[HIGH COURT OF AUSTRALIA.]

LEVER BROS. . . . . APPELLANTS;
OPPONENTS,

AND

G. MOWLING & SON . . . . . RESPONDENTS.
APPLICANTS,

ON APPEAL FROM THE SUPREME COURT OF VICTORIA.

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MELBOURNE, *June* 2, 3.

Griffith C.J., Barton, Isaacs and Higgins JJ.

Trade Mark—Application pending when Trade Marks Act 1905 *came into force—Appeal referred to Supreme Court—Appeal to High Court—"Calculated to deceive"—Trade Marks Act* 1905 (*No.* 20 *of* 1905), *secs.* 6, 14—*Trade Marks Act* 1890 (*No.* 2) (*Vict.*) (*No.* 1183), *secs.* 13, 16 (2), 17.

An application for the registration of a trade mark was pending in Victoria at the time the *Trade Marks Act* 1905 came into operation, and, pursuant to sec. 6 of that Act and to sec. 13 of the *Trade Marks Act* 1890 (No. 2) (Vict.), an appeal from the Commonwealth Registrar of Trade Marks to the Attorney-General of the Commonwealth was by him referred to the Supreme Court.

Held, that the reference to the Supreme Court was authorized and that an appeal lay from a decision of that Court to the High Court.

A trade mark consisting of a label containing the words "Mowling's Best" with a representation of three stars between those words, and in another line the words "Three Star" followed by a blank, *held* to be distinctive and not to be calculated to deceive within the meaning of sec. 16 (2) or sec. 17 of the *Trade Marks Act* 1890 (No. 2) (Vict.), with respect to a registered trade mark consisting of the word "Starlight," or an unregistered trade mark consisting of a female figure surrounded by stars and the word "Starlight."

Decision of Supreme Court: *In re G. Mowling & Son's Application for a Trade Mark*, (1908) V.L.R., 123; 29 A.L.T., 169, affirmed.

APPEAL from the Supreme Court of Victoria.

On 25th June 1906 G. Mowling & Son applied under the

Victorian *Trade Marks Act* 1890 (No. 2) to the Commissioner of Trade Marks of Victoria for the registration in Class 47 in respect of "Common Soap" of a trade mark which was as follows :—

The essential particulars of the trade mark were described as "the distinctive label."

This application was filed on 26th June 1906, and was advertised in the Victorian *Government Gazette* on 22nd August 1906 and in the *Australian Official Journal of Trade Marks* on 24th August 1906.

At the time when that application was made Lever Brothers Limited were the registered proprietors in Victoria of a trade mark consisting of the word "Starlight" in Class 47 in respect of "Laundry Soap," and dated 10th June 1898, and also of a trade mark consisting of the same word "Starlight" in Class 48 in respect of "Toilet Soap," and also dated 10th June 1898. Lever Brothers Limited had also been using in Victoria for a number of years, and were then still using, a label of which the following is a copy :—

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On 3rd September 1906 Lever Brothers Limited gave notice of opposition to the application of G. Mowling & Son on the ground, substantially, that the applicants' label, if registered as a trade mark, would, having regard to the registered trade marks of, and the label used by, Lever Brothers Limited, be calculated to deceive.

In the affidavits filed in support of the opposition it was alleged that the soap to which the opponents' trade marks were applied had become known in the market as "Starlight Soap" and was likely to become known as "Star Soap," and that the deponents believed that the applicants' soap to which their label was applied would also be likely to become known as "Starlight Soap" or "Star Soap."

In one of the affidavits filed in reply to the opposition it was stated that the device of a star and/or the word "star" was common to the trade in Victoria in respect of goods in Class 47.

The Commonwealth *Trade Marks Act* 1905 came into operation on 2nd July 1906, and thereafter the application was dealt with by the Commonwealth Trade Marks Office.

On 18th May 1907 the Registrar of Trade Marks dismissed the opposition. Lever Brothers Limited thereupon appealed to the Law Officer, namely, the Attorney-General of the Commonwealth, and thereafter requested him to refer the appeal to "the Court" by virtue of the powers alleged to be given to him by sec. 14 (*b*) of the *Trade Marks Act* 1905 and sec. 13 (4) of the *Trade Marks Act* 1890 (No. 2) (Vict.)

The Attorney-General then referred the appeal to the Supreme Court of Victoria. At the hearing of the appeal an application was made by the opponents for leave to produce fresh evidence to the effect that the applicants were also applying for the registration of a device of the sun and the word "Sun" in Class 47 to be applied to candles, which was opposed by the present opponents as being the registered proprietors and users of numerous registered trade marks in Class 47 comprising the word "Sun" and compounds thereof including "Sunlight" and of a device of the sun in respect of soap.

