THE LAW

RELATING TO

TRADE MARKS

BY

R. S. MUSHET,
OF LINCOLN'S INN BARRISTER-AT-LAW.

LONDON:
SMITH, ELDER, & CO., 15 WATERLOO PLACE.
1885.
[All rights reserved.]
PREFACE.

In this little book an attempt is made to collect in as small a compass as possible, the principles of the law of this country relating to Trade Marks.

Since a large proportion of those principles are now embodied in comparatively recent statutory enactments, it was thought that the object of the book would be more conveniently and satisfactorily attained by appending explanatory notes to each section of the Acts of Parliament relating to the subject than by adopting the form of a treatise.

The rules relating to trade marks issued by the Board of Trade in pursuance of the Patents, Designs, and Trade Marks Act, 1883, have been added at the end of the volume, as well as the Instructions compiled by the authorities at the Patent Office for the guidance of those who desire to register trade marks.

Reference is made in the Addenda to the short notes, contained in the legal newspapers, of some few cases which have been decided whilst the book was passing through the press but which have not yet been reported at length.

R. S. M.

8 Stone Buildings, Lincoln's Inn,
July 1885.
## CONTENTS

**I.—**The Merchandise Marks Act, 1862, 25 and 26 Vict., c. 88.

<table>
<thead>
<tr>
<th>Sec.</th>
<th>Description of words</th>
<th>Page</th>
</tr>
</thead>
<tbody>
<tr>
<td>1.</td>
<td>Forging a trade mark or falsely applying any trade mark with intent to defraud, a misdemeanor</td>
<td>10</td>
</tr>
<tr>
<td>2.</td>
<td>Applying a forged trade mark to any vessel, case, wrapper, &amp;c., in or with which any article is sold or intended to be sold, a misdemeanor</td>
<td>12</td>
</tr>
<tr>
<td>3.</td>
<td>Penalty for selling articles with false trade marks</td>
<td>14</td>
</tr>
<tr>
<td>4.</td>
<td>Additions to and alterations of trade marks with intent to defraud to be deemed forgery</td>
<td>16</td>
</tr>
<tr>
<td>5.</td>
<td>Person selling an article with false trade mark to give information where he procured it</td>
<td>17</td>
</tr>
<tr>
<td>6.</td>
<td>Penalty for marking false indication of quantity, &amp;c., upon an article with intent to defraud</td>
<td>19</td>
</tr>
<tr>
<td>7.</td>
<td>Penalty for selling articles with false indication of quantities, &amp;c., upon them</td>
<td>23</td>
</tr>
<tr>
<td>8.</td>
<td>Provision that it is not an offence to apply to particular goods names known to be used for indicating such goods</td>
<td>25</td>
</tr>
<tr>
<td>9.</td>
<td>Description of forged trade marks in indictments, &amp;c.</td>
<td>26</td>
</tr>
<tr>
<td>10.</td>
<td>Conviction not to affect any right or civil remedy</td>
<td>26</td>
</tr>
<tr>
<td>11.</td>
<td>Intent to defraud a particular person need not be alleged or proved</td>
<td>28</td>
</tr>
<tr>
<td>12.</td>
<td>Persons who aid in commission of misdemeanors to be also guilty</td>
<td>29</td>
</tr>
<tr>
<td>13.</td>
<td>Punishment for misdemeanors under the Act</td>
<td>29</td>
</tr>
<tr>
<td>14.</td>
<td>Recovery of penalties</td>
<td>30</td>
</tr>
<tr>
<td>15.</td>
<td>Summary proceedings before justices</td>
<td>32</td>
</tr>
<tr>
<td>16.</td>
<td>Plaintiffs to recover full costs in actions</td>
<td>32</td>
</tr>
<tr>
<td>17.</td>
<td>Limitations of actions</td>
<td>33</td>
</tr>
<tr>
<td>18.</td>
<td>Vendor of an article with a trade mark to be deemed to contract that mark is genuine</td>
<td>34</td>
</tr>
<tr>
<td>19.</td>
<td>Vendor of an article with description upon it of its quantity, &amp;c., to be deemed to contract that the description is true</td>
<td>36</td>
</tr>
<tr>
<td>20.</td>
<td>In suits court may order article to be destroyed, and may award injunction</td>
<td>37</td>
</tr>
<tr>
<td>21.</td>
<td>Persons aggrieved by forgeries may recover damages</td>
<td>43</td>
</tr>
</tbody>
</table>
## CONTENTS

