

[HIGH COURT OF AUSTRALIA.]

LEVER BROS., LTD. APPELLANTS ;
OPPONENTS,

AND

LEWIS GRANT ABRAMS RESPONDENT.
APPLICANT,

ON APPEAL FROM THE REGISTRAR OF TRADE MARKS.

Trade Marks Act 1905 (No. 20 of 1905) secs. 25, 114—Application for registration of trade mark—Resemblance to trade mark already on register—Identity of principal features of design—Mark likely to deceive—The like goods or class of goods.

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SYDNEY,
May 25, 27.
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Griffith C.J.,
O'Connor and
Higgins JJ.

*Per Griffith C.J. and O'Connor J. :—*Sec. 25 of the *Trade Marks Act 1905* relates to questions arising between the owner of an existing trade mark and a person applying for registration of another. Whereas sec. 114 relates to questions arising as between an applicant for registration and the public; and the question to be determined under the latter section is whether, if the trade mark which it is sought to register were registered, the public would be likely to be deceived into thinking that they were buying the goods of the owner of another trade mark.

The appellants were the owners of a trade mark consisting of the word “Sunlight” registered in respect of soap (not included in other classes) polishing extract, polishing paste, and similar compounds and materials for polishing or cleaning cutlery, china, glass, earthenware, buildings, marble, paint and other substances (being goods included in Class 50, sub-class 10, in the Schedule to the Act). The respondent sought to register as a trade mark in respect of boot polish, linoleum polish or cream, and harness dressing (goods which the appellants had never made or sold) a design of which the essential particular was the word “Sunlight” printed in a style similar to that which had been adopted by the appellants for many years in using the registered trade mark, and the added matter included a representation of the rising sun, which also had been used for many years by the appellants in connection

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with the word "Sunlight," and the name of the respondent with the word "Agent" printed below it. The application, which was opposed by the appellant, was granted by the Registrar.

Held, per totam curiam, on appeal from the Registrar, that whether the goods in respect of which the respondent sought to register were or were not, within the meaning of sec. 25, "the like goods, or class of goods" with those of the appellants, they were, on the evidence, so connected with those goods in trade, in the minds of persons dealing in and using them, and the trade mark sought to be registered so nearly resembled that of the appellants, that, if applied to the respondent's goods, it was calculated to deceive the public into believing that they were goods of the appellants' manufacture, and that, therefore, the trade mark came within the words of sec. 114, and ought not to be registered.

Eno v. Dunn, 15 App. Cas., 252, applied.

Semble, per Griffith C.J. and O'Connor J., that the goods in respect of which the trade mark was sought to be registered were, with the possible exception of boot polish, "the like goods, or class of goods" with those manufactured by the appellant, and therefore that the case came within sec. 25.

Meaning of the words "the like goods, or class of goods" in that section discussed.

Decision of the Registrar of Trade Marks: *In the matter of the application of L. G. Abrams for a trade mark*, November 5th 1908, reversed.

APPEAL from a decision of the Registrar of Trade Marks allowing registration of a trade mark.

The respondent applied to the Registrar of Trade Marks under the *Trade Marks Act* 1905 for registration of a trade mark in Class 50, sub-class 10, in respect of boot polish, linoleum polish (or cream), and harness dressing, in his name. It is not necessary to describe the design of the trade mark in detail, as it is fully described in the judgment of *Griffith C.J.* hereunder. The application contained the following statement:—"The essential particulars of the trade mark are the following: the word 'Sunlight,' and I disclaim any right to the exclusive use of the added matter." The appellants, who were registered under the Act as proprietors of a trade mark consisting of the word "Sunlight" to be applied to "soap (not included in other classes), polishing extract, polishing paste and similar polishing compounds and materials for polishing or cleaning cutlery china glass earthenware buildings marble paint and other substances, and being

