

(a) As to this, see *per* Lord Chelmsford in *Wotherspoon v. Currie*, L. R. 5 H. L. 508; and *per* Malins, V.-C., in *Anglo-Swiss Condensed Milk Co. v. Swiss Condensed Milk Co.*, W. N. 1871, p. 163. And see *post*, p. 152, note (i), and p. 153, note (a).

(b) What will constitute infringement is not to be defined. See *per* Stawell, C. J., in the Sup. Ct. of Victoria in *Hennessy v. White*, 6 W. W. and A'B. Eq. 216.

(c) As to this criterion, see *Archbold v. Sweet*, 1 Mo. & Rob. 162; *Shrimpton v. Laight*, 18 Beav. 164; *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. C. 523 (*per* Lord Cranworth); *Barnard v. Pillow*, W. N. 1868, p. 94; *Anglo-Swiss Condensed Milk Co. v. Swiss Condensed Milk Co.*, W. N. 1871, p. 163; *Wotherspoon v. Currie*, L. R. 5 H. L. 508; *Candy v. Mitchell*, 37 L. T. N. S. 268, 766; *Abbott v. Bakers & Confectioners' Association, Ltd.*, W. N. 1872, p. 31; L. J. N. of C. 1871, p. 199; *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 376, 392, 394; *London & County Banking Co. v. Hampshire & North Wilts Bank*, Dig. 618; *Moses v. Sargood*, Dig. 636; *In re Worthington*, 14 Ch. D. 8; *Liebig's Extract of Meat Co. v. Anderson*, W. N. 1883, p. 185; *In re Christiansen*, 3 P. R. 54; *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 Ch. D. 454; *Lerer v. Goodwin*, 36 Ch. D. 1; *Steinway & Sons v. Henshaw*, 5 P. R. 77; *Upper Assam Tea Co. v. Herbert & Co.*, 7 P. R. 183; *Jarrett v. British North Borneo Cigar Co.*, 37 Sol. J. 116; *Eno v. Dunn*, 10 P. R. 261; *Liebig's Extract of Meat Co. v. Chemists' Co-operative Society*, 13 P. R. 736; *Powell v. Birmingham Vinegar Brewery Co.*, (1896) 2 Ch. 51; (1897) A. C. 710; *Clark v. Sharp*, 15 P. R. 141; *Alaska Packers' Association v. Crooks*, 18 P. R. 129; *Singer Manufacturing Co. v. British Empire Manufacturing Co., Ltd.*,

20 P. R. 313; *Hennessy v. White*, 6 W. W. & A'B. Eq. 216; *Hennessy v. Hogan*, *ib.* 225; *McLean v. Fleming*, 96 U. S. 245; *Daves v. Davies*, Dig. 426; *Colman v. Crump*, 70 N. Y. 573; *Manhattan Medicine Co. v. Wood*, 108 U. S. 218; *Wolfe v. Hart*, 4 V. L. R. Eq. 125; *Ralli v. Fleming*, Ind. L. R. 3 Cal. 417; *Ex parte Kennedy*, 9 V. L. R. (L.) 335; *Champion v. Smith*, 21 N. S. W. R. (Eq.) 110; *Nami Chand v. Wallace*, 34 Cal. 495; *R. v. Antier*, 6 Q. O. R. (Q. B.) 146; *Columbia Mill Co. v. Alcorn*, 150 U. S. 460. In *Singer Manufacturing Co. v. Loog* (3) (8 App. Cas. 18), Lord Selborne, C., says, “The imitation of a man's trade mark, in a manner liable to mislead the unwary, cannot be justified by showing either that the device or inscription upon the imitated mark is ambiguous, and capable of being understood by different persons in different ways, or that a person who carefully and intelligently examined and studied it might not be misled.” Compare *Payton v. Snelling*, 17 P. R. 48; affirmed (1901) A. C. 308; *Payton v. Titus Ward & Co.*, 17 P. R. 58; *Imperial Tobacco Co. (of Great Britain and Ireland), Ltd. v. Parnell & Co.*, 21 P. R. 368, 398; *National Cash Register Co. v. Theenan*, 24 P. R. 211. But it has often been said that in considering this question the Court will have regard to the class of customers who would be likely to buy the goods in respect of which the infringement is alleged, *e.g.*, *In re Pianotist Co., Ltd.*, 23 P. R. 774; *Aquascutum, Ltd. v. Cohen & Wilks*, 26 P. R. 651; *St. Mungo Co. v. Viper Co.*, 27 P. R. 420; *Nami Chand v. Wallace*, 31 Cal. 495. Purchasers of gold ingots or motor cars will be assumed to be more careful buyers than children or servants who buy matches or soap by the pennyworth.

(d) See *Moses v. Sargood*, Dig. 636;

be of no practical use. If a purchaser looking at the article offered to him would naturally be led, from the mark impressed on it, to suppose it to be the production of the rival manufacturer, and would purchase it in that belief, the Court considers the use of such a mark to be fraudulent. But I go farther. I do not consider the actual physical resemblance of the two marks to be the sole question for consideration. If the goods of a manufacturer have, from the mark or device he has used, become known in the market by a particular name, I think that the adoption by a rival trader of *any mark which will cause his goods to bear the same name in the market (a)*, may be as much a violation of the rights of that rival as the actual copy of his device."

*Read v. Richardson*, 45 L. T. N. S. 54; *Ascough v. Johnson & Co.*, 3 Times L. R. 735; *Hubbuck v. Brown*, 17 P. R. 638, 645; *de Kuyper v. N. & G. Baird, Ltd.*, 20 P. R. 581; *Manhattan Medicine Co. v. Wood*, 108 U. S. 218; *Pinto v. Radman*, 8 P. R. 181, 189; *Cochrane v. McNish*, (1896) A. C. 225; *Mitchell v. Joshua Bros.*, 17 V. L. R. 736; *R. v. Autier*, 6 Q. O. R. (Q. B.) 148; *Nami Chand v. Wallace*, 34 Cal. 495; *Doran v. Hogadore*, 11 Ont. L. R. 321.

(a) Thus, where the plaintiff's yarn had become known as "Bhe Hathi," or "two elephant" yarn, from the representation of two elephants on the trade mark, the defendants were restrained from using two different elephants (*Orr-Ewing & Co. v. Johnston & Co.*, 7 App. Cas. 219); where the plaintiff's beer was known as "Dog's Head Beer," the defendants were restrained from using on their beer the head of a different kind of dog from that used by the plaintiffs (*Read v. Richardson*, 45 L. T. N. S. 54); where the plaintiff's clothing was known as "Crown Clothing," from the use of a royal crown, the defendants were restrained from using an imperial crown between two standards (*Moses v. Sargood*, Dig. 636). So, in *Edelsten v. Edelsten*, 1 De G. J. & S. 185, where the plaintiff's wire had acquired the name of "Anchor Wire," because of his trade mark being an anchor, the defendant was restrained from using an anchor in conjunction with a crown. See *Cartier v. Carlile*, 31 Beav. 292; *Cartier v. Westhead*, Dig. 199; *Cartier v. May*, Dig. 200 ("Cross Cotton"); *In re Jelley, Son & Jones*, 51 L. J. Ch. 639 ("Dog brand Files"); *In re Whitely*, 43 L. T. N. S.

627 ("Globe Steel"); *In re Rabone*, Dig. 643 ("Lion" edge tools); *In re Worthington*, 14 Ch. D. 8 ("Triangle Beer"); *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 Ch. D. 451 ("Milkmaid" or "Dairymaid Brand"); *In re Baschiera & Co.*, 33 Sol. J. 469 ("Lion" matches); *Wilkinson v. Griffiths*, 8 P. R. 370 ("Red Medal" Polish); *In re Société Anonyme des Ferreries de l'Etoile*, (1894) 2 Ch. 26 ("Star brand" glass); *In re Dewhurst & Sons, Ltd.*, (1896) 2 Ch. 137 ("Golden Fan" cotton); *Hodgson v. Kynoch, Ltd.*, 15 P. R. 465 ("Lion" soap); *London Road Car Co. v. Era Omnibus Association*, Times, June 23, 1898; *ib.* April 28, 1899 ("Flag" omnibuses); *Price's Patent Candle Co., Ltd. v. Jones' Sundry Compounds Co., Ltd.* ("Ship brand" soap), 19 P. R. 17; *Boord & Son v. Huddart*, 21 P. R. 149; and *Boord & Son v. Thom & Cameron*, 24 P. R. 697 ("Cat and Barrel" gin); and see *Star Cycle Co., Ltd. v. Frankenburgs*, 23 P. R. 337; 24 P. R. 46, 408; *Nitdals Tændstikfabrik v. R. Lehmann & Co.*, 25 P. R. 793; *Aquascutum, Ltd. v. Cohen & Wilks*, 26 P. R. 651; *Taylor v. Virasami*, Ind. L. R. 6 Mad. 108 ("Talwar" shirtings); *Smith v. Fair*, 14 Ont. Rep. 729 ("Red Seal" cigars); *Reiners, Von Laer & Co. v. Fehr*, 9 Cape Good Hope. 145. But in *Curtis, Harrey & Co. v. Kraft, Meyer & Co.*, Chitty, J., June 16th, 1882, it was thought that the German words "Diamant Pulver" were not likely to be mistaken for the English words "Diamond Powder." And see *In re Wills*, (1893) 2 Ch. 262. See also *McLean v. Fleming*, 96 U. S. 245; *Barsalou v. Darling*, 9 Can. Sup. Ct. 677; *Price's Patent Candle Co. v. Everitt*, 11 Cape Good Hope, 213; *Doran v.*



Deception  
of ultimate  
purchaser.

“The principle of law may be very plainly stated, and that is, that nobody has any right to represent his goods as the goods of somebody else” (a), and as the natural consequence of marking goods so as to cause them to bear the same name in the market as those of a well-known firm is to deceive the ultimate purchaser, such deception will be restrained, even though the original purchaser is not deceived (b). “No man is entitled to represent his goods as being the goods of another man, and no man is permitted to use any mark, sign or symbol, device, or other means, whereby, without making a direct false representation himself to a purchaser who purchases from him, he enables such purchaser to tell a lie or to make a false representation to somebody else who is the ultimate customer” (c). “If a man does that, the natural consequence of which (although it does not deceive the person with whom he deals, and is therefore no misrepresentation to him) is to enable that other person to deceive and pass off his goods as somebody else’s, for that he is answerable. But this is confined to those things which in their necessary or natural uses accompany the things sold. For instance, the corks of champagne bottles marked ‘Moët and Chandon’ must be in the bottles sold, and must accompany the bottles. They must necessarily accompany the thing to the retail buyer, and so must labels to be put on the bottles. The very reason for their existence is that they must be put on the bottles, and if they are deceptive and fraudulent, then the person who prepares them is answerable for it. Such things must not be used if their natural and legitimate consequence is, not to deceive the person to whom they are sold, but

*Hogsdore*, 11 Ont. L. R., 321; *Boston Rubber Shoe Co. v. Boston Rubber Co. of Montreal*, 32 Can. Sup. Ct. 315.

(a) Per Lord Halsbury, C., in *Reddaway v. Banham*, (1896) A. C. 199, at p. 204.

(b) See *Singer Manufacturing Co. v. Loog* (3), 8 App. Cas. 15; *Orr-Ewing & Co. v. Johnston & Co.*, 7 App. Cas. 219; *In re Christiansen*, 3 P. R. 54; *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 Ch. D. 454; *Wilkinson v. Griffith*, 8 P. R. 370; *Edge v. Johnson*, 9 P. R. 134; *Brinsmead v. Brinsmead*, 12 Times L. R. 631; 13 *ib.* 3; *Reddaway v. Banham*, (1896) A. C. 199; *Grezier v. Autran*, 13 P. R.

1; *Cochrane v. McNish*, (1896) A. C. 225; *Powell v. Birmingham Vinegar Brewery Co.*, (1896) 2 Ch. 54; (1897) A. C. 710; *Ralli v. Fleming*, Ind. L. R. 3 Cal. 417; *Manockji Petit Manufacturing Co., La. v. Mahalaxmi Spinning & Weaving Co., Ltd.*, Ind. L. R. 10 Bomb. 617; *Sparks v. Harper*, 3 Queens. L. J. 158, 201.

(c) Per James, L. J., in *Singer Manufacturing Co. v. Loog* (3), 18 Ch. D. 412; adopted by Lord Maenaghten in *Reddaway v. Banham*, (1896) A. C. 179. And see *Reddaway v. Frictionless Engine Packing Co., Ltd.*, 19 P. R. 505.

to enable the purchaser to pass off the goods as being the goods of other persons" (a).

And the same principle of preventing that which would deceive the ultimate purchaser is observed where the probability of deception arises, not from the imitation of a trade mark proper, but from copying the peculiar get-up of the plaintiff's goods or from some similar act. In *Lever v. Goodwin* (b) the plaintiffs' soap was got up in a special manner, which had been copied somewhat nearly by the defendants; and Chitty, J., said, "The law applicable to the case is plain: it is founded on fraud. The simplest case is where the seller misrepresents to the buyer that the goods which are being offered for sale are the goods, not of the person who made them, but of some other manufacturer. That is a case merely between the buyer and the seller. Then comes the case where the manufacturer, by devices which are to accompany the goods on their sale in the market, gets them up in such a form as to be calculated to deceive the ultimate buyer into the belief that the goods which he, the manufacturer, is putting on the market are the goods of some other maker. Here, generally speaking, a double fraud is committed: first, there is the fraud which is perpetrated on the ultimate buyer; and, secondly, there is a fraud perpetrated on the other manufacturer, who loses part of his trade. In this class of cases the trade is seldom deceived; the retail dealers know from whom they are buying, and if there is a fraudulent device, they are rarely taken in by it. But in such a case the manufacturer puts an instrument of fraud into their hands. Now, it has been said more than once in this case, that the manufacturer ought not to be held liable for the fraud of the ultimate seller—that is, the shopkeeper or the shopkeeper's assistant; but that is not the true view of the case. The question is whether the defendants have or have not knowingly put into the hands of the retail dealers the means of deceiving the ultimate purchasers" (c).

Deception by  
get-up of  
goods.

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

(b) 4 P. R. 192 (Chitty, J. ; 36 Ch. D. 1 (C. A.). And see *Colman v. Farrow & Co.*, 15 P. R. 198; *Day v. Riley*, 17 P. R. 517; *R. J. Elliott & Co. v. Hodgson*, 19 P. R. 518; *County Chemical Co. v. Frankenburg*, 21 P. R. 722; *Helidon Spa Water Co. v. Hamlyn Spa Water Co.*, 29 V. L. R. 182; *Bryant &*

*May v. Heyde*, N. S. W. 7 L. R. Eq. 72; *Lever Bros. v. Nannucci*, Cape Good Hope, 17 S. C. R. 507; *Coats v. Merrick Thread Co.*, 149 U. S. 562; *Saxlehner v. Eisner*, 179 U. S. 19.

(c) And see *Grezier v. Autran*, 13 P. R. 1; *Bayer v. Baird*, 15 P. R. 615; *Joseph Rodgers & Sons, Ltd. v. Hearnshaw*, 23 P. R. 349; *Jameson v. Dublin Distillers' Co.*, (1900) 1 I. R. 43.

So, in another case (*a*), Kekewich, J., said "The plaintiffs are entitled to have their trade mark protected; and, further than that, they are entitled to have their business protected to this extent, that if any person has used the words which they employ, so as to pass off, or so as to tend to pass off, the goods of that other person as the goods of the plaintiffs, then the plaintiffs are entitled, apart from their trade mark, to insist that that should be restrained." And in *Barlow & Jones, Ltd. v. Johnson & Co.* (*b*), Bowen, L. J., said, "It is an injury to take a name understood in the trade as connoting a particular maker, and to sell goods under it which are not that maker's make; and it is an injury none the less because the immediate vendee is not deceived. If the probable and natural result is that the immediate vendee, though not deceived himself, will use the name so as to deceive others—his ulterior vendees—it is an injury to take the name and use it in that way, and it is a fraud in equity if it is known by the person who takes it that that will be the ultimate and probable result." (*c*).

Infringement  
of essential  
part, or of  
combination.

The infringement of a trade mark may consist in the adoption of the essential part of the plaintiff's trade mark by the defendant, as the word "Eureka" (*d*), or "Glenfield" (*e*), or "Apollinaris" (*f*). And where there is no imitation of the essential part, a resemblance in particulars common to the trade does not constitute an infringement (*g*). But, on the other hand, the in-

(*a*) *Sanitas Co., Ltd. v. Condy*, 4 P. R. 530. And see, *per* Kay, J., in *In re Sanitas Co., Ltd.*, 4 P. R. 533.

(*b*) 7 P. R. 395, 419.

(*c*) And see *Wilkinson v. Griffith*, 8 P. R. 370; *Edge v. Johnson*, 9 P. R. 134; *Singer Manufacturing Co. v. Spence*, 10 P. R. 297; *Singer Manufacturing Co. v. Juno Manufacturing Co.*, 163 U. S. 169.

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

(*e*) *Wotherspoon v. Currie*, L. R. 5 H. L. 508. And see *Jamieson & Co. v. Jamieson*, 15 P. R. 169.

(*f*) *Apollinaris Co. v. Norrish*, 33 L. T. N. S. 242; *Siegert v. Ehlers*, Dig. 432; and *Siegert v. Finnlater*, 7 Ch. D. 801 ("Angostura Bitters"); *Emo v. Stephens* Dig. 609 ("Fruit Salt"); *Reinhardt v. Spalding*, 49 L. J. Ch. 57 ("Family Salve"); *Berliner Brauerei Gesellschaft Tivoli v. Knight, Stocks & Co.*, W. N. 1883, p. 70 ("Tivoli" beer); *Slazenger v. Malings*, W. N. 1885, p. 124

"The Lawford" racquet; *Compania General de Tabacos v. Rehder*, 5 P. R. 61 ("Cavite" cigars); *Laurie v. Baker*, 2 P. R. 213 ("Patent cups"); *Grezier v. Ziemer & Co.*, 89 L. T. (Journal) 117, and *Rey v. Lecouturier*, 2 P. R. 265; 27 *ib.* 268 ("Chartreuse" liqueur); *Cochrane v. McNish*, (1896) 1 C. 225 ("Club" soda water); *Davis v. Kennedy*, 13 Grant, Up. Can. Ch. 523 ("Pain-killer"); *Crawford v. Shuttock*, *ib.* 149 ("Imperial" soap). See also, *per* Cotton, L. J., in *In re Leonard & Ellis*, 26 Ch. D. 288; *Fulcan Match Co. v. Johnson & Co.*, 1 Kyshe, 650.

(*g*) *Locke v. Webster*, Jessel, M. R., April 4th, 1879; *In re Horsburgh*, 53 L. J. Ch. 237; *Rugby Portland Cement Co. v. Rugby & Newbold Portland Cement Co.*, 8 P. R. 241; 9 *ib.* 46; *Leahy v. Glover*, 10 P. R. 141; *Lever v. Bedingfield*, 16 P. R. 3; *Jamieson v. Jamieson*, 15 P. R. 169; *Payton v. Snelling*, 17

fringement may consist in the imitation of the general appearance of the plaintiff's mark, and where both trade marks are of a composite character, it is possible that, though no one particular mark has been exactly imitated, or the principal mark which has been reproduced cannot, for some reason or other, be protected as a trade mark, the combination may be very similar and likely to deceive, and will therefore be restrained by injunction (a).

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

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

P. R. 48; affirmed, (1901) A. C. 308; *Payton & Co., Ltd. v. Titus Ward & Co.*, 17 P. R. 58; *Thomas Hubbuck & Son, Ltd. v. Brown*, 17 P. R. 638; *Marshall v. Sidebotham*, 18 P. R. 43; *Alaska Packers' Association v. Crooks*, 18 P. R. 129; *Hennessy & Co. v. Dompé*, 19 P. R. 333; 20 P. R. 175; *Imperial Tobacco Co. (of Great Britain and Ireland), Ltd. v. Purnell & Co.*, 21 P. R. 368, 598; *B. Warsop & Sons, Ltd. v. Warsop*, 21 P. R. 481; *King & Co., Ltd. v. Gillard & Co., Ltd.*, 21 P. R. 589; 22 P. R. 327; *Colley's Patents, Ltd. v. British Patent Perforated Paper Co.*, 21 P. R. 689; *Schweppes, Ltd. v. Gibbens*, 22 P. R. 113, 601; *Same v. Biscombe*, *ib.* 121, 603; *Hennessy & Co. v. Keating*, 25 P. R. 125, 361; *Slater, Rodger & Co. Ltd. v. Stulart*, 26 P. R. 192; *J. B. Williams Co. v. H. Brownley & Co.*, 26 P. R. 481; *J. B. Williams Co. v. J. B. Newbery & Co.*, 26 P. R. 489; *Aquatantum, Ltd. v. Cohen & Wilks*, 26 P. R. 651; *Wallace & Co. v. King & Co.*, Bomb. High Ct., April 30th, 1879; *Coats v. Merrick Thread Co.*, 149 U. S. 562; *Stachelberg v. Ponce*, 128 U. S. 686; *Marshall v. Hawkins*, 4 N. Z. L. R. Sup. Ct. 59.

(a) *Abbott v. Bakers & Confectioners' Tea Association*, W. N. 1871, p. 207; *ib.* 1872, p. 31; *Hargreaves v. Smith*, Dig. 338; *Lazenby v. Lazenby*, Dig. 160; *In re Barker & Son*, 53 L. T. N. S. 23; *Compania General de Tabacos v. Rehder*,

5 P. R. 61; *Great Tower Street Tea Co. v. Langford & Co.*, 5 P. R. 66; *Ascough v. Johnson & Co.*, 3 Times L. R. 735; *Pinto v. Badman*, 8 P. R. 181, 183; *Rowland v. Mitchell*, 13 P. R. 457; *Liebig's Extract of Meat Co. v. Chemists' Co-operative Society*, 13 P. R. 635 (with which compare *Lerer v. Beddingfield*, 16 P. R. 3); *Colman v. Farrow & Co.*, 15 P. R. 198; *Price's Patent Candle Co., Ltd. v. Ogston & Tennant, Ltd.*, 26 P. R. 797; *Wright, Crossley & Co. v. Bizard*, 27 P. R. 299; *Ralli v. Fleming*, Ind. L. R. 3 Calc. 417; *Whitney v. Hickling*, 5 Grant, Up. Can. Ch. 605; *Davis v. Reid*, 17 *ib.* 69; *Hop Bitters Manufacturing Co. v. Wharton*, 10 V. L. R. (L.) 377; *Martell v. Paarl Berg Wine & Spirit Co.*, 12 Cape Good Hope, 326; *Badische Anilin & Soda Fabrik v. Monckji Shapurji Katrak*, Ind. L. R. 17 Bomb. 581; *California Fig Syrup Co. v. E. Worden & Co.*, 86 Fed. Rep. 212. But see *Blackwell v. Crabb*, 36 L. J. Ch. 504.

(b) *Per* Lord Chelmsford in *Wotherspoon v. Currie*, L. R. 5 H. L. 508. And see *Moses v. Sargood*, Dig. 636; *In re Farina* (2), 27 W. R. 456; *Hennessy v. White*, 6 W. W. & A'B. Eq. 216; *Hennessy v. Hogan*, *ib.* 225; *McLean v. Fleming*, 96 U. S. 245; *Wolfe v. Hart*, 4 V. L. R. Eq. 125; *Heyde v. Wittkowski*, 5 N. S. W. Rep. (E.) 74; *Bryant & May v. Heyde*, 7 N. S. W. Rep. (E.) 72; *Nami Chand v. Wallace*, 34 Calc. 495.

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

Examples.

Thus it was held that "Cacaotine" was a colourable imitation of "Cocoatina" (b), "Steel pens" of "Stephens" (c), "Tung's" of "Tonge's" (d), "Leopoldsalt" of "Leopoldshall" (e), "Lactopepsine" of "Lactopeptine" (f), "Murrilo" of "Muralo" (g), "Cocoine" of "Cocoaine" (h), "Bovina" of "Bovilene" (i). Again, a beehive was held to be a colour-

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

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

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

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

(e) *Raddle v. Norman*, L. R. 14 Eq. 318.

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

(g) *Muralo Co. v. Taylor*, 27 P. R. 261.

(h) *Barnett v. Phalon*, 9 Bos. 192; R. Cox, 376.

(i) *Lockwood v. Bostwick*, 2 Daly, 521; R. Cox, 555. Other instances are:—"Shrewsbury-Marchal Patent Thread" put for "Shrewsbury, Marshall & Co. Patent Thread," *Marshall v. Ross*, L. R. 8 Eq. 651, "Burgiss" for "Burgess," *Burgess v. Hills*, 26 Beav. 244; "Genuine" for "Guinness," *Guinness v. Heap*, Dig. 617; "Derwent" for "Derby," *Derby*

*Photographic Dry Plate Co. v. Pollard, Graham & Co.*, 2 Times L. R. 276; "Condisanitas" for "Sanitas," *Sanitas Co., Ltd. v. Condy*, 4 P. R. 195, 530; "Apollinis" for "Apollinaris," *Apollinaris Co., Ltd. v. Herrfeldt*, 4 P. R. 478; "Steinberg" for "Steinway," *Steinway & Sons v. Henshaw*, 5 P. R. 77; "Demotie" for "Demon," *Slazenger & Sons v. Feltham & Co.*, 6 P. R. 531; "El Divino" and "El Destinacion" for "El Destino," *Pinto v. Trott*, 8 P. R. 173; *Pinto v. Balman*, 8 P. R. 181; "Margarita," for "Flor de Margaretta," *Benedictus v. Sullivan, Powell & Co.*, 12 P. R. 25; "Stafford" for "Trafford," *Smith v. Carron Co.*, 13 P. R. 108; "Savoline" for "Savonol," *J. C. & J. Field & Co., Ltd. v. Wajel Syndicate, Ltd.*, (1900) 1 Ch. 651; "St. Ives" for "St. Ivel" cheeses, *Aplin & Barratt v. Richards*, 20 P. R. 799; "Securine" for "Seccotine" cement, *McCue, Steenson & Orr, Ltd. v. Nichols & Co.*, 21 P. R. 15; "Iron Oxide" for "Iron Ox" tablets, *Iron Ox Remedy Co., Ltd. v. Co-operative Wholesale*

able imitation of a bell of a similar shape, similarly printed on a label (a). Where dealers in condensed milk had adopted, for what they called their "Standard" brand, a trade mark which consisted of a representation of a standard divided into four quarters, which respectively contained four well-known trade marks of other firms in the same trade, the use of the composite mark was restrained on motion by the owners of two of the marks copied (b).

In *Seixo v. Provezende* (c) the plaintiff, a Portuguese noble-

*Seixo v.  
Provezende.*

*Society, Ltd.*, 24 P. R. 425; *Iron Ox Remedy Co., Ltd. v. Leeds Industrial Co-operative Society, Ltd.*, 24 P. R. 434; "Dr. Wilson's Pink Pills for Anæmic People" for "Dr. Williams' Pink Pills for Pale People," *Dr. Williams' Medicine Co. v. Tothill*, Cape Good Hope, 20 S. C. R. 483; and see *Dr. Williams' Medicine Co. v. Alexander*, Cape Good Hope, 22 S. C. R. 589; "Hostetter & Smyte" for "Hostetter & Smith," *Hostetter v. Fowinkle*, 1 Dill. 329; "Rogers & Son" for "J. Rodgers & Sons," *Rodgers v. Philp*, 1 U. S. Pat. Gaz. 29; "Andrew Coe's Superphosphate of Lime" for "Coe's Superphosphate of Lime," *Coe v. Bradley*, 3 *ib.* 541; "Star" for "Stark," *Gardner v. Bailey*, Dig. 365; "Wamyesta" for "Wamsutta," *Wamsutta Mills v. Allen*, 12 Phila. 535. On the other hand, "Ivy," as applied to soap, was held not infringed by "Ivory," *Goodwin v. Ivory Soap Co.*, 18 P. R. 389; nor "Glacier" (transparent paper) by "Glazine," *McCaw, Stevenson & Orr v. Lee*, 23 P. R. 1; nor "Shuron" (sure-on) by "Stay-on" as applied to eye-glasses, *Kirstein, Sons & Co. v. Cohen Bros.*, 39 Can. Sup. Ct. 286.

(a) *Bell, Black & Co. v. Bell & Co.*, Dig. 514. Other instances are:—A crown with "B. B. S." in italics put for a crown with "B. B. H." in Roman characters, *Barrows v. Pelsall Coal & Iron Co.*, Dig. 530; a volcano with a man coming out of it and the words "Volcanic Paraffin Matches" for a volcano with the words "The Vulcan Paraffin Matches," *Vulcan Match Manufacturing Co. v. Kios & Co.*, Pearson, J., June 22nd, 1883; a device of a diamond with a K in the centre for a device of a plain diamond, *Curtis & Harrey v. Pope*, 5 P. R. 146; "Rottgen" with two crosses for "Rodgers" with a star and a cross,

*Rodgers & Sons, Ltd. v. Rottgen*, 5 Times L. R. 678; an ace of spades for an ace of clubs coupled with imitation of the letterpress, *Munday v. Carey*, 22 P. R. 273; a label bearing the device of a cathedral with a river and bridge by another label representing the same group of objects, *Prier's Patent Candle Co., Ltd. v. Ogston & Tennant, Ltd.*, 26 P. R. 797; a pelican with an inscription in gold on a green ground for a crane with an inscription in gold on a green ground, *Balfour & Co. v. Kilburn & Co.*, 1 Hyde, 270; an orb rising over a piece of water with the words "Rising Moon Stove Polish" for an orb with rays rising over a piece of water with the words "Rising Sun Stove Polish," *Morse v. Worrell*, 10 Phila. 168; a sprig of grape vine for a sprig of hop vine, *Hop Bitters Manufacturing Co. v. Wharton*, 10 V. L. R. (L.) 371; a unicorn's head for a horse's head similarly arranged, *Barsalon v. Darling*, 9 Can. Sup. Ct. 677; three Rs arranged triangularly in a triangle for three Bs similarly arranged in a diamond, *Frankau v. Pope*, 11 Cape Good Hope, 209. But in *McCartney v. Garnhart*, 45 Mo. 593, it was held that two picks with a pair of scales, and the words "J. H. Garnhart's Old Bourbon," were not too similar to two anchors and the initials "S. McC." Where the infringement consisted in a general resemblance between labels on "Old Bachelor" tobacco and "Old Coon" tobacco, it was held that the wrong was not remedied by printing across the former the words "Not Old Coon": *McCann v. Anthony*, 21 Mo. App. 83.

(b) *Schnitzer & Co. v. Piggott, Cockson & Co.*, and *Anglo-Swiss Condensed Milk Co. v. Same*, Bacon, V.-C., July 12th, 1884. See Grocer for 1884, p. 37.

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

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

*Wotherspoon  
v. Currie.*

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

If the defendant makes use of a name which is the plaintiff's registered trade mark, it is none the less an infringement if he adds the word "Quality" or "Model" or some similar word (c).

Similarity of  
packing or  
get-up.

Where the goods of one manufacturer are so packed or arranged as externally to resemble those of others engaged in the same trade, as where starch was put up commonly in the trade in packets of a certain colour and appearance, the similarity common to all does not of itself expose the manufacturer to an action, but it makes it incumbent upon him to take care that his distinguishing mark is really distinguishing (d). And where a plaintiff has

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

(b) See also *Thompson v. Montgomery*, 41 Ch. D. 35; (1891) A. C. 217; *Grezier v. Autran*, 13 P. R. 1; *Bewlay & Co. v. Hughes*, 15 P. R. 290; *Rey v. Lecouturier*, 25 P. R. 265; 27 *ib.* 268.

(c) *E.g.*, *Vacuum Oil Co., Ltd. v. Gouch*, 27 P. R. 76; *Bechstein v. Barker*, 27 P. R. 484. Cf. *Armstrong Oiler Co., Ltd. v. Patent Axle-box Co., Ltd.*, 27 P. R. 362,

where oilers were sold as "Armstrong Type Oilers" to customers who knew that the goods were not the plaintiffs', and the defendants escaped.

(d) See *per* Lord Hatherley, C., *Wotherspoon v. Currie*, 5 H. L. 508; also *Colman v. Farrow & Co.*, 15 P. R. 198; *Payton & Co. v. Snelling, Lambert & Co., Ltd.*, (1901) A. C. 308; *Payton & Co. v. Titus Ward & Co.*, 17

been in the habit of packing or getting up his goods in a peculiar and distinctive manner (a), he will be entitled to restrain another from imitating his packages (b), even though his actual trade mark is bad (c); and the imitation of bottles (d) or barrels (e) of a peculiar design, such as is used only by the plaintiff, will afford a strong presumption that fraud is intended. As Cotton, L. J., said in *Lever v. Goodwin* (f), "there may be no monopoly at all in the individual things, but if they are so combined by the defendants as to pass off the defendants' goods as the plaintiffs', then the defendants have brought themselves within the old Common Law doctrine, in respect of which Equity will give to the aggrieved party an injunction, in order to restrain the defendants from passing off their goods as those of the plaintiffs." A good example of this is where the defendants closely imitated the pictorial cards on which the plaintiffs' combs were sold, the combs themselves also being similar (g). It has been held in America (h) that a label, on which is a representation of a box filled with cakes of soap, wrapped in variously coloured paper wrappers and arranged in a particular way, is not infringed by offering for sale boxes containing cakes of soap so wrapped and arranged.

However, where a defendant had, in obedience to express directions, put up his silk in imitation of the plaintiff's bundles, his

Not conclusive.

P. R. 58; *Imperial Tobacco Co. (of Great Britain and Ireland), Ltd. v. Purnell & Co.*, 21 P. R. 368, 598; *Schweppes, Ltd. v. Gibbens*, 22 P. R. 113, 601; *King & Co., Ltd. v. Gillard & Co.*, 22 P. R. 139; *Barford, Ltd. v. Mowling*, 8 C. L. R. 460; *Helidon Spa Water Co. v. Hamlyn Spa Water Co.*, 29 V. L. R. 182. And see *Wurm v. Webster*, 21 P. R. 373, where the complaint was as to the imitation of a uniform for a band.

(a) See *Packham & Co. v. Sturgess & Co.*, 15 P. R. 669, 673, as to the importance of the get-up being special and peculiar; also *County Chemical Co., Ltd. v. Frankenburg*, 21 P. R. 722.

(b) *Great Tower Street Tea Co. v. Langford & Co.*, 5 P. R. 66; *Ascough v. Johnson & Co.*, 3 Times L. R. 735; *Edge v. Harrison*, 8 P. R. 74, 79; *Liebig's Extract of Meat Co. v. Chemists' Co-operative Soc.*, 13 P. R. 737; *Knott v. Marshall*, W. N. 1891, p. 214; *Jones v. Hallworth*, 14 P. R. 225; *Colman v. Farrow & Co.*, 15 P. R. 198; *Hodgson v. Kynoch, Ltd.*, 15 P. R. 465; *Payton & Co., Ltd. v. Snelling, Lambard & Co.*, 16 P. R.

283; *Day v. Riley*, 17 P. R. 517; *Adolph Frankau & Co., Ltd. v. Pfueger*, 26 P. R. 741; *Lever Bros. v. Nannucci*, Cape Good Hope, 17 S. C. R. 507; *Edge v. Nicolls*, 27 P. R. 671; reversed, C. A., Nov. 22nd, 1910.

(c) *Lever v. Goodwin*, 36 Ch. D. 1; *Day v. Riley*, 17 P. R. 517; *McCall v. Theal*, 28 Grant, Up. Can. Ch. 48; *Smith v. Fair*, 14 Ont. Rep. 729; *Sparks v. Harper*, 3 Queensland L. J. 158, 201; *Mitchell v. Joshua*, 17 V. L. R. 736.

(d) *Henry v. Price*, 1 Leg. Obs. 364; *Siebert v. Findlater*, 7 Ch. D. 801; *Fullwood v. Fullwood* (1), W. N. 1873, p. 185; *Grezier v. Autran*, 13 P. R. 1; *Mitchell v. Joshua*, 17 V. L. R. 736; *Saxlehner v. Eisner*, 179 U. S. 19.

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

(f) 36 Ch. D. 1. And see *Bayer v. Baird*, 15 P. R. 615.

(g) *Parker v. Satchwell*, 17 P. R. 713; 18 *ib.* 299.

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



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

User in posters, circulars, &c.

It seems that a trade mark consisting of a device, which causes the trader's goods to be known by a particular name, may be infringed by a poster bearing a similar device (c), but it has been held in Scotland that a word registered as a trade mark is not infringed by its being used in circulars and advertisements in a properly descriptive sense (d).

Infringement must be by use on same class of goods.

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

No infringement where registration wider than user.

And where a trader has registered a trade mark for an extensive class of goods, but has only used it for a small part of the goods in the class, another person does not infringe his rights by using

(a) *Woolham v. Ratcliff*, 1 H. & M. 259. And see *Frese v. Bachof* (1), 13 Bl. C. C. 234; *Sawyer v. Kellogg*, 7 Fed. Rep. 721; 9 *ib.* 601.

(b) *Hennessy v. Kennett*, Dig. 556. But in the Indian case of *Orr-Ewing v. Choonerloll Mullick*, Cor. 150, the defendant was restrained, though there was no evidence of his having sold the spurious goods (which he had bought ready marked) to any one but the plaintiff's agent.

(c) See *Price's Patent Candle Co., Ltd. v. Jeyes' Sanitary Compounds Co., Ltd.*, 19 P. R. 17; *Bourne v. Swan & Edgar*, (1903) 1 Ch. 211; *Anglo-Swiss Condensed Milk Co. v. Pearks, Gunston & Tee*, 20 P. R. 509; 21 P. R. 261; *Star Cycle Co. v. Frankenburgs*, 24 P. R. 46, 405; *Charles P. Kinnell & Co. v. Ballantine*, 26 P. R. 13.

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

(e) *Hall v. Barrows*, 4 De G. J. & S. 150; *Ainsworth v. Walmesley*, L. R. 1 Eq. 518; *Moses v. Sargood*, Dig. 636; *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *In re Whiteley*, 43 L. T. N. S. 627;

*In re Rabour*, Dig. 643; *In re Ashton, Hall*, V.-C., Feb. 26th, 1881; *Colman v. Crump*, 70 N. Y. 573.

