Special leave to appeal rescinded. Respondent to pay the costs of the appeal and of the motion. One set of costs only.

Solicitors, for the appellant, *Percy D. Cox* by *H. C. Ellison Rich.*

Solicitors, for the respondent Costello, *Kennedy & White* by *Sullivan Brothers.*

Solicitors, for the respondent Minister, *J. V. Tillett,* Crown Solicitor for New South Wales.

C. A. W.

[HIGH COURT OF AUSTRALIA.]

JAMES F. McKENZIE & Co. . . . . APPELLANTS; APPLICANTS,

AND

E. A. LESLIE AND J. R. LESLIE . . . RESPONDENTS. OPPONENTS,

ON APPEAL FROM THE REGISTRAR OF TRADE MARKS.

Trade Mark—Registration—Trade Marks not identical—Likelihood of deception—Honest concurrent user in one State—Conditions as to mode of user—Trade Marks Act 1905 (*No.* 20 *of* 1905), *secs.* 6, 28, 44, 114—*Trade Marks Act* 1865 (*N.S.W.*) (*No.* 9 *of* 1865), *secs.* 2, 4, 7.

A. had for over 20 years used two trade marks, one consisting of the word "Excelsior" and the other a device containing that word, in respect of baking powder, in New South Wales, but chiefly in one district thereof. B. had during the same period used a trade mark, consisting of a device containing the word "Excelsior," also in respect of baking powder, in New South Wales,

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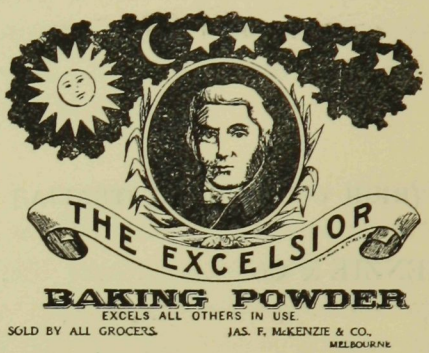
but in a different district. In 1886 B. obtained in New South Wales registration of his trade mark under the *Trade Marks Act* 1865 (N.S.W.)

On applications by A. for registration of his trade marks for the Commonwealth, the Registrar granted the applications limited as to user to the States other than New South Wales.

Held, that, the marks not being identical, and there having been honest concurrent user for the period mentioned, A.'s marks should be registered, subject with respect to New South Wales to conditions as to mode of user.

APPEAL from the Registrar of Trade Marks.

Applications were made by James F. McKenzie & Co., merchants, of Melbourne, on 17th July 1906 for the registration of two trade marks. The first application, No. 1192, was for the word "Excelsior," and the second, No. 1193, was for the following mark:—



The first application was in respect of a number of articles in Class 42 including baking powder, and the second was in respect of baking powder alone in Class 42. The applicants were at the time of the application the registered proprietors of both trade marks in Victoria, Queensland and Western Australia. Both applications were opposed by Elizabeth Annie Leslie and James Robert Leslie of Double Bay near Sydney, executrix and executor of William Leslie, deceased, who were the proprietors of a trade mark registered in New South Wales on 2nd February 1886, which was described as follows:—"A stone printed label indicative of Leslie's Excelsior Baking Powder, made to suit a four sided packet, used as a wrapper for baking powder packets and bearing as a trade mark an illustration of the Excelsior Knight ascending a mountain holding a flag with the inscription

'Leslie's Excelsior Baking Powder.' Picture of a dog following. The whole printed in black ink on yellow paper."

The following is a copy of the picture above described:—

The objections to both applications were the same, and were as follows:—

1. That the applicant company is not the proprietor of the alleged trade mark.

2. That the applicant company is not entitled to be registered as proprietor of the alleged trade mark.

3. That the alleged trade mark so nearly resembles a trade mark already on the register under a State *Trade Marks Act* as to be likely to deceive.

4. That the alleged trade mark is calculated to cause confusion of trade.

5. That it is not clear that deception or confusion of trade will not arise if registration be permitted, and that the onus is on the applicant company.

6. That the alleged trade mark is not distinctive so far as the applicant company is concerned.

7. That the opponents are the registered proprietors of a New South Wales trade mark No. 1461 of 2nd February 1886 consisting of or containing a device and the word "Excelsior" in respect of baking powder.

8. That an application by the opponents is about to be made in the Commonwealth of Australia for registration of a trade mark consisting of the word "Excelsior" and a device in Class 42 in respect of baking powder and such application has only been delayed by the necessity of obtaining probate of the will of the State registrant.

9. That the opponents have used the "Excelsior" trade mark in respect of baking powder for many years past and have acquired a reputation thereunder.

