

As to the other point, that there was no corroboration of the respondent's evidence, there are two answers. First, that there is no rule of law that the evidence of parties to a divorce suit must necessarily be corroborated. The Court as a matter of prudence will not act upon uncorroborated evidence unless it is manifestly true, as it may be. But there is no such rule of law. The second answer is that, as a matter of fact, the evidence of the respondent was abundantly corroborated. So that there is no foundation for the argument, even if the point of law were a good one. There is therefore no ground for granting special leave, and, as an appeal does not lie as of right, the whole appeal fails.

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ISAACS J. I agree.

GAVAN DUFFY J. I agree; but I do not wish to be taken as determining that, where under sec. 109 of the *Marriage Act* 1890 the Court chooses to call a witness, the Court is limited to asking such questions as may be put by a party in examination in chief.

Appeal dismissed with costs.

Solicitor, for the appellant, *S. J. H. Stephen* for *K. T. Stephen*, Maffra.

Solicitors, for the respondent, *Madden & Butler*.

B. L.

[HIGH COURT OF AUSTRALIA.]

ROBERT HARPER & COMPANY PRO- } APPELLANTS;
PRIETARY LTD. }
OPPONENTS,

AND

A. BOAKE ROBERTS & COMPANY LTD. . RESPONDENTS.
APPLICANTS,

H. C. OF A. *Trade Mark—Application—Opposition—Similar marks—Likelihood of deception—*
1914. *Similarity of goods—Burden of proof—Application to rectify register—Non-user*
of trade mark—*Trade Marks Act 1905 (No. 20 of 1905), secs. 25, 71, 72, 114.*

MELBOURNE,
Feb. 24, 25,
26; March 6.

Griffith C.J.,
Barton and
Isaacs JJ.

An application for the registration of a trade mark in class 42 for “fruit extracts” was opposed by the proprietor of a number of trade marks which were registered in class 42 for, *inter alia*, preserved fruits, essence of coffee and chicory, and soluble cocoa essence.

Held, that there was such a similarity between “fruit extracts” and the other goods above-mentioned that members of the public might be induced to confound the owners of one with the owners of the others; that the applicants had not discharged the onus which was upon them of showing that their mark, if registered, would not be likely to deceive the public into thinking that the applicants’ goods were goods manufactured or sold by the opponents; and, therefore, that the application should be refused.

Eno v. Dunn, 15 App. Cas., 252, and *Lever Bros. Ltd. v. Abrams*, 8 C.L.R., 609, applied.

Semble, where a registered trade mark has not for three years been used by the proprietor in connection with certain goods in respect of which it is registered, an application to rectify the register by expunging the registration in respect of those goods may properly be made under secs. 71 and 72 of the *Trade Marks Act 1905* by a person who wishes to register in respect of those goods a trade mark which, under sec. 25, if the register were not so rectified, would be disentitled to registration; and, therefore, on an appeal from the

dismissal of the opposition to an application for registration of a trade mark, the opposition being founded on sec. 25, the High Court would, on a *prima facie* case for such rectification being made out, adjourn the hearing to allow of an application for rectification being made.

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APPEAL from the Registrar of Trade Marks.

An application was, on 31st July 1911, made by A. Boake Roberts & Co. Ltd. for the registration of a trade mark in class 42 in respect of "Fruit Extracts." On the application the mark was printed thus:—



The essential particular of the trade mark was stated to be "the distinctive label." The application was opposed by Robert Harper & Co. Proprietary Ltd., who were the registered proprietors of a number of trade marks in class 42 in respect of a large number of substances used as food, or as ingredients in food, including preserved fruits, dessicated cocoanut, ground spices, mixed spice, black pepper, white pepper, cayenne pepper, dried herbs, coffee and chicory, essence of coffee and chicory, soluble cocoa essence, oatmeal, avena, groats, hops, castor sugar, icing sugar, crushed linseed, baking powder, ground rice, tea, bird seed, parrot food, oatena, rolled avena, flaked oatmeal and fruit juices. The opponents' trade marks were the word "Star;" devices consisting of a five-pointed star, of a six-pointed star, and of an eight-pointed star; the words "Silver Star"; the words "Gold Star"; a device consisting of a small eight-pointed star in the centre of a larger eight-pointed star, the whole superimposed upon a Maltese cross, beneath the words "Star Brand"; and the device of a sun below the words "Sun Brand."

