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SKINNER v. THE KING.

Isaacs J.

the word "common" is used with it by way of emphasis and to prevent any possible mistake, it entirely negatives any metaphorical notion, and it seems to me to be beyond question that it indicates just such a woman as is described in the quotation I have read. That is substantially what the learned Judge told the jury, and I therefore think that he was quite right, and that leave to appeal should be refused.

GAVAN DUFFY J. I concur.

POWERS J. I concur.

RICH J. I also concur.

Special leave to appeal refused.

Solicitors, *Gavan Duffy & King* for *D. P. Claverie*, Armidale.

B. L.

[HIGH COURT OF AUSTRALIA.]

COLLITT AND ANOTHER . . . . APPELLANTS;
DEFENDANTS,

AND

BORSALINO GUISEPPE E FRATELLO SOCIETA ANONIMA . . . } RESPONDENTS.
PLAINTIFFS,

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MELBOURNE, *May* 13; *June* 20, 23, 24, 27.

ON APPEAL FROM THE SUPREME COURT OF VICTORIA.

Trade Mark—Passing off—Name of person applied to goods—Secondary meaning.

Barton A.C.J., Isaacs, Powers and Rich JJ.

The name of a person may acquire a secondary meaning as denoting goods made by a certain manufacturer, so as to prevent another person applying

that name without explanation or qualification to similar goods not made by that manufacturer.

Held, on the evidence, that the proper name "Borsalino," which was part of the name of the plaintiff company, had acquired a meaning denoting that goods to which it was applied were manufactured by that company, and that the plaintiff company was therefore entitled to have the defendants restrained from applying the word "Borsalino" without explanation or qualification to goods manufactured by another company, whose title also included that proper name.

Decision of the Supreme Court of Victoria (*Hodges* J.) affirmed.

APPEAL from the Supreme Court of Victoria.

An action was brought in the Supreme Court by Borsalino Guiseppe e Fratello Societa Anonima, a company duly incorporated according to the law of Italy, against Thomas Morton Collitt and Herbert Bayford Collitt, retail hatters carrying on business in Melbourne, claiming, *inter alia*, an injunction restraining the defendants from passing off or attempting to pass off hats marked "G. B. Borsalino fu Lazzaro & Co." as hats of the plaintiffs' manufacture and/or without clearly distinguishing the same from the plaintiffs' hats.

The facts are sufficiently stated in the judgment hereunder.

The action was heard before *Hodges* J., who granted an injunction restraining the defendants from passing off G. B. Borsalino fu Lazzaro & Co. hats as hats of the plaintiffs' manufacture.

From this decision the defendants now appealed to the High Court.

Irvine K.C. and *Weigall* K.C. (with them *Mann*), for the appellants. There is no passing off unless there is a probability of deception, and there is no probability of deception unless a person when he thinks he is getting the goods of one maker is getting the goods of another maker. The evidence does not establish that the word "Borsalino" as applied to hats had acquired a secondary meaning and meant, in the minds of the purchasing public, hats manufactured by the respondents, and, therefore, since the appellants only used that word to describe the hats manufactured by G. B. Borsalino fu Lazzaro & Co., they did

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not describe those hats in such a way as to lead the public to believe that they were the hats of the respondents' manufacture: See *S. Chivers & Sons* v. *S. Chivers & Co. Ltd.* (1). The right to prevent another person from selling goods under a particular name is a right which may change in degree and in kind from time to time. Therefore, if another man lawfully uses that name, although confusion will be caused in the trade, the first-mentioned person has no remedy. The right depends on the conditions at the time of the alleged wrong. Here the evidence shows that, although at one time the word "Borsalino" meant hats manufactured by the respondents, at the time of the alleged wrong it meant hats manufactured either by the respondents or by G. B. Borsalino fu Lazzaro & Co. The finding that in 1909 the word "Borsalino" had not in the minds of the purchasing public acquired a secondary meaning is a good finding. [They referred to *Burgess* v. *Burgess* (2); *Kerly on Trade Marks*, 3rd ed., p. 532; *Turton* v. *Turton* (3); *Jamieson & Co.* v. *Jamieson* (4); *Valentine Meat Juice Co.* v. *Valentine Extract Co.* (5); *John Brinsmead & Sons Ltd.* v. *Brinsmead and Waddington & Sons Ltd.* (6); *Daimler Motor Car Co. Ltd.* v. *British Motor Traction Co. Ltd.* (7); *Daimler Motor Co.* (1904) *Ltd.* v. *London Daimler Co. Ltd.* (8).]