goods included in Class 50 sub-class 10," and were registered proprietors of the word "Sunlight" as a trade mark in all the Australian States in respect of substantially the same goods or classes of goods, opposed the application. It appeared from the grounds of their objections, as stated to the Registrar, that they were registered also for the word "Sunlight" in other classes besides Class 50, for common soap, soap powders, and other articles for laundry purposes, such as candles, matches, starch, washing soda, &c. The word "Sunlight" and the design of a rising sun similar to that on the respondent's labels, had for many years been used as a trade mark by the appellants in connection with goods of their manufacture, and in advertisements for those goods, not only in Australia, but in other parts of the world, to such an extent that, as was alleged, the word "Sunlight" and the design of a rising sun had become identified with the appellants' business. It was contended that the trade marks were practically identical, and that the goods were "the like goods, or class of goods," so that the case came within sec. 25 of the *Trade Marks Act* 1905, and, further, that if the respondent's mark were registered, it would be likely to deceive the public, within the meaning of sec. 114 of the Act, into believing that goods of the respondent's manufacture, bearing the mark, were goods of the appellants' manufacture. It was said that young people and domestic servants formed the class of persons who commonly bought at shop counters not only the goods sold by the appellants but those manufactured by the respondent, and that the appellants' goods had acquired so great a reputation in Australia owing to the efforts and enterprise of the appellants that persons using a trade mark resembling theirs would unfairly get the benefit of the appellants' expenditure and business energy. And it was contended on general grounds that, under the circumstances, it was at any rate not clear that injury would not result to the appellants and deception to the public from the registration of the trade mark put forward by the respondent. Although it was contended that the respondent's goods were "the like goods, or class of goods" with those of the appellants, there was no evidence that the appellants had ever manufactured or sold goods of that particular description. The respondent's conten-

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tions before the Registrar were in effect a denial that there was any likelihood of deception from the use of the trade mark in question in connection with his goods, partly on the ground that the trade marks were substantially different, and partly on the ground that the goods made and sold by the appellants were not in fact associated in trade with the goods in respect of which the respondent sought registration of his mark. The Registrar came to the conclusion that the goods covered by the appellants' registration were all soaps or of a soapy nature, and that they were not, either in their use or their nature, the like goods or class of goods with those of the respondent. He was also of opinion that the public were not likely to be deceived by the use of the respondent's trade mark on goods of his manufacture, and granted the application, dismissing the opposition with costs.

From that decision the present appeal was brought.

Dr. Cullen K.C. (*Leverrier* with him), for the appellants. The goods in respect of which the respondent sought to register are "the like goods, or class of goods" with those manufactured by the appellants for which their trade mark is registered. They are actually in the same sub-class in the Schedule, and in addition to that they are cleansing compounds associated together in trade. Both classes are dealt in by the same class of trader, and are purchased by the same class of persons as a general rule. They are both used in the same department of domestic economy. If they are sold under similar trade marks deception is almost inevitable; the public will, or, at any rate may, infer that the same person manufactures both classes of goods. The English provision, sec. 72 of the 46 & 47 Vict. c. 57, has the words "the same goods or description of goods," whereas sec. 25 has "the like goods, or class of goods," requiring similarity rather than identity of class. Yet even under the English section mere general similarity or connection in trade would appear to be sufficient, such, for instance, as the connection between wines and spirits: *In re Australian Wine Importers, Ltd.* (1). The word "Sunlight" has become identified in the popular mind with goods of the appellants' manufacture.

(1) 41 Ch. D., 278, at p. 287.