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It was stated in the evidence that fruit extracts were not sold ready for consumption as food, but were sold to manufacturers to be utilized as ingredients in the manufacture of food substances, whereas all the substances in respect of which the opponents' trade mark was registered were sold in the ordinary course to the public for consumption without further manufacture.

The Registrar held that the marks proposed to be registered did not so closely resemble any of the opponents' trade marks as to be calculated to deceive, and he therefore dismissed the opposition with costs.

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

During the hearing of the arguments before the High Court, an application was made by counsel for the respondents to adjourn the hearing in order to enable an application to be made by the respondents to rectify the register, by expunging the registration of the appellants' trade marks in respect of fruit juices on the ground that the appellants had not for the past three years and upwards used their trade marks in respect of fruit juices.

Schutt and Starke, for the appellants. The respondents' proposed mark is not distinctive: *Kerly on Trade Marks*, 3rd ed., p. 194; *Sebastian on Trade Marks*, 5th ed., p. 596, note *g*. Although the appellants' marks are not registered in respect of fruit extracts they could use those marks in respect of fruit extracts, and would in that way get the benefit of their reputation gained by means of those marks. The public would be likely to be deceived by the registration of a mark similar to any of their marks, if that mark might be used in respect of any article of food. The goods in respect of which the appellants' trade marks are registered, and those in respect of which the respondents seek to have their mark registered, are similar or of similar classes, and the application should be refused under sec. 25 of the *Trade Marks Act* 1905. The respondents' mark is also likely to deceive within the meaning of sec. 114. [They also referred to *Lever Bros. Ltd. v. Abrams* (1); *Eno v. Dunn* (2);

(1) 8 C.L.R., 609.

(2) 15 App. Cas., 252.

Lever Bros. v. G. Mowling & Son (1); *William Charlick Ltd. v. H. C. OF A. Wilkinson & Co. Proprietary Ltd.* (2).] 1914.

Irvine A.-G. and J. R. Macfarlan, for the respondents. In a matter of this kind it is the duty of an applicant to show that if his mark is registered there is no reasonable probability of the public being deceived by a legitimate use of the mark. In determining this question the Court will have regard to the actual course of trade and to the particular class of the public who deal with the particular goods in the course of trade. The Court will also regard the mark as a whole: *Sebastian on Trade Marks*, 5th ed., p. 596; *Pinto v. Badman* (3). The Court will not assume that the label will be substantially altered in its proportions so as to make some part of it more prominent. The respondents are willing to accept conditions. They do not wish to enter into the market in which the appellants trade. Sec. 25 does not apply, because the respondents' mark is not so similar to any of the appellants' marks as to be likely to deceive, nor is "fruit extract" like any of the goods in respect of which the appellants' marks are registered. If "fruit juices" and "fruit extracts" can be said to be like goods or like classes of goods, then the respondents should be allowed to make an application under secs. 71 and 72 to have the register rectified by expunging the appellants' registration in respect of fruit juices on the ground of non-user for three years. See *Edwards v. Dennis*; *In re Edwards' Trade Mark* (4); *John Batt & Co. v. Dunnett* (5); *In re Hart's Trade Mark* (6).

[ISAACS J. referred to *In re Paine & Co.'s Trade Mark* (7); *In re Neuchatel Asphalte Co.'s Trade Mark* (8).]

Sec. 51A of the *Trade Marks Act* 1905-1912 does not prevent such an application being made, for it only validates the original registration. The case is not within sec. 114, because the respondents' mark, if registered, is not likely to deceive.

Starke, in reply. The application to rectify the register should

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(1) 6 C.L.R., 136.

(2) 16 C.L.R., 370.

(3) 8 R.P.C., 181, at p. 191.

(4) 30 Ch. D., 454, at p. 474.

(5) (1898) 2 Ch., 432, at p. 441;

(1899) A.C., 428.

(6) (1902) 2 Ch., 621.

(7) 25 R.P.C., 329.

(8) (1913) 2 Ch., 291, at p. 302.

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have been made before the respondents applied to register their mark. There is grave doubt whether, in view of secs. 50, 51 and 51A of the *Trade Marks Act* 1905-1912, a case for rectification under secs. 71 and 72 could be made, and therefore the hearing should not be adjourned. [He referred to *In re Gutta Percha and India Rubber Co. of Toronto's Applications* (1); *In re Turney & Son's Trade Mark* (2).

