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As to the notice to quit there are two answers. First, before the magistrates counsel for the appellant said that he did not raise any objection on that ground, and, secondly, upon the evidence, a full month's notice to quit was given. Whether in the case of a monthly tenancy a month's notice terminating at the end of a month of the tenancy is necessary or not it is not necessary to decide. The appeal fails on all grounds.

BARTON J. I concur.

O'CONNOR J. I concur.

ISAACS J. I concur.

Appeal dismissed with costs.

Solicitor, for the appellant, *W. E. Douglas.*
Solicitors, for the respondent, *Ellison & Hewison.*

B. L.

[HIGH COURT OF AUSTRALIA.]

BEDGGOOD & COMPANY . . . . APPELLANTS; APPLICANTS,

AND

GRAHAM . . . . . RESPONDENT. OPPONENT,

ON APPEAL FROM THE REGISTRAR OF TRADE MARKS.

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MELBOURNE, *March* 24, 25, 26.

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

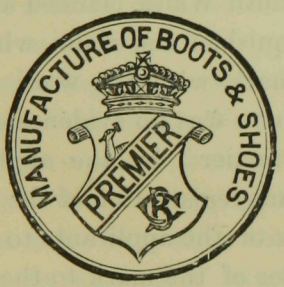
Trade Mark—Registration—Similarity of marks—"Honest concurrent user"—"Special circumstances"—Trade Marks Act 1905 (*No.* 20 *of* 1905), *secs.* 8, 9, 16, 25, 28.

An application for registration of a trade mark having been opposed by the registered proprietor of a trade mark limited to New South Wales, was granted subject to a limitation to the States other than New South Wales. On appeal by the applicant to the High Court,

Held, on the evidence, that the mark of the applicant and that of the opponent were not the same or nearly identical, that, even if they were, there had been honest concurrent user of the marks in New South Wales, and that there were special circumstances within the meaning of sec. 28 of the *Trade Marks Act* 1905, and consequently that the applicant was entitled to registration in respect of New South Wales.

APPEAL from the Registrar of Trade Marks.

On 2nd June 1906 Bedggood & Co. applied for the registration of a trade mark in class 38 in respect of boots and shoes. The mark was as follows :—



The essential particulars were stated to be the word "Premier" and the combination of devices, and the applicants disclaimed any right to the exclusive use of the words "manufacture of boots and shoes."

The application was opposed by George Graham, who was registered in New South Wales as the proprietor of a trade mark consisting of the words "Premier Brand" in a circle, in respect of boots and shoes, for which application was made on 3rd November 1889, and a certificate of registration granted on 3rd January 1890.

It appeared that the applicants were the registered proprietors of a trade mark identical with that in respect of which registration was now sought in all the States of the Commonwealth except New South Wales; that on 17th September 1900 the applicants applied in New South Wales for registration of the same trade mark, that the application was opposed by the present opponent, that the application was then withdrawn, that the applicants on 3rd November 1900 applied for registration of the same trade mark excluding the word "Premier," and that their application was granted; and that on 9th September 1907 the opponent applied under the *Trade Marks Act* 1905 for registration

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of the trade mark of which he was then the registered proprietor in New South Wales, and this application was granted subject to a limitation to New South Wales. There was also evidence that prior to and continuously since 1889 the applicants had used the mark of which registration was now sought in New South Wales in connection with boots and shoes of their manufacture.

The Registrar of Trade Marks held that the applicants had failed to make out a case for registration so far as New South Wales was concerned; that if the applicants, when they made application in New South Wales, claimed any right in the word "Premier," they relinquished the claim when they applied for registration of their mark with the word "Premier" removed therefrom; and that there was no evidence of honest concurrent user of the word "Premier" by the applicants, or of special circumstances to warrant registration of the mark. He therefore ordered the trade mark of the applicants to be registered subject to a limitation as to user of the mark to the States of the Commonwealth other than New South Wales.

From this decision so far as New South Wales was concerned the applicants now appealed to the High Court.

The applicants also moved to rectify the register by expunging the respondent's mark, but, in the events that happened, by consent this motion was withdrawn.