The label of the respondent bears a striking resemblance to the trade mark of the appellants, the word "Sunlight" which is its chief feature being printed in a style generally adopted by the appellants in their trade mark. The added matter is insignificant with the exception of the rising sun, which also has been very largely used in trade by the appellants in connection with the word "Sunlight." To grant registration of the respondent's label as a trade mark would be in effect assisting him to get the benefit of the reputation which the appellants have won for their goods. In the first place the appellants rely on sec. 25 of the *Trade Marks Act*. That is more general in its terms than the corresponding provision of the English Act, both in regard to the class of goods and the similarity of device. There is no necessity to prove that the appellants have traded in the particular goods mentioned in the respondent's application, as would be necessary in a passing off case. It is only necessary, assuming that the goods are within the words of the section, to satisfy the Registrar that there is such a resemblance of design as may cause deception which will prejudicially affect the opponents. But even if the case is not within that section, it is clearly within sec. 114. That section is designed to protect the public. It is not necessary for the opponent to show conclusively that deception must follow the registration. If a *prima facie* case of similarity of design tending to cause a confusion is made out, the onus is on the applicant to rebut it. The Registrar was of opinion that, as the appellants had never manufactured the particular articles in respect of which the respondent sought registration, there would be no deception. That was the wrong test. *Edwards v. Dennis*; *In re Edwards' Trade Mark* (1), on which he relied, was an action of infringement. The true test is whether the goods are so commonly dealt in together in the market as to be likely to lead to confusion in the minds of customers: *Kerly on Trade Marks*, 2nd ed., p. 218; *In re The Australian Wine Importers, Ltd.* (2). Under sec. 114, as under sec. 73 of the English Act of 1883, the only question is whether the use of the mark would be likely to deceive: *Eno v. Dunn* (3). The Registrar has a discretion and should exercise it in refusing

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(1) 30 Ch. D., 454.

(2) 41 Ch. D., 278.

(3) 15 App. Cas., 252.

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registration unless it is clear that there will be no deception. [He referred also to *Sebastian on Trade Marks*, 4th ed., p. 350; *In re Compagnie Industrielle des Pétroles' Application*; *In re Price's Patent Candle Co.'s Trade Mark* (1); *Eastman Photographic Materials Co., Ltd. v. John Griffith's Cycle Corporation, Ltd.* (2); *Re Albert Baker & Co.'s Trade Mark* (3).]

[HIGGINS J. referred to *In re Albert Baker & Co.'s Application*; *In re Aerated Bread Co.'s Application* (4).]

Apart from these sections the word "Sunlight" is not a proper mark to be registered as a trade mark in respect of boot polish, as it has reference to the character and quality of the goods. It is not an invented word and is descriptive. [He referred to *Kerly on Trade Marks*, 2nd ed., p. 181; *Eastman Photographic Materials Co. v. Comptroller-General of Patents, Designs and Trade Marks* (5).]

Peden (*E. M. Mitchell* with him), for the respondent. The last point was not taken in the grounds of appeal.

[GRIFFITH C.J.—I do not see anything descriptive of the goods in the word "Sunlight."]

The decision of the Registrar depends largely upon questions of fact. As to such questions this Court should not review his findings unless they are unsupported by evidence.

[O'CONNOR J. Is not this a rehearing, sec. 44 sub-sec. (2)?]

The Act does not say so. The Registrar had before him the certificate of the examiner, which contains material that is not before this Court: see sec. 33.

Sec. 25 does not apply. The goods are not "the like goods, or class of goods." The section means that the same trade mark will not be registered in the names of different persons in respect of, say, soap, or that if one person has a trade mark registered in respect of a particular class no other person may register the same mark in respect of any goods in that class. "The like" is equivalent to "such." The fact that the appellants are registered in respect of one member of sub-class 10 cannot have been intended to prevent another person being registered

(1) (1907) 2 Ch., 435; 24 R.P.C., 519.

(2) 15 R.P.C., 105.

(3) 25 R.P.C., 513.

(4) (1908) 2 Ch., 86.