(f) *Eno v. Dunn*, 15 App. Cas. 252; *Eastman Photographic Materials Co. v. Griffiths' Cycle Corp.*, 15 P. R. 105; *Premier Cycle Co., Ltd. v. Premier Tube Co., Ltd.*, 12 Times L. R. 181; *Dunlop Pneumatic Tyre Co., Ltd. v. Dunlop-Trussault Cycle Co., Ltd.*, 40 Sol. J. 544; *Same v. Dunlop Lubricant Co.*, 16 P. R. 12; *Chamleon Co., Ltd. v. Marshalls, Ltd.*, 17 P. R. 527; *Valentine Meat Juice Co. v. Valentine Extract Co.*, 17 P. R. 673; *Boord v. Huddart*, 21 P. R. 149; *Finlay v. Shamrock Co.*, 22 P. R. 301; *Dunlop Pneumatic Tyre Co. v. Dunlop Motor Co., Ltd.*, 23 P. R. 761; 24 P. R. 572; *Lucas, Ltd. v. Fabry Automobile Co., Ltd.*, 23 P. R. 33; *Turner's Motor Manufacturing Co., Ltd. v. Miesse Petrol Car Syndicate, Ltd.*, 24 P. R. 572; *Scottish Union and National Insurance Co. v. Scottish Union Insurance Co.*, 25 P. R. 560; 26 P. R. 105; *Warwick Tyre Co., Ltd. v. New Motor Co., Ltd.*, 27 P. R. 161. See *In re Gutta Percha Co. of Toronto, Ltd.*, 26 P. R. 84, 428; *Wamsutta Mills v. Allen*, 12 Phila. 535.

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

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

Rights of agent of foreign firm.

On the other hand, it has been held (c) that the concessionnaire of a spring for a term is not entitled, at all events during the term, to open another spring in the same neighbourhood, and sell

Rights of lessee of spring.

(a) 30 Ch. D. 454. And compare *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 Ch. D. 454; *Hargreave v. Freeman*, (1891) 1 Ch. 39; *Phillips v. Ogden*, 12 P. R. 325; *In re Bott & Co.*, (1898) 2 Ch. 432.

(b) 23 Bl. C. C. 459. And see *In re Apollinaris Co.*, (1891) 2 Ch. 186, 226, 230.

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

the water derived therefrom under the same name as the water derived from the first spring, and in competition with that water.

Sale of materials under name.

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

Infringement of disused mark.

It has been held in America that the use by a manufacturer of a mark previously used by another manufacturer, but discontinued by him for a year, is an infringement of the rights of the latter (*b*); but it is no infringement to use in an honest way a mark which has failed to obtain protection in the hands of another trader by reason of that trader's misstatements; and an infringer of the mark as subsequently used by the honest trader cannot escape by setting up the prior user of the dishonest trader (*c*).

Infringement by use of a registered mark.

Registration of a trade mark which resembles a prior trade mark which is registered, so nearly as to be calculated to deceive, does not prevent the owner of the prior mark from obtaining an injunction to restrain its use (*d*). Where the plaintiff's mark had been registered for an extensive class of goods, and the defendant's mark had been registered for a class which overlapped the plaintiffs' but had been used only for goods distinct from theirs, on the defendant beginning to use his mark on goods included in his registration, but similar to those for which the plaintiffs' mark had been registered and used, his registration was rectified by limiting it to the distinct goods, and an injunction was granted as to the goods on which he was newly using it (*e*). Again, where the proprietors of a mark registered for coffee in 1876 began, in 1889, to apply it to tea, they were restrained from so doing on motion by the proprietor of a similar mark registered for tea in 1877 (*f*).

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

(*b*) *Lemoine v. Gaunt*, 2 E. D. Smith, 313; *R. Cox*, 142. But see *Symonds v. Greene*, 28 Fed. Rep. 531.

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

(*d*) *Read v. Richardson*, 45 L. T. N. S. 54; *Goodwin v. Venning*, 24 Sol. J. 690. Compare *Phillips v. Ogden*, 12 P. R. 325.

And in New South Wales the use of a registered mark has been restrained: *Harris v. Ogg*, 5 N. S. W. Rep. (E.) 114; *Bryant & May v. Heyde*, 7 N. S. W. Rep. (E.) 72.

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

(*f*) *Upper Assam Tea Co. v. Herbert & Co.*, 7 P. R. 183.

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

Infringement by improper use of genuine mark, or on maker's inferior goods.

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

Moulded bottles.

(*a*) *Barnett v. Leuchars*, 13 L. T. N. S. 195 (boxes for "Pharaoh's Serpents"); *Richards v. Williamson*, 30 L. T. N. S. 716 (gun stamps); *Hennessy v. Rohmann*, 36 L. T. N. S. 51; *Hennessy v. Cooper*, Dig. 549 (cases for brandy); *Hennessy v. Neary*, 19 P. R. 36; *John Jameson, Ltd. v. Clarke*, 19 P. R. 255; and see *Major Bros. v. Franklin & Son*, 25 P. R. 406; *Bass v. Laidlaw* (2), 26 P. R. 211.

(*b*) *Hennessy v. Kennett*, Dig. 556; *Hennessy v. White*, 6 W. W. & A' B. Eq. 216; *Hennessy v. Hogan*, *ib.*, 225 (cases intended for brandy of superior quality used for brandy of inferior quality); *Gillott v. Kettle*, 3 Duer, 624; R. Cox, 148 (labels indicating superior pens placed on boxes of inferior ones); *Teicher v. Levy*, 23 P. R. 117; *Kicker, Greer & Co., Ltd. v. Mayman*, N. S. W.

1 S. R. (Eq.) 73; *Ingram v. India Rubber, Gutta Percha and Telegraph Co., Ltd.*, 29 V. L. R. 172. And see *John Jameson, Ltd. v. Clarke*, 19 P. R. 255; *Palestine Wine and Trading Co., Ltd. v. J. Cohen & Co.*, 23 P. R. 568.

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

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

(*e*) *Idris & Co. v. Ward*, C. A. Feb. 11th, 1889.

(*f*) *Welch v. Knott*, 4 K. & J. 747; *Rose v. Loftus*, 47 L. J. Ch. 576. See, however, *Wood v. Burgess*, 24 Q. B. D. 162, a case under the Merchandise Marks Act, 1887; also *Burns v. Turner*, Ct. Sess. Cas. 4th Ser. XXV. 38.

(*g*) 71 L. T. (Journal) 388.

to show that the soda-water in the bottles was of the defendant's manufacture, or that the defendants had filled or sold them. The Master of the Rolls (Sir G. Jessel), however, stated that if some of the plaintiff's engraved bottles had come fairly into the defendants' possession, they would have been entitled to refill and sell them, at all events if they had placed on them their own adhesive labels, so as to cover the plaintiff's name and trade mark. And this opinion appears to have been adopted by North, J., in *Barrett v. White* (a), but it has not met with universal acceptance (b).

Infringement  
by engraver.

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

Untrue  
allegation of  
registration.

It does not appear that the position of a defendant in an action for infringement is altered for the worse by the fact of his having alleged his trade mark to be registered, before it in fact was so (f);

(a) North, J., May 12th, 1883. See also *Woolley & Son v. Morrison* (Sc.), 21 P. R. 63; *Donohoe v. Cherry* (Ir.), 26 P. R. 545; and in the Cape Colony: *United Tobacco Companies v. Crook*, 25 Cape Good Hope S. C. R. 343; and in Australia, *Jones v. Gedge*, 9 C. L. R. 262; and see the cases under the Merchandise Marks Act, 1887, *infra*.

(b) See *Thwaites v. McKelilly* (Ir.), 21 P. R. 397; *Barr & Co. v. Mair & Douglas* (Sc.), 21 P. R. 665; *Burn v. Stone*, 27 Times L. R. 6. So in New South Wales: *Holbrooks, Ltd. v. Parry*, 18 N. S.

W., W. N. 98; and *Champion v. Smith*, 21 N. S. W. L. R. (Eq.) 110.

(c) *Guinness v. Ulmer*, 10 L. T. O. S. 127; *Sarlechner v. Eisner*, 179 U. S. 19.

(d) *Farina v. Silverlock*, 1 K. & J. 509; 6 De G. M. & G. 214; 4 K. & J. 650; *Jameson v. Johnston*, 18 P. R. 259; *De Kuyper v. Witteman*, 23 Fed. Rep. 871; *Holt v. Menendez*, 128 U. S. 182.

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

(f) *Ellis & Sors v. Ruthin Soda Water Co.*, Jessel, M. R., Nov. 21st, 1879.

but by so doing he will expose himself to penalties under § 67 of the Trade Marks Act, 1905 (a).

It seems that a trader is entitled to place his trade mark on articles not of his own make, unless there is some trade custom or contract that he shall not do so, and to remove the maker's mark for the purpose of substituting his own, and that such a course would not be actionable (b). Nor is there any reason why it should be so. The maker's mark has already performed its function when the goods are sold, and when it is removed from the goods the maker ceases to be responsible for the guarantee implied by its presence on them. The purchaser, by substituting his own mark, undertakes the responsibility for the quality of the goods, which are, in effect, selected and guaranteed by him (c), and his right to have a selection mark of his own is recognised in terms by § 3 of the Trade Marks Act, 1905.

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

(a) See also § 3 (1) (e) of the Merchandise Marks Act, 1887.

(b) See *Johnson v. Raylton*, 7 Q. B. D. 438. Compare *Stacey v. Chilworth Gunpowder Co.*, 24 Q. B. D. 90.

(c) See *Hirsch v. Jonas*, 3 Ch. D. 584; *Wood v. Lambert*, 32 Ch. D. 247; *In re Apollinaris Co.*, (1891) 2 Ch. 186, 225, 230, 235; *Leahy v. Glover*, 10 P. R. 141; *In re Wills* (2), (1893) 2 Ch. 262.

## CHAPTER V.

## THE CRIMINAL PROSECUTION.

Remedies for  
fraudulent  
imitations.

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

Infringement  
of trade mark  
not forgery at  
Common Law.

At Common Law the imitation of a trade mark or of a trade wrapper is not a forgery. “A forgery must be of some document or writing” (*b*); “it is the forging of a false document to represent a genuine document” (*c*). In a case in which the prisoner had imitated the label used on Borwick’s baking powder, and was indicted for forgery (*d*), the Court of Crown Cases Reserved, consisting of Pollock, C. B., Willes and Byles, J.J., and Bramwell and Channell, B.B., decided that the conviction for forgery was not sustainable, though an indictment for false pretences would have been good. The grounds of the decision are thus stated by Bramwell, B.: “I think that this was not a forgery. Forgery supposes the possibility of a genuine document, and that the false document is not so good as the genuine document, and that the one is not so efficacious for all purposes as the other. In the present case, one of these documents is as good as the other: the one asserts what the other does; the one is as true as the other; but one gets improperly used. But the question is whether the document itself is a false document. It is said that the wrapper is so like one used by somebody else, that it may mislead; but that

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

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

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

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

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

is not material to the question we have to decide. The prisoner may have committed a gross fraud in using the wrappers for that which was not the genuine powder, and may possibly be indicted for obtaining money by false pretences, but I think he cannot be convicted of forgery" (a).

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

Not even if the mark consists of a signature.

Under the Merchandise Marks Act, 1862 (c), the forgery of trade marks was made a misdemeanour, and the Criminal Law made to cover such offences as those committed in *R. v. John Smith* (d) and *R. v. Closs* (e). And this is so now under the Merchandise Marks Act, 1887 (f).

The Merchandise Marks Act, 1862.

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

1. Forging a trade mark registered in the United Kingdom

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

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

(b) D. & B. 460; 7 Cox, 494. 25 & 26 Vict. c. 68, § 7, now provides for spurious pictures with a forged signature.

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

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

(e) D. & B. 460; 7 Cox, 494. See *R. v. Lloyd* (Recorder of Birmingham, Oct. 13th, 1881), in which the infringement of a gunmaker's trade mark was punished under the Merchandise Marks Act, 1862, with six months' imprisonment. In *R. v. Willis*, C. C. C., September 21st, 1885, Hawkins, J., inflicted six years' penal servitude on a person who had offered for sale watches of base

metal thinly coated with gold and bearing a forged Goldsmiths' Hall mark. In *R. v. Boyes*, C. C. C., April 6th, 1886, the Recorder of London inflicted four months' imprisonment without hard labour for imitation of the prosecutor's perfumes, bottles, and labels. In *R. v. Pemberton*, 20 Iron, 110, the defendant had forged the "Low Moor" trade mark on iron tubes not of the Low Moor Co.'s material or manufacture, and Day, J., inflicted three months' imprisonment without hard labour. See *Cooper v. Hamilton*, 6 N. Z. L. R. 598, as to the practice in New Zealand.

(f) 50 & 51 Vict. c. 28. And see notes to this Act, *infra*.

(g) As to this Act generally, see *Gridley v. Scinborne*, 5 Times L. R. 71; *Wood v. Burgers*, 24 Q. B. D. 162; *Stacey v. Chilworth Gunpowder Co.*, 24 Q. B. D. 99; *R. v. Lipton*, 32 L. R. Ir. 115; *Kirshenboim v. Salmon & Gluckstein*,



- or protected in any British possession or foreign state to which § 103 or 104 of the Patents Act, 1833 (*a*), has been made applicable (*b*).
2. Falsely applying to goods any trade mark as above, or any mark so nearly resembling such a trade mark as to be calculated to deceive (*c*).
  3. Making any die, block, machine, or other instrument for the purpose of forging or of being used for forging a trade mark as above (*d*).
  4. Applying (*e*) to goods any false trade description (*f*);—*i.e.*, any description, statement, or other indication, direct or indirect—
    - (a) As to the number, quantity, measure, gauge or weight of any goods (*g*); or
    - (b) As to the place or country in which any goods were made or produced (*h*); or
    - (c) As to the mode of manufacturing or producing any goods (*i*); or
    - (d) As to the material of which any goods are composed (*k*); or
    - (e) As to any goods being the subject of an existing patent, privilege, or copyright (*l*): or

(1898) 2 Q. B. 19; *Coppen v. Moore* (1), (1898) 2 Q. B. 300; *ib.* 306; *Christie, Manson & Woods v. Cooper*, (1900) 2 Q. B. 522; *Cameron v. Wiggins*, (1901) 1 Q. B. 1; *Huddow v. Neilson*, Ct. of Sess. Cas. 5th Ser. II. 19; *Thwaites v. McErilly*, 21 P. R. 397; *North Eastern Breweries, Ltd. v. Gibson*, 91 L. T. N. S. 78; *Fowler v. Cripps*, (1906) 1 K. B. 16. Also the notes to the Act in Appendix H.

(a) Now § 91 of the Patents and Designs Act, 1907.

(b) §§ 2 (1) (a), 3 (1) and 4.

(c) §§ 2 (1) (b), 3 (1), 5 and 6. And see *Copley v. Kirk*, 84 L. T. (Journal) 140.

(d) §§ 2 (1) (c), 4 and 6.

(e) *Coppen v. Moore* (1), (1898) 2 Q. B. 300; *Langley v. Bombay Tea Co.*, (1900) 2 Q. B. 460; *Lord Advocate v. Jacobs*, (1908) S. C. 90; and *Lord Advocate v. Suits, Ltd.*, *ib.* 1163.

(f) §§ 2 (1) (d), 3, 5 and 6. Compare § 18.

(g) See *R. v. Sherwood*, 7 Cox, 270; *R. v. Ragg*, 8 Cox, 265; *R. v. Lee*, 9 Cox, 460; *R. v. Ananiadi*, Manchester Police Court, July 30th, 1889; *Hooper*

*v. Balfour*, 62 L. T. N. S. 646; *Budd v. Lucas*, (1891) 1 Q. B. 408; *R. v. Lipton*, 32 L. R. Ir. 115; *R. v. Manoukian*, Manchester Police Court, May 10th, 1898; *Star Tea Co. v. Whitworth*, 91 L. T. N. S. 87; *Langley v. Bombay Tea Co.*, (1900) 2 Q. B. 460.

(h) See § 7, with respect to watches; and see *R. v. Lipton*, 32 L. R. Ir. 115; *Bishop v. Toler*, 65 L. J. M. C. 1; *Coppen v. Moore* (1), (1898) 2 Q. B. 300; *Williamson v. Tierney*, 83 L. T. N. S. 592; *Cameron v. Wiggins*, (1901) 1 K. B. 1; *Davenport v. Apollinaris Co., Ltd.*, 89 L. T. N. S. 19; *R. v. Butcher*, 1 Cr. App. R. 54; *R. v. Phillips*, 2 Cr. App. R. 295; *Hooper v. Riddle*, 21 Cox, 177; *Watson v. Dr. Jaeger's Sanitary Woollen System Co.*, 13 Times L. R. 150.

(i) See *R. v. Lipton*, 32 L. R. Ir. 115; *Kirshenboim v. Salmon & Gluckstein*, (1898) 2 Q. B. 19.

(k) See *Morgan v. McAdam*, 36 L. J. Ch. 228; *Fowler v. Cripps*, (1906) 1 K. B. 16; *Meadows v. Cuteshy*, 107 L. T. (Journal) 440; *Davenport v. Apollinaris Co.*, 89 L. T. N. S. 19.

(l) See § 89 of the Patents and Designs

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

By § 4 (b) it is made forgery of a trade mark to falsify a genuine trade mark, whether by alteration, addition, effacement, or otherwise. At Common Law "it is forgery to alter a material part of a true instrument" (h). Thus, where in a bill of exchange "0" was added to "8" and "y" to "eight," so as to make it appear to be for £80 (i). And "the making of any false instrument which is the subject of forgery, with a fraudu-

Additions to and alterations of trade marks.

Forgery at Common Law.

Act, 1907, replacing § 105 of the Patents Act, 1883; and *R. v. Wallis*, 3 P. R. 1; *R. v. Crompton*, 3 P. R. 367; *R. v. Morris*, Great Marlborough Street Police Court, December 16th, 1886; *R. v. Townsend*, 13 P. R. 265.

(a) See *Haddow v. Neilson*, Ct. of Sess. Cas. 5th Ser. II. 19; *Thwaites v. McEvilly*, 21 P. R. 397; *North Eastern Breweries, Ltd. v. Gibson*, 91 L. T. N. S. 78; *Burns v. Turner*, Ct. of Sess. Cas. 4th Ser. XXV. 38; *Donohoe v. Cherry*, 26 P. R. 545; *Stone v. Burn*, 27 Times L. R. 6. And see *post*, Appendix II.

(b) §§ 2 (1) (d), 3, 5 and 6. Compare § 18.

(c) §§ 2 (1) (e), 3 (1) and (4).

(d) §§ 2 (1) (f) and 6.

(e) § 2 (2). See *Christie v. Foster Brewing Co., Ltd.*, 18 V. L. R. 292, where it was held that a corporation might be guilty of offences under the corresponding Victorian Act, and the meaning of "having goods in possession for sale" was discussed.

(f) § 11; *R. v. Manoukian* (2), Manchester Police Court, September 8th, 1903.

(g) § 20. And see Trade Marks Act, 1905, § 68, and Patents and Designs Act, 1907, § 90, as to wrongful assumption of the Royal Arms.

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

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

lent intent, although in the name of a non-existing person, is as much a forgery as if it had been made in the name of one who was known to exist, and to whom it was due" (a). "An exact resemblance, or facsimile, is not required to constitute the crime of forgery, for if there be a sufficient resemblance to show that a false making was intended, and that the false stamp is so made as to have an aptitude to deceive, that is sufficient" (b).

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

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

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

**Official prosecutions.** By the Merchandise Marks Act, 1891 (k), the customs entry relating to imported goods is, for the purposes of the Act of 1887, to be a trade description applied to the goods (l); and provision is made for official prosecutions by the Board of Trade (m). By the Merchandise Marks Act, 1894 (n), the powers conferred by the Act of 1891 upon the Board of Trade may be exercised by the Board of Agriculture in certain cases.

(a) *R. v. Elsworth*, 2 East, P. C. 957. And see *R. v. Lewis*, Foster, Cr. Cas. 116; *R. v. Avery*, 8 C. & P. 596; *R. v. White*, 72 C. C. C. Sessions Papers, 222.

(b) *Per* Grose, J., in *R. v. Collicott*, 2 Leach, 1048, a Stamp case.

(c) See *Coply v. Kirk*, 84 L. T. (Journal) 140.

(d) For a defence on this ground to succeed, it must be proved that the required circumstances existed at the date of the Act; subsequent common user will not do. In *R. v. Rylands*, Times, April 9th and Dec. 9th, 1909

(the "Witney Blanket" case), a defence failed on this ground.

(e) § 18. See the Memorandum at p. 718 issued by the Customs authorities.

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

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

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

(i) § 18.

(k) 54 & 55 Vict. c. 15.

(l) § 1.

(m) § 2.

(n) 57 & 58 Vict. c. 19.

In Ireland the Department of Agriculture has corresponding powers under the Merchandise Marks (Ireland) Act, 1909 (a).

A conviction under these Acts does not relieve the defendant from any civil proceedings (b).

Civil remedy not affected by conviction.

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

Where deception succeeds, indictment for false pretences will lie.

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

Convictions.

(a) 9 Edw. 7, c. 24.

(b) § 19 of the principal Act.

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

(d) 6 Cox, 380.

(e) It was also held that an offer to sell on sale or return was immaterial, the actual bargain being for cash.

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

pretences (a). In *R. v. Suter & Coulson* (b), it was held by the Court of Crown Cases Reserved that a representation that a mark of "18" on a watch was a genuine hall-mark of the Goldsmiths' Company was clearly a false pretence within the statute (c).

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

The case of *R. v. Bryan* (d) gave rise to some differences of opinion in respect to the Law of False Pretences. The prisoner in that case was found by the jury to have obtained money from pawnbrokers on spoons which he had fraudulently represented to have as much silver on them as Elkington's "A" spoons. They also found that he had represented the foundations to be of the best material, knowing that to be untrue, and that in consequence of this he obtained the moneys mentioned in the indictment. The Recorder of London reserved the case for the consideration of the Court of Crown Cases Reserved. Twelve judges heard the case, and of these ten held that the conviction must be quashed, Willes, J., and Bramwell, B., dissenting. The language employed by some of the judges on that occasion, and in particular by Lord Campbell, C.J. (e), led to an impression that in the opinion of the judges it was impossible to convict under the Statute of False Pretences, when the misrepresentation had reference only to quality and not to substance: that is to say, that where, for instance, an infinitesimal quantity of gold was found in a ring represented to be of eighteen-carat gold, the presence of that infinitesimal quantity of gold prevented the false representations from supporting a criminal charge (f). Where the jewellery contained no metal of the kind specified, the prisoner was convicted (g). Anticipating such a result, Bramwell, B.,

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

(b) 10 Cox, 577.

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

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

(e) He said, for instance, that the conviction proceeded upon "a mere misrepresentation, during the bargaining for the purchase of a commodity, of the quality of that commodity." "If the seller were criminally liable for unduly

exaggerating the value of the article, the buyer would be for unduly depreciating." He "found no case in which a mere misrepresentation at the time of sale of the quality of the goods had been held to be an indictable offence."

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

(g) *R. v. Roebuck*, 7 Cox, 126; D. & B. 24. And see *R. v. Ball*, C. & M.

said (a) that the result of the decision would be that the prisoner would be indictable if Elkington's spoons had half an ounce and his none, but not if Elkington's had one ounce, and his a quarter of an ounce.

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

The whole question is now fully explained and set at rest by the judgment in *R. v. Ardley* (e). There the prisoner obtained money for a watch chain which he represented to be of fifteen-carat gold, stamped on every link, but which representation was untrue. In giving judgment, Bovill, C. J., said: "The case which has been most pressed upon us is *R. v. Bryan* (f). The representation in that case was that certain plated spoons were 'equal to Elkington's A.' *Primâ facie* that representation would seem to be a mere matter of opinion, and the Court held that it was not sufficient to support the conviction. But many of the judges expressed the opinion that there might well be cases in which misrepresentations, though as to quality, would be within the statute. Cockburn, C. J., says, 'If the prisoner had represented these articles as being of Elkington's manufacture, when in point of fact they were not, and he knew it, that would be an entirely different thing.' Pollock, C. B., says, 'I think if a tradesman or a merchant were to concoct an article of merchandise expressly for the purpose of

249; *R. v. Stevens*, 1 Cox, 85; and *R. v. Priestley*, 63 C. C. C. Sessions Papers, 541.

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

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

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

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

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

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

deceit, and were to sell it as and for something very different even in quality from what it was, the statute would apply.' It is plain that these learned judges considered that a specific representation of quality, if known to be false, would be within the statute. Coleridge, J., expressly concurs in the observations of Pollock, C. B. Erle, J., at the close of his judgment, says: 'No doubt it is difficult to draw the line between the substance of the contract and the praise of an article in respect of a matter of opinion; still it must be done, and the present case appears to me not to support a conviction, upon the ground that there is no affirmation of a definite triable fact in saying the goods were equal to Elkington's "A," but the affirmation is of what is mere matter of opinion, and falls within the category of untrue praise in the course of a contract of sale, where the vendor has in substance the article contracted for, namely, plated spoons.' Crompton, J., also considered that the statute applies 'where the thing sold is of an entirely different description from what it is represented to be.' Willes, J., who dissented from the judgment of the Court, goes the whole length of saying that a representation as to quality, if known to be false, is enough to support a conviction. And Bramwell, B., leans to the same opinion.

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

Intentional  
misstatement  
as to fact  
punishable.

From this case it follows that where a person has made a false statement in regard to a specific question of fact, knowing that statement to be false, with intent to defraud, and he does defraud by means of that statement, then, even though the statement

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

have reference to the quality of the article, he will be liable to be convicted (a).

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

Wrongful user of trade marks.

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

False pretences as to weight.

By § 67 of the Trade Marks Act, 1905, replacing § 105 of the Patents Act, 1883, penalties are now imposed on persons untruly representing that a trade mark is registered (d).

False pretences as to registration of trade marks.

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

False pretences without words.

(a) On this principle, in New South Wales, a prosecution was directed against a person who had sold German cigars as Havannahs: *Heyde v. Wittkowski*, 5 N. S. W. Rep. (E.) 74.

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

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

(d) See § 3 (1) of the Merchandise

Marks Act; also *Wright, Crossley & Co. v. Dobbin & Co.*, 15 P. R. 21; *MacSymons' Stores, Ltd. v. Shuttleworth*, 15 P. R. 748, in which the decision of the Irish Q. B. D. was approved; and *R. v. Morris*, Great Marlborough Street Police Court, December 16th, 1886.

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



## CHAPTER VI.

## THE CIVIL REMEDY. I.

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

(a) *Singer Manufacturing Co. v. Wilson*, 2 Ch. D. 434, 453.

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

in this sense, that the original purchaser knew perfectly well who was the real manufacturer of the goods, and therefore was not deceived into believing that he had bought goods manufactured by another person; yet if the trade mark was put on the goods for the purpose of enabling that purchaser, when he came to resell the goods, to deceive any one of the public into thinking that he was purchasing the goods of the manufacturer to whom the trade mark properly belonged, then that was equally a deception, a selling of goods with a false representation, which would give the original user of the trade mark a right of action. That was the Common Law right."

An action on the case for deceit at Common Law may then be brought, not only by the person who has been induced to purchase goods manufactured by one maker in the faith that they have been manufactured by another, but also by the maker of whose manufacture the goods in question have falsely been represented to be. It seems at least probable that this principle was recognized as early as the reign of Queen Elizabeth. In *Southern v. How* (a), a case was quoted by Doderidge, J., in which, in that reign, a clothier of Gloucester, who manufactured better cloth than any other person in the trade, had invented and applied to his cloth a special mark to denote his manufacture. Another clothier then pirated this mark and applied it to his own inferior cloth; and it was held in the Court of Common Pleas that an action on the case for deceit would lie against the fraudulent clothier. Whether the action was brought by the buyer of the cloth or by the rival clothier cannot be determined, since the reporters differ on this point; but this much is clear, that Chief Justice Popham (b) reported the case as establishing the right of the defrauded clothier to compensation for the injury done him.

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

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

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

Action may be brought by manufacturer defrauded.

Common Law.  
Right to  
redress.

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

At Common  
Law, fraudu-  
lent intention  
must be  
proved.

According to the strict principles of the Common Law, for an action in respect of a trade mark to be successful, it must be proved that the defendant acted with fraudulent intention. "Proof of fraud on the part of the defendant," says Lord Westbury, C., "is of the essence of the action" (b). The general law on the subject of false representations is summed up by Parke, B., in *Taylor v. Ashton* (c), as being that, independently of any contract between the parties, no one can be made responsible for a representation of such a kind as there was in that case (*i.e.*, a false representation of the flourishing state of a bank, which had induced the plaintiff to take shares), unless it be fraudulently made. The law so enunciated was applied in a succession of trade mark cases at Common Law (d), the effect of which was stated by Lord Westbury as above. But it is not necessary that a person should sit down and say to himself: "I propose to defraud my neighbour," but if a man of common sense and intelligence, knowing his neighbour's rights, sets to work to do things which are necessarily calculated to injure him, he must be taken to be guilty of fraud—that

(a) 5 C. B. 109.

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

(c) 11 M. & W. 415. And see *Derry v. Peck*, 14 App. Cas. 337.

(d) See, among other cases, *Singleton v. Bolton*, 3 Doug. 293; *Crawshay v. Thompson*, 4 Man. & G. 357; *Rodgers v. Nowill*, 5 C. B. 109; *Myers v. Baker*, 3 H. & N. 802. In *Crawshay v. Thompson*, Coltman, J., expressed himself thus: "It appears to me that an intention to deceive is a necessary ingredient in this case. The intention is for the jury;

and fraud must be made out by proof of an intention existing in the mind of the party that the iron should pass as the iron of the plaintiff." And in *Hargreaves v. Smith*, Dig. 238, Lush, J., told the jury that an intention to divert customers from the plaintiffs to the defendant must be proved. See *per* Lord Blackburn in *Singer Manufacturing Co. v. Loog* (3), 8 App. Cas. 15, in the House of Lords; *Lawrie v. Baker*, 2 F. R. 213; *Reddaway v. Dentham Hemp Spinning Co.*, (1892) 2 Q. B. 639, *per* Lopes, L. J.

is to say, of knowingly injuring his neighbour—knowingly violating his neighbour's rights by some false pretence (a). Common Law.

It has been held that intentional fraud cannot be inferred from the fact alone that the plaintiff has informed the defendant that in his opinion the defendant was using a trade mark calculated to deceive, nor even from the fact being that the trade mark so used is really calculated to deceive: there must be evidence that the defendant believed such deception to be probable (b); in other words, that the defendant has sold his goods "as and for" the plaintiff's goods (c). "But," said Lord Blackburn, in *Singer Manufacturing Co. v. Loog* (3) (d), "it is to my mind obvious that, though the defendants might have committed no actionable wrong whilst using the plaintiff's trade mark innocently, yet, if they persevered with the use of it after they had knowledge of the facts, they would do wrong, and there would be evidence to support a claim at law for damages for knowingly selling the defendants' goods as and for the plaintiff's." And in a Canadian case at law (e), it was held that the plaintiff was entitled to damages, though the defendant denied any fraudulent intention, since the mark had been registered for a year as the plaintiff's, and the defendant must be taken to have known it. Defendant must have expected deception.

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

(a) *Pinto v. Badman*, 8 P. R. 181, 184, per Day, J.

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

(c) *Sykes v. Sykes*, 3 B. & Cr. 541; *Morison v. Salmon*, 2 Scott, N. R. 449; 2 Man. & G. 385; *Crawshay v. Thompson*, ubi supra. In equity, it is not necessary to prove fraudulent intention otherwise than by proving that the defendant has used a mark which is, in fact, calculated to deceive; and this was recognised by the Court of Queen's Bench in *Dixon v. Fawcus*, 3 Ell. & Ell. 537. Since, by the Judicature Act of 1873,

§ 25, the rules of Equity are to prevail where they conflict with those of the Common Law, it appears that at least nominal damages should now be recoverable in the King's Bench Division on proof of such facts as would be satisfactory to a Court of Equity. See *Reddaway v. Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639, per Lopes, L. J.

(d) 8 App. Cas. 15.

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

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

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

(h) Compare the language of the Court

Common Law.  
Questions  
for jury.

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

As to the questions to be left to the jury in a case of passing off, it was said by Lindley, L. J., on a motion for a new trial in the case of *Reddaway v. Bentham Hemp Spinning Co.* (d), in which the plaintiffs claimed an injunction to restrain the defendants from using the words "camel hair" in connection with the sale or manufacture of belting by them so as to induce the belief that such belting was of the plaintiffs' manufacture, that "two questions at least should be left to the jury, viz.: (1) What does camel hair belting mean? Does it mean belting made by the plaintiffs as distinguished from belting made by other manufacturers, or does it mean belting of a particular kind without reference to any particular maker? (2) If it has the first of these meanings, then the next question will be, Do the defendants so describe their belting as to be likely to mislead purchasers and to lead them to buy the defendants' belting as and for the belting of the plaintiffs? The second question, if answered in the affirmative, would entitle the plaintiffs to an injunction without proof of any intent to deceive." In the subsequent action of *Reddaway v. Banham* (e), brought by the same plaintiffs against different defendants for similar relief, Collins, J., left the following questions to the jury: (1) Does "camel hair belting" mean belting made by the plaintiffs as distinct from belting made by other manufacturers? Or (2) Does it mean belting of a particular kind without reference to any particular maker? (3) Do the defendants so describe their belting as to mislead

of King's Bench in *Polhill v. Walter*, 3 B. & Ad. 114. And see *Singer Manufacturing Co. v. Wilson*, 2 Ch. D. 434—442, 451—453; and *Singer Manufacturing Co. v. Loog* (3), 8 App. Cas. 15.

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

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

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

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

(d) (1892) 2 Q. B. 639.

(e) (1895) 2 Q. B. 286; (1896) A. C. 199.

purchasers and to lead them to buy the defendants' belting as and for the belting of the plaintiffs? (4) Did the defendants endeavour to pass off their goods as and for the goods of the plaintiffs so as to be likely to deceive purchasers? The fourth question was added at the request of the plaintiffs' counsel, the learned judge considering the first three questions only to be necessary. The jury answered questions (1) (3) and (4) in the affirmative, and question (2) in the negative, and the judge thereupon gave judgment for the plaintiffs. The only material difference between the two cases was that in the latter it was admitted by the plaintiffs that the material of which the belting was made was substantially camel's hair, whereas the former case was decided on the footing that "camel hair" was a fancy name. The Court of Appeal, in reversing the judgment of Collins, J., attached great importance to this distinction, and held that none of the questions left by Collins, J., ought to have been left to the jury, inasmuch as a manufacturer could not be restrained from correctly describing his goods by reason of a rival manufacturer having sold similar goods under the same name, and there was no evidence that the defendants had attempted to pass off their goods as the plaintiffs' otherwise than by the use of the term "camel hair"; and Rigby, L. J., was of opinion that if there had been a case for the jury one of the questions which ought to have been left to them was whether upon the evidence the term "camel hair belting" was a description or a fancy name. The House of Lords, however, restored the judgment of Collins, J., and Lord Macnaghten expressly agreed with the learned judge that the fourth question which he left to the jury was unnecessary (a).

In order to entitle the plaintiff to recover, it must be shown that the defendant's conduct has injuriously affected the plaintiff, and the plaintiff's pleadings must be so framed as to disclose a sufficient cause of action; so that where a banking business was established in London under the same name as a previously existing bank, it was held that the proprietor of the earlier bank could not recover, since he had not averred that he was a banker or had

Common Law.

Plaintiff must be injured.

(a) In *Saxlehner v. Apollinaris Co.*, (1897) 1 Ch. 893, Kekewich, J., adopted the same view. In *Magnolia Metal Co. v. Tandem Syndicate, Ltd.*, 15 P. R. 701,

the questions put to the jury were stated somewhat differently, and hardly in as suitable a form.

Common Law. ever carried on a banking business (a). This case was decided on the same principle on which it was held, in the Court of Chancery, that there was no infringement of trade mark unless there was actually in the market a vendible article to which the mark was in some way attached, and that no right to an injunction existed before the article had, in fact, been produced, even though it had been repeatedly advertised, and considerable outlay so incurred (b).

Costs incurred by defendant's fraud recovered from him.

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

Innocent vendor of goods falsely marked.

It has been held in America that an innocent vendor of goods falsely marked, the genuineness of which he has not warranted, is entitled to maintain an action to recover the price of the goods from a person to whom he has sold them (d).

Damages.

Although it cannot be assumed by the Court, in default of evidence, that the same quantity of goods which a defendant has sold under a trade mark imitated from that of the plaintiff would have been sold by the plaintiff but for the defendant's unfair competition (e), yet, where the whole profit made by an infringer upon the sale of the goods wrongfully marked was awarded by the jury as damages, the American Court held that this was not excessive, and said that the fact that it was impossible to apportion the profit rendered it just that the infringer should lose the whole (f). And in *Taylor v. Carpenter* (g), when the defendant,

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

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

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

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

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

(f) *Graham v. Plate*, 40 Cal. 593; 6 Amer. Rep. 639. And see *Hostetter v. Fawinkle*, 1 Dill. 329.

(g) 2 Wood. & M. 1: 9 L. T. O. S. 514; R. Cox, 32, 42.

against whom a verdict had been found with substantial damages, Common Law. moved for a new trial, urging, among other arguments, that the jury should have been told that if the defendant's goods were not inferior to the plaintiffs', the latter could not recover, or at all events could recover only nominal damages, it was held that the plaintiffs were not only not debarred from recovering at all, but that they could recover substantial damages, "since the actual damage suffered by loss of sales by the plaintiffs, which was the ground of recovery, was just as great as if the thread had been inferior, though the credit of their mark and thread might not suffer as much thereby, if it did at all."

That a plaintiff is entitled to recover some damages where his trade mark has been infringed, appears clearly from *Blofeld v. Payne* (a), in which Lord Denman, C. J., told the jury that even if the defendants' hones were not inferior, the plaintiff was still entitled to some damages, inasmuch as his right had been invaded by the fraudulent act of the defendants. The jury found a verdict for the plaintiff, with a farthing damages, and also found that the defendants' hones were not inferior to the plaintiff's. The verdict was upheld by the Court of King's Bench, Littledale, J., saying that "the act of the defendants was a fraud against the plaintiff, and that even if it occasioned him no specific damage, it was still to a certain extent an injury to his right." It is evident that in this case, although the plaintiff did not suffer in reputation by the sale of inferior hones as his, yet he suffered in another way, his custom being diminished to an undetermined extent by goods being sold as his, so as to compete with those really of his make (b).

Nominal damages where right infringed.

The first recorded case of trade mark brought before the judicial notice of the Court of Chancery was that of *Blanchard v. Hill* (c), in 1742, which, however, resulted in a statement by Lord Hardwicke, C., that he did not know "any instance of granting an

Equity—  
*Blanchard v. Hill.*

(a) 4 B. & Ad. 410.

