

[HIGH COURT OF AUSTRALIA.]

THE DAIMLER COMPANY LIMITED . APPELLANTS;

AND

THE REGISTRAR OF TRADE MARKS . RESPONDENT.

ON APPEAL FROM THE REGISTRAR OF TRADE MARKS.

H. C. OF A. *Trade Mark—Application to register—Distinctive mark—Word which is a surname*
1914.

MELBOURNE,
Sept. 10, 11,
14.

Griffith C.J.,
Isaacs,
Gavan Duffy
and Rich JJ.

—Order that word be deemed distinctive—Conditions—Appeal—Jurisdiction of
High Court—Trade Marks Act 1905-1912 (No. 20 of 1905—No. 19 of 1912),
secs. 16, 32, 34.

A refusal by the Registrar of Trade Marks of an application to him for an order under sec. 16 (1) (e) of the *Trade Marks Act 1905-1912* that a word be deemed a distinctive mark may be reviewed by the High Court.

Where it is sought to register as a trade mark a word which is a surname, a declaration must be obtained from the Registrar of Trade Marks under that section that the word shall be deemed to be a distinctive mark, and, having made such a declaration, the Registrar may then attach to the registration of the word as a trade mark such reasonable conditions as will protect the rights of any persons who before the application for registration have used the word with respect to their goods.

Held, upon the evidence, that the word “Daimler,” which was originally a surname, should be deemed to be a distinctive mark.

APPEALS from the Registrar of Trade Marks.

Two applications were made to the Registrar of Trade Marks by the Daimler Co. Ltd., of Coventry, England, to register as a trade mark the word “Daimler,” one in Class 22 in respect of motor cars, motor cycles, motor chassis and motor vehicles of all kinds included in that class, and the other in Class 6 in respect

of engines, motor car engines, traction motors other than agricultural, and aeroplanes.

The Registrar having informed the applicants that he was of opinion that the word was not a registrable trade mark but that he was prepared to hear the applicants upon the matter, a further application was made for an order under sec. 16 (1) (e) of the *Trade Marks Act* 1905-1912 that the word should be deemed a registrable trade mark.

The evidence showed that "Daimler" was the surname of a German inventor named Gottlieb Daimler who in the earlier stage of motor car development gave his name to companies in Germany, England and elsewhere, and was one of the original directors of the Daimler Motor Co. Ltd. which was formed in England in 1896, and to the business of which company the applicants succeeded in 1904. In one of the declarations it was stated that for four or five years after the formation of the Daimler Motor Co. Ltd. the word "Daimler" continued to signify in England goods made in accordance with Daimler's inventions, but that such inventions soon became entirely obsolete and that before the word was known on the Australian market it had lost in England all meaning except as part of the names of certain manufacturing companies and as the trade name adopted by the Daimler Motor Co. Ltd. It was also stated that no firm or company having the word "Daimler" as part of its name had ever carried on business or been registered in Australia, where the use of that word began in 1902 or 1904 as the name of the motor cars manufactured and exported by the applicants, and that the word had ever since then in Australia kept that meaning. It was further stated that the names "Milnes-Daimler" and "Austro-Daimler" or "Austrian-Daimler" had been applied to motor cars manufactured by other manufacturers, and that some motors bearing those names had been brought to Australia, but in very small numbers. It was also stated that so far as could be discovered the word "Daimler" was not the surname of any person in Australia.

The Registrar of Trade Marks held that the word "Daimler" was not in its nature adapted to distinguish the goods of the applicants from those of other persons, and that it had not

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

Mann, for the appellants.

Schutt, for the respondent, the Registrar of Trade Marks. No appeal is given by the *Trade Marks Act* 1905-1912 from a refusal by the Registrar to make an order under sec. 16 (1) (e) that a mark be deemed to be distinctive. The section seems to indicate that if the application is made to him his decision is to be final. [He referred to *In re Application of the Australian Milk Ferment Proprietary* (1).]

Mann. The intention of sec. 16 (1) (e), in giving power to the Registrar, Law Officer or Court to make the order, is that the order may be made by the Law Officer on appeal from the Registrar, or by the Court on appeal from the Registrar or from the Law Officer. The application for the order is part of an application under sec. 32 to register the trade mark, in respect of which an appeal lies under sec. 34.

GRIFFITH C.J. On the construction of sec. 16 (1) (e) I think the correctness of the Registrar's decision is open to review by this Court, whether the matter is regarded as an appeal from the refusal of the Registrar to make an order that the word shall be deemed a distinctive mark, or as incidental to a refusal by the Registrar to grant an application for registration of the word as a trade mark, or as an original application to this Court.

ISAACS J. I concur.

GAVAN DUFFY J. I do not think that a sufficient opportunity has been given to me to determine the question, and therefore I express no opinion upon it.

RICH J. I agree with what the Chief Justice has said.