(5) (1898) A.C., 571.

for the same mark in respect of other members of the same subclass. That is an unreasonable contention and a departure from the recognized principles of trade mark law. The appellants' registration is in respect of soaps and soapy compounds, as the Registrar found. All their registrations in other classes of goods are for soaps and things of that nature, in no case for articles of the same kind as the respondent's goods. If the words of the certificate are doubtful, it is permissible to consider what the appellants have done under it, as evidence of what their application was intended to cover. They have never made or dealt in the articles made by the respondent, or any articles except soap and soapy compounds. It should be inferred, therefore, that they intended only to register in respect of such goods. [He referred to *Hargreave v. Freeman* (1); *Edwards v. Dennis: In re Edwards' Trade Mark* (2).] A person is not entitled to registration of a trade mark in respect of goods in which he does not trade or intend to trade.

[GRIFFITH C.J.—That argument might be relevant in a proceeding under sec. 72 of the Act.]

The Court will not assume that the registration was intended to cover goods in respect of which they were not entitled to registration. The respondent's mark is, at any rate, not identical with that of the appellants'. The whole design is the trade mark: sec. 115. And the application must disclaim any right to the exclusive use of the added matter: sec. 32 (2) (b). The respondent must use the whole trade mark, but the added matter may be used by any other person as part of his trade mark. [He referred to *Lever Bros. v. G. Mowling* (3)]. It will not be assumed that the respondent will use the mark in any other way than as registered: *In re Biegel's Trade Mark* (4). If so used the added matter would clearly differentiate the mark from that of the appellants. Not being identical, the mark is not objectionable unless it so nearly resembles the other as to be likely to deceive. It is not likely to deceive unless there is a certain degree of connection or similarity in the nature of the goods. The same principles apply as in passing off cases, though the onus of proof

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(1) (1891) 3 Ch., 39.

(2) 30 Ch. D., 454.

(3) (1909) V.L.R., 59.

(4) 4 R.P.C., 525.

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is differently placed. These are manufacturers' marks, and should be dealt with from that standpoint. [He referred to *Kerly on Trade Marks*, 3rd ed., p. 229; 2nd ed., p. 219; *Lever Brothers Limited v. G. Mowling & Sons* (1); *Edwards v. Dennis: In re Edwards' Trade Mark* (2); *In re Leiner's Application for a Trade Mark* (3); *In re Trade Mark of Suter, Hartmann and Rahtjens Composition Co., Ltd.* (4).] Customers of ordinary intelligence are not likely to be misled; (see *Lever Bros. v. G. Mowling & Son* (5)). The nature of the goods is very important in this connection: *Singer Machine Manufacturers Co. v. Wilson* (6). The respondent's goods are, in their appearance, composition and use, altogether unlike those of the appellants'.

[GRIFFITH C.J.—Your case is stronger as to boot polish than as to the other two articles.]

The Court can make an order excluding the other articles from the registration if it thinks that they are on a different footing. *Eno v. Dunn* (7) depended upon its own peculiar facts. The expression "Fruit Salt" was never applied to any known substance in the popular mind until the particular production of Eno was sold as such. The present case would be more nearly analogous to that if the respondent sought to use the words "Sunlight Soap" on his trade mark. As to sec. 114 it is open to question whether this is a mark within the meaning of that section. [He referred to 46 & 47 Vict. c. 57, sec. 73; *Trade Marks Act* (Eng.) 1905, sec. 11; *Kerly & Underhay, Trade Marks Act* 1905; *Trade Marks Act*, sec. 16 (e).] Assuming that it is such a mark, it is not calculated to deceive. The design is different in important respects from the device said to have been advertised by the appellants. The respondent is willing to omit the word "agent" from the design if it is likely to mislead. There is no evidence that any of the appellants' goods except a particular kind of soap have been associated in the public mind with the word "Sunlight," or that the articles made by the respondent are so associated with soap as to lead the public to expect that the same person would manufacture both.

(1) (1909) V.L.R., 59.

(2) 30 Ch. D., 454.

(3) 20 R.P.C., 253.

(4) 19 R.P.C., 42.

(5) 6 C.L.R., 136.

(6) 2 Ch. D., 434, at p. 443.

(7) 15 App. Cas., 252.