Schutt (with him *Starke*), for the respondents. At the time of the acts complained of, the word "Borsalino" had acquired a secondary meaning denoting hats manufactured by the respondents. The finding of the learned Judge is that in the minds of those of the public who troubled about the matter that secondary meaning had been acquired, and the evidence supports that finding. The respondents' trade mark being the word "Borsalino," it is highly probable that their goods would come to be known by that name. At the time hats manufactured by G. B. Borsalino fu Lazzaro & Co. came into the Victorian market the respondents could have restrained them from using the name "Borsalino" to describe their goods, and that position has never been changed.

(1) 17 R.P.C., 420.
(2) 3 D.M. & G., 896, at p. 903.
(3) 42 Ch. D., 128, at p. 135.
(4) 15 R.P.C., 169, at p. 192.
(5) 17 R.P.C., 673.
(6) 30 R.P.C., 137.
(7) 18 R.P.C., 465.
(8) 24 R.P.C., 379, at p. 385.

[He referred to *Burgess* v. *Burgess* (1); *Reddaway* v. *Banham* (2); *Powell* v. *Birmingham Vinegar Brewery Co.* (3).]

[He was stopped.]

Irvine K.C., in reply. The primary meaning of a proper name when applied to goods is that the goods are made by a person bearing that name, and in order to give a person a monopoly of the name it must have acquired some other and secondary meaning. Here "Borsalino" originally meant hats made by a person named Borsalino, and it never meant anything else. [He referred also to *Cellular Clothing Co. Ltd.* v. *Maxton & Murray* (4); *Millington* v. *Fox* (5).]

[ISAACS J. referred to *Electromobile Co. Ltd.* v. *British Electromobile Co. Ltd.* (6).]

Cur. adv. vult.

The judgment of the Court was read by

June 27.

RICH J. This is an appeal from so much of the judgment of *Hodges* J., dated 15th August 1912, as granted an injunction against the defendants to the action and ordered them to pay the costs of the action.

The action was brought by Borsalino Guiseppe e Fratello Societa Anonima, the present respondents, against Thomas Morton Collitt and Herbert Bayford Collitt, the present appellants, and was treated by the parties and dealt with by his Honor as a passing off action.

The respondents are a company incorporated according to the law of Italy, and are large manufacturers of felt hats, which they sell in Australia and elsewhere.

The appellants are retail hatters carrying on business at 103 Swanston Street, Melbourne.

The respondent company is the registered proprietor throughout Australia of three trade marks, in which the word "Borsalino" is the distinctive feature.

For upwards of fifteen years before this action was brought

(1) 3 D. M. & G., 896.
(2) (1896) A.C., 199.
(3) (1896) 2 Ch., 54, at pp. 79, 80.
(4) (1899) A.C., 326, at p. 336.
(5) 3 My. & Cr., 338.
(6) 25 R.P.C., 149.

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the respondent company had imported into Victoria large quantities of hats of its own manufacture. The word "Borsalino" was marked on the leather lining and diagonally across the top of the crown of these hats.

During the same period the respondent company extensively advertised its hats through the medium of mirrors, show cards and catalogues, on which the word "Borsalino" is the conspicuous feature, and stands, with the exception of one kind of show card in which the initials of the makers are printed in the margin, isolated and prominent.

At the end of 1908 a firm called G. B. Borsalino fu Lazzaro & Co. began to import hats of its manufacture into Victoria.

These hats were branded in the lining "G. B. Borsalino fu Lazzaro & Co." This firm also advertised its hats by means of cards, plaques, pictures, &c., which all contained the name of the firm in full.

The defendants, who at the beginning of carrying on business only stocked the respondent company's hats, had a docket (Ex. G1) written or printed containing the word "Borsalino" and the price. This docket was affixed by the defendants to the respondent company's hats.

In November 1909 the defendants stocked some of the hats made by the firm of G. B. Borsalino fu Lazzaro & Co., and affixed the same docket to those hats.