Cur. adv. vult.

March 6,

GRIFFITH C.J. The respondents in this case applied to register a trade mark for "Fruit Extracts" in class 42, which comprises substances used as food, or as ingredients in food. The "essential particular" was described as "the distinctive label," which was printed or placed on the application. It is an oblong label of no specific size, having in its middle a small five-pointed star upon a flaming sun with the word "Trufruit" in large letters, and the word "Extract" in smaller letters, in separate lines above the device, and the words "A pure fruit extract" and "Highly concentrated" in two lines below the device. A space is left between the lines "Trufruit" and "Extract," apparently for the insertion of the name of the fruit from which the extract contained in the bottle or other receptacle is made, and the word "Trufruit" is printed in inverted commas. On the application itself the label was printed in black and white, but under the Act any colour might be lawfully used by the proprietor if the trade mark were registered.

The appellants, who opposed the registration, are the proprietors of a number of trade marks for a large number of substances used as food, or as ingredients in food, including preserved fruits, essence of coffee and chicory, soluble cocoa essence and fruit juices. Their trade marks are the word "Star" alone, the devices of a five-pointed star, of a six-pointed star, and of an eight-pointed star, the words "Gold Star," the words "Silver Star," the device of a small eight-pointed star upon a larger eight-pointed star super-imposed upon a Maltese cross with the words "Star Brand" printed above, and the device of a sun below the words "Sun Brand."

(1) (1909) 2 Ch., 10.

(2) 10 T.L.R., 175.

The objection taken by the appellants is founded upon secs. 25 and 114 of the *Trade Marks Act* 1905. Sec. 25 provides that "except by order of the Court, the Registrar shall not register in respect of goods a trade mark identical with one belonging to a different proprietor which is already on the register in respect of the like goods, or class of goods, or so nearly resembling such a trade mark as to be likely to deceive." No doubt "fruit extracts" and "fruit juices" are like goods, or like classes or descriptions of goods, whichever expression is used. The question, therefore, is whether the device sought to be registered so closely resembles any of the appellants' marks as to be likely to deceive. On a comparison of the device and the marks—and in great part cases like this depend upon a comparison by the eye—it is plain to me that the respondents' proposed trade mark so nearly resembles one or more of the appellants' trade marks, which they are entitled to use for fruit juices, as to be likely to deceive persons if the proposed trade mark is registered in respect of fruit extracts. But if this were the only objection I should be disposed to accede to the respondents' application to adjourn the hearing of this matter in order to allow an application to be made under secs. 71 and 72 to expunge the registration of the appellants' trade marks in respect of fruit juices, for which a good *prima facie* case was made out upon the written proceedings brought before us. It is necessary, therefore, to deal with the objection founded upon sec. 114, which depends upon somewhat different considerations. That section 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 . . . shall be used or registered as a trade mark or part of a trade mark." That section was expounded by the House of Lords in the well known case of *Eno v. Dunn* (1). The test under that section is: Would the public be likely to be deceived, if this mark were registered, into thinking that the applicants' goods were really goods manufactured or sold by the opponents? It must be borne in mind that the label, if registered, may be of any size and any colour. It would be idle to contend that it was only intended to be used as a small black

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label a little larger than a postage stamp. The matter was dealt with by this Court in *Lever Bros. Ltd. v. Abrams* (1), where it was pointed out that there must be some nexus of similarity between the kinds of things to which the registered mark is applied and those as to which the new mark is sought to be applied. It is not necessary that they should be the same, but there must be some nexus of similarity. I think there is in substance such a nexus of similarity between preserved fruits, essence of coffee, and chicory on the one hand, and soluble cocoa essence and fruit extracts on the other, that persons might be induced to confound the owners of the one with the owners of the other.

The probability of deception is difficult to determine, and I should hesitate very much to decide against the applicants in this case but for the further rule laid down in *Eno v. Dunn* (2), which I follow, that is, that the onus lies on the applicant in cases of doubt to show that there is no probability of deception. I have come to the conclusion, after some hesitation, that the applicants have not discharged that onus, and, therefore, that registration ought to be refused in consequence of sec. 114. For this reason the appeal should be allowed.

BARTON J. I think it unnecessary to add anything to the judgment which has just been delivered, with which I entirely agree.