(b) See *per* Erskine, J., in *Morison v. Salmon*, 2 Scott, N. R. 449; 2 Man. & G. 385; and *per* Wilde, C. J., in *Rodgers v. Nowill*, 5 C. B. 109; *Chappell v. Davidson*, 2 K. & J. 123; *Singer Manufacturing Co. v. Wilson*, 2 Ch. D. 434, 442, 451, 454; *Lawrie v. Baker*, 2 P. R. 213; *Monro v. Hunter*, 21 P. R. 296; and *Bondier v. Depatie*, 3 Dorien, 233;

*Reddaway v. Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; *Alexander & Co. v. Henry & Co.*, 12 P. R. 360, where damages were awarded under both heads. And see *Major Bros. v. Franklin & Son*, 25 P. R. 406. Contrast *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Hipkins v. Plant*, 15 P. R. 294; *Slazenger v. Spalding*, 27 P. R. 20.

(c) 2 Atk. 484.



Equity.

injunction in Chancery to restrain one trader from using the same mark with another," and that he thought "it would be of mischievous consequence to do it."

Growth of jurisdiction of Chancery.

In *Day v. Day* (1816) (a), *Henry v. Price* (1831) (b), and *Gout v. Aleploglu* (1833) (c), however, injunctions were granted to restrain the infringement of the plaintiffs' trade marks, and from this time the steadily increasing number of such cases coming before the Court of Chancery shows the growing favour with which that Court was regarded by suitors, the chief incentive no doubt being the more beneficial character of the remedy awarded, by injunction and account, as compared with the Common Law remedy of damages. By degrees the Court of Chancery absorbed the jurisdiction in trade-mark cases, until such cases were rarely, if ever, tried in the Common Law Courts, except when they were remitted by a Chancery judge for trial of the Common Law right. That practice was discontinued in consequence of Sir John Rolt's Act (d), and the effect was, notwithstanding the extended power given to the Common Law Courts by the Merchandise Marks Act of the same year (e), to confine the consideration of this class of cases more strictly, if possible, than before to the Court of Chancery.

Registration Acts administered by Chancery Division.

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

Board of Trade.

The registrar appointed under the Trade Marks Act is, however, subject to the superintendence of the Board of Trade, which has power to refer all appeals to the Court (h).

Principles adopted in Equity with respect to trade marks.

The principles on which the Courts of Equity have long acted in cases where a valid trade mark has been affixed to the goods or

(a) Dig, 21.

(b) 1 Leg. Obs. 364.

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

(d) 25 &amp; 26 Vict. c. 27.

(e) 25 &amp; 26 Vict. c. 88, § 21.

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

(g) § 117 of Patents Act, 1883; § 3 of Trade Marks Act, 1905.

(h) T. M. Act, 1905, § 59. And see *In re Normal Co., Ltd.*, 35 Ch. D. 231. As to the position of the late Commissioners of Patents, whose functions were transferred to the Board of Trade in 1883, see *In re Meikle*, 24 W. R. 1067; *In re Barrows*, 5 Ch. D. 353; *In re Rotherham*, 14 *ib.* 585.

to wrappers or vessels containing them—principles by which those cases must, as it seems, be governed for the future, before which-ever branch of the High Court of Justice they may come (a)—are thus explained by Sir G. Jessel, M. R., in *Singer Manufacturing Co. v. Wilson* (b).

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

“Another element which is sometimes imported into these cases has also no material bearing: that is, that if the maker knows that they are not the goods of the person entitled to use the trade mark, and communicates that knowledge to the immediate purchaser, it makes, as I have said, no difference; and even if he does not know it, and tells the immediate purchaser that the goods are of his own manufacture, it will still not save him from an injunction, because, although the immediate purchaser from him is aware that the goods in question are not manufactured by any other person than the vendor, yet, as he passes them on, the representation does not necessarily pass on with them, and therefore the next purchaser, or the following or some other purchaser, or the public at large, who are the ultimate purchasers, would be as much deceived as if no such communication took place. Consequently, you have nothing more to do than to show that the trade mark has been taken” (c).

(a) See Judicature Act of 1873, § 25.

(b) 2 Ch. D. 434.

(c) And see *per* Lord Cairns, C., *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 391, and Lord O'Hagan, *ib.* 396; *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 Ch. D. 454; and *per* Bowen, L. J., in *Barlow & Jones, Ld. v. Johnson*,

At first  
Equity fol-  
lowed the  
Common Law.

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

*Millington*  
*v. Fox.*

In the year 1838, however, when the case of *Millington v. Fox* (b) came before Lord Cottenham, C., the Lord Chancellor perceived that when goods made by one man were put upon the market bearing the trade mark of another, the same evil effects were produced, whether the mark was so affixed for fraudulent purposes or with innocent intentions, since purchasers would buy A.'s goods in the belief that they were B.'s, and B. would be deprived of the custom intended for him; so that A., whether by his own contrivance or not, would profit at the expense of B. and the public. In that case it was accordingly held by the Lord Chancellor that the plaintiffs were entitled to an injunction, although he stated in express terms that he saw no reason for thinking that there had been any fraudulent user by the defendant of the plaintiffs' mark (c).

Question as to  
foundation of  
jurisdiction.

The decision in this case gave rise to some difference of opinion among the judges, some holding that the jurisdiction of the Court of Chancery in these cases, like that of the Common Law Courts,

7 P. R. 395, 419; *Cochrane v. McNish*, 13 P. R. 100. So, in Scotland, "on an application for an interdict it is not only not necessary to prove any pecuniary damage, but it is not necessary to prove that any injury has been actually inflicted. A threat of injury is a sufficient ground for an application for an interdict; and in like manner a reasonable apprehension of injury from the proceedings of the parties complained against is also in many circumstances a very good ground for such an application." *Per* the Lord President, in *Singer Manufacturing Co. v. Kimball & Morton*, Ct. Sess. Cas. 3rd Ser. XI. 267. And in India, "it is not enough to say that there was no fraudulent intention. That is no reason why an injunction should not be granted." *Per* Phear, J., *Graham & Co. v. Kerr, Dods & Co.*, 3 Beng. L. R. App. 4.

(a) *Blanchard v. Hill*, 2 Atk. 484;

*Canham v. Jones*, 2 V. & B. 218. Even now the fear of establishing a monopoly is sometimes expressed in connection with the protection of trade marks and trade names. But it is well to remember that, as was well said by Lord Craighill in *Dunnachie v. Young*, Ct. Sess. Cas. 4th Ser. X. 874: "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."

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

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

was founded on intentional fraud, and denying any exclusive right in trade marks (a), while others held that, intentional fraud not being necessary for the injunction, the jurisdiction must be held to be founded on the protection of a right of property in the trade mark (b).

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

The explanation given by Wood, V.-C., of the decision in *Millington v. Fox* (f) and other cases in which relief was given without proof of fraudulent user, was, that it was on the principle "that although a person had used another man's trade mark perfectly innocently, yet if he continued for one moment after he

Deference to  
Common Law.

Principle of  
*Millington*  
*v. Fox* ex-  
plained by  
V.-C. Wood.

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

(b) *Farina v. Silverlock*, 6 De G. M. & G. 214; *Burgess v. Hills*, 26 Beav. 244; *Clement v. Muddick*, 1 Giff. 98; *Emperor of Austria v. Day*, 3 De G. F. & J. 217; *Welch v. Knott*, 4 K. & J. 747; *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Hull v. Barrows*, 4 ib. 150; *McAndrew v. Bassett*, 4 ib. 380; *Leather Cloth Co.'s case*, 4 ib. 137; 11 H. L. C. 523; *Cartier v. Carlile*, 31 Beav. 292; *Moet v. Couston*, 33 ib. 578; *Barnett v. Leuchars*, 13 L. T. N. S. 495; *Maxwell v. Hogg*, L. R. 2 Ch. 307; *Collins Co. v. Reeves*, 28 L. J. Ch. 56; *Bradbury v. Beeton*, 39 ib. 57; *Radde v. Norman*, L. R. 14 Eq. 348; *Hirst v. Denham*, ib. 542; *Smith v. Mason*, W. N. 1875, p. 62; *Apollinaris Co. v. Norrish*, 33 L. T. N. S. 242; *Cheavin v. Walker*, 5 Ch. D. 850; *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 376; *Same v. Loog* (3), 8 ib. 15; *Grillon v. Guénin*,

W. N. 1877, p. 14; *Ransome v. Graham*, 51 L. J. Ch. 897; *Cowen v. Hulton*, 46 L. T. N. S. 897; *Hutchard v. Mège*, 18 Q. B. D. 771; *Oakey & Sons v. Dalton*, 35 Ch. D. 700; and see *Reddaway v. Banham*, (1896) A. C. 199; *Suzlechner v. Apollinaris Co.*, (1897) 1 Ch. 893. So in Scotland—*Singer Manufacturing Co. v. Kimball & Morton*, Ct. Sess. Cas. 3rd Ser. XI. 267; in Ireland—*Kinahan v. Bolton*, 15 Ir. Ch. 75; *Wheeler v. Johnston*, 3 L. R. Ir. 284; in India—*Orr-Ewing & Co. v. Grant, Smith & Co.*, 2 Hyde, 185; in Canada—*Walker v. Alley*, 13 Grant, Up. Can. Clr. 366; in the United States—*Davis v. Kendall*, 2 R. I. 566; R. Cox, 112; *Clark v. Clark*, 25 Barb. 76; R. Cox, 206; *Gillott v. Esterbrook*, 47 Barb. 455; R. Cox, 340; 48 N. Y. 374; *McLean v. Fleming*, 96 U. S. 245; *Kidd v. Johnson*, 100 ib. 617; and many other cases.

(c) 3 My. & Cr. 1.

(d) *Perry v. Truefitt*, 6 Beav. 66; *Rodgers v. Nowill*, 6 Hare, 325; *Foot v. Lea*, 13 Ir. Eq. 484; *Farina v. Silverlock*, 1 K. & J. 509; and others.

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

(f) 3 My. & Cr. 338.

had been told of it to use another man's trade mark, he did so fraudulently, and if he sought to keep in his pocket profits which he had made by representing, however innocently; that his goods were another person's, after he had been told of the fact, it was fraud" (a).

By Lord  
Westbury.

From this view Lord Westbury, C., dissented (b), and the view which he took as to the principles which ought to govern the action of the Courts of Equity was thus stated by him in the *Leather Cloth Cos.' case* (c): "The representation which the defendant is supposed to make, that his goods are the goods of another person, is not actually made otherwise than by his appropriating and using the trade mark which such other person has an exclusive right to use in connection with the sale of some commodity; and if the plaintiff has an exclusive right to use any particular mark or symbol, it becomes his property for the purposes of such application, and the act of the defendant is a violation of such right of property, corresponding with the piracy of copyright or the infringement of a patent. I cannot therefore assent to the dictum that there is no property in a trade mark. It is correct to say that there is no exclusive ownership of the symbols which constitute a trade mark, apart from the use or application of them; but the word 'trade-mark' is the designation of marks or symbols when applied to a vendible commodity, and the exclusive right to make such user or application is rightly called 'property.' The true principle, therefore, seems to be that the jurisdiction of the Court in the protection given to trade marks rests upon property; and that the Court interferes by injunction, because that is the only mode by which such property can be effectually protected. The same things are necessary to constitute a title to relief in Equity in the case of the infringement of the right to a trade mark as in the case of the violation of any other kind of property. First, the plaintiff must prove that he has an exclusive right to use some particular mark or symbol in connection with some manufacture or vendible com-

(a) *McAndrew v. Bassett*, 33 L. J. Ch. 561. See *per* Lord Cairns in *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 376, 391; and *per* Lord Blackburn in that case (*ib.* 400); and in *Singer Manufacturing Co. v. Loog* (3), 8 App. Cas. 15; also *McCaw, Stevenson & Orr, Ltd.*

*v. Nickols & Co.*, 21 P. R. 15.

(b) *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Leather Cloth Cos.' case*, 4 *ib.* 137; *Hall v. Barrows*, *ib.* 150; *McAndrew v. Bassett*, *ib.* 389.

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

modity; and, secondly, that this mark or symbol has been adopted or is used by the defendant so as to prejudice the plaintiff's custom and injure him in his trade or business" (a).

The view taken by Lord Westbury of the existence of property in a trade mark, independently of statute, has, however, not escaped criticism in later years, and the prevailing opinion in recent times is probably in accordance with that expressed by Lord Herschell in the leading case of *Reddaway v. Banham* (b): "The principle which is applicable to this class of cases was, in my judgment, well laid down by Lord Kingsdown in *Leather Cloth Co. v. American Leather Cloth Co.* (c). It had been previously enunciated in much the same way by Lord Langdale in the case of *Croft v. Day* (d). Lord Kingsdown's words were as follows: 'The fundamental rule is that one man has no right to put off his goods for sale as the goods of a rival trader, and he cannot, therefore (in the language of Lord Langdale in the case of *Perry v. Truefitt* (e)), 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.' It is, in my opinion, this fundamental rule which governs all cases, whatever be the particular mode adopted by any man for putting off his goods as those of a rival trader, whether it is done by the use of a mark which has become his trade mark, or in any other way. The word 'property' has been sometimes applied to what has been termed a trade mark at Common Law. I doubt myself whether it is accurate to speak of there being property in such a trade mark, though, no doubt, some of the rights which are incident to property may attach to it. Where the trade mark is a word or device never in use before, and meaningless, except as indicating by whom the goods in connection with which it is used were made, there could be no conceivable legitimate use of it by another person. His only object in employing it in connection with goods of his manufac-

Lord Herschell's view.

(a) In *Walker v. Alley*, 13 Grant, Up. Can. Ch. 366, Van Koughnet, Chancellor of Upper Canada, said: "Some difficulty may be created by the use of the word 'property' in trade marks. It may be said, 'What is property, unless it be something tangible?' I take property, when used in this con-

nection and sense, to be a means by which money or money's worth, in the shape of profit or otherwise, is created or obtained."

(b) (1896) App. Cas. 199, 209.

(c) 11 H. L. C. 538.

(d) 7 Beav. 84.

(e) 6 Beav. 66.

ture must be to deceive. In circumstances such as these the mere proof that the trade mark of one manufacturer had been thus appropriated by another would be enough to bring the case within the rule as laid down by Lord Kingsdown, and to entitle the person aggrieved to an injunction to restrain its use. In the case of a trade mark thus identified with a particular manufactory, the rights of the person whose trade mark it was would not, it may be, differ substantially from those which would exist if it were, strictly speaking, his property. But there are other cases which equally come within the rule that a man may not pass off his goods as those of his rival which are not of this simple character—cases where the mere use of the particular mark or device which had been employed by another manufacturer would not of itself necessarily indicate that the person who employed it was thereby inducing purchasers to believe that the goods he was selling were the goods of another manufacturer.

“The name of a person, or words forming part of the common stock of language, may become so far associated with the goods of a particular maker that it is capable of proof that the use of them by themselves, without explanation or qualification, by another manufacturer would deceive a purchaser into the belief that he was getting the goods of A. when he was really getting the goods of B. In a case of this description the mere proof by the plaintiff that the defendant was using a name, word, or device which he had adopted to distinguish his goods would not entitle him to any relief. He could only obtain it by proving further that the defendant was using it under such circumstances or in such manner as to put off his goods as the goods of the plaintiff. If he could succeed in proving this, I think he would, on well-established principles, be entitled to an injunction.”

In what sense fraud is required in Equity.

Still, whether it is or is not admitted that the Law of Trade Marks is based upon a right of property, fraud also is necessary to entitle the owner of the trade mark to redress (*a*). But the fraud need not necessarily consist in an intention to deceive on the part of the defendant, but may consist in an actual deception, or in the creation of a probability of deception (*b*), indepen-

(*a*) See *per Mellish, L. J.*, in *Singer Manufacturing Co. v. Wilson*, 2 Ch. D. 434, 453.

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

dently of any fraudulent intention. "Imposition on the public," says Lord Westbury (*a*), "is indeed necessary for the plaintiff's title; but in this way only, that it is the test of the invasion by the defendant of the plaintiff's right of property; for there is no injury done to the plaintiff if the mark used by the defendant be not such as may be mistaken, or is not likely to be mistaken, by the public for the mark of the plaintiff. But the true ground of the Court's jurisdiction is property."

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

Intention  
immaterial  
in Equity.

The right in a registered trade mark is strictly a right of property (*d*); the person entitled to it is the proprietor (*e*); he is entitled to the exclusive use of it (*f*); and though his rights in regard to it are in some respects less unlimited than those of owners of other kinds of property—*e.g.*, the inability to transfer it except in connection with the goodwill of the business (*g*)—still, subject to the statutory provisions, he is entitled to deal with it as he chooses.

Right of  
property in  
registered  
mark.

In trade-mark cases, "in order to found the jurisdiction of the Court," says the Lord Chancellor of Ireland (*h*), "there must be established, first, the existence of the trade mark; next, the fact of an imitation, whether a direct imitation, or one with such variations that the Court must regard them as merely colourable; and, thirdly, the fact that the imitations were made without licence or anything that the Court could regard as acquiescence in their use." The law is the same in the three kingdoms,

Elements  
necessary to  
found juris-  
diction.

*Ld. v. Owens*, 6 P. R. 236; *Reddaway v. Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639.

(*a*) *Hall v. Barrows*, 4 De G. J. & S. 150. And see *per* Lord Cranworth, C., in *Farina v. Silverlock*, 6 De G. M. & G. 214; and *per* Jessel, M. R., in *Cheavin v. Walker*, 5 Ch. D. 850.

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

(*c*) Jessel, M. R., in *Singer Manufacturing Co. v. Wilson*, 2 Ch. D. 434. And see *Orr-Ewing & Co. v. Johnston & Co.*,

13 Ch. D. 434; *Reddaway v. Banham*, (1896) A. C. 199; and the cases collected at note (*b*) on p. 183, *supra*.

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

(*e*) §§ 3, 4, 5 of the Act of 1875; §§ 62, 66, 71, 72, 76 of the Act of 1883; §§ 3, 4, 9, 12, &c. of the Act of 1905.

(*f*) § 3 of the Act of 1875; § 76 of the Act of 1883; § 39 of the Act of 1905.

(*g*) § 2 of the Act of 1875; § 70 of the Act of 1883; § 22 of the Act of 1905.

(*h*) *Kinahan v. Bolton*, 15 Ir. Ch. 75.



for, said Bacon, V.-C., in *Singer Manufacturing Co. v. Loog* (3) (a), "the law of Scotland does not in this respect (*i.e.*, with respect to trade marks) differ from the law of England." The principles which govern the one govern the other.

Proceedings  
in Equity.

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

(a) 18 Ch. D. 395.

(b) The injunction may be granted, notwithstanding an offer of submission by the defendants: *Geary v. Norton*, 1 De G. & Sm. 9; *Tonge v. Ward*, 21 L. T. N. S. 480; *Gallice v. Levy*, Eady, J., May 15th, 1906.

(c) *Guinness v. Heap*, Dig. 617; *McLean v. Fleming*, 96 U. S. 245. And see *Reid v. Sibbald*, 18 Journ. of Jurisp. 392.

(d) *Guinness v. Heap*, Dig. 617; *American Tobacco Co. v. Guest*, (1892) 1 Ch. 630.

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

(f) See *infra*, p. 262, note (b).

(g) 31 Beav. 292. And see *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Lever v. Goodwin*, 36 Ch. D. 1; *Saxlehner v. Apollinaris Co.*, (1897) 1 Ch. 893.

(h) Unless the defendant can prove

that he has bought and resold the improperly marked goods without being aware of the true ownership of the trade mark which he is shown to have infringed: *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Moet v. Couston*, 33 Beav. 578; *Hipkins v. Plant*, 15 P. R. 294; *Slazenger v. Spalding*, 27 P. R. 20.

(i) *Neilson v. Betts*, L. R. 5 H. L. 1; *Weingarten v. Bayer* (H. L.), 22 P. R. 341.

(k) *Furina v. Silverlock*, 1 K. & J. 509; 6 De G. M. & G. 214; 4 K. & J. 650; *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Apollinaris Co. v. Edwards*, Seton, 6th ed. 636; *Graveley v. Winchester*, *ib.* 695.

(l) *Dent v. Turpin*, 2 J. & H. 139; *Upmann v. Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. 130.

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

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

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

Consideration shown for innocent infringer.

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

But innocent infringement checked.

Where a manufacturer in this country places an imitation of another manufacturer's trade mark on his goods, or gets up his goods in such a way as to resemble the get-up of the other manufacturer's goods, not with any intention of selling the goods in this country, but with a view of exporting them to another country where the other manufacturer's goods are sold, there to create an unfair competition, relief will be granted in this country.

Infringement for purpose of foreign trade.

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

(b) *Cope v. Evans*, L. R. 18 Eq. 138. And see *Liebig's Extract of Meat Co. v. Hanbury*, 17 L. T. N. S. 298; *Bass v.*

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

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

(d) *Moet v. Couston*, 33 Beav. 578; *Orr-Fwing v. Chooneeloll Mullick*, Cor. 150; *American Tobacco Co. v. Guest*, (1892) 1 Ch. 630; *Hipkins v. Plant*, 15 P. R. 294; *Slazenger v. Spalding*, 27 P. R. 20.

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

Examples of this have frequently occurred in the cotton trade with respect to goods intended for shipment to India and the East (*a*).

Foreign  
fraudulent  
samples.

Although there is no jurisdiction in the English Courts to try a case in which a foreign subject has sent direct to another foreign country, or to a British colony or dependency, goods bearing an infringement of a trade mark used by a British firm in their trade with such country, colony, or dependency, yet, if the spurious goods or samples of them have been sold or offered for sale in the United Kingdom, an action will lie (*b*).

Issue of writ  
for service  
in Scotland  
or Ireland.

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

(*a*) *E.g.*, *Orr-Ewing v. Johnston*, 13 Ch. D. 434; 7 App. Cas. 219.

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

(*c*) 38 Ch. D. 330.

(*d*) 45 Ch. D. 78.

(*e*) 41 Ch. D. 542. Cf. *Morgan Crucible Co., Ltd. v. Vulcan Crucible Co.*, 23 P. R. 229.

the property of the defendants any injunction that might be granted, and that, on the balance of convenience, leave should be given.

In connection with the above, it seems relevant to refer to the cases relating to service out of the jurisdiction of a motion to rectify, to which defendants to an action for infringement so often resort. This point seems first to have arisen in *In re Compagnie Générale d'Eaux Minérales et de Bains de Mer* (a), where an application was made to expunge a mark registered in the name of a foreign company having no place of business in the United Kingdom, and it was held by Stirling, J., that there was no jurisdiction to serve notice of motion on the company, and that the proper course was to serve it on the Comptroller-General of Patents (now Registrar) only, and, after a day had been fixed for the hearing of the motion, to send a letter to the foreign company, with a copy of the notice of motion, stating that an application would be made on the day fixed affecting their interests. A similar practice has since been adopted upon an application to register a trade mark (b), and upon an opposition to registration (c). The course suggested by Stirling, J., was approved by the Court of Appeal in *In re King & Co.* (d), which was, again, a case of rectification, Lindley, L. J., however, doubting whether the notice of motion might not have been properly served on the foreigner, inasmuch as the Court had jurisdiction to rectify the register independently of the service, the only object of which was to give notice to the foreigner of the nature of the proceedings; and it would appear from the last-mentioned case that, provided sufficient notice of the proceedings is given to the proprietor, it is immaterial whether the notice of motion is addressed to him as well as to the Registrar or not, but the course now usually adopted is to address it to the Registrar only. In that case the application was by an English firm to expunge a mark registered in the name of an Irish company having a branch office in London, and, the applicants having sent to the company's office in Ireland a letter informing them of the nature of the application, together with a copy of the notice of motion in which the name of the company had been at first inserted

Motion to expunge mark registered by a foreigner.

(a) (1891) 3 Ch. 451. This was followed in *In re Ashton*, 48 W. R. 389.

(b) *In re Stringer*, 8 P. R. 445.

(c) *In re Robertson, Sanderson & Co.*, 9 P. R. 213.

(d) (1892) 2 Ch. 462.

but afterwards struck out, the Court ordered the mark to be expunged although the company elected not to appear. So in *In re Stringer (a)*, which was a motion to direct the Comptroller to proceed with an application to register an old mark notwithstanding the existence of a similar mark belonging to a Swedish company, where the company received notice by letter of the nature of the proceedings but sent no answer, the Court, upon proof of delivery of the letter to the company, directed the Comptroller to proceed in their absence, without prejudice to any opposition, the applicant undertaking to give due notice to the company of the advertisement. And a similar order was made in *In re Royal Baking Powder Co. (b)*.

Scandal and  
impertinence.

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

Trial without  
a jury appro-  
priate.

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

Interlocutory  
injunction.

It is usual for the plaintiff in trade-mark cases to apply for an interlocutory injunction at an early period. When such an application is to be made, it is the duty of the plaintiff to make it

(a) 8 P. R. 445.

(b) 14 P. R. 425.

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

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

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

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

(g) *E.g.*, *Alexander v. Henry*, 12 P. R. 360.

speedily (*a*), and delay on his part in coming to the Court is liable to be construed as signifying that the case is one which he does not consider to be of an urgent nature, and which, therefore, does not deserve the special favour of the Court (*b*). The plaintiff is, however, entitled to delay long enough to secure the necessary evidence to establish his case (*c*); and although no interlocutory injunction is asked for—as, for instance, where it is rendered unnecessary by reason of the defendant having discontinued the acts of which the plaintiff is complaining—the plaintiff is not precluded from his right to a perpetual injunction, if in other respects he has such a right (*d*), nor from his right to state, if true, that the defendant is acting without authority in what he is doing (*e*).

It has sometimes been argued that in a case of infringement or unfair competition a letter ought to be written before action, cautioning the wrongdoer. The usual result of such a letter is to cause the wrongdoer to tone down his course of procedure, so as to make it more difficult for an action to succeed, while continuing to take advantage of the complainant's reputation, and the necessity for such a letter can hardly be urged now after the observations of Lord Macnaghten in the House of Lords in *Weingarten v. Bayer* (*f*):—"It was also urged that if the plaintiffs really objected to Mr. Charles Bayer taking their scroll, they ought to have written to complain, and told him what they complained of before taking legal proceedings. I cannot think that there is any substance in that objection. Why should a person, assailed and injured by unfair competition, teach his opponent how far he may safely go in undermining a rival business which he wishes to destroy? Why should he throw away the only chance of obtaining, by process of law, redress for injury already done?"

Letter before action.

In the older cases (*g*), the tendency of the Court was to refuse

When granted.

(*a*) *E.g.*, per Romilly, M. R., in *Chubb v. Griffiths*, 35 Beav. 127.

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

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

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

(*e*) *Anderson v. Liebigs Extract of Meat Co., Ltd.* 45 L. T. N. S. 757.

(*f*) 22 P. R. 341, at p. 350. See also pp 263-5, *infra*.

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

to grant an injunction on an interlocutory application, unless the clearest evidence of the plaintiff's right was producible, but rather to send that right to be tested at Common Law. That course of proceeding being now extinct (*a*), some relaxation has taken place, and, in particular, where there is reason to suspect intentional deceit on the part of the defendant, much less absolute proof of the plaintiff's title is required (*b*); and it occasionally happens that after an interlocutory injunction has been granted, it is held at the hearing that the evidence is insufficient to justify any relief being given (*c*). The interlocutory injunction will, however, not be granted where the defendant has innocently infringed, and has withdrawn the offending articles from sale and offered an undertaking immediately on being served with the writ (*d*), nor where there is any considerable conflict (*e*), nor where the plaintiff has been guilty of delay (*f*); and if it is granted the plaintiff will be required to give an undertaking as to damages. When an

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

(*b*) *Radde v. Norman*, L. R. 14 Eq. 348. And see *National Folding Box & Paper Co. v. National Folding Box Co.*, 43 W. R. 156. Also *Jarrett v. British North Borneo Cigar Co.*, 37 Sol. J. 116, where the infringement was innocent. If a defendant's defence and counterclaim contain any allegations of fact which the plaintiff does not desire to admit, he must deal specifically with them: *Benbow v. Low* (2), 13 Ch. D. 553.

(*c*) *E.g.*, in *Alaska Packers' Association v. Crooks*, 16 P. R. 503; 18 P. R. 129; *Parsons v. Gillespie*, (1898) A. C. 239; *Degraves v. Whiteman*, 5 V. L. R. Eq. 304.

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

(*e*) *Green v. Rooke*, W. N. 1872, p. 49; L. J. N. of C. 1872, p. 54; *Farina v. Cathery*, L. J. N. of C. 1867, p. 134; *Hennessy v. Rohmann*, 36 L. T. N. S. 51; *Mitchell v. Henry*, 15 Ch. D. 181; *Coventry Machinists' Co. v. Helsby*, 13 Times L. R. 92; *ib.* 161; *Yost Typewriter Co., Ltd. v. Typewriter Exchange Co.*, 19 P. R. 422; *Star Cycle Co. v. Frankenburgs*, 23 P. R. 337; *Moseley & Sons, Ltd. v. Nathan*, 23 P. R. 345; *Fine Cotton Spinners & Doublers' Association, Ltd. v. Harwood, Cash & Co.*, 24 P. R. 533; *C. A. Peters, Ltd. v. Domestic Inventions Co.*, 25 P. R. 387; *Somervell Bros. v.*

*Cuthbert & Co.*, 12 Cape Good Hope, 255; and other cases. If an interlocutory injunction is asked for on the ground that the defendant claims a right to use the plaintiff's trade mark, but there is evidence that he is not in fact using the mark or threatening an immediate exercise of his alleged right of user, the motion will be ordered to stand to the hearing, as in *Linoleum Manufacturing Co. v. Nairn*, Dig. 536, or refused, with costs, as in *Davis v. Tylor*, Jessel, M. R., July 27th, 1877 ("Ferndale" coal).

(*f*) *Isaacson v. Thompson*, 41 L. J. Ch. 101; *Chinn v. Thomas*, 5 V. L. R. Eq. 188; *Yost Typewriter Co., Ltd. v. Typewriter Exchange Co.*, 19 P. R. 422. In the Irish case of *Grant v. Levitt*, 18 P. R. 361, where a motion for injunction was by consent treated as the trial, a delay of eighteen months was held no bar to an injunction, though the operation of it was suspended for six weeks. In the Scotch case of *Green v. Shepherd*, Ct. of Sess. Cas. 3rd Ser. IV. 1028, the plaintiff having by his summons asked for damages and an interdict, the Court refused a motion for an interim interdict, on the ground that the summons was framed on the footing that there was no case for an interim interdict, and that the plaintiff must first establish his right by recovering damages.

application for an interlocutory injunction is made, but not pressed, by reason of its becoming apparent that there is a serious question to try, leave is frequently given to expedite the trial.

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

Where application for registration pending.

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

Liberty given to move to dissolve.

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

Submission not relieved against.

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

Stay of proceedings after submission.

A plaintiff whose right to his trade mark or get-up is challenged is entitled to have it admitted in open Court, and it seems that under ordinary circumstances a defendant cannot avoid sub-

Right to submission in open Court.

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

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

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

(d) *Curtis & Harvey v. Pape*, 5 P. R. 146. But stopping the infringement at

the commencement of the action has been held in America no ground for withholding an injunction where the defendant put the plaintiff to proof: *Hutchinson v. Blumberg*, 51 Fed. Rep. 829.



mitting to an order in Court and paying the consequent costs, by offering to submit to judgment in chambers (a).

Infringer not entitled to make terms.

When one trader has infringed the rights of another by imitating his trade mark or get-up, he must submit to an injunction, and cannot make terms, as, *e.g.*, that there shall be no advertisement of this order (b).

Form of injunction.

The injunction may be granted in such a form as to restrain the imitation of the general style of the plaintiff's mark, while not interfering with the use of particular features (c), or, if granted so as to restrain the use of particular features, it may be limited so as not to interfere with the use of them absolutely and in all events (d); or, again, it may be granted in such terms as to restrain any imitation of a composite mark as a whole, or of any of the elements of which it is composed (e), or any other form of substitution or passing off (f). And it seems that in cases where the plaintiff's trade is confined to particular parts of the Empire, the injunction may be limited correspondingly (g).

(a) *Gandy v. Flen...*, 18 P. R. 276; *Gallice v. Levy*, Eady, J., May 15th, 1906; *Royal Warrant Holders' Association v. Kitson*, 26 P. R. 157. See, however, *Slazenger v. Pigott*, 12 P. R. 439, where the costs were not to exceed the costs of an application in chambers.

(b) *Hipkins v. Plant*, 15 P. R. 294; *Henry Clay & Bock & Co. v. Phillips*, 27 P. R. 508.

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

(d) *Ford v. Foster*, L. R. 7 Ch. 611; *Braham v. Beachin* (1), 7 Ch. D. 848; *Siegert v. Findlater*, 7 Ch. D. 801; *Massam v. Thorley's Cattle Food Co.*, 14 Ch. D. 748; *Dence v. Mason* (1), Dig. 534; *Orr-Ewing v. Johnston*, 7 App. Cas. 219; *Montgomery v. Thompson*, (1891) A. C. 217; *Thompson v. Bent's Brewery Co.*, 8 P. R. 479; *Grezier v. Autran*, 13 P. R. 1; *In re Thompson*, 13 P. R. 35; *Brinsmead v. Brinsmead*, 12 Times L. R. 631; 13 *ib.* 3; *Magnolia Metal Co. v. Atlas Metal Co.*, 14 P. R. 194; *Reddaway v. Banham*, (1896) A. C. 199, 221, where Lord Macnaghten thought that in all cases where the defendant was to be restrained from using unfairly words or marks which he was at liberty to use provided he used them fairly, the form of injunction is *Orr-Ewing v. Johnston* (7 App. Cas. 219)

ought to be adopted: *Bewlay & Co. v. Hughes*, 15 P. R. 290; *Wheeler v. Johnston*, 3 L. R. Ir. 284; *Whitstable (Free Fishers and Dredgers of) v. Elliott*, W. N. 1888, p. 27; *J. & P. Cash, Ltd. v. Cash*, 19 P. R. 181; *Holloway v. Clent*, 20 P. R. 525; *Daimler Motor Co., (1904) Ltd. v. London Daimler Co., Ltd.*, 24 P. R. 379; *Iron Ox Remedy Co., Ltd. v. Co-operative Wholesale Society, Ltd.*, 24 P. R. 425; *Iron Ox Remedy Co., Ltd. v. Leeds Industrial Co-operative Society, Ltd.*, 24 P. R. 434; *Rey v. Lecouturier*, 25 P. R. 265; 27 *ib.* 268. As to the difference in the form of the injunction to restrain the defendant from using the plaintiff's name where it is also the defendant's name and where it is not, see *Pinet v. Maison Pinet* (1), 14 P. R. 933; and *Pinet v. Maison Pinet* (2), (1898) 1 Ch. 179; 15 F. R. 65.

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

(f) Speaking generally, it is not the practice of the Court in granting an injunction to insert any qualifying words which might leave it open to the defendant to say that the Court had in anticipation laid down a course of conduct which he might pursue: *Kerfoot v. R. A. Cooper, Ltd.*, 25 P. R. 508.

(g) *Barber v. Manico*, 10 P. R. 93; *Carrer v. Bowker*, Dig. 581; *Rodgers & Sons, Ltd. v. Rottgen*, 5 Times L. R. 678;

In the case of an appeal delay is no less fatal than in the proceedings in the Court below (*a*); but no appeal ought to be brought from a refusal to grant an interlocutory injunction if the defendant, while refusing to submit to an injunction or to give an undertaking, removes the cause of complaint (*b*). Where the delay was slight and was caused by the mistaken advice of an official as to the date from which the time for appealing ran, the Court in its discretion, under Order LVIII., rule 5, of the Rules of the Supreme Court granted an extension of time (*c*). Where an injunction had been granted to restrain the sale by the defendant of "The Original Lazenby's Harvey's Sauce," an appeal against the decision was ordered to be advanced, on the ground of the irreparable damage the continuance of the injunction would occasion (*d*). It seems that when the Court of Appeal has overruled a demurrer or objection on a point of law, it will not stay the further hearing of the case with the evidence until after an appeal to the House of Lords from this decision on the point of law is decided (*e*). And where the Court of Appeal ordered a new trial in an action to restrain the defendants from passing off their goods as the plaintiffs', the Court declined to stay the new trial pending an appeal to the House of Lords (*f*).

Where a defendant in a trade mark action continues to use the prohibited trade mark, or a mark insufficiently altered from it (*g*),

Committal  
for contempt.

*Orr-Ewing & Co. v. Johnston & Co.*, 13 Ch. D. 434, 464; 7 App. Cas. 219, 227. And see *Lee v. Haley*, L. R. 5 Ch. 155; and *Cowie v. Herbert*, 14 P. R. 436; *In re Puine* (2), (1893) 2 Ch. 567; and *In re Société Anonyme des Ferreries de l'Etoile* (2), (1894) 1 Ch. 61. It seems, however, that no distinction for this purpose will be drawn between different parts of the United Kingdom: *Cellular Clothing Co. v. Maxton & Murray*, (1899) A. C. 326, 342; *Royal Insurance Co., Ltd. v. Midland Insurance Co., Ltd.*, 26 P. R. 95. Cf. *Alaska Packers' Association v. Crooks*, 16 P. R. 503.

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

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

(*c*) *Reddaway v. Irwell and Eastern Rubber Co., Ltd.*, 24 P. R. 93.

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

(*e*) See *In re Palmer* (2), 22 Ch. D. 88. In that case the question was with reference to an application to strike a mark off the register. In *Fels v. Hodgson & Simpson*, 21 P. R. 95, it was held that the defendant could not agree that if the plaintiff consented to the dismissal of the action he should not be debarred from appealing after the hearing of an appeal in a similar case to the House of Lords, since the result might be to extend the time for appealing.

(*f*) *Edge v. Johnson*, 9 P. R. 134.