On 8th September, 23rd November and 1st December 1911, the defendants on being asked for a Borsalino hat showed the customers hats of the plaintiffs' manufacture, but in the end sold hats manufactured by the firm of G. B. Borsalino fu Lazzaro & Co., representing them to be "Borsalinos." No docket was given by the defendants on the first occasion but on the two later occasions the dockets (Exhibits U and X) given to the purchasers stated that the hat sold was a "Borsalino" hat. Thereupon the plaintiff filed a statement of claim praying, *inter alia*, for an injunction to restrain the defendants from passing off or attempting to pass off hats marked "G. B. Borsalino fu Lazzaro & Co." as hats of the plaintiffs' manufacture.

At the hearing, *Hodges* J. found that the plaintiffs' hats were well known to both wholesale and retail dealers by the name of

"Borsalino," but that "they were known hardly at all to the individual purchaser by that name." His Honor, however, held that the sales to which reference has already been made were "a distinct passing off of the 'G. B. Borsalino' hat as a 'Borsalino' hat;" and, although finding against a distinct fraud, his Honor found "against the defendants in that they did acts not only calculated to mislead, but acts which did deceive."

On the appeal before this Court there was really no dispute as to the law so far as it affected this case. The question resolved itself into one of fact. Mr. *Irvine*, on behalf of the defendants, admitted that if the word "Borsalino," as applied to the plaintiffs' hats, had acquired a secondary meaning and retained it at the dates of the acts complained of, the appeal must fail. He contended, however, that the word had acquired no such meaning, and, even if it had, that meaning had become obliterated by the intrusion into the market of the hats manufactured by the firm of G. B. Borsalino fu Lazzaro & Co., which, at the date of the acts complained of, had become known equally with the plaintiffs' hats as "Borsalino."

It becomes necessary, therefore, to examine the evidence. On behalf of the plaintiffs, ten persons engaged in the retail trade and four engaged in the wholesale trade were called, who deposed that the plaintiffs' hats were, for eight to fifteen years prior to the hearing, known as "Borsalino" hats, and several of the witnesses stated that if a member of the public asked for a "Borsalino," they would take him to mean a hat which in fact was manufactured by the plaintiffs. The defendants themselves both admit that the plaintiffs' hat was known in the trade as "Borsalino" until the introduction of the hat manufactured by the firm of G. B. Borsalino fu Lazzaro & Co., but that, thereafter, to the defendants, contrary to the otherwise invariable usage of the trade, "both hats were Borsalino." Indeed, as already pointed out, the docket (Ex. G1), printed for the defendants to indicate the plaintiffs' hats, was affixed by them to the hats manufactured by the firm of G. B. Borsalino fu Lazzaro & Co. long before these hats could possibly have been known as "Borsalino." This conduct of the defendants, who are indemnified in this action by the firm, is by no means supported by the firm itself.

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G. Ferrando, the firm's agent in Victoria, is careful to explain that the firm's hats were advertised and sold as "G. B. Borsalino fu Lazzaro," in order to avoid confusion with those of the plaintiffs, and that the firm did not claim the right to use the word "Borsalino" alone.

The firm's agent in New South Wales, although in Court, was not called as a witness.

Irwin, Ferrando's traveller, admits that the plaintiffs' hats had been known in the market for a long time as "Borsalino," and that at the end of 1909 his firm's hats were being advertised in Messrs. Gliddon & Rowley's shop under the name of G. B. Borsalino fu Lazzaro and, similarly, at the end of 1912 or beginning of 1913, in Messrs. Craig, Williamson & Co.'s shop.

This witness, at any rate, and by necessary inference Messrs. Gliddon & Rowley and Messrs. Craig, Williamson & Co., had no suspicion that the public called the "G.B." hats "Borsalino." He is emphatic in stating even at the trial that it would not be fair to supply wholesale houses with small tickets with "Borsalino" simply on, and gives his reason: "because we do not sell ours as 'Borsalino.'" Richards and Rossi, also called on behalf of the defendants, distinguish "Borsalino" hats from "G.B." hats. The plaintiffs' evidence, corroborated as it is by the defendants' witnesses, coupled with the answers to interrogatories, is conclusive proof that the word "Borsalino" had acquired and retained a secondary meaning, which was not confused or obliterated by the trade dealings of the firm G. B. Borsalino fu Lazzaro & Co.