**Note.**
23. Defendant obtaining a verdict to have full indemnity for costs 46
24. Plaintiff suing for a penalty may be compelled to give security for costs 47
25. Act not to affect Corporation of Cutlers 49
26. Short title 49

**II.—THE PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883,**
46 & 47 Vict., c. 57.

**PART I.**

**PRELIMINARY.**
1. Short title 50
2. Division of Act into parts 51
3. Commencement of Act 51

**PART IV.**

**TRADE MARKS.**

**Registration of Trade Marks.**
62. Application for registration 51
63. Limit of time for proceeding with application 63
64. Conditions of registration of trade mark 63
65. Connection of trade mark with goods 78
66. Registration of a series of marks 79
67. Trade marks may be registered in any colour 81
68. Advertisement of application 83
69. Opposition to registration 84
70. Assignment and transmission of trade mark 88
71. Conflicting claims to registration 91
72. Restrictions on registration 93
73. Further restriction on registration 100
74. Saving for power to provide for entry on register of common marks as additions to trade marks 103

**Effect of Registration.**
75. Registration equivalent to public use 108
76. Right of first proprietor to exclusive use of trade mark 109
77. Restrictions on actions for infringement, and on defence to action in certain cases 110

**Register of Trade Marks.**
78. Register of trade marks 112
79. Removal of trade mark after fourteen years unless fee paid 113
CONTENTS.

Fees.

50. Fees for registration, &c. ........................................ 115

Sheffield Marks.

81. Registration by Cutlers' Company of Sheffield marks .... 116

PART V.

GENERAL


82. Patent Office .................................................. 123
83. Officers and clerks ............................................. 124
84. Seal of Patent Office .......................................... 125
85. Trust not to be entered in registers .......................... 125
86. Refusal to grant patent, &c., in certain cases ............. 126
87. Entry of assignments and transmissions in registers ...... 126
88. Inspection of and extracts from registers .................. 128
89. Sealed copies to be received in evidence ................... 129
90. Rectification of registers by court ........................... 129
91. Power for Comptroller to correct clerical errors ......... 140
92. Alteration of registered mark ................................ 141
93. Falsification of entries in registers ........................ 142
94. Exercise of discretionary power by Comptroller .......... 143
95. Power of Comptroller to take directions of law officers . 143
96. Certificate of Comptroller to be evidence ................ 143
97. Applications and notices by post ........................... 144
98. Provision as to days for leaving documents at office .... 145
99. Declaration by infant, lunatic, &c. ........................ 145
100. Transmission of certified printed copies of specifications, &c. .............................. 146
101. Power for Board of Trade to make general rules for classifying goods and regulating business of Patent Office ............................................... 146
102. Annual reports of Comptroller .............................. 149

International and Colonial Arrangements.

103. International arrangements for protection of inventions, designs, and trade marks .................. 149
104. Provision for colonies and India ........................... 152

Offences.

105. Penalty on falsely representing articles to be patented . 153
106. Penalty on unauthorised assumption of royal arms ...... 154

Scotland; Ireland; &c.

107. Saving for courts in Scotland ............................... 155
108. Summary proceedings in Scotland ........................... 155
# CONTENTS

## RULES

1. Preliminary
2. Interpretation
3. Fees
4. Forms
5. Classification of goods
6. Application for Registration
7. Application by firm
8. Agency
9. Acknowledgment of application
10. Contents of form of application
11. Description, &c., of documents
12. Qualification of goods
13. Representations of trade mark
14. Representations of a series of trade marks
15. Translation of foreign characters
16. Mode of sending notices, &c.

## Exercise of Discretionary Powers

17. Hearing by Comptroller
18. Notice of wish to be heard before Comptroller
19. Notification of decision

## Appeal to Board of Trade

20. Notice of appeal to be given
21. Statement of grounds of appeal
22. Copy of notice to Board of Trade
23. Directions by Board
24. Notice of time of hearing

---

### 1. Preliminary

- Proceeding for revocation of patent in Scotland
- Reservation of remedies in Ireland
- General saving for jurisdiction of courts
- Isle of Man

### 2. Repeal; Transitional Provisions; Savings

- Repeal and saving for past operation of repealed enactments, &c.
- Former registers to be deemed continued
- Saving for existing rules
- Saving for prerogative