ISAACS J. read the following judgment:—I am also of opinion that this appeal should be allowed.

The respondents have failed to satisfy their obligation of negating the danger of deception. The well-known words of Lords Watson and Herschell in *Eno v. Dunn* (2) definitely settle that obligation. In a very recent case—*In re United Kingdom Tobacco Co.* (3)—Lord (then Mr. Justice) Parker said:—“Where a person applies for the registration of a new mark it is for him to show that that mark is free from all danger of leading, either on the part of the public or on the part of the trade, to deception or confusion.”

(1) 8 C.L.R., 609.

(2) 15 App. Cas., 252.

(3) 29 R.P.C., 489, at p. 496.



That is a very distinct onus, and if after considering all the relevant circumstances a doubt remains, the mark is not to be registered. The resources of art and ingenuity must be sufficient to create a distinctive mark for the applicant's goods, without creating at the same time a zone of danger either for other traders or the public.

The Commissioner says:—"The determination of the dispute between the parties rests solely on a comparison of the marks." It was argued that all the tribunal has to do in such a case is to look at the marks, and if visually they appear sufficiently different the matter is settled. If the Commissioner's words mean that, they need correction, and, in view of the contention before us, it is desirable to add a few words on this subject.

*In re Worthington & Co.'s Trade Mark* (1) shows that consideration must be given not merely to the label as it appears upon the document lodged for registration, but upon the possible appearance it may present, in whatever lawful form the registered owner may choose to use it, in the honest and ordinary course of trade.

In *In re Trade Mark of La Société Anonyme des Verreries de l'Etoile* (2) the very point was met by the Court of Appeal. *Lindley* L.J. said (3):—"Two marks may be calculated to deceive either by appealing to the eye or to the ear, or by one appealing to the eye and one to the ear." There, one firm had registered as a trade mark the device of a star, and their goods were known by the designation of "Star" or "Star Brand." The other firm registered the words "Red Star Brand" without any device. This was held objectionable, and was expunged on the application of the first firm. *Lindley* L.J. said (3):—"Finding that the applicants' glass is sold as 'Star' glass, or 'Star Brand' glass, and bearing in mind that the star may be in any colour, I cannot say that 'Red Star Brand' is not calculated to deceive." And so *per Kay* L.J. (4).

In the *United Kingdom Tobacco Co. Case* (5) Lord Parker thought that *prima facie* the two competing marks showed no

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(1) 14 Ch. D., 8.

(2) (1894) 2 Ch., 26.

(3) (1894) 2 Ch., 26, at p. 28.

(4) (1894) 2 Ch., 26, at p. 30.

(5) 29 R.P.C., 489, at p. 496.



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likelihood of deception or confusion, but added "that is not conclusive on the subject. There may be special considerations which induce the Court to infer that some confusion may arise, though from the words themselves *prima facie* it is unlikely that any such confusion would arise."

Then his Lordship referred to the evidence as to the way the public ordered the goods, and found that they in practice shortened the full registered trade mark in such a way as to tend to confusion in case the second were registered. He said (1) "there is a danger of the registration of this new mark leading to confusion or deception, not because the word does not distinctively differ from the word already on the register, but because of the tendency of the public to abbreviate, and to use the abbreviation of a brand as the ordinary designation in common parlance of that brand."

In the present case there is a large body of evidence, the truth of which cannot be doubted, showing that the appellants' goods are known at all events by a great many traders and others as "Star" goods.

That includes preserved fruits, and coffee, chicory and cocoa essences. I attach more importance to the preserved fruits than to the coffee, chicory and cocoa essences.

The question as to preserved fruits is whether as to them the applicants have discharged their burden by clearing their mark of danger of deception and confusion. This a question of fact dependent on the circumstances of the case. There are two of these circumstances which make me think they have not. One is the prominence of the star on their label, which, by means of energetic and not at all dishonest business measures, might easily, and I think would probably, lead to the star being regarded as the guide, and to the goods being spoken of as Star fruit extract. The device of the star would probably form an extremely vivid mental impression, which would find outward expression in the word Star itself. Then the next feature of prominence is the word "Trufruit." That is plainly intended to catch the eye, and impress itself on the mind. Preserved fruit is fruit treated in some way, probably compressed and flavoured, and between such

(1) 29 R.P.C., 489, at 497.