It would, indeed, be singular, if Mr. *Irvine's* contention were right, that the advertisements and methods of trade adopted by this firm, in order, as Ferrando states, to prevent confusion, should bring about what was being so carefully guarded against.

The principles of law applicable to this case are stated in the often cited passage from the judgment of Lord *Herschell* in *Reddaway* v. *Banham* (1):—"The name of a person, or words forming part of the common stock of language, may become so far associated with the goods of a particular maker that it is capable of proof that the use of them by themselves without explanation or qualification by another manufacturer would

(1) (1896) A.C., 199, at p. 210.

deceive a purchaser into the belief that he was getting the goods of A. when he was really getting the goods of B. In a case of this description the mere proof by the plaintiff that the defendant was using a name, word, or device which he had adopted to distinguish his goods would not entitle him to any relief. He could only obtain it by proving further that the defendant was using it under such circumstances or in such manner as to put off his goods as the goods of the plaintiff. If he could succeed in proving this I think he would, on well-established principles, be entitled to an injunction."

It is not necessary that the persons purchasing goods should know of the manufacturer by name, and have in mind when they purchase the goods that they are made by a particular individual. "It seems to me," says Lord *Herschell*, "that one man may quite well pass off his goods as the goods of another if he passes them off to people who will accept them as the manufacture of another, though they do not know that other by name at all": *Birmingham Vinegar Brewery Co. Ltd.* v. *Powell* (1).

Nor does the fact of the defendant bearing the same name as the plaintiff enable him to invade the latter's right of property: See *Valentine Meat Juice Co.* v. *Valentine Extract Co. Ltd.* (2), *per Collins* L.J. and Lord *Alverstone* M.R. See also *John Brinsmead & Sons Ltd.* v. *Brinsmead and Waddington & Sons Ltd.* (3). The present case is still stronger, for the defendants' name is not "Borsalino," and they have shown no authority from G. B. Borsalino fu Lazzaro & Co. to use the simple name "Borsalino."

Mr. *Irvine* contended that it would be difficult for a proper name, especially of the manufacturer of the goods, to acquire a secondary meaning, but Lord *Halsbury* in the *Electromobile Co. Ltd.* v. *British Electromobile Co. Ltd.* (4) points out that "the simpler the title and the more ordinary the words used the more difficult the plaintiffs' case is." *Millington* v. *Fox* (5) was an instance of the plaintiff's exclusive right to his own name as a trade name apart from fraud.

Careful consideration of the evidence, which does not depend on the veracity and demeanour of witnesses, leads to the conclusion

(1) (1897) A.C., 710, at p. 715.
(2) 17 R.P.C., 673, at pp. 679, 681.
(3) 30 R.P.C., 137.
(4) 25 R.P.C., 149, at p. 153.
(5) 3 My. & Cr., 338, at p. 352.

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that the word "Borsalino," which, at first, was naturally used as a surname, acquired and retained, at all events in Victoria, a secondary meaning denoting the hats manufactured by the plaintiffs.

For these reasons we are of opinion that the orders made by the learned Judge are right, and this appeal fails.

Appeal dismissed with costs.

Solicitors, for the appellants, *Moule, Hamilton & Kiddle.*
Solicitor, for the respondents, *F. B. Waters.*

B. L.

[HIGH COURT OF AUSTRALIA.]

NORTHWAY . . . . . APPELLANT;
DEFENDANT,

AND

COULTHARD . . . . . RESPONDENT.
PLAINTIFF,

ON APPEAL FROM THE SUPREME COURT OF SOUTH AUSTRALIA.

H. C. OF A. 1913.

ADELAIDE, *May* 27, 28

Barton A.C.J., Gavan Duffy and Rich JJ.

THE case turned solely on questions of fact.

The judgment of the Supreme Court of South Australia (*Buchanan* A.J.) was affirmed.

Appeal dismissed with costs.

Solicitor, for the appellant, *George McEwin.*
Solicitor, for the respondent, *Robert Homburg, Jun.*

B. L.