Cullen K.C., in reply, referred to *Sebastian on Trade Marks*, 4th ed., p. 214; *Kerly on Trade Marks*, 3rd ed., pp. 180, 429; *In re Royal Worcester Corset Co's Application* (1); 46 & 47 Vict. c. 57, sec. 72. The appellants are entitled to the relief asked with costs. He also referred to *Trade Marks Act* 1905 (No. 20 of 1905), sec. 95; *Dunlop v. Cooper* (2).

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GRIFFITH C.J. I think that this appeal must be allowed. The appellants appeal from a decision of the Registrar of Trade Marks allowing registration of a trade mark which the respondent had applied to have registered. The mark in question is a circular label having written across it, and occupying the middle portion or section, the word "Sunlight" in large letters, those at the outer edges being considerably larger than those in the middle. Above that word where the north pole of the circle would be is an emblem of the rising sun with the word "Nothing" on one side of it and the word "brighter" on the other. Beneath the rising sun is the word "for" having below it a space intended apparently to receive the name of the article to which the trade mark was to be applied, and in the lower segment of the circle is the word "Agent" over "L. G. Abrams, Sydney." The respondent desires to make the essential particular of his trade mark the word "Sunlight," the rest of the label being added matter.

The application was for registration of the trade mark in respect of boot polish, linoleum cream, and harness dressing. The appellants objected to the registration upon the ground generally that the trade mark of the applicant was likely to deceive. The objection was based upon two separate provisions of the *Trade Marks Act* 1905. The first is sec. 25 which provides: (His Honor read the section), and the other is sec. 114 which provides: (His Honor read the section). Sec. 25 relates, as appears on its face, to questions arising between the owner of an existing trade mark and a person desiring to register another mark. Sec. 114, as was pointed out by Lord *Macnaghten* in *Eno v. Dunn* (3), in dealing with a similar sec. (73) in the English *Trade Marks*

(1) (1909) 1 Ch., 459, at p. 466.

(2) 7 C.L.R., 146.

(3) 15 App. Cas., 252, at p. 263.

H. C. OF A. 1909. *Act 1883*, relates to questions arising as between the trade and the public. The appellants are the owners of the registered trade mark "Sunlight," consisting of that word only, which is registered in respect of various things included in Class 50, sub-class 10 under the *Trade Marks Act*, viz., "soap (not included in other classes), polishing extract, polishing paste, and similar polishing compounds, and materials for polishing or cleaning cutlery, china, glass, earthenware, buildings, marble paint and other substances being goods included in Class 50, sub-class 10."

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To deal first with sec. 25, it is contended by the applicant that the boot polish, linoleum cream and harness dressing are not "the like goods, or class of goods" with those for which the appellants are registered. So far as linoleum cream and harness dressing are concerned I have not much difficulty in saying that they are "the like goods, or class of goods." The meaning of those words was discussed in *In re The Australian Wine Importers' Ltd.* (1), and, although the Court there did not think it necessary to formally decide whether wine, whisky and rum were the same class of goods, they found no difficulty in expressing the opinion that they were. I do not find very much difficulty in saying that polishing extract, polishing paste, and materials for polishing, amongst other things, earthenware, buildings, marble &c., are the same class of goods as harness dressing or linoleum cream. With regard to boot polish there is perhaps a little more difficulty, but I express no opinion on the subject, as I do not think it necessary to do so. I think therefore that, if sec. 25 alone were referred to, the goods in respect of which the respondent desires to register would come within the section, except possibly so far as boot polish is concerned. The mark of the respondent is not identical with that of the appellants, because the added matter is part of the trade mark which he desires to register, although not essential, and is not part of the appellants' registered trade mark. But it is a significant fact that the emblem of the rising sun, which the respondent makes part of his mark, but as to which he disclaims any right of exclusive user, is a mark that has been commonly used by the appellants, so that the respondent proposes in fact to make use of the mark

(1) 41 Ch. D., 278.

that the appellants have been using for their goods for many years. If he uses his trade mark he will have to use the same mark as that used by the appellants. It follows that the two marks are practically almost identical, apart, of course, from the words "Agent L.G. Abrams."