10. That baking powder in tins marked "Excelsior" is

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commonly recognized in the trade and by the public as the goods of the opponents.

11. That the registration of the alleged trade mark by the applicants would be unjust to the said opponents and contrary to natural justice.

The other facts are sufficiently stated in the judgment of *Griffith* C.J. hereunder.

The Registrar held in respect of both marks that it would be improper for him to apply the provisions of sec. 28 of the *Trade Marks Act* 1905, and that they so closely resembled the opponents' registered trade mark as to be likely to deceive. He therefore ordered the registration of the trade marks to be proceeded with subject to a limitation as to user to the States of the Commonwealth other than New South Wales in so far as they applied to baking powder.

From these decisions the applicants now appealed to the High Court.

Schutt, for the appellants. The appellants are entitled to the registration of both marks in respect of New South Wales under one or other of secs. 8, 9, or 16 (*e*) of the *Trade Marks Act* 1905. The word "Excelsior" is not a word having reference to the quality of the article, but is a distinctive word: *Braham* v. *Bustard* (1); *In re Chorlton and Dugdale's Trade Mark* (2).

There is ample evidence that the appellants have been using their trade marks in New South Wales for upwards of 29 years. Neither of their marks so nearly resembles that of the respondents as to be calculated to deceive, so that sec. 114 does not apply. Even if there were any similarity, where there has been honest concurrent user, the first of the users who applies to the Court is entitled under sec. 28 to registration.

Starke and *Levinson*, for the respondents. The word "Excelsior" is an important and substantial part of the respondents' trade mark registered in New South Wales, and any one who used that there in connection with baking powder would be an infringer. The respondents by user and registration have

(1) 1 Hem. & M., 447, at p. 455. (2) 53 L.T. N.S., 337.

acquired an exclusive right to the use in New South Wales of their trade mark and of the word "Excelsior," and although the appellants have honestly used their trade mark there, they have not done so rightfully. The three mark rule only came into operation in England after the *Trade Marks Registration Act* 1875, and the purpose of it was to register old marks, and marks which came into existence after 1875 were not within the rule: *Jackson & Co.* v. *Napper* (1); *In re Schmidt's Trade Mark*; *In re Verity's Trade Mark* (2); *Kerly on Trade Marks*, 3rd ed., p. 264. That led to the passing of sec. 21 of the English *Trade Marks Act* 1905 as to the honest concurrent user, corresponding with sec. 28 of the Commonwealth Act. The conditions under which the *Trade Marks Act* 1865 (N.S.W.) was passed were entirely different from those in England in 1875. There were probably very few old marks in existence in New South Wales then, and the scheme of the Act was to recognize no mark as a trade mark until registration, and to give the registered proprietor the exclusive right to the user of his trade mark throughout New South Wales: see secs. 2, 4, 7; *Walker* v. *Cargill* (3); *Hornsby* v. *Hudson* (4). It was therefore held in *Blogg* v. *Anderson* (5), that two persons could not be registered in respect of the same trade mark. The respondents' registration in New South Wales gave them an exclusive right to their trade mark, and if it did not, then their user of the mark was prior to that of the appellants' use of their mark so that the respondents have an exclusive right at common law to the mark in New South Wales. The fact that the user by the respondents was in a different district from that of the appellants' user makes no difference. [They referred to *Ford* v. *Foster* (6).] The respondents' right of objection is under sec. 114 of the *Trade Marks Act* 1905, and under that section the rights of the public are more to be considered than the rights of the parties. The respondents' device has come to mean "Excelsior," and that word has come to mean the respondents' goods, and if the applications were granted a considerable number of persons would be likely to be deceived.

(1) 35 Ch. D., 162, at p. 177.
(2) 19 R.P.C., 58, at p. 63.
(3) 5 N.S.W. L.R., 243.
(4) 11 N.S.W. L.R. (Eq.), 148.
(5) 21 N.S.W. L.R. (Eq.), 238.
(6) L.R. 7 Ch., 611, at p. 632.

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Under any conditions which could be imposed the use of the word "Excelsior" would lead to confusion. [They also referred to *In re Application of Albert Baker & Co.* (1898) *Ltd.* (1); *In re Application of Pomril Ltd.* (2); *In re Currie & Co.'s Application* (3); *Anglo-Swiss Condensed Milk Co* v. *Metcalf* (4).]

Schutt, in reply. Under the New South Wales Act two or more persons may be entitled to use the same trade mark, but the person who gets registered is given a simple mode of proving that he is entitled to the mark. There is no case shows that his right is made exclusive. [He referred to *In re Lyndon's Trade Mark* (5); *In re Kutnow's Trade Mark* (6); *In re Whiteley's Trade Mark* (7).]