(*g*) *Devlin v. Devlin*, 69 N. Y. 212; *Daniel v. Whitehouse* (2), 16 P. R. 71, where North, J., thought that, though the Court had power to commit any person who assisted another in committing a breach of an injunction, a mere servant acting under his master's orders ought not to be joined as a respondent to a motion to commit.

after an injunction has been issued against him, he renders himself liable to committal (a). In order to support the motion to commit, "it should appear clearly that the ordinary mass of customers, paying that attention which persons usually do in buying the article in question, would be easily deceived" (b), and if the plaintiff fails to prove his case strictly, the motion will fail (c). It was said by Lord Langdale, M. R., in *Croft v. Day* (d), that "if the defendants were willing to make a proper distinction, and the plaintiffs refused to attend to their proposal, the Court would itself determine whether the proposed distinction was sufficient." If the defendant sets up acquiescence on the part of the plaintiff, he must make out a case amounting almost to such a licence as to entitle him to proceed against other infringers—such acquiescence, in fact, as to create a new right in him; and in default of such a licence, the order for committal will be made, unless the defendant satisfies the Court of his intention to use a trade mark which will not interfere with the plaintiff's rights (e). Where the contempt committed has not been gross, it is usual not to make an actual order for committal, but only to order the

(a) *Rodgers v. Nowill*, 3 De G. M. & G. 614; *Gillis v. Hall*, R. Cox, 596. On August 8th, 1877, V.-C. Malins made an order to commit the defendant in *Dence v. Mason* (Dig. 570), who had, notwithstanding the injunction, continued to sell goods and issue labels using the name "Brand" thus—"Frank Mason & Co.'s ('Brand's') Essence of Beef," and so on. He was discharged on December 18th, on undertaking not to use the name "Brand" until the hearing of the action: Dig. 570. In *Devlin v. Devlin*, 69 N. Y. 212, the Supreme Court of New York imposed a fine. In *U. S. v. Roche*, 1 M'Crory, 385, it was held that the declaration that the U. S. Statute of 1870 was invalid did not affect the validity of an injunction granted independently of the Act, and that an attachment must issue against a defendant who had committed breaches of the injunction.

(b) *Swift v. Dey*, 27 N. Y. Super. Ct. 611; R. Cox, 319, 324; and see *per* Lord Langdale, M. R., in *Croft v. Day*, 28 Leg. Obs. 378. See also *London General Omnibus Co., Ltd. v. Sullivan* (C. A.), Times, June 1, 1900. In *Braham v. Beachim* (1), 7 Ch. D. 848, an injunction

was granted to restrain the defendants from calling themselves "The Radstock Colliery Proprietors," or saying that they were the proprietors of collieries at Radstock; and it was afterwards held (*Braham v. Beachim* (2), Dig. 633) that the defendants had committed no breach of the injunction by styling themselves "The Radstock Coal and Waggon Co., Colliery Proprietors, Radstock, Somerset." In *Dence v. Brand*, W. N. 1881, p. 31, it was held that the defendant had not committed a breach of an injunction restraining him from representing that he was the original inventor of essence of beef by stating that he was the original manufacturer of that article.

(c) *E.g.*, *Ripley v. John Arthur & Co.*, 19 P. R. 443, where the plaintiffs had obtained an injunction in general terms in default of pleading, and moved to commit without adducing evidence that what the defendants were doing was a breach of the injunction, and the Court was unable to arrive at that conclusion from a mere comparison of the goods themselves.

(d) 28 Leg. Obs. 378.

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

person in contempt to pay the costs of the motion for committal: *e.g.*, where an auctioneer, in contempt of an injunction, offered for sale "Vanity Fair" cigarettes, supposing the notice of motion served on him not to be properly authenticated, but did not actually effect any sale, V.-C. Malins made no order for committal, on his apologising, submitting to the injunction, and paying all the costs (*a*). But a defendant can only be ordered to pay the costs of a motion for committal, if his conduct has been such that a committal might have been ordered (*b*). Where an injunction had been granted to restrain the infringement of a mark on cotton, in which a conspicuous feature consisted of a cross, from which the cotton had become known as "Cross Cotton," and the defendant adopted an altered label, containing the words "Cross Cotton," and otherwise calculated to deceive, Wood, V.-C., refused to order a committal, on the ground that the defendant had ingeniously avoided committing a breach of the injunction, and that the plaintiff had delayed to enforce his right for fifteen months; but he enlarged the terms of the injunction so as effectually to put a stop to the new fraud, and ordered the defendant to pay all the costs (*c*). So where the sole breach of the injunction was by an agent of the defendant's without his knowledge, the Court refused a motion to commit the defendant, but deprived him of costs on the ground that he was civilly liable for the act of his agent (*d*). Sometimes an application is made to commit the editor or publisher of a newspaper on the ground that he has published something prejudicial to the fair trial of a pending action for infringement; but such a motion in *Singer Manufacturing Co. v. Loog* (*e*), based on a newspaper paragraph stating that further proceedings would be taken on the conclusion of the action, was refused, on the ground that the paragraph would have no influence on the trial of the action. Again in *Coats v. Chadwick* (*f*), it was laid down by Chitty, J., that the plaintiff, in an impending action for infringement of trade mark, is at liberty to warn the trade by circular against infringement; but if the warning contains matter which will prejudice the de-

(*a*) *Marcovitch v. Bramble, Wilkins & Co.*, Dig. 595; and see *Daniel v. Whitehouse* (?), 16 P. R. 71; *Palestine Wine and Trading Co., Ltd. v. J. Cohen & Co.*, 23 P. R. 568; *Jefferson, Dodd, Ltd. v. Dodd's Drug Stores, Ltd.*, 25 P. R. 16.

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

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

(*d*) *Parker Manufacturing Co., Ltd. v. Cooper*, 18 P. R. 319.

(*e*) Dig. 635.

(*f*) (1894) 1 Ch. 347.

fence of the action, that is a contempt; and an injunction was granted, the defendants not asking for a committal.

Revivor.

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

Where two marks used.

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

Name used with trade mark.

Moreover, the habitual use of his own name in combination with his verbal trade mark by the manufacturer of the "Eureka" shirts was held not to disentitle him to relief against defendants who had made use of the word "Eureka" though in combination with the name of their own firm (f). But where the name is the only distinctive part of the mark, and that is not taken, no injunction

(a) *Oakey & Sons v. Dalton*, 35 Ch. D. 700; *Rey v. Lecouturier*, 25 P. R. 265; 27 *ib.* 268.

(b) *Republic of Peru v. Reeves*, 40 N. Y. Super. Ct. 516.

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

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

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

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

will be granted in respect of the use by the defendant of a non-distinctive part of the mark. There has, in fact, been no infringement (a).

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

*Singer Manufacturing Co. v. Wilson.*

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

Questions of title to trade marks.

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

Between landlord and tenant of iron works.

In another case (e), A., having for some time leased certain brick works, and also certain mines, from which fire-clay was taken for manufacture at the works, removed his business elsewhere, whereupon B. commenced business at the brick works in question, but did not lease the same mines. A. having filed a bill against B., as fraudulently representing (in effect) that the latter had suc-

Successive lessees of brick works.

(a) *E.g.*, it was held in Scotland that the fact that one firm called their goods "Wotherspoon's Victoria Lozenges," could not prevent another firm from styling theirs "Gray's Victoria Lozenges": *Wotherspoon v. Gray*, Ct. Sess. Cas. 3rd Ser. II. 38. And see *Cooper v. Maclachlan* (Sc.), 18 P. R. 380; 19 P. R. 27. See also the English case of *Hommel v. Bauer & Co.*, 22 P. R. 43, 47; and *Pirie v. Goodall*, (1892) 1 Ch. 35.

(b) *Singer Manufacturing Co. v. Wilson*, 2 Ch. D. 434. Cf. *Singer Manufacturing Co. v. Spence*, 10 P. R. 297; and *Singer Manufacturing Co. v. British Empire Manufacturing Co., Ltd.*, 20 P. R. 313, where relief was granted.

(c) 8 App. Cas. 15.

(d) 3 My. & Cr. 1. See *Dickson v. McMaster & Co.*, 18 Ir. Jur. 202.

(e) *Harper v. Pearson*, 3 L. T. N. S. 547.

ceeded to his business, Vice-Chancellor Wood, in the course of his judgment in favour of the plaintiff, took occasion to intimate that it would have been almost a matter of course to have granted an injunction to the owner of the mines of fire-clay used by A. but not by B., if he had made application for it. This was, indeed, rather a case of fraudulent misrepresentation than of trade mark.

Owner and  
lessee of a  
spring.

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

Manufacturer  
and printer of  
cotton goods.

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

Principal and  
agent.

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

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

(b) *Apollinaris Co., Ltd. v. Scherer*, 23 Bl. C. C. 459; and see *In re Apollinaris Co., Ltd.*, (1891) 2 Ch. 181.

(c) *Amoskeag Manufacturing Co. v. Garner*, 55 Barb. 151; R. Cox, 541; and see *In re Sykes*, 43 L. T. N. S. 626. But see *Amoskeag Manufacturing Co. v. Garner* (2), 54 How. Pr. 298. And compare *Goodfellow v. Prince*, 35 Ch. D. 9, as

to the difference between manufacturer and importer. An injunction has been obtained by one retail dealer against another in respect of the get-up of an article purchased in bulk by both parties from the same manufacturer: *Knott v. Marshall*, W. N. 1894, p. 214. See also *Ullmann & Co. v. Leuba*, 25 P. R. 673.

(d) 12 Phila. 535.

(e) *Hirsch v. Jonas*, 3 Ch. D. 584. See *Dence v. Mason* (1), Dig. 534;

In *In re Apollinaris Co.* (a) it was held by the Court of Appeal that an importer of foreign goods cannot register or claim as his own the trade mark of the foreign producer, whether the goods are produced by a course of manufacture or by a process of nature; nor whether the importer has or has not an exclusive contract for this country; nor whether the producer does or does not consent; and further, that whether an importer can or cannot register as his own the producer's trade marks after the importer has acquired the control of the producer's entire output (which was not distinctly decided), the registration by the importer in his own name, while only having a lesser right, of trade marks belonging to the producer, cannot be rendered valid by the subsequent acquisition by the importer of the right to the whole output. And as an importer cannot register the foreign producer's trade mark, so neither can he, without registration, sue for an infringement (b). It follows that where an importer registers as his own the mark of a foreign producer without his authority, the mark will be ordered to be struck off the register (c); but it has been held in America that an exclusive consignee from a foreign manufacturer may affix a trade mark of his own to the foreign goods, and after ceasing to import such goods may use his trade mark for other similar goods without infringing the rights of the foreign manufacturer, provided that he uses distinctive labels (d).

Manufacturer  
and importer.

In another case (e), a combination mark, which was used on cotton goods manufactured by Ward, and consigned through Robinson, the exporting agent, to Galbraith, the merchant, at Rangoon, consisted of five separate stamps or labels, of which three had been used separately by Robinson, one (in a slightly different form) by Robinson and Galbraith, and the remaining one

Manufacturer  
and exporter.

*J. Defries & Sons v. Electric & Ordnance Accessories Co.*, 23 P. R. 341; *Swift v. Peters*, 11 U. S. Pat. Gaz. 1110; *McLean v. Fleming*, 96 U. S. 245; *Thomson & Co. v. Robertson*, Ct. Sess. Cas. 4th Ser. XV. 880.

(a) (1891) 2 Ch. 186, 226, 230. The name of the spring has since been registered on a special application under the present Act by the foreign company which owned the spring: *In re Apollinaris Co.*, (1907) 2 Ch. 178.

(b) *Richards v. Butcher* (1), 7 P. R. 288.

(c) *In re European Blair Camera Co.*,

13 P. R. 600.

(d) *Société des Huiles d'Olive v. Rorke*, 5 App. D. N. Y. 175; *Saxlehner v. Graef*, 81 Fed. Rep. 704.

(e) *Robinson v. Finlay*, 9 Ch. D. 487. In this case Bacon, V.-C., had held that the mark belonged to the exporter, and it seems that this may be so in a proper case. In *Godillot v. Hazard*, 81 N. Y. 263, the importer was recognised as the proprietor of the mark. Compare *In re "Tarantella" Trade Marks*, 27 P. R. 573, where the exporters from Italy were ordered to be registered jointly with the English importers.



was used for the first time by the three on the goods which passed through the course of dealing above stated; and it was held on appeal that neither Ward nor Robinson had such an exclusive right to the combination as to be entitled to restrain the other from using it. And there are other cases in which both parties have been held to be entitled by long user to use the same mark (a); but for this to be so the user must have been substantial (b).

Exporter and merchant.

A question of a somewhat similar character arose in *In re Jones (c)*. In that case cotton goods were habitually exported by Jones of Manchester to Manilla, for sale there on commission, through Andrews & Co., of Manchester and Manilla, one of the partners in which firm, named Rotschke, was resident at Manilla; and two trade marks were designed and used for the goods which passed through this course of trade. Each of the marks contained a representation of Andrews & Co.'s house of business in Manilla, and, besides this, one of the marks had the name "Andrews & Co.," and the other had that name and also the name "Robert Jones of Manchester" and Rotschke's crest, with a statement that it was Rotschke's trade mark. It was held by Chitty, J., and the Court of Appeal that there was no contract that, after the joint adventure came to an end, either party was to be entitled, as against the other, to use or register the trade marks, and that if there had been such a contract it could not have been enforced, since, having regard to the composition of the marks, the result would be to deceive the public.

Manufacturer and merchant.

The construction of an agreement between two parties with respect to a mark on brandy had to be determined by the Court in *In re Rivière (d)*, in which it was held by Pearson, J., and the Court of Appeal that the true purport of the arrangement was that the mark in question, which had been used and registered by Rivière & Co., the French manufacturers, in France, before it was adopted by McDowell & Co., wine and spirit merchants, in Madras, was to be used exclusively by McDowell & Co. so long

(a) *Day v. Neale*, Bacon, V.-C., May 24th, 1881; *Binbow v. Low* (4), 44 L. T. N. S. 875; and other cases cited at p. 125, note (a).

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

(c) 53 L. T. N. S. 1.

(d) 53 L. T. N. S. 237. See *In re Roger* (2), 12 P. R. 149; *Freeman Bros. v. Sharpe Bros. & Co., Ltd.*, 16 P. R. 205; *R. Thorne & Sons, Ltd. v. Pimms, Ltd.*, 26 P. R. 221; *Lavergne v. Hooper, Ind.* L. R. 8 Mad. 149.

only as they took their brandy from Rivière & Co., and was only to be used by them on such brandy; and that on McDowell & Co. ceasing to take their brandy from Rivière & Co. the original right of the latter to the mark was to revive.

In *Winsor v. Clyde (a)*, it was held that a firm who had carried on business as shippers of merchandise by ships which they did not own, but of which they had the entire management while loading and unloading, &c., and who had denominated each line of vessels used by them and plying in a particular direction by the name of "The Keystone Line for ———," had acquired a right of property in the name, and were entitled to restrain the use of the name by another firm who owned the ships employed by the former firm for a certain period on one of their lines, after the termination of the connection, the latter firm having had at best a revocable licence to use the name. Shipper and shipowner.

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

In the "Chartreuse" case the monks of the Grande Chartreuse had been expropriated and expelled by the French Government, and their business establishment, goodwill, trade marks, &c., had been sold by the liquidator to a company which became the owner of the French business and continued to carry it on, using the same marks and names. The monks had, however, manufactured their liqueur under a secret process which had not been disclosed, though there was evidence to show that there was little, if any, difference between their liqueur and that of the new company. It was held by the Court of Appeal and the *Rey v. Lecouturier.*  
"Chartreuse."

(a) 9 Phila. 513.

(b) *Yale Cigar Manufacturing Co. v. Yale*, 30 U. S. Pat. Gaz. 1183. See *Hayward Bros., Ltd. v. Peakall*, 26 P. R. 89.

House of Lords that in the United Kingdom the goodwill, trade marks, &c. had not been transferred to the new company, and an injunction was granted to restrain them from carrying on business in England in the same way as the monks had done, and in which the company alone was legally entitled to carry on business in France (a).

Secret recipe. Again, in *Cotton v. Gillard* (b), it was decided by the Master of the Rolls that a man had no right to use a trade mark applied to a sauce with the composition of which he was unacquainted, even though he had, as he believed, bought that right from the person entitled to the same; it followed that he could not prevent its use by the person acquainted with the secret, of which he had in fact been the inventor. But it has been held in America (c) that a person who has been accustomed to manufacture for another, in accordance with the latter's instructions, may receive an assignment of the trade mark which has been habitually used on the goods so manufactured. And it seems that where an article known by a particular name or mark has been manufactured by partners, of whom one has been acquainted with the secret of the process and the other not, the former cannot, after the dissolution of the partnership, restrain the other from using the name or mark, for the right therein of the one partner is equal to that of the other (d).

Registered trade marks.

With respect to registered trade marks, such difficulties can seldom arise in the future, since it is the registered proprietor who has, *primâ facie*, the exclusive right to the mark (e), subject only to the possibility of a rectification of the register (f).

(a) *Rey v. Lecouturier*, 25 P. R. 265; 27 *ib.* 268. And compare the observations of Lord Herschell and Lord Davey in the "Yorkshire Relish" case, *Powell v. Birmingham Vinegar Brewery Co.*, (1897) A. C. 710, at pp. 716, 717.

(b) 44 L. J. Ch. 90. Compare *Coffeen v. Brunton*, 5 McLean, 256; R. Cox, 132; *Taylor v. Bemis*, 4 Biss. 406.

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

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

(e) In the Scotch case of *Dunnachie v. Young & Sons*, Ct. Sess. Cas. 4th Ser. X. 874, the name "Glenboig" was used and

registered by two companies trading as brickmakers on the Glenboig estate for the bricks made there, and a third firm carrying on the same business in the neighbourhood of the Glenboig estate began to use the name, alleging that it was descriptive of all bricks made of the seam of clay which ran through the Glenboig estate, and which they alleged that they were working. The Court of Session, however, decided against this contention, and granted an interdict at the suit of the two companies. See also *Montgomerie v. Donald & Co.*, Ct. Sess. Cas. 4th Ser. XI. 506; *Hayward Bros., Ltd. v. Peakall*, 26 P. R. 89.

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

It is, therefore, of great importance that the registration should be effected in a form which will recognise all existing rights. Thus, in *Ex parte Hemming & Son* (a), in which recent occupiers of a needle mill were registering the name of the mill as their trade mark, a note was appended to the entry on the register, stating that the registered proprietors did not claim the exclusive right to the use of the name so as to prevent the owner or occupier for the time being from using the name for any legitimate purpose. If the name of the wrong person has been placed on the register, the rightful owner ought to apply for rectification (b).

It occasionally happens that a trade mark becomes vested in more than one person. The question then arises whether either of these is entitled to succeed in a suit against an infringer, to which the other person entitled is not a party. In a case of this description, *Shadwell, V.-C.*, gave it as his opinion, that whether the plaintiff had the right in himself, or jointly with some other persons, he still had sufficient right to bring forward the case (c). In *Dent v. Turpin* (d), *Wood, V.-C.*, decided in accordance with this view, saying that the plaintiff had a clear right to an injunction and the erasure of the spurious marks, without making the other person interested a party, while as to the account, only the plaintiff's share having been prayed for, that, though it might be difficult to ascertain, was yet ascertainable. In any case, the wrong-doer had no right to complain of any technical difficulty arising from his own wrongful act, though the result was to involve him in two suits instead of one. In *Southorn v. Reynolds* (e), he decided in the same way, saying that his previous decision had not been interfered with (f). So, in the Scotch case of *Dunnachie v. Young & Sons* (g), the name "Glenboig" was used and registered as the trade mark of one company, and

More than one proprietor.

(a) *Jessel, M. R.*, April 27th, 1881.

(b) Thus, in *Rey v. Lecouturier*, 25 P. R. 265; 27 *ib.* 268, the liquidator's name had been placed on the register, but this was removed on application by the monks, who were held not to have lost their rights.

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

(d) 2 J. & H. 139. Compare *In re Ehrmann*, (1897) 2 Ch. 495; *Whitstable Oyster Fishery Co. v. Hayling Fisheries*,

*Ld.*, 17 P. R. 461; 18 P. R. 434, where concurrent rights were claimed in a trade name.

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

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

(g) Ct. Sess. Cas. 4th Ser. X. 874.

as part of the trade mark of another company, and an interdict was granted in an action in which the two companies were co-plaintiffs, to restrain the use of the name by a third company.

Partnership  
trade mark.

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

*Delondre v. Shaw.*

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

Prize  
medallist.

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

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

(b) 2 Sim. 237. And see *Page v. Townsend*, 5 Sim. 395.

(c) It should be observed that the reason given by Mr. Bickersteth (afterwards Lord Langdale and M. R.), who argued the case, for the joinder of Pelletier as a co-plaintiff, was that, though having no interest in the medicine, he yet was entitled to prevent his name being used. It is further to be observed, that the subsequent decision of Lord Langdale, in *Clark v. Freeman*, 11 Beav. 112, does not conflict with the position taken up by him in *Delondre v. Shaw*, since Pelletier not only manufactured the medicine, but supplied it to Delondre, so that he had a pecuniary interest in the maintenance of his reputation. *Clark v. Freeman* (as to which see p. 308, *infra*) was decided on the

point that the plaintiff did not manufacture or sell pills.

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

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

(f) 1 H. & M. 264.

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

The person sought to be enjoined in a trade mark case is commonly a rival manufacturer, who is using the spurious mark to promote the sale of his own commodities. The fact that the fraud has been committed by a servant of the trader makes no difference, for principals "are bound to know what their agents do, and if they do not know, they are responsible exactly as if they did know." Hence, where a defendant's manager had affixed to his master's goods, without the knowledge of the latter, as he alleged, a ticket infringing the rights of the plaintiff, an injunction was granted against the master, with costs (a). And, similarly, where a clerk had sold goods in a spurious wrapper, with a verbal representation that the goods and wrapper were genuine (b). But if there has been only a single instance of passing off by a servant, who has since left his master's employment, the case is not one in which an injunction ought to be granted against the master (c). Nor does any liability of the employer relieve the servant or agent from his personal responsibility (d).

Infringement  
by servants.

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

Agents.

The remedy will, however, not only be awarded against such persons as are to profit directly by the perpetration of a fraud,

Engravers.

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

(b) *Low v. Hart*, 90 N. Y. 457; *Havana Cigar and Tobacco Factories, Ltd. v. Tiffin* (1905) *Ld.*, 26 P. R. 473. And see *Grierson, Oldham & Co., Ltd. v. Birmingham Hotel & Restaurant Co., Ltd.*, 18 P. R. 158, 159, and *Monro v. Hunter*, 21 P. R. 296, where injunctions were granted notwithstanding that the servant was acting (as was alleged) contrary to the instructions of his master.

(c) *Leahy v. Glover*, 10 P. R. 141. And see *Rutter & Co. v. Smith*, 18 P. R. 49; *Carr & Sons v. Crisp & Co., Ltd.*, 19 P. R. 497; *John Knight & Sons, Ltd. v. Crisp & Co., Ltd.*, 21 P. R. 670; *Burberrys v. Watkinson*, 23 P. R. 141; *C.*

*A. Peters, Ltd. v. Domestic Inventions Co.*, 25 P. R. 387; *Kodak, Ltd. v. Grenville*, 25 P. R. 416. So also in Scotland, *Montgomerie & Co., Ltd. v. Young Bros.*, 21 P. R. 285.

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

(e) *Farina v. Cathery*, L. J. N. of C. 1867, p. 134; *Siegert v. Findlater*, 7 Ch. D. 801. And see *Siegert v. Ehlers*, Dig. 432; *Dadirrian v. Gullian*, 79 Fed. Rep. 784.

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

(g) *Siegert v. Lawrence*, 11 V. L. R. 47.

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

but also against all who connect themselves with and assist in the same. Thus, persons who engrave or print a trade mark for one not entitled to use it may be restrained (a).

*Guinness v. Ullmer.*

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

Spurious goods in innocent hands.

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

(a) *John Jameson & Son, Ltd. v. R. S. Johnston & Co., Ltd.*, 18 P. R. 259; *De Kuyper v. N. & G. Baird, Ltd.*, 20 P. R. 581.

(b) 10 L. T. O. S. 127.

(c) Decided by V.-C. Parker, and referred to in *Farina v. Silverlock*, 1 K. & J. 509, 512. See 3 Eq. Rep. 886, 890.

(d) 1 K. & J. 509. And so as to box-makers who supplied cigar boxes got up and marked in imitation of the

plaintiff's boxes to other cigar manufacturers: *Cuervo v. Jacob Henkel Co.*, 50 Fed. Rep. 471. And see *Hostetter Co. v. Brueggeman Reinert Distillery Co.*, 46 Fed. Rep. 158.

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

(f) Where the plaintiff obtained a verdict. See 4 K. & J. 650.

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

(h) *Upmann v. Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. 130. And see *Rivero*

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

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

In *Moët v. Pickering* (f) wharfingers were in possession of wines spuriously branded, but they had no knowledge that the brand was spurious, and they offered to act with respect to the wine as the Court should direct, upon having their charges and Wharfinger's lien.

v. *Norris*, Seton, 6th ed. 625; *Del Valle v. Mayer*, *ib.*; *Moët v. Pickering*, 8 Ch. D. 372.

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

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

(c) *Upmann v. Elkan*, L. R. 12 Eq. 140. See *Moët v. Pickering*, 8 Ch. D.

372; *Upmann v. Forester*, 24 Ch. D. 231; *Upmann v. Currey*, 29 Sol. J. 735.

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

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

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



costs paid or provided for. The Court of Appeal held that they were entitled to a lien on the wine for their charges, and that, even if the plaintiffs in the action for infringement were entitled to any lien on the wine for their costs, which was doubted, that lien must, at all events, be postponed to that of the wharfingers; and the Court also held that the latter had not done anything to disentitle them to their costs, which must be paid in both Courts by the plaintiffs.

Warehousemen.

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

Questions of contract.

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

*Steinthal v. Samson.*

Where, among other symbols, the arms, crest, and motto (the latter being the word "Excelsior") of one of the partners were used as trade marks of a partnership, and on dissolution of the partnership it was agreed that the other partner might use all the trade marks of the firm except such private arms, crest, and motto, it was held that no breach of the agreement had been committed by the continuing partner in using the word "Excelsior," apart from the arms and crest, on some of his goods, since it had

(a) 34 Beav. 157.

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

(c) Judicature Act, 1873, § 24.

(d) *Ainsworth v. Bentley*, 14 W. R. 630; *Ward v. Beeton*, L. R. 19 Eq. 207; *Gage v. Canada Publishing Co.*, 11 Can. Sup. Ct. 306.

(e) *Tudor v. Tudor*, W. N. 1873, p. 72; *Fullwood v. Fullwood* (2), 9 Ch. D. 176.

(f) *Hagg v. Darley*, 47 L. J. Ch. 567 ("Old Government Sanitary Company").

(g) *Lumley v. Wagner*, 5 De G. & Sm. 485; 1 De G. M. & G. 604. And see *Ainsworth v. Walmsley*, L. R. 1 Eq. 518, as to a singer's voice.

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

been so used alone previously as a trade mark, and it was not then used as a motto, but as a trade mark (*a*).

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

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

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

The Court will not specifically enforce an agreement the object of which is to defraud the public by putting goods spuriously marked on the market (*f*), nor will it protect a person who has

Other cases.

Name of cigarettes.

*Barrows v. Pelsall Coal & Iron Co.*

Fraudulent agreement.

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

(*b*) *Osborne, Garrett & Co. v. Parton, Son & Co.*, Bacon, V.-C., July 25th, 1884.

(*c*) *Ex parte Grist & Bowring*, 11 V. L. R. 630.

(*d*) *Hornbostel v. Kinney*, 52 N. Y. Super. Ct. 41.

(*e*) Dig. 530.

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

used his trade mark on spurious as well as on genuine goods (a), or has intended to commit fraud by buying the right to stamp on his own goods the name of another person who has acquired a reputation in the trade (b). And where an action for damages was brought against a person who had filled with inferior seed seed-bags which he had bought from the plaintiffs, marked with their labels, it was held on demurrer that the plaintiffs, having knowingly been parties to a fraud upon the public, were not entitled to recover (c).

Contract with  
trade-mark  
owner for  
purchase of  
goods.

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

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

(b) *Samuel v. Berger*, 24 Barb. 163 ;  
R. Cox, 178. See *Rodgers v. Philp*, 1 U. S.

Pat. Gaz. 29 ; *In re Tolle*, 2 *ib.* 415.

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

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

make, since by so doing he makes himself responsible for the quality of them, just as if he had made them himself (a).

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

Contract for purchase of goods with a specified mark.

In the case of paintings, described in a catalogue as being the work of Claude Lorraine and Teniers, it was held by Lord Kenyon, C. J., that the description was merely an expression of the vendor's opinion, and not a warranty of the authenticity of the paintings (e); in a similar case, however, where the painter was said to be Canaletto, it was held by the Court of King's Bench to be for the jury to say whether or not the description amounted to a warranty (f). The paintings being so much more modern,

Painter's name on paintings.

(a) See *per* Brett, L. J., in S. C. But compare Merchandise Marks Act, 1887, § 3 (2).

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

(c) Compare *Nichol v. Gaults*, 10 Ex. 191. Similarly, in *Gillespie & Co. v. Marshall*, Dig. 648, the question was discussed whether a contract to supply "Marshall's Canada Plates" was per-

formed by the delivery of plates such as were usually supplied by Marshall, but which were not "Canada Plates" in the strict commercial sense.

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

(e) *Jeuwine v. Slade*, 2 Esp. N. P. C. 572.

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

it was more reasonable in this case to suppose that the vendor intended to make an assertion as to the fact of their authenticity, as within his own knowledge.

Merchandise  
Marks Act.

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

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

Risks in-  
curred by  
infringement.

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

(a) 50 & 51 Vict. c. 28, § 17.

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

## CHAPTER VII.

## THE CIVIL REMEDY. II.

DEFENCES—DISCOVERY AND INSPECTION—ACCOUNT—  
DAMAGES—COSTS.**Defences.**

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

1. *Non-Infringement.*

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

1. Non-infringement.

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

The trade mark, so called, may present some one or more of the essential particulars required by the Act, and may not be objectionable in itself; but yet the fact of non-registration under the Act will, if it is a mark capable of registration, whether it was or was not used before the 13th August, 1875, effectually debar the person who has used it from obtaining the injunction, *quâ* trade mark, which would otherwise be awarded as a matter of

2. No registration or certificate.

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

course (a). And this is so, even though the trade-mark owner has taken all steps in his power to protect his rights, and the Registry Office is responsible for the delay (b). If, being incapable of registration, it is an old mark, a certificate of refusal to register under the present Act will preserve the existing right to protection (c). If, being incapable of registration, it is a new mark, it cannot be sued on as a trade mark but only in an action for passing off (d), in which it may be referred to as corroborative evidence of fraud (e). In such a case, the state of things would be similar to that in which it is a mode of packing that has been imitated (f). The injunction which would not be granted to restrain the infringement of the unregistered and uncertified trade mark would, as it seems, be granted to restrain the fraud, in which the imitation of marks was a mere incident.

### 3. *The Plaintiff not the Registered Proprietor.*

3. Plaintiff not the registered proprietor.

By §§ 38, 39 of the Act of 1905, it is the registered proprietor who has the exclusive right to the registered mark (g), and has the power to deal with it. Any equities in respect of it may, however, be enforced, and in a case where a trade mark had been registered in the name of a firm, and a new firm took over the business and goodwill, and commenced an action for infringement before the trade mark had been transferred into their names, the action was allowed to proceed (h). If the trade mark has been

(a) See Trade Marks Act, 1905, § 42; also *Goodfellow v. Prince*, 35 Ch. D. 9; *Hart v. Colley*, 44 Ch. D. 193; and *Hargreave v. Freeman*, (1891) 3 Ch. 39. Registration is a "condition precedent to suing." Per Chitty, J., in *Mouson & Co. v. Boehm*, 26 Ch. D. 398; and in *Barlow & Jones, Ltd. v. Johnson & Co.*, 7 P. R. 395, 405.

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

(c) T. M. Act, 1905, § 42. See per Lord Blackburn in *Orr-Ewing v. Registrar of Trade Marks*, 4 App. Cas. 498. In *Orr-Ewing & Co. v. Johnston & Co.*, 13 Ch. D. 434, a certificate of registration or of refusal to register does not appear to have been called for.

(d) Trade Marks Act, 1905, § 45.

(e) Jessel, M. R., has intimated from the bench that this view is correct. And see per Pearson, J., in *In re Riviere & Co.*, W. N. 1884, p. 75; and per Kay, J., in

*In re Sanitas Co., Ltd.*, 4 P. R. 533; and per Cotton, L. J., in *Barlow & Jones, Ltd. v. Johnson & Co.*, 7 P. R. 395, 411; also *Hart v. Colley*, 44 Ch. D. 193; and the Canadian case of *Smith v. Fair*, 14 Ont. Rep. 729.

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

(g) See *Richards v. Butcher* (1), 7 P. R. 288, in which it was held that an importer of foreign goods could not sue in respect of an infringement of trade marks which belonged to and were registered in the name of the foreign producer, even though he had an exclusive contract in the United Kingdom.

(h) *Ihlee v. Henshaw*, 31 Ch. D. 323. And see *Reveliere v. Gateley*, 89 L. T. (Journal) 314.

registered by some person not entitled to it, the proper course is for the true owner to rectify the register before commencing an action for infringement or passing off.

The intention of the Act appears to be, that when a trade mark has been duly registered, the objection which formerly prevailed, by which a trade mark was excluded from protection when there were no vendible goods in the market stamped therewith (*a*), is no longer to be available to a defendant. But it would be dangerous to rely on this in view of such decisions as *Edwards v. Dennis* (*b*), and the mark might be removed from the register under §§ 35, 37 of the Act of 1905.

#### 4. *Plaintiff's Trade Mark bad in itself.*

This defence has hitherto had to be founded mainly on the definition of a trade mark in the Act under which the mark was registered. Thus, marks registered or tendered for registration between August 13th, 1875, and December 31st, 1883, had to comply with the definition in § 10 of the Trade Marks Registration Act, 1875; marks registered or tendered for registration between January 1st, 1884, and December 31st, 1888, had to comply with the definition in § 64 of the Patents Act, 1883; marks registered or tendered for registration between January 1st, 1889, and March 31st, 1906, had to comply with the last-mentioned definition as modified by § 10 of the Patents Act, 1888. It is now, however, provided by § 36 of the Act of 1905, in effect, that registrability under that Act is to be the test in all cases, as a mark which was registered wrongfully under an earlier Act will still stand if it could have been registered under the present Act (*c*). Then the question arises whether the contention, that the mark does not comply with the conditions imposed upon marks tendered for registration, can be set up by way of defence, or whether a motion to rectify the register is necessary. That such

4. Plaintiff's  
trade mark  
bad.

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

(*b*) 30 Ch. D. 454; *Hargreave v. Freeman*, (1891) 3 Ch. 39. And see *In re Batt*, (1898) 2 Ch. 432; (1899) A. C. 428.

(*c*) *In re Compagnie Industrielle des*

*Pétroles*, (1907) 2 Ch. 435. See *In re Gestner*, (1907) 2 Ch. 478; (1908) 1 Ch. 513; *In re Philippart*, 25 P. R. 565; *In re Orlicoola, Ltd.*, 27 P. R. 850, where marks wrongly registered under the prior Acts were held equally bad under the Act of 1905.



a contention may be set up by way of defence seems probable, having regard to the fact that by § 39 of the Act of 1905 an exclusive right is conferred by registration only if the registration is valid (*a*). The usual and more prudent course is to apply for rectification (*b*).

In *In re Palmer* (1) (*c*), Jessel, M. R., fully discussed the point, and Lindley, L. J., said that "after careful examination of §§ 3, 5, and 10 of the Trade Marks Registration Act, 1875, I am satisfied that a mark which is not a trade mark, and which therefore ought never to have been registered, does not become a trade mark by being on the register for five years." The Vice-Chancellor of Ireland has taken the same view (*d*), and the same principle has been followed in Victoria (*e*). In America also the same conclusion has been arrived at, under the United States Statute (*f*). In this country, however, it is essential to bear in mind the provisions of sect. 41 of the Act of 1905, by which the original registration of a trade mark is, after seven years, to be taken to be valid in all respects, unless it is open to certain specified objections.

### 5. Trade Mark severed from Goodwill.

5. Trade mark severed from goodwill.

It is a good defence to an action for infringement of trade mark to prove that the plaintiff is not the owner of the business and goodwill concerned in the particular goods or classes of goods in respect of which the trade mark is registered (*g*). But here also the safer course is to apply for rectification.

### 6. Licence.

6. Licence.

The defendant may plead a licence from the plaintiff, or from a co-proprietor of the mark (*h*), as a defence to an action, though

(*a*) See *Pinto v. Budman*, 8 P. R. 181, 189, 193; *Apollinaris Co., Ltd. v. Herrfeldt*, 4 P. R. 478; *Leonard & Ellis v. Wells & Co.*, 26 Ch. D. 288.

(*b*) Even if a motion to rectify is not necessary, it seems that the question of validity will not be tried upon an interlocutory motion for injunction: *Hommel v. Gebrüder Bauer*, 20 P. R. 801.

(*c*) 21 Ch. D. 47. See also *In re Carter Medicine Co.*, (1892) 3 Ch. 472.

(*d*) *Bodega Co., Ltd. v. Owens*, 6 P. R. 236.

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

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

(*g*) See § 22 of Act of 1905. There can be no trade mark in gross: *Cotton v. Gillard*, 44 L. J. Ch. 90. See *In re Wellcome*, 32 Ch. D. 213; *Pinto v. Budman*, 8 P. R. 181.

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

no rights can thus be given him as against third parties. In one American case (*a*) it was held that the plaintiffs, who had received an exclusive licence from the owner of a trade mark, were entitled to an injunction against the successors in business of persons who had been partners in business with the licensor, but had tacitly acquiesced in his retaining the sole right in the mark. However, the Court would not allow a licensee to defraud the public by the sale of goods under a mark which was similar to that on the licensor's own goods, while the goods themselves were not the goods or goods equivalent to the goods of the licensor (*b*).

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

### 7. Delay and Acquiescence.

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

7. Delay and acquiescence.

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

(*b*) *Oldham v. James*, 13 Ir. Ch. 393; 14 *ib.* 81; *Bloss v. Bloomer*, 23 Barb. 604; R. Cox, 200; *Samuel v. Berger*, 24 Barb. 163; R. Cox, 178.

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

(*d*) *Motley v. Downman*, 3 My. & Cr. 1; *Morison v. Mout*, 9 Hare, 241; *Flavel v. Harrison*, 10 Hare, 467; *Wason v. Waring*, 15 Beav. 151; *Attorney-General v. Sheffield Gas Consumers' Co.*, 3 De G. M. & G. 327; *Burgess v. Burgess*, *ib.*

896; *Farina v. Gebhardt*, 3 Eq. Rep. 891; *Chappeli v. Sheard*, 2 K. & J. 117; *Coles v. Sims*, 5 De G. M. & G. 1; *Kinahan v. Bolton*, 15 Ir. Ch. 75; *Hovenden v. Lloyd*, 18 W. R. 1132; *Isaacson v. Thompson*, 41 L. J. Ch. 101; *Estcourt v. Estcourt Hop Essence Co.*, L. R. 10 Ch. 276; and other cases cited below.