Now I pass to sec. 114. That section, or rather the corresponding section in the *English Trade Marks Act*, which differs only slightly in words, has been expounded by the House of Lords in *Eno v. Dunn* (1). It is a section for the protection of the public, and the question to be determined under it is whether, if such a trade mark as the respondent seeks to register were registered, the public would be likely to be deceived into thinking that they were buying the goods of the appellants. It is suggested for the respondent that it does not actually appear in this case whether the appellants actually sold any goods which may properly be described as polishing extract or polishing paste as distinguished from soap and soap compounds. But that is not the question for consideration. The appellants' trade mark is upon the register lawfully, and there has been no application to expunge it. The appellants are at liberty under their registration to make and sell those things marked with their registered mark, and if they did so, there is, I think, every reason to suppose that ordinary reasonable persons seeing the respondent's trade mark on his goods would be led to believe that the goods to which it was attached were goods manufactured by the appellants. That the respondent thought so himself, is, I think, fairly plain from the fact that he has adopted as part of his trade mark the emblem of the rising sun, and also from the use of the words, "Agent L. G. Abrams," although he says that that is a true description of his business. Any ordinary person of the class likely to purchase these goods, on looking at them would think, on seeing these words, that Abrams was merely the agent for this particular kind of goods which were manufactured by some one else. In my opinion the design is likely to deceive the public, and I do not think that the case can be distinguished from *Eno v. Dunn* (1). What I am now saying applies with particular force to the case of

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 1909. between the thing to which one trade mark is applied and that
 { to which the other is applied. As Lord *Herschell* said in *Eno v.*
 LEVER BROS. *Dunn* (1)—if a person applied the expression “fruit salt” to
 LTD. such a thing as an umbrella it was not at all likely that it would
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 Griffith C.J. manufactured by Mr. Eno. But there is no such dissimilarity
 between boot polish and polishing paste or extract, which are
 things for which the appellants’ trade mark is registered. In
 my opinion, the likeliness of the respondent’s trade mark to
 deceive is clearly established. *Eno v. Dunn* (2) is an authority
 for the proposition that as soon as a *prima facie* case of a
 liability to confusion between a trade mark that it is sought to
 register and one already on the register is made out, the onus is
 cast upon the applicant of showing affirmatively that his mark
 is not calculated to deceive. In this case I think the affirmative
 proposition, that the trade mark is likely to deceive, has been
 established.

For these reasons I think that the application should have
 been refused, and, therefore, that the appeal should be allowed.

O’CONNOR J. I am of the same opinion and have very little to
 add. The opposition to registration of the trade mark in ques-
 tion is put upon grounds involving the interpretation of secs. 25
 and 114 of the *Trade Marks Act* 1905. Sec. 25 is taken from
 the English Act, 5 Edw. VII. c. 15, sec. 19, and, notwithstanding
 some verbal differences, its effect is substantially the same as that
 of the English section from which it is taken. The English
 section itself is merely the repetition of a section which has been
 in the English *Patents Act* for a number of years. I therefore
 take it that the English decisions expounding the English Acts
 are applicable to cases arising under sec. 25 of the Act now
 in question.

I need not repeat what my learned brother the Chief Justice
 has said with regard to these goods being “the like goods, or
 class of goods.” In so far as harness dressing and linoleum cream
 are concerned there can be no question that they are so nearly

(1) 15 App. Cas., 252, at p. 260.