[ISAACS J. referred to *In re "Apollinaris" Trade Mark* (8).]

Cur. adv. vult.

June 14.

GRIFFITH C.J. These are two appeals from the Registrar of Trade Marks who refused applications made by the present appellants for the registration of two trade marks in respect of baking powder. The first application, No. 1192, was for registration of the word "Excelsior" and no more. The application was made for the whole of the Commonwealth, and was granted except with respect to New South Wales. The respondents carry on business in New South Wales as manufacturers of baking powder, and they objected to the registration of the appellants' mark on various grounds which may be summarized under the following three, viz., (1) That the respondents are the registered proprietors in New South Wales of a trade mark substantially the same as that of the applicants; (2) that, if that be not a good objection, the appellants are not entitled to have their mark registered because they have not honestly used the mark in New South Wales for any period; and (3) that the two marks are so alike as to be calculated to deceive.

The respondents' mark is a large label printed on yellow paper

(1) 25 R.P.C., 513, at p. 527.
(2) 18 R.P.C., 181.
(3) 13 R.P.C., 681.
(4) 3 R.P.C., 28.
(5) 32 Ch. D., 109.
(6) 10 R.P.C., 401.
(7) 43 L.T.N.S., 627.
(8) (1907) 2 Ch., 178.

and of such a shape as to wrap round the four sides of a box. On one side is printed in very large type the word "Leslie's," in smaller type the words "Baking Powder" and the name "William Leslie" on a scroll. On the opposite side is a device supposed to suggest the word "Excelsior" by reference to the poem of Longfellow. The device is that of a man in armour walking along level ground there being low hills in the distance. The man is followed by a dog, and is himself carrying a black banner on which are the words "Leslie's Excelsior Baking Powder."

That mark was registered in New South Wales in 1886 and the respondents claim that the effect of that registration was that they acquired not only a right to the exclusive use of that label in New South Wales, but also the exclusive right to the use of the word "Excelsior" there. They claim that right under sec. 6 of the Commonwealth *Trade Marks Act* 1905 and the New South Wales *Trade Marks Act* 1865. Sec. 6 of the former Act provides that:—"The State Trade Marks Acts of each State shall, on the commencement of this Act, cease to apply to trade marks further than as follows:—(*a*) The State Trade Marks Act under which a trade mark is registered shall continue to apply to that trade mark so long as the registration under that Act remains in force." It follows that the New South Wales Act applies to the respondents' trade mark while the registration remains in force. By sec. 2 of the *Trade Marks Act* 1865 (N.S.W.) it is provided that:—

"A mark shall not be recognized or considered to be the trade mark of any person until the same has been registered by or on behalf of the person claiming to be entitled thereto as his trade mark."

By sec. 4 it is provided that any person desirous of registering a trade mark shall comply with certain formalities and "the Registrar shall unless it be shown to the satisfaction of the Registrar that such trade mark had been previously registered or that some other person is entitled to such trade mark or that such trade mark is so like some other trade mark that it may be mistaken for the same issue to the applicant a certificate setting forth that such trade mark to be described on such certificate has

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been duly registered and that the person named in such certificate is entitled to the use of the trade mark described therein."

Sec. 7 declares the rights conferred by registration of a trade mark; it provides that:—"The registration of any trade mark shall not confer any patent right over or any sole right to manufacture any article to which it is proposed to apply such trade mark but the certificate of the registration of any trade mark shall be proof of the right of the person named in such certificate or of the registered transferee of such certificate to use such trade mark except in case of any suit instituted to try the right of any person to have had such trade mark registered."

It was contended that the word "Excelsior" is substantially the same as the elaborate label of the respondents to which I have referred. I do not think it is. If it were, an interesting question would arise as to whether the registration of the respondents' trade mark in New South Wales gives an exclusive right under all circumstances to use the trade mark in New South Wales, that is to say, even in the case where another person has been honestly using the same mark in New South Wales for many years. It has been suggested that that is the result of the words of sec. 7, and there is a dictum to that effect in a judgment of the Supreme Court of New South Wales.

But the words of sec. 7 only say that the certificate of registration "shall be proof of the right of the person named in such certificate . . . to use such trade mark," and not that no one else is entitled to use it. It is true that no one could maintain an action for infringement of a trade mark unless he was the registered owner of the mark, but the words seem very inapplicable to deprive a person of a right of property, which a right to a trade mark was at common law. However, it is not necessary to decide that question, because it cannot be said that the two marks are identical.