### 3. General Definitions

- General definitions
- Schedules

---

## III.—Trade Marks Rules, 1883.

- Application for Registration
- Exercise of Discretionary Powers
- Appeal to Board of Trade

---

PAGE

1. Preliminary
2. Interpretation
3. Fees
4. Forms
5. Classification of goods
6. Application for Registration
7. Application by firm
8. Agency
9. Acknowledgment of application
10. Contents of form of application
11. Description, &c., of documents
12. Qualification of goods
13. Representations of trade mark
14. Representations of a series of trade marks
15. Translation of foreign characters
16. Mode of sending notices, &c.

---

19. Notification of decision

---

20. Notice of appeal to be given
21. Statement of grounds of appeal
22. Copy of notice to Board of Trade
23. Directions by Board
24. Notice of time of hearing
## CONTENTS

### Advertisement of Application.

- Rule 25. Application to be advertised in official paper .......................... 170
- Rule 26. Definition of official paper .......................................................... 170
- Rule 27. Means of advertising trade mark to be supplied to official paper .... 170
- Rule 28. Advertisement of series ................................................................. 171

### Opposition to Registration.

- Rule 29. Manner of bringing case before court ........................................... 171

### Register of Trade Marks.

- Rule 30. Time of registration of trade marks .............................................. 172
- Rule 31. Where applicant dies before registration, the trade mark may be registered for successor to goodwill of business ........... 173
- Rule 32. Entries to be made in register ......................................................... 173
- Rule 33. Notice of registration ................................................................. 174
- Rule 34. Request by subsequent proprietor .................................................. 174
- Rule 35. Signature of request ....................................................................... 174
- Rule 36. Contents of request ....................................................................... 174
- Rule 37. Declaration to accompany request ..................................................... 175
- Rule 38. Further proof of title if required ...................................................... 175
- Rule 39. Body corporate ........................................................................... 175
- Rule 40. Definition of applicant .................................................................. 175
- Rule 41. Comptroller may require statement from rival claimants .......... 176
- Rule 42. Submission to court of conflicting claims ........................................ 176
- Rule 43. Settlement of special case ................................................................. 176
- Rule 44. Orders of court to be left at Patent Office ...................................... 177
- Rule 45. Removal of mark from register ......................................................... 177
- Rule 46. Alteration of address in register ....................................................... 177
- Rule 47. Publication of rectification or variation of register ......................... 178
- Rule 48. Notice to Comptroller of order of court for alteration of trade mark under section 92 of Act .......................................................... 178

### Inspection of Register.

- Rule 49. Hours of inspection ........................................................................ 179

### Power to Dispense with Evidence.

- Rule 50. Comptroller to have power to dispense with evidence .................. 179

### Amendments.

- Rule 51. Amendment of documents and drawings ........................................ 180

### Enlargement of Time.

- Rule 52. Comptroller may enlarge time ....................................................... 180

### Cutlers' Company.

- Rule 53. Sheffield applications in duplicate .................................................. 181
- Rule 54. Notice to Comptroller ................................................................. 181
CONTENTS.

RULE
55. (1.) Time within which Comptroller may object to application made at Sheffield 181
   (2.) Advertisement of application made at Sheffield 181
   (3.) Manner of notifying to Cutlers' Company application received by Comptroller 182
56. Similarity of proceedings at London and Sheffield 182

Certificates.
57. Certificate by Comptroller 182

Declarations.
58. Manner in which, and persons before whom, declaration is to be taken 183
59. Notice of seal of officer taking declaration to prove itself 184

Repeal.
60. Previous rules repealed 184

First Schedule.
Fees 185

Second Schedule.
Index of Forms 187
Forms 188

Third Schedule.
Classification of goods 206

IV.—INSTRUCTIONS TO PERSONS WHO WISH TO REGISTER TRADE MARKS.
Preliminary 216
Sale of official publications 219
Definition of a trade mark 219
Application for registration 221
Additional representations of mark 222
Series of trade marks 223
Common or open marks 223
Classification of goods 224
Advertisements in the "Trade Marks Journal" 224
Restrictions on registration 225
Oppositions 226
Forms of counter-statement and bond 226
Fees 229
Cutlers' Company 229
Manchester office 230
Certificates 230
Registration of subsequent proprietors of registered trademarks 231

INDEX 232