(*e*) *Ford v. Foster*, L. R. 7 Ch. 611; *Wheeler & Wilson v. Shakespeare*, 39 L. J. Ch. 36; *In re Kuhn & Co.*, 53 L. J. Ch. 238; *National Starch Manufacturing Co. v. Munn's Patent Maizena & Starch Co.*, (1894) A. C. 275.

Supreme Court of Victoria, in *Neva Stearine Co. v. Mowling* (a), appears convincing. "Great stress," said Holroyd, J., "has been laid on this: that a person who is entitled to a distinctive trade name or mark is said to have acquired property in it, and that the property once acquired cannot be lost. But what is the nature of the property, if that be the right designation to give it? It is that, when an article has become known to the public generally by a particular name or mark, no other person has a right to simulate that name or mark so as to induce the public to believe that his goods are the goods of the inventor. If that be the reason, then the right, if it be acquired in that way, must be lost when the reason for it ceases. If the use of the name by another person will no longer induce that belief, then the right to the property must be gone." Thus, in *In re Hyde & Co.* (b), it was held that the words "Bank of England" had long ceased to be a trade mark in respect of sealing-wax, by reason of the user for six years of those words on sealing-wax by persons other than those who had originally adopted it, without interference by the latter, and the registration of the lapsed trade mark was accordingly rescinded. There the mark had ceased to be private property before registration was effected, but even if the mark was distinctive when registered, it would appear that in the event of its subsequently losing its distinctive character, it would be "wrongly remaining on the register" under sect. 35 of the Act of 1905, and could be expunged.

Principle of  
this defence.

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

(a) 9 V. L. R. (E.) 98.  
(b) 7 Ch. D. 724.

(c) 13 L. T. N. S. 746. And see *Neva Stearine Co. v. Mowling*, 9 V. L. R. (E.) 98.

to allow a plaintiff to avail himself of delay to obtain benefit for himself. In that case you will not grant him relief."

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

On motion for injunction.

Where, however, the case has arrived at the hearing, the degree of delay or acquiescence must be much greater; there must be such an acquiescence as to amount, not only to a positive licence, but to an implication of an actual grant, before the parties can be for ever deprived of their rights (c). In *Fullwood v. Fullwood* (2) (d), Fry, J., laid down that mere lapse of time, short of the statutory period fixed for the limitation of actions, would not deprive a plaintiff in an action for infringement of a trade mark, which is an action for the assertion of a legal right, of his right to the injunction. And in an American case (e), while it was held that a delay of twenty-five years effectually disentitled the plaintiffs to relief as against an innocent vendor of goods falsely marked, the question as to the rights of a trade mark owner,

At the hearing.

(a) *Per* Lord Langdale, M. R., in *Gordon v. Cheltenham Rail. Co.*, 5 Beav. 233. And see *Isaacson v. Thompson*, 41 L. J. Ch. 101; *Flavel v. Harrison*, 10 Hare, 167; *Erans v. Smith*, 3 Times L. R. 390; *Mallan v. Davis*, 3 Times L. R. 221; *Van Oppen & Co., Ltd. v. Van Oppen*, 20 P. R. 617; *Royal Warrant Holders' Association v. Slade & Co., Ltd.*, 25 P. R. 245; *Chinn v. Thomas*, 5 V. L. R. Eq. 188. But compare *Heyde v. Wittkowski*, 5 N. S. W. Rep. (E.) 74.

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

(c) *Patching v. Dubbins*, Kay, 11; *Gordon v. The Cheltenham Rail. Co.*, 5 Beav. 233; *Rodgers v. Rodgers*, 31 L. T. N. S. 285; *Grant v. Levitt*, 18 P. R. 361; *Reddaway v. Robert Stevenson Bros., Ltd.*, 20 P. R. 276; *Leuba v.*

*Ullmann & Co.*, 1 Hong Kong L. R. 131; 2 *ib.* 1: reversed 25 P. R. 673. And see *Lambly v. White*, 41 L. J. Ch. 351; *Weaver v. Sanitary, &c. Co.*, L. J. N. of C. 1887, p. 144 (where the defendants had used the word for eleven years, to the plaintiff's knowledge); *Weaver v. Stiff*, L. J. N. of C. 1887, p. 144 (where the defendants had so used the mark for ten years); *Gillott v. Esterbrook*, 47 Barb. 455; R. Cox, 340; 18 N. Y. 374; *Filley v. Fussett*, 44 Mo. 173; R. Cox, 530; *McLean v. Fleming*, 96 U. S. 245; *Holt v. Menendez*, 128 U. S. 182; *Saxlehner v. Eisner*, 179 U. S. 19. The same was formerly the case on demurrer.

(d) 9 Ch. D. 176.

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

after a similar delay, against a guilty manufacturer, was left open. In Victoria also it has been said that "in cases of fraud a much longer period of acquiescence would be necessary than where there was no fraud" (a). But a long delay may be regarded as rendering harmless that which might at an earlier period have been regarded as a misrepresentation (b).

Rights must  
be actively  
defended.

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

No delay  
where no  
knowledge.

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

Delay by  
retiring  
partner.

It has been held in America that if a member of a partnership retires therefrom without setting up any claim to an interest in the trade mark, and makes no objection to its being used by the

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

(b) *Marquis of Londonderry v. Russell*, 3 Times L. R. 360; *McCue, Stevenson & Orr v. Lee*, 23 P. R. 1; *Cropper Minerva Machines Co. v. Cropper, Charlton & Co.*, 23 P. R. 388. And see *London General Omnibus Co. v. Lavell*, (1901) 1 Ch. 135.

(c) *Clegg v. Edmonton*, 8 De G. M. & G. 810.

(d) This dictum was approved and followed by Wood and Selwyn, L. J.J., in *Lehmann v. McArthur*, L. R. 3 Ch. 496. And see *Ripley v. Bunday*, 14 P. R. 591. But see *Attorney-General v. Sheffield*

*Gas Consumers' Co.*, 3 De G. M. & G. 327; and *Kinahan v. Bolton*, 15 Ir. Ch. 75.

(e) *Weldon v. Dicks*, 10 Ch. D. 247; *In re Farina* (2), 27 W. R. 456; *Mouson & Co. v. Boehm*, 26 Ch. D. 398; *Apolinaris Co. v. Herrfeldt*, 4 P. R. 478; *Barlow & Jones, Ltd. v. Johnson & Co.*, 7 P. R. 395, 419; *In re La Société Anonyme des Ferreries de l'Etoile* (2), (1894) 2 Ch. 26; *Rowland v. Michell*, (1897) 1 Ch. 71; *Saxlehner v. Eisner*, 179 U. S. 19. Compare *In re Heaton*, 27 Ch. D. 570.

(f) *Siebert v. Findlater*, 26 W. R. 462.

continuing partner, he must be taken to acquiesce in its being appropriated by the latter (a); but that if, on the other hand, a partner submits to the appropriation of the firm trade mark by his partner, at a time when he is, in a measure, in the latter's power, by reason of the latter being in sole possession of an important secret used in the business, he will be held not to have lost his right (b); and that a continued user of the mark by the retiring partner, even on a spurious article, is evidence that he does not intend to give up his rights therein (c).

Inasmuch as in a case where no proof of actual deception is produced, the Court has to try a hypothetical case, turning on the probabilities of deception, it has been held that a person who believes others to be infringing his trade mark is entitled to wait until he can collect a sufficient number of cases to prove to the Court that the proceedings of which he complains do actually deceive the public; and that his right to protection is not gone by reason of such delay (d). It seems that in *Rodgers v. Rodgers* (e), and *Estcourt v. Estcourt Hop Essence Co.* (f), the delay would have been condoned had it resulted in the production of satisfactory evidence of deception. On the other hand, where a plaintiff delayed his motion until December, having been in possession of sufficient evidence in May, the delay was fatal to the motion (g).

Delay for purpose of securing evidence.

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

Delay in regard to motion to commit.

Even if the delay has not been such as to disentitle the plaintiff to his injunction, it may yet obtain some indulgence for the defendant; as, for instance, the permission to dispose of the wares

Indulgence to defendant, plaintiff having delayed.

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

(b) *Weston v. Ketcham* (1), 39 N. Y. Super. Ct. 54.

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

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

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

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

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

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

on which he expended money in consequence of the plaintiff's delay (a).

Account or  
damages  
withheld.

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

Costs not  
given.

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

### 8. Plaintiff's Misrepresentation.

8. Plaintiff's  
misrepresenta-  
tion.

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

(a) *Clowes v. Hogg*, W. N. 1870, p. 268; S. C. on appeal, W. N. 1871, p. 40; *Anglo-Swiss Condensed Milk Co. v. Swiss Condensed Milk Co.*, W. N. 1871, p. 163. And see *County Chemical Co., Ltd. v. Frankenburg*, 21 P. R. 722, where delivery up was refused.

(b) *Harrison v. Taylor*, 11 Jur. N. S. 408; *Reddaway v. Robert Stevenson & Bros., Ltd.*, 20 P. R. 276; *McLean v. Fleming*, 96 U. S. 215; *Carver v. Bowker*, Dig. 581; *Holt v. Menendez*, 128 U. S. 182. And see *Beard v. Turner*, 13 L. T. N. S. 746; *Leuba v. Ullmann*, 1 Hong Kong L. R. 131; 2 *ib.* 1; reversed 25 P. R. 673.

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

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

(e) *Per Lord Romilly, M. R., in Cocks*

*v. Chandler*, L. R. 11 Eq. 446.

(f) *Per Lord Westbury, C., in Leather Cloth Co. v. American Leather Cloth Co.*, 4 De G. J. & S. 137. And see *Edelsten v. Vick*, 11 Hare, 78; *Post v. Marsh*, 16 Ch. D. 395; *Talbot v. Judges*, 3 Times L. R. 398; *Lewis's v. Goodbody*, 67 L. T. N. S. 191; *In re Hill*, 10 P. R. 113; *Bile Bean Manufacturing Co. v. Davidson*, 22 P. R. 553; *Cropper Minerva Machines Co. v. Cropper, Charlton & Co.*, 23 P. R. 388; *Manhattan Medicine Co. v. Wood*, 108 U. S. 218; *Wolfe v. Lang & Co.*, 13 V. L. R. 752. As to whether the plaintiff's misrepresentation will afford an answer to his Common Law claim for damages, see *per Williams, L. J., in Jamieson v. Jamieson*, 15 P. R. 169, 191, or to an injunction in a passing off case, see *Wolff v. Nopitsch*, 18 P. R. 27, 32; compare *B. Warsop & Sons, Ltd. v. Warsop*, 21 P. R. 481; *Bile Bean Manufacturing Co. v. Davidson*, 22 P. R. 553; *Worden v. California Fig Syrup Co.*, 187 U. S. 516. Words which would be disentitled to protection in a Court of

It is impossible to define what misrepresentation will disentitle the plaintiff to relief; all that can be said is, that "he that hath committed iniquity shall not have equity" (a).

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

Misstatements  
in plaintiff's  
marks.

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

*Perry v.  
Truefitt.*

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

*Leather Cloth  
Cos.' case.*

justice by reason of their being calculated to deceive, are not to be registered under the Trade Marks Act, 1905, § 11.

(a) *Palmer v. Harris*, 60 Penn. St. 156; *R. Cox*, 523. See *Bluckwell v.*

*Armistead*, 5 Am. L. T. 85.

(b) 8 Sim. 477.

(c) 6 Beav. 66.

(d) 8 Sim. 477.

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

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



If there was a wilfully false statement he would not stop to inquire whether it was too gross to mislead."

Cases in tobacco trade.

The tobacco trade has been fruitful in cases of this description. Thus in *Wood v. Lambert (a)*, John Wood & Son of London sold their English-made cigarettes sometimes in boxes labelled "cigarettes of the finest selected Turkish tobacco, manufactured by Jancal Tachta, Constantinople," sometimes in boxes labelled "St. Petersburg—P. Mavrogordato & Co.—cigarettes"; and it was held that the word "Eton," which had been used upon the boxes so labelled was disentitled alike to registration and protection. So in *Newman v. Pinto (b)*, where the plaintiff sold cigars in boxes branded with the Spanish words "La Pureza—Habana—Ramon Romnedo," and bearing labels on which appeared the words "La Pureza," the written signature of Ramon Romnedo (who was in fact a non-existent personage), and the arms of Spain and Havannah, and it was proved that the cigars, though made of Havannah tobacco, were imported from Bremen, and no evidence was given by the plaintiff as to the actual place of manufacture, it was held that the get-up of the goods was such as to represent that the cigars were manufactured in Havannah by Ramon Romnedo, and that the plaintiff, having failed to prove that this representation was true, he was disentitled to sue in respect of his label, which was only used as part of the fraudulent get-up, which Bowen, L. J., described as "an elaborate concatenation of pictorial lies." It is, however, to be noticed that in *In re Wills (c)*, where Messrs. W. D. and H. O. Wills had used their registered trade mark as part of a label containing the name of an imaginary Spanish firm and the word "Habana" upon boxes of cigars manufactured for them by an English firm, Wright, J., held that Messrs. Wills, by their mark, simply represented that the cigars were sold by them, and that the misrepresentation as to the manufacture of the cigars did not deprive the mark of its distinctive character

(a) 32 Ch. D. 217. The same principle applies in the United States: *Palmer v. Harris*, 60 Penn. St. 156; *Schumacher & Ettliger v. Schwenke (2)*, 36 U. S. Pat. Gaz. 457; *Solis Cigar Co. v. Pozo*, 16 Col. 388; 25 Am. St. Rep. 279; *Hilson & Co. v. Foster*, 80 Fed. Rep. 896; in Canada: *Labbatt v. Trester*,

2 St. Dig. 726; and in New South Wales: *Heyde v. Wittkowski*, 5 N. S. W. Rep. (E.) 74. See *Kirker, Green & Co., Id. v. Mayman*, N. S. W. 1 S. R. Eq. 73.

(b) 4 P. R. 508. Cf. *In re Fuente*, (1891) 2 Ch. 166.

(c) (1893) 2 Ch. 262.

so as to disentitle them to protection, and *Wood v. Lambert* (a) was further distinguished on the ground that the user by Messrs. Wills of their trade mark for cigars was not general or extensive and had ceased for several years.

In short, the Court will not protect a trade mark, label, &c., which contains, or has attached to it, a serious misstatement calculated to deceive (b). Mere puffing, however, or exaggerated statements as to the value, &c., of patent medicines, and similar preparations, will not disentitle their owners, since every one knows how to estimate the value of such statements correctly (c). Thus, in *Holloway v. Holloway* (d), the assumption of the title of "Professor" was disregarded. In *Metzler v. Wood* (e) it was held that the plaintiffs were not disentitled either by a representation that the publication was the 600th edition of the work, it being shown to be a trade custom to call 250 copies an edition; or by a statement that the work was specially revised by the author, the fact being that a previous edition which the present one followed had been so revised. In *Hogg v. Kirby* (f), the defendant, who had brought out what he intended to be taken for a continuation of the plaintiff's magazine, set up in his defence the fact that the plaintiff's magazine untruly professed to be by "William Granger, Esq." Lord Eldon granted the injunction; and it is certainly improbable that any one could be injured by the use of a name previously unknown (g).

Again, in *M. Melachrino & Co. v. R. Melachrino & Co.* (h), it was held that the plaintiffs were not disentitled, either because they placed the word "registered" on their trade mark as used, though it differed from the registered trade mark in having what were blank spaces in the latter filled in with coats-of-arms, nor because they sold their cigarettes as "Egyptian cigarettes," whereas on one occasion they had re-made in England with Egyptian tobacco a small quantity of cigarettes which had been damaged on the voyage from Egypt to England. And it has

Puffing.

*Melachrino v. Melachrino.*

(a) 32 Ch. D. 247.

(b) In *Raggett v. Findlater*, L. R. 17 Eq. 29, costs were given against the plaintiff mainly on account of a misstatement by him; *Worden v. California Fig Syrup Co.*, 187 U. S. 516.(c) *Holloway v. Holloway*, 13 Beav. 209.

(d) 13 Beav. 209.

(e) 8 Ch. D. 606.

(f) 8 Ves. 215.

(g) And see *Dale v. Smithson*, 12 Abb. Pr. 237; *R. Cox*, 282; *Meriden Britannia Co. v. Parker*, 39 Conn. 450; 12 Amer. Rep. 401.(h) Chitty, J., May 29th, 1888. And see *In re Lyle & Kinahan, Ltd.*, 24 P. R. 37, 249.

been held in America that the use of the word "imported" in connection with goods of home-manufacture does not disentitle the plaintiff, if the word is used without intention to deceive and does not produce that effect (*a*).

False statement in foreign language.

If the misrepresentation is in other respects such as to disentitle, the fact of its being made in a foreign language does not necessarily save the plaintiff from losing the rights which he would have had if no such statements had been made (*b*).

Use of predecessor's name.

The use of the name of his predecessor by one who has succeeded him in business, when such use will not lead to any other supposition than that the business is the same (*c*), or the use of his own name, without more, by one whose name happens to be the same as that of another manufacturer (*d*), is not such a misrepresentation as to disentitle such a person to relief against fraud. But where a trader has been in the habit of labelling his goods (*e.g.*, a particular medicine) with statements which refer to himself personally, and his successor in business continues to use the same statements, "a Court of Equity will extend no aid to sustain a claim to a trade mark of an article which is put forth with a misrepresentation to the public as to the manufacturer of the article, and as to the place where it is manufactured both of which particulars were originally circumstances to guide the purchaser of the medicine" (*e*). When a person has bought the business of a company in liquidation from the liquidator, he is entitled to describe himself as the successor to the business, and to use the trade names for the goods sold therein; but he is not entitled to trade in the name of the company *simpliciter*, nor to describe himself as the "original firm," and, if he does so, the misrepresentation will debar him of his right to relief against imitators (*f*).

Collateral misrepresentations.

Collateral misrepresentations made by the plaintiff, as, for

(*a*) *Funke v. Dreyfus*, 34 La. Ann. 80.

(*b*) *Palmer v. Harris*, 60 Penn. St. 156; *R. Cox*, 523.

(*c*) *Leather Cloth Co.'s case*, 1 H. & M. 271; 4 De G. J. & S. 137; 11 H. L. C. 523; *Churton v. Douglas*, Johns. 174; *Hudson v. Osborne*, 39 L. J. Ch. 79; *Massam v. Thorley's Cattle Food Co.*, 14 Ch. D. 748.

(*d*) *Holloway v. Holloway*, 13 Beav. 209; *Burgess v. Burgess*, 3 De G. M. & G. 896; *Turton v. Turton*, 42 Ch. D.

128; *Tussaud v. Tussaud*, 44 Ch. D. 678; *Saunders v. Sun Life Assurance Co. of Canada*, (1894) 1 Ch. 537; *Crawford v. Bernard*, 11 P. R. 580; *Jamieson v. Jamieson*, 15 P. R. 169; *Brown Chemical Co. v. Meyer*, 139 U. S. 540.

(*e*) Per U. S. Supreme Court in *Manhattan Medicine Co. v. Wood*, 108 U. S. 218.

(*f*) *Cropper Minerva Machines Co. v. Cropper, Charlton & Co.*, 23 P. R. 388.

instance, in an advertisement in the newspapers, do not necessarily disentitle him to protection (a). Nor do misstatements of so trifling a character as not to mislead purchasers (b), or statements not made till after the institution of the action (b). And it seems that the effect of a misrepresentation, though material, may be cured by discontinuance for a long period before action brought (c).

It is not the province of the Court, however, to protect speculations which aim at inducing the public to buy one thing when they think they are buying another; and therefore, where both plaintiffs and defendant were engaged in speculations of that character, although the Court refused, on the ground of the plaintiff's delay, to grant the injunction they prayed, it declined to give costs to the defendant, who was *in pari delicto* (d). And on similar grounds relief will be refused to a plaintiff who has used his trade mark on goods of inferior quality to those with which the mark has become associated (e), or who has used the mark beyond the limits to which he was confined on the assignment of it to him (f), or who adopted it in infringement of the rights of another (g).

Fraudulent speculation.

In *Hogg v. Maxwell* (h) the plaintiff registered, under the Copyright Acts, the title of an intended magazine in 1863, but did not bring out the work. In June, 1866, the defendant registered the same name. The plaintiff discovered this in August. He then hastened on his own publication, which was first announced on September 24th, and published next day. In the meantime the plaintiff had, on the 19th, undertaken to advertise the defendant's intended magazine, but retracted the undertaking, and gave the defendant notice of his claim to the title on the 25th. Proceedings were taken by both parties with a view to an injunction, which was refused in both cases, the Court being of

*Hogg v. Maxwell.*

(a) *Curtis v. Bryan*, 2 Daly, 212; R. Cox, 434. And see *Ford v. Foster*, L. R. 7 Ch. 611; *Davis v. Rogers*, 89 L. T. (Journal) 292; *Plotzker v. Lucas*, 24 P. R. 551.

(b) *Siegert v. Findlater*, 7 Ch. D. 801.

(c) *In re Wills*, (1893) 2 Ch. 262; *Benedictus v. Sullivan, Powell & Co.*, 12 P. R. 25.

(d) *Estcourt v. Estcourt Hop Essence Co.*, L. R. 10 Ch. 276. And see *In re Saunton & Co.*, Dig. 625; *Newman v. Pinto*, 4

P. R. 508.

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

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

(g) *O'Rourke v. Central City Soap Co.*, 26 Fed. Rep. 576; *Parlett v. Guggenheimer*, 67 Md. 542; *Lawrence Manufacturing Co. v. Tennessee Manufacturing Co.*, 31 Fed. Rep. 776; 138 U. S. 537. And see *In re Heaton*, 27 Ch. D. 570.

(h) L. R. 2 Ch. 316.

opinion, in *Hogg v. Maxwell*, that the plaintiff had got beforehand by improper means, which disentitled him to relief.

Short weight. The Court will not protect persons in carrying on a trade in which short measure is given systematically and knowingly (a). And in *Hennessy v. Wheeler* (b), the New York Court of Common Pleas refused relief to brandy merchants who sold their brandy in bottles containing quarts and pints of nominal measure, but really considerably less. But this decision was reversed on appeal, on the ground that the bottles were not bought on the faith of their containing any particular quantity of brandy, and that no one was proved to have been deceived or was likely to be so. Similarly, where the plaintiff stated that his medical preparation was "sold only in quart bottles," and the bottles, though such as were commonly known in the trade as quart bottles, really contained substantially less, it was held in America that the misstatement was not such as to deprive the plaintiff of his right to protection (c).

#### 9. Word "Patent" improperly used by Plaintiff.

9. Improper use of word "patent."

"It is impossible not to see," says Mellish, L. J., "that persons do try to use their right in trade marks for the purpose of getting a monopoly in particular articles, just as if they had a patent for the goods which they manufacture" (d). A special form of misrepresentation consists in the use by persons in their trade marks of words inducing the belief that they have a patent for the articles to which those trade marks are affixed; and the tendency which the use of such words has to procure for the persons using them an unfair monopoly, or to prolong a monopoly granted only for a limited time, causes it to be regarded with special disfavour. The importance of the point is forcibly pointed out by Wood, V.-C., in *Morgan v. McAdam* (e). He says: "All those who are induced to buy these crucibles thus described as 'Patent Plumbago Crucibles,' are to a certain extent deceived, because they are led to believe that the article is protected by a patent, and thus may

(a) See *per Giffard, L. J.*, in *Lee v. Haley*, L. R. 5 Ch. 155.

(b) 51 How. Pr. 457; 69 N. Y. 271.

(c) *Alexander v. Morse*, 14 R. I. 153.

(d) *Singer Manufacturing Co. v. Wilson*, 2 Ch. D. 434, 456.

(e) 36 L. J. Ch. 228.

be induced to purchase it from the plaintiffs, under the belief that there is a patent, and that the plaintiffs, or at least some limited number of persons, are the only persons authorised to sell it; and further they are led to believe that if they should be minded to set up any manufactory of the same kind for themselves, they would be unable to do so in consequence of the plaintiffs being the possessors, either by way of licence or ownership, of a patent preventing the world at large from imitating the article which is sold by them under this particular designation" (a).

Where, therefore, the plaintiff has used in his trade mark the word "patent," or words to that effect, although, in point of fact, he has never had a patent for the goods to which the mark is applied, the Court will refuse to extend to him the protection which he has forfeited. Previously to Sir John Rolt's Act (b), liberty was given to the plaintiff to bring an action at law (c), but since then the action has been simply dismissed, with or without costs (d). And the course would be the same if the words were first inserted in the trade mark after the expiration of a patent which had existed (e). In *Sykes v. Sykes* (f), a patent had been taken out by the plaintiff's father. That patent was held to be invalid, on account of a defect in the specification, but the use of the word "patent" was not held to disqualify the plaintiff from recovering at law. The question does not seem, however, to have been fairly raised in that early case, and it has been held in America that marks containing a reference to a patent declared to be invalid could not be protected by injunction (g).

There has been some apparent difference of opinion in regard to the case in which the word "patent" has been inserted in the trade mark while the article was still patented, and has been retained there after the patent has run out. In such a case (h), Wood, V.-C., held that the plaintiffs were entitled to recover, the blocks for the labels having been made during the existence of the

Plaintiff  
disentitled.

Retention of  
word after  
expiration of  
patent.

(a) And see *per* the same learned judge, in *Flavel v. Harrison*, 10 Hare, 467.

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

(c) *Flavel v. Harrison*, 10 Hare, 467.

(d) *Morgan v. McAdam*, 36 L. J. Ch. 228; *Lamplough v. Balmer*, W. N. 1867, p. 293; *Leather Cloth Co. v. Lonsont*, L. R. 9 Eq. 352; *Nixey v. Roffey*, W. N. 1870, p. 227. And see *Ford v. Foster*, L. R. 7 Ch. 611; *In re Adams*, 9 P. R. 174 (where the Court refused to alter a

mark by striking out the word "patent"); *Meaby & Co. v. Triticine, Ltd.*, 15 P. R. 1.

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

(f) 3 B. & Cr. 541; cf. *per* Vaughan Williams, L. J., in *Jamieson v. Jamieson*, 15 P. R. 169, 191.

(g) *Consolidated Fruit Jar Co. v. Dorfinger*, 6 Am. L. T. N. S. 511.

(h) *Edelsten v. Vick*, 11 Hare, 78. And see *Leather Cloth Co. v. Hirschfeld* (1), 1 N. R. 551.

patent, when the representation was perfectly true. Lord Kingsdown, in discussing this judgment (*a*), said that he agreed with it if the word "patent" were only used as part of the designation of an article, but that he could not do so if the trade mark represented the article as protected by an existing patent. In a subsequent case (*b*), the Vice-Chancellor explained his meaning as being in harmony with that of Lord Kingsdown. "If originally you have a patent, and the article is in the market as a patent article, and you stamp all your goods which are sent out with these words 'patent pins,' or 'patent wire,' or whatever the particular article might be, at the end or the expiration of the patent it is not necessary, as I thought, to call in the whole of the previous stamps, and remodel the whole of your stamps, and have a new form of packing your article in order that you may inform the world that the patent, which did exist, has expired. Of course it would be better, and those who are inclined to act with scrupulous honesty would take care to put the date of their patent, which would obviate all difficulty (*c*), upon the articles which they designate as patented." In a later case (*d*), it was clearly established by the Court of Appeal that the principle enunciated by Lord Kingsdown is the rule of the Court, and that the use of the word "patent," so as to indicate an existing patent, is equally fatal, whether there has never been a patent for the article in question, or the patent which did exist has expired. But the Court will not entertain this question unless it is raised in the pleadings (*e*).

Word so used  
as not to  
deceive.

As has been seen, Lord Hatherley, when V.-C. (*f*), and Lord Kingsdown (*g*), were of opinion that when the word "patent" formed part of the name of an article, and did not operate so as to induce a belief in the existence of a patent, the trade mark in which the word appeared might be protected. A distinct decision to this effect was pronounced by James, V.-C., in *Marshall v. Ross* (*h*), where "patent thread" was compared by the learned

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

(*b*) *Morgan v. McAdam*, 36 L. J. Ch. 228.

(*c*) Note the provisions of the Patents and Designs Act, 1907, § 33.

(*d*) *Chearin v. Walker*, 5 Ch. D. 850; *Thomas Hubbuck & Son, Ltd. v. Brown*, 17 P. R. 638. And see *A. Boake, Roberts & Co., Ltd. v. Wayland*, 26 P. R. 251; *In*

*re Gestetner*, (1907) 2 Ch. 478; (1908) 1 Ch. 513.

(*e*) *Lever v. Goodwin*, W. N. p. 1887, p. 107; *A. Boake, Roberts & Co., Ltd. v. Wayland*, 26 P. R. 251.

(*f*) *Morgan v. McAdam*, 36 L. J. Ch. 228.

(*g*) *Leather Cloth Cos.' case*, 1 H. L. C. 523.

(*h*) L. R. 8 Eq. 651.

judge to "patent leather boots" (a). And where the plaintiffs had described themselves as "patentees" of an article of which they had secured the exclusive manufacture by registration, though not by letters patent, it was held that they were not disentitled (b). In the American case of *Lauferty v. Wheeler* (c), it was held that the plaintiff was not disentitled by reason of having described his goods as "Patent, Sept.," after being officially informed that his application for a patent had been allowed, but before the actual issue of letters patent.

A patentee is not bound to decide a doubt as to the validity of his patent adversely to himself, and consequently the plaintiff, in an action for infringement of a trade mark for boot-tips, was held not to be disentitled to relief by the fact that the word "patentee" appeared in his trade mark, he being the owner of an existing patent, notwithstanding that it had been shown that questions might be raised as to the validity of the patent, and the plaintiff had himself admitted that he had some doubt as to the validity (d).

When validity of patent doubtful.

The fact that the misrepresentation is so gross as hardly to be capable of deceiving will not exonerate the person making it from the consequences. Thus, the use on untanned leather cloth of the words "tanned patented" was a ground for refusing assistance (e).

Grossness of misrepresentation no excuse.

Where a plaintiff described himself on his labels as "manufacturer and patentee," it was held that this was equivalent to describing the article as "patent," and the bill was dismissed, without costs (f). And in *Consolidated Fruit Jar Co. v. Dorflinger* (g), it was held that certain trade marks consisting of the words "Mason's Patent, November 30th, 1858," "Mason's Improved," and "The Mason Jar of 1858," were bad, the patent of 1858 being invalid by judicial decision.

"Manufacturer and patentee."

When a plaintiff used on his stopper labels with the words "Royal Letters Patent," the explanation that he had for twenty-five years paid the stamp duty on "patent medicines," and that he was only continuing to use the labels he had had on hand when he discovered his medicines did not belong to that class, was not

*Lampough v. Balmer.*

(a) See the observations on this case in *Leather Cloth Co. v. Lonsont*, L. R. 9 Eq. 345. And see, too, *Ransome v. Graham*, 51 L. J. Ch. 897.

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

(c) 63 How. Pr. 488; 11 Daly. 194.

(d) *Blakey v. Latham*, 85 L. T.

(Journal) 47.

(e) *Leather Cloth Cos.' case*, 4 De G. J. & S. 137; 11 H. L. C. 523.

(f) *Nixey v. Ruffey*, W. N. 1870, p. 227.

(g) 6 Am. L. T. N. S. 511.



accepted as satisfactory, and his motion for an injunction to restrain an imitator was refused (*a*).

Collateral  
use of word.

If, however, the plaintiff's trade is a perfectly honest trade, and the trade mark is a perfectly honest trade mark, the fact that the plaintiff has committed a purely collateral misrepresentation, by describing himself, though not in the trade mark itself, as "patentee," will not disentitle him to his remedy (*b*). And where a registered label for soda water contained the words "manufactured by Royal Letters Patent," which were explained by the plaintiff to mean "manufactured by means of patented machinery," the Privy Council, being of opinion that the plaintiff's trade was an honest trade, held that he was not disentitled to relief "by reason of some words not designed to mislead, and at most equivocal" (*c*).

Must be  
pleaded.

And in any case this defence is one which must be pleaded, and which cannot be raised unless it is pleaded (*d*).

#### 10. Words "Registered" or "Trade Mark" improperly used by Plaintiff.

On the same principles on which the deceptive use of the word "patent" has been held to disentitle a plaintiff to relief, so a misrepresentation as to a trade mark being registered which is not so, or a misrepresentation as to what it is that is the trade mark, may similarly disentitle to relief.

Statutory  
provisions.

By § 105 of the Patents Act, 1883 (*e*), it was provided that

(*a*) *Lamplough v. Balmer*, W. N. 1867, p. 293.

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

(*c*) *Cochrane v. McNish*, (1896) A. C. 225. And see *National Starch Manufacturing Co. v. Munn's Patent Maizena & Starch Co.*, (1894) A. C. 275; *Ingram v. India Rubber, Gutta Percha & Telegraph Co., Ltd.*, 29 V. L. R. 172.

(*d*) *Lever v. Goodwin*, W. N. 1887, p. 107; *Boake, Roberts & Co., Ltd. v. Wayland & Co.*, 26 P. R. 251.

(*e*) This replaced § 7 of 5 & 6 Will. IV. c. 83. See *Myers v. Baker*, 3 H. & N. 802. In America a penalty is similarly assigned for the use of the word "Patented" on an unpatented article: U. S. Rev. St. § 4901. See *Wilson v. Singer Manufacturing Co.*, 16 U. S. Pat. Gaz.

1091; *Stimpson v. Pond*, 2 Curtis, 502. And an article which, together with patented elements, contains new and valuable unpatented elements, ought not, as a rule, to be termed "patented": *Deverall v. Banker*, 45 U. S. Pat. Gaz. 591. But the penalty is only incurred if there is an attempt to defraud (*Tompkins v. Butterfield*, 25 Fed. Rep. 556), and that question is for the jury (*Walker v. Hawkshurst*, 5 Bl. C. C. 494; *Deverall v. Banker*, 45 U. S. Pat. Gaz. 591); who are justified in convicting if they are reasonably satisfied upon the evidence as to the material facts, and proof beyond a reasonable doubt is not required (*Hawloetz v. Kass*, 25 Fed. Rep. 765); a corporation is responsible for the act of its superintendent in wrongfully

“any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade mark applied to any article sold by him as registered, which is not so, shall be liable for every offence on summary conviction to a fine not exceeding £5.” And it was also provided that “a person shall be deemed, for the purposes of this enactment, to represent that an article is patented, or a design or a trade mark is registered, if he sells the article with the word ‘patent,’ ‘patented,’ ‘registered,’ or any word or words expressing or implying that a patent or registration has been obtained for the article, stamped, engraved, or impressed on, or otherwise applied to the article.” This section has now been replaced, as to trade marks, by § 67 of the Trade Marks Act, 1905, and as to patents and designs, by § 89 of the Patents and Designs Act, 1907, but in substance the law remains the same. Under the Act of 1883 it was held that a person was subject to a penalty who represented an article to be patented, after he had applied for a patent and obtained provisional protection, but before the actual grant (*a*); and, similarly, where a person represented a trade mark to be registered, after he had applied for registration, and the application had been advertised in the “Trade Marks Journal,” but before the actual registration (*b*). So, too, where a trade mark had been registered but had been expunged before the date of the representation (*c*); and where goods of foreign manufacture were sold in the United Kingdom under a label containing the word “registered,” the use of that word was held to amount to a representation that the label was registered as a trade mark in the United Kingdom notwithstanding that the name of the foreign place where, in point of fact, the goods were manufactured appeared in small type on a different part of the label (*d*). It seems, however, that a statement that a trade mark is

describing an unpatented article as “patented,” and will be liable to a penalty if he knew or should have known that the article was not patented, but not if he *bonâ fide* believed it was so: *Tompkins v. Butterfield*, 25 Fed. Rep. 556. In *U. S. v. Morris*, 2 Bond, 23, Leavitt, J., held that the statute did not apply unless the goods were patentable: but in *Oliphant v. Salem Flouring Mills*, 5 Sawy. 128, Deady, J., held that it applied whether the goods were

patentable or not.

(*a*) *R. v. Wallis*, 3 P. R. 1; *R. v. Crompton*, *ib.* 367.

(*b*) *R. v. Morris*, Great Marlborough St. Police Court, Dec. 16, 1886.

(*c*) *Wright, Crossley & Co. v. William Dobbin & Co.*, 15 P. R. 21.

(*d*) *Wright, Crossley & Co. v. William Dobbin & Co.*, 15 P. R. 21; *McSymons' Stores, Ltd. v. Shuttleworth*, *ib.* 748. And see *Pneumatic Rubber Stamp Co. v. Lindner*, *ib.* 525.

registered before it in fact is so, does not disentitle the proprietor to sue, after registration has been effected (*a*), though it exposes him to a penalty (*b*), and may affect the costs of the action (*c*). Nor is the proprietor of a registered trade mark disentitled by the fact that he places the word "registered" on his trade mark when in use, though spaces left blank in the mark as registered are filled in when it is in use (*d*).

Use of word  
"trade  
mark"  
without  
registration.

The question whether the use by a trader upon his goods of the word "trade mark," without the word "registered," in connection with a word or device which has not been registered, amounts to a representation that the word or device has been registered, so as to expose the trade to the penalties of sect. 67, or to disentitle him to relief in an action brought by him to restrain passing off, is a question which must depend upon the facts of the particular case. The use of the word "trade mark" does not necessarily imply registration, for a trade mark can exist perfectly well without registration, though it cannot in most cases be protected without it, and in *Sen-Sen Co. v. Britten* (*e*), Stirling, J., considered that the word was not there used so as to convey any misrepresentation, and granted relief. In *Thomas Hubbuck & Son, Ltd. v. Brown* (*f*), Kekewich, J., adopted the same view, and modified the opinion he had previously expressed in *Lewis's v. Goodbody* (*g*), and it may generally be taken that the words "trade mark" *per se* do not imply registration (*h*).

Use of word  
"trade  
mark" in  
wrong place  
on label.

The word "trade mark" may be misused in another way: by being placed on a label or other composite mark in such a position as to indicate that a particular part of a registered mark is alone claimed, and not the mark as a whole, so as to lead persons to suppose that the remainder of the mark is open to the public. In such a case the person so using the word may be disentitled to bring an action, and his mark may be expunged (*i*). But here,

(*a*) See *per Brett, L. J.*, in *Reed v. Richardson*, 45 L. T. N. S. 54.