(2) 15 App. Cas., 252.

allied to one another in their use, in their nature and in the class of persons dealing at the places where they are likely to be bought, that there is strong reason for holding them to be the same class of goods as those for which the appellants are registered. Dr. *Cullen's* argument has satisfied me that the same considerations apply to the boot polish, though not perhaps so strongly. The trade mark, for the purpose of determining whether it is identical with or so nearly resembling the Sunlight trade mark as to be likely to deceive, must, I think, be taken to be the whole trade mark registered. The applicant's counsel has made it clear that if he wishes to obtain the protection of the Act he is bound to use the whole trade mark. I shall therefore consider the case on that basis. That is to say, the trade mark is not the word "Sunlight" only, but "Sunlight" with the additions which appear upon the mark itself. There is, I think, good ground for holding that if the applicant's trade mark is applied to these goods, it is when thus applied one which so nearly resembles the Sunlight trade mark that it is likely to deceive. I prefer, however, to base my decision upon the provisions of sec. 114 which correspond with sec. 73 of the English *Trade Marks Act* of 1883. Lord *Herschell* stated the principle upon which that section is to be applied very clearly in *Eno v. Dunn* (1), where he said:—"I think it is enough to say that I am not satisfied that there would be no reasonable danger of the public being deceived. The case was argued on behalf of the respondent as if he had an absolute right to have any trade mark registered which was not proved to fall within the term of either the 72nd or 73rd section of the Act. I do not so read the Statute. Those sections prohibit the registration of a trade mark in certain specified cases; but there is no duty cast upon the Comptroller of registering every other trade mark that may be applied for. On the contrary, whilst he is in certain cases prohibited from registering, a discretion whether to register or not appears to me to be in all cases plainly conferred. Of course this discretion must be reasonably and not capriciously exercised; but it is, in my opinion, a reasonable exercise of it to refuse registration when it is not clear that deception might not result from it." *Kay J.* in *In re The Australian Wine Importers'*

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(1) 15 App. Cas., 252, at p. 261.

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upon the register as a trade mark, the device of a golden fleece having the words "Golden Fleece" printed on it, the device consisting of a sheep suspended by a band passed round it and upon the sheep the printed words. That was the trade mark under which a wine and spirit merchant had sold his goods for a number of years. Another wine merchant sought to put upon the register a new mark consisting of a sheep suspended, as in the other mark, and the words "Golden Fleece," not for spirits, but for wine. It was contended that the latter was likely to be confused with the trade mark actually on the register. *Kay J.* said (1):—"The meaning and intention of that might be, assuming, as I am for the moment, that the other tradesman who has already got the mark on the register has a large and well established business—to get the advantage of that well established business; that is, to make the world suppose or suspect that this wine is wine which has either been manufactured or selected by the man who has been selling the 'Golden Fleece' spirits; in other words, to get the advantage of another man's trade; to profit by his reputation; to deceive buyers into the belief that the wine sold is wine manufactured or sold by the other merchant. If there is a possibility of that kind of deception the Comptroller ought, in my opinion, to say that the mark shall not come upon the register. It is not all the same question as though the spirit merchant were now bringing an action against the applicants to prevent them using the trade mark. That is quite a different matter. Probably he might not succeed: it might be said to him 'You shall not have an injunction; the Court will not interfere by its extraordinary jurisdiction in your favour, because you are only using the mark for spirits': but does it follow that, because he could not get an injunction, the other man is entitled to put the trade mark upon the register? In my opinion it does not follow at all, and I have said so many times." Those are the principles which are to be applied in the administration of sec. 114. Now what is the position of these parties? The opponents, it appears, have had their mark registered some considerable time,