Starke (with him *Dethridge*), for the appellants. The evidence establishes that at the time the respondent's trade mark was registered in New South Wales, the appellants were using in New South Wales a trade mark bearing the word "Premier" to denote goods of their manufacture. Unless the New South Wales Trade Marks Acts deprived the appellants of their trade mark they are still entitled to use it in New South Wales. The New South Wales Acts do not prevent the registration of more than one person in respect of the same mark or of similar marks, although the contrary was held in *Blogg* v. *Anderson* (1). There is not sufficient identity between the two marks to prevent that of the appellants being now registered in respect of New South Wales. The applicants' trade mark should be registered as being a

(1) 21 N.S.W. L.R. (Eq.), 238.

mark within sec. 16 of the *Trade Marks Act* 1905. Even if the two marks were substantially identical, both the appellants and the respondent may obtain registration under sec. 28 of the *Trade Marks Act* 1905, notwithstanding the provisions of sec. 9 of that Act, there having been concurrent user by both parties.

Schutt, for the respondent. The meaning of sec. 9 (3) of the *Trade Marks Act* 1905 is that, in order to entitle a person to be registered in respect of an unregistered trade mark which had been used by him in a State, he must show that if he had applied to have it registered in the State his application would have been successful notwithstanding any opposition. The certificate of registration under the New South Wales Acts is conclusive proof that the respondent was properly registered, and therefore the appellants could not have been registered there. Here the marks are substantially the same or so alike that one might be mistaken for the other, and the applicants' mark could not have been registered in New South Wales. Under sec. 9 the appellants were bound to show that their mark had in New South Wales become identified with their goods and denoted their goods. There is no evidence whatever upon that point. Nor does the evidence negative the finding of the Registrar that there was no honest concurrent use of the mark in New South Wales by the appellants.

Counsel was not heard in reply.

GRIFFITH C.J. This is an appeal from a decision of the Registrar of Trade Marks refusing the appellants' application for the registration for New South Wales of a trade mark used by them in connection with boots and shoes. The mark consists of a shield surmounted by a crown within a circle, having written across the shield from the lower left hand side to the upper right hand side the word "Premier." Above that word is the arm of a man holding a hammer, and below it a monogram of the letters B. and C. Before the coming into operation of the Commonwealth *Trade Marks Act* 1905 the appellants had this device registered in all the States except New South Wales. The respondent objected to its being registered in the Commonwealth

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register in respect of New South Wales on the ground that he was the proprietor of a trade mark registered in New South Wales in January 1890. That trade mark consisted of the words "Premier Brand" in a circle. The Registrar rejected the application of the appellants so far as New South Wales is concerned, and this appeal is from that decision.

A good deal of evidence was given from which it is established, clearly enough I think, that from a period anterior to the registration of the respondent's trade mark in New South Wales the appellants were using in New South Wales the device which they now seek to register in connection with boots and shoes, and have been using it ever since. The question, then, is whether, under these circumstances, the objection is a good one.

A number of interesting questions have been raised and argued with respect to the meaning of the New South Wales Act of 1865, under which the respondent's trade mark was registered; and if the appellants found it necessary to rely on sec. 9 of the Commonwealth *Trade Marks Act* 1905, which gives special rights with regard to unregistered trade marks in use before the passing of the Act, it would have been necessary to express an opinion on those questions. But I think that the application to register the device in question may be regarded, as far as New South Wales is concerned, as an application to register a trade mark for the first time. The objection that another person has a trade mark substantially the same or nearly identical is not a fatal objection under sec. 28. In my opinion the two marks are not the same or nearly identical. But, if they were, the case is clearly brought within sec. 28, which provides that :—"In case of honest concurrent user or of special circumstances 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." As I have said, I think there is strong evidence of honest concurrent user in New South Wales. Moreover, that user was known for many years to the respondent, and he has allowed the appellants to go on using their device in the southern parts of New South

Wales, and, though he has threatened litigation, he has never taken any steps to prevent that user. I think there were both concurrent user and special circumstances, if either were necessary. Under these circumstances it appears to me that the Registrar was wrong in refusing registration with regard to New South Wales, and that the appeal should be allowed. It is pointed out that the form of the application is not entirely satisfactory. We think it better to order the application to be granted so far as New South Wales is concerned, but modifying the trade mark by stating that the essential particulars are "a distinctive device containing the word 'Premier' in the manner above shown."

O'CONNOR J. I am of the same opinion.

ISAACS J. I agree.

Appeal allowed. Application to be granted with the modification above stated. Respondent to pay the costs of the appeal.

Solicitors, for the appellants, *Waters & Crespin.*
Solicitors, for the respondent, *Madden & Butler.*

B. L.

END OF VOL. VII.