The Supreme Court dismissed the appeal and also the applica-

tion for leave to produce fresh evidence: *In re G Mowling & Son's Application for a Trade Mark* (1).

Mitchell K.C. (with him *Sproule*), for the appellants.

Irvine K.C. (with him *Levinson*), for the respondents, took a preliminary objection. The appeal is incompetent. As the application was pending in Victoria at the time the *Trade Marks Act* 1905 came into operation, the proceedings were by virtue of sec. 6 continued under the Victorian Trade Marks Acts. Sec. 13 of the *Trade Marks Act* 1890 (No. 2) (Vict.) provided for a reference of an appeal by the Law Officer to the Supreme Court. But under sec. 14 of the *Trade Marks Act* 1905 the Commonwealth Law Officer had no power to refer an appeal to the Supreme Court. Even if he had, the Supreme Court for that purpose only exercised an administrative jurisdiction as *persona designata* and not its ordinary judicial jurisdiction. Its determination would be a judicial one, no doubt, but it was given in the exercise of ministerial functions given to it as an "authority" within the meaning of sec. 14. Its decision would not make the matter *res judicata*. The fact that the Supreme Court was chosen as a tribunal to come to a decision did not make it a tribunal from which an appeal lies to the High Court: *Holmes* v. *Angwin* (2).

Mitchell K.C. was not called upon.

GRIFFITH C.J. We are all of opinion that an appeal lies to this Court. We think that the jurisdiction of the Supreme Court under the Victorian Act was a judicial jurisdiction from which an appeal would lie, and that nothing in sec. 6 or in sec. 14 of the *Trades Marks Act* 1905 has altered the character of that jurisdiction.

Mitchell K.C. The respondents' trade mark is challenged both under sec. 16 (2) and sec. 17 of the *Trade Mark Act* 1890 (No. 2) (Vict.). It is calculated to deceive both in respect of the appellants' registered trade mark and of their unregistered trade mark.

(1) (1908) V.L.R., 123; 29 A.L.T., 169. (2) 4 C.L.R., 297.

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The respondents are entitled to disclaim any non-essential parts, and when those are omitted the possibility of deception is greatly increased: *In re Murphy's Trade Mark* (1). The name of the respondents is not essential and may be omitted: *In re Trade Marks of the Stock-Owners' Meat Co. of New South Wales* (2). The onus is upon the respondents to show that their trade mark is not calculated to deceive, and if there is any doubt the trade mark will not be registered: *Lever* v. *Newton* (3); *Eno* v. *Dunn* (4).

[ISAACS J. referred to *In re Chesebrough's Trade Mark "Vaseline"* (5).]

There is nothing distinctive about the respondents' trade mark, and therefore it should not be registered.

[ISAACS J.—The label itself may be distinctive.]

The respondents have put forward the view that the word "Star" is common to the trade, and if that be so, they are not entitled to register their trade mark, for there is nothing else which makes the mark distinctive.

Counsel also referred to *In re Trade Mark of La Société Anonyme des Verreries de l'Etoile* (6); *In re Dewhurst's Application* (7); *In re Application of Pomril Ltd.* (8); *In re Remfry's Trade Mark* (9); *In re Sanitas Co.'s Trade Mark* (10); *In re Arbenz' Application* (11); *In re Australian Wine Importers' Trade Mark* (12); *In re Rosing's Application* (13); *In re Sphincter Grip Armoured Hose Co.'s Trade Mark* (14); *In re Dexter's Application*; *In re Wills's Trade Marks* (15).

The application to be allowed to produce fresh evidence should be allowed. There was jurisdiction to allow it.

Irvine K.C. was not heard.

GRIFFITH C.J. The trade mark in question in this case, and which is sought to be registered in Victoria in respect of common

(1) 7 R.P.C., 163.
(2) 14 R.P.C. 733.
(3) 26 N.Z.L.R., 856.
(4) 15 App. Cas., 252.
(5) (1902) 2 Ch. 1.
(6) 10 R.P.C., 436; 11 R.P.C., 142.
(7) 13 R.P.C., 288, at p. 294.
(8) 18 R.P.C., 181, at p. 184.
(9) 23 V.L.R., 44; 18 A.L.T., 253.
(10) 4 R.P.C., 533.
(11) 4 R.P.C., 143.
(12) 6 R.P.C., 311.
(13) 54 L.J. Ch. 975.
(14) 10 R.P.C., 84.
(15) (1893) 2 Ch., 262.