On the other two objections the Registrar was of opinion on the evidence that there had been no honest user—no genuine user—of the word "Excelsior" by the appellants in New South Wales, and he found that the two marks so closely resembled one another as to be calculated to deceive. There was abundant evidence that the respondents had used their mark in New South

Wales since 1882. But the Registrar appears to me to have fallen into error, perhaps from his not having a sufficient knowledge of the geography of New South Wales. The evidence for the respondents showed that their trade mark had been used since 1882 in the western district of New South Wales surrounding the town of Dubbo, which had no commercial intercourse with the Riverina District. But the evidence also showed that the appellants had used their trade mark in the Riverina District for a long period. It is said that the appellants' witnesses did not make sufficiently definite statements as to the places where the trade mark was used. But all the statements are made by persons carrying on business at different towns in the Riverina District, and they say they had known the appellants' trade mark all the time that the respondents' mark was being used. There is ample evidence therefore of honest concurrent user in New South Wales for a period of over 20 years. Under those circumstances, the objection under the Act of New South Wales being gone, what ought to be done? All that remains for the respondents to rely upon is sec. 114 of the *Trade Marks Act* 1905 which provides that "no 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, or the use of which would be contrary to law or morality, shall be used or registered as a trade mark or part of a trade mark."

As a matter of strict right, if there are two marks belonging to two different persons of which there has been honest concurrent user, I should not like to say that sec. 114 would over-ride sec. 28, which makes provision for the case of honest concurrent user. It provides that in the case of honest concurrent user, "the Registrar, Law Officer, or the Court may, in his or its discretion, permit the registration of the same trade mark or of nearly identical trade marks for the like goods or class of goods by more than one proprietor, subject to such conditions and limitations as to mode or place of user or otherwise as he or it thinks fit to impose." But it is not necessary to have recourse to that section, because the only objection there could be to the registration of the appellants' trade mark is the possibility of deception, and whether the case of possibility of deception pro-

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vided for in sec. 114 would make it practically mandatory on the Court to impose conditions as to the mode or place of user it is unnecessary to determine now. The only objection is that the appellants' trade mark might be calculated to deceive persons who have been accustomed to attach the word "Excelsior" to the respondents' goods. The Court has, on an appeal to it, power under sec. 44 to attach conditions to the grant of an application for registration. To deprive the appellants of the right to use their trade mark, which they have been using for 25 years, would be unjust to them, and to allow them to use it in such a manner as to represent to persons accustomed to buy the respondents' article that the article of the appellants was that of the respondents would, while in no sense absolutely depriving the respondents of any right, interfere substantially with their right. Therefore, in my opinion, this is a proper case for imposing conditions upon the registration. The conditions have been discussed during argument, and those which I and my brothers think reasonable are that in respect of New South Wales the application should be granted subject to the conditions that the appellants shall not use the mark upon yellow paper, and shall, in every case in which they use the trade mark in New South Wales, prefix the word "McKenzie's."

The other appeal is as to application No. 1193. The parties are the same and the objections are the same, but the mark which the appellants seek to have registered is different. It consists of the portrait of an elderly gentleman in the middle: above him are the sun, the crescent moon and five stars, and below him is the word "The Excelsior" on a scroll. As far as that mark is concerned there is no similarity between it and the respondents' registered trade mark, and any probability of deception is limited to the word "Excelsior" which occurs in both. It has been used by the appellants in New South Wales for over 20 years. In this case, for the reasons given in the other case, we think the applications should be granted with respect to New South Wales with this exception, that it shall not be used upon yellow wrappers or labels. Both appeals, therefore, will be allowed.

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Higgins J.

ISAACS J. I entirely concur, with this additional observation: I think sec. 114 of the *Trade Marks Act* 1905 applies both to the use and the registration of trade marks.

HIGGINS J. read the following judgment. I concur in the orders which have been stated. I think that the conditions which are imposed on the registration under application 1192, taken with secs. 6, 50 and 51 of the *Trades Marks Act* 1905, sufficiently protect any rights which the respondents have under the New South Wales registration. Under sec. 50, registration under that Act is mere *primâ facie* evidence of right to ex-exclusive use; and under sec. 51 it becomes after five years conclusive evidence "subject to this Act"—that is to say, subject (*inter alia*) to sec. 6.

Appeals allowed.

Solicitors, for the appellants, *Waters & Crespin.*
Solicitor, for the respondents, *S. E. Pile,* Sydney.

B. L.

[HIGH COURT OF AUSTRALIA.]

HOPE . . . . . APPELLANT;

AND

THE KING . . . . . RESPONDENT.

ON APPEAL FROM THE SUPREME COURT OF VICTORIA.

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MELBOURNE, *March* 15.

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

Appeal to High Court in Criminal Case — Special leave — Evidence — Dying declaration.

On the trial of a woman for the murder of a girl, statements made by the deceased girl within 24 hours of her death, which had been reduced to writing and signed by her, and also conversations between her and the