(*b*) See Trade Marks Act, 1905, § 67, replacing Patents Act, 1883, § 105; *R. v. Morris*, Great Marlborough St. Police Court, Dec. 16th, 1886; *Wright, Crossley & Co. v. Dobbin*, 15 P. R. 21; *McSymons' Stores, Ltd. v. Shuttleworth*, *ib.* 748.

(*c*) *Harris v. Ogg*, 5 N. S. W. Rep. 114.

(*d*) *M. Meluchrino & Co. v. R. Melu-*

*chrino & Co.*, Chitty, J., May 29th, 1888.

(*e*) (1899) 1 Ch. 692.

(*f*) 17 P. R. 148; affirmed *ib.* 638.

(*g*) 67 L. T. N. S. 194.

(*h*) This was in fact the view taken in the House of Lords in *Royal Baking Powder Co. v. Wright, Crossley & Co.*, 18 P. R. 95, though not expressly so stated in the judgments.

(*i*) *In re Apollinaris Co.*, (1891) 2 Ch. 186, 233—235; *In re Wills*, (1893) 2 Ch. 262.

again, it must not be assumed that whenever the word "trade mark" is placed upon a label it must be intended to denote only that particular part of the label upon which it is placed (*a*); it is a question of fact in each case whether the word is used to mislead (*b*). On the same principle, the wrongful use of the word "registered" has been held to be a ground for depriving a successful defendant of his costs (*c*).

By the Merchandise Marks Act, 1887, § 3 (1), a statement "as to any goods being the subject of an existing patent, privilege, or copyright," is, if untrue, a "false trade description" punishable under the Act. Under § 18, however, the provisions of the Act with respect to false trade descriptions are not to apply to the use of a trade description which was at the passing of that Act "lawfully and generally applied to goods of a particular class, or manufactured by a particular method, to indicate the particular class or method of manufacture of such goods." This will protect such combinations as "patent thread," in *Marshall v. Ross* (*d*), or "patent leather" boots.

Merchandise  
Marks Act,  
1887.

#### INOPERATIVE DEFENCES.

Among the defences which have occasionally been set up in actions for infringement of trade mark, but without success, are the following:

Ignorance of the plaintiff's rights. This will not suffice to prevent the issue of the injunction (*e*); although it may have the effect of relieving the defendant from the necessity of accounting (*f*).

(*a*) *In re Bass, Ratcliff & Gretton, Ltd.*, (1902) 2 Ch. 579. Since this decision the point can hardly be taken successfully except under very special circumstances.

(*b*) *Hammond v. Malcolm, Brunner & Co.*, 9 P. R. 301. And see *Benedictus v. Sullivan, Powell & Co.*, 12 P. R. 25.

(*c*) *In re Bradley*, 9 P. R. 205; *In re Paine* (2), 10 *ib.* 71. And see the observations of the L. J.J. in the same case, (1893) 2 Ch. 567. See also *Wincer & Co., Ltd. v. Armstrong & Co.*, 16 P. R. 167; *B. Warsop & Sons, Ltd. v. Warsop*, 21 P. R. 481. Cf. *Read v. Richardson*, 45 L. T. N. S. 54.

(*d*) L. R. 8 Eq. 651.

(*e*) *Burgess v. Hills*, 26 Beav. 244; *Gary v. Norton*, 1 De G. & S. 9; *Cartier v. Carlile*, 31 Beav. 292; *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Moet v. Couston*, 33 Beav. 578; *Orr-Ewing & Co. v. Grant, Smith & Co.*, 2 Hyde, 185; *Blogg v. Anderson*, N. S. W. 21 L. R. Eq. 238; *Upmann v. Forester*, 24 Ch. D. 231, and other cases.

(*f*) *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Moet v. Couston*, 33 Beav. 578; *Rose v. Loftus*, 47 L. J. Ch. 576; *Hipkins v. Plant*, 15 P. R. 291; *Sluzenger v. Spalding*, 27 P. R. 20.

Ignorance.

|  |  |
|--|--|
| No intention to sell.                          | Absence of intention to sell the goods bearing the spurious mark is no defence (a).  |
| No actual deception or fraud.                  | Absence of proof of actual deception or fraudulent intention is no defence, if in the opinion of the Court or jury there is such imitation as to be calculated to deceive (b).         |
| Immediate purchasers not deceived.             | It is no defence to prove that all the persons who bought from the defendant goods bearing the plaintiff's mark were well aware that they were not of the plaintiff's manufacture (c). |
| Indication of quality as well as manufacturer. | Nor to say that the marks used indicate quality or pattern, if they also indicate a particular manufacturer or merchant (d).   |
| Words ambiguous.                               | Nor to show that the words, of the use of which the plaintiff complains, are ambiguous and capable of being understood by different persons in different ways (e).                     |
| Only part of mark taken.                       | Nor to say that the plaintiff's entire mark has not been copied (f).   |
| Name used is defendant's own.                  | Nor to say that the name, to the use of which by the defendant the plaintiff objects, is the defendant's own, if he has used it so as to deceive (g).                                  |
| Name inaccurate in                             | Nor to say that the words, to the use of which by the defendant  |

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

(b) *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Cope v. Evans*, L. R. 18 Eq. 138; *Bodega Co., Ltd. v. Owens*, 6 P. R. 236; *Carr & Sons v. Crisp & Co., Ltd.*, 19 P. R. 497; *Orr-Ewing & Co. v. Grant, Smith & Co.*, 2 Hyde, 185; *Coats v. Holbrook*, 2 Sandf. Ch. 586; R. Cox, 20; *Taylor v. Carpenter*, 11 Paige, 292; 2 Sandf. Ch. 603; R. Cox, 45; *Coffeen v. Brunton*, 4 McLean, 516; 5 *ib.* 256; R. Cox, 82, 132; *Davis v. Kendall*, 2 R. I. 566; R. Cox, 112; *McLean v. Fleming*, 96 U. S. 245. And see Ch. IV. on Infringement.

(c) *Sykes v. Sykes*, 3 B. & Cr. 541; *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Rose v. Loftus*, 47 L. J. Ch. 576; *Singer Manufacturing Co. v. Loog* (3), 8 App. Cas. 15; *Balfour & Co. v. Kilburn & Co.*, 1 Hyde, 270; *Anglo-Swiss Condensed Milk Co. v. Metcalf*, 31 Ch. D. 454; *Reddaway v. Frictionless Engine Packing Co.*, 19 P. R. 505. And cases at p. 148, *supra*.

(d) See cases at pp. 79-80, *supra*.

(e) *Singer Manufacturing Co. v. Loog* (3), 8 App. Cas. 15, *per* Lord Selborne,

C.; *M. Melachrino & Co. v. R. Melachrino & Co.*, Chitty, J., May 29th, 1888.

(f) *Ford v. Foster*, L. R. 7 Ch. 611; *Wotherspoon v. Currie*, L. R. 5 H. L. 508. And see cases at pp. 152, 153, *supra*. Cf. *Rugby Portland Cement Co. v. Rugby & Newbold Portland Cement Co.*, 8 P. R. 241; *Barber v. Manico*, 10 P. R. 93.

(g) *Charlton v. Douglas*, Johns. 174; *Burgess v. Burgess*, 3 De G. M. & G. 896; *Pullar v. Pullar*, Fry J., April 9th, 1883; *Nicholls v. Kimpton*, 3 Times L. R. 674; *M. Melachrino & Co. v. R. Melachrino & Co.*, Chitty, J., May 29th, 1888; *Warner v. Warner*, 5 Times L. R. 359; *Army & Navy Co-operative Soc., Ltd. v. Army & Navy & Civil Service Co-operative Soc. of India, Ltd.*, 8 P. R. 426, 472; *Otard, Dupuy & Co. v. Otard de Monte Bello Cognac Co.*, 9 Times L. R. 295; 10 *ib.* 67; *Brinsmead v. Brinsmead*, 12 *ib.* 631; 13 *ib.* 3; *J. & J. Cash, Ltd. v. Cash*, 19 P. R. 181; *Joseph Rodgers & Sons v. Simpson*, 23 P. R. 348; *Joseph Rodgers & Sons v. Hearnshaw*, 23 P. R. 349; *Gage v. Canada Publishing Co.*, 11 Can. Sup. Ct. 306. And see *Bayer v. Bard*, 15 P. R. 651 (a case of initials). See also cases at p. 141.

the plaintiff objects, forms an accurate description of the goods which the defendant is selling, if the use is calculated to deceive (*a*). secondary meaning only.

Nor to produce a colourable authority to use the name of a person having the same name as that used by the plaintiff in his business (*b*). Colourable authority.

Nor to say that the goods which the defendant is selling under the mark in question are goods manufactured by the plaintiff, if they are of a different quality from that of which the defendant represents them to be (*c*). Goods plaintiff's own of different quality.

Nor to say that the spurious goods are equal in quality to the genuine ones, for the plaintiff's right is equally invaded (*d*). Equality in quality.

The defendant will not escape by showing that he has used his own name in conjunction with the mark or word which is alleged to be used in infringement of the plaintiff's rights (*e*). Addition of defendant's name.

(*a*) *Reddaway v. Banham*, (1896) A. C. 199; *Rockingham Rail. Co. v. Allen*, 12 Times L. R. 345.

(*b*) *Perry v. Trucfitt*, 6 Beav. 66; *Croft v. Day*, 7 Beav. 84; *Moet v. Clybourn*, Dig. 533; *Dence v. Mason* (1), Dig. 534; 41 L. T. N. S. 573; *Melachrino & Co. v. Melachrino Egyptian Cigarette Co.*, 4 P. R. 215; *Birmingham Vinegar Brewery Co., Ltd. v. Liverpool Vinegar Co., Ltd.*, W. N. 1888, p. 139; *Rendle v. Rendle & Co.*, 63 L. T. N. S. 94; *Edge v. Harrison*, 8 P. R. 74. But see *Beard v. Turner*, 13 L. T. N. S. 746; *Dence v. Brand*, W. N. 1881, p. 31.

(*c*) *Hennessy v. Kennett*, Dig. 556; *Hennessy v. White*, 6 W. W. & A. B. Eq. 216; *Hennessy v. Hogan*, *ib.* 225; *Gillott v. Kettle*, 3 Duer. 624; *Teacher v. Levy*, 23 P. R. 117; *Kirker, Greer & Co., Ltd. v. Mayman*, N. S. W. 1 S. R. 73.

(*d*) *Blofeld v. Payne*, 4 B. & Ad. 410; *Edelsten v. Edelsten*, 1 De G. J. & S. 185 (per Lord Westbury, C., "It is not necessary, for the injunction, to prove . . . that the credit of the plaintiff is injured by the sale of an inferior article. The injury done to the plaintiff in his trade by loss of custom is sufficient to support his title to relief"); *Singer Manufacturing Co. v. Looy* (3), 8 App. Cas. 15, per Lord Blackburn; *Coats v. Holbrook*, 2 Sandf. Ch. 586; R. Cox, 20; *Taylor v. Carpenter*, 11 Paige. 292; 2 Sandf. Ch. 603; R. Cox, 45; *Partridge v. Menck*, 2 Barb. Ch. 101; 1 How. App. Cas. 558; R. Cox, 72.

(*e*) *Wotherspoon v. Currie*, L. R. 5 H. L. 508; *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 376; *Siegert v. Findlater*, 7 Ch. D. 801; *Braham v. Bustard*, 1 H. & M. 447; *Ford v. Foster*, L. R. 7 Ch. 611; *Kinahan v. Bolton*, 15 Ir. Ch. 75; *Eno v. Stephens*, Dig. 609; *Rose v. Loftus*, 47 L. J. Ch. 576; *Field v. Lewis*, Dig. 280; *Reinhardt v. Spalding*, 49 L. J. Ch. 57; *Berliner Brauerei Gesellschaft Tirol v. Knight, Stocks & Co.*, W. N. 1883, p. 70; *Eno v. Dunn*, 10 P. R. 261; *Grezier v. Aufran*, 13 P. R. 1; *Birmingham Vinegar Brewery Co., Ltd. v. Powell*, (1897) A. C. 710; *Daniel v. Whitehouse* (2), 16 P. R. 71; *Burberrys v. Raper & Pulleyn*, 23 P. R. 170; *Gt. North of Scotland Rail. Co. v. Mann*, Ct. Sess. Cas. 4th Ser. XIX. 1035; *Nami Chand v. Wallace*, 34 Cal. 495. And see *Reddaway v. Ahlers*, 19 P. R. 12; *Reddaway v. Frictionless Packing Co.*, 19 P. R. 505; *Reddaway v. Robert Stevenson & Bros., Ltd.*, 20 P. R. 313; *Singer Manufacturing Co. v. British Empire Manufacturing Co., Ltd.*, 20 P. R. 313; *Siegert v. Ehlers*, Dig. 432; *Davis v. Kennedy*, 13 Grant, Up. Can. Ch. 523. And see *Pillsbury v. Pillsbury-Washburn Flour Mills Co.*, 64 Fed. Rep. 841, where a statement that the defendant's goods were not the same as the plaintiff's was held not a good defence. But compare *Cheavin v. Walker*, 5 Ch. D. 850; *Barrett v. Gamm*, 74 L. T. (Journal) 388; *Barrett v. White*, North, J., May 12th, 1883; *Somerville v. Schembri*, 12 App.

- Addition of address. Nor by showing that he has always placed his own address on the goods (*a*).
- Addition of word "Improved." Nor by showing that he has used the word "Improved" in connection with his goods (*b*).
- User by others. Nor by showing that the same mark has been used by other persons on goods of another class (*c*), or by fewer than three firms besides the plaintiff on goods of the same class (*d*), or by different firms abroad, if not in England (*e*).
- Fraudulent anticipation. Nor by showing that another trader used the mark before the plaintiff, if that other trader's right to the mark has been adjudged to be gone by reason of misrepresentations contained in it (*f*).
- Infringement by others. Nor by showing that the plaintiff's trade mark has been infringed by others without his knowledge or acquiescence (*g*).
- A plurality of marks or names. It is no defence to say that the plaintiff uses more than one trade mark on the same goods (*h*), nor that his goods have been known by a variety of names (*i*).
- Additions in practice to marks as registered. Nor that the plaintiff in practice uses devices, &c., on his trade marks which are not registered as part of them—*e.g.*, filling in blank spaces with coats-of-arms (*k*).
- Infringement in district of a licensee. Nor that the infringement has been committed in a district in which the plaintiff has appointed a licensee (*l*).

Cas. 453; *McCall v. Theal*, 28 Grant, Up. Can. Ch. 48; *Pratt's Appeal*, 117 Penn. St. 401; *Bryant & May v. Heyde*, 7 N. S. W. Rep. (E.) 72; *Saxlehner v. Eisner*, 179 U. S. 19.

(*a*) *Gray v. Taper Sleeve Pulley Works*, 16 Fed. Rep. 436. Cf. *Craft v. Day*, 7 Beav. 84.

(*b*) *Russia Cement Co. v. Le Page*, 147 Mass. 206; *Alexander v. Morse*, 14 R. I. 153; *Gage v. Canada Publishing Co.*, 11 Can. Sup. Ct. 306; *Californian Fig Syrup Co. v. Improved Fig Syrup Co.*, 51 Fed. Rep. 296; 54 *ib.* 175.

(*c*) *Hall v. Burrows*, 4 De G. J. & S. 150; *Ainsworth v. Walmsley*, L. R. 1 Eq. 518; *Somerville v. Schembri*, 12 App. Cas. 453; *Colman v. Crump*, 70 N. Y. 573.

(*d*) *Dent v. Turpin*, 2 J. & H. 139; *Worcester Royal Porcelain Co. v. Locke & Co.*, 19 P. R. 479; *Dunnachie v. Young & Sons*, Ct. Sess. Cas., 4th Ser. X. 874; and cases at pp. 124, 125.

(*e*) *Berliner Brauerei Gesellschaft Tirol v. Knight, Stocks & Co.*, W. N. 1883, p. 70; *Jackson v. Napper*, 35 Ch. D. 162; *Newman v. Pinto*, 4 P. R. 508 (*per*

*Kekewich, J.*); *Boord & Son v. Huddart*, 21 P. R. 149; *Boord & Son v. Thom & Cameron*, 24 P. R. 697. So in Canada: *Smith v. Fair*, 14 Ont. Rep. 729.

(*f*) *Parlett v. Guggenheimer*, 67 Md. 542.

(*g*) *Ford v. Foster*, L. R. 7 Ch. 611; *Boord & Son v. Huddart*, 21 P. R. 149; *Boord & Son v. Thom & Cameron*, 24 P. R. 697; *Taylor v. Carpenter*, 3 Story, 458; *R. Cox*, 14; *Filley v. Fassett*, 44 Mo. 173; *R. Cox*, 530.

(*h*) *Braham v. Bustard*, 1 H. & M. 447; *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 376; *Wheeler v. Johnston*, 3 L. R. Ir. 284.

(*i*) *Orr-Ewing & Co. v. Johnston & Co.*, 13 Ch. D. 434.

(*k*) *Newman v. Pinto*, 57 L. T. N. S. 31 (*per Kekewich, J.*); *Melachrino v. Melachrino Egyptian Cigarette Co.*, 4 P. R. 215; *M. Melachrino & Co. v. R. Melachrino & Co.*, Chitty, J., May 29th, 1888; *Hammond v. Malcolm, Brunker & Co.*, 9 P. R. 301.

(*l*) *Marie Nerve Food Co. v. Raumbach*, 32 Fed. Rep. 205.

Mere exaggerated statements of the merits of medical or other compounds on the part of the plaintiff, which do not amount to fraud, will not exonerate the defendant from the consequences of his own fraud (*a*). Nor will other statements by the plaintiff, which, though not absolutely correct, cannot mislead in any important respect (*b*)—*e.g.*, an allegation that the plaintiff's mark was registered before registration had actually been effected (*c*); or the putting the word "registered" on the mark as used, though spaces left blank in the mark as registered are filled in (*d*). Puffing.

The defendant will not escape by alleging laches on the part of the plaintiff in prosecuting his action, if no greater delay has taken place than was requisite to enable necessary evidence to be obtained (*e*). Slight delay.

Infancy is no defence, for "if an infant practises a fraud, he is liable for the consequences" (*f*), and he will be in the same position as an adult with respect to the payment of costs (*g*). And so with a married woman having separate estate (*h*). Infancy.

Registration of the defendant's mark at Stationers' Hall, or in the trade marks register (*e*), is no defence (*i*). Defendant's mark registered.

Nor is it any defence to say that an injunction, if granted, would interfere with the defendant's business, or with that of other manufacturers, since they will be able to trade as they please, with the sole exception of using the plaintiff's trade mark (*k*). Interference with defendant's business.

### Discovery and Inspection.

The plaintiff in a trade mark case sometimes thinks it advisable, for the purposes of his action, to obtain from the defendant, a disclosure of certain particulars of his business—as, for instance, of Discovery.

(*a*) *Holloway v. Holloway*, 13 Beav. 209; *Metzler v. Wood*, 8 Ch. D. 606; *Rowland v. Mitchell*, (1897) 1 Ch. 71; *Comstock v. White*, 18 How. Pr. 421. See cases at p. 229.

(*b*) *Siebert v. Findlater*, 7 Ch. D. 801. See cases at p. 231.

(*c*) *Reed v. Richardson*, 45 L. T. N. S. 54; *Upper Assam Tea Co. v. Herbert & Co.*, 7 P. R. 183; *Goodwin v. Fenning*, 24 Sol. J. 690.

(*d*) *M. Melachrino & Co. v. R. Melachrino & Co.*, Chitty, J., May 29th, 1888.

(*e*) *Lee v. Haley*, L. R. 5 Ch. 155;

*Care v. Myers*, Dig. 304. See *McLean v. Fleming*, 96 U. S. 245.

(*f*) Per Plumer, V.-C., in *Cory v. Gertken*, 2 Madd. 49.

(*g*) *Chubb v. Griffiths*, 35 Beav. 127; *Woolf v. Woolf*, 43 Sol. J. 127.

(*h*) *Nicholls v. Kimpton*, 3 Times L. R. 674.

(*i*) *Reinhardt v. Spalding*, 49 L. J. Ch. 57. And see cases at p. 158.

(*k*) *Ransome v. Graham*, 51 L. J. Ch. 897. See *Cope v. Evans*, L. R. 18 Eq. 138; *Bass v. Dauber*, 19 L. T. N. S. 626.



the names of customers to whom the goods alleged to be marked with the plaintiff's trade mark have been sold, or on whose account such goods have been conveyed.

Principles on which given.

The principles on which this advantage is given or withheld are thus stated by Lord Hatherley, C. (a): "The Court does not, when discovery is a matter of indifference to the defendant, weigh in golden scales the question of materiality or immateriality; but where the nature of the discovery required is such that the giving of it may be prejudicial to the defendant, the Court takes into consideration the special circumstances of the case, and whilst, on the one hand, it takes care that the plaintiff obtains all the discovery which can be of use to him, on the other it is bound to protect the defendant against undue inquisition into his affairs. The question of materiality must be tested by reference to the case made by the plaintiff's pleadings, and to what will be in issue at the hearing."

Not given where oppressive.

"The more strict the Court is in compelling a full answer, the more necessary it is that the Court should be vigilant in seeing that the process of the Court is not made use of in an oppressive manner" (b). Where, therefore, the L.J.J. were of opinion that the discovery asked was such as the plaintiff, even if he failed at the hearing, might yet afterwards use in a manner prejudicial to the defendant, and were not satisfied that there was any real prospect of its being of material service to the plaintiff at the hearing, they reversed the order of the Vice-Chancellor of Lancaster, by whom such discovery had been granted (c).

*Benbow v. Low.*

So in *Benbow v. Low* (d) the defendants, who were also plaintiffs by counterclaim, exhibited interrogatories requiring the plaintiffs to state (*inter alia*) what quantities of soap had been sold by them bearing the name in dispute, between the dissolution of the original partnership and the date of the action, distinguishing between the quantities sold in each year, and between the quantities sold in England and in the United States and in the continent of Europe; and Bacon, V.-C., and the Court

(a) *Moore v. Craven*, L. R. 7 Ch. 94.

(b) *Per Selwyn*, L. J., in *Lockett v. Lockett*, L. R. 4 Ch. 341. And see *Piggott v. Anglo-American Telegraph Co.*, 19 L. T. N. S. 46.

(c) *Carrer v. Pinto Leite*, L. R. 7 Ch. 90. "If the Court sees that all fair and

legitimate purposes will be answered by a restricted discovery, it will so restrict it": *per Hall*, V.-C., in *Orr v. Diaper*, 4 Ch. D. 92, commenting on this case. The present Rules of Court favour such restrictions.

(d) 16 Ch. D. 93.

of Appeal hold that the plaintiffs were justified in refusing to answer, as the question was framed, not for the ordinary purposes of discovery, but in order to get at the details of a part of the plaintiffs' evidence.

In *In re Wills* (a), which was an application to remove a trade mark from the register, Kekewich, J., ordered the respondents to give discovery of documents after the evidence was all but completed, but restricted the order to documents relating to certain specified questions framed with a view to show that the respondents' mark was common to the trade and not distinctive; but the Court of Appeal regarded even this restricted form of order as oppressive, and discharged it upon the terms of the respondents undertaking to deliver a statement of the labels on which they intended to rely, and to produce all relevant documents in Court. *In re Wills.*

On the other hand, "the Court, while it takes care that no oppressive use is made of its forms of procedure, must take care that parties are not allowed to refuse discovery which they ought to make" (b). Where, therefore, a defendant who, having been the agent in London of the plaintiff, an American sewing-machine maker, continued, after dismissal, to advertise himself as the plaintiff's agent, and to sell as "the Howe Sewing Machine" machines not made by the plaintiff, and refused to give discovery of all the machines sold by him, with the prices, profits, names of purchasers, and other particulars, on the ground that he would thereby disclose the names of his customers and the secrets of his trade, Romilly, M. R., held that the discovery might be extremely material to the plaintiff, and ordered it to be given (c). Again, where the plaintiff obtained an injunction against the defendants, and the defendants offered to submit to an injunction and pay costs, and then moved to stay proceedings, the answer to the plaintiff's interrogatories not having yet been given, Wood, V.-C., said that the plaintiff had a right to ascertain the facts in his own way, by the answer of the defendants to his interrogatories, and that until the defendants had Given when necessary.

(a) (1892) 3 Ch. 201.

(b) Per Giffard, L. J., in *Thompson v. Dunn*, L. R. 5 Ch. 576. And see *Renard v. Levinstein*, 10 L. T. N. S. 94; *Russell v. Brichton*, Ct. Sess. Cas. 1st Ser. XV.

1270; *Union Paper Collar Co. v. Metropolitan Collar Co., Ltd.*, 3 Daly, 171; *Byass v. Sullivan*, 21 How. Pr. 50.

(c) *Howe v. McKernan*, 30 Beav. 547.

put in their answer, it was impossible for the Court to say whether or not he had done rightly in rejecting the terms offered by the defendants. The motion was refused, with costs (a).

*Leather Cloth Co. v. Hirschfeld.*

In *Leather Cloth Co. v. Hirschfeld* (b), a decree having been made directing the defendant to account for all goods sold by him with a particular stamp, it was decided by the same learned judge that the defendant was compellable to disclose the names of all persons to whom he had sold any such goods, and that if he could not say to which of his customers the stamped goods were sold, he was then (but not otherwise) compellable to disclose the names of all customers to whom he had sold goods which he would not swear positively were unstamped.

*Fennessy v. Clark.*

In *Fennessy v. Clark* (c), an action for an injunction to restrain an infringement of trade mark, and for damages or an account, after an order had been made for the trial of issues of fact before a judge and jury, and before the plaintiff had elected between damages and an account, the plaintiff took out a summons for a fuller statement by the defendant of the number of his sales and for inspection of his books; but the application was refused as being premature.

*Orr v. Diaper.*

In *Orr v. Diaper* (d) discovery was granted, though no other relief was sought in the action, but it is questionable whether this decision can now be relied on.

In *Poisson v. Robertson* (e), the question was raised, but not decided, whether the assignee of a partial interest in a secret remedy was as such entitled to a knowledge of the secret, but the Court refused an application for inspection of the recipe on the ground that at the date of the application the action was at an end.

Discovery under Merchandise Marks Act, 1887.

By § 2 (2) (b) of the Merchandise Marks Act, 1887, a person who sells or exposes for sale goods having a forged trade mark or false trade description applied thereto is guilty of an offence against the Act, unless he proves, among other things, "that, on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons from whom

(a) *Stephens v. Brett*, 10 L. T. N. S. 231.

(b) 1 H. & M. 295. And see *Powell v. Birmingham Vinegar Brewery Co.*, 14

P. R. 1.

(c) 37 Ch. D. 184.

(d) 4 Ch. D. 92.

(e) 86 L. T. N. S. 302.

he obtained" the goods; and § 12 authorises the issue of a search-warrant (a).

In *Hennesy v. Rohmann* (b), Malins. V.-C., granted inspection of cases and bottles used by the defendants. In *Smith v. Harris* (c), the plaintiff in a trade-mark case alleged by his statement of claim that he had for many years used the word "Glenlivet" on his invoices, letters, billheads, and whiskey casks, and, on the defendant's application, he was ordered to produce for inspection the invoices, letters and billheads in his possession so marked, but not the casks.

Inspection  
under Judi-  
cature Acts.

In the last-mentioned case the defendant alleged by his statement of defence that the plaintiff had for many years been well aware of the word "Glenlivet" being widely used in the trade in connection with other makes of whiskey; and the Court of Appeal ordered (d) the defendant within an appointed time to deliver particulars of the names of the persons alleged to have used the word with the plaintiff's knowledge, and the times when and the places where they had done so, and ordered that, if the defendant should not do so, the paragraph in the defence should be struck out. Again, in *Humphries v. Taylor Drug Co.* (1) (e) the plaintiff in a trade-mark action having alleged by his statement of claim that persons had been deceived, he was ordered to deliver particulars of the names and addresses of the persons alleged to have been deceived. But in *Duke v. Wisden* (f), which was a passing off action, the Court of Appeal held that it was sufficient for the plaintiffs to give information of the times and places of the sales complained of without giving the names and addresses of the purchasers. If a defendant alleges that the trade mark is invalid, he must, if re-

Particulars.

(a) By sect. 6 of the Merchandise Marks Act, 1862, full information had to be given within forty-eight hours.

(b) 36 L. T. N. S. 51. This was under Order LII. r. 3, of the Rules of Court then in force, now Order L. r. 3.

(c) 48 L. T. N. S. 869.

(d) Feb. 6th, 1884.

(e) 39 Ch. D. 693. And see *Aquascutum, Ltd. v. Moore & Scantlebury*, 20 P. R. 640; *Imperial Tobacco Co., Ltd. v. Purnell & Co.*, 20 P. R. 718.

(f) 77 L. T. N. S. 67. So per C.A., *Blackburn v. Lodge*, Ann. Pr. 1911, 446, 454. This was followed by Eady, J., in chambers in *Banana Food Co., Ltd. v. Jones* (Feb. 15th, 1901). It has also been followed in Victoria (*National Starch Co. v. Robert Harper & Co. Proprietary, Ltd.* (1906), V. L. R. 8), where the Court expressly declined to follow *Aquascutum, Ltd. v. Moore & Scantlebury* (20 P. R. 640) and *Imperial Tobacco Co. v. Purnell*, 20 P. R. 718. And see *A. Boake, Roberts & Co., Ltd. v. Wayland*, 26 P. R. 249.

quired, give particulars of the alleged invalidity (*a*), and where a defendant has alleged that the mark has been used by traders other than the plaintiffs, particulars of such user have frequently been directed (*b*). But in some cases in which the defendant has alleged common user and has given particulars of persons alleged to have used the name, he has been permitted to give evidence of user by persons not named in the particulars (*c*).

### Account.

Account.

A most important part of the remedy given in Equity for the infringement of the rights of the owner of a trade mark is the account of the profits, by which such profits as have been dishonestly acquired by a defendant by means of the reputation of another are restored to the plaintiff, whose they ought to have been at first. The principle is the same as where a man is made to account for the profits which he has improperly received, arising from the fraudulent manufacture of a secret medicine (*d*) or the publication of a newspaper (*e*).

Incident to injunction.

“The liability to account for the profits is incident to the injunction” (*f*), and “on authority and principle it is clear that if a man manufactures goods and knowingly marks them with the trade mark of another person, he is accountable for the profits so made” (*g*), and that, whether he manufactures on his own account, or only puts up goods for others (*h*).

Wherever another's mark is placed on the goods by the defendant.

So long as the defendant is aware that he is using a trade mark, which is not his, the fact that he does not know to whom the trade mark belongs which is on the goods he is selling does not in the slightest degree affect the right of the owner to an injunc-

(*a*) *Rouland v. Mitchell*, 13 P. R. 457 (see p. 460); *Grosvenor Chemical Co. v. Greenfield*, (1909) 1 Ir. R. 32.

(*b*) E.g., *Brooke, Bond & Co. v. City Tea Co.*, Chitty, J., Feb. 27th, 1893; *Same v. Shaw*, North, J., Feb. 27th, 1893, in *Anglo-Swiss Condensed Milk Co. v. Parks*, 20 P. R. 509; *Aquascutum, Ltd. v. Moore*, 20 P. R. 640; *Schweppes, Ltd. v. Gibbons*, 22 P. R. 116; *Star Cycle Co. v. Frankenburgs*, 24 P. R. 46, 405.

(*c*) *Star Cycle Co., Ltd. v. Frankenburgs*, 24 P. R. 46, 405; and in Scotland, *Parozone Co., Ltd. v. Johnston Gibson*, 21 P. R. 317. Such permission, however, obviously reduces the value of the par-

ticulars to very little indeed.

(*d*) *Green v. Folgham*, 1 S. & S. 398.

(*e*) *Giblett v. Read*, 9 Mod. 459.

(*f*) Per Romilly, M. R., in *Cartier v. Carlile*, 31 Beav. 292. And see *Lever v. Goodwin*, 36 Ch. D. 1; and *Saxlehner v. Apollinaris Co.*, (1897) 1 Ch. 893.

(*g*) Per Romilly, M. R., in *Moet v. Conston*, 33 Beav. 578. See *Carter v. Bowker*, Dig. 581. The account only extends to goods actually sold under the spurious mark, not to goods manufactured but not sold. See *Stonebraker v. Stonebraker*, 33 Md. 252.

(*h*) *Sawyer v. Kellogg*, 7 Fed. Rep. 721; 9 *ib.* 601.

tion and an account of profits. And since the defendant cannot himself have placed on the goods another's trade mark, without being aware that he was infringing someone's trade-mark rights, though he may not have known exactly whose it was, he will be accountable in all cases in which he has himself placed the mark on the goods (a).

But where the defendant has used the mark innocently, although the plaintiff will be entitled to his injunction, he will not necessarily be entitled to an account, except in respect of any user by the defendant after he became aware of the prior ownership (b). On this principle, in *Ellin v. Slack* (c), a defendant who had bought and resold goods bearing a mark which infringed the plaintiff's trade mark, but without knowledge of the infringement, and who, on hearing of the infringement, had at once desisted from any further sales and offered to submit to a perpetual injunction with costs, was relieved from accounting.

Not always so, where defendant used innocently.

In many cases the main object of the action is to obtain the injunction, the account being of very secondary importance (d); and occasionally the injury suffered by the plaintiff, and the profits received by the defendant, have been so small that the account has not formed part of the relief awarded, so that the old rule that the injunction was subordinate to the account (e) no longer holds good.

Account sometimes useless.

As a plaintiff may be disentitled to his injunction by reason of his own laches, so he may be disentitled by the same reason to the account of profits. If he permits the defendant to continue his infringement for a prolonged period, he will not then be allowed to treat him as his salesman, and claim an account (f). But if the plaintiff has not been aware of the fact of the defendant's user, the length of that user will not deprive him of his right to an account (g).

No account where laches.

(a) *Cartier v. Carlile*, 31 Beav. 292; *Moet v. Couston*, 33 Beav. 578. And see S. C. 10 L. T. N. S. 395.

(b) *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Moet v. Couston*, 33 Beav. 578; *Hipkins v. Plant*, 15 P. R. 294; *Sluzenger v. Spalding*, 27 P. R. 20.

(c) 24 Sol. J. 290.

(d) *Perce v. Franks*, 15 L. J. Ch. 122; *Burgess v. Hately*, 26 Beav. 249; *Leather Cloth Co. v. American Leather Cloth Co.*, 4 De G. J. & S. 137; *McAndrew v. Bassett*, *ib.* 380; *Barnett v. Leuchars*, 13

L. T. N. S. 495; *Shipwright v. Clements*, 19 W. R. 599, &c.

(e) *Delondre v. Shaw*, 2 Sim. 237.

(f) *Beard v. Turner*, 13 L. T. N. S. 746; *Harrison v. Taylor*, 11 Jur. N. S. 408; *McLean v. Fleming*, 96 U. S. 245; *Amoskiag Manufacturing Co. v. Garner* (2), 54 How. Pr. 298; *Holt v. Menendez*, 128 U. S. 182; *Low v. Fells*, 35 Fed. Rep. 361.

(g) *Sawyer v. Kellogg*, 7 Fed. Rep. 721; 9 *ib.* 601.

Offer of  
submission.

Where a defendant offered, among other things, to account for profits, but the plaintiff, declining the offer of submission, insisted upon his own terms, including an account, the Court granted the account, but only upon the plaintiff's request, and at his peril in respect of costs, in case it should turn out that the account furnished by the defendant of his own accord was accurate (*a*).

Sub-divided  
account.

In *Dent v. Turpin* (*b*), where a defendant had infringed a trade mark, which had become by bequest the property of two different persons, and those persons brought distinct actions against the defendant, the prayer in each case including an account and payment of such share of the profits as should be shown to be attributable to the individual plaintiff's share, it was held that such an account and payment could be granted.

Extent of  
account.

As to the extent of the account, the general rule is (though it seems possible that there may be exceptions to it), that where goods are sent into the market under a spurious mark or name or get-up which is calculated to deceive, the account must extend to the whole of the goods so sent into the market, and will not be limited to such part of the goods as can be proved to have caused deception, nor yet so as to exclude such part of the goods as can be proved to have been sold without deception, seeing that the goods carry with them the means of deception, and ultimate or intermediate purchasers may well be deceived, even though the immediate purchaser, who is usually a wholesale or retail trader, may not be. The manufacturers of the spurious goods cannot retain the profits which they have made by putting into the hands of the retailers the means of deceiving the public, whether they have made such use of those means as to produce deception or not (*c*). The account will not be given for a period of more than six years before the commencement of the action, and it will not include every species of profit made by the defendant during that

(*a*) *Nunn v. D'Albany*, 34 Beav. 595.

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

(*c*) *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Lever v. Godwin*, 36 Ch. D. 1; *Sackner v. Apollinaris Co., Ltd.*, (1897) 1 Ch. 893. According to the American decisions, the defendant must account for the whole of the profits made by the sales under the wrongful mark (*Benkert v. Feder*, 34 Fed. Rep. 534), even though he may have sustained a loss on his

business as a whole: *Atlantic Milling Co. v. Rowland*, 27 Fed. Rep. 24. In computing profits no deduction can be made for expenses not exclusively attributable to the wrongful venture: *Société Anonyme v. Western Distilling Co.*, 46 Fed. Rep. 921. And when the plaintiff elects to take an account of the profits made by the defendant, the profits which he would himself have made are immaterial: *Atlantic Milling Co. v. Rowland*, 27 Fed. Rep. 24.

period, but only so much as is properly attributable to the use of the plaintiff's trade mark (*a*). The account must extend, at all events in case of fraud, to sales prior to the plaintiff's registration, as well as to sales since then (*b*). If the defendant was at first ignorant that he was using a trade mark, the account may be made to commence from the date when he became aware of that fact (*c*); and where the plaintiff had himself been guilty of misrepresentation, and the defendant's business was carried on upon so much larger a scale than the plaintiff's as to render it impossible to suppose that the use of the plaintiff's mark had alone brought the defendant his customers, the account was only given from the date of filing the bill, and not earlier (*d*).

An account of profits is usually directed at the plaintiff's risk (*e*). Where an account had been directed of the sale and profits of a book published in infringement of the plaintiff's rights notwithstanding an affidavit by the defendant that about half of 11,000 copies printed had been sold, and the account showed that 9,000 copies had been sold, but that instead of a profit there had been a small loss, it was held that the affidavit had been shown to be untrustworthy, and that the plaintiff was justified in requiring the account to be taken, and was entitled to the costs thereby occasioned (*f*).

Account directed at plaintiff's risk.

The acceptance of an account of profits by the plaintiff operates as a condonation of the infringement; so that a plaintiff must elect between the account and an inquiry as to damages, but cannot insist on both (*g*), though he may at the outset claim both in the alternative, reserving his election till a later stage (*h*).