soap, is a label consisting of three lines, the first line having at one end of it the word "Mowling's" and at the other the words "The Best," while between them is a pictorial representation of three large six-pointed stars enclosed in lines something like an Egyptian cartouche. The next line consists of the words "Three Star," followed by a blank, intended, I suppose, to be filled in with the word "soap," and the third line contains in very small print the words "manufactured by G. Mowling and Son, Melbourne." The registration of this label is objected to substantially on two grounds, both of which are based upon secs. 16 (2) and 17 of the Victorian *Trade Marks Act* 1890 (No. 2). Sec. 16 (2) provides that:—Except as aforesaid the Commissioner shall not register with respect to the same goods or description of goods a trade mark having such resemblance to a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive." Sec. 17 provides that:—"It shall not be lawful to register as part of or in combination with a trade mark any words the use of which would by reason of their being calculated to deceive or otherwise be deemed disentitled to protection in a Court of justice or any scandalous design." It is said that this trade mark, if registered, would be calculated to deceive on two grounds, first, that the appellants have registered as a trade mark the word "Starlight" in respect of laundry soap and toilet soap; and, secondly, that the appellants have for some years used in Victoria a label, which, however, is not registered, consisting of an oval frame enclosing a female figure with the word "Starlight" over her head, pointing with her left hand to a very bright star, and having in the body of the label several other stars, and the words "Royal Toilet Soap," the whole label being surrounded with eight large stars and twelve groups of four stars each.

The question to be determined is whether the respondents' label as described is so like either of these two labels as to be calculated to deceive. The majority of the Court below were of opinion that it was not. The onus may be upon an applicant to show that the trade mark is not calculated to deceive. But there is no similarity between the word "Starlight," taken by itself, and the respondents' label, unless, indeed, it can be said that by regis-

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tering the word "Starlight" the appellants have appropriated to themselves the use of the word "Star" in any combination. The use of the words "Three Star" does not suggest to the mind of an ordinary person that the thing to which those words are attached is the same article which he is accustomed to know under the word "Starlight." I confess that my difficulty is to find anything in this part of the case to answer. It is said that an ignorant messenger sent to buy "Starlight" soap might be deceived into buying "Three Star" soap. But when one is considering whether a trade mark is reasonably calculated to deceive, it must be supposed that people of ordinary intelligence—not particularly bright and intelligent, and not particularly stupid—are being dealt with. On the facts I entirely concur with the majority of the Supreme Court that the respondents' label is not calculated to deceive on this ground.

In respect of the other label which the appellants have been using, I entirely concur with the judgment of *Cussen* J. when he said that the appellants' case on this label is weaker than that on the word "Starlight."

Another point suggested is that on its face the respondents' label is not distinctive and therefore should not be registered. Unless there is some authority showing that such a label is not "distinctive," one would say that on its face it is distinctive. It is not like any other label we know to be in existence. It distinguishes the goods as being the goods of the person using it. I again find a difficulty in grasping or answering this objection. The real answer is found by looking at the label. On its face it is distinctive, and, unless the plain, ordinary meaning of the word "distinctive" has been cut down by some authority, I do not see how it can possibly be said not to be distinctive.

I have referred to this point although it may be doubtful whether it could have been raised in the Supreme Court, as it was not one of the grounds taken in the notice of objection. If there had been any difficulty in the rest of the case, it would have been necessary to consider that question more carefully. For the reasons I have given I agree with the decision of the majority of the Supreme Court.

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Isaacs J.

BARTON J. I am of the same opinion and do not think it necessary to add anything. I think the opposition was groundless and that this appeal also is groundless.

ISAACS J. I concur in the judgment of the Court. I think that, assuming as we must that the respondents' label will be fairly used, there is no reasonable probability of there being deception.

HIGGINS J. I concur.

Appeal dismissed with costs.

Solicitor, for the appellants, *E. Hart* for *A. De Lissa*, Sydney.
Solicitors, for the respondents, *Braham & Pirani.*

B. L.

Foll *Murphy v Farmer* 79 ALR 1 | Foll *Murphy v Farmer* (1988) 62 ALJR 420 | Foll *Hill v Donohoe* (1911) 13 CLR 224 | Dist *Poole v Wah Min Chan* (1947) 75 CLR 218

[HIGH COURT OF AUSTRALIA.]

LYONS . . . . . APPELLANT;
DEFENDANT,

AND

SMART . . . . . RESPONDENT.
INFORMANT,

ON APPEAL FROM A COURT OF PETTY SESSIONS OF VICTORIA.

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MELBOURNE, *May* 28, 22. *June* 1, 2, 11.

Griffith C.J., Barton, O'Connor, Isaacs and Higgins JJ.

Customs Act 1901 (*No.* 6 *of* 1901), *secs.* 229, 233—*Unlawful possession of goods—Unlawful importation—Possession unconnected with importation—Knowledge—Prohibited imports.*

Sec. 233 of the *Customs Act* 1901 does not impose a penalty on a person who is in possession of goods which have been unlawfuly imported, but who was in no way connected with their importation, although he knows that they have been so imported.

So held by the Court (*Isaacs J.* dissenting).