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Mann. A word which is a surname may be a distinctive mark: *In re Joseph Crosfield & Sons Ltd.* (1); *In re Pope's Electric Lamp Co.'s Applications* (2); *In re R. J. Lea Ltd.'s Application* (3); *Teofani & Co. Ltd. v. A. Teofani* (4); *Daimler Motor Co. (1904) Ltd. v. London Daimler Co. Ltd.* (5). On the evidence the word "Daimler" is distinctive of the appellants' goods, and they are entitled to an order under sec. 16 (1) (e) of the *Trade Marks Act* 1905-1912. The rights of the public and of any persons who have used "Daimler" as part of the name by which they distinguish their goods are not rights which can be used against the appellants at the present time. There is machinery under the Act for protecting those rights. The only questions at present are: Is the word distinctive; and, if it is, are the appellants entitled to the sole use of it? The only effect of making the order asked for is to put the appellants in the same position as if the mark was within one of the other classes in sec. 16 (1). [He also referred to *In re Application of Actien Gesellschaft Apollinaris Brunnen vormals Georg Kreuzberg* (6); *James F. McKenzie & Co. v. Leslie* (7).]

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[ISAACS J. referred to *Registrar of Trade Marks v. W. & G. Du Cros Ltd.* (8).

GRIFFITH C.J. referred to *In re Application of Itala Fabbrica di Automobili* (9).]

Schutt. The Registrar has no power to attach a condition to the granting of an order under sec. 16 (1) (e), for under reg. 50 of the *Trade Marks Regulations* 1913 the making of such an order is equivalent to the registration of the trade mark. The evidence shows that the word "Daimler" has come to mean a particular kind of motor engine, and that it is not distinctive of the appellants' goods. The fact that other persons use the word "Daimler" in Australia as part of the name by which they call their goods shows that the word is not distinctive.

(1) (1910) 1 Ch., 130, at p. 148.

(2) (1911) 2 Ch., 382.

(3) (1912) 2 Ch., 32; (1913) 1 Ch., 446.

(4) (1913) 2 Ch., 545.

(5) 24 R.P.C., 379.

(6) 24 R.P.C., 436.

(7) 9 C.L.R., 247.

(8) (1913) A.C., 624.

(9) 27 R.P.C., 493, at p. 497.

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The judgment of the Court was delivered by

GRIFFITH C.J. These are appeals from the refusal of the

Registrar of Trade Marks to accept two applications for the registration of the word "Daimler" as a trade mark in respect of motor cars, aeroplanes and other machines of a like kind. The word "Daimler," which was the surname of one Gottlieb Daimler, a German, is said to come within clause (e) of the new list of registrable trade marks contained in sec. 16 (1) of the *Trade Marks Act* 1905 as amended in 1912, which is: "Any other distinctive mark" (that is, other than those previously enumerated), "but a name, signature, or word or words, other than such as fall within the descriptions in the above paragraphs (a), (b), (c) and (d) shall not, except by order of the Registrar, Law Officer, or Court, be deemed a distinctive mark."

For the purposes of these applications it is assumed, and rightly assumed, that "Daimler" is to be treated as a word, not a name of anybody, and therefore not as within clause (a); and it is also assumed to be a surname, which is expressly excluded by clause (d). It was therefore necessary, in order that the application for registration should be accepted, that a declaration should be obtained that the word should be deemed to be a distinctive mark. A great deal of evidence was given before the Registrar to establish that it was in fact distinctive of the applicants' goods. He was not satisfied with it, and declined to make the declaration. He therefore refused to accept the applications, and the matter now comes before us.

Upon the evidence it appears to us that the word "Daimler" has acquired in the Commonwealth of Australia a distinctive meaning, namely, that goods bearing that name are the product of the appellants' factory. It appears, however, incidentally that besides the products of the appellants' factory a few of the products of the factories of at least two other manufacturers, namely, the Austro-Daimler Co. and the Milnes-Daimler Co., have been brought to Australia, and it is suggested that if the word "Daimler" alone were registered as a trade mark those two companies might possibly be prejudiced. That may be doubtful, but there can be no objection to precautions being taken to prevent injustice being done to them, and the Court has ample power to secure their protection under the provisions of

the Act, which allows conditions to be imposed either on the acceptance or the registration of a trade mark.

Under these circumstances we think that, the applicants agreeing to be bound by such conditions, if any, as may be proper for protecting the right of any persons who had before the date of the applications *bonâ fide* used in the Commonwealth the word "Daimler" with respect to their goods, the Court should declare that for the purpose of the applications to the Registrar the mark applied for is to be deemed to be distinctive within the meaning of sec. 16 (1) (e), and that the Registrar should proceed with the applications accordingly. The matter will be referred back to the Registrar with this declaration and order. He will have power to impose such conditions as seem reasonable to him, subject, of course, to an appeal to this Court.

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Applicants agreeing to be bound by such conditions (if any) as may be proper for protecting the rights of any persons who had before the date of the applications bonâ fide used in the Commonwealth the word "Daimler" with respect to their goods, declare that for the purposes of the applications the mark applied for is to be deemed distinctive within sec. 16 (1) (e). Registrar to proceed with applications accordingly.

Solicitors, for the appellants, *Blake & Riggall*.

Solicitor, for the respondent, *Gordon H. Castle*.

B. L.