Election between account and damages.

It has sometimes been considered that the Court has a discretion to refuse to direct an account and to compel a successful plaintiff to accept an inquiry as to damages (*i*), but after the decision of the House of Lords in *Weingarten v. Bayer* (*k*), adopting the

Right to elect between account and damages.

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

(*b*) *Smith v. Fair*, 14 Ont. Rep. 729.

(*c*) *Moet v. Couston*, 33 Beav. 578; *Edelsten v. Edelsten*, 1 De G. J. & S. 185. But in America the state of knowledge of the infringer appears to be immaterial, and a defendant may be made to account for an inadvertent infringement: *Oakes v. Tonsmierre*, 49 Fed. Rep. 447.

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

(*e*) As an inquiry as to damages may be. See *Tonge v. Ward*, 21 L. T. N. S.

480.

(*f*) *Dicks v. Jackson*, Chitty, J., March 31st, 1884.

(*g*) *Neilson v. Betts*, L. R. 5 H. L. 1.

(*h*) This is the usual course in England; and see *Leidersdorf v. Flint* (2), 50 Wis. 401.

(*i*) E.g., *Weingarten v. Bayer* (Joyce, J., and C. A.), 20 P. R. 289, 649; *Van Zeller v. Mason, Cuttley & Co.*, 25 P. R. 37.

(*k*) 22 P. R. 341, at p. 351.



view taken by Lord Westbury in *Edelsten v. Edelsten* (a), it can hardly be questioned that the plaintiff is entitled to make his own election between them.

### Damages.

Damages.

It is in the option of a successful plaintiff in a trade mark action to elect between an account of profits and an inquiry as to damages, although, as before stated, he cannot have both (b). Damages being the appropriate remedy at Common Law, while the account of profits was peculiar to Equity, the result, and probably the cause of the great majority of trade mark cases being brought into Equity, has been that an account has been frequently awarded, and not damages. This has been the case notwithstanding that the Courts of Equity have had the power of giving relief in the shape of damages (c), since in many cases the account forms the most convenient remedy.

When given.

Some of the remarks made in reference to the account apply in respect of damages: thus, the defendant is liable in damages for the user of what he has reason to know, or suppose to be, a forged trade mark, though he may be ignorant of the owner; but not necessarily for user of a mark which he did not at all know to be wrongly used (d); while, on the other hand, the plaintiff may be held to be disentitled to damages by reason of his own delay (e). Damages may be awarded in respect of infringements prior to the plaintiff's registration, since registration is only a condition precedent to suing (f).

(a) 1 De G. J. & S. 185; and see *Lerer v. Goodwin*, 4 P. R. 492; *Saxlehner v. Apollinaris Co.*, 14 P. R. 645.

(b) *Neilson v. Betts*, L. R. 5 H. L. 1; *Weingarten v. Bayer*, 22 P. R. 341; *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Lerer v. Goodwin*, 4 P. R. 492; 36 Ch. D. 1; *Saxlehner v. Apollinaris Co.*, (1897) 1 Ch. 893; and *Leidersdorf v. Flint* (2), 50 Wis. 401. *Van Zeller v. Mason Cattle & Co.*, 25 P. R. 37, seems to have been based on a misapprehension as to the decision of the House of Lords in *Weingarten v. Bayer*, 22 P. R. 341.

(c) Thus, inquiries as to damages were given in *Cheavin v. Walker*, 5 Ch. D. 850, 861; and *Graveley v. Winchester*, Seton, 6th ed. 695.

(d) *Edelsten v. Edelsten*, 1 De G. J. & S. 185; *Cartier v. Carlile*, 31 Beav. 292;

*Mort v. Custon*, 33 ib. 578; 10 L. T. N. S. 395; *Hipkins v. Plant*, 15 P. R. 291; *Slazenger v. Spalding*, 27 P. R. 20. Thus, in *Weed v. Peterson*, 12 Abb. Pr. N. S. 178, it was held that, though an injunction must be granted with costs, yet, as the defendants had acted perfectly *bonâ fide*, no damages could be given. But, however innocent the defendant may have been, there has still been an invasion of the plaintiff's rights, and it would appear that at Common Law the plaintiff is entitled to at least nominal damages. See p. 179.

(e) *Amoskeag Manufacturing Co. v. Garner* (2), 54 How. Pr. 298; *Holt v. Mendez*, 128 U. S. 182.

(f) *Barlow & Jones, Ltd. v. Johnson & Co.*, 7 P. R. 395, 411.

For damages to be recovered it is not necessary that special damage should be proved; it is sufficient to show that the plaintiff's right has been invaded, in which case some damages, even if only nominal, will usually be given (*a*). Even if the wrongful act has been done by a servant, contrary to his employer's directions, it appears that the employer will still be liable, at all events in nominal damages, if the servant was acting within the scope of his employment (*b*). And it has been held in Scotland (*c*), in New Zealand (*d*), and New South Wales (*e*), that more than nominal damages may be awarded for a fraudulent imitation, even without proof of special damage.

Special  
damage need  
not be proved.

The measure of damages which can be recovered when special damage is proved is not yet clearly settled by authority; but in *Leather Cloth Co. v. Hirschfeld* (*f*), it was held by Wood, V.-C., that it would not be assumed in the absence of evidence that the amount of goods sold by the defendant under the fraudulent trade mark would have been sold by the plaintiff but for the defendant's unlawful use of the plaintiff's trade mark: for the Court could not assume that the persons who bought what the plaintiff averred were inferior articles, at an inferior price, would necessarily, if they had not done so, have bought the superior articles at the higher prices. Again, in *Magnolia Metal Co. v. Atlas Metal Co.* (*g*), notwithstanding that the defendants had sold a large quantity of the spurious goods, Collins, J., refused to award any damages in the absence of evidence that the plaintiffs had been thereby deprived of the sale of any goods, or that the reputation of their goods had suffered, and this view was affirmed by the Court of Appeal. In America it has been said that "every consideration of reason, justice, and sound policy demands that one who fraudulently uses the trade mark of another should not be allowed to shield himself from liability for the profit he has made

Measure of  
damages.

(*a*) *Blofeld v. Payne*, 4 B. & Ad. 410. And see *Sykes v. Sykes*, 3 B. & Cr. 541; *Marison v. Salmon*, 2 Scott, N. R. 449; 2 Man. & G. 385; *Monro v. Hunter*, 21 P. R. 296; and cases at p. 179, n. (*b*). But in a case where the defendant was not the substantial infringer and the sales by him were small the Court refused an inquiry as to damages: *Boord & Son v. Huddart*, 21 P. R. 149.

(*b*) *Monro v. Hunter*, 21 P. R. 296.

(*c*) *Thomson & Co. v. Daily*, Ct. Sess.

Cas. 4th Ser. XXIV. 1173.

(*d*) *Littlejohn & Son v. Mulligan*, 3 N. Z. L. R. (Sup. Ct.) 446.

(*e*) *Wilson v. Smith*, N. S. W. 2 S. R. 174.

(*f*) L. R. 1 Eq. 299. See *Davenport v. Rylands*, *ib.* 302; *Alexander & Co. v. Henry & Co.*, 12 P. R. 360.

(*g*) 14 P. R. 389. Cf. *Pinto v. Trott*, 8 P. R. 173, 179; and *Thomson & Co. v. Daily*, Ct. Sess. Cas. 4th Ser. XXIV. 1173.

by the use of the trade mark on the plea that it is impossible to determine how much of the profit is due to the trade mark and how much to the intrinsic value of the commodity. The fact that it is impossible to apportion the profit renders it just that he should lose the whole" (a); and the usual practice in America appears to be to assess damages at the amount of the profits which the plaintiffs would have made if they had sold the same quantity of the genuine goods as the defendants had sold of the spurious ones (b), or, at all events, at the amount of the actual profits reaped by the defendants from the infringement (c). The observation, however, seems just, that the measure of damages is really the injury done to the plaintiffs, and not the profits made by the defendants (who in *Leather Cloth Co. v. Hirschfeld* (d) were selling at lower prices than the plaintiffs) (e); and in an Indian case (f), where it was shown that the price of the plaintiff's goods had been necessarily lowered in consequence of the defendants' fraudulent competition, it was held that the amount of the reduction in price gave the measure of damages. So it was said in *Atlantic Milling Co. v. Robinson* (g) that the extent to which the defendants' infringement had interfered with the plaintiff's sales was the measure of damages. All the above elements were present in *Alexander & Co. v. Henry & Co.* (h), in which the plaintiffs recovered over 8,000*l.* by way of damages in respect of their thread having been practically driven out of the Mexican market by repeated fraudulent imitations of their trade marks, the damages being made up of (1) profits which the plaintiffs would have made if they had sold thread of their own equal in quantity to the thread sold under certain spurious tickets, they having previously had a substantial monopoly of the market; (2) damage incurred by enforced reduction of the plaintiffs' prices; (3) damage occasioned by the competition of the defendants under other tickets, which had only been rendered possible by the injury to the plaintiffs' reputation caused by the sale of inferior thread under the fraudulent tickets.

(a) See *per* Crockett, J., in *Graham v. Plate*, 40 Cal. 593; 6 Amer. Rep. 639.

(b) *Hostetter v. Fowinkle*, 1 Dill. 329; *Faber v. Hovey*, Dig. 481.

(c) *Graham v. Plate*, 40 Cal. 593; *Peltz v. Fischele*, 62 Mo. 171.

(d) L. R. 1 Eq. 299.

(e) *Vulcan Match Co. v. Jebson & Co.*,

1 Kyshe, 650. See *Addington v. Cullinane*, 28 Mo. App. 238.

(f) *Manockji Petit Manufacturing Co. v. Mahalaxmi Spinning & Weaving Co., Ltd.*, Ind. L. R. 10 Bomb. 617.

(g) 20 Fed. Rep. 217.

(h) 12 P. R. 360.

Where a defendant offers submission in terms which are re- Offer of  
jected by the plaintiff, the latter will be allowed an inquiry as submission.  
to damages at his own risk (*a*), but if the plaintiff does not  
recover more than the defendant offered, the plaintiff will have  
to pay the costs (*b*).

### Costs.

#### (i.) *In Actions.*

The same general principles on which costs are given in other General rule  
cases prevail in those in which a question of trade mark is at as to costs—  
issue. Thus, the primary rule is that costs follow the event. follow event.  
that is to say, that where a plaintiff succeeds, he will get his  
costs (*c*); where he is unsuccessful, he will have to pay costs (*d*).  
The fact that merely nominal damages have been awarded will  
not deprive a successful plaintiff of his right to his costs, since  
a question of his right has been involved (*e*). And where a plain-  
tiff had registered a label containing common words, without a  
disclaimer, it was held that this was not such a wrongful act as  
to disentitle him to costs as against the defendants, who had used  
an identically similar label (*f*). So when a plaintiff succeeded  
substantially on his whole claim, but failed in one item which  
involved no additional expense, he was allowed the full costs of  
the action (*g*).

Costs, however, being in the discretion of the Court, the Court Relief some-  
will, under some circumstances, grant the injunction, but without times granted  
costs, as where the plaintiff has persisted in litigation which had without costs.  
become unnecessary (*h*), or where the successful plaintiff has been

(*a*) *Tonge v. Ward*, 21 L. T. N. S. 480.  
See *Dicks v. Jackson*, Chitty, J., March  
31st, 1884; *Thomson & Co. v. Daily*, Ct.  
Sess. Cas. 4th Ser. XXIV. 1173.

(*b*) E.g., *Fettes v. Williams*, 25 P. R.  
511.

(*c*) *Chappell v. Davidson*, 2 K. & J.  
123; *Farina v. Silverlock*, 1 K. & J. 509;  
6 De G. M. & G. 214; 4 K. & J. 650;  
*Collins Co. v. Walker*, 7 W. R. 222;  
*Edelsten v. Edelsten*, 1 De G. J. & S.  
185; *McAndrew v. Bassett*, 4 *ib.* 380.

(*d*) *Woolham v. Ratcliff*, 1 H. & M. 259;  
*Williams v. Osborne*, 13 L. T. N. S. 493;  
*Morgan v. McAdam*, 36 L. J. Ch. 228;

*Bass v. Dawber*, 19 L. T. N. S. 626;  
*Lucke v. Webster*, Jessel, M. R., April  
4th, 1879; *Watt v. O'Hanlon*, 4 P. R. 1.

(*e*) *Marison v. Salmon*, 2 Scott, N. R.  
449; 2 Man. & G. 385. But in a similar  
case the Canadian Court gave no costs:  
*Bondier v. Deputie*, 3 Dorion, 233.

(*f*) Per Kekewich, J., in *Newman v.*  
*Pinto*, 4 P. R. 508.

(*g*) *Kodak, Ltd. v. London Stereoscopic*  
*and Photographic Co., Ltd.*, 20 P. R. 337.

(*h*) *Mullington v. Fox*, 3 My. & Cr.  
338; *Moet v. Conston*, 33 Beav. 578;  
*Hudson v. Bennett*, 12 Jur. N. S. 519.

guilty of delay (*a*), or brings unfounded charges of fraud (*b*), or has made false statements to the public in relation to his trade mark (*c*). So, again, where forwarding agents, who had been made the medium for importing spuriously-marked cigars, had not participated in the fraud, had offered to give what information they could, and had submitted to act as the Court should direct (*d*).

Relief granted, plaintiff to pay costs.

Under some circumstances the plaintiff may obtain his injunction and yet have to pay the costs of some defendants, as where a dock company was innocently in possession of spuriously-marked goods (*e*). And again, where wine bearing a spurious brand was in the possession of wharfingers, it was held by the Court of Appeal that they were entitled to their costs of being made defendants to an action for infringement, notwithstanding that they had submitted to act as the Court should direct only upon having their charges and costs paid or provided for (*f*).

Relief refused, no costs.

On the other hand, while the relief claimed by the plaintiff is refused, the defendant may still be left to pay his own costs, as where the plaintiff has lost his remedy by lapse of time (*g*), or improper use of the word "patentee" (*h*), or other similar reasons (*i*), the defendant's fraudulent intention being evident; or, more commonly, where the defendant's conduct, though not so clearly fraudulent as to entitle the plaintiff to an injunction, has yet been so suspicious and uncandid as to call for some punishment (*k*). Thus, where the Vice-Chancellor considered

(*a*) *Millington v. Fox*, 3 My. & Cr. 338; *Beard v. Turner*, 13 L. T. N. S. 746; *Perks v. Hall & Co.*, W. N. 1881, p. 111; *Amoskeag Manufacturing Co. v. Garner* (2), 51 How. Pr. 298.

(*b*) *Montgomerie & Co. v. Young Bros.*, 20 P. R. 781.

(*c*) *Ingram v. India Rubber, Gutta Percha and Telegraph Co., Ltd.*, 29 V. L. R. 172.

(*d*) *Upmann v. Elkan*, L. R. 7 Ch. 130. See *Moet v. Pickering*, 8 Ch. D. 372.

(*e*) *Upmann v. Elkan*, L. R. 7 Ch. 130.

(*f*) *Moet v. Pickering*, 8 Ch. D. 372.

(*g*) *Rodgers v. Rodgers*, 31 L. T. N. S. 285; *Ripley v. Bandy*, 14 P. R. 591.

(*h*) *Nixey v. Roffey*, W. N. 1870, p. 227. And where a plaintiff company was held to be disentitled to an injunction by reason of the wrongful use of the word "patent," and the defendant, as having

been the company's manager, was in some sense responsible for this, he was deprived of the costs which would otherwise have been given him: *Leather Cloth Co. v. Lonsont*, L. R. 9 Eq. 345.

(*i*) E.g., *Fetridge v. Wells*, 13 How. Pr. 385; *R. Cox*, 180.

(*k*) *Edgington v. Edgington*, 11 L. T. N. S. 299; *Bass v. Dawber*, 19 *ib.* 626; *Ainsworth v. Walmsley*, L. R. 1 Eq. 518; *Wigham v. Clarke*, W. N. 1876, p. 68; *Robineau v. Charbonnel*, *ib.* p. 160; *Borthwick v. Evening Post, Ltd.*, 37 Ch. D. 449; *Thorneloe v. Hill*, (1894) 1 Ch. 569; *Lambert & Butler v. Goodbody*, 19 P. R. 377. And see *Newman v. Pinto*, 4 P. R. 508, and *Lerer v. Bedingfield*, 16 P. R. 3, where defendants who succeeded in the Appeal Court were left to pay their own costs of the action though allowed the costs of the appeal. See *Humphries v. Taylor Drug Co.* (2), 59 L. T. N. S. 820;

that the defendant had acted fraudulently, but thought himself bound by a decision of the Court of Appeal on the motion to dismiss the bill, he did so without costs (*a*). Where the defendant had filled with his own lime-juice bottles brought to him for the purpose, though they were stamped with the plaintiff's name, and the plaintiff brought an action, making charges which amounted to fraud, but which the Court did not consider to be justified, though the defendant had done that which he was not entitled to do, and the defendant gave an undertaking not to repeat the offence, no order was made, and each party was left to pay his own costs (*b*). The costs of interlocutory proceedings are usually made costs in the cause (*c*), but where an application to the Court is contested and fought out, it is usual for this to be done only with respect to the costs of the successful party, leaving the unsuccessful party to bear his own in any event.

In some cases a portion only of the relief asked for has been granted, and the costs have either been apportioned in a manner corresponding to the amount of success achieved, or each party has been left to pay his own costs. Thus, where a plaintiff company succeeded on the question of imitation of labels and wrappers, but failed as to trade mark, the plaintiffs were given their costs up to the motion for injunction, each party having to bear his own after that (*d*). In *Day v. Neale* (*e*) no costs were given on either side, the plaintiffs having asked for an injunction in respect of several trade marks, in only two of which they had an exclusive right, and having delayed to take proceedings for more than two years, while the defendants were in the wrong as to the two marks. In *Metzler v. Wood* (*f*), the plaintiffs, who succeeded

Apportionment of costs.

also *Talbot v. Moore*, 13 N. Y. Sup. Ct. 106; *Beggs v. Whitman*, 5 V. L. R. Eq. 304; *Hop Bitters Manufacturing Co. v. Lake*, 10 V. L. R. (E.) 231. Compare *King & Co., Ltd. v. Gillard & Co., Ltd.*, 21 P. B. 589; 22 P. R. 327, where the Court of Appeal held that a misrepresentation by the successful defendant as to medals and awards was not a ground for depriving him of his costs.

*a*) *Wotherspoon v. Currie*. See L. R. 5 H. L. 519.

*b*) *Rose v. Loftus*, 47 L. J. Ch. 576. And see *Perks v. Hall & Co.*, W. N. 1881, p. 111. So in N. S. W., where the successful party had nutruely marked

his goods as if the mark were registered: *Harris v. Ogg*, 5 N. S. W. Rep. (E.) 114. As to costs where fraud is charged but not made out, see *Baker v. Rawson*, 45 Ch. D. 519, 536; and *Hugreave v. Freeman*, (1891) 3 Ch. 39.

*c*) For example, see *Isaacs v. Thompson*, 41 L. J. Ch. 101; *Brook v. Evans*, 2 L. T. N. S. 740; *Wallis v. Wallis*, 4 Dr. 458.

*d*) *Compagnie Lafarge v. Hendricks*, Dig. 512. And see *Jackson & Co. v. Napper*, 35 Ch. D. 162; and *Baker v. Rawson*, 45 *ib.* 519, 536.

*e*) Bacon, V.-C., May 21th, 1881.

*f*) 8 Ch. D. 606.

on the main question of imitation of the title of their publication, were deprived of half their costs, on the ground of their having made claims as to copyright which failed. Where a plaintiff succeeded in establishing a limited right in a word, and also that the defendant had acted fraudulently, but failed to show a general right in the word, and that certain labels used by the defendant were deceptive, the defendant was ordered by the Irish Court to pay the general costs of the suit, but the plaintiff was ordered to pay and set off against his own costs the costs of all the affidavits of the defendant's witnesses (except that of the defendant himself), since they had been addressed to the part of the case on which the plaintiff failed (*a*). On the other hand, where an action was brought for infringement of trade mark and for passing off, and fraud was proved on the part of the defendant, but infringement of trade mark was not proved, the defendant was ordered to pay the whole of the costs (*b*); but in another similar case the plaintiff was allowed his costs of the action except so far as they had been increased by the claim in respect of the trade mark (*c*). In a Bombay case (*d*), in which six marks were in question, and the defendants succeeded as to all but one, which they had offered to give up within six days after the commencement of the suit, it was held that the defendants must only pay their own costs with regard to that mark, and one-sixth of the plaintiff's costs up to and including the day on which the offer was made, and that all the remaining costs of both parties must be paid by the plaintiffs. Where a defendant had untruefully alleged that he was the first to use a word in dispute, and that the plaintiff had copied from him, no costs were given, though the action was dismissed (*e*).

Sometimes the costs of one issue are given to the plaintiff, and those of another to the defendant, with a set off, or occasionally a rule of thumb mode of division between the parties is adopted. Thus, in a case where the plaintiff succeeded on one issue and failed on another, and the defendant had acted fraudulently, the Court

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

(*b*) *Rowland v. Mitchell*, 13 P. R. 457; *Hodgson v. Kynoch, Ltd.*, 15 *ib.* 465.

(*c*) *Lever v. Beddingfield*, 15 P. R. 453. This case was, however, reversed on the facts, and judgment was entered for

the defendants without costs, 16 P. R. 3.

(*d*) *Wallace & Co. v. King & Co.*, Bombay High Ct., April 30th, 1879.

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

ordered the defendant to pay one-third of the plaintiff's costs and made no order as to the defendant's costs (*a*). So where an action for infringement of trade mark and a motion for rectification were heard together, and neither party was wholly successful, the costs were lumped together and the plaintiff was ordered to pay two-fifths of the total costs (*b*). Where a case was overloaded with useless evidence, the successful plaintiff was allowed the general costs of the action less half the cost of the evidence (*c*).

If a plaintiff makes a charge which he is unable to substantiate, he may obtain an injunction with costs, and yet have to pay all costs occasioned by the making of that charge (*d*). In the same way, if a plaintiff insists upon having an account taken, after the defendant has given full information, the plaintiff will have to pay the costs of that account if it turn out to have been unnecessary (*e*). So if he unsuccessfully persists in his claim for damages after the defendant has submitted to an injunction, he must pay the costs of such claim (*f*).

There is a wide distinction between cases in which the costs of issues are given separately and cases in which the costs of the action are given to one party except so far as they have been increased by special issues, as in the first class the general costs are apportioned (*g*), while in the second class they are given to the successful party, and it is of much importance to see that the order is drawn up so as to give effect to the intentions of the Court (*h*).

Costs of unfounded charges, &c.

Where increased costs only set off.

(*a*) *Fondlater, Mackie, Todd & Co. v. Newman*, 19 P. R. 235.

(*b*) *Bourne v. Swan & Edgar*, (1903) 1 Ch. 211.

(*c*) *Daimler Motor Co.* (1904), *Id. v. London Daimler Co., Id.*, 24 P. R. 379.

(*d*) *Pierce v. Franks*, 15 L. J. Ch. 122; *Standish v. Whitwell*, 14 W. R. 512; *Wylam v. Clarke*, W. N. 1876, p. 68; *Saichner v. Apollinaris Co.*, (1897) 1 Ch. 893; *Pneumatic Rubber Stamp Co. v. Limber*, 15 P. R. 525; *Society of Accountants and Auditors v. Goodway*, 24 P. R. 159. And see *Apollinaris Co. v. Duckworth*, 23 P. R. 540, where a successful defendant was made to pay the costs of an unfounded charge of fraud against the plaintiffs. See also *ante*, p. 257, note (*b*).

*v. Nunn v. D'Albuquerque*, 34 Beav. 595.

(*f*) *Magnolia Metal Co. v. Atlas Metal Co.*, 14 P. R. 389; *Hipkins v. Plant*, 15 *ib.* 294.

(*g*) *Jenkins v. Jackson*, (1891) 1 Ch. 89.

(*h*) Thus in *Harman, Id. v. Tiffin*, 26 P. R. 173, the Court of Appeal had expressed its intention of giving the plaintiffs, who succeeded on appeal, the costs of the action except so far as they had been increased by a claim for infringement of trade mark, and the order having been drawn up in a form corresponding to that in *Jenkins v. Jackson*, (1891) 1 Ch. 89, it became necessary to obtain an order from the C. A. correcting the slip which had been made: 27 P. R. 602. See also the award of costs in *Hepton Wood Stone Firms, Id. v. Gething*, 27 P. R. 605.



Scale of costs when defendant submits.

When a defendant in a trade mark action submits to a perpetual injunction with costs, the mere fact of his having submitted constitutes no special ground, under R. S. C., 1883, Order LXV. r. 9, for directing the costs to be taxed on the higher scale, but in such a case the Court will refuse to punish him for submitting at once, and will leave the costs to be taxed on the lower scale (*a*). But there may be cases in which costs will be given on the higher scale *e.g.*, where the action has been fought out at great length (*b*).

Costs of motion to commit.

A motion to commit for breach of an injunction is not unfrequently made without any expectation of obtaining an order for actual committal, but the defendant can only be ordered to pay the costs of such a motion if the facts would have warranted a committal (*c*). But where an order for committal was rescinded by the Court of Appeal, no costs were given the defendant, on account of the equivocal conduct of some of his agents (*c*). Where a motion to commit was dismissed on the ground of delay, as well as that the actual terms of the injunction had not been disobeyed, though its spirit had been. Wood, V.-C., while refusing the motion, enlarged the injunction and made the defendant pay the costs (*d*). Where there was a difference of opinion between the members of the Court of Appeal whether upon the evidence a breach had been committed, no order was made as to the costs of the appeal (*e*). In a case in which the Supreme Court of New York had fined a defendant for contempt, the Court of Appeals, while considering itself bound by the decision of the Supreme Court as to the fact of the breach, yet thought the decision so doubtful that it gave no costs of the appeal (*f*).

Costs of appeals.

The costs of appeals are usually governed by the same principle as those in the Courts of First Instance, and follow the event. Thus, in *McLean v. Fleming* (*g*), in which the U. S. Circuit Court considered the plaintiff to be entitled to an injunction and an account, but the Supreme Court reversed the decision with re-

(*a*) *Hudson v. Osgerby*, 50 L. T. N. S. 323. But see *Grezier v. Ziemer*, 89 L. T. (Journal) 117.

(*b*) *Great Tower Street Tea Co. v. Smith*, 6 P. R. 165; *In re Crosfield*, 27 P. R. 133, where the costs of three counsel were also allowed. But see *In re Apollinaris Co.*, (1891) 2 Ch. 186.

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(*c*) *E.g.*, *Dence v. Brand*, W. N. 1881, p. 31.

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

(*e*) *Ripley v. John Arthur & Co.*, 19 P. R. 443.

(*f*) *Derlin v. Declin*, 69 N. Y. 212.

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

spect to the account, on the ground of the plaintiff's own laches, it was held that the plaintiff must have his costs in the Court below, but the defendant (appellant) his costs of the appeal. The costs of an unnecessary appeal must be paid by the appellant. Thus, where a respondent appeared at the hearing of an appeal, after having received notice from the appellant that no alteration would be asked in the order in the Court below with respect to his costs, which the appellant had been ordered to pay, that respondent was left to pay the costs of such appearance (a). And where, in an action for imitation of the name of the plaintiffs' journal, the plaintiffs brought on an appeal from the decision of the judge directing the motion for an injunction to stand to the hearing, after the defendants had changed the name of their publication, the plaintiffs were ordered to pay the costs of the appeal, notwithstanding that the defendants had refused to submit to an injunction, or to give an undertaking as to their original title (b). In *Newman v. Pinto* (c) the plaintiff, who had succeeded in the Court of First Instance, was held by the Court of Appeal to be disentitled to relief on the ground of misrepresentations contained in his trade mark; but the defendants, who had used the same trade mark, containing the same misrepresentations, were not allowed the general costs of the action, but only the costs of the appeal. Where the Court of Appeal makes an order for repayment to the appellant of the costs paid by him in the Court below, interest on the costs between the date of payment and the date of the order of the Court of Appeal is not chargeable (d). As a general rule the costs of the shorthand notes of the evidence in the Court below will not be included in the costs of the appeal, but they may be allowed under special circumstances (e).

One of the main objects which the Court has in view in the exercise of its jurisdiction is "to repress unnecessary litigation, and to keep litigation within those bounds which are essential to enable the parties to vindicate and establish their rights" (f). Costs in case of compromise.

(a) *Upmann v. Elkan*, L. R. 7 Ch. 130.

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

(c) 1 P. R. 508. Cf. *Lever v. Beddingfield*, 16 P. R. 3.

(d) *Edge & Sons v. Gallon*, 16 P. R. 509.

(e) See *Edge & Sons v. Gallon*, 16 P. R. 509.

(f) Per Lord Cottenham, C., in *Millington v. Fox*, 3 My. & Cr. 338. See the order made in *Pinto v. Badman*, 8 P. R. 181, 192.

Although, therefore, a plaintiff whose rights have been attacked is not bound to rely on the assurance of his assailant that the act will not be repeated, but is entitled to the protection of an injunction (*a*), yet if he, immediately after the suit is commenced, is offered and may obtain all he seeks, and still thinks proper to go on with the suit, the Court may give him his decree, but will not give him the costs of the suit so unnecessarily prosecuted (*b*). The defendant is, however, the aggressor, since the litigation has been first occasioned by his unwarrantable interference with the plaintiff's rights in respect of his trade mark, and this is equally the case whether the aggression was made with knowledge or in ignorance of those rights of the plaintiff. The defendant must therefore offer all the plaintiff has a right to obtain, and the offer must include all the costs which have been occasioned by his improper conduct (*c*). Thus, where in a patent case an injunction was granted, the defendants having previously promised to commit no further infringement and to pay the costs of preparing the bill, Knight Bruce, V.-C., gave the plaintiffs their costs at the hearing, since the defendants ought to have offered, on the injunction being obtained, to pay all costs up to that time (*d*). The same result followed where a defendant, who had offered to pay the taxed costs as between party and party, but refused to pay them as between solicitor and client, put in his answer, and then, the plaintiff offering to accept the costs as between party and party, declined to pay the costs of the answer (*e*).

But if an innocent infringer withdraws all marked articles from sale, and offers an undertaking immediately upon being served with

(*a*) *Geary v. Norton*, 1 De G. & S. 9; *Routh v. Webster*, 10 Beav. 561; *Tonge v. Ward*, 21 L. T. N. S. 480; *Coats v. Holbrook*, 2 Sandf. Ch. 586; *R. Cox*, 20; *Radway v. Coleman*, 15 Grant, Up. Can. Ch. 50; *Guardian Fire and Life Assurance Co. v. Guardian and General Insurance Co., Ltd.*, 50 L. J. Ch. 252.

(*b*) *Per Wigram, V.-C.*, in *Colburn v. Simms*, 2 Hare, 560, commenting on *Millington v. Fox*. And see *McAndrew v. Bassett*, 4 De G. J. & S. 380; *Hudson v. Bennett*, 12 Jur. N. S. 519; *Upmann v. Elkau*, L. R. 12 Eq. 140; 7 Ch. 130; *Williams v. Osborne*, 13 L. T. N. S. 498; *Slazenger v. Pigott*, 12 P. R. 439; *Grand Hotel Co. of Caledonia Springs, Ltd. v. Wilson*, 21 P. R. 117, 128; and see *Vernon v. Buchanan's Flour Mills, Ltd.*,

23 P. R. 17.

(*c*) *Fradella v. Weller*, 2 R. & M. 247; *Kelly v. Hooper*, 1 Y. & C. Ch. 197; *Geary v. Norton*, 1 De G. & S. 9; *Burgess v. Hills*, 26 Beav. 244; *Burgess v. Hately*, *ib.* 249; *Wallis v. Wallis*, 4 Dr. 458; *Collins Co. v. Walker*, 7 W. R. 222; *Moet v. Couston*, 33 Beav. 578; *Num v. D'Albuquerque*, 34 *ib.* 595; *Hipkins v. Plant*, 15 P. R. 294; *Maréchal v. McColgan*, 18 P. R. 262; *Hat Manufacturers Supply Co. v. Tomlin*, 23 P. R. 413; *Nitedals Taendstikfabrik v. R. Lehmann & Co., Ltd.*, 25 L. R. 793.

(*d*) *Geary v. Norton*, 1 De G. & S. 9. See *Lochgelly Co., Ltd. v. Lumphmanns Iron Co.*, Ct. Sess. Cas. 4th Ser. VI. 482.

(*e*) *Kelly v. Hooper*, 1 Y. & C. Ch. 197.

the writ, and the plaintiff afterwards moves for an injunction, the motion may be refused with all costs, less the costs of the writ, which will have been incurred before the defendant's offer (a). On the other hand, where the infringement is not innocent the plaintiff is not bound to be satisfied with an undertaking (b); but where the defendant consents to an order in the terms of the writ to be obtained in chambers, the plaintiff will not be entitled as a matter of course to any additional costs incurred by his bringing the matter into Court (c). If, however, the Court considers that the nature of the case was such as to justify the plaintiff in desiring that the order should be made public, the defendant will not obtain any reduction in the costs by offering to submit in chambers (d). In short, if the defendant wishes to escape further costs he must make a clean offer of the whole of the relief to which the plaintiff is entitled, and must not seek to impose terms as to non-advertisement or otherwise on which he is not entitled to insist (e). If, however, he offers the plaintiff all to which he is entitled, and the plaintiff nevertheless continues the litigation, the latter will have to pay the costs subsequent to the offer (f).

It has been suggested that a person whose trade mark has been infringed should give notice to the infringer of his intention to take proceedings, so as to give him an opportunity of explaining his conduct or submitting (g); and if he does so, and a fair offer is made, he should not hasten to incur needless expense (h), or he may be punished in respect of costs. Lord Romilly, M. R., was, however, of opinion (i) that, the defendant having been the

Notice to  
infringer.

(a) *Caruncho v. Highmoor*, 27 Sol. J. 199. And see *Clarke v. Hudson's Executors*, 18 P. R. 310; *Burgoyne & Co., Ltd. v. Godfree*, 22 P. R. 169.

(b) *Smith v. Carron Co.*, 13 P. R. 108; *Slazenger v. Pigott*, 12 *ib.* 439; *Jameson v. R. S. Johnston & Co., Ltd.*, 18 P. R. 259. See *Dover v. New Townend Cycle Co., Ltd.*, 21 P. R. 135.

(c) *Slazenger v. Pigott*, 12 P. R. 439.

(d) *Gandy Belt Co., Ltd. v. Fleming, Ltd.*, 18 P. R. 276; *Gallice v. Levy*, Eady, J., May 15, 1906; *Royal Warrant Holders' Association v. Kitson*, 26 P. R. 157. And the same has been held in Ireland: *Jameson v. R. S. Johnston & Co.*, 18 P. R. 259.

(e) See *Hipkins v. Plant*, 15 P. R.

294; *Henry Clay & Bock, Ltd. v. Phillips*, 27 P. R. 508.

(f) E.g., *Fettes v. Williams*, 25 P. R. 511.

(g) *Chappell v. Davidson*, 2 K. & J. 123; *Wallis v. Wallis*, 4 Dr. 458; *Twentsche Stoom Bleekery Goor v. Ellinger & Co.*, 26 W. R. 70.

(h) *Williams v. Osborne*, 13 L. T. N. S. 498. And see the opinion of Jessel, M. R., cited in *Upmann v. Forester*, 24 Ch. D. 231; and *In re Kuhn & Co.*, 53 L. J. Ch. 238.

(i) In *Burgess v. Hately*, 26 Beav. 249. In *Field v. Lewis*, Dig. 280, Wood, V.-C., granted an injunction with costs, though no notice had been given before bill filed. And see *Coats v. Holbrook*,

aggressor, the plaintiff would be justified in filing his bill without making any application to the defendant; and in *Upmann v. Elkan* (a) he indicated his adherence to the same view, saying that he did not mean to lay down that the person whose trade mark had been imitated might not file a bill without making any inquiry at all. In the later case of *Upmann v. Forester* (b), Chitty, J., decided in accordance with this opinion, giving costs to a plaintiff who had moved for an injunction without giving any previous notice, though the defendant had acted perfectly innocently, and would have submitted if notice had been given him. And he stated that this was also the opinion of Jessel, M. R. (c). But in *Upmann v. Currey* (d), a case very similar to *Upmann v. Forester* (e), the innocent defendant offered in Court to empty and deliver up or destroy the boxes in which the cigars had been sold to him, and which were labelled (but without his knowledge) in imitation of the plaintiff's boxes, and Smith, J., refused an injunction, and gave no costs on either side. So in *American Tobacco Co. v. Guest* (f), where an action was brought without any previous notice against a retail dealer who had innocently sold a small quantity of infringing goods, and the defendant submitted to an injunction, Stirling, J., made no order as to costs, and expressed his opinion that proceedings ought in the first instance to be taken against those who placed the spurious goods upon the market. In an Irish case (g) where the infringement was not innocent, but the defendants asked for particulars of the acts complained of, and offered to insert any reasonable notices in the newspapers to show that they had no connection with the plaintiffs' firm and to pay the costs, and the plaintiffs took no notice of the offer, it was held by the Master of the Rolls that the plaintiffs by declining to consider the defendants' suggestions, had lost their right to relief, the defendants having in the meantime inserted advertisements in the newspaper disclaiming all connection with the plaintiffs, and the action was dismissed without

2 Sandf. Ch. 586; R. Cox, 20; and *Sawyer v. Kellogg*, 7 Fed. Rep. 721; 9 *ib.* 601.

(a) L. R. 12 Eq. 140; L. R. 7 Ch. 130.

(b) 24 Ch. D. 231.

(c) See *per* Jessel, M. R., in *In re Kuhn & Co.*, 53 L. J. Ch. 238; and *Barrett v. Gomm*, 74 L. T. (Journal)

388. Also *Fennessy v. Day*, 55 L. T. N. S. 161. So *Siegert v. Lawrence*, 11 V. L. R. 47, in Victoria.

(d) 29 Sol. J. 735.

(e) 24 Ch. D. 231.

(f) (1892) 1 Ch. 630.

(g) *Valentine v. Valentine*, 31 L. R. Ir. 488.

costs. That there is, however, no right to require a preliminary letter seems to follow from the decision of the House of Lords in *Weingarten v. Bayer* (a), in which Lord Macnaghten pointed out that a person whose rights had been invaded might lose his opportunity of obtaining proper relief if he were required to write such a letter. In fact, the usual consequence of such a letter is that the offender does something which makes it more difficult for relief to be obtained, but without making the full amends to which the person injured is fairly entitled.