and have been in the habit of making soap and soap products; their wares have been largely advertised and have become connected in the mind of the public with the word "Sunlight." That is to say, they have established by advertisement and trade of an extensive nature a very large business in all their goods which are identified with the word "Sunlight." That is their position. The position of the applicant is that, though he has invented and traded in this class of goods, he has not sold them under this particular name before. The whole field was open to him to choose from as to what should be his trade mark. The onus is on him, as was pointed out in *Eno v. Dunn* (1) by Lord Watson, to show that there is no likelihood of confusion or deception of the public in the use of the trade mark which he has chosen. Now under these circumstances I look at the trade mark applied for and I find there the word "Sunlight," which is associated with the sale of the opponents goods of the like kind in the minds of persons likely to use these things for domestic purposes. I find there also the emblem of the rising sun and, what is more important still, the word agent above the name of the applicant. Well it is quite true that this Court may make an order granting registration in a modified form, striking out the word "agent" and the rising sun, but I think their presence throws a strong light upon the advantage which the applicant sought in using the word "Sunlight." There is, so far as I can see, no other reason why the applicant, who is going to manufacture these goods himself, who manufactures other articles, and has a separate business as agent, should describe himself in the trade mark as agent rather than as manufacturer. It all goes to strengthen the suggestion to the public that the goods sold are "Sunlight" goods of the opponents manufacture. Now it is not necessary, nor do I wish to assert, that there is any fraud or improper dealing in all this, but it is for the Court to consider whether, under all the circumstances, the public are likely to be deceived by the use of a trade mark of this kind. I have come to the conclusion that, having regard to the form of the trade mark applied for, the business carried on by the opponents, the way in which the word "Sunlight" has become identified with their preparations, and

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the similarity of their preparations to those for which the trade mark is now sought to be registered, the use of this trade mark would be likely to deceive, and that the application should not be granted.

I therefore agree that the appeal against the order of the Registrar must be allowed.

HIGGINS J. I am also of opinion that the appeal should be allowed. But I desire to express no opinion as to the meaning of sec. 25. The exact meaning and application of that section must be left for the future to determine. I rely purely upon sec. 114, which prevents the registration of any "mark the use of which would by reason of its being likely to deceive or otherwise be deemed disentitled to protection in a Court of Justice." This phrase comes in between a prohibition as to registration of a scandalous design and of a mark the use of which would be contrary to law or morality. This is based upon the English Act of 1883, sec. 73. The cases in which the English Courts have found that a mark should not be registered under that section are collected in *Kerly*, 2nd ed., p. 200 and the following pages. Sec. 114 I regard as not intended for the protection of one trader against another, or for the protection of one trade mark as against another, but as prohibiting the registration of any trade mark which is likely to deceive the public. This view is, I think, not only confirmed, but clearly laid down in *Eno v. Dunn* (1), and *In re The Australian Wine Importers, Ltd.* (2). Here we have in paragraph 6 of the declaration of Mr. Meek and the following paragraphs specific evidence to this effect—that if an unskilled purchaser were to go into a shop, having bought "Sunlight" soap, and liking it, and were to see "Sunlight" boot polish also sold there, he would be likely to fancy that the articles were made in the same manufactory. Now that statement is not really categorically denied in the declaration of Abrams, the applicant. If we refer to paragraphs 7—9 of his declaration it will be seen that he puts forward as an answer this platitude, that "the sale of the goods depends at the present time not upon the name, but upon the merits of the article."

(1) 15 App. Cas., 252.

(2) 41 Ch. D., 278.

The rest of his statements are wordy, argumentative and unconvincing. To support him he has the statement of a Mr. McDermott, a grocer and general storekeeper, who sells “‘Sunlight’ and other brands of soap, boot polish, and other like goods.” He does not use “Sunlight” boot polish, has had no experience of the sales of it, and gives as the sum of his opinion that, because he is sure that the public are not deceived as to the makers of “Champion” vinegar and “Champion” jam being the same person, therefore they are not likely to be deceived between the makers of “Sunlight” boot polish and “Sunlight” soap. I think we are at liberty to form our own opinion upon the facts as well as this witness, and I unhesitatingly come to the conclusion that under the circumstances of this case the trade mark is likely to deceive the public.

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Appeal allowed. Declaration that the application should be refused. Respondent to pay the costs of the appeal and costs before the Registrar, to be taxed in this Court.

C. A. W.

Solicitor, for the appellant, *A. De Lissa*.

Solicitor, for the respondent, *J. I. Burfitt*.