A plea of infancy will not excuse an infant infringer from paying the costs which his conduct has occasioned (b). And so with a married woman having separate estate (c). Infancy does not excuse from costs.

A person who has induced another person to manufacture for him goods marked with the trade mark of a third person is liable to repay to the person he has made the instrument of his fraud the costs of legal proceedings brought about by the infringement, including any sum which that person may have reasonably paid to compromise the matter (d). Costs occasioned to a third party by defendant's fraud.

### (ii.) *In Registration Cases.*

When an application for the registration of a trade mark is opposed and brought before the Court, the costs are usually ordered to be paid by the unsuccessful party, as having been occasioned by his wrongful claim or opposition. Thus, where a claim was made to register and use a trade mark, which would have been an infringement of an existing mark, the persons who wrongly claimed the mark were ordered to pay the costs of cross-adjourned summonses, as well as of an action for an injunction which had been rendered necessary by the claim (e). And in *In re Rosing* (f), the Cutlers' Co. of Sheffield, who had opposed an Costs in registration cases.

(a) 22 P. R. 341. See p. 350.

(b) *Cory v. Gerteken*, 2 Madd. 49; *Chubb v. Griffiths*, 35 Beav. 127; *Woolf v. Woolf*, 43 Sol. J. 127.

(c) *Nicholls v. Kimpton*, 3 Times L. R. 674.

(d) *Dixon v. Faucus*, 3 Ell. & Ell. 537.

(e) *Davis v. Tylor*, Jessel, M. R., April 24th, 1879. See *Jackson & Co. v. Napper*, 35 Ch. D. 162; *In re Grosmith*, 6 P. R. 180; *In re Burgoyne*, *ib.* 227, and many other cases.

(f) 54 L. J. Ch. 975.

application in what they believed to be the interest of the public (and whose opposition succeeded in the Court of Appeal), were ordered by V.-C. Bacon to pay the costs of their opposition, which failed before him.

No costs.

If, on the other hand, each party is partially successful, no costs will be given on either side (*a*). And where application was made for the registration of a label containing descriptive words, and the applicants disclaimed some of the descriptive words, but not all, and conducted their case on the footing that registration would give them an exclusive right to such words, the Court of Appeal held that though the registration must be granted, and would not have the effect of giving any such right, the litigation had nevertheless been caused by the applicants, and no costs could be given them (*b*). And in *In re Dunn* (*c*), in which the Court of Appeal reversed the refusal of the Court below to allow registration, they only gave costs of the appeal, and none of the hearing below. If an applicant for registration proposes to ask that the respondent may be ordered to pay the costs of the application, it is desirable (*d*), though not essential (*e*), that this should be mentioned in the notice of motion.

Costs paid by successful applicant.

Where an applicant took advantage of the precise wording of the Act of 1875 to obtain registration as a part of his trade mark of words to the exclusive use of which he was not entitled, and the application was unsuccessfully opposed, Jessel, M. R., held that, notwithstanding the success of the applicant, he must still pay the costs of the application, as he was taking advantage of the Act to do that which the Act did not intend him to do (*f*).

Costs of registrar.

Where the registrar is served with notice of an application to the Court, and he appears, his costs are in the discretion of the Court, though he cannot be ordered to pay costs (*g*). But it has been held that under the Act of 1905, as under the previous Acts, he is entitled to appear on the hearing of the application, and to receive his costs of so doing, since it is proper that he should

(*a*) *In re Jelley, Son & Jones*, 51 L. J. Ch. 639; *In re Rosing*, 54 L. J. Ch. 975; *Mouson & Co. v. Boehm*, 26 Ch. D. 398.

(*b*) *In re Hudson*, 32 Ch. D. 311. And see *In re Swift Specific Co.*, 6 P. R. 352.

(*c*) 41 Ch. D. 444.

(*d*) *In re North Shore Mill Co., Ltd.*, 22 P. R. 599.

(*e*) *In re Davis*, 14 P. R. 903.

(*f*) *In re Maignen*, 28 W. R. 759.

(*g*) T. M. Act, 1905, § 48.

know what order is made (a). But when the application raises purely a question *inter partes*, e.g., whether two marks do or do not conflict, it is usual for him not to appear, whether the application be for registration or for rectification, on receiving an assurance that no exceptional order will be asked for.

Where the registrar opposes an application, and his opposition fails, he cannot now be required to pay the costs of the successful applicant (b); and the rule has in fact been established that the comptroller will generally receive his costs, whether successful or unsuccessful (c), but where the case is a test case, each party may be left to pay his own costs (d). In the case of a successful appeal by a trade mark owner against a refusal to register, the appellant will still be left to pay the registrar's costs in the Court of First Instance, but it is not usual to make him pay also the costs of the appeal (d). If the comptroller refuses to register on the ground of similarity to an earlier mark, and upon an appeal by the applicant to the Court, the proprietor of the earlier mark appears and objects to the application, no costs may be given (e), or costs may be given against him if his objection is unsuccessful (f), while he obtains them if successful (g).

Costs of opposed applications in the Registry Office are now in the discretion of the registrar, or, on appeal to the Board of Trade, of the Board (h).

Since, by the terms of the old Rule 16 (i), an opposed application did not stand for the determination of the Court until the comptroller informed the applicant that the opponent had given security, no costs incurred before that point in the proceedings, but only those incurred after it, could formerly be given by the Court or be included in an order to pay costs (k); and it has been held that the Court could not give a successful

(a) This was repeatedly so laid down under the earlier Acts: e.g., *In re Orr-Ewing* (2), 28 W. R. 412.

(b) Notwithstanding *In re Rotherham*, 14 Ch. D. 585; *In re Patent Plumbago Crucible Co.*, Jessel, M. R., August 1st, 1879; *In re Jones Bros.*, Hall, V.-C., July 10th, 1880.

(c) *In re Van Duzer*, 34 Ch. D. 623; *In re Leaf, Sons & Co.*, 34 Ch. D. 632; *In re Farbenfabriken vormals Fried. Bayer & Co.*, (1894) 1 Ch. 645.

(d) See *Eastman Co., Ltd. v. Comp-*

*troller-General*, (1898) A. C. 571, 585; *In re California Fig Syrup Co.*, 26 P. R. 846, 864.

(e) *In re Holbrooks, Ltd.*, 26 P. R. 791.

(f) *In re Simpson*, L. J. N. of C. 1890, p. 143.

(g) *In re Royal Worcester Corset Co.*, 26 P. R. 175.

(h) T. M. Act, 1905, § 14 (10).

(i) Repeated in § 69 of the Patents Act, 1883, as amended, now repealed.

(k) *In re Brandreth*, 9 Ch. D. 618.



opponent the costs of the proceedings in the Registry Office, under either § 69 or § 90 of the Patents Act, 1883 (a). The same will no doubt be the rule under the Act of 1905, by which the registrar can, and does, give costs himself. In *In re Apollinaris Co.* (b), the Court of Appeal refused to give costs on the higher scale, though the case was one of unusual complexity and difficulty. But in *In re Crosfield* (c), Eady, J., considered that the case was one in which costs on the higher scale should be allowed, and, further, allowed the costs of three counsel, as was also done in *In re Burroughs, Wellcome & Co.* (d), a rectification case.

Costs of application to remove.

If a person registers as his property a trade mark to which he is not entitled, he will, as a rule, have to pay the costs of the necessary application to remove it from the register (e), though there may be exceptional cases in which this rule will not be followed: as if the mark was originally his property, but has become common through the common piracy of the trade, and they have delayed to apply for removal for some time after his registration, and have then done so without notice to him, he being a foreigner (f); or if the mark is removed from the register on the application of a person who has copied it, and who has only applied for rectification under stress of an action for infringement (g). Again, where a mark was removed from the register by the Court of Appeal on a ground which had not been raised in the Court below, and the applicant had acted in a fraudulent manner, no costs were given in either Court (h). So, also, a successful applicant has been deprived of costs on the ground of delay (i), and on the ground of the unsatisfactory state of the

(a) *In re Australian Wine Importers, Ltd.*, 41 Ch. D. 278.

(b) (1891) 2 Ch. 186, 236.

(c) 27 P. R. 433.

(d) 22 P. R. 164.

(e) *In re Hyde & Co.*, 7 Ch. D. 724; *In re Palmer* (3), 24 *ib.* 504; *In re Kuhn & Co.*, 53 L. J. Ch. 238; *Burland & Co. v. Broxburn Oil Co., Ltd.* (2), 42 Ch. D. 274; *In re Vignier*, 6 P. R. 496; *In re Edge*, 8 *ib.* 207; *In re Hare*, 24 P. R. 263. Where the registered proprietor had given up business, and the benefit of his trade mark was claimed by his mortgagees, and an order was made in the absence both of the registered proprietor and of the mortgagees for re-

moval of the mark and payment of costs by the mortgagees, the registered proprietor was afterwards added at the instance of the mortgagees as one of the parties to pay costs: *In re Davis*, 14 P. R. 903.

(f) *In re Kuhn & Co.*, 53 L. J. Ch. 238.

(g) *In re Perry Davis & Son*, 5 P. R. 333; *Humphries v. Taylor Drug Co.* (2), 59 L. T. N. S. 820. See *In re Gianacis*, 6 P. R. 467; and *Richards v. Butcher* (2), 8 *ib.* 37, 49.

(h) *Thompson v. Montgomery*, 41 Ch. D. 35. And see *In re Bradley*, 3 P. R. 205.

(i) *In re Talbot*, 11 P. R. 77; 63 L. J. Ch. 264.

evidence (a). Where an application to remove a trade mark from the register was refused in the Court of First Instance (though subsequently granted on appeal) on the ground that the party applying was not aggrieved at the time of the hearing, though he had been so at the time when the application was made, and until very shortly before the hearing, when a concession was made by the registered proprietor, Kekewich, J., while declining to remove the mark from the register, gave the applicant the costs up to the hearing (b). As a rule, a person who fails in an application to rectify will have to pay the costs of the application (c). It seems doubtful whether a respondent to an application to rectify, who is served with a notice of discontinuance, can treat such notice as entitling him to get his costs taxed, and therefore the notice should be accompanied by a statement that he shall have his costs (d).

Where a firm of shipowners had been restrained, as carriers, from parting with cases of mineral waters containing bottles alleged to bear infringements of the plaintiffs' labels, and an American resident claimed to be the owner of the goods, and applied for leave to re-ship them to Hamburg, it was held that he must give security for the costs of his application (e). And where an application for the registration of a trade mark was made by a foreign resident and opposed, it was held that he must give security for costs, and that, unless he did so within seven days, his application must be refused without further order (f). A foreign company will not be required to give security for the costs of proceedings in England with reference to the registration of trade marks, or of an appeal, if it has substantial assets in England available to answer the costs (g). Where a foreign company made a special application to the Board of Trade for registration of a trade mark under sect. 9 (5) of.

Security for costs.

(a) *In re European Blair Camera Co.*, 13 P. R. 603. And see *In re Thompson*, *ib.* 35.

(b) *In re Apollinaris Co.*, (1891) 2 Ch. 186, 199. See 63 L. T. N. S. 162, 168.

(c) *In re Atkins Filter and Engineering Co., Ltd.*, 3 P. R. 164, and many other cases, e.g., in *In re Burroughs, Wellcome & Co.*, 22 P. R. 164.

(d) *In re Dyson*, 65 L. T. N. S. 488.

(e) *Apollinaris Co. v. Wilson*, 31 Ch. D. 632.

(f) *In re Hurter*, W. N. 1887, p. 71.

But a registered proprietor residing abroad who desires to oppose a motion for rectification will not as a general rule be required to give security for costs: *In re La Société Anonyme des Ferreries de l'Etoile* (1), 10 P. R. 290; cf. *In re La Compagnie Générale d'Eaux Minérales, &c.*, (1891) 3 Ch. 451.

(g) *In re Apollinaris Co.*, (1891) 1 Ch. 1.

the Act of 1905, and the application was referred by the Board to the Court, with a direction to the applicants to serve a third party with notice, it was held, on application by the third party, that the applicants must give security for costs, notwithstanding a contention that if the case had been heard by the Board of Trade no security could have been ordered, and that the application having been referred to the Court contrary to the wish of the applicants, they were unwilling litigants (a).

(a) *In re Royal Worcester Corset Co.*, Warrington, J., Nov. 26th, 1908.

## CHAPTER VIII.

## PASSING OFF AND ANALOGOUS CASES.

A CONVENIENT, though not exhaustive, summary of the law on the subject of what has now come to be known as the law of "passing off," and which is expressly excepted by the Trade Marks Act, 1905 (a), from the operation of that statute, was given by Kay, L. J., in *Powell v. Birmingham Vinegar Brewery Co.* (b).

Passing off:  
per Kay, L. J.

"The law relating to this subject may be stated in a few propositions:—

- (1) It is unlawful for a trader to pass off his goods as the goods of another.
- (2) Even if this is done innocently it will be restrained: *Millington v. Fox* (c).
- (3) *A fortiori* if done designedly, for that is a fraud.
- (4) Although the first purchaser is not deceived, nevertheless if the article is so delivered to him as to be calculated to deceive a purchaser from him, that is illegal: *Sykes v. Sykes* (d).
- (5) One apparent exception is, that where a man has been describing his goods by his own name, another man having the same name cannot be prevented from using it, though this may have the effect of deceiving purchasers: *Burgess v. Burgess* (e); *Turton v. Turton* (f).
- (6) But this exception does not go far. A man may so use his own name as to infringe the rule of the law: 'It is a question of evidence in each case whether there is false representation or not:' per Turner, L. J., in *Burgess v. Burgess* (e). So he may be restrained if he associates another man with him so that under their joint names

(a) § 45.

(b) (1896) 2 Ch. 54, at p. 79.

(c) 3 My. & Cr. 338.

(d) 3 B. & C. 541.

(e) 3 De G. M. & G. 896.

(f) 42 Ch. D. 128.

he may pass off goods as the goods of another person: *Croft v. Day* (a); *Clayton v. Day* (b); *Melachrino v. Melachrino Egyptian Cigarette Co.* (c).

- (7) Another apparent exception is where a man has under a patent had a monopoly for fourteen years, and has given the article a descriptive name, he cannot, when the patent has expired, prevent another from selling it under that name: *Young v. Macrae* (d); *Linoleum Manufacturing Co. v. Nairn* (e).
- (8) I am not sure this would be so if the name so used were the name of the patentee, or even a purely fanciful name not descriptive.
- (9) Certainly where there has not been a patent, and an article has been made and sold under a fanciful name not descriptive, so that the article as made by one person has acquired reputation under that name, another trader will not be permitted to use the name for a similar article made by him: *Braham v. Bustard* (f); *Cochrane v. Macnish & Son* (g).
- (10) To this last proposition there is again a limitation. If the first maker has slept upon his rights, and allowed the name to be used by others until it has become *publici juris*, the Court will not interfere."

*Per Lord  
Herschell.*

It is important also to remember that, so long as the public know that the name employed indicates the manufacture of some particular manufacturer, it is immaterial whether they know who that manufacturer is or not. Thus, in the same case, Lord Herschell said in the House of Lords (h): "I think that the fallacy of the appellants' argument rests on this: that it is assumed that one trader cannot be passing off his goods as the manufacture of another unless it be shown that the persons purchasing the goods know of the manufacturer by name, and have in their mind when they purchase the goods that they are made by a particular individual. It seems to me that one man may quite well pass off his goods as the goods of another if he passes them off to people who will accept them as the manufacture of another,

(a) 7 Beav. 84.

(b) 26 Sol. J. 43.

(c) 4 P. R. 215.

(d) 9 Jur. N. S. 322.

(e) 7 Ch. D. 834.

(f) 1 H. & M. 447.

(g) (1896) A. C. 225.

(h) (1897) A. C. 710, 715.

though they do not know that other by name at all. In the present case it seems to me that 'Yorkshire Relish' meant the manufacture of a particular person. I do not mean that in the minds of the public the name of the manufacturer was identified, but that it meant a particular manufacture, and that when a person sold 'Yorkshire Relish,' as the defendants did, by selling it as 'Yorkshire Relish,' and calling it 'Yorkshire Relish,' they represented to the public that it was that manufacture which was known as and by the name of 'Yorkshire Relish.'"

As Smith, L. J., said in the same case (a): "What the purchasers in truth asked for was either the old 'Yorkshire Relish' made by the plaintiff which they had been accustomed to buy, or, if they did not know the plaintiff made it, then for 'Yorkshire Relish' made by the same maker, whosoever he might be."

Another valuable statement may be found in the judgment of Parker, J., in *Burberrys v. Cording* (b): "The principles of law applicable to a case of this sort are well known. On the one hand, apart from the law as to trade marks, no one can claim monopoly rights in the use of a word or name. On the other hand, no one is entitled by the use of any word or name, or indeed in any other way, to represent his goods as being the goods of another to that other's injury. If an injunction be granted restraining the use of a word or name, it is no doubt granted to protect property, but the property, to protect which it is granted is not property in the word or name, but property in the trade or goodwill which will be injured by its use. If the use of a word or name be restrained, it can only be on the ground that such use involves a misrepresentation, and that such misrepresentation has injured, or is calculated to injure another in his trade or business. If no case of deception by means of such misrepresentation can be proved, it is sufficient to prove the probability of such deception, and the Court will readily infer such probability if it be shown that the word or name has been adopted with any intention to deceive. In the absence of such intention, the degree of readiness with which the Court will infer the probability of deception must depend on the circumstances of each particular case, including the nature of the word

(a) (1896) 2 Ch. at p. 89. And see *per* Lindley, L. J., at p. 68.

(b) 26 P. R. 693, at p. 701.

or name, the use of which is sought to be restrained. It is important for this purpose to consider whether the word or name is *primâ facie* in the nature of a fancy word or name, or whether it is *primâ facie* descriptive of the article in respect of which it is used. It is also important for the same purpose to consider its history, the nature of its use by the person who seeks the injunction, and the extent to which it is or has been used by others. If the word or name is *primâ facie* descriptive or be in general use, the difficulty of establishing the probability of deception is greatly increased. Again, if the person who seeks the injunction has not used the word or name simply for the purpose of distinguishing his own goods from the goods of others; but primarily for the purpose of denoting or describing the particular kind of article to which he has applied it, and only secondarily, if at all, for the purpose of distinguishing his own goods, it will be more difficult for him to establish the probability of deception. But whatever be the nature or history of the word or name, in whatever way it has been used, either by the person seeking the injunction or by others, it is necessary, where there has been no actual deception, to establish at least a reasonable probability of deception. In such cases the action is, in effect, a *quia timet* action, and unless some reasonable probability is established, the proper course is, in my opinion, to refuse an injunction, leaving the plaintiff to his remedy if cases of actual deception afterwards occur."

Cases of true trade mark.

A trade mark is a technical matter, and for there to be an infringement of trade mark there must be a valid trade mark in existence—that is to say, there must not only be such a device in existence as is capable of forming a trade mark, but it must be actually attached to vendible articles in the market (*a*), or, if first used since the Trade Marks Act of 1875, must be properly registered under the Trade Marks Act, 1905, or, if an old mark, must be the subject of a certificate of refusal (*b*).

Cases not of true trade mark.

Where, however, there has been a representation that an article made by A. is made by B., by means of which one person has secured custom intended for another, so that both the purchaser

(*a*) *McAndrew v. Bassett*, 4 De G. J. & S. 380; *Maxwell v. Hogg*, L. R. 2 Ch. 307. See also *In re Leonard & Ellis*, 26 Ch. D. 288.

(*b*) See the Trade Marks Act, 1905, § 42. Also *Edward v. Dennis*; 30 Ch. D. 454; *In re Batt & Co.*, (1898) 2 Ch. 432; (1899) A. C. 428.

and the genuine trader have been defrauded, there the injury is the same, and the Court will interfere and protect the right of both parties to trade freely without fraudulent deceptions, although the fraud has taken another form than that of imitating a trade mark.

As stated by Kay, L. J. (a), and also by Turner, L. J., in *Burgess v. Burgess* (b), "no man can have any right to represent his goods as the goods of another person." "The most obvious way," said Lord Halsbury, C. (c), "in which a man would be infringing the rule laid down by Turner, L. J., is if he were to say in terms, 'these are the goods manufactured by' a rival tradesman; and it seems to be assumed that unless he says something equivalent to that, no action will lie. It appears to me that that is an entire delusion. By the course of trade, by the existence and technology of trade, and by the mode in which things are sold, a man may utter that same proposition, but in different words and without using the name of the rival tradesman at all. A familiar example, of course, is when, without using any name, by the identity of the form of the bottle, or the form of the label, or the nature of the thing sold in the package, he is making the statement, not in the express words, but in one of those different forms in which the statement can be made by something that he knows will be so understood by the public" (d).

Methods of passing off.

An important class of cases of this description consists of cases in which there has been a wrongful assumption by one person or firm of the trade or firm name under which a reputation has been gained by another person or firm, and which has, therefore, become a very important part of the goodwill of the business of such person or firm (e), although when used as a name, and not as a mark on vendible goods, it is not used as a trade mark. The imitation of such a name falsely represents not merely a certain class of goods, but the entire business, to be that of one not the true proprietor.

Trade name.

(a) See *ante*, p. 271.

(b) 3 De G. M. & G. 896.

(c) *Birmingham Vinegar Brewery Co. v. Powell*, (1897) A. C. 710. And see *Reddaway v. Banham*, (1896) A. C. 199, 204.

(d) And see *Coats v. Merrick Thread Co.*, 149 U. S. 562; *Saxlehner v. Apolli-*

*naris Co.*, (1897) 1 Ch. 893, where this principle was applied to a case in which the reputation acquired for the plaintiff's goods was due to the exertions of the defendant.

(e) *Per Wood, V.-C.*, in *Churton v. Douglas, Johns*, 174. And see *Pomeroy, Ltd. v. Scale*, 24 P. R. 177.



No exclusive right in name apart from business.

“In this country,” said Lord Chelmsford (*a*), “we do not recognise the absolute right of a person to a particular name, to the extent of entitling him to prevent the assumption of that name by a stranger. The right to the exclusive use of a name in connection with a trade or business is familiar to our law; and any person using that name, after a relative right of this description has been acquired by another, is considered to have been guilty of a fraud, or at least of an invasion of another’s right, and renders himself liable to an action, or he may be restrained from the use of the name by injunction.” But a man who has never carried on business under a particular name cannot, even though he has some kind of right to use that name, interfere with its being used by another. Thus, where the plaintiff was the mortgagee of the goodwill of a business, including the right to use the name under which the business was carried on, but had never exercised his right so to do (*b*).

Name by which goods identified.

There is another kind of trade name besides the trade name which is synonymous with firm name—viz., the trade name which is applied, not to the firm by whom the goods are manufactured and sold, but to the goods themselves; and it was with immediate reference to a trade name of this description (*c*), though the principles laid down by him are equally applicable to both classes of trade names, that Lord Blackburn (*d*), after referring to frauds committed by the infringement of trade marks, went on to say: “There is another way in which goods not the plaintiff’s may be sold as and for the plaintiff’s. A name may be so appropriated by user as to come to mean the goods of the plaintiff, though it is not, and never was, impressed on the goods or on the packages in which they are contained, so as to be a trade mark, properly so called, or within the recent statutes. Where it is established that such a trade name bears that meaning, I think the use of that

(*a*) *Du Boulay v. Du Boulay*, L. R. 2 P. C. 441. And see *Dockrell v. Dougall*, 80 L. T. N. S. 556; *Lore v. Latimer*, 32 Ont. R. 231.

(*b*) *Beazley v. Soares*, 22 Ch. D. 660. And see *Lore v. Latimer*, 32 Ont. R. 231.

(*c*) “Singer” sewing machines.

(*d*) In *Singer Manufacturing Co. v. Loog* (3), 8 App. Cas. 15. And see *Reddaway v. Banham*, (1896) A. C. 199; *Grezier v. Autran*, 13 P. R. 1; *Rockingham Rail. Co. v. Allen*, 12 Times L. R.

345; *Powell v. Birmingham Vinegar Brewery Co.*, (1896) 2 Ch. 54; (1897) A. C. 710; *Coventry Machinists’ Co. v. Helsby*, 13 Times L. R. 92; *ib.* 161; *Rickerby v. Reay*, 20 P. R. 380; *Rey v. Lecouturier*, 25 P. R. 265; 27 *ib.* 268; *R. Thorne & Sons, Ltd. v. Pimms, Ltd.*, 26 P. R. 221; *Neva Stearine Co. v. Mowling*, 9 V. L. R. (E.) 98; *Noera v. Williams’ Manufacturing Co.*, 158 Mass. 110; *Cady v. Schultz*, 19 R. I. 193; 61 Am. St. Rep. 763.

name, or one so nearly resembling it as to be likely to deceive, as applicable to goods not the plaintiff's, may be the means of passing off those goods as and for the plaintiff's, just as much as the use of a trade mark; and I think the law (so far as not altered by legislation) is the same. And I think it settled by a series of cases that both trade marks and trade names are in a certain sense property, and that the right to use them passes with the goodwill of the business to the successors of the firm which originally established them, even though the name of that firm be changed so that they are no longer strictly correct."

It cannot be said to be generally admitted that a right of property can be acquired in a trade name. The Vice-Chancellor of Ireland said (*a*), "it has been repeatedly held that there is no property in the name of a firm, or of an individual, or of a place of business; and that the only right of an individual or firm to the sole use of a trade name, as distinguished from a trade mark, is this, that when a name has become identified, by adoption and user, with a particular trade or manufacture or business, the person who has so used or adopted it can obtain the aid of this Court to restrain the use of it by others in such a way as to lead customers or the public to think that the trade or business of the person so using it is his trade or business." And he went on to say that in a registered trade mark there is a larger right. The distinction, however, does not appear to be of much practical importance, as it is now admitted on all hands that if a trade name is so imitated as to render deception probable, relief will be granted, and the test of infringement of a trade mark, in which the right of property is undoubted, is the production of such a probability of deception (*b*).

Property in trade name questioned.

The non-registration of trade names of the kind primarily referred to by Lord Blackburn is no bar to an action for the wrongful imitation of them (*c*); and where a trade mark consist-

Unregistered trade name protected.

(*a*) *Bodega Co., Ltd. v. Owens*, 6 P. R. 236. And see *Reddaway v. Banham*, (1896) A. C. 199, 209, 210, per Lord Herschell.

(*b*) Per Lord Westbury, in *Hall v. Barrows*, 4 De G. J. & S. 150. And see *Curtiss v. Messler*, 13 A. L. T. 127; *Crawford v. Bernard*, 11 P. R. 580; *Cady v. Schultz*, 19 R. I. 193; 61 Am. St. Rep. 763.

(*c*) *In re Sanitas Co., Ltd.*, 4 P. R.

533; *Reddaway v. Bentham Hemp Spinning Co.*, (1892) 2 Q. B. 639; *Eno v. Dunn*, 10 P. R. 261; *Huntley & Palmer v. Reading Biscuit Co.*, *ib.* 277; *Reddaway v. Banham*, (1896) A. C. 199; *Rockingham Rail. Co. v. Allen*, 12 Times L. R. 345; *Daniel v. Whitehouse*, (1898) 1 Ch. 685; *Bewlay & Co. v. Hughes*, 15 P. R. 290; *Worcester Royal Porcelain Co., Ltd. v. Locke & Co.*, 19 P. R. 479; *Muralo Co. v. Taylor*, 27 P. R. 261.

ing of the words "Stone Ale" alone had been expunged from the register as not being registrable, an injunction to restrain the use of those words was nevertheless granted (a), and the same thing happened with respect to the words "Yorkshire Relish" (b), and "Silver Pan" (c).

Form of  
injunction.

In cases in which unregistered trade names, and not registered trade marks, have been imitated, the usual form of injunction is to prohibit the use of the word "without clearly distinguishing" (d) the defendant's goods from the plaintiff's. But if the defendant cannot find an effective method of distinguishing, as may often be the case, he must not use the name at all (e).

Descriptive  
words become  
distinctive.

*Reddaway v.  
Banham.*

The case of *Reddaway v. Banham* (f), has established (g) that a name which in its primary sense is a correct description of the goods to which it is applied, may possibly acquire in the trade a technical signification identifying it with the goods of a particular manufacturer, so as to be entitled to protection upon the principles above stated. In that case the plaintiff had for many years manufactured a belting from yarn consisting mainly of camel's hair and sold it under the name of "Camel hair belting." The defendant, who was formerly in the employment

(a) *Thompson v. Montgomery*, 41 Ch. D. 35; (1891) A. C. 217; *Thompson v. Bent's Brewery Co.*, 8 P. R. 479; *In re Thompson*, 13 *ib.* 35. And see *Magnolia Metal Co. v. Atlas Metal Co.*, 14 *ib.* 389; and *In re Magnolia Metal Co.*, (1897) 2 Ch. 371; *Godillot v. American Grocery Co.*, 71 Fed. Rep. 873; and *Sparks v. Harper*, 3 Queens. L. J. 158, 201. See also *Bayer v. Baird*, 15 P. R. 615, where a disclaimer of the exclusive right to certain initials as part of a trade mark was held in Scotland to be no bar to an action to restrain a rival trader from using those initials in such a way as to pass off his goods as the goods of the plaintiff; and *Birmingham Small Arms Co., Ltd. v. Webb & Co.*, 24 P. R. 27, where certain initials, which being printed in the usual manner were under the Acts then in force incapable of registration, had come to denote the plaintiffs' goods, and an injunction was granted to restrain the use of the same initials in a different order. The initials in question are now registered under the wider provisions of the Act of 1905. See *In re Birmingham Small Arms Co., Ltd.*, 24 P. R. 563. In *Aerated Bread Co., Ltd. v. Aerated Bakeries (Manchester), Ltd.*,

Eady, J., Oct. 22, 1909, an injunction was granted to restrain the defendants from passing off by using the letters "A.B.C." and the injunction was made perpetual at the hearing (Neville, J., Nov. 20, 1909). In *Reynier v. Bide*, Neville, J., Nov. 20, 1909, the name protected was "Jössefors. Ld." for gloves.

(b) In *In re Powell*, (1893) 2 Ch. 388; *Powell v. Birmingham Vinegar Brewery Co.*, (1896) 2 Ch. 54; (1897) A. C. 710.

(c) *In re Faulder & Co., Ltd.*, 18 P. R. 37, 535; *Faulder & Co., Ltd. v. O. & G. Rushton, Ltd.*, 20 P. R. 477, 491.

(d) See *Thompson v. Montgomery*, (1891) A. C. 217; *Magnolia Metal Co. v. Atlas Metal Co.*, 14 P. R. 389; *Kinnell v. Ballantine*, 27 P. R. 185, and many other cases.

(e) *Powell v. Birmingham Vinegar Brewery Co.*, (1895) 2 Ch. 54; (1897) A. C. 710.

(f) (1896) A. C. 199.

(g) This is quite in accordance with the cases relating to geographical words, e.g., "Glenfield Starch" (*Wotherspoon v. Currie*, L. R. 5 H. L. 508); "Stone Ale" (*Thompson v. Montgomery*, (1891) A. C. 217).

of the plaintiff, afterwards manufactured a similar belting on his own account, and sold it under the same name, and the correspondence showed that he did this *malâ fide*. The jury found that the phrase "Camel hair belting" meant camel hair belting made by the plaintiff as distinguished from belting made by other manufacturers, and did not mean belting of a particular kind without reference to the maker, and that the defendant so described his belting as to be likely to mislead purchasers into buying his belting for the plaintiff's. Upon these findings, Collins, J., granted an injunction. This judgment was reversed by the Court of Appeal on the ground that a manufacturer could not be restrained from calling his goods by a name which correctly described them, but when the case came before the House of Lords the original judgment was restored. Lord Halsbury, C., after referring to the principle of law laid down by Turner, L.J., in *Burgess v. Burgess* (a), said: "How far the use of particular words, signs, or pictures, does or does not come up to the proposition which I have enunciated in each particular case must always be a question of evidence, and the more simple the phrasology, the more like it is to be a mere description of the article sold, the greater becomes the difficulty of proof (b); but if the proof establishes the fact the legal consequences appear to follow." Lord Herschell dealing with the same point said: "The name of a person or words forming part of the common stock of language, may become so far associated with the goods of a particular maker that it is capable of proof that the use of them by themselves without explanation or qualification by another manufacturer, would deceive a purchaser into the belief that he was getting the goods of A., when he was really getting the goods of B. In a case of this description the mere proof by the plaintiff that the defendant was using a name, word, or device which he had adopted to distinguish his goods would not entitle him to any relief. He could only obtain it by proving further that the defendant was using it under such circumstances or in such manner as to put off his goods as the goods of the plaintiff. If he could succeed in proving this, I think he would, on well established principles, be entitled to an injunction (c).

(a) 3 De G. M. & G. 896. See *ante*, p. 275.

(b) See *Cellular Clothing Co. v. Maxton & Murray*, (1899) A. C. 326; *Winser & Co.*,

*Ld. v. Armstrong*, 16 P. R. 167; *A. W. Gamage, Ld. v. H. E. Randall, Ld.*, *ib.* 185.

(c) Some recent examples of cases in which injunctions were granted on this

In my opinion, the doctrine on which the judgment of the Court of Appeal was based, that where a manufacturer has used as his trade mark a descriptive word, he is never entitled to relief against a person who so uses it as to induce in purchasers the belief that they are getting the goods of the manufacturer who has theretofore employed it as his trade mark, is not supported by authority, and cannot be defended on principle." Lord Herschell then dealt with the view taken by the Court of Appeal, that the defendants could not be liable to an action because in using the words "camel hair" in connection with their belting they were simply telling the truth. As to that he said: "I think the fallacy lies in overlooking the fact that a word may acquire in a trade a secondary signification differing from its primary one, and that if it is used to persons in the trade who will understand it, and be known and intended to understand it in its secondary sense, it will none the less be a falsehood that in its primary sense it may be true."

Difficulty of descriptive words becoming distinctive.

*Cellular Clothing Co.'s case.*

But the extreme difficulty of proving that a word which is merely descriptive or expressive of the quality of the goods has acquired a secondary meaning was emphasized in the subsequent case of *Cellular Clothing Co. v. Maxton and Murray (a)*, in which Lord Davey said: "There are two observations which must be made: one is that a man who takes upon himself to prove that words, which are merely descriptive or expressive of the

principle are the following: *Reddaway v. Ahlers*, 19 P. R. 12; *Reddaway v. Frictionless Engine Packing Co.*, 19 P. R. 505; *Reddaway v. Robert Sterenson & Bros., Ltd.*, 20 P. R. 276; *Smidt v. Reddaway*, 32 Calo. 401 ("Camel Hair" or "Karmal Hair" in connection with belting); *Faulder & Co. v. O. & G. Rushton, Ltd.*, 20 P. R. 477 ("Silver Pan" jam); *Boston Rubber Shoe Co. v. Boston Rubber Co. of Montreal*, 32 Can. Sup. Ct. 315, where the injunction was granted as to the name of the company, the ground of the injunction being that the plaintiffs' shoes had become known as "Bostons," which name had been fraudulently appropriated by the defendants. See and compare *H. E. Randall, Ltd. v. British and American Shoe Company*, (1902) 2 Ch. 354, and *H. E. Randall, Ltd. v. E. Bradley & Son*, 24 P. R. 657, 773.

(a) (1899) A. C. 326. Accordingly injunctions were refused in respect of the following words: "Flaked oat-

meal" (*Parsons v. Gillespie*, (1898) A. C. 239); "Oval Blue" (*Ripley v. Griffiths*, 19 P. R. 590); "Naphtha" soap (*Fels v. Hedley & Co.*, 20 P. R. 437; 21 P. R. 91; *Fels v. Stephenson Bros.*, 20 P. R. 443; 21 P. R. 89; *Fels v. Christopher Thomas & Bros., Ltd.*, 20 P. R. 447; 21 P. R. 85); "Erect Form" corsets (in common type) (*Weingarten v. Bayer*, 20 P. R. 649; 22 P. R. 341; *Weingarten v. Rosenthal*, 21 P. R. 212); "Slip-on" garments (*Burberrys v. Cording*, 26 P. R. 693. And see *Aerators, Ltd. v. Tollitt*, (1902) 2 Ch. 319; *S. Chivers & Sons v. S. Chivers & Co., Ltd.*, 17 P. R. 420; *Warwick Trading Co. v. Urban*, 21 P. R. 240; *Hommel v. Gebrüder Bauer*, 22 P. R. 43; *Plotzker v. Lucas*, 24 P. R. 551; *British Vacuum Cleaner Co. v. New Vacuum Cleaner Co.*, 24 P. R. 641; *Electromobile Co., Ltd. v. British Electromobile Co., Ltd.*, 25 P. R. 149; *Wilson v. Lyman*, 25 Ont. App. R. 303; *Gillett v. Lumsden*, 8 Ont. L. R. 168; *Standard Co. v. Standard Co.*, P. C., Nov. 3rd, 1910.

quality of the goods, have acquired the secondary sense to which I have referred, assumes a much greater burden—and, indeed, a burden which it is not impossible, but at the same time extremely difficult, to discharge—a much greater burden than that of a man who undertakes to prove the same thing of a word not significant and not descriptive, but what has been compendiously called a ‘fancy’ word.

The other observation which occurs to me is this: that where a man produces or invents, if you please, a new article and attaches a descriptive name to it—a name which, as the article has not been produced before, has, of course, not been used in connection with the article—and secures for himself either the legal monopoly or a monopoly in fact of the sale of that article for a certain time, the evidence of persons who come forward and say that the name in question suggests to their minds and is associated by them with the plaintiff’s goods alone is of a very slender character, for the simple reason that the plaintiff was the only maker of the goods during the time that his monopoly lasted, and therefore there was nothing to compare with it, and anybody who wanted the goods had no shop to go to, or no merchant or manufacturer to resort to, except the plaintiff. And on this point I adopt what was said in felicitous language by Fry, L. J., in *Siebert v. Hindlater* (a). That is, my Lords, a matter of express decision in the case of a patent. If a man invents a new article and protects it by a patent, then during the term of the patent he has, of course, a legal monopoly; but when the patent expires all the world may make the article, and if they may make the article they may say that they are making the article, and for that purpose use the name which the patentee has attached to it during the time when he had the legal monopoly of the manufacture. But the same thing in principle must apply where a man has not taken out a patent, as in the present case, but has a virtual monopoly because other manufacturers, although they are entitled to do so, have not in fact commenced to make the article. He brings the article before the world, he gives it a name descriptive of the article; all the world may make the article, and all the world may tell the public what article it is they make, and for that purpose they may *primâ facie* use the name by which the article is known on the market.”

(a) 7 Ch. D. 